UPC CFI, Local Division Milan, 15 April 2025, Dainese v Alpinestars Research

PATENT LAW – PROCEDURAL LAW

UPC Milan Local Division has "universal" jurisdiction

- **regarding defendant domiciled in Italy (Article 32 UPCA, Articles 4(1)** EU Regulation Brussels Recast and amended by Reg. n. 542/2014.
- **If it is a Court of domicile, the UPC- as well as a National Court- has competence to adjudicate on infringement issues related to European patents validated in non-UPC countries.**

Source: Unified Patent Court

UPC Court of First Instance,
Local Division Milan, 15 April 2025
(Zana)
UPC_CFI_792/2024
App. N. 55795/2024
Final order
Order no. ORD_58591/2024
of the Court of First Instance of the Unified Patent Court delivered on 15/04/2025
Headnotes
1. The UPC "*shall be deemed to be a court of a Member State*" pursuant the Article 71a of the Regulation (EU) n. 1215/2012 (recast) as amended by Regulation (EU) 542/2014. Its interpretation provided for by the Court of Justice of the European Union apply to the UPC as it were a national court.
2. In light of Court of Justice decision in case C-339/2022, 25 February 2025, UPC Milan Local Division has universal jurisdiction to adjudicate on infringement issues related to European patents over the defendants domiciled in Italy pursuant to Article 32 UPCA as well as pursuant to Articles 4(1) and 71a and 71b of the Regulation (EU) n. 1215/2012 (recast) as amended by Regulation (EU) 542/2014. Different interpretation would have the effect of recognising that the UPC has less territorial jurisdiction than a national court, contrary to the provisions of Article 71a 7f the Regulation (EU) n. 1215/2012 (recast) as amended by Regulation (EU) 542/2014.
3. UPC Milan Local Division, in case it is the Court of the domicile of the defendant, has jurisdiction to adjudicate on infringement issues related to European patents validated in nonUPC Countries, in this case in Spain.

Keywords
rule 19 RoP, art. 31 and 34 UPCA, jurisdiction Spain
APPLICANT
Alpinestars Research S.P.A (Defendant n. 2 in the main proceedings)
RESPONDENTS
Dainese spa (claimant in the main proceedings)
PATENT AT ISSUE

Patent no.	Proprietor/s
EP4072364	Dainese S.p.A.
EP3498117	Dainese S.p.A.

DECIDING JUDGE
The judge rapporteur **Alima Zana**
Language of proceedings
English
Summary of facts
1. On 8 August 2024, Dainese spa brought an action alleging infringement of EP 364 in the "*Territory for Relief*" - defined as the territories of the Contracting Member States of the Unified Patent Court Agreement (hereinafter "UPCA") and Spain (p. 36 Statement of claim) against six defendants: precisely, for the purposes of this related proceedings, against Alpinestars Research s.p.a (defendant n. 2) domiciled in Italy. The claimant sought, inter alias, a permanent injunction preventing the Defendants or any of them from carrying out any further infringing acts of EP '364, Penalty payment in case of non-compliance, order to take corrective measures, Declaration of infringement, Recalling the products from the channels of commerce, definitive removal of the Infringing Products from the channels of commerce, the destruction of the Infringing Products and of the materials and implements concerned, order to give information, order to display and publish the decision, Damages- with joint and several liability- and Payment of legal costs.
2. On 11 October 2024, Defendant 2 filed preliminary objections in accordance with Rop 19, para. 1, RoP, requesting the Court to find:
A. The UPC lacks jurisdiction to decide on the alleged patent infringement
B. In the alternative to request A, the complaint is inadmissible due to
C. In the alternative to requests A and B, the UPC lacks jurisdiction on the alleged infringement in Spain of the Spanish national validation of EP 4072364 and consequently the complaint is dismissed with respect to the alleged infringement of the Spanish national validation of EP 4072364.
D. In the alternative request C, the period for lodging the Statement of defense is extended to a period of three months from the decision on this preliminary objection in accordance with R. 19.6 RoP.
E. Plaintiff bears the costs of the proceedings."
3. On 25.10.2024 Dainese filed its response to preliminary objection, requesting to dismiss the application.
Grounds of the decision
A. On alleged lack of Jurisdiction due to
[…]
B. On alleged inadmissibility due to

