

## THE EFFECT OF AN OPT OUT UNDER ARTICLE 83 OF THE AGREEMENT ON A UNIFIED PATENT COURT ON JURISDICTION FOR DECISIONS ON THE MERITS AND PRELIMINARY INJUNCTIONS<sup>1</sup>

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### 1. The Unified Patent Court and the issue of Article 83

Since the Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012, implementing enhanced cooperation in the area of the creation of unitary patent protection (Unitary Patent Regulation) and the Council Regulation (EU) No 1260/2012 of 17 December 2012, implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements (Regulation on Translation Arrangements) have been adopted in December 2012 and following that the Agreement on a Unified Patent Court (UPC Agreement) was signed on 19 February 2013, the creation of a Unitary Patent and of a Unified Patent Court to enforce it seem to be making steady progress towards implementation, which is expected early 2015. As of then, Unitary Patents, with effect in all Member States participating in the enhanced cooperation can be obtained and the first action can then be launched in the Unified Patent Court.

It is clear that the Unified Patent Court will have exclusive jurisdiction for the infringement and validity of Unitary Patents right from the start, without any exception. In addition to that, the Court is also intended to have exclusive jurisdiction for traditional European patents, which will remain a permanent alternative for the Unitary Patent. However, giving unconditional exclusive jurisdiction for those patents to a court that does not exist yet and that will apply rules that are not yet completely known was one step too far. Therefore, the UPC Agreement contains a transitional regime which will initially apply for a period of at least 7 years, but may even be prolonged.

According to Article 32 UPC Agreement (UPCA), the Unified Patent Court will inter alia have exclusive competence for actions for actual or threatened infringements of patents and supplementary protection certificates and related defences, including counterclaims concerning licences, actions for declarations of non-infringement of patents and supplementary protection certificates, actions for provisional and protective measures and injunctions and for actions and counterclaims for revocation of patents and for declaration of invalidity of supplementary protection certificates, both for Unitary Patents and for traditional European patents, the latter of course only with regard to countries participating in the UPC Agreement.

This would mean that immediately upon the court going live, central attacks on the validity of European patents would become possible, whereas currently these are the exclusive jurisdiction of each country of registration of the national parts of such patent, due to Article 24(4) Brussels I Regulation. In order to enable patent owners to prevent this immediate effect, Article 83(1) UPCA provides that during a transitional period of seven years after the date of entry into force of the Agreement, an action for infringement or for revocation of a traditional European patent or an action for infringement or for declaration of invalidity of a supple-

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<sup>1</sup> This publication was concluded on 28 August 2013, when the implementation was still in full progress.

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mentary protection certificate issued for a product protected by a traditional European patent may still be brought before national courts or other competent national authorities. This section thus deals with the jurisdiction of the national courts over traditional European patents.

In addition, Article 83(3) UPCA provides that unless an action has already been brought before the Court, a proprietor of or an applicant for a traditional European patent granted or applied for prior to the end of the transitional period as well as a holder of a supplementary protection certificate issued for a product protected by a traditional European patent, shall have the possibility to opt out from the exclusive competence of the Court, which thus deals with the jurisdiction of the UPC. Whereas it is clear that the intention of this provision is that filing an opt out shall block the jurisdiction of the Unified Patent Court with regard to validity of traditional European patents and SPC's for such patents, it is less clear what the effect for infringement actions would be.<sup>4</sup> That would probably not have been an issue if Article 83(3) UPCA simply provided that a patent owner can opt out from the competence of the Unified Patent Court, but the addition of the word "exclusive" has raised questions.

## 2. The effect of an opt out on actions on the merits

Basically there are two possible interpretations. First, the phrase "opt out from the exclusive competence" may simply have been worded that way because Article 32 contains the phrase that "the Court shall have exclusive competence in respect of" and may thus have been intended as a simple reference to the competence of the Court in general, which happens to include the word "exclusive" in Article 32. This interpretation would indeed mean that an opt out for a given traditional European patent fully blocks out the Unified Patent Court's competence with regard to that patent.

