
UPCA not applicable in national infringement proceedings
Higher Regional Court of Karlsruhe, judgment dated February 14, 2024,
docket no.: 6 U 232/22

Reported by Dr. Tobias Wuttke and Paul Lepschy

Bringing the UPCA into force does not (yet) render obsolete national patent infringement proceedings based on European patents without unitary effect. In its judgment dated February 14, 2024 (docket no. 6 U 232/22), the Higher Regional Court of Karlsruhe — apart from making some interesting comments on the question of the extent to which an opposition decision is equivalent to the description of the patent — clarifies that such legal disputes will continue to be fought on secure terrain: the UPCA and its substantive law are not applicable in national infringement proceedings.

1. Introduction

Since the UPCA entered into force, the UPC has had the sole jurisdiction in particular for infringement complaints arising from and revocation actions against European patents with and without unitary effect (Art. 32 (1) lits. a) and d) in conjunction with Art. 2 lit. g) UPCA; international jurisdiction pursuant to Art. 31 UPCA, in particular in conjunction with Art. 71a et seqq. of the Brussels Ia Regulation assumed).

For European patents without unitary effect, however, the transitional provision of Art. 83 (1) UPCA applies, according to which revocation and infringement complaints can still be filed before national courts during a transitional period of seven years after the UPCA enters into force or, additionally, according to paragraph 3, the exclusive

jurisdiction of the UPC can even be excluded (“opt-out”). Looking subsequently at Art. 3 lit. c) UPCA, the following is stated: “This Agreement shall apply to any European patent [...] without prejudice to Article 83 [...]”.

Does this mean that a national court has (concurrent) jurisdiction under Art. 83 (1) UPCA, but must apply the UPCA and in particular the substantive law provided for therein?

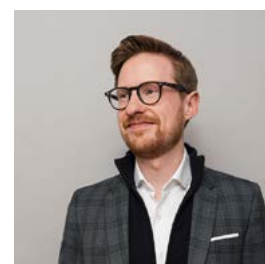
2. The decision by the Higher Regional Court of Karlsruhe

The Higher Regional Court of Karlsruhe clearly rejects this interpretation in its judgment dated February 14, 2024. Following the consent in accordance with Art. 59 (2) German Constitution (Grundgesetz), the UPCA formally has the same status as national patent law; however, the powers of “the court” in accordance with Art. 56 et seqq. UPCA can, according to Art. 2 lit. a) UPCA (court = UPC), only be those of the UPC. Its own substantive law from Art. 25 et seqq. UPCA — i.e., the right to prohibit the direct and indirect use of an invention — can therefore, from a systematic point of view, only be applied by the UPC. This is also explicitly expressed in Art. 24 (1) lit. b) UPCA which specifically addresses the UPC (“the court”) — and only the court — as the implementer of the UPCA.

The Higher Regional Court of Karlsruhe obiter states that the application of Art. 25 et seqq. UPCA would not have led to a different outcome of the dispute.



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3. Comments

The decision of the Higher Regional Court of Karlsruhe does not only convince for the reasons expressed in it, but also in two other respects:

On the one hand, the following internal systematic consideration applies:
Art. 3 lit. c) UPCA specifically determines the application of the UPCA “without prejudice to Article 83”. If this exception to the exception is supposed to express that only the jurisdiction arises from Art. 83 UPCA by way of derogation, it would logically have to be located in the jurisdiction provisions of Art. 31 f. UPCA. In the chosen regulatory context, it can therefore only be understood to mean that the UPCA does not apply in any other respect in cases of Art. 83 UPCA.

On the other hand, the meaning and purpose of Art. 83 UPCA in the overall system only allows for this understanding. After all, the opt-out under Art. 83 (3) UPCA in particular is intended to provide an opportunity to opt out of the new system. The possibility that the national court seized would then nevertheless apply the new provisions of the UPCA would not be compatible with this.

The “Valentine’s Day” decision of the Higher Regional Court of Karlsruhe is therefore a gift for lovers of national infringement proceedings, but also illustrates that those who prefer the UPCA must actually go to the UPC. Although the application of Art. 25 et seqq. UPCA would not have resulted in a different ruling in the case to be decided, the situation may be different in many cases (e.g. with regard to the scope of a right of prior use that may only exist nationally; see Art. 28 UPCA). In this respect, the choice of jurisdiction thus remains one of the most important strategic decisions in patent infringement actions.