

UPC CFI, Central Division Paris, 2 May 2024, Nokia v Mala Technologies

connectivity fault management (cfm) in networks with link aggregation group connections

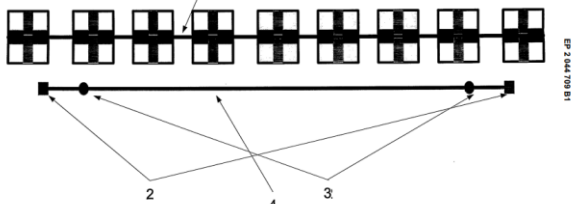


FIG. 1

Preliminary objection against jurisdiction of the UPC because of ‘lis pendens’ with German revocation action rejected (Rule 19.1(a) RoP, Article 71c Brussels I, Article 83 UPCA)

- **Lis pendens rules of Article 71c(2) Brussels I Reg recast do not apply to a case in which the lawsuit before the national German court was brought two years before the beginning of the transitional period**

48. A literal application of [Art. 71c \(2\)](#) Brussels I Reg recast suggests that [Articles 29](#) to [32](#) Brussels I Reg recast do not apply in this case, given that the proceedings were brought before a court of a Member State (Germany) prior to the beginning of the transitional period, rather than during it

49. The issue arises of whether [Art. 71c \(2\)](#) Brussels I Reg recast is applicable by analogy to a case in which the lawsuit before the national court has not been brought during the transitional period, but two years before the beginning of this transitional period

60. [...], in sum, [Art. 29-31](#) Brussels I Reg recast are not applicable in the current proceedings.

No stay of UPC revocation action possible because of pending German revocation proceedings

- **Article 30 (1) Brussels I Reg recast is not applicable and in accordance with Art. 33 (10) UPCA and Rule 295 RoP, the UPC may only stay its proceedings in cases involving EPO opposition proceedings when a swift decision is anticipated from the EPO.**

However, the preconditions outlined in this provision are clearly not met. There is neither an imminent decision expected from the EPO nor is the German Federal Supreme Court poised to deliver a prompt decision.

65. There is also no provision in the UPCA or the RoP that would allow the underlying rationale behind these EPO-related provisions to be applied broadly. Hence, there is no legal foundation for staying the proceedings before this court.

No time extension for lodging Statement of defence to revocation

- **because of preliminary objection (Rule 49.1 RoP, Rule 9.3 RoP)**

66. The deadline for the lodging of a Defence to revocation is stipulated by [R. 49.1 RoP](#). This Rule forms part of an elaborate regime of deadlines set out in the

RoP. One of the Court’s aims is to provide expeditious and high-quality decisions, striking a fair balance between the interests of rights holders and other parties and taking into account the need for proportionality and flexibility (cf. [Preamble to the Unified Patent Court Agreement, paragraph 6](#)). The regime of deadlines provided for by the RoP (including [R. 49.1 RoP](#)) implements this objective through procedural measures. It provides a balance by setting deadlines that are short enough to allow for expeditious decisions while at the same time being long enough to allow the parties to prepare and present their case in a manner suitable for the Court to deliver high-quality decisions. [R. 9.3 RoP](#) offers the Court the possibility to extend a time period referred to in the RoP upon a reasoned request by a party. [R. 9.3 RoP](#) addresses the need for proportionality and flexibility. Proportionality and flexibility need to be applied, however, while maintaining the overall goal of delivering expeditious and high-quality decisions, thereby striking a fair balance between the interests of rights holders and other parties.

67. The mere existence of a Preliminary objection alone does not justify granting an extension of the time period for submitting a Defence. Indeed, the deadline regime provided for by the RoP was established with consideration of parties and their representatives which have lodged a Preliminary objection. If the lodging of a Preliminary Objection would suffice for a time extension, a party lodging a Preliminary Objection would have it in its hands to influence and alter the tight timeframe as provided for by the UPCA.