However, especially in the light of Article 83(1), which provides a choice to bring actions either before the UPC or before the national courts during the transitional period, the intention of Article 83(3) UPCA may also have been to only exclude the exclusivity of the UPC's competence, but not its jurisdiction as such. On the other hand, that interpretation poses a problem, since in that case it would at least not be clear from the text of the provision that an opt out blocks the jurisdiction of the UPC with regard to validity of a traditional European patent, which undoubtedly was an objective of this provision.

In the meantime a proposal for a Regulation of the European Parliament and of the Council amending Regulation (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Brussels I Amendment)<sup>5</sup> was published on 26 July 2013, which *inter alia* has as an objective to define the operation of the rules on *lis pendens* during the transitional period referred to in Article 83(1) UPC Agreement (ground 3 for the amendment) and also provides for an explicit inclusion of the UPC as a court within the meaning of the Brussels I Regulation. To that end, a proposed Article 71c prescribes that the rules of the Brussels I Regulation (recast) apply when, during the transitional period referred to in Article 83(1) UPC Agreement, proceedings are brought before the Unified Patent Court on the one hand and before the national courts of Contracting Member States to that Agreement on the other hand. To that end, Article 71c of the Brussels I Amendment simply provides that Articles 29 to 32 shall apply where during the transitional period referred to in Art. 83(1) of the UPC Agreement proceedings are brought in the Unified Patent Court and in a court of a Member State party to the UPC Agreement. Unfortunately, it remains unclear

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<sup>4</sup> See for example: Jeremy Morton, [The Unified Patent Court Transitional Regime – Why the Drafting is Flawed](#), CMS Cameron McKenna, p. 3; [A Guide through Europe's New Unified Patent System](#), McDermott Will & Emery, p. 10.

<sup>5</sup> [COM\(2013\) 554 final](#), 2013/0268 (COD), European Commission 2013

whether Articles 29 and 30 Brussels I Regulation (recast) still need to be applied in case of an opt out, or whether these are basically made redundant by the opt out.

## **2.1 Conclusion on actions on the merits**

It is unfortunate that Article 83 UPCA has not been worded more clearly and that the Brussels I Amendment has not shed any additional light on the issue. On balance, it seems more likely that an opt out completely blocks the competence of the Unified Patent Court for actions on the merits resulting in a final adjudication than that it would leave the option for the patentee to still bring an action for infringement after he opted out.

However, Article 83(4) UPCA provides for withdrawing an opt out. This provision does not define what acts constitutes such a withdrawal, it only provides that the Court Registry should be “notified accordingly in this event”. Since there are no specific requirements in the UPC Agreement itself, any suitable event can constitute a withdrawal. Such withdrawal may considerably mute the whole issue.

The UPC Agreement contains no details on how litigation is actually conducted. This will be in the Rules of Procedure as meant in Article 41 UPCA. In the meantime the 15th draft of these Rules of Procedure has been published for public consultation. Rule 4 provides that written pleadings and other documents shall be lodged at the Registry in electronic form. Under Rule 12 and 13, an infringement action is started by lodging a Statement of claim with the chosen division, which according to Rule 4 is done at the Registry. In our view, it seems quite possible that such a lodging of a Statement of claim should also be viewed as a withdrawal of the opt out, of which the Registry is thereby accordingly notified. It may be preferable to somewhat adapt Rule 5 to this situation.

Article 83(4) UPCA provides that withdrawal of an opt out would not be possible if an action has already been brought before a national court. Again, it is unclear whether this refers to actions for invalidity only, or also to actions for infringement. The latter would not seem logical in the view of Article 83(1) UPCA, nor Article 71c Brussels I Amendment. Besides, why should a patent owner who discovers a limited infringement in a country where litigation is cheap and who therefore decides to go to the national court in that country be excluded from taking his case to the UPC if the infringement subsequently spreads out all over Europe? In that perspective, it would be good if blocking the withdrawal of an opt out would be limited by the UPC to pending invalidity actions. In fact, a restrictive approach of Article 83(4) UPCA would be desirable. Why should the patent owner be prevented from bringing an action in the UPC? In view of the current (and more recent) proposal for the Brussels I Amendment, the issue in our view is now sufficiently covered by articles 71c(2), 29 and 30 Brussels I Regulation, as a consequence of which the UPC should suspend a case for those countries where prior national actions are pending. No further limitations would be needed, but of course the restriction in Article 83(4) UPCA cannot be ignored completely without amending the Agreement, so it should be downplayed as much as possible.

