



university of  
 groningen

# **Cross-Border Patent Infringement Litigation within the European Union**

**PhD thesis**

to obtain the degree of PhD at the  
University of Groningen  
on the authority of the  
Rector Magnificus Prof. E. Sterken  
and in accordance with  
the decision by the College of Deans.

This thesis will be defended in public on  
Thursday 17 December 2015 at 09.00 hours

by

**Michael Christian Alexander Kant**

born on 7 March 1980  
in Cologne, Germany

**Supervisors**

Prof. M.H. ten Wolde

Prof. J.B. Wezeman

**Assessment Committee**

Prof. A. Schwartze

Prof. S.J. Schaafsma

Prof. P.G.F.A. Geerts

## PREFACE

When prof. mr. dr. M.H. ten Wolde asked me seven years ago, at the end of my LL.M. study at the University of Groningen, if I could imagine to write a doctoral thesis on a topic of private international law, I immediately was both excited and fascinated by this idea. After one day and one (sleepless) night of thinking about this project, I came to the conclusion that I would definitely like to face this challenge.

Regarding the specific topic of the thesis, it became clear to me very soon that I would like to cover somehow two areas of law: international procedural law and property law. When discussing this question with prof. mr. dr. M.H. ten Wolde, he invited me, with regard to the second aspect, to think about a thesis on patent law. After some pre-research in the library of the University of Groningen, during the last days of my LL.M. study, I agreed with this subject – and have never regretted this decision. As I would return to Germany after the LL.M. study to start the “*Rechtsreferendariat*”, I would write the doctoral thesis as an external researcher. During the “*Rechtsreferendariat*” in and near Düsseldorf, I could undertake basic research on my topic in the library of the University of Düsseldorf. After successfully finishing the Second Legal State Exam in 2010, I could then begin to write the text of the doctoral thesis.

At this point, I would like to honestly thank prof. mr. dr. M.H. ten Wolde for his continuing intellectual support during all stages of the thesis: planning, structuring and writing. In our regular meetings in Groningen and Scheemda during the last years, prof. mr. dr. M.H. ten Wolde always took the time to discuss key questions which gave me more than only psychological assistance, but helped me to attain new perspectives and thinking about problematic issues with a new perspective. After every meeting with him, I was inspired to continue my thesis, taking into consideration many helpful hints and proposals. Likewise, I would like to particularly thank my second supervisor, prof. mr. dr. J.B. Wezeman, Dean of Faculty.

Further, I thank prof. mr. dr. P.G.F.A. Geerts (University of Groningen), prof. mr. dr. S.J. Schaafsma (Leiden University) and Univ.-Prof. Dr. A. Schwartz, LL.M. (University of Innsbruck) for participating in the Assessment Committee.

Also, I would like to express my special thanks to mr. dr. J.G. Knot for his assistance when translating the summary of the thesis into Dutch, and to Karien Galli who always helped me when technical problems arose, for instance concerning electronic access to the library of the University of Groningen. Writing the thesis far away from Groningen, it has always been a good feeling that there was someone to rely on when having to resolve such problems. Likewise, I would like to thank the personnel of the law department and the library of the University of Trier for their kind assistance to attain searched literature.

Above all, I owe particular thanks to the University of Groningen which offered me, as an external phd researcher, the great opportunity to write this phd thesis.

This thesis shall be dedicated to Susanne Martin for her invaluable and endless understanding and support, and to my parents, Dr. Hans-Rüdiger Kant and Siegtrud Kant, who have always supported me when necessary.

*“At the moment, one of the most problematic areas of private international law is that of jurisdiction in intellectual property cases where a claim for infringement of a right raises the issue of the validity of that right.”*

(J. Fawcett)

# TABLE OF CONTENTS

TABLE OF CONTENTS .....	1
TABLE OF ABBREVIATIONS .....	16
INTRODUCTION .....	22
1. SIGNIFICANCE OF THE TOPIC .....	23
2. THE APPROACH PURSUED IN THIS THESIS .....	25
CHAPTER 1 .....	26
1. BASIC TERMS AND PRINCIPLES .....	27
1.1 WHAT IS A PATENT? .....	27
1.1.1 The concepts of a patent – historical embedding .....	27
1.1.1.1 The common law perspective .....	27
1.1.1.2 The civil law perspective .....	29
1.1.1.2.1 France .....	29
1.1.1.2.2 Germany .....	30
1.1.2 Ways of justification for the existence of patents .....	30
1.1.2.1 The common law perspective .....	30
1.1.2.2 The civil law perspective .....	32
1.2 NATIONAL PATENTS, EUROPEAN PATENTS AND EUROPEAN PATENTS WITH UNITARY EFFECT .....	32
1.2.1 Status quo: National patents and European patents .....	32
1.2.2 To be established: European patents with unitary effect .....	33
1.3 PATENT CATEGORIES: PRODUCT PATENTS AND PROCESS PATENTS .....	34
1.3.1 The common law perspective .....	34
1.3.2 The civil law perspective .....	36
1.3.2.1 France .....	36
1.3.2.2 Germany .....	38
1.3.3 The European perspective .....	40
1.4 THE PRINCIPLE OF TERRITORIALITY .....	41
1.4.1 Different conceptions of the principle of territoriality .....	41
1.4.1.1 Private international law interpretation .....	42
1.4.1.2 Substantive law interpretation .....	42
1.4.1.3 Combined approach .....	42
1.4.2 Is the principle of territoriality relevant for international jurisdiction in cross-border patent infringement disputes? .....	42
1.4.2.1 Court decisions in the United Kingdom .....	43
1.4.2.1.1 The Moçambique rule .....	43
1.4.2.1.3 Jurisdiction of English courts where the Brussels Ibis Regulation (respectively its predecessors) applies (respectively apply) .....	47

1.4.2.2 Court decisions in France .....	49
1.4.2.3 Court decisions in Germany .....	50
1.4.2.4 Court decisions in the Netherlands.....	53
1.4.2.5 Conclusion.....	55
 CHAPTER 2.....	 57
2. INTERNATIONAL JURISDICTION WITH REGARD TO PATENT INFRINGEMENT PROCEEDINGS ACCORDING TO THE BRUSSELS IBS REGULATION .....	 58
2.1 JURISDICTION AT THE DOMICILE OF THE DEFENDANT – ARTICLE 4(1).....	59
2.2 JURISDICTION REGARDING TORTS – ARTICLE 7(2) .....	61
2.2.1 General remarks and introduction to Article 7(2) .....	61
2.2.2 Types of actions covered by Article 7(2) .....	63
2.2.2.1 Applicability of Article 7(2) to an action for a declaration of non-infringement .....	63
2.2.2.1.1 The legal situation before the Folien Fischer decision of the ECJ.....	64
2.2.2.1.1.1 Exemplary case-law of EU Member States.....	64
2.2.2.1.1.1.1 National case-law against the applicability of Article 7(2).....	64
2.2.2.1.1.1.1.1 Gerechtshof ‘s-Gravenhage, Decision from 22 January 1998, Evans Medical Ltd v Chiron Corporation – Evans Medical .....	64
2.2.2.1.1.1.1.2 Swedish Supreme Court (Högsta Domstolen), Decision from 14 June 2000, Case No. Ö 2095-99 – Flootek .....	66
2.2.2.1.1.1.1.3 Brussels Court of First Instance (Rechtbank van eerste aanleg te Brussel), Decision from 12 May 2000, Case No. 2000/857/A – Röhm Enzyme.....	67
2.2.2.1.1.1.1.4 Corte di Cassazione, Decision from 19 December 2003, Case No. 19550, B.L. Macchine automatiche s.p.a. v Windmöller & Hölscher KG .....	69
2.2.2.1.1.1.1.5 Oberlandesgericht München, Decision from 25 October 2001, Case No. 6 U 5508/00 – Leit- und Informationssystem II .....	71
2.2.2.1.1.1.1.6 Tribunal de Grande Instance de Paris, Decision from 5 November 2003 – Dijkstra Plastics .....	75
2.2.2.1.1.2 National case-law in favour of the applicability of Article 7(2) .	75
2.2.2.1.1.2.1 Swiss Supreme Court (Bundesgericht), Decision from 13 March 2007, Case No. 4C.318/2006 .....	75
2.2.2.1.1.2.2 Regional Court of Frankfurt (Landgericht Frankfurt), Decision from 25 March 2010, Case No. 2-03 O 580/08 .....	78
2.2.2.1.1.2 Legal doctrine.....	78
2.2.2.1.2 The reference for a preliminary ruling by the Bundesgerichtshof .....	92
2.2.2.1.3 The Opinion of Advocate General Jääskinen in the Folien Fischer case..	94
2.2.2.1.3.1 Literal interpretation.....	95
2.2.2.1.3.1.1 No action for liability in tort .....	95
2.2.2.1.3.1.2 Consequence of a literal interpretation: No connecting factor which would be essential for the applicability of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation).....	96
2.2.2.1.3.1.3 Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) merely favours the aggrieved party.....	97
2.2.2.1.3.2 Teleological interpretation .....	97
2.2.2.1.3.3 Schematic interpretation.....	98

2.2.2.1.3.4 Practical consequences of a broad interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation).....	99
2.2.2.1.4 The Folien Fischer decision of the ECJ .....	101
2.2.2.1.5 Comment .....	103
2.2.2.2 Applicability of Article 7(2) to a preventive action for an injunction.....	105
2.2.2.3 Inapplicability of Article 7(2) to competing contractual actions .....	108
2.2.3 The applicability of the principle of ubiquity to the constellation of patent infringement (determination of the place of the infringing event in terms of Article 7(2)) .....	109
2.2.3.1 Extraterritorial place of the event giving rise to the damage .....	110
2.2.3.1.1 Starting point: The principle of territoriality as a principle of substantive law .....	111
2.2.3.1.2 Is the principle of territoriality (although being a principle of substantive law) also relevant with regard to the determination of the place where the harmful event occurred according to Article 7(2)?.....	111
2.2.3.1.3 The determination of the place where the harmful event occurred according to Article 7(2) on the basis of ECJ case-law .....	113
2.2.3.1.3.1 Aspects which suggest that the ECJ advocates a conception according to which the place where the harmful event occurred according to Article 7(2) is completely independent from the place of the infringing act according to substantive law .....	113
2.2.3.1.3.2 Aspects which suggest that the ECJ advocates a conception according to which the place where the harmful event occurred according to Article 7(2) is indirectly linked with the place of the infringing act according to substantive law .....	114
2.2.3.1.3.3 Relevance of the Shevill decision of the ECJ for the question of whether an extraterritorial place of the event giving rise to the damage can exist .....	117
2.2.3.1.3.3.1 Arguments for and against the applicability of the Shevill decision to cases of cross-border patent infringement in order to determine the place of the event giving rise to the damage .....	117
2.2.3.1.3.3.2 Conclusion as to the applicability of Shevill and its further significance.....	119
2.2.3.1.3.4 Inapplicability of the principle of territoriality .....	120
2.2.3.1.3.5 Conclusion: Principle of territoriality is no obstacle for an extraterritorial place of the event giving rise to the damage .....	121
2.2.3.1.4 Constellations of extraterritorial places of the event giving rise to the damage .....	122
2.2.3.1.4.1 Relevant aspects .....	123
2.2.3.1.4.1.1 Filter 1: Accountability (“Zurechnungszusammenhang”) .....	123
2.2.3.1.4.1.2 Filter 2: Particularly close connection.....	124
2.2.3.1.4.1.2.1 Place of transit.....	124
2.2.3.1.4.1.2.2 Place of manufacture .....	125
2.2.3.1.4.1.2.2.1 Product patents .....	126
2.2.3.1.4.1.2.2.2 Process patents .....	126
2.2.3.1.4.1.2.3 Determination of the place of the event giving rise to the damage in case of the infringement of IP rights via the internet.....	127
2.2.3.1.4.2 Conclusion.....	129
2.2.3.1.5 No reciprocal attribution of the place of the event giving rise to the damage according to Article 7(2) in case of several perpetrators .....	130
2.2.3.2 Extraterritorial place where the damage occurred or may occur.....	132

2.2.3.2.1 Conception 1: Absence of any place where the damage occurred .....	132
2.2.3.2.2 (Prevailing) conception 2: Place where the damage occurred is the place where the patent right has been infringed (“Ort der Rechtsgutverletzung”).....	132
2.2.3.2.3 Conception 3: Potential existence of further places where the damage occurred besides the place where the patent right has been infringed .....	134
2.2.3.2.3.1 Place of domicile (seat) of the patent holder.....	134
2.2.3.2.3.2 Place of the impact on/saturation of the market (“Ort der Marktbeeinflussung”/“Ort der Marktsättigung”) .....	135
2.2.3.2.3.3 Place of the conflict of interests between the patent holder and the infringer (“Ort der Interessenkollision”) .....	138
2.2.3.2.3.4 Conclusion.....	139
2.2.4 Territorial scope of the authority to decide of a court pursuant to Article 7(2) ....	139
2.2.4.1 Conception 1: The invoked court only has authority to decide with regard to patents granted for the forum State .....	140
2.2.4.2 Conception 2: The court has authority to decide also with regard to patents granted for other States than the forum State .....	142
2.2.4.3 Effects of the so-called mosaic principle developed in the Shevill decision on the territorial scope of cognition of courts concerning cross-border patent infringement cases .....	142
2.2.4.3.1 Particularly close connection between the case (the infringement) and the forum .....	144
2.2.4.3.1.1 Place of the event giving rise to the damage .....	144
2.2.4.3.1.2 Place where the damage occurred .....	144
2.2.4.3.2 Avoidance of forum shopping .....	145
2.2.4.3.3 Conclusion.....	145
2.2.4.4 Consequences for the territorial scope of authority to decide .....	145
2.3 EXTENSION OF JURISDICTION AT THE PLACE OF DOMICILE OF ONE OF SEVERAL (ALLEGED) INFRINGERS DUE TO CLOSE CONNECTION OF THE CLAIMS – ARTICLE 8(1) .....	146
2.3.1 Analogous application of Article 8(1) vis-à-vis third State defendants? .....	147
2.3.2 Close connection .....	151
2.3.2.1 Multiple infringers infringing the same patent right .....	152
2.3.2.1.1 Constellation 1: Infringers acting independently from each other .....	152
2.3.2.1.2 Constellation 2: Infringers acting jointly .....	153
2.3.2.1.3 Constellation 3: Chain of infringers .....	154
2.3.2.2 Multiple infringers infringing parallel patent rights.....	155
2.3.2.2.1 Constellation 4: Infringers acting independently from each other by different acts and different modes of use .....	156
2.3.2.2.2 Constellation 5: Infringers acting independently from each other by different acts, while the same product is concerned.....	156
2.3.2.2.3 Constellation 6: Infringers acting by identical modes of use, while different patents are concerned.....	157
2.3.3 The Roche Nederland case of the ECJ .....	161
2.3.3.1 The Roche Nederland decision of the ECJ.....	161
2.3.3.2 Consequences of the Roche Nederland decision of the ECJ and the (attenuating) effect/impact of the Solvay decision of the ECJ .....	164
2.3.3.2.1 Joint acting .....	167
2.3.3.2.2 Chain of infringers .....	168
2.3.3.2.3 Chain of infringers in the case of a European patent with unitary effect .....	168
2.4 EXCLUSIVE JURISDICTION – ARTICLE 24(4).....	170
2.4.1 Introductory considerations.....	170



2.4.2 Infringement and nullity (invalidity) of patent rights in infringement proceedings .....	174
2.4.2.1 Interpretation of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation before the GAT decision .....	176
2.4.2.1.1 United Kingdom .....	176
2.4.2.1.1.1 Court decisions .....	176
2.4.2.1.1.1.1 Coin Controls .....	176
2.4.2.1.1.1.2 Fort Dodge .....	178
2.4.2.1.1.1.3 Sepracor .....	179
2.4.2.1.1.2 Legal doctrine .....	180
2.4.2.1.2 The Netherlands .....	180
2.4.2.1.2.1 Court decisions .....	180
2.4.2.1.2.1.1 Expandable Grafts Partnership I .....	181
2.4.2.1.2.1.2 Expandable Grafts Partnership II .....	184
2.4.2.1.2.2 Legal doctrine .....	184
2.4.2.1.3 Germany .....	185
2.4.2.1.3.1 Court decisions .....	185
2.4.2.1.3.1.1 Kettenbandförderer III .....	185
2.4.2.1.3.1.2 Reinigungsmittel für Kunststoffverarbeitungsmaschinen .....	186
2.4.2.1.3.1.3 Schwungrad .....	186
2.4.2.1.3.2 Legal doctrine .....	188
2.4.2.2 Interpretation after the GAT decision .....	189
2.4.2.3 The scope of the GAT decision .....	189
2.4.2.3.1 Potential infringer having his habitual residence outside the European Union .....	189
2.4.2.3.2 Infringement of a European patent .....	190
2.4.2.3.3 Infringement of a patent granted by a third State, or by the EPO for such a State .....	192
2.4.2.3.3.1 Conception 1: Exhaustive regime of the Brussels Ibis Regulation ..	193
2.4.2.3.3.2 Conception 2: Regulatory sovereignty of national law .....	198
2.4.2.3.3.3 Conception 3: Reflexive application of Article 24(4) .....	199
2.4.2.3.3.3.1 Indirect reflexive application of Article 24(4) .....	199
2.4.2.3.3.3.2 Direct reflexive application of Article 24(4) .....	202
2.4.2.4 Requirements as to the defence of invalidity .....	214
2.4.2.4.1 Must the defence of invalidity of the patent be admissible? .....	214
2.4.2.4.1.1 Nature of the aspect of admissibility of the defence of invalidity of the patent .....	214
2.4.2.4.1.1.1 Admissibility of the defence of invalidity: procedural law .....	214
2.4.2.4.1.1.2 Admissibility of the defence of invalidity: substantive law .....	215
2.4.2.4.1.2 Scope of Article 24(4) .....	215
2.4.2.4.2 Must the defence of invalidity of the patent be sufficiently substantiated? .....	217
2.4.2.4.3 Are there temporal restrictions as to the raise of a defence of invalidity? .....	220
2.4.2.4.4 Is the defence of invalidity of the patent excluded if the defendant acts in bad faith? .....	223
2.4.2.4.5 Is the invalidity defence excluded if it is obviously unfounded? .....	226
2.4.2.4.5.1 Missing substantive entitlement .....	226
2.4.2.4.5.2 Legally binding decision on the validity of the patent in the State where it has been granted .....	228
2.4.2.5 Consequences of the defence of invalidity .....	230

2.4.2.5.1 Complete transfer of the case by the infringement court to a court having jurisdiction according to Article 24(4) .....	231
2.4.2.5.2 Decision by the infringement court assuming that the concerned patent is existent and valid.....	238
2.4.2.5.3 Stay of the infringement proceedings until the court of another Member State with jurisdiction under Article 24(4) has ruled upon the validity of the patent .....	242
2.4.2.5.3.1 On which legal basis can a stay of infringement proceedings be founded? .....	243
2.4.2.5.3.1.1 Article 29 .....	243
2.4.2.5.3.1.2 Article 30 .....	245
2.4.2.5.3.1.3 Article 31(1) .....	246
2.4.2.5.3.1.4 Analogous application of Article 30 (as the provision of Section 9 of the Brussels Ibis Regulation that relatively fits best).....	246
2.4.2.5.3.1.5 Provisions of national (procedural) law .....	248
2.4.2.5.3.2 Is there a time limit for the initiation of counter-proceedings (invalidity/nullity proceedings respectively revocation proceedings or opposition proceedings (European patent))? .....	252
2.4.2.5.3.3 Must the defendant institute counter-proceedings in persona? .....	253
2.4.2.5.3.3.1 The insight of Roche Nederland.....	253
2.4.2.5.3.3.2 Constellations beyond Roche Nederland .....	253
2.4.2.5.3.3.2.1 Constellation 1: Joint infringement proceedings against several defendants; only one defendant institutes counter-proceedings ....	253
2.4.2.5.3.3.2.2 Constellation 2: Independent infringement proceedings against several defendants; only one defendant institutes counter-proceedings.....	255
2.4.2.5.3.4 Must the infringement court stay proceedings when a nullity/invalidity defence has been raised? .....	255
2.4.2.5.3.4.1 General considerations .....	255
2.4.2.5.3.4.2 Are the parties' interests to be taken into account?.....	256
2.4.2.5.3.4.2.1 The claimant's interests.....	256
2.4.2.5.3.4.2.2 The defendant's interests.....	258
2.4.2.5.3.4.2.2.1 Vis-à-vis the claimant's request for a transfer in toto .	258
2.4.2.5.3.4.2.2.2 Defendant's personal interest in a transfer in toto.....	259
2.4.2.5.3.4.2.3 Conclusion.....	261
2.5 CROSS-BORDER INTERIM RELIEF .....	261
2.5.1 Importance of interim relief with regard to intellectual property infringement....	261
2.5.2 Interim relief within the scope of application of the Brussels Ibis Regulation .....	263
2.5.2.1 Provisional proceedings before a court having jurisdiction according to Articles 4 or 7 to 26 (jurisdiction as to the substance/jurisdiction on the merits) and therefore having accessory jurisdiction for provisional measures .....	265
2.5.2.1.1 Jurisdiction .....	265
2.5.2.1.1.1 Conception 1: Requirement of factual jurisdiction on the merits ....	266
2.5.2.1.1.2 Conception 2: Sufficiency of "fictitious/potential" jurisdiction on the merits .....	267
2.5.2.1.1.3 Conclusion.....	269
2.5.2.1.2 Requirements of cross-border legal protection by way of interim relief	269
2.5.2.1.2.1 Grant of the right to a hearing .....	270
2.5.2.1.2.2 Refusal of recognition and enforcement of provisional measures in case of irreconcilability with decisions in the State of enforcement.....	272

2.5.2.2 Provisional proceedings before a court having jurisdiction according to Article 35 .....	276
2.5.2.2.1 Character and effect of Article 35 .....	276
2.5.2.2.1.1 Conception 1: Article 35 does not per se confer jurisdiction, but merely refers to national laws .....	276
2.5.2.2.1.2 Conception 2: Article 35 is an autonomous head of jurisdiction .....	277
2.5.2.2.1.3 Conclusion .....	278
2.5.2.2.2 Personal and territorial scope of application of Article 35 .....	279
2.5.2.2.2.1 Conception 1: Applicability of Article 35 vis-à-vis defendants domiciled in non-Member States .....	279
2.5.2.2.2.2 Conception 2: Applicability of Article 35 merely vis-à-vis defendants domiciled in Member States .....	280
2.5.2.2.2.3 Conclusion .....	283
2.5.2.2.3 Specific requirements of Article 35 .....	284
2.5.2.2.3.1 Which provisional measures fall under the scope of application of Article 35? .....	285
2.5.2.2.3.2 The prerequisite of a “real connecting link” .....	289
2.5.2.2.3.2.1 Reference objects of the “real connecting link” .....	290
2.5.2.2.3.2.1.1 Conception 1: Relevance of the “Belegenheitsanknüpfung”/“Wirkungsort” .....	290
2.5.2.2.3.2.1.2 Conception 2: Relevance of the “Vollstreckungsort” .....	291
2.5.2.2.3.2.1.3 Conception 3: “Real connecting link” between the provisional measure and the applicable law .....	292
2.5.2.2.3.2.1.4 Conclusion .....	293
2.5.2.2.3.2.2 Specific meaning of the term “real connecting link” regarding different types of provisional measures .....	296
2.5.2.2.3.2.2.1 Interim injunctions .....	296
2.5.2.2.3.2.2.2 Interim performance orders .....	297
2.5.2.2.3.2.2.3 Evidence orders .....	298
2.5.2.2.3.2.3 Are cross-border interim measures generally excluded in case of legal or factual complexity of cases? .....	298
2.5.2.2.3.2.4 Scope of jurisdiction in the case of multistate patent infringements .....	299
2.5.2.2.3.2.5 Recognition and enforcement of measures according to Article 35 .....	301
2.5.2.3 Raise of the invalidity defence in provisional proceedings .....	302
2.5.2.3.1 Raise of the invalidity defence in provisional proceedings before a court having jurisdiction according to Articles 4 or 7 to 26 (accessory jurisdiction) .....	302
2.5.2.3.1.1 Overview .....	302
2.5.2.3.1.2 Conception 1: Applicability of Article 24(4) .....	303
2.5.2.3.1.3 Conception 2: Inapplicability of Article 24(4) .....	304
2.5.2.3.1.4 Conclusion .....	309
2.5.2.3.2 Raise of the invalidity defence in provisional proceedings before a court having jurisdiction according to Article 35 .....	310
2.5.2.3.2.1 Overview .....	310
2.5.2.3.2.2 Conception 1: Applicability of Article 24(4) .....	310
2.5.2.3.2.3 Conception 2: Temporary validity of provisional measures rendered by the infringement court .....	311
2.5.2.3.2.4 Conception 3: Inapplicability of Article 24(4) .....	311
2.5.2.3.2.5 Conclusion .....	315

CHAPTER 3.....	316
3. REFORM OF INTERNATIONAL JURISDICTION WITH REGARD TO PATENT INFRINGEMENT ACTIONS.....	317
3.1 EXISTING REFORM PROJECTS .....	317
3.1.1 The Hague Judgments Convention and the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) .....	317
3.1.2 ALI Principles .....	318
3.1.3 CLIP Principles .....	319
3.2 SHOULD, WITH REGARD TO PATENT INFRINGEMENT CASES, GENERAL RULES OF JURISDICTION BE APPLICABLE, OR SHOULD THE COURTS OF THE PROTECTION STATE HAVE EXCLUSIVE JURISDICTION ALSO IN PATENT INFRINGEMENT DISPUTES? .....	319
3.2.1 Introduction .....	319
3.2.2 Which specific interests relevant in the field of patent law are conceivable which would require to confer exclusive jurisdiction in patent infringement disputes to courts in the protection State? .....	321
3.2.2.1 “Gleichlauf” between jurisdiction and the applicable substantive patent law .....	321
3.2.2.2 Sovereignty of the granting State .....	325
3.2.2.3 Interest of the courts of the granting State to have exclusive jurisdiction to decide in patent infringement disputes .....	329
3.2.2.4 Party interests .....	329
3.2.2.4.1 The plaintiff's perspective .....	329
3.2.2.4.2 The defendant's perspective .....	330
3.2.2.4.3 Special case: Multistate delicts .....	331
3.2.2.5 Judicial economy .....	331
3.2.2.6 Indirect (mediate) solution of the torpedo problem.....	333
3.2.2.7 Further considerations .....	334
3.2.3 Conclusion.....	338
3.3. APPLICATION AND CONSTRUCTION OF RULES OF JURISDICTION AS TO CROSS-BORDER PATENT INFRINGEMENT DISPUTES .....	339
3.3.1 Jurisdiction regarding torts .....	339
3.3.1.1 Extraterritorial jurisdiction according to Article 7(2) of the Brussels Ibis Regulation .....	339
3.3.1.2 Existing reform proposals .....	340
3.3.1.2.1 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) .....	340
3.3.1.2.2 ALI Principles .....	342
3.3.1.2.3 Principles on Conflict of Laws in Intellectual Property (CLIP Principles) .....	343
3.3.1.2.4 The Heidelberg Report on the Application of Regulation Brussels I .....	345
3.3.1.2.5 The Commission Proposal 2010 for Reform of the Brussels I Regulation .....	346
3.3.1.3 Clarification through an amendment of Article 7(2).....	348
3.3.1.4 Extraterritorial jurisdiction according to a future Global Judgments Convention .....	349
3.3.1.5 Particular problem: Tortious jurisdiction regarding multistate delicts.....	350
3.3.1.5.1 Localisation of the places where the harmful event occurred .....	350
3.3.1.5.2 Territorial scope of the authority to decide .....	352
3.3.1.6 Final comment and formulation proposal .....	360
3.3.2 Extension of jurisdiction at the place of domicile of one of several (alleged) infringers due to close connection of the claims .....	361

3.3.2.1 Identifying the crucial issue .....	361
3.3.2.2 Existing reform proposals .....	362
3.3.2.2.1 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) .....	362
3.3.2.2.2 ALI Principles .....	362
3.3.2.2.3 Principles on Conflict of Laws in Intellectual Property (CLIP Principles) .....	365
3.3.2.2.3.1 Avoidance of the risk of incompatible judgments .....	366
3.3.2.2.3.2 The same factual situation .....	367
3.3.2.2.3.2.1 Corporate groups .....	368
3.3.2.2.3.2.2 Joint infringement .....	369
3.3.2.2.3.2.3 Chain of infringers .....	370
3.3.2.2.3.2.4 Unconcerted parallel infringements .....	371
3.3.2.2.3.2.5 Further constellations of “essentially the same situation of fact” .....	372
3.3.2.2.3.3 The same legal situation .....	373
3.3.2.2.3.3.1 Divergence of applicable laws .....	373
3.3.2.2.3.3.2 Divergence of legal bases of actions .....	376
3.3.2.2.3.4 The competent court according to Article 2:206(3) of the CLIP Principles .....	377
3.3.2.2.3.4.1 First restriction: Predominant role of one of the co-defendants .....	378
3.3.2.2.3.4.2 Second restriction: No consolidation of actions in certain constellations where a connection is deemed not to be strong enough .....	378
3.3.2.2.4 The Heidelberg Report on the Application of Regulation Brussels I .....	382
3.3.2.2.5 The Commission Proposal 2010 for Reform of the Brussels I Regulation .....	386
3.3.2.3 Further considerations .....	387
3.3.2.3.1 Consolidation of proceedings in the case of infringement of national patents .....	387
3.3.2.3.2 Restricting the places of jurisdiction where actions may be consolidated .....	387
3.3.2.3.3 The concept of “abuse of jurisdiction” .....	389
3.3.2.3.4 “Concerted parallel infringements” .....	393
3.3.2.4 Final comment and formulation proposal .....	395
3.3.3 Exclusive jurisdiction .....	396
3.3.3.1 Identifying the crucial issues .....	396
3.3.3.1.1 Reflexive application of Article 24(4) of the Brussels Ibis Regulation ..	396
3.3.3.1.2 Effect on jurisdiction of an invalidity defence raised before an extraterritorial infringement court .....	396
3.3.3.1.2.1 Admissibility of an incidental decision, rendered by the extraterritorial infringement court, on the validity of a patent once an invalidity defence has been raised .....	397
3.3.3.1.2.2 Definition of the term “preliminary question” .....	400
3.3.3.1.2.3 Which effect (if any) should an incidental decision have? .....	400
3.3.3.1.2.3.1 Conception 1: Incidental decisions with erga omnes effect .....	400
3.3.3.1.2.3.2 Conception 2: Absence of res iudicata of incidental decisions ..	401
3.3.3.1.2.3.3 Conception 3: Incidental decisions with inter partes effect .....	401
3.3.3.1.2.3.4 Conception 4: No definition of the effect of incidental decisions .....	404
3.3.3.1.2.3.5 Conclusion .....	405

3.3.3.1.2.4 Stay of infringement proceedings as an alternative to an incidental decision? .....	405
3.3.3.1.2.5 Additional rules as to related proceedings .....	407
3.3.3.1.2.6 Stay of infringement proceedings in case of a later brought invalidity action .....	407
3.3.3.1.2.7 Providing additional rules (besides the rules on the stay of infringement proceedings) with regard to the cooperation between the (extraterritorial) infringement court and the invalidity court .....	407
3.3.3.1.2.8 Exclusion of recognition and enforcement of an incidental validity decision rendered by the infringement court if the patent has already been declared void by the courts of the granting State .....	407
3.3.3.1.2.9 Contradiction between the incidental decision on the validity of a patent rendered by the extraterritorial infringement court (with inter partes effect), and a later decision on the validity of this patent produced by a court in the granting State (with erga omnes effect) .....	408
3.3.3.1.2.10 Conclusion: How should exclusive jurisdiction as to the issue of validity of a patent be constructed? .....	410
3.3.3.2 Existing reform proposals .....	410
3.3.3.2.1 Hague Convention on Choice of Court Agreements (2005) .....	410
3.3.3.2.2 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) .....	411
3.3.3.2.3 ALI Principles .....	413
3.3.3.2.3.1 General orientation – Solution via subject-matter jurisdiction instead of possibility of incidental decisions .....	413
3.3.3.2.3.2 Additional rules as to related proceedings .....	416
3.3.3.2.3.3 The ALI Principles' response to the stated need for a provision about the possibility of staying infringement proceedings in case of a later brought invalidity action .....	418
3.3.3.2.3.4 The ALI Principles' response to the stated need for additional rules (besides the rules on the stay of infringement proceedings) with regard to the cooperation between the (extraterritorial) infringement court and the invalidity court .....	418
3.3.3.2.4 Principles on Conflict of Laws in Intellectual Property (CLIP Principles) .....	420
3.3.3.2.4.1 Admissibility and definition of the circumstances of an incidental decision, rendered by the extraterritorial infringement court, on the validity of a patent once an invalidity defence has been raised .....	420
3.3.3.2.4.2 Definition of the effect of an incidental decision .....	421
3.3.3.2.4.3 Stay of infringement proceedings as an alternative to an incidental decision? .....	422
3.3.3.2.4.4 Additional rules as to related proceedings .....	423
3.3.3.2.4.5 Stay of infringement proceedings in case of a later brought invalidity action .....	428
3.3.3.2.4.6 The CLIP Principles' response to the stated need for additional rules (besides the rules on the stay of infringement proceedings) with regard to the cooperation between the (extraterritorial) infringement court and the invalidity court .....	431
3.3.3.2.4.7 Exclusion of recognition and enforcement of an incidental validity decision rendered by the infringement court if the patent has already been declared void by the courts of the granting State .....	433

3.3.3.2.4.8 Contradiction between the incidental decision on the validity of a patent rendered by the extraterritorial infringement court (inter partes effect), and a subsequent decision on the validity of this patent produced by a court in the granting State (erga omnes effect).....	434
3.3.3.2.5 The Heidelberg Report on the Application of Regulation Brussels I .....	434
3.3.3.2.6 The Commission Proposal 2010 for Reform of the Brussels I Regulation .....	434
3.3.3.3 Final comment and formulation proposal .....	436
3.3.4 Cross-border interim relief .....	437
3.3.4.1 Identifying the crucial issues .....	437
3.3.4.1.1 Should the courts of the granting State have exclusive jurisdiction regarding provisional measures? .....	437
3.3.4.1.2 Explicit codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures.....	438
3.3.4.1.3 Clarification of the requirements regarding accessory jurisdiction.....	438
3.3.4.1.4 Definition of the real connecting link-criterion.....	439
3.3.4.1.5 Definition of provisional, including protective, measures .....	439
3.3.4.1.6 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State.....	440
3.3.4.1.7 Creation of clear rules regarding the coordination of several, including preliminary, proceedings .....	440
3.3.4.1.8 Refusal of recognition of provisional measures when irreconcilable with other judgments .....	440
3.3.4.1.9 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures .....	441
3.3.4.1.10 Creation of a clarifying provision of whether Article 24(4) of the Brussels Ibis Regulation is applicable where an invalidity defence is raised in provisional proceedings? .....	443
3.3.4.2 Existing reform proposals .....	444
3.3.4.2.1 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) .....	444
3.3.4.2.1.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures.....	446
3.3.4.2.1.2 The Draft Hague Convention's response to the stated need for a clarification of the requirements regarding accessory jurisdiction for provisional measures .....	446
3.3.4.2.1.3 Limitation of independent jurisdiction for provisional measures ....	446
3.3.4.2.1.4 Definition of provisional, including protective, measures .....	447
3.3.4.2.1.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another State .....	448
3.3.4.2.1.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings .....	450
3.3.4.2.1.7 The Draft Hague Convention's approach of refusal of recognition of provisional measures when irreconcilable with other judgments .....	450
3.3.4.2.1.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures.....	452
3.3.4.2.1.9 The Draft Hague Convention's indirect contribution to the creation of a clarifying provision of the effect of an invalidity defence being raised in provisional proceedings (applicability of Article 24(4) of the Brussels Ibis Regulation) .....	452
3.3.4.2.2 ALI Principles .....	452

3.3.4.2.2.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures.....	453
3.3.4.2.2.2 The ALI Principles' response to the stated need for a clarification of the requirements regarding accessory jurisdiction for provisional measures.....	453
3.3.4.2.2.3 Limitation of independent jurisdiction for provisional measures ....	453
3.3.4.2.2.4 Definition of provisional, including protective, measures .....	454
3.3.4.2.2.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another State .....	454
3.3.4.2.2.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings .....	455
3.3.4.2.2.7 The ALI Principles' approach of refusal of recognition of provisional measures when irreconcilable with other judgments .....	455
3.3.4.2.2.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures.....	456
3.3.4.2.2.9 The ALI Principles' indirect contribution to the creation of a clarifying provision on the effect of an invalidity defence being raised in provisional proceedings (applicability of Article 24(4) of the Brussels Ibis Regulation).....	456
3.3.4.2.3 Principles on Conflict of Laws in Intellectual Property (CLIP Principles) .....	457
3.3.4.2.3.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures.....	458
3.3.4.2.3.2 Clarification of the requirements regarding accessory jurisdiction for provisional measures (Article 2:501(1) of the CLIP Principles).....	459
3.3.4.2.3.3 Definition of the real connecting link-criterion with regard to independent jurisdiction for interim relief (Article 2:501(2) of the CLIP Principles).....	460
3.3.4.2.3.3.1 Jurisdiction of the courts of a State where the measure is to be enforced .....	461
3.3.4.2.3.3.2 Jurisdiction of the courts of a State for which protection is sought .....	462
3.3.4.2.3.3.3 Conclusion regarding the twofold approach of Article 2:501(2) of the CLIP Principles .....	464
3.3.4.2.3.4 Definition of provisional, including protective, measures .....	464
3.3.4.2.3.4.1 General definition and non-exhaustive list of examples .....	465
3.3.4.2.3.4.2 The measures mentioned in Article 2:501(3)2 of the CLIP Principles .....	465
3.3.4.2.3.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State.....	467
3.3.4.2.3.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings in order to mitigate the danger of irreconcilable decisions .....	468
3.3.4.2.3.6.1 Proceedings on the substance and preliminary proceedings .....	468
3.3.4.2.3.6.2 Several preliminary proceedings .....	469
3.3.4.2.3.7 The CLIP Principles' approach of refusal of recognition of provisional measures when irreconcilable with other judgments .....	469
3.3.4.2.3.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures.....	470
3.3.4.2.3.9 The CLIP Principles' indirect contribution to the creation of a clarifying provision of the effect of an invalidity defence in provisional proceedings (applicability of Article 24(4) of the Brussels Ibis Regulation).....	471
3.3.4.2.4 The Heidelberg Report on the Application of Regulation Brussels I .....	472



3.3.4.2.4.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures.....	472
3.3.4.2.4.2 Clarification of the requirements regarding accessory jurisdiction..	473
3.3.4.2.4.3 Definition of the real connecting link-criterion.....	473
3.3.4.2.4.4 Definition of provisional, including protective, measures .....	473
3.3.4.2.4.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State.....	473
3.3.4.2.4.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings in order to mitigate the danger of irreconcilable decisions .....	473
3.3.4.2.4.7 The Heidelberg Proposal's missing approach of refusal of recognition of provisional measures when irreconcilable with other judgments .....	474
3.3.4.2.4.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures.....	474
3.3.4.2.4.9 Creation of a clarifying provision of whether Article 24(4) of the Brussels Ibis Regulation is applicable where an invalidity defence is raised in provisional proceedings.....	475
3.3.4.2.5 The Commission Proposal 2010 for Reform of the Brussels I Regulation .....	475
3.3.4.2.5.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures.....	475
3.3.4.2.5.2 Clarification of the requirements regarding accessory jurisdiction..	476
3.3.4.2.5.3 Definition of the real connecting link-criterion.....	477
3.3.4.2.5.4 Definition of provisional, including protective, measures .....	477
3.3.4.2.5.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State.....	479
3.3.4.2.5.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings .....	482
3.3.4.2.5.7 The approach of the Commission Proposal 2010 of refusal of enforcement of provisional measures when irreconcilable with other judgments .....	483
3.3.4.2.5.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures.....	486
3.3.4.2.5.9 Creation of a clarifying provision of whether Article 24(4) of the Brussels Ibis Regulation is applicable where an invalidity defence is raised in provisional proceedings.....	489
3.3.4.3 Final comment and formulation proposal .....	489
CHAPTER 4.....	492
4. THE CREATION OF A EUROPEAN PATENT WITH UNITARY EFFECT AND A UNIFIED PATENT COURT AS AN ALTERNATIVE IN ORDER TO AVOID EXISTING JURISDICTIONAL PROBLEMS?.....	493
4.1 INTRODUCTION .....	493
4.2 THE LONG MARCH TOWARDS A UNIFORM PATENT IN EUROPE AND AN ADEQUATE LITIGATION SYSTEM.....	494
4.3 EUROPEAN PATENT WITH UNITARY EFFECT .....	498
4.3.1 Which are the basic features of such a patent?.....	498
4.3.2 Evaluation of the unitary patent .....	499
4.3.2.1 Unification of patent protection in the European Union? .....	499

4.3.2.2 Facilitation of patent protection?	502
4.3.2.3 Reduction of costs?	503
4.3.2.4 Compliance with EU law?	505
4.3.2.4.1 Article 118 TFEU versus Article 114 TFEU	505
4.3.2.4.1.1 Article 114 TFEU	506
4.3.2.4.1.2 Article 118 TFEU	507
4.3.2.4.2 Conclusion	509
4.4 UNIFIED PATENT COURT (UPC)	509
4.4.1 Which are the basic features of the UPC?	510
4.4.2 Evaluation of the UPC	512
4.4.2.1 Creation of legal certainty?	512
4.4.2.2 Effectiveness of the UPC?	515
4.4.2.3 Reduction of costs?	517
4.4.2.4 Compliance with EU law?	519
4.4.2.4.1 Compliance with primary EU law	519
4.4.2.4.2 Compliance with the Brussels Ibis Regulation	519
4.4.2.4.2.1 Treatment of the UPC as a court of a Member State	521
4.4.2.4.2.2 Operation of the jurisdiction rules applicable in relation to the UPC concerning Member State defendants	525
4.4.2.4.2.3 Creation of uniform jurisdiction rules vis-à-vis third State defendants	529
4.4.2.4.2.3.1 Article 71b(2) 1 <sup>st</sup> sentence of Regulation 542/2014	531
4.4.2.4.2.3.2 Article 71b(2) 2 <sup>nd</sup> sentence of Regulation 542/2014	532
4.4.2.4.2.3.3 Article 71b(3) 1 <sup>st</sup> sentence of Regulation 542/2014	533
4.4.2.4.2.3.4 Article 71b(3) 2 <sup>nd</sup> sentence of Regulation 542/2014	535
4.4.2.4.2.3.5 Creation of additional fragmentation due to jurisdiction of the UPC with regard to patent disputes concerning States not participating in the UPC Agreement	538
4.4.2.4.2.4 Application of the rules on lis pendens and related actions in relation to the UPC and the national courts of Member States which are not Contracting Parties to the UPC Agreement (Article 71c(1) of Regulation 542/2014)	539
4.4.2.4.2.5 Application of the rules on lis pendens and related actions in relation to the UPC and the national courts of Member States which are Contracting Parties to the UPC Agreement, during the transitional period (Article 71c(2) of Regulation 542/2014)	541
4.4.2.4.2.6 Operation of the rules on recognition and enforcement in relation between Member States which have ratified the UPC Agreement and the Member States that have not ratified the UPC Agreement	542
4.4.2.4.2.7 Conclusion	544
4.4.2.5 The UPC's democratic deficit	545
4.5 FINAL CONSIDERATIONS	545
CONCLUSION	546
SUMMARY	567
SAMENVATTING	571
TABLE OF CASES	576

BIBLIOGRAPHY .....	591
FURTHER MATERIAL .....	631
CURRICULUM VITAE .....	632

## TABLE OF ABBREVIATIONS

A.C.	Appeal Cases
AfP	Zeitschrift für Medien- und Kommunikationsrecht
AG	Advocate General
Alb. L.J. Sci. & Tech.	Albany Law Journal of Science and Technology
ALI	American Law Institute
All ER	All England Law Reports
All ER Rep	All England Law Reports Reprint
Art.	Article
Arts.	Articles
BC	Benelux Court of Justice
Bd.	Band (Volume)
BGer	Bundesgericht (Swiss Supreme Court)
BGH	Bundesgerichtshof (Federal Court of Justice, Germany)
BIE	Bijblad bij de Industriële Eigendom
BPatG	Bundespatentgericht
BPatGE	Entscheidungen des Bundespatentgerichts
CAFC	United States Court of Appeal for the Federal Circuit
CLIP	European Max Planck Group on Conflict of Laws in Intellectual Property
C.L.J.	Cambridge Law Journal
C.M.L. Rev.	Common Market Law Review
Co Rep	Coke's Report
ECHR	European Court of Human Rights
EC	European Community
E.C.L. Review	European Constitutional Law Review

ed(s)	editor(s)
edn	edition
Einl	Einleitung (Introduction)
E.I.P.R.	European Intellectual Property Review
E.L. Rev.	European Law Review
E.N.P.R.	European National Patent Reports
EPC	European Patent Convention
EPLA	European Patent Litigation Agreement
EPLAW	European Patent Lawyers Association
EPLP	European Patent Litigation Protocol
EPO	European Patent Office
EU	European Union
EuGVO / EuGVVO	Europäische Gerichtsstands- und Vollstreckungsverordnung (Brussels I Regulation)
EuGVÜ	Europäisches Gerichtsstands- und Vollstreckungsübereinkommen
EU	European Union
EuLF	The European Legal Forum
EuR	Europarecht
EuZW	Europäische Zeitschrift für Wirtschaftsrecht
EWCA Civ	Court of Appeal of England and Wales Civil Division
EWHC (Ch)	High Court of England and Wales (Chancery Division)
EWHC (Pat)	High Court of England and Wales (Patents Court)
EWiR	Entscheidungen zum Wirtschaftsrecht
fn.	footnote
Fordham Intell. Prop. Media & Ent. L.J.	Fordham Intellectual Property, Media and Entertainment Law Journal

F.S.R.	Fleet Street Reports
Godbolt	Godbolt's Reports
GPR	Zeitschrift für das Privatrecht der Europäischen Union
GRUR	Gewerblicher Rechtsschutz und Urheberrecht
GRUR Int.	Gewerblicher Rechtsschutz und Urheberrecht – Internationaler Teil
GRUR-RR	Gewerblicher Rechtsschutz und Urheberrecht Rechtsprechungs-Report
HR	Hoge Raad (Dutch Supreme Court)
I.C.L.Q.	International & Comparative Law Quarterly
IER	Intellectuele Eigendom & Reclamerecht
IIC	International Review of Intellectual Property and Competition Law
IJPL	International Journal of Procedural Law
ILA	International Law Association
InstGE	Entscheidungen der Instanzgerichte zum Recht des geistigen Eigentums
IP	Intellectual Property
IPJ (= ZGE)	Intellectual Property Journal (= Zeitschrift für geistiges Eigentum)
I.P.Q.	Intellectual Property Quarterly
<i>IPRax</i>	<i>Praxis des Internationalen Privat- und Verfahrensrechts</i>
IPRspr.	Die deutsche Rechtsprechung auf dem Gebiete des Internationalen Privatrechts
J.D.I.	Journal du Droit International
JIPITEC	Journal of Intellectual Property, Information Technology and E-Commerce Law
J.I.P.L.P.	Journal of Intellectual Property Law & Practice
JW	Juristische Wochenschrift

JZ	JuristenZeitung
Law & Pol’y Int’l Bus.	Law and Policy in International Business
LG	Landgericht
LG Düsseldorf Entscheidungen	Landgericht Düsseldorf, Entscheidungen der 4. Zivilkammer
L.M.C.L.Q.	Lloyd’s Maritime and Commercial Law Quarterly
LMK	Lindenmaier-Möhring – Kommentierte BGH-Rechtsprechung
L.R.Q.B.	Law Reports – Queen's Bench
Mitt.	Mitteilungen der Deutschen Patentanwälte
MMR	MultiMedia und Recht
n.	note
N.I.L.R.	Netherlands International Law Review
NIPR	Nederlands Internationaal Privaatrecht
NIR	Nordiskt Immateriellt Rättsskydd
NJ	Nederlandse Jurisprudentie
NJF	Nederlandse Jurisprudentie Feitenrechtspraak civiele uitspraken
NJkort	Nederlandse Jurisprudentie kort
NJW	Neue Juristische Wochenschrift
no.	number
nos.	numbers
OGH	Oberster Gerichtshof (Austrian Supreme Court)
OJ	Official Journal of the European Communities
OLG	Oberlandesgericht
p.	page
para.	paragraph
paras.	paragraphs

RabelsZ	Rabels Zeitschrift für ausländisches und internationales Privatrecht – The Rabel Journal of Comparative and International Private Law
Rb	Rechtbank
Rev. crit. DIP	Révue critique de droit international privé
RG	Reichsgericht
RIW	Recht der Internationalen Wirtschaft
R.P.C.	Reports of Patent Cases
RvdW	Rechtspraak van de Week
s.	section
ss.	sections
S.L.T.	Scots Law Times
SME	small and medium-sized enterprises
TEC	Treaty establishing the European Community
Tex. Intell. Prop. L.J.	Texas Intellectual Property Law Journal
TEU	Treaty on European Union
TFEU	Treaty on the Functioning of the European Union
TGI	Tribunal de grande instance
TRIPS Agreement	Agreement on Trade-Related Aspects of Intellectual Property Rights
U. Ill. L. Rev.	University of Illinois Law Review
UK	United Kingdom
UPC	Unified Patent Court
US / U.S.	United States
VLR	Victorian Law Reports
Vorbem	Vorbemerkung (= preliminary remark)
WIPR	World Intellectual Property Report



W.P.C.	Webster's Patent Cases
WRP	Wettbewerb in Recht und Praxis
WTO	World Trade Organization
ZEuP	Zeitschrift für Europäisches Privatrecht
ZGE (= IPJ)	Zeitschrift für geistiges Eigentum (= Intellectual Property Journal)
ZIP	Zeitschrift für Wirtschaftsrecht
ZPO	Zivilprozessordnung (Code of Civil Procedure)
ZUM	Zeitschrift für Urheber- und Medienrecht
ZVglRWiss	Zeitschrift für Vergleichende Rechtswissenschaft
ZZP	Zeitschrift für Zivilprozess
ZZPInt	Zeitschrift für Zivilprozess International

## INTRODUCTION

## 1. Significance of the topic

As a matter of fact, intellectual property (“IP”) rights constitute for many companies and individuals the core assets they own, and on which they ground their business activity. As a consequence, protection of IP rights is for such entities a decisive issue, which also means that litigation is crucial, even if it involves costs and uncertainties.<sup>1</sup> Besides, the more globalisation proceeds, the more companies being involved in cross-border business activities apply for patents in, respectively for multiple States. Due to the principle of territoriality (which shall be subject to a deepened analysis at a later point) patents are however only valid in the State(s) in, respectively for which they have been granted, even if such patents may have the same content. In case that such *parallel* patents are infringed by another company, there is not only one infringement, but the infringement of each national patent constitutes a separate infringement. In such a situation, the patent holder will usually be interested in suing the infringer for all infringements at one place, while the infringer might be interested in the contrary. The situation becomes even more complicated where not only several patents are affected, but where there are also several infringers which potentially have acted in a coordinated way. Then the patent holder might be strongly interested to proceed against all infringers in a consolidated way, in that he sues all of them at one place, which, again, might be in opposition to the infringers' interests. With regard to patents, a special problem consists in the fact that such intellectual property rights only come into existence when being granted by a State (for instance in contrast to copyright). In light of this, the question arises in which way infringement proceedings are affected when the alleged infringer raises the defence of invalidity of the concerned patent. For, not only the grant of patents, but also a decision on the validity of a patent might be considered so closely connected with sovereignty of the granting State that only the courts of this State might be competent to decide on this matter. Apart from such procedural questions, one should not lose out of sight that interim relief plays a considerable role especially in cross-border disputes.

It has been underlined that there is a growing conflict between the increasing internationalisation of economic activity on the one hand and the nation-State-based organisation of the patent system on the other hand.<sup>2</sup> For, in a globalised world, the economic considerations more and more go beyond the scope of patent legislation and jurisdiction.<sup>3</sup> On a global scale, the solution might therefore even lie in granting international patents being valid all around the world, and in harmonising and integrating judicial systems to address existing problems with regard to international patent infringement and patent validity litigation.<sup>4</sup> However, as one may doubt that this approach is realistic,<sup>5</sup> it seems preferable to

---

<sup>1</sup> Fumagalli 2010, p. 16.

<sup>2</sup> Artelsmair 2005, p. 14.

<sup>3</sup> Artelsmair 2005, p. 14.

<sup>4</sup> Pavana Kumar (2009)97(7) Current Science 1009, at p. 1012. In this context, the project of a Global Judgments Convention may be mentioned, which shall in parts be subject to a closer discussion at a later point in this thesis. However, the conception that a world patent (respectively major supranational rights) would best serve the protection of inventions has been refused by other parts of legal doctrine. For instance, it has been put forth that patent protection is rather to be found “in international, multilateral and bilateral collaboration and implementation, of which the EPO based on the European Patent Convention is a good example”, cf. Schade (2010)41(7) IIC 806, at p. 811.

<sup>5</sup> Concerning this proposal, Pavana Kumar admits that “this is easier said than done, given the complex political systems of the nations of the world”, cf. Pavana Kumar (2009)97(7) Current Science 1009, at p. 1012. It may be added that such a “global solution” will presumably fail due to existing significant differences with regard to legal cultures, attitudes and mentalities, and also due to the absence of a general trust among the States which would form the indispensable basis for such a universal, i.e. global, project.

strive for alternatives to “global patents”<sup>6</sup>. With regard to the European Union, this would mean to focus on the goal to strengthen patent protection within Europe, avoiding that patent protection within Europe becomes not only less effective and more expensive than patent protection in comparable markets, such as the USA or Japan, but to avoid as well that Europe’s ability to act in international arenas is likewise limited. Against this background, there seems to be a growing pressure to centralise the patent system.<sup>7</sup>

From the European perspective, we today face a co-existence of national patents and European patents, and this landscape will be enriched by so-called European patents with unitary effect. The main difference between these types of patents consists in their varying territorial scope of protection. Apart from the existence of different types of patents, which may already cause the problem to decide which type of patent to choose (which will depend on primarily economic aspects), multiple further problems exist at diverse levels: international procedural law (in particular international jurisdiction), choice of law and substantive law. The title of this thesis – “Cross-border patent infringement litigation within the European Union” – may already generate several connotations. First, the thesis will deal with patent infringement *litigation*, and will therefore primarily deal with *procedural law*, in particular the field of international jurisdiction. Aspects of choice of law and substantive law will only be mentioned when essential to discuss and fully comprehend a specific procedural aspect. For instance, one might wonder whether respectively in which way the principle of territoriality which will be treated in more detail in the framework of this thesis has also relevance for procedural law. Noteworthy, a patent holder may become involved into proceedings in numerous constellations. For instance, he may find out that someone else is infringing his patent, and he will consequently intend to stop this infringing activity. On the other hand, it may also occur that someone else sues the patent holder by way of an action for a declaration of non-infringement in order to attain a judicial decision that there is actually no patent infringement. Apart from these constellations, pure validity actions may be initiated or defences of invalidity may be raised. While invalidity defences will be treated in this thesis due to the strong connection with and influence on infringement actions, this thesis will not deal with pure validity actions. Second, this thesis will concentrate on patent *infringement* litigation, thereby excluding, on the one hand, contractual actions (such as actions arising from a conflict in the framework of a license agreement), but also pure validity actions as already mentioned. Third, I will, in principle, leave aside purely national disputes (unless necessary to illustrate a specific issue), but focus on *cross-border* proceedings.

During the recent years, cross-border patent disputes have gained more and more significance. This may also be based on the insight that an effective patent enforcement is an indispensable element of a functioning patent system besides choice of law and substantive law rules. Or one might even go so far to express it in the following way: In reality, the “best” patent will lose much of its significance and economic value if there is no effective judicial way to stop others from infringing it. This thesis pursues the objective to deliver a contribution for elaborating how effective patent infringement litigation should be formed. Being focused on the legal situation within the European Union, this thesis will primarily focus on the legal provisions of the Brussels Ibis Regulation which has been developed from the previous Brussels Convention and the Brussels I Regulation. Since law is no static phenomenon, but rather constantly develops, the main objective of this thesis is to analyse different ways to amend existing deficiencies in cross-border patent litigation and to draft solutions: within the

---

<sup>6</sup> Cf. the provocative title of a work by *Trimble* “Global Patents – Limits of Transnational Enforcement” whereas *Trimble* clarifies in the first sentence of the introduction that such a global patent does not exist, cf. *Trimble* 2012, p. 1.

<sup>7</sup> Artelsmair 2005, p. 14.

existing system of the Brussels Ibis Regulation – being amended – on the one hand, or through alternative instruments and means on the other hand. In this respect, the European patent with unitary effect, and the Unified Patent Court, as alternative solutions to the present system of patent protection within Europe shall be treated.

## **2. The approach pursued in this thesis**

For a clear orientation, I shall briefly outline in which way this thesis is constructed. Subsequent to these introductory remarks, I will proceed with discussing certain basic terms and principles in Chapter 1. In Chapter 2, I will then treat in detail rules of international jurisdiction with regard to patent infringement actions according to the Brussels Ibis Regulation. The focus in Chapter 2 will lie on illustrating which essential problems with regard to cross-border patent infringement proceedings are (still) existing under the Brussels Ibis Regulation which should be taken into consideration when eventually recasting the Regulation. The findings of Chapter 2 will form the basis for a deepened analysis undertaken in Chapter 3 concerning the question in which way these rules of international jurisdiction according to the Brussels Ibis Regulation could (respectively should) be reformulated. Besides analysing existing reform proposals I will also deliver own formulation proposals. In Chapter 4, I will deal with the creation of a European patent with unitary effect and a Unified Patent Court as an eventual alternative to classical European patents in order to avoid existing jurisdictional problems. Finally, I shall finish this thesis with a conclusion of my findings and proposals, and a summary.

I would like to finish this introduction with a formal remark. Only for reasons of convenience, I chose the masculine form when referring to a plaintiff, defendant etc. This certainly does not imply any evaluation.

This study discusses the law and proposals on 1 June 2015, the date the research ended.

## CHAPTER 1

## **1. Basic terms and principles**

### **1.1 What is a patent?**

While the existence of a patent system is generally recognised in both common law and civil law countries, there are significant differences between those kinds of legal systems, which do not only concern details, but also affect fundamental questions and decisions such as the following: What is a patent? What is its nature? Which reasons may exist to justify a patent system? A closer look reveals that different answers may be received from the common law and the civil law perspective. Before analysing cross-border patent infringement proceedings and evaluating in which way such proceedings can be led most effectively in Europe, I shall give a short overview which are the concepts of a patent according to common law and civil law, and treat the different ways of justification for the existence of patent systems.

#### **1.1.1 The concepts of a patent – historical embedding**

##### **1.1.1.1 The common law perspective**

In the following paragraphs, I shall briefly outline how a patent is considered and characterised in common law. For reasons of simplification, I shall primarily refer to English law, while it shall not be concealed that the described principles equally, respectively similarly, apply to other common law systems, such as the U.S. American law.

The idea of a patent as it exists in England today is strongly determined by the Patents Act 1977. However, in order to ensure a comprehensive understanding of its conceptional basis, I shall start with a short overview of the development of the concept of a patent existing before 1977. Historically, patents were considered monopolies offered by the State, i.e. by the Crown. Such special privileges were granted to trade guilds and corporations as well as to individuals. Thus between the years 1331 and 1452, various letters of protection were issued to foreign weavers and other craftsmen.<sup>8</sup> Originally, such monopolies offered by the State were designed to encourage the setting up of new industries,<sup>9</sup> but also as rewards.<sup>10</sup> To give a prominent example dating from the sixteenth- and seventeenth-century in Britain, the Crown granted privileges to subjects in return for the subject carrying out some corresponding duty. In the beginning, these privileges were granted in so-called “letters patent”, derived from the Latin expression “*litterae patentes*”, meaning “open letters” from the Crown to the subject. They were named in this way “because they are not sealed up, but exposed to view, with the Great Seal pendant at the bottom, and are usually addressed by the Sovereign to all the subjects of the Realm”.<sup>11</sup>

In contrast to the current system, which includes a sort of system of checks and balances, such a mechanism did not exist at that time, which resulted in the situation that privileges were conferred quite freely by the Crown. This situation had two negative consequences: on the one hand, patents were even granted for activities that were already being performed by individuals. An “inventor” was understood to cover not only the deviser of the invention but

---

<sup>8</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-07.

<sup>9</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-08.

<sup>10</sup> Bently & Sherman 2001, p. 310; Cornish & Llewelyn 2003, para. 3-04.

<sup>11</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-02.

also one who imported it from abroad.<sup>12</sup> For instance, to illustrate that practice, the Crown granted a monopoly over the selling of playing cards (Darcy's Patent for the monopoly of importing, manufacturing and selling playing cards, which was the subject of the famous *Case of Monopolies*).<sup>13</sup> On the other hand, towards the end of the Elizabeth's reign, abuses crept in. Monopolies were granted to court favourites and the like in respect of the right to sell staple commodities, which led to vociferous complaints.<sup>14</sup>

As this practice provoked more and more criticism, the abuses of the monopoly system becoming so scandalous that the agents most concerned in enforcing certain patents were impeached and some twenty patents were thereupon revoked by proclamation,<sup>15</sup> the Crown's right to grant such privileges was both challenged in the courts<sup>16</sup> and became subject to parliamentary intervention with the passage of the 1624 Statute of Monopolies. The latter effected a limitation of the circumstances in which a patent could be granted and also restrained the duration of the patents for new manufacture to a period of fourteen years (covering two terms of apprenticeship).<sup>17</sup>

From 1624 to 1835 the actual procedure for the grant and enforcement of patents remained completely a matter for the common law.<sup>18</sup> Regarding the nature of the patent itself, the nineteenth century brought the most significant changes; patents changed from primarily being a creature of Crown prerogative to become a creature of bureaucracy.<sup>19</sup> This process was accompanied by the development of patent *law*, both in an academic way and by judicial decisions. Important changes in the procedure for obtaining the grant (including provisional protection) were introduced by the Act of 1852 which provided also for the establishment of the Patent Office,<sup>20</sup> and by the Acts of 1883 to 1888 there came into being the system that existed until 1 June 1978 when substantially the whole of the Patents Act 1977 came into operation.<sup>21</sup> Until the Patents and Designs Act 1932 the grounds upon which a patent could be revoked, meaning the grounds of invalidity, had remained the grounds available at common law, but that Act, while retaining the grounds at common law, additionally introduced several specific statutory grounds.<sup>22</sup> By the Patents Act 1949, the last of the "old statutes",<sup>23</sup> i.e. those statutes before the Patents Act 1977, the legislator abolished the grounds available at common law leaving the statutory grounds specified in that Act as constituting the complete code of grounds upon which a patent could be revoked.<sup>24</sup> The Patents Act 1949 provided, for the first time, for the appointment of specialist patent judges to hear patent matters.<sup>25</sup> The Patents Act 1977 has effected far-reaching changes in the English patent system and law. Despite the enactment of the Patents Act 1977, a number of provisions of the Act of 1949 (as amended) continued to apply to existing patents and patent applications,<sup>26</sup> i.e. patents granted and

---

<sup>12</sup> Cornish & Llewelyn 2003, para. 3–05.

<sup>13</sup> Darcy v. All(e)in (1602) Co Rep 84b, 1 W.P.C. 1; cf. Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-09.

<sup>14</sup> Reid 1999, para. 1.16.

<sup>15</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-10.

<sup>16</sup> Clothworkers of Ipswich Case (1614) Godbolt 252.

<sup>17</sup> Bently & Sherman 2001, p. 311.

<sup>18</sup> Reid 1999, para. 1.19.

<sup>19</sup> Bently & Sherman 2001, p. 311.

<sup>20</sup> Reid 1999, para. 1.19.

<sup>21</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-23.

<sup>22</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-23; Reid 1999, para. 1.19.

<sup>23</sup> Reid 1999, para. 1.19.

<sup>24</sup> House of Lords 27 October 1970, *American Cyanamid Company (Dann's) Patent*, [1970] F.S.R. 443 – *American Cyanamid Company (Dann's) Patent*; Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-23.

<sup>25</sup> Cf. s.84(1) of the Patents Act 1949

<sup>26</sup> Cf. s.127 and Scheds. 1, 2, 3 and 4 of the Patents Act 1977.



applications for patents in being before 1 June 1978 (when substantially the whole of the Patents Act 1977 entered into force), the last of which did not expire until 1998.<sup>27</sup> I shall come back to the Patents Act 1977 when treating specific aspects of English patent law at a later point in this Chapter. Here it may suffice to highlight that the Patents Act 1977, in particular, introduced provisions as to novelty and inventive steps which follow corresponding provisions in the European Patent Convention (EPC).<sup>28</sup> With regard to subsequent sets of rules established to amend the Patents Act 1977, I shall, owed to the objective pursued here to merely deliver a brief overview of the concepts of a patent, restrict myself to mention the Patents Act 2004. One of the main purposes of this Act was to bring UK domestic law into line with the revisions to the EPC agreed in November 2000.<sup>29</sup>

### **1.1.1.2 The civil law perspective**

Similarly to the common law perspective, civil law legal systems also assume that IP rights such as patents shall promote industry and economic progress by protecting the inventor's intellectual and commercial achievement and connected interests, assigning him the economic value of the intellectual goods created by him.<sup>30</sup> However, as will become clear in the following paragraphs, while this general idea is equal in both legal systems, the concept of a patent as well as the justifications given for the existence of patents vary to a notable extent between common and civil law. As there are also differences between civil law States, both France and Germany shall be treated.

#### **1.1.1.2.1 France**

Similarly to the development in common law, the civil law patent can be deduced from the medieval privilege. In contrast to patents, the function of a privilege was not in the first place to exclude others from the invention and its exploitation, but to entitle the inventor to make use of his invention.<sup>31</sup> This led to the situation that the Sovereign more and more used the grant of privileges to gain money and to promote his favourites. The climax of this privilege system on the European continent, governed by civil law<sup>32</sup>, came under the regime of absolutism in France. In this period, money flowing from the grant of privileges had become a main revenue of the State, particularly for the running of royal manufactures.<sup>33</sup> In contrast to England, where the Statute of Monopolies of 1624 limited the misuse of the allocation of patents and restricted it to the first inventor, the privilege system in France stayed in force regardless of a legal restriction of the privilege as to the duration and the inheritableness in 1762. It was not before 1789 that, in the course of the French Revolution, the privilege system was formally abolished.<sup>34</sup> One important consequence of the French Revolution was its image of the human being having genuine human rights and fundamental liberties. Consequently, inventions were now considered human achievements worthy to be protected because an

---

<sup>27</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-23.

<sup>28</sup> These provisions are s. 2(1),(2) and (3) of the Patents Act 1977, corresponding to Articles 54-56 of the EPC; cf. Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-25.

<sup>29</sup> Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 1-36.

<sup>30</sup> Jestaedt 2008, para. 2.

<sup>31</sup> Osterrieth 2010, para. 25.

<sup>32</sup> It is admitted that one might differentiate, beyond the differentiation between civil law and common law legal families, between those systems and the Nordic legal family. However, for reasons of simplification, the latter group shall not be separately taken into consideration in this thesis.

<sup>33</sup> Osterrieth 2010, para. 25.

<sup>34</sup> Osterrieth 2010, para. 26.

individual had created them. According to this idea, the French Patent Act of 1791 made the inventor the *owner* of his invention. Also in accordance with the latter concept, but in opposition to English law at that time, the French Patent Act of 1791 did not require an official examination of novelty or even utility.<sup>35</sup> Furthermore, patents for imported things and methods were granted as well.<sup>36</sup> As the act of invention itself conferred ownership of the thing or the invented process to the inventor, the official examination of novelty and utility would only have a declaratory rather than a constitutive effect.<sup>37</sup> Today it is in particular the *Code de la propriété intellectuelle* which contains rules as to French patents.

#### 1.1.1.2.2 Germany

In Germany – which initially consisted of multiple territorial States – the idea of industrial property did not play an important role at the beginning of the nineteenth century, due to the fact that the lack of one unified German State led to burdens for commerce, which was still captured in a guild system, and industry.<sup>38</sup> However, step by step, the liberal ideas of the French Revolution also found their way into the German territories. In contrast to France, but similarly to England, the general opinion in most German territories now consisted in a dislike of any monopolies, because monopolies were considered as an institution being contrary to the given liberties.<sup>39</sup> Only the bigger German States, if any, introduced acts to protect inventions, while smaller States merely granted privileges if the inventions were already protected in another State. Prussia was very reluctant to grant patents, because authorities believed that commerce was best promoted by granting merely few patents.<sup>40</sup> Similarly, the German Customs Society (Deutscher Zollverein), founded in 1833, promoted a further restriction of the patent system, because patents were considered as tax monopolies which should be prevented. After the foundation of the German Empire in 1871, the first German Patent Act was passed in 1877, and updated in 1891. The latter brought along a refined patent protection, protecting not necessarily the actual inventor but the one who was registered first after an examination by the patent office. Consequently, the grant of a patent had constitutive and not only declaratory effect.<sup>41</sup> Today, the *Patentgesetz* which contains both substantive and procedural provisions is the most relevant national legal source of patent law in Germany.

### 1.1.2 Ways of justification for the existence of patents

#### 1.1.2.1 The common law perspective

Noteworthy, both “individual” and “public” justifications have been referred to in the arguments in favour of patents for invention, as for other kinds of intellectual property law.<sup>42</sup> On the one hand, it has been emphasised that an inventor has a natural or moral right to the products of his mental labour (*deontological* or *natural rights* justification). According to this theory, social or competitive consequences are not taken into consideration. On the other hand, it has been argued that justice demands that an inventor's contribution should be

---

<sup>35</sup> Kraßer 2009, p. 60.

<sup>36</sup> Kraßer 2009, p. 60.

<sup>37</sup> Kraßer 2009, p. 60-61.

<sup>38</sup> Jestaedt 2008, para. 29.

<sup>39</sup> Jestaedt 2008, para. 29.

<sup>40</sup> Jestaedt 2008, para. 29.

<sup>41</sup> Osterrieth 2010, paras. 31-32.

<sup>42</sup> Cornish & Llewelyn 2003, para. 3–36.

recognised by the grant of a reward.<sup>43</sup> However, the most prominent rationale being developed under (English) common law in order to justify a strong, effective patent system is the thesis that the grant of patent monopolies effects *public benefits*, in that a system more similar to copyright – with its “property”-like duration and its protection of all original creations, but only against copying – would seem more appropriate, if the major reason for a patent system were to give the inventor his just reward.<sup>44</sup> This argumentation is called the *consequentialist* or *utilitarian* justification. While it has been used in different variations, its basic idea is that the public should only ever have to endure the harm caused by the grant of a patent if the public also receives some corresponding benefit.<sup>45</sup> The main objectives of a patent system are thus said to be the encouragement of industry, employment and growth, rather than justice to the “inventor” for his effort.<sup>46</sup> The latter aspect is thus seen as a mere by-product of granting a patent, as an incidental consequence of modern patent systems, which do not protect each inventor who conceives an invention but only entitle the first-comer – i.e. the first to apply for a patent, not necessarily being the first to invent – by giving him priority.<sup>47</sup> In detail, it has been argued that the public interest in the patent system flows from the fact that the patentee introduced a form of technology that had not previously been available. Initially, this often simply involved the patentee importing information about a trade or a craft from another State. Later, this rationale was replaced by the argument that the public benefit lay in the disclosure of the invention occurring on publication of the patent application. This role of the patent has been referred to as the “information function” of the patent system.<sup>48</sup> According to this point of view, patents are considered to act as incentives to individuals or organizations to disclose information that may have otherwise remained secret.<sup>49</sup> Furthermore, it has been emphasised that patents provide an incentive for the production of new inventions.<sup>50</sup> Following this approach, the underlying purpose of a patent system might actually be seen in the “encouragement of improvements and innovation”<sup>51</sup>, the inventor receiving, in return for making known his improvement to the public, the benefit of a period of monopoly during which he becomes entitled to prevent others from performing his invention except by his licence. As they benefit economically from such a system, investors are considered more willing to fund research and development. Consequently, patents link scientific and technical research with commercial interests.<sup>52</sup>

It has been argued that the whole patent transaction can thus be thought of as a bargain or contract between the inventor and the State, both parties bringing consideration to that contract. The consideration of the State consists in giving the patent to the inventor, and the inventor, applying for the patent, brings consideration in terms of fees and by adding his invention to the store of public information, ultimately giving up his monopoly in his invention.<sup>53</sup>

---

<sup>43</sup> Cf. Bently & Sherman 2001, p. 313 with further references with regard to diverse justifications for patents.

<sup>44</sup> Cornish & Llewelyn 2003, para. 3–36.

<sup>45</sup> Bently & Sherman 2001, pp. 313–314.

<sup>46</sup> Cornish & Llewelyn 2003, para. 3–05.

<sup>47</sup> Cornish & Llewelyn 2003, para. 3–36.

<sup>48</sup> Bently & Sherman 2001, p. 314.

<sup>49</sup> Bently & Sherman 2001, p. 314.

<sup>50</sup> Bently & Sherman 2001, p. 314.

<sup>51</sup> Court of Appeal, and House of Lords 9 May 1991, *Asahi Kasei Kogyo KK's Application*, [1991] R.P.C. 485, 523 (Lord Oliver of Aylmerton) – *Asahi Kasei Kogyo KK's Application*.

<sup>52</sup> Bently & Sherman 2001, p. 315.

<sup>53</sup> Bainbridge 2012, p. 390 and there n. 5.

### 1.1.2.2 The civil law perspective

In contrast to common law, which strongly emphasises the idea of public benefit when arguing in favour of an effective patent system (while there are different attempts concerning the exact argumentation), the civil law approach rather tends to stress the *protection of private interests* and so emphasises the character of patents as a type of *intellectual property*. As to those private interests, it can be differentiated between *economic interests*, following directly from the fact that the inventor invested money in the development of a product or a process<sup>54</sup> and thus shall benefit from the fruits of his invention, and *personal interests* based on the personality right of the inventor as an individual and thus linked indirectly with an invention.<sup>55</sup> Although the latter aspect might be more relevant in the field of copyright law, it is generally recognised that the personality right is to be protected as to patent rights, too.<sup>56</sup> On the other hand, public interests are generally regarded as simple motives of the legislator without having (much) independent importance. However, in some respect also civil law legal systems take into consideration those public interests, for instance in respect of attributing IP rights, determining the object respectively extent of protection, and ensuring legal protection.<sup>57</sup>

## 1.2 National patents, European patents and European patents with unitary effect

### 1.2.1 Status quo: National patents and European patents

At present, patent protection in Europe is characterised by the coexistence of two available types of patents: national patents granted by competent national authorities, and European patents granted by the European Patent Office, a body of the European Patent Organisation (EPO) which is an international organisation being situated in Munich and The Hague, comprising 38 members (among which 28 are EU Member States, besides 10 other European countries).

Both national patents and European patents, the latter being bundles of national patents,<sup>58</sup> are granted and protected according to national law. As to European patents, their scope of protection is thus more limited than eventually to be expected according to their designation at first glance. On the one hand, the European Patent Convention (hereinafter EPC) provides a single procedure for granting European patents. One single patent application being filed in any language and prosecuted in English, French or German, must be made. The full text of the patent is to be published in the chosen official language of the EPO. A translation into the other two official languages of the EPO, of the part of the patent defining the scope of protection, i.e. the claims, must be produced. Eventually, the designated States of the EPC may require further translation into their own languages after grant, typically within a period of three months.<sup>59</sup> On the other hand, it is to be noted that a European patent is not *per se* effective for all Contracting States to the EPC. Rather, the applicant must choose for which countries protection shall be gained, and validate the European patent in these States

---

<sup>54</sup> The potential objects of a patent shall be discussed at a later point.

<sup>55</sup> Osterrieth 2010, para. 2.

<sup>56</sup> Jestaedt 2008, para. 3.

<sup>57</sup> Jestaedt 2008, para. 4.

<sup>58</sup> It has been underlined that European patents cannot be regarded as purely national patents because national patent laws determine the interpretation of national patents whereas Article 69 of the European Patent Convention (EPC) is decisive for the interpretation of European patents, cf. Norrgård 2009, p. 219.

<sup>59</sup> Following the London Agreement, the number of states requiring such translation has decreased.

according to the respective validation requirements which may vary among each other. Furthermore, the fate of a European patent, once having been granted and validated, may vary among the States for which protection has been gained. The present European patent thus actually represents a bundle of national patents. In procedural respect, this causes the need to potentially litigate a European patent in multiple jurisdictions, and to enforce it separately in each State. As a consequence, contradictory decisions may appear in a State and between States in first, second or third instance, due to different evidence put before judges, different experts used in different jurisdictions, different advocates dealing with the case and inconsistent implementation of European Directives.<sup>60</sup> Although there has been harmonisation in the approaches taken by different countries, the remaining differences can still result in forum shopping, with the different particularities of different countries' judicial systems being exploited variously by patentees and defendants.<sup>61</sup> Also, some countries may have more infringers than others, and in some of the smaller countries, the cost of litigation may be out of proportion to the level of infringement, leading to the result that patent enforcement may not be a viable undertaking in smaller countries.

