

Bundle patents before the UPC – two perspectives on which law to apply

The less practical but right approach – national law applies!

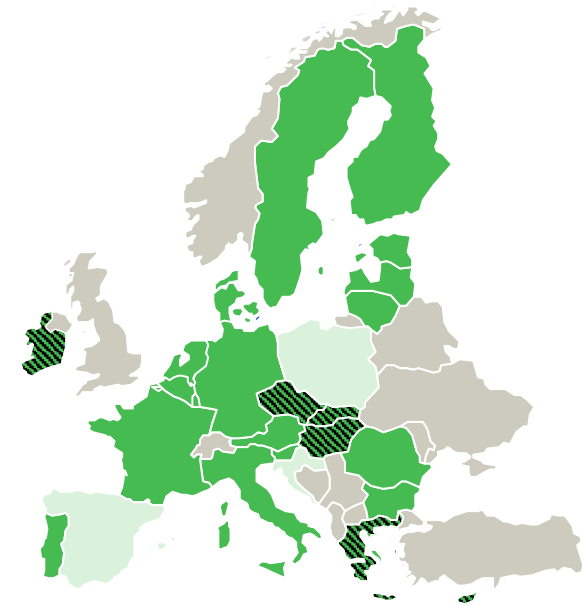
Wolrad Prinz zu Waldeck und Pyrmont, LL.M IP (GWU)

GRUR Jahrestagung 2025, Berlin

17. Oktober 2025

Structure

1. What is the issue?
2. Why does it matter?
3. Has it not already been resolved?
4. A closer look
5. Again: why does this matter?