Whatever the correct interpretation of all of this should be, it is clear that the contracting parties have failed to shed sufficient light on the issue and therefore it is now for the Unified Patent Court itself to decide it once it has gone live.

## **3. Preliminary injunctions**

The issue gets even more complicated in case of a preliminary injunction. Article 24(1)a UPCA provides that Union law takes priority over the UPC Agreement and Article 31 UPCA provides that jurisdiction shall be established in accordance with the Brussels I Regulation. Also,

in view of the light of Article 5 Unitary Patent Regulation and its history, it is quite clear that both the European Union and the contracting Member States of the enhanced cooperation agreed that Union law should have priority. Now, Article 35 of the Brussels I Regulation (recast) provides that “application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that Member State, even if the courts of another Member State have jurisdiction as to the substance of the matter”. Under Consideration 11 of the Brussels I Regulation (recast) and certainly under the proposed Brussels I Amendment it is clear the Unified Patent Court is a court as meant in Article 35.

Does this mean that Article 35 of the Brussels I Regulation (recast) provides for jurisdiction for the Unified Patent Court to grant a preliminary injunction as meant in Article 62(1) UPCA for a traditional European patent which has been opted out, even if the correct interpretation of Article 83(3) UPCA would be that the UPC in such case would not have jurisdiction in infringement actions on the merits?

Several points need to be discussed before the question on the jurisdiction for preliminary injunctions can be answered. First of course the competence of the UPC in the transitional period needs to be discussed, which has been done in the previous paragraphs. Subsequently the revocation of provisional measures when proceedings on the merits are not brought before the UPC will be described. Furthermore the consequences of the proposed amendments to the Brussels I Regulation will be treated and the applicability of the Brussels I Regulation to the UPC. Then the provisions in the UPC Agreement that describe the UPC as a common court will be discussed.

### **3.1 Revocation of provisional measures**

The question on jurisdiction for provisional measures is limited in relevance by the fact that the provisional measures must eventually be revoked if the UPC has no jurisdiction on the merits.

Articles 62 and 60 UPCA govern provisional and protective measures that can be given by the UPC. Article 60 UPCA mainly concerns orders to preserve evidence, but on the basis of Article 62(5), sections 60(5) to 60(9) are also applicable to provisional and protective measures as meant in Article 62, including preliminary injunctions.<sup>6</sup>

Article 60(8) in conjunction with Rule 213 states that the UPC must, at the defendant's request, ensure that the provisional or protective measures are revoked or cease to have effect if proceedings have not been started on the merits of the case within the specified time period in the Court's order, not exceeding 31 calendar days or 20 working days (whichever is longest). Note that to satisfy this requirement it is not sufficient to bring proceedings on the merits in a national court of a Member State that would have jurisdiction, since Article 60(8) states that these proceedings must be brought "before the Court", which is an exclusive reference to the UPC under Article 2(a) UPCA.

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<sup>6</sup> Callens & Granata may be read to suggest that these subsections only apply by analogy to provisional measures relating to evidence and freezing orders, but we doubt whether this was actually their intention; it may be just a question of wording. See P. Callens & S. Granata, *Introduction to the Unitary Patent and the Unified Patent Court. The (Draft) Rules of Procedure of the Unified Patent Court*, Deventer: Kluwer 2013, p 118, last paragraph. Also, the draft Rules of Procedure would contradict such view, since provisions from those subsections are incorporated in Rules 212 and 213 for all provisional and protective measures.

As we assumed for the purpose of this part of the discussion, the UPC would not have jurisdiction on the merits for an opt out patent. Therefore, assuming the UPC has jurisdiction for provisional measures and providing that the defendant makes the request for revoking the measures, the provisional measures could only have effect for this maximum time period. The question is then whether this period can be extended by starting the proceedings on the merits, even though it is clear that the UPC lacks jurisdiction. In such a case Rule 361 would apply: before the UPC can decide that the application is manifestly inadmissible it has to give the parties an opportunity to be heard. Thus, the effect of the provisional measures could be extended in this manner until after the UPC has decided on the admissibility. This may however be an abuse of the UPC's procedure. It is unclear if this could be a ground for earlier revocation of the measures. If that is not the case the applicant may be liable for damages, given the concepts of "abuse of process" in common law and "abuse of rights" in civil law.