8.In the alternative, according to the defendant n. , the action introduced by Dainese would be inadmissible due to […]
9. This request falls outside the scope of **Rule 19 ROP** and cannot be included in a Preliminary Objection and is, therefore, inadmissible: indeed.
As pointed out by the UPC CoA "*the list of preliminary objections of **R. 19.1 RoP** must be regarded as exhaustive. The application of **R. 19** to **21 RoP** therefore cannot be extended to other defenses, such as abusive procedural conduct and manifest lack of foundation*" **(UPC CoA, UPC_CFI_471/2023, 2 September 2024 confirming the Mannheim Local Division**: "*The other arguments put forward by AYLO – that the action is abusive and manifestly unfounded – are not grounds for a preliminary objection within the meaning of **R. 19.1** RoP. These arguments are therefore not to be taken into account in the context of the decision pursuant to **R. 20.1 RoP**. Rather, the assessment will be made in the final decision on the merits, if necessary*").
In particular, The UPC CoA stated that "***R. 19** to **21 RoP** provide for a special procedure for deciding on preliminary objections. This procedure differs in several respects from the general procedure for dealing with defenses (**R. 23 et seq. RoP**) and the special procedure for deciding actions which are manifestly inadmissible or manifestly lacking any foundation in law (**R. 361 RoP**). For example, the failure to lodge a preliminary objection within the time period is treated as a submission to the jurisdiction of the Court and the competence of the division (**R. 19.7 RoP**), the preliminary objection is decided by the judge-rapporteur (**R. 20.1 RoP**) and the decision or order of the judge rapporteur is subject to appeal under certain conditions (**R. 21 RoP**).*
Against this background, this further argument of defendant 2 is also unfounded.

C. On the alleged lack of jurisdiction for Spain

10. Following considerations are made in accordance with:
- **the Regulation (EU) 1215/2012** (recast) as amended by Regulation (EU) 542/2014, in particular recitals nn. **13** and **15**, articles nn. **4**, **7**, **24 para. 4**, and **nn. 71a**, **71b**;
- **articles 31** and **34 UPCA**;
-The CGUE case law (seed in particular Case C-399/22 (CGUE, Grand Chambre, 25 February 2025);
- the UPC case law (see in particular Local Division Düsseldorf, 28 January 2025, Fujifilm v Kodak, UPC_CFI_355/2023; Paris, Local Division, 21 March 2025, UPC_CFI_702/2024).
11. The judge rapporteur notes that:
- the international jurisdiction of this Court shall be established in accordance with Regulation (EU) No 1215/2012 (**article 31 UPCA**);
- The UPC "*shall be deemed to be a court of a Member State*" pursuant **The Article 71a** - the Regulation (EU) 1215/2012 (recast) as amended by Regulation (EU) n. 542/2014;
- all the provisions set forth in the **EU Regulation Brussels Recast** (and their interpretation provided for by the Court of Justice) apply to the UPC as it were a national Court;
- in this regards, the recent decision of the Court of Justice (**Case C-339/22 (CGUE, Grand Chambre, 25 February 2025) ECLI:EU:C:2025:108**) declared as following:
*1) "**Article 24, point 4,** of Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, must be interpreted as meaning that: a court of the Member State of the defendant's domicile, seised under **Article 4(1)** of that Regulation of an action for infringement of a patent granted in another Member State, shall retain jurisdiction to hear and determine that action if, in the context of that action, the defendant disputes, by way of a plea, the validity of that patent, whereas jurisdiction to rule on that validity lies exclusively with the courts of that other Member State.*
*2) **Article 24, point 4**, of Regulation No 1215/2012 must be interpreted as meaning that: it does not apply to a court of a third State and, consequently, does not confer any jurisdiction, exclusive or otherwise, on such a court as regards the assessment of the validity of a patent granted or validated in that State. Where a court of a Member State is seised, on the basis of **Article 4(1)** of that regulation, of an action for infringement of a patent granted or validated in a third State in which the question of the validity of that patent is raised by way of a plea, that court shall have jurisdiction, pursuant to **Article 4(1),** to rule on that plea, since its decision in that regard is not capable of affecting the existence or content of that patent in that third State or of leading to the amendment of the national register of that State"*
-therefore, the Court of Justice recognises long-arm Jurisdiction to adjudicate on infringement issues related to European patents before the National Court of an EU Member State if it is the defendant Domicile taking into account that:
-the cited **article 24(4) Brussels I bis Regulation** is an exception and it must be interpreted in accordance with its objective: only disputes concerning the registration or validity of a patent are reserved to the Member State in which the patent was granted;
- *"Accordingly, a court of the Member State in which the defendant is domiciled, which has jurisdiction, under **Article 4(1)** of the Brussels I bis Regulation, in an action alleging infringement of a patent granted in another Member State, does not lose that jurisdiction merely because, as its defence, that defendant challenges the validity of that patent" (see paragraph 41, judgment of the Court of Justice, cited).*
12. It follows that the UPC, deemed to be a court of a Member State, in case it is the Court of the domicile of the defendant, has jurisdiction to adjudicate on infringement issues related to European patents validated in non-UPC Countries (so called long jurisdiction).
Indeed:
(i) **The article 71b of the Brussels I Regulation**, that governs the UPC's jurisdiction, expressly includes

