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Kompetenz-Kompetenz at the UPC

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Maybe not all readers of this blog will know that there once was a “[North German Confederation](#)” which existed from July 1867 to December 1870, after which it became part of the newly to-be-founded German kingdom. This confederation even had its own [constitution](#), which became somewhat of a blueprint for the German constitution of 1871.

In 1869, the famous jurist [Hugo Böhlau](#) published an article on precisely this constitution, in which he explained the issue of “Kompetenz-Kompetenz” (‘competence-competence’) for the first time. This concept can be explained [as](#) (to cite Wikipedia): “*a jurisprudential doctrine whereby a legal body, such as a court or arbitral tribunal, may have competence, or jurisdiction, to rule as to the extent of its own competence on an issue before it*”.

In other words: You (as a court) have “Kompetenz-Kompetenz” if you can decide whether you may take on a case or not – or how far your judgments extend. (Given that *inter alia* problems like these [led](#) to the US civil war, it is surprising that it took until 1869 that this term was coined.)

This ‘Kompetenz-Kompetenz’ problem has arisen from time to time since then in a wide variety of legal scenarios, especially where arbitration is concerned. However, this issue is also not unknown to intellectual property law. An often discussed example is the tendency of UK courts to decide upon worldwide FRAND licences – something that even UK judges have described as ‘[jurisdictional imperialism](#)’.

With the Unified Patent Court, however, such ‘Kompetenz-Kompetenz’ problems are unavoidable and even the most detailed transitional provisions (which, however, do not really exist in the UPCA) will not be able to cover all constellations. It is therefore not surprising that a whole series of UPC decisions have already been issued, including those by the Court of Appeal, concerning the competence of the UPC – and some of these will be discussed later in this post.

The first case was before the local division in Helsinki. The patent, out of which preliminary measures were requested, had, however, been subject to an “opt-out”. This “opt-out” had later been withdrawn via a so-called “opt-in”.

According to the UPCA, both the “opt-out” and the “opt-in” cannot be filed unconditionally. Summarized: If a case has been filed before the UPC then the patent cannot be opted out. Consequently, if a national case has been filed in an UPC country, then the patent cannot be opted in again.

Here it was the case that in 2020, i.e. before the commencement of the UPC system in 2023, a proceeding for infringement and a nullity action had been filed in Germany.

The Helsinki division [argued](#) that due to these proceedings, the “opt-in” was ineffective and thus the UPC not competent at all.

The court of appeal, however, did not share this [view](#). In its order it stated that only national proceedings that had started after the UPC came into place would prevent an “opt-in”. As that was not the case here, it declared the UPC competent and remitted the case to the division, where the proceeding would now start all over again.

In the second case, the patent owner had asked the UPC for determination of damages – in a case, however, where infringement had been ruled by a national court (here: the Düsseldorf regional court). The Hamburg division had now [declined](#) the competence of the court due to lack of basis in the UPC agreement. Again, the Court of Appeal took a different view – it [allowed](#) the separate proceedings and again remitted the case back to the first instance.

More complicated situations arise when it comes to the territorial reach of the UPC. Besides the UPC Agreement itself, also European law comes into place, especially the so-called “[Brussels-Ia-regime](#)”; this could be the subject of an article on its own right, though.

In the first case, where controversial territorial aspects were involved, the plaintiff had *inter alia* asked for an injunction in Ireland. The local division in The Hague [granted](#) that injunction, mainly on the basis that the defendant had not contested that and that, since Ireland is a signatory to the UPC Agreement, even though it has not ratified the agreement yet, an injunction in Ireland would principally be possible.

Here, the Court of Appeal did not follow that view and issued an [order](#) lifting the injunction for Ireland. This is the only case amongst those covered in this article where finally the UPC declared itself not competent.

In the second case, a request for a preliminary injunction had been granted. During the appeal stage, Romania had joined as the 18th country of the UPC, upon which the plaintiff, asked that the injunction should cover Romania, too. The defendant had protested against this, *inter alia* pointing to the fact that the plaintiff had – since he had won in first instance – filed no appeal and thus the enhancement of territorial scope would be a violation of the principle of *reformatio in peius*. The Court of Appeal, however, had no problems with this request, and as it confirmed the injunction, [issued](#) that this injunction should cover Romania as well.

The third and final case involved the question whether and under what circumstances the UPC may grant injunctions even outside the UPC territory. Here the plaintiff sued out of a patent that was valid in Germany and the UK only. The UK is not a UPC country, it is not even member of the EU. However, as the defendant was domiciled in Germany and due to the special regulations of the “[Brussels-Ia-directive](#)”, the Düsseldorf division [assumed](#) in principle the competence of the UPC to issue such injunctions. In the present case, however, it found the patent not to be valid, so no injunction was granted.

As of yet, there is no decision concerning this question from the Court of Appeals. Meanwhile the view of the Düsseldorf division has been more or less backed by the CJEU in its recent [decision](#)

C-339/22 (BSH Elektrogeräte GmbH ./ Electrolux AB). Consequently, plaintiffs have started to ask the UPC for injunctions not only in the UK, but also other EU countries which are not members of the UPC territory, such as Spain or Poland (e.g. [here](#) and [here](#)).

Summarizing, “Kompetenz-Kompetenz” issues have been on the table in quite a few decisions before the UPC and maybe not surprisingly, in most cases the UPC has declared itself competent. Concerning the question of territorial reach, due to the developments at the CJEU it may be that its reach is broader than initially expected.

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