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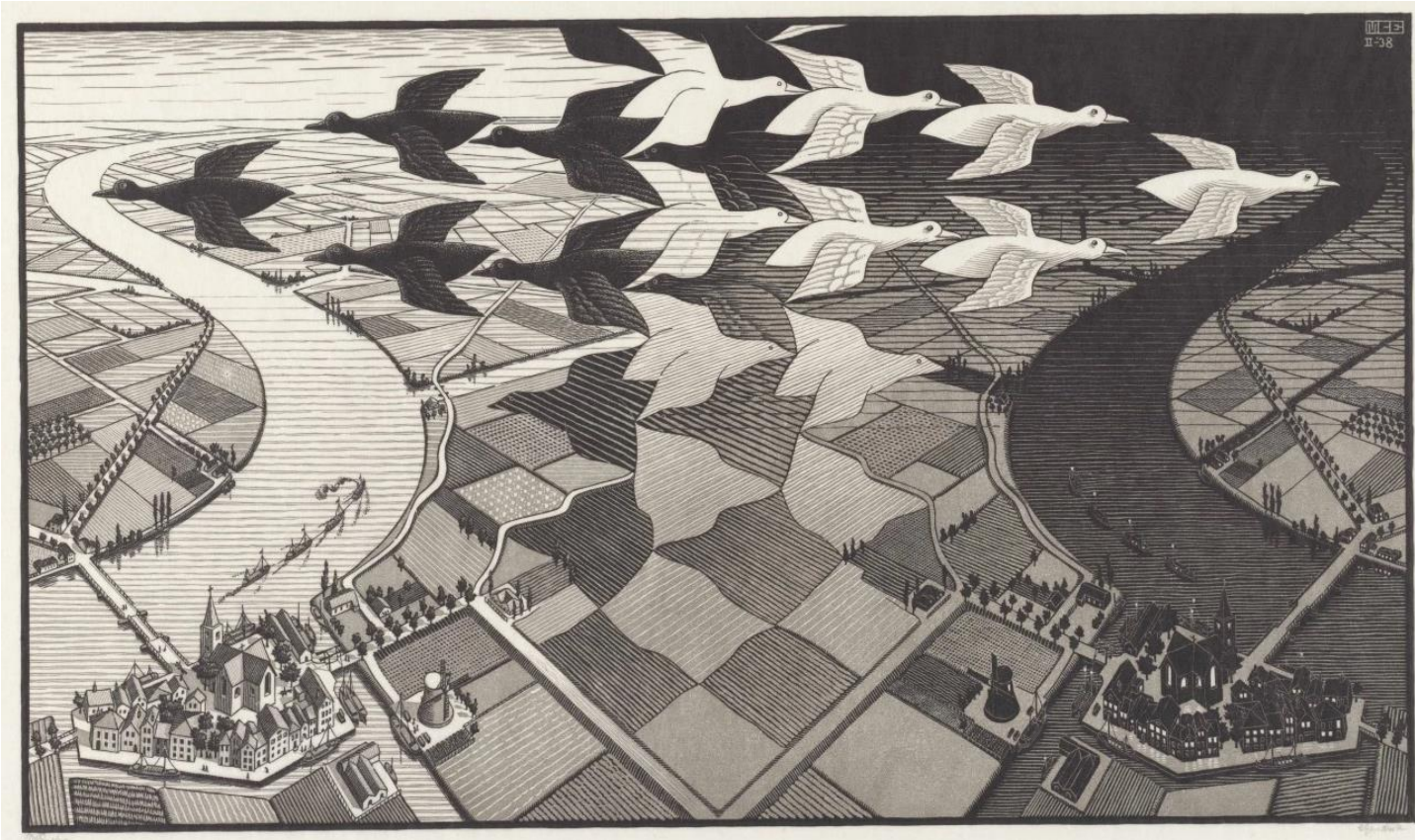
An enigma behind an illusion: applicable law before the UPC

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MC Escher, 'Dag en nacht' (1938)



Overview of the argument

The substantive law of the UPCA applies to EP's litigated before the UPC, because:

1. The text of Articles 3 and 25-27 UPCA unambiguously suggests substantive law applies to EP's and EPUE's alike
 2. The adoption of uniform substantive provisions aligns with the intentions of the UPCA's drafters
 3. Rules on validity are also harmonized before the UPC
 4. Article 34 UPCA necessarily presupposes uniform substantive law throughout UPC territory
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1. First concern: international jurisdiction and Article 34 UPCA
 2. Second concern: what about opt-outs?

