

Expansive Jurisdiction of the UPC vs. a Torpedo Action before a National Court

In a recently published [Blog post](#), we described the practice of the Unified Patent Court (UPC) in extending its jurisdiction beyond the states that have formally joined the enhanced co-operation on the unitary patent. This time, we ask whether it is possible to defend oneself against the UPC's long-arm jurisdiction. We examine whether initiating proceedings before a Polish court for a declaration of non-infringement can protect us from a UPC finding of infringement that is effective in all the contracting states.

At the outset, it should be emphasized that we are dealing here with an emerging practice, and no established line of case law exists on which these considerations could be based. Many of the issues presented here will inevitably be tested in future UPC decisions as well as by national courts whose response to the expansionism of the UPC remains largely uncertain.

What follows from the CJEU judgment in *BSH v. Electrolux*

In the article cited above, we analyzed [the judgment of the Court of Justice of the European Union \(CJEU\) of 25 February 2025 in Case C-339/22 BSH Hausgeräte GmbH v. Electrolux AB](#), which — although not directly concerning the UPC — requires us to acknowledge that the Unified Patent Court may adjudicate on infringements of a European patent even when they occur in an EU Member State that is not party to the UPC Agreement, or in a non-EU state that is party to the European Patent Convention. However, it may not rule on the validity of those parts of a European patent that have been validated in EU Member States or parties to Lugano Convention that are not parties to the UPC Agreement. Where invalidity proceedings are pending before a national court, the UPC may stay its proceedings especially where it concludes that “there is a reasonable, non-negligible possibility of that patent being declared invalid by the court of that other Member State that has jurisdiction” (para. 51 of the judgment).

If the invalidity challenge concerns national parts of a European patent validated in states that are neither EU members nor parties to the Lugano Convention and, moreover, do not participate in the unitary patent system (e.g. the United Kingdom), the UPC may examine the challenge, but any finding of invalidity will have only *inter partes* effect.

The Status of the UPC under the Brussels I bis Regulation

Article 71a 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 \(Brussels I bis\)](#) introduces the notion of a “common court” and grants this status to the Unified Patent Court (UPC) and the Benelux Court of Justice. When such a court exercises jurisdiction in matters falling within the scope of the Regulation (including, for example, patent infringement and validity), **it is deemed to be a court of a Member State**. Its jurisdiction is determined under the Regulation, taking account of Article 71b. Such a court is empowered to hear all matters falling within the scope of the UPC Agreement that, under the Regulation, would fall within the jurisdiction of the states participating in the system. This therefore includes issues of infringement and validity of unitary patents and European patents for which no opt-out has been registered (point 1 in connection with Articles 3 and 32 of the UPC Agreement). Brussels I bis also separately defines the UPC’s jurisdiction in cases where: (a) the defendant is not domiciled in one of the Member States and the Regulation does not otherwise confer jurisdiction over them (the appropriate application of the Regulation’s jurisdictional rules) (point 2); and (b) the UPC has jurisdiction under Article 71b(2) in a dispute relating to an infringement of a European patent giving

rise to damage within the Union — with respect to damage arising outside the Union as a result of such infringement (point 3).

Reference to the rules on resolving jurisdictional conflicts

Pursuant to Article 71c(1), **Articles 29-32 (provisions on *lis pendens* and related actions) 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.** In other words, the mechanisms governing *lis pendens* apply to relations between the UPC and national courts of Member States that remain outside the unitary patent system. Thus, if parallel proceedings are initiated before a court in Poland, Spain, or Croatia and before the UPC, these provisions of the Regulation must be applied. Article 71c(2) clarifies that the same rules apply in relations between the UPC and the contracting Member States during the 7-year transitional period.

A) Actions involving the same cause of action (Article 29)

Article 29 of the Regulation provides: *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* (para. 1).

If proceedings before a Polish court were intended to block an infringement action before the UPC, establishing that the situation falls within the scope of Article 29 would be most advantageous. In such a case, the national court must stay the proceedings; it has no margin of discretion. **If the UPC is the court seised later, it must stay the proceedings** (para. 1), and once the jurisdiction of the court first seised is confirmed, the UPC must decline jurisdiction (para. 3).

Article 29 applies to “the same cause of action” — a term with autonomous meaning in EU law (independent of how it may be understood in national law). **It requires identity of parties, subject matter, and cause of action, both in law and in fact.** As the Court of Justice of the EU (CJEU) held in its [*judgment of 6 December 1994 in Case C-406/92 Tatry*](#):

An action seeking to have the defendant held liable for causing loss and ordered to pay damages has the same cause of action and the same object as earlier proceedings brought by that defendant seeking a declaration that he is not liable for that loss.

This reasoning can easily be applied to the pair: infringement claim / declaration of non-infringement. The same conclusion is also clearly expressed in the [*The jurisdiction of European co-*](#)

[urts in patent disputes](#) handbook published by the EPO. The authors refer to this specifically in the context of so-called “torpedo actions,” describing situations in which filing an action for a declaration of non-infringement in State X, known for lengthy court proceedings, may effectively block infringement actions in States Y and Z (p. 18).

However, it must be remembered that identity of actions under Article 29 Brussels I bis depends on the identity of the legal and factual basis. In patent disputes, **this requires that the proceedings concern the same European patent and the same alleged infringing acts.**

Yet an open question remains as to the extent of the effects of staying the proceedings: will they concern only the national part of the patent and shield the defendant from an assessment of infringement in Poland/Spain/Croatia/the third state by the UPC? It appears that in light of the CJEU judgment in *BSH v Electrolux*, this need not be the limit. If the jurisdiction of a Member State outside the UPC system is established pursuant to Article 4(1) Brussels I bis (the defendant’s domicile), then — following the CJEU’s reasoning — such a court could hear an infringement action concerning the national parts of a European patent covering other states as well. The CJEU, contrary to Electrolux’s position, agreed that Swedish courts could examine claims concerning infringements of national parts of the patent other than the Swedish part. Applying this to the situation involving the UPC, it would not be unreasonable to conclude that a court of a state outside the unitary patent system could in such circumstances also adjudicate on infringements not only of the relevant national part, but also on broader cross-border infringements. **This could hypothetically produce the effect of blocking the entire proceedings before the UPC** (see [here](#)).

B) Actions involving related claims (Article 30)

Article 30 Brussels I bis applies to related claims. According to paragraph 1, *where related actions are pending in the courts of different Member States, any court other than the court first seised may stay its proceedings*. Where such parallel proceedings take place at first instance, the court seised later may, upon application of a party, decline jurisdiction — provided that the court first seised has jurisdiction over the actions and that consolidation is permitted under its law (para. 2).

Paragraph 3 defines related actions as those: *actions are deemed to be related where they are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings*. Article 30 appears a persuasive candidate for application in cases where one court hears an infringement action and another an invalidity action. These proceedings are not identical, yet a potential infringement judgment and a declaration of invalidity would clearly be mutually inconsistent.

It must be emphasised, however, that in cases of related actions **the court is not required to stay the proceedings**. One must recall the CJEU's conclusion in *BSH v Electrolux*: a court may stay proceedings if there is a reasonable, non-negligible possibility of that patent being declared invalid by the court of that other Member State that has jurisdiction.

A different regime for third states

It should be noted that the above considerations concern jurisdictional conflicts between the UPC and courts of EU Member States. The situation differs where the court on the other side of the UPC is a court of a third country, e.g., a UK court.

A) Actions involving the same cause of action

Under Article 33(1), staying proceedings in the event of parallel actions filed with the UPC and with a court of a third state is discretionary. It is possible only if it may be expected that the court of the third state will issue a judgment capable of recognition and enforcement in that Member State, and the Member State court (here the UPC) is satisfied that the stay is necessary for the proper administration of justice. If the court in the third state has already issued a judgment capable of recognition and enforcement, the UPC must discontinue the proceedings (para. 3).

B) Actions involving related claims

A stay is also discretionary where the action brought before a Member State court is related to an action in a third state. The court may stay the proceedings if the same conditions as under Article 33(1) are met, supplemented by the requirement that "it is expedient to hear and determine the related actions together to avoid the risk of irreconcilable judgments resulting from separate proceedings" (Article 34(1)). The same rule as in Article 33(3) applies to discontinuance in the case of related claims.

Different rules for provisional and protective measures

It should also be noted that possibilities of escaping the long arm of the UPC remain limited. A torpedo action — even if it results in a stay of the UPC proceedings — does not deprive the UPC of the ability to order interim measures.

Article 35 Brussels I bis provides:

Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that Member State, even if the courts of another Member State have jurisdiction as to the substance of the matter.

In the context of the UPC, the reference to the law of a Member State must of course be understood as referring to the Unified Patent Court.

Conclusion

A torpedo action may appear to be an attractive defensive strategy against the expansionism of the UPC: **a potential defendant may bring an action for a declaration of non-infringement before a court of a state such as Poland, Croatia, or Spain.** In such a case, under Article 29 Brussels I bis, the UPC will be unable to examine alleged infringements in those states. It is worth emphasising that an action for a declaration of non-infringement offers a greater chance of achieving this effect (identity of claims — mandatory stay) than an invalidity challenge (related claims — discretionary stay). A similar strategy may be pursued by bringing an action in a third state, but in that scenario a stay will be discretionary. It remains to be seen how the UPC and national courts will respond to such arguments.