68. The present case does not qualify as extraordinary even though the legal issues discussed in this Preliminary objection warrant extensive research and concern issues which have not been addressed in the UPCA. The parties are expected to allocate their resources accordingly

Source: [Unified Patent Court](#)

**UPC Court of First Instance,
Central Division Paris, 2 May 2024**

(Haedicke)
UPC_CFI-484/2023

Order

of the Court of First Instance of the Unified Patent Court
Central Division (Paris Seat)

rejecting a Preliminary objection
concerning the Preliminary objection No.
App_8708/2024

lodged in the revocation action No. ACT_595045/2023
issued on 2. May 2024

Applicant:

Mala Technologies Ltd., represented by its Managing Director, Izhak Tamir, 41 Yosef Tzvi Street, 52312 Ramat Gan, Israel, [...] - Defendant in the main action – represented by Dr Thomas Lynker, attorney-at-law, TALIENS Partnerschaft von Rechtsanwälten mbB, Amalienstrasse 67, 80799 Munich, Germany, thomas.lynker@taliens.com and Dr Thomas Kurig,

German and European Patent Attorney, Becker Kurig & Partner Patentanwälte

Defendant:

Nokia Technology GmbH, represented by its Managing Directors Marc Malten and Kristina Marie Vainio, Carl-Theodor-Strasse 6, 40213 Düsseldorf, Germany, [...] - Claimant in the main action – represented by Boris Kreye, attorney-at-law, Bird & Bird LLP, Maximiliansplatz 22, 80333 Munich, Germany

PATENT AT ISSUE:

EP 2 044 709 B1

PANEL:

Panel 1 of the Central Division - Paris Seat

DECIDING JUDGE:

This order has been issued by the judge-rapporteur Maximilian Haedicke

LANGUAGE OF PROCEEDINGS: English

SUBJECT MATTER OF THE PROCEEDINGS

Revocation action. Preliminary objection. Final Order

STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES

Applicant in the Preliminary objection proceedings, Defendant in the main proceedings (hereinafter referred to as ‘Applicant’), requests that

I. the Preliminary objection be allowed;

II. the decision on the Preliminary objection be issued in accordance with **Rule 20.1** of the Rules of Procedure (“RoP”);

III. the Unified Patent Court (“UPC”) decline its jurisdiction for the revocation action and reject the revocation action as inadmissible;

IV. on an auxiliary basis, in the event that the Court does not decline its jurisdiction as requested in item III., that the proceedings be stayed until a final decision of the German Federal Court of Justice has been issued in the German revocation appeal proceedings, docket no. X ZR 6/24;

V. the proceedings be stayed until a final decision on the Preliminary objection has been issued;

VI. on an auxiliary basis, in the event that the proceedings are not stayed as requested under V., that the deadline to lodge a defence to the revocation be extended by one month.

Defendant in the Preliminary objection proceedings, Claimant in the main proceedings (herein referred to as ‘Defendant’), opposes the Preliminary objection. Defendant requests that:

I. the Preliminary objection be rejected;

II. Applicant’s request to stay the proceedings until a final decision has been issued by the German Federal Court of Justice (Docket No. X ZR 6/24) be rejected;

III. in the alternative, the proceedings regarding the German portion of the patent at issue be separated and stayed;

IV. in the further alternative, the Preliminary objection be dealt with in the main proceedings (R. 48, 20.2 RoP).

V. in the further alternative, the parties be heard in a hearing before a decision on the Preliminary objection is taken (**R. 48, 20.1, 264 RoP**).

Defendant further requests that:

VI. the Applicant’s request to stay the proceedings until a final decision has been issued on the Preliminary objection be rejected;

VII. the Applicant’s request to extend the deadline for lodging a Statement of defence by one month be rejected.

Summary of proceedings

1. Defendant in this Preliminary objection (‘Defendant’) has brought a revocation action in relation to the patent at issue (EP 2 044 709 B1) before this Seat of the Unified Patent Court, registered as number ACT_ 595045/2023 UPC_CFI_484/2023.

2. On 16 February 2024 the Defendant in the revocation action, Applicant in this Preliminary objection (‘Applicant’), filed a Preliminary objection pursuant to **Rules 19.1(a)**, and **48** of the Rules of Procedure of the Unified Patent Court (‘RoP’) denying the competence of the Court on the grounds of a revocation action previously filed with the German Federal Patent Court.

3. Defendant in the Preliminary objection submitted written comments regarding the Preliminary objection on 4 March 2024.

4. An oral hearing (by video conference) was scheduled by the Court to give the parties the opportunity to be heard (**R. 20, 48, 264 RoP**).