However, since this is the predictable outcome of the action, the UPC should and most likely will take this into account when making the assessment under Article 62(2) UPCA, weighing up the interests of the parties and in particular taking into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.

Thus, if the UPC has jurisdiction regarding provisional measures, it can be expected that these measures will in general only have effect for a maximum period of 31 calendar days or most likely even refused based on either an abuse of procedure or a simple weighing of the interests. Additionally, in case provisional measures were granted and later revoked, the UPC can order the applicant to pay to the defendant damages suffered as a result of executing the provisional measures.

Interestingly this also seems to be the case if the measures themselves were granted on good grounds, but were revoked or lapsed due to an act or omission by the applicant, such as not bringing proceedings on the merits. Thus, if the UPC would have jurisdiction to order provisional measures concerning an opt out patent, it would be possible that the applicant of such measures would face an obligation to pay damages for executing these measures, once they have been revoked.<sup>7</sup>

### **3.2 Applicability of the Brussels I Regulation**

The proposed Articles 71a to 71d of the Brussels I Amendment govern the application of the Brussels I Regulation (recast) to the common courts, including explicitly the UPC and the Benelux Court of Justice. Without the proposed amendments the Brussels I Regulation (recast) would also apply to the UPC, as recital 11 in the preamble states that courts common to several Member States are regarded as "courts of the Member States" for the purpose of the Regulation.<sup>8</sup> This was specifically added in the recast in December 2012 for this purpose. Article 1 further clarifies that the Regulation applies "whatever the nature of the court or tribunal". The Commission however notes that this recital is not of binding nature and does not provide sufficient legal certainty.<sup>9</sup> Additionally, as mentioned before, the UPC Agreement states in Article 31 that the "international jurisdiction of the Court" shall be established in accordance with the Brussels I Regulation (1215/2012) or the Lugano Convention.

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<sup>7</sup> The revocation being inevitable due to the lack of jurisdiction of the UPC on the merits, except if the defendant would fail to request revocation.

<sup>8</sup> See also P. Callens & S. Granata, *Introduction to the Unitary Patent and the Unified Patent Court. The (Draft) Rules of Procedure of the Unified Patent Court*, Deventer: Kluwer 2013, p 85.

<sup>9</sup> COM(2013) 554 final, p. 5.

### 3.3 Status of the Unified Patent Court

The UPC Agreement stresses that the UPC is a court common to the participating Member States and that it is part of the judicial system of those Member States. The preamble to the UPC Agreement states:

*Considering that the Unified Patent Court should be a court common to the Contracting Member States and thus part of their judicial system, with exclusive competence in respect of European patents with unitary effect and European patents granted under the provisions of the EPC;*

Article 1 of the Agreement:

*The Unified Patent Court shall be a court common to the Contracting Member States and thus subject to the same obligations under Union law as any national court of the Contracting Member States.*

Article 21 of the Agreement:

*As a court common to the Contracting Member States and as part of their judicial system, the Court shall cooperate with the Court of Justice of the European Union to ensure the correct application and uniform interpretation of Union law, as any national court, in accordance with Article 267 TFEU in particular. [...]*

As consequence of the fact that the UPC is a court common to the Member States it is the Member States that are responsible for any breaches of Union law by the UPC, Article 22(1) of the Agreement:

*The Contracting Member States are jointly and severally liable for damage resulting from an infringement of Union law by the Court of Appeal, in accordance with Union law concerning non-contractual liability of Member States for damage caused by their national courts breaching Union law.*

Finally, Article 23 of the Agreement states:

*Actions of the Court are directly attributable to each Contracting Member State individually, including for the purposes of Articles 258, 259 and 260 TFEU, and to all Contracting Member States collectively.*

### 3.4 Jurisdiction of the UPC for provisional measures based on Article 35 Brussels I Regulation

We believe that Article 35 of the Brussels I Regulation cannot establish jurisdiction for the UPC in proceedings on provisional measures in case of an opt out patent where the UPC has no jurisdiction on the merits. The arguments for this will be given below. First, we will contrast two views of the relationship between the UPC and the Brussels I Regulation that give different answers to the present question on jurisdiction. Secondly the reasons for supporting the view of the UPC as a national court from the perspective of Union law will be listed. Next, arguments will be drawn from the enforcement provisions and from an analogy with the Benelux Court of Justice. The reference to the UPC Agreement in the proposed art. 71a(1) will be discussed. Finally the internal jurisdictional rules for regular courts will be treated.