The text of Articles 3 and 25-27 UPCA

Article 3

Scope of application

This Agreement shall apply to any:

- (a) European patent with unitary effect;
- (b) supplementary protection certificate issued for a product protected by a patent;
- (c) European patent which has not yet lapsed at the date of entry into force of this Agreement or was granted after that date, without prejudice to Article 83; and
- (d) European patent application which is pending at the date of entry into force of this Agreement or which is filed after that date, without prejudice to Article 83.

Article 25

Right to prevent the direct use of the invention

A patent shall confer on its proprietor the right to prevent any third party not having the proprietor's consent from the following:

Article 26

Right to prevent the indirect use of the invention

1. A patent shall confer on its proprietor the right to prevent any third party not having the proprietor's consent from supplying or offering to supply, within the territory of the Contracting Member States in which that patent has effect,

Article 27

Limitations of the effects of a patent

The rights conferred by a patent shall not extend to any of the following:

- (g) 'Patent' means a European patent and/or a European patent with unitary effect.

The legislative intent (i)

Council working document 30 October 2007 (14492/07)

2. General features of the EU patent jurisdiction

- In order to ensure efficiency and coherence of patent litigation the EU patent jurisdiction should be an **exclusive jurisdiction** dealing with validity, infringement and inter-related proceedings concerning European patents and future Community patents.
- It should be a **Community jurisdiction specialised in patent litigation.**
- It should be an **integrated system** effective in all MS.
- It should comprise a **first instance** with local and regional divisions as well as one central division, a **second instance** and a **Registry**.
- All divisions would form an integral part of a **unified Community jurisdiction with uniform procedures.**
- All divisions would be specialised and distinct bodies. They would, however, be linked with the European Court of Justice.

CHAPTER IIIA – SUBSTANTIVE LAW

Article 14a

Substantive patent law

For the purpose of litigation under this Agreement the Court shall base its decisions on:

- (a) the provisions of this Agreement;
- (b) the provisions of Council Regulation (EC) No ... on the Community patent;
- (c) those provisions of the European Patent Convention which apply to every European patent;
- (d) those provisions of national law which have been enacted by the Contracting Parties to implement Article 65, Article 67, paragraphs (2) and (3) and Article 70, paragraphs 3 and 4, of the European Patent Convention;
- (e) the provisions of Regulation (EC) No 816/2006 of the European Parliament and the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceuticals for export to countries with public health problems; and
- (f) the provisions of Regulation (EC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for plant protection products, as amended.

ons”, 19

18) does:

Rules on validity also harmonized

- Superfluous if UPCA was only intended to confer jurisdiction
- National differences also exist in relation to validity rules; if national law still governs patents, why not also in respect of validity?

Article 65

Decision on the validity of a patent

1. The Court shall decide on the validity of a patent on the basis of an action for revocation or a counterclaim for revocation.

2. The Court may revoke a patent, either entirely or partly, only on the grounds referred to in Articles 138(1) and 139(2) of the EPC.

Article 34 UPCA (i)

- “As a rule, injunctions will cover the territory of those CMS for which the patent has effect (...) It is true that the attacked embodiments are not offered anymore in Germany. However, this does not justify excluding Germany from the preliminary injunction (...) The same applies to other countries in which the attacked embodiments were not offered” (*CoA Insulet/EOFlow*)
- In line with clear wording + intent of Article 34 UPCA

Article 34

Territorial scope of decisions

Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member States for which the European patent has effect.

17. Decisions with EU-wide effect

In order to take full account of the European or Community dimension of an integrated patent litigation system, the competent jurisdiction (MS/regional or central divisions) should be entitled, with effect for the entire territory of the EU (for Community patents) or with effect for the territories which have been designated in a patent application and for which patent protection is in place (for European patents):

Article 34 UPCA (ii)

- General problem: what is the basis for international jurisdiction of the UPC's Local Divisions?
- LD Mannheim: art. 4 Brussels I Reg (= home state court), so long as defendant resides in UPC territory
- Correct? Art. 71a Brussels I Reg: For the purposes of this Regulation, a court common to several Member States ... shall be deemed to be a court of a Member State.
- LD Hamburg: jurisdiction ex art. 7(2) Brussels I Reg extends to all UPC territories by virtue of Art. 34 UPCA
- Correct? Jurisdiction ex art. 7(2) Brussels I Reg is territorially limited and EU law > UPCA (cf. art. 20 UPCA).