5. Prior to the oral hearing, on 9 April 2024, the parties submitted further comments regarding the Preliminary objection.

6. The hearing took place by video conference on 17 April 2024. At the hearing, the parties presented their arguments and addressed questions from the judge-rapporteur (hereinafter ‘JR’). At the end of the hearing, the JR indicated that the decision or order would be delivered in due course

Summary of facts

7. Applicant is the proprietor of **EP 2 044 709 B1** which is valid only in Germany.

8. On 29 April 2021, Nokia Solutions and Networks GmbH & Co. KG filed a revocation action against Applicant with the German Federal Patent Court (docket no. 5 Ni 22/21 (EP), hereinafter “**German revocation action**”) requesting that the German part of the European patent EP 2 044 709 (hereinafter “**patent at issue**” or “**EP 709**”) be declared invalid.

9. On 18 July 2023, the German Federal Patent Court dismissed the German revocation action and upheld the patent at issue in its entirety. The full written decision of the German Federal Patent Court was served on the parties on 13 December 2023 (Applicant) and 14 December 2023 (Nokia Solutions and Networks GmbH & Co. KG).

10. On 15 December 2023, Defendant (i.e. Nokia Technology GmbH) filed an action for the revocation of EP 709 with the Central Division of the Court of First Instance of the Unified Patent Court – Paris Seat (hereinafter “**Central Division**”, “**CD**” or “**CD Paris**”), registered as No. ACT_595045/2023.

11. On 15 January 2024, Nokia Solutions and Networks GmbH & Co. KG filed an appeal against the decision of the German Federal Patent Court with the German

Federal Court of Justice (docket number X ZR 6/24).

Applicant's arguments

12. Applicant claims that the jurisdiction of the Unified Patent Court is to be determined in accordance with [Art. 29](#) et seq. Regulation (EU) No 1215/2012 (recast) (hereinafter "[Brussels I Reg recast](#)"). The jurisdiction of the UPC as a common court to several Member States ([Art. 71a](#) Brussels I Reg recast) must be determined in accordance with [Art. 71b](#) Brussels I Reg recast. Applicant points out [that Art. 71a](#) et seq. Brussels I recast have supplemented the Brussels I Reg recast in order to establish the international jurisdiction of common courts such as the UPC. Therefore, the international jurisdiction of the UPC strictly depends on [Art. 71b](#) Brussels I Reg recast. According to [Art. 71b \(1\)](#) Brussels I Reg recast, the UPC has jurisdiction where, under the Brussels I Reg recast, the courts of a Member State of the UPCA would have jurisdiction. Therefore, as is the case with national courts, the entire Chapter II of the Brussels I Reg recast must be applied in order to determine the jurisdiction of the UPC. This also includes the application of [Art. 29-32](#) Brussels I Reg recast in the event that national proceedings are already pending. [Art. 71c \(2\)](#) Brussels I Reg recast merely clarifies that [Art. 29-32](#) Brussels I Reg recast will (also) apply where proceedings are brought in the UPC and in a court of a Member State during the transitional period, but without limiting the applicability of [Art. 29-32](#) Brussels I Reg recast to such proceedings. Consequently, [Art. 29](#) et seq. Brussels I Reg recast are applicable to the present case regardless of the fact that the German revocation action was filed before the beginning of the transitional period provided for in Art. 83 UPCA.

13. Applicant further points out that if the UPC had been launched without a transitional period, there would still be a need to apply Art. 29 et seq. Brussels I Reg recast in order to avoid conflicting judgements. In this scenario as well, [Art. 29](#) et seq. Brussels I Reg recast would be applicable under [Art. 71b \(1\)](#) Brussels I Reg recast.

14. This is not affected by the transitional period. Rather, [Art. 71c \(2\)](#) Brussels I recast expressly deals with this transitional period and clarifies the applicability of [Art. 29-32](#) Brussels I Reg recast. There is no reason to distinguish between an action before and during the transitional period.

15. On an auxiliary basis, Applicant argues that [Art. 29-32](#) Brussels I Reg recast are applicable as [Art. 71c \(2\)](#) Brussels I Reg recast is applicable by analogy. The interests regarding two proceedings, both initiated during the transitional period, are identical to those concerning two proceedings, one of which was initiated before the beginning of the transitional period. In both scenarios, there is a risk of conflicting or contradictory judgments. [Art. 71c \(2\)](#) Brussels I Reg recast aims to prevent such conflicting or contradictory judgments through reference to [Art. 29-32](#) Brussels I Reg recast.

