Munich Local Chamber
UPC_CFI_339/2024

Order

of the Court of First Instance of the Unified Patent Court issued on 18 March 2025

HEADNOTES

The alleged incompatibility of the legal basis of the UPC, in particular the provisions of the UPC Agreement, with the requirements of European primary law in the form of the TEU and the TFEU, and the alleged resulting invalidity of the UPC Agreement, does not constitute grounds for opposition within the meaning of Rule 19(1) of the Rules of Procedure.

Nor can an objection under Rule 19(1) of the Rules of Procedure be successfully based on a possible breach of Article 47(2) of the EU Charter of Fundamental Rights or Article 6(1), first sentence, of the ECHR.

If a representative of the claimant has declared a withdrawal from the ‘opt-out’ in relation to the contested patent, it is not necessary for the claimant to prove – of their own accord – the representative’s authority regarding the declared withdrawal in or with the statement of claim. Proof is only required, or must be submitted, in the event that the authority is contested.

For jurisdiction to be accepted, it is not necessary that an infringement has actually occurred or is imminent. Rather, in the context of the jurisdiction review, it is sufficient for the claimant to make a plausible assertion that an act of infringement justifying jurisdiction has taken place and that this cannot be ruled out from the outset.

PLAINTIFF

Sun Patent Trust, represented by its Managing Trustee Joseph Casino, 437 Madison Avenue, New York, NY 10022, USA

represented by:	Dr Henke, solicitor, of the law firm Bardehle Pagenberg, Bohnenstraße 4, 20457 Hamburg

DEFENDANT

1. **Roku, Inc.**, represented by its directors, 1173 Coleman Avenue, San Jose, CA 95110, USA

2. **Roku International B.V.**, represented by its directors, Nieuwe Weteringstraat 38, 1017ZX Amsterdam, Netherlands

Defendants 1) and 2) represented by:	Dr Kramer, solicitor at the law firm Vossius & Partner, Georg-Glock-Straße 3, 40474 Düsseldorf

PATENT IN DISPUTE

European Patent No. EP 3 200 463

DECISION-MAKING BODY/CHAMBER

Panel 2 of the Munich Local Chamber

PARTICIPATING JUDGE

The order was issued by Judge Dr D. Voß as Rapporteur.

LANGUAGE OF THE PROCEEDINGS

German

SUBJECT

Objection under Rules 19.1(a) and 20.1 of the Rules of Procedure

BRIEF SUMMARY OF THE FACTS

1. The claimant is the registered proprietor of European patent EP 3 200 463 (hereinafter: the patent in dispute). The grant of the patent in dispute was published on 31 October 2018.

2. In May 2023, the claimant invoked the exemption under Article 83(3) of the European Patent Convention (hereinafter also: 'opt-out') in respect of the contested patent. On 21 May 2024, Mr Philippe Vigand declared his withdrawal from the 'opt-out' (App_29033/2024).

3. The patent in dispute is in force in the Federal Republic of Germany, France, Italy and the Netherlands. The claimant is bringing proceedings against the defendants for infringement of the patent in dispute in these Member States, seeking an injunction, recall, removal, destruction, information, provisional damages, a declaration of damages and publication of the decision, asserting claims for information and damages from 31 November 2018.

4. The statement of claim dated 13 June 2024 was served on the defendants on 18 July 2024. By a written submission dated 18 August 2024, the defendants lodged an objection pursuant to Rule 19 of the Rules of Procedure. The claimant responded to this in a written submission dated 2 September 2024, to which the defendants replied in a written submission dated 10 March 2025.

CLAIMS

5. The defendants apply:

   1. that the objection be upheld and the claim dismissed as inadmissible,

   in the alternative,

   2. to stay the present proceedings in accordance with Article 21 of the UPC Agreement and Article 38(2) of Annex I to the UPC Agreement, and to refer the following question to the Court of Justice of the European Union for a preliminary ruling on the interpretation of EU law:

      'Is it compatible with Article 267 TFEU for the Unified Patent Court, established by individual Member States by means of an international agreement, to be entrusted with the application of EU law in the field of patent law in place of the courts of the Member States, whilst being subject to the supervision of the Court of Justice of the European Union through preliminary ruling proceedings pursuant to Article 21 of the UPC Agreement?'

6. The applicant requests that

   that the objection be dismissed.

MAIN ARGUMENTS OF THE PARTIES

7. The defendants are of the view that the UPC lacks jurisdiction pursuant to Rule 19.1(a) of the Rules of Procedure, as the legal basis of the UPC, in particular the provisions of the UPC Agreement, is incompatible with the requirements of European primary law in the form of the TEU and the TFEU and is therefore invalid within the meaning of Article 267(1)(b) TFEU. Irrespective of the question of its effective institutionalisation, the EPG consequently lacks, in any event, an effective legal basis for conducting the present proceedings and issuing a decision. The EPG therefore lacks jurisdiction over the present dispute. Rather, the national courts have jurisdiction over this matter.