### 3.4.1 Two different views on the relationship between UPC and Brussels I Regulation

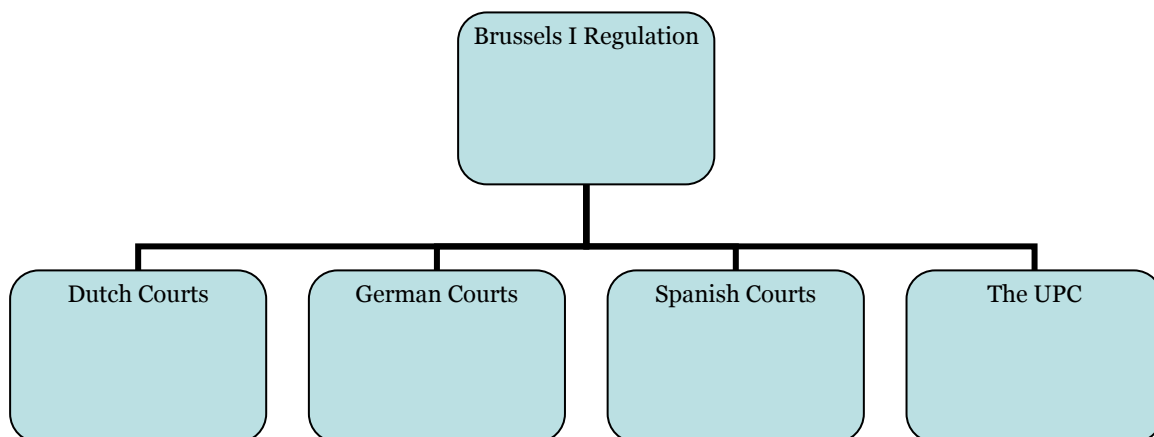
To answer the question on the jurisdiction of the UPC pursuant to Article 35 Brussels I Regulation in case of opt out patents, the first question that should be dealt with is the nature of the relationship between the UPC and the Brussels I Regulation. Two different views of that relationship will lead to different conclusions on the jurisdiction of the UPC under the Brussels I Regulation.

The first view is illustrated in Figure 1 below.<sup>10</sup> The UPC stands beside the national courts in its relationship to the Brussels I Regulation. In this view, for example, the UPC Agreement would not be compatible with Article 24(4) of the Brussels I Regulation. This is the reasoning followed by R. Pinckney:

*"The Brussels I Regulation currently gives the national court of a Member State exclusive jurisdiction for revocation actions concerning European Patents registered in that Member State [Article 24(4) of the Brussels I Regulation]. [...] [F]or revocation and infringement proceedings concerning European Patents during the transitional period, jurisdiction is shared between the UPC and national courts of Member States. [...] The Brussels I Regulation will need to be amended to allow for the non-exclusive jurisdiction provided for in Article 83(1) of the UPC Agreement."<sup>11</sup>*

That reasoning is in our view that because Article 24(4) bestows jurisdiction on the courts of a certain Member State, the UPC cannot also have jurisdiction.

Under this view the UPC is seen as being a separate entity next to the courts of the Member States. Therefore, if this view is applied to the present question, the UPC would have jurisdiction under Article 35 of the Brussels I Regulation, because Article 35 gives jurisdiction to "courts of the Member State"<sup>12</sup> for provisional measures even if courts of another Member State have substantive jurisdiction.