With regard to actions concerning national patents, national courts have jurisdiction. In case of references for a preliminary ruling, the ECJ will come into play. The same currently applies with regard to European patents. Once the Unified Patent Court (UPC) will have been installed, that court will have jurisdiction for European patents (beside national courts for a transitional period of seven years). The ECJ will remain competent to answer references for a preliminary ruling.

### **1.2.2 To be established: European patents with unitary effect**

By way of Regulation 1257/2012 and Regulation 1260/2012, the so-called European patent with unitary effect is being developed as a third option beside national patents and classical European patents as illustrated above.<sup>62</sup> While the question of whether simultaneous protection via a unitary patent and a national patent is possible will have to be clarified in national provisions,<sup>63</sup> Article 4(2) of Regulation 1257/2012 makes clear that it will be impossible to have the same patent granted as a unitary patent and a classical European patent without unitary effect. A European patent with unitary effect will be effective in all participating Member States and thus will ensure uniform protection for an invention in these States.

With regard to European patents with unitary effect, the future Unified Patent Court (UPC) shall have jurisdiction (beside national courts for a transitional period of seven years). The ECJ will come into play in case of references for a preliminary ruling.

---

<sup>60</sup> Rodriguez (2012)34(6) E.I.P.R. 402, at p. 403.

<sup>61</sup> Kazi (2011)33(8) E.I.P.R. 538, at p. 539; Rodriguez (2012)34(6) E.I.P.R. 402, at p. 403; Lock (2011)36(4) E.L. Rev. 576, at p. 577; drawing a more differentiated picture of forum shopping, underlining that forum shopping can be both good and bad: Ebbink 2006, pp. 257-258. As an example that forum shopping may even have a beneficial effect, *Ebbink* mentions the case of originally rather slow courts which, when confronted with an alleged torpedo, proved amenable to speed up the delivery of an opinion on jurisdiction, which means that in those cases, a perceived "competition" between the national courts proved a positive factor, cf. Ebbink 2006, p. 258. Favouring a less critical attitude towards forum shopping cf. also Kur 2009, p. 8.

<sup>62</sup> Already envisaging a patent with such Union-wide effect: Bossung (2002)51(6) GRUR Int. 463, at p. 470.

<sup>63</sup> Luginbühl (2013)62(4) GRUR Int. 305, at p. 307.

### 1.3 Patent categories: product patents and process patents

Noteworthy, both common law and civil law systems provide for the possibility to grant a patent on a *product* (product patent) or on a *process* (process patent). As the differentiation between product patents and process patents will be relevant in this thesis, I shall continue with a short illustration of the most important rules in this respect, addressing the common law, civil law and European perspective.

#### 1.3.1 The common law perspective

Again, I shall refer to English law when discussing the common law perspective. According to the above cited Statute of Monopolies from 1624, all grants of monopoly rights were declared to be void at common law, except from letters patent and grants of privilege in respect of any “manner of new manufactures”. Under the Patents Act 1949, the predecessor of the Patents Act 1977, the definition of a patent was extended: an invention, to be patentable, must either be a “manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies”, or be a new method or process of testing applicable to the improvement or control of manufacture.<sup>64</sup>

Under the Patents Act 1977 – its passage being necessary for bringing into harmony English law with the provisions of the European Patent Convention of 1973, to which the United Kingdom adhered<sup>65</sup> – the former definition of an invention as a “manner of new manufacture” as well as the body of case-law which interpreted that definition has become obsolete. It has been replaced by a statutory codification of the requirements of patentability, in section 1(1) to 1(4) of the Patents Act 1977, based upon and intended to have the same effects as the corresponding provisions of Articles 52 to 57 of the European Patent Convention, with certain amendments to section 1(3) and (4) giving effect to Article 27(2) of the TRIPS Agreement.<sup>66</sup> The text of section 1 of the Patents Act 1977 provides as follows:

##### Section 1

(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say–

- (a) the invention is new;
- (b) it involves an inventive step;
- (c) it is capable of industrial application;
- (d) the grant of a patent for it is not excluded by subsections (2) and (3) below;

and references in this Act to a patentable invention shall be construed accordingly.

(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of–

- (a) discovery, scientific theory or mathematical method;

---

<sup>64</sup> Section 101(1) of the Patents Act 1949; cf. Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 2.01.

<sup>65</sup> Reid 1999, para. 1.20.

<sup>66</sup> Cf. s.130(7) of the Patents Act 1977; Miller, Burkill, Birss & Campbell 2011 (Terrell), para. 2-07; Cornish & Llewelyn 2003, para. 5–54.

(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;

(c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;

(d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

(3) A patent shall not be granted—

(...);

(b) for any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro-biological process or the product of such a process.

(...)

According to the definition in section 1(1) of the Patents Act 1977, the term “patentable invention” is defined as an invention that satisfies the four conditions laid down in that section. Besides, protection concerning a process is not excluded by the negative enumeration within section 1(2) of the Patents Act 1977 clearly reflecting Article 52(2) of the EPC. The wording of section 1 of the Patents Act 1977 is thus formulated in a way that comprises both product patents and process patents.

Furthermore, the fact that patent protection principally equally applies to a process can also be derived from the fact that section 1(3)(b) of the Patents Act 1977 which reflects Article 53(b) of the EPC, while excluding certain essentially biological *processes* from patentability, explicitly states that a patent can be granted in case of a micro-biological *process*.

Additionally, the definition of the term “invention” in section 125(1) of the Patents Act 1977 affects product patents as well as process patents:

#### **Section 125**

(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawing contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

The fact that both product patents and process patents are protected under the Patents Act 1977 is further confirmed by the fact that provisions as section 60(1) of the Patents Act 1977 where both categories of patents are explicitly addressed:

#### **Section 60      Infringement**

(1) Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say—

- (a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
- (b) where the invention is a process, he uses the process or he offers it for the use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;
- (c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise. [underscores added]

As a result, it can be concluded that all new technological processes, machines, devices, articles, products and compositions are, in principle, of inherently patentable nature.<sup>67</sup>

### 1.3.2 The civil law perspective

In the following paragraphs, it shall be demonstrated that the differentiation between product patents and process patents is also known and ensured in civil law systems within Europe. At least in this respect, the situation is therefore comparable to the situation in England. The French and the German legal systems shall be chosen as sample legal systems.

#### 1.3.2.1 France

In contrast to French copyright law, which contains a typology of what can be object of a copyright, the set of rules concerning patents do not imply such an enumeration of types of patentable inventions.<sup>68</sup> However, the *Code de la propriété intellectuelle* contains *inter alia*, in its first title implying several provisions with regard to patents (“*brevets d'invention*”), in the first chapter, third part, provision L. 611-10 which reads:

##### **L. 611-10**

(1) Sont brevetables les inventions nouvelles impliquant une activité inventive et susceptibles d'application industrielle.

(2) Ne sont pas considérées comme des inventions au sens du premier alinéa du présent article notamment:

- (a) Les découvertes ainsi que les théories scientifiques et les méthodes mathématiques;
- (b) Les créations esthétiques,
- (c) Les plans, principes et méthodes dans l'exercice d'activités intellectuelles, en matière de jeu ou dans le domaine des activités économiques, ainsi que les programmes d'ordinateurs;
- (d) Les présentations d'informations.

(3) Les dispositions du 2 du présent article n'excluent la brevetabilité des éléments énumérés auxdites dispositions que dans la mesure où la demande de brevet ou le brevet de concerne que l'un de ces éléments considéré en tant que tel.

<sup>67</sup> Reid 1999, para. 2.2; Wilson 2002, p. 8 et seq.

<sup>68</sup> Piotraut 2004, p. 133.



#### **(L. 611-10**

(1) New inventions are patentable which involve an inventive step and which are susceptible of industrial application.

(2) The following are not regarded as inventions within the meaning of the first paragraph of this article:

(a) Discoveries as well as scientific theories and mathematical methods;

(b) Aesthetic creations;

(c) Schemes, principles and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) Presentations of information.

(3) The provisions of paragraph 2 of this article exclude patentability of the enumerated items referred to in these provisions only to the extent to which the patent application or the patent relates to such items as such.)<sup>69</sup>

In the first paragraph of L. 611-10, the French legislator used, in accordance with Article 52(1) of the EPC, the term “invention” in a quite broad way, neither referring to a product in the sense of a physical object, nor to a process. Besides, protection concerning a process is not excluded by the negative enumeration within the second paragraph of L. 611-10 which clearly reflects Article 52(2) of the EPC. This may already suggest that patents can be gained for both products and processes.

Additionally, in provision L. 611-17, the French legislator, while generally excluding certain essentially biological *processes* from the scope of patentable inventions, explicitly admitted microbiological *processes* and the products thereof as patentable:

#### **L. 611-17**

Ne sont pas brevetables:

(...)

c) Les races animales ainsi que les procédés essentiellement biologiques d'obtention de végétaux ou d'animaux, cette disposition ne s'appliquant pas aux procédés microbiologiques et aux produits obtenus par ces procédés.

#### **(L. 611-17**

The following things are not patentable:

(...)

(c) Animal varieties as well as well as essentially biological processes for the production of plants or animals, while this provision does not apply to microbiological processes and products gained from such processes. [underscores added])<sup>70</sup>

---

<sup>69</sup> Translation provided by the author of this thesis.

<sup>70</sup> Translation provided by the author of this thesis.

The fact that this provision which reflects Article 53(b) of the EPC, not only *mentions* processes in the framework of a discussion of patentability, but *explicitly states* that certain types of processes are patentable proves that French law in principle, i.e. in the framework of existing restrictions as to specific areas, provides for patent protection both for products and processes.<sup>71</sup> In case of a product patent, the product, as the object of the invention, is simply a physical object that can be described according to its composition, structure, form and function.<sup>72</sup> A process patent refers to an invention of the application of means according to a succession of states or stages to become effective within a determined order and under specific conditions in order to reach a result, be it a product or an immaterial effect.<sup>73</sup>

### 1.3.2.2 Germany

The German Patentgesetz, which contains substantive provisions as to the protection of German patents on a national basis, applies both to product patents and to process patents. This is already suggested by the open wording of section 1(1) of the Patentgesetz (“Patente”) and the fact that section 1(2) of the Patentgesetz *explicitly mentions patents for specific processes* in conjunction with biological material. In this respect, German patent law differs, in schematic respect, from the legal situation in France presented above, where, closely reflecting Articles 52 and 53 of the EPC, inventions of processes are merely indirectly addressed as objects for a patent, by way of a re-exception (cf. L. 611-17 of the French Code de la propriété intellectuelle discussed above). Although the provisions of the German Patentgesetz also reflect the provisions of the European Patent Convention, the German legislator, in deviation from the Convention, explicitly mentioned and declared patentable, in section 1(2) of the Patentgesetz, processes to create, work or use biological material, and added exceptions in other provisions.<sup>74</sup> Besides, section 9 of the Patentgesetz expressly differentiates between product patents and process patents.

For a better understanding of the following discussion of the treatment of product patents and process patent, the mentioned provisions shall be cited first. Section 1(1) and (2) of the Patentgesetz provides:

#### § 1 Erfindung, Patentfähigkeit

(1) Patente werden für Erfindungen erteilt, die neu sind, auf einer erfinderischen Tätigkeit beruhen und gewerblich anwendbar sind.

---

<sup>71</sup> The differentiation between product patents and process patents may also be extended. In this respect, *Piotraut* mentions three further categories: the category of patents for the new application of a known mean (which French jurisprudence, after originally showing a rather generous attitude, has considerably restricted in the meanwhile), the category of patents for the new combination of known means (which is only accepted if the combination of the means produces a technical effect which goes beyond the mere addition of the technical effects of each mean), and the category of patents concerning the invention of a specific choice of one mean amongst a group of known means in order to reach a particular result (which is apparently accepted pursuant to a decision of the *Cour de cassation* from 1967); cf. *Piotraut* 2004, p. 133 et seq., with further references in particular with regard to relevant French case-law.

<sup>72</sup> *Piotraut* 2004, p. 134.

<sup>73</sup> *Piotraut* 2004, p. 134.

<sup>74</sup> For instance section 2a of the Patentgesetz which contains limiting rules for processes with regard to plant or animal varieties and essentially biological processes for the production of plants or animals, but allowing *inter alia* the patentability for inventions concerning microbiological processes or the products thereof, which corresponds to Article 53(b) of the EPC.

(2) Patente werden für Erfindungen im Sinne von Absatz 1 auch dann erteilt, wenn sie ein Erzeugnis, das aus biologischem Material besteht oder dieses enthält, oder wenn sie ein Verfahren, mit dem biologisches Material hergestellt oder bearbeitet wird oder bei dem es verwendet wird, zum Gegenstand haben. (...)

### **(§ 1 Invention, Patentability)**

(1) Patents are granted for inventions that are new, based on an inventory activity and commercially applicable.

(2) Patents are also granted for inventions in the sense of subsection 1, if they concern a product that consists of biological material or contains such material, or if they concern a process through which biological material is manufactured or worked or in which it is used. (...)<sup>75</sup>

Section 9 of the Patentgesetz reads:

### **§ 9 Wirkung des Patents**

Das Patent hat die Wirkung, dass allein der Patentinhaber im Rahmen des geltenden Rechts befugt ist, die patentierte Erfindung im Rahmen des geltenden Rechts zu benutzen. Jedem Dritten ist es verboten, ohne seine Zustimmung

1. ein Erzeugnis, das Gegenstand des Patents ist, herzustellen, anzubieten, in Verkehr zu bringen oder zu gebrauchen oder zu den genannten Zwecken entweder einzuführen oder zu besitzen;
2. ein Verfahren, das Gegenstand des Patents ist, anzuwenden oder, wenn der Dritte weiß oder es auf Grund der Umstände offensichtlich ist, dass die Anwendung des Verfahrens ohne Zustimmung des Patentinhabers verboten ist, zur Anwendung im Geltungsbereich dieses Gesetzes anzubieten;
3. das durch ein Verfahren, das Gegenstand des Patents ist, unmittelbar hergestellte Erzeugnis anzubieten, in Verkehr zu bringen oder zu gebrauchen oder zu den genannten Zwecken entweder einzuführen oder zu besitzen.

### **(§ 9 Effects of the Patent)**

The patent has the effect that only the holder of the patent has the right, in the framework of the applicable law, to use, in the framework of the applicable law, the invention for which the patent was granted. Every third party may not, without the consent of the patent holder,

1. manufacture, offer, put into circulation, use or, for the aforementioned purposes, import or possess a product which is the object of the patent;
2. apply a process which is the object of the patent or, if the third party knows or if it is obvious in the circumstances that the application of the process is prohibited without consent of the patent holder, offer such a process which is the object of a patent for application within the scope of application of this Act;
3. offer, put into circulation or use or, for the aforementioned purposes, import or possess the product that has been immediately manufactured by way of a process which is the object of the patent.)<sup>76</sup>

---

<sup>75</sup> Translation provided by the author of this thesis.

<sup>76</sup> Translation provided by the author of this thesis.

Patents can thus be granted with regard to products or processes. Accordingly, inventions are classified into patents which, on the one hand, concern the design of products, objects, equipment or materials, or, on the other hand, concern processes concerning the manufacture of products, the use of objects or the achievement of a result. Product patents and process patents have different legal effects, due to the fact that different types of use are protected by these patents. Indeed the classification of patents into product patents and process patents is based on these differences as to the protection granted by the respective patent category.<sup>77</sup>

The object of a product patent is not the product as such, but rather the invention that led to the product.<sup>78</sup> However, the protection of a product patent is effected by prohibiting a third party from dealing with the concerned product in a certain way specified by the law (cf. Section 9 2<sup>nd</sup> sentence no. 1 of the Patentgesetz).<sup>79</sup> In light of this, the product patent grants comprehensive protection, because the patent holder is granted the exclusive right of all possibilities to manufacture and use the product concerned.<sup>80</sup> As a consequence, the infringement of a product patent does not depend on a specific mode or way of manufacture.<sup>81</sup>

As to process patents (cf. Section 9 2<sup>nd</sup> sentence no. 2 and no. 3 of the Patentgesetz), it is to be differentiated between processes of manufacture (no. 3) – which is interpreted in a broad way<sup>82</sup> – and other processes (no. 2). Process patents of manufacture show the particularity that not only the process is protected but also the product that is *immediately* manufactured through that process. In contrast to product patents according to Section 9 2<sup>nd</sup> sentence no. 1 of the Patentgesetz, protection according to no. 3 only exists if there is an *immediate* connection between the protected process and the product. As a consequence, a product is not protected according to no. 3 if the manufacture was undertaken on the basis of *another* process than the protected process.<sup>83</sup>

### 1.3.3 The European perspective

It is noteworthy that the conception of a differentiation between product patents and process patents has also been adopted at the European level. When discussing national provisions of patent law above, it has become clear that, although these provisions differ to a certain extent, they are however similar. As has been mentioned, the reason for this phenomenon is the construction of the respective provisions, in the analysed legal systems, reflecting the articles of the European Patent Convention. For convenience, the respective rules of the EPC shall be coherently presented here as far as being relevant in this context. As the so-called European patent constitutes in fact a bundle of national patents, this harmony of conceptions is required to ensure an adequate patent protection.

Article 52 of the EPC provides:

---

<sup>77</sup> Bacher & Melullis 2006 (Benkard – Patentgesetz), § 1 PatG, para. 4; Reichardt 2006, p. 12.

<sup>78</sup> BPatG 16 October 1973, 32 W (pat) 82/72, BPatGE 17, 181, at p. 185; Bacher & Melullis 2006 (Benkard), § 1 PatG, para. 12; Mes 2005, § 1 PatG, para. 124.

<sup>79</sup> Bacher & Melullis 2006 (Benkard – Patentgesetz), § 1 PatG, para. 12; Reichardt 2006, p. 12.

<sup>80</sup> Bacher & Melullis 2006 (Benkard – Patentgesetz), § 1 PatG, para. 16 with further references to German case-law; Mes 2005, § 1 PatG, para. 125 with further references to German case-law.

<sup>81</sup> Bacher & Melullis 2006 (Benkard – Patentgesetz), § 1 PatG, para. 16a with further references to German case-law; Mes 2005, § 1 PatG, para. 135 with further references to German case-law.

<sup>82</sup> Cf. Bacher & Melullis 2006 (Benkard – Patentgesetz), § 1 PatG, para. 28 with further references to German case-law; Mes 2005, § 1 PatG, para. 137; with further references to German case-law.

<sup>83</sup> Reichardt 2006, p. 13.

## **Article 52 Patentable inventions**

(1) European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information.

(3) The provisions in paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

(...)

And Article 53 of the EPC contains a restrictive provision that explicitly mentions processes, reading:

## **Article 53 Exceptions to patentability**

European patents shall not be granted in respect of:

(...)

(b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof.

Additionally, Article 64(2) of the European Patent Convention (EPC) explicitly confirms the potential patentability of inventions concerning processes:

## **Article 64 Rights conferred by a European patent**

(...)

(2) If the subject-matter of the European patent is a process, the protection conferred by the patent shall extend to the products directly obtained by such process.

## **1.4 The principle of territoriality**

Both in civil law and common law legal systems, the principle of territoriality has always been accepted. However, different conceptions exist about the exact scope and meaning of this principle. In the following paragraphs, I shall deliver a brief outline.

### **1.4.1 Different conceptions of the principle of territoriality**

To put it in a nutshell, three possible interpretations can be distinguished.

#### 1.4.1.1 Private international law interpretation

On the one hand, it has been put forth that the principle of territoriality immediately and necessarily effects that the fate of intellectual property rights – i.e. both their creation, existence and termination – is fully determined by the legal provisions of the State where respectively for which the concerned right has been granted.<sup>84</sup>

#### 1.4.1.2 Substantive law interpretation

Besides, the prevailing legal opinion advocates a conception according to which the principle of territoriality has no effect at the level of private international law, but solely at the level of substantive law, in that intellectual property rights, due to their territorial limitation, are merely protected within the territory of the granting State.<sup>85</sup> Accordingly, national patents granted by national authorities only confer protection for the States to which these authorities belong. As a consequence, patents can only be infringed through actings committed in the protection State.

#### 1.4.1.3 Combined approach<sup>86</sup>

However, a decision between the aforementioned conceptions is dispensable,<sup>87</sup> because those conceptions usually will hardly lead to different results in practice. For those who advocate a private international law interpretation admit that the principle of territoriality is also relevant for the territorial limitation of the effect of the concerned intellectual property rights,<sup>88</sup> and on the other hand, those who prefer a substantive law interpretation, acknowledge that the territoriality of the concerned intellectual property rights have effects at the level of private international law (in terms of the principle of *lex loci protectionis*, meaning that the law of the granting State is decisive for the assessment of private international law with regard to patents).<sup>89</sup> After all, there is no doubt or dispute about the existence of both the principle of territoriality and the principle of *lex loci protectionis*.<sup>90</sup> Therefore, the issue of whether the principle of *lex loci protectionis* is an inevitable consequence of the principle of territoriality, or rather constitutes an autonomous principle, does not have to be decided.

### 1.4.2 Is the principle of territoriality relevant for international jurisdiction in cross-border patent infringement disputes?

Regardless of the exact meaning of the principle of territoriality, the question arises which role is to be attributed to this principle with regard to the issue of international jurisdiction. *In concreto*: Shall the courts situated in the granting State, due to the principle of territoriality, be conferred exclusive international jurisdiction also (beside validity actions) with regard to actions concerning the infringement of patents granted for this State?

---

<sup>84</sup> Troller 1952, p. 48; Ebner 2004, pp. 21-22; Sack (2000)46(3) WRP 269, at p. 270 with further references.

<sup>85</sup> Drexel 2015 (Münchener Kommentar zum BGB), Internationales Immaterialgüterrecht, para. 14; Otte (2001)21(4) IPRax 315, at p. 316; Hye-Knudsen 2005, p. 7, there fn. 8-10; Schack (2003)23(2) IPRax 141, at p. 141; Fezer & Koos 2010 (Staudinger), para. 883; Keller 2006, p. 449.

<sup>86</sup> Cf. Sack (2000)46(3) WRP 269, at p. 270; cf. also: Hye-Knudsen 2005, pp. 7-8.

<sup>87</sup> Hye-Knudsen 2005, pp. 7-8; differently: Schauwecker 2009, p. 15.

<sup>88</sup> Troller 1952, pp. 48-53.

<sup>89</sup> Fezer 2009, Einleitung H. Internationales Markenprivatrecht, para. 15.

<sup>90</sup> Schauwecker 2009, p. 14; Hye-Knudsen 2005, pp. 7-8; Otte (2001)21(4) IPRax 315, at p. 316.

Traditionally, national courts of European Member States denied, by reference to the principle of territoriality, to have international jurisdiction to decide on infringement actions concerning foreign patents respectively other intellectual property rights.<sup>91</sup> While German courts relatively early adopted a more liberal approach, English, French and Dutch courts upheld a restrictive conception for a long time.

To illustrate the (change of) attitude of national courts of selected States within the European Union as to the issue in question, I shall give an overview of relevant jurisprudence in the United Kingdom, France, Germany and the Netherlands.

### 1.4.2.1 Court decisions in the United Kingdom

Traditionally, English courts have been of the opinion that they do not have jurisdiction with regard to infringement proceedings concerning foreign patents respectively proceedings concerning foreign intellectual property rights in general.<sup>92</sup> Only within the scope of the Brussels Convention respectively Brussels I Regulation they have ultimately accepted such jurisdiction.<sup>93</sup> This strict conception has been primarily based on two principles developed in common law: the so-called *Moçambique rule* and the *double-actionability rule*. With regard to actions which do not affect the Brussels Convention respectively the Brussels I Regulation, English courts have kept their strict view of not having jurisdiction where foreign patents are concerned.

#### 1.4.2.1.1 The *Moçambique rule*

In its landmark *Moçambique* decision, the *House of Lords* held – which has been called the *Moçambique rule* – that English courts do not have jurisdiction to entertain an action to recover damages for a trespass to land situate abroad.<sup>94</sup> Being initially developed in the context of a trespass to lands, this rule was later applied as well to intellectual property rights being registered or acquired otherwise<sup>95</sup> abroad.<sup>96</sup> The following three citations may give an idea of this conception. In *Tyburn Productions, Justice Vinelott* addressed

<sup>91</sup> Stauder & Kur 2001, p. 152; Ebner 2004, pp. 164-166.

<sup>92</sup> Cf. Bragieli (1999)2 I.P.Q. 135

<sup>93</sup> Cf. the historical overview delivered in: High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another, [1998] F.S.R. 222, 226-230 – *Fort Dodge*.

<sup>94</sup> House of Lords 8 September 1893, The British South Africa Company v The Companhia de Moçambique and Others, [1893] A.C. 602 (= [1891] All ER Rep 640, 653) – *Moçambique*; cf. Zigann 2002, pp. 31-33.

<sup>95</sup> Noteworthy, the *Moçambique rule* is also applied to intellectual property rights for which registration is not required, such as copyright; cf. High Court of Justice (Chancery Division) 2 February 1990, Tyburn Productions Limited v Doyle, [1990] R.P.C. 185 – *Tyburn*; cf. also Wadlow 1998, para. 6-48 (Wadlow emphasises that “no distinction is made between registered and unregistered rights”); Hye-Knudsen 2005, p. 15; Arnold (1990)12(7) E.I.P.R. 254; Kieninger (1998)47(4) GRUR Int. 280, at p. 284; Zigann 2002, pp. 38-40.

<sup>96</sup> High Court of Australia, Decision from 20 January 1905, Potter v. Broken Hill Pty. Co. Ltd., [1905] VLR 612, 618 – *Potter*; cf. Zigann 2002, p. 35; constant jurisprudence, cf. High Court of Justice (Chancery Division) 2 February 1990, Tyburn Productions Limited v Doyle, [1990] R.P.C. 185 – *Tyburn*; cf. also High Court of Justice (Chancery Division) 22 April 1986, Def Lepp Music and Others v Stuart-Brown and Others, [1986] R.P.C. 273 – *Def Lepp Music*; Outer House (Scotland) 13 December 1988, James Burrough Distillers plc v Speymalt Whisky Distributors Ltd., [1989] S.L.T. 561 – *James Burrough Distillers*; High Court of Justice (Chancery Division) 9 December 1994, Plastus Kreativ AB v Minnesota Mining and Manufacturing Co, [1995] R.P.C. 438 – *Plastus Kreativ*; High Court of Justice (Chancery Division) 24 May 1991, L.A. Gear Incorporated v Gerald Whelan & Sons Limited, [1991] F.S.R. 670 – *L.A. Gear*; cf. also Peinze 2002, p. 267 et seq. with further references to English case-law; cf. also Austin (2009)40(4) IIC 393, at pp. 395-397.

“(…) the central issue in this case (…) whether the distinction between transitory and local actions which was considered by the House of Lords in *British South Africa Co. v. Companhia de Moçambique* [1893] A. C. 602 was fundamental to their decision and if it was, whether an action raising questions as to the validity or infringement of patent rights, copyrights, rights of trade mark and other intellectual property rights are properly to be considered actions of a local nature or whether it was, as it were, a historical prologue setting out the basis of the narrower rule that the English courts will not entertain proceedings raising question as to the title to or for damages for trespass to land.”<sup>97</sup>

After an extended discussion, *Justice Vinelott* concluded that the *Moçambique rule* was also applicable to proceedings concerning intellectual property rights. As a consequence, English courts would not have jurisdiction for validity and infringement proceedings concerning foreign intellectual property rights.

To give another example, *Justice Mummery* held in *L.A. Gear* in 1991, referring to *Tyburn* that

“(…) it is difficult to see how any such claim could properly be made in the proceedings in Ireland for infringement of the United Kingdom trade mark. A United Kingdom trade mark is territorial in its operation. It only has force and effect in the United Kingdom. It has no effect in the Republic of Ireland. An action for infringement of it is local and not transitory in nature. In other words the acts of infringement relied upon must take place within the United Kingdom: see: Dicey and Morris, *The Conflict of Laws*, (11th edition), volume 2 pages 1390 and 1391 and also *Tyburn Productions Limited v. Conan Doyle*[1991] Ch. 75 where it was held that actions for infringement of intellectual property rights, such as patents, trade marks and copyrights, are in the nature of local and not transitory actions. (…)”<sup>98</sup>

In a similar way, *Lord Justice Dillon* explicated in *Mölnlycke* that

“(…) from the nature of a United Kingdom patent, proceedings for infringement of a United Kingdom patent can only be brought in a United Kingdom court, in the present case the English court, and could only be founded on infringement in England. The German court could entertain a claim for infringement of the comparable German patent, but could not entertain a claim for infringement of an English patent. Conversely the English court could not entertain a claim for infringement of a German patent.”<sup>99</sup>

In 1982, the *Moçambique rule* was limited to some extent by Section 30 of the Civil Jurisdiction and Judgments Act 1982 which provides:

**Section 30      Proceedings in England and Wales or Northern Ireland for torts to immovable property.**

(1) The jurisdiction of any court in England and Wales or Northern Ireland to entertain proceedings for trespass to, or any other tort affecting, immovable property shall extend to cases in which the property in question is situated outside that part of the United Kingdom unless the proceedings are principally concerned with a question of the title to, or the right to possession of, that property.

(2) Subsection (1) has effect to the 1968 Convention and the Lugano Convention and the Regulation and to the provisions set out in Schedule 4.

---

<sup>97</sup> High Court of Justice (Chancery Division) 2 February 1990, *Tyburn Productions Limited v Doyle*, [1990] R.P.C. 185, 189 – *Tyburn*.

<sup>98</sup> High Court of Justice (Chancery Division) 24 May 1991, *L.A. Gear Incorporated v Gerald Whelan & Sons Limited*, [1991] F.S.R. 670, 674 – *L.A. Gear*.

<sup>99</sup> Court of Appeal 27 June 1991, *Mölnlycke AB and Another v Procter & Gamble Limited and Others* (No. 4), [1992] R.P.C. 21, 28 – *Mölnlycke AB and Another v Procter & Gamble Limited and Others*.



However, English courts and legal doctrine have mostly not considered this limitation of the *Moçambique rule* according to the Civil Jurisdiction and Judgments Act to apply to intellectual property rights, which has been fiercely criticised by legal commentators, because the *application* of the *Moçambique rule* to patents and other intellectual property rights was based exactly on a claimed comparability between such rights and immovable property.<sup>100</sup> In this respect, *Fawcett/Torremans* have rightly stated:

“Further, following the passing of section 30(1), we now have the bizarre situation whereby the limitation in cases involving foreign intellectual property rights is wider than that in cases involving foreign land. An action for trespass to foreign land which does not involve any issue of title to the land can now be heard by the English courts, whereas the result of *Tyburn* is that an action for infringement of a foreign intellectual property right, which does not involve any issue as to the title to the right but merely, for example, the question of whether there has been an act of infringement, cannot be heard.”<sup>101</sup>

Although parts of legal doctrine have proposed or at least discussed to abolish the *Moçambique rule* for the area of intellectual property law<sup>102</sup>, this has been rejected.<sup>103</sup> So, the *Court of Appeal* decided in *Lucasfilm Ltd v Ainsworth I* that there is a subject-matter limitation in relation to infringement of a foreign copyright. The court stated:

“We accordingly conclude that for sound policy reasons the supposed international jurisdiction over copyright infringement claims does not exist. If it is ever to be created it should be by Treaty with all the necessary rules about mutual recognition, *lis pendens* and so on. It is not for judges to arrogate to themselves such a jurisdiction.”<sup>104</sup>

However, this decision was later reversed by the decision of the *Supreme Court* (*Lucasfilm Ltd v Ainsworth II*) where the Supreme Court, on the basis of an extended reasoning also referring to Article 22(4) of the Brussels I Regulation, Article 8 of the Rome II Regulation and the conceptions of the ALI Principles and the CLIP Principles, finally held:

“We have come to the firm conclusion that, in the case of a claim for infringement of copyright of the present kind, the claim is one over which the English court has jurisdiction, provided that there is a basis for *in personam* jurisdiction over the defendant, or, to put it differently, the claim is justiciable (...).”<sup>105</sup>

“There are no issues of policy which militate against the enforcement of foreign copyright (...).”<sup>106</sup>

#### 1.4.2.1.2 The *double-actionability rule*

The second principle which has been referred to in order to justify that English courts lack jurisdiction as to proceedings concerning foreign intellectual property rights, is the so-called

<sup>100</sup> Cf. Schauwecker 2009, p. 24; Fentiman (1997)56(3) C.L.J. 503, at p. 505; Zigann 2002, p. 44: Zigann has impressively characterised this phenomenon as “Paradoxie der gesamten englischen Rechtsprechung zum internationalen Zivilprozessrecht des gewerblichen Rechtsschutzes” (“paradox of the total English jurisprudence with regard to international procedural law concerning intellectual property”).

<sup>101</sup> Fawcett & Torremans 2011, para. 6.167.

<sup>102</sup> Cf. Cornish (1996)45(4) GRUR Int. 285; cf. Wadlow 1998, para. 6–31; Cohen (1997)19(7) E.I.P.R. 379; Fawcett & Torremans 2011, paras. 6.170–6.178 with further references to case-law.

<sup>103</sup> Cf. Wadlow 1998, para. 6–32; Schauwecker 2009, p. 24 et seq.

<sup>104</sup> Court of Appeal 16 December 2009, *Lucasfilm Ltd v Ainsworth*, [2009] EWCA Civ 1328, [2010] F.S.R. 10, para. 183 – *Lucasfilm v Ainsworth I*.

<sup>105</sup> Supreme Court 27 July 2011, *Lucasfilm Ltd v Ainsworth*, [2011] UKSC 39, [2011] F.S.R. 41, para. 105 – *Lucasfilm v Ainsworth II*.

<sup>106</sup> Supreme Court 27 July 2011, *Lucasfilm Ltd v Ainsworth*, [2011] UKSC 39, [2011] F.S.R. 41, para. 109 – *Lucasfilm v Ainsworth II*.

*double-actionability rule* developed by the English *High Court* in its *Phillips v Eyre* decision where *Justice Willes* explicated clearly:

“As a general rule, in order to found a suit in England for a wrong alleged to have been committed abroad, two conditions must be fulfilled. First, the wrong must be of such a character that it would have been actionable if committed in England (...). Secondly, the act must not have been justifiable by the law of the place where it was done.”<sup>107</sup>

*Dicey and Morris*<sup>108</sup> have described, up to the twelfth edition<sup>109</sup> of their celebrated work “*The Conflict of Laws*”, this principle in Rule 203 in a similar way:

#### **Rule 203**

(1) As a general rule, an act done in a foreign country is a tort and actionable as such in England, only if it is both

(a) actionable as a tort according to English law, or in other words is an act which, if done in England, would be a tort; and

(b) actionable according to the law of the foreign country where it was done.

(2) (...)

On the basis of this principle, English courts would never have jurisdiction for an action concerning the infringement of a foreign patent, because acts committed abroad can, due to the principle of territoriality, only infringe the respective foreign patent. On the other hand, only infringing acts committed in England can constitute a tort according to English law.<sup>110</sup> The latter aspect is expressed clearly in Article 60(1) of the Patents Act 1977 which provides:

#### **Section 60      Infringement**

(1) Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say– (...). [underscore added]

Besides, English courts have not admitted the supplementary consideration that the infringing act, if it had been committed in England affecting a *fictitious* English patent, would constitute a patent infringement according to English law.<sup>111</sup>

---

<sup>107</sup> High Court of Justice (Exchequer Chamber) 23 June 1870, *Phillips v Eyre*, [1870-71] L.R. 6 Q.B. 1, 28-29 – *Phillips and Eyre*; cf. Bragiel (1999)2 I.P.Q. 135, at p. 144 et seq.; Floyd & Purvis (1995)17(3) E.I.P.R. 110, at p. 111; Wadlow 1998, para. 6–07; Kieninger (1998)47(4) GRUR Int. 280, at pp. 285-286.

<sup>108</sup> Collins 1993 (*Dicey and Morris*), p. 1487 et seq.

<sup>109</sup> Since the entry into force of Part III of the Private International Law (Miscellaneous Provisions) Act 1995 on 1 May 1996, the double actionability rule persists merely with regard to defamation claims. In the 14th edition of “*Dicey and Morris on the Conflict of Laws*”, this principle has therefore been described as the basis of clause (2) of Rule 235 as follows: “As a general rule, an act done in a foreign country which is alleged to give rise to a liability such as is mentioned in clause (1) of this Rule is actionable as such in England, only if it is both (a) actionable as such according to English law (or in other words is an act which, if done in England, would give rise to such a claim) and (b) actionable according to the law of the foreign country where it was done.” (cf. Collins 2006 (*Dicey and Morris*), para. 35R-123).

<sup>110</sup> Kieninger (1998)47(4) GRUR Int. 280, at p. 285; Hye-Knudsen 2005, p. 16.

<sup>111</sup> Kieninger (1998)47(4) GRUR Int. 280, at p. 285; Hye-Knudsen 2005, p. 16.

It is noteworthy that the *double-actionability rule* has been abolished<sup>112</sup> – except from the determination of issues arising in any defamation claim<sup>113</sup> – by Section 10 of the Private International Law (Miscellaneous Provisions) Act 1995<sup>114</sup> which provides:

#### Section 10

The rules of the common law, in so far as they –

(a) require actionability under both the law of the forum and the law of another country for the purpose of determining whether a tort or delict is actionable; or

(b) allow (as an exception from the rules falling within paragraph (a) above) for the law of a single country to be applied for the purpose of determining the issues, or any of the issues, arising in the case in question,

are hereby abolished so far as they apply to any claim in tort or delict which is not excluded from the operation of this Part by section 13 below.

#### 1.4.2.1.3 Jurisdiction of English courts where the Brussels Ibis Regulation (respectively its predecessors) applies (respectively apply)

The negative attitude of English courts towards a decision in proceedings on the infringement of a foreign intellectual property right has been given up in relation to proceedings within the scope of the Brussels Convention respectively the Brussels I Regulation/Brussels Ibis Regulation. This change of view became manifest for the first time in the decisions in the *Pearce v Ove Arup* case.

In this case regarding a foreign copyright, *Justice Lloyd* decided that English courts do have jurisdiction when being conferred jurisdiction upon by the Brussels Convention, because the effectiveness of the Brussels Convention would be impaired otherwise. In particular, he held that

“(...) the [Brussels] Convention does require an English court to accept jurisdiction where an action is brought against an English domiciled defendant (with or without other defendants) for breach of a Dutch copyright, and to hear that action on the merits, and thus overrides, so far as is necessary for that purpose, both Rule 203 [in: Dicey and Morris, The Conflict of Laws, Volume 2, 12<sup>th</sup> ed., 1993] and the Moçambique rule, even though neither of them is a rule as to jurisdiction. Each of them, to the extent that they would preclude the English court from hearing such an action, would in my judgment impair the effectiveness of the Convention by frustrating the operation of the basic rule in Article 2, and must therefore give way in order to allow the jurisdictional rules of the Convention to have their proper effect. The position is quite different from other exclusionary rules, such as Acts of State, because the Rule 203 and the Moçambique rule proceed on the clear premise that the English courts are not a suitable forum for such an action whereas the courts of another country are appropriate. It seems to me that, where that other country is another Contracting State, this is a position which subverts the policy and provisions of the Convention. To borrow a phrase from another area of Community law, although

<sup>112</sup> The result of the express abolition of the common law choice of law rules, except in relation to defamation claims, is a general choice of law rule requiring reference to the *lex loci delicti* which may, in an appropriate case, be displaced in favour of the law of another State by reference to the rule of displacement, cf. ss.11, 12 of the Private International Law (Miscellaneous Provisions) Act 1995, cf. Collins 2006 (Dicey and Morris), para. 35-002.

<sup>113</sup> Cf. Article 13 of the Private International Law (Miscellaneous Provisions) Act 1995; Collins 2006 (Dicey and Morris), para. 35-014.

<sup>114</sup> Section 10 of the Private International Law (Miscellaneous Provisions) Act 1995 is part of Part III of this Act. Part III entered into force on 1 May 1996.

they are not rules as to jurisdiction, they are “measures having an equivalent effect” to rules of jurisdiction, and are inconsistent with the mandatory effect of the Convention and its basic rules as to domicile-based jurisdiction in Article 2 [underscore and content in brackets added].”<sup>115</sup>

This decision was confirmed by the *Court of Appeal*. After an extensive review of the authorities, *Lord Justice Roch* concluded for the court:

“For the reasons which we have set out we are satisfied that the Moçambique rule does not require the English court to refuse to entertain a claim in respect of the alleged infringement of Dutch copyright; and that, in those circumstances, the court is not required by the first limb of the double actionability rule to hold that the claim is bound to fail because the acts done in Holland cannot amount to an infringement of United Kingdom copyright [underscores added].”<sup>116</sup>

These considerations as to jurisdiction of English courts for proceedings with regard to the infringement of a foreign copyright were applied in the *Coin Controls* case on the infringement of a foreign patent. By reference to the Schlosser Report and the statement contained therein that the doctrine of *forum (non) conveniens* developed in common law may not be applied with regard to the Brussels Convention (and the same applies to the Brussels I Regulation), *Justice Laddie* held in this decision:

“One of the purposes of the [Brussels] Convention is to replace the differing domestic rules, at least in relation to forum, by a simple set of rigid provisions forcing litigation into the courts of one country and out of the courts of others. As the Schlosser Report states:

... in accordance with the general spirit of the 1968 Convention, the fact that foreign law has to be applied, either generally or in a particular case, should not constitute a sufficient reason for a court to decline jurisdiction. Where the courts of several States have jurisdiction, the plaintiff has deliberately been given a right of choice, which should not be weakened by application of the doctrine of *forum conveniens*.

(...) (If the Convention requires the courts here to accept the foreign claims, then the same rules apply to other Contracting States and none of us have the power or right to ignore or override it. If the Convention gives jurisdiction to the courts of one country, they cannot reject the gift. They must accept it and act on it [content in brackets added].”<sup>117</sup>

Noteworthy, the considerations undertaken in *Pearce v Ove Arup* and *Coin Controls* explicitly and exclusively referred to the Brussels Convention, underlining the fact that the provisions of the Brussels Convention (and the same goes for the Brussels Ibis Regulation) must be applied in a way that ensures the effectiveness of the Convention (Brussels Ibis Regulation). Due to this immediate reference of the employed reasoning to the rules of the Brussels Convention (Brussels Ibis Regulation), it is to be expected that English courts will continue to deny jurisdiction in cases of infringement of foreign intellectual property rights where the Brussels regime is not applicable,<sup>118</sup> although parts of English legal doctrine have submitted that, also in such cases, denying jurisdiction to the English courts is not justified.<sup>119</sup>

---

<sup>115</sup> High Court of Justice (Chancery Division) 7 March 1997, *Gareth Pearce v Ove Arup Partnership Ltd and Others*, [1997] F.S.R. 641, 653-654 – *Pearce I*.

<sup>116</sup> Court of Appeal 21 January 1999, *Gareth Pearce v Ove Arup Partnership Ltd*, [1999] F.S.R. 525, 562 – *Pearce II*.

<sup>117</sup> High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suzo International (U.K.) Limited and Others*, [1997] F.S.R. 660, 671 – *Coin Controls*.

<sup>118</sup> Cf. Hye-Knudsen 2005, p. 16, while Hye-Knudsen does not mention that the double-actionability rule has already been abolished by Section 10 of the Private International Law Act 1995.

<sup>119</sup> Collins 2006 (Dicey and Morris), para. 35-032; Fawcett & Carruthers 2008 (Cheshire, North & Fawcett), p. 490; Fawcett & Torremans 2011, paras. 5.240, 6.209 and 6.255.

### 1.4.2.2 Court decisions in France

Like courts in England, French courts, by reference to the principle of territoriality<sup>120</sup>, the French *ordre public*<sup>121</sup> and the legal notion of *service public* (to be understood as comprising all acts of public authority)<sup>122</sup>, originally assumed to have exclusive jurisdiction (not only regarding validity proceedings but also) with regard to infringement proceedings concerning French patents, denying jurisdiction of foreign courts for actions concerning French patents, and equally denied jurisdiction of French courts with regard to foreign patents as a matter of assumedly exclusive jurisdiction of the respective foreign courts.<sup>123</sup> While few progressive legal commentators at least advocated, already before World War I, jurisdiction of French courts for infringement actions concerning foreign patents – whereas it was not contested that French patents would have exclusive jurisdiction as to infringement actions concerning French patents<sup>124</sup> – the majority of legal commentators shared the strict and clear opinion of the courts that French courts may only, and exclusively, decide on French patents.<sup>125</sup>

The argumentation of the French courts (and the majority of legal commentators) shall be illustrated by the decision of the *Tribunal de grande instance de Paris* in the *Yema* case from 1971, where the court, in order to establish exclusive jurisdiction for infringement proceedings concerning a foreign patent, expressly referred to the aspects of *ordre public interne* and the fact that the grant of a French patent was to be considered a French act of authority. The court stated:

“Attendu que l'octroi du brevet nécessaire à l'exercice des droits de l'inventeur est un acte de concession émanant des pouvoirs publics dont l'intervention détermine, en droit international privé, la solution des conflits de lois en la matière; qu'un service public ne pouvant fonctionner que selon les lois qui l'instituent, les litiges nés de ce fonctionnement à l'occasion de la délivrance d'un brevet français sont nécessairement de la compétence des juridictions françaises assurant le maintien de l'ordre public interne qui prime en l'occurrence toutes autres considérations.”<sup>126</sup>

(“The grant of the patent which is a prerequisite for the use of the inventor's rights is an act of public authority whose intervention determines, in matters of private international law, the solution of the respective conflicts of law. A public service can only operate according to the laws which establish it. Disputes arising from this operation on the occasion of issuing a French patent necessarily fall within the competence of French jurisdiction ensuring to maintain the internal public order (*ordre public interne*) which predominates in this case all other considerations.”)<sup>127</sup>

However, this decision has been subject to considerable criticism, in particular concerning the court's reference to the aspect of *ordre public*.<sup>128</sup> Nowadays, French courts assume to have international jurisdiction to decide on the infringement of foreign patents according to the local rules of jurisdiction pursuant to Articles 42 et seq. of the Nouveau code de procédure civile (New Code of Civil Procedure).<sup>129</sup> It has been accepted as a general rule that the

<sup>120</sup> Cf. Vivant 1977, paras. 258-274; Treichel 2001, p. 12.

<sup>121</sup> Cf. Treichel 2001, p. 12; Loussouarn, Bourel & Vareilles-Sommières 2013, para. 695.

<sup>122</sup> Treichel 2001, p. 12.

<sup>123</sup> Treichel 2001, p. 12, and there fns. 9 and 10 with comprehensive references to French case-law.

<sup>124</sup> Hye-Knudsen 2005, p. 14; Treichel 2001, p. 13.

<sup>125</sup> Treichel 2001, pp. 12-13; Hye-Knudsen 2005, pp. 13-14; Mousseron, Raynard & Véron (1998)29(8) IIC 884, at p. 888.

<sup>126</sup> TGI Paris 4 May 1971, (1974)63 Rev. crit. DIP 110, at p. 111, with case note G. Bonet – *Yema*.

<sup>127</sup> Translation provided by the author of this thesis.

<sup>128</sup> G. Bonet (case note) TGI Paris 4 May 1971, (1974)63 Rev. crit. DIP 112, at p. 117 – *Yema*.

<sup>129</sup> Treichel 2001, p. 13 et seq.

principle of territoriality has no longer any effect on the issue of international jurisdiction with regard to intellectual property rights.<sup>130</sup>

### 1.4.2.3 Court decisions in Germany

In its *Lampen* decision in 1890, the German *Reichsgericht* impressively explicated that German courts would not have jurisdiction with regard to infringement proceedings concerning English patents. The court made clear that according to its view, the fact that the effects of English patents were restricted to the territory of England would lead to the consequence that only English courts would have jurisdiction as to (infringement) actions concerning English patents. In this respect, the court held:

“Da das englische Patent nur für England erteilt ist und nur für England erteilt werden konnte, so können Kläger einen Anspruch auf Schutz des ihnen für England erteilten Patents auch nur in England erheben.”<sup>131</sup>

(“As the English patent is granted only for England, and could only be granted for England, plaintiffs can only claim protection of their patent granted for England in England.”)<sup>132</sup>

Thus, the court concluded from the principle of territoriality according to which an English patent is protected only in England that this fact is inevitably linked with the issue of jurisdiction. The court continued distinctly:

“Dem deutschen Richter ist auch in dem Falle, wenn zufällig bei ihm ein Gerichtsstand begründet wäre, nicht anzunehmen, etwa auf die Klage eines Engländers gegen einen Engländer, welcher im deutschen Gerichtsbezirk Vermögen hat, einen Anspruch dahin zu thun, daß sich der Beklagte in England der gewerblichen Herstellung und Veräußerung von Werkzeugen oder Maschinen zu enthalten habe, welche dem Kläger durch ein englisches Patent patentiert seien.”<sup>133</sup>

(“The German court, even in case that incidentally a venue was founded, may not be demanded to decide with regard to an action raised by an Englishman against another Englishman who disposes of assets in the German court district, by which the plaintiffs seeks to have the defendant convicted to refrain from commercial manufacture and distribution of tools or machinery for which the plaintiff has an English patent.”)<sup>134</sup>

Despite the general existence of protection of patent rights both in the English and in the German legal system, the *Reichsgericht* explicated, by underlining the absence of a unitary right respectively protection:

“Man darf nicht aus den verschiedenen Patentgesetzen der einzelnen Kulturstaaen einen allgemeinen Satz ableiten, es werde das Erfinderrecht geschützt. Ein solcher allgemeiner Satz wäre nur eine Abstraction, welche nicht geeignet ist das, was sich in verschiedenen Gesetzgebungen Gleichmäßiges findet, zu einem gemeinsamen Recht zu machen. (...) In diesem Sinne ist, – man mag es beklagen, – das Erfinderrecht zu einem gemeinsamen Rechtsinstitut der Kulturstaaen noch nicht geworden, und der Richter kann es dazu nicht machen. (...) Erst wenn Staatsverträge dahin führen, daß Patente, welche in dem einen Staate erteilt sind, auch für das Gebiet der anderen Staaten als erteilt gelten, würde sich das Patentrecht als ein den kontrahierenden Staaten gemeinsames Rechtsinstitut ansprechen lassen, so

---

<sup>130</sup> Treichel 2001, p. 14, with further references.

<sup>131</sup> RG 18 June 1890, Case No. 107/90 I, (1890)19(32-33) JW 280, at p. 281 – *Lampen*.

<sup>132</sup> Translation provided by the author of this thesis.

<sup>133</sup> RG 18 June 1890, Case No. 107/90 I, (1890)19(32-33) JW 280, at p. 281 – *Lampen*.

<sup>134</sup> Translation provided by the author of this thesis.

daß dann ein dem Staate, welcher das Patent verliehen hat, begangener Eingriff in das Patent in dem anderen Staat verfolgt werden könnte.”<sup>135</sup>

“One may not derive from the different patent laws of the individual “cultural States” a general rule that the inventor's right would be protected. Such a general rule would merely be an abstraction which is not suitable to form similar rights in the different legal systems into one common law. (...) In this sense, unfortunately, the inventor's right has not become a common legal institution of the “cultural States”, and the court cannot make it one. (...) Only when treaties determine that patents which have been granted in and for the one State are considered to be also granted for the territory of the other States, the patent law/the right of the patentee [due to the ambiguity of the German term “*Patentrecht*”, meaning both patent law in general and the personal right of the patentee, it is not clear which term the *Reichsgericht* actually referred to] could be addressed as a common legal institution of the Contracting States, so that an infringement of the patent, committed to the State which granted the patent, could be pursued in the other State.”<sup>136</sup>

The *Reichsgericht* abandoned this strict jurisprudence in 1931 with regard to trademark law in its *Norsk Vacuum Oil Compani* decision and decided that, concerning trademark law, the issue of whether a trademark is protected or not according to German law does not coincide with the issue of whether German courts have jurisdiction as to infringement proceedings regarding this trademark. The *Reichsgericht* held:

“Aus der Nichteintragung eines ausländischen Warenzeichens in der deutschen Zeichenrolle folgt nur, daß diesem Zeichen nicht der Schutz des deutschen Warenzeichenrechts zugute kommt. (...) Dagegen besteht kein Grund gegen die Zulässigkeit der Inanspruchnahme eines Inländers, der die Verletzungshandlung gegen ein nur in einem ausländischen Staate geschütztes Warenzeichen dort begangen hat, vor einem deutschen Gericht aus dem ausländischen Warenzeichengesetz.”<sup>137</sup>

“It can solely be derived from the non-registration of a foreign trademark in the German trademark register that this trademark is not protected according to German trademark law. (...) However, there is no reason against the admissibility of an action against a national who has committed in a foreign State the infringing act against a trademark that is merely protected in that foreign State, before a German court on the basis of that foreign trademark law.”<sup>138</sup>

In regard of trademarks, the *Bundesgerichtshof* continued this jurisprudence of the *Reichsgericht*. So, the *Bundesgerichtshof* decided in its *Flava/Erdgold* decision in 1956, emphasising, in particular, that the sovereignty of the foreign State would not be impaired by the jurisdiction of German courts because the judgment rendered in Germany would only have effects in Germany:

“Es ist seit langem in Rechtsprechung und Schrifttum anerkannt, daß ein Inländer mit inländischem Gerichtsstand, der die Verletzungshandlung gegen ein im ausländischen Staat geschütztes Warenzeichen dort begangen hat, vor einem deutschen Gericht auf Grund des ausländischen Warenzeichens auf Schadensersatz in Anspruch genommen werden kann. (...) Aber auch für Ansprüche auf Unterlassung der Verletzung von im Ausland bestehender Zeichenrechte, begangen im Auslande, muß die Verfolgung im Inland offenstehen. (...) Da das vom deutschen Gericht erwirkte Urteil nur Wirkungen im Inland erzeugt, bleibt die ausländische Souveränität unangetastet.”<sup>139</sup>

“It has been recognised for a long time by the courts and by legal commentators that, when there is a venue in Germany, a national who committed in a foreign State the infringing act against a trademark being protected in that foreign State, may be sued for damages before a German court on the basis of the foreign trademark. (...) But also regarding claims for omitting the infringement of foreign trademark

---

<sup>135</sup> RG 18 June 1890, Case No. 107/90 I, (1890)19(32-33) JW 280, at p. 281 – *Lampen*.

<sup>136</sup> Translation provided by the author of this thesis.

<sup>137</sup> RG 8 July 1930, Case No. 542/29 II, (1931)60(6-7) JW 428, at p. 429 – *Vacuum Oil*.

<sup>138</sup> Translation provided by the author of this thesis.

<sup>139</sup> BGH 2 October 1956, I ZR 9/54, (1957)59(5) GRUR 215, at p. 218 – *Flava/Erdgold*; cf. also BGH 24 July 1957, I ZR 21/56, (1958)60(4) GRUR 189, at p. 196 – *Zeiß*.

rights, committed abroad, it must be possible to sue the infringer in Germany. (...) As the judgment rendered by the German court produces effects only in Germany, the foreign sovereignty remains untouched.”<sup>140</sup>

However, in regard of patents, courts maintained the conception of a strict coherence between the principle of territoriality and jurisdiction, i.e. the idea of exclusive jurisdiction of the courts in the protection State. This is illustrated by the formulation of the *Reichsgericht* in its *Geschwindigkeitsmesser* decision from 1934 where the court held:

“Ebenso kommen Patentverletzungsansprüche nach feststehender Rechtsprechung (...) nicht in Betracht, soweit es sich um die Verfolgung von Ansprüchen wegen Verletzung ausländischer Patente im Ausland handelt.”<sup>141</sup>

(“Likewise, claims arising from patent infringement do not exist according to established case-law (...), as far as the assertion of claims arising from the infringement of foreign patents, committed abroad, is concerned.”)<sup>142</sup>

Another example can be found in the jurisprudence of the *Oberlandesgericht Hamm* which held in its *Einbruchkerbmaschine* decision:

“Für die Frage, ob die Klägerin als Lizenznehmerin eines allein auf den Namen N. lautenden englischen Patents der Beklagten die Einfuhr und den Vertrieb in England verbieten kann, sind die deutschen Gerichte nicht zuständig. Das gleiche würde gelten für die Frage, ob eine Herstellung von Einbruchkerbmaschinen in England, die die Beklagte bisher aber nicht vorgenommen hat und nach ihrer Angabe auch nicht vornehmen will, die Rechte der Klägerin aus dem englischen Patent Nr. 426966 verletzt.”<sup>143</sup>

(“With regard to the question of whether the plaintiff as a licensee of an English patent that is solely registered under the name N., may enjoin the defendant from importing and distributing (the concerned product) in England, German courts do not have jurisdiction. The same would apply to the question of whether a manufacture of “Einbruchkerbmaschinen” (specific machines) in England, which the defendant has not undertaken so far, and according to her assertion does not intend to undertake either, infringes the plaintiff’s rights based on the English patent No. 426966.”)<sup>144</sup>

However, step by step, courts advocated international jurisdiction of German courts also with regard to infringement proceedings concerning foreign patents: So, the *Landgericht Düsseldorf* stated in its *Hohlkörper* decision in 1958, although finally leaving open the question in the concrete case because the court did not find it necessary to be decided:

“Nachdem der BGH im Warenzeichenrecht für die deutschen Gerichte eine universelle Gerichtsbarkeit [annotation by the author of this thesis: the court chose the wrong term; the correct term would be “internationale Zuständigkeit”] in Anspruch nimmt, sind keine zwingenden Gründe mehr zu erkennen, weshalb für das Patentrecht der entgegengesetzte Standpunkt aufrechterhalten werden sollte.”<sup>145</sup>

(“As the BGH assigns, in trademark law, universal jurisdiction to German courts, no compelling reasons remain why the opposite point of view should be maintained for patent law.”)<sup>146</sup>

Even clearer, and not rendered as an *obiter dictum*, the *Landgericht Düsseldorf* expressed its liberal view in its *Frauenthermometer* decision in 1966:

---

<sup>140</sup> Translation provided by the author of this thesis.

<sup>141</sup> RG 6 June 1934, Case No. I. 243/33, (1934)39(11) GRUR 657, at p. 664 – *Geschwindigkeitsmesser*.

<sup>142</sup> Translation provided by the author of this thesis.

<sup>143</sup> OLG Hamm 29 January 1936, 3 U 143/35, (1936)41(9) GRUR 744, at 745-746 – *Einbruchkerbmaschine*.

<sup>144</sup> Translation provided by the author of this thesis.

<sup>145</sup> LG Düsseldorf 18 March 1958, (1958)7(8/9) GRUR Int. 430, at p. 430 – *Hohlkörper*.

<sup>146</sup> Translation provided by the author of this thesis.



“Die deutsche Gerichtsbarkeit [annotation by the author of this thesis: the court obviously chose the wrong term; the correct term would be “internationale Zuständigkeit”] ist auch insoweit begründet, wie die Klage auf die Verletzung ausländischer Patent- und Gebrauchsmusterrechte (...) gestützt wird. Das frühere Reichsgericht (...) hat zwar insoweit im Hinblick auf die territorial begrenzte Geltung der Patent- und Gebrauchsmusterrechte einen abweichenden Standpunkt vertreten. Die Bedenken des Reichsgerichts sind jedoch zumindest auf dem verwandten Rechtsgebiet des Warenzeichenrechts (für das das Territorialitätsprinzip in gleicher Weise gilt) von Rechtsprechung und herrschender Lehre als nicht durchschlagend erkannt worden (...). Für das Gebiet des Patent- und Gebrauchsmusterrechts kann nichts anderes gelten. Jeder Staat erkennt an, daß andere Staaten Warenzeichen und technische Schutzrechte mit Wirkung für ihr Staatsgebiet erteilen können. Eine Anerkennung dieser Schutzrechte durch die Gerichte eines anderen Staates kann dem Verleihungsstaat nur recht sein, und ein Eingriff in die fremde Souveränität liegt schon deshalb nicht vor, weil das vor einem deutschen Gericht erwirkte Urteil nur Wirkungen im Inland erzeugt. (...) Es ist daher gerechtfertigt, die deutsche Gerichtsbarkeit [internationale Zuständigkeit; cf. annotation above] auch für Klagen aus ausländischen Patent- oder Gebrauchsmusterrechten zu bejahen, sofern ein inländischer Gerichtsstand besteht [content in brackets added]. (...)”<sup>147</sup>

(“International jurisdiction of German courts also exists insofar as the action is founded on the infringement of foreign patent and utility model rights (...). The former Reichsgericht (...), with regard to the territorially restricted validity of patents and model rights, indeed held a deviating point of view. However, the concerns of the Reichsgericht have, at least regarding the related legal area of trademark law (to which the principle of territoriality equally applies), have been found not convincing by courts and prevailing legal doctrine (...). For the field of patent and model right law nothing else can apply. Each State recognises that other States can grant trademarks and intellectual property rights being effective for the territory of the granting State. A recognition of these intellectual property rights by the courts of another State can only lie in the interest of the granting State, and there is no infringement of the foreign sovereignty, because the judgment rendered by a German court has only effect in Germany. (...) Therefore it is justified to approve international jurisdiction of German courts also with regard to actions concerning foreign patent or utility model rights, as far as there is a venue in Germany. (...)”<sup>148</sup>

#### 1.4.2.4 Court decisions in the Netherlands

Initially, Dutch courts, similarly to the English, French and German courts, clearly denied to have jurisdiction concerning actions as to the infringement of foreign intellectual property rights as patents. A famous decision which illustrates this attitude is the decision rendered by the *Rechtbank Amsterdam* in the *Fokker* case in 1926.<sup>149</sup> The decision was based on the following facts:<sup>150</sup>

The Dutch aircraft manufacturer A.H.G. Fokker (F) who had his domicile in Germany during World War I was sued for damages, in Germany, by the Luft-Verkehrs-Ges.m.b.H. (L), a German company, for the alleged infringement of a German patent belonging to L. However, when the deciding court finally rendered a judgment, after several years of proceeding, and convicted F to pay damages to L as demanded, F had already moved back to the Netherlands. In the absence of a treaty between the Netherlands and Germany on the mutual recognition and enforcement of judgments, the German judgment could not be enforced in the Netherlands. Therefore, L sued F for damage again, in Amsterdam in the Netherlands, for infringing L's German patent by an infringing act in Germany. F, denying any patent

<sup>147</sup> LG Düsseldorf 27 October 1966, 4 O 127/63, (1968)17(3) GRUR Int. 101, at p. 102 – *Frauenthermometer*; cf. also OLG Düsseldorf 25 March 1966, 2 U 93/65, (1968)17(3) GRUR Int. 100 – *Kunststofflacke*.

<sup>148</sup> Translation provided by the author of this thesis.

<sup>149</sup> Rb. Amsterdam 25 January 1926, Luft-Verkehrs-Ges. m. b. H. (Germany) v A. H. G. Fokker (Netherlands), with case note C.D. Salomonson, (1928)33(1) GRUR 25 – *Fokker*.

<sup>150</sup> Adopted from: Case note C.D. Salomonson Rb. Amsterdam 25 January 1926, Luft-Verkehrs-Ges. m. b. H. (Germany) v A. H. G. Fokker (Netherlands), (1928)33(1) GRUR 25, at pp. 25-26 – *Fokker*; cf. also Hye-Knudsen 2005, pp. 12-13.

infringement, also argued that even if F's acting in Germany was to be considered an infringement of L's German patent, such acting would not be unlawful in the Netherlands and the holder of a German patent would not be entitled to claim damages for the alleged infringement of this German patent before a foreign court. The *Rechtbank Amsterdam* essentially agreed with the defendant's argumentation. On the one hand, the *Rechtbank* explicated that, when a Dutch committed an unlawful act (tort) against a German in Germany, a Dutch court principally has jurisdiction for an action brought by the German (victim) against the Dutch (infringer). But, on the other hand and essential for this case, the *Rechtbank* expressed its view that the case of a patent infringement was to be treated differently: the court concluded from the fact that the patent was protected on a territorial basis without any extraterritorial effect, i.e. only in Germany in the concrete case, that Dutch courts lack jurisdiction to decide on an action concerning such a foreign patent, because they are situated outside the sphere of protection of the German patent. The *Rechtbank Amsterdam* thus assumed that the principle of territoriality and the question of international jurisdiction are inevitably linked with each other.

This restrictive jurisprudence was given up in the *Interlas* case ultimately decided by the *Hoge Raad* in 1989.<sup>151</sup> In this case (which is considered to be the first example of a decision ordering extraterritorial prohibitory measures, while it actually merely confirmed the earlier case-law, but was the decision to which the courts referred to in subsequent decisions, including decisions in patent infringement cases)<sup>152</sup> an American company, a French company and a Dutch company sued another Dutch company established in Middelburg.<sup>153</sup>

In its decision, the *Hoge Raad* held decisively:

“Tenzij uit de wet, uit de aard van de verplichting of uit een rechtshandeling anders volgt, wordt hij die jegens een ander verplicht is iets te geven, te doen of na te laten, daartoe door de rechter, op vordering van de gerechtigde, veroordeeld. In het algemeen is er geen reden om aan te nemen dat er voor zulk een veroordeling geen plaats is wanneer het gaat om een verplichting – eventueel een verplichting naar vreemd recht – die buiten Nederland moet worden nagekomen.

Een meer beperkte opvatting als door het onderdeel verdedigd vindt geen steun in het recht en zou in een tijd van toenemende internationale contacten tot het voor de praktijk onwenselijke resultaat leiden dat in geval van onrechtmatige daden met een internationaal karakter – zoals aantasting van intellectuele eigendomsrechten en ongeoorloofde mededinging in meer landen of grensoverschrijdende milieuvervuiling – de Nederlandse gelaedeerde genoopt zou kunnen worden zich in alle betrokken landen tot de rechter te wenden.”<sup>154</sup>

(“Unless anything else follows from the law, the nature of the obligation or from a juridical act, a person who is obliged towards somebody to give something, to do or not to do something will be ordered to do so by the judge on demand of the person to whom the obligation is owed. In general there is no reason to assume that such an order cannot be given when the case is about an obligation – possibly an obligation under the law of a foreign country – which has to be fulfilled outside the Netherlands.

A more restricted vision finds no support in law and would, at a time of increasing international contacts, lead to the undesirable result for the practice, that in the case of torts with an international character – like infringement of intellectual property rights and unfair competition in several countries,

---

<sup>151</sup> HR 24 November 1989, Focus Veilig BV (*Interlas*) (Netherlands) v The Lincoln Electric Co. (US) and Others, NJ 1992, 404 – *Interlas*.

<sup>152</sup> Nuyts, Szychowska & Hatzimihail 2008, p. 10 and there fn. 27 with further references.

<sup>153</sup> Cf. Brinkhof BIE 1991, 66, at p. 69.

<sup>154</sup> HR 24 November 1989, Focus Veilig BV (*Interlas*) (Netherlands) v The Lincoln Electric Co. (US) and Others, NJ 1992, 404, para. 4.2.4 – *Interlas*.

or environmental pollution crossing borders – the Dutch injured party would be compelled to go to court in every country concerned.”)<sup>155</sup>

On the basis of this jurisprudence, Dutch courts have liberally assumed jurisdiction for actions for damages and for prohibitory actions concerning the infringement of foreign intellectual property rights.<sup>156</sup> However, this practice was often considered as going too far and has therefore been subject to fierce criticism.<sup>157</sup> In view of and in reaction to this criticism, the *Gerechtshof 's-Gravenhage* considerably limited the said practice of assuming jurisdiction too generously in its famous *Expandable Grafts* decision in 1998.<sup>158</sup> It is noteworthy that the *Hoge Raad* confirmed and further elaborated the *Interlas* doctrine in its later *Postech* decision explicitly with regard to intellectual property rights,<sup>159</sup> stating:<sup>160</sup>

“(…) Bij de behandeling van dit onderdeel dient te worden vooropgesteld dat, indien de Nederlandse rechter op grond van enige regel van (commuun) internationaal bevoegdheidsrecht bevoegd is kennis te nemen van een vordering betreffende de inbreuk op een naar buitenlands recht verkregen intellectueel eigendomsrecht, hij desgevorderd in beginsel een verbod kan uitspreken van handelingen in het buitenland. Dit geldt ook in kort geding en ongeacht de grond waarop de Nederlandse rechter zijn internationale bevoegdheid heeft gebaseerd (...).<sup>161</sup>

“(…) When treating this part it is to be premised that, if the Dutch court, on the basis of a rule of (Community) law of international jurisdiction, is competent to decide on a claim concerning the infringement of an intellectual property right that is acquired according to foreign law, it can, in principle, order an injunction concerning actions abroad. This also applies in the case of “kort geding” and notwithstanding the ground on which the Dutch court has based its international jurisdiction (...).”<sup>162</sup>

#### 1.4.2.5 Conclusion

It may thus be concluded that the courts of all selected States (with regard to English courts at least where the Brussels Ibis Regulation is applicable) accept to have international jurisdiction for infringement actions also in case that foreign patents are effected. Legal doctrine generally acknowledges that courts have international jurisdiction for infringement proceedings for damages and claims for prohibition concerning foreign patents and other intellectual property rights.<sup>163</sup> Due to the fact that exclusive jurisdiction according to Article 24(4) of the Brussels Ibis Regulation (respectively its predecessors) merely affects validity actions, it can be concluded *a contrario* that infringement actions do not fall within the scope of exclusive jurisdiction. As a consequence, Member States courts may not deny international jurisdiction for infringement actions in case of the infringement of a foreign patent as far as the Brussels

<sup>155</sup> Translation provided by *Brinkhof*, cf. *Brinkhof* (1994)16(8) E.I.P.R. 360, at p. 361.

<sup>156</sup> Cf. *Brinkhof* (1994)16(8) E.I.P.R. 360, at pp. 360-361.

<sup>157</sup> *Bertrams* (1995)44(3) GRUR Int. 193, at p. 201; *Brinkhof* (1997)46(6) GRUR Int. 489, at p. 497; *Von Meibom & Pitz* (1998)47(10) GRUR Int. 765, at p. 767.

<sup>158</sup> *Gerechtshof 's-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352, 359 – *Expandable Grafts Partnership II*; cf. *Von Meibom & Pitz* (1998)47(10) GRUR Int. 765, at p. 767 et seq.

<sup>159</sup> *Schaafsma* 2011, p. 436.

<sup>160</sup> For a deepened analysis of the development from *Interlas* to *Postech*, cf. *Schaafsma* 2011.

<sup>161</sup> HR 19 March 2004, C02/110HR, *Koninklijke Philips Electronics N.V. v Postech Corporation and Others*, NJ 2007, 585, para. 3.4.3, with case note P. Vlas – *Postech*.

<sup>162</sup> Translation provided by the author of this thesis.

<sup>163</sup> *Peinze* 2002, p. 61; *Von Meibom & Pitz* (1996)87(7) Mitt. 181, at p. 182 (= *Von Meibom & Pitz* (1997)19(8) E.I.P.R. 469, at p. 469); *Fezer & Koos* 2010 (*Staudinger*), paras. 1128-1130; *Kieninger* (1998)47(4) GRUR Int. 280, at p. 290; *Neuhaus* (1996)87(9) Mitt. 257, at p. 261; *Hye-Knudsen* 2005, p. 10.

Ibis Regulation is applicable.<sup>164</sup> The principle of territoriality, as a principle of substantive law, does not lead to another result, because it merely affects the substantive limitation of the patent, but does not determine in which State patent disputes are to take place.<sup>165</sup>

---

<sup>164</sup> Hye-Knudsen 2005, p. 10; Lundstedt (2001)32(2) IIC 124, at p. 124 (= (2001)50(2) GRUR Int. 103, at p. 103).

<sup>165</sup> Adolphsen (2006)11 ZZPInt 137, at p. 155.

## CHAPTER 2

## 2. International jurisdiction with regard to patent infringement proceedings according to the Brussels Ibis Regulation

The Brussels Ibis Regulation applies regardless of which type of patent (national patent, European patent or (future) European patent with unitary effect) is concerned. However, it is to be mentioned that the case-law and the opinions of legal doctrine referred to in this chapter have been rendered with regard to national patents and “classical”<sup>166</sup> European patents as bundles of national patents.<sup>167</sup>

Within the system of the Brussels Ibis Regulation, jurisdiction for patent infringement proceedings may be always based on Article 4(1) of the Brussels Ibis Regulation. Other heads of jurisdiction for cross-border patent infringement proceedings may be (on the assumption that the prerequisites discussed in detail in this chapter are fulfilled) Articles 7(2) and 8(1) of the Brussels Ibis Regulation. In case that the defendant raises the defence of invalidity of the concerned patent, Article 24(4) of the Brussels Ibis Regulation determines that the courts of the protection State have exclusive jurisdiction with regard to a decision on the validity of the patent. Finally, concerning cross-border interim relief, Article 35 of the Brussels Ibis Regulation contains a specific provision.<sup>168</sup>

The Brussels Ibis Regulation replaced the Brussels I Regulation which had followed the Brussels Convention. In parallel to the Brussels Convention, the Lugano Convention was signed by the EC Member States and the EFTA Member States (without Liechtenstein) in 1988. The Lugano Convention which largely corresponds to the Brussels Convention<sup>169</sup> was subsequently replaced by its recast, the 2007 Lugano Convention, which aimed to bring in line the Lugano Convention with the Brussels I Regulation.<sup>170</sup>

In opposition to the Brussels Convention, there is no interpretative body under the Lugano

---

<sup>166</sup> In this thesis, the terms “classical” European patent and “ordinary” European patent are used as synonyms for such European patents which lack a unitary effect. If the bare term “European patent” is employed, it also generally refers to such a European patent without unitary effect.

<sup>167</sup> Since the Brussels Ibis Regulation has only been applicable since 10 January 2015, replacing the Brussels I Regulation, the case-law and the opinions of legal doctrine cited in this thesis have for the utmost part been produced, at the European level, under the Brussels Convention and the Brussels I Regulation. With regard to the Lugano Convention that was originally constructed parallel to the Brussels Convention, it is to be noted that the recast of the Lugano Convention, the 2007 Lugano Convention, differs from the Brussels I Regulation and the Brussels Ibis Regulation.

Unless indicated otherwise for reasons of correctness and clearness, all Articles referred to in this chapter of the thesis are those of the Brussels Ibis Regulation. Due to the fact that the provisions of the Brussels Convention, the Brussels I Regulation and the Brussels Ibis Regulation that are relevant in the framework of this thesis are very similar to a considerable extent (or are partly even almost identical), I shall refer to the existing case-law and legal doctrine as to the Brussels Convention and the Brussels I Regulation when discussing and analysing relevant Articles of the Brussels Ibis Regulation. This is even more justified given that Recital 34 in the preamble to the Brussels Ibis Regulation postulates continuity between the Brussels Convention, the Brussels I Regulation and the Brussels Ibis Regulation, in particular with regard to the interpretation by the ECJ of the said Convention and Regulations. When discussing and analysing specific issues, I shall, for reasons of clarity and comprehensibility, refer to the respective provisions of the Brussels Ibis Regulation, unless specific problems merely arose under the Brussels Convention or the Brussels I Regulation, respectively when referring to case-law specifically based on, or legal doctrine developed with regard to one of these sets of rules. However, when certain findings and conclusions are still applicable with regard to successors (Brussels I Regulation and Brussels Ibis Regulation), all relevant provisions are cited.

<sup>168</sup> As shall be shown in detail in this chapter, jurisdiction for provisional measures may also exist as “accessory jurisdiction” of courts which have jurisdiction on the merits.

<sup>169</sup> With regard to patent infringement proceedings, Articles 2(1), 5(3), 6(1) and 16(4) of the Lugano Convention may be relevant, cf. also Tritton 2008, para. 14–111.

<sup>170</sup> Kropholler & Von Hein 2011, Einl EuGVO, para. 10.

Convention which gives binding judgments on the Lugano Convention. Noteworthy, the authors of the Lugano Convention aimed to overcome this problem and the dangers of the development of diverging jurisprudence on the Lugano Convention in the Lugano States and between substantially similar provisions in the Brussels and Lugano Conventions being interpreted differently by the ECJ and the Lugano States by legislating a number of Protocols and Declarations constituting an integral part of the Lugano Convention.<sup>171</sup> In particular, according to Protocol 2, the courts of the Lugano States must pay “due account” to the principles laid down by any relevant decision delivered by courts of the other contracting States concerning provisions of the Lugano Convention. Moreover, the EFTA Member States declared that they consider it appropriate that the courts pay “due account” to the rulings contained in the ECJ and courts of the Member States in respect of provisions in the Brussels Convention which are substantially reproduced in the Lugano Convention.<sup>172</sup> On the other hand, the EC Member States declared that they considered it appropriate that the ECJ, when interpreting the Brussels Convention, should pay “due account” to the rulings under the Lugano Convention.<sup>173</sup> In light of this, the jurisprudence of the ECJ and EU Member States courts as to the Brussels Convention respectively the Brussels I Regulation is also relevant for the interpretation of corresponding provisions of the Lugano Convention, and *vice versa*. Consequently, although this thesis primarily treats the Brussels regime, I shall also refer to decisions rendered with regard to provisions of the Lugano Convention which correspond to provisions of the Brussels Convention/Brussels I(bis) Regulation, when analysing provisions of the latter sets of rules.