8. The provisions of the EPGÜ are incompatible with EU law because the EPG has been incorporated into the structure of the national (patent) courts through an international agreement between individual Member States, without the involvement of the European Union, and without being integrated into the judicial system of the respective Member States. The ECJ had established this incompatibility with EU law in its Opinion 1/09 of 8 March 2011 (Annex VP1) regarding the agreement then planned to establish a unified patent court system. The amendments made to the current EPGÜ compared to that earlier version did not remove this incompatibility.

9. Rather, the provisions of the UPC would have established an international patent court which lies outside the institutional and judicial framework of the Union and which, at the same time, would have exclusive jurisdiction to rule on a considerable number of actions brought by individuals in connection with European patents and European patents with unitary effect, and to which the interpretation and application of Union law in this area would thus be exclusively entrusted. The EPGÜ would deprive the courts of the Member States of their powers to interpret and apply Union law in this area, and the Court of Justice of its power to answer questions referred by those courts for a preliminary ruling. This constitutes a distortion of the competences assigned by the Treaties to the Union institutions and the Member States, which are essential for safeguarding the nature of Union law. If the EPG were now to apply EU law autonomously pursuant to Article 24(1)(a) of the EPGÜ, the ECJ could not, contrary to Article 19(1), second sentence, TEU, as this is simply not provided for in the EPG’s judicial structure. If the EPG nevertheless considers itself competent in matters that also concern EU law, it infringes Article 19 TEU and thus also the primacy of EU law under Article 19 TEU.

10. Under Article 19 TEU and Article 267 TFEU, the EU judicial system provides for only two types of legitimate courts: the Union's own courts, on the one hand, and the courts of the Member States, on the other. The creation of courts deviating from this system and the transfer of judicial powers to them is incompatible with Article 19 TFEU and Article 267 TFEU. Accordingly, Article 267 TFEU also provides exclusively for a court of a Member State to have the right to make a reference. A court of a Member State is understood to mean only a court that forms part of the existing judicial system of a Member State. However, the EPG is not such a court. The mere declaration in Article 21 of the EPGÜ does not alter this. What is decisive are the actual circumstances. According to these, the EPG has no legal, organisational or procedural connection whatsoever with the national courts of the contracting Member States of the EPGÜ. Rather, it displaces them from their previous jurisdiction. Legal proceedings before the EPG are decoupled from national proceedings. The EPG acts autonomously and independently of the national courts.

11. The introduction of Article 71a(2) of the Brussels Ia Regulation likewise changes nothing. A declaration at the level of secondary legislation is irrelevant. It cannot alter the requirements of primary law and is in contradiction with it. Rather, an amendment to the Treaties, i.e. to primary law itself, would be required. This would require unanimity (Article 48(4) TEU). A fortiori, the declarations in Article 1(2) of the EPGÜ and Articles 20 and 21 of the EPGÜ could have no effect. This is because the EPGÜ is an international treaty concluded by the Member States, but not by the EU.

12. According to the above reasoning, the EPG is indeed correctly not entitled to refer a case within the meaning of Article 267 TFEU. However, a refusal to refer a case on this ground would amount to the EPG declaring its own illegitimacy through its own decision. A decision to refer a case to the CJEU pursuant to Article 267(2) TFEU and paragraph 266.1 of the Rules of Procedure is, rather, appropriate. In view of the considerable time that has elapsed since the EPG came into force and the large number of decisions the EPG has already issued, there is a significant urgency to clarify these issues, which in the present case amounts to a reduction of discretion to zero.

13. The defendants further contend that the judicial structure of the EPG infringes their right to a lawful judge under Article 47(2) of the Charter of Fundamental Rights of the European Union, read in conjunction with Article 7(2) of the EPGÜ, and Article 6(1), first sentence, of the European Convention on Human Rights, read in conjunction with Article 7(2) of the EPGÜ. Article 47(2) of the EU Charter of Fundamental Rights and Article 6(1), first sentence, of the ECHR require that a court be lawfully established, i.e. in accordance with the applicable legal provisions. Article 7(2) of the EPGÜ stipulates that the Central Chamber must have 'a division in London (...)'. However, due to the UK's withdrawal from the EU in July 2020, the EPG no longer has a division in London. Consequently, the EPG was clearly not established in accordance with the requirements of the EPGÜ.