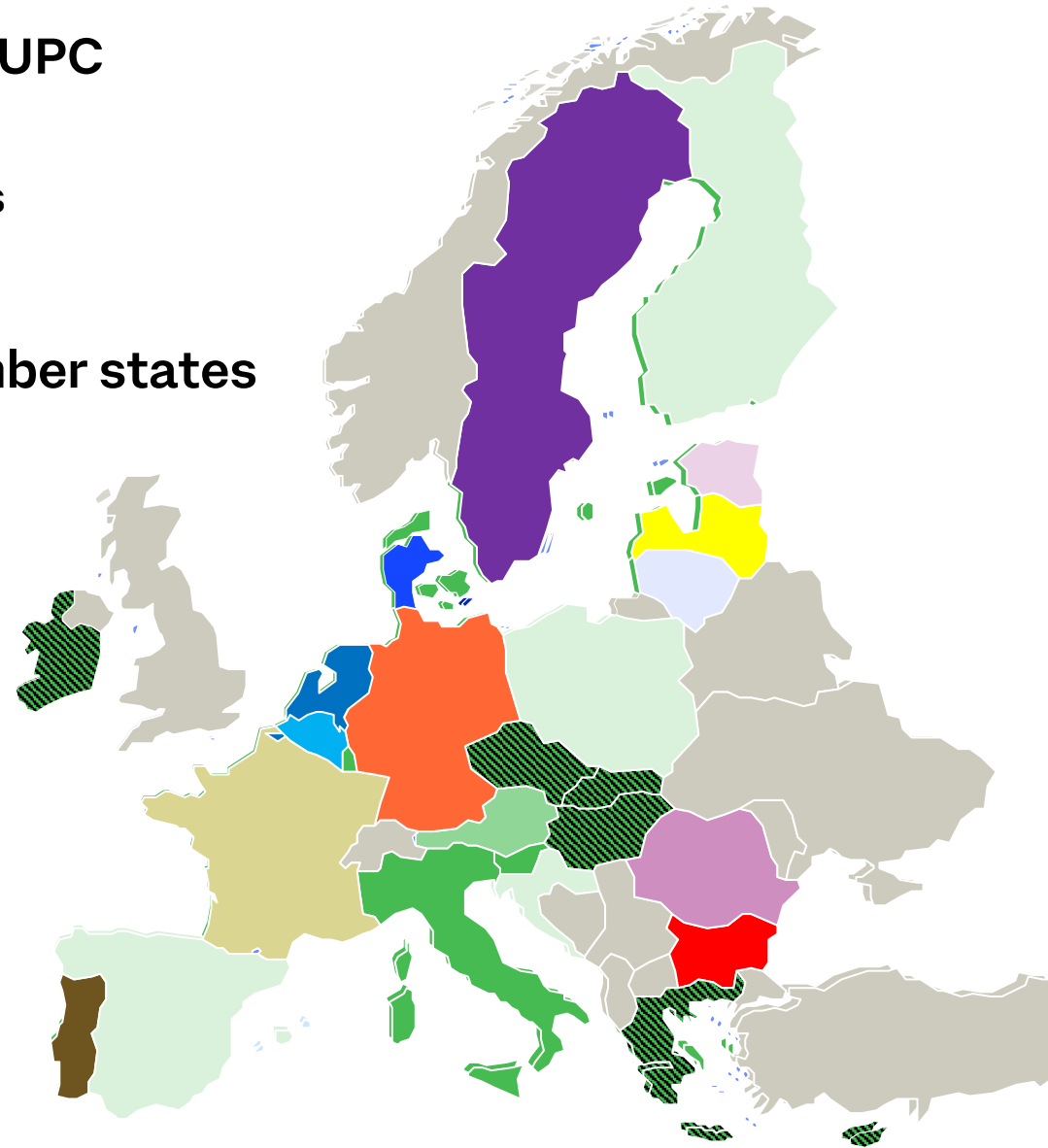


1.

What is the issue?

Which law to apply to EP bundle patents?

- **Substantive law of infringement of the UPC**
 - Art. 25 et seqq. UPCA – scope of protection
 - Art. 64 et seqq. UPCA – legal consequences
- **The national law of the respective member states**
 - DE: §§ 9 et seqq., §§ 139 et seqq. GPA
 - NL: §§ 53 et seqq., §§ 70 et seqq. Dutch PA
 - FR: Arts. L613-3 et seqq. French IP Code
 -

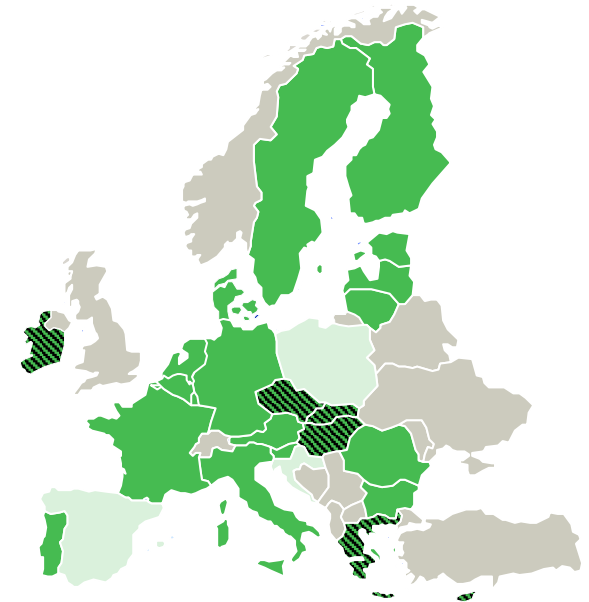


2.

Why does this matter?

Diverging assessment under UPCA and national laws

- **Scope of infringing acts, e.g.**
 - Direct infringement (extraterritorial effects?)
 - indirect infringement
 - Limitations
- **Remedies**
 - Injunction
 - Recall/Removal/Destruction
 - Rendering of accounts
 - Damages
- **Who qualifies as an infringer, and when – direct/indirect infringer, accomplice, accessory?**