## 2.1 Jurisdiction at the domicile of the defendant – Article 4(1)

The fundamental principle<sup>174</sup> of *actor sequitur forum rei*, laid down in Article 4(1) of the Brussels Ibis Regulation, states:

### Article 4(1) of the Brussels Ibis Regulation

Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.<sup>175</sup>

As the ECJ has expressly ruled in *Josi Reinsurance*, persons shall principally be sued in their State of domicile because this makes it easier, in principle, for them to defend themselves.<sup>176</sup> According to Article 62, the question of whether a party is domiciled in the Member State whose courts are seised of a matter is answered on the basis of the *lex fori*. In contrast to this construction, the Regulation chooses a different solution in the case of companies, other legal persons or associations of natural or legal persons. For these constellations, Article 63 contains an autonomous rule to determine the domicile: the domicile is considered to be situated at the place of the statutory seat, the central administration, or the principal place of

<sup>171</sup> Cf. Article 65 of the Lugano Convention; cf. Tritton 2008, para. 14–113.

<sup>172</sup> Tritton 2008, para. 14–113.

<sup>173</sup> Tritton 2008, para. 14–113.

<sup>174</sup> Mankowski even speaks of “Grundphilosophie“, cf. Mankowski 2011 (Rauscher), Art 2 Brüssel I-VO, para. 1.

<sup>175</sup> The wording of Article 4(1) is identical with the wording of Article 2(1) of the Brussels I Regulation.

<sup>176</sup> ECJ 13 July 2000, C-412/98, Group Josi Reinsurance Company SA v Universal General Insurance Company (UGIC), [2000] ECR I-05925, para. 35 – *Josi Reinsurance*. Cf. also ECJ 17 June 1992, C-26/91, Jakob Handte & Co. GmbH v Traitements Mécano-chimique des Surfaces SA (TMCS), [1992] ECR I-03967, para. 14 – *Handte*.

business. It must be noticed that Article 4(1) merely regulates the international jurisdiction and does not guarantee that a specific local court in the State of domicile is competent.

It shall not be concealed that it has been doubted in the past that Article 4(1) (respectively its predecessors) is applicable to patent infringement proceedings, because the link between patent infringement litigation and the question of validity of the patent was considered to be so close that the specific provision of Article 24(4) (respectively its predecessors) containing a special rule for proceedings concerned with the registration or validity of patents would also be applicable to infringement proceedings.<sup>177</sup> However, that opinion is not convincing. The wording of Article 24(4) reveals clearly its limitation to the aspects of registration and validity of patents. Therefore, the prevailing opinion correctly draws the *a contrario*-conclusion that infringement proceedings should not be covered by Article 24(4).<sup>178</sup>

Another issue which has been raised is whether Article 4(1) (respectively its predecessors) only confers jurisdiction in the case of national patents of EU Member States and European patents – with regard to those patents there is no dispute nowadays<sup>179</sup> – or also applies to infringement actions concerning patents which are granted by and for non-Member States. So, it has been put forth that the Brussels Ibis Regulation (respectively its predecessors) would not be applicable to proceedings dealing with such patents, because there was no sufficient connection to justify the application of the Brussels Ibis Regulation (respectively its predecessors). In analogy to Article 6(1) (respectively its predecessors), national law should therefore be decisive for the question of international jurisdiction because the Regulation would not be applicable.<sup>180</sup> However, this interpretation fails because it is based on a misinterpretation of the system of competences in the Regulation: the domicile of the defendant being the *decisive* factor in that system of competences, the Regulation even does not contain or claim another criterion than the missing domicile of the defendant. Moreover, actions concerning patents granted in non-Member States do not leave the scope of civil and commercial matters (cf. Article 1(1)) either.<sup>181</sup> Courts of the State where the domicile of the defendant is situated thus having international jurisdiction for patent infringement proceedings according to Article 4(1), it is to be underlined that this competence is comprehensive, meaning that the issue may be decided under consideration of all relevant aspects and concerning all actions.<sup>182</sup>

---

<sup>177</sup> Cf. the comments of the French and United Kingdom Governments in the *GAT* case, referred to in the Opinion of the Advocate General, cf. Advocate General 16 September 2004, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, paras. 18-19 – *GAT*: “(...) The applicability of Article 16(4) of the Brussels Convention to infringement actions can prevent conflicting judgments and is therefore in the interests of legal certainty (...)”; Reichardt 2006, pp. 54-57; Adolphsen (2007)27(1) IPRax 15, at p. 17.

<sup>178</sup> With regard to Article 16(4) of the Brussels Convention: Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015), p. 36: “Other actions, including those for infringement of patents, are governed by the general rules of the Convention.”; Neuhaus (1996)87(9) Mitt. 257, at p. 261; Hye-Knudsen 2005, p. 17; Nagel & Gottwald 2013, § 3, para. 85.

<sup>179</sup> Contrary to previous times, cf. among others – tellingly – Véron (2001)128(3) J.D.I. 805, at p. 809: “(I)l a fallu près de 15 ans avant que des tribunaux européens acceptent de sanctionner la violation de droits de propriété industrielle étrangers. Mais, cette innovation a été ensuite reçue dans la pratique judiciaire européenne.”

<sup>180</sup> Cf. Tritton & Tritton (1987)9(12) E.I.P.R. 349, at p. 351; cf. also: Pertegás Sender 2002, paras. 4.23-4.24.

<sup>181</sup> Schauwecker 2009, p. 76.

<sup>182</sup> Geimer 2010 (Geimer & Schütze, *Europäisches Zivilverfahrensrecht*), Art. 2 EuGVVO, para. 161; Geimer 2015, para. 1146.



## 2.2 Jurisdiction regarding torts – Article 7(2)

### 2.2.1 General remarks and introduction to Article 7(2)

In Article 7(2)<sup>183</sup>, the Brussels Ibis Regulation provides for a head of special jurisdiction with respect of torts:

#### Article 7 of the Brussels Ibis Regulation

A person domiciled in a Member State may be sued in another Member State:  
(...)

(2) in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur.

In its *Kalfelis* decision on the interpretation of Articles 5(3) and 6(1) of the Brussels Convention (corresponding to Articles 7(2) and 8(1) of the Brussels Ibis Regulation), the ECJ postulated that the notion of *tort* must be interpreted in a European-autonomous way,<sup>184</sup> which is particularly relevant concerning the relationship between contracts and torts. The ECJ held:

“It must therefore be stated (...) that the term “matters relating to tort, delict or quasi-delict” within the meaning of Article 5(3) of the Convention must be regarded as an independent concept covering all actions which seek to establish the liability of a defendant and which are not related to a “contract” within the meaning of Article 5(1) [underscore added].”<sup>185</sup>

This fundamental principle of independent interpretation has subsequently been confirmed, regarding the interpretation of Article 5(3) of the Brussels Convention, in constant case-law, for instance in *Reichert II*<sup>186</sup>, *Réunion Européenne*<sup>187</sup>, *Gabriel*<sup>188</sup>, *Tacconi*<sup>189</sup>, *Henkel*<sup>190</sup> and *Engler*<sup>191</sup>. Beyond that, the ECJ made clear that the same applies to Article 5(3) of the

---

<sup>183</sup> Article 5(3) of the Brussels I Regulation provided in an almost identical way (merely the order of the words in the first sentence has been modified in Article 7(2) of the Brussels Ibis Regulation):

“A person domiciled in a Member State may, in another Member State, be sued:  
(...)

(3) in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur.”

Besides these minor modifications, Article 7(2) of the Brussels Ibis Regulation did not bring along any substantive change vis-à-vis Article 5(3) of the Brussels I Regulation (cf. Von Hein (2013)59(3) RIW 97, at p. 102).

<sup>184</sup> Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 9.

<sup>185</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 18 – *Kalfelis*.

<sup>186</sup> ECJ 26 March 1992, C-261/90, Mario Reichert and Others v Dresdner Bank AG, [1992] ECR I-02149, para. 16 – *Reichert II*.

<sup>187</sup> ECJ 27 October 1998, C-51/97, Réunion Européenne SA and Others v Spliethoff’s Bevrachtungskantoor BV, and the Master of the vessel Alblasgracht V002, [1998] ECR I-06511, para. 22 – *Réunion Européenne*.

<sup>188</sup> ECJ 11 July 2002, C-96/00, Rudolf Gabriel, [2002] ECR I-06367, para. 33 – *Gabriel*.

<sup>189</sup> ECJ 17 September 2002, C-334/00, Fonderie Officine Meccaniche Tacconi SpA v Heinrich Wagner Sinto Maschinenfabrik GmbH (HWS), [2002] ECR I-07357, para. 21 – *Tacconi*.

<sup>190</sup> ECJ 1 October 2002, C-167/00, Verein für Konsumenteninformation v Karl Heinz Henkel, [2002] ECR I-08111, para. 36 – *Henkel*.

<sup>191</sup> ECJ 20 January 2005, C-27/02, Petra Engler v Janus Versand GmbH, [2005] ECR I-00481, para. 29 – *Engler*.

Brussels I Regulation.<sup>192</sup> In its *Reisch Montage* decision on the interpretation of Article 6(1) of the Brussels I Regulation, the ECJ explicitly referred to its case-law with regard to the Brussels Convention, holding:

“It is settled case-law that the provisions of the regulation must be interpreted independently, by reference to its scheme and purpose (see, in relation to the Brussels Convention, Case C-433/01 Blijdenstein [2004] ECR I-981, paragraph 24 and the case-law cited).”<sup>193</sup>

This jurisprudence as to the relationship between the interpretation of the Brussels Convention and the Brussels I Regulation – which also applies to the Brussels Ibis Regulation – was referred to and confirmed in *Hassett*<sup>194</sup> and *Zuid-Chemie*<sup>195</sup>, where the court explicitly underlined the necessity of continuity in the interpretation of those two instruments, in accordance with Recital 19 in the preamble to the Brussels I Regulation which reads:

#### **Recital 19 in the preamble to the Brussels I Regulation**

Continuity between the Brussels Convention and this Regulation should be ensured, and transitional provisions should be laid down to that end. The same need for continuity applies as regards the interpretation of the Brussels Convention by the Court of Justice of the European Communities and the 1971 Protocol should remain applicable also to cases already pending when this Regulation enters into force.

Similarly, Recital 34 in the preamble to the Brussels Ibis Regulation provides:

#### **Recital 34 in the preamble to the Brussels Ibis Regulation**

Continuity between the 1968 Brussels Convention, Regulation (EC) No 44/2001 and this Regulation should be ensured, and transitional provisions should be laid down to that end. The same need for continuity applies as regards the interpretation by the Court of Justice of the European Union of the 1968 Brussels Convention and of the Regulations replacing it.

It is generally accepted that the infringement of a patent constitutes a tort according to Article 7(2).<sup>196</sup> However, due to the territorial nature of IP rights, IP infringements are substantially different from other kinds of torts.<sup>197</sup>

---

<sup>192</sup> The same interpretation developed under the Brussels Convention (and the Brussels I Regulation) also applies under the Brussels Ibis Regulation.

<sup>193</sup> ECJ 13 July 2006, C-103/05, *Reisch Montage AG v Kiesel Baumaschinen Handels GmbH*, [2006] ECR I-06827, para. 29 – *Reisch Montage*.

<sup>194</sup> ECJ 2 October 2008, C-372/07, *Nicole Hassett v South Eastern Health Board and Cheryl Doherty v North Western Health Board*, [2008] ECR I-07403, para. 17 – *Hassett*.

<sup>195</sup> ECJ 16 July 2009, C-189/08, *Zuid-Chemie BV v Philippo's Mineralenfabriek NV/SA*, [2009] ECR I-06917, paras. 17-19 – *Zuid-Chemie*.

<sup>196</sup> In place of others: OLG Düsseldorf 22 July 1999, 2 U 127/98, (2001)21(4) IPRax 336 – *Schussfadengreifer II*; LG Düsseldorf 25 August 1998, 4 O 165/97, (1999)48(5) GRUR Int. 455, at p. 457 – *Schussfadengreifer I*; Neuhaus (1996)87(9) Mitt. 257, at p. 262; Otte (2001)21(4) IPRax 315, at p. 316; Zigann 2002, p. 90; Kropholler & Von Hein 2011, Art. 5 EuGVO, para. 74; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 213; Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 79; Brinkhof (1997)46(6) GRUR Int. 489, at p. 490; Hausmann (2003)3(5/6) EuLF 277, at p. 277; Grabinski (2001)50(3) GRUR Int. 199, at p. 203; Laubinger 2005, p. 38 et seq.; Hye-Knudsen 2005, p. 63; Von Meibom & Pitz (1996)87(7) Mitt. 181, at p. 182 (=Von Meibom & Pitz (1997)19(8) E.I.P.R. 469, at p. 470); Adolphsen (2006)11 ZZPInt 137, at p. 155; Ten Wolde & Henckel (2013)3(2) IJPL 195, at pp. 202-203; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 12; Stadler 2012 (Musielak), Artikel 5

## 2.2.2 Types of actions covered by Article 7(2)

While the applicability of Article 7(2) to patent infringement actions does not represent a problem, the situation is less clear with regard to the constellation of an action for a declaration of non-infringement (action for a negative declaration) and the constellation of a preventive action for an injunction. In fact, it has been discussed controversially whether such actions fall within the scope of Article 7(2).

### 2.2.2.1 Applicability of Article 7(2) to an action for a declaration of non-infringement

The issue whether an action for a negative declaration (negative declaratory action) falls within the scope of Article 7(2) does not arise in case that the plaintiff institutes such an action before a court on the basis of Article 7(2), and the defendant (i.e. the patent owner) does not challenge jurisdiction. For instance, the defendant may eventually have an interest in filing a counterclaim for infringement before the court of the State where the possible infringer manufactures or sells products possibly infringing the concerned patent.<sup>198</sup> In such a case, the invoked court can gain jurisdiction according to Article 26(1) given its preconditions are fulfilled, in particular if no other court has exclusive jurisdiction according to Article 24.

In principle, it is not contested, apart from the case of infringers who initiate actions for a declaration of non-infringement, in countries which are considered to decide slowly, for the sole reason to delay proceedings (torpedo tactic)<sup>199</sup>, that competitors may principally have a justified interest in having judicially confirmed that they do not infringe a patent.<sup>200</sup>

Accordingly, Advocate General Tesauro explicated in his Opinion in the *Tatry* case that

“(…) the bringing of proceedings to obtain a negative finding, which is generally allowed under the various national procedural laws and is entirely legitimate in every respect, is an appropriate way of dealing with genuine needs on the part of the person who brings them. For example, he may have an interest, where the other party is temporizing, in securing a prompt judicial determination – if doubts

---

EuGVVO, para. 22; Auer 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 5 VO (EG) No. 44/2001, para. 126.

<sup>197</sup> Kono & Jurčys 2012, p. 49.

<sup>198</sup> This is suggested by *Véron*, cf. P. Véron (case note) TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, at N151-152, while it is unclear if Véron also has in mind the possibility of jurisdiction on the basis of Article 24.

<sup>199</sup> It is noteworthy that the term “torpedo” is used with varying connotations. While this notion is partly employed (as in this thesis) with a negative meaning, others have used it in a more neutral way, actually as a synonym to “action for a negative declaration”. For instance, *Gardella* underlined that “*torpedoes* have had to cope with their negative and pre-emptive character which is by itself a highly debated subject in international litigation because of the potential (and abusive) rush to the courthouse triggered by use of this procedural device. In light of such concerns, determination of an appropriate forum to adjudicate a negative declaratory judgment bears special consideration. Sufficient contacts are able to mitigate if not to overcome criticism against excessive *forum shopping* and against the tactical nature of pre-emptive declarations”, cf. *Gardella* 2008, p. 187. This conception becomes obvious as well in the following citation: “Regardless of the criticism of commentators and of the negative attitude of many courts pointing at the abusive nature of *torpedoes*, the formal validity and the viability of this strategy has been supported by the ECJ in the *Gasser* case (...)”, cf. *Gardella* 2008, p. 189.

<sup>200</sup> Wadlow 1998, para. 8–28; Véron (2001)128(3) J.D.I. 805, at p. 824; Hye-Knudsen 2005, p. 115; Winkler 2011, p. 178; Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 797; W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 268; cf. *Gardella* 2008, p. 206.

exist or objections are raised – of the rights, obligations or responsibilities deriving from a given contractual relationship [underscore added]. (...)”,<sup>201</sup>

As to the crucial question of whether actions for a declaration of non-infringement fall within the scope of Article 7(2), the ECJ finally rendered a landmark decision in the *Folien Fischer* case on the interpretation of Article 5(3) of the Brussels I Regulation.

In order to illustrate the problem in a comprehensible way, I shall pursue the approach of presenting the differing opinions with regard to this issue which have been developed both in the case-law of the Member States and in legal doctrine before the ECJ was given the opportunity to make a decision on this matter in the *Folien Fischer* case in 2012.

### **2.2.2.1.1 The legal situation before the *Folien Fischer* decision of the ECJ**

#### **2.2.2.1.1.1 Exemplary case-law of EU Member States**

While the following compilation of decisions of EU Member States courts on the question of whether an action for a negative declaration falls within the scope of Article 7(2) does not claim to be exhaustive, it may in any event demonstrate that the majority of Member States courts which had to deal with this question decided against the applicability of Article 5(3) in that constellation.<sup>202</sup> Only few courts adopted a more liberal approach.

##### **2.2.2.1.1.1.1 National case-law against the applicability of Article 7(2)<sup>203</sup>**

###### **2.2.2.1.1.1.1.1 *Gerechtshof ‘s-Gravenhage*, Decision from 22 January 1998, *Evans Medical Ltd v Chiron Corporation – Evans Medical***

In *Evans Medical*, the *Gerechtshof ‘s-Gravenhage* decided in second instance that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is not applicable to an action of a negative declaration, because such an action does not affect a claim concerning an obligation resulting from a tort.

The following facts formed the basis of the decision: The appellant (Evans Medical Ltd., hereinafter Evans) had lodged an appeal from the judgment given by the *Rechtbank ‘s-Gravenhage* on 14 May 1997 concerning jurisdiction of the court.<sup>204</sup> In the proceedings being the subject of this preliminary dispute as to jurisdiction, the respondents (Chiron Corporation, hereinafter Chiron) had claimed, in essence, the invalidation of the Dutch part of the European patent of which Evans was the registered proprietor and a declaration that their products do not infringe Evans’ European patent in the designated countries, save the United

---

<sup>201</sup> Advocate General 13 July 1994, C-406/92, The owners of the cargo lately laden on board the ship ‘Tatry’ v The owners of the ship ‘Maciej Rataj’, [1994] ECR I-05439, para. 23 – *Tatry*.

<sup>202</sup> This evaluation is shared by *Sujecki*, cf. *Sujecki* (2012)61(1) GRUR Int. 18, at p. 19.

<sup>203</sup> The cited national case-law concerns both Article 5(3) of the Lugano Convention, the Brussels Convention and the Brussels I Regulation. However, as all these provisions are to be interpreted equally, I shall present them together.

<sup>204</sup> *Gerechtshof ‘s-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 250 – *Evans Medical*.

Kingdom.<sup>205</sup> In its appeal, Evans asked both for reversal of the judgment of the *Rechtbank 's-Gravenhage* and that the Dutch court be declared to have had no jurisdiction to decide on the action of a declaration of non-infringement initiated by Chiron.<sup>206</sup> Chiron contested the grounds of appeal and asked for confirmation of the judgment of the *Rechtbank 's-Gravenhage*.

By reference to the Jenard Report, the *Gerechtshof 's-Gravenhage* first emphasised the fundamental importance of the basic principle of *actor sequitur forum rei* incorporated in Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation) and held that, with accordance to this provision, a company must be sued in the court of the State where the company is domiciled, meaning that Evans would have to be summoned before the English court.<sup>207</sup> In view of Chiron's argumentation, the *Gerechtshof 's-Gravenhage* then analysed whether Chiron could bring an action for a negative declaration against Evans before a Dutch court on the basis of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation). By reference to the Jenard Report and the *Mines de Potasse* and *Marinari* decisions of the ECJ, the court underlined that jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is justified because there is a close connecting factor between the dispute and the court which has jurisdiction to hear it,<sup>208</sup> and that, as Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) constitutes an exception from the main rule of Article 2 of the Brussels Convention (Article 4 of the Brussels Ibis Regulation), Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) must be interpreted restrictively, according to the jurisprudence of the ECJ in *Kalfelis*.<sup>209</sup> In light of the latter decision, where the ECJ held that the notion of "matters relating to tort, delict and quasi-delict" covers all actions which seek to establish the liability of a defendant and which are not related to a 'contract' within the meaning of Article 5(1) of the Brussels Convention (Article 7(1) of the Brussels Ibis Regulation), the *Gerechtshof 's-Gravenhage* concluded, as the action for a negative declaration brought by Chiron did not concern a claim of such content, but aimed, on the contrary, to establish that the claimant is not liable for patent infringement, that Chiron's claim did not fall within the scope of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation).<sup>210</sup> Additionally, the court decided that the exceptional nature of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) does not leave any room for the interpretation that it should also include a claim for a declaration that an act which has not yet taken place does not infringe patent rights, because where no tort has as yet taken place no court can be assigned "where the harmful event occurred", and such an extension would even further restrict the scope of the main rule of Article 2 of the Brussels Convention (Article 4 of the Brussels Ibis Regulation). As a consequence, the court held that the Dutch court had no jurisdiction to hear Chiron's claim.<sup>211</sup> The *Gerechtshof 's-Gravenhage* denied – in any case as far as regarding the examination of the intended acts of Chiron

---

<sup>205</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 250 – *Evans Medical*.

<sup>206</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 250 – *Evans Medical*.

<sup>207</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 251 – *Evans Medical*.

<sup>208</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 252 – *Evans Medical*.

<sup>209</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 253 – *Evans Medical*.

<sup>210</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 253 – *Evans Medical*.

<sup>211</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 253-254 – *Evans Medical*.

abroad – the existence of a “particularly close connecting factor between the claim and a court other than the one of the State of the abode of the defendant” (in the present case the Dutch court).<sup>212</sup> Moreover, the court stressed that the Protocol on the Settlement of Litigation concerning the Infringement and Validity of Community Patents ([1989] O.J. L401/34, 30 December 1989) (which has not entered into force) makes a distinction in Article 14 in respect of the jurisdiction between applications for a declaration of non-infringement and actions concerning infringement.<sup>213</sup> Besides, the *Gerechtshof 's-Gravenhage* clearly rejected Chiron’s argumentation that an application for a declaration of non-infringement forms the mirror image of an application for an injunction to prevent infringement and that the rule concerning jurisdiction laid down in Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) which applies to infringement cases applies, “in mirror image”, to cases concerning a declaration of non-infringement. In this respect, the court stressed again that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) only relates to torts according to a restricted interpretation as illustrated above, not allowing any “mirror image” analogous application in the case of an action for a negative declaration.<sup>214</sup> Otherwise, the general rule of Article 2 of the Brussels Convention (Article 4 of the Brussels Ibis Regulation) would be narrowed to a larger extent than Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) allows, without the presence of the justification on which Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is founded (“the particularly close connecting factor”).<sup>215</sup> Last but not least, as to Chiron’s argument in favour of the applicability of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) to an action for a declaration of non-infringement, that there is in fact no difference between an action for infringement and an application for a declaration of non-infringement, because the action for infringement also has a declaratory aspect, the court laconically held that this statement may be true, but without any relevance for the issue of jurisdiction, because it does not make the action for a negative declaration an action which seeks to establish the non-contractual liability of a defendant.<sup>216</sup>

This decision was subsequently confirmed by the *Rechtbank 's-Gravenhage* in its *Freelift* decision from 19 June 2002.<sup>217</sup>

#### **2.2.2.1.1.1.2 Swedish Supreme Court (*Högsta Domstolen*), Decision from 14 June 2000, Case No. Ö 2095-99 – *Flootek***

In its *Flootek* decision, the Swedish Supreme Court (*Högsta Domstolen*) held that an action for a negative declaration does not fall within the scope of Article 5(3) of the Lugano Convention because it does not concern a claim for damages in the course of a tort committed.<sup>218</sup>

<sup>212</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 254 – *Evans Medical*.

<sup>213</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 254 – *Evans Medical*.

<sup>214</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 254 – *Evans Medical*.

<sup>215</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 254 – *Evans Medical*.

<sup>216</sup> *Gerechtshof 's-Gravenhage* 22 January 1998, *Evans Medical Ltd v Chiron Corporation*, [2001] E.N.P.R. 9, 248, 254 – *Evans Medical*.

<sup>217</sup> *Rb. 's-Gravenhage* 19 June 2002, *Freelift BV (Netherlands) and Freelift Limited (UK) v Stannah Stairlifts Limited and Stannah Lift Services Limited (UK)*, NJkort 2002, 60 – *Freelift*.

<sup>218</sup> *Högsta Domstolen* 14 June 2000, Ö 2095-99, (2001)32(2) IIC 231, at p. 232 (= (2001)50(2) GRUR Int. 178, at p. 179) – *Flootek*.

The decision was based on the following facts:<sup>219</sup> The defendant, Kaldnes Miljøteknologi, a company which had its domicile in Norway, was the holder of two Swedish patents for a technique for purifying water – a national patent and a European patent designating Sweden. The European patent had been revoked, the decision being under appeal. The defendant and its Swedish licensee had written warning letters to the plaintiff, Flootek AB, a Swedish company selling devices for purifying water, on the alleged ground that this constituted an infringement of the Swedish patent. In reaction to this, the plaintiff filed a claim with the City Court in Stockholm, asking for a declaration of non-infringement pursuant to Sec. 63 of the Swedish Patent Act. The City Court declined jurisdiction; it was held that it was not possible in this case to found the competence of the court on Article 5(3) of the Lugano Convention. The Court of Appeal (*Svea Hovrätt*) upheld this decision, and also the Supreme Court (*Högsta Domstolen*) confirmed that Article 5(3) of the Lugano Convention was not applicable to an action for a negative declaration.

Essentially, the Supreme Court founded its decision on the idea that a deviation from the basic rule of Article 2(1) of the Lugano Convention, according to which claims have to be filed with the courts in the defendant's State of domicile, may only be admitted in exceptional constellations. As Article 5(3) of the Lugano Convention constitutes such a deviation from the fundamental rule, it must consequently be interpreted narrowly as a matter of principle.<sup>220</sup> According to the court, such a restrictive interpretation which is very close to the exact wording of Article 5(3) of the Lugano Convention is also necessary due to the interest in achieving a uniform interpretation among all Contracting States (of the Lugano Convention).<sup>221</sup> The latter argument reveals that the court doubted that the wording of Article 5(3) of the Lugano Convention leaves enough room for an interpretation such as to also comprise an action according to which the roles of the parties are reversed in the sense that an action is not initiated in order to have the opponent held liable to pay damages, but, in contrast, is launched in order to gain a declaration by the concerned court that no such liability exists. This attitude of the Supreme Court is in particular illustrated by the following formulation:

“Flootek's move for declaration by the court that the application of its techniques does not infringe certain patent rights is not founded on the ground that any damage has occurred, nor does it provide scope for a full determination of the question whether Flootek by utilizing its technique will be liable for damages vis-à-vis Kaldnes Miljøteknologi. Therefore, the case does not concern a claim for damages, which is raised in a Contracting State where the harmful event occurred. This means that Flootek's action does not fall within the scope of application of Article 5(3) of the Convention.”<sup>222</sup>

### **2.2.2.1.1.1.3 Brussels Court of First Instance (*Rechtbank van eerste aanleg te Brussel*), Decision from 12 May 2000, Case No. 2000/857/A – *Röhm Enzyme***

In *Röhm Enzyme*, the Brussels Court of First Instance (*Rechtbank van eerste aanleg te Brussel*) held that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) does not cover an action for a declaration of non-infringement which has been initiated as a torpedo action.

<sup>219</sup> Högsta Domstolen 14 June 2000, Ö 2095-99, (2001)32(2) IIC 231, at p. 231 (= (2001)50(2) GRUR Int. 178, at p. 178) – *Flootek*.

<sup>220</sup> Högsta Domstolen 14 June 2000, Ö 2095-99, (2001)32(2) IIC 231, at p. 231 (= (2001)50(2) GRUR Int. 178, at p. 178) – *Flootek*.

<sup>221</sup> Högsta Domstolen 14 June 2000, Ö 2095-99, (2001)32(2) IIC 231, at p. 231 (= (2001)50(2) GRUR Int. 178, at p. 178) – *Flootek*.

<sup>222</sup> Högsta Domstolen 14 June 2000, Ö 2095-99, (2001)32(2) IIC 231, at p. 232 (= (2001)50(2) GRUR Int. 178, at p. 179) – *Flootek*.

Essentially, the following facts formed the basis for the decision of the court: The defendant, the company DSM N.V., is holder of a European patent which designates the countries of Austria, Belgium, Sweden, Switzerland, Germany, Denmark, Spain, France, United Kingdom, Greece, Italy, Liechtenstein, Luxembourg and the Netherlands. The plaintiff, the company Röhm Enzyme GmbH, sought to declare that the European patent is null and void as far as the Belgian territory is concerned, and to declare that the plaintiff himself does not infringe the European patent. Additionally, the plaintiff asked the court to declare that he is free to manufacture, market and sell his products in the mentioned countries.<sup>223</sup> Before handling the case on the merits, the parties explicitly restricted the proceeding to the question of whether the invoked court has jurisdiction.<sup>224</sup> The defendant claimed that the Belgian court had no jurisdiction to decide on claims which are extraterritorial vis-à-vis the Belgian territory.<sup>225</sup> Besides, the defendant filed a counterclaim for frivolous litigation. He put forth that the plaintiff had introduced the extraterritorial declaratory claim in order to benefit from the priority rule of Article 21 of the Brussels Convention (which structurally corresponds to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified), intending to delay proceedings and block the possibility for handling the case by the courts in the other jurisdictions.<sup>226</sup> According to the defendant, *mala fide* parties could thus be inspired to introduce cross-border declaratory claims in Belgium, with the purpose of blocking all other claims for five to ten years. The defendant put forth that such a conduct constitutes an abuse of procedure and must therefore be ended immediately.<sup>227</sup>

With regard to the question of whether the plaintiff could sue the defendant who had no domicile in Belgium, on the basis of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), by way of an action for a declaration of non-infringement, the court rejected the plaintiff's argumentation that, if a tort had been committed in Belgium by the defendant, the plaintiff would have the possibility to sue the defendant, domiciled in another contracting State, before the Belgian courts, and that the same should apply to the constellation of an action for a negative declaration as the mirror claim. The court resolutely stated their attitude that

“(s)uch an interpretation is not in conformity with the jurisdictional rules.”<sup>228</sup>

The court enumerated three grounds for jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), but stated that none of these grounds are existent in the case of an action for a negative declaration where damages have not been caused yet:

“Jurisdiction is granted to the courts of the State where the harmful event has occurred because the judge of the place where the facts have taken place is better placed to analyse the constitutive elements of the tort. This judge is also best placed from a society point of view to rule upon the damages that should be awarded. Most of the time, the victims of the tort will be domiciled in that State and it is

<sup>223</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 572 (=2001)50(2) GRUR Int. 170, at p. 170) – *Röhm Enzyme*.

<sup>224</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 572 (=2001)50(2) GRUR Int. 170, at p. 170) – *Röhm Enzyme*.

<sup>225</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at pp. 572-573 (=2001)50(2) GRUR Int. 170, at pp. 170-171) – *Röhm Enzyme*.

<sup>226</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at pp. 572-573 (=2001)50(2) GRUR Int. 170, at pp. 170-171) – *Röhm Enzyme*.

<sup>227</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 573 (=2001)50(2) GRUR Int. 170, at p. 171) – *Röhm Enzyme*.

<sup>228</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 577 (=2001)50(2) GRUR Int. 170, at p. 172) – *Röhm Enzyme*.



better that they get damages according to the uniform legislation of the State where the harmful event occurred.”<sup>229</sup>

In light of this, the court did not leave any doubt that

“(a) decision concerning the non-existence of a harmful event does not make sense. The civil judge has only jurisdiction to judge a dispute. The plaintiff(s) need(s) standing and interest to introduce a case: the declaratory claim of non-infringement of the plaintiff(s) does not present any interest.”<sup>230</sup>

As the *Rechtbank* held that the plaintiff could have pursued no other goal than abusing the rule of Article 21 of the Brussels Convention (which structurally corresponds to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified), when introducing the cross-border action for a declaration of non-infringement, it sentenced the plaintiff to pay damages to the defendant.<sup>231</sup>

#### **2.2.2.1.1.1.4 Corte di Cassazione, Decision from 19 December 2003, Case No. 19550, B.L. Macchine automatiche s.p.a. v Windmüller & Hölscher KG**

The Italian *Corte di Cassazione* held that jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) does not cover the constellation of an action for a negative declaration being initiated as a torpedo action.<sup>232</sup>

In the first instance, the case was brought before the *Tribunale di Bologna* which decided against the applicability of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) to this constellation.<sup>233</sup> In essence, the decision was based on the following facts: The plaintiff, domiciled in Italy, manufactured packing machines. In February 1993, the defendant who manufactured packing machines in Germany requested the plaintiff to stop the sale of packing machines of a certain type immediately, founding this request on the fact that the defendant was holder of a specific European patent for Belgium, Germany, France, Great Britain, Italy and the Netherlands. In 1994, the plaintiff filed an action, before the *Tribunale di Bologna*, for a negative declaration in order to receive the judicial declaration that neither the manufacture nor the marketing of the concerned machine of the plaintiff infringed the said European patent of the defendant. The defendant argued that

---

<sup>229</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 577 (= (2001)50(2) GRUR Int. 170, at pp. 172-173) – *Röhm Enzyme*.

<sup>230</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 577 (= (2001)50(2) GRUR Int. 170, at p. 173) – *Röhm Enzyme*.

<sup>231</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 578 (= (2001)50(2) GRUR Int. 170, at p. 173) – *Röhm Enzyme*.

<sup>232</sup> Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 264 – *Verpackungsmaschine II*. Cf. also for instance Tribunale di Milano 21 March 2002 (unreported), (2004)26(6) E.I.P.R. N91; differently: L. Adami and M. Franzosi (case note) Tribunale di Milano 21 March 2002 (unreported), (2004)26(6) E.I.P.R. N91, at N91-N92 (*Adami and Franzosi* adopt a critical view towards the strict conception of the *Tribunale di Milano* and stress: “Indeed, when the action for declaration of non-infringement is based on a real and concrete interest in the authors’ opinion such action of non-infringement should be deemed allowable. There is all the more reason that this is true in the light of the new text of Article 5(3), as amended by EC regulation 44/2001, according to which a defendant having domicile in a Member State can be summoned before the court of the place where the harmful event occurred, or *may occur*. If we ignore these aspects, there is the risk of making a step backwards, i.e. a return to regarding European patents not as single patents, but rather as mere bundles of national patents, each of them being regulated under the individual legal systems of the Member States.”).

<sup>233</sup> Tribunale di Bologna 16 September 1998, I ZR 236/97, (2000)49(11-12) GRUR Int. 1021 – *Verpackungsmaschine I*.

Italian courts did not have jurisdiction to decide the case. In particular, the defendant put forth that Article 5(3) was not applicable to the plaintiff's action.<sup>234</sup> Explicitly referring to the *Kalfelis* decision of the ECJ and previous case-law of the *Corte di Cassazione* (Unified Senates, Decision from 8 August 1989, Case No. 3657, and Decision from 13 February 1993, Case No. 1821), the *Tribunale di Bologna* underlined that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) constitutes an exception from the basic rule of Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation) which is justified because of the particular close connection between the dispute and the court(s) of the place where the tort has been committed.<sup>235</sup> The *Tribunale di Bologna* then stated that this connecting factor lacks in the case of actions for a negative declaration, because the plaintiff of such an action claims himself that no tort has been committed.<sup>236</sup> Consequently, the court held that Article 5(3) of the Brussels Convention does not cover an action for a negative declaration.

The plaintiff unsuccessfully appealed against this judgment before the *Corte di Appello di Bologna*.<sup>237</sup> The latter court referred to the jurisprudence of the ECJ according to which the notion of "tort" is to be interpreted in an autonomous way. By reference to the ECJ, the *Corte di Appello di Bologna* underlined that all actions fall within the scope of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) which seek to establish the liability of a defendant for non-contractual grounds. According to the conception of the *Corte di Appello di Bologna*, the applicability of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) presupposes that a tortious conduct – which is qualified as tortious – has actually been committed. In this light, the court stated that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is not applicable where an action seeks to establish the *lawfulness* of a conduct.<sup>238</sup>

Against the latter decision, the plaintiff appealed on points of law before the *Corte di Cassazione*. The *Corte di Cassazione* confirmed the decisions of the previous instances, based on two main arguments: First, the court held that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) presupposes the occurrence of an event which has effected a damage. In contrast, an action for a negative declaration is not functionally linked with the declaration of a damage. In light of this, the court concluded that an action for a declaration of non-infringement and an action seeking to establish the liability of the infringer are not identical actions which only differ concerning the identity of the plaintiff, but constitute structurally different actions.<sup>239</sup> Second, the court underlined that, if the alleged infringer was enabled to institute an action for a negative declaration before a court of the place where he claims that no damage has occurred, this would imply to deprive the potentially aggrieved party of his right to institute proceedings before the court(s) of the place where he claims that the harmful event occurred.<sup>240</sup>

<sup>234</sup> Tribunale di Bologna 16 September 1998, I ZR 236/97, (2000)49(11-12) GRUR Int. 1021, at p. 1021 – *Verpackungsmaschine I*.

<sup>235</sup> Tribunale di Bologna 16 September 1998, I ZR 236/97, (2000)49(11-12) GRUR Int. 1021, at p. 1021 – *Verpackungsmaschine I*.

<sup>236</sup> Tribunale di Bologna 16 September 1998, I ZR 236/97, (2000)49(11-12) GRUR Int. 1021, at p. 1022 – *Verpackungsmaschine I*.

<sup>237</sup> Cf. reference in Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 264, at p. 264 – *Verpackungsmaschine II*.

<sup>238</sup> Cf. reference in Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 264, at p. 264 – *Verpackungsmaschine II*.

<sup>239</sup> Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 264, at p. 265 – *Verpackungsmaschine II*.

<sup>240</sup> Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 264, at p. 265 – *Verpackungsmaschine II*.

The *Tribunale di Milano* followed this jurisprudence of the *Corte di Cassazione* in its decision No. 3773 (interim injunction) from 26 March 2007.<sup>241</sup>

#### **2.2.2.1.1.1.5 *Oberlandesgericht München*, Decision from 25 October 2001, Case No. 6 U 5508/00 – *Leit- und Informationssystem II***

In *Leit- und Informationssysteme II*, the German *Oberlandesgericht München* decided in second instance that an action for a declaration of non-infringement does not fall within the scope of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), because this form of action does not seek to establish tortious liability of the defendant.

The case started in first instance before the German *Landgericht München I*. The following facts formed the basis of the case: The plaintiff, domiciled in Munich, had developed and afterwards manufactured and sold a navigation system for road vehicles. This system was inter alia integrated in the vehicles of the German company P. The French affiliate of the plaintiff, company S, delivered navigation systems to company P for integration in vehicles. The defendant, domiciled in France, is holder of a European patent concerning an electronic guidance and information system for road traffic. The European patent designated the countries of Austria, Belgium, Switzerland, Germany, France, Great Britain, Italy, Liechtenstein, Luxembourg, the Netherlands and Sweden. The defendant sued the plaintiff for patent infringement before the French *Tribunal de Grande Instance* in Paris. Company S joined that proceeding.

The plaintiff initiated an action for a declaration of non-infringement as to the German and the French part of the said European patent of the defendant. The plaintiff expressly put forth that the *Landgericht München I* was competent for decision on the basis of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), because he argued that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) also covers actions for a negative declaration.<sup>242</sup>

As to the question of jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), the *Landgericht München I* differentiated between the German and the French part of the concerned European patent. The court held that actions for a negative declaration principally fall within the scope of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation). With regard to the German part of the European patent, the court therefore held that it was competent to decide. Concerning the French part of the European patent of the defendant, the *Landgericht München I* denied its jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), explicating that, due to the principle of territoriality applicable to patent law, a French patent (respectively the French part of a European patent) could only be infringed in France. The place where the damage occurred could thus only be situated in France.<sup>243</sup>

---

<sup>241</sup> Tribunale di Milano 26 March 2007, Case No. 3773, (2008)3(1) J.I.P.L.P. 6, I. Betti (case note) Tribunale di Milano 26 March 2007, Case No. 3773, (2008)3(1) J.I.P.L.P. 6, at pp. 6-7.

<sup>242</sup> LG München I 20 September 2000, 21 O 5046/99, InstGE 1, 236, referred to in: OLG München 25 October 2001, 6 U 5508/00, InstGE 2, 61, at p. 63.

<sup>243</sup> LG München I 20 September 2000, 21 O 5046/99, InstGE 1, 236, referred to in: OLG München 25 October 2001, 6 U 5508/00, InstGE 2, 61, at p. 66.

Remarkably, both the plaintiff and the defendant appealed against this decision of the *Landgericht München I* before the *Oberlandesgericht München*. While the plaintiff appealed against the dismissal of the action for inadmissibility regarding the French part of the European patent, the defendant appealed against the statement of the *Landgericht München I* of having jurisdiction pursuant to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) with regard to the German part of the European patent.<sup>244</sup>

In second instance, the *Oberlandesgericht München* dismissed the plaintiff's appeal, denying international jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) for the initiated action for a negative declaration concerning non-infringement of the French part of the European patent in France, because the court held that there was no room for an exception from the principle rule of Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation). Concerning the defendant's appeal, the *Oberlandesgericht München* held that international jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) for the initiated action for a negative declaration concerning non-infringement of the German part of the European patent in Germany does not exist either, because, according to the court, Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is generally not applicable to actions for a negative declaration.<sup>245</sup> The *Oberlandesgericht München* grounded its finding on several arguments. First, referring to the *Kalfelis* decision of the ECJ, the court underlined that the term "matters relating to tort, delict or quasi-delict" within the meaning of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) must be considered as an independent concept covering all actions which seek to establish the liability of a defendant and which are not related to a "contract" within the meaning of Article 5(1) of the Brussels Convention (Article 7(1) of the Brussels Ibis Regulation). While a patent infringement constitutes a tort, the plaintiff put forth that no such infringement has occurred or may occur. His action did not imply a claim for damages, but was rather based on the non-existence of such a claim.<sup>246</sup> Indirectly, it becomes clear that the court was of the opinion that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) intends to protect the aggrieved party, when the court explicated that the plaintiff of an action for a negative declaration may not choose the *forum delicti commissi*, because he did not act as the aggrieved holder of a (patent) right. Again by reference to *Kalfelis*, the *Oberlandesgericht München* emphasised that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), as it constitutes an exception from the basic rule of Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation), must be interpreted restrictively. Additionally, underlining that the (potentially) aggrieved holder of a patent may choose between the courts competent according to Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation) at the place where the defendant is domiciled, and the courts competent according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) at the places where the harmful event occurred, the court held that there is no need to grant such a right to the alleged infringer of a patent. It is noteworthy that the *Oberlandesgericht München* did not deliver any further reasoning for this differentiation. Moreover, the *Oberlandesgericht München* stressed that interpreting Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) such as to also cover an action for a declaration of non-infringement would result in depriving the patent holder of his right to choose the place of jurisdiction, because a choice of jurisdiction by the alleged infringer in favour of the courts of the place where the alleged harmful event has

---

<sup>244</sup> LG München I 20 September 2000, 21 O 5046/99, InstGE 1, 236, referred to in: OLG München 25 October 2001, 6 U 5508/00, InstGE 2, 61, at p. 67.

<sup>245</sup> OLG München 25 October 2001, 6 U 5508/00, InstGE 2, 61, at p. 68.

<sup>246</sup> OLG München 25 October 2001, 6 U 5508/00, InstGE 2, 61, at p. 69.

occurred would block an infringement action in both this State and the State where the potential infringer is domiciled, due to the fact that the ECJ clarified in *Tatry* that both actions have the same object. Besides, a broad interpretation of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) would imply the risk that the alleged infringer invokes a court of a State where proceedings are known to relatively take a long period of time, in order to delay the whole proceeding, which would impede the effective enforcement of the rights of the patent holder. Furthermore, the *Oberlandesgericht München* held that the consequence of a race between the parties of suing each other does not correspond to the idea of a sound administration of justice. Last but not least, the court referred to Articles 93(5) and 94(2) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark and to Article 14(5), 17(2) of the Protocol on the settlement of litigation concerning the infringement and validity of Community Patents (Protocol on litigation) (which has never entered into force). According to the cited provisions, international jurisdiction in the *forum delicti commissi* is expressly excluded in the case of actions of a declaration of non-infringement of a Community trade mark respectively a Community patent. The court in the *forum delicti commissi* has only jurisdiction concerning the torts which have been committed in the territory of the State where the courts is sitting. These rules applying in the case of infringement of Community trade marks and Community patents, the *Oberlandesgericht München* draws the conclusion that the same applies *a fortiori* to parallel rights, in particular to the European patent which has a uniform scope of protection, but consists of a bundle of national patents.<sup>247</sup>

This decision of the *Oberlandesgericht München*, according to which Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is not applicable to actions for a negative declaration, has been confirmed in a later case by the *Landgericht Leipzig*<sup>248</sup> in first instance and the *Oberlandesgericht Dresden*<sup>249</sup> in second instance. The *Landgericht Leipzig*, also by reference to the decisions cited above by the Swedish Supreme Court (*Högsta Domstolen*) and the Italian *Corte di Cassazione*, underlined that in the case of an action for a declaration of non-infringement, the legal relationship between the parties *per se* lacks a tortious or similar character. According to the *Landgericht Leipzig*, this excludes the applicability of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation).<sup>250</sup> Besides, the court stressed that the *GAT* decision of the ECJ, according to which Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection, does not require another interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) which does not concern exclusive jurisdiction.<sup>251</sup> As the plaintiff of the brought action for a negative declaration did not question the validity of the concerned patent, rules of exclusive jurisdiction according to Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) were not applicable.<sup>252</sup>

The *Oberlandesgericht Dresden*, deciding in second instance, agreed with the decision of the *Landgericht Leipzig*. Similarly to the *Oberlandesgericht München*, the *Oberlandesgericht Dresden* emphasised that the text of Article 5(3) of the Brussels I Regulation (Article 7(2) of

<sup>247</sup> OLG München 25 October 2001, 6 U 5508/00, InstGE 2, 61, at p. 71.

<sup>248</sup> LG Leipzig 27 May 2008, 5 O 757/06, IPRspr. 2008 No. 96, 314.

<sup>249</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504.

<sup>250</sup> LG Leipzig 27 May 2008, 5 O 757/06, IPRspr. 2008 No. 96, 314, at pp. 315-316.

<sup>251</sup> LG Leipzig 27 May 2008, 5 O 757/06, IPRspr. 2008 No. 96, 314, at p. 316.

<sup>252</sup> LG Leipzig 27 May 2008, 5 O 757/06, IPRspr. 2008 No. 96, 314, at p. 316.

the Brussels Ibis Regulation) strikes against the applicability of this provision to an action for a negative declaration, because Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) presupposes a tortious legal relationship between the parties while the plaintiff of an action for a declaration of non-infringement conversely claims that no harmful event occurred.<sup>253</sup> On the other hand, the *Oberlandesgericht Dresden* underlined that Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) is not applicable in case of an action for a negative declaration either because the plaintiff of such an action does not question the validity of the concerned patent, but presupposes that validity.<sup>254</sup>

As the *Oberlandesgericht München*, the *Oberlandesgericht Dresden* also emphasised that the alleged infringer is not to be granted the right to choose between jurisdiction of the courts of the place where the defendant is domiciled and another jurisdiction.<sup>255</sup> Even more clearly than the *Oberlandesgericht München*, the *Oberlandesgericht Dresden* held that the purpose of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is to facilitate the proceeding for the aggrieved party, but not in favour of the one who searches legal certainty.<sup>256</sup> The court also picked up the arguments of the *Oberlandesgericht München* that interpreting Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) in a way that an action for a declaration of non-infringement would be covered could effect a blockade for the infringement action, meaning that the aggrieved party would be deprived of his right to choose the place of jurisdiction. As a consequence, there would be the danger of impeding the effective enforcement of the rights of the patent holder.<sup>257</sup> As the *Oberlandesgericht München*, the *Oberlandesgericht Dresden* stated that a race between the parties of suing each other must be avoided in light of a sound administration of justice.<sup>258</sup> Ultimately, as the *Oberlandesgericht München*, the *Oberlandesgericht Dresden* also referred to the provisions of Articles 93(5) and 94(2) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark by way of an argumentation *a fortiori* in order to underline that courts in the *forum delicti commissi* have only jurisdiction concerning torts which have been committed in the territory of the State where the courts are situated.<sup>259</sup> The *Oberlandesgericht Dresden* thus decided that an action for a negative declaration does not fall within the scope of application of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), neither by way of a direct application, nor (as the court did not recognise any legal gap in this respect) by way of an analogous application.<sup>260</sup>

The decision of the *Oberlandesgericht München* cited above was also confirmed by the *Landgericht München I* in a subsequent decision<sup>261</sup>, in which the *Landgericht München I*, after broadly and thoroughly referring to previous case-law and legal doctrine, followed the conception of the *Oberlandesgericht München*, underlining in particular the wording of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) and the fact that this provision constitutes an exception to the basic rule of Article 2(1) of the Brussels I Regulation (Article 4(1) of the Brussels Ibis Regulation) which requires a restricted interpretation.

<sup>253</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at p. 505.

<sup>254</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at p. 506.

<sup>255</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at p. 505.

<sup>256</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at p. 505.

<sup>257</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at pp. 505-506.

<sup>258</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at p. 506.

<sup>259</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at p. 506.

<sup>260</sup> OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504, at p. 506.

<sup>261</sup> LG München I 23 October 2008, 7 O 17209/07, InstGE 10, 178.

#### **2.2.2.1.1.1.6 *Tribunal de Grande Instance de Paris*, Decision from 5 November 2003 – *Dijkstra Plastics***

The *Dijkstra Plastics* decision constitutes the first French decision on jurisdiction in an action for a cross-border declaration of non-infringement of a patent.<sup>262</sup> The *Tribunal de Grande Instance de Paris* held that French courts have international jurisdiction to hear the action for a declaration of non-infringement based on the French part of a European patent under Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), whereas this provision does not allow a court to issue a cross-border declaration of non-infringement. As a consequence, the Tribunal de Grande Instance declined jurisdiction to decide on the non-French parts of a European patent.<sup>263</sup>

The decision was based on the following facts: The plaintiff, the Dutch company Dijkstra Plastics, manufactured and marketed buckets used for liquid products such as sauces in various European countries, including France. The defendant, the German company Saier Verpackungstechnik, owns a European patent covering pot-shaped containers, in particular a bucket. Faced with the threat of a patent infringement action, the plaintiff initiated an action for a declaration of non-infringement against the defendant before the Tribunal de Grande Instance de Paris. The case was based both on the French part of the defendant's European patent, and on its Austrian, Belgian, German, Liechtenstein, Luxembourg and Swiss counterparts. The defendant did not challenge the jurisdiction of the Tribunal de Grande Instance de Paris to rule on the French part of the European patent. However, the disputed issue was whether the Tribunal de Grande Instance de Paris had also jurisdiction in an action for a cross-border declaration of non-infringement under Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) with regard to the non-French parts of the European patent.<sup>264</sup>

The *Tribunal de Grande Instance de Paris* accepted jurisdiction to hear the action for a declaration of non-infringement based on the French part of the European patent according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), but stated that Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) does not allow a court to issue a cross-border declaration of non-infringement and therefore declined jurisdiction to decide on the non-French parts of the European patent. *In dicta*, the court mentioned that, according to the basic rule of Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation), only the courts of the Member State where the defendant is domiciled have jurisdiction to make a cross-border decision.<sup>265</sup>

#### **2.2.2.1.1.1.2 National case-law in favour of the applicability of Article 7(2)**

##### **2.2.2.1.1.1.2.1 Swiss Supreme Court (*Bundesgericht*), Decision from 13 March 2007, Case No. 4C.318/2006**

In a decision from 13 March 2007, the Swiss Supreme Court (*Bundesgericht*) decided that an action for a declaration of non-infringement principally falls within the scope of Article 5(3)

---

<sup>262</sup> TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, with case note P. Véron.

<sup>263</sup> TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, with case note P. Véron.

<sup>264</sup> TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, with case note P. Véron.

<sup>265</sup> TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, with case note P. Véron.

of the Lugano Convention<sup>266</sup> unless the plaintiff exerts his right of choice according to Article 5(3) of the Lugano Convention (which corresponds to Article 7(2) of the Brussels Ibis Regulation) in an inappropriate way in order to establish jurisdiction of a court which lacks the required proximity to evidence and facts.<sup>267</sup>

Presented in a simplified way, the decision of the *Bundesgericht* was based on the following facts: The plaintiff, having its seat in Basel/Switzerland, was a company doing business in the field of reinsurance. In 1998, the plaintiff had arranged a reinsurance contract between C. B.V., a Dutch company, and the reinsurance company K which had its seat in Bermuda. That reinsurance contract contained K's obligation to assure so-called cashback operations according to which consumers were promised partial repayment of the purchase price of products purchased from retailers. C. B.V. and K also concluded a so-called "Hold-Harmless-Agreement" according to which K should be held harmless by C. B.V. in case of any insurance payments based on a specific insurance policy. In summer 2001, C. B.V. became insolvent. The defendant was appointed as insolvency administrator. In default of insurance protection, numerous claims of consumers could not be satisfied. In 2002, the plaintiff brought an action for a negative declaration against the defendant before the Court of First Instance of Basel/Switzerland, in order to gain the judicial declaration that the plaintiff is not liable for damages. The defendant put forth that the plaintiff must be held liable for damages because of the "Hold-Harmless-Agreement" between C. B.V. and K, being concluded in the framework of the reinsurance contract between C. B.V. and K which had been arranged by the plaintiff. In 2005, the Court of First Instance of Basel (*Zivilgericht Basel-Stadt*) held that it lacked jurisdiction to decide on the merits. This decision was confirmed, in second instance, by the Court of Appeal of Basel (*Appellationsgericht des Kantons Basel-Stadt*), in 2006. The plaintiff then brought the case before the *Bundesgericht*.<sup>268</sup>

As the *Bundesgericht* essentially referred to the argumentation of the Court of Appeal of Basel, I shall present this decision first. Regarding the question of applicability of Article 5(3) of the Lugano Convention to the plaintiff's action for a negative declaration, the Court of Appeal of Basel decided that, in principle, not only the aggrieved party but also the alleged infringer may choose to initiate an action at the place where the harmful event occurred pursuant to Article 5(3) of the Lugano Convention (which corresponds to Article 7(2) of the Brussels Ibis Regulation). However, the court excluded this right of choice in the case that it would result in an "inappropriate" ("*unsachgemäß*") result, meaning that it would run contrary to the objective of expedience intended by Article 5(3) of the Lugano Convention (which corresponds to Article 7(2) of the Brussels Ibis Regulation).<sup>269</sup> The plaintiff claimed that he had not undertaken any acts in the Netherlands, but had only acted in Basel.<sup>270</sup> Although the Court of Appeal of Basel accepted that Basel formed a place of the event giving rise to the damage, it held that courts in Basel lacked the required factual proximity because the acts which had been undertaken in Basel formed only a minor part of the total events, emphasising that the claims in question were based on the interaction between the plaintiff and K in conjunction with the "Hold Harmless Agreement" with its focus situated in the Netherlands, where C. B.V. had its seat and the damage had also occurred. In view of these conditions, the Court of Appeal stated that, with regard to the aspects of proximity to evidence

---

<sup>266</sup> In this case, the discussed provision was Article 5(3) of the Lugano Convention. However, as the Lugano Convention, the Brussels Convention, the Brussels I Regulation and the Brussels Ibis Regulation are generally interpreted in accordance with each other, the explications made in this decision can also be referred to when analysing Article 7(2) of the Brussels Ibis Regulation.

<sup>267</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at pp. 546-547.

<sup>268</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 544.

<sup>269</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 546.

<sup>270</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 547.



and facts, Basel as a place of the event giving rise to the damage would take a back seat vis-à-vis the place where the damage occurred.<sup>271</sup> Consequently, the Court of Appeal of Basel decided that Swiss courts had no jurisdiction as to the plaintiff's action for a negative declaration on the basis of Article 5(3) of the Lugano Convention (which corresponds to Article 7(2) of the Brussels Ibis Regulation).<sup>272</sup>

The *Bundesgericht* confirmed the decision of the Court of Appeal of Basel. First of all, the *Bundesgericht* clarified that, for jurisdiction concerning the constellation of an action for a negative declaration, it cannot be decisive on which legal basis potential claims are based, because the plaintiff of such an action does not bring forward any claim at all.<sup>273</sup> The court underlined that at the time when the action for a declaration of non-infringement is instituted, it does not need to be certain on which legal basis the defendant intends to ground his claims.<sup>274</sup> The *Bundesgericht* emphasised that an action for a negative declaration, seeking for a declaration that the plaintiff is not liable for damages, has the same cause of action as the action of the opponent seeking for a declaration of the existence of liability, because it constitutes the mirror image of the latter action.<sup>275</sup> In light of this, the *Bundesgericht* drew the conclusion that the action for a negative declaration is to be brought before the courts of the place where an infringement action would have to be judged.<sup>276</sup> Explicitly referring to the *Kronhofer* decision of the ECJ, the *Bundesgericht* underlined that “the rule laid down in Article 5(3) of the Lugano Convention is based on the existence of a particularly close connecting factor between a dispute and courts other than those for the place where the defendant is domiciled, which justifies the attribution of jurisdiction to those courts for reasons relating to the sound administration of justice and the efficacious conduct of proceedings”,<sup>277</sup> and reasoned that the right of choice between the places of jurisdiction, according to Article 5(3) of the Lugano Convention (which corresponds to Article 7(2) of the Brussels Ibis Regulation), is also granted to the alleged infringer.<sup>278</sup> Nonetheless, the *Bundesgericht* restricted this right of choice in favour of the alleged infringer in the way that it must be certain that there is actually a particularly close connecting factor between the invoked court and the dispute. Otherwise, the (alleged) infringer could, in the case of actings which can be undertaken at any place, choose – for tactical reasons – a place for his infringing acting where he assumes courts to decide in his favour – i.e. to the disadvantage of the aggrieved party – when subsequently initiating an action for a declaration of non-infringement. The court held that this result would diametrically run contrary to the objective of ensuring the efficacious taking of evidence and conduct of proceedings.<sup>279</sup> The court underlined that its finding was neither meant to introduce the doctrine of *forum non conveniens*, nor to generally balance the interests of the parties in favour of the aggrieved party, but merely pursued the goal to avoid that the alleged infringer exerts his right of choice according to Article 5(3) of the Lugano Convention (which corresponds to Article 7(2) of the Brussels Ibis Regulation) in an inappropriate way.<sup>280</sup> The *Bundesgericht* underlined that factual proximity of the courts at Basel to the dispute would exist if it was to be clarified whether the plaintiff committed certain acts in Basel. However, this was not the case, because

<sup>271</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 547.

<sup>272</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at pp. 545, 547.

<sup>273</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 545.

<sup>274</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 545.

<sup>275</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 546.

<sup>276</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 546.

<sup>277</sup> ECJ 10 June 2004, C-168/02, *Rudolf Kronhofer v Marianne Maier and Others*, [2004] ECR I-06009, para. 15 – *Kronhofer*.

<sup>278</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 546.

<sup>279</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 547.

<sup>280</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 547.

the plaintiff did not show which claims were controversial between the parties concerning which the taking of evidence would be easier before courts in Basel than before Dutch courts.<sup>281</sup> In accordance with the Court of Appeal of Basel, the *Bundesgericht* underlined that the cashback operations were not sufficiently connected to Basel and were not performed in Switzerland, but in the Netherlands.<sup>282</sup>

The *Bundesgericht* decided that the plaintiff exerted his right of choice according to Article 5(3) of the Lugano Convention (which corresponds to Article 7(2) of the Brussels Ibis Regulation), which principally exists also in the case of an action for a negative declaration, in an inappropriate way in order to establish jurisdiction of a court which lacks the required proximity to evidence and facts, and that Swiss courts actually had no jurisdiction to decide on the merits of this case.<sup>283</sup>

#### **2.2.2.1.1.2.2 Regional Court of Frankfurt (*Landgericht Frankfurt*), Decision from 25 March 2010, Case No. 2-03 O 580/08**

The reasoning of the *Bundesgericht* discussed in the previous paragraph was referred to and confirmed by the German *Landgericht Frankfurt* in a decision from 25 March 2010.<sup>284</sup> By express reference to the *Bundesgericht*, the *Landgericht Frankfurt* underlined that actions for a negative declaration principally fall within the scope of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation). The parties' roles being reversed vis-à-vis the constellation in infringement proceedings, it cannot be decisive for jurisdiction on which legal basis the plaintiff grounds his claims, because he does not bring forward any claims at all, but only the inexistence of (potential) claims brought forward against him by the defendant.<sup>285</sup> Therefore, an action for a negative declaration is generally to be instituted before the courts of the place where infringement proceedings would have to be brought.<sup>286</sup>

While underlining that the right of choice between the places of jurisdiction according to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is generally granted to the aggrieved party, the *Landgericht Frankfurt*, as the *Bundesgericht*, further explicated that it is the plaintiff of an action for a declaration of non-infringement, i.e. the alleged infringer, who has this right of choice, if there is a particular proximity to evidence and facts between the invoked court and the (infringing) act to be judged.<sup>287</sup>

#### **2.2.2.1.1.2 Legal doctrine**

In contrast to the situation as to the jurisprudence of EU Member States courts, the clear majority of legal commentators have argued for the applicability of Article 7(2) concerning an

---

<sup>281</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 548.

<sup>282</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 548.

<sup>283</sup> BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544, at p. 548.

<sup>284</sup> LG Frankfurt 25 March 2010, 2-03 O 580/08, IPRspr. 2010 No. 220, 561 (= (2010)41(5) AfP 509).

<sup>285</sup> LG Frankfurt 25 March 2010, 2-03 O 580/08, IPRspr. 2010 No. 220, 561, at p. 563 (= (2010)41(5) AfP 509, at p. 511).

<sup>286</sup> LG Frankfurt 25 March 2010, 2-03 O 580/08, IPRspr. 2010 No. 220, 561, at p. 563 (= (2010)41(5) AfP 509, at p. 511).

<sup>287</sup> LG Frankfurt 25 March 2010, 2-03 O 580/08, IPRspr. 2010 No. 220, 561, at p. 563 (= (2010)41(5) AfP 509, at p. 511).

action for a negative declaration,<sup>288</sup> while others have advocated the opposite opinion.<sup>289</sup> In the following paragraphs, I shall briefly present the main lines of reasoning of both conceptions. For reasons of clearness, I shall not treat the opinions separately, but show in which way the arguments of both advocates and opponents of the applicability of Article 7(2) to an action for a negative declaration are interrelated with each other.

First of all, it could be underlined that the wording of Article 7(2) does not contain any differentiation between specific types of actions.<sup>290</sup> Despite the wording of the provision, legal commentators militating against the application of Article 7(2) to actions for a declaration of non-infringement have put forth that, due to the fact that Article 7(2) is an exception to the basic provision of Article 4(1), Article 7(2) must be interpreted in a restrictive way.<sup>291</sup> According to the latter opinion, that result could be derived from the jurisprudence of the ECJ in its *Kalfelis* decision where the court held that

“(…) the ‘special jurisdictions’ enumerated in Articles 5 and 6 of the [Brussels] Convention constitute derogations from the principle that jurisdiction is vested in the courts of the State where the defendant is domiciled and as such must be interpreted restrictively. It must therefore be recognized that a court which has jurisdiction under Article 5(3) [of the Brussels Convention] over an action in so far as it is based on tort or delict does not have jurisdiction over that action in so far as it is not so based [underscores and content in brackets added].”<sup>292</sup>

Further, one might put forth that the ECJ explicated, in its *Kalfelis* decision, when defining the term “matters relating to tort, delict or quasi-delict” as to non-contractual liability:

“It must therefore be stated (...) that the term “matters relating to tort, delict or quasi-delict” within the meaning of Article 5(3) of the [Brussels] Convention must be regarded as an independent concept covering all actions which seek to establish the liability of a defendant and which are not related to a “contract” within the meaning of Article 5(1) [of the Brussels Convention] [underscore and content in brackets added].”<sup>293</sup>

In light of this, it has been highlighted that an action for a declaration of non-infringement does in no way seek to establish such liability of the defendant, and that, by initiating an action for a declaration of non-infringement, the plaintiff himself alleges that no harmful event occurred, while Article 7(2) exactly requires that such a harmful event occur or may occur.<sup>294</sup> In this context, it has also been underlined that the ECJ ruled in its *Reichert II* decision, taking reference to the instrument of *action paulienne* according to French law, that actions which are not initiated to have the debtor convicted to pay damages due to a committed fraudulent conduct are not covered by Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation):

---

<sup>288</sup> Cf. subsequent footnotes in detail. In addition, without argumentation: Fezer & Koos 2010 (Staudinger), para. 1134; Schack 2010, para. 336 (*Schack* principally shares the opinion that Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) favours the aggrieved party, which is said to be relativised to some extent insofar as the alleged infringer, by initiating an action for a declaration of non-infringement, may make use of the multiplication of the *forum delicti* in the case of “*Distanzdelikte*” and “*Streudelikte*”); Gottwald 2002, p. 248.

<sup>289</sup> Cf. subsequent footnotes in detail. In addition, without further argumentation: Schlosser 2009, Art. 5 EUGVVO, para. 15.

<sup>290</sup> Adolphsen 2009, para. 498; Lundstedt (2001)32(2) IIC 124, at p. 132 (= (2001)50(2) GRUR Int. 103, at p. 107).

<sup>291</sup> P. Véron (case note) TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, at N151-152.

<sup>292</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 19 – *Kalfelis*.

<sup>293</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 18 – *Kalfelis*.

<sup>294</sup> P. Véron (case note) TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, at N151-152.

“It may be seen, moreover, from the Commission' s observations, which are not challenged on this point, that in French law the action paulienne may be instituted both against dispositions made for consideration by the debtor when the beneficiary acts in bad faith and against transactions entered into without consideration by the debtor even if the beneficiary acts in good faith.

The purpose of such an action is not to have the debtor ordered to make good the damage he has caused his creditor by his fraudulent conduct, but to render ineffective, as against his creditor, the disposition which the debtor has made. It is directed not only against the debtor but also against the person who benefits from the act, who is not a party to the obligation binding the creditor to his debtor, even, in cases where there is no consideration for the transaction, where that third party has not committed any wrongful act.

In these circumstances an action such as the *action paulienne* in French law cannot be regarded as a claim seeking to establish the liability of a defendant in the sense in which it is understood in Article 5(3) of the [Brussels] Convention and therefore does not come within the scope of that provision.  
[underscores and content in brackets added]”<sup>295</sup>

In view of this jurisprudence of the ECJ in *Reichert II*, it could be derived that actions for a declaration of non-infringement do not fall within the scope of Article 7(2), because such actions as well do not seek to establish the liability of the defendant.<sup>296</sup>

However, such reasoning has not remained undisputed. Proponents of the applicability of Article 7(2) to an action for a negative declaration have stressed that the concept of liability does not require actual damage to be sustained. As a consequence, future (imminent) torts are also covered.<sup>297</sup> This has ultimately been made clear by adding the last clause “or may occur” into Article 5(3) of the Brussels I Regulation (which is also included in Article 7(2) of the Brussels Ibis Regulation), modifying the text of Article 5(3) of the Brussels Convention without actually changing the meaning of the provision.<sup>298</sup> In view of this, the opposing opinion would not be compatible with the system of the Brussels I(bis) Regulation, also because actions for a declaration of non-infringement are covered by Article 5(1) of the Brussels I Regulation (Article 7(1) of the Brussels Ibis Regulation) as well.<sup>299</sup>

Furthermore, arguing in favour of the conception that Article 7(2) is applicable to the constellation of actions for a declaration of non-infringement, it is to be underlined that the opposing view is not in line with the jurisprudence of the ECJ either. While admitting that the ECJ actually held in its *Kalfelis* decision that special jurisdictions within the system of the Brussels Convention – and the same applies to the Brussels Ibis Regulation – are to be interpreted restrictively, it has been underlined that a closer look on the passage of the above cited *Kalfelis* decision which takes into consideration the whole respective paragraph, reveals that the ECJ, by emphasising the necessity of a restrictive interpretation of the special jurisdictions, merely intended to stress that the competence of a court to decide on *contractual* matters does not automatically confer the competence to decide on *non-contractual* issues.<sup>300</sup> This idea is expressly stated in the second sentence of the respective paragraph, which is directly linked to its first sentence (“therefore”):

---

<sup>295</sup> ECJ 26 March 1992, C-261/90, Mario Reichert and Others v Dresdner Bank AG, [1992] ECR I-02149, paras. 18-20 – *Reichert II*.

<sup>296</sup> This argumentation is mentioned, but not shared by *Lundstedt*, cf. *Lundstedt* (2001)32(2) IIC 124, at p. 131 (= (2001)50(2) GRUR Int. 103, at p. 106).

<sup>297</sup> Véron (2001)128(3) J.D.I. 805, at p. 827.

<sup>298</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, paras. 191-192.

<sup>299</sup> Kropholler & Von Hein 2011, Art. 5 EuGVO, para. 78; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 18.

<sup>300</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 267.

“(…) the ‘special jurisdictions’ enumerated in Articles 5 and 6 of the [Brussels] Convention constitute derogations from the principle that jurisdiction is vested in the courts of the State where the defendant is domiciled and as such must be interpreted restrictively. It must therefore be recognized that a court which has jurisdiction under Article 5(3) [of the Brussels Convention] over an action in so far as it is based on tort or delict does not have jurisdiction over that action in so far as it is not so based [underscore and content in brackets added].”<sup>301</sup>

Additionally, it has been put forward that the ECJ has, in its *Kalfelis* decision, in no way addressed the question of the type of action.<sup>302</sup> However, the correctness of this general statement is doubtful, given the explications of the ECJ in paragraph 18 of this decision where the ECJ referred to “all actions which seek to establish the liability of a defendant (...)”.<sup>303</sup>

With regard to an action of the patent holder, it is uncontested that Article 7(2) confers jurisdiction both concerning an action for performance and an action for a declaration of infringement.<sup>304</sup> In view of this, it could be argued that not applying Article 7(2) to an action for a negative declaration would lead to an unexplainable split between jurisdiction for positive and negative declaratory relief,<sup>305</sup> there being no reason respectively justification why the connection between the dispute and the courts should be less close in the case of an action for a declaration of non-infringement.<sup>306</sup>

Arguing in favour of the applicability with regard to actions for a negative declaration, it could further be put forth that an action for a declaration of non-infringement is governed by the same rules of jurisdiction as the claim for damages, because it simply mirrors the positive action by the victim of that action.<sup>307</sup> The action for a declaration of non-infringement thus falls on its merits under the definition of tort.<sup>308</sup> Although an action for a declaration of non-infringement does not constitute an action for damages, both an infringement action and an action for a declaration of non-infringement concern, at their core, the question of liability.<sup>309</sup> On the other hand, while admitting that a declaration of non-infringement represents the “mirror image” of an infringement action as far as the object of the action is concerned, it has been put forth that this idea cannot be applied to the rules of jurisdiction because they pursue different purposes. In contrast to an infringement action being initiated in order to sanction a

<sup>301</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 19 – *Kalfelis*.

<sup>302</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 267.

<sup>303</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 18 – *Kalfelis*.

<sup>304</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 234; ECJ, 5 February 2004, C-18/02, Danmarks Rederiforening, acting on behalf of DFDS Torline A/S, v LO Landsorganisationen i Sverige, acting on behalf of SEKO Sjöfolk Facket För Service och Kommunikation, [2004] ECR I-01417, paras. 21-22 – *DFDS Torline*; cf. Mankowski (2004)50(7) RIW 481, at p. 495; W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 267.

<sup>305</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 192.

<sup>306</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at pp. 267-268; Lundstedt (2001)32(2) IIC 124, at p. 132 (= (2001)50(2) GRUR Int. 103, at p. 107); Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 83; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 18.

<sup>307</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 191.

<sup>308</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 191; cf. also Rb. Utrecht 15 October 2003, Case No. 152725, Rost Chemicals BV (Netherlands) v NV De Craene (Belgium) and Others, NJF 2004, 73, para. 4.18 – *Rost Chemicals*.

<sup>309</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 191; W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 267; Czernich, Tiefenthaler & Kodek 2009, Art 5, para. 78.

patent infringement, an action for a declaration of non-infringement postulates the lack of existence of any infringement.<sup>310</sup>

Legal commentators arguing against the conception that an action for a negative declaration falls within the scope of Article 7(2) have vehemently stressed that Article 7(2), respectively the right to choose, with regard to jurisdiction, between the courts of the place where the event giving rise to the damage (“*Handlungsort*”) and the place where the damage occurred (“*Erfolgsort*”) shall protect the aggrieved party,<sup>311</sup> referring to the *Mines de Potasse* decision of the ECJ. It has also been underlined that the German principle of favourability of private international law (“*kollisionsrechtliches Günstigkeitsprinzip*”) protects the aggrieved party and that it was the aggrieved party that was given the right to choose between the above indicated jurisdictions in the *Mines de Potasse* decision. In light of this, it has been concluded that the ECJ probably indeed had in mind the principle of favourability of private international law when deciding in this way, and that the principle of favourability of private international law is therefore also applicable to Article 7(2). According to this conception, it would be contradictory if the actor of an action for a declaration of non-infringement, i.e. the alleged infringer, was also given the choice of jurisdiction according to Article 7(2), which would ultimately disable the choice of jurisdiction of the aggrieved party.<sup>312</sup> In order to argue for this opinion, reference has been made to the Opinion of Advocate General Capotorti given in the *Mines de Potasse* case, who explicated:

“(…) The injured party, who must establish the unlawful act, is automatically deemed the weaker party and as such worthy of protection in the choice of the court having jurisdiction. (...)”<sup>313</sup>

However, it is noteworthy that the ECJ, in contrast to the Advocate General, who advocated to merely refer to the place where the damage occurred, decided that both the place of the event giving rise to the damage and the place where the damage occurred shall be deemed relevant with regard to jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation). Beyond that, the ECJ also denied a wide interpretation of the “place where the damage occurred” so as to avoid to establish a “*Klägergerichtsstand*” as such in favour of the aggrieved party (cf. below in detail).

With regard to the transfer of the German principle of favourability of private international law (“*kollisionsrechtliches Günstigkeitsprinzip*”) to Article 7(2), it is to be criticised that such a conception cannot convince for two reasons: First, it is impossible to conclude that principles being applicable according to German private international law are applicable as well in the European jurisdictional system. Secondly, another inconsistency lies in the fact that the German principle of favourability of private international law does not affect jurisdiction but merely concerns the question of which substantive law is applicable. As there is a clear distinction between such rules on the applicable substantive law and rules of international procedural law within the German legal system, a conclusion from a principle of the one set of rules to the other set of rules is not possible. While the favourability principle indeed pursues the objective to protect the aggrieved party, rules of procedural law such as

---

<sup>310</sup> P. Véron (case note) TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, at N151-152.

<sup>311</sup> Noteworthy, such an interpretation of Article 7(2) of the Brussels Ibis Regulation is not supported by the wording of this provision, cf. Wukoschitz (2009)40(2) AfP 127, at p. 128.

<sup>312</sup> Huber (1995)50(12) JZ 603, at p. 607; cf. also R. Magnus (case note) ECJ 25 October 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, (2013) LMK 341419.

<sup>313</sup> Advocate General 10 November 1976, C-21/76, Handelskwekerij G. J. Bier B.V. v Mines de Potasse d’Alsace S.A., [1976] ECR 01735, para. 9 – *Mines de Potasse*.

Article 7(2) intend to secure a high level of procedural effectivity (“*Prozessökonomie*”) through decisions characterised by factual proximity.<sup>314</sup>

It could be brought forth that Article 7(2) may also have the objective to grant the plaintiff of an infringement action the procedural advantage to choose the competent court. In this respect, it has been underlined that protection of the weaker party is a recognised objective of certain other provisions<sup>315</sup> of the Brussels Ibis Regulation (respectively its predecessors) on special or exclusive jurisdiction. Such provisions are based on the idea that the protection of the weaker party is given preference against the protection of the defendant who normally is in a weaker position.<sup>316</sup>

Against the latter argument, it can be argued that Article 7(2) – unlike Articles 17 and 18 – does not pursue the goal to favour the structurally weaker plaintiff, for social considerations, by giving jurisdiction to the courts of the State where the plaintiff is domiciled.<sup>317</sup> Rather, according to the constant jurisprudence of the ECJ, the reason for jurisdiction according to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is the existence of a particularly close connecting factor between the dispute and the courts of the place where the harmful event occurred, which justifies the attribution of jurisdiction to those courts to ensure the sound administration of justice and the efficacious conduct of proceedings.<sup>318</sup> For instance, the ECJ explicated in *Zuid-Chemie*, in line with its finding in multiple previous decisions:

“(…) (T)he Court has stated that the rule of special jurisdiction laid down in Article 5(3) of the Brussels Convention is based on the existence of a particularly close connecting factor between the dispute and the courts of the place where the harmful event occurred, which justifies the attribution of jurisdiction to those courts for reasons relating to the sound administration of justice and the efficacious conduct of proceedings (see to that effect, inter alia, *Mines de Potasse d’Alsace*, paragraph 11; Case C-220/88 *Dumez France and Tracoba* [1990] ECR I-49, paragraph 17; Case C-68/93 *Shevill and Others* [1995] ECR I-415, paragraph 19; and Case C-364/93 *Marinari* [1995] ECR I-2719, paragraph 10). The courts for the place where the harmful event occurred are usually the most appropriate for deciding the case, in particular on the grounds of proximity and ease of taking evidence (see *Henkel*, paragraph 46) [underscores added].”<sup>319</sup>

Factual proximity between the deciding court and the allegedly infringing act to be assessed exists independently of concrete objectives pursued by an action in light of an alleged patent infringement, and of which procedural role the alleged infringer and victim play in the

---

<sup>314</sup> Hölder 2004, p. 190.