14. The apparent breach of the provisions of the EPGÜ is not remedied by the "Decision of the Administrative Committee pursuant to Article 87(2) of the EPGÜ amending the Agreement" of 26 June 2023. Firstly, the present action was brought before the decision took effect. Secondly, there is no legal basis for the removal of London and its replacement by Milan as a division of the Central Chamber. Article 87(2) EPC cannot be invoked. This provision concerns only amendments adapting the EPC to changes in Union law or international treaties that have occurred during the EPC's period of validity. Furthermore, as an executive body, the Administrative Committee is not permitted to make fundamental changes, such as alterations to the court's structure. This is reserved for all democratically legitimate decisions of the contracting member states. Even if Article 87(2) of the EPGÜ could in principle have been invoked as a legal basis, London might at most have been removed, but Milan should not have been included.

15. Since it cannot be ruled out that, for example, the composition of the various chambers would have been different had the EPG been established correctly, this defect affects all proceedings pending before the EPG.

16. In the defendant's view, the EPG also lacks jurisdiction on the basis of the 'opt-out' declared by the claimant. It is disputed that the withdrawal from the application of the exemption was validly declared. It is disputed that, at the time the withdrawal was declared pursuant to Article 48 EPC, Mr Philippe Vigand was even authorised to act as a representative before the EPG and was the appointed representative of the patent proprietor. There is no evidence whatsoever of Mr Vigand having been duly authorised by the patent proprietor, not only in the CMS but also in the statement of claim. The claimant does not address the withdrawal of the 'opt-out' in the statement of claim, let alone Mr Vigand's alleged authority to represent. It can be left open whether the power of attorney should also have been filed in the CMS. In any event, the statement of claim lacks a coherent argument regarding the effective withdrawal of the 'opt-out'. In the present case, there is also no presumption based on the register regarding Mr Vigand's authority to represent. Rather, this is undermined by the register, as Mr Vigand is named as a representative neither in the European Register nor in the national registers. Furthermore, he is not the representative who, at the time, declared the application of the exemption under Article 83(3) of the EPGÜ.

17. Finally, with regard to the second defendant, the defendants dispute the territorial jurisdiction of the Munich Local Chamber pursuant to Article 33(1)(a) of the EPGÜ, Rule 19.1(b) of the Rules of Procedure. The claimant has merely alleged acts of infringement by the second defendant prior to the entry into force of the EPGÜ. Insofar as the claimant argues that the second defendant operates the German-language website www.roku.com/de and has submitted the terms of use of this website as Annex BP-P 15,

these terms of use are no longer current. Defendant 2) does not operate the website and is not responsible for the German market. Furthermore, accepting the local jurisdiction of the Munich Local Chamber based on the claimant's submissions would violate the prohibition on retroactive effect, e.g. under Article 28 of the Vienna Convention on the Law of Treaties. An act occurring prior to the entry into force of the EPGÜ is not sufficient to establish the local jurisdiction of the Chamber.

18. The claimant considers that the argument regarding the alleged incompatibility of the EPGÜ with Article 19(1), second sentence, of the TEU is misplaced in an objection. The Local Chamber cannot deny its own jurisdiction on the grounds of an alleged incompatibility of the EPGÜ with EU law. The defendants essentially requested that the Local Chamber declare itself incompetent, as the EPG was allegedly unable to ensure compliance with EU law in a manner consistent with Article 19 TEU. The provisions of the EPGÜ, and thus the legal source from which the Local Chamber derives its jurisdiction, should therefore be disregarded. Ironically, the defendants were thereby calling on the Local Chamber to interpret and apply EU law, even though the EPG's power to do precisely that was the crux of their criticism. If the defendants' argument of incompatibility were correct, then the Local Chamber would not even be empowered to decline jurisdiction.

19. The provisions of the EPG, and in particular the EPGÜ, are consistent with Article 19 TEU and Article 267 TFEU. The EPG is integrated into the national court systems. This follows from Articles 1, 20, 21 and 34 of the EPGÜ. In particular, the EPG is a common court of the Member States, and the review of Union law by the ECJ is ensured for the EPG by way of preliminary rulings in accordance with Rule 266 of the Rules of Procedure. The mere fact that the legal basis and the allocation of jurisdiction for the EPG are not to be found in primary European law does not suggest that the court is contrary to European law. There is no contradiction between secondary law and primary Union law that might require an amendment or addition to primary law.

20. A reference to the ECJ is not warranted. The argument put forward by the defendants was not only taken into account in the legislative process of the EPGÜ, but had also already been addressed by the ECJ in its Opinion 1/09 of 8 March 2011 (acte éclairé). The concerns raised at that time have not only been resolved in the current, applicable version of the EPGÜ, but the ECJ opinion has also sufficiently (and positively) clarified that no such conflict exists.