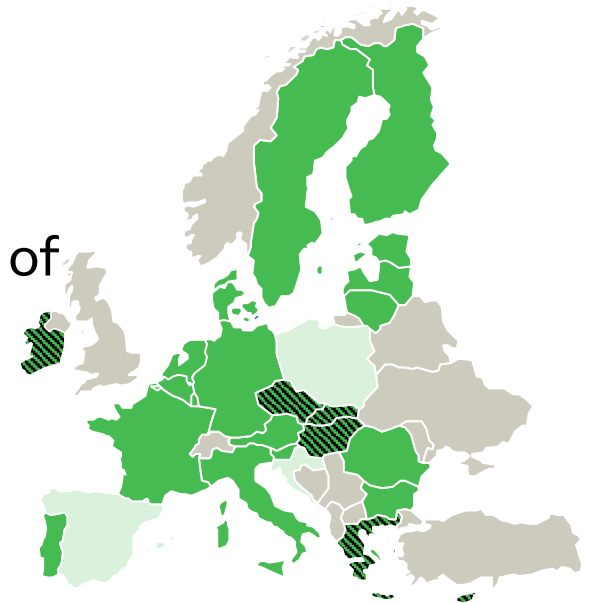
Indirect infringement

Art. 26 (1) UCPA

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,** any person other than a party entitled to exploit the patented invention.....

Sec. 10 GPA

Patents further have the effect **that any third party is prohibited,** in the absence of the consent of the proprietor of the patent, from supplying or offering to supply, **within the territorial scope of this Act,** persons other than those entitled to exploit the patented invention



Bolar exemption

Art. 27 (d) UCPA + Art. 13(6) DIR 2001/82/EC

6. Conducting the necessary studies, tests and trials with a view **to the application of paragraphs 1 to 5** and the consequential practical requirements shall not be regarded as contrary to patent-related rights or to supplementary-protection certificates for medicinal products.

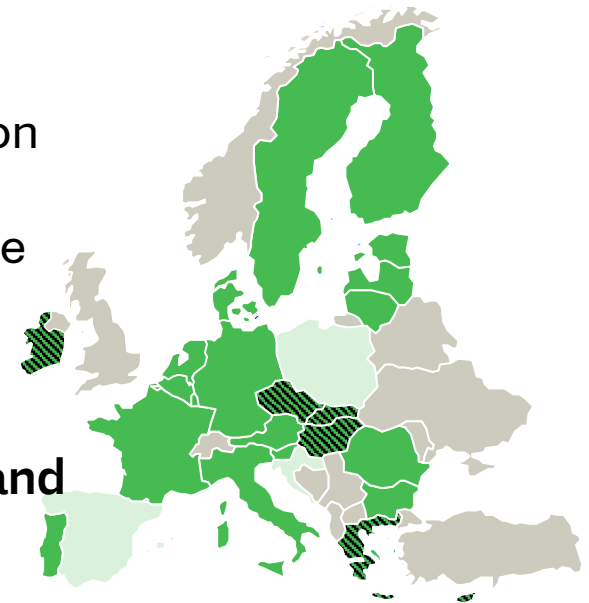
Sec. 11 GPA

2b. studies, experiments and the practical requirements resulting therefrom which are necessary for obtaining authorisation to put medicinal products into circulation in the European Union, or which are necessary for obtaining authorisation to put medicinal products into circulation in the Member States of the European Union **or in third countries**



***Belkin v. Philips*, UPC_CoA_534/2024, 3 Oct. 2025**

1. **The term ‘offer’ within the meaning of Article 25(a) EPGÜ must be interpreted autonomously.** Offer is to be understood in the economic sense and is not to be based on the legal understanding in the sense of a binding contractual offer. The offer therefore does not need to contain all the details that would be necessary for the immediate conclusion of a contract by mere acceptance of the offer.
3. An ‘infringer’ within the meaning of Art. 63 UPCA in conjunction with Art. 25 UPCA is also someone who does not themselves carry out the acts referred to in Art. 25 UPCA, but to whom the acts of the third party are attributable because they are an instigator, accomplice or accessory. **Who is an instigator, accomplice or accessory in this sense is determined on the basis of an autonomous interpretation of Article 63 UPCA and Article 25 UPCA.**



3.

Question already
conclusively answered in
Fives v. Reel?