<sup>315</sup> Cf. Lundstedt (2001)32(2) IIC 124, at p. 133, there fn. 42 (= (2001)50(2) GRUR Int. 103, at p. 107, there fn. 40).

<sup>316</sup> This idea is mentioned, but not shared by *Lundstedt*, cf. Lundstedt (2001)32(2) IIC 124, at p. 133 (= (2001)50(2) GRUR Int. 103, at p. 107).

<sup>317</sup> Kropholler & Von Hein 2011, Art. 5 EuGVO, para 78; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 18.

<sup>318</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 267; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 18.

<sup>319</sup> ECJ 16 July 2009, C-189/08, *Zuid-Chemie BV v Philippo’s Mineralenfabriek NV/SA*, [2009] ECR I-06917, para. 24 – *Zuid-Chemie*, cf. also ECJ 30 November 1976, C-21/76, *Handelskwekerij G. J. Bier B.V. v Mines de Potasse d’Alsace S.A.*, [1976] ECR 01735, paras. 10-11 – *Mines de Potasse*; ECJ 11 January 1990, C-220/88, *Dumez France and Another v Hessische Landesbank (Helaba) and Others*, [1990] ECR I-00049, para. 17 – *Dumez*; ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 19 – *Shevill*; ECJ 19 September 1995, C-364/93, *Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company*, [1995] ECR I-02719, para. 10 – *Marinari*; ECJ 1 October 2002, C-167/00, *Verein für Konsumenteninformation v Karl Heinz Henkel*, [2002] ECR I-08111, para. 46 – *Henkel*; ECJ 10 June 2004, C-168/02, *Rudolf Kronhofer v Marianne Maier and Others*, [2004] ECR I-06009, para. 15 – *Kronhofer*.

proceeding.<sup>320</sup> In light of this, the aspect of factual proximity is justified both with regard to actions for a performance and actions for a negative declaration.<sup>321</sup> In this respect, both types of actions constitute two side of the same coin. This *objective* goal of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) has also been confirmed, for instance, by Advocate General Léger in his Opinion delivered on 15 January 2004 in the *Kronhofer* case where he stated:

“The Court’s reasoning is based entirely on the need to ensure that jurisdiction is attributed to the courts which are objectively the best placed to assess whether, in the specific case, the factors giving rise to liability are present. In other words, it was not prompted by a concern that the victim should be given the right to choose which courts should have jurisdiction, by extending the application of Articles 5(2), 8(2) and 14 of the Brussels Convention [underscore added].”<sup>322</sup>

Both parties (i.e. the patent holder and the alleged infringer) benefit from this objective goal of legal respectively jurisdictional certainty and legal proximity and proximity to evidence.<sup>323</sup> Therefore, it could be argued that the plaintiff of an infringement action would be unjustifiedly privileged towards the alleged infringer if an action for a declaration of non-infringement would not be admissible on the basis of Article 7(2).<sup>324</sup> Favouring one of the parties as to the determination of jurisdiction would thus be contrary to the objective goal pursued.<sup>325</sup> Furthermore, Article 7(2), according to its underlying idea, is *not restricted to the protection of the aggrieved party*, but also applicable to an action for a declaration of non-infringement.<sup>326</sup>

In light of the general objective of Article 7(2) to ensure the sound administration of justice and the efficacious conduct of proceedings, it can be concluded that there is no space for a restriction of Article 7(2) pursuant to the doctrine of *forum non conveniens* either.<sup>327</sup> Further, in its *Dumez* decision, the ECJ expressly denied

“(…) any interpretation of the [Brussels] Convention which, otherwise than in the cases expressly provided for, might lead to recognition of the jurisdiction of the courts of the plaintiff’s domicile and would enable a plaintiff to determine the competent court by his choice of domicile [content in brackets added].”<sup>328</sup>

Arguing against the applicability of Article 7(2) in the case of an action for a declaration of non-infringement, it could be pointed out that, if Article 7(2) was applicable in this constellation, the (alleged) infringer – and not the aggrieved party – would be favoured, because, concerning “*Distanzdelikte*”, the place of the event giving rise to the damage (“*Handlungsort*”) is often located at the place of domicile of the alleged infringer, meaning

<sup>320</sup> Kühnen 2012, para. 772; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 18.

<sup>321</sup> Kühnen 2012, para. 772.

<sup>322</sup> Advocate General 15 January 2004, C-168/02, Rudolf Kronhofer v Marianne Maier and Others, [2004] ECR I-06009, para. 34 – *Kronhofer*.

<sup>323</sup> Leible 2011 (Rauscher), Art 5 Brüssel I-VO, paras. 74, 83; M. Weller (case note) BGH 1 February 2011, KZR 8/10, (2011) LMK 318709.

<sup>324</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 268.

<sup>325</sup> Domej (2008)28(6) IPRax 550, at p. 553; M. Weller (case note) BGH 1 February 2011, KZR 8/10, (2011) LMK 318709.

<sup>326</sup> Hölder 2004, p. 190; similar: Hess 2010, § 6, para. 66, there in fn. 317 where the author states that the protective objective of the action for a negative declaration would not be sufficiently taken into account if Article 5(3) did not cover this type of action.

<sup>327</sup> Kropholler & Von Hein 2011, Art. 5 EuGVO, para. 78; Domej (2008)28(6) IPRax 550.

<sup>328</sup> ECJ 11 January 1990, C-220/88, *Dumez France and Another v Hessische Landesbank (Helaba) and Others*, [1990] ECR I-00049, para. 19 – *Dumez*.



that a “*Klägergerichtsstand*” in favour of the infringer would then be established. In this respect, it is noteworthy that the ECJ has, in its *Mines de Potasse* decision, broadened the meaning of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) to also encompass the place where the damage occurred (“*Erfolgsort*”), in order to strengthen the effectiveness of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), because the place of the event giving rise to the damage will often be the place of the domicile of the alleged infringer (with the consequence that the alleged infringer is favoured). The ECJ held:

“Thus the meaning of the expression ‘place where the harmful event occurred’ in Article 5(3) [of the Brussels Convention] must be established in such a way as to acknowledge that the plaintiff has an option to commence proceedings either at the place where the damage occurred or the place of the event giving rise to it.

This conclusion is supported by the consideration, first, that to decide in favour only of the place of the event giving rise to the damage would, in an appreciable number of cases, cause confusion between the heads of jurisdiction laid down by Articles 2 and 5(3) of the [Brussels] Convention, so that the latter provision would, to that extent, lose its effectiveness. [underscore and content in brackets added]”<sup>329</sup>

However, the ECJ also denied a wide interpretation of the “place where the damage occurred” such as to avoid to establish a “*Klägergerichtsstand*” as such in favour of the aggrieved party. Several aspects are remarkable in this respect. In *Marinari*, the ECJ held that the “place where the damage occurred” does not encompass the place where the assets of the aggrieved party are located. The ECJ held:

“Finally, as regards the argument as to the relevance of the location of the assets when the obligation to redress the damage arose, the proposed interpretation might confer jurisdiction on a court which had no connection at all with the subject-matter of the dispute, whereas it is that connection which justifies the special jurisdiction provided for in Article 5(3) of the [Brussels] Convention. Indeed, the expenses and losses of profit incurred as a result of the initial harmful event might be incurred elsewhere so that, as far as the efficiency of proof is concerned, that court would be entirely inappropriate [underscores and content in brackets added].”<sup>330</sup>

The ECJ confirmed and continued this jurisprudence in *Kronhofer*:

“(…) In a situation such as that in the main proceedings, such an interpretation would mean that the determination of the court having jurisdiction would depend on matters that were uncertain, such as the place where the victim’s ‘assets are concentrated’ and would thus run counter to the strengthening of the legal protection of persons established in the Community which, by enabling the claimant to identify easily the court in which he may sue and the defendant reasonably to foresee in which court he may be sued, is one of the objectives of the [Brussels] Convention (see Case C-256/00 *Besix* [2002] ECR I-1699, paragraphs 25 and 26, and DFDS *Torline*, paragraph 36). Furthermore, it would be liable in most cases to give jurisdiction to the courts of the place in which the claimant was domiciled. As the Court found at paragraph 14 of this judgment, the [Brussels] Convention does not favour that solution except in cases where it expressly so provides.

In view of the foregoing considerations, (...) Article 5(3) of the [Brussels] Convention must be interpreted as meaning that the expression ‘place where the harmful event occurred’ does not refer to the place where the claimant is domiciled or where ‘his assets are concentrated’ by reason only of the fact that he has suffered financial damage there resulting from the loss of part of his assets which arose and was incurred in another Contracting State [underscores and content in brackets added].”<sup>331</sup>

<sup>329</sup> ECJ 30 November 1976, C-21/76, *Handelskwekerij G. J. Bier B.V. v Mines de Potasse d’Alsace S.A.*, [1976] ECR 01735, paras. 19-20 – *Mines de Potasse*.

<sup>330</sup> ECJ 19 September 1995, C-364/93, *Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company*, [1995] ECR I-02719, para. 20 – *Marinari*.

<sup>331</sup> ECJ 10 June 2004, C-168/02, *Rudolf Kronhofer v Marianne Maier and Others*, [2004] ECR I-06009, paras. 20-21 – *Kronhofer*.

In its *Dumez* decision, the ECJ pursued this jurisprudence addressing the constellation that the plaintiff is an indirect victim. The court ruled:

“(…) (W)hilst the place where the initial damage manifested itself is usually closely related to the other components of the liability, in most cases the domicile of the indirect victim is not so related.

It must therefore be stated (...) that the rule on jurisdiction laid down in Article 5(3) of the [Brussels] Convention cannot be interpreted as permitting a plaintiff pleading damage which he claims to be the consequence of the harm suffered by other persons who were direct victims of the harmful act to bring proceedings against the perpetrator of that act in the courts of the place in which he himself ascertained the damage to his assets [underscores and content in brackets added].”<sup>332</sup>

The cases cited in the foregoing paragraphs concerned actions brought by the aggrieved party towards the alleged infringer which, in theory, leaves open the possibility that the ECJ would exclude the place of the event giving rise to the damage in the case of an action for a declaration of non-infringement raised by the alleged infringer.<sup>333</sup> However, it is to be borne in mind that the ECJ has continuously held that the decisive factor for jurisdiction according to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is the “existence of a particularly close connecting factor between the dispute and the deciding court”, independently from the domicile of each party, in order to ensure the “sound administration of justice and the efficacious conduct of proceedings”.

As to the aspect of factual proximity, it could be argued against the applicability of Article 7(2) of the Brussels Ibis Regulation to actions for a negative declaration that favouring the aggrieved party contributes to factual proximity, because it is the aggrieved party, and not the alleged infringer, who principally bears the burden of proof in matters of tortious claims. Given it is this role of the aggrieved party that secures factual proximity, one might conclude that the choice of the forum must be reserved for the aggrieved party. Granting this right to the alleged infringer, too, could jeopardise the objective and the function of Article 7(2), even if this was in accordance with legitimate interests of the alleged infringer.<sup>334</sup>

However, it is to be borne in mind that the ECJ made clear that there is no link between the burden of proof and jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation).<sup>335</sup> So, the ECJ held in its *Shevill* decision:

“In the area of non-contractual liability, the context in which the questions referred have arisen, the sole object of the Convention is to determine which court or courts have jurisdiction to hear the dispute by reference to the place or places where an event considered harmful occurred.

It does not, however, specify the circumstances in which the event giving rise to the harm may be considered to be harmful to the victim, or the evidence which the plaintiff must adduce before the court seized to enable it to rule on the merits of the case.

Those questions must therefore be settled solely by the national court seized, applying the substantive law determined by its national conflict of laws rules, provided that the effectiveness of the [Brussels] Convention is not thereby impaired.

The fact that under the national law applicable to the main proceedings damage is presumed in libel actions, so that the plaintiff does not have to adduce evidence of the existence and extent of that

<sup>332</sup> ECJ 11 January 1990, C-220/88, *Dumez France and Another v Hessische Landesbank (Helaba) and Others*, [1990] ECR I-00049, paras. 21-22 – *Dumez*.

<sup>333</sup> *Domej* (2008)28(6) IPRax 550, at p. 554.

<sup>334</sup> As to the provision of § 32 ZPO (which principally corresponds to Article 7(2) in structural respect): Foerste 2004, pp. 149-150.

<sup>335</sup> Cf. also Thole (2013)66(17) NJW 1192, at p. 1193.

damage, does not therefore preclude the application of Article 5(3) of the [Brussels] Convention in determining which courts have territorial jurisdiction to hear the action for damages for harm caused by an international libel through the press [underscores and content in brackets added].”<sup>336</sup>

Furthermore, it has been underlined that *not only* the aggrieved party bears the burden of proof, but that, according to general principles, *each* party – i.e. also the alleged infringer – has to prove the facts which are favourable to him. Consequently, it depends on the circumstances of a concrete case which party will be most interested in a forum where evidence can be best manufactured. Apart from this aspect, both parties – bearing the burden of proof or not – may be interested in a forum where proceedings can be conducted most cost-efficiently.<sup>337</sup> If it was necessary to determine in each case which party has the greatest interest in a forum close to evidence, in order to grant this party the right to choose the forum, this would finally result in an examination on an individual basis which is contrary to the jurisprudence of the ECJ according to which jurisdiction pursuant to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is to be determined according to abstract criteria.<sup>338</sup>

Arguing for the applicability of Article 7(2) in the constellation of actions for a declaration of non-infringement, it is to be highlighted that, due to the fact that national courts in Europe interpret the scope of patent protection in different ways,<sup>339</sup> the choice of the forum is of great importance for the outcome of the proceedings. If the plaintiff of an action for a declaration of non-infringement is denied jurisdiction according to Article 7(2) and if he can only initiate an action on the basis of Article 4(1), he is discriminated against the patent holder. In other words, the creditor, in particular if suing for damages, would be treated more favourably without justification for such privilege, while opening Article 7(2) also for actions for a declaration of non-infringement ensures equal procedural chances (“*Waffengleichheit*”) for both parties.<sup>340</sup> After all, the fact that it is usually the creditor who sues the debtor and not *vice versa*, cannot serve as an argument why the creditor should *per se* have the privilege to determine jurisdiction. The very fact that this constellation may result in a lack of legal protection for the debtor has led to the development of the action for a declaration of non-infringement, securing equal procedural chances. A discrimination of the plaintiff of an action for a declaration of non-infringement could only be justified if the creation of “*Waffengleichheit*” would *per se* require such discrimination of the debtor.<sup>341</sup> While exceptions to this principle might be generally justified in the case of (groups of) persons who deserve particular protection, this aspect does not apply as to patent infringement proceedings, because there is, *a priori*, no weaker party.<sup>342</sup> Another evaluation could only be justified if the aggrieved party would otherwise, on the whole, get into a weaker procedural position than the

---

<sup>336</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, paras. 37-40 – *Shevill*.

<sup>337</sup> Domej (2008)28(6) IPRax 550, at p. 553 et seq.

<sup>338</sup> Domej (2008)28(6) IPRax 550.

<sup>339</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 268; Scharen 2012 (Benkard – Europäisches Patentübereinkommen), EPÜ Art. 69, paras. 66-76; cf. Tilmann & von Falck (2000)102(7) GRUR 579, at p. 584.

<sup>340</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 268; Schmaranzer 2014 (Burgstaller, Neumayr, Geroldinger & Schmaranzer), Art 5 EuGVO, para. 48; Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 192; P. Mankowski (case note) BGH 1 February 2011, KZR 8/10, (2011)27(8) EWiR 253, at p. 254; Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 5, para. 66.

<sup>341</sup> Domej (2008)28(6) IPRax 550, at p. 553.

<sup>342</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 268; Lundstedt (2001)32(2) IIC 124, at p. 134 (= (2001)50(2) GRUR Int. 103, at p. 108); Domej (2008)28(6) IPRax 550, at p. 553.

alleged infringer.<sup>343</sup> Additionally, suing a patent holder before a court of the State for whose territory he has been granted a patent should be considered neither unfair, nor unexpected for the patent holder.<sup>344</sup>

After all, it is far from being sure *a priori* that the defendant of an infringement action has committed a tort and should therefore be denied the advantages of Article 7(2) when subsequently filing an action for declaration of non-infringement. Whether he is liable of a patent infringement still has to be clarified in the infringement proceedings.<sup>345</sup>

As another argument against the applicability of Article 7(2) to actions for a negative declaration, it could be put forward that the ECJ warned, in its *Dumez* decision, against a multiplication of places of jurisdiction, stating that

“(…) it is necessary to avoid the multiplication of courts of competent jurisdiction which would heighten the risk of irreconcilable decisions, this being the reason for which recognition or an order for enforcement is withheld by virtue of Article 27(3) of the [Brussels] Convention [underscore and content in brackets added].”<sup>346</sup>

In *Marinari*, the ECJ confirmed its view with regard to

“(…) the objective of the [Brussels] Convention, which is to provide for a clear and certain attribution of jurisdiction (see Case 241/83 Roesler v Rottwinkel [1985] ECR 99, paragraph 23, and Case C-26/91 Handte v Traitments Mécano-Chimiques des Surfaces [1992] ECR II-3967, paragraph 19) (… [underscore and content in brackets added].”<sup>347</sup>

However, this being true, it is a matter of fact that the application of Article 7(2) to actions of a negative declaration neither runs contrary to the objective of the Brussels Ibis Regulation to provide for a clear and certain attribution of jurisdiction (cf. *Marinari*), nor does it effect a multiplication of places of jurisdiction which the ECJ intends to avoid (cf. *Dumez*), because there is no creation of new places of jurisdiction, but the alleged patent infringer is merely given the possibility to use the jurisdictions which are open to the patent holder as well.<sup>348</sup>

Besides, denying the applicability of Article 7(2) to the constellation of actions for a declaration of non-infringement could be irreconcilable with the jurisprudence of the ECJ in *Gubisch* and *Tatry*. In its *Gubisch* decision, on the interpretation of Article 21 of the Brussels Convention (which structurally corresponds to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified), the ECJ explicated, concerning the relationship between an action to enforce a contract and an action for its rescission or discharge, that

“(…) the question whether the contract is binding (…) lies at the heart of the two actions. If it is the action for rescission or discharge of the contract that is brought subsequently, it may even be regarded as simply a defence against the first action, brought in the form of independent proceedings before a court in another Contracting State.

---

<sup>343</sup> Domej (2008)28(6) IPRax 550, at p. 553.

<sup>344</sup> Lundstedt (2001)32(2) IIC 124, at p. 134 (= (2001)50(2) GRUR Int. 103, at p. 108).

<sup>345</sup> Domej (2008)28(6) IPRax 550, at p. 553.

<sup>346</sup> ECJ 11 January 1990, C-220/88, *Dumez France and Another v Hessische Landesbank (Helaba) and Others*, [1990] ECR I-00049, para. 18 – *Dumez*.

<sup>347</sup> ECJ 19 September 1995, C-364/93, *Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company*, [1995] ECR I-02719, para. 10 – *Marinari*.

<sup>348</sup> W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 268; Lundstedt (2001)32(2) IIC 124, at p. 132 (= (2001)50(2) GRUR Int. 103, at p. 107).

In those procedural circumstances it must be held that the two actions have the same subject-matter, for that concept cannot be restricted so as to mean two claims which are entirely identical.

If (...) the questions at issue concerning a single sales contract were not decided solely by the court before which the action to enforce the contract is pending and which was seised first, there would be a danger for the party seeking enforcement that under Article 27(3) [of the Brussels Convention] a judgment given in his favour might not be recognised, even though any defence put forward by the defendant alleging that the contract was not binding had not been accepted. There can be no doubt that a judgment given in a Contracting State requiring performance of the contract would not be recognised in the State in which recognition was sought if a court in that State had given a judgment rescinding or discharging the contract. Such a result, restricting the effects of each judgment to the territory of the State concerned, would run counter to the objectives of the [Brussels] Convention, which is intended to strengthen legal protection throughout the territory of the Community and to facilitate recognition in each Contracting State of judgments given in any other Contracting State [underscores and content in brackets added].<sup>349</sup>

As to the relationship between an action seeking to have the defendant held liable for causing loss and ordered to pay damages and an earlier action brought by that defendant for a declaration of non-liability, the ECJ ruled subsequently in *Tatry*:

“(...) (O)n a proper construction of Article 21 of the [Brussels] Convention, 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 [underscore and content in brackets added].”<sup>350</sup>

On the basis of this jurisprudence of the ECJ, it would seem logical to understand Article 7(2) as well as to cover both actions which seek to establish the liability of a defendant and actions for a declaration of non-infringement.<sup>351</sup> The opposing opinion negates the jurisprudence of the ECJ concerning Article 21 of the Brussels Convention (structurally corresponding to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified) which is based on the “*Kernpunkttheorie*”, despite its similarity in schematic respect.<sup>352</sup>

Against the applicability of Article 7(2) to actions for a negative declaration, one might argue that barring Article 7(2) in that constellation has the effect to curtail the danger of Italian/Belgian torpedo actions<sup>353</sup> via Article 29.<sup>354</sup> Such torpedo actions are actions for a declaration of non-infringement instituted by the alleged infringer of a patent before the courts of a State known for the long duration of its judicial proceedings, especially Belgium and Italy.<sup>355</sup> Doing so, the plaintiff of such an action pursues the objective to benefit from the effect of *lis pendens* provided for in Article 29(1) which reads:

---

<sup>349</sup> ECJ 8 December 1987, C-144/86, *Gubisch Maschinenfabrik KG v Giulio Palumbo*, [1987] ECR 04861, paras. 16-18 – *Gubisch*.

<sup>350</sup> ECJ 6 December 1994, C-406/92, *The owners of the cargo lately laden on board the ship ‘Tatry’ v The owners of the ship ‘Maciej Rataj’*, [1994] ECR I-05439, para. 45 – *Tatry*.

<sup>351</sup> Adolphsen 2009, para. 498; W. Wurmnest (case note) *Corte di Cassazione (Unified Civil Senates)* 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265, at p. 267; Domej (2008)28(6) IPRax 550, at p. 553; Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 83.

<sup>352</sup> Adolphsen 2009, para. 498

<sup>353</sup> The term “torpedo” has been developed by *Franzosi*, cf. *Franzosi* (1997)19(7) E.I.P.R. 382, at p. 384; cf. also *Franzosi* (2002)33(2) IIC 154, at pp. 154-163.

<sup>354</sup> This idea is mentioned, but not shared, by *von Hein*, in: *Kropholler & Von Hein* 2011, Art. 5 EuGVO, para. 78; cf. also R. Magnus (case note) ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, (2013) LMK 341419.

<sup>355</sup> Hye-Knudsen 2005, p. 171. Patent infringement proceedings in Belgium are said to last around five to ten years, cf. *Rechtbank van eerste aanleg te Brussel* 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 573 (= (2001)50(2) GRUR Int. 170, at p. 171) – *Röhm Enzyme*.

## Article 29(1)

Without prejudice to Article 31(2), 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.

As has been analysed above, the infringement action and the action for a declaration of non-infringement raised by the alleged infringer are established between the same parties and have the same cause of action.<sup>356</sup> Due to Article 29(1), a subsequent infringement action by the patent holder against the alleged infringer would thus be blocked until the jurisdiction of the court seised is established (priority principle).<sup>357</sup> In case of a European patent, the existence of the same cause of action requires that the infringement action and the action for a declaration of non-infringement concern the same national parts of the European patent.<sup>358</sup> If different national parts of a European patent are affected, infringement proceedings may be stayed on the basis of Article 30(1) which provides:

## Article 30(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.

It is noteworthy that a stay of proceedings pursuant to Article 30(1) depends, in contrast to the legal situation under Article 29(1), on the discretion of the deciding court.<sup>359</sup> By instituting an action for a declaration of non-infringement at an early stage, the alleged infringer will generally effect the stay of infringement proceedings.<sup>360</sup> In order to avoid abusive<sup>361</sup> torpedo actions,<sup>362</sup> several solutions are conceivable.<sup>363</sup> Besides the idea to admit exceptions from the

---

<sup>356</sup> Hye-Knudsen 2005, pp. 173-174, cf. the cited *Gubisch* and *Tatry* decisions of the ECJ: ECJ 8 December 1987, C-144/86, *Gubisch Maschinenfabrik KG v Giulio Palumbo*, [1987] ECR 04861, paras. 16-18 – *Gubisch*; ECJ 6 December 1994, C-406/92, *The owners of the cargo lately laden on board the ship 'Tatry' v The owners of the ship 'Maciej Rataj'*, [1994] ECR I-05439, para. 45 – *Tatry*; M. Weller (case note) BGH 1 February 2011, KZR 8/10, (2011) LMK 318709.

<sup>357</sup> Grabinski 2003, pp. 462-463; Hye-Knudsen 2005, pp. 170, 173; Pitz (2001)50(1) GRUR Int. 32, at p. 32; Ullmann (2001)103(10-11) GRUR 1027, at p. 1032; De Jong (2005)27(2) E.I.P.R. 75, at p. 75.

<sup>358</sup> Grabinski 2003, p. 464.

<sup>359</sup> Grabinski 2003, p. 470.

<sup>360</sup> Grabinski 2003, p. 462; Luginbühl 2005, p. 390.

<sup>361</sup> Cf. D. Stauder (case note) Tribunale di Bologna 16 September 1998, I ZR 236/97, (2000)49(11-12) GRUR Int. 1022, at p. 1022.

<sup>362</sup> It has been put forth that admitting the action for a declaration of non-infringement at the *forum delicti commissi* will actually *not raise* the possibilities of abusive torpedo actions, because initiating such actions before courts with notoriously slow proceedings in order to block infringement proceedings before another court does not require that the action for a declaration of non-infringement is raised before a court that has jurisdiction. The plaintiff will usually already benefit from the considerable time that the notoriously slow court needs to decide that it does not have jurisdiction, cf. M. Weller (case note) BGH 1 February 2011, KZR 8/10, (2011) LMK 318709.

<sup>363</sup> Besides, by reference to the *Gasser* decision and the *Turner* decision of the ECJ, it has been put forth in legal doctrine that even in the case where an action for a declaration of non-infringement is brought abusively, for the sole purpose to impede another action, Article 27 of the Brussels I Regulation (Article 29 of the Brussels Ibis Regulation) must be applied without any exception, because the public interest in the unrestricted application of the jurisdiction rules of the Brussels I(bis) Regulation in general and Article 27 of the Brussels I Regulation (Article 29 of the Brussels Ibis Regulation) in particular precedes the private interest of the patent holder in a most effective enforcement of his rights, cf. Leitzen (2004)53(12) GRUR Int. 1010, at pp. 1014-1015. Against

priority principle of Article 29(1) in such constellations<sup>364</sup> and the proposal that the court before which an action for a declaration of non-infringement is brought in such circumstances, shall separate the merits of the case from the issue of jurisdiction and quickly rule about its jurisdiction as such,<sup>365</sup> it would also be conceivable to regulate that Article 7(2) is not applicable to such actions for a negative declaration.

Although it might be true that the abuse of procedural rules must not be admitted, Article 7(2) does not seem to be an appropriate means to solve the problem of (Italian or Belgian) torpedo actions.<sup>366</sup> As has been illustrated above, the plaintiff of an action for a negative declaration may have a justified interest in instituting such an action.<sup>367</sup> Rather, the blockading effect of torpedo actions should be met by a restrictive application of the term “the same cause of action” in Article 29(1) due to the different territorial effects of the patents,<sup>368</sup> and by efficiently making use of interim relief.<sup>369</sup>

In comparative respect, one might underline, on the one hand, that Article 97(5) of Regulation (EC) No 207/2009<sup>370</sup>, containing rules on international jurisdiction as to the Community trade mark, reads:<sup>371</sup>

**Article 97(5) of Regulation (EC) No 207/2009**

Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9(3), second sentence, has been committed.

As actions for a declaration of non-infringement concerning Community trade marks are explicitly excluded from the possibility to be initiated before the courts of the State where the infringement has been committed, one might conclude *a fortiori* that the same must apply in case of an action for a declaration of non-infringement concerning a (national or European) patent which is no Community right.

---

this point of view, it can be argued that the ECJ, in its *Gasser* decision, merely held that the fact that the duration of proceedings before the courts of the State first seised is *generally* considered to be excessively long does not justify to deviate from the rules of jurisdiction laid down in the Brussels I Regulation (Brussels Ibis Regulation), i.e. including the rules on a stay of proceedings according to Article 29 of the Brussels Ibis Regulation. In this respect, it has been put forth that the *Gasser* decision of the ECJ does not exclude that Article 29 of the Brussels Ibis Regulation is not applied in case that the *concrete* assessments reveal that the court first seised has not decided on its jurisdiction, although an unjustifiably long term has expired (cf. Kühnen 2012, para. 1367).

<sup>364</sup> Grabinski 2003, p. 466 et seq.

<sup>365</sup> Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571, at p. 574 (= (2001)50(2) GRUR Int. 170, at p. 171) – *Röhm Enzyme*.

<sup>366</sup> Adolphsen 2009, para. 498

<sup>367</sup> Hye-Knudsen 2005, pp. 173, 115; Wadlow 1998, para. 8–28; Véron (2001)128(3) J.D.I. 805, at p. 824; P. Mankowski (case note) BGH 1 February 2011, KZR 8/10, (2011)27(8) EWiR 253, at p. 254.

<sup>368</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 192; P. Mankowski (case note) BGH 1 February 2011, KZR 8/10, (2011)27(8) EWiR 253, at p. 254; De Vecchi Lajolo (2013)16(7) MMR 422, at p. 426; Czernich, Tiefenthaler & Kodek 2009, Art 5, para. 78.

<sup>369</sup> Adolphsen 2009, para. 499

<sup>370</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1–42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>371</sup> With respect to Article 93(5) of the Council Regulation (EC) No 40/94, the predecessor of Council Regulation (EC) No 207/2009, cf. Kohler 2000, 28.

On the other hand, also referring to the specific legal nature of Community trade marks as Community rights, it is to be stressed that Article 97(5) of Regulation (EC) No 207/2009 contains a specific rule and should therefore be restricted to its own ambit and scope of application.<sup>372</sup>

#### 2.2.2.1.2 The reference for a preliminary ruling by the *Bundesgerichtshof*

Due to the fact that the issue whether an action for a negative declaration falls within the scope of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) was decisive in a case which was brought before it, the German *Bundesgerichtshof* decided to stay the proceedings and to refer the following question to the ECJ for a preliminary ruling:

“Is Article 5(3) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters to be interpreted as meaning that jurisdiction in matters relating to tort or delict also exists in respect of an action for a negative declaration in which a potential injuring party asserts that the party potentially injured by a particular situation has no claim in tort or delict (in this case, infringement of the provisions of competition law)?”<sup>373</sup>

Although the case brought before the *Bundesgerichtshof* concerned a matter of competition law, the essential problem of whether an action for a negative declaration falls within the scope of Article 7(2) is comparable with the problem to be discussed here of whether Article 7(2) covers an action for a declaration of non-infringement of a patent. That is why this case, in particular the jurisprudence of the ECJ and the Opinion of the Advocate General delivered before it, shall be subject to closer analysis, after briefly presenting the dispute in the main proceedings. Remarkably, this reference for a preliminary ruling by the *Bundesgerichtshof* put the ECJ in the position for the first time to render an explicit decision on the highly controversial question of the applicability of Article 7(2) (respectively its predecessors) on actions for a negative declaration.<sup>374</sup> Previously, as to the problems of “*Rechtshängigkeit*” and the barrier effect (“*Sperrwirkung*”) of Article 29(1), the ECJ had at least clarified some relevant aspects in its case-law, while, with regard to a reference for a preliminary ruling by the *Oberlandesgericht Düsseldorf* concerning the interpretation of Article 21(1) of the Brussels Convention (which structurally corresponds to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified) where the referring court requested a definite interpretation of the terms “*Rechtshängigkeit*” and “*Partei*” (“party”),<sup>375</sup> the ECJ did not make a decision because the parties agreed on an extrajudicial solution.<sup>376</sup>

The reference for a preliminary ruling by the *Bundesgerichtshof* was based on the following facts: Folien Fischer, a company established in Switzerland which developed, manufactured and sold laminated paper goods and adhesive film, distributed base material for continuous card forms, inter alia in Germany. Fofitec, a company also having its registered office in Switzerland and being part of the Folien Fischer group of companies, held several patents in the same field of business. Ritrama SpA, a company established in Italy, developed,

<sup>372</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 192.

<sup>373</sup> Cf. Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 19, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>374</sup> Sujecki (2012)61(1) GRUR Int. 18, at p. 18.

<sup>375</sup> OLG Düsseldorf 30 September 1999, 2 W 60/98, (2000)49(8-9) GRUR Int. 776 – *Impfstoff III*.

<sup>376</sup> Sujecki (2012)61(1) GRUR Int. 18, at p. 18, there fn. 6; Pitz (2001)50(1) GRUR Int. 32, at p. 32.



manufactured and distributed various kinds of laminates and multilayer film. By letter of March 2007, Ritrama SpA alleged that the distribution policy of Folien Fischer and its refusal to grant patent licences were contrary to competition law. Following that letter, Folien Fischer and Fofitec made an application for a negative declaration before the *Landgericht Hamburg* with a view to obtaining a judicial declaration, first, that Folien Fischer was not obliged to desist from its sales practice in relation to the granting of discounts and the terms of its distribution contracts and, secondly, that Ritrama SpA had no claim either to the elimination of or compensation for that sales practice. Folien Fischer and Fofitec also sought a declaration that Fofitec was not obliged to grant the defendant a licence for the relevant European patents that it holds. After that action for a negative declaration had been brought, Ritrama SpA brought an action for performance before the *Tribunale di Milano*. In support of its application for the award of damages and an order requiring Fofitec to issue mandatory licences for the patents in question, Ritrama SpA argued that the conduct of Folien Fischer and Fofitec was anti-competitive. The action for a negative declaration brought by Folien Fischer and Fofitec was dismissed as inadmissible, for lack of international jurisdiction, by judgment of the *Landgericht Hamburg* of 9 May 2008 in first instance.<sup>377</sup> In second instance, that decision was confirmed on appeal on 14 January 2010 by the *Oberlandesgericht Hamburg*, which did not accept the international jurisdiction of the German courts, on the ground that the jurisdiction in matters relating to tort or delict provided for in Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) could not apply to an action for a negative declaration such as that brought by Folien Fischer and Fofitec since the court held that the very purpose of such an action is to establish that no tort or delict has been committed in Germany.<sup>378</sup> Folien Fischer and Fofitec brought an appeal on a point of law before the *Bundesgerichtshof*, maintaining the forms of order they had sought on appeal.<sup>379</sup> In its order for reference, the *Bundesgerichtshof* emphasised that the ECJ had not yet given a ruling on whether the jurisdiction provided for in Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is also established where the potential injuring party brings an action for a negative declaration seeking a declaration that the potential injured party has no claim based on an alleged tort or delict.<sup>380</sup> Taking into account the divergent views expressed by legal commentators<sup>381</sup> and various courts of Member States of the European Union, as well as the Swiss Confederation,<sup>382</sup> the *Bundesgerichtshof* considered

---

<sup>377</sup> LG Hamburg 9 May 2008, 315 O 410/07, cited in Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>378</sup> OLG Hamburg 14 January 2010, 3 U 133/08, cited in Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 17, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>379</sup> Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, paras. 11-18, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>380</sup> BGH 1 February 2011, KZR 8/10, para. 11, (2011)60(6) GRUR Int. 554, at p. 555 ((=)(2011)32(20) ZIP 975, at p. 976) – *Trägermaterial für Kartenformulare I*.

<sup>381</sup> BGH 1 February 2011, KZR 8/10, para. 13, (2011)60(6) GRUR Int. 554, at p. 555 ((=)(2011)32(20) ZIP 975, at p. 976) – *Trägermaterial für Kartenformulare I*.

<sup>382</sup> BGH 1 February 2011, KZR 8/10, para. 12, (2011)60(6) GRUR Int. 554, at p. 555 ((=)(2011)32(20) ZIP 975, at p. 976) – *Trägermaterial für Kartenformulare I*; though, it has been criticised that the *Bundesgerichtshof* should have cited more case-law for and against the applicability of Article 5(3) of the Brussels I Regulation to actions for a declaration of non-infringement, cf. P. Mankowski (case note) BGH 1 February 2011, KZR 8/10, (2011)27(8) EWIR 253, at pp. 253-254, with further references to such differing case-law.

that the correct interpretation of that provision is not obvious in such cases.<sup>383</sup> As a consequence, the *Bundesgerichtshof* decided to stay the proceedings and to refer the above cited question to the ECJ for a preliminary ruling.<sup>384</sup> In its reasoning, the *Bundesgerichtshof* expressed that it was inclined to apply Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) to an action for a negative declaration.<sup>385</sup> In short, the *Bundesgerichtshof* referred to the wording of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), because, also concerning an action for a negative declaration, a tort is the subject of the proceeding.<sup>386</sup> Further, the court underlined that also with regard to an action for a negative declaration, factual proximity – which the court identified as the decisive factor for jurisdiction according to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), rather than privileging the aggrieved party<sup>387</sup> – exists between the dispute and the invoked court, the latter aspect being independent from which party (i.e. the potential victim or the alleged infringer) is the plaintiff of an action.<sup>388</sup> Additionally, the *Bundesgerichtshof* emphasised that an interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) according to which this provision also comprises actions for a negative declaration does not establish a multiplication of places of jurisdiction.<sup>389</sup> Besides, the court stressed that Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) does not contain any proviso of abuse (“*Missbrauchsvorbehalt*”).<sup>390</sup>

### 2.2.2.1.3 The Opinion of Advocate General Jääskinen in the *Folien Fischer* case

As to the question of whether Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is applicable to actions for a negative declaration in matters relating to tort or delict, Advocate General Jääskinen first recognised the argument that such an action may be considered a mirror image of

“(...) the action for performance or for damages which, as its symmetrical opposite, is the counterpart of the former action [underline added].”<sup>391</sup>

<sup>383</sup> BGH 1 February 2011, KZR 8/10, para. 11, (2011)60(6) GRUR Int. 554, at p. 555 ((2011)32(20) ZIP 975, at p. 976) – *Trägermaterial für Kartenformulare I*.

<sup>384</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, paras. 18-19, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>385</sup> BGH 1 February 2011, KZR 8/10, para. 14, (2011)60(6) GRUR Int. 554, at p. 555 ((2011)32(20) ZIP 975, at p. 976) – *Trägermaterial für Kartenformulare I*.

<sup>386</sup> BGH 1 February 2011, KZR 8/10, para. 15, (2011)60(6) GRUR Int. 554, at p. 555 ((2011)32(20) ZIP 975, at p. 976) – *Trägermaterial für Kartenformulare I*.

<sup>387</sup> BGH 1 February 2011, KZR 8/10, para. 21, (2011)60(6) GRUR Int. 554, at p. 556 ((2011)32(20) ZIP 975, at p. 977) – *Trägermaterial für Kartenformulare I*.

<sup>388</sup> BGH 1 February 2011, KZR 8/10, paras. 16-18, (2011)60(6) GRUR Int. 554, at pp. 555-556 ((2011)32(20) ZIP 975, at pp. 976-977) – *Trägermaterial für Kartenformulare I*.

<sup>389</sup> BGH 1 February 2011, KZR 8/10, para. 17, (2011)60(6) GRUR Int. 554, at pp. 555-556 ((2011)32(20) ZIP 975, at pp. 976-977) – *Trägermaterial für Kartenformulare I*.

<sup>390</sup> BGH 1 February 2011, KZR 8/10, para. 20, (2011)60(6) GRUR Int. 554, at p. 556 ((2011)32(20) ZIP 975, at p. 977) – *Trägermaterial für Kartenformulare I*.

<sup>391</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 40, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

However, having stated the foregoing, the Advocate General immediately relativised this thought – which would actually have strongly argued for an interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) such as to cover actions for a negative declaration, by explicating:

“However, just as an image can be distorted by a mirror, the symmetry referred to may not be perfect or indeed relevant at all. In this instance, I am inclined to think, not without some reservations, that the majority view in the present case may be open to question, taking into account not least the wording and purpose of Article 5(3) of Regulation (EC) No 44/2001, the fact that it is immaterial in this case that an action for a negative declaration and a positive action have the same object, and the practical consequences of the broad interpretation suggested.”<sup>392</sup>

*Advocate General Jääskinen* then clearly took the view that an action for a negative declaration does *not* fall within the scope of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), founding his opinion on literal, teleological, schematic and practical aspects.

### 2.2.2.1.3.1 Literal interpretation

#### 2.2.2.1.3.1.1 No action for liability in tort

Beginning with a literal interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), the Advocate General referred to the jurisprudence of the ECJ in *Tacconi* according to which

“(…) the expression ‘matters relating to tort, delict or quasi-delict’ within the meaning of Article 5(3) of the Brussels Convention covers all actions ‘which seek to establish the liability of a defendant’ and which ‘are not related to a “contract” within the meaning of Article 5(1) of the [Brussels] Convention’, a contract entailing an obligation freely entered into by one party towards another. (...) [underscore and content in brackets added]”<sup>393</sup>

While not doubting that the second condition of a non-contractual legal relationship between the parties was fulfilled, the Advocate General expressed his conception that, the normal roles in matters relating to tort or delict being reversed in the case of an action for a negative declaration,

“(…) an application for a negative declaration does not seek to establish the liability of the defendant, as in the case-law cited above, but on the contrary, seeks to rule out the claimant’s liability. (...)”<sup>394</sup>

---

<sup>392</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 41, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>393</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 45, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*; cf. ECJ 17 September 2002, C-334/00, *Fonderie Officine Meccaniche Tacconi SpA v Heinrich Wagner Sinto Maschinenfabrik GmbH (HWS)*, [2002] ECR I-07357, paras. 21-23 – *Tacconi*; ECJ 1 October 2002, C-167/00, *Verein für Konsumenteninformation v Karl Heinz Henkel*, [2002] ECR I-08111, para. 41 – *Henkel*.

<sup>394</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 47, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

and even formulated that an action for a negative declaration

“(…) is not, strictly speaking, an action for liability in tort, since it does not seek a finding as to the existence of infringements of competition law allegedly committed by the claimants on German territory, but has the diametrically opposed objective of exonerating them by seeking a finding that their conduct is in conformity with that law [underscore added]. (…)”<sup>395</sup>

In order to confirm this argumentation, the Advocate General referred to the jurisprudence of the ECJ in *Reichert II* where the court excluded the *action paulienne* in French law from the scope of the Brussels Convention, ruling that

“(…) a non-contractual action does not fall within the scope of (Article 5(3)) [of the Brussels Convention] where it does not seek compensation for harm within the meaning of that provision, even if the action is based on allegedly wrongful conduct [content in brackets added].”<sup>396</sup>

#### **2.2.2.1.3.1.2 Consequence of a literal interpretation: No connecting factor which would be essential for the applicability of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation)**

On the basis of his opinion that an action for a negative declaration is no action for liability in tort, *Advocate General Jääskinen* drew – consistently from that starting point – the conclusion that, in the case of an action for a negative declaration, there is no such connecting factor which would be necessary for Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) to be applicable. He expressed that idea in remarkable clearness as follows:

“(…) An action for a negative declaration (…) presupposes that even the risk of the damage actually occurring is excluded, thus effectively eliminating the connecting factor, and therefore the specific ground of jurisdiction attaching to it, as provided in Article 5(3) of Regulation (EC) No 44/2001.”<sup>397</sup>

While conceding that an action for a negative declaration could be founded on the general rule of jurisdiction based on the domicile of the defendant according to Article 2(1) of the Brussels I Regulation (Article 4(1) of the Brussels Ibis Regulation), the Advocate General expressed his opinion that this does not apply to jurisdiction pursuant to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), because

“(a)n action for a negative declaration seeks a finding in private international law which in my view necessarily implies that the connecting factor in international procedural law does not exist.”<sup>398</sup>

---

<sup>395</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 47, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>396</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 52, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>397</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 49, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>398</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 50, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

### 2.2.2.1.3.1.3 Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) merely favours the aggrieved party

By reference to the *Mines de Potasse* decision of the ECJ, the Advocate General expressed his understanding from the case-law of the ECJ that it is the aggrieved party – and not the alleged infringer – that shall benefit from the choice between the jurisdiction of the courts of place of the event giving rise to the damage and the place where the damage occurred:

“(…) Although the Court does not expressly say so, it seems to me that the choice between the two fora was thus made available to the claimant in an action in a matter relating to tort or delict is intended to favour the presumed victim, who is generally the claimant in the proceedings. There is nothing in the case-law to indicate that the same favour should be extended to the perpetrator of a possible harmful act [underscore added].”<sup>399</sup>

### 2.2.2.1.3.2 Teleological interpretation

In teleological respect, *Advocate General Jääskinen* underlined that Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) forms an exception from the general rule of Article 2(1) of the Brussels I Regulation (Article 4(1) of the Brussels Ibis Regulation), meaning that

“(…) preference must always be given to the general ground of jurisdiction based on the defendant's domicile, save in a few well-defined situations in which the subject-matter of the litigation or the autonomy of the parties warrants a different connecting factor.”<sup>400</sup>

By reference to the case-law of the ECJ, particularly in *Réunion Européenne*<sup>401</sup> and *Zuid-Chemie*<sup>402</sup>, where the court expressly stated that the rules of jurisdiction which derogate from the general principle that jurisdiction lies with the courts of the State in the territory of which the defendant is domiciled do not allow an interpretation going beyond the circumstances contemplated by the Brussels Convention/Brussels I Regulation (Brussels Ibis Regulation), the Advocate General concluded that Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation)

“(…) must be interpreted in a strict, not to say restrictive, fashion.”<sup>403</sup>

In this respect, the ECJ has continuously held that Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) requires

---

<sup>399</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 48, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>400</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 55, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>401</sup> ECJ 27 October 1998, C-51/97, *Réunion Européenne SA and Others v Spliethoff's Bevrachtungskantoor BV*, and the Master of the vessel *Alblasgracht V002*, [1998] ECR I-06511, para. 16 – *Réunion Européenne*.

<sup>402</sup> ECJ 16 July 2009, C-189/08, *Zuid-Chemie BV v Philippo's Mineralenfabriek NV/SA*, [2009] ECR I-06917, para. 22 – *Zuid-Chemie*.

<sup>403</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 56, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

“(…) the existence of a particularly close connecting factor between (the) dispute and the court which may be called upon to hear it, with a view to the efficacious conduct of proceedings [underscore added].”<sup>404</sup>

As to the latter requirement, the Advocate General expressed his serious doubts that

“(i)n an action for a negative declaration, such enhanced proximity cannot be identified without risk of error.”<sup>405</sup>

### 2.2.2.1.3.3 Schematic interpretation

According to *Advocate General Jääskinen*, a proper schematic interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), i.e. its position within the system of rules of the Brussels I Regulation (Brussels Ibis Regulation) and its interference with such rules, also argues in favour of a restrictive treatment of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) such as to not cover an action for a declaration of non-infringement.

With regard to the *Tatry* decision of the ECJ on the interpretation of Article 21 of the Brussels Convention (which corresponds to Article 29 of the Brussels Ibis Regulation), the Advocate General accepted that

“(…) in matters relating to tort or delict, an action for a negative declaration may have the same object as the positive action of which it is the counterpart, in so far as one seeks a judicial declaration that a potential perpetrator has not committed a harmful act whereas the other seeks to establish the opposite [underscore added].”<sup>406</sup>

However, the Advocate General refused to apply the idea of this jurisprudence of the ECJ to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), because he was of the opinion that different issues were affected:

“(…) (I)n *Tatry*, the Court's ruling was concerned only with provisions relating to *lis pendens*, which do not as such lay down grounds of jurisdiction but merely determine which of the two courts seised concomitantly must give a ruling first. The issue was therefore very different from that before the Court in this case.”<sup>407</sup>

---

<sup>404</sup> As to Article 5(3) of the Brussels Convention: ECJ 10 June 2004, C-168/02, *Rudolf Kronhofer v Marianne Maier and Others*, [2004] ECR I-06009, para. 15 – *Kronhofer*; as to Article 5(3) of the Brussels I Regulation: ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, *eDate Advertising GmbH v X (C-509/09)* and *Oliver Martinez and Robert Martinez v MGN Limited (C-161/10)*, [2011] ECR I-10269, para. 40 – *eDate Advertising and Martinez*.

<sup>405</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 58, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>406</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 61, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>407</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 63, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

As a consequence, with regard to the requirement in Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) of a connecting factor between the action and the court invoked, *Advocate General Jääskinen* concluded that

“(…) although the notion of the object of the action does make it possible to define the scope of the dispute submitted to a court for the purposes of establishing *lis pendens* and the authority of *res judicata* arising from such a situation, in accordance with that judgment, this does not mean that that notion makes it possible to determine whether or not a given action exhibits the connecting factor required by Article 5(3) of Regulation (EC) No. 44/2001 [underscore added].”<sup>408</sup>

Concerning the relationship between the object of the action and the connecting factor within the framework of Article 5 of the Brussels I Regulation (Article 7 of the Brussels Ibis Regulation), the Advocate General gave clear prevalence to the latter aspect, referring to the formulation of this provision. He stated that

“(…) the form of words used in Article 5 of Regulation (EC) No 44/2001 means that jurisdiction is based not on the object of the action but on the connecting factor stipulated for each ground of jurisdiction, which, as a comparative analysis of the rules of jurisdiction contained in that article shows, are two different things. (…)”<sup>409</sup>

With regard to the argument put forward by proponents of a broad interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) according to which an action for a negative declaration would also be covered by this provision, as, under the other grounds of jurisdiction provided for in Article 5 of the Brussels I Regulation (Article 7 of the Brussels Ibis Regulation) both a positive action and an action for a negative declaration are covered, too,<sup>410</sup> the Advocate General undertook a clear differentiation. While admitting that in a situation not concerning tort or delict, the positive or negative nature of an action does not influence the connecting factor stipulated in the provisions of Article 5 of the Brussels I Regulation (Article 7 of the Brussels Ibis Regulation), he clearly expressed his opinion that

“(…) (i)n matters relating to tort or delict, on the other hand, the nature of the action is an essential criterion in determining jurisdiction, since what matters is the existence or otherwise of the harmful event determining the connecting factor [underscore added].”<sup>411</sup>

#### **2.2.2.1.3.4 Practical consequences of a broad interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation)**

Additionally, *Advocate General Jääskinen* underlined that practical considerations would militate against an interpretation of Article 5(3) of the Brussels I Regulation (Article 7(2) of

---

<sup>408</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 62, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>409</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 64, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>410</sup> Cf. Ten Wolde & Henckel (2013)3(2) *IJPL* 195, at p. 206.

<sup>411</sup> Advocate General 19 April 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 66, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

the Brussels Ibis Regulation) according to which an action for a negative declaration would fall within the scope of this provision. While conceding that the ECJ has, in its *Tatry*<sup>412</sup> and *Gasser*<sup>413</sup> decisions, generally<sup>414</sup> accepted the tactic of one party to “torpedo” or “short-circuit” the action of the other party by means of a *lis pendens* objection under Article 21 of the Brussels Convention (which structurally corresponds to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified), the Advocate General warned against a (potential) promotion of the torpedo tactic, emphasising that

“(…) accepting the proposition that an action for a negative declaration in a matter relating to a tort or delict may be based on the special ground of jurisdiction provided for in Article 5(3) of Regulation (EC) No 44/2001 could (...) exacerbate the risk of torpedo actions by giving the perpetrators of potentially harmful acts the option of bringing proceedings before a court other than that of the place in which the defendant is domiciled.”<sup>415</sup>

On the other hand, the Advocate General rejected the argument put forward by the French Government that the scope of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) should, while potentially also comprising an action for a negative declaration, be restricted in the way that

“(…) the authority of *res judicata* of the decision given on the basis of an action for a negative declaration such as that in the main proceedings should be confined in the territory of the Member State in which the competent court has its seat, given that actions of that type are not admissible as such in French law on non-contractual liability.”<sup>416</sup>

In this respect, *Advocate General Jääskinen* underlined that a different conception would not be in line with the system of the Brussels I Regulation (Brussels Ibis Regulation) which would lose its effectiveness if the effect of the decision of a court being competent on the basis of a consented ground of jurisdiction should be confined to the territory of the Member State in which that court is situated in the case that the legal or practical consequences of such consent turn out unacceptable. As to the latter aspect, the Advocate General emphasised that

“(…) (t)he purpose and very *raison d'être* of Regulation (EC) No 44/2001 is to lay down rules of jurisdiction which apply to the courts of all the Member States simultaneously and which ensure that for one and the same dispute a single decision is given that has international effects.”<sup>417</sup>

---

<sup>412</sup> ECJ 6 December 1994, C-406/92, The owners of the cargo lately laden on board the ship ‘Tatry’ v The owners of the ship ‘Maciej Rataj’, [1994] ECR I-05439 – *Tatry*.

<sup>413</sup> ECJ 9 December 2003, C-116/02, Erich Gasser GmbH v MISAT Srl, [2003] ECR I-14693 – *Gasser*.

<sup>414</sup> The finding of the ECJ in *Gasser* that “Article 21 of the Brussels Convention must be interpreted as meaning that it cannot be derogated from where, *in general*, the duration of proceedings before the courts of the Contracting State in which the court first seized is established is excessively long [accentuation added]” has been interpreted in the way that the ECJ did not exclude the possibility of another holding for particular situations, cf. Véron (2004)35(6) IIC 638, at p. 641.

<sup>415</sup> Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 70, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>416</sup> Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 67, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>417</sup> Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 69, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> (lastly accessed on 1 June 2015) – *Folien Fischer*.



#### 2.2.2.1.4 The *Folien Fischer* decision of the ECJ

In contrast to the Opinion of *Advocate General Jääskinen*, the ECJ held that Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) must be interpreted as meaning that an action for a negative declaration seeking to establish the absence of liability in tort, delict or quasi-delict, is covered by this legal provision.<sup>418</sup>

First of all, the ECJ made clear that on the basis of the wording of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) – “matters relating to tort, delict or quasi-delict” –

“(…) the possibility that an action for a negative declaration might fall within the scope of that provision cannot automatically be excluded.”<sup>419</sup>

The ECJ then confirmed its settled case-law, referring explicitly to its decisions in *Zuid-Chemie*<sup>420</sup> and *eDate Advertising and Martinez*<sup>421</sup>, that special jurisdiction according to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), as an exception from the general rule that jurisdiction lies with the courts of the defendant’s place of domicile,

“(…) is based on the existence of a particularly close connecting factor between the dispute and the courts of the place where the harmful event occurred or may occur, which justifies the attribution of jurisdiction to those courts for reasons relating to the sound administration of justice and the efficacious conduct of proceedings (…).”<sup>422</sup>

Grounds of proximity and ease of taking evidence being decisive as to the question of jurisdiction according to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), the ECJ, by reference to its *Wintersteiger*<sup>423</sup> decision, confirmed its settled jurisprudence that the formulation of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) – “place where the harmful event occurred or may occur” – covers

“(…) both the place where the damage occurred and the place of the event giving rise to that damage and, in consequence, the defendant may be sued, at the option of the applicant, in the courts of either of those places (…).”<sup>424</sup>

---

<sup>418</sup> Wittwer & Fussenegger (2013)21(4) ZEuP 812, at p. 820; Ten Wolde & Henckel (2013)3(2) IJPL 195, at p. 205; Thole (2013)66(17) NJW 1192, at p. 1193.

<sup>419</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 36, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>420</sup> ECJ 16 July 2009, C-189/08, *Zuid-Chemie BV v Philiplo’s Mineralenfabriek NV/SA*, [2009] ECR I-06917, para. 24 – *Zuid-Chemie*.

<sup>421</sup> ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, *eDate Advertising GmbH v X (C-509/09) and Oliver Martinez and Robert Martinez v MGN Limited (C-161/10)*, [2011] ECR I-10269, para. 40 – *eDate Advertising and Martinez*.

<sup>422</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 37, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>423</sup> ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 19, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>424</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 39, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

Referring to the Opinion of *Advocate General Jääskinen*, the ECJ underlined the special nature of an action for a negative declaration by which the claimant seeks to establish that the preconditions for liability are not fulfilled, meaning that

“(…) an action for a negative declaration entails a reversal of the normal roles in matters relating to tort or delict, since, in such an action, the claimant is the party against whom a claim based on a tort or delict might be made, while the defendant is the party whom that tort or delict may have adversely affected [underscore added].”<sup>425</sup>

However, in contrast to the Advocate General, the ECJ did not conclude from that reversal of the parties’ roles that an action for a negative declaration may *per se* not be covered by Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), because

“(t)he objectives, pursued by that provision (...) of ensuring that the court with jurisdiction is foreseeable and of preserving legal certainty are not connected either to the allocation of the respective roles of claimant and defendant or to the protection of either.”<sup>426</sup>

As a consequence, the ECJ held that

“(…) that reversal of roles is not such as to exclude an action for a negative declaration from the scope of point (3) of Article 5 Regulation No 44/2001.”<sup>427</sup>

Beyond responding to the argumentation put forth by the Advocate General in this respect, the ECJ held that during the stage at which the court verifies jurisdiction, it does neither examine the admissibility nor the substance of the application for a negative declaration in the light of the national law, but restricts itself to identify the points of connection with the Member State in which the court seised is sitting. In light of this, the ECJ held:

“In those circumstances, the special nature of the action for a negative declaration (...) has no bearing on the examination that the national court must carry out in order to determine whether it has jurisdiction in matters relating to tort, delict or quasi-delict, since the only matter to be established is whether there is a point of connection with the Member State in which the court seised is sitting.”<sup>428</sup>

In contrast to the Advocate General, the ECJ refused the conception that Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is meant to offer the weaker party stronger protection, comparably to the rules on jurisdiction laid down in Sections 3 to 5 of the Brussels I Regulation (Brussels Ibis Regulation). Rather, the ECJ underlined that

---

<sup>425</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 43, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>426</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 45, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>427</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 44, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>428</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 51, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

“(…) the application of point (3) of Article 5 [of the Brussels I Regulation] is not contingent upon the potential victim initiating proceedings [content in brackets added].”<sup>429</sup>

With regard to the argument put forth by *Advocate General Jääskinen* that an action for a negative declaration does not fall within the scope of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) because it does not seek to establish the liability of the defendant, but on the contrary, seeks to rule out the claimant’s liability, the ECJ admitted that the interests of the applicants of the respective actions are different. Despite of this, the ECJ found that in both cases

“(…) the examination undertaken by the court seised essentially relates to the same matters of law and fact.”<sup>430</sup>

In contrast to the conception of the Advocate General, who refused to apply the idea of the jurisprudence of the ECJ in *Tatry* to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), because he found that different issues were affected, the ECJ extended this jurisprudence to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) as well and, explicitly referring to *Tatry*, restated:

“(…) (A)n action seeking to have the defendant held liable for causing loss and ordered to pay damages has the same cause of action as an action brought by that defendant seeking a declaration that he is not liable for that loss [underscore added].”<sup>431</sup>

The *Bundesgerichtshof* founded its subsequent judgment on this jurisprudence of the ECJ.<sup>432</sup>

### 2.2.2.1.5 Comment

In *Folien Fischer*, the ECJ had – for the first time – the opportunity to comment on the controversy whether an action for a declaration of non-infringement falls within the scope of Article 7(2) (respectively its predecessor).<sup>433</sup> It is to be appreciated that the court did not follow the Opinion of the Advocate General who argued in favour of a conception according to which such an action would not be covered by Article 7(2) (respectively its predecessor), but decided in favour of an interpretation according to which Article 7(2) integrates an action for a negative declaration. This result is convincing in several respects: Neither the wording nor the purpose of Article 7(2) justify a different treatment of an action for damages against the alleged infringer of a patent by the presumed victim and an action for a declaration of non-infringement against the presumed victim by the alleged infringer. The fact that both actions actually concern the same cause of action becomes even more obvious when considering the constellation of an action for a positive declaration of infringement against the alleged infringer by the presumed victim and an action for a negative declaration against the

---

<sup>429</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 47, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>430</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 48, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>431</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 49, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> (lastly accessed on 1 June 2015) – *Folien Fischer*.

<sup>432</sup> BGH 29 January 2013, KZR 8/10, (2013)13(5) GRUR-RR 228 – *Trägermaterial für Kartenformulare II*.

<sup>433</sup> B. Sujecki (case note) ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, (2012)23(24) EuZW 952, at p. 953.

presumed victim by the alleged infringer. The only fact that should be decisive for the question if a court has jurisdiction to decide on a tort on the basis of Article 7(2) is whether there is a particularly close connecting factor between the dispute and the deciding court.<sup>434</sup> In this respect, it is essential that the ECJ explicitly stated that the purpose of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is not to serve the plaintiff's interests exclusively. The *Folien Fischer* decision of the ECJ is also consistent in light of the court's jurisprudence in *Gasser* that initiating (counter-)proceedings before a court where the duration of proceedings is generally considered to be excessively long does not justify to deviate from the rules of jurisdiction laid down in the Brussels I Regulation (Brussels Ibis Regulation).<sup>435</sup> In this respect, the mere possibility of torpedo actions should not be condemned *a priori*.<sup>436</sup> Only the existence of further circumstances may lead to the result that there is an abusive conduct. However, the examination of such additional circumstances is not possible at the place of jurisdiction according to Article 7(2).<sup>437</sup> After all, Article 7(2) does not contain any proviso of abuse ("*Missbrauchsvorbehalt*").

The *Folien Fischer* decision of the ECJ may indeed be called a landmark decision for international proceedings, because it ultimately confirms that torpedo actions are, in principle, an admissible means in European civil procedural law. Nonetheless, it must be stated, in spite of the principally positive incentive of the *Folien Fischer* decision, considerable problems with regard to *lis pendens* have been created by the integration of the action for a negative declaration into the framework of Article 7(2), arising from the relation between Article 7(2) and Article 29(1), at least on the basis of the current interpretation of these provision (respectively their predecessors) by the ECJ. While the court has constantly confirmed a narrow scope of authority to decide with regard to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), excluding contractual claims, the ECJ has constantly decided in favour of a broad effect of *lis pendens* according to Article 21 of the Brussels Convention/Article 27 of the Brussels I Regulation (structurally corresponding to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified). In this respect, the question arises whether the ECJ should modify its interpretation of the term "the same cause of action" according to Article 21(1) of the Brussels Convention/Article 27(1) of the Brussels I Regulation (Article 29(1) of the Brussels Ibis Regulation) in order to bring in line Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) and Article 21 of the Brussels Convention/Article 27 of the Brussels I Regulation (Article 29 of the Brussels Ibis Regulation).<sup>438</sup> For the current situation may lead to drastic gaps of legal protection.<sup>439</sup> For instance, the unsolved question already arises with regard to "*Platzdelikte*" whether an action for a negative declaration raised on the basis of Article 7(2) will have the general effect of *lis pendens* with accordance to Article 29(1) regarding a positive action for damages –

<sup>434</sup> Thole (2013)66(17) NJW 1192, at p. 1193.

<sup>435</sup> ECJ 9 December 2003, C-116/02, *Erich Gasser GmbH v MISAT Srl*, [2003] ECR I-14693, paras. 70-73 – *Gasser*.

<sup>436</sup> More critical towards torpedo actions in general: C. Vanleenhove (case note) ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, (2013)31(1) NIPR 25, at p. 28. *Vanleenhove* rightly points out however that the problem of such torpedo litigation will be mitigated by Article 31(2) of the Brussels Ibis Regulation, according to which, where a court of a Member State is seised on which parties have agreed to confer exclusive jurisdiction, any court of another Member State shall stay the proceedings until such time as the court seised on the basis of the agreement declares that it has no jurisdiction under the agreement.

<sup>437</sup> Sujecki (2012)61(1) GRUR Int. 18, at p. 23; B. Sujecki (case note) ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, (2012)23(24) EuZW 952, at p. 953.

<sup>438</sup> Cf. R. Magnus (case note) ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, (2013) LMK 341419.

<sup>439</sup> Gebauer (2013)21(4) ZEuP 870, at p. 875.

which is eventually also based on a contract.<sup>440</sup> Even more significantly, the same question arises with regard to “*Streudelikte*”, be it concerning actions at several places where the damage occurred or will occur in terms of Article 7(2), be it in case of actions at the place of the event giving rise to the damage and at the place where the damage occurred, be it in case of actions at several places where courts have unrestricted authority to decide like at the place of the event giving rise to the damage and the place of domicile of the defendant. In all these constellations, an answer needs to be found as to the problem arising where an action for a negative declaration against the presumed victim raised before court A bars an action for damages against the alleged infringer to be raised before court B.<sup>441</sup>

Another problem which has been created by the *Folien Fischer* decision of the ECJ – and which is still unsolved – is, in case of several alleged infringers of a patent, whether the raise of an action for a declaration of non-infringement by one infringer before any court within the European Union having jurisdiction according to Article 7(2) can bar an action for damages by the presumed victim on the basis of Article 8(1).<sup>442</sup> At this place, it may suffice to state that these scenarios illustrate that the ECJ will have to define more clearly respectively redefine in which case several actions have the same cause of action rather than – which is without doubt a positive first step – merely opening the scope of application of Article 7(2). Unfortunately, the recast of the Brussels I Regulations has not brought a significant amelioration of this structural problem.

### 2.2.2.2 Applicability of Article 7(2) to a preventive action for an injunction

With regard to Article 5(3) of the Brussels Convention (and Article 5(3) of the Lugano Convention), it was controversial whether this provision covered preventive actions for an injunction, because the provision read:

#### Article 5(3) of the Brussels Convention/Lugano Convention

A person domiciled in a Contracting State may, in another Contracting State, be sued:

(...)

in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred.

The formulation “occurred”, in opposition to the wording “occurred or may occur” which was introduced by Article 5(3) of the Brussels I Regulation (and is also contained in Article 7(2) of the Brussels Ibis Regulation), could also be interpreted as to require that a damage must already have arisen when the action for an injunction is being instituted. While the majority of legal commentators favoured a broad interpretation of Article 5(3) of the Brussels Convention such as to also comprise preventive actions for an injunction,<sup>443</sup> the case-law of the Contracting States of the Brussels Convention tended to deny the applicability of Article 5(3)

---

<sup>440</sup> Gebauer (2013)21(4) ZEuP 870, at p. 879.

<sup>441</sup> Gebauer (2013)21(4) ZEuP 870, at p. 881 et seq.

<sup>442</sup> Gebauer (2013)21(4) ZEuP 870, at p. 885.

<sup>443</sup> Cf. for instance: Behr (1992)41(8-9) GRUR Int. 604, at p. 607; Geimer 2010 (Geimer & Schütze, *Europäisches Zivilverfahrensrecht*), Art. 5 EuGVVO, para. 229; Geimer 2015, para. 1522 (with reference to the Lugano Convention and further references to case-law); Schack 2010, para. 333..

of the Brussels Convention to such actions.<sup>444</sup> In its *Henkel* decision from 2002, the ECJ made clear that, beyond the pure wording of Article 5(3) of the Brussels Convention, actions for an injunction could be initiated although no damage had occurred yet; as a consequence, the court stated that preventive actions for an injunction were subject to Article 5(3) of the Brussels Convention. The court explicated in detail:

“(…) The courts for the place where the harmful event occurred are usually the most appropriate for deciding the case, in particular on the grounds of proximity and ease of taking evidence. Those considerations are equally relevant whether the dispute concerns compensation for damage which has already occurred or relates to an action seeking to prevent the occurrence of damage.

That interpretation is moreover supported by the Report by Professor Schlosser on the Convention on the Accession of the Kingdom of Denmark, Ireland and the United Kingdom of Great Britain and Northern Ireland to the Brussels Convention (OJ 1979 C 59, pp. 71, 111), which states that Article 5(3) of the Brussels Convention also covers actions whose aim is to prevent the imminent commission of a tort (or delict).

It is therefore not possible to accept an interpretation of Article 5(3) of the Brussels Convention according to which application of that provision is conditional on the actual occurrence of damage. Furthermore, it would be inconsistent to require that an action to prevent behaviour considered to be unlawful, such as that brought in the main proceedings, whose principal aim is precisely to prevent damage, may be brought only after that damage has occurred [underscores added].”<sup>445</sup>

In view of the Brussels I Regulation, which had already been established when the ECJ decided, the court further left no doubt that preventive actions for an injunction fall within the scope of Article 5(3) of the Brussels Convention:

“Finally, Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1), while not applicable *ratione temporis* to the main proceedings, is such as to confirm the interpretation that Article 5(3) of the Brussels Convention does not presuppose the existence of damage. That regulation clarified the wording of Article 5(3) of the Brussels Convention that the new version of that provision resulting from that regulation refers to the place where the harmful event occurred or may occur’. In the absence of any reason for interpreting the two provisions in question differently, consistency requires that Article 5(3) of the Brussels Convention be given a scope identical to that of the equivalent provision of Regulation No 44/2001. This is all the more necessary given that that regulation is intended to replace the Brussels Convention in relations between Member States with the exception of the Kingdom of Denmark, with that convention continuing to apply between the Kingdom of Denmark and the Member States bound by that regulation [underscore added].”<sup>446</sup>

The ECJ subsequently confirmed this jurisprudence in *DFDS Torline* where the court held:

“(…) (T)he Court has already held that it is not possible to accept an interpretation of Article 5(3) of the Brussels Convention according to which application of that provision is conditional on the actual occurrence of damage. Likewise it has held that the finding that the courts for the place where the harmful event occurred are usually the most appropriate for deciding the case, in particular on the grounds of proximity and ease of taking evidence, is equally relevant whether the dispute concerns compensation for damage which has already occurred or relates to an action seeking to prevent the

<sup>444</sup> Cf. for instance LG Bremen 28 March 1991, 12 O 729/89, (1991)37(5) RIW 416; OLG Bremen 17 October 1991, 2 U 34/91, (1992)38(3) RIW 231; Rb. Middelburg 24 April 1987, Case No. KG40/1987, *De Stichting Natuur en Milieu and Others (Netherlands) v NV Verenigde Energiebedrijven van het Scheldeland EBES* (Belgium), NJ 1989, 744, para. 3.3; deciding in favour of the application of Article 5(3) of the Brussels Convention to preventive actions for an injunction: LG Düsseldorf 25 March 1999, 4 O 198/97, (1999)48(8-9) GRUR Int. 775 – *Impfstoff II*.

<sup>445</sup> ECJ 1 October 2002, C-167/00, *Verein für Konsumenteninformation v Karl Heinz Henkel*, [2002] ECR I-08111, paras. 46-48 – *Henkel*.

<sup>446</sup> ECJ 1 October 2002, C-167/00, *Verein für Konsumenteninformation v Karl Heinz Henkel*, [2002] ECR I-08111, para. 49 – *Henkel*.

occurrence of damage (Case C-167/00 Henkel [2002] ECR I-8111, paragraphs 46 and 48) [underscore added].”<sup>447</sup>

The extension of the text of Article 5(3) in the Brussels I Regulation (“... or may occur”) – which is also part of Article 7(2) of the Brussels Ibis Regulation – ultimately made clear that preventive actions for an injunction fall within the scope of Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation).<sup>448</sup> The facts in the *Henkel* case being characterised by the constellation of the danger of repetition (“*Wiederholungsgefahr*”), the ECJ did not have to decide whether a preventive action for an injunction also falls within the scope of Article 5(3) of the Brussels Convention in case of the danger of first infringement (“*Erstbegehungsgefahr*”). As this dispute already existed before the creation of the Brussels I Regulation, it has rightly been concluded that the European legislator, by creating Article 5(3) of the Brussels I Regulation, did not intend to differentiate between those two constellations, meaning that both constellations are covered by Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation).<sup>449</sup> Additionally, it is to be emphasised that conferring jurisdiction according to Article 7(2) bears particular practical importance in the constellation of the danger of first infringement, because, in case that a harmful event has occurred before (constellation of the danger of repetition), jurisdiction pursuant to Article 7(2) already exists for this reason.<sup>450</sup> Furthermore, it is to be noticed that the particular close connection between the dispute and the deciding court which is decisive for Article 7(2) is existent both in the case of the danger of first infringement and in the case of the danger of repetition.<sup>451</sup> Therefore, both constellations fall within the scope of application of Article 7(2).<sup>452</sup>

While determining “the place where the harmful event may occur” can be more complicated in the constellation of the danger of first infringement than in the constellation of the danger of repetition, because subjective aspects will be decisive,<sup>453</sup> that obstacle is manageable in the case of potential infringement of intellectual property rights, as the *Landgericht Düsseldorf* proved in its *Impfstoff II* decision.<sup>454</sup> In this decision based on the constellation of the danger of first infringement, the court referred, by application of a comparative approach concerning the national laws of the Contracting States of the Brussels Convention, both to the place where the infringing act is to be expected, and to the place where the protected right is situated.<sup>455</sup> As it is probable that the patent holder, in case of an imminent patent infringement, will usually initiate infringement proceedings before the courts of the State where the patent has been granted, the determination of the “place where the harmful event will occur” should be feasible.<sup>456</sup> At any rate, jurisdiction according to Article 7(2) requires that a future harmful event can be based on *concrete* facts, while the mere vague possibility

---

<sup>447</sup> ECJ, 5 February 2004, C-18/02, Danmarks Rederiforening, acting on behalf of DFDS Torline A/S, v LO Landsorganisationen i Sverige, acting on behalf of SEKO Sjöfolk Facket För Service och Kommunikation, [2004] ECR I-01417, para. 27 – *DFDS Torline*.

<sup>448</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 228; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, paras. 2 and 8; Nagel & Gottwald 2013, § 3, para. 90; Lundstedt & Maunsbach (2003) 72(3) NIR 212, at p. 216; Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 5, para. 65.

<sup>449</sup> Hye-Knudsen 2005, p. 113.

<sup>450</sup> Hye-Knudsen 2005, p. 113.

<sup>451</sup> Grabinski (2001) 50(3) GRUR Int. 199, at p. 203.

<sup>452</sup> Heinze 2007, pp. 214-215; Nagel & Gottwald 2013, § 3, para. 90.

<sup>453</sup> Hye-Knudsen 2005, p. 114.

<sup>454</sup> LG Düsseldorf 25 March 1999, 4 O 198/97, (1999) 48(8-9) GRUR Int. 775 – *Impfstoff II*.

<sup>455</sup> LG Düsseldorf 25 March 1999, 4 O 198/97, (1999) 48(8-9) GRUR Int. 775, at p. 778 – *Impfstoff II*.

<sup>456</sup> Hye-Knudsen 2005, p. 114.

that such a harmful event could occur sometime does not suffice.<sup>457</sup> This requirement will definitely be fulfilled in the case of the danger of repetition.<sup>458</sup>

### 2.2.2.3 Inapplicability of Article 7(2) to competing contractual actions

In its *Kalfelis* decision, the ECJ clearly decided that jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) does not authorise a court to decide also on competing contractual actions. Emphasising the character of Article 5 of the Brussels Convention (Article 7 of the Brussels Ibis Regulation) – like Article 6 of the Brussels Convention (Article 8 of the Brussels Ibis Regulation) – as exceptions from the general jurisdictional rule (*forum sitae defensoris*) of Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation), the court held that

“(…) the “special jurisdictions” enumerated in Articles 5 and 6 of the [Brussels] Convention constitute derogations from the principle that jurisdiction is vested in the courts of the State where the defendant is domiciled and as such must be interpreted restrictively . It must therefore be recognized that a court which has jurisdiction under Article 5(3) over an action in so far as it is based on tort or delict does not have jurisdiction over that action in so far as it is not so based [underscore and content in brackets added].”<sup>459</sup>

The fact that Article 8(1) provides for the possibility to initiate a joint proceeding against several defendants being domiciled in different Member States – which structurally constitutes a violation of the principle of Article 4(1) by the Brussels Ibis Regulation itself – does not justify the establishment of an annex competence<sup>460</sup> of courts having jurisdiction according to Article 7(2) for contractual issues,<sup>461</sup> because the ECJ explicitly excluded such an approach in *Réunion Européenne* where the court stated:

“(…) (T)wo claims in one action for compensation, directed against different defendants and based in one instance on contractual liability and in the other on liability in tort or delict cannot be regarded as connected.”<sup>462</sup>

Moreover, such an annex competence cannot be based on Article 30(1) either, because the latter provision presupposes that the invoked court already has jurisdiction, but does not establish jurisdiction of a court on the basis of a connection between several actions.<sup>463</sup>

As a consequence, if the alleged infringer is also a licence holder of the concerned patent, the court invoked in patent infringement proceedings on the basis of Article 7(2) cannot decide on

---

<sup>457</sup> Kropholler & Von Hein 2011, Art. 5 EuGVO, para. 76; Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 84; Cour d'appel d'Orléans 6 May 2003, (2004)93(1) Rev. crit. DIP 139, with case note H. Gaudemet-Tallon; Heinze 2007, p. 215.