16. Applicant claims a lack of jurisdiction of the Unified Patent Court under Article 31 Brussels I Reg recast. Both the German Federal Patent Court (and the German Federal Court of Justice as the competent court of

appeal) and the Central Division have exclusive jurisdiction for a revocation action regarding EP 709. At the time the German revocation action was filed, the German Federal Patent Court had exclusive jurisdiction in proceedings concerning the validity of the German part of a European patent (see [Article 24 \(4\)](#) Brussels I Reg recast) and the German Federal Court of Justice now has exclusive jurisdiction in respect of the appeal filed against the decision of the German Federal Patent Court. The UPC has exclusive jurisdiction with regard to actions for revocation of European patents (see [Articles 3\(c\)](#) and [32\(1\)\(d\) UPCA](#)). There is a high risk of irreconcilable judgments because both the German revocation proceedings 5 Ni 22/21 (EP) / X ZR 6/24 as well as the UPC revocation action ACT_595045/2023 concern the same patent. The claimants in both proceedings even rely on the same (identical) grounds for invalidity / revocation and the same facts and legal arguments. The revocation proceedings before the Central Division ultimately only concern the German part of EP 709, since EP 709 has been validated in Germany only.

17. To the extent the CD Paris considers Article 31 Brussels I Reg recast inapplicable, the lack of jurisdiction of the Central Division also results from Article 29 (1), (3) Brussels I Reg recast. German revocation proceedings 5 Ni 22/21 (EP) / X ZR 6/24 as well as the UPC revocation proceedings ACT_595045/2023 represent "two (revocation) proceedings in (two different) courts of different Member States" within the meaning of [Art. 29](#) Brussels I Reg recast. The two court proceedings also involve the "same cause of action" within the meaning of [Art. 29](#) Brussels I Reg recast. In the case at hand, both proceedings, i.e. the German revocation proceedings 5 Ni 22/21 (EP) / X ZR 6/24 as well as the UPC revocation proceedings ACT_595045/2023, concern the validity of the German part of the European patent EP 709. The claimants refer to the same grounds of invalidity and have even cited the same prior art documents. The German revocation action as well as the revocation action at hand also involve the "same parties" within the meaning of [Art. 29](#) Brussels I Reg recast. In the German revocation proceedings 5 Ni 22/21 (EP) / X ZR 6/24 as well as the UPC revocation proceedings ACT_595045/2023, both claimants share identical and indissociable interests.

18. If the Central Division finds (in addition) that the requirements of [Article 29](#) Brussels I Reg recast are not met, the present revocation proceedings are to be stayed in accordance with [Article 30 \(1\)](#) Brussels I Reg recast. The revocation proceedings before the German Federal Patent Court and the revocation proceedings before the Central Division concerning the German part of EP 709 are related actions within the meaning of [Article 30 \(1\) and \(3\)](#) Brussels I Reg recast, as there is a risk of irreconcilable judgments.

19. In view of the high degree of probability that the Central Division will conclude that it does not have jurisdiction and competence in the present revocation proceedings, the main proceedings shall be stayed until

a final decision on the Preliminary objection has been taken.

20. In the event that the Central Division rules that the main proceedings will not be stayed, Defendant requests an extension of the deadline to lodge a defence in the main proceedings by one month as a less favourable alternative.

Defendant's arguments

21. Defendant argues that [Art. 29-32](#) Brussels I Reg recast are not applicable to the present case as the German revocation action was not filed "during the transitional period" within the meaning of [Art. 71c \(2\)](#) Brussels I Reg recast. With regard to the question of the UPC functioning as a common court to several Member States, [Art. 71c \(2\)](#) Brussels I Reg recast serves as the *lex specialis* for determining the scope of application of [Art. 29-32](#) Brussels I Reg recast. In accordance with [Art. 71c \(2\)](#) Brussels I recast, [Art. 29-32](#) Brussels I Reg recast only applies where, during the transitional period referred to in [Art. 83 UPCA](#), proceedings are brought in the UPC and in a court of a Member State party to the UPCA. The German revocation action however was filed on 29 April 2021 and therefore before the beginning of the transitional period starting with the entry into force of the UPCA on 1 June 2023. If [Art. 29-32](#) Brussels I Reg recast were applicable by virtue of [Art. 71b](#) Brussels I recast, [Art. 71c \(2\)](#) Brussels I Reg recast would not have a separate scope of application.