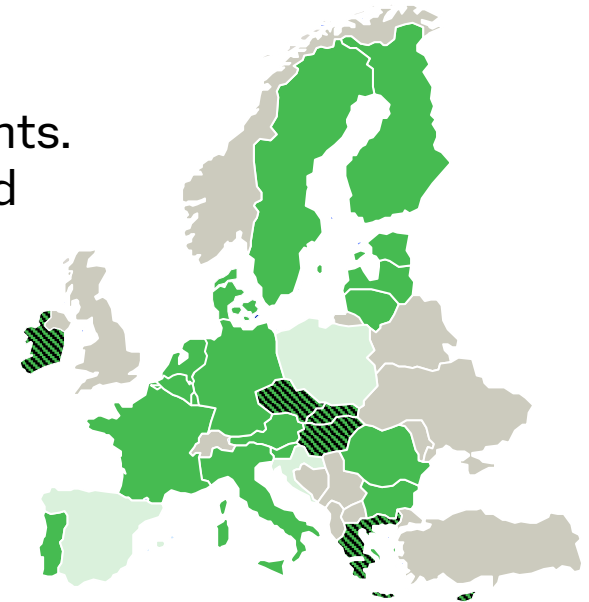
Fives v. Reel, UPC_CoA_30/2024, 16 Jan 2025

Issue: Does the UPC have competence for determining the amount of damages where the infringement had been established by a national (German) court

60. The requirement to apply national patent law pursuant to Art. 64(3) of the European Patent Convention (EPC) has been replaced by the UPCA at least insofar as proceedings before the UPC are concerned.

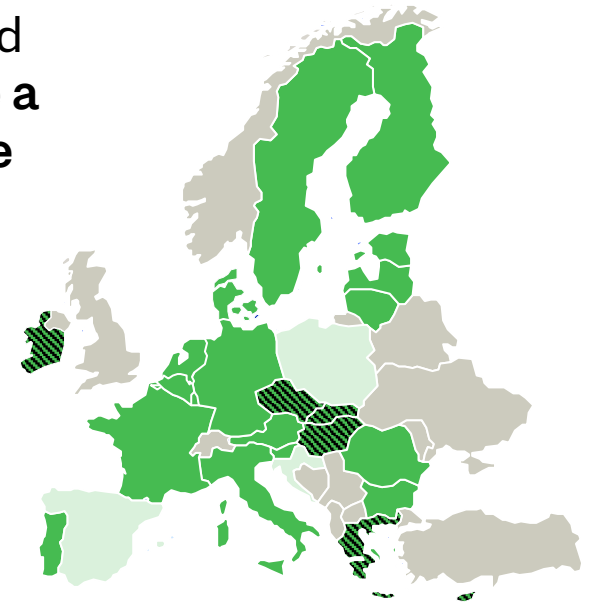
62. The UPC has its own substantive law on patent infringements. Part I, Chapter V UPCA has the heading “Sources of law and substantive law” and includes:

- Art. 25 UPCA, Right to prevent the direct use of the invention
- Art. 26 UPCA, Right to prevent the indirect use of the invention
- Art. 27 UPCA, Limitations of the effects of a patent
- ...



Fives v. Reel, UPC_CoA_30/2024, 16 Jan 2025

63. These provisions apply to European patents and European patents with unitary effect alike (Art. 2(g) UPCA). Application of the law of non-contracting States is referred to in Art. 24(2) and (3) UPCA.
64.
66. **If an action is lodged with the UPC, within its jurisdiction and encompassing a damages request, there is by consequence a complete set of substantive rules applicable insofar as the European patents of the CMSs are concerned.** They are subject to uniform substantive law and procedural rules.

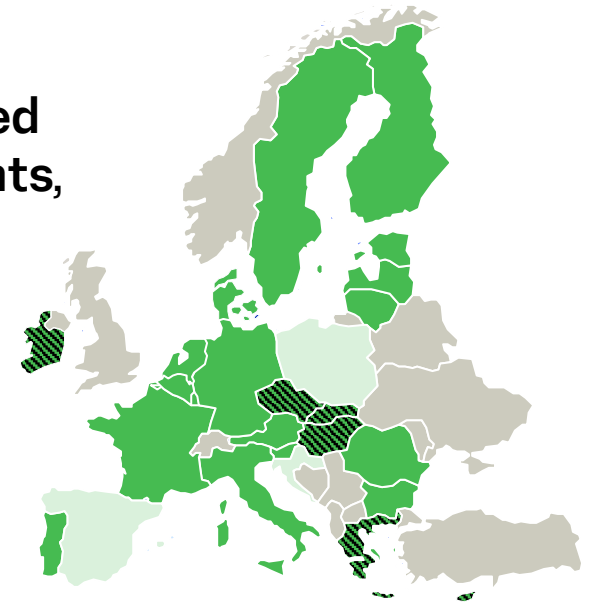


Novartis v. Celltrion, UPC_CFI_165/2024, 6 Sept. 2024

Headnote 1

Art. 25 UPCA constitutes uniform substantive law and Art. 62 (1) UPCA uniform procedural law, which takes precedence over national patent laws and whose content is to be interpreted independently by the Court.