<sup>458</sup> Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 84.

<sup>459</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 19 – *Kalfelis*.

<sup>460</sup> In favour of such an annex competence of the invoked court: Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 222.

<sup>461</sup> Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 82.

<sup>462</sup> ECJ 27 October 1998, C-51/97, Réunion Européenne SA and Others v Spliethoff's Bevrachtungskantoor BV, and the Master of the vessel Alblasgracht V002, [1998] ECR I-06511, para. 50 – *Réunion Européenne*.

<sup>463</sup> Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 82; ECJ 24 June 1981, C-150/80, Elefanten Schuh GmbH v Pierre Jacmain, [1981] ECR 01671, para. 19 – *Elefanten Schuh*; ECJ 27 October 1998, C-51/97, Réunion Européenne SA and Others v Spliethoff's Bevrachtungskantoor BV, and the Master of the vessel Alblasgracht V002, [1998] ECR I-06511, para. 39 – *Réunion Européenne*; ECJ 5 October 1999, C-420/97, Leathertex Divisione Sintetici SpA v Bodeltex BVBA, [1999] ECR I-06747, para. 38 – *Leathertex*.



eventual contractual claims arising from the contractual relationship between the defendant and the plaintiff, but is restricted to decide on the patent infringement as a tort.

### 2.2.3 The applicability of the principle of ubiquity to the constellation of patent infringement (determination of the place of the infringing event in terms of Article 7(2))

It is undisputed that the courts of the State where the patent has been granted have jurisdiction according to Article 7(2) with regard to patent infringement proceedings. However, it is highly controversial whether, *beyond this*, courts outside this State can have jurisdiction with accordance to Article 7(2) in the case of patent infringement, i.e. whether Article 7(2) can serve as the basis for extraterritorial jurisdiction in patent infringement proceedings. In its *Mines de Potasse* decision, the ECJ, pursuing the approach of an independent interpretation, clarified that

“(…) where the place of the happening of the event which may give rise to liability in tort, delict or quasidelict and the place where that event results in damage are not identical, the expression ‘place where the harmful event occurred’, in Article 5(3) of the [Brussels] Convention, must be understood as being intended to cover both the place where the damage occurred and the place of the event giving rise to it.

The result is that the defendant may be sued, at the option of the plaintiff, either in the courts for the place where the damage occurred or in the courts for the place of the event giving rise to and is at the origin of that damage [underscore and content in brackets added].”<sup>464</sup>

In light of the extended wording (“or may occur”) in comparison to Article 5(3) of the Brussels Convention since the creation of Article 5(3) of the Brussels I Regulation and being also part of Article 7(2) of the Brussels Ibis Regulation, the *Mines de Potasse* decision of the ECJ must be understood as also comprising constellations of imminent infringement. Starting from *Mines de Potasse*, I shall analyse whether, respectively in which way that jurisprudence is to be applied to patent infringement proceedings. The first question to ask in this respect is whether a separation between the place where the event giving rise to the damage (“*Handlungsort*”) and the place where the harmful event occurred (or may occur) (“*Erfolgort*”) is *possible* in the case of patent infringement, respectively, in case it is, whether such a differentiation *makes sense* as to the application of Article 7(2) in the case of patent infringement proceedings.

It has been discussed controversially, in conjunction with disputes concerning the infringement of intellectual property rights, whether these two jurisdictional heads can operate independently of each other.<sup>465</sup> According to the prevailing opinion in legal doctrine and case-law of the Member States, the place where the harmful event occurred or may occur is always situated in the State where the patent has been granted, having the effect that a choice according to the *Mines de Potasse* decision of the ECJ does not exist concerning patent infringement proceedings. Proponents of this opinion derive this result from the principle of territoriality according to which a (national or European) patent granted in one State does not have any effect in another State, and consequently cannot be infringed by an acting committed abroad.<sup>466</sup> Nonetheless, other legal scholars advocate the possibility of extraterritorial

---

<sup>464</sup> ECJ 30 November 1976, C-21/76, *Handelskwekerij G. J. Bier B.V. v Mines de Potasse d’Alsace S.A.*, [1976] ECR 01735, paras. 24-25 – *Mines de Potasse*.

<sup>465</sup> Lundstedt & Maunsbach (2003)72(3) NIR 212, at p. 215; Lundstedt (2008)77(2) NIR 122, at p. 130.

<sup>466</sup> Cf. for instance: Rogge & Grabinski 2006 (Benkard – Patentgesetz), § 139 PatG, para. 101b; Bettinger & Thum (1999)48(8-9) GRUR Int. 659, at p. 664; Brinkhof (1997)46(6) GRUR Int. 489, at p. 491; Bukow 2003, pp. 40-74; Fawcett & Torremans 2011, para. 5.50; Grabinski (2001)50(3) GRUR Int. 199, at p. 204; Heinze

jurisdiction on the basis of Article 7(2) (respectively its predecessors) also with regard to patent infringement proceedings.<sup>467</sup> According to the latter opinion, such extraterritorial jurisdiction can potentially be grounded either on the place of the event giving rise to the damage or the place where the harmful event occurred or may occur. In the following paragraphs, I shall first deal with the question of whether, concerning patent infringement, a place of the event giving rise to the damage can exist outside the State where the patent has been granted. Subsequently, I shall treat the parallel issue whether a place where the harmful event occurred or may occur can be situated outside the State for whose territory a patent has been granted.

### 2.2.3.1 Extraterritorial place of the event giving rise to the damage

Can, concerning a patent infringement, a place of the event giving rise to the damage exist outside the protection State? First of all, it is noteworthy that the question of the existence of a place of the event giving rise to the damage in matters of patent infringement becomes relevant in two constellations.<sup>468</sup> On the one hand, one might think of acts being committed abroad and having effect in the State where the patent is protected (*“nach innen gerichtete Handlungen”*). That constellation may be illustrated by the following case:

Patent holder P holds a European patent for a machine for the territories of Germany and the Netherlands. Infringer INF manufactures an identical machine in France and sells it, *inter alia*, in Germany and the Netherlands.

On the other hand, it is conceivable that acts are committed within the State where the patent is protected, but are exclusively aimed at another State in which no patent protection exists (*“nach außen gerichtete Handlungen”*). In this respect, the following case may serve for illustration:

Patent holder P holds a European patent for a machine for the territories of Germany and the Netherlands. Infringer INF manufactures an identical machine in Germany for exclusive sale in France.

While, as has been illustrated above, the prevailing opinion in legal doctrine and case-law of the Member States advocates a conception according to which, due to the principle of territoriality, the existence of an extraterritorial place of the event giving rise to the damage is

---

2007, p. 221 et seq., 231; Kieninger (1998)47(4) GRUR Int. 280, at p. 282; Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 85a; Sack (2000)46(3) WRP 269, at p. 271; Treichel 2001, p. 24; BGH 17 March 1994, I ZR 304/91, (1994)96(7) GRUR 530, at p. 531 – *Beta*; OLG Düsseldorf 22 July 1999, 2 U 127/98, (2001)21(4) IPRax 336, at p. 338 – *Schussfadengreifer II*; LG Düsseldorf 25 August 1998, 4 O 165/97, (1999)48(5) GRUR Int. 455, at p. 457 – *Schussfadengreifer I*; LG Düsseldorf 25 March 1999, 4 O 198/97, (1999)48(8-9) GRUR Int. 775, at p. 777 – *Impfstoff II*; BGer 23 October 2006, 4C.210/2006, (2007)56(6) GRUR Int. 534, at p. 535.

<sup>467</sup> Cf. for instance: Nuyts 2008, p. 105 et seq.; Pansch (2000/01)1(5) EuLF 353, at pp. 354-356; Pansch 2003, p. 274 et seq.; Reichardt 2006, p. 44 et seq.; Adolphsen 2009, paras. 479 et seq.; sceptically: Keukenschrijver 2013 (Busse – Patentgesetz), § 143 PatG, para. 16; Franzosi (1997)19(7) E.I.P.R. 382, at p. 383; Hausmann (2003)3(5/6) EuLF 277, at pp. 279-280; Hye-Knudsen 2005, p. 65 et seq.; Kubis 1999, pp. 227-230; Laubinger 2005, pp. 44, 52 et seq.; Otte (2001)21(4) IPRax 315, at p. 317; Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 227; Nagel & Gottwald 2013, § 3, para. 85; Schack 2010, para. 347; Schack (2000)3(3) MMR 135, at p. 137; Fezer & Koos 2010 (Staudinger), para. 1138; Uhl 2000, p. 191; Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 794; as to copyright law: Jooris (1996)18(3) E.I.P.R. 127, at p. 140 (*Jooris* underlines that a distinction has to be drawn between the effects and the causes of the infringement).

<sup>468</sup> The following classification has been chosen according to Geller (2000)49(8-9) GRUR Int. 659, at p. 663 and Schauwecker 2009, p. 100.

excluded *a priori*, others have argued that that result would be contrary to the idea of Article 7(2) (respectively its predecessors) which is to ensure that a court decides which is particularly close to facts and evidence.

#### **2.2.3.1.1 Starting point: The principle of territoriality as a principle of substantive law**

According to the principle of territoriality, a principle of substantive law, patent protection geographically covers merely the territory of the State where the patent has been granted. Patent infringement requires a use without approval of the patent holder on (within) the territory of the State where patent protection has been acquired ("*Schutzland*"). As a consequence, a patent infringement by merely acting in another State is *a priori* impossible. However, it is recognised that, in certain circumstances, the principle of territoriality does not preclude that parts of the infringing act can be realised outside the protection State ("*Auslandssachverhalt*").

#### **2.2.3.1.2 Is the principle of territoriality (although being a principle of substantive law) also relevant with regard to the determination of the place where the harmful event occurred according to Article 7(2)?**

Subsequently to its decision in *Mines de Potasse*, where the ECJ held that the place where the harmful event occurred according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is to be interpreted independently, the court held in *Marinari* that substantive law (the *lex causae*) is not decisive for the determination of that place<sup>469</sup>:

"It must (...) be noted that the [Brussels] Convention did not intend to link the rules on territorial jurisdiction with national provisions concerning the conditions under which non-contractual civil liability is incurred. Those conditions do not necessarily have any bearing on the solutions adopted by the Member States regarding the territorial jurisdiction of their courts, such jurisdiction being founded on other considerations.

There is no basis for interpreting Article 5(3) of the [Brussels] Convention by reference to the applicable rules on non-contractual civil liability, as proposed by the German Government. That interpretation is also incompatible with the objective of the Convention, which is to provide for a clear and certain attribution of jurisdiction (...). The delimitation of jurisdiction would then depend on uncertain factors such as the place where the victim's assets suffered subsequent damage and the applicable rules on civil liability [underscores and content in brackets added]."<sup>470</sup>

In this respect, it could be put forth that the cited jurisprudence of the ECJ does not preclude to take into account the principle of territoriality in conjunction with the determination of the place where the harmful event occurred according to Article 7(2), because the principle of territoriality does not constitute a particularity of a specific national law but forms a principle which is *generally (internationally)* accepted and applied. Consequently, the requirements of legal certainty and predictability would be met and fulfilled if that principle was also applied to Article 7(2).<sup>471</sup>

---

<sup>469</sup> Nuyts 2008, p. 122; Von Hein (2005)25(1) IPRax 17, at p. 22, additionally underlining that the *Shevill* decision of the ECJ does not lead to another view either.

<sup>470</sup> ECJ 19 September 1995, C-364/93, Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company, [1995] ECR I-02719, paras. 18-19 – *Marinari*.

<sup>471</sup> Bukow 2003, pp. 71-73; Heinze 2007, pp. 223-224.

However, such an argumentation would unduly mingle the areas of substantive and procedural law and is thus to be rejected *a priori*. The mere fact that any positive effects (as legal certainty and predictability) would be reached by applying the principle of territoriality to the jurisdictional issue, respectively any negative effects (as the creation of legal uncertainty and unpredictability) could be avoided, cannot justify such a schematic (structural) break.

While, in light of the foregoing, it is to be stated that the principle of territoriality, as a principle of substantive law, does not have an immediate (direct) effect on the issue of jurisdiction, an issue of procedural law, it would seem a hasty conclusion to derive from this result that the principle of territoriality does not have any effect on the question where the place where the harmful event occurred, according to Article 7(2). It could rather be that the principle of territoriality has a *mediate (indirect)* effect on the determination of the relevant place pursuant to Article 7(2). This would be the case if Article 7(2) was linked with the *substantive* facts. In other words, it is to be analysed whether the part of the act which is referred to for determining the place where the harmful event occurred according to Article 7(2), must be (at least a part of) the infringing act according to substantive law. If the answer to this question was yes, the conclusion would have to be drawn that an extraterritorial place where the harmful event occurred according to Article 7(2) would be excluded due to the mediate (indirect) effect of the principle of territoriality which excludes that an element of the facts is realised outside the protection State. Alternatively, if the addressed analysis revealed the result that the act to which Article 7(2) refers is completely independent from the substantive facts, i.e. the infringing act according to substantive law, the principle of territoriality would not represent any obstacle, i.e. no mediate (indirect) obstacle either, for the existence of an extraterritorial place where the harmful event occurred according to Article 7(2).<sup>472</sup> In light of this finding, it is to be underlined that the decisive factor for the addressed analysis is not the principle of territoriality – which as such is not controversial – but rather the interpretation of Article 7(2). In this respect, it is noteworthy that the Jenard Report explicitly does not clarify that issue, but restricts itself to the following formulation:

“Article 5(3) [of the Brussels Convention] uses the expression 'the place where the harmful event occurred'. The Committee did not think it should specify whether that place is the place where the event which resulted in damage or injury occurred or whether it is the place where the damage or injury was sustained. The Committee preferred to keep to a formula which has already been adopted by number of legal systems (Germany, France) [content in brackets added].”<sup>473</sup>

Consequently, interpretation, i.e. concretion of what is the meaning of the expression “place where the harmful event occurred”, is allocated to the courts. In the following paragraphs, I shall therefore analyse relevant case-law of the ECJ with regard to this matter.

---

<sup>472</sup> Similar: Schauwecker 2009, p. 102.

<sup>473</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF> (lastly accessed on 1 June 2015), p. 26.

### 2.2.3.1.3 The determination of the place where the harmful event occurred according to Article 7(2) on the basis of ECJ case-law

#### 2.2.3.1.3.1 Aspects which suggest that the ECJ advocates a conception according to which the place where the harmful event occurred according to Article 7(2) is completely independent from the place of the infringing act according to substantive law

Since its *Mines de Potasse* decision, the ECJ has constantly used the terms of “*place of the event giving rise to the damage*” and “*place where the damage occurred*”.<sup>474</sup> The expression “place of the event giving rise to the damage” is, as such, broad enough to cover all acts which in some way have effected the occurrence of the damage without necessarily forming part of the facts which constitute the infringing act according to substantive law.<sup>475</sup>

In its *Marinari* decision, the ECJ held that substantive law is irrelevant for the determination of that place, because otherwise the principle of legal certainty as to the attribution of jurisdiction would be impaired<sup>476</sup>:

“It must (...) be noted that the [Brussels] Convention did not intend to link the rules on territorial jurisdiction with national provisions concerning the conditions under which non-contractual civil liability is incurred. Those conditions do not necessarily have any bearing on the solutions adopted by the Member States regarding the territorial jurisdiction of their courts, such jurisdiction being founded on other considerations.

There is no basis for interpreting Article 5(3) of the [Brussels] Convention by reference to the applicable rules on non-contractual civil liability, as proposed by the German Government. That interpretation is also incompatible with the objective of the Convention, which is to provide for a clear and certain attribution of jurisdiction (...). The delimitation of jurisdiction would then depend on uncertain factors such as the place where the victim’s assets suffered subsequent damage and the applicable rules on civil liability [underscores and content in brackets added].”<sup>477</sup>

That jurisprudence was rendered in reaction to the written observation of the German Government which had submitted that

“(...) in interpreting Article 5(3) of the [Brussels] Convention, the Court should take account of the applicable national law on non-contractual civil liability. Thus, where, under that law, an actual adverse effect on goods or rights is a precondition for liability (as, for instance, under paragraph 823(1) of the Bürgerliches Gesetzbuch – the German Civil Code), the “place where the harmful event occurred” means both the place of that adverse effect and the place of the event giving rise to it. On the other hand, it considers that where national law does not make redress conditional upon an actual adverse effect upon property or a right (as, for instance, under Article 1382 of the French Civil Code and Article 2043 of the Italian Civil Code), the victim may choose between the place of the event giving rise to the damage and the place where he suffered financial damage [underscore and content in brackets added].”<sup>478</sup>

---

<sup>474</sup> ECJ 30 November 1976, C-21/76, *Handelskwekerij G. J. Bier B.V. v Mines de Potasse d’Alsace S.A.*, [1976] ECR 01735, paras. 15 and 19 – *Mines de Potasse*.

<sup>475</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 214; Bukow 2003, pp. 55-56.

<sup>476</sup> Nuyts 2008, p. 122.

<sup>477</sup> ECJ 19 September 1995, C-364/93, *Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company*, [1995] ECR I-02719, paras. 18-19 – *Marinari*.

<sup>478</sup> ECJ 19 September 1995, C-364/93, *Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company*, [1995] ECR I-02719, para. 16 – *Marinari*.

According to settled case-law of the ECJ, the aspect of factual proximity between the case and the deciding court are of special importance in the framework of Article 7(2). For instance, the ECJ held in *Folien Fischer*:

“In matters of tort or delict, the courts of the place where the harmful event occurred or may occur are usually the most appropriate for deciding the case, in particular on grounds of proximity and ease of taking evidence (see, to that effect, Case C-167/00 Henkel [2002] ECR I-8111, paragraph 46, and *Zuid-Chemie*, paragraph 24) [underscore added].”<sup>479</sup>

Given that particular importance attributed to factual proximity, one might assume that the ECJ would not feel barred from localising a place of the event giving rise to the damage, according to Article 7(2), somewhere else than at the place of the substantive facts of a patent infringement, in case that it should turn out that evidence can be gained more easily there.<sup>480</sup>

#### **2.2.3.1.3.2 Aspects which suggest that the ECJ advocates a conception according to which the place where the harmful event occurred according to Article 7(2) is indirectly linked with the place of the infringing act according to substantive law**

However, despite the above explanation which derives the conclusion from the jurisprudence of the ECJ that the court clearly differentiates between the facts of a tort according to substantive law and the place where the event giving rise to the damage occurs pursuant to Article 7(2), avoiding to mingle both aspects, doubts remain whether the ECJ indeed in any way ignores the substantive facts of a tort when determining the place of jurisdiction according to Article 7(2).

First of all, it should be borne in mind that the ECJ has constantly emphasised that Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) is an exception to the basic provision of Article 2(1) of the Brussels Convention/Brussels I Regulation (Article 4(1) of the Brussels Ibis Regulation) and must therefore be interpreted restrictively, in order to avoid a multiplication of *fora* in favour of the plaintiff.<sup>481</sup>

Referring to the above argumentation based on the *Marinari* decision of the ECJ, it is to be noticed that the ECJ primarily intended to exclude places of subsequent damage (“*Folgeschäden*”) from the scope of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), which is revealed by the following sentence in the ECJ’s decision:

“(…) The delimitation of jurisdiction would then depend on uncertain factors such as the place where the victim’s assets suffered subsequent damage and the applicable rules on civil liability [underscore added].”<sup>482</sup>

In its *Dumez* decision, the ECJ explicated:

---

<sup>479</sup> ECJ 25 October 2012, C-133/11, *Folien Fischer AG and Fofitec AG v Ritrama SpA*, para. 38, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> – *Folien Fischer*.

<sup>480</sup> Similar: Schauwecker 2009, p. 113.

<sup>481</sup> Bukow 2003, p. 59; Neuhaus (1996)87(9) Mitt. 257, at p. 264.

<sup>482</sup> ECJ 19 September 1995, C-364/93, *Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company*, [1995] ECR I-02719, para. 19 – *Marinari*.

“(…) (W)hilst the place where the initial damage manifested itself is usually closely related to the other components of the liability, in most cases the domicile of the indirect victim is not so related.”<sup>483</sup>

As the ECJ thus construed a relation between the place where the initial damage occurred – being relevant for Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) – and the other components of liability, one might conclude *a contrario* that the damage, in order to confer jurisdiction to the courts at the place where it occurs must be part of the substantive facts of the patent infringement.<sup>484</sup>

Further, the ECJ held in *Kronhofer*:

“(…) (T)here is nothing (…) to justify conferring jurisdiction to the courts of a Contracting State other than that on whose territory the event which resulted in the damage occurred and the damage was sustained, that is to say all of the elements which give rise to liability. To confer jurisdiction in that way would not meet any objective need as regards evidence or the conduct of the proceedings.”<sup>485</sup>

Formulating in this way, the ECJ construed a relation between the place of jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) and the place where all elements giving rise to liability, i.e. the substantive facts, have been realised.

In its *Tessili* decision on the interpretation of Article 5(1) of the Brussels Convention, the ECJ generally postulated that the interpretation of terms of the Brussels Convention (and the same applies to the Brussels I Regulation and the Brussels Ibis Regulation) can equally be undertaken according to the *lex fori* or the *lex causae*:

“The [Brussels] Convention frequently uses words and legal concepts drawn from civil, commercial and procedural law and capable of different meaning from one Member State to another. The question therefore arises whether these words and concepts must be regarded as having their own independent meaning and as being thus common to all the Member States or as referring to substantive rules of the law applicable in each case under the rules of conflict of laws of the court before which the matter is first brought.

Neither of these two options rules out the other since the appropriate choice can only be made in respect of each of the provisions of the [Brussels] Convention to ensure that it is fully effective having regard to the objectives of Article 220 of the Treaty. In any event it should be stressed that the interpretation of the said words and concepts for the purpose of the [Brussels] Convention does not prejudice the question of the substantive rule applicable to the particular case [underscore and content in brackets added].”<sup>486</sup>

Accordingly, the ECJ referred to the *lex causae* in order to determine the place of performance of a contractual obligation. The court explicated:

“(…) It is for the court before which the matter is brought to establish under the [Brussels] Convention whether the place of performance is situated within its territorial jurisdiction. For this purpose it must determine in accordance with its own conflict of laws what is the law applicable to the legal relationship

---

<sup>483</sup> ECJ 11 January 1990, C-220/88, *Dumez France and Another v Hessische Landesbank (Helaba) and Others*, [1990] ECR I-00049, para. 21 – *Dumez*.

<sup>484</sup> Schauwecker 2009, pp. 114, 115; cf. also the argumentation used by the *Oberlandesgericht Düsseldorf* in its *Schussfadengreifer II* decision: OLG Düsseldorf 22 July 1999, 2 U 127/98, (2001)21(4) IPRax 336, at p. 337 – *Schussfadengreifer II*.

<sup>485</sup> ECJ 10 June 2004, C-168/02, *Rudolf Kronhofer v Marianne Maier and Others*, [2004] ECR I-06009, para. 18 – *Kronhofer*.

<sup>486</sup> ECJ 6 October 1976, C-12/76, *Industrie Tessili Italiana Como v Dunlop AG*, [1976] ECR 01473, paras. 10-11 – *Tessili*

in question and define in accordance with that law the place of performance of the contractual obligation in question [content in brackets added].<sup>487</sup>

Evidently, there is a conflict between that jurisprudence of the ECJ in its *Tessili* decision and its *Marinari* decision where, as has been stressed above, the ECJ held that substantive law shall be irrelevant for the determination of the place of the event giving rise to the damage according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation).

In light of the foregoing, it must be noted that there is no distinct jurisprudence of the ECJ as to the issue whether the place of the event giving rise to the damage according to Article 7(2) and the substantive facts of a patent infringement are actually to be treated completely independently from each other, or whether the part of the act referred to within the framework of Article 7(2) must be (at least a part of) the infringing act according to substantive law. The ECJ has not rendered an explicit decision on this question yet. In particular, the ECJ has not decided yet if the places where preparatory acts are carried out constitute places of the event giving rise to the damage according to Article 7(2).<sup>488</sup> The ECJ has not decided either on the question of whether there is jurisdiction on the basis of an extraterritorial place of the event giving rise to the damage in the case of acts being committed abroad and having effect in the protection State, respectively acts that are committed within the protection State, but which are exclusively aimed at another State in which no patent protection exists.<sup>489</sup>

The ECJ seems to undertake, in formal respect, an independent determination of the place of the event giving rise to the damage, but actually construes a conjunction between the applicable substantive law and the place of the event giving rise to the damage (and the place where the damage occurred)<sup>490</sup> which may even be inevitable in the long run, because it is the *lex causae* which determines the scope of obligations to act and to omit.<sup>491</sup> Eventually, the ECJ had in mind, when postulating the requirement of an independent interpretation of the place of the event giving rise to the damage according to Article 7(2), a choice of a place amongst those places which are relevant for a tort in substantive respect.<sup>492</sup> In light of this, it has rightly been put forth that assuming an extraterritorial place of the event giving rise to the damage would require a truly independent determination which has not been realised by the ECJ so far.<sup>493</sup>

Last but not least, the jurisprudence of the ECJ in its *Roche Nederland*<sup>494</sup> and *GAT*<sup>495</sup> decisions reveals a certain trend towards a “renationalisation” of patent proceedings.<sup>496</sup>

<sup>487</sup> ECJ 6 October 1976, C-12/76, *Industrie Tessili Italiana Como v Dunlop AG*, [1976] ECR 01473, para. 13 – *Tessili*. The ECJ subsequently confirmed this jurisprudence in its *Custom Made* decision, cf. ECJ 29 June 1994, C-288/92, *Custom Made Commercial Ltd v Stawa Metallbau GmbH*, [1994] ECR I-02913, paras. 26, 29 – *Custom Made*.

<sup>488</sup> Cf. Bukow 2003, p. 56. Denying the relevance of mere preparatory acts in this context: Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 35; Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 87; Kropholler & Von Hein 2011, Art. 5 EuGVO, para. 83a.

<sup>489</sup> Schauwecker 2009, p. 116; cf. also: Pertegás Sender 2002, para. 3.87.

<sup>490</sup> Schauwecker 2009, p. 122; Schack 2010, para. 339; Jayme & Kohler (1995)15(6) IPRax 343, at p. 348.

<sup>491</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 259.

<sup>492</sup> Schauwecker 2009, p. 122; eventually to be interpreted similarly: Schack 2010, para. 339; Schack (2000)3(3) MMR 135, at p. 137; Neuhaus (1996)87(9) Mitt. 257, at p. 264.

<sup>493</sup> Schauwecker 2009, p. 122 et seq.

<sup>494</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535 – *Roche Nederland*.

<sup>495</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509 – *GAT*.

<sup>496</sup> Adolphsen (2007)27(1) IPRax 15; Schauwecker (2008)57(2) GRUR Int. 96, at p. 101.



### **2.2.3.1.3.3 Relevance of the *Shevill* decision of the ECJ for the question of whether an extraterritorial place of the event giving rise to the damage can exist**

When analysing whether the principle of territoriality has an (indirect) effect on the determination of the place of the event giving rise to the damage in terms of Article 7(2), the question arises whether hints to solve this issue can be derived from the *Shevill* decision of the ECJ.<sup>497</sup> However, the crucial question to be answered first – being discussed highly controversially<sup>498</sup> – is whether the jurisprudence of the ECJ in *Shevill* can be transferred to the constellation of patent infringement.

In essence, the *Shevill* decision of the ECJ was based on the following facts: The plaintiff, Miss Fiona Shevill, considered that an article of the newspaper *France-Soir* published by the defendant, the French company Presse Alliance SA domiciled in France, in the territory of various Member States, was defamatory in that it suggested that the plaintiff was part of a drug-trafficking network for which she had laundered money. Therefore, the plaintiff issued a writ in the High Court of England and Wales claiming damages for libel from the defendant in respect of the copies of *France-Soir* distributed in France and the other European countries including those sold in England and Wales. The plaintiff subsequently amended her pleading, deleting all references to the copies sold outside England and Wales.<sup>499</sup>

In its *Shevill* decision, the ECJ held that

“(i)n the case of a libel by a newspaper article distributed in several Contracting States, the place of the event giving rise to the damage, within the meaning of those judgments, can only be the place where the publisher of the newspaper in question is established, since that is the place where the harmful event originated and from which the libel was issued and put into circulation [underscore added].”<sup>500</sup>

With regard to the constellation of cross-border patent infringement, it could be argued that the place of the event giving rise to the damage can be located at the place where the infringing product is offered and/or sent away. However, it has been discussed controversially if this is correct.

#### **2.2.3.1.3.3.1 Arguments for and against the applicability of the *Shevill* decision to cases of cross-border patent infringement in order to determine the place of the event giving rise to the damage**

In favour of the applicability of the *Shevill* decision to the constellation of cross-border patent infringement, it could be argued that the *Shevill* case concerned rights of personality which are also intangible rights like patent rights. However, it is to be noticed in this respect that rights of personality are valid without any territorial restriction (principle of universality).<sup>501</sup> This feature constitutes a fundamental difference in comparison with intellectual property

---

<sup>497</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415 – *Shevill*.

<sup>498</sup> In favour of the applicability of the *Shevill* decision to the constellation of patent infringement cf. for instance Nuyts 2008, p. 117 et seq.; Fezer & Koos 2010 (Staudinger), para. 1139; cf. Tritton 2008, para. 14–027; Lange (2000)46(9) WRP 940, at pp. 942–943 (concerning trade marks); against the applicability of the *Shevill* decision to the constellation of patent infringement cf. for instance Brinkhof (1997)46(6) GRUR Int. 489, at pp. 490–491; Reber (2005)49(3) ZUM 194, at pp. 196–197.

<sup>499</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, paras. 3, 8 – *Shevill*.

<sup>500</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 24 – *Shevill*.

<sup>501</sup> Otte (2001)21(4) IPRax 315, at p. 318; Lange (2000)46(9) WRP 940, at p. 942.

rights as patent rights which are only valid within a specific territory (principle of territoriality). Remarkably, it is exactly this feature that produces difficulties with regard to the determination of the place of the event giving rise to the damage according to Article 7(2). Due to the universal validity of rights of personality (in contrast to patent rights), it is uncontested that both the place of the event giving rise to the damage and the place where the damage occurred can be located abroad.<sup>502</sup> In contrast, with regard to the cross-border infringement of patents, the place where the infringement is committed in substantive respect must be located in the protection State. Therefore, principles developed in *Shevill* cannot simply be transferred to parallel patent infringement cases.<sup>503</sup>

As another argument in favour of the applicability of the *Shevill* decision, it has been put forth that the ECJ accepted, in *Shevill*, that the causal event can be located outside the State where the right to reputation is judicially protected, when the ECJ ruled that the causal event relating to material distributed in England and amounting to defamation in England could be in France.<sup>504</sup> Against this assertion, it has rightly been emphasised that it is a misconception that the ECJ, in its *Shevill* decision, accepted that the causal event can be located outside the protection State; rather, in *Shevill*, where rights of personality were concerned, the place of the event giving rise to the damage was *both* located, *inter alia*, in England and in France. Consequently, the ECJ did not recognise an extraterritorial place of the event giving rise to the damage in that case.<sup>505</sup>

Besides, the *Shevill* case concerned the constellation of one continuous act of press publication. Although publication was undertaken in several countries, the ECJ was of the opinion that there was only one coherent infringing act.<sup>506</sup> On the assumption that the parallel infringement of several patents constitutes acts which are independent from each other (“*unabhängige Teilakte*”, “*selbstständige Verletzungshandlungen*”), parts of legal doctrine have put forth that the constellation is different from *Shevill*.<sup>507</sup> However, that conception is to be rejected, because it would wrongly take into consideration the substantive principle of territoriality in terms of the jurisdictional issue of the application of Article 7(2). If, regarding parallel patent infringement actions, every act of bringing into circulation of products was principally considered a separate act of patent infringement in *procedural* respect, one coherent event would be torn apart.<sup>508</sup> As the principle of territoriality is not applicable to the issue of jurisdiction, an independent interpretation of Article 7(2) must be chosen. In matters of jurisdiction, there may be a uniform event, as the parallel infringement actions can have a common origin at the place of manufacture. Thus it can be justified to consider the act of manufacture and the subsequent act of bringing into circulation as one uniform event.<sup>509</sup>

It has been pointed out that the definition of the place of the event giving rise to the damage in patent infringement cases cannot be given according to the defendant’s domicile as decided in *Shevill*, because, in cases regarding patent infringement, there is generally a closer link with the State where the tortious act occurred, independently from the place where the defendant’s domicile is located. Further, Article 7(2) would never confer an alternative basis of jurisdiction to Article 4(1) if the place of the event giving rise to the damage necessarily

<sup>502</sup> Schauwecker 2009, p. 119.

<sup>503</sup> Hausmann (2003)3(5/6) EuLF 277, at pp. 281-282; Pansch (2000/01)1(5) EuLF 353, at p. 357; cf. also Kortmann 2005, p. 64.

<sup>504</sup> Nuyts 2008, p. 118, and there fn. 68.

<sup>505</sup> Schauwecker 2009, p. 120.

<sup>506</sup> Bukow 2003, pp. 103-104; Winkler 2011, p. 222.

<sup>507</sup> Treichel 2001, p. 25; cf. Tritton 2008, para. 14–027; Brinkhof (1997)46(6) GRUR Int. 489, at p. 491.

<sup>508</sup> Reichardt 2006, p. 130.

<sup>509</sup> Reichardt 2006, p. 130.

coincides with the domicile of the person liable.<sup>510</sup> In this respect, it is to be emphasised that the wording of Article 7(2) actually reveals that Article 7(2) is only applicable as to courts located in another Member State than the State where the defendant is domiciled.<sup>511</sup> Applying the *Shevill* decision to cases of cross-border patent infringement would thus not only require to transfer the *Shevill* decision to territorially restricted rights, but also to apply this jurisprudence to cases where the place of the event giving rise to the damage is not identical with the place of domicile of the alleged infringer (because infringement actions can already be based on Article 4(1) at the place of domicile of the alleged infringer). A deviation between the place of domicile of the alleged infringer and the place of the event giving rise to the damage may occur in cases of patent infringement via internet, in case that the infringing material is uploaded at a place other than the place of the infringer's domicile. Another scenario where the place of the event giving rise to the damage and the place of the defendant's domicile can fall apart is that of an action for a declaration of non-infringement where an alleged infringer initiates proceedings in order to reach a declaration that he does not infringe the defendant's patent.<sup>512</sup>

### 2.2.3.1.3.3.2 Conclusion as to the applicability of *Shevill* and its further significance

To conclude, it is to be stated that the *Shevill* jurisprudence of the ECJ cannot be transferred *in toto* to the constellation of cross-border patent infringement cases. However, this result does not mean that certain findings of this jurisprudence – in particular with regard to the issue of the scope of cognition of the courts at the place of the event giving rise to the damage and at the place where the damage occurred – may not be relevant with regard to cross-border patent infringement cases, which shall be subject of a deepened analysis subsequently.

Although *Shevill* is not applicable to the constellation of cross-border patent infringement, some general statements given by the ECJ in this decision are still of interest also in this context. Interestingly, the ECJ held, (also) in *Shevill*, with regard to the place where the damage occurred (“*Erfolgsort*”) that

“(…) the courts of each Contracting State in which the defamatory publication was distributed and in which the victim claims to have suffered injury to his reputation have jurisdiction to rule on the injury caused in that State to the victim's reputation.”<sup>513</sup>

By the latter formulation, the court constructed a conjunction between substantive law and jurisdiction of a court potentially situated outside the protection State. This construction may match with regard to the rights of personality due to the principle of universality, but structurally cannot be applied to rights which are territorially restricted as patents (principle of territoriality).

Additionally, the ECJ explicated in *Shevill*:

<sup>510</sup> Pertegás Sender 2002, para. 3.90.

<sup>511</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 3; Lange (2000)46(9) WRP 940, at p. 941; Neuhaus (1996)87(9) Mitt. 257, at p. 262; Kropholler & Von Hein 2011, vor Art. 5 EuGVO, para. 4.

<sup>512</sup> Schauwecker 2009, p. 120; Fezer & Koos 2010 (Staudinger), para. 1139.

<sup>513</sup> ECJ 7 March 1995, C-68/93, Fiona Shevill and Others v Presse Alliance SA, [1995] ECR I-00415, para. 30 – *Shevill*.

“In the area of non-contractual liability (...) the sole object of the [Brussels] Convention is to determine which court or courts have jurisdiction to hear the dispute by reference to the place or places where an event considered harmful occurred.

It does not, however, specify the circumstances in which the event giving rise to the harm may be considered to be harmful to the victim, or the evidence which the plaintiff must adduce before the court seised to enable it to rule on the merits of the case.

Those questions must therefore be settled solely by the national court seised, applying the substantive law determined by its national conflict of laws rules, provided that the effectiveness of the Convention is not thereby impaired [underscore and content in brackets added].”<sup>514</sup>

It can be concluded from this formulation used by the ECJ that the principle of an autonomous determination of the place where the harmful event occurred (“*Begehungsort*”) does not apply without any restrictions.<sup>515</sup> So, parts of legal doctrine have suggested that reference to the *lex causae* will be required in order to determine the place of the event giving rise to the damage.<sup>516</sup>

#### 2.2.3.1.3.4 Inapplicability of the principle of territoriality

In the absence of a clear attitude of the ECJ regarding the question of whether the place of the event giving rise to the damage is to be determined independently from the *lex causae*, meaning that the principle of territoriality is in no way applicable, it is necessary to revert to general considerations and principles.

Arguing in favour of the consideration of the principle of territoriality in the framework of Article 7(2), one might put forth that the European legislator codified the principle of territoriality in the Rome II Regulation.<sup>517</sup> In that Regulation, the European legislator indeed established unified rules of conflict of laws concerning non-contractual obligations, and Article 8(1) of the Rome II Regulation, dealing with the infringement of intellectual property rights, embodies the principle of *lex loci protectionis* which is closely related with the substantive principle of territoriality.<sup>518</sup> Article 8(1) of the Rome II Regulation provides:

“The law applicable to a non-contractual obligation arising from an infringement of an intellectual property right shall be the law of the country for which protection is claimed.”

In spite of the general separation between matters of jurisdiction and the applicable law, it might be possible to derive the applicability of the same principles for both the Brussels Ibis Regulation and the Rome II Regulation. In this respect, it is remarkable that the jurisprudence of the ECJ also reveals a certain coherence regarding the interpretation of the (pre-)

---

<sup>514</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, paras. 37-39 – *Shevill*.

<sup>515</sup> Ebner 2004, p. 188; Kubis 1999, pp. 126-130; Schauwecker 2009, p. 121.

<sup>516</sup> Schack 2010, para. 339.

<sup>517</sup> Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), OJ L199 of 31 July 2007, pp. 40-49, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32007R0864&from=EN>> (lastly accessed on 1 June 2015).

<sup>518</sup> Heinze 2007, p. 224; Buchner (2005)54(12) GRUR Int. 1004, at pp. 1004-1008; Grünberger (2009)108 ZVglRWiss 134, at pp. 145-146; Illmer 2011 (Huber), Art. 8 Rome II, para. 3; Drexl 2015 (Münchener Kommentar zum BGB), Internationales Immaterialgüterrecht, para. 14; Leistner 2009, p. 99; cf. also Fentiman 2005 (Intellectual Property and Private International Law), pp. 134-148.

predecessors of the Brussels Ibis Regulation and the Rome I Regulation<sup>519</sup> concerning the law applicable to contractual obligations, i.e. the Brussels Convention and the Rome Convention<sup>520</sup>.<sup>521</sup> In light of this, and considering that the ECJ has also jurisdiction to interpret both the provisions of the Rome II Regulation and the Brussels Ibis Regulation, a similar coherence of interpretation of the provisions of the latter Regulations could be concluded.<sup>522</sup> Consequently, the principle of territoriality could be also relevant with regard to Article 7(2), i.e. concerning the determination of the place of jurisdiction according to Article 7(2).

However, the foregoing argumentation is based on the wrong assumption that the principle of *lex loci protectionis* and the principle of territoriality can be equated. But, although the principle of *lex loci protectionis* and the principle of territoriality are closely related with each other, it remains a matter of fact that the principle of *lex loci protectionis* is a principle of private international law which should not be mingled with matters of substantive law like the principle of territoriality which concerns the territorial limits of IP rights.<sup>523</sup> For it is private international law that determines which substantive law is applicable.<sup>524</sup>

Moreover, Article 8(1) of the Rome II Regulation only provides which law is applicable in case of a patent infringement, but does not contain any hint as to the determination of the place *where* a patent has been infringed which is decisive in terms of Article 7(2). Besides, when interpreting a provision of European law, the aspect of *effet utile* must be taken into account. According to this principle, the interpretation of a provision must not lead to the result that this provision loses its specific meaning and scope of application. In this regard, it is to be underlined that, *if* the principle of territoriality actually *was* to be applied to Article 7(2), Article 7(2) would be deprived of its *effet utile*, because then only the courts of the protection State would be competent, meaning that jurisdiction according to Article 7(2) would *per se* be identical with jurisdiction according to Article 24(4).<sup>525</sup>

#### **2.2.3.1.3.5 Conclusion: Principle of territoriality is no obstacle for an extraterritorial place of the event giving rise to the damage**

To conclude, it is to be stated that the principle of territoriality has neither an immediate (direct) nor a mediate (indirect) effect on the determination of the place of the event giving rise to the damage according to Article 7(2).<sup>526</sup> Consequently, the substantive principle of territoriality constitutes no obstacle against the existence of an extraterritorial place of the event giving rise to the damage pursuant to Article 7(2).<sup>527</sup>

<sup>519</sup> Regulation (EC) No 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I), OJ L177 of 4 July 2008, pp. 6-16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TEXT/PDF/?uri=CELEX:32008R0593&from=en>> (lastly accessed on 1 June 2015).

<sup>520</sup> Convention on the law applicable to contractual obligations (Rome Convention). OJ C27 of 26 January 1998, pp. 34-53, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TEXT/PDF/?uri=CELEX:41998A0126%2802%29&from=EN>> (lastly accessed on 1 June 2015).

<sup>521</sup> Regarding such a coherence of interpretation between the Brussels Convention and the Rome Convention as to the interpretation of the term “contract”, respectively between the Brussels I Regulation and the Rome I Regulation, cf. Bitter (2008)28(2) IPRax 96, at pp. 97, 100.

<sup>522</sup> Suggesting this conclusion, but denying it: Winkler 2011, pp. 196-197.

<sup>523</sup> Illmer 2011 (Huber), Art. 8 Rome II, para. 3, there fn. 9.

<sup>524</sup> Drexler 2015 (Münchener Kommentar zum BGB), Internationales Immaterialgüterrecht, para. 14.

<sup>525</sup> Winkler 2011, pp. 196-197.

<sup>526</sup> Cf. also Fezer & Koos 2010 (Staudinger), para. 1138.

<sup>527</sup> Adolphsen (2006)11 ZZPInt 137, at p. 156.

#### 2.2.3.1.4 Constellations of extraterritorial places of the event giving rise to the damage

Having arrived at the conclusion that the principle of territoriality does not effect that the place of the event giving rise to the damage cannot be located outside the protection State, I shall analyse in the following paragraphs whether, respectively in which constellations, parts of infringing acts (“*Teilakte*”) which are accomplished (“*vollendet*”) in the protection State can constitute a place of the event giving rise to the damage according to Article 7(2). In this respect, I shall explicitly deal with the manufacture and the transit of products which allegedly infringe patents.

Frequently, the place where a product which allegedly infringes a patent and the place of domicile of the alleged infringer will be identical, effecting that the courts of that place already have jurisdiction according to Article 4(1), without the need to ground jurisdiction on Article 7(2).<sup>528</sup> However, the following cases may serve to illustrate that such a synchronism between Article 4(1) and Article 7(2) does not necessarily exist:

##### Case 1:

Patent holder P holds a European patent for a machine for the territories of Germany and Poland. Infringer INF, domiciled in Belgium, manufactures an identical machine and sells it in Poland via transit through Germany. As P doubts that Belgian courts will decide within a reasonable period, P shies away from suing INF before Belgian courts, which have jurisdiction according to Article 4(1), but sues INF in Germany for patent infringement of the Polish part of the European patent, on the basis of Article 7(2). Do German courts have jurisdiction as to this claim according to Article 7(2)?

##### Case 2:

Patent holder P holds a European patent for a machine for the territories of Germany and the Netherlands. Infringer INF, domiciled in Belgium, manufactures an identical machine in Spain and sells it in Germany and the Netherlands. As P doubts that Belgian courts will decide within a reasonable period, P shies away from suing INF before Belgian courts, which have jurisdiction according to Article 4(1), but sues INF in Spain for patent infringement of the Dutch and the German parts of the European patent, on the basis of Article 7(2). Do Spanish courts have jurisdiction as to this claim according to Article 7(2)?

Principally, it is to be restated that the principle of territoriality merely concerns patent rights in substantive respect, and therefore does not *a priori* preclude jurisdiction according to Article 7(2) in case that (parts of) infringing acts with regard to a patent infringement are accomplished outside the protection State.<sup>529</sup>

With regard to Case 1, the transit of the allegedly infringing product through Germany and its import into Poland could be considered as parts (“*Teilakte*”) of a uniform cross-border

---

<sup>528</sup> Grabinski (2001)50(3) GRUR Int. 199, at p. 205; Meier-Beck (1999)101(5) GRUR 379, at p. 381; Hye-Knudsen 2005, p. 71; Winkler 2011, pp. 196, 198; Adolphsen 2009, para. 492; Musger 2012, p. 28.

<sup>529</sup> Reichardt 2006, p. 45; Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 5, para. 72; Nagel & Gottwald 2013, § 3, para. 85.

infringing act. As the transit through the territory of Germany constitutes a part (“*Teilakt*”) of that uniform cross-border infringing act, it could be argued that German courts have jurisdiction according to Article 7(2) (also) concerning the Polish part of the European patent.

Concerning Case 2, it could be argued that Spanish courts have jurisdiction according to Article 7(2) with regard to both the infringement of the Dutch and the German part of the European patent, because the manufacture of the allegedly infringing product in Spain constitutes a part (“*Teilakt*”) of a uniform cross-border infringing act which is accomplished (“*vollendet*”) both in the Netherlands and Germany as protection States.

#### 2.2.3.1.4.1 Relevant aspects

In light of these cases, it is to be questioned in which circumstances an extraterritorial localisation of the place of the event giving rise to the damage pursuant to Article 7(2) is justified. In the following, I shall take a closer look on the aspects of accountability (“*Zurechnungszusammenhang*”) and the existence of a particularly close connection. These factors can be understood as filters to avoid that jurisdiction according to Article 7(2) as an exception to the basic jurisdictional rule of Article 4(1) (jurisdiction at the place where the defendant is domiciled) is extended excessively.

##### 2.2.3.1.4.1.1 Filter 1: Accountability (“*Zurechnungszusammenhang*”)

As has been mentioned above, the wording “place of the event giving rise to the damage” that is used in Article 7(2) constitutes *per se* a broad expression which leaves room to comprise also such (parts of) acts which are not part of the *substantive* facts. On this basis, it has been argued that the term “place of the event giving rise to the damage” also covers acts outside the protection State insofar as they are causal and accountable to the patent infringement accomplished in the protection State.<sup>530</sup> Due to the latter restriction of accountability, the mere manufacture of a product abroad does not suffice to conceive this act as being part of a patent infringement in the protection State; although it is actually causal in the broadest sense possible,<sup>531</sup> the stricter requirement of accountability is not met.<sup>532</sup> On the other hand, it has been argued that the act of putting into circulation an object, intendedly and with a clear purpose, directed towards the protection State – for instance by a specific labelling in the language of the protection State or permanent contractual relations to an importer in the protection State – may meet the requirement of accountability to a patent infringement in the protection State. Consequently, the place where the object is put into circulation in such a way could then be considered a place of the event giving rise to the damage according to Article 7(2).<sup>533</sup> The danger that in case that several parts of the manufacture of allegedly infringing

---

<sup>530</sup> Bukow 2003, pp. 55-56; Adolphsen 2009, para. 490; Hye-Knudsen 2005, p. 73; Pansch (2000/01)1(5) EuLF 353, at pp. 355-356; Hausmann (2003)3(5/6) EuLF 277, at p. 280.

<sup>531</sup> This evaluation is not uncontested, cf. Adolphsen 2009, para. 490

<sup>532</sup> Arguing in a similar way, underlining that the mere manufacture of a product without any further link to the State where patent protection exists does not suffice to establish a place of the event giving rise to the damage according to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation): Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 262b; although arguing in a different way (already denying causality), Adolphsen agrees with the result arrived at here, cf. Adolphsen 2009, para. 490 and Adolphsen (2006)11 ZZPInt 137, at p. 156.

<sup>533</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 262b; Hausmann (2003)3(5/6) EuLF 277, at p. 280 (Hausmann advocates to expand the concept of the “place of the event giving rise to the damage” to some extent, but argues that manufacture in the non-protecting State is still

products are carried out in several Member States, meaning that there could be several places of the event giving rise to the damage according to Article 7(2),<sup>534</sup> which could finally result in a multiplication of places of jurisdiction<sup>535</sup> and forum shopping, can be effectively reduced by the discussed requirement of accountability.<sup>536</sup>

Applying these considerations to the sample cases presented above, I arrive at the following intermediate results:

In Case 1, the transit of the machine through Germany is carried out intendedly and with the clear purpose to bring it to Poland to sell it there. Consequently, German courts would have jurisdiction according to Article 7(2) as to infringement proceedings concerning the Polish part of the European patent.

In Case 2, the foregoing considerations would lead to the result that Spanish courts cannot found jurisdiction according to Article 7(2) on the mere fact that INF manufactures the machine in Spain. However, Spanish courts would be considered competent pursuant to Article 7(2) to decide on the alleged infringement of the Dutch and the German part of the European patent for the reason that INF intendedly and with a clear purpose, acting from Spain, put the machine into circulation in the Netherlands and Germany.

#### **2.2.3.1.4.1.2 Filter 2: Particularly close connection**

In light of the fact that the ECJ has constantly emphasised, since its *Mines de Potasse* decision, that the *existence of a particularly close connecting factor between the dispute and the deciding court* is essential for jurisdiction according to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), it is doubtful if the requirement of accountability (“*Zurechnungszusammenhang*”) suffices to secure the existence of such a “particularly close connecting factor”. It is noteworthy that the ECJ, by demanding such a particularly close connection, explicitly intended to secure the sound administration of justice and the efficacious conduct of proceedings.<sup>537</sup>

Starting from Cases 1 and 2, I shall differentiate in the following analysis between the place of transit and the place of manufacture.

##### **2.2.3.1.4.1.2.1 Place of transit**

While some legal writers have put forth that the mere transit of products for their illegal sale abroad already suffices in order to establish a place of the event giving rise to the damage according to Article 7(2) (respectively its predecessors),<sup>538</sup> the majority of legal commentators have refused such a broad interpretation of Article 7(2) (respectively its predecessors). In fact,

---

not prohibited, because the earliest point at which the infringement takes place is with the importation into the protection State); Adolphsen (2006)11 ZZPInt 137, at p. 157; Adolphsen 2009, para. 490.

<sup>534</sup> Pertegás Sender 2002, paras. 3.92-3.93.

<sup>535</sup> Neuhaus (1996)87(9) Mitt. 257, at p. 264; despite the actual risk of a multiplication of places of jurisdiction, this problem might be rather academical, because in practice, a patentee will only initiate infringement proceedings before the courts of the place of the event giving rise to the damage in case of good reasons, like a simplified taking of evidence, cf. Hye-Knudsen 2005, p. 73.

<sup>536</sup> Winkler 2011, p. 205.

<sup>537</sup> Ten Wolde & Henckel (2013)3(2) IJPL 195, at p. 199.

<sup>538</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, para. 250.



the latter opinion appears more convincing, because in the case of transporting a product through a State without any intention to use the product in this State, i.e. in a constellation of mere transit of the product, there is neither factual (nor legal) proximity between the object and the concerned State.<sup>539</sup> In particular, proceedings before a court in the State of transit would not benefit from a specific proximity of evidence; on the contrary, it is even doubtful which evidence, if any, could be gained in the State of transit. Therefore, proceedings in the State of transit would not secure the sound administration of justice and the efficacious conduct of proceedings. To conclude, there is no particularly close connecting factor between the place of transit and a potential patent infringement in the protection State, meaning that the place of mere transit does not constitute a place of the event giving rise to the damage and thus courts of the State of transit lack jurisdiction according to Article 7(2).

Applying this result to Case 1, I arrive at the conclusion that German courts do not have jurisdiction as to proceedings concerning the potential infringement of the Polish part of the European patent, because – although being transported intendedly via Germany with the clear purpose to bring it to Poland to sell it there – the product was never meant to be brought in closer relation to Germany than only in form of the transit through German territory which does not suffice to establish a particularly close connection to Germany according to Article 7(2).

#### **2.2.3.1.4.1.2.2 Place of manufacture**

On the basis of the prevailing opinion in legal doctrine and case-law of the EU Member States pursuant to which the principle of territoriality must also be taken into consideration regarding the issue of jurisdiction according to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), as well as pursuant to the conception that the principle of territoriality has at least an indirect (mediate) effect, it is to be concluded that a particularly close connection in the sense of Article 7(2) between a patent infringement and an invoked court only exists in the protection State, because only there the patent can be infringed, and the law of this State is applied to the patent infringement.<sup>540</sup> In this respect, it has been put forth that only the last part of an act that finally accomplishes the patent infringement is decisive for the determination of the place of the event giving rise to the damage according to Article 7(2), which has been named the so-called “last event rule”.<sup>541</sup>

Others have emphasised that the place of manufacture is the place where the cause for the patent infringement that is accomplished in the protection State is set.<sup>542</sup> Further, it has been pointed out that the relevant evidence required for infringement proceedings will especially be located at the place of manufacture. Accordingly, the sound administration of justice and the efficacious conduct of proceedings would be promoted by conferring jurisdiction to the place of manufacture as a place of the event giving rise to the damage according to Article 7(2).<sup>543</sup> Additionally, it has been suggested that accepting the place of manufacture as a place of the event giving rise to the damage according to Article 7(2) may even effect a concentration of several proceedings in case that the manufacture of an object leads to the infringement of

<sup>539</sup> Hye-Knudsen 2005, p. 74; Grabinski (2001)50(3) GRUR Int. 199, at p. 204.

<sup>540</sup> Grabinski (2001)50(3) GRUR Int. 199, at p. 205; Neuhaus (1996)87(9) Mitt. 257, at p. 264; Von Meibom & Pitz (1996)87(7) Mitt. 181, at pp. 182-183 (= Von Meibom & Pitz (1997)19(8) E.I.P.R. 469, at p. 470); LG Düsseldorf 25 August 1998, 4 O 165/97, (1999)48(5) GRUR Int. 455, at p. 457 – *Schussfadengreifer I*; Treichel 2001, p. 24.

<sup>541</sup> Neuhaus (1996)87(9) Mitt. 257, at p. 264; Grabinski (2001)50(3) GRUR Int. 199, at p. 204.

<sup>542</sup> Nuyts 2008, p. 120; Pansch (2000/01)1(5) EuLF 353, at p. 355.

<sup>543</sup> Cf. also Pansch (2000/01)1(5) EuLF 353, at p. 356; cf. also Meier-Beck (1999)101(5) GRUR 379, at p. 381.

*parallel* patents, where several proceedings would have to be initiated before different courts otherwise.<sup>544</sup>

Besides, it has been proposed in legal doctrine, as to the question of whether an extraterritorial place of manufacture is to be considered a place of the event giving rise to the damage in the sense of Article 7(2) due to the existence of a particularly close connection, to distinguish between product patents and process patents.<sup>545</sup> Comparably to the legal situation in national patent systems, a European patent cannot only be granted for a product, but also for a process, which results from the broad definition of patentable inventions in Article 52(1) of the European Patent Convention (EPC)<sup>546</sup> which provides:

“European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.”

#### **2.2.3.1.4.1.2.2.1 Product patents**

With regard to product patents, it has rightly been underlined that the infringing acts of bringing into circulation, using, offering, importing and possessing such products for those purposes constitute acts of patent infringement that are independent from the manufacture of the concerned object.<sup>547</sup> Consequently, those acts can be considered and evaluated independently from the manufacture, which does not even require knowledge of the act of manufacture. It is thus logical to conclude that the mere fact of manufacture of a product does not establish such a particularly close connection that would be necessary to consider an extraterritorial place of manufacture as a place of the event giving rise to the damage in the sense of Article 7(2) concerning a patent infringement in the protection State.<sup>548</sup>

#### **2.2.3.1.4.1.2.2.2 Process patents**

In contrast, as to European process patents, there can be a particularly close connection between the courts at an extraterritorial place of manufacture and a patent infringement in the protection State, with the consequence that that place of manufacture could then be considered a place of the event giving rise to the damage concerning the patent infringement.<sup>549</sup> In this respect, Article 64(2) of the EPC gains special importance, which reads as follows:

“If the subject-matter of the European patent is a process, the protection conferred by the patent shall extend to the products directly obtained by such process.”

Remarkably, this provision, regarding process patents, extends the scope of protection to the products which are *directly (immediately)* manufactured through the protected process which gains particular importance in case that the patent on the process is not valid as such in the State of manufacture.<sup>550</sup> Insofar, manufacture has rightly been characterised as a part of the

---

<sup>544</sup> Hye-Knudsen 2005, p. 73.

<sup>545</sup> Reichardt 2006, p. 130 et seq.

<sup>546</sup> It is to be noted that the provisions of Articles 52(2) and 52(3) of the EPC contain certain restrictions and clarifications concerning patentability with regard to Article 52(1) of the EPC.

<sup>547</sup> Reichardt 2006, p. 130 et seq.

<sup>548</sup> Reichardt 2006, p. 131.

<sup>549</sup> Reichardt 2006, p. 131.

<sup>550</sup> Reichardt 2006, p. 132.

uniform tort of offering, bringing into circulation, using, importing or possessing a product being manufactured according to a protected process.<sup>551</sup> Products are thus protected only when manufacture is directly based on the protected process – otherwise process patents do not have effect on the products as such. In clearer words: The use of exactly the protected process is a precondition for the existence of a patent infringement in the protection State (unless there is an (additional) patent on the product).<sup>552</sup> Therefore, gaining evidence on this very issue will be decisive in such patent infringement cases. That can usually be undertaken most easily at the place of manufacture.<sup>553</sup> Consequently, it has been concluded, with regard to European process patents, that an extraterritorial place of manufacture has a particularly close connection to the patent infringement in the protection State and can thus be considered a place where the harmful event occurred according to Article 7(2).<sup>554</sup>

The ECJ underlined, in its *Marinari* decision, that no reference is to be made to substantive law for the interpretation of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), because otherwise the principles of legal certainty and predictability as to the attribution of jurisdiction would be impaired<sup>555</sup>:

“There is no basis for interpreting Article 5(3) of the [Brussels] Convention by reference to the applicable rules on non-contractual civil liability, as proposed by the German Government. That interpretation is also incompatible with the objective of the [Brussels] Convention, which is to provide for a clear and certain attribution of jurisdiction (...). The delimitation of jurisdiction would then depend on uncertain factors such as the place where the victim's assets suffered subsequent damage and the applicable rules on civil liability [underscores and content in brackets added].”<sup>556</sup>

In this respect, it could be doubted if the differentiation between product patents and process patents is admissible. However, as has been shown in Chapter 1 of this thesis, the differentiation between product patents and process patents is also familiar to national legal systems. Also, the provision of Article 64(2) of the EPC which is binding for all Contracting States to the European Patent Convention implies the possibility of obtaining a process patent besides a product patent. In light of this, pursuing the approach of a differentiation between product patents and process patents does not mean a mere reference to national provisions and is therefore reconcilable with the *Marinari* decision of the ECJ.<sup>557</sup>

#### **2.2.3.1.4.1.2.3 Determination of the place of the event giving rise to the damage in case of the infringement of IP rights via the internet**

It has rightly been highlighted in legal doctrine that, while torts committed via the internet are not beyond the scope of Article 7(2), the internet brings an extra dimension to the jurisdictional rules laid down therein.<sup>558</sup> Apart from developing specific rules on jurisdiction with regard to the infringement of personality rights,<sup>559</sup> the ECJ developed in its *Wintersteiger*

<sup>551</sup> Reichardt 2006, p. 133.

<sup>552</sup> Reichardt 2006, p. 133.

<sup>553</sup> Reichardt 2006, p. 133 et seq.

<sup>554</sup> Reichardt 2006, p. 136.

<sup>555</sup> Nuyts 2008, p. 122.

<sup>556</sup> ECJ 19 September 1995, C-364/93, Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company, [1995] ECR I-02719, para. 19 – *Marinari*.

<sup>557</sup> Winkler 2011, p. 204.

<sup>558</sup> Ten Wolde & Henckel (2013)3(2) IJPL 195, at p. 207 with further references.

<sup>559</sup> Cf. ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, eDate Advertising GmbH v X (C-509/09) and Oliver Martinez and Robert Martinez v MGN Limited (C-161/10), [2011] ECR I-10269 – *eDate Advertising and Martinez*.

decision a specific rule regarding the infringement of a national trade mark registered in a Member State through online advertisements by an advertiser domiciled in another Member State. The court held:

“In the case of an alleged infringement of a national trade mark registered in a Member State because of the display, on the search engine website, of an advertisement using a keyword identical to that trade mark, it is the activation by the advertiser of the technical process displaying, according to pre-defined parameters, the advertisement which it created for its own commercial communications which should be considered to be the event giving rise to an alleged infringement, and not the display of the advertisement itself [underscores added].”<sup>560</sup>

On the basis of this interpretation of the term “place of the event giving rise to the damage” in the said specific constellation of trade mark infringement via online advertisement, according to which the activation of the technical process of displaying the advertisement is decisive, the ECJ localised this place at the place of establishment of the advertiser:

“(…) (S)ince it is a definite and identifiable place, both for the applicant and for the defendant, and is therefore likely to facilitate the taking of evidence and the conduct of the proceedings, it must be held that the place of establishment of the advertiser is the place where the activation of the display process is decided [underscore added].”<sup>561</sup>

By contrast, the ECJ clearly stated that the place of establishment of the server cannot, due to its uncertain location, be the place where the event giving rise to the damage occurred, although the technical process by the advertiser is activated on that server belonging to the operator of the search engine used by the advertiser. In this regard, the court expressly emphasised “the objective of foreseeability, which the rules on jurisdiction must pursue.”<sup>562</sup>

Underlining that the principle of ubiquity also applies to the constellation of the infringement of trade marks through online advertisements, the ECJ held that Article 7(2) must be interpreted as meaning

“(…) that an action relating to infringement of a trade mark registered in a Member State because of the use, by an advertiser, of a keyword identical to that trade mark on a search engine website operating under a country-specific top-level domain of another Member State may be brought before either the courts of the Member State in which the trade mark is registered or the courts of the Member State of the place of establishment of the advertiser [underscore added].”<sup>563</sup>

Although the *Wintersteiger* decision concerned a case of trade mark infringement, it is probable that the ECJ would apply this jurisprudence as to the determination of the place of the event giving rise to the damage also with regard to cases of patent infringements,<sup>564</sup>

---

<sup>560</sup> ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 34, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>561</sup> ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 37, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>562</sup> ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 36, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>563</sup> ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 40, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>564</sup> Cf. also Ten Wolde & Henckel (2013)3(2) IJPL 195, at p. 207, and there fn. 61 referring *inter alia* to the *Wintersteiger* decision of the ECJ: “The ECJ appears to have developed a set of rules on jurisdiction tailor-made to suit (...) intellectual property rights committed via the Internet.”

because trade marks and patents as territorially restricted IP rights are similar to each other. However, it is to be pointed out that this approach pursued by the ECJ, concerning the determination of the place of the event giving rise to the damage at the place of establishment of the advertiser, respectively infringer, ultimately has the effect that the choice, according to Article 7(2), between the place of the event giving rise to the damage and the place where the damage occurred, loses much of its importance, because the place of establishment of the advertiser will generally be identical with his place of domicile where courts already have jurisdiction pursuant to Article 4(1).<sup>565</sup> In fact, the interpretation of Article 7(2) pursued by the ECJ in *Wintersteiger* concerning the determination of the place of the event giving rise to the damage entails the danger to partly deprive Article 7(2) of its *effet utile*. For this reason, it seems advisable not to follow this approach in the framework of an eventual future recast of the Brussels Ibis Regulation. Therefore, this approach will not be subject to further discussion in Chapter 3 of this thesis.

#### 2.2.3.1.4.2 Conclusion

On the basis of the foregoing paragraphs, it is to be concluded that the existence of an extraterritorial place of the event giving rise to the damage according to Article 7(2) of the Brussels Ibis Regulation requires that the conditions of accountability and a particularly close connection between the infringing act and the invoked court are fulfilled.

As to the possibility of an extraterritorial place of the event giving rise to the damage at the place of manufacture with regard to European patents, a differentiation between product patents and process patents seems reasonable and justified. For, concerning product patents, the infringing acts of bringing into circulation, using, offering, importing and possessing such products for the enumerated purposes constitute acts of patent infringement which are independent from the manufacture of the concerned object. The mere fact of manufacture of a product *as such* does not establish a particularly close connection that would be necessary for establishing jurisdiction pursuant to Article 7(2). In opposition, regarding European process patents, an extraterritorial place of the event giving rise to the damage can exist at the place of manufacture if the concerned product is *directly (immediately)* manufactured through the protected process (cf. Article 64(2) of the EPC). This conception also takes into account the importance of the basic rule of Article 4(1) which implies that Article 7(2) as an exception of this rule must be interpreted restrictively.

On the basis of this differentiating conception, the solution of Case 2 would be that Spanish courts lack jurisdiction as to the Dutch and the German part of the European patent, because the manufacture of the product in Spain does not suffice to accomplish an infringement of the Dutch and the German part of the European product patent. If, by derogation from Case 2, the subject-matter of P's European patent was a process, and INF manufactured identical products in Spain, a further differentiation would be necessary: If the manufacture of these products was directly based on the protected process, Spain would be considered a place of the event giving rise to the damage pursuant to Article 7(2) with regard to an infringement of P's patent. As a consequence, Spanish courts would then have jurisdiction according to Article 7(2). If, however, INF used another method for manufacture than the one protected by P's process patent, that protection would not extend to the products. As a consequence, Spain would not be a place of the event giving rise to the damage as to P's patent, and Spanish courts would not have jurisdiction according to Article 7(2).

---

<sup>565</sup> Cf. Mansel, Thorn & Wagner (2013)33(1) IPRax 1, at p. 16.

### 2.2.3.1.5 No reciprocal attribution of the place of the event giving rise to the damage according to Article 7(2) in case of several perpetrators

In a number of recent decisions, the ECJ made clear that the mere fact that a tort – in the context of this thesis one might think of the infringement of a patent – has been committed by several perpetrators, does not justify to ground international jurisdiction of a court in the State where one of the infringers acted according to Article 7(2), with regard to *all* infringers, but solely concerning the very infringer who actually acted in this State.<sup>566</sup>

In this respect, the *Melzer* decision of the ECJ concerning the interpretation of Article 5(3) of the Brussels I Regulation is to be mentioned. In this case, the German *Landgericht Düsseldorf* referred the following question to the ECJ for a preliminary ruling:

“In the context of jurisdiction in matters relating to tort or delict under Article 5(3) of Regulation [No 44/2001], where there is cross-border participation of several persons in a tort or delict, is reciprocal attribution of the place where the event occurred admissible for determining the place where the harmful event occurred?”<sup>567</sup>

In line with its constant jurisprudence according to which Article 7(2) of the Brussels I Regulation (respectively its predecessors) must be interpreted restrictively because this provision constitutes a derogation from the fundamental principle of Article 4(1) (respectively its predecessors),<sup>568</sup> the ECJ held that

“(…) in circumstances (...) in which only one among several presumed perpetrators of the alleged harmful act is sued before a court within whose jurisdiction he has not acted, an autonomous interpretation of Article 5(3) of Regulation No 44/2001, in accordance with the objectives and general scheme thereof, precludes the event giving rise to the damage from being regarded as taking place within the jurisdiction of that court.”<sup>569</sup>

In its reasoning, the court, in particular, highlighted that Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels I Regulation) is based on the existence of a particularly close connecting factor between the dispute and the courts of the place where the harmful event occurred or may occur, with regard to the sound administration of justice and efficacious conduct of proceedings.<sup>570</sup> Underlining that the relevant connecting factor must be situated within the jurisdiction of the court seised,<sup>571</sup> the ECJ held that in circumstances in which only one among several presumed perpetrators of an alleged harmful act is sued before a court within whose jurisdiction this perpetrator has not acted, there is principally no

---

<sup>566</sup> Hau & Eichel (2015)12(2) GPR 95, at p. 98.

<sup>567</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 19, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>568</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, paras. 23-24, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>569</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 40, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>570</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 26, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>571</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 18, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

connecting factor based on the defendant's acts.<sup>572</sup> In order to take jurisdiction according to Article 7(2), the deciding court must establish why the place of the event giving rise to the damage still must be regarded as having taken place within its jurisdiction, which would require, according to the ECJ, an assessment similar to that to be undertaken when examining the substance of the dispute even at the stage of examining jurisdiction.<sup>573</sup> The ECJ further held that, in the absence of a common concept in the national legal systems on the one hand and the European Union on the other hand enabling imputation of the act of one perpetrator to other perpetrators, the deciding national court would probably refer to the *lex fori*.<sup>574</sup> However, the ECJ stressed that such a use of national legal concepts in the context of the Brussels I Regulation (and the same applies to the Brussels Ibis Regulation) would create different outcomes among the Member States which would impair the aim of unifying the rules of jurisdiction pursued by the Regulation,<sup>575</sup> and would not be in line with the objective of legal certainty and predictability of jurisdiction. For, depending on the applicable law, the action of a person which took place in a Member State other than the forum State might or might not be classified as the event giving rise to the damage for the purpose of the attribution of jurisdiction pursuant to Article 5(3) of the Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation).<sup>576</sup> The ECJ made clear that this decision does not impair, in particular, the possibility of consolidating actions against several infringers according to Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) where the conditions for consolidation are fulfilled.<sup>577</sup> Noteworthy, the ECJ confirmed its jurisprudence in *Melzer* in its subsequent *Hi Hotel*<sup>578</sup> and *Coty Germany*<sup>579</sup> decisions.

---

<sup>572</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 30, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>573</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 31, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*. In this respect, one might criticise that the ECJ did not take into consideration that the question of an reciprocal attribution of the place of the event giving rise to the damage – situated at the level of *procedural law* – is *not* identical with, but has to be distinguished from the assessment of an attribution of tortious actings which takes place at the level of *substantive law*, cf. Mansel, Thorn & Wagner (2014)34(1) IPRax 1, at pp. 13-14; R. Wagner (case note) ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, (2013)24(14) EuZW 544, at p. 547.

<sup>574</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 32, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*. One might have expected from the ECJ more detailed considerations with regard to (the development of) an eventual *autonomous* interpretation of a reciprocal attribution of the place of the event giving rise to the damage in case of several perpetrators, cf. R. Wagner (case note) ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, (2013)24(14) EuZW 544, at p. 547.

<sup>575</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 34, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>576</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 35, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>577</sup> ECJ 16 May 2013, C-228/11, *Melzer v MF Global UK Ltd*, para. 39, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*.

<sup>578</sup> ECJ 3 April 2014, C-387/12, *Hi Hotel HCF SARL v Uwe Spoering*, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0387&rid=3>> – *Hi Hotel*.

<sup>579</sup> ECJ 5 June 2014, C-360/12, *Coty Germany GmbH, formerly Coty Prestige Lancaster Group GmbH v First Note Perfumes NV*, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0360&rid=4>> – *Coty Germany*.

### 2.2.3.2 Extraterritorial place where the damage occurred or may occur

Having discussed, in the foregoing paragraphs, the question of whether (respectively where) there can be an extraterritorial place of the event giving rise to the damage according to Article 7(2), I shall now turn to the parallel question of whether there can be, concerning a patent infringement, an extraterritorial place where the damage occurred.

#### 2.2.3.2.1 Conception 1: Absence of any place where the damage occurred

In contrast to the situation as to the place of the event giving rise to the damage, parts of legal doctrine have doubted that a place where the damage occurred can exist with regard to the infringement of patents. So, it has been put forward that, in patent infringement cases, the forum where damage arises for the purposes of Article 7(2) (respectively its predecessors) is necessarily the place where the act of infringement occurred.<sup>580</sup> In this respect, it could be argued that patents as intellectual property rights, in the absence of any physicalness, cannot be localised at a specific place,<sup>581</sup> and that only the consequences of a patent infringement can be localised, i.e. the material (financial) disadvantages at the expense of the patent holder which arise, for instance, through the unauthorised bringing into circulation of a protected product by the patent infringer.<sup>582</sup> On the basis of this opinion, the question of the eventual existence of an extraterritorial place where the damage occurred does not arise.

#### 2.2.3.2.2 (Prevailing) conception 2: Place where the damage occurred is the place where the patent right has been infringed (“*Ort der Rechtsgutverletzung*”)

The majority of legal commentators however advocate a conception according to which there is a place where the damage occurred with regard to cases of patent infringement, and, referring to the principle of territoriality, localise this place (only) at the place where the patent right has been infringed, i.e. in the protection State.<sup>583</sup> According to this opinion, the place of the event giving rise to the damage, regarding the infringement of patents, will always be identical with the place where the damage occurred,<sup>584</sup> because the infringement of the patent is realised where the infringing act is committed.<sup>585</sup> Conception 2 was also shared by the German *Oberlandesgericht Düsseldorf* in its famous *Schussfadengreifer II*<sup>586</sup> decision which was rendered subsequently to the *Schussfadengreifer I*<sup>587</sup> decision by the German *Landgericht Düsseldorf*.

---

<sup>580</sup> Pertegás Sender 2002, para. 3.90, there fn. 124; Reber (2005)49(3) ZUM 194, at p. 196.

<sup>581</sup> Schack 2010, para. 343.

<sup>582</sup> Schauwecker 2009, p. 137.

<sup>583</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, paras. 253, 262b; Treichel 2001, p. 24; Schlosser 2009, Art. 5 EuGVVO, para. 19; Kortmann 2005, p. 27; Adolphsen (2006)11 ZZPInt 137, at p. 156.

<sup>584</sup> Kühnen 2012, para. 770.

<sup>585</sup> Bukow 2003, pp. 80-83, in particular p. 83; Grabinski (2001)50(3) GRUR Int. 199, at p. 204; Neuhaus (1996)87(9) Mitt. 257, at p. 264; Von Meibom & Pitz (1996)87(7) Mitt. 181, at p. 182 (= Von Meibom & Pitz (1997)19(8) E.I.P.R. 469, at p. 470); Laubinger 2005, pp. 48-49; Bettinger & Thum (1999)48(8-9) GRUR Int. 659, at p. 664; cf. Fawcett & Torremans 2011, para. 5.71; Pansch (2000/01)1(5) EuLF 353, at p. 354.

<sup>586</sup> OLG Düsseldorf 22 July 1999, 2 U 127/98, (2001)21(4) IPRax 336, at pp. 337-338 – *Schussfadengreifer II*.

<sup>587</sup> LG Düsseldorf 25 August 1998, 4 O 165/97, (1999)48(5) GRUR Int. 455, at p. 458 – *Schussfadengreifer I*.



In order to curtail jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) on the basis of the place where the harmful event occurred, the ECJ held in its *Marinari* decision that

“(…) the term “place where the harmful event occurred” in Article 5(3) of the [Brussels] Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters does not, on a proper interpretation, cover the place where the victim claims to have suffered financial damage following upon initial damage arising and suffered by him in another Contracting State [underscore and content in brackets added].”<sup>588</sup>

Deciding in this way, the ECJ stated clearly that *only the initial/direct damage* is to be considered relevant as damage in the framework of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation). Places where subsequent or mediate damage comes into existence are therefore irrelevant in jurisdictional respect.<sup>589</sup> If such subsequent respectively mediate/indirect damage was to be taken into account, this would result in an overflowing jurisdiction according to Article 7(2), which would be problematic because Article 7(2), with accordance to the constant jurisprudence of the ECJ (as to the predecessors of Article 7(2)), is to be interpreted restrictively since it constitutes an exception to Article 4(1).<sup>590</sup> An extensive interpretation of the notion of place where the damage occurred which also takes into account indirect damage might even result in the creation of a *forum actoris* which is against the express conception of the Brussels Ibis Regulation.<sup>591</sup> Besides, it is to be taken into consideration that all preconditions for liability have already been fulfilled in the State where the initial damage occurred. As a consequence, aspects of factual proximity (proximity to evidence) and efficacious conduct of proceedings do not require to assign jurisdiction to courts of another State.<sup>592</sup> Last but not least, the ideas of legal certainty and predictability of jurisdiction which are inherent to the Brussels Ibis Regulation in order to strengthen legal protection of persons domiciled in the European Union require that an informed plaintiff is able to foresee before which court(s) he may initiate proceedings, and that an informed defendant is able to foresee before which court(s) apart from the courts at his domicile he may be sued. These principles of legal certainty and predictability would be disregarded if indirect/consequential damage would be relevant for determining the place where the damage occurred according to Article 7(2).<sup>593</sup>

However, Conception 2 does not reach different results in comparison with Conception 1, because according to both conceptions jurisdiction according to Article 7(2) will be

---

<sup>588</sup> ECJ 19 September 1995, C-364/93, Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company, [1995] ECR I-02719, para. 21 – *Marinari*.