21. In the claimant's view, the defendant's right to a lawful judge is clearly not affected. The Central Chamber has no connection whatsoever to this case. Apart from that, the amendment pursuant to the decision of the

Administrative Committee of 26 June 2023, this amendment constitutes a revision and addition to Article 7(2) of the EPGÜ, which does not require the retroactive application of Article 87(2) of the EPGÜ.

22. The withdrawal from the ‘opt-out’, according to the claimant, was validly declared and conclusively demonstrated. Mr Vigand had already been a registered representative before the UPC at the time of the declaration of withdrawal (written witness statement by Mr Vigand, Annex BP-T 6a). Proof of a representative’s power of attorney pursuant to Article 48 EPC is, in principle, not required. A written power of attorney need only be submitted if the court so requires. Furthermore, Mr Vigand had been duly authorised by the patent proprietor to declare the withdrawal of the ‘opt-out’ on its behalf (written witness statement by Mr Casino, Annex BP-T 6b).

23. Ultimately, the claimant has also conclusively demonstrated the territorial jurisdiction of the Munich Local Chamber. The fact that the evidence submitted regarding the patent infringement by the second defendant in Germany dates from a time prior to the entry into force of the EPG is irrelevant. Under Article 68 of the EPGÜ, the EPG is also authorised to award damages. Such an award is typically made in respect of acts of infringement occurring in the past. In any event, the second defendant naturally did not cease the acts of infringement set out in the statement of claim upon the entry into force of the EPGÜ. It follows from the updated terms of use that the second defendant operated the website until 5 August 2024, and thus also after the date of entry into force of the EPGÜ. Furthermore, the defendants had not responded to the EU declaration of conformity submitted or to the product label of a Roku Streaming Bar purchased in Germany by the second defendant.

REASONS FOR THE ORDER

24. The opposition, filed in due time and form in accordance with Rules 19.1 to 19.3 of the Rules of Procedure, is (in any event) unfounded.

I.

25. Under Rule 19.1 of the Rules of Procedure, an objection may relate to: the (lack of) jurisdiction of the EPG as a whole (Rule 19.1(a) of the Rules of Procedure), the (lack of) jurisdiction of the Chamber of the EPG specified by the claimant (Rule 19.1(b) of the Rules of Procedure) and the (incorrect) language of the statement of claim (Rule 19.1(c) of the Rules of Procedure). Rule 19.1 of the Rules of Procedure therefore lists only three grounds for objection. This list is exhaustive. An objection cannot be based on any other grounds (Court of Appeal, UPC_CoA_188/2024, Order of 3 September 2024 – Aylo v Disch).

26. Rule 19.1(a) of the Rules of Procedure concerns the 'jurisdiction of the Court, including the objection that the exception under Rule 5 applies to the patent at issue'. In view of this, the provision refers to Articles 31 ('International jurisdiction') and 32 ('Jurisdiction of the Court') contained in Chapter VI ('International and other jurisdiction of the Court') of the EPC, as well as to Article 83 ('Transitional provisions') contained in Chapter VI ('Decisions') of the EPC. A defendant may therefore raise an objection to the existence of jurisdiction claimed under these provisions by way of an opposition. Whether such an objection is successful must consequently be assessed on the basis of the requirements set out in the provisions referred to.

27. Rule 19.1(b) of the Rules of Procedure, by expressly referring to Rule 13.1(i) of the Rules of Procedure, contains a reference to Article 33 of the EPGÜ ('Competence of the Chamber of the Court of First Instance'). A defendant may therefore, by means of an objection raised pursuant to Rule 19.1(b) of the Rules of Procedure, challenge the jurisdiction of the local, regional or central chamber specifically chosen by a claimant.

28. Neither Rule 19.1(a) of the Rules of Procedure nor Rule 19.1(b) of the Rules of Procedure contains any further references or cross-references to other provisions of the EPC or to aspects not covered by Articles 31, 32, 83 of the EPC or Article 33 of the EPC.

II.

29. In view of this, the objection must be dismissed insofar as the defendants base it on Rule 19.1(a) of the Rules of Procedure and ground it on the (alleged) incompatibility of the EPGÜ with primary law of the European Union, the (alleged) breach of the principle of the right to a specific judge, and the (alleged) lack of standing on the part of the claimant. In this respect, the objection is not based on an admissible ground for objection and must therefore be regarded as inadmissible, or at any rate as unfounded.