22. [Art. 71c \(2\)](#) Brussels I Reg recast is moreover not applicable by analogy. The scope of application of [Art. 71c \(2\)](#) Brussels I Reg recast was intentionally limited to proceedings that were brought in the UPC and in a court of a Member State during the transitional period within the meaning of Art. 83 UPCA. [Art. 71c \(2\)](#) Brussels I Reg recast was drafted specifically for the transitional period; the risk of conflicting judgments was taken into account with regard to such proceedings that had already been brought in a court of a Member State before the beginning of the transitional period. Furthermore, the interests during and before the beginning of the transitional period are not similar. Before the entry into force of the UPCA, the claimant did not have the option to choose between filing a lawsuit before the national courts or before the UPC.

23. If the Central Division finds that [Art. 29-32](#) Brussels I Reg recast may be applicable in principle, the Defendant claims that Art. 31(1) Brussels I Reg recast is not applicable due to the absence of exclusive jurisdiction for both the CD and the German Federal Court of Justice ("FCJ"). The UPC and national courts have parallel jurisdiction for revocation proceedings concerning European patents in accordance with Art. 83(1) UPCA.

24. [Article 29 \(1\), \(3\)](#) Brussels I Reg recast is not applicable. Defendant, and the claimant in the parallel nullity proceedings against the German portion of the patent at issue, Nokia Networks and Solutions GmbH & Co. KG ("NSN"), are not "same parties" within the meaning of [Art. 29\(1\)](#) Brussels I Reg Recast. The principle of autonomy of legal entities requires that each legal entity should, as a matter of principle, have the

right to take its own legal action independently of the actions of other group entities. According to the CJEU, two different entities/persons may be regarded as the "same parties" within the meaning of [Art. 29\(1\)](#) Brussels I Reg recast in exceptional cases, namely where the interests are identical and indissociable. Moreover, the revocation action also includes attacks that deviate from the arguments in the German revocation action, such as the insufficiency attack on claim 2 (cf. para. 70), the added-matter attack based on features 1.3.1. and 1.3.2 of claim 1 (cf. para. 75, 76 and 82-85) and the added-matter attacks against claim 6 (cf. para. 86) as well as against claims 2 and 4 (para. 87-89).

25. In addition, the declaration of overall invalidity of the patent at issue has practical consequences for all Member States, meaning that it is irrelevant that the patent at issue is only valid in Germany. The revocation of the patent at issue by the CD would lead to an *ex tunc* annulment of all claims for damages that may have arisen in the Member States of the UPCA. Although the patent at issue is only valid in Germany, claims for damages for the period from 11 March 2019 to 11 June 2019 could exist due to automatic validation, for example, under Belgian law (see Art. XI.83 of the Belgian Code of Economic Law). Automatic validation is likewise provided for under French and Luxembourg law (see Art. 64 and 65(1), (3) EPC in conjunction with Art. 1(1) London Agreement and the Table of National Law relating to the EPC, Section IV Translation requirements after grant).

26. A stay of the revocation proceedings is not appropriate. Staying the proceedings would unduly restrict the Defendant's right to attack the validity of the patent at issue by way of a popular action, merely because another entity has already brought a revocation action against a portion of the patent at issue before a national court. There is no general rule under the UPCA that revocation proceedings must be stayed because other proceedings relating to the same patent are pending. Rather, revocation proceedings may be brought before the UPC even if an opposition before the EPO is pending.

27. If, contrary to Defendant's view, the PCD considers that a stay is appropriate, the proceedings should in any event be stayed only with respect to the German portion of the patent at issue, and otherwise continue. The issue of staying the proceedings should be discussed at a later stage of the proceedings, e.g. at the interim conference or at the oral hearing.

Points at issue

28. The first issue is whether [Art. 29-31](#) Brussels I Reg recast are directly applicable and can determine the relationship between the two lawsuits.