<sup>589</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 5 EuGVVO, paras. 254, 262b; Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, paras. 43 and 46; Ten Wolde & Henckel (2013)3(2) IJPL 195, at pp. 217-219.

<sup>590</sup> Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 86.

<sup>591</sup> Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 45 with reference to ECJ 11 January 1990, C-220/88, Dumez France and Another v Hessische Landesbank (Helaba) and Others, [1990] ECR I-00049, para. 19 – *Dumez*.

<sup>592</sup> Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 44 with reference to ECJ 10 June 2004, C-168/02, Rudolf Kronhofer v Marianne Maier and Others, [2004] ECR I-06009, para. 18 – *Kronhofer*.

<sup>593</sup> Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 45 with reference to ECJ 19 February 2002, C-256/00, Besix SA v Wasserreinigungsbau Alfred Kretzschmar GmbH & Co. KG (WABAG), Planungs- und Forschungsgesellschaft Dipl. Ing. W. Kretzschmar GmbH & Co. KG (Plafog), [2002] ECR I-01699, paras. 25-26 – *Besix*; ECJ, 5 February 2004, C-18/02, Danmarks Rederiforening, acting on behalf of DFDS Torline A/S, v LO Landsorganisationen i Sverige, acting on behalf of SEKO Sjöfolk Facket För Service och Kommunikation, [2004] ECR I-01417, para. 36 – *DFDS Torline*; ECJ 10 June 2004, C-168/02, Rudolf Kronhofer v Marianne Maier and Others, [2004] ECR I-06009, para. 20 – *Kronhofer*.

established at the place of the event giving rise to the damage, be it that no place where the harmful event occurred exists, be it that the place of the event giving rise to the damage and an existing place where the harmful event occurred are identical.<sup>594</sup> As a consequence of both conceptions, an extraterritorial place where the damage occurred cannot exist, because a patent can only be infringed in the protection State.<sup>595</sup>

### **2.2.3.2.3 Conception 3: Potential existence of further places where the damage occurred besides the place where the patent right has been infringed**

Nonetheless, it is doubtful if the principle of territoriality indeed has the effect that the place where the damage occurred, as to the infringement of a patent, can only be located at the place where the patent right has been infringed, i.e. in the protection State, or if, in addition to that place, there can be further places where the damage occurred. To recall the *Marinari* decision of the ECJ, the court held that the place of jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) is to be determined *independently from the applicable rules on non-contractual civil liability*.<sup>596</sup> In this respect, it is to be noticed that the substantive principle of territoriality, although it might be existent in numerous legal systems, forms a principle of the national law applicable in the specific case to be decided. In light of this, determining the place where the damage occurred in the sense of Article 7(2) by referring to the principle of territoriality would be irreconcilable with the interpretation of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) undertaken by the ECJ in *Marinari*.<sup>597</sup> Consequently, assuming that the place where the damage occurred must be identical with the place where the patent right has been infringed, i.e. in the protection State, does not correspond to the independent interpretation of Article 7(2) of the Brussels Ibis Regulation (respectively its predecessors) demanded by the ECJ.<sup>598</sup> Moreover, in case that, due to the principle of territoriality, jurisdiction according to Article 7(2) would only be conferred to the courts in the State where the patent has been granted, there would be an automatic synchronism between jurisdiction according to Article 7(2) and jurisdiction according to Article 24(4).<sup>599</sup> With regard to patent infringement, special jurisdiction according to Article 7(2) would then lose any importance vis-à-vis exclusive jurisdiction according to Article 24(4) which would mean to deprive Article 7(2) of its *effet utile*. An interpretation of Article 7(2) which effects this result is to be rejected.

In the following, I shall analyse which further places besides the place where the patent right has been infringed (“*Ort der Rechtsgutverletzung*”) could be considered places where the damage occurred.

#### **2.2.3.2.3.1 Place of domicile (seat) of the patent holder**

It could be argued that the place where the damage occurred can be localised at the place of domicile of the patent holder, because the patent infringer would have had to pay a licence, i.e. he actually omitted to pay a licence at this place what he would have had to do in order to

---

<sup>594</sup> Heinze 2007, p. 233.

<sup>595</sup> Grabinski (2001)50(3) GRUR Int. 199, at p. 204.

<sup>596</sup> ECJ 19 September 1995, C-364/93, Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company, [1995] ECR I-02719, para. 19 – *Marinari*.

<sup>597</sup> Winkler 2011, p. 212; Nuyts 2008, p. 123; Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 86a.

<sup>598</sup> Cf. also Hausmann (2003)3(5/6) EuLF 277, at p. 280.

<sup>599</sup> Pertegás Sender 2002, para. 3.100; Fezer & Koos 2010 (Staudinger), para. 1137.

legally make use of the protected product or process. Insofar, the patent holder suffers financial loss at this place.<sup>600</sup> Besides, financial loss of the patent holder could be effected in the form of a reduced sale of products. It could also be put forth that the damage occurs at the domicile of the patent holder, because the patent is protected there.<sup>601</sup>

A closer look on these arguments however reveals that they are not convincing. First of all, it is to be underlined that the place where the patent holder suffers financial loss is not relevant for the determination of the place where the damage occurred in the sense of Article 7(2), because financial loss merely constitutes an indirect, i.e. a consequential damage;<sup>602</sup> the initial damage is already realised at the place of infringement of the patent right. As illustrated above, the ECJ however only accepts initial damage to be relevant in the framework of Article 7(2). Furthermore, the place of domicile of the patentee is independent from the question in which State patent protection has been gained. The place where the patentee is domiciled *can be*, but *does not have to be* located in the protection State. In contrast to immovable property, which is clearly located at a specific *place*, a patent is granted for the territory of a specific *State*. Due to the fact that a granted patent exists anywhere in the protection State, a localisation is only possible at the place where the infringing act is committed, because the patent is realised at this place at the moment of infringement.<sup>603</sup> In this respect, considering the place of domicile of the patentee in the framework of Article 7(2) would also be contrary to the principles of legal predictability and certainty, because the patentee can choose his domicile and transfer his patent right to another person whose place of domicile would then be decisive in jurisdictional respect, meaning that the place of domicile of the patentee could be easily influenced and manipulated by the patentee.<sup>604</sup> Furthermore, considering the place of domicile of the patent holder as a place where the damage occurred according to Article 7(2) would mean to create a *forum actoris* which would violate the fundamental principle of Article 4(1)<sup>605</sup> because the European legislator has neither explicitly provided for an exception from the rule of Article 4(1)<sup>606</sup>, nor is it evident that courts at the place of domicile of the patent holder are *per se* closer to facts and evidence than courts at the place of domicile of the defendant, i.e. the alleged infringer with regard to patent infringement.<sup>607</sup> The effect of establishing a *forum actoris* would be severe particularly due to the considerable territorial scope of application of the Brussels Ibis Regulation.<sup>608</sup>

#### **2.2.3.2.3.2 Place of the impact on/saturation of the market (“Ort der Marktbeeinflussung”/“Ort der Marktsättigung”)**

Further, it could be argued that the place where the damage occurred according to Article 7(2) can be determined at the extraterritorial place of impact on the market, i.e. the place of saturation of the market, beyond the protection State, concerning a specific product for which the patentee holds a patent, by the import of an allegedly infringing product through the

<sup>600</sup> Cf. as to copyright law: Kiethe (1994)47(4) NJW 222, at p. 225.

<sup>601</sup> Cf. as to copyright law: Ohl (1961)63(10) GRUR 521, at pp. 523-524.

<sup>602</sup> Fawcett & Torremans 2011, paras. 5.72-5.74; Wadlow 1998, paras. 2-95-2-97.

<sup>603</sup> Schauwecker 2009, p. 139 et seq.; Stauder (1976)25(11) GRUR Int. 465, at p. 474; Geimer 2015, para. 1503; Fawcett & Torremans 2011, para. 5.71; Tritton 2008, para. 14-025.

<sup>604</sup> Bukow 2003, p. 93; Uhl 2000, p. 214.

<sup>605</sup> Stauder (1976)25(11) GRUR Int. 465, at p. 474; Kieninger (1998)47(4) GRUR Int. 280, at p. 282; Treichel 2001, p. 23 et seq.; Lange (2000)46(9) WRP 940, at p. 941; Schack 2010, para. 344.

<sup>606</sup> Schauwecker 2009, p. 140.

<sup>607</sup> Hye-Knudsen 2005, p. 76; Bukow 2003, p. 92.

<sup>608</sup> Emphasising this fact with regard to the Brussels Convention: Stauder (1976)25(11) GRUR Int. 465, at p. 474.

alleged infringer, in case that the patent holder loses business relationships at that place as a direct (immediate) result of this import.<sup>609</sup> This conception must be considered in light of the fact that the term “place where the damage occurred”, with accordance to the imprecise formulation by the ECJ, may comprise, in German law<sup>610</sup>, both the “*Ort der Rechtsgutverletzung*” (place of the infringement of the patent) and the “*Schadensort*” (place of the damage). It is to be underlined that “*Rechtsgutverletzung*” and “*Schaden*” are to be strictly differentiated in German law. The occurrence of a “*Rechtsgutverletzung*” can, but not necessarily does, coincide with the occurrence of a “*Schaden*”. Regarding this, it has been pointed out that the “*Schadensort*” (place of the damage) has its own relevance in terms of jurisdiction, because it reveals a close connection between the dispute and the invoked court that goes beyond the mere infringement of the patent right as such.<sup>611</sup>

Since its *Mines de Potasse* decision, the ECJ has constantly held that the reason for jurisdiction according to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), comprising the place of the event giving rise to the damage and the place where the damage occurred, is a particularly close connection between the dispute and the invoked court, with a view to the efficacious conduct of the proceedings. Consequently, the crucial question is whether a particularly close connection exists between the place of impact on the market and the court before which proceedings are initiated, i.e. whether proceedings before a court at the place of impact on the market can be conducted efficaciously.

As to this issue, opponents of the conception being discussed here, according to which the place of impact on the market is to be considered a place where the damage occurred, have argued that the damage is not a necessary element to prove the infringement of a patent (although it is generally an essential element to proving an action in tort).<sup>612</sup> Therefore, the existence of a particularly close connection between the courts at the place of impact on the market and a dispute concerning patent infringement could be denied. However, such a view would disregard that the ECJ decided in *Marinari* that determining jurisdiction pursuant to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) may not be realised by reference to the applicable rules on non-contractual civil liability.<sup>613</sup> Accordingly, the question of whether a patent infringement *per se* requires damage cannot be answered *a priori*.

Besides, it could be argued that the plaintiff who sues the alleged infringer of a patent for damages must prove the existence of a damage, and the invoked court must examine the scope of the alleged damage.<sup>614</sup> While parts of legal doctrine have concluded from these

---

<sup>609</sup> Otte (2001)21(4) IPRax 315, at p. 319.

<sup>610</sup> Noteworthy, this differentiation does not exist in each legal system of the Member States. Especially the romanistic legal systems and the Common Law do not imply such a clear differentiation. The absence of a common European concept might have been the main reason for the ECJ to refrain from a clearer identification of what exactly is meant by the “place where the damage occurred” in the sense of Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation). In addition, it is to be remarked that the European legislator has not clarified either the issue what is to be understood by “damage” contained in other documents; for instance, Article 4(1) of the Rome II Regulation concerning conflict of law rules for non-contractual relations also uses the term “law of the country in which the damage occurs” which could equally mean the law of the State where the “*Rechtsgutverletzung*” or the “*Schaden*” have been realised.

<sup>611</sup> Otte (2001)21(4) IPRax 315, at p. 318.

<sup>612</sup> Lundstedt (2001)32(2) IIC 124, at pp. 136-137 (= (2001)50(2) GRUR Int. 103, at p. 109); cf. Fawcett & Torremans 2011, para. 5.66.

<sup>613</sup> ECJ 19 September 1995, C-364/93, Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company, [1995] ECR I-02719, para. 19 – *Marinari*.

<sup>614</sup> Bukow 2003, p. 89.

circumstances that an efficacious conduct of proceedings will be attained at the place of impact on the market due to its proximity to evidence,<sup>615</sup> it is doubtful if the significance of that place for an efficacious conduct of proceedings is indeed existent. In this respect, it has been rightly suggested that a specific proximity to facts and evidence at the place of impact on the market will regularly be without particular use, because the amount of damages will regularly be determined according to the licence (fees) which would have reasonably been agreed between the parties if they had concluded a licence contract. In this context, the amount of the manufactured pieces of the concerned product will be a decisive factor. In light of this, proximity to facts and evidence in order to determine the amount of damages to pay, will be more likely to exist at the place of manufacture, because there the number of manufactured pieces can be determined more easily.<sup>616</sup> Additionally, it is to be considered that evidence (“*Beweisführung*”) is impaired by the fact that, in cases of cross-border patent infringement, the alleged infringer will often claim that he developed a new market for his products which would not have been accessible for the patentee.<sup>617</sup>

However, the decisive question as to the issue if the place of impact on the market can be considered a place where the damage occurred in the sense of Article 7(2) is whether this conception is reconcilable with the jurisprudence of the ECJ in its *Marinari* decision, where the court also explicitly restricted Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) by stating that

“(…) the term “place where the harmful event occurred” in Article 5(3) [of the Brussels Convention] (…) does not, on a proper interpretation, cover the place where the victim claims to have suffered financial damage following upon initial damage arising and suffered by him in another Contracting State [underscore and content in brackets added].”<sup>618</sup>

By this, the ECJ made clear that only initial damage constitutes “damage” in the sense of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation).<sup>619</sup> Arguing in favour of the conception that an extraterritorial place of impact on the market can be considered a place where the damage occurred pursuant to Article 7(2), one might emphasise that this damage does not constitute a mere consequential or indirect damage of a patent infringement committed in the protection State, which would not be relevant in terms of Article 7(2), but rather constitutes an initial (immediate) damage in the other State which is relevant for determining jurisdiction pursuant to Article 7(2), meaning that the constellation is different from that in *Marinari* and that therefore the cited passage of the *Marinari* decision cannot be applied to this constellation.<sup>620</sup> On the other hand, the damage in question could also be qualified as a pure consequential damage of the infringement of the patent. As a consequence, the place of impact on the market would then be no place where the damage occurred according to Article 7(2).<sup>621</sup> Differentiating between the infringement of the patent right as such and negative financial effects which result from this patent infringement, it appears indeed convincing to qualify *only the infringement of the patent right as the initial damage*, which means that all subsequent negative effects can merely constitute a consequential damage which has no effect in terms of Article 7(2).<sup>622</sup> In light of this, the

<sup>615</sup> Otte (2001)21(4) IPRax 315, at p. 318; Winkler 2011, p. 215.

<sup>616</sup> Bukow 2003, p. 90.

<sup>617</sup> Bukow 2003, p. 90.

<sup>618</sup> ECJ 19 September 1995, C-364/93, Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company, [1995] ECR I-02719, para. 21 – *Marinari*.

<sup>619</sup> Ten Wolde/Knot & Weller 2012 (unalex Kommentar), Art. 5 Nr. 3 Brüssel I-VO, para. 6.

<sup>620</sup> Cf. Otte (2001)21(4) IPRax 315, at p. 319.

<sup>621</sup> Bukow 2003, pp. 86, 91.

<sup>622</sup> Wadlow 1998, paras. 2–95–2–97; Fawcett & Torremans 2011, paras. 5.72–5.74; Geimer 2015, para. 1501; Schack (2000)3(3) MMR 135, at p. 137.

situation in discussion is actually comparable to the situation in the *Marinari* case, where the act giving rise to a claim for damages was terminated by the seizure, the financial effects in Italy being only consequences of this relevant act.<sup>623</sup>

Last but not least, it could be argued that restricting the interpretation of the place where the damage occurred in the sense of Article 7(2) to the place of the infringement of the patent would logically result in a synchronism between the place of the event giving rise to the damage and the place where the harmful event occurred<sup>624</sup> which would considerably deprive Article 7(2) of its *effet utile*.<sup>625</sup> However, this argumentation goes astray. While it is true that the conception according to which the place where the damage occurred in the sense of Article 7(2) is the place of infringement of the patent right, has the effect that the place giving rise to the damage and the place where the damage occurred are identical as to cases of patent infringement,<sup>626</sup> this does not impair the fact that both places exist.<sup>627</sup> Considering the place of impact on the market, respectively the place of saturation of the market as a place where the damage occurred in terms of Article 7(2), would rather mean to construct a *third* type of place of jurisdiction according to Article 7(2).<sup>628</sup> This would be irreconcilable with the structure of Article 7(2) and the constant interpretation of Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) by the ECJ.

#### **2.2.3.2.3.3 Place of the conflict of interests between the patent holder and the infringer (“Ort der Interessenkollision”)**

Besides, one might think of localising a place where the damage occurred according to Article 7(2) at the place where the *interests* of the patent holder are infringed, i.e. at the place where the interests of the patent holder and those of the infringer conflict with each other.<sup>629</sup> In this respect, one might underline that the determination of the place where the damage occurred is to be undertaken independently from substantive patent protection according to the applicable law of the protection State, which results in the independent evaluation of the parties’ interests inasmuch as jurisdiction according to Article 7(2) is concerned.<sup>630</sup>

However, as this conception actually constitutes a variant of the conception discussed above which refers to the place of the impact on the market respectively saturation of the market, it is to be rejected for the same reason: In line with the jurisprudence of the ECJ, it is to be differentiated between the infringement of the patent right as such and negative financial effects which result from this patent infringement. Only the *infringement* of the patent right forms the initial damage which is relevant for the determination of the place of jurisdiction in terms of Article 7(2). Further (subsequent) negative effects – comprising any conflicts of interests – can merely constitute a consequential damage which has no relevance for jurisdiction according to Article 7(2).

---

<sup>623</sup> Bukow 2003, p. 87.

<sup>624</sup> Otte (2001)21(4) IPRax 315, at p. 318.

<sup>625</sup> Winkler 2011, p. 214 et seq.

<sup>626</sup> Schauwecker 2009, p. 141.

<sup>627</sup> Bukow 2003, p. 88.

<sup>628</sup> Bukow 2003, p. 88.

<sup>629</sup> Fezer & Koos 2010 (Staudinger), para. 1138.

<sup>630</sup> Fezer & Koos 2010 (Staudinger), para. 1138.

#### 2.2.3.2.3.4 Conclusion

As a consequence, it is to be stated that only the place where the patent right has been infringed (“*Ort der Rechtsgutverletzung*”) is to be considered as the place where the damage occurred according to Article 7(2). Otherwise the clear differentiation between initial and consequential damage which has been purported by the ECJ would be disregarded.

The same applies with regard to the determination of the place where the damage occurred in the framework of IP infringements via the internet. The ECJ made clear, in its *Wintersteiger* decision, that, concerning the infringement of a national trade mark registered in a Member State through online advertisements by an advertiser domiciled in another Member State,

“(i)t is the courts of the Member State in which the trade mark at issue is registered which are best able to assess (...) whether a situation such as that in the main proceedings actually infringes the protected national mark. Those courts have the power to determine all the damage allegedly caused to the proprietor of the protected right because of an infringement of it and to hear an application seeking cessation of all infringements of that right.

Therefore it must be held that an action relating to infringement of a trade mark registered in a Member State through the use, by an advertiser, of a keyword identical to that trade mark on a search engine website operating under a country-specific top-level domain of another Member State may be brought before the courts of the Member State in which the trade mark is registered [underscore added].<sup>631</sup>

The ECJ later confirmed and applied this jurisprudence, in its *Pinckney* decision, with regard to the infringement of copyrights via the internet.<sup>632</sup> The court held:

“(...) Article 5(3) of the [Brussels I] Regulation must be interpreted as meaning that, in the event of alleged infringement of copyrights protected by the Member State of the court seised, the latter has jurisdiction to hear an action to establish liability brought by the author of a work against a company established in another Member State and which has, in the latter State, reproduced that work on a material support which is subsequently sold by companies established in a third Member State through an internet site also accessible with the jurisdiction of the court seised. That court has jurisdiction only to determine the damage caused in the Member State within which it is situated [content in brackets added].”<sup>633</sup>

#### 2.2.4 Territorial scope of the authority to decide of a court pursuant to Article 7(2)

Having treated, in the foregoing paragraphs, the issue of an extraterritorial place of the event giving rise to the damage and an extraterritorial place where the damage occurred according to Article 7(2), the subsequent question arises in how far the invoked court is authorised to decide, in territorial respect, if patents granted in different States are infringed through the *same* act by one (alleged) infringer. This constellation concerns so-called *multistate delicts*,

---

<sup>631</sup> ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, paras. 28-29, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>632</sup> Cf. Hau & Eichel (2015)12(2) GPR 95, at p. 98; Mansel, Thorn & Wagner (2014)34(1) IPRax 1, at pp. 12-13.

<sup>633</sup> ECJ 3 October 2013, C-170/12, *Peter Pinckney v KDG Mediatech AG*, para. 47, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0170&rid=5>> (lastly accessed on 1 June 2015) – *Pinckney*; confirmed in ECJ 22 January 2015, C-441/13, *Pez Hejduk v EnergieAgentur.NRW GmbH*, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62013CJ0441&rid=3>> (lastly accessed on 1 June 2015) – *Pez Hejduk*.

which schematically constitute a sort of cross-border delicts.<sup>634</sup> In case of such *parallel* infringements of different national patents (or national and European patents), the patent holder may have an interest to initiate proceedings with regard to all infringements before one court in order to reduce costs and avoid the risk of conflicting decisions by different courts.<sup>635</sup> However, the crucial question to examine is whether the invoked court is indeed authorised to decide on potential infringements of patents granted for another State than the forum State. It is to be clarified whether, besides the above considerations on an extraterritorial place of the event giving rise to the damage respectively an extraterritorial place where the damage occurred, another possibility can be *factually* established to conduct patent infringement proceedings outside the protection State, based on a comprehensive authority to decide.

#### **2.2.4.1 Conception 1: The invoked court only has authority to decide with regard to patents granted for the forum State**

According to the traditional opinion in legal doctrine and jurisprudence, jurisdiction according to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) merely enables a court to decide on patent infringements with regard to patents which have been granted for the State where the court is situated.<sup>636</sup>

Diverse arguments are conceivable for this conception: First of all, it could be argued that the wording of Article 7(2) does not cover the constellation of multistate delicts.<sup>637</sup> Besides, schematic reasons as to the structure of the Brussels Ibis Regulation could be referred to. In this respect, it might be underlined that Article 7(2) – in contrast to other provisions of the Brussels Ibis Regulation such as Articles 4(1) and 8 – does not have the purpose to consolidate multiple proceedings before one court, but aims at establishing additional places of jurisdiction. Due to the different purposes of Article 7(2) on the one hand, and Articles 4(1) and 8 on the other hand, it would not be possible to extend Article 7(2) in the sense of the other provisions. On the contrary, it could be reasoned that the fact that Article 8 confers the possibility to consolidate multiple proceedings before one court shows that the European legislator has been aware of, respectively has taken into consideration the need for a consolidation of proceedings, but intendedly refused to provide for a similar rule in Article 7. As a consequence, one could conclude that Article 7(2) should not be extended to multistate delicts.<sup>638</sup>

Besides, reference might be made to corresponding provisions of the Community trade mark Regulation, the Community designs Regulation (Article 83(2)) and the Litigation Protocol annexed to the Community Patent Convention (which has not entered into force) (Article 17(2)).

---

<sup>634</sup> Drexel 2015 (Münchener Kommentar zum BGB), Internationales Immaterialgüterrecht, para. 252. It is noteworthy that the constellation of multistate delicts is to be distinguished from parallel delicts according to Article 8(1) where several delicts are committed by several infringers.

<sup>635</sup> Hausmann (2003)3(5/6) EuLF 277, at p. 280.

<sup>636</sup> Stauder (1998)18(5) IPRax 317, at p. 321; Brinkhof (1997)46(6) GRUR Int. 489, at p. 491; Neuhaus (1996)87(9) Mitt. 257, at p. 264; Hausmann (2003)3(5/6) EuLF 277, at p. 281; Nagel & Gottwald 2013, § 3, para. 85; Grabinski (2001)50(3) GRUR Int. 199, at p. 205; Adolphsen 2009, paras. 483, 494 et seq.; Kortmann 2005, p. 64.

<sup>637</sup> Schauwecker 2009, p. 157.

<sup>638</sup> Cf. Schauwecker 2009, p. 158.



For instance, Article 97(5) in conjunction with Article 98(2) of the Community trade mark Regulation<sup>639</sup> provides:

#### **Article 97 of the Community trade mark Regulation**

(...)

(5) Proceedings in respect of the actions and claims referred to in Article 92, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9(3), second sentence, has been committed.

#### **Article 98 of the Community trade mark Regulation**

(...)

(2) A Community trade mark court whose jurisdiction is based on Article 93(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

In light of the fact that these provisions clarify that a court having jurisdiction on the basis of an act of infringement committed in the forum State has no jurisdiction concerning separate acts of infringement committed in other Member States, it could be concluded *a fortiori* that the same must apply in case that no unitary rights such as the Community trade mark or the (future) Community patent are concerned, but independent national rights that only have in common the European patent grant from which they originated.<sup>640</sup>

Moreover, one might put forward that restricting the scope of authority to decide in territorial respect does not unduly impair the plaintiff, because the plaintiff can always institute parallel infringement proceedings before a court which has jurisdiction at the place of domicile of the defendant, according to Article 4(1).<sup>641</sup> Furthermore, a positive effect of restricting the scope of authority to decide in territorial respect would be that forum shopping would be avoided.<sup>642</sup>

One might also underline that a territorial restriction of the scope of authority to decide can be derived from the *Shevill* decision of the ECJ.<sup>643</sup> Although, as illustrated above, the *Shevill* decision concerning rights of personality is not *per se* transferable to the constellation of the cross-border infringement of territorially restricted rights, the result must be relevant *a fortiori* to the cross-border infringement of patents (in the constellation of multistate delicts). If, as the ECJ held in *Shevill*, jurisdiction according to Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation) at the place where the damage occurred is restricted in the case of a uniform right (such as the right of personality) where the damage occurs at multiple places due to the universal character of such a right, the same must go in the case of

---

<sup>639</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1-42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>640</sup> Pertegás Sender 2002, para. 3.124; cf. Brinkhof (1997)46(6) GRUR Int. 489, at p. 491; Bertrams (1995)44(3) GRUR Int. 193, at p. 197; Neuhaus (1996)87(9) Mitt. 257, at p. 265.

<sup>641</sup> Adolphsen 2009, para. 495; Grabinski (2001)50(3) GRUR Int. 199, at p. 205; Fawcett & Torremans 2011, para. 5.61.

<sup>642</sup> Stauder & Kur 2001, p. 155.

<sup>643</sup> Stauder (1998)18(5) IPRax 317, at p. 321; Schlosser 2009, Art. 5 EuGVVO, para. 20; Fawcett & Torremans 2011, para. 5.58.

multiple places of damage which do not ground on a uniform delict, but only on a common physical initial act like in the case of patent infringement.<sup>644</sup>

#### **2.2.4.2 Conception 2: The court has authority to decide also with regard to patents granted for other States than the forum State**

While the majority of legal commentators tend to allocate courts authority to decide merely with regard to patents granted for the forum State, the question remains whether such a restrictive view is always justified.

The addressed reference to the provisions of the Community trade mark Regulation, the Community designs Regulation (Article 83(2)) and the Litigation Protocol annexed to the Community Patent Convention (which has not entered into force) (Article 17(2)), and the conclusion *a fortiori* that Article 7(2) does not confer authority to courts to decide on the infringement of patents which have been granted outside the forum State, are actually not convincing. European patents – in contrast to the Community trade mark, the Community design and the (future) European patent with unitary effect – lack the character of unitary rights which constitutes a fundamental difference. The national parts of European patents are independent from each other which effects that there is *a priori* no need to ensure a uniform treatment.<sup>645</sup> In contrast, the cited Regulations and the Litigation Protocol annexed to the Community Patent Convention aim at establishing a uniform character of the concerned unitary rights,<sup>646</sup> and are therefore based on different evaluations which cannot be transferred on Article 7(2).<sup>647</sup> As a consequence of this fundamental difference between those unitary rights and European patents, the restriction of jurisdiction contained in the cited provisions cannot be transferred on the issue of jurisdiction according to Article 7(2).

#### **2.2.4.3 Effects of the so-called mosaic principle developed in the *Shevill* decision on the territorial scope of cognition of courts concerning cross-border patent infringement cases**

It has been illustrated above that the *Shevill* decision of the ECJ on the cross-border infringement of rights of personality is *not* transferable to the constellation of cross-border patent infringement cases, due to the nature of patents as rights which are only valid in a certain territory which constitutes a significant difference vis-à-vis rights of personality which are valid without any territorial restriction. However, it has also already been suggested that this result does not necessarily mean that the *Shevill* decision does not contain any findings which may be applicable in the framework of cross-border patent infringement cases. In the following, I shall thus deal with the issue whether certain findings of the ECJ in *Shevill* might be helpful for answering the question of whether the court before which patent infringement proceedings are brought may also decide on parallel patent infringements concerning patents granted for other States than the forum State, and, if so, in which way. In particular, I shall treat the so-called mosaic principle.

In its *Shevill* decision, the ECJ, confirming its jurisprudence in *Mines de Potasse* that the place where the harmful event occurred in the sense of Article 5(3) of the Brussels

---

<sup>644</sup> Schauwecker 2009, p. 157.

<sup>645</sup> Reichardt 2006, p. 150.

<sup>646</sup> Pansch (2000/01)1(5) EuLF 353, at p. 360.

<sup>647</sup> Kortmann 2005, p. 64.

Convention (Article 7(2) of the Brussels Ibis Regulation) comprises both the place of the event giving rise to the damage and the place where the damage occurred, clearly differentiated between the scope of authority to decide at these places. As to the place of the event giving rise to the damage, the ECJ explicated:

“In the case of a libel by a newspaper article distributed in several Contracting States, the place of the event giving rise to the damage, within the meaning of those judgments, can only be the place where the publisher of the newspaper in question is established, since that is the place where the harmful event originated and from which the libel was issued and put into circulation [underscore added].”<sup>648</sup>

With regard to the scope of authority to decide at the place of the event giving rise to the damage, the ECJ held that courts at this place dispose of a wide scope of authority to decide:

“The court of the place where the publisher of the defamatory publication is established must therefore have jurisdiction to hear the action for damages for all the harm caused by the unlawful act [underscore added].”<sup>649</sup>

As to the place where the damage occurred,

“(…) the place where the event giving rise to the damage, entailing tortious, delictual or quasi-delictual liability, produced its harmful effects upon the victim”,<sup>650</sup>

the ECJ explicated that

“(i)n the case of an international libel through the press, the injury caused by a defamatory publication to the honour, reputation and good name of a natural or legal person occurs in the places where the publication is distributed, when the victim is known in those places”<sup>651</sup>

and postulated that courts at this place are only competent to decide inasmuch as damage realised in their territory is affected (mosaic principle):

“It follows that the courts of each Contracting State in which the defamatory publication was distributed and in which the victim claims to have suffered injury to his reputation have jurisdiction to rule on the injury caused in that State to the victim's reputation.”<sup>652</sup>

In order to reason that restriction of authority to decide at the place where the damage occurred vis-à-vis the place of the event giving rise to the damage, the ECJ explicitly referred to the requirement of the sound administration of justice:

“In accordance with the requirement of the sound administration of justice, the basis of the rule of special jurisdiction in Article 5(3) [of the Brussels Convention], the courts of each Contracting State in which the defamatory publication was distributed and in which the victim claims to have suffered injury to his reputation are territorially the best placed to assess the libel committed in that State and to determine the extent of the corresponding damage [underscore and content in brackets added].”<sup>653</sup>

---

<sup>648</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 24 – *Shevill*.

<sup>649</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 25 – *Shevill*.

<sup>650</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 28 – *Shevill*.

<sup>651</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 29 – *Shevill*.

<sup>652</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 30 – *Shevill*.

<sup>653</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 31 – *Shevill*.

The so-called mosaic principle developed by the ECJ in *Shevill* is essentially based on the idea of a particularly close connection between the case which is brought before a court and this forum, respectively the intensity and scope of such connection. Besides, it has been emphasised that this principle also intends to avoid forum shopping, because the plaintiff's possibilities to choose the place where to sue the defendant are restrained.<sup>654</sup>

In light of this, the question arises in which respect these ideas, i.e. the considerations of a particularly close connection and the avoidance of forum shopping, are also relevant as to cases of cross-border patent infringements. This might lead to the result that certain evaluations as to the scope of authority to decide, developed in the *Shevill* decision, are applicable to those cases as well.

#### **2.2.4.3.1 Particularly close connection between the case (the infringement) and the forum**

In the following paragraphs, I shall analyse separately, regarding courts at the place of the event giving rise to the damage and courts at the place where the damage occurred, in how far there is a particularly close connection between the deciding court and *parallel* patent infringements, i.e. infringements concerning patents granted in, respectively for another State than the forum State.

##### **2.2.4.3.1.1 Place of the event giving rise to the damage**

As illustrated in detail above, it has on the one hand been put forth that a particularly close connection in the sense of Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation) between a patent infringement and an invoked court only exists in the protection State, because only there the patent can be infringed, and the law of this State is applied to the patent infringement. Others have affirmed the existence of a particularly close connection between an extraterritorial place of manufacture and the forum because patent infringement is *caused* at that place. However, as presented in detail above, a differentiation between product patents and process patents seems preferable. With regard to product patents, the mere fact of manufacture of an object does not establish such a particularly close connection that would be necessary to consider an extraterritorial place of manufacture as a place of the event giving rise to the damage in the sense of Article 7(2) concerning a patent infringement in the protection State. In contrast, concerning European process patents, manufacture forms part of the uniform tort of offering, bringing into circulation, using, importing or possessing a product if this product has been manufactured according to the protected process (cf. Article 64(2) of the EPC).

##### **2.2.4.3.1.2 Place where the damage occurred**

As concluded above, the place where the damage occurred according to Article 7(2) is necessarily localised at the place where the patent right has been infringed ("*Ort der Rechtsgutverletzung*"). Only at this place there is a particularly close connection between the

---

<sup>654</sup> Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 92; Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 208; Treichel 2001, p. 26; Kropholler & Von Hein 2011, Art. 5 EuGVO, para. 84; Fezer & Koos 2010 (Staudinger), para. 1139.

patent infringement and the forum whereas there is no such particularly close connection between a court and a parallel infringement of a foreign patent.<sup>655</sup>

#### **2.2.4.3.2 Avoidance of forum shopping**

If courts having jurisdiction according to Article 7(2) were given authority to decide on parallel patent infringements, plaintiffs would be widely encouraged to choose the forum which they consider best suited to decide according to their opinion, regardless of any proximity between the chosen court and the patent infringements on which to decide. Favouring the plaintiff overly in such a way would result in a windfall profit for the plaintiff and would deny, or at least neglect, the defendant's legitimate interests.<sup>656</sup> It is in this light that the mosaic principle as a structural element of Article 7(2) is to be understood, which constitutes an obstacle to excessive forum shopping which, due to its general character, should not be confined to cases concerning defamation, libel or slander (like in the constellation of the *Shevill* case).<sup>657</sup>

#### **2.2.4.3.3 Conclusion**

At this point, it is to be stated that the considerations of a particularly close connection on the one hand, and the avoidance of forum shopping on the other hand, which are the underlying ideas of the *Shevill* decision are also relevant as to jurisdiction according to Article 7(2) in the framework of cross-border patent infringement proceedings. With regard to the idea of a particularly close connection, the place of manufacture can be an extraterritorial place of the event giving rise to the damage in the case of European process patents, if the infringing product has been manufactured according to the protected process. Additionally, it is to be underlined that both aspects are of general importance concerning actions for damages which militates for their general transferability also to cases of cross-border patent infringements.<sup>658</sup>

#### **2.2.4.4 Consequences for the territorial scope of authority to decide**

On the basis of the foregoing, I can draw the following conclusions:

Although the *Shevill* decision of the ECJ is not applicable as such to the constellation of cross-border patent infringement proceedings, considerations made by the ECJ in this decision as to the territorial scope of authority to decide of the courts at the place of the event giving rise to the damage and at the place where the damage occurred can be transferred to that constellation.

With regard to the place of the event giving rise to the damage, those in favour of a wide interpretation of the term "place of the event giving rise to the damage" according to Article 5(3) of the Brussels Convention/Brussels I Regulation (Article 7(2) of the Brussels Ibis Regulation), who are of the opinion that the place of manufacture generally suffices to

---

<sup>655</sup> Pansch (2000/01)1(5) EuLF 353, at p. 361.

<sup>656</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 208.

<sup>657</sup> Mankowski 2012 (Magnus & Mankowski), Art 5 Brussels I Regulation, para. 208; Leible 2011 (Rauscher), Art 5 Brüssel I-VO, para. 92.

<sup>658</sup> Kropholler & Von Hein 2011, Art. 5 EuGVO, para. 85; generally: Glöckner (2005)51(7) WRP 795, at pp. 799-800; Berger (2005)54(6) GRUR Int. 465, at pp. 468-469.

establish such a place of the event giving rise to the damage have – consistently – argued that a court at the place of manufacture can also decide on parallel infringements, i.e. also on infringements concerning patents granted for another State than the forum State, because all these infringements originate at the place of manufacture. According to this view, the acts of manufacture and bringing into circulation of the concerned products are actually part of the same uniform act.<sup>659</sup> However, it has been shown above that this conception is not fully convincing, and that a differentiation between European product patents and process patents is preferable. For the reasons explicated above, only in the case of European process patents, a court at the place of manufacture should also be authorised to decide on the infringement of parallel patents granted in respectively for the territory of another State than the forum State, provided that the infringing product has been manufactured according to the protected process. Such authority to decide serves procedural economy, and the common issue of the uniform determination of the extent of protection of the patent (Article 69 of the EPC) can be decided by one court.

As to the place where the damage occurred, i.e. the place where the patent right is being infringed, the invoked court has only authority to decide on *this* infringement whereas it does not have authority to decide on *parallel* infringements, i.e. infringements of patents granted in, respectively for another State than the forum State. This mosaic principle has been confirmed by the ECJ also with regard to infringements via the internet.<sup>660</sup>

## 2.3 Extension of jurisdiction at the place of domicile of one of several (alleged) infringers due to close connection of the claims – Article 8(1)

In the following paragraphs, I shall treat the question in which circumstances infringement actions against several (alleged) infringers can be consolidated at the place of domicile of one of the defendants. The relevant provision in the Brussels Ibis Regulation is Article 8(1) which reads as follows:<sup>661</sup>

### Article 8 of the Brussels Ibis Regulation

A person domiciled in a Member State may also be sued:

<sup>659</sup> Neuhaus (1996)87(9) Mitt. 257, at p. 265; Hye-Knudsen 2005, p. 69; Winkler 2011, p. 225.

<sup>660</sup> With regard to the infringement of personality rights: ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, *eDate Advertising GmbH v X* (C-509/09) and *Oliver Martinez and Robert Martinez v MGN Limited* (C-161/10), [2011] ECR I-10269 – *eDate Advertising and Martinez*; with regard to the infringement of a national trade mark registered in a Member State through online advertisements by an advertiser domiciled in another Member State: ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 34, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*; with regard to the infringement of copyrights protected by the Member State of the court seised: ECJ 3 October 2013, C-170/12, *Peter Pinckney v KDG Mediatech AG*, para. 47, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0170&rid=5>> (lastly accessed on 1 June 2015) – *Pinckney*; confirmed in ECJ 22 January 2015, C-441/13, *Pez Hejduk v EnergieAgentur.NRW GmbH*, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62013CJ0441&rid=3>> (lastly accessed on 1 June 2015) – *Pez Hejduk*.

<sup>661</sup> Article 6(1) of the Brussels I Regulation identically provided:

“A person domiciled in a Member State may also be sued:

(...)

(1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims 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.”

(1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled provided the claims 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.

In contrast to Article 4(1), but in accordance with Article 7(2), Article 8(1) does not only concern the international jurisdiction, but also affects the local jurisdiction.<sup>662</sup> Consequently, Article 8(1) is only applicable if one of the defendants has his domicile in the district of the invoked court.<sup>663</sup>

### 2.3.1 Analogous application of Article 8(1) vis-à-vis third State defendants?

Despite the clear wording of Article 8(1) of the Brussels Ibis Regulation (respectively its predecessors) which refers to “a person domiciled in a Member State”, a considerable part of legal doctrine has advocated anyway a conception according to which Article 8(1) of the Brussels Ibis Regulation (respectively its predecessors) should, by way of an analogy, be also applied vis-à-vis a co-defendant whose domicile is located in a non-Member State if at least one co-defendants is domiciled in a Member State. In this respect, proponents of this conception have argued that Article 8(1) should not be restricted, due to the fact that even the general place of jurisdiction of a defendant domiciled in a Member State is not protected against the applicability of Article 8(1). In light of this, it would appear unjustified to grant higher protection to a defendant having his domicile in a non-Member State,<sup>664</sup> in that consolidation of actions according to Article 8(1) against defendants domiciled in a Member State would be possible to a higher degree than with regard to third State defendants.<sup>665</sup>

Those who are against an analogous application of Article 8(1) vis-à-vis third State defendants have however underlined that there are actually no hints that the clear wording of Article 8(1)<sup>666</sup> does not correspond to the European legislator's will when creating the provision.<sup>667</sup> With regard to Article 6(1) of the Brussels Convention, the Jenard Report states, by merely referring to “Contracting States”, not mentioning third States:

“It follows from the text of the [Brussels] Convention that, where there are several defendants domiciled in different Contracting States, the plaintiff can at his option sue them all in the courts for the place where any one of them is domiciled [underscore and content in brackets added].”<sup>668</sup>

---

<sup>662</sup> LG Düsseldorf 25 March 1999, 4 O 198/97, (1999)48(8-9) GRUR Int. 775, at p. 777 – *Impfstoff II*; Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 2.

<sup>663</sup> LG Düsseldorf 25 March 1999, 4 O 198/97, (1999)48(8-9) GRUR Int. 775, at p. 777 – *Impfstoff II*; Hye-Knudsen 2005, p. 119.

<sup>664</sup> Neuhaus (1996)87(9) Mitt. 257, at p. 265; Ebner 2004, p. 198; Hölder 2004, pp. 52-53; Hye-Knudsen 2005, p. 119; Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 7; Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 6, para. 4; Wagner 2011 (Stein/Jonas – Kommentar zur Zivilprozessordnung), Art. 6 EuGVVO, para. 22. In favour of an extension of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) to defendants domiciled in a third State cf. also Corneloup & Althammer 2012 (unalex Kommentar), Art. 6 Brüssel I-VO, para. 22.

<sup>665</sup> Auer 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 6 VO (EG) No. 44/2001, para. 16.

<sup>666</sup> Also stressing this aspect: Grolimund 2000, para. 459; Laubinger 2005, p. 63; Stadler 2012 (Musielak), Artikel 6 EuGVVO, para. 3.

<sup>667</sup> Lüthi 2011, para. 76; others even do not discuss at all an eventual analogous application of Article 8(1) of the Brussels Ibis Regulation (respectively its predecessors) vis-à-vis third State defendants, cf. Tritton 2008, para. 14–030.

<sup>668</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 26, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

Arguing against an analogous application of Article 8(1) of the Brussels Ibis Regulation vis-à-vis third State defendants, reference may be taken as well to Article 6(1) of the Brussels Ibis Regulation which provides:

#### **Article 6 of the Brussels Ibis Regulation**

(1) If the defendant is not domiciled in a Member State, the jurisdiction of the courts of each Member State shall, subject to Article 18(1), Article 21(2) and Articles 24 and 25, be determined by the law of that Member State.

Remarkably, Article 6(1) contains a special rule for third State defendants,<sup>669</sup> according to which the provisions concerning jurisdiction according to the Brussels Ibis Regulation shall only be applicable *exceptionally*, namely where Article 18(1), Article 21(2), Article 24 or Article 25 are concerned. In all other cases, jurisdiction of Member States courts shall be determined by the respective national law of the Member State where the invoked court is situated. This is in line with Recital 14 of the Brussels Ibis Regulation reading as follows:

#### **Recital 14 of the Brussels Ibis Regulation**

A defendant not domiciled in a Member State should in general be subject to the national rules of jurisdiction applicable in the territory of the Member State of the court seised.

However, in order to ensure the protection of consumers and employees, to safeguard the jurisdiction of the courts of the Member States in situations where they have exclusive jurisdiction and to respect the autonomy of the parties, certain rules of jurisdiction in this Regulation should apply regardless of the defendant's domicile.

This also corresponds to the following explications of the Jenard Report with regard to Article 4 of the Brussels Convention (which corresponds to Article 6 of the Brussels Ibis Regulation):

“Article 4 [of the Brussels Convention] applies to all proceedings in which the defendant is not domiciled in a Contracting State, and provides that the rules of internal law remain in force [content in brackets added].”<sup>670</sup>

“The only exception to the application of the rules of jurisdiction of internal law is the field of exclusive jurisdiction (Article 16 [of the Brussels Convention]). The rules which grant exclusive jurisdiction to the courts of a State are applicable whatever the domicile of the defendant [content in brackets added].”<sup>671</sup>

---

<sup>669</sup> Emphasising this aspect in order to argue against the application of Article 8(1) vis-à-vis third State defendants: Grolimund 2000, para. 410; Stadler 2012 (Musielak), Artikel 6 EuGVVO, para. 3. However, proponents of such an application by way of analogy have underlined that not applying Article 8(1) vis-à-vis third State defendants would result in a discrimination of EU citizens towards citizens of third States, which would contradict the purpose and objective of Article 8 of the Brussels Ibis Regulation to privilege citizens of EU Member States, cf. Wagner 2011 (Stein/Jonas – Kommentar zur Zivilprozessordnung), Art. 6 EuGVVO, para. 22; cf. also Auer 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 6 VO (EG) No. 44/2001, para. 16.

<sup>670</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 20, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>671</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 21, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).



It has been shown that the European legislator, when creating Article 4(1) of the Brussels Convention, actually intended to enable Contracting States to continue to apply, vis-à-vis third State defendants, exorbitant jurisdiction rules provided for in national law which would not apply any longer vis-à-vis defendants domiciled in Contracting States.<sup>672</sup> In light of the foregoing, the better arguments therefore militated against an application of Article 8(1) vis-à-vis third State defendants.<sup>673</sup>

However, in *Ellen Mirjam Sapir*, the ECJ had the chance to resolve this controversial issue. In this case, the German *Bundesgerichtshof* expressly referred the following question (among two other questions) to the ECJ for a preliminary ruling:

“(…)

(3) Does Article 6(1) of Regulation No 44/2001 also apply to defendants not domiciled in the European Union? (...)”<sup>674</sup>

The ECJ (rightly) interpreted this question as to comprise

“(…) whether Article 6(1) of Regulation No 44/2001 must be interpreted as meaning that it is intended to apply to defendants who are not domiciled in a Member State in the case where they are sued in proceedings brought against several defendants, some of whom are also persons domiciled in the European Union.”<sup>675</sup>

The ECJ denied this question, founding its decision on three arguments which have partly already been addressed above. First of all, the ECJ referred to the distinct text of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation). The court held that

“(…) as far as concerns the persons to whom it applies, it is clear from the introductory part of Article 6(1) of Regulation No 44/2001 that it refers expressly to defendants in the European Union.”<sup>676</sup>

Emphasising the exceptional character of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation), the ECJ further stressed that

“(…) it is settled case-law that Article 6(1) of Regulation No 44/2001 lays down a special rule which must be strictly interpreted and cannot be given an interpretation going beyond the cases expressly envisaged by that regulation (...)”<sup>677</sup>

Third, the ECJ referred to the provision of Article 4(1) of the Brussels I Regulation (which essentially corresponds to Article 6(1) of the Brussels Ibis Regulation)<sup>678</sup>, according to which

---

<sup>672</sup> Grolimund 2000, paras. 261-269.

<sup>673</sup> Lüthi 2011, para. 79; Laubinger, p. 63, Czernich, Tiefenthaler & Kodek 2009, Art 6, para. 6; Beilfuss, Spider p.80, Muir Watt, Magnus/mankowski, Art. 6 para 20; Grolimund, para 459 et seq.

<sup>674</sup> ECJ 11 April 2013, C-645/11, Land Berlin v Ellen Mirjam Sapir and Others, para. 28, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0645&rid=1>> – *Ellen Mirjam Sapir*.

<sup>675</sup> ECJ 11 April 2013, C-645/11, Land Berlin v Ellen Mirjam Sapir and Others, para. 49, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0645&rid=1>> – *Ellen Mirjam Sapir*.

<sup>676</sup> ECJ 11 April 2013, C-645/11, Land Berlin v Ellen Mirjam Sapir and Others, para. 52, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0645&rid=1>> – *Ellen Mirjam Sapir*.

<sup>677</sup> ECJ 11 April 2013, C-645/11, Land Berlin v Ellen Mirjam Sapir and Others, para. 53, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0645&rid=1>> – *Ellen Mirjam Sapir*.

in case of a defendant domiciled in a third State, jurisdiction of the courts of each Member State shall in principle be determined by the national law of the forum State, whereas rules of exclusive jurisdiction according to Article 22 of the Brussels I Regulation (Article 24 of the Brussels Ibis Regulation), and prorogation of jurisdiction pursuant to Article 23 of the Brussels I Regulation (Article 25 of the Brussels Ibis Regulation) are also applicable vis-à-vis third State defendants. The ECJ made clear that, subject to the latter rules of exclusive jurisdiction and prorogation of jurisdiction,

“(…) Article 4(1) of Regulation No 44/2001 contains an express provision which governs exhaustively the matter of persons domiciled outside the European Union (...) [underscore added].”<sup>679</sup>

Apart from cases concerning exclusive jurisdiction or prorogation of jurisdiction, co-defendants within the meaning of Article 6(1) of the Brussels I Regulation/Article 8(1) of the Brussels Ibis Regulation must therefore be domiciled in another Member State.

This result is confirmed by the fact that the European legislator did not change the respective text of Article 6(1) of the Brussels I Regulation when creating Article 8(1) of the Brussels Ibis Regulation. As it is to be expected that the European legislator was well aware of the controversial discussion regarding an eventual analogous application of Article 6(1) of the Brussels I Regulation to third State defendants, one should conclude that the European legislator intendedly decided against such an approach when leaving unattached the wording of the provision.<sup>680</sup> In light of this, the argument that the European legislator, when creating Article 6(1) of the Brussels Convention, did not sufficiently consider the constellation of third State defendants,<sup>681</sup> has become obsolete, because the European legislator again had the chance to correct his legislative decision when creating the Brussels Ibis Regulation, but did not do so. As a consequence, it is to be stressed that there is no unwanted legal gap which would justify an analogous application of Article 8(1) vis-à-vis third State defendants.<sup>682</sup>

In *Réunion Européenne*, the ECJ had already clarified that Article 6(1) of the Brussels Convention (which corresponds to Article 8(1) of the Brussels Ibis Regulation) cannot be relied upon to add a defendant domiciled in a Member State to proceedings which have been brought against a defendant who is not domiciled in any Member State.<sup>683</sup> Answering to a reference for a preliminary ruling submitted by the French *Cour de Cassation*, *inter alia* with regard to the interpretation of Article 6(1) of the Brussels Convention, the ECJ expressly held, underlining in first line the significance of the principle of legal certainty, that

---

<sup>678</sup> It is noteworthy that Article 6(1) of the Brussels Ibis Regulation has been enhanced insofar as it not only determines that the Regulation is applicable in matters of exclusive jurisdiction (Article 24 of the Brussels Ibis Regulation) and prorogation of jurisdiction (Article 25 of the Brussels Ibis Regulation) – as Article 4(1) of the Brussels I Regulation provides with regard to the corresponding Articles 22 and 23 of the Brussels I Regulation – but also in constellations of Articles 18(1) and 21(2) of the Brussels Ibis Regulation.

<sup>679</sup> ECJ 11 April 2013, C-645/11, *Land Berlin v Ellen Mirjam Sapir and Others*, para. 54, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0645&rid=1>> – *Ellen Mirjam Sapir*.

<sup>680</sup> Noteworthy, the text of Article 6(1) of the Brussels Convention, the predecessor of Article 6(1) of the Brussels I Regulation, already raised the question discussed here, cf. Czernich, Tiefenthaler & Kodek 2009, Art 6, para. 6. Likewise, the respective wording in Article 6(1) of the Lugano Convention was not changed in its recast, the 2007 Lugano Convention. This demonstrates that the *status quo* obviously should not be altered in this respect.

<sup>681</sup> Grabinski (2001)50(3) GRUR Int. 199, at p. 206; Zigann 2002, p. 124; Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 7.

<sup>682</sup> Laubinger 2005, p. 63; cf. Czernich, Tiefenthaler & Kodek 2009, Art 6, para. 6; Lüthi 2011, para. 79.

<sup>683</sup> Tritton 2008, para. 14–030.

“(…) the objective of legal certainty pursued by the [Brussels] Convention would not be attained if the fact that a court in a Contracting State had accepted jurisdiction as regards one of the defendants not domiciled in a Contracting State made it possible to bring another defendant, domiciled in a Contracting State, before that same court in cases other than those envisaged by the [Brussels] Convention, thereby depriving him of the benefits of the protective rules laid down by it [underscore and content in brackets added].”<sup>684</sup>

The difference between the constellations in *Ellen Mirjam Sapir* and *Réunion Européenne* consists in the inverse roles of the defendants: In *Ellen Mirjam Sapir*, the Member State defendant was the anchor defendant and the third State defendant was the co-defendant, while the third State defendant was the anchor defendant and the Member State defendant was the co-defendant in *Réunion Européenne*.

Pursuant both to the text and to the meaning of Article 8(1), it is obvious that Article 8(1) cannot be the legal basis for suing a defendant domiciled in a Member State before the court of a third State, because the Brussels Ibis Regulation can only determine jurisdiction within the Member States.<sup>685</sup>

### 2.3.2 Close connection

The prerequisite of close connection contained in Article 8(1) (respectively Article 6(1) of the Brussels I Regulation) has been expressly formulated when the former Brussels Convention was replaced by the Brussels I Regulation. However, it is generally accepted that the transformation into the Regulation did not effect any change as to the content of the previous rule, Article 6(1) of the Brussels Convention. In its *Kalfelis* decision,<sup>686</sup> the ECJ referred to the wording of Article 22(3) of the Brussels Convention (which corresponds to Article 30(3) of the Brussels Ibis Regulation). According to the *Tatry* decision of the ECJ concerning Article 22(3) of the Brussels Convention (Article 30(3) of the Brussels Ibis Regulation), the term “connection” must be interpreted in a broad sense.<sup>687</sup>

As to patent infringement proceedings, several constellations may occur which could be subject to the application of Article 8(1).<sup>688</sup> Generally speaking, it can be distinguished between the infringement, by multiple infringers, of the same patent right (Constellations 1 to 3) and the infringement, by multiple infringers, of parallel patent rights (Constellations 4 to 6). In order to determine the scope of application of Article 8(1), these constellations shall be subject to a separate analysis. In its famous (and highly controversial) *Roche Nederland* decision, the ECJ had the opportunity to decide on the (alleged) infringement of parallel European patents.<sup>689</sup> The consequences of the *Roche Nederland* decision of the ECJ shall be

<sup>684</sup> ECJ 27 October 1998, C-51/97, *Réunion Européenne SA and Others v Spliethoff's Bevrachtungskantoor BV*, and the Master of the vessel *Alblasgracht V002*, [1998] ECR I-06511, para. 46 – *Réunion Européenne*.

<sup>685</sup> Auer 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 6 VO (EG) No. 44/2001, para. 17.

However, this constellation is to be differentiated from the constellation decided by the ECJ in *Réunion Européenne*, which concerned the question of whether actions could be consolidated before a *Member State* court. In this respect, I do not share Auer's opinion who refers exactly to the *Réunion Européenne* decision to argue that Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) cannot serve as the legal basis for suing a defendant domiciled in a Member State before the court of a third State.

<sup>686</sup> ECJ 27 September 1988, C-189/87, *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others*, [1988] ECR 05565, para. 12 – *Kalfelis*.

<sup>687</sup> ECJ 6 December 1994, C-406/92, *The owners of the cargo lately laden on board the ship 'Tatry' v The owners of the ship 'Maciej Rataj'*, [1994] ECR I-05439, para. 53 – *Tatry*.

<sup>688</sup> Laubinger 2005, pp. 63-71.

<sup>689</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535 – *Roche Nederland*.

subject to a separate closer analysis. In its subsequent *Solvay* decision,<sup>690</sup> the ECJ modified (respectively limited) its jurisprudence given in *Roche Nederland*. In contrast to *Roche Nederland*, the *Solvay* decision was based on the constellation of (alleged) infringement, committed by several companies from different Member States, of the same national parts of European patents being in force in yet another Member State.

As both the constellation of infringement of parallel patents, and the constellation of infringement of the same patent, have been subject to fierce discussion before the *Roche Nederland* decision (and the subsequent *Solvay* decision), they shall be discussed first in the following paragraphs. It will become obvious that in particular the *Roche Nederland* decision of the ECJ, rather than contributing to a definite clarification of Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) has actually even extended confusion how to interpret this provision in an adequate and reasonable way. In this respect, it is remarkable that the ECJ attenuated, in *Solvay*, its restrictive interpretation of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) chosen in its *Roche Nederland* decision which has seen a lot of criticism in the literature due to its restrictive interpretation of the provision, although it has been criticised, on the other hand, that the approach chosen by the ECJ in *Solvay* is so liberal that the principles of legal certainty and predictability have not been sufficiently taken into consideration.<sup>691</sup>

### **2.3.2.1 Multiple infringers infringing the same patent right**

#### **2.3.2.1.1 Constellation 1: Infringers acting independently from each other**

This constellation shall be illustrated by the following case.

##### Case 1:

E holds an English patent concerning a machine. This patent is infringed by a Dutch company (D), which sells a machine of identical manner in England (infringement 1). Independently from this infringement, E's patent is also subject to infringement by a German company (G) which also sells a machine of identical manner in England (infringement 2).

In this first constellation, it is obvious that, although the identical patent right is concerned, there is no inner link between the two infringements. Rights to be derived from infringement 1 are independent from rights originating from infringement 2.<sup>692</sup> As the infringers in this constellation act without influencing each other, and thus commit the infringements independently from one another, they are not liable for the infringements in a relationship of joint debtors.<sup>693</sup> As a consequence, the claims lack such a close connection that would be required for Article 8(1) to be applicable.

---

<sup>690</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

<sup>691</sup> Schacht (2012)114(11) GRUR 1110, at p. 1113.

<sup>692</sup> Tetzner (1976)78(12) GRUR 669, at p. 671; Hess 1987, p. 33; Otte 1998, p. 711; Laubinger 2005, p. 64; Pertegás Sender 2002, paras. 3.35-3.36.

<sup>693</sup> Bukow 2003, p. 200.

### 2.3.2.1.2 Constellation 2: Infringers acting jointly

The following case shall illustrate the scenario in question:

#### Case 2:

E holds an English patent concerning a machine. This patent is infringed by a Dutch company (D), which sells a machine of identical manner in England (infringement 1). As to this business activity (distribution), D is supported by a German company (G) (infringement 2).

In this constellation, D and G are liable for the patent infringements as joint debtors. In this respect it is to be mentioned that already the Jenard Report<sup>694</sup> referred to the constellation of joint debtors as an example for the applicability of Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) when stating:

“In order for this rule to be applicable there must be a connection between the claims made against each of the defendants, as for example in the case of joint debtors.”<sup>695</sup>

Correspondingly, most courts and legal doctrine have accepted that this constellation is covered by Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation).<sup>696</sup> The required connection between the actions against D and G is based on their joint acting, i.e. on the outcome of their joint plans and organisation of their business. Given this, the risk, respectively the danger of irreconcilable judgments is to be avoided.<sup>697</sup> Moreover, the defendants in the constellation in question do not have to be protected from being sued, via Article 8(1), before the courts of the State of domicile of another defendant, because the defendants voluntarily chose to collaborate as to the patent infringements. Consequently, they could take into consideration the possibility of being sued jointly.<sup>698</sup>

---

<sup>694</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>695</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015), p. 26; cf. also Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 8; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 6 EuGVVO, para. 20.

<sup>696</sup> Tetzner (1976)78(12) GRUR 669, at pp. 671-672; Cornish & Llewelyn 2003, para. 2–79: “At least where the English defendant is principally responsible, this must be a straightforward case for applying Art.6(1)”; Cornish & Llewelyn (2000)31(6) IIC 627, at p. 643, there fn. 49; Fawcett & Torremans 2011, paras. 5.142-5.143; Grabinski (2001)50(3) GRUR Int. 199, at pp. 207-208; Treichel 2001, p. 36; as to court decisions: LG Düsseldorf 16 January 1996, 4 O 5/95, LG Düsseldorf Entscheidungen 1996(1)1, at p. 3 – *Reinigungsmittel für Kunststoffverarbeitungsmaschinen*; High Court of Justice (Chancery Division) 7 March 1997, Gareth Pearce v Ove Arup Partnership Ltd and Others, [1997] F.S.R. 641, 647 – *Pearce I*; High Court of Justice (Chancery Division – Patents Court) 29 January 1999, Sepracor Inc. v Hoechst Marion Roussel Limited and Others, [1999] F.S.R. 746 – *Sepracor*; Gerechtshof ’s-Gravenhage 23 April 1998, Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others, [1999] F.S.R. 352 – *Expandable Grafts Partnership II*.

<sup>697</sup> Bukow 2003, p. 183.

<sup>698</sup> Bukow 2003, pp. 183-184.

### 2.3.2.1.3 Constellation 3: Chain of infringers

Another scenario consists in the constellation that multiple infringers infringe the same patent right, but, in contrast to the first constellation, the infringements are connected with each other in the way of subsequent steps of infringing acts (chain of infringers). Contrary to constellation 2 (infringers acting jointly), infringers do not collaborate on the basis of a joint plan in constellation 3. Each infringer commits a complete infringement on his own.<sup>699</sup>

The following case shall illustrate this constellation:

#### Case 3:

E holds an English patent concerning a machine. This patent is infringed by a Dutch company (D), which produces a machine that is identical with the machine being protected by E's patent, and delivers the machine to the French company F (infringement 1). F sells it to the Portuguese company P (infringement 2). P uses the machine in his factory (infringement 3).

As the Jenard Report explicitly considered joint debtors as an example for the applicability of Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation), the question of whether D, F and P are to be considered joint debtors shall be the initial point of further analysis. At least if this was the case, the application of Article 8(1) would appear justified.

Two aspects should be taken into consideration in this respect. First, E's rights against D, F and P are of the same nature (based on the patent right as intellectual property right), and they are linked with each other by way of an inner context. The multiple infringements are linked with each other in the way that a former infringement enables a later infringement to be realised, although each infringer commits a complete infringement *in persona*. A second aspect to be taken into consideration specifically concerns E's right to claim damages on all economic steps of infringements, i.e. against D, F and P. However, it is evident that E cannot have the right to claim damages, once having successfully sued one of the infringers, against the other ones *additionally*, because he would then get more than pure compensation. In that light, it appears most convincing to treat D, F and P as joint debtors.<sup>700</sup> Each defendant's interest in being sued before the courts of his State of domicile is predominated by E's interest to sue all defendants before one court via Article 8(1), because the infringers, acting in a chain of multiple infringers, must anticipate that they might be sued jointly in a situation of joint debtors.

In the discussed sample case, E can therefore sue D, F and P for patent infringement. As the multiple infringements are linked with each other in the way that a former infringement enables a later infringement to be realised, the connection is close enough that Article 8(1) is applicable. Hence, D, F and P can be sued together in the Netherlands, in France and in Portugal, because these States are the States of domicile of one of the concerned defendants.

---

<sup>699</sup> Lange (2007)109(2) GRUR 107, at p. 114; Schauwecker 2009, p. 83.

<sup>700</sup> Rogge & Grabinski 2006 (Benkard – Patentgesetz), § 139 PatG, para. 20; Keukenschrijver 2013 (Busse – Patentgesetz), § 139 PatG, para. 118.

However, the question may be asked if the foregoing analysis is also valid for *actions for injunction* (“*Unterlassungsklagen*”). Usually, a debtor is only responsible for his own injunction. Thus there is no situation of joint debtors if multiple infringers are sued for injunction. For this reason, Article 8(1) should be considered not applicable in this situation.<sup>701</sup> In contrast, Article 8(1) should be fully applicable in case that actions for damages and for injunction are combined with each other, because both actions are *factually* connected. Moreover, *pieces of evidence* could then be used in both cases immediately, proving the *procedural* connection between the actions. Consequently, it also corresponds to the interests of the defendants to be sued before the same court with regard to both actions, because this procedure saves energy, time and money.

Admittedly, the ECJ stated in its *Kalfelis* decision that

“(…) it must be observed, as already indicated above, that the “special jurisdictions” enumerated in Articles 5 and 6 of the [Brussels] Convention constitute derogations from the principle that jurisdiction is vested in the courts of the State where the defendant is domiciled and as such must be interpreted restrictively [content in brackets added].”<sup>702</sup>

However, in the situation in question, a derogation from the general principle of Article 4(1) (rule of *forum defensoris/actor sequitur forum rei* principle) appears justified because the concerned defendant himself benefits from this solution.<sup>703</sup> In addition, it must be taken into account that contradictory decisions can be avoided by bringing both actions for damages and for injunction before the same court, this method being considerably easier than leaving to the courts to coordinate their decisions if courts of different Member States are involved, in accordance with Article 30(1), which rules:

“Where related actions are pending in the courts of different Member States, any court other than the court first seised may stay its proceedings.”

Finally, with regard to the question of whether there is a constellation of joint debtors, it is to be underlined that in the case of several chains of infringers, acting independently from each other, each chain of infringers must be treated separately. Hence, the question of whether Article 8(1) is applicable has to be decided for each chain of infringers, different outcomes being possible.<sup>704</sup>

### 2.3.2.2 Multiple infringers infringing parallel patent rights

In light of the *Roche Nederland* decision of the ECJ in 2006, concerning the infringement of several parts of a European patent by multiple infringers, I shall now proceed to the analysis in which constellations Article 8(1) is applicable in cases of parallel patent infringements.

For an adequate embedding of the *Roche Nederland* decision into the existing context, the legal situation, i.e. in particular previous court decisions as to this complex, shall be taken into consideration.

---

<sup>701</sup> Bukow 2003, pp. 197-198.

<sup>702</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 19 – *Kalfelis*.

<sup>703</sup> Bukow 2003, pp. 197-198.

<sup>704</sup> Neuhaus (1996)87(9) Mitt. 257, at p. 266.

#### **2.3.2.2.1 Constellation 4: Infringers acting independently from each other by different acts and different modes of use**

It has never been severely doubted that there is no close connection in the sense of Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) where multiple infringers commit infringements as to parallel patents which might be *de facto* identical, but are undertaken by different modes of use.<sup>705</sup> This constellation shall be illustrated by Case 4.

##### Case 4:

E holds an English patent for a machine. This patent is infringed by an English producer (EP) (infringement 1). E also holds a Dutch patent for a machine which corresponds to the English patent (a parallel national patent or a European patent with the same content). This patent is infringed by a Dutch dealer (D) (infringement 2).

#### **2.3.2.2.2 Constellation 5: Infringers acting independently from each other by different acts, while the same product is concerned**

In order to clarify this constellation, the following case shall serve as an example:

##### Case 5:

E holds an English patent for a machine. This patent is infringed by an English producer (EP) (infringement 1). E also holds a Dutch patent for a machine which corresponds to the English patent (a parallel national patent or a European patent with the same content). This patent is infringed by a Dutch dealer (D) who sells the products of EP (infringement 2).

On the one hand, it could be argued that there is such a close connection between E's claims against EP and D that Article 8(1) is applicable, because the same product is concerned, and the use of this product infringes the different patents. This would affect uniform facts.<sup>706</sup> As a consequence, the English court, respectively the Dutch court could decide on both infringements.

However, it is to be emphasised that the claims against the infringers stem from different rights, namely from parallel national patent rights or from different parts of a European patent which consists in a bundle of national patents.<sup>707</sup> Once a European patent has been granted, its national parts exist independently from each other, meaning that the different national parts of a European patent can be subject to different developments and may have different fates.<sup>708</sup> As a consequence, claims in this situation lack such a close connection as required by Article 8(1), because the defendants have – both concerning parallel national patents and national

---

<sup>705</sup> Stauder (1976)25(11) GRUR Int. 465, at p. 476; Tetzner (1976)78(12) GRUR 669, at p. 671; Treichel 2001, p. 36.

<sup>706</sup> Neuhaus (1996)87(9) Mitt. 257, at p. 266.

<sup>707</sup> Tetzner (1976)78(12) GRUR 669, at p. 671; Grabinski (2001)50(3) GRUR Int. 199, at p. 207.

<sup>708</sup> This aspect is ruled in Article 138 of the European Patent Convention.



parts of a European bundle patent – infringed *different* patents which are not interrelated. Article 2(2) of the European Patent Convention states:

“The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless this Convention provides otherwise.”

As the European patent shall have the effect of and be subject to the same conditions as a national patent, it can be derived that a European patent, once having been granted, must not necessarily have the same legal fate with regard to all States for which the patent has been granted. Accordingly, Article 64(1) of the European Patent Convention states:

“A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date on which the mention of its grant is published in the European Patent Bulletin, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.”

Thus synchronising the effects of European patents and pure national patents, it is logical that the question of which law is applicable is solved in a parallel way in Article 64(3) of the European Patent Convention:

“Any infringement of a European patent shall be dealt with by national law.”

In the absence of further connecting circumstances, claims due to infringements of different parts of a European patent concerning the same object of infringement therefore lack such a close connection as required by Article 8(1).<sup>709</sup>

#### **2.3.2.2.3 Constellation 6: Infringers acting by identical modes of use, while different patents are concerned**

This constellation may be illustrated by the following case:

##### Case 6:

A holds a European patent being valid for the territory of England, France and the Netherlands. E, having his domicile in England, manufactures products which infringe A’s patent, and delivers these products to F, N and S, having their domiciles in France, in the Netherlands and in Spain. F, N and S sell the products to customers in their States of domicile.

Could A sue E, F, N and S in the Netherlands as N’s State of domicile?

At first glance, it becomes obvious that this constellation, too, is characterised by the phenomenon of chains of infringers. However, in contrast to the first constellation, there are *several* chains of infringers, namely: E – F – F’s customers; E – N – N’s customers; E – S – S’s customers.

---

<sup>709</sup> Laubinger 2005, p. 66.

Consequently, the question arises whether the infringements committed by F, N and S are connected in such a close way that Article 8(1) should be applicable. In 1997, the English *High Court of Justice (Chancery Division)* decided that the infringers (*in casu* several companies belonging to the same group) of a European patent granted for several Contracting States, by the identical mode of use, could be sued jointly via Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation).<sup>710</sup> The court considered it sufficient that the claims in question were based on *parallel* patent rights and on the *identical mode of use*, without another link between the parties being necessary for jurisdiction according to Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation).<sup>711</sup>

However, in a later decision, the English *High Court of Justice (Chancery Division)* denied the applicability of Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) in the constellation in question, referring to the legal independence of national patents, emphasising the lack of contrary decisions when different courts have to decide.<sup>712</sup> This decision was confirmed by the English *Court of Appeal*.<sup>713</sup> The court stressed that the European patent consists in a bundle of national patents and that the scope of each national part is limited to the territory of the State of registration. Due to the possibility of subsequent limitation of the scope of these parts – independently from each other – there would be no risk of irreconcilable judgments resulting from separate proceedings, because a judgment on the infringement in one protection State would be based on the applicable national law, having effect only in that State.<sup>714</sup>

Dutch courts originally tended to adopt a rather liberal attitude towards the applicability of Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation).<sup>715</sup> However, the *Gerechtshof s'-Gravenhage* underlined the nature of a European patent as a bundle of several national patents, and also emphasised the legal independence of such patents as soon as having been granted. Moreover, the court pointed out that Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) is to be considered as an exception from the basic rule of Article 2(1) of the Brussels Convention (Article 4(1) of the Brussels Ibis Regulation). In the decided case, the defendants' interest in being sued separately before courts in their respective States of domicile was evaluated higher than the plaintiff's interest in connecting the proceedings.<sup>716</sup>

Accordingly, legal doctrine has mostly agreed with the latter opinion, emphasising the legal autonomy of patent rights which also goes for European patents<sup>717</sup>, and has therefore concluded that the infringements of parallel patent rights by an identical mode of use, while the objects of infringement are different, do not create a connection which is close enough to

<sup>710</sup> High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suizo International (U.K.) Limited and Others*, [1997] F.S.R. 660, 672 – *Coin Controls*.

<sup>711</sup> Affirmatively: *Franzosi & Tilman* (2005)96(2) Mitt. 55, at p. 57 concerning the infringement of a European patent.

<sup>712</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 236 – *Fort Dodge*.

<sup>713</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 237 et seq. – *Fort Dodge*.

<sup>714</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 243 – *Fort Dodge*.

<sup>715</sup> Hye-Knudsen 2005, p. 123 with further references; cf. concerning Dutch case-law also *Brinkhof* (1997)46(6) GRUR Int. 489, at p. 492.

<sup>716</sup> *Gerechtshof s'-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352 – *Expandable Grafts Partnership II*.

<sup>717</sup> *Grabinski* (1998)100(11) GRUR 857, at p. 865.

justify joint jurisdiction via Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation).<sup>718</sup>

In its *Kalfelis* decision, the ECJ stated:

“(…) The principle laid down in the [Brussels] Convention is that jurisdiction is vested in the courts of the State of the defendant's domicile and that the jurisdiction provided for in Article 6(1) is an exception to that principle. It follows that an exception of that kind must be treated in such a manner that there is no possibility of the very existence of that principle being called in question [underscore and content in brackets added].”<sup>719</sup>

On the basis of this decision of the ECJ, it is to be underlined that the principle according to which persons domiciled in a Member State, whatever be their nationality, shall be sued in the courts of that Member State, may be abandoned only in exceptional cases. Besides this aspect – the protection of the defendant – a generous application of Article 8(1) would promote extensive forum shopping. Additionally, one should bear in mind that the ECJ has constantly emphasised that the principle of legal certainty is to be ensured. To give an example, the ECJ held (again) in *Marcello Costa and Ugo Cifone*:

“The principle of legal certainty requires, moreover, that rules of law be clear, precise and predictable as regards their effects, in particular where they may have unfavourable consequences for individuals and undertakings (...).”<sup>720</sup>

In so far, one should take into consideration that legal certainty also includes the predictability of jurisdiction, which can be guaranteed to a higher extent when exceptions from legal principles, as the principle founded in Article 4(1), are interpreted in a cautious, restrictive way, which can be achieved by the *spider-in-the-web* rule which shall be discussed in the following paragraphs.

As a consequence, for Article 8(1) to be applicable, further connecting factors must exist.

The *Gerechtshof s’Gravenhage* decided in *Expandable Grafts v. Boston Scientific*<sup>721</sup> that Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) is only applicable in the case that all defendant companies belong to the same group and have jointly committed the patent infringement, whereas, for the ground of legal certainty, only the courts of that State would have jurisdiction where the principal office which steers the companies’ activities has its seat (*spider-in-the-web* theory). The court in particular referred to the assumption of a common plan in this constellation. Although this construction, which has been treated controversially both by legal commentators and courts, was finally rejected by the ECJ in its *Roche Nederland* decision in 2006, it shall shortly be illustrated in order to fully comprehend the *Roche Nederland* decision of the ECJ, its impact and its importance. An

---

<sup>718</sup> Brinkhof (1997)46(6) GRUR Int. 489, at p. 497; Grabinski (2001)50(3) GRUR Int. 199, at p. 207; Ebner 2004, p. 203.

<sup>719</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 8 – *Kalfelis*.

<sup>720</sup> ECJ 16 February 2012, Joined Cases C-72/10 and C-77/10, criminal proceedings against Marcello Costa (C-72/10) and Ugo Cifone (C-77/10), para. 74, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0072&rid=1>> – *Marcello Costa and Ugo Cifone*.

<sup>721</sup> Gerechtshof s’-Gravenhage 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352 – *Expandable Grafts Partnership II*.

analysis of the *spider-in-the-web* theory shall also deliver instructive insights how the Brussels Ibis Regulation could (should) be amended in the future.<sup>722</sup>

In particular, Dutch courts have been confronted with cases where the principal company was not situated in an EU Member State. Thus the question arose whether the *spider-in-the-web* theory would be also applicable to these cases.