81. a) Contrary to the Defendants' view, the Court is **not required to apply different national laws to European bundle patents**, such as the patent in suit, during the transitional period.



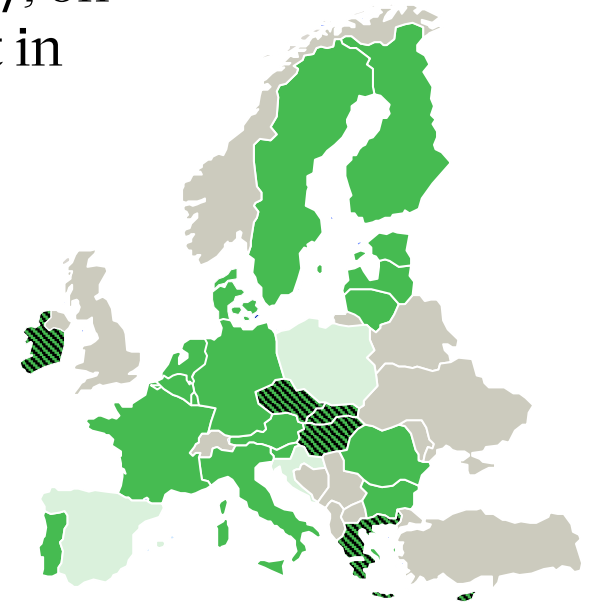
Novartis v. Celltrion, UPC_CFI_165/2024, 6 Sept. 2024

82. ... With the creation of the UPC, **Art. 64 (3) EPC**, which stipulates that national law applies to patent infringement proceedings (...), **was amended on the basis of Art. 149a (1) (a) EPC**. The amendment changes the jurisdiction (Art. 31, 32 UPCA), the procedural law (UPCA and RoP), the effect of the decision (Art. 34 UPCA) and the enforcement (Art. 82 UPCA) in favour of the UPC as European infringement court (...). **The UPCA also creates a uniform substantive law of infringement (see Art. 25, 26 UPCA), which interferes with Art. 64 (1) EPC in a permissible manner via Art. 142 (1) EPC (...). This substantive law in the UPCA will become part of the national law of the Contracting Member States after the UPCA has been ratified by the respective member state and incorporated or implemented into its law.**



Novartis v. Celltrion, UPC_CFI_165/2024, 6 Sept. 2024

83. ... In this respect, Art. 25 et seq. of the UPCA take precedence over the patent infringement provisions in the single national patent laws of the UPCA Contracting Member States as special provisions with regard to patent infringement (...).
84. It is therefore for the Court to determine independently, on the basis of the UPCA, what requirements must be met in order for an infringement to exist. ...



Hurom v. NUC, UPC_CFI_159/2024, 11 March 2024

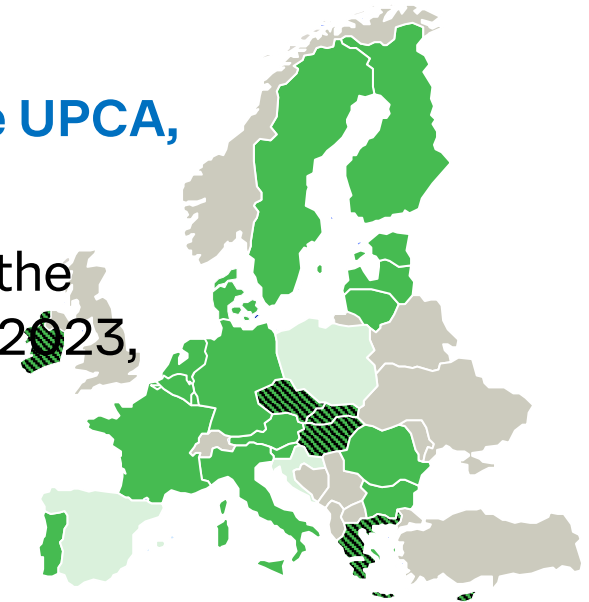
Headnote 3

Considering these principle, with regard to the determination whether substantive law as laid down in the UPCA or substantive national laws of the UPCA member states applies to acts allegedly infringing traditional European bundle patents, the following applies:

a) to acts committed after the entry into force of the UPCA, the substantive law as laid down in the UPCA applies;

b) to acts committed before the entry into force of the UPCA, the substantive national laws apply;

c) to ongoing acts started before the entry into force of the UPCA and continued after the entry into force on 1 June 2023, the substantive law as laid down in the UPCA applies.

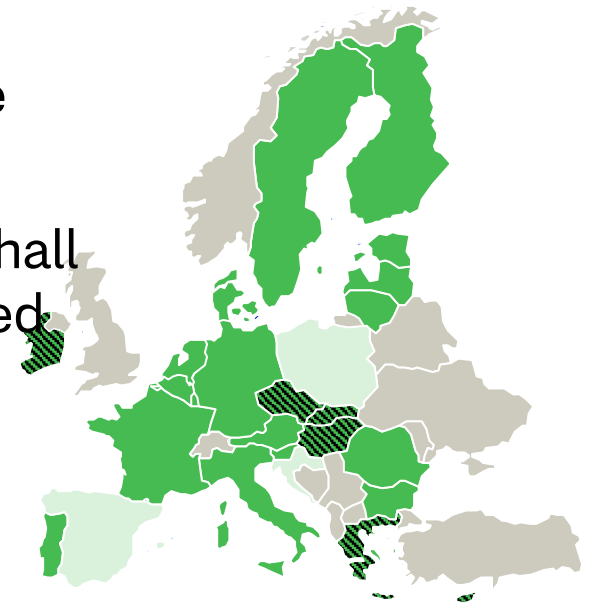


OLG Karlsruhe, 14.2.2024, 6 U 232/22, *Cutting Machine*

Headnote

1. The Agreement on a Unified Patent Court does not alter the fact that **claims brought before national courts for infringement of the German part of a European patent** without unitary effect and for use of the subject matter of its application are governed by Art. 2(2), Art. 64(1), (3) EPC in conjunction with Sections 139 et seq. PatG and Art. II § 1 IntPatÜbkG.
2. The provisions in Art. 56 et seq. EPGÜ concern only the powers of the Unified Patent Court.
3. The ‘substantive law’ codified in Art. 25 et seq. EPGÜ shall only apply in the event of proceedings before the Unified Patent Court.

(GRUR-RS 2024, 4825; confirmed in GRUR-RS 2024, 4839, *Magnetsteuerventil*)



4.

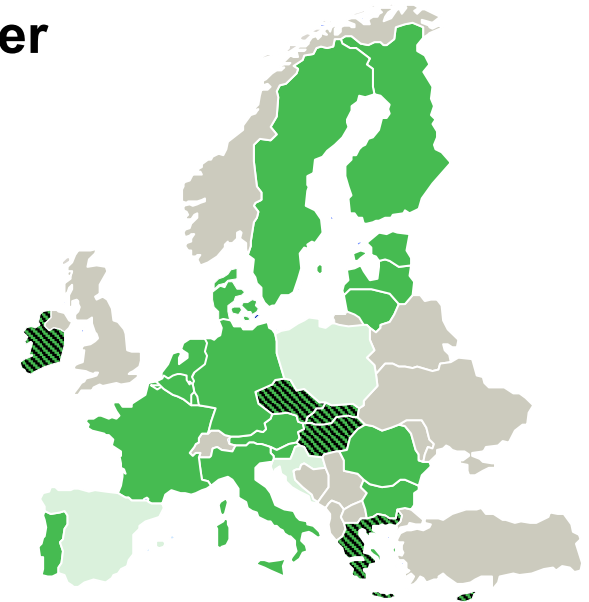
A closer look

Article 3 UPCA - Scope of application

This Agreement shall apply to any:

- (a) European patent with unitary effect;
- (b) ...
- (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)

→ Jurisdictional rule, does not address applicable law



Article 24 UPCA – Sources of law

In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on:

(a) Union law, including Regulation (EU) No 1257/2012 and Regulation (EU) No 1260/2012 (1);

(b) this Agreement;

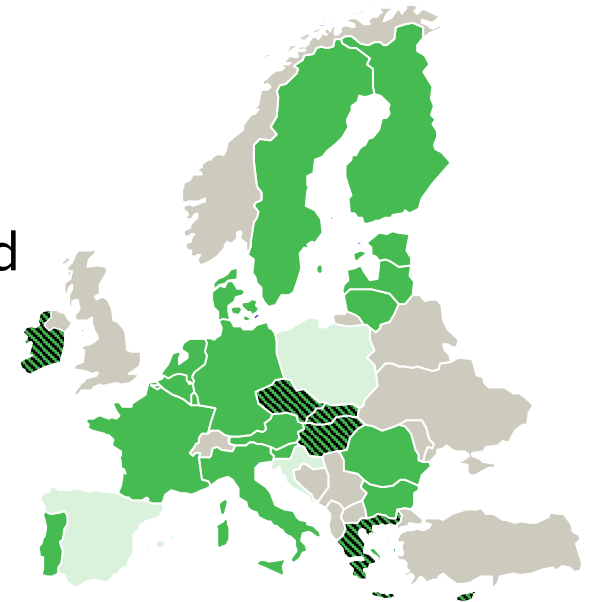
(c) the EPC; → **Art. 64 I & III EPC**

(d) other international agreements applicable to patents and binding on all the Contracting Member States; and

(e) national law.

→ Enumeration of sources of law, no hierarchy of norms

→ Art. 8 Rome II Regulation



Interpretative note of the Preparatory Committee– Consequences of the application of Article 83 UPCA

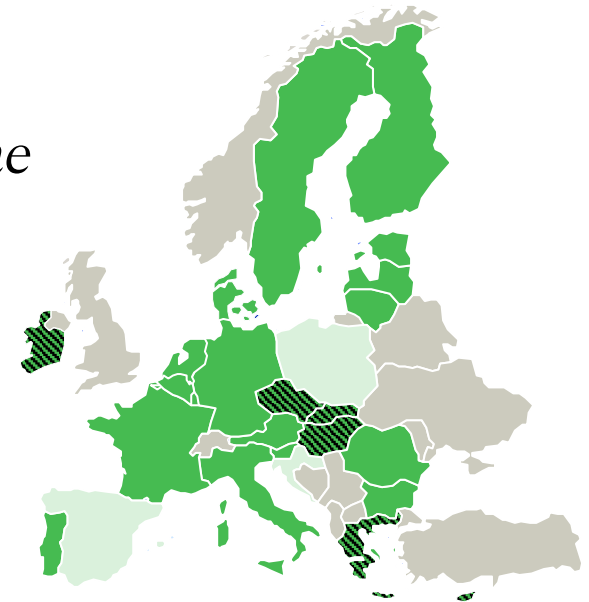
19. It is the Preparatory Committee's view that if an application for a European patent, a European patent or a Supplementary Protection Certificate that has been issued for a product protected by a European Patent is opted out (or during the transitional period the case is brought before a national court), **the Agreement no longer applies to the application for a European patent, the European patent or the Supplementary Protection Certificate concerned. As a consequence the competent national court would have to apply the applicable national law.**



Note Council of the European Union, 26.5.2011, Creating a Unified Patent Litigation System (Doc.-No. 10630/11)