1)

30. The (alleged) incompatibility of the legal basis of the EPG, in particular the provisions of the EPGÜ, with the requirements of European primary law in the form of the TEU and the TFEU, and the (alleged) resulting invalidity of the EPGÜ, is not listed among the grounds for an objection. Rule 19.1(a) of the Rules of Procedure, cited by the defendants, specifies, as already mentioned, as a ground for opposition (solely) the (lack of) jurisdiction of the EPG, whereby reference is made (only) to Articles 31, 32 and 83 of the EPGÜ. It must therefore be examined whether the EPG has jurisdiction under these provisions. The validity and applicability of the

aforementioned articles of the EPGÜ for the purpose of the jurisdiction review is hereby, as it were, taken for granted.

31. There is no indication that the subject matter of opposition proceedings – so to speak, incidentally – also includes the validity of the EPGÜ (in its entirety or in relation to specific provisions) and the compatibility of the EPGÜ with Article 19 TEU and Article 267 TFEU. As also explained, opposition proceedings under Rule 19 of the Rules of Procedure are limited to specific formal procedural grounds. They serve to ensure the efficient conduct of proceedings and procedural economy, and are intended to clarify – at the earliest possible stage of the proceedings and by the rapporteur alone – the jurisdiction of the EPG and the language of the proceedings. Proceedings which are recognisable at an early stage of the proceedings as falling outside the jurisdiction of the EPG or the relevant chamber should not need to be processed further on the merits; deficiencies in the choice of language should be corrected at an early stage. By contrast, the objection under Rule 19.1 of the Rules of Procedure is not designed as a 'general' review procedure of the EPGÜ as a whole or of individual provisions of the EPGÜ. It therefore does not serve the purpose of having the EPGÜ as a whole or individual provisions thereof examined or reviewed for compliance with Union law. Nor does it serve this purpose where the validity of the aforementioned rules on jurisdiction is at issue. As mentioned, Rule 19.1 of the Rules of Procedure requires the EPG to apply Articles 31, 32, 33 and 83 of the EPGÜ for the purpose of assessing jurisdiction.

32. The question of whether it is compatible with Article 267 TFEU that the EPG is entrusted with the application of EU law in the field of patent law in place of the courts of the Member States, and is thereby subject to the supervision of the CJEU through preliminary ruling proceedings pursuant to Article 21 EPC, is not directly relevant to the question of the EPG's jurisdiction. Nor is it of indirect relevance for the reasons set out above. An incidental review of the alleged unlawfulness of the EPC under Union law is not to be carried out. The referral to the CJEU pursuant to Article 267 TFEU, sought by the defendants in the alternative, is therefore not appropriate. The question referred is not relevant to the decision in the opposition proceedings.

2)

33. The defendants' claim of an (alleged) breach of the right to a lawful judge under Article 47(2) of the Charter of Fundamental Rights of the European Union, read in conjunction with Article 7(2) of the European Patent Convention and Article 6(1), first sentence, of the European Convention on Human Rights, read in conjunction with Article 7(2) of the European Patent Convention, is likewise unsuccessful. The infringement alleged by the defendants is not included in the list of grounds for objection under Rule 19.1 of the Rules of Procedure. Consequently, an objection cannot be based on any alleged infringement of Article 47(2) of the EU Charter of Fundamental Rights or Article 6(1), first sentence, of the ECHR.

34. Nor is it apparent that the alleged infringement has any (indirect) bearing on the rules of jurisdiction to be examined under Articles 31, 32 and 83 of the EPGÜ. In so far as the defendant's submission is to be understood as meaning that the national courts are the courts of competent jurisdiction within the meaning of the aforementioned provisions, but that this jurisdiction has been 'withdrawn' from the parties due to the improper establishment of the EPG, the arguments set out in II.1) apply mutatis mutandis. The validity and applicability of the jurisdiction rules of the EPGÜ are not a permissible subject of review in opposition proceedings.

35. It should also be noted that the present action for infringement of the patent in dispute has rightly been brought before a local chamber of the EPG in accordance with the internal allocation of jurisdiction within the EPG, Art. 32(1)(a) and 33(1)(a) of the EPGÜ. There are no apparent grounds for the Central Chamber to have jurisdiction. No breach of the principle of the proper court can be identified in this respect. The only connecting factor for any potential jurisdiction of the Central Chamber could be the fact that the first defendant does not have its registered office in a contracting member state. However, even if this defendant were to be considered in isolation, the Central Chamber would not have jurisdiction in the present case. No agreement between the parties pursuant to Article 33(7) EPC has been submitted. Article 33(1)(a), third subparagraph, EPC provides for a right of choice, which the claimant exercised in its favour by bringing the infringement action before a local chamber. Finally, it should be noted that, pursuant to Article 7(2) of the EPC in conjunction with Annex II, the Paris Central Chamber (seat) would have jurisdiction over an infringement action concerning the patent in dispute. The IPC class of the patent in dispute is H. With regard to the Central Chamber in Paris (seat), however, the EPG is, even according to the defendant's submission, established in accordance with the provisions of the EPGÜ.