29. If [Art. 29](#) et seq. Brussels I recast are not directly applicable, then the scope of application of [Art. 29](#) et seq. Brussels I Reg recast in connection with [Art. 71a - 71d](#) Brussels I Reg recast must be determined.

30. If [Art. 29](#) et seq. Brussels I Reg recast are not directly applicable and not applicable in conjunction with [Art. 71a - 71d](#), it must be determined whether [Art. 71c \(2\)](#) Brussels I recast is applicable by analogy.

31. If the UPC has jurisdiction, then a stay of the proceedings must be considered.

No direct applicability of [Articles 29 to 32](#) Brussels I Reg recast

32. The UPCA does not provide material rules concerning the international jurisdiction of the UPC. The UPCA does not specifically provide rules for the relationship between lawsuits before the UPC and lawsuits before national courts which have been lodged prior to the transitional period stipulated in Art. 83 UPCA. The rules on international jurisdiction were previously, i.e. before the enactment of the UPCA, unified within the EU by the Brussels I Regulation. Therefore [Art. 31 UPCA](#) merely stipulates that the international jurisdiction of the UPC is determined in accordance with Brussels I Reg recast.

33. The issue of competing lis pendens is governed by [Art. 29 to 32](#) Brussels I Reg recast. [Art. 29-31](#) Brussels I Reg recast provide instruments for the courts of the EU Member States to coordinate civil proceedings which are related to each other and are pending simultaneously in different Member States. The rules on procedural coordination aim to avoid parallel proceedings in different countries and the resulting irreconcilable decisions.

34. [Art. 29-31](#) Brussels I Reg recast are not directly applicable to the UPC and do not of themselves determine the relationship between lawsuits before the UPC and before national courts.

35. [Art. 29](#) Brussels I Reg recast states:

(1) Without prejudice to Article 31 (2), where proceedings involving the same cause of action and between the same parties are brought in the courts of different Member States, any court other than the court first seised shall of its own motion stay its proceedings until such time as the jurisdiction of the court first seised is established.

(2) ...

36. The UPC is not a court of the Member States, however according to [Art. 71a](#) Brussels I Reg recast it should be 'deemed to be' a court of a Member State. It is, within the meaning of the Brussels I Reg recast, a 'common court'. According to [Art. 71a \(1\), \(2a\)](#), Brussels I Reg recast, the Unified Patent Court is considered a "common court" (Article 2(a)) within the meaning of Brussels I Reg recast in order to integrate these courts into the Brussels I system of jurisdiction.

37. [Article 71a](#) states:

For the purposes of this Regulation, a court common to several Member States as specified in paragraph 2 (a 'common court') shall be deemed to be a court of a Member State when, pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of this Regulation.

For the purposes of this Regulation, each of the following courts shall be a common court:

(a) the Unified Patent Court established by the Agreement on a Unified Patent Court signed on

19 February 2013 (the 'UPC Agreement'); and (...)

38. [Art. 71a – 71d](#) Brussels I Reg recast stipulate the rules relating to such "common courts". These provisions make clear that [Art. 29](#) et seq. Brussels I Reg recast are not directly applicable to the UPCA. [Art. 71a](#) et seq. Brussels I Reg recast provide for special rules with regard to the application of [Articles 29 to 32](#) Brussels I Reg recast to "common courts" within the meaning of the Brussels I Reg recast.

39. If [Art. 29](#) et seq. Brussels I Reg recast were immediately applicable, then [Art. 71a](#) et seq. Brussels I Reg recast would be superfluous. Instead, the scope and manner of application of [Art. 29](#) et seq. Brussels I Reg recast are determined by [Art. 71a – 71d](#) Brussels I Reg recast.

Scope of Application of [Articles 29 to 32](#) Brussels I Reg recast in relation to [Art. 71a – 71d](#) Brussels I Reg recast

40. As a general principle, according to [Art. 71b](#) Brussels I Reg recast the jurisdiction of common courts is similar to the jurisdiction of the courts of the Member States. This is stipulated in [article 71b \(1\)](#) Brussels I Reg recast which states that:

(1) a common court shall have jurisdiction where, under this Regulation, the courts of a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument.

(2)...

