

# Return to the UPC – but how?

## The UPC Local Division Helsinki and Court of Appeal on the requirements for an opt-in

Already in the first few months, the UPC had to deal with one of the most important, if not the most important question arising during the transitional period: Under which specific circumstances is it possible to withdraw an opt-out pursuant to Article 83(4) UPCA in view of national proceedings pending for the same patent?

In the case *AIM Sport v Supponor* (UPC\_CFI\_214/2023), the Local Division (LD) Helsinki ruled on 20 October 2023 that European patents which have been opted out are permanently excluded from the jurisdiction of the UPC if national proceedings were still pending at the time the UPCA, and thus the UPC, entered into force on 1 June 2023. On 12 November 2024, the Court of Appeal (CoA) (UPC\_CoA\_489/2023, UPC\_CoA\_500/2023) took a different view and found that Art. 83(4) UPCA only refers to actions which are brought before a national court **during the transitional regime**, i.e. after June 1, 2023.

### Facts

In the case at hand, the opt-out was declared during the sunrise period on 12 May 2023, with regard to AIM Sport's European patent EP 3 295 663. The withdrawal of the opt-out (opt-in) was filed on 5 July 2023. On the same

day, the patent owner lodged an infringement action (ACT\_545571/2023), also including a request for provisional measures (ACT\_551054/2023) against Supponor. At the time of both the opt-out and the opt-in declarations, and thus also on June 1, 2023, appeal proceedings regarding an infringement action and a nullity action relating to this patent, which had commenced in 2020, were still pending before German courts.

## Decision

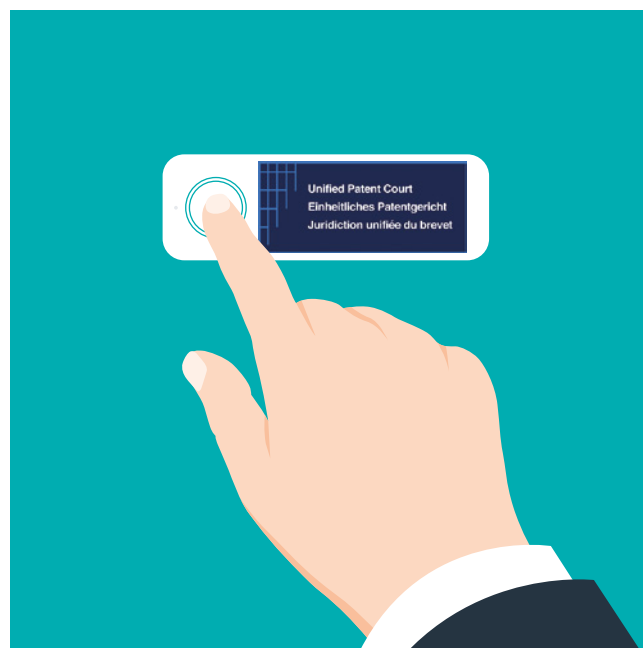
These decisions essentially concern the interpretation of Art. 83(4) UPCA and Rule 5.8 RoP and in particular the terms ›action‹ and ›has already been brought‹.

The panels of both instances of the UPC agreed that the term ›**action**‹ in Art. 83(4) UPCA refers not only to infringement and revocation actions, but to all actions mentioned in Art. 32(1) UPCA over which the UPC has jurisdiction.

However, the CoA assessed the significance of Art. 83(4) UPCA in the overall context of Art. 83 UPCA, which tellingly bears the title ›Transitional regime‹, differently than the LD Helsinki. In the CoA's opinion, both the system and the purpose of Art. 83 UPCA do not allow any other conclusion than that all the provisions therein relate to the duration of the transitional period. In particular, the term ›action‹ used in the various paragraphs of Art. 83(4) UPCA is to be understood uniformly: According to para. 1, parallel jurisdiction of the national courts and the UPC only exists during this period. The effect of opting-out under para. 3 only exists from the beginning of the transitional period, i.e. from June 1, 2023, and the term ›action‹ in para. 3 necessarily refers to actions brought during the transition period. Finally, para. 5 also evidently refers to actions brought during the transitional period. The panel sees no reason why the term ›action‹ in para. 4 should be interpreted differently.

According to the CoA, Art. 83 UPCA is about respecting the rights and expectations of European patent owners and giving them the opportunity to gain more confidence in the functioning of the UPC before subjecting their patents to the new system. The opt-in option serves to reverse the consequences of an earlier opt-out and to use the UPC as soon as this confidence has been gained (UPC\_CoA\_489/2023, UPC\_CoA\_500/2023, paragraph 30, emphasis added):

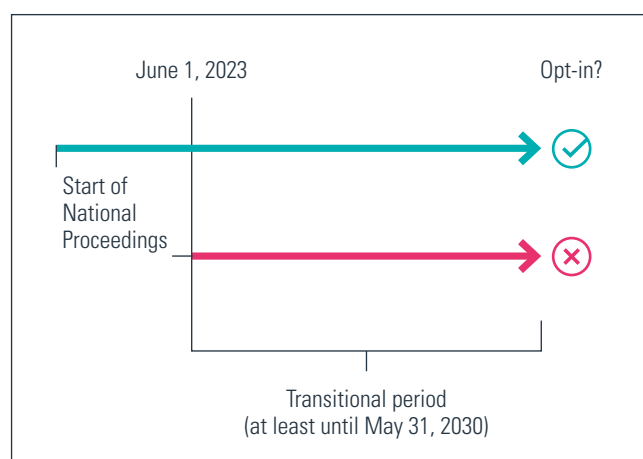
»[O]bject and purpose of Art. 83 UPCA is not to prevent parallel litigation and contradictory decisions, but to provide the mechanism for the transitional regime during which the patent proprietor is given a choice to opt out from the UPC jurisdiction and undo that choice later...«



Therefore, the term ›has already been brought‹ in the context of Art. 83(4) UPCA is to be understood to mean an action brought before a national court after the transitional regime came into existence.

## Takeaway

The phrase ›unless an action has already been brought before a national court‹ in Art. 83(4) UPCA only refers to actions brought after 1 June 2023. National litigation brought prior to this date, whether still pending or not, is not covered by the transitional regime of Art. 83 UPCA and does, therefore, not conflict with an effective opt-in.



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