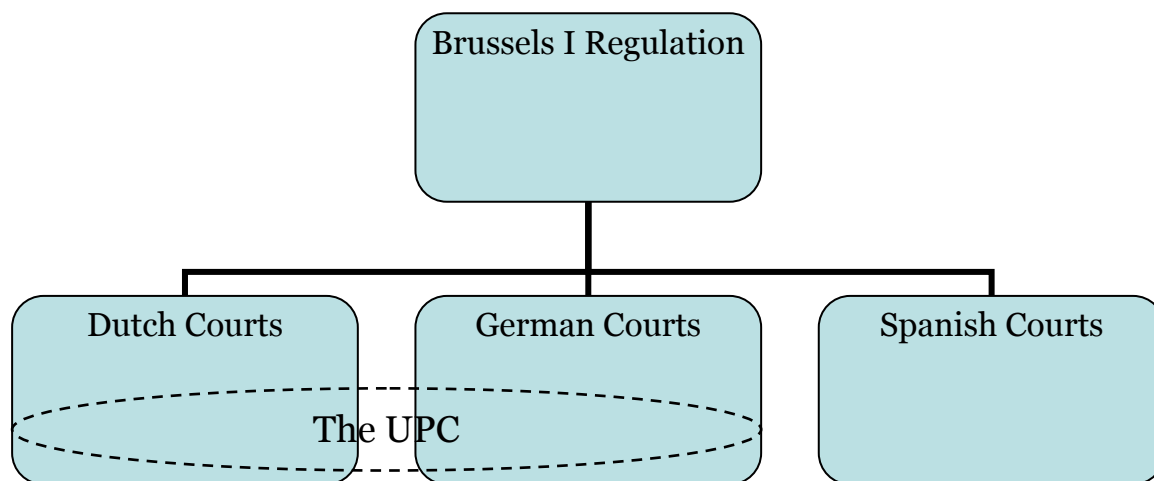
**Figure 1**

<sup>10</sup> For clarity the Benelux Court of Justice is omitted from the figures and only three national courts have been included: the national courts of two contracting member states to the UPC Agreement and the courts of one member state that does not participate in the UPC Agreement.

<sup>11</sup> R. Pinckney, *Will amendments to the Brussels I Regulation delay the start-up of the UPC?*, *Bristows*, 19/02/2013: <http://www.bristows.com/articles/will-amendments-to-the-brussels-i-regulation-delay-the-start-up-of-the-upc>

<sup>12</sup> The proposed art. 71a(1) states that the term "court of a member state" can be applied to the UPC.

The second view is illustrated by Figure 2. In this view the UPC forms a part of the court systems of the participating Member States. Under the Brussels I Regulation the jurisdiction would be assigned to a Member State<sup>13</sup>, with the internal law of that Member State then determining the division of jurisdiction between the courts of that Member State.<sup>14</sup> In determining the division of jurisdiction between UPC and the national courts this internal law would be constituted by the UPC Agreement (or, where needed under national constitutional law, its implementation into national law).



**Figure 2**

For example, in case of a Dutch defendant in infringement proceedings the Brussels I Regulation would establish jurisdiction for the courts of the Netherlands. It is then the UPC Agreement that determines the division of the jurisdiction between the Dutch national courts and the UPC. Should the Brussels I Regulation establish jurisdiction for two Member States party to the UPC Agreement and the UPC Agreement establishes jurisdiction for the UPC, it would be the UPC Agreement that would determine the division of the UPC that has jurisdiction. In the relation between Spain<sup>15</sup> and the UPC, the Brussels I Regulation applies as with any national court of the other Member States.

In this view the UPC would not have jurisdiction for provisional measures based on Article 35 of the Brussels I Regulation for an opt out patent. Article 35 would give jurisdiction to the courts of each Member State for provisional measures. The courts of the Netherlands for example would thus have jurisdiction.<sup>16</sup> The UPC Agreement then, in the relation between the Dutch courts and the UPC, would determine that for an opt out patent it is the Dutch national courts that have jurisdiction instead of the UPC.

Under Article 94 of the Dutch Constitution, most provisions of the UPC Agreement, including Articles 31, 32 and 83, would have direct effect within The Netherlands. The history of Article 5(3) of the UPC Regulation confirms that it was the intention that the provisions of the UPC

<sup>13</sup> Some provisions of the Brussels I Regulation not only establish jurisdiction of a member state, but also establish which court in the member state has jurisdiction, for example article 7(2). These however are not applicable for patent litigation.

<sup>14</sup> S.J. Schaafsma, 'Samenloop van EEX en BVIE', IER 2012/74, §9.