36. The argument that it cannot be ruled out that the composition of the various chambers would have been different had the EPG been established correctly does not hold water. Nor would it hold water even if the assumption regarding the composition were in fact correct. Article 47(2) of the EU Charter of Fundamental Rights states that everyone has the right to have their case heard by an independent and impartial tribunal previously established by law, in a fair hearing, in public and within a reasonable time. The wording of Article 6(1) of the ECHR is similar. It follows from this fundamental or human right, in particular, that the court must be established by law before it commences its judicial activities, and that the principles governing its organisational structure as well as its subject-matter and territorial jurisdiction must be regulated by law (in advance). Ad hoc courts (without a statutory basis) for specific individual cases are, by contrast, prohibited. The composition of individual panels of a (permanent and pre-established by law) court does not, however, as such affect the right to a lawful judge. Only if the judge specifically appointed to hear the case is not independent and/or impartial may this constitute a breach of Article 47(2) of the EU Charter of Fundamental Rights or Article 6(1) of the ECHR. The defendants do not allege the latter.

III.

37. The objection is unfounded in so far as the defendants, pursuant to Rule 19.1(a) of the Rules of Procedure, question the EPG's jurisdiction on the grounds of the application of the exception under Article 83(3) of the EPGÜ. The claimant has validly withdrawn from this.

38. Under Article 32(1)(a) of the EPGÜ, the EPG has, inter alia, exclusive jurisdiction over actions for actual or threatened infringement of patents, whereby this subject-matter jurisdiction also applies, under Article 2(g) of the EPGÜ, to infringement proceedings concerning a European patent which, in accordance with Article 3(c) EPGÜ had not yet expired at the time of the EPGÜ's entry into force. The EPG's jurisdiction ratione materiae is therefore, in principle, established in the present case. The claimant is asserting claims based on the (alleged) use of a European patent which had not yet expired on 1 June 2023.

39. However, the exclusive jurisdiction of the EPG pursuant to Article 32(1)(a), (2)(g) and (3)(c) of the EPGÜ does not apply without restriction during the transitional period. Under Article 83(1) of the EPGÜ, during a transitional period of seven years following the entry into force of the EPGÜ, actions for (alleged) infringement of a European patent (without unitary effect) may continue to be brought before national courts. Article 83(3) EPCU also gives the proprietor of a European patent the option to exclude the EPG's jurisdiction over a European patent. The claimant or the proprietor of the European patent therefore generally has a right of choice during the transitional period, provided the relevant conditions are met. In the case of exclusive jurisdiction pursuant to Art. 32(1)(a) of the UPC Agreement, this therefore constitutes concurrent jurisdiction with regard to a European patent during the transitional period (Munich Local Chamber, UPC_CFI_342/2024, order of 10 February 2025 – Phoenix Contact v. Industria Lombarda Materiale Elettrico et al.).

40. During the transitional period, the delimitation of the EPG's jurisdiction under Article 32(1)(a) of the EPGÜ in relation to national courts is determined, in light of the foregoing, by whether or not the European patent alleged to have been infringed has been excluded from the exclusive jurisdiction of the EPG. If there is a (valid) 'opt-out' within the meaning of Article 83(3) EPC, only the national court has jurisdiction. The EPG, on the other hand, has no jurisdiction unless, in the absence of an objection, the EPG's jurisdiction is deemed to have been accepted in accordance with Rule 19.7 of the Rules of Procedure. If the exemption under Article 83(3) EPC has not been invoked, or if the patent proprietor
'opt-out' pursuant to Article 83(4) of the UPC Agreement (effectively), the concurrent jurisdiction of the UPC and the national court is restored, so that the UPC – as a result of the claimant exercising the right of choice available in this respect – has jurisdiction (Munich Local Chamber, UPC_CFI_342/2024, Order of 10 February 2025 – Phoenix Contact v Industria Lombarda Materiale Elettrico et al.).