The difficult issue of opt-outs

- Wording of UPCA clearly suggests UPCA substantive law applies in spite of opt-out:

Article 3

Scope of application

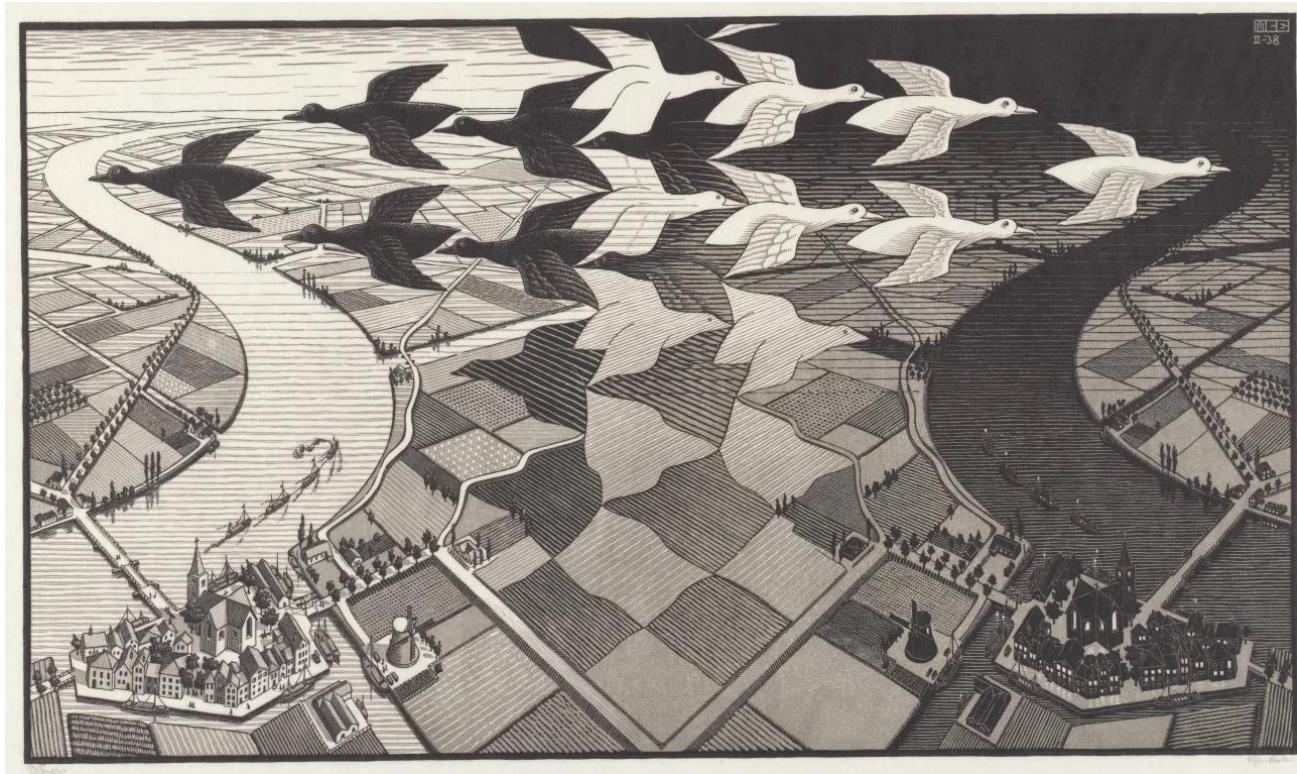
This Agreement shall apply to any:

3. Unless an action has already been brought before the Court, a proprietor of or an applicant for a European patent granted or applied for prior to the end of the transitional period under paragraph 1 and, where applicable, paragraph 5, as well as a holder of a supplementary protection certificate issued for a product protected by a European patent, shall have the possibility to opt out from the exclusive competence of the Court.

- Undesirable if substantive law depends on forum
- But not in line with idea behind opt-out, as noted by PrepCom.
- Incongruous results: cf. indirect infringement, remedies
- “Error” caused by compromise of transition period
- Can linking applicable law to the forum be justified?

We do IP.

Thank you very much for your attention!





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