<sup>15</sup> As Spain is not participating in the UPC Agreement. Also, a UPC decision would not have effect in Spain due to Article 34 UPCA.

<sup>16</sup> Providing that the condition of the "real connecting link" from the Van Uden judgement, CJEU C391/95, is met.



Agreement would have effect as national law. In The Netherlands this would in principle not even require an implementation, although it seems likely that Article 80 of the Dutch Patent Act, which gives exclusive jurisdiction in infringement and validity matters in first instance to the District Court The Hague, will be amended in order to be in conformity with the UPC Agreement. Of course, this may be different in other countries and more extensive implementation may be needed.

We believe that the second view is clearly supported by provisions in the Brussels I Regulation and the UPC Agreement for the following reasons.

### **3.4.2 Provisions on the UPC as a national court from the perspective of European Union law**

In the preamble, Article 1 and Article 21 of the UPC Agreement the UPC is referred to as a "court common to the Contracting Member States" and "part of their judicial system", as mentioned above. The provisions establishing the UPC are not European Union law<sup>17</sup> and the UPC is not an institution created by Union law. From the view of Union law the UPC is thus a national institution of each of the contracting Member States.

That the UPC is seen as a national court from the perspective of Union law is further supported by the provisions in Articles 21, 22 and 23 of the UPC Agreement. In Article 21 it is stated that the UPC shall cooperate with the CJEU "as any national court". In Article 22 it is stipulated that the Member States are liable for damages resulting from infringement of Union law by the UPC, in the same manner as they are liable for such damages caused by breaches by their national courts. Article 23 states that the actions of the UPC are directly attributable to each Contracting Member State.

The proposed amendments of the Brussels I Regulation also describe the UPC as a court of a Member State. Article 71a(1) states that for the purposes of the Brussels I Regulation a common court shall be "a court of a Member State". Pursuant to Article 71b(1) it has jurisdiction, if under the Brussels I Regulation, the courts of a Member State party to the agreement have jurisdiction.

### **3.4.3 The enforcement provisions**

The proposed provisions on the enforcement of judgements also support the view of the UPC as part of the national court systems. Instead of providing that the judgements given by the UPC shall be recognized and enforced, Article 71c(a) only provides for the recognition and enforcement in Member States that are not a contracting state. It is therefore the UPC Agreement that governs enforcement of UPC judgements in contracting Member States.

It should be noted that these provisions are, as stated in the explanatory memorandum<sup>18</sup>, clarifications. This can also be deduced from the provision for the mirror situation of Article 71d(b), as also without this provision the judgements of the non-contracting Member States would have to be enforced. The fact that special provisions have been created for the enforcement of UPC judgements therefore does not indicate that without those provisions these judgements cannot be enforced.

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<sup>17</sup> Section 0 *supra*; P. Callens & S. Granata, *Introduction to the Unitary Patent and the Unified Patent Court. The (Draft) Rules of Procedure of the Unified Patent Court*, Deventer: Kluwer 2013, p 51.

<sup>18</sup> COM(2013) 554 final, p. 3.

### 3.4.4 The Benelux Convention on Intellectual Property

Schaafsma has commented on the application of the jurisdictional rules established in the Benelux Convention of Intellectual Property (BCIP) for the case that the BCIP cannot be regarded as falling within the scope of Article 71 of the Brussels I Regulation, in which case the Brussels I Regulation has priority over the rules given in the BCIP.

In Schaafsma's opinion, if the Brussels I Regulation would establish jurisdiction for the courts of one of the Benelux Member States (for example based on art. 22(4)), it would then be the BCIP<sup>19</sup> as internal law that would establish which court within the Benelux area has jurisdiction.<sup>20</sup>

When applying this reasoning *mutatis mutandis* to the UPC and Article 35 of the Brussels I Regulation, the result is that if Article 35 establishes jurisdiction for one of the contracting Member States, it is then the UPC Agreement that governs the division of the jurisdiction between the courts of the Member State and the UPC.

### 3.4.5 The reference to the UPC agreement in the proposed art. 71a(1) Brussels I Amendment

In support of asserting jurisdiction for the UPC in provisional measures with an opt out patent it may be argued that this is established by the combination of the proposed art. 71a(1), with the definition of "a court of a Member State" extended to include the UPC, and art. 35, which gives jurisdiction to the "courts of a Member State".

