



UPC_CFI_702/2024
Procedural order
of the Court of First Instance of the Unified Patent Court, issued on
21/03/2025

APPLICANTS

Mul-T-Lock France
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Mul-T-Lock Switzerland
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Represented by Stanislas Roux-Vaillard

RESPONDENT

IMC Créations
Parc des Essarts
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Represented by Renaud Gaglione

PATENT IN DISPUTE

<i>Patent number</i>	<i>Owner(s)</i>
EP4153830	IMC Créations

COMPOSITION OF THE CHAMBER – CHAMBER SITTING IN PLENARY SESSION

Chair	Camille Lignieres
Judge-Rapporteur	Carine Gillet
Qualified judge in legal matters	Rute Lopes
Rute Lopes	

LANGUAGE OF THE PROCEEDINGS: French

ORDER

1. By writ of 20 November 2004, IMC Créations brought an action for infringement of patent EP830 before the Paris Local Division against the French company Mul T Lock France and the Swiss company Mul T Lock.

2. By written submission dated 27 February 2025, Mul T Lock lodged a preliminary objection, contesting the jurisdiction of the JUB to hear the action for infringement of the patent in its Spanish, British and Swiss designations, requesting the court:

Primarily,

- Decline the jurisdiction of the Unified Patent Court to rule on the alleged infringement of the national designations of patent EP 4 153 830 in force in the States where it does not have unitary effect, and in particular its Spanish, Swiss and British designations;

Or, at the very least,

- Declare that the Unified Patent Court shall not exercise jurisdiction to rule on the alleged infringement of the national designations of patent EP 4 153 830 in force in the States where it does not have unitary effect, and in particular its Spanish, Swiss and British designations;

Consequently,

- Dismiss the Applicant's action insofar as it relates to these designations and declare it extinguished,
- Order the Applicant to bear the costs of the preliminary objection proceedings;

In the alternative,

- Refer this preliminary objection to the main proceedings, in accordance with Rule 20(2) RoP.

3. IMC Créations, invited by the Registry on 28 February 2025 to submit its observations on the preliminary objection, in accordance with R.19.5 RoP, made corrections to its initial statement of case on 11 March 2025 and abandoned its claims against defendant 2 (Mul T Lock Suisse), which is a Swiss branch of Mul T Lock France.

4. On 11 March 2025, IMC Créations requested the court to dismiss the preliminary objection, making the following claims:

1) Find that the territorial scope of the infringement action, which is the subject of the statement of claim, is limited to the States party to the Agreement establishing the Jurisdiction, for the unitary effect of the European patent, and to Switzerland, for the effect of the European patent in that State;

- 2) Declare that a mere procedural option available to the defendant is not a ground under Rule 19 of the Rules of Procedure;
- 3) In any event, rule on the preliminary objection, pursuant to Rule 20 of the Rules of Procedure, by declaring itself competent with regard to the infringement action concerning the European patent for its effects in Switzerland, in accordance with the Lugano Convention, and by rejecting the request to refer the preliminary objection to the main proceedings;
- 4) Reject the request concerning the costs of the preliminary objection proceedings incurred by the defendant.

Arguments of the Parties

5. The MulTLock companies state that:

-Patent EP 4 153 830 ("EP 830") entitled "*Lock comprising a slide flush with a base plate provided with a recess for receiving a slide translation stop*", filed on 21 June 2021 with priority from 26 June 2020, granted on 29 March 2023, was granted unitary effect on 8 November 2023 in the contracting Member States that had ratified the JUB Agreement on the date of registration, namely: Austria, Belgium, Bulgaria, Germany, Denmark, Estonia, Finland, France, Italy, Lithuania, Luxembourg, Latvia, Malta, the Netherlands, Portugal, Sweden and Slovenia. Patent EP 830 is in force outside the Contracting Member States of the AJUB, in Spain, the United Kingdom and Switzerland.

Due to the vagueness of the statement of claim regarding the territorial scope of the measures sought by the applicant, which appear to refer to Switzerland, Spain and Poland, or even "abroad", the applicants request that the UPC declare itself competent only in respect of the countries in which the patent has unitary effect and decline jurisdiction for any application based on a national designation of EP 830.

-The international jurisdiction of the JUB is governed by the Brussels I bis Regulation or by the Lugano Convention when the jurisdiction of a third State party to the Convention, in particular Switzerland, is involved, as these texts designate the court in which the defendant is domiciled. However, where the validity of the European patent is likely to be contested, either by way of action or by way of exception, the national courts have exclusive jurisdiction (Articles 24(4) and 27 of the Brussels I bis Regulation and Articles 22(4) and 25 of the Lugano Convention), so that many national courts hearing an action for infringement of a European patent decline jurisdiction when the validity of a foreign designation of a European patent is contested.

The solution adopted by the CJEU on 25 February 2025 creates a significant imbalance between the parties, to the benefit of the claimant and to the detriment of the defendant, forcing the latter to initiate as many individual invalidity actions in each of the Member States where the national designations invoked by the claimant in the infringement proceedings are registered. This situation infringes the right to a fair trial within the meaning of Article 6(1) of the European Convention on Human Rights. It undermines legal certainty and the prevention of the risk of divergent decisions and is likely to compromise the very purpose and objective of the Unified Patent Court.

-With regard to patents in force in third countries, the solution infringes on the sovereignty of States, since it is for the courts of the EU Member States to assess validity and infringement in accordance with the applicable national law. It undermines legal certainty with the uncertainty of enforcing the decision in the third countries concerned.

-The applicants suggest that the solution in the CJEU judgment, delivered on preliminary questions from a national court, should not be implemented and that the UPC should not have jurisdiction to rule on the infringement of a patent registered outside a Member State that is a contracting party to the UPC Agreement, even where the validity of that patent is contested or likely to be contested, considering that the criteria for the jurisdiction of the common court, which is based on a convention, are not necessarily those applicable to the national courts of a Member State of the European Union; considering that patents granted by third countries do not constitute a matter governed by the UPC, the instrument establishing the common jurisdiction, or choosing not to exercise this jurisdiction on the basis of considerations of general international law.

-The decision of the Düsseldorf Local Division of 28 January 2025 (Fujifilm/Kodak CFI_355/2023), which held that it had jurisdiction to rule on the infringement of the British part of a patent in dispute, is open to criticism and cannot be transposed, in that it concerns the jurisdiction of a third State and not a State bound by the Brussels I bis Regulation or the Lugano Convention, and in that the court held that the defendant had not filed a counterclaim for invalidity of the British part before the JUB and that the case then pending before the CJEU was irrelevant.

-The defendants therefore request that the JUB decline jurisdiction to rule on the national designations of the contested patent in non-contracting states of the AJUB, namely Switzerland, the United Kingdom and Spain, regardless of whether or not a counterclaim for invalidity of the patent has been formalised by the defendants, who still have time to do so at this stage, it being noted that if the JUB retained its jurisdiction, it would have to apply the national laws of each of the designations of the patent in question, pursuant to Article 8(1) of Regulation (EC) No 864/2007 (Rome II Regulation).

-In the alternative, they request that the question of the jurisdiction of the JUB be referred back to the main proceedings, in accordance with R. 20(2) RdP.

6. IMC Créations responds that:

-the territorial scope of the infringement action is limited to the effects of the European patent, in the States party to the AJUB and in Switzerland, countries in which the acts of infringement originate, but also in any other foreign State.

-R.19 RdP does not allow the defendant to invoke a simple optional procedural option, namely to challenge the validity of the patent, which is purely hypothetical at this stage.

-Under the Lugano Convention, to which Switzerland is a party, the court with jurisdiction to hear an action for infringement of a European patent is, in principle, the court of the defendant's domicile, including for acts of infringement committed on Swiss territory, the court seised having the power, in the event of a challenge to the validity of the Swiss part of the patent, to suspend or proceed with the infringement action, depending on its assessment of the merits of the arguments put forward in support of the invalidity of the Swiss part of the patent.

-According to CJEU judgment C339-22 of 25 February 2025, the court of the Member State of the European Union within whose jurisdiction the defendant is domiciled, hearing an action for infringement of a patent granted in another Member State, remains competent to hear that action where, in the course of the proceedings, the defendant challenges the validity of that patent by way of exception, whereas jurisdiction to rule on that validity lies exclusively with the courts of that other Member State.

GROUNDS FOR THE DECISION

7. Mul T Lock France and its branch in Switzerland contest the jurisdiction of the JUB to hear the infringement action brought by IMC Créations, based on the Spanish, Swiss and United Kingdom parts of the European patent.

8. The applicant refers variably to "France, Switzerland and abroad".

9. The infringement action and the ancillary measures sought can, by virtue of the principle of territoriality of the patent, only concern the countries where the title is in force, namely, in this case, the countries designated in the unitary patent, as well as the national parts of the European patent in force, having effect in countries that are not signatories to the UPC Agreement, namely Switzerland, Spain and the United Kingdom.

Admissibility of the preliminary objection

10. In the absence of an email address for the defendants, the statement of claim was served by registered letter with acknowledgement of receipt, sent by post on 17 January 2025, in accordance with Rule R.271.4 (a) of the Rules of Procedure, to the defendants who were the addressees, so that the defendants are deemed to have received it on 27 January 2025 (Rule 271.6 (b) of the Rules of Procedure). The preliminary objection was raised on 27 February 2025, within the one-month time limit set out in Rule R.19.1 RdP, and concerns the jurisdiction of the court, so it is admissible.

Legal basis

11. According to Article 31 of the Agreement on the Unified Patent Court (UPC Agreement), the international jurisdiction of the UPC is established in accordance with EU Regulation No 1215/2012 (Brussels I bis) or, where applicable, on the basis of the Lugano Convention.

The jurisdiction in principle, in civil and commercial matters, in the Member States of the European Union, is, according to Articles 4 of the Brussels Regulation and 8(1) of the same text, in the case of multiple defendants, that of the courts of the Member State of the domicile of the defendant or one of them.

By way of exception, pursuant to Article 24(4) of the Regulation, "*Without prejudice to the domicile of the parties, (...) in matters relating to the validity of patents, (...) whether the issue is raised by way of action or defence, the courts of the Member State in whose territory the application for registration or registration has been filed (...) shall have exclusive jurisdiction.*

Without prejudice to the jurisdiction conferred on the European Patent Office [by the European Patent Convention], the courts of each Member State shall have exclusive jurisdiction in matters relating to the registration or validity of a European patent granted for that Member State."

Finally, according to Article 27 of the Brussels I Bis Regulation, "*The court of a Member State with which a case is brought as the main action and for which the courts of another Member State have exclusive jurisdiction pursuant to Article 24 shall of its own motion decline jurisdiction.*"

Pursuant to Article 71a of the Brussels I bis Regulation, the Unified Patent Court is a court common to several Member States and is deemed to be a court of a Member State when exercising its jurisdiction under the UPC.

The Lugano Convention of 30 October 2007, applicable when the jurisdiction of a third State (non-member of the European Union) that is a party to that convention (Swiss Confederation, Kingdom of Denmark, Kingdom of Norway and Republic of Iceland), including Switzerland, establishes the same principle of jurisdiction for the courts of the defendant's domicile and the same exception under Articles 22(4) and 25 when the validity of the patent is at issue.

The CJEU ruling

12. With regard to the jurisdiction of a court of the Union in relation to States bound by the Brussels I bis Regulation, the CJEU, in its judgment of 25 February 2025 (Case C-339/22 BSH Hausgeräte GmbH v Electrolux AB), ruled on a preliminary question that: "*Article 24(4) of Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters must be interpreted as meaning that:*

A court of the Member State of the defendant's domicile, seised under Article 4(1) of that regulation of an action for infringement of a patent granted in another Member State, retains jurisdiction to hear that action where, in the course of that action, the defendant raises as a defence the validity of that patent, whereas jurisdiction to rule on that validity lies exclusively with the courts of that other Member State.

13. It follows that the courts of the Member State in which the patent was granted have exclusive jurisdiction to hear a challenge to the registration or validity of the patent, whether that challenge is raised by way of an action or a defence in proceedings for infringement brought before a court of another Member State of the European Union.

14. The court hearing the infringement action must therefore decline jurisdiction with regard to the invalidity of the patent. However, the court hearing the case does not lose its jurisdiction to hear the infringement action solely because the defendant challenges the validity of the title by way of exception.

15. The court may, in particular if there is a reasonable and significant chance that the patent will be revoked by the court of the Member State in which the patent was granted, suspend the proceedings pending the decision of the court hearing the action for revocation.

16. With regard to titles issued by third countries (not bound by the Brussels I bis Regulation or the Lugano Convention), the CJEU has ruled that "*Article 24(4) of Regulation (EU) No 1215/2012 must be interpreted as meaning that:*

It does not apply to a court of a third State and, consequently, does not confer exclusive or non-exclusive jurisdiction on such a court with regard to the assessment of the validity of a patent granted or validated by that State.

If a court of a Member State is seised, on the basis of Article 4(1) of that regulation, of an action for infringement of a patent granted or validated in a third State, in which the validity of that patent is raised as a defence, that court shall have jurisdiction, pursuant to Article 4(1), to rule on that plea, its decision in that regard not affecting the existence or content of the patent in that third State or entailing any amendment to the national register of that State.

17. Thus, by virtue of the principle of non-interference and state sovereignty, only the courts of the third state in which the patent was granted or validated have jurisdiction to declare the patent invalid, which may lead to an amendment of that state's national register.

18. However, the court hearing the infringement action, when the ground of invalidity of the patent granted by the third State is raised by way of exception, has jurisdiction in principle, on the basis of Article 4(1) of the Regulation, to rule on that ground, the decision having only *inter partes* effect.

Response to the defendants' arguments

19. The JUB, a common court, is, pursuant to Article 71a of the Brussels I bis Regulation, deemed to be a court of a Member State of the European Union. It is required to apply EU law, as interpreted by the decisions of the CJEU, in accordance with Article 20 of the AJUB. In the present case, there is no reason to disregard or decide not to implement the solutions put forward by the CJEU, without excluding patents registered in States other than those in which the AJUB is in force.

20. The solution reached by the CJEU judgment of 25 February 2025 applies in this case with regard to the Spanish part of the patent and with regard to the British part of the patent. It is also transposable to the Swiss part of the European patent, as this is a dispute involving the JUB (assimilated to a court of a Member State of the European Union) and a State bound by the Lugano Convention, to which Article 31 of the AJUB refers, which establishes the same jurisdiction in principle for the courts of the defendant's domicile and the same exceptions with regard to the registration or validity of the patent, pursuant to Articles 22(4) and 25, when the validity of the patent is at stake.

21. The JUB therefore has jurisdiction to hear the infringement action brought by IMC Créations in respect of the Spanish and Swiss parties, where appropriate, by staying the proceedings pending the decision of the national court hearing the action for invalidity, if there was a reasonable and significant risk that the patent would be invalidated by the court of the State in which the patent was granted.

The JUB also has jurisdiction to hear the infringement action brought by the British part of the patent and, where applicable, to rule on the validity of the title, provided that the decision on the patent invalidity exception has only *inter partes* effect.

22. Furthermore, the Paris Local Division has territorial jurisdiction, due to the domicile in France of one of the defendants, to hear the infringement action brought by IMC Créations, especially since at this stage of the proceedings, the invalidity of the national parts of the patent, in force in Spain (a country bound by Brussels I bis) or Switzerland (a country bound by the Lugano Convention) or the United Kingdom, has not been invoked.

23. The patent holder must be able to concentrate all of its infringement claims, in the event of infringement disputes in several Member States of the Union, and obtain comprehensive compensation before a single court, thereby avoiding the risk of divergent decisions (above-mentioned CJEU judgment, paragraph 49).

24. In order to ensure legal certainty and the predictability of the rules of jurisdiction, the jurisdiction of the defendant's court to rule on an infringement action must not be made dependent on the defendant's procedural strategy (CJEU judgment - paragraph 46).

25. There is no infringement of the rights of defence or the principle of equality of arms between the parties, since, in the event of a challenge to the validity of the patent by way of exception, the court hearing the infringement action has the power to stay the proceedings in order to take into account, where appropriate, the decision of the court of the Member State of the European Union or of a State bound by the Lugano Convention, or to give a decision with *inter partes* effect only, where the validity of the patent granted by a third State is contested.

26. In view of all these factors, the preliminary objection challenging the jurisdiction of the Paris Local Division of the UPC to rule on the alleged infringement of the national designations of EP 4 153 830 in force in the States where it does not have unitary effect, and in particular its Spanish, Swiss and British designations, without it being necessary to refer this question to the main proceedings.

27. The costs and expenses relating to the preliminary objection will be decided upon with the decision on the merits.

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merits.

The

court:

-rejects the preliminary objection raised by Mul T Lock

-Says that there is no need to refer the preliminary objection to the main proceedings

- States that Mul T Lock France and Switzerland must file their defence before 28 April 2025

-Defer the decision on the merits, the costs and expenses of the preliminary objection proceedings.

An appeal may be lodged against this order within 15 calendar days of its notification to the unsuccessful party, in accordance with Article 73(2)(a) UPCA and Rule 220.2 RdP.

Done and pronounced in Paris on 21 March 2025

Camille Lignières, Presiding Judge

Date: 21 March
Camille Lignières 2025
13:58:50 +01'00'

Carine Gillet, Judge-Rapporteur

21 March 2025
Carine Gillet 14:48:26
+01'00

Rute Lopes, legally qualified judge

Rute
Alexandra Da
Silva Sabino
Lopes

Digitally signed by
Rute Alexandra Da
Silva Sabino Lopes
Data: 21 March
2025
10:52:23

DETAILS OF THE ORDER

Order No. ORD_11997/2025 in ACTION No.: ACT_61422/2024 UPC No.:

UPC_CFI_702/2024

Type of action: Action for infringement Related
proceedings no.: 10014/2025

Type of application: Preliminary objection