

Kluwer Patent Blog

Courting consistency in the UPC?

Liz Cohen (Bristows) · Friday, May 17th, 2024

During the 12 months since the UPC first opened its doors for business, court users across Europe have been studying the decisions that have been emerging from the various divisions in order to understand the practical application of the Rules of Procedure and the approach of the various judges of the courts. This in turn is inevitably used to inform a client's commercial strategy and ultimately to determine whether the UPC is the European court of choice. It is of course too early for a substantive decision on validity and infringement in the first cases filed, most cases taking at least 12 months to reach a hearing. Notwithstanding this, much has been made of the interim decisions issued to date, particularly in relation to issues such as transparency, access to eF-documents and preliminary injunctions, only a few of which have proceeded to appeal.

Well before the UPC opened its doors, it was generally accepted that with so many forums in which to bring UPC litigation, it would take a number of years, and appeal decisions, to iron out the inevitable inconsistencies that arise from decision-making by different courts despite those courts operating under the same Rules of Procedure. European practitioners are well used to this, having historically dealt with the consequences of inconsistencies in patent decisions from national courts notwithstanding that those courts are operating under the same umbrella law of the European Patent Convention. The explanation usually given for these inconsistencies is the difference in the litigation procedures in each of the national courts, particularly in relation to expert evidence, disclosure and length of trial.

So in a court like the UPC, where the Rules of Procedure should be uniformly applied, will the inconsistencies persist?

One knotty fundamental area which is yet to be resolved is the approach to jurisdiction. This is nicely illustrated by three decisions, one from the Helsinki local division in *AIM Sport v Supponor* (UPC CFI_214/2023), one from the Munich Local Division in *10x Genomics v NanoString* (UPC CFI_17/2023) and a recent decision of the Paris Central Division in *Nokia v Mala Technologies* (UPC_CFI_484/2023). In Helsinki, AIM was blocked from bringing a PI action on the basis that national proceedings that had been initiated in relation to one designation of the relevant European patent before 1 June 2023 (when the UPC opened its doors) were considered to prevent the withdrawal of AIM's opt-out for the purposes of starting

proceedings in the UPC. Conversely, in the second *10x Genomics v NanoString* decision issued in Munich, the Court considered itself to have jurisdiction to decide a PI application for an EP despite infringement and revocation proceedings having been brought in German national courts under the German designation of the EP, which had resulted in an injunction being granted to 10x Genomics. In a similar vein, in the Paris Central Division, national invalidity proceedings against part of an EP that were brought before 1 June 2023 were not considered to prevent a revocation action against the whole of the EP before the UPC.

One distinction that may explain the differences between the Helsinki and Munich and Paris decisions may be that the AIM PI action in Helsinki concerns the question of a withdrawal of an opt out rather than jurisdiction alone. However, all three actions concern the pre-UPC existence of relevant national proceedings and, whether or not the existence of an opt-out is the distinguishing feature, the judgments suggest a limited engagement with the Brussels Regulation by the UPC when coming to these decisions. On the face of it these are markedly different approaches and it will be interesting to see how they are dealt with by the Court of Appeal. We note that the Helsinki decision is under appeal (UPC CoA_500/2023) and no doubt court users wait with bated breath to see the outcome.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).

Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Friday, May 17th, 2024 at 3:00 pm and is filed under [Litigation](#), [Procedure](#), [UPC](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.