In addition to the arguments already given, we would contradict this by pointing to the condition given in the proposed Article 71a: "when, pursuant to the agreement establishing it, it exercises jurisdiction". Thus, the UPC only falls under the definition of a "court of a Member State" for the Brussels I Regulation when it exercises jurisdiction in accordance with the UPC Agreement, so the matter is then referred back to the interpretation of Article 83(3) UPCA. Since, for the purpose of this part of the discussion, we have assumed that the UPC Agreement does not provide for jurisdiction in case of an opt out patent, the Brussels I Regulation then cannot give the UPC this jurisdiction.

### 3.4.6 Internal jurisdictional rules

Under Dutch law the District Court of The Hague has exclusive jurisdiction in cases of patent infringement, both on the merits and for provisional measures.<sup>21</sup> Consider the case where in patent infringement proceedings for provisional measures the Dutch courts have jurisdiction based on art. 35 of the Brussels I Regulation. In this case the District Court of Rotterdam cannot assume jurisdiction based on art. 35, because of the jurisdictional rules in the internal law of the Netherlands. Even though Article 35 establishes jurisdiction for the Dutch courts, that does not mean that every court of the Netherlands has jurisdiction. When the UPC is seen as a national court from the perspective of the Brussels I Regulation, as has been argued above, the same applies. The courts of the Netherlands would have jurisdiction based on the Brussels I Regulation, with the UPC Agreement then governing whether the UPC has jurisdiction (since, as mentioned above, the Articles 31, 32 en 83 UPCA have direct effect within The Netherlands, even if Article 80 Dutch Patent Act were not changed).

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<sup>19</sup> Article 4.6 BCIP.

<sup>20</sup> S.J. Schaafsma, 'Samenloop van EEX en BVIE', IER 2012/74, §9.

<sup>21</sup> Art. 80 Rijksoctrooiwet 1995.

## 3.5 Conclusion on preliminary injunctions

Two different views have been presented on the application of the Brussels I Regulation to the UPC: the view where the UPC stands besides national courts for this application and the view where the UPC is part of the court systems of the participating Member States. The assumption was that the correct interpretation of Article 83(3) would be that the Unified Patent Court would not have jurisdiction in a case on infringement on the merits. In the first view the UPC would have jurisdiction under Article 35 of the Brussels I Regulation in provisional measures for an opt out patent and in the second the UPC would not have jurisdiction.

The second view is supported by references to the UPC as a "court common to the contracting Member States", "part of their judicial system" and "as any national court" and by the fact that the provisions establishing the UPC are not European Union law.

Furthermore the enforcement provisions present in the proposed amendments of the Brussels I Regulation only refer to the relationship between the UPC and the non-contracting Member States, as the relationship between the UPC and the contracting Member States is governed by the Agreement. Schaafsma's opinion on the application of the jurisdictional rules of the BCIP also supports the second view.

Finally, art. 71a(1) of the proposed amendments to the Brussels I Regulation provides that the Brussels I Regulation only applies to the UPC when it exercises jurisdiction pursuant to the UPC Agreement. The UPC cannot thus have jurisdiction if this is not provided for in the UPC Agreement. Article 71a(1) seems to be a *lex specialis* that takes priority over Article 35 Brussels I Regulation (recast).

Our conclusion therefore is that the Unified Patent Court does not have jurisdiction to grant preliminary injunctions if under Article 83(3) UPCA it does not have jurisdiction to grant final injunctions.

If, despite these reasons, the Unified Patent Court would have jurisdiction for provisional measures for an opt out patent, there is still another problem. This is the prescribed revocation of those measures at the request of the defendant when the proceedings on the merits are not brought before the UPC itself within a certain time or the proceedings on the merits are inadmissible. This will most likely in itself already block the grant of any such preliminary injunction.

Of course, as we discussed above for actions on the merits, filing an application for a preliminary injunction might well be considered a withdrawal of the opt out which, dependent on the interpretation of article 83(4) UPCA with regard to pending national actions, may create jurisdiction for the Unified Patent Court after all. That would then of course also expose the patent owner to a central attack on the validity if his traditional European patent.

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