The *Rechtbank s'Gravenhage* denied this question in *Baxter International Inc. v. Pharmacia & Upjohn AB et al.*, where the principal seat was situated in the United States of America.<sup>723</sup> Interestingly, the *Rechtbank s'Gravenhage* decided contrarily in *Augustine Medical Inc. v. Mallinckrodt Medical BV and Others*.<sup>724</sup> The court decided in the same way in *Genetics Institute Inc. et al. v. Baxter International Inc.*,<sup>725</sup> where it stated explicitly that the *spider-in-the-web* criterion does not apply where the principal seat would be situated in a non-Member State because of the plaintiff's need for justice which would require a European judge. In *G.D. Searle & Co. and the Monsanto Company v. Merck Sharp & Dome B.V. et al.*, the *Rechtbank s'Gravenhage* held that, due to the fact that the plaintiff was not able to recognise the steering structure of the group of defendant companies, the latter could also be sued before the courts of every State where one of the defendant companies had its seat.<sup>726</sup> It is noticeable that after a certain initial reluctance of Dutch courts as to the applicability of the *spider-in-the-web* rule, they have rather continuously followed it.<sup>727</sup>

It has been put forth in literature that the *spider-in-the-web* construction, despite its – at least in the European point of view – negative consequence for proceedings when the principal defendant is domiciled in a non-Member State, must be accepted, due to the territorial limitation of the Brussels Convention/Brussels I Regulation (Brussels Ibis Regulation) and due to the lack of alternatives (if the plaintiff shall not be granted an unlimited right to choose the place of jurisdiction). But this would mean that only the identity of the intellectual property right and the object of infringement would be decisive for Article 8(1) to be applicable, which would not be justified for the reasons described above.<sup>728</sup>

However, this point of view has also been contested. First of all, it has been criticised that there is no legal foundation – neither in Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) nor in another provision of the Regulation – for the restricting *spider-in-the-web* construction.<sup>729</sup> Moreover, it has been put

---

<sup>722</sup> Although a considerable number of problems have remained unsolved under the Brussels Ibis Regulation which has replaced the Brussels I Regulation, it is to be hoped that a future reform of the Brussels Ibis Regulation will effect relevant amendments. In this context, it is to be mentioned that, according to Article 79 of the Brussels Ibis Regulation, by 11 January 2022 the Commission shall present a report to the European Parliament, to the Council and to the European Economic and Social Committee on the application of this Regulation. Where appropriate, the report shall be accompanied by a proposal for amendment of the Brussels Ibis Regulation.

<sup>723</sup> Rb. 's-Gravenhage 20 May 1998, *Baxter International Inc. v. Pharmacia & Upjohn AB and Others*, IER 1998, 31.

<sup>724</sup> Rb. 's-Gravenhage 15 July 1998, *Augustine Medical Inc. v. Mallinckrodt Medical BV and Others*, IER 1998, 40.

<sup>725</sup> Cited according to Zigann 2002, pp. 127-128, there fn. 525; cf. also Tilmann & von Falck (2000)102(7) GRUR 579, at p. 582, there fn. 17.

<sup>726</sup> Cited according to Zigann 2002, p. 128, there fn. 526.

<sup>727</sup> Cf. Rb. 's-Gravenhage 29 September 1999, *DSM NV and Another v. Orffa Nederland Feed BV and Others*, IER 2000, 8; Rb. 's-Gravenhage 16 February 2000, *SciMed Life Systems Inc (USA) v. Arterial Vascular Engineering BV and Others*, BIE 2004, 9 – *Ballon katheter I*; cf. also Zigann 2002, pp. 128-129.

<sup>728</sup> With regard to the Brussels Convention: Laubinger 2005, p. 70.

<sup>729</sup> Treichel 2001, p. 32; Ebner 2004, p. 205.

forth that neither the schematic structure of this rule nor its history provide a sufficient basis for it.<sup>730</sup> Additionally, it might be argued that the restriction of Article 8(1) by the *spider-in-the-web* theory constitutes a rule which is definitely *not* in favour of European companies, because multinational groups of companies often have their principal seats in the United States of America. On the other hand, it has also been underlined that a plaintiff may often simply be incapable to find out which of several joint companies steers all other companies' activities in respect of the common plan of patent infringement.<sup>731</sup> For it is not certain that it is always the principal company which has organised the infringement.

### 2.3.3 The *Roche Nederland* case of the ECJ

#### 2.3.3.1 The *Roche Nederland* decision of the ECJ

After years of differing judgments in Europe and numerous comments in legal doctrine, the ECJ finally decided in *Roche Nederland* against the possibility to join claims against affiliated companies for coordinated infringement of European bundle patents before the courts in the State where the principal office which steers the companies' activities has its seat.<sup>732</sup>

The underlying facts in this case were as follows: Two American citizens, Frederick Primus and Milton Goldenberg, owned the European patent No 131 627, concerning specific CEA-family antigens and antibodies, and their methods of use, being valid in ten EPC Contracting States. Primus and Goldenberg claimed that the patent was infringed by Roche Nederland BV and members of the Roche Group, having their seats in eight different countries (the United States of America, the United Kingdom, Germany, Belgium, France, Austria, Switzerland and Sweden). The defendants were jointly sued before the *Rechtbank 's-Gravenhage*. They contested jurisdiction of that court, denied infringement and contested the validity of the patent. Both the *Rechtbank 's-Gravenhage* in first instance and the *Gerechtshof 's-Gravenhage* in second instance attested that Dutch courts would have jurisdiction as to all defendants and all patent infringements undertaken in their countries of domicile. However, they arrived at different conclusions as to the question of whether the reproach of infringement was justified which was affirmed by the *Gerechtshof 's-Gravenhage*. Finally, the case was brought before the Dutch *Hoge Raad*. This court decided to stay the proceedings and referred two questions to the ECJ in order to clarify the conditions under which claims concerning infringements of European patents may be joined before one court.

The following questions were referred for a preliminary ruling:

“(1) Is there a connection, as required for the application of Article 6(1) of the Brussels Convention, between a patent infringement action brought by a holder of a European patent against a defendant having its registered office in the State of the court in which the proceedings are brought, on the one hand, and against various defendants having their registered offices in Contracting States other than that of the State of the court in which the proceedings are brought, on the other hand, who, according to the patent holder, are infringing that patent in one or more other Contracting States?

(2) If the answer to Question 1 is not or not unreservedly in the affirmative, in what circumstances is such a connection deemed to exist, and is it relevant in this context whether, for example,

<sup>730</sup> Hye-Knudsen 2005, p. 128.

<sup>731</sup> Bornkamm 2000, p. 136.

<sup>732</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535 – *Roche Nederland*, cf. also Gonzalez Beilfuss 2008, pp. 83-84.

- the defendants form part of one and the same group of companies?
- the defendants are acting together on the basis of a common policy, and if so is the place from which that policy originates relevant?
- the alleged infringing acts of the various defendants are the same or virtually the same?”<sup>733</sup>

In his Opinion from 8 December 2005, *Advocate General Léger* carefully explained that the decisive criterion in Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation), the intent to avoid “irreconcilable judgments”, requires a stricter interpretation than with regard to the same term in the context of Article 22(3) of the Brussels Convention (Article 30(3) of the Brussels Ibis Regulation).<sup>734</sup> Therefore, the Advocate General drew the conclusion that a risk for irreconcilable judgments does not exist in the constellation in question, because European patents, once having been granted, exist independently from each other. As to the objection that the scope of bundle patents is to be determined by the protocol governing the interpretation of Article 69 of the European Patent Convention, the Advocate General stressed that the protocol merely regulates how the content of the patent should be defined, distinguishing this issue from the legal scope of patent protection. The Advocate General finally pointed out that a legal situation where claims could be connected according to the *spider-in-the-web* rule, would lead to a severe jeopardy of legal certainty which represents a high goal of the Brussels Convention (respectively its successors).<sup>735</sup> In its judgment, the ECJ followed the Advocate General’s Opinion that

“(…) in order that decisions may be regarded as contradictory it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of *the same situation of law and fact*.”<sup>736</sup>

As to the aspect of the same factual situation, the court then argued that

“(…) the existence of the same situation of fact cannot be inferred (in the case of European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of these States), since the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same.”<sup>737</sup>

With regard to the requirement of the same legal situation, the court continued by referring to Articles 2(2), 64(1) and 64(3) of the European Patent Convention:

“Furthermore, although the Munich Convention lays down common rules on the grant of European patents, it is clear from Articles 2(2) and 64(1) of that convention that such a patent continues to be governed by the national law of each of the Contracting States for which it has been granted.

In particular, it is apparent from Article 64(3) of the Munich Convention that any action for infringement of a European patent must be examined in the light of the relevant national law in force in each of the States for which it has been granted.

<sup>733</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 17 – *Roche Nederland*.

<sup>734</sup> Advocate General 8 December 2005, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 79-90 – *Roche Nederland*.

<sup>735</sup> Among numerous decisions of the ECJ as to this attitude: ECJ 16 February 2012, Joined Cases C-72/10 and C-77/10, criminal proceedings against Marcello Costa (C-72/10) and Ugo Cifone (C-77/10), available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0072&rid=1>> – *Marcello Costa and Ugo Cifone*.

<sup>736</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 26 – *Roche Nederland*.

<sup>737</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 27 – *Roche Nederland*.

It follows that, where infringement proceedings are brought before a number of courts in different Contracting States in respect of a European patent granted in each of those States, against defendants domiciled in those States in respect of acts allegedly committed in their territory, any divergences between the decisions given by the courts concerned would not arise in the context of the same legal situation.”<sup>738</sup>

Unlike the Advocate General’s reasoning, the ECJ even explicitly declared that

“(…) even if the broadest interpretation of “irreconcilable” judgments, in the sense of contradictory, were accepted as the criterion for the existence of the connection required for the application of Article 6(1) [of the Brussels Convention], it is clear that such a connection could not be established between actions for infringement of the same European patent where each action was brought against a company established in a different Contracting State in respect of acts which it had committed in that State [content in brackets added].”<sup>739</sup>

According to the ECJ, this result is considered to be the same even in a constellation where defendant companies belonging to the same group have acted in an identical or similar manner in accordance with a common policy elaborated by one of those companies (*spider-in-the-web* constellation). Although in this constellation the factual situation would be the same, the legal situation would differ. Consequently, there would be no risk of contradictory decisions.<sup>740</sup> Besides, the ECJ stressed that consolidating such actions before one court would ultimately create a source of risks, because it would effect a multiplication of potential heads of jurisdiction with the consequence that the principle of legal certainty, which is of fundamental importance under the Brussels Ibis Regulation (respectively its predecessors)<sup>741</sup> would be undermined, the damage being even more serious if the defendant had a wide choice, which would encourage the practice of forum shopping which the Brussels Ibis Regulation (and its predecessors) seek(s) to avoid and which the ECJ, in its *Kalfelis* decision<sup>742</sup>, specifically sought to prevent.<sup>743</sup> Moreover, in *Roche Nederland*, the ECJ expressed its reluctance towards a broad application of Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) insofar as the ECJ underlined that the court seised would have to adjudicate on the substance of the case before it could establish its jurisdiction, such a preliminary examination eventually producing additional costs and prolonging procedural time-limits, while it might happen that jurisdiction finally has to be declined.<sup>744</sup> The ECJ pointed out that even on the basis of a broader interpretation of Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation), the consolidation of the patent infringement actions before one court could not prevent at least a partial fragmentation of the patent proceedings, if the issue of validity is brought up in the

---

<sup>738</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 29-31 – *Roche Nederland*.

<sup>739</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 33 – *Roche Nederland*.

<sup>740</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 34-35 – *Roche Nederland*.

<sup>741</sup> ECJ 19 February 2002, C-256/00, *Besix SA v Wasserreinigungsbaufirma Alfred Kretzschmar GmbH & Co. KG (WABAG), Planungs- und Forschungsgesellschaft Dipl. Ing. W. Kretzschmar GmbH & Co. KG (Plafog)*, [2002] ECR I-01699, paras. 24-26 – *Besix*; ECJ 1 March 2005, C-281/02, *Andrew Owusu v N.B. Jackson and Others*, [2005] ECR I-01383, para. 41 – *Owusu*; ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 28 – *GAT*.

<sup>742</sup> ECJ 27 September 1988, C-189/87, *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others*, [1988] ECR 05565, para. 9 – *Kalfelis*.

<sup>743</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 36-38 – *Roche Nederland*.

<sup>744</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 39 – *Roche Nederland*.

proceedings regarding the foreign patent with the consequence that all other courts than the courts of the State of registration lack jurisdiction.<sup>745</sup>

### 2.3.3.2 Consequences of the *Roche Nederland* decision of the ECJ and the (attenuating) effect/impact of the *Solvay* decision of the ECJ

Against the background of the fierce dispute before courts and in legal doctrine with regard to the scope of application of Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation), the question arises which conclusions can and must be drawn from the decision of the ECJ in the *Roche Nederland* case. After the *Roche Nederland* decision, it was feared that consolidation of proceedings in multiple defendant situations had become totally impossible with regard to cross-border infringement actions concerning national patents and European patents,<sup>746</sup> even if companies belong to the same group and have acted in an identical or similar manner in accordance with a common policy determined by one of those companies.<sup>747</sup> Following the argumentation of the ECJ in its *Roche Nederland* decision, by reference to the requirement of the same factual and legal situation, it was considered that this not only concerned the national parts of a European patent, but also concerned pure national patents, because for the latter the existence of the same legal situation is even less probable, because they have not been harmonised comparably to European patents by the European Patent Convention.<sup>748</sup>

Remarkably, the ECJ however attenuated its restrictive jurisprudence developed in *Roche Nederland* in its subsequent *Solvay* decision which underlines that constellations are still conceivable in which consolidation according to Article 8(1) is possible. In *Solvay*, the *Rechtbank 's-Gravenhage* referred *inter alia* the following question regarding Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) to the ECJ for a preliminary ruling:

“(1) In a situation where two or more companies from different States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, does the possibility arise of 'irreconcilable judgments' resulting from separate proceedings as referred to in Article 6(1) of Regulation No 44/2001 [underscores added]?”<sup>749</sup>

By reference to its *Roche Nederland* decision and confirming and further developing the criteria for consolidation set up in that decision (risk of irreconcilable judgments due to the

<sup>745</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 40 – *Roche Nederland*; cf. ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 31 – *GAT*.

<sup>746</sup> Norrgård 2009, p. 223.

<sup>747</sup> Schauwecker 2009, p. 90; *Schlosser* even put forth that the decision of the ECJ in *Roche Nederland* has the consequence that a consolidation against several co-defendants in such cases has generally become impossible which severely impairs patent protection where large-scale strategies of patent infringement are affected, due to a multiplication of costs and procedural risks when different national courts must be invoked for the respective national part of a European patent, cf. P. Schlosser (case note) ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, (2007)62(6) JZ 305, at p. 306. Cf. also Knaak (2007)56(5) GRUR Int. 386, at p. 391.

<sup>748</sup> Gonzalez Beilfuss 2008, p. 88; cf. also Schauwecker 2009, p. 90.

<sup>749</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.



existence of the same situation of fact and the same situation of law),<sup>750</sup> the ECJ held in its *Solvay* decision that

“(…) Article 6(1) of Regulation No 44/2001 must be interpreted as meaning that a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to ‘irreconcilable judgments’ resulting from separate proceedings as referred to in that provision. It is for the referring court to assess whether such a risk exists, taking into account all the relevant information in the file [underscores added].”<sup>751</sup>

In contrast to the constellation in *Roche Nederland*, where the defendants were sued for allegedly infringing the respective national part of a European patent *being granted for the territory of their State of domicile*, it is noteworthy that in the *Solvay* case, the defendants did not deliver the same product in the State where their seat was located, *but in common third States*.<sup>752</sup> The case thus concerned the alleged infringement of several *foreign* parts of a European patent. As the products delivered in the third States were identical, the allegedly infringing actings were identical as well. If both actions would be dealt with separately at the respective place of domicile of the defendants, two courts would have to decide on the same foreign facts on the basis of the same foreign legal system.<sup>753</sup>

Despite certain deficiencies and uncertainties with regard to the reasoning of the ECJ in its *Solvay* decision,<sup>754</sup> it can be assumed that regarding the infringement of European patents through the same product in the same States by several companies having their seat in different States, there is the same situation of fact and of law, which may lead to irreconcilable judgments if several courts render a decision. As a consequence, Article 8(1) of the Brussels Ibis Regulation principally applies in this constellation.<sup>755</sup> Problematically, the reasoning of the ECJ why it considered that there was the same situation of fact and of law in the concrete constellation raises new questions. So, the ECJ held:

“It follows from the specific features of a case such as that in the main proceedings that potential divergences in the outcome of the proceedings are likely to arise in the same situation of fact and law, so that it is possible that they will culminate in irreconcilable judgments resulting from separate proceedings.”<sup>756</sup>

Unfortunately, the ECJ did not clarify what such “specific features of a case” may be. The court merely explicated that,

---

<sup>750</sup> Schacht (2012)114(11) GRUR 1110, at p. 1110.

<sup>751</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 30, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

<sup>752</sup> Schacht (2012)114(11) GRUR 1110, at p. 1111.

<sup>753</sup> Schacht (2012)114(11) GRUR 1110, at p. 1111.

<sup>754</sup> Cf. the following explications.

<sup>755</sup> Schacht (2012)114(11) GRUR 1110, at p. 1111.

<sup>756</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 27, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

“(…) were Article 6(1) of Regulation No 44/2001 not applicable, two courts would each have to examine the alleged infringements in the light of the different national legislation governing the various national parts of the European patent alleged to have been infringed (…).”<sup>757</sup>

In this respect, it is however to be underlined that only the courts of the Member State where the defendant is domiciled have jurisdiction to assess the alleged infringement of foreign parts of a European patent, according to Article 4 of the Brussels Ibis Regulation.<sup>758</sup> With regard to the assessment of whether there is a sufficient close connection to justify a consolidation of proceedings according to Article 8(1) of the Brussels Ibis Regulation, the ECJ stated that

“(…) it is for the national court to take into account, inter alia, the dual fact that, first, the defendants in the main proceeding are each separately accused of committing the same infringements with respect to the same products and, secondly, such infringements were committed in the same Member States, so that they adversely affect national parts of the European patent at issue.”<sup>759</sup>

In this respect, it has rightly been criticised that it is not clear whether the mentioned “dual fact” refers to the same situation of fact, to the same situation of law or eventually to both aspects.<sup>760</sup>

According to the *Solvay* decision of the ECJ, the mere fact that two companies incidentally deliver identical products to a foreign market and thereby commit patent infringements, would suffice to consolidate proceedings according to Article 8(1) of the Brussels Ibis Regulation, because there would be the same situation of fact and of law. Curiously, proceedings against several subsidiary companies which each distribute infringing products merely in the State where they have their respective seats, could not be consolidated pursuant to Article 8(1) of the Brussels Ibis Regulation, while proceedings against companies acting fully independently of each other which deliver identical products to the same foreign State could be consolidated before the courts of the States of their respective seats on the basis of Article 8(1) of the Brussels Ibis Regulation.<sup>761</sup> Such a broad application of Article 8(1) of the Brussels Ibis Regulation seems unjustified in light of the principle of legal certainty and the principle of predictability of the rules of jurisdiction being inherent to the Brussels Ibis Regulation and also contained in Recital 15 of the Brussels Ibis Regulation<sup>762</sup> in cases where patent infringements committed by several defendants through identical products appear without mutual knowledge of the defendants.<sup>763</sup> Although Recital 16 of the Brussels Ibis Regulation<sup>764</sup>

---

<sup>757</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 28, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

<sup>758</sup> Schacht (2012)114(11) GRUR 1110, at p. 1112; Kühnen 2012, para. 763.

<sup>759</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 29, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

<sup>760</sup> Schacht (2012)114(11) GRUR 1110, at p. 1112.

<sup>761</sup> Schacht (2012)114(11) GRUR 1110, at pp. 1112-1113.

<sup>762</sup> Recital 15 of the Brussels Ibis Regulation provides: “The rules of jurisdiction should be highly predictable and founded on the principle that jurisdiction is generally based on the defendant’s domicile. Jurisdiction should always be available on this ground save in a few well-defined situations in which the subject-matter of the dispute or the autonomy of the parties warrants a different connecting factor. The domicile of a legal person must be defined autonomously so as to make the common rules more transparent and avoid conflicts of jurisdiction.”

<sup>763</sup> Schacht (2012)114(11) GRUR 1110, at p. 1112.

<sup>764</sup> Recital 16 of the Brussels Ibis Regulation provides: “In addition to the defendant’s domicile, there should be alternative grounds of jurisdiction based on a close connection between the court and the action or in order to facilitate the sound administration of justice. The existence of a close connection should ensure legal certainty and avoid the possibility of the defendant being sued in a court of a Member State which he could not reasonably have foreseen. This is important, particularly in disputes concerning non-contractual obligations arising out of violations of privacy and rights relating to personality, including defamation.”

states that alternative grounds of jurisdiction besides jurisdiction at the defendant's domicile should be provided for by the Brussels Ibis Regulation, and Recital 21 of the Brussels Ibis Regulation<sup>765</sup> demands to minimise the possibility of concurrent proceedings and to ensure that irreconcilable judgments will not be given in different Member States, which might serve as an argument for a broad interpretation of Article 8(1) of the Brussels Ibis Regulation, it is to be emphasised that these aspects cannot set aside the fundamental requirement of predictability of rules of jurisdiction.<sup>766</sup> Therefore, it has been put forth in legal doctrine that consolidating actions on the basis of Article 8(1) of the Brussels Ibis Regulation should require a subjective element, which may consist in the fact that the defendants had mutual knowledge of their actings,<sup>767</sup> or acted as co-perpetrators (“*Mittäter*”).<sup>768</sup>

Beyond the constellation considered by the ECJ in *Solvay*, some further constellations are and remain conceivable where consolidation of actions against several infringers with regard to cross-border patent infringements can be based on Article 8(1) of the Brussels Ibis Regulation. These constellations shall be treated in the following paragraphs.

### 2.3.3.2.1 Joint acting

This constellation can be illustrated by the following sample case:

E holds a European patent for a specific machine, granted for the United Kingdom, the Netherlands and Germany. The infringers G, domiciled in Germany, and B, having his domicile in Belgium, jointly produce a machine that corresponds to the machine for which E holds his patent.

Can E sue both G and B in Germany or in Belgium?

When the ECJ tried to restrict the scope of application of Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) in *Roche Nederland*, its decision was based on the constellation that *parallel* patent rights were infringed by multiple infringers. However, the criteria considering the applicability of Article 8(1) developed by the ECJ in this context (the same situation of law and fact) do not affect the constellation where multiple persons jointly infringe the *same* patent right. It is evident that where the same patent is concerned through the infringement committed by the same persons who collaborate with each other, i.e. where there is a singular identical factual act, both the factual and the legal situation are identical. As a consequence, Article 8(1) is applicable in this case.

---

<sup>765</sup> Recital 21 of the Brussels Ibis Regulation provides: “In the interests of the harmonious administration of justice it is necessary to minimise the possibility of concurrent proceedings and to ensure that irreconcilable judgments will not be given in different Member States. There should be a clear and effective mechanism for resolving cases of *lis pendens* and related actions, and for obviating problems flowing from national differences as to the determination of the time when a case is regarded as pending. For the purposes of this Regulation, that time should be defined autonomously.”

<sup>766</sup> Similar: Schacht (2012)114(11) GRUR 1110, at p. 1113.

<sup>767</sup> Schacht (2012)114(11) GRUR 1110, at p. 1113.

<sup>768</sup> Kühnen 2012, para. 775.

### 2.3.3.2.2 Chain of infringers

Likewise, the constellation of multiple infringers infringing the same patent right subsequently (chain of infringers) is not affected by the *Roche Nederland* decision of the ECJ, because this decision explicitly referred to *parallel* patents, i.e. patents *not being identical*.

### 2.3.3.2.3 Chain of infringers in the case of a European patent with unitary effect

Furthermore, Article 8(1) could be applicable in the case of the infringement of a (future) European patent with unitary effect by multiple infringers subsequently committing infringements of the same European patent with unitary effect (chain of infringers). The outcome of this problem could represent a decisive argument for (or against) such a European patent with unitary effect.

Notwithstanding the special nature of such a European patent with unitary effect, the crucial question is whether the same situation of fact exists with regard to all infringing acts. In this respect one might argue that the ECJ founded, in its *Roche Nederland* decision, the non-existence of identical acts of infringement on the fact that the multiple infringers acted in different States.<sup>769</sup> However, such an argumentation would disregard the fact that the *Roche Nederland* decision expressly concerns the infringement of an ordinary European patent (i.e. without unitary effect) and might therefore not be fully transferable to the situation of a European patent with unitary effect which differs from an ordinary European Patent insofar as it constitutes a unitary right for all the Member States and not only a bundle of national patents. Correspondingly, the German *Bundesgerichtshof* decided in a case after the *Roche Nederland* decision of the ECJ that Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) is applicable in the case of a Community trade mark being infringed by multiple infringers acting as a chain of infringers.<sup>770</sup> Likewise, legal doctrine has generally advocated the application of Article 6(1) of the Brussels Convention/Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) in the constellation in question.<sup>771</sup>

Contrary to that conception, the *Gerechtshof 's-Gravenhage* denied the existence of the same situation of fact in a case of the infringement of a Community trade mark by multiple infringers, acting in different countries.<sup>772</sup> Referring to the *Roche Nederland* decision of the ECJ, the *Gerechtshof 's-Gravenhage* underlined that such an identical legal situation can exist in the case of a *spider-in-the-web* constellation, i.e. a situation where multiple companies belonging to the same group have acted in an identical or similar manner in accordance with a common policy elaborated by one of them. The court stated:

“(…) Er is evenwel geen sprake van eenzelfde feitelijke situatie. Dit kan anders zijn in het geval waarin de verwerende vennootschappen tot hetzelfde concern behoren en op dezelfde of nagenoeg dezelfde wijze hebben gehandeld in overeenstemming met een gemeenschappelijk beleidsplan dat is uitgegaan van slechts een van hen(…).”<sup>773</sup>

<sup>769</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 33 – *Roche Nederland*.

<sup>770</sup> BGH 14 December 2006, I ZR 11/04, (2007)56(10) GRUR Int. 864, at p. 866, paras. 14-19 – *Aufarbeitung von Fahrzeugkomponenten*; cf. Norrgård 2009, p. 223; cf. Corneloup & Althammer 2012 (unalex Kommentar), Art. 6 Brüssel I-VO, para. 33.

<sup>771</sup> Knaak (2007)56(5) GRUR Int. 386, at p. 391.

<sup>772</sup> *Gerechtshof 's-Gravenhage* 23 August 2007, *Bacardi & Company Limited v Food Brokers B.V. and Others*, available at WWW <[http://oami.europa.eu/pdf/natcourt/Bacardi-Bat\\_Beverage.pdf](http://oami.europa.eu/pdf/natcourt/Bacardi-Bat_Beverage.pdf)> – *Bacardi*.

<sup>773</sup> *Gerechtshof 's-Gravenhage* 23 August 2007, *Bacardi & Company Limited v Food Brokers B.V. and Others*, available at WWW <[http://oami.europa.eu/pdf/natcourt/Bacardi-Bat\\_Beverage.pdf](http://oami.europa.eu/pdf/natcourt/Bacardi-Bat_Beverage.pdf)>, para. 13 – *Bacardi*.

(“... However, there is not the same situation of fact. This can be different in the case where the defendant companies belong to the same group, and acted in an identical or almost identical manner in accordance with a common policy emanating from one of them (...).”)<sup>774</sup>

In this respect, it is to be emphasised that the Dutch court did not consider the *spider-in-the-web* constellation a *conditio sine qua non* for the existence of the same situation of fact, but comprehensively understood this situation to be a non-exclusive assumption for the same factual situation being existent.<sup>775</sup>

However, as has rightly been criticised,<sup>776</sup> it is true that also concerning Community intellectual property rights such as the Community trade mark or the future European patent with unitary effect, the existence of the same legal situation is not self-evident, which has been ignored by courts<sup>777</sup> as well as by legal doctrine.<sup>778</sup> In fact, the existing Regulations concerning Community intellectual property rights (the Community trade mark Regulation and the Community designs Regulation), and also the Rome II Regulation provide that for all matters which are not covered in these Regulations, the law of the Member State shall be applicable where the infringement has been committed.

In this respect, Article 101(2) of the Community trade mark Regulation<sup>779</sup> provides:

“On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.”

And Article 102(2) of the Community trade mark Regulation<sup>780</sup> adds:

“In all other respects the Community trade mark court shall apply the law of the Member State in which the acts of infringement or threatened infringement were committed, including the private international law.”

Similarly, Article 88(1) of the Community designs Regulation<sup>781</sup> provides:

“The Community design courts shall apply the provisions of this Regulation.”

---

<sup>774</sup> Translation provided by the author of this thesis.

<sup>775</sup> Ultimately consenting to this evaluation of a “spider-in-the-web” constellation: Schauwecker 2009, p. 92; however, *Schauwecker* seems to misinterpret the reasoning of the *Gerechtshof ‘s-Gravenhage*, when stating that this court denied the existence of the same situation of fact in default of a “spider-in-the-web” constellation, thus suggesting that the court evaluated the non-existence of such a constellation as a *conditio sine qua non* for the same factual situation.

<sup>776</sup> Schauwecker 2009, p. 93.

<sup>777</sup> BGH 14 December 2006, I ZR 11/04, (2007)56(10) GRUR Int. 864, at p. 866, para. 19 – *Aufarbeitung von Fahrzeugkomponenten*.

<sup>778</sup> Knaak (2007)56(5) GRUR Int. 386, at p. 391.

<sup>779</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1-42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>780</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1-42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>781</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, OJ L3 of 5 January 2002, pp. 1-24, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:en:PDF>> (lastly accessed on 1 June 2015), amended by Council Regulation (EC) No 1891/2006 of 18 December 2006, OJ L386 of 29 December 2006, pp. 14-16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32006R1891&from=EN>> (lastly accessed on 1 June 2015).

Article 89(2) of the Community designs Regulation<sup>782</sup> completes:

“The Community design court shall take such measures in accordance with its national law as are aimed at ensuring that the orders referred to in paragraph 1 are complied with.”

Besides, Article 8(2) of the Rome II Regulation<sup>783</sup> rules:

“In the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable shall, for any question that is not governed by the relevant Community instrument, be the law of the country in which the act of infringement was committed.”

As all of these Regulations provide that national law shall be applicable in the case that the Regulations do not contain a rule, the dispute whether the Rome II Regulation prevails over the other Regulations does not matter in this context.<sup>784</sup> Community intellectual property rights like the future European patent with unitary effect certainly effect a definitely higher degree of unification than the institute of the ordinary European patent as a mere bundle of national rights. Nevertheless, national law keeps the function of filling the gaps. This effects that there are not (necessarily) the same factual situations, with regard to infringement actions concerning Community intellectual property rights, in case that multiple infringers domiciled in different Member States have acted by way of a chain of infringers.

## 2.4 Exclusive jurisdiction – Article 24(4)

### 2.4.1 Introductory considerations

Industrial property rights not being protected by Article 24(1),<sup>785</sup> Article 24(4) is the only provision of the Brussels Ibis Regulation which exclusively affects patent proceedings. The provision reads:<sup>786</sup>

---

<sup>782</sup> Cf. fn. 779.

<sup>783</sup> Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), OJ L199 of 31 July 2007, pp. 40-49, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32007R0864&from=EN>> (lastly accessed on 1 June 2015).

<sup>784</sup> Schauwecker 2009, p. 93.

<sup>785</sup> Wadlow 1998, para. 2–109; Bukow 2003, p. 203.

<sup>786</sup> The *GAT* decision of the ECJ (being discussed at a later point), which may be called a landmark decision of the ECJ in this context, was rendered under the regime of and with regard to Article 16(4) of the Brussels Convention which was replaced (while the content remained unchanged) by Article 22(4) of the Brussels I Regulation, the direct predecessor of Article 24(4) of the Brussels Ibis Regulation. One decisive difference between Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation on the one hand and Article 24(4) of the Brussels Ibis Regulation on the other hand consists in the fact that the text of Article 24(4) of the Brussels Ibis Regulation has been supplemented by the phrase “irrespective of whether the issue is raised by way of an action or as a defence”. Since it is exactly this issue – whether the raise of an invalidity defence is sufficient for the applicability of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation – which has been subject to the *GAT* decision of the ECJ, fierce discussion and dispute in case-law and legal doctrine before and still after the *GAT* decision and finally a significant element of several reform proposals, special emphasis shall be put on Article 22(4) of the Brussels I Regulation (Article 16(4) of the Brussels Convention). In contrast to Articles 5(3) and 6(1) of the Brussels I Regulation which have, as already illustrated, mostly been adopted as Articles 7(2) and 8(1) of the Brussels Ibis Regulation, the situation is different concerning the relation between Article 22(4) of the Brussels I Regulation and Article 24(4) of the Brussels Ibis Regulation, due to the addressed supplement within the text of Article 24(4) of the Brussels Ibis Regulation which codifies the jurisprudence of the ECJ in its *GAT* decision. For this reason, I refer to the text of Article 22(4) of the Brussels I Regulation not only in a footnote, but prefer to concede it the same importance as Article 24(4) of the Brussels Ibis Regulation by citing it within the main text.

#### Article 24 of the Brussels Ibis Regulation

The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties:

(...)

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, irrespective of whether the issue is raised by way of an action or as a defence, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction in proceedings concerned with the registration or validity of any European patent granted for that Member State;

(...).

Remarkably, the predecessor of Article 24(4) of the Brussels Ibis Regulation, Article 22(4) of the Brussels I Regulation (which replaced Article 16(4) of the Brussels Convention without changes as to its wording and content), provided in a similar way, but without the phrase “irrespective of whether the issue is raised by way of an action or as a defence” being contained in Article 24(4) of the Brussels Ibis Regulation:

#### Article 22 of the Brussels I Regulation

The following courts shall have exclusive jurisdiction, regardless of domicile:

(...)

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State;

(...).

As Article 24(4) explicitly refers to the *courts* of the Member States, it is to be noticed that it merely concerns the international jurisdiction of the courts of the EU Member States, while the question of local jurisdiction is governed by national procedural law.<sup>787</sup> As the Jenard

---

At this point, it should suffice to mention that the present formulation of Article 24(4) of the Brussels Ibis Regulation does not preclude that another solution could be realised in the framework of a future reform of the Brussels Ibis Regulation. Details as to this issue shall be discussed in Chapter 3 of this thesis.

Remarkably, the revised Lugano Convention which entered into force on 1 January 2010 already anticipated the mentioned change of wording from Article 22(4) of the Brussels I Regulation to Article 24(4) of the Brussels Ibis Regulation (“irrespective of whether the issue is raised by way of an action or as a defence”), cf. Wagner & Janzen (2010)30(4) IPRax 298, at p. 304; cf. also Borrás 2008, pp. 250-251; cf. also Borrás & Hausmann 2012 (unalex Kommentar), Art. 22 Brüssel I-VO, para. 75.

<sup>787</sup> Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 1; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 20.

Report has already clarified (with regard to Article 16(4) of the Brussels Convention), the subject-matter of the action is decisive for Article 24(4) to be applicable. On the contrary, it is not relevant where the parties – plaintiff and defendant – are domiciled or which nationality they have.<sup>788</sup> If Article 24(4) is applicable, the jurisdiction conferred is exclusive, and prorogation of jurisdiction in accordance with Article 25 is not possible (cf. Article 25(4)):

#### **Article 25 of the Brussels Ibis Regulation**

(4) Agreements or provisions of a trust instrument conferring jurisdiction shall have no legal force if they are contrary to Articles 15, 19 or 23, or if the courts whose jurisdiction they purport to exclude have exclusive jurisdiction by virtue of Article 24.

Additionally, Article 24(4) also precedes Article 26, as Article 26(1) states:

#### **Article 26 of the Brussels Ibis Regulation**

(1) Apart from jurisdiction derived from other provisions of this Regulation, a court of a Member State before which a defendant enters an appearance shall have jurisdiction. This rule shall not apply where appearance was entered to contest the jurisdiction, or where another court has exclusive jurisdiction by virtue of Article 24.

Regarding the question of whether proceedings are covered by the scope of application of Article 24(4), the ECJ declared in *Duijnstee* (concerning the interpretation of Article 16(4) of the Brussels Convention) that this issue shall be solved by way of an autonomous interpretation, not taking into account the *lex fori* or the *lex causae*. Concretely, the ECJ ruled:

“In the present case, both an interpretation according to the law of the Contracting State whose courts have jurisdiction under Article 16(4) [of the Brussels Convention] and an interpretation according to the *lex fori* would be liable to produce divergent solutions, which would be prejudicial to the principle that the rights and obligations which the persons concerned derive from the Convention should be equal and uniform. Thus the term “proceedings concerned with the registration, or validity of patents” contained in Article 16(4) [of the Brussels Convention] must be regarded as an independent concept intended to have uniform application in all the Contracting States [underline and content in brackets added].”<sup>789</sup>

As to the *ratio legis* of Article 24(4) (respectively its predecessors), several aspects have been emphasised both by the ECJ and in legal doctrine. On the one hand, the ECJ pointed out in its *Sanders* decision, that the courts which dispose of exclusive jurisdiction are those most appropriate to decide:

---

<sup>788</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015), p. 34: “These rules, which take as their criterion the subject-matter of the action, are applicable regardless of the domicile or nationality of the parties. In view of the reasons for laying down rules of exclusive jurisdiction, it was necessary to provide for their general application, even in respect of defendants domiciled outside the Community.” Cf. Borrás & Hausmann 2012 (unalex Kommentar), vor Art. 22 Brüssel I-VO, para. 8.

<sup>789</sup> ECJ 15 November 1983, C-288/82, Ferdinand M. J. J. Duijnstee v Lodewijk Goderbauer, [1983] ECR 03663, paras. 18-19 – *Duijnstee*.



“As regards the matters listed under subparagraphs (2), (3), (4) and (5) of that article [Article 16 of the Brussels Convention] it is clear that the courts which are given exclusive jurisdiction are those which are the best placed to deal with the disputes in question [content in brackets added].”<sup>790</sup>

Although this decision was given by reference to Article 16(1) of the Brussels Convention (Article 24(1) of the Brussels Ibis Regulation), the underlying general idea also applies to Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) because the ECJ explicitly mentioned Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation), too. The aspect of proximity to law and evidence was picked up by the ECJ in its *Duijnstee* decision with regard to the interpretation of Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) where the ECJ held:

“In that regard, it must be noted that the exclusive jurisdiction in proceedings concerned with the registration or validity of patents conferred upon the courts of the Contracting State in which the deposit or registration has been applied for is justified by the fact that those courts are best placed to adjudicate upon cases in which the dispute itself concerns the validity of the patent or the existence of the deposit or registration.”<sup>791</sup>

Correspondingly, the ECJ confirmed in its famous *GAT* decision:

“In relation to the objective pursued, it should be noted that the rules of exclusive jurisdiction laid down in Article 16 of the [Brussels] Convention seek to ensure that jurisdiction rests with courts closely linked to the proceedings in fact and law [content in brackets added].”<sup>792</sup>

This reasoning has been shared in legal doctrine.<sup>793</sup> On the other hand, it has been underlined already in the Jenard Report that the issue of patents represents an act of national sovereignty requiring the courts of the granting State to have exclusive jurisdiction on validity questions.<sup>794</sup> In addition to this aspect, the ECJ highlighted, also in its *GAT* decision, that patents are granted by national administrative authorities:

“That exclusive jurisdiction is also justified by the fact that the issue of patents necessitates the involvement of the national administrative authorities (...).”<sup>795</sup>

That alternative explanation and justification for exclusive jurisdiction according to Article 24(4) has also been supported by legal doctrine.<sup>796</sup>

It is noteworthy that the ground for exclusive jurisdiction regarding intellectual property such as according to Article 24(4) has been characterised as a reincarnation of “*forme*

---

<sup>790</sup> ECJ 14 December 1977, C-73/77, Theodorus Engelbertus Sanders v Ronald van der Putte, [1977] ECR 02383, para. 11 – *Sanders*.

<sup>791</sup> ECJ 15 November 1983, C-288/82, Ferdinand M. J. J. Duijnstee v Lodewijk Goderbauer, [1983] ECR 03663, para. 22 – *Duijnstee*.

<sup>792</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 21 – *GAT*.

<sup>793</sup> Tritton & Tritton (1987)9(12) E.I.P.R. 349, at p. 350; Laubinger 2005, p. 106; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 221.

<sup>794</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015), p. 36: “Since the grant of a national patent is an exercise of national sovereignty, Article 16(4) of the Judgments Convention provides for exclusive jurisdiction in proceedings concerned with the validity of patents.”

<sup>795</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 23 – *GAT*.

<sup>796</sup> Hölder 2004, p. 170; Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 40.

*territorialiteit*” (as one component of the “*formele-territorialiteitsbeginsel*”)<sup>797</sup> with a more narrow scope constantly shrinking.<sup>798</sup> In Article 16(4) of the Brussels Convention, the former “*formele territorialiteit*” comprising comprehensive protection became a ground for exclusive jurisdiction applicable only to registration and validity.<sup>799</sup> In this respect, *Schaafsma* impressively explicated:

“(…) Het huidige onbegrip van de conflictregel in het beginsel van nationale behandeling is, als gezegd, uiteindelijk het gevolg van een dubbele schaarbeweging waarbij enerzijds het conflictenrecht Savigniaans is geworden, en anderzijds het intellectuele-eigendomsrecht is ‘geciviliseerd’. In dat latente en langdurige proces is het begrip van de conflictregel in het beginsel van nationale behandeling als zijnde het sluitstuk van het formele-territorialiteitsbeginsel, verdampt. En uit de nevelen trad uiteindelijk voor auteursrecht en industriële-eigendomsrecht – langs verschillende wegen – de *lex loci protectionis*-conflictregel naar voren. Zo bleef de materiële-territorialiteitscomponent van het formele-territorialiteitsbeginsel bestaan. De formele-territorialiteitscomponent van dat beginsel verdween; in het auteursrecht zonk deze component weg, in het industriële-eigendomsrecht reïncarneerde hij als een beperkte exclusieve-bevoegdheidsgrond.”<sup>800</sup>

“(…) The current lack of understanding of the conflict-of-law rule in the principle of national treatment is, as mentioned, the consequence of double scissor movements, whereas, on the one hand, conflict-of-law rules have become Savignian, and, on the other hand, intellectual property law has been ‘civilised’. In that latent and longsome process, the understanding of the conflict-of-law rule in the principle of national treatment as the end of the “*principle of formele territorialiteit*” evaporated. And out of the mists, the conflict-of-law rule of *lex loci protectionis* appeared – on different paths – for copyright law and industrial property law. While the component of “*materiële territorialiteit*” of the “*principle of formele territorialiteit*” remained, the component of “*formele territorialiteit*” of that principle disappeared; this component sank away in copyright law, while it reincarnated in industrial property law as a restricted ground for exclusive jurisdiction.”<sup>801</sup>

Where “*formele territorialiteit*” has reincarnated as a ground for exclusive jurisdiction, such a ground for jurisdiction is to be assumed.<sup>802</sup>

## 2.4.2 Infringement and nullity (invalidity) of patent rights in infringement proceedings

Probably the most controversial issue with respect to Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) has always been the correlation between patent infringement proceedings and the question of nullity of the patent concerned. In particular, two aspects are problematic: First, it is essential that with regard to jurisdiction, the general jurisdiction rule of Article 4(1) and the special jurisdiction rules of Article 7(2), 8(1), 25 and 26 are applicable to infringement proceedings, while actions with regard to the alleged nullity of patent rights are governed by the rule of Article 24(4) which gives exclusive jurisdiction to the courts concerned.<sup>803</sup> Second, it is to be noticed that the possibilities to bring before court both infringement and nullity proceedings differ: On the one hand, there are States where the defendant of an infringement

<sup>797</sup> In this respect, “*formele territorialiteit*” means that a court merely applies its own national law. In contrast to “*formele territorialiteit*”, “*materiële territorialiteit*” means that the scope of application of national law merely comprises the own territory; according to *Schaafsma*’s definition, “*formele-territorialiteitsbeginsel*” means a principle which comprises both “*formele territorialiteit*” and “*materiële territorialiteit*”, cf. *Schaafsma* 2009, para. 56.

<sup>798</sup> *Schaafsma* 2009, paras. 567 and 679.

<sup>799</sup> *Schaafsma* 2009, para. 570.

<sup>800</sup> *Schaafsma* 2009, para. 573.

<sup>801</sup> Translation provided by the author of this thesis.

<sup>802</sup> *Schaafsma* 2009, paras. 682 and 679.

<sup>803</sup> Cf. Borrás & Hausmann 2012 (unalex Kommentar), Art. 22 Brüssel I-VO, paras. 66 and 71.

action can raise the defence of invalidity of the patent in question, having *inter partes* effect, and/or can raise a counter-claim, the latter having *erga omnes* effect.<sup>804</sup> On the other hand, the procedural (court) structure of Germany (and Austria) is characterised by the fact that jurisdiction for infringement proceedings and nullity proceedings are strictly divided. The court seised in infringement proceedings is not empowered to decide on the question of validity of a patent, but must generally assume the validity of the concerned patent. If a decision on the validity of that patent appears necessary though, the court must stay its proceeding according to German civil procedural law (§ 148 ZPO) and wait for a decision of the *Bundespatentgericht*, if a nullity action has been filed there.

Already under Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation, it was clear that the respective provision of exclusive jurisdiction was applicable when the defendant of an infringement action raised a counter-claim, because a separate action is concerned which is not directly linked with the infringement action.<sup>805</sup> It was also accepted that Article 6(3) of the Brussels Convention/Brussels I Regulation (Article 8(3) of the Brussels Ibis Regulation) is not applicable in this constellation, according to which a person domiciled in a Member State may also be sued on a counter-claim arising from the same contract or facts on which the original claim was based, in the court in which the original claim is pending, because Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) overrules Article 6(3) of the Brussels Convention/Brussels I Regulation (Article 8(3) of the Brussels Ibis Regulation) as *lex specialis*.<sup>806</sup> Although, apparently, the ECJ has not made a decision concerning the relationship between Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) and Article 6(3) of the Brussels Convention/Brussels I Regulation (Article 8(3) of the Brussels Ibis Regulation) yet, the court confirmed in two judgments that Article 17 of the Brussels Convention (Article 25 of the Brussels Ibis Regulation), giving exclusive jurisdiction to the courts of a Contracting State (i.e. the courts of a Member State in the case of the Brussels Ibis Regulation) if the parties have agreed upon a choice of jurisdiction), should take precedence over Article 6(3) of the Brussels Convention (Article 8(3) of the Brussels Ibis Regulation). The ECJ explicitly stated in both decisions:

“The way in which that provision [Article 17 of the Brussels Convention] is to be applied must be interpreted in the light of the effect of the conferment of jurisdiction by consent, which is to exclude both the jurisdiction determined by the general principle laid down in Article 2 [of the Brussels Convention] and the special jurisdictions provided for in Articles 5 and 6 of the Convention. (...) [content in brackets added]”<sup>807</sup>

These decisions may at least give a hint how the ECJ would evaluate the relationship between Article 24(4) and Article 8(3). Besides, it is even doubtful whether the conditions set up by Article 8(3), i.e., basically, a close connection between the original claim and the counter-claim, are fulfilled in the case of an infringement action and the defence of invalidity of the

<sup>804</sup> For instance in the Netherlands (cf. Brinkhof (2000)31(6) IIC 706, at p. 718), in England (cf. Cornish & Llewelyn (2000)31(6) IIC 627, at p. 644; Wadlow 1998, paras. 3–133–3–136) and in Italy (cf. Mangini (1983)42(4) GRUR Int. 226, at p. 227).

<sup>805</sup> Fawcett & Torremans 2011, paras. 7.40–7.41; Ebner 2004, p. 210.

<sup>806</sup> Tritton 2008, para. 14–070; Tritton & Tritton (1987)9(12) E.I.P.R. 349, at p. 351; Bukow 2003, p. 206; Mäder 1999, p. 102.

<sup>807</sup> ECJ 14 December 1976, C-24/76, *Estasis Salotti di Colzani Aimo et Gianmario Colzani v Rüwa Polstereimaschinen GmbH*, [1976] ECR 01831, para. 7 – *Salotti*; ECJ 14 December 1976, C-25/76, *Galeries Segoura SPRL v Société Rahim Bonakdarian*, [1976] ECR 01851, para. 6 – *Segoura*.

patent, since a counter-claim for revocation is not based on the same facts as an infringement action.<sup>808</sup>

However, due to the fact that the supplement “irrespective of whether the issue is raised by way of an action or as a defence” forms part of Article 24(4) of the Brussels Ibis Regulation, was not contained in Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation, it was doubtful until the *GAT* decision of the ECJ whether, respectively in how far the *defence*, based on the alleged invalidity of a patent, which is put forth in infringement proceedings has the effect that Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation is applicable, with the potential consequence that the court invoked for the infringement proceeding loses jurisdiction (which would be expectable in cross-border proceedings). As the defence of invalidity of the patent is probably the most important defence in infringement proceedings,<sup>809</sup> the answer to that question must be considered crucial for infringement proceedings.

### **2.4.2.1 Interpretation of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation before the *GAT* decision**

Until the leading *GAT* decision delivered by the ECJ, both national courts and legal doctrine within the Member States favoured different solutions as to that problem. Before analysing in how far the *GAT* decision brought some light as to the scope of application of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation in this respect, a brief overview shall be delivered of these perspectives, because the analysis of the *GAT* decision will also have to take into consideration those previous conceptions.

#### **2.4.2.1.1 United Kingdom**

##### **2.4.2.1.1.1 Court decisions**

Traditionally, English courts have tended to interpret Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation in a broad way. Several leading cases have been decided which have considerably formed the English perspective on exclusive jurisdiction according to Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation.<sup>810</sup> These cases shall be presented in the following paragraphs, adhering to their chronological order.

##### **2.4.2.1.1.1.1 *Coin Controls***

The decision *Coin Controls*<sup>811</sup> of the English *High Court of Justice – Chancery Division* was based on the following facts: The plaintiff was the proprietor of three patents: a United Kingdom patent, a German patent and a Spanish patent, for coin dispensing apparatus. These

---

<sup>808</sup> Pertegás Sender 2002, para. 4.59.

<sup>809</sup> Kubis (2007)98(5) Mitt. 220, at p. 221; Adolphsen (2007)27(1) IPRax 15, at p. 17; cf. also Hellstadius & Meier-Ewert (2005)36(3) IIC 313, at p. 319: “allegedly 95.5% of all infringement cases”.

<sup>810</sup> This fact is even intensified by the circumstance that English law is significantly determined by case-law.

<sup>811</sup> High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suzo International (U.K.) Limited and Others*, [1997] F.S.R. 660 – *Coin Controls*.

national patents had arisen out of a single patent application made to the European Patent Office. The four defendants belonged to the Suzo Group. The plaintiff sued all defendants for jointly infringing all three patents.

First, *Justice Laddie* referred to the judgment of *Justice Lloyd* in *Pearce I*, a case concerned with copyright infringement, where *Justice Lloyd* had held that an infringement proceeding on a foreign copyright could be instituted in England if international jurisdiction can be based on the provisions of the Brussels Convention. He had stated:

“My conclusion on this point is that the Convention does require an English court to accept jurisdiction where an action is brought against an English domiciled defendant (with or without other defendants) for breach of a Dutch copyright, and to hear that action on the merits, and thus overrides, so far as is necessary for that purpose, both Rule 203 and the *Moçambique* rule, even though neither of them is a rule as to jurisdiction. Each of them, to the extent that they would preclude the English court from hearing such an action, would in my judgment impair the effectiveness of the Convention by frustrating the operation of the basic rule in Article 2 [of the Brussels Convention], and must therefore give way in order to allow the jurisdictional rules of the Convention to have their proper effect. The position is quite different from other exclusionary rules, such as Acts of State, because both Rule 203 and the *Moçambique* rule proceed on the clear premise that the English courts are not a suitable forum for such an action whereas the courts of another country are appropriate. It seems to me that, where that other country is another Contracting State, this is a position which subverts the policy and provisions of the Convention. To borrow a phrase from another area of Community law, although they are not rules as to jurisdiction, they are “measures having an equivalent effect” to rules of jurisdiction, and are inconsistent with the mandatory effect of the Convention and its basic rule as to domicile-based jurisdiction in Article 2 [of the Brussels Convention] [content in brackets added].”<sup>812</sup>

This judgment was confirmed by the *Court of Appeal* in second instance (*Pearce II*).<sup>813</sup>

Coming back to *Coin Controls*, *Justice Laddie* concluded, as to the relationship between patent infringement proceedings and the defence of invalidity of the patent in question, that the court before which the infringement proceedings were brought would lose jurisdiction in favour of the courts of the State where the patent had been granted. He held:

“As I have said, validity is frequently in issue, and sometimes the most important issue, in English patent infringement proceedings. (...) We have always taken the view that you cannot infringe an invalid patent. (...) However the fact that the defendant can challenge validity does not mean that he will. (...) Until he does, only infringement is in issue and the approach in *Pearce* applies. The court cannot decline jurisdiction on the basis of mere suspicions as to what defence may be run. But once the defendant raises validity the court must hand the proceedings over to the courts having exclusive jurisdiction over that issue. Furthermore, since Article 19 [of the Brussels Convention] obliges the court to decline jurisdiction in relation to claims which are “principally” concerned with Article 16 [of the Brussels Convention] issues, it seems to follow that jurisdiction over all of the claim, including that part which is not within Article 16 [of the Brussels Convention] must be declined. It may well be that if there are multiple discrete issues before a court it will be possible to sever one or more claims from another and to decline to accept jurisdiction only over those covered by Article 16 [of the Brussels Convention], but I do not believe that that approach applies where infringement and validity of an intellectual property right are concerned. They are so closely interrelated that they should be treated for jurisdiction purposes as one issue or claim [content in brackets added].”<sup>814</sup>

Since it was apparent in this case that the validity of the German and the Spanish patents would be challenged by the defendants, *Justice Laddie* denied jurisdiction of the *High Court*

---

<sup>812</sup> High Court of Justice (Chancery Division) 7 March 1997, *Gareth Pearce v Ove Arup Partnership Ltd and Others*, [1997] F.S.R. 641, 653-654 – *Pearce I*.

<sup>813</sup> Court of Appeal 21 January 1999, *Gareth Pearce v Ove Arup Partnership Ltd*, [1999] F.S.R. 525 – *Pearce II*.

<sup>814</sup> High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suzo International (U.K.) Limited and Others*, [1997] F.S.R. 660, 676-677 – *Coin Controls*.

of *Justice* for the pending infringement proceedings. *Justice Laddie* mainly founded his decision on the wording of Article 19 of the Rome Convention (which corresponds to Article 25 of the Rome I Regulation)<sup>815</sup> and held that the expression “principally concerned” should be interpreted in a broad sense, referring also to the Jenard Report:

“In the absence of binding authority, I also do not accept the second argument as to the meaning of “principally concerned”. I can see no reason to give the Article a narrow linguistic interpretation. The Jenard report suggests that what is excluded is incidental matter. Something which is a major feature of the litigation is not incidental and is therefore a matter with which the action is principally concerned. The issue which has to be decided then is whether the three foreign claims sought to be raised in the English courts are principally concerned, in this broad sense, with the issue of validity of the foreign patents.”<sup>816</sup>

#### 2.4.2.1.1.2 *Fort Dodge*

In *Fort Dodge*<sup>817</sup>, the Dutch company Akzo Nobel N.V. (A) and one of its subsidiaries and exclusive licensee under the patent (B) commenced patent infringement proceedings in the Netherlands against the United Kingdom company Animal Health Limited and four other companies being all part of the American Home Products group of companies (C, D, E, F, G), which made and sold canine parvovirus vaccines. A and B were seeking both interim and final relief, in respect of alleged acts of infringement of both Dutch and the United Kingdom patents which had been granted to A. Some months later, C, D, E, F and G petitioned the Patents Court in England for the revocation of the United Kingdom patent. This part of the proceedings concerned an application for an injunction to restrain the respondents from bringing or maintaining legal proceedings in the Netherlands in respect of the alleged patent infringement by reasons of any act committed within the jurisdiction of the English courts (anti-suit injunction). The application was based on the assumption that the only court with jurisdiction to determine whether the United Kingdom patent had been infringed was the English *Patents Court*.

Although *Justice Laddie* generally confirmed that English law provides the procedural means of anti-suit injunctions, he explicitly restricted its scope of application, emphasising the general principle of mutual trust between courts of different States, by underlining:

“In my view there is a world of difference between restraining a party from bringing or pursuing proceedings in a foreign court on the ground that to do so would breach a valid agreement not to do so and restraining the party on the ground that you do not trust the foreign court to apply an international convention properly or to act fairly.”<sup>818</sup>

Due to the fact that the question which consequences arise from the defence of invalidity of a patent during an infringement process concerning that patent could be solved, in the absence of a definite legal provision respectively a decision of the ECJ at that time, in different ways, *Justice Laddie* held that a final decision on that matter could only be taken by the ECJ. He frankly declared:

---

<sup>815</sup> Article 25 of the Rome I Regulation provides: “Where a court of a Member State is seised of a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 22, it shall declare of its own motion that it has no jurisdiction.”

<sup>816</sup> High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suizo International (U.K.) Limited and Others*, [1997] F.S.R. 660, 676 – *Coin Controls*.

<sup>817</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222 – *Fort Dodge*.

<sup>818</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 235 – *Fort Dodge*.

“Both the Dutch court and this court are seeking to implement the provisions of the convention. Neither has a bigger say than the other as to which construction is right. The ultimate court for determining that is the European Court of Justice. It is that court, not this, which can tell the Dutch courts – and us – what is the correct construction. It is clearly unsatisfactory that different courts in different countries adopted markedly different approaches to a convention which is supposed to bind them equally and to create a uniform regime. But the answer to this is not for one nation's courts to try to squeeze out the courts of its neighbour. In my judgment the correct course, if the differences continue, is for the matter to be brought before the European Court of Justice as soon as possible.”<sup>819</sup>

The *Court of Appeal* confirmed this position and underlined that

“(…) the matter is accordingly not “acte clair”. The question which view is right is one of considerable importance to the enforcement of intellectual property rights in jurisdictions subject to the Brussels Convention. We believe that it is necessary for the European Court of Justice to consider the construction of those Articles and their application to the facts and therefore it would be right to refer appropriate questions to that Court.”<sup>820</sup>

(…) In those circumstances we do not consider we would be justified in reaching a final conclusion that the pursuit, by Akzo, of the claim in the Dutch courts in respect of the United Kingdom patent would be vexatious. It follows that we are not prepared to grant a full injunction at this time. The reference is necessary in order to decide whether final relief by way of injunction or declaration would be appropriate. We now therefore proceed to consider whether interim relief by way of injunction or otherwise would be appropriate pending the determination of the reference to the European Court.”<sup>821</sup>

Consequently, the *Court of Appeal* referred this question to the ECJ. Interestingly, the *Court of Appeal* decided only few days after *Justice Laddie* had made his decision. The presumption that the *Court of Appeal* intended to influence the Dutch court before which the infringement proceedings were negotiated was even confirmed by the *Court of Appeal* itself when expressing:

“We have every confidence that the Dutch court will, when deciding what to do, take into account that this Court will be referring to the European Court of Justice questions to elucidate how Articles 6, 16(4), 19 and 24 [of the Brussels Convention] should be applied to the dispute. It will give proper weight to our conclusion that it would be wrong for this Court to anticipate the decision of the European Court. It will, we believe, also consider carefully the other views expressed in this judgement and, of course, the submissions of the parties and the facts [content in brackets added].”<sup>822</sup>

Unfortunately, the ECJ had no opportunity to render a decision because the main proceedings were terminated.

#### 2.4.2.1.1.3 *Sepracor*

The facts of the subsequent *Sepracor* decision<sup>823</sup> were as follows: *Sepracor Inc.* was the co-proprietor of a United Kingdom patent for terfenadine carboxylate, and, through applications to the European Patent Office, also the proprietor of patents in a number of European

---

<sup>819</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 236 – *Fort Dodge*.

<sup>820</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 246 – *Fort Dodge*.

<sup>821</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 247 – *Fort Dodge*.

<sup>822</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222, 247 – *Fort Dodge*.

<sup>823</sup> High Court of Justice (Chancery Division – Patents Court) 29 January 1999, *Sepracor Inc. v Hoechst Marion Roussel Limited and Others*, [1999] F.S.R. 746 – *Sepracor*.

countries. One of the defendants had commenced proceedings in Belgium in order to receive a declaration that the national designations of the patent in Germany and Belgium were invalid or not infringed. Sepracor Inc. alleged that this was done so as to tie in litigation in Germany to the timetable in Belgian patent infringement actions, which were liable to take five years to resolve. Sepracor Inc. then issued proceedings in England seeking a declaration that the United Kingdom patent and its European equivalents were valid and alleging that they had been infringed.

Confirming his decision in *Fort Dodge*, Justice Laddie denied that English courts had jurisdiction as to the infringement of foreign patents where their validity was in question. He declared:

“In the light of the decision in *Fort Dodge*, Sepracor Inc. accepts that the pleaded claims in relation to the foreign designations are not justiciable.”<sup>824</sup>

#### 2.4.2.1.1.2 Legal doctrine

Some English authors have agreed to the court decisions cited above which clearly demonstrate the tendency of English courts to deny jurisdiction for infringement proceedings concerning foreign patents when the validity of such patents is called into question.<sup>825</sup> Others have taken a rather critical attitude towards an extensive application of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation.<sup>826</sup> It has been alternatively proposed that the court before which infringement proceedings have been brought shall also have jurisdiction as to the evaluation of validity of the patent in question, but only with *inter partes* effect.<sup>827</sup> Besides, it has been put forth that the court invoked for infringement proceedings shall stay the proceedings until the decision on the validity of the patent has been rendered by the foreign court or administrative authority.<sup>828</sup>

#### 2.4.2.1.2 The Netherlands

##### 2.4.2.1.2.1 Court decisions

In particular with respect to patent and trade mark litigation, it is to be noticed that Dutch procedural law is remarkably coined by the provisional measure of the *kort geding* according to Articles 289 to 291 of the Dutch Civil Procedural Order. In the decision *Rhône Poulenc Rorer v Prographarm* the President of the *Rechtbank 's-Gravenhage* explicitly declared that the provision of Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation) does not constitute an obstacle for the jurisdiction of the Dutch court concerned with infringement proceedings by way of a *kort geding* due to its provisional character which excludes a final judgment on the validity of patents. Although the court will take into consideration a defence of invalidity of the patent in question put forth by the defendant, this

<sup>824</sup> High Court of Justice (Chancery Division – Patents Court) 29 January 1999, *Sepracor Inc. v Hoechst Marion Roussel Limited and Others*, [1999] F.S.R. 746, 753 – *Sepracor*.

<sup>825</sup> Arnold (1990)12(7) E.I.P.R. 254, at p. 259; Bragiel (1999)2 I.P.Q. 135, at p. 154.

<sup>826</sup> Fawcett & Torremans 1998, pp. 204-207; Dutson (1998)47(3) I.C.L.Q. 659, at p. 667; rather neutral: Karet (1998)3 I.P.Q. 317, at pp. 329-330.

<sup>827</sup> Before the *GAT* decision of the ECJ: Cf. Wadlow 1998, paras. 3–109-3–111.

<sup>828</sup> Floyd & Purvis (1995)17(3) E.I.P.R. 110, at p. 111; Dutson (1998)47(3) I.C.L.Q. 659, at pp. 667-668; mentioning this opinion: Karet (1998)3 I.P.Q. 317, at p. 329.



examination of invalidity merely has the nature of a prognosis and lacks influence on the validity of the patent. In case of a defence of invalidity in the main proceedings, the court will stay them until the question of validity will have been clarified by the court having jurisdiction according to Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation).<sup>829</sup> The *Gerechtshof 's-Gravenhage* restricted this broad perspective to some extent in its decision *Hoffmann-La Roche*. In this decision, the court held that an incidental decision by means of a *kort geding* should at least be possible if the patent right was confirmed, and under the precondition that the case was not too complicated in factual and legal respect.<sup>830</sup>

However, the most important decisions delivered by Dutch courts regarding the question of the scope of application of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation were the two decisions in the *Expandable Grafts Partnership* case. These shall be subject of the following paragraphs.

#### 2.4.2.1.2.1.1 *Expandable Grafts Partnership I*

In the joint decision of the *Rechtbank 's-Gravenhage* in *Julio Cesar Palmaz and Others v Boston Scientific B.V. and Others*, and *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*<sup>831</sup>, the decisive facts were as follows: In both proceedings, the plaintiffs sued the defendants (two Dutch, one Belgian, one English, one Swiss, one Norwegian, one French, one Swedish, one Spanish and one Italian company, all of which being interconnected) for infringements of European patents. Expandable Grafts Partnership sought determination of the issue of infringement in accelerated proceedings before the *Rechtbank 's-Gravenhage* and, in addition, interim relief including injunctions restraining infringement in all the countries (except Germany and the United Kingdom) which had been designated in the relevant European patent. At the date of the hearing, there was litigation pending between the parties (and further parties) in the Netherlands, Belgium, France, Germany, the United Kingdom, Italy, Sweden and Spain in all of which (apart from Germany, Sweden and Spain) both infringement and validity were in issue. The defendants challenged the jurisdiction of the *Rechtbank 's-Gravenhage* over the foreign defendants and in respect of the Dutch defendants to the extent that the claim covered cross-border relief. They also denied patent infringement and alleged that the patents were invalid. In particular, the defendants argued that under Article 16 of the Brussels Convention (and the Treaty of Lugano) the respective courts of those countries in which validity had been put in issue had exclusive jurisdiction and that under Article 19 of the Brussels Convention (and the Treaty of Lugano) the invoked *Rechtbank 's-Gravenhage* should decline jurisdiction. In the process of finding a decision, the court took into close consideration<sup>832</sup> the English decision in *Coin Controls* of

---

<sup>829</sup> Rb. 's-Gravenhage 5 January 1993, Rhône Poulenc Rorer SA (France) and Others v Pharmachemie BV (Netherlands) and Others, IER 1993, 15, para. 4.2 – *Rhône Poulenc*.

<sup>830</sup> Gerechtshof 's-Gravenhage 12 December 1996, Hoffmann-La Roche AG v Organon Teknika B.V. and Others, (1998)47(1) GRUR Int. 58, with case note D. Stauder.

<sup>831</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, Julio Cesar Palmaz and Others v Boston Scientific BV and Others, and Case No. 97/1368, Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others, [1998] F.S.R. 199 – *Expandable Grafts I*.

<sup>832</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, Julio Cesar Palmaz and Others v Boston Scientific BV and Others, and Case No. 97/1368, Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others, [1998] F.S.R. 199, 211-214 – *Expandable Grafts I*.

the English *High Court of Justice – Chancery Division*<sup>833</sup>. Although the *Rechtbank 's-Gravenhage* ultimately did not share the opinion of the English court, it conceded that

“(…) much store must be given to a decision of another European court – certainly if it concerns a thoroughly reasoned and documented decision as in this case.”<sup>834</sup>

The *Rechtbank 's-Gravenhage* first analysed how the words “a claim principally concerned with” in Article 19 of the Brussels Convention (Article 25 of the Brussels I Regulation) are to be interpreted, pointing out that any interpretation will have to be made autonomously in conformity with the Brussels Convention (Brussels I Regulation).<sup>835</sup> As to the crucial problem whether the defence of invalidity of the patents renders the claim to an injunction not to infringe the patents into one “principally concerned with” the validity of the patents in the sense of Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation), the court made clear that it is decisive that an injunction cannot be obtained without giving a decision on the legal validity of the patent. The court reasoned two possible solutions to this point:

“This dilemma can be solved in principle in the manner proposed by the defendants: the infringement court – which in principle has jurisdiction – has to declare itself not to have jurisdiction as soon as the invalidity of the patent is claimed by way of defence.

The dilemma can also be solved in such manner that the infringement court considers itself competent to take cognizance of the claim, but – in the occurrence and after estimating, or not, the likelihood of invalidation – finds that it cannot give a decision on it until after the invalidity court which has such jurisdiction has given its opinion on the validity of the patent, to which end it will stay the infringement proceedings, if necessary.”<sup>836</sup>

Regarding the wording of the Brussels Convention (which largely corresponds to that of the Brussels I Regulation) and the Jenard Report, the *Rechtbank 's-Gravenhage* clarified that

“(…) neither the text of the [Brussels] Convention nor the one of the Jenard report compel the choice of either solution. After all, the Convention does not say anything on that subject and arguments in both senses may be derived from Jenard. We must probably conclude that neither the authors of the Convention nor of Jenard took into account that in patent proceedings the discussion of infringement and the one of invalidity are almost Siamese twins and hardly ever occur separately [content in brackets added].”<sup>837</sup>

Taking into account the purpose of the Brussels Convention (Brussels I Regulation) which is to strengthen the legal protection of persons established within the territory of the Contracting States (respectively Member States as to the Brussels I Regulation), the court judged that both solutions indicated above could prevent a speedy adjudication in patent litigations and compel

---

<sup>833</sup> High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suzo International (U.K.) Limited and Others*, [1997] F.S.R. 660 – *Coin Controls*.

<sup>834</sup> Rb. ‘s-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 211 – *Expandable Grafts I*.

<sup>835</sup> Rb. ‘s-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 211-212 – *Expandable Grafts I*.

<sup>836</sup> Rb. ‘s-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 212 – *Expandable Grafts I*.

<sup>837</sup> Rb. ‘s-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 212-213 – *Expandable Grafts I*.

the institution of separate related proceedings.<sup>838</sup> However, the court finally arrived at the conclusion that this risk is higher if the first solution was chosen, because

“(…) it invites defendants to bring invalidation actions with the sole purpose of taking away jurisdiction from a court which originally had jurisdiction and thus compelling the patent owner to incur additional expenses, or to obtain a gain of time.”<sup>839</sup>

Additionally, the court pointed out the possibility that – if the patent is valid – there is actually no patent infringement, and that the procedure on the merits can then be decided without any real need for instituting invalidation proceedings and in any case without waiting for such proceedings.<sup>840</sup> Besides, the *Rechtbank 's-Gravenhage* emphasised the fact that, according to the *Duijnste* decision of the ECJ,

“(…) Article 16(4) of the Brussels Convention/Treaty of Lugano, being an exception to the main rule, must be interpreted restrictively rather than extensively.”<sup>841</sup>

On this basis, the *Rechtbank 's-Gravenhage* reasoned that

“(…) an interpretation which would have as a result that the jurisdiction of the Court would not be established until after the defence has been pleaded, is contrary to the objectives of the Brussels Convention/Treaty of Lugano to such an extent that this possibility should only be chosen if – also taking into account the conditions for European integration – it would be unavoidable.”<sup>842</sup>

The court denied such unavoidability due to the present circumstances in Germany and in the Netherlands:

“Practice in the Federal Republic shows that a less drastic solution than the one chosen by the English court is possible, namely an assessment of the risk of invalidation and a stay of the infringement proceedings if the likelihood of invalidation justifies this. A similar conduct provides a satisfactory solution also in the Dutch preliminary proceedings practice in respect of patents the invalidity of which is invoked.”<sup>843</sup>

---

<sup>838</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 213 – *Expandable Grafts I*; as to this aspect, the analysis of *Hye-Knudsen* in *Hye-Knudsen* 2005, p. 34, appears too reduced, because *Hye-Knudsen* conceals that the *Rechtbank 's-Gravenhage* explicitly recognised that also when the infringement court – which in principle has jurisdiction – declares not to have jurisdiction as soon as the invalidity of the patent is claimed by way of defence, the objection of delay in patent disputes applies just as much (if not more). The court explicated in this sense: “In that case also a dispute is presented to, for example, the court of the country of infringement whereas then – after the defence – it appears that the expenses were incurred in vain and that the proceedings must be instituted again in the country of registration of the patent, or the countries of registration.”

<sup>839</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 212-213 – *Expandable Grafts I*.

<sup>840</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 212-213 – *Expandable Grafts I*.

<sup>841</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 212-213 – *Expandable Grafts I*.

<sup>842</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 214 – *Expandable Grafts I*.

<sup>843</sup> Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 214 – *Expandable Grafts I*.

Therefore, the *Rechtbank 's-Gravenhage* reached the conclusion that, at least as to the injunction claim, the alleged invalidity of the patents claimed by the defendants did not impact jurisdiction of the court. However, the court conceded that it may not be able to reach a final decision before a decision has been made by the invalidation courts having jurisdiction in the various States for which the injunction was claimed. If necessary, the proceeding should be stayed till then.<sup>844</sup>

#### 2.4.2.1.2.1.2 *Expandable Grafts Partnership II*

The *Gerechtshof 's-Gravenhage* which was concerned with the matter at second instance partly shared the opinion of the *Rechtbank 's-Gravenhage* as far as it pointed out the link between nullity and infringement as to the main proceeding, stating:

“It is a fact that infringement and nullity are indissolubly linked with each other, since it is impossible to infringe a patent that is null and void. Unless it is immediately clear that a nullity action cannot be deemed to be meant seriously, in the case of main proceedings on the merits the court which is asked to pronounce judgment on the infringement issue will have to adopt a cautious attitude towards the infringement action and in principle will have to stay the infringement proceedings until the foreign court has pronounced judgment on the nullity issue.”<sup>845</sup>

However, in contrast to the *Rechtbank 's-Gravenhage*, the *Gerechtshof 's-Gravenhage* decided that the same applies to infringement injunctions by way of *kort geding*, because this situation requires at least the same degree of caution.<sup>846</sup> Impressively, emphasising the need to ameliorate this state, the court noticed:

“Obviously the separate hearing and settlement of the infringement issue and the nullity issue by two different national courts is far from ideal. It would be desirable for the infringement and nullity issues to be decided by the same court. It would also be desirable if the hearing and settlement of actions for infringement and nullity of several patents originating from one European bundle of patents could be concentrated in one court. But this solution is barred by Article 16(4) of the Brussels/Lugano Convention. National courts cannot make the said wishes come true. Amendment of the Conventions seems to be inevitable.”<sup>847</sup>

#### 2.4.2.1.2.2 Legal doctrine

Dutch legal doctrine generally tended to deny the applicability of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation on proceedings by way of *kort geding*, restricting its scope of application to the main proceeding.<sup>848</sup> However, it was put forth that constellations are conceivable where Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation must be taken into respect, also with respect to provisional (protective) measures: For instance, if a patent infringement is evident, in cases of a “strong”

<sup>844</sup> Rb. ‘s-Gravenhage 29 October 1997, Case No. 97/1367, *Julio Cesar Palmaz and Others v Boston Scientific BV and Others*, and Case No. 97/1368, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1998] F.S.R. 199, 214 – *Expandable Grafts I*.

<sup>845</sup> *Gerechtshof 's-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352, 361 – *Expandable Grafts Partnership II*.

<sup>846</sup> *Gerechtshof 's-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352, 361-362 – *Expandable Grafts Partnership II*.

<sup>847</sup> *Gerechtshof 's-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352, 361 – *Expandable Grafts Partnership II*.

<sup>848</sup> Bertrams (1995)44(3) GRUR Int. 193, at p. 198.

patent which has already been successfully claimed before a court or within administrative proceedings, or if the patent holder runs the risk of considerable damage.<sup>849</sup>

### 2.4.2.1.3 Germany

According to the prevailing opinion in Germany before the *GAT* decision, the defence of nullity/invalidity of a foreign patent in infringement proceedings would *not* have the effect that Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation would be applicable giving the courts of the State where the patent had been granted exclusive jurisdiction unless the question of validity was not subject to a counter-claim.<sup>850</sup>

#### 2.4.2.1.3.1 Court decisions

German courts did not deny jurisdiction in the case of foreign patents as to the examination of their validity if this examination was undertaken by way of a preliminary question, and under the precondition that the defence of invalidity was permitted in the concerned infringement proceedings.<sup>851</sup> In the following paragraphs, I shall take a closer look on the leading cases before German courts.

##### 2.4.2.1.3.1.1 *Kettenbandförderer III*

In the *Kettenbandförderer III* case,<sup>852</sup> the *Landgericht Düsseldorf* had to decide on the basis of the following facts: The plaintiff was the holder of a British patent concerning a special conveyor. The defendant who distributed such conveyors was sued by the plaintiff for patent infringement. In the course of its judgment, the *Landgericht Düsseldorf* first made clear that Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation) contains a provision of exclusive jurisdiction only for nullity actions. The court explicitly stated:

“Da Artikel 16 Nr. 4 GVÜ eine Ausnahme – im Sinne einer ausschließlichen Zuständigkeit der Gerichte des Vertragsstaates, in dem die Erteilung des Patents erfolgt ist – nur für Nichtigkeitsklagen gegen Patente vorsieht, gilt Artikel 2 Abs. 1 GVÜ auch für Verletzungsklagen aus einem ausländischen Patent, und zwar auch insoweit, als die Klage – wie hier – darauf gerichtet ist, der beklagten Partei die Vornahme bestimmter Handlungen in dem betreffenden ausländischen Staat zu untersagen.”<sup>853</sup>

(“As Article 16(4) of the Brussels Convention provides for an exception – in terms of exclusive jurisdiction of the courts of the Contracting State where the patent has been granted – only for nullity actions against patents, Article 2(1) of the Brussels Convention applies also to infringement actions as to a foreign patent, and also insofar as the action – as in this case – aims at prohibiting the defendant to undertake certain acts in the concerned foreign state.”)<sup>854</sup>

However, the court pointed out to be empowered to decide on a defence of nullity/invalidity:

---

<sup>849</sup> Brinkhof (1997)46(6) GRUR Int. 489, at p. 493.