41. However, [Art. 71b](#) Brussels I Reg recast does not provide for a general application of [Art. 29](#) et seq. Brussels I Reg recast by determining the jurisdiction of common courts such as the UPC. If this were the case, both [Art. 71c \(1\) and \(2\)](#) Brussels I Reg recast would not have a separate scope of application and would lack any meaning.

42. Moreover, the wording of both subsections of [Art. 71c](#) Brussels I Reg recast ("Articles 29 to 32 shall apply where [...]") implies that [Art. 71c](#) Brussels I Reg recast determines exclusively when [Art. 29](#) et seq. Brussels I Reg recast apply.

43. Therefore, [Art. 71c](#) Brussels I Reg recast provides for special rules for cases of lis pendens. [Article 71c](#) states:

(1) Articles 29 to 32 shall apply where proceedings are brought in a common court and in a court of a Member State not party to the instrument establishing the common court.

(2) Articles 29 to 32 shall apply where, during the transitional period referred to in Article 83 of the UPC Agreement, proceedings are brought in the Unified Patent Court and in a court of a Member State party to the UPC Agreement.

44. In [Art. 83 UPCA](#) the transitional period referred to is defined as follows:

1. During a transitional period of seven years after the date of entry into force of this Agreement, an action for infringement or for

revocation of a European patent or an action for infringement or for declaration of invalidity of a supplementary protection certificate issued for a product protected by a European patent may still be brought before national courts or other competent national authorities.

45. The wording of [Art. 83 UPCA](#) makes clear that the transitional period starts with the date of entry into force of the UPCA and lasts for a period of seven years. During the transitional period provided for in [Art. 83 UPCA](#), the proprietor of a patent may choose whether to assert his claim before the Unified Patent Court or the national courts. [Art. 71c \(2\)](#) Brussels I Reg recast takes this into account if the two competing courts are called upon in parallel proceedings.

46. According to [Art. 83 UPCA](#) the transitional period commences with the date of entry into force of the agreement, i.e. 1 June 2023.

47. In the current case, the lawsuit before the German Federal Patent Court was not lodged during the transitional period but was filed on 29 April 2021 and hence approximately two years before the beginning of the transitional period.

48. A literal application of [Art. 71c \(2\)](#) Brussels I Reg recast suggests that [Articles 29 to 32](#) Brussels I Reg recast do not apply in this case, given that the proceedings were brought before a court of a Member State (Germany) prior to the beginning of the transitional period, rather than during it.

No Application of [Art. 71c \(2\)](#) Brussels I Regulation recast by analogy

49. The issue arises of whether [Art. 71c \(2\)](#) Brussels I Reg recast is applicable by analogy to a case in which the lawsuit before the national court has not been brought during the transitional period, but two years before the beginning of this transitional period.

50. It has been argued that [Art. 71c \(2\)](#) Brussels I Reg recast is applicable by analogy if an action for revocation had already been brought before a national court before the entry into force of the UPCA (Tilman/Plassmann, UPC commentary, Article 89 mn 32).

51. This court does not follow that view and does not extend the scope of applicability of [Art. 71c \(2\)](#) Brussels I Reg recast beyond its literal wording.

52. In order to apply [Art. 71c \(2\)](#) Brussels I Reg recast by analogy, an unintended gap and a similarity of the interests would be required.

53. There is no unintended gap in the Brussels I Regulation or in the UPC.

54. As a general principle, decisions of courts of sovereign states and sovereign entities such as international organizations like the UPC are independent of each other. The principle of sovereignty grants each country's courts as well as the UPC court the authority to independently determine their jurisdiction and to adjudicate cases independently of the courts of other countries.

55. Only if there are rules which define the interrelationship of judgments of courts of sovereign countries can the judgment of the courts of one country

have effects on the jurisdiction of the courts of another country.

56. The independence of both national and international courts may carry the risk that contradictory judgments will be issued by the various courts, however this risk is merely the consequence of the sovereignty of the respective countries.

57. Based on this principle and the clear and unambiguous wording of [Art. 71c \(2\)](#) Brussels I Reg recast, it can be assumed that the legislators of the UPCA considered this general rule of sovereignty of each national and international jurisdiction.