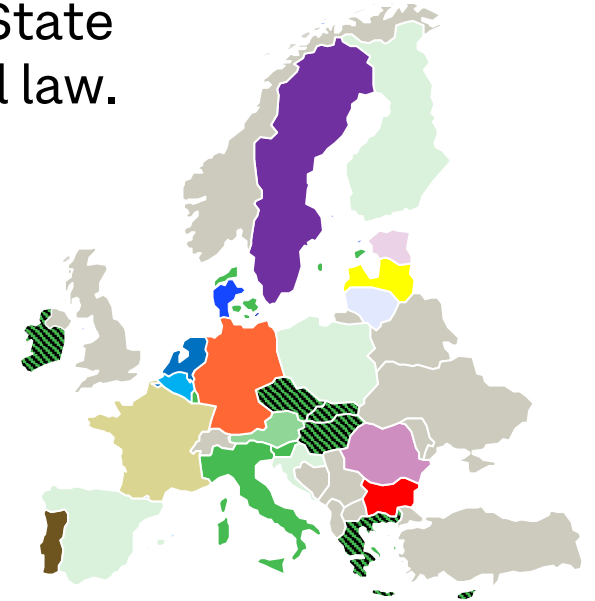
„The creation of unitary patent protection and the setting up of a unified and specialised patent jurisdiction“ (p. 4)

„The unified patent court could therefore be set up by an agreement to be concluded between the Member States on the creation of a common jurisdiction“ (p. 10)



Why national law applies

- UPCA is primarily an agreement on the creation of a common court and regulates its jurisdiction, but does not change the substantive law applicable to European bundle patents.
- Articles 2 and 64 EPC clearly stipulate that a European patent shall be treated as a national patent in each Contracting State and that its infringement shall be assessed under national law. These provisions have not been amended.
- The UPCA is based on Art. 149a EPC. Art. 64 EPC was not replaced on the basis of Art. 142 EPC.



Why national law applies

- The legislator deliberately created the unitary patent as an alternative to the bundle patent. This choice would be undermined if essentially the same substantive law applied to both systems.
- If the applicable law depended on the court seised (UPC/UPCA vs. national court/national law), parties would not be able to predict at the time of an act which law would apply to them. This would lead to legal uncertainty and encourage forum shopping and abusive strategies.
- The application of the new UPCA law to existing patents and acts committed before the UPCA came into force would constitute an impermissible retroactive change in the law.

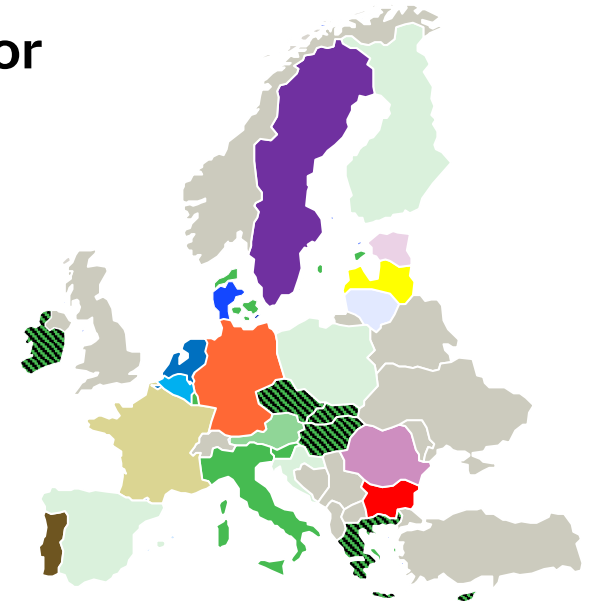


5.

Again, why does this
matter?

Practical implications

- **Legal certainty and predictability: Permissible acts remain consistent and do not retroactively change due to choice of venue/strategic behaviour**
- **Parties may have to plead infringement under the several national laws but still in single proceedings for up to 18 CMS. Possibility of „reference pleadings“?**
- **Q: Who bears the burden of allegation and proof?
Law of other CMS as foreign law?**



Thank you

This material is provided by Freshfields, an international legal practice. We operate across the globe through multiple firms. For more information about our organisation, please see <https://www.freshfields.com/en-gb/footer/legal-notice/>.

Freshfields Bruckhaus Deringer LLP is a limited liability partnership registered in England and Wales (registered number OC334789). It is authorised and regulated by the Solicitors Regulation Authority (SRA no. 484861).

This material is for general information only. It is not intended to provide legal advice on which you may rely. If you require specific legal advice, you should consult a suitably qualified lawyer.