

# Jurisdiction of national courts of States party to the Agreement on a Unified Patent Court in respect of actions relating to classic European patents during the transitional period

A critical analysis of the Venice Court (Companies Division) judgment of 12 November 2025 (N. R.G. 10432/2024).

---

## RAIS AMILS ARNAL

Partner

IP Practice Area, Gómez-Acebo & Pombo

## ÁNGEL GARCÍA VIDAL

Professor of Corporate & Commercial Law, University of Santiago de Compostela

Academic counsel (external consultant), Gómez-Acebo & Pombo

## 1. Jurisdiction in respect of actions relating to classic European patents during the transitional period following the entry into force of the Agreement on a Unified Patent Court

- 1.1. The Unified Patent Court (UPC) has jurisdiction ('competence') in respect of actions relating to classic European patents (i.e. European patents

without unitary effect) provided that the opt-out in the Agreement on a Unified Patent Court (UPC Agreement or Agreement) — the possibility of excluding the UPC's jurisdiction over a particular classic European patent — has not been exercised or, if exercised, has been withdrawn. However, for a certain period, this jurisdiction is not exclusive.

In fact, the UPC Agreement establishes a transitional regime for court proceedings relating to those European patents without unitary effect and to supplementary protection certificates (SPCs) granted on the basis of one of these patents. Thus, Article 83(1) of the Agreement provides that during a transitional period of seven years after the date of entry into force of the 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”.

The aforementioned Article 83(1) of the Agreement expressly refers to actions for infringement of European patents and supplementary protection certificates, as well as actions for revocation. If we compare the wording of this provision with that of Article 32(1) of the Agreement, we see that the latter, in listing the actions over which the UPC has exclusive jurisdiction, also includes other actions closely related to infringement actions: “actions for provisional and protective measures and injunctions” (Article 32(1)(c)) and “actions for damages or compensation derived from the provisional protection conferred by a published European patent application” (Article 32(1)(f)). Given the close relationship between these actions and actions

for infringement of European patents and supplementary protection certificates, expressly referred to in Article 83(1), we understand that a logical interpretation of this provision should also extend it to these actions.

More controversial is the case of “actions for declarations of non-infringement” (Article 32(1)(b)). On the one hand, these actions are undoubtedly similar to actions for infringement, which would argue in favour of the transitional regime of Article 83(1) also applying to such actions for declarations of non-infringement. However, it is also true that this would mean that during the transitional period it would still be possible to bring actions for declarations of non-infringement to torpedo actions for infringement, which is why some legal scholars<sup>1</sup> have considered that if such actions were not expressly included in the wording of Article 83 of the UPC Agreement, it is to ensure that, after the Agreement enters into force, actions for declarations of non-infringement can only be brought before the UPC. In any case, the UPC has not yet ruled on this matter.

- 1.2. Thus, in accordance with Article 83(1) of the UPC Agreement, once the Agreement has entered into force, the possibility of continuing to bring the above actions before national courts automatically applies. In other words, a person seeking to bring one such action will not have to meet

---

<sup>1</sup> SCHALLMOSER, K., “Division of jurisdiction in transitional period,” *EPLAW Patent Blog*, 1 October 2013, p. 6.

any requirements or take any steps other than bringing the action before the relevant national court within the transitional period set out in the Agreement. This being the case, the national court will retain its jurisdiction, even if the transitional period ends while the action is pending (Article 83(2) ATUP).

The aim is to prevent holders of patents or supplementary protection certificates applied for when the UPC was not yet operational from being forced to go before it. In other words, the aim is to safeguard the situation that existed when these rights were applied for, since if, at that time, the holders had known that the UPC would have jurisdiction in respect of any action relating to those patents, they might have chosen not to apply for a European patent, but to apply for national patents instead, thereby avoiding the UPC's competent jurisdiction.

The aforementioned transitional period of seven years may be extended to fourteen years from the entry into force of the UPC Agreement. Article 83(5) provides that, after the first five years from the entry into force of the Agreement, the Administrative Committee may decide to prolong the transitional period by up to seven years, depending on the outcome of a broad consultation with users of the system and a survey on the number of European patents and supplementary protection certificates with respect to which actions for infringement or for revocation or declaration of invalidity

are still brought before national courts, the reasons for this and the implications thereof.

This transitional period could therefore last for fourteen years. And, bearing in mind that European patents have a duration of twenty years from the date of application and that the granting of a patent can take several years, it cannot be ruled out that patents granted shortly before the entry into force of the UPC Agreement may expire before the end of the transitional period.

## **2. The erroneous interpretation by the Venice Court (Companies Division) in its judgment of 12 November 2025 (N. R. G. 10432/2024)**

Despite the above legislation, the recent ruling of the Venice Court (Specialised Business Section) of 12 November 2025 (N.R.G. 10432/2024) has made an interpretation that, in our opinion, would contravene the provisions of Article 83 of the UPC Agreement discussed above.

In this specific case, the holder of an Italian national patent, as well as a European patent validated in Italy, brought an action before that national court against a company for the alleged infringement of those patents. This action was based on the consideration that, although the UPC has jurisdiction to hear actions for infringement of classic European patents, during the transitional period, national courts, such as the Court of Venice in this case, are also courts of competent jurisdiction.

Nevertheless, the Venice Court, acting on its own initiative, held that it did not have

jurisdiction to hear the action for infringement of the claimant's classic European patent validated in Italy. According to the court, it would only have jurisdiction if the claimant had made use of the opt-out, i.e. if it had made use of the power provided for in the UPC Agreement itself to exclude the UPC's jurisdiction over a particular classic European patent.

It should be noted that, according to Article 83(3) of the UPC Agreement, unless an action has already been brought before the UPC, the proprietor or applicant of a European patent granted or applied for before the end of the seven-year transitional period (extendable for a further seven years), as well as the holders of supplementary protection certificates issued for products protected by European patents, have the possibility of opting out

of the exclusive jurisdiction of the Court. To this end, they shall notify the Registry of the Court of Appeal of this fact no later than one month before the end of the transitional period. The exemption shall take effect from the date of its entry in the Registry's register.

national courts retain their jurisdiction. Thus, in accordance with Article 83(1) of the Agreement, the holder of a classic European patent or a supplementary certificate may bring an action for infringement of their patent before a national court, but may find that the defendant brings an action for invalidity of the same European patent before the UPC, since, as mentioned above, the transitional regime of Article 83(1) of the Agreement maintains the jurisdiction of national courts, but does not deprive the UPC of its jurisdiction. The only way to prevent this from happening (and to deprive the UPC of such jurisdiction) is by means of the opt-out provided for in Article 83(3) of the agreement.

However, the Venice Court interprets both provisions in a way that we consider to be completely contrary to this, and instead of recognising the shared jurisdiction of the national courts and the UPC during the transitional period (unless the opt-out has been used, in which case claims may only be brought before national courts), it considers that jurisdiction to hear actions based on a classic European patent lies solely with the UPC and that a national court may only hear such actions if the proprietor has made use of the aforementioned opt-out.

Consequently, the Italian court states that 'concurrent' jurisdiction during the transitional period does not therefore mean that the proprietor can choose, on a case-by-case basis, which court to bring proceedings before; in fact, this would create uncertainty and dysfunction, both for

of the exclusive jurisdiction of the Court. To this end, they shall notify the Registry of the Court of Appeal of this fact no later than one month before the end of the transitional period. The exemption shall take effect from the date of its entry in the Registry's register.

This possibility of excluding the UPC's jurisdiction goes a step further than Article 83(1) of the Agreement, which provides for a transitional period during which na-

potential defendants — exposed to the discretion of the proprietor — and for those seeking to bring an action against the proprietor in relation to a European patent, since the interpretation put forward by the claimant does not explain how they should proceed during the transitional period in the absence of an unequivocal signal derived from the exercise of the opt-out.

This interpretation departs — in our view, unduly — from the unanimous interpretation of Article 83 of the UPC Agreement

and the transitional jurisdiction of national courts. The opt-out is not necessary to be able to bring proceedings before national courts during the transitional period, but is rather a protective mechanism conferred on proprietors to prevent the UPC from hearing cases concerning their classic European patents or supplementary certificates granted on the basis thereof and, thereby, preventing third parties from bringing actions against them (for invalidity or declarations of non-infringement) that could have effects in all the States party to the Agreement.