41. Under Article 83(4) EPC, the proprietor of a patent that is the subject of a request to avail of the derogation under Article 83(3) EPC may, at any time, file a request with the Registry to withdraw from the derogation invoked, provided that no action has yet been brought before a national court. In accordance with Rule 5.7 of the Rules of Procedure, the request to withdraw must contain the information specified in Rule 5.3 of the Rules of Procedure. It is therefore necessary, inter alia, to specify the representative appointed by the applicant or proprietor pursuant to Article 48 EPC (Rule 5.3 (b)(i) of the Rules of Procedure) or any other person submitting the request on behalf of the proprietor, as well as the power of attorney for the submission of the request to withdraw from the application of the derogation (Rule 5.3(b)(ii) of the Rules of Procedure). The patent proprietor is therefore – as is the case when claiming the exemption – not obliged to appoint a representative pursuant to Article 48(1) and (2) EPC in conjunction with Rule 8 of the Implementing Regulations for the withdrawal application. He may also authorise another person. Under Rule 5.7 of the Rules of Procedure, the withdrawal takes effect from the date of entry in the register.

42. The withdrawal from the 'opt-out' was validly declared by Mr Vigand on 21 May 2024 (App_29033/2024). According to the application, Mr Vigand acted as a "Representative pursuant to Article 48 of the Agreement on a UPC". The withdrawal was confirmed in the CMS on 21 May 2024.

43. The defendant's challenge regarding Mr Vigand's status and authorisation at the time of the withdrawal application ultimately fails to hold water. Mr Vigand is – undisputedly – listed in the EPG's CMS as a "Registered representative before the UPC (Art. 48 UPCA)". According to his written witness statement (Exhibit BP-T 6a), he has held this status continuously since 23 March 2023. This is consistent with the data visible in the CMS regarding App_781/2023, according to which the confirmation of registration as a representative before the UPC is dated 22 March 2023. In his written witness statement, Mr Vigand further stated that he had been authorised by the claimant, in the person of Mr Casino, to declare the withdrawal from the 'opt-out' as a representative. The Court sees no reason to doubt the accuracy of the content of this written witness statement in this respect either. The same applies to the written witness statement of Mr Casino (Exhibit BP-T 6b). Mr Casino, the managing trustee of the claimant, stated in this affidavit, among other things, that Mr Vigand was authorised on 18 May 2024 to represent the claimant before the UPC and to make statements, with the authorisation also extending to the declaration withdrawing the 'opt-out' on behalf of the claimant. The defendants made no comment on the written witness statements.

44. In so far as the defendants object that the statement of claim and the CMS lacked any evidence of Mr Vigand's proper authorisation, their argument does not hold water. In accordance with Rule 5.3(b)(i) of the Rules of Procedure, where a representative within the meaning of Article 48(1) and (2) of the EPGÜ declares a withdrawal from the exemption relied upon, proof of power of attorney is not required. This requirement exists, pursuant to

Rule 5.3(b)(ii) of the Rules of Procedure only for other persons. Rule 5.3(b)(i) of the Rules of Procedure is consistent with Rule 285 of the Rules of Procedure, according to which a representative who claims to represent a party shall be treated as such. Only if his authority is contested by the opposing party must he, on the court's instruction, produce a written power of attorney. Consequently, the court is not required to verify a representative's authority of its own motion pursuant to Article 48(1), (2) EPGÜ. It was therefore not necessary to attach proof of power of attorney to the statement of claim or the application for withdrawal.

45. The defendant's contention that the statement of claim contained no coherent argument whatsoever regarding the (valid) withdrawal from the 'opt-out' is, admittedly, correct in substance. Nevertheless, it does not succeed in the present case. Even if such a submission should have been made within the scope of the information required under Rule 13.1(i) of the Rules of Procedure, the opposition proceedings do not serve to review whether the formal requirements for a statement of claim within the meaning of Rule 13 of the Rules of Procedure have been met. Furthermore, the defendant's underlying objection—namely, the alleged invalidity of the withdrawal and, consequently, the lack of jurisdiction of the EPG under Article 32(1) of the EPGÜ—is precisely the subject of this opposition. The defendant therefore suffers no disadvantage whatsoever from the omission of this argument in the statement of claim.

IV.

46. The Munich Local Chamber has local jurisdiction pursuant to Article 33(1)(a) of the EPGÜ. The objection is therefore also unfounded in so far as it is based on Rule 19.1(b) of the Rules of Procedure.

47. For infringement actions within the meaning of Article 32(1)(a) of the EPGÜ, the local or regional chambers are, in principle, competent pursuant to Article 33(1) of the EPGÜ, whereby the action may be brought both before the chamber of the Contracting State in whose territory the actual or threatened infringement has occurred (Article 33(1) (a) EPGÜ), or before the chamber of the Contracting Member State in whose territory the defendant or one of the defendants has its registered office (Art. 33(1)(b) EPGÜ). In the present case, jurisdiction is established pursuant to Art. 33(1)(a) EPGÜ (place of the tort).