disputes arising under European patents, even if they relate to non-Contracting States. This means that the regulation is not territorially limited to the contracting States;
(ii) **The article 34 UPCA** must be interpreted consistently; this rule seems rather only regulate the case in which the EP is not validated in the entire territory of the UPC**. Art. 34 UPCA** does not, however, contain any regulation regarding European patents that are validated outside the territory of the UPC well as before the UPC, even in States that do not take part in the UPC **(see Local Division Düsseldorf, Decision dated 28 January.2025, Fujifilm v Kodak (UPC_CFI_355/2023**).
This solution is not affected by the CoA decision (**UPC_CoA_388/2024, APL_39884/2024**), that revoked a preliminary injunction erroneously extended by the First Instance Court (Local Division of the Hague) to Ireland.
Indeed, in the above cited case, the applicant requested to extend the injunction against the respondent "*for the Contracting Member States in which the patent is in force*". The Court of Appeal has correctly revoked the First Instance order considering that Ireland was not (and it is still not) a Contracting Member State since it has only signed the UPCA which still has to be ratified.
Different interpretation would have the effect of recognising that the UPC has less territorial jurisdiction than a national court, contrary to the provisions of **Article 71a.**
13. It follows that in case a defendant is domiciled in Italy, the Milan Local Division jurisdiction is "*universal*", pursuant to **Article 32 UPCA** as well as pursuant **to Articles 4(1)** and **71a** and **71b** of EU Regulation Brussels Recast and amended by Reg. n. 542/2014.
14. In the case at issue, the defendant n. 2 challenges the territorial jurisdiction exclusively in respect of the alleged infringement in Spain of the Spanish national validation of EP 4072364. In the light of above considerations, the Judge rapporteur considers the preliminary objection unfounded.
15. Indeed, the defendant n. 2 has registered office in Italy, in an EU Membre State participating to the UPC system: Therefore, Milan Local Division is the Court of domicile.
Therefore, in accordance with the cited decision of the Court of Justice **(case C-339/22 CJEU**) directly applicable to defendant n.2, this Court, as Court of domicile, has jurisdiction over the violation of the Spanish portion of EP 364.
Indeed:
(i) if it is a Court of domicile, the UPC- as well as a National Court- has competence to adjudicate on infringement issues related to European patents validated in non-UPC countries.
In this case, at this stage, neither revocation action nor disputes concerning the registration or validity of a patent are been introduced against the Spanish national validation of EP 364.
This principle -the universal jurisdiction in respect to the defendant domiciled in a Contracting Member State- is confirmed by UPC case law before the cited Judgment of the Court of Justice (**UPC, Duesseldorf LD, decision of January 28, 2025, UPC CFI 355/202 Fujifilm/Kodak**)and after this decision (**see. Paris, Local Division, 21 March 2025, UPC_CFI_702/2024**).
For these reasons, the preliminary objection is dismissed.

D. The request to extend the period for lodging the statement of defence

16. In the light of the above considerations explained at point lett. B, the request raised by defendant n. 2 (on the extension of period for logging the Statement of defence) cannot be included in a Prel iminary objection and must to be dismissed.

The leave to appeal

17 The appeal may be lodged against this order within 15 calendar days of its notification to the losing party, in accordance with **Article 73(2)(a) UPCA** and **Rule 220.2 RoP.**

In the light of the above considerations

ORDER

1. The preliminary objection logded by Alpinestars Research spa -defendant n. 2- is dismissed;
2. The costs of the proceedings will be dealt with the main proceedings.

Milan,
15 April 2025
The Judge rapporteur Alima Zana

Information about appeal

An appeal to this order may be brought in accordance with **Art. 73 UPCA** and **R. 220.2 RoP** within 15 calendar days of the notification of this order

ORDER DETAILS

Order no. ORD_58591/2024 in ACTION NUMBER: ACT_45469/2024
UPC number: UPC_CFI_472/2024
Action type: Infringement Action Related proceeding no. Application No.: 55795/2024
Application Type: Preliminary objection