58. There is no general principle within the UPCA that precludes the UPC from asserting jurisdiction in revocation proceedings merely because other proceedings relating to the same patent are pending before other courts. Rather, revocation proceedings may be brought before the UPC even if an opposition before the EPO is pending, see [Art. 33 \(8\), \(10\) UPCA](#). There is no reason why the same principle should not apply to national courts (absent a legal rule to the contrary).

59. Furthermore, the interests of claimants filing revocation lawsuits before and after the entry into force of the UPCA are distinct. A party which filed a lawsuit in a national court before the entry into force of the UPCA should not be barred from filing a lawsuit before the UPC because at the time of filing the national lawsuit it was not clear if and when the UPCA would enter into force and when the UPC would be operational. At this time, a claimant could not make a choice between the UPC and a national court. In contrast, a claimant which files a lawsuit during the transitional period can make such a choice.

60. Therefore, in sum, [Art. 29-31](#) Brussels I Reg recast are not applicable in the current proceedings.

No stay of proceedings

61. There is no need for a stay of proceedings until the Preliminary objection is decided, as the Preliminary objection has already been resolved (in a timely manner).

62. The court sees no legal basis for the claimant's request for a stay of the proceedings regarding the patent as a whole or the German portion thereof.

63. [Article 30 \(1\)](#) Brussels I Reg recast is not applicable.

64. In accordance with [Art. 33 \(10\) UPCA](#) and [Rule 295 RoP](#), the UPC may only stay its proceedings in cases involving EPO opposition proceedings when a swift decision is anticipated from the EPO. However, the preconditions outlined in this provision are clearly not met. There is neither an imminent decision expected from the EPO nor is the German Federal Supreme Court poised to deliver a prompt decision.

65. There is also no provision in the UPCA or the RoP that would allow the underlying rationale behind these EPO-related provisions to be applied broadly. Hence, there is no legal foundation for staying the proceedings before this court. ⁴

No Time extension

66. The deadline for the lodging of a Defence to revocation is stipulated by [R. 49.1 RoP](#). This Rule forms part of an elaborate regime of deadlines set out in the

RoP. One of the Court's aims is to provide expeditious and high-quality decisions, striking a fair balance between the interests of rights holders and other parties and taking into account the need for proportionality and flexibility (cf. [Preamble to the Unified Patent Court Agreement, paragraph 6](#)). The regime of deadlines provided for by the RoP (including [R. 49.1 RoP](#)) implements this objective through procedural measures. It provides a balance by setting deadlines that are short enough to allow for expeditious decisions while at the same time being long enough to allow the parties to prepare and present their case in a manner suitable for the Court to deliver high-quality decisions. [R. 9.3 RoP](#) offers the Court the possibility to extend a time period referred to in the RoP upon a reasoned request by a party. [R. 9.3 RoP](#) addresses the need for proportionality and flexibility. Proportionality and flexibility need to be applied, however, while maintaining the overall goal of delivering expeditious and high-quality decisions, thereby striking a fair balance between the interests of rights holders and other parties.

67. The mere existence of a Preliminary objection alone does not justify granting an extension of the time period for submitting a Defence. Indeed, the deadline regime provided for by the RoP was established with consideration of parties and their representatives which have lodged a Preliminary objection. If the lodging of a Preliminary Objection would suffice for a time extension, a party lodging a Preliminary Objection would have it in its hands to influence and alter the tight timeframe as provided for by the UPCA.

68. The present case does not qualify as extraordinary even though the legal issues discussed in this Preliminary objection warrant extensive research and concern issues which have not been addressed in the UPCA. The parties are expected to allocate their resources accordingly.

Order

On these grounds, having heard the parties on all aspects and elements of relevance for the following order, the court issues the following order:

- the Preliminary objection is rejected;
- Applicant's request to stay the proceedings until the Preliminary objection is decided is rejected.
- Applicant's request to stay the proceedings until a final decision is delivered by the German Federal Court of Justice (Docket No. X ZR 6/24) is rejected;
- Applicant's request to extend the time period for lodging a Defence to the revocation according to R 49.1 RoP is rejected.

Issued on 2. May 2024.

Judge-rapporteur Maximilian Haedicke

Information about appeal

This rejection of a Preliminary objection focuses on fundamental issues concerning the relationship between lawsuits before the UPCA and national courts. Therefore, leave to appeal is granted.