48. According to the claimant's statement of claim, the alleged unlawful use of the patent in dispute is said to have taken place in the Federal Republic of Germany and thus also within the jurisdiction of the Munich Local Chamber. According to the claimant's submission, the second defendant is alleged to have been involved in this act of infringement. The second defendant is alleged to distribute products of the Roku Group in Europe and to be involved in the distribution of the contested embodiments. In this context, the claimant has submitted an extract from the German-language website "www.roku.com/de-de/ " (Exhibit BP-P 4), on which, amongst other things, the contested embodiments are offered, and, referring to the website's terms of use (Exhibit BP-P 15), has argued that the second defendant operates this website.

The claimant has further asserted that the second defendant appears as the responsible company in the terms of use for the contested embodiments (Exhibit BP-P 22), that it is furthermore listed as the importer in the EU Declaration of Conformity (Exhibit BP-P 9) and is also named on a product label of a unit of the contested designs purchased in the Federal Republic of Germany. In view of this, the claimant has conclusively demonstrated an act of infringement by the second defendant within the jurisdiction of the Munich Local Chamber.

49. Insofar as the defendants argue that the terms of use submitted by the claimant (Exhibit BP-P 15) are dated 4 August 2021 and are no longer current, and that the second defendant does not operate the website and is not responsible for the German market, it can be left open for the time being whether this objection is valid. For jurisdiction to be established, it is not necessary that an infringement has actually occurred or is imminent. Rather, in the context of the jurisdiction assessment, it is sufficient – as is the case here – to make a plausible assertion that an act of infringement justifying jurisdiction has taken place and that this cannot be ruled out from the outset. Whether a harmful event has actually occurred or is imminent is a question of the merits of the claim (see Article 5(3) of Regulation (EC) No 44/2001 (now Article 7(2) of the Brussels I Regulation): ECJ, judgment of 28 January 2025, C-375/13 – Kolassa v Barclays Bank; ECJ, judgment of 19 April 2012, C-523/10 – Wintersteiger v Products 4U).

50. Notwithstanding this, it should be noted that the defendants did not contest the claimant's submissions regarding the EU declaration of conformity and the product label of a copy of the contested design purchased in the Federal Republic of Germany. They contested the claimant's submissions solely with regard to the terms of use. In this respect, however, the defendants left uncontested the plaintiff's further submission in the opposition proceedings that the terms of use of the German-language website had been updated on 5 August 2024, which is why the second defendant had operated the website up to that date and thus also during the period following the entry into force of the EPG.

51. The fact that the alleged act of infringement by the second defendant took place (in part) before the UPC came into force is irrelevant to the question of jurisdiction. The jurisdiction of the EPG pursuant to Article 32(1)(a) of the EPGÜ, Article 2(g) and Article 3(c) of the EPGÜ extends to infringement actions even in so far as they are based on acts of use that are alleged to have taken place prior to the entry into force of the EPGÜ. No breach of Article 28 of the WVK can be identified in this regard. With regard to jurisdiction, there is no retroactive effect (Munich Local Chamber, Order of 10 February 2025, UPC_CFI_342/2024 – Phoenix Contact v Industria Lombarda Materiale Elettrico).

V.

52. In accordance with Rule 20.1 of the Rules of Procedure, the parties are hereby notified that the proceedings will continue in accordance with the Rules of Procedure following the rejection of the opposition. The respective outstanding sets of pleadings must be filed within the prescribed time limit.

53. Under Rule 21.1 of the Rules of Procedure, an appeal against a decision by the Rapporteur to reject the opposition may only be lodged in accordance with Rule 220.2 of the Rules of Procedure. The appeal must therefore be allowed, which is at the discretion of the Rapporteur. Taking into account recital 8 of the Rules of Procedure, the appeal is allowed in the present case. The decision concerns a point of law which may be relevant to a large number of cases, so that a uniform application and interpretation of the jurisdiction provisions of the EPC is appropriate.

ORDER

1. The defendant's objection, including the alternative claims, is dismissed.

2. The proceedings are to continue.

3. The appeal is allowed.

INFORMATION REGARDING THE APPEAL

Pursuant to Rule 21.1 of the Rules of Procedure in conjunction with Rule 220.2 of the Rules of Procedure, an appeal may be lodged against the order within 15 days of service of the order.

DETAILS OF THE ORDER

Order No. ORD_69037/2024 in CASE NUMBER: ACT_36560/2024

UPC number:	UPC_CFI_339/2024
Type of case:	Infringement action
No. of the associated proceedings Application No.:	47532/2024
Type of application:	Objection

Daniel Voß

Digitally signed by Daniel Voß
Date: 18 March 2025
10:06:54 +01:00