

EIP



UPC decides that the formalities of withdrawal of opt out do not matter

Dolby International AB v. Epson France SAS UPC_CFI_77/2025

Order of 27 May 2025 ORD_18316/2025[1]

The Hamburg Local Division of the UPC has decided that a withdrawal of opt out from the UPC is valid, even though it did not comply with the clear, albeit arguably over-strict, rules of procedure.

Epson filed a preliminary objection in the infringement action filed against it by Dolby, arguing that the withdrawal of opt out of the patent from the competence of the UPC was defective.

Rule 5.1(b) RoP requires that an “Application to opt out shall be made in respect of **all of the states** for which the European patent **has been granted** or which have been designated in the application”. That is, it must include ALL the states designated at grant, not only those in which the patent has remained in force, or in respect of which a validation procedure has been carried out.

Rule 5.7 RoP then goes on to say that a withdrawal of the opt out must be “not in respect of different states for which the European patent has been granted or which have been designated in the application”. Thus again, all states must be listed.

In the opt out of the patent in suit, the opt out was correctly requested in respect of all 38 EPC member states in respect of which the patent was granted, but when the withdrawal of opt out was subsequently requested, the withdrawal document that was filed only named DE, ES, FR, GB, IT and NL.

The preliminary objection was decided by the judge-rapporteur as sole judge, who held that the withdrawal was nevertheless valid. The judge-rapporteur relied on the fact that during the process of submitting the opt out and the withdrawal of opt out, all the countries designated in the application at grant are automatically listed in the CMS (taking the data from the EPO Register). Therefore, it was considered that the declaration submitted at the end of the CMS process implicitly refers to all such countries. Therefore, the lack of listing of all the countries in the withdrawal document was not a fatal deficiency. Alternatively, it was considered that the withdrawal of opt out inherently refers back to the opt out itself, and therefore must be taken to refer to the same countries.

Accordingly, the preliminary objection was rejected and the infringement action will continue, although the order could be appealed.

This decision does not reflect what the UPC Rules of Procedure actually say. However, it is consistent with the UPC's general reluctance to conclude that it lacks jurisdiction.

[1] <https://www.unified-patent-court.org/en/node/125704>