<sup>850</sup> Hye-Knudsen 2005, p. 26; Neuhaus (1996)87(9) Mitt. 257, at p. 267.

<sup>851</sup> Schauwecker 2009, p. 215.

<sup>852</sup> LG Düsseldorf 1 February 1994, 4 O 193/87, LG Düsseldorf Entscheidungen 1998(1) 1 – *Kettenbandförderer III*.

<sup>853</sup> LG Düsseldorf 1 February 1994, 4 O 193/87, LG Düsseldorf Entscheidungen 1998(1) 1, at p. 3 – *Kettenbandförderer III*.

<sup>854</sup> Translation provided by the author of this thesis.

“(…) Zwar ist der Einwand (der Gültigkeit des Klagepatents) im Verletzungsverfahren an sich statthaft (Sec. 74(1) lit. a, (3); Sec. 72(1) lit. a, d, e; Sec. 1(1) lit. a, b PatG-GB (...).”<sup>855</sup>

“(…) Indeed the defence (of invalidity of the patent in question) is allowed in the infringement proceeding (Section 74(1) lit. a, (3); Section 72(1) lit. a, d, e; Section 1(1) lit. a, b of the British Patents Act (...).”<sup>856</sup>

#### **2.4.2.1.3.1.2 Reinigungsmittel für Kunststoffverarbeitungsmaschinen**

The *Landgericht Düsseldorf* decided in a similar way in the *Reinigungsmittel für Kunststoffverarbeitungsmaschinen* case.<sup>857</sup> Simplifying the facts for reasons of clearness, the situation was as follows: The plaintiff was the holder of a European patent being valid for, *inter alia*, Germany and the United Kingdom. Defendant 1 (among several defendants which shall be omitted here) was the authorised dealer, for the territory of the United Kingdom, of the X company, a licence holder of the plaintiff, concerning a liquid cleaning agent. The plaintiff claimed that the defendant had sold a counterfeit of his products, and raised an action for patent infringement. Besides other defences, the defendant also argued that the plaintiff's patent was invalid. Interestingly, and in contrast to its previous decision in *Kettenbandförderer III*, this judgment of the *Landgericht Düsseldorf* does not reveal a single hint that the court felt any doubt to have jurisdiction to consider the defence of invalidity. Apparently, the court found it natural to treat the defence of invalidity of the patent according to English law, within the framework of the infringement proceeding. This attitude becomes obvious when the court, in the middle of its judgment, laconically mentioned:

“Ihrer Inanspruchnahme können die Beklagten auch nicht mit Erfolg den Einwand der Patentnichtigkeit, Sec. 74 Absatz 1 des britischen Patentgesetzes (britPatG), entgegenhalten.”<sup>858</sup>

“(The defendants cannot successfully defend themselves by way of the defence of patent nullity, Section 74(1) of the British Patent Act.”)<sup>859</sup>

#### **2.4.2.1.3.1.3 Schwungrad**

This rather restrictive interpretation of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation was continued in the *Schwungrad* case<sup>860</sup>, which was also brought before the *Landgericht Düsseldorf* first, and was then brought before the *Oberlandesgericht Düsseldorf* which finally initiated preliminary proceedings before the ECJ. The following facts had to be taken into consideration: The plaintiff and the defendant were two German companies being active in the field of automobile drive technology. The defendant was the holder of two French patents concerning a specific mechanical means. As the plaintiff offered such a product to a third party, the defendant sued the plaintiff for alleged infringement. The alleged infringer raised a claim for declaration of non-infringement before the *Landgericht Düsseldorf*. In its judgment the court took into consideration the preceding

<sup>855</sup> LG Düsseldorf 1 February 1994, 4 O 193/87, LG Düsseldorf Entscheidungen 1998(1) 1, at p. 5 – *Kettenbandförderer III*.

<sup>856</sup> Translation provided by the author of this thesis.

<sup>857</sup> LG Düsseldorf 16 January 1996, 4 O 5/95, LG Düsseldorf Entscheidungen 1996(1)1 – *Reinigungsmittel für Kunststoffverarbeitungsmaschinen*.

<sup>858</sup> LG Düsseldorf 16 January 1996, 4 O 5/95, LG Düsseldorf Entscheidungen 1996(1)1, at p. 4 – *Reinigungsmittel für Kunststoffverarbeitungsmaschinen*.

<sup>859</sup> Translation provided by the author of this thesis.

<sup>860</sup> LG Düsseldorf 31 May 2001, 4 O 128/00, (2001)50(11) GRUR Int. 983 – *Schwungrad*.

English decisions in *Coin Controls* and *Fort Dodge* cited above, where the *High Court* and the *Court of Appeal* had come to the conclusion that the defence (respectively the counter-claim) of invalidity/nullity of a patent effected that the court being competent for infringement proceedings lost its jurisdiction. However, in conformity with its prior practice in the cases *Kettenbandförderer III* and *Reinigungsmittel für Kunststoffverarbeitungsmaschinen* cited above, the *Landgericht Düsseldorf* ultimately considered itself competent to adjudicate the case brought before it, including an incidental assessment of the validity issue. The court declared:

“Die internationale Zuständigkeit ist auch nicht dadurch entfallen, dass sich die Klägerin gegenüber dem Verletzungsvorwurf der Beklagten unter anderem mit der Nichtigkeit der Streitpatente verteidigt hat. Ein solcher Einwand kann zwar nach französischem Recht, nach dem sich Bestand und Schutzwirkungen der (französischen) Streitpatente beurteilt, auch im Verletzungsrechtsstreit erhoben werden. Ein solches Vorbringen hat jedoch nicht zur Folge, dass die ausschließliche Zuständigkeit französischer Gerichte nach Artikel 16 Nr. 4 EuGVÜ für den hier zu entscheidenden Rechtsstreit begründet wird.”<sup>861</sup>

(“International jurisdiction has not been taken away either by the fact that the plaintiff, vis-à-vis the claim of infringement by the defendant, has raised the defence of nullity of the patents in question. Such a defence can, in accordance with French law which is applicable as to the question of the existence and the protective effects of the (French) patents in question, also be raised in infringement proceedings. However, such a defence does not effect that the exclusive jurisdiction of French courts according to Article 16(4) of the Brussels Convention will be established for this trial.”)<sup>862</sup>

Besides references to Dutch court decisions the *Landgericht Düsseldorf* explicitly referred to the decision *Duijnstee* of the ECJ in order to justify its decision to give preference to a restrictive interpretation of Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation):

“Die Kammer hält an ihrer Auslegung insbesondere im Hinblick auf die Rechtsprechung des EuGH fest, wonach die vertragsautonom auszulegende Bestimmung des Artikel 16 Nr. 4 EuGVÜ restriktiv auszulegen ist.”<sup>863</sup>

(“The Chamber adheres to its interpretation in particular with respect to the case-law of the European Court of Justice, according to which the provision of Article 16(4) of the Brussels Convention, to be interpreted autonomously, must be interpreted restrictively.”)<sup>864</sup>

The *Landgericht Düsseldorf* finally dismissed the claim. Upon appeal by the plaintiff, the case was brought before the *Oberlandesgericht Düsseldorf*, which made a reference for a preliminary ruling to the ECJ on the question of whether exclusive jurisdiction only applies when a claim is raised for declaration of patent invalidity, or also when the issue of validity or invalidity is raised by one of the parties in proceedings concerning the infringement of a patent by way of a defence.<sup>865</sup> This was the start of the famous *GAT* case of the ECJ illustrated above that has – at least to a considerable extent – effected a fundamental change of legal theory and practice in Europe as to the interpretation of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation, and has finally led to the reformulation of the provision in Article 24(4) of the Brussels Ibis Regulation.

<sup>861</sup> LG Düsseldorf 31 May 2001, 4 O 128/00, (2001)50(11) GRUR Int. 983, at p. 983 – *Schwungrad*.

<sup>862</sup> Translation provided by the author of this thesis.

<sup>863</sup> LG Düsseldorf 31 May 2001, 4 O 128/00, (2001)50(11) GRUR Int. 983, at p. 983 – *Schwungrad*.

<sup>864</sup> Translation provided by the author of this thesis.

<sup>865</sup> OLG Düsseldorf 5 December 2002, 2 U 104/01, (2003)52(12) GRUR Int. 1030 – *GAT*.

#### 2.4.2.1.3.2 Legal doctrine

The perspective of the *Landgericht Düsseldorf* has generally been shared by the prevailing opinion in German legal doctrine, at least under the condition that the law of the State where the patent has been granted provides for the possibility of an incidental examination of the validity of the patent.<sup>866</sup>

This attitude has been based on three main aspects: First, it has been emphasised that the joint enforcement of the national parts of a European patent would not be possible if there was the danger that a defence of nullity of the patent in question would influence the jurisdiction of the court deciding on an infringement action.<sup>867</sup> Additionally, reference has been taken to the wording of Article 19 of the Brussels Convention (Article 25 of the Brussels I Regulation) which is closely connected to Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation).<sup>868</sup> Article 19 of the Brussels Convention (Article 25 of the Brussels I Regulation) provides:

“Where a court of a Contracting State (Member State) is seised of a claim which is *principally concerned* with a matter over which the courts of another Contracting State (Member State) have exclusive jurisdiction by virtue of Article 16 (Article 25), it shall declare of its own motion that it has no jurisdiction.”

It has been emphasised that the term “principally concerned” points at the interpretation that a mere defence of nullity/invalidity of a patent would not be sufficient to effect the applicability of Article 19 of the Brussels Convention (Article 25 of the Brussels I Regulation). This argumentation is supported by the French version of the Brussels Convention which reads:

“Le juge d'un État contractant, saisi à titre *principal* d'un litige pour lequel une juridiction d'un autre État contractant est exclusivement compétente en vertu de l'article 16, se déclare d'office incompétent.”

In this context, one might argue that in the case of a mere defence of invalidity, in opposition to the case of a counter-claim, the question of invalidity of the patent is only a preliminary question and thus cannot influence the question of jurisdiction.<sup>869</sup>

In light of the danger that infringement proceedings might be seriously delayed when the court invoked for infringement proceedings loses jurisdiction due to a raised defence of invalidity of a patent before a court in the State where the patent has been granted, the danger of a misuse of Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation) has been stressed. Even if the defence was not successful in the end, it would be possible indeed that the patent would not be valid any longer and that the opponent could strengthen his market position in the meantime.<sup>870</sup>

---

<sup>866</sup> Cf. already Stauder (1997)46(11) GRUR Int. 859, at p. 860; Stauder (2003)3(5/6) EuLF 286, at p. 287; cf. Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 50; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, paras. 19, 231, 237-238; Hye-Knudsen 2005, p. 27; Franzosi & Tilman (2005)96(2) Mitt. 55, at p. 57; Meier-Beck (1999)101(5) GRUR 379, at p. 380; Grabinski (2001)50(3) GRUR Int. 199, at p. 209.

<sup>867</sup> Meier-Beck (1999)101(5) GRUR 379, at p. 380; Grabinski (2001)50(3) GRUR Int. 199, at p. 209; Treichel 2001, p. 49.

<sup>868</sup> Stauder (1997)46(11) GRUR Int. 859, at p. 860, and there fn. 8.

<sup>869</sup> Cf. Fezer & Koos 2010 (Staudinger), para. 1133; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, paras. 19, 231.

<sup>870</sup> Hye-Knudsen 2005, p. 29, there fn. 39; cf. also Meier-Beck (1999)101(5) GRUR 379, at p. 380.



#### 2.4.2.2 Interpretation after the *GAT* decision

As has been shown, the interpretation of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation varied to a remarkable extent within the Member States and, besides, also between courts and legal doctrine. Against this background, the *GAT* decision of the ECJ was awaited with tension and the hope that some major issues of conflict of the Brussels Convention/Brussels I Regulation would finally be resolved. Unfortunately, the ECJ did not fulfil these expectations. In contrast, the subsequent analysis will demonstrate that the *GAT* decision has even produced more problems and uncertainties than have been solved by the judgment.<sup>871</sup>

In essence, the ECJ held that

“(…) Article 16(4) of the [Brussels] Convention is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concern all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection [content in brackets added].”<sup>872</sup>

#### 2.4.2.3 The scope of the *GAT* decision

As to the facts of the *GAT* case, it has already been mentioned that the dispute took place between two companies having their seats in Germany, i.e. within an EU Member State, about two French patents, i.e. patents granted by an EU Member State. Independently from questions of how to interpret the *GAT* decision in detail, and of which further requirements should be demanded, an interesting problem is whether the judgment also applies in case that a potential infringer has his habitual residence outside the European Union and/or other patents than national patents granted by an EU Member State are concerned. These latter two constellations shall be subject to research first. After that, I shall analyse the constellation that a patent granted by a third State, i.e. a non-Member State of the European Union respectively Contracting State of the Lugano Convention, or a patent granted by the EPO for such a State,<sup>873</sup> is subject to infringement.

##### 2.4.2.3.1 Potential infringer having his habitual residence outside the European Union

Due to the construction of Articles 4 to 6 of the Brussels Ibis Regulation, these provisions are not applicable in the case of a potential infringer having his habitual residence in a non-Member State. As a consequence, international jurisdiction of a Member State court can then

---

<sup>871</sup> *Fentiman* therefore characterizes the decision as “unrealistic and much-criticized”, cf. *Fentiman* 2008, p. 173. Less critical: *Feldges* 2007, p. 113. Cf. also *Torremans* 2009, p. 201: “(T)he Court's approach will create a whole new set of problems involving multiple cases in multiple courts dealing with the same issue, under the same harmonised legal provision and based on the same facts that are to be assessed globally on the same basis. The judgments arising from these multiple cases in the various national courts may from a theoretical point of view never conflict, as each national law only covers its own territory, but to anyone applying for European patents this conclusion is incomprehensible and as far as possible removed from business reality.” For an illustration of several major problems and uncertainties which have been created by the *GAT* decision, cf. *Torremans* 2009, pp. 202-203. In full clearness, *Torremans* concludes (*Torremans* 2009, p. 205): “For the foreseeable future the problems will remain and the judgment in *GAT v LUK* created more problems rather than solved them by cutting off avenues of potential solutions under the existing system.”

<sup>872</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 31 – *GAT*.

<sup>873</sup> This aspect is rightly emphasised by *Schauwecker* in: *Schauwecker* 2009, p. 227.

only come into existence by way of a prorogation of jurisdiction according to Article 25 which is expressly permitted by Article 6(1):

#### **Article 6(1) of the Brussels Ibis Regulation**

If the defendant is not domiciled in a Member State, the jurisdiction of the courts of each Member State shall, subject to Articles 24 and 25, be determined by the law of that Member State.

Article 25 provides:

#### **Article 25 of the Brussels Ibis Regulation**

(1) If the parties, regardless of their domicile, have agreed that a court or the courts of a Member State are to have jurisdiction to settle any disputes which have arisen or which may arise in connection with a particular legal relationship, that court or those courts shall have jurisdiction, unless the agreement is null and void as to its substantive validity under the law of that Member State. Such jurisdiction shall be exclusive unless the parties have agreed otherwise. (...)

(...)

(4) Agreements or provisions of a trust instrument conferring jurisdiction shall have no legal force if they are contrary to Articles 15, 19 or 23, or if the courts whose jurisdiction they purport to exclude have exclusive jurisdiction by virtue of Article 24.

(...).

Due to the restricting reference to Article 24, in Article 25(4), it is clear that Article 24 must also be taken into account if the parties have agreed on a prorogation of jurisdiction. In the absence of a valid prorogation of jurisdiction, Article 24(4) still applies, because Article 6(1) rules that Article 24 is also applicable if the jurisdiction for patent infringement proceedings is determined by national law (“subject to (...) Article(s) 24”).<sup>874</sup>

#### **2.4.2.3.2 Infringement of a European patent**

A second variation to the scenario dealt with in the *GAT* case consists in the following constellation: The defendant is domiciled in an EU Member State, but the patent being subject to an infringement proceeding is not a national patent, but a European patent. The question arises if the ECJ would then have decided in the same way as it did in *GAT*. In this respect, I shall have a closer look on the argumentation pursued by the ECJ in its *GAT* decision. The ECJ pointed out that those courts shall be competent which are closely linked to the proceedings in fact and law.<sup>875</sup> As one main item of argumentation for the exclusive jurisdiction of national courts in proceedings concerned with the registration or validity of patents, the Court stressed:

---

<sup>874</sup> HR 30 November 2007, C02/228HR and C02/280HR, *Roche Nederland BV (Netherlands) and Others v Dr. F.J. Primus and Dr. M.D. Goldenberg*, NJ 2008, 77 – *Roche Nederland*, cf. Lundstedt (2008)77(2) NIR 122, at p. 126; Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015), p. 34.

<sup>875</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 21 – *GAT*.

“That exclusive jurisdiction is also justified by the fact that the issue of patents necessitates the involvement of the national administrative authorities.”<sup>876</sup>

It might be argued that this idea does not apply in the case of European patents which are granted by the European Patent Office (EPO), being situated in Munich (place of the register) and The Hague, while no national authority has been involved in their grant.<sup>877</sup> However, it should be kept in mind that after the grant of a European patent, the patent will be also registered in the national registers.

Additionally, it is to be mentioned that national patents and European patents, i. e. bundles of national patents, are equalised as to their effect and treatment by Articles 2 and 64 of the European Patent Convention (EPC). Article 2(2) of the EPC states:

#### **Article 2 of the EPC**

(2) The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless otherwise provided in this Convention.

Additionally, Article 64(1) EPC provides:

#### **Article 64 of the EPC**

(1) A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date of publication of the mention of its grant, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

As to the treatment of infringement of such European patents, Article 64(3) EPC completes:

#### **Article 64 of the EPC**

(3) Any infringement of a European patent shall be dealt with by national law.

Besides its argumentation of exclusive jurisdiction due to a close link to the proceedings in fact and law, the ECJ also stressed the importance of the position of Article 16(4) of the Brussels Convention within the scheme of the Brussels Convention (and the same goes for Article 24(4) of the Brussels Ibis Regulation within the scheme of the Brussels Ibis Regulation), stating:

“In the light of the position of Article 16(4) [of the Brussels Convention] within the scheme of the Convention and the objective pursued, the view must be taken that the exclusive jurisdiction provided for by that provision should apply whatever the form of proceedings in which the issue of a patent’s

---

<sup>876</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 23 – *GAT*.

<sup>877</sup> *Kur* (2006)37(7) IIC 844, at p. 848.

validity is raised, be it by way of an action or a plea in objection, at the time the case is brought or at a later stage in the proceedings [content in brackets added].”<sup>878</sup>

This latter idea, which was developed by the ECJ in the course of the judgment, applies both to national patents and European patents. As a consequence, the *GAT* decision is also relevant for European patents.

#### **2.4.2.3.3 Infringement of a patent granted by a third State, or by the EPO for such a State**

If an infringement proceeding is initiated against the defendant before the court of a Member State having jurisdiction according to Article 4(1) (if the defendant is domiciled in the Member State where the court is situated), Article 6(2) (if the defendant is domiciled in a non-Member State) or according to Article 25 or Article 26 (the two latter provisions being applicable independently from the domicile), the crucial question is whether Article 24(4) is applicable.

First, it is to be borne in mind that Article 24 is applicable regardless of the jurisdiction for patent infringement proceedings being determined by national law. Therefore the fact that the Brussels Ibis Regulation does not serve itself as a source of jurisdiction does not hinder or even exclude the application of Article 24(4).

Under the Brussels I Regulation, it has been put forth that the Brussels I Regulation (and the same position might now also be taken as to the Brussels Ibis Regulation) is not applicable, but “that national basis of jurisdiction (should) apply to the issue whether a court has jurisdiction in cases involving a patent registered outside the European Judicial Area.”<sup>879</sup> However, this conception misconceives that, according to the fundamental provision of Article 2(1) of the Brussels I Regulation (which is now Article 4(1) of the Brussels Ibis Regulation), it is the domicile of the defendant which is to be considered the decisive factor for the applicability of the Brussels I Regulation (and the same goes now with regard to the Brussels Ibis Regulation). The fact of where a patent has been registered is not relevant for *this* question.

Having clarified that the application of Article 24(4) does not have to be denied for structural reasons, the probably most important problem consists in the wording of Article 24(4) which allows the *direct* application of this provision only in the case that a patent has been granted in or for a *Member State*:

#### **Article 24 of the Brussels Ibis Regulation**

The following courts of a Member State shall have exclusive jurisdiction, regardless of domicile of the parties:

(...)

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, (...), the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.

---

<sup>878</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 25 – *GAT*.

<sup>879</sup> Pertegás Sender 2002, para. 4.33.

(...).

The question of whether, respectively in which way Article 24(4) can be applied with regard to the other constellations indicated above is one of the main problems which have been discussed both in literature and case-law before the *GAT* decision – and are continuously being discussed after it. Several approaches have been proposed which shall be subject to a closer analysis in the following paragraphs.<sup>880</sup>

#### 2.4.2.3.3.1 Conception 1: Exhaustive regime of the Brussels Ibis Regulation

Based on the wording of Article 24 which expressly refers to the courts of *Member States* in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place, one could argue that, where the Brussels Ibis Regulation is affected, exclusive jurisdiction can only be derived from the rules of that Regulation. This would mean to allot the Brussels Ibis Regulation not only a binding, but also an exhaustive and concluding scope of application. As a consequence, jurisdiction granted by the Brussels Ibis Regulation would have to be accepted and respected, and must not be influenced by (a defence granted by) national (procedural) law.

When discussing the relationship between the Brussels Ibis Regulation and rules of national procedural law, the decision of the ECJ in *Owusu* must be taken into consideration which was made pursuant to a reference for a preliminary ruling by the English *Court of Appeal*.<sup>881</sup> This decision was based on the following facts: A defendant domiciled in England was sued in the English courts, under Article 2 of the Brussels Convention (Article 4 of the Brussels Ibis Regulation), in connection with a tort committed in Jamaica. On the basis of the doctrine of *forum non conveniens*<sup>882</sup>, the defendant sought a stay of the proceedings putting forward that the courts of Jamaica were the most appropriate forum. The ECJ denied such a stay and emphasised that a Contracting State of the Brussels Convention may not apply the doctrine of *forum non conveniens*:

“(...) the Brussels Convention precludes a court of a Contracting State from declining the jurisdiction conferred on it by Article 2 of that convention on the ground that a court of a non-Contracting State would be a more appropriate forum for the trial of the action even if the jurisdiction of no other Contracting State is in issue or the proceedings have no connecting factors to any other Contracting State.”<sup>883</sup>

---

<sup>880</sup> The discussion of the applicability of Article 24(4) of the Brussels Ibis Regulation in the case where a patent has been granted by or for the territory of a third State has already been led under Article 16(4) of the Brussels Convention and Article 22(4) of the Brussels I Regulation. Again, I would like to make clear that for reasons of a better readability, I shall only refer to Article 24(4) of the Brussels Ibis Regulation when discussing different arguments and opinions, and only mention Article 16(4) of the Brussels Convention respectively Article 22(4) of the Brussels I Regulation where this seems necessary for a clear and correct presentation.

<sup>881</sup> ECJ 1 March 2005, C-281/02, *Andrew Owusu v N.B. Jackson and Others*, [2005] ECR I-01383 – *Owusu*.

<sup>882</sup> According to the doctrine of *forum non conveniens*, a court has discretionary power to stay an action where the court is satisfied that there is some other available forum, having jurisdiction, which is the appropriate forum for trial of the action, i.e. in which the case may be tried more suitably for the interests of all the parties and the ends of justice, cf. House of Lords 19 November 1986, *Spiliada Maritime Corporation v Cansulex Ltd*, [1986] 3 W.L.R. 972, [1987] A.C. 460 – *Spiliada*; cf. also Fawcett & Carruthers 2008 (Cheshire, North & Fawcett), pp. 426-443.

<sup>883</sup> ECJ 1 March 2005, C-281/02, *Andrew Owusu v N.B. Jackson and Others*, [2005] ECR I-01383, para. 46 – *Owusu*.

In the light of this decision one might argue that a court of a Member State before which patent infringement proceedings have been initiated would not be entitled to decline jurisdiction, according to its national law, for the sole reason that a court of a non-Member State demands exclusive jurisdiction where the defence of invalidity of the patent has been raised.

However, a closer analysis of the *Owusu* decision reveals that its scope was explicitly limited. The ECJ addressed only the issue of staying proceedings on *forum non conveniens* grounds in cases *subject to Article 2 of the Brussels Convention* (Article 4 of the Brussels Ibis Regulation).<sup>884</sup> As to the further question raised by the referring English *Court of Appeal* of whether the application of *forum non conveniens* was ruled out in *all* circumstances, the ECJ left open if a different result might be possible, and national law preserved, in cases involving a different basis of jurisdiction, and (importantly) a different ground for declining to exercise jurisdiction,<sup>885</sup> because of the hypothetical nature of that question which was not relevant in the concrete case. In light of this, the ECJ held:

“Thus, the justification for a reference for a preliminary ruling is not that it enables advisory opinions on general or hypothetical questions to be delivered but rather that it is necessary for the effective resolution of a dispute (...).”<sup>886</sup>

It is to be underlined that the ECJ explicitly understood the further question as to concern

“(...) cases where there were identical or related proceedings pending before a court of a non-Contracting State, a convention granting jurisdiction to such a court or a connection with that State of the same type as those referred to in Article 16 of the Brussels Convention.”<sup>887</sup>

With regard to this second question, it seems to go too far to construe that the silence of the ECJ as such contains a further meaning, because the court simply *could not* answer that question.<sup>888</sup> It is therefore interesting and necessary to subject the *Owusu* decision to a further general analysis.

Remarkably, the ECJ essentially founded its reasoning on general considerations when researching whether the *forum non conveniens* doctrine is compatible with the Brussels Convention (Brussels Ibis Regulation).

On the one hand, the ECJ underlined the importance of legal certainty, declaring:

“Respect for the principle of legal certainty, which is one of the objectives of the Brussels Convention (...) would not be fully guaranteed if the court having jurisdiction under the Convention had to be allowed to apply the *forum non conveniens* doctrine.”<sup>889</sup>

As to the constellation of patent infringement proceedings where the invoked court would decline jurisdiction in favour of a court in a non-Member State, the decision of the first court to act in this way would also be determined by its *discretion* which would be contrary to legal

---

<sup>884</sup> Fentiman 2008, p. 165.

<sup>885</sup> Fentiman 2008, p. 165.

<sup>886</sup> ECJ 1 March 2005, C-281/02, Andrew Owusu v N.B. Jackson and Others, [2005] ECR I-01383, para. 50 – *Owusu*.

<sup>887</sup> ECJ 1 March 2005, C-281/02, Andrew Owusu v N.B. Jackson and Others, [2005] ECR I-01383, para. 48 – *Owusu*.

<sup>888</sup> Schauwecker 2009, p. 235.

<sup>889</sup> ECJ 1 March 2005, C-281/02, Andrew Owusu v N.B. Jackson and Others, [2005] ECR I-01383, para. 38 – *Owusu*.

certainty. Furthermore, the consequences of a defence of invalidity for the jurisdiction of a court before which infringement proceedings have been initiated differ between the Member States as to patents granted in and for third States.<sup>890</sup>

Besides, the ECJ pointed out the importance of the legal protection of persons domiciled in the Community (respectively in the Union according to the wording used in the Brussels Ibis Regulation) which is relevant in the constellation in question, too:

“The legal protection of persons established in the Community would also be undermined. First, a defendant, who is generally better placed to conduct his defence before the courts of his domicile, would not be able, in circumstances such as those of the main proceedings, reasonably to foresee before which other court he may be sued. Second, where a plea is raised on the basis that a foreign court is a more appropriate forum to try the action, it is for the claimant to establish that he will not be able to obtain justice before that foreign court or, if the court seised decides to allow the plea, that the foreign court has in fact no jurisdiction to try the action or that the claimant does not, in practice, have access to effective justice before that court, irrespective of the cost entailed by the bringing of a fresh action before a court of another State and the prolongation of the procedural time-limits.”<sup>891</sup>

Another rather general aspect emphasised by the ECJ is the necessity to guarantee a uniform application of rules of jurisdiction:

“Moreover, allowing *forum non conveniens* in the context of the Brussels Convention would be likely to affect the uniform application of the rules of jurisdiction contained therein in so far as that doctrine is recognised only in a limited number of Contracting States, whereas the objective of the Brussels Convention is precisely to lay down common rules to the exclusion of derogating national rules.”<sup>892</sup>

If – and only if – the general considerations employed in *Owusu* also concerned the constellation to be discussed here, one might conclude that national (procedural) law must never be applied in the event that the Brussels Ibis Regulation contains any rules such as Article 24(4) in the constellation concerned. Consequently, this interpretation of Article 24(4) would be clearly in line with the *Owusu* decision.<sup>893</sup> It would guarantee that the Brussels Ibis Regulation exclusively rules jurisdiction. Furthermore, a uniform interpretation and application of the Brussels Ibis Regulation between the Member States would be ensured which would also create and ensure legal certainty. Additionally, such an interpretation of Article 24(4) would conduce to legal protection of persons domiciled in the EU due to the obligation of Member States courts to exert jurisdiction and to respect the rules of recognition and enforcement.

However, the crucial question is the following: Is the constellation which was decided in *Owusu* actually sufficiently comparable to the constellation under research here? On the one hand, one might be tempted to agree based on the reasoning that, if patent proceedings are dismissed due to an exclusive jurisdiction in another State, this decision is also based on considerations of *forum non conveniens*.<sup>894</sup> The only difference could be considered the fact of exclusive jurisdiction becoming relevant in the patent cases.<sup>895</sup> One might argue that the ECJ, in *Owusu*, merely intended to restrict the general possibility of a *forum non conveniens*

---

<sup>890</sup> Schauwecker 2009, p. 235.

<sup>891</sup> ECJ 1 March 2005, C-281/02, *Andrew Owusu v N.B. Jackson and Others*, [2005] ECR I-01383, para. 42 – *Owusu*.

<sup>892</sup> ECJ 1 March 2005, C-281/02, *Andrew Owusu v N.B. Jackson and Others*, [2005] ECR I-01383, para. 43 – *Owusu*.

<sup>893</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 194.

<sup>894</sup> Fentiman 2008, p. 176.

<sup>895</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 192; Fentiman 2008, p. 176.

defence.<sup>896</sup> Thus, a dismissal of an action in certain, defined cases might be admitted.<sup>897</sup> However, this only means to shift the problem at another level: Which are these cases? How can they be defined? And according to which criteria? Who is entitled to define them?

Besides, further doubts remain. When the ECJ held that

“(i)t must be observed, first, that Article 2 of the Brussels Convention is mandatory in nature and that, according to its terms, there can be no derogation from the principle it lays down except in the cases expressly provided for by the Convention (...)”<sup>898</sup>

it is to be pointed out that this idea cannot *per se* apply to the constellations in question here. For this argument being applicable, it would be rather necessary to allocate Articles 24(4) and 27 an concluding character as to the dismissal of an action due to lack of jurisdiction, i. e. to allocate Articles 24(4) and 27 the additional content that jurisdiction existing according to the Brussels Ibis Regulation must be exerted in all cases which are not covered. However, doing so would not respect the fact that the Brussels Ibis Regulation is restricted to the “*inneregemeinschaftlichen Rechtsverkehr*”. There is no justification respectively no legal basis for the Brussels Ibis Regulation to allocate jurisdiction to courts of third States.<sup>899</sup>

Other doubts as to such an interpretation of Article 24(4) ground on a comparison with other case-law of the ECJ. I shall continue my research with an analysis of the judgment of the ECJ in *Coreck Maritime*<sup>900</sup> which was delivered before *Owusu*, and strangely ignored by the ECJ in the latter case.<sup>901</sup> This analysis will reveal that the situation is not as clear as it might seem in the light of an isolated evaluation of the *Owusu* judgment.

In *Coreck Maritime*, the ECJ had to decide on four questions concerning the interpretation of Article 17(1) of the Brussels Convention, on the occasion of a reference for a preliminary ruling by the *Hoge Raad der Nederlanden*, Netherlands. Those questions were raised in proceedings concerning the validity of a jurisdiction clause between Coreck Maritime GmbH, a company incorporated according to German law established in Hamburg, Germany, the issuer of the bills of lading, and Handelsveem BV, the holder in due course of the bills of lading, V. Berg and Sons Ltd and Man Producten Rotterdam BV, the owners of the cargo under the bills of lading, and The People's Insurance Company of China, the insurer of that cargo. As to the question of which law should govern the validity of a third-state jurisdiction agreement to the exclusive jurisdiction of a non-Member State, the ECJ decided in favour of the law applicable under the conflicts rules of the forum:

“(...) Article 17 of the [Brussels] Convention does not apply to clauses designating a court in a third country. A court situated in a Contracting State must, if it is seised notwithstanding such a jurisdiction clause, assess the validity of the clause according to the applicable law, including conflict of laws rules, where it sits (...) [content in brackets added].”<sup>902</sup>

---

<sup>896</sup> Fentiman 2008, p. 165.

<sup>897</sup> Schauwecker 2009, p. 238.

<sup>898</sup> ECJ 1 March 2005, C-281/02, *Andrew Owusu v N.B. Jackson and Others*, [2005] ECR I-01383, para. 37 – *Owusu*.

<sup>899</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 192; Fentiman 2008, pp. 166-167.

<sup>900</sup> ECJ 9 November 2000, C-387/98, *Coreck Maritime GmbH v Handelsveem BV and Others*, [2000] ECR I-09337 – *Coreck Maritime*.

<sup>901</sup> This issue is distinctly emphasised and criticised by *Fentiman*, cf. Fentiman 2008, p. 174.

<sup>902</sup> ECJ 9 November 2000, C-387/98, *Coreck Maritime GmbH v Handelsveem BV and Others*, [2000] ECR I-09337, para. 19 – *Coreck Maritime*.



In the course of its reasoning, the ECJ explicitly referred to the *Schlosser Report* on the Brussels Convention<sup>903</sup>.<sup>904</sup> This report clearly states:

“In cases where parties agree to bring their disputes before the courts of a State which is not a party to the 1968 Convention there is obviously nothing in the 1968 Convention to prevent such courts from declaring themselves competent, if *their law* recognizes the validity of such an agreement. (...) If a court within the Community is applied to despite such an agreement, its decision on the validity of the agreement depriving it of jurisdiction must be taken in accordance with *its own lex fori*. In so far as the *local rules of conflict of laws* support the authority of provisions of foreign law, the latter will apply (...).”<sup>905</sup>

The rules of private international law as to jurisdiction of the forum thus being decisive in this constellation, the report clearly provides:

“(...) If, when these tests are applied, the agreement is found to be *invalid*, then the jurisdictional provisions of the 1968 Convention become applicable.”<sup>906</sup>

However, *a contrario*, this inescapably implies that a court must have the power to decline jurisdiction if such an agreement is *valid*, because then the European regime is inapplicable, allowing a court to decline jurisdiction under national law. *Coreck Maritime* thus suggests that a national court might in certain cases decline to exercise jurisdiction derived from the Regulation.<sup>907</sup>

In this light – although *Coreck Maritime* did not directly concern Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) – at least severe doubts seem justified as to an exhaustive understanding of the Brussels Ibis Regulation according to which (a defence provided by) national procedural law would principally not be applicable where the Brussels Ibis Regulation contains any applicable rule of jurisdiction.

It has been rightly underlined that such a conception would produce “results which could hardly be justified” (“*kaum zu rechtfertigende Ergebnisse*”)<sup>908</sup> where parties had agreed on an exclusive prorogation of jurisdiction in favour of a court or courts of a third State – a situation similar to the situation of Article 25 as to Member States – but at least the defendant is domiciled in a Member State; then Article 4 would give jurisdiction to the courts of the State of domicile of the defendant, Article 25 not conferring exclusive character to such jurisdiction due to its wording which only refers to courts of Member States. And Article 4(1) provides that its restriction is merely possible “subject to this Regulation”, the latter not containing any specific rules as to the prorogation of jurisdiction in favour of courts of third States.<sup>909</sup> A

---

<sup>903</sup> Schlosser Report, OJ C59 of 5 March 1979, pp. 71-151, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1979\\_059\\_R\\_0071\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1979_059_R_0071_01&rid=1)> (lastly accessed on 1 June 2015).

<sup>904</sup> ECJ 9 November 2000, C-387/98, *Coreck Maritime GmbH v Handelsveem BV and Others*, [2000] ECR I-09337, para. 19 – *Coreck Maritime*.

<sup>905</sup> Schlosser Report, OJ C59 of 5 March 1979, pp. 71-151, para. 176, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1979\\_059\\_R\\_0071\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1979_059_R_0071_01&rid=1)> (lastly accessed on 1 June 2015).

<sup>906</sup> Schlosser Report, OJ C59 of 5 March 1979, pp. 71-151, para. 176, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1979\\_059\\_R\\_0071\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1979_059_R_0071_01&rid=1)> (lastly accessed on 1 June 2015).

<sup>907</sup> Fentiman 2008, p. 174.

<sup>908</sup> Heinze & Dutta (2005)25(3) IPRax 224, at p. 227.

<sup>909</sup> This scenario has been impressively depicted by *Heinze/Dutta*, cf. Heinze & Dutta (2005)25(3) IPRax 224, at p. 227.

Member State court would thus be obliged to decide on a patent infringement case brought before it although parties might have agreed on the jurisdiction of a court of a third State.<sup>910</sup>

Additionally, it is to be pointed out that, according to the conception in question, a Member State court could neither dismiss the action, nor would it be allowed to stay the proceedings, because the Brussels Ibis Regulation exhaustively rules the stay of proceedings<sup>911</sup> and, moreover, a stay would partly limit the jurisdiction, as a court of a third State would then be competent to decide on the validity question. With reference to the *Owusu* judgment, this would not only be contrary to the principle of legal certainty by guaranteeing a binding order of jurisdiction without discretionary consideration<sup>912</sup>, but would also disregard the principle of legal protection of persons domiciled in the Community. The deciding court would be forced to decide by way of an *inter partes* decision or would have to presume – against the defendant – the validity of the patent. As a consequence, the legal situation would be completely different in comparison with Member State patents where courts are not allowed to examine their validity by way of an *inter partes* decision according to the *GAT* decision.<sup>913</sup>

It would actually appear hard to accept that the Brussels Ibis Regulation intends to compromise the interests of persons within the EU in such a way.<sup>914</sup> Actually, the Brussels Ibis Regulation *cannot* contain a rule which explicitly imposes on third States to exert an exclusive jurisdiction. That “legal impossibility of enacting a rule that the courts of a non-Member State have jurisdiction”<sup>915</sup> may not be misunderstood in such a way that this aspect has been *implicitly* ruled.<sup>916</sup> For this would be clearly beyond the competences of the European legislator.

Consequently, the conception of an exhaustive regime of the Brussels Ibis Regulation implying that national (procedural) law can in no way have effect if the Brussels Ibis Regulation provides a respective rule – even if it is not applicable in the specific case – is to be rejected.

#### **2.4.2.3.3.2 Conception 2: Regulatory sovereignty of national law**

In view of the insight that the conception of an exhaustive regime of the Brussels Ibis Regulation as described above does not offer an appropriate solution, a possible alternative could be to fall back on national law as has been carved out impressively by *Fentiman*: “Or does it suggest that such cases are the province of national law?”<sup>917</sup> Following this approach, one could think of determining the effects of a defence of nullity of a patent granted in or for a third State solely pursuant to the rules of national (procedural) law.

In this respect, it has been suggested that the domicile of the defendant or places of special jurisdiction do not create a sufficient link to the forum in the Member State, so that national law must be applied.<sup>918</sup> However, against the background of *Owusu*, it must be stated that, even if a dismissal of an action was admitted in certain, defined cases, it would not be

---

<sup>910</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 194.

<sup>911</sup> Cf. Article 29 et seq.

<sup>912</sup> This aspect is emphasised by Schauwecker, cf. Schauwecker (2009)58(3) GRUR Int. 187, at p. 194.

<sup>913</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 194.

<sup>914</sup> Schauwecker 2009, p. 242.

<sup>915</sup> Briggs & Rees 2009, para. 2.259.

<sup>916</sup> Schauwecker 2009, p. 242.

<sup>917</sup> Fentiman 2008, p. 165.

<sup>918</sup> Cf. Layton & Mercer 2004, para. 19.010.

defensible to confer national law the competence to decide if jurisdiction according to the Brussels Ibis Regulation could be denied by sovereign national law. Independently from the outcome of the question of whether *Owusu* is fully applicable to the constellation under research, it seems obvious anyway at least that it cannot be completely ignored. So a reference to national law would seem only justified if and inasmuch as this would create a smaller opposition to the fundamental principles of the Brussels Ibis Regulation and their essential goals of legal certainty and unique application than the application of the doctrine of *forum non conveniens* which has been subject to the *Owusu* decision.<sup>919</sup>

#### **2.4.2.3.3.3 Conception 3: Reflexive application of Article 24(4)**

Having denied an exhaustive effect of the Brussels Ibis Regulation, while also refusing regulatory sovereignty of national law in cases where jurisdiction is granted by the Brussels Ibis Regulation, the question must be posed if a solution may be found in between those positions.

Actually two major approaches have been elaborated and developed in this respect. It is to be noticed that the dividing lines between these two approaches are rather diffuse. Moreover, not all supporters of what is being characterised as a “*reflexive application* of Article 24(4)” in this thesis actually distinctly differentiate between these two theories.

On the one hand, it is conceivable to apply Article 24 by way of an analogy in cases where a patent is granted in or for a third State. This approach is commonly referred to as a *direct reflexive application*. On the other hand, one could also apply national law in these cases, but import principles of the Brussels Ibis Regulation into the respective national (procedural) laws (*indirect reflexive application*).

With regard to both approaches, it is to be borne in mind that such an extended interpretation of Article 24 is anything but self-evident and needs to be founded on good reasons.<sup>920</sup> It must be founded on a balancing of the concerned interests relevant in the field of PIL.<sup>921</sup> Additionally, it is to be borne in mind that refusing jurisdiction to the courts of a Member State which, in principle, have jurisdiction according to Article 4, can only be justified if the Brussels Ibis Regulation does not provide any solution being more appropriate.<sup>922</sup>

##### **2.4.2.3.3.3.1 Indirect reflexive application of Article 24(4)**

The theory of the *effet réflexe* was originally elaborated by *Droz* in his famous work “Compétence judiciaire et effets des jugements dans le Marché Commun” which was published in 1972. Having in mind primarily the situation of immovables, ruled in Article 16(1) of the Brussels Convention (Article 24(1) of the Brussels Ibis Regulation),<sup>923</sup> *Droz* reasoned that Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) rules that certain connecting elements are decisive to give courts exclusive

<sup>919</sup> Schauwecker 2009, pp. 238, 239.

<sup>920</sup> Wenner 2002, p. 1022.

<sup>921</sup> Wenner 2002, p. 1022 (after an analysis of the concerned interests, *Wenner* draws the conclusion that the parties’ interests should be considered decisive, cf. Wenner 2002, p. 1025).

<sup>922</sup> Teixeira de Sousa (2003)23(4) IPRax 320, at p. 322.

<sup>923</sup> Although *Droz* refers to Article 16(1) of the Brussels Convention (Article 24(1) of the Brussels Ibis Regulation), his argumentation also applies to Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) and can therefore be utilised here.

jurisdiction, and that this does not change in the situation that these courts are situated in a third State. He impressively stated:

“En effet, les raisons qui ont conduit à l'énumération du catalogue de l'article 16 [de la Convention de Bruxelles] subsistent dans le cas où les éléments de rattachement sont situés hors de la Communauté. Si le droit commun français veut que les juges français soient incompétents pour trancher un litige relatif à un immeuble situé à l'étranger, les raisons qui militent en France pour cette solution conservent leur valeur: les juges français ne seront pas mieux armés pour trancher des questions ayant trait par exemple à une immatriculation sur un registre foncier autrichien. Il en est de même lorsqu'on estime qu'un juge français n'a pas à intervenir pour prononcer la mainlevée d'une saisie-arrêt effectuée à l'étranger.”<sup>924</sup>

(“Actually, the reasons which have led to the enumeration of the catalogue of Article 16 [of the Brussels Convention] persist in the case that the connecting elements are situated outside the Community. If French law rules that French courts do not have jurisdiction to solve a case concerning immovable property being situated abroad, the reasons which strike for this solution in France keep their validity: French courts will not be better armed for solving questions dealing with, for instance, a registration in an Austrian land register. The same is true when considering that a French court shall not intervene to pronounce the dissolution of a seizure effected abroad.”)<sup>925</sup>

In a later publication, appearing in 1990, *Droz* reformulated:

“Si donc un juge français est radicalement incompétent pour juger d'un immeuble ou d'un brevet allemand, en raison de la spécificité et de la particularité du droit réel ou du droit des brevets allemands, on ne voit pas pourquoi il serait mieux armé pour juger d'un bail rural argentin ou de la validité d'un brevet japonais!”<sup>926</sup>

(“Consequently, if a French court does not have jurisdiction to decide on German immovables or on a German patent, due to the originality and the peculiarity of German real property law or patent law, there is no reason why the court would be better armed for deciding on an Argentinian lease of land or on the validity of a Japanese patent.”)<sup>927</sup>

As to the legal nature of the “*effet réflexe*”, *Droz* qualified the reflexive application as a specific case of application of the doctrine of *forum non conveniens*:

“Cette prise en considération indirecte de l'article 16 constitue en fait un cas d'application exceptionnelle de la théorie du *forum non conveniens* et il n'est pas étonnant que notre position ait trouvé écho en pays de Common Law.”<sup>928</sup>

(“This indirect consideration of Article 16 [of the Brussels Convention] actually constitutes a specific case of application of the theory of *forum non conveniens* and it is not surprising that our position has been echoed in common law countries [content in brackets added].”)<sup>929</sup>

According to *Droz's* conception, national laws should thus have the *possibility* to decide *whether* to apply Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) vis-à-vis third States.<sup>930</sup> However, while this approach might have been possible under the Brussels Convention (although such a possibility for the Contracting States actually would not promote legal certainty and predictability), it has at the latest become obsolete with the creation of the Brussels I Regulation, and continues to be under the Brussels Ibis Regulation, because the Brussels Ibis Regulation (respectively its predecessor) is *directly*

---

<sup>924</sup> Droz 1972, para. 167.

<sup>925</sup> Translation provided by the author of this thesis.

<sup>926</sup> Droz (1990)79(1) Rev. crit. DIP 1, at p. 14.

<sup>927</sup> Translation provided by the author of this thesis.

<sup>928</sup> Droz (1990)79(1) Rev. crit. DIP 1, at p. 15.

<sup>929</sup> Translation provided by the author of this thesis.

<sup>930</sup> Droz 1972, para. 168.

*applicable* in the Member States. Further, it has to be applied in an *identical* way by the Member States, its content being subject to an autonomous interpretation.<sup>931</sup>

With regard to Article 16 of the Brussels Convention, it could, in theory, be put forth that treaty law takes preference over national law and, consequently, an extensive application of Article 16 of the Brussels Convention as such vis-à-vis third States – instead of applying rules of national law – would be preferable. However, proponents of an indirect reflexive application of Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) have put forth that this objection is rather theoretical and *Droz's* approach would only construe the Brussels Convention in a reasonable way.<sup>932</sup> Arguing in favour of *Droz's* idea of an indirect reflexive effect of Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation), it has also been put forward that, in the event that the defendant is not domiciled within the EU, national private international law is decisive anyway, by virtue of the express provision of Article 4(1) of the Brussels Convention (Article 6(1) of the Brussels Ibis Regulation); then it could be considered reasonable to reach the same result in the case of a defendant domiciled within the EU.<sup>933</sup>

A major merit of the approach of an indirect reflexive application of Article 24(4) would certainly be that it would be in line with the decision of the ECJ in *Coreck Maritime*, because (nominally) national law would be applicable. Moreover, the approach would conform to the *Owusu* decision of the ECJ, because courts of Member States would not decline jurisdiction conferred by the Brussels Ibis Regulation according to national law for the mere reason that another court would be a more convenient forum. For national (procedural) law would only be applicable if it effected *identical or at least almost identical* legal consequences as Article 24(4),<sup>934</sup> i.e. if it corresponded to “evaluations immanent to the Brussels Ibis Regulation” (“*verordnungsimmanente Wertungen*”) founding on the common ground that the Brussels Ibis Regulation provides the claimant, in certain circumstances, with one forum only, excluding all other competing jurisdictions.<sup>935</sup>

However, while the latter consideration definitely bears some theoretical charm, it is highly doubtful how it could be practically realised. According to the idea that principles/evaluations of the Brussels Ibis Regulation would have to be respected when applying national (procedural) law, it would be necessary to determine which degree of consistency between national (procedural) law and the Brussels Ibis Regulation is required to assume that such “evaluations immanent to the Brussels Ibis Regulation”<sup>936</sup> are preserved. Following this reasoning, it has been proposed to differentiate between six degrees of consistency: Consistency in terms; consistency in specific objectives, provided that national law is non-discretionary; consistency in specific objectives, whether or not the rule of national law is discretionary; consistency in general objectives, whether or not the rule of national law is discretionary; consistency in general objectives, provided that national law is non-discretionary; consistency in design.<sup>937</sup> At this point, the disadvantages of the discussed approach become obvious: First, such a categorisation appears arbitrary and therefore does

---

<sup>931</sup> ECJ 15 November 1983, C-288/82, Ferdinand M. J. J. Duijnste v Lodewijk Goderbauer, [1983] ECR 03663, paras. 18-19 – *Duijnste*.

<sup>932</sup> J.P. Verheul (case note) Rb. Amsterdam 13 May 1975, Eurotex Italia (Italy) v C. Rensel (Netherlands), (1975)22 N.I.L.R. 209.

<sup>933</sup> As to Article 16 of the Brussels Convention: J.P. Verheul (case note) Rb. Amsterdam 13 May 1975, Eurotex Italia (Italy) v C. Rensel (Netherlands), (1975)22 N.I.L.R. 209.

<sup>934</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 193.

<sup>935</sup> As to the Brussels I Regulation: Heinze & Dutta (2005)25(3) IPRax 224, at p. 227.

<sup>936</sup> As to the Brussels I Regulation: Heinze & Dutta (2005)25(3) IPRax 224, at p. 227.

<sup>937</sup> Fentiman 2008, p. 171-172.

not promote legal certainty. Besides, even if it was possible to define clear categories, it would be rather difficult to determine in which category a specific case falls. In light of this, the approach discussed obviously offers no pragmatic solution. Moreover, differing interpretations in the Member States would be provoked, with the potential (but probable) effect of an inconsistent application of the Brussels Ibis Regulation in the Member States due to the fact that the rules of national law of the Member States vary from each other.<sup>938</sup> The ECJ has clearly stated that this situation should be avoided.<sup>939</sup> Furthermore, one might at least theoretically think of the legal situation that a State does not provide in its legal order a rule (respectively a legal consequence) comparable with Article 24(4). Then the danger of a “*Normenmangel*” (i.e. a legal “gap” due to the absence of a provision) would exist because then the national law could not be applied, while Article 24(4) would not be applicable either.<sup>940</sup>

Last but not least it is probable that the ECJ – if the court had to decide at this very moment – would choose a solution which strives for taking into account both its *Coreck Maritime* decision and its *Owusu* decision. As has been mentioned above,<sup>941</sup> the ECJ ignored *Coreck Maritime* when deciding *Owusu*. It is conceivable that the ECJ simply lost sight of its decision in *Coreck Maritime* or that the court did not recognise potential parallels between the two cases. But it is also possible that the ECJ *deliberately* did not take into account *Coreck Maritime* when deciding *Owusu* because the court was of the opinion that no such parallels existed. Given the latter hypothesis being true, one would have to conclude that only *Owusu* was relevant in the constellation under discussion, which implies that national (procedural) law would not be applicable at all.<sup>942</sup>

#### 2.4.2.3.3.2 Direct reflexive application of Article 24(4)

Having researched the approach of an indirect reflexive application of Article 24(4) in the sense that the evaluations of this provisions must be reflected in national (procedural) provisions in order to make them being applicable, I shall now treat the variant of a direct reflexive application of Article 24(4) in the event of patent infringement proceedings as to patents granted in or for third States, when the defence of invalidity of the patent has been raised. According to this approach, the defence of invalidity would have the same effect concerning patents granted in an EU Member State and in a non-Member State.

To begin the analysis of the arguments which militate for and against the theory of a direct reflexive application of Article 24(4), it is to be mentioned that this issue is probably one of the most controversial subjects with regard to Article 24(4). First of all, it is to be underlined that the “advantage” of a (direct) reflexive application of Article 24(4) in case that a patent has been granted by or in another State, which might be seen in the fact that the law of such third States would not have to be determined by Member States courts because courts of such third States then have exclusive jurisdiction, should be neglected, because this argument would apply in all cases where different legal systems are involved and would therefore mean the end of (the need for) private international law.<sup>943</sup>

<sup>938</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 193.

<sup>939</sup> This aspect is explicitly emphasised by *Heinze/Dutta*, cf. Heinze & Dutta (2005)25(3) IPRax 224, at p. 228.

<sup>940</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 193.

<sup>941</sup> Fentiman 2008, p. 174.

<sup>942</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 193.

<sup>943</sup> Geimer 2015, paras. 930-931.

As an argument against the concept of a direct application of Article 24(4) of the Brussels Ibis Regulation (respectively its predecessors), it may be referred to the clear wording of both Article 24(4) of the Brussels Ibis Regulation<sup>944</sup> and Article 27 of the Brussels Ibis Regulation<sup>945</sup> (respectively the predecessors of these provisions). Both provisions explicitly use the terms “courts of the *Member State*” (Article 24) respectively “courts of another *Member State*” (Article 27). It is to be underlined that the Brussels Ibis Regulation, as a legal act between the Member States, cannot contain a positive allocation of jurisdiction to courts of third States, because the Brussels Ibis Regulation has no power to force third States to decide on cases.<sup>946</sup> International jurisdiction of such third States is rather determined by the law applicable in and for their territory.<sup>947</sup> Thus, Article 24 merely allocates international jurisdiction to the courts of Member States, and does not contain such provisions regarding third States.<sup>948</sup>

Although the wording of Article 24 and Article 27 of the Brussels Ibis Regulation (respectively their predecessors) may be distinct, the foregoing argumentation against a direct reflexive application of Article 24(4) – being purely based on the wording of Article 24(4) – is actually not convincing. Noteworthy, this is not for the reasons that provisions of national procedural law which contain rules concerning local jurisdiction (i.e. with regard to courts within the respective State), are generally recognised to enclose also rules of international jurisdiction, and, similarly, the Brussels Convention (the same argument would apply as to the Brussels Ibis Regulation) expressly addresses Contracting States (Member States) and should however be considered to also have effect vis-à-vis third States.<sup>949</sup> The latter argumentation cannot be correct, because it would imply comparing two things which simply lack comparability, a typical comparison of “apples to oranges”: Whilst the extending interpretation from local jurisdiction to international jurisdiction concerns different *factual aspects*, an extending interpretation from Contracting States (Member States) to third States would concern different *addressees*. Additionally, it is to be noticed that a conclusion based on national attitudes respectively habits of interpretation might be relevant with regard to the interpretation of a Convention which becomes incorporated national law (if at all); however, as to the Brussels Ibis *Regulation*, it is to be noted that it must be interpreted by way of an autonomous interpretation.<sup>950</sup> The foregoing argumentation referring to the clear wording of Article 24 and Article 27 suffers from an equalisation of a *direct application* of Article 24(4) and the allocation of a *direct reflexive effect* to Article 24(4). Regarding the criticism that the construct of a reflexive effect of a legal provision generally does not exist,<sup>951</sup> meaning that Article 24(4) is simply not applicable in the case of a patent which is granted in a third State,<sup>952</sup> it is to be underlined that a direct reflexive application as understood in this context structurally constitutes an application by way of an *analogy*. In other words, the discussion is

<sup>944</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 12; with regard to Article 16 of the Brussels Convention, cf. already Piltz (1979)32(21) NJW 1071, at p. 1072 and there fn. 22; Martiny 1984, para. 183.

<sup>945</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 190; Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2c; Queirolo 2012 (Magnus & Mankowski), Art 25 Brussels I Regulation, para. 7.

<sup>946</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2b; Wenner 2002, p. 1022; this aspect is also admitted by Kropholler who still approves a reflexive application of Article 22 of the Brussels I Regulation (Article 24 of the Brussels Ibis Regulation), cf. Kropholler 1988, p. 241.

<sup>947</sup> Kropholler 1988, p. 241, while Kropholler still approves a reflexive application of Article 22.

<sup>948</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 12.

<sup>949</sup> This argumentation is pursued by Grundmann, cf. Grundmann (1985)5(5) IPRax 249, at p. 251.

<sup>950</sup> ECJ 15 November 1983, C-288/82, Ferdinand M. J. J. Duijnste v Lodewijk Goderbauer, [1983] ECR 03663, paras. 18-19 – *Duijnste*.

<sup>951</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2c.

<sup>952</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 12; Mäder 1999, p. 87.

not about applying Article 24(4) *directly* vis-à-vis third States, but by allocating Article 24(4) a *direct reflexive effect*, i.e. applying Article 24(4) by way of an *analogy*. An analogy premises the existence of a “legal gap” which was not intended by the legislator, and the existence of a comparable situation which should be ruled in the same way as the constellation being explicitly ruled. Therefore, the fact that the wording of Article 24 and Article 27 expressly refers to courts of *Member States*, cannot serve as an argument against the concept of a direct reflexive application of Article 24(4), but simply demonstrates that Article 24(4) cannot be applied directly if the patent in question has been granted in or for a third State, while an analogous application of Article 24(4) would remain possible.

Arguing against a direct reflexive application of Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) by way of a historical interpretation, recourse has been taken to the Almeida Cruz-Desantes Real-Jenard Report<sup>953</sup> and the Jenard-Möller Report<sup>954</sup>, both concerning Article 16 of the Brussels Convention. The Almeida Cruz-Desantes Real-Jenard Report, referring to the Jenard-Möller Report, actually stated:

“25.(d) As already pointed out in the Jenard-Möller Report (paragraph 54), 'Article 16(1) applies only if the property is situated in the territory of a Contracting State. The text is sufficiently explicit on this point. If the property is situated in the territory of a third State, the other provisions of the Convention apply, e.g. Article 2 if the defendant is domiciled in the territory of a Contracting State, and Article 4 if he is domiciled in the territory of a third State, etc.’”<sup>955</sup>

Admittedly, the point of view of the report as to the application of Article 16 of the Brussels Convention has also been subject to critique<sup>956</sup> as it lacks profound arguments but rather restricts itself to regard the wording without analysing its content and further meaning. Also for this reason, proponents of a direct reflexive application of Article 24(4) (respectively its predecessors) have characterised the view in the report as “bad sense and worse law”.<sup>957</sup>

Nonetheless, proponents of such a direct reflexive application have additionally referred to the following part of Opinion 1/03 of the ECJ from 7 February 2006 (Lugano):<sup>958</sup>

<sup>953</sup> Almeida Cruz/Desantes Real/Jenard Report, OJ C189 of 28 July 1990, pp. 35-56, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1990\\_189\\_R\\_0035\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1990_189_R_0035_01&rid=1)> (lastly accessed on 1 June 2015).

<sup>954</sup> Jenard/Möller Report, OJ C189 of 28 July 1990, pp. 57-121, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1990\\_189\\_R\\_0057\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1990_189_R_0057_01&rid=1)> (lastly accessed on 1 June 2015).

<sup>955</sup> Almeida Cruz/Desantes Real/Jenard Report, OJ C189 of 28 July 1990, pp. 35-56, para. 25.(d), available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1990\\_189\\_R\\_0035\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1990_189_R_0035_01&rid=1)> (lastly accessed on 1 June 2015).

<sup>956</sup> Cf. Droz (1990)79(1) Rev. crit. DIP 1, at p. 13 et seq.

<sup>957</sup> Briggs & Rees 2009, para. 2.259.

<sup>958</sup> Cf. Advocate General 18 December 2008, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, [2009] ECR I-03571, para. 86 – *Apostolides*; cf. also ECJ 28 April 2009, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, [2009] ECR I-03571, paras. 48-51 – *Apostolides* (while (merely) referring to Member States, the ECJ did not explicitly address the issue of a reflexive application of Article 22 of the Brussels I Regulation (Article 24 of the Brussels Ibis Regulation) vis-à-vis third States. However, it seems that the ECJ actually did *not* approve such a reflexive application when formulating, in para. 51: “The fact that the land is situated in the northern area may possibly have an effect on the domestic jurisdiction of the Cypriot courts, but cannot have any effect for the purposes of that regulation.”). Cf. also H.P. Meidanis (case note) ECJ 28 April 2009, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, (2009)34(6) E.L. Rev. 963, at p. 971; G. de Baere (case note) ECJ 28 April 2009, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, (2010)47(4) C.M.L. Rev. 1123, at p. 1144; Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2b (with further references there in fn. 24).



“(…) Thus, where the new Lugano Convention contains articles identical to Articles 22 and 23 of Regulation No 44/2001 and leads on that basis to selection as the appropriate forum of a court of a non-member country which is a party to that Convention, where the defendant is domiciled in a Member State, in the absence of the Convention, that latter State would be the appropriate forum, whereas under the Convention it is the non-member country.”<sup>959</sup>

Another crucial argument against the concept of a direct *effet réflexe* of Article 24(4) is the fact that the essential goal and the basis of the Brussels Ibis Regulation (as well as its predecessors) – to create legal certainty by providing for predictable places of jurisdiction, and by avoiding opposing decisions – is restricted to the Community (Union) territory.<sup>960</sup> The whole Brussels Ibis Regulation is, due to Article 81 TFEU (ex Article 65 TEC), limited to the creation of a system of jurisdiction within the Community (Union). The basis of conferring jurisdiction to other Member States courts is the mutual trust in the equivalence of Member States courts. As to the Brussels Convention, it was already underlined that its sole mission was to circumscribe jurisdictions of Contracting States from each other, not between Contracting States and third States.<sup>961</sup> Otherwise conflicts would come into existence between the Brussels Convention and such conventions on recognition and enforcement which Contracting States to the Brussels Convention and third States have agreed on deviant rules on jurisdiction. Consequently, such conventions on recognition and enforcement between single Contracting States and third States would be precluded, because the Brussels Convention at least already contained rules on jurisdiction and therefore, insofar, this aspect could only be ruled jointly by all Contracting States of the Brussels Convention. However, Article 59 of the Brussels Convention would allow for bilateral conventions on the recognition and enforcement of judgments between Contracting States and third States. This would imply that these parties can also negotiate on jurisdiction.<sup>962</sup>

Even *Droz*, a strong supporter of the *effet réflexe* of Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation), admitted:

“En effet, l’article 16 [de la Convention de Bruxelles] a pour objet essentiel d’assurer la compétence directe exclusive des tribunaux des Etats contractants et non pas de poser des règles relatives à leur incompétence. Dans les relations intercommunautaires, l’incompétence se déduit de la compétence du tribunal exclusivement désigné.”<sup>963</sup>

(“Actually, Article 16 [of the Brussels Convention] pursues the essential goal to guarantee the exclusive jurisdiction of the courts of the Contracting States, and not to deliver rules concerning their non-jurisdiction. Within intra-community relations, non-jurisdiction is deduced from the jurisdiction of the court which has exclusive jurisdiction [underscores and content in brackets added].”) <sup>964</sup>

*Droz* restated his notion in a later publication in the following way:

“(…) il est certain que l’article 16 [de la Convention de Bruxelles] ne vise expressément que les immeubles situés ou encore les brevets enregistrés dans un Etat contractant.”<sup>965</sup>

(“(…) certainly, Article 16 [of the Brussels Convention] expressly concerns only immovables situated or patents registered in a Contracting State [underscores and content in brackets added].”) <sup>966</sup>

<sup>959</sup> ECJ 7 February 2006, C-1/03 (Opinion), Request made by the Council of the European Union, [2006] ECR I-01145, para. 153.

<sup>960</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 28 – *GAT*; Fentiman 2008, p. 159.

<sup>961</sup> Basedow 1982 (Hb-IZVR), para. 126 (concerning the Brussels Convention in general).

<sup>962</sup> Basedow 1982 (Hb-IZVR), para. 126 (concerning the Brussels Convention in general).

<sup>963</sup> *Droz* 1972, para. 166.

<sup>964</sup> Translation provided by the author of this thesis.

<sup>965</sup> *Droz* (1990)79(1) Rev. crit. DIP 1, at p. 14.

Nevertheless, arguing in favour of a direct reflexive application of Article 24(4) where a patent has been granted in or for a third State, it might be argued that, even if the creation of legal certainty by providing for predictable places of jurisdiction, and by avoiding opposing decisions, was restricted to the Community (Union) territory, that would not imply that this objective could not be *extended* to third States. On the basis of this line of reasoning, one might find that Article 24(4), conferring exclusive jurisdiction, contains such a compellent allocation of jurisdiction that it should also be applied vis-à-vis third States. One might even argue that Article 24(4) does not intend to confer jurisdiction to a Member State court as such, but to a court of the State where the patent has been granted. In this respect, the Brussels Convention (and the same might be argued for the Brussels Ibis Regulation) has been considered to be not only a “core of a European civil procedural law”<sup>967</sup>, but also the basis of a European civil procedural code vis-à-vis third States.<sup>968</sup>

However, the idea of such an *extension* of jurisdiction to third States would disregard the fact that the courts of the Member State where the defendant is domiciled are not only entitled, but also obliged to grant jurisdiction (“*Justizgewährungsanspruch*”), and that the same goes for the courts of the Member States having jurisdiction in accordance with Articles 7 et seq. of the Brussels Ibis Regulation (respectively its predecessors).<sup>969</sup> The idea of this reasoning is that the claimant must not be deprived of his right to benefit from a certain head of jurisdiction under the Brussels Ibis Regulation.<sup>970</sup> As a matter of fact, obligations of a Member State towards third States arising from conventions can only be fulfilled in the framework of Article 71,<sup>971</sup> because the claimant’s “*Justizgewährungsanspruch*” and his guarantee of a venue (“*Gerichtsstand*”) which are both inherent to the Brussels Ibis Regulation, would be violated otherwise.<sup>972</sup> In view of this, a reflexive application of Article 24(4) actually seems to be in opposition to the fundamental principle of the Brussels Ibis Regulation that the exceptions to the rule of Article 4(1) (jurisdiction of the courts where the defendant has his domicile) provided in Article 7 to 26 must be interpreted in a narrow way.<sup>973</sup>

Arguing anyway in favour of a reflexive application of Article 24(4), it could be put forth, while admitting that, due to the fundamental importance of the principle of Article 4(1), other provisions ruling jurisdiction, including Article 24, must not be interpreted too broadly, that given Article 24(4) contains a compellent allocation of jurisdiction, Article 4(1) *cannot per se* overrule Article 24(4). For this would not appear justified in view of the importance of rules of exclusive jurisdiction, given that exclusive jurisdiction is merely granted in circumstances enumerated in Article 24 (besides Article 25 according to which Member States courts can be granted exclusive jurisdiction by way of a prorogation of jurisdiction).

---

<sup>966</sup> Translation provided by the author of this thesis.

<sup>967</sup> Spellenberg (1980)15(4) EuR 329, at p. 329.

<sup>968</sup> Grundmann (1985)5(5) IPRax 249, at p. 254.

<sup>969</sup> Geimer 1983 (Geimer & Schütze, Internationale Urteilsanerkennung), pp. 193-194; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 13, and Art. 2 EuGVVO, para. 164; Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2c; Rechberger & Frauenberger-Pfeiler (2001)6 ZZPInt 3, at pp. 22-23; Teixeira de Sousa (2003)23(4) IPRax 320, at p. 322.

<sup>970</sup> Fallon 2008, p. 258.

<sup>971</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2c; imprecisely: Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 14.

<sup>972</sup> Rechberger & Frauenberger-Pfeiler (2001)6 ZZPInt 3, at pp. 22-23; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 13 (*Geimer* refers both to the places of jurisdiction according to Article 2 and Articles 5 et seq.); Teixeira de Sousa (2003)23(4) IPRax 320, at p. 322; Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2c.

<sup>973</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 190.

However, as a matter of fact, Article 24 does not prohibit the courts of the Member States to declare themselves competent, because the Brussels Ibis Regulation does not prescribe that the litigation must be brought before the courts of the third State where the patent has been granted even if the validity issue has been raised (as the Regulation would do in favour of Member States courts if the validity of a Member State patent or European patent was concerned),<sup>974</sup> because the Brussels Ibis Regulation does not affect the jurisdiction of courts in third States. In this respect, one may refer to Article 6(2), 5(2).<sup>975</sup> More precisely, it is to be stated that Article 24 can only *found jurisdiction* of a court of a Member State, but it *cannot preclude* jurisdiction of a court of a Member State.<sup>976</sup> It is therefore not true that even if Article 24(4) did not create the jurisdiction of a court of a non-Member State, its negative effect (excluding jurisdiction of the Member State court where infringement proceedings have been initiated) would have to be respected.<sup>977</sup>

In practice, *chaos* would be caused, if courts of non-Member States were granted exclusive jurisdiction to the same extent as Article 24 confers to the courts of Member States, because this would mean to apply Community standards to non-Member States which will certainly have their own standards. Consequently, if exclusive jurisdiction was to be respected it would have to be exclusive jurisdiction to the extent as it is demanded by the respective non-Member State.<sup>978</sup> In this context, it is to be underlined that one should not blindly trust the grounds on which third States claim exclusive jurisdiction for their courts. As a consequence, a double-checking by applying some controlling Community standard has been considered to be necessary.<sup>979</sup> In this respect, the Groupe Européen de Droit International Privé – GEDIP (European Group for Private International Law – EGPIIL), in the framework of an proposed amendment of the Brussels I Regulation, proposed to accept (in the absence of any exclusive jurisdiction vested in Member States courts) exclusive jurisdiction by courts of non-Member States if the following two conditions are fulfilled: First, such jurisdiction must be founded under the law of the respective non-Member State on the basis of its own provisions. Second, such provisions must be analogous to Article 22 of the Brussels I Regulation (Article 24 of the Brussels Ibis Regulation). According to the working group, these ideas should be integrated in a separate provision (Article 22bis).<sup>980</sup> Although this approach might be logical, it is complicated and rather hard to manage by practitioners who mostly are not familiar with international procedural law on a day-to-day basis.<sup>981</sup>

Arguing in favour of a direct reflexive application of Article 24(4), it might be put forth, with regard to the addressed risk of the potential creation of *chaos*, that denying a reflexive application of Article 24(4) would be opposed to the objective, the conception and the spirit of the Brussels Ibis Regulation, which has, in Article 24, defined certain connecting factors which are considered solely appropriate in the affected constellations.<sup>982</sup> Following this

<sup>974</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 13.

<sup>975</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 190.

<sup>976</sup> Illustration of the prevailing opinion delivered in: Grundmann (1985)5(5) IPRax 249, at p. 250.

<sup>977</sup> Differently: Heinze & Dutta (2005)25(3) IPRax 224, at p. 228.

<sup>978</sup> Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 5.

<sup>979</sup> Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 5.

<sup>980</sup> EGPIIL (2009)29(3) IPRax 283, at p. 284, Article 22bis; referred to in: Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 5; cf. also Kohler (2009)29(3) IPRax 285, at p. 285.

<sup>981</sup> Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 5.

<sup>982</sup> Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 7; Kropholler 1988, p. 242; Hausmann 1994 (Wieczorek & Schütze), Art. 16 EuGVÜ, para. 7, Grundmann (1985)5(5) IPRax 249, at p. 251 et seq.; similar: Droz 1972, paras. 164 ff; Gothot & Holleaux 1985, para. 37; Gaudemet-Tallon 2010, para. 100; Briggs & Rees 2009, paras. 2.62 and 2.259; Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 22, para. 6; cf. also the Dutch decisions concerning the application of Article 16(1) of the Brussels Convention with regard to cases where immovable property is situated in a non-Contracting State: Rb. Rotterdam 20 February 1978, Mesch-

approach, it might be argued that it cannot be assumed that the creators of the Brussels Ibis Regulation (respectively its predecessors) intended to disrespect, vis-à-vis third States, a criterion which has been considered reasonable vis-à-vis Member States (respectively Contracting States with regard to the Brussels Convention).<sup>983</sup> Furthermore, it could be argued that, with regard to immovables (Article 16(1) of the Brussels Convention respectively Article 24(1) of the Brussels Ibis Regulation) it has equally been remarked that it is justified to apply this rule of jurisdiction also vis-à-vis third States, if there are compelling reasons for establishing a “*Belegenheitszuständigkeit*” as exclusive jurisdiction. It could be put forth that international *chaos* would be the consequence or at least provoked in the very event that these *compelling reasons are disregarded*.<sup>984</sup>

However, it is to be emphasised that such a respect of exclusive jurisdiction in non-Member States can neither be based on the sovereignty of a foreign State which would ban courts of other States from deciding on immovables situated within their territory,<sup>985</sup> nor on the idea of “international fairness”.<sup>986</sup> First, it is not clear who shall be protected by this principle; no defendant domiciled in a Member State would be protected. Besides, in the constellation where, for instance, a Dutch court decides on a dispute between a Dutch claimant and a Dutch defendant concerning a European patent granted for Norway, most pieces of evidence being available in the Netherlands, this would not appear to be “unfair”, but “fairly” reasonable.

Another argument which may be stressed against a direct reflexive application of Article 24 is the presumed danger of negative conflicts of competence (“*negative Kompetenzkonflikte*”) arising if the courts of a Member State consider to lack jurisdiction, due to a reflexive application of Article 24, in favour of the courts of a non-Member State, which however do not claim exclusive jurisdiction according to the law of this third State and consider themselves not competent.<sup>987</sup> It may be demanded that, in the absence of a positive allocation of jurisdiction to third States, there must not be the possibility of derogation either, in order to avoid such negative conflicts of competence, which could come into existence due to the fact that the Brussels Ibis Regulation might use other connecting elements than national laws, and the scope of application of Article 24 and provisions of national (procedural) laws of third States might therefore differ.<sup>988</sup> In this context it is to be pointed out that it is not sure that the foreign third State actually utilises the exclusive jurisdiction granted by way of a reflexive application of Article 24,<sup>989</sup> although it is a matter of fact that, concerning patents, the States where a patent has been granted generally claim exclusive jurisdiction as to the question of the validity of the respective patent, at least concerning decisions having *erga omnes* effect.

---

Vermögensanlage GmbH-Emissions KG (Germany) v Orspan SA (Spain), NJ 1978, 621, with case note J.C. Schultz; considered already by Rb. Amsterdam 13 May 1975, Eurotex Italia (Italy) v C. Rensel (Netherlands), NJ 1976, 323, with case note J.C. Schultz, and (1975)22 N.I.L.R. 206, with case note J.P. Verheul.

<sup>983</sup> Schack 2010, para. 359.

<sup>984</sup> As to immovables: Schröder 1971, p. 371.

<sup>985</sup> Schröder 1971, pp. 367-369; Schack 2010, para. 352.

<sup>986</sup> The argument that “international fairness” would require a reflexive application of Article 24 of the Brussels Ibis Regulation (respectively its predecessors) has been put forth by, for instance Coester-Waltjen 1996, p. 105; Jayme 1988, p. 108 et seq; Simotta 2008 (Fasching – Kommentar zu den Zivilprozeßgesetzen), Art 22 EuGVVO, para. 15.

<sup>987</sup> Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 5; Thiel & Tschauner 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 22 VO (EG) No. 44/2001, para. 7.

<sup>988</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2b.

<sup>989</sup> As to Article 16(1) of the Brussels Convention, concerning immovables: Wenner 2002, p. 1025.

In order to avoid the risk of negative conflicts of competence, assuming a direct reflexive effect of Article 24(4) would at least require that certain conditions are fulfilled.<sup>990</sup> First, the condition has been set up that the third State's courts *concretely claim* exclusive jurisdiction.<sup>991</sup> This condition has been considered necessary to meet the fundamental concern of the Brussels Ibis Regulation (respectively its predecessor) to grant access to the courts (of the Member States), as free as possible, if certain minimal connections exist. Otherwise, if the third State does not provide international jurisdiction of its courts for this dispute, denial of justice ("*Justizverweigerung*") could be the consequence.<sup>992</sup> On the other hand, the condition that the third State *demand*s an exclusive jurisdiction would take into account the fact that a reflexive application of Article 24 must not be imposed on sovereign third States.<sup>993</sup> In reaction to this condition, the argument has been brought forward that a limitation of a reflexive effect to the cases in which a third State also claims exclusive jurisdiction, would force courts to determine foreign rules of jurisdiction which would overburden the examination by the courts of the Member States.<sup>994</sup> Besides, it has been highlighted that such an approach would hardly be compatible with the basic principles of legal certainty and previsibility.<sup>995</sup> Additionally, the courts would have to enquire which heads of exclusive jurisdiction exist in the law of a non-Member State. Whilst the forum seised can easily resort to lists of heads of exclusive jurisdiction of courts of Member States, the situation is much more complicated vis-à-vis courts of third States where such an easy way of information does not exist.<sup>996</sup> This all being true, it is to be admitted that the situation as to patent litigations seems less problematic, at least in this respect, as illustrated by some fundamental opponents of the idea of a direct reflexive application of Article 24(4). There is no doubt that, as to patent litigation, States generally confer exclusive jurisdiction to their courts as to registration and validity issues.<sup>997</sