

**EIP**

# XSYS Germany GmbH & ors. v. Esko-Graphics Imaging GmbH

## **Decision of 2 June 2025 (Order no. ORD\_23545/2025)**

Ekso originally brought infringement proceedings against XSYS in respect of its EP 3 742 231 patent, relating to a method of curing photo-curable printing plates, in August 2024. This patent had been opted out of the UPC's exclusive competence in May 2023, however that opt out was withdrawn in August 2024.

Ekso's complaint referred to alleged infringing acts by XSYS which took place both before and after the formal commencement of the UPC and also which took place during the period when the patent was opted out.

In October 2024, XSYS objected to this, contending that the Court was not competent to decide on acts of alleged infringement which occurred prior to its inception or during the period of the opt out.

Two interesting questions relating to temporal limitations therefore arose for the Court to contend with.

- Did the UPC have jurisdiction to deal with alleged infringements taking place before its formation by way of the entry into force of the UPCA (1 June 2023); and
- Did the UPC have jurisdiction to deal with alleged infringements taking place prior to the withdrawal of the opt-out (26 August 2024)

The Munich Local Division held that the UPC did have the relevant jurisdiction, and XSYS brought the present appeal in response.

XSYS raised a number of arguments in its grounds of appeal, including principles of non-

retroactivity of treaties under the Vienna Convention as interpreted by the European Court of Human Rights and comparable principles in the area of international dispute resolution. XSYS argued that retroactivity only applied if clearly intended in the wording of the UPCA and even requested a reference to the CJEU should the UPC Appeal Court disagree with its position.

In response, Ekso argued that the Vienna Convention only applied to issues of substantive law and not to procedural rules. They argued that rules relating to the determination of the competence of the court were procedural in nature. They also pointed out that retroactive competence of the UPC was consistent with the aims of the UPC; namely to harmonise patent law amongst member states.

In reaching its decision on the first question, the Court took the starting point under the Vienna Convention that “a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty and in the light of its object and purpose” and therefore looked to the wording of the relevant UPCA Article; here, Art. 32(1).

The Court found that there was no temporal limitation provided for in this provision, nor in Art. 3 UPCA (which defines the patent rights in respect of which the UPCA applies) and that this reflected the object and purpose of the UPCA itself identified above.

On the second question, the Court held that there was nothing in the Articles of the UPCA governing the opt out and withdrawal procedure that precluded a party from enforcing its rights at the UPC for allegedly infringing acts which took place during the period when the patent was opted out. In the words of the Court:

“The provisions on withdrawal do not provide for a partial or limited withdrawal: either the patent is opted-out, in which case the patent is entirely out of the exclusive competence of the Court or, if the opt-out is no longer in force, the patent is entirely under the exclusive competence of the UPC, without any limitation...”

The Court further commented that a different approach would lead to a fragmented system, contrary to the object and purpose of the UPCA.

The Court made one other important observation; namely that the issue of applicable law had not been raised by the present appeal. This judgment therefore leaves open the question as to which law should be applied in relation to acts having occurred before the entry into force of the UPCA.

This provides useful certainty to patentees looking to take advantage of the UPC but who have previously opted their European patents out of the UPC's exclusive competence.

Provided that a party complies with all of its obligations associated with withdrawing that opt out, it will be able to capture infringing acts taken in the interim, as well as those falling within the five-year period of limitation (as defined by Art. 72 UPCA) even if that predates 1 June 2023.