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Trends and new developments of case law on cross border patent litigation

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The recent CJEU decision in BSH Hausgeräte v. Electrolux (C-339/23)

- The case originated in Sweden, where BSH sued Electrolux for patent infringement concerning vacuum cleaners. The contested patent was validated not only in Sweden but across multiple EU jurisdictions, as well as in third states such as the UK and Turkey.
- Electrolux challenged the Swedish court's jurisdiction, citing Article 24(4) of the Brussels I Regulation (EU) 1215/2012. This provision grants exclusive jurisdiction to the courts of the state in which a patent was granted for matters concerning its validity. Electrolux argued that its counterclaim for invalidity deprived the Swedish court of jurisdiction over the entire case. The Swedish court agreed and dismissed the infringement claim. BSH appealed, leading to a referral to the Court of Justice of the European Union (CJEU) to clarify the extent of EU courts' jurisdiction over patents granted in other EU states and third countries.





The CJEU Decision

On 25 February 2025 The CJEU ruled that:

1. Jurisdiction Over EU Patents

EU courts retain jurisdiction over infringement disputes involving patents granted in other EU states, even when a defendant raises validity objections. However, the actual determination of a patent's validity remains the exclusive jurisdiction of the granting state. Courts may, at their discretion, stay proceedings if a serious validity challenge is pending in the competent jurisdiction.

2. Jurisdiction Over Third-State Patents

The Court held that Article 24(4) does not apply to patents granted by non-EU states. Therefore, EU courts may assess the validity of third-state patents as part of infringement proceedings, though any findings will be limited to the parties involved (inter partes) and will not affect the official patent register of the granting state.

3. Long-Arm Jurisdiction & Stays

The decision confirms that EU courts have jurisdiction on over cross-border infringement disputes, reinforcing the ability of courts to hear cases involving non-EU patents under certain conditions. Courts may choose to stay proceedings if there is a reasonable likelihood that a third-state court will declare the patent invalid.



Significance and Impact of the CJEU decision



The BSH ruling significantly alters the jurisdictional landscape for European patent litigation. Previously, the mere assertion of an invalidity counterclaim could force EU courts to relinquish jurisdiction. This ruling prevents such procedural tactics, ensuring that infringement proceedings can continue even when validity is contested.

By allowing EU courts to adjudicate infringement disputes involving third-state patents on an inter partes basis, the ruling also raises questions about how far European courts might extend their reach, including other jurisdictions.



ITALY

The decision by the UPC Milan Local Division of 8 April 2025

The UPC wasted no time in applying the CJEU's ruling in the BSH case. The Paris Local Division has now asserted jurisdiction over a French defendant for alleged infringements of the Spanish, Swiss and British parts of a European patent (see UPC_CFI_702/2024). The Court ruled that it has jurisdiction to hear the infringement claims concerning the Spanish and Swiss parts, with the option to stay proceedings if there is a reasonable and significant risk that the patent could be annulled by the competent national court. Additionally, it confirmed its authority to hear the infringement claim related to the UK part of the patent and, if necessary, assess its validity-provided that any decision on invalidity would have inter partes effect only.





On 8 April 2025, the UPC Local Division Milan (see UPC CFI 792/2024) fully adopted CJEU's reasoning in BSH/Electrolux:

- a) The UPC "shall be deemed to be a court of a Member State" pursuant the Article 71a of the Regulation (EU) n. 1215/2012 (recast) as amended by Regulation (EU) 542/2014 ("Brussels Ibis Regulation"). The interpretation provided by the CJEU applies to the UPC as if it were a national court
- b) The UPC holds "universal" jurisdiction over defendants domiciled in Contracting Member States including infringement cases for European patents validated in non-UPC member states
- c) The UPC does not lose that jurisdiction merely because, as its defence, that defendant challenges the validity of the national part of that European patent.



Key takeaways and open questions

Consequently, a significantly new legal landscape has emerged for patent holders, whereby:

- (i) they may initiate a single legal proceeding encompassing all acts of infringement committed by the defendant, or even by multiple co-defendants;
- (ii) they are afforded the strategic opportunity to choose the forum in which to enforce their exclusive rights, taking into account the established jurisprudence of the courts of the relevant Member State or the Unified Patent Court (UPC), particularly in cases involving multiple co-defendants and potential concurrent jurisdictions.

Patents may be enforced across multiple EU Member States through proceedings before the Unified Patent Court (UPC). The broader issue of how to address preliminary matters—such as the validity of the patent-in-suit in a case with cross-border implications extends beyond the scope of patent law and raises questions of wider legal significance

Ongoing dialogue between U.S. and Italian IP professionals is both essential and strategically beneficial for the client.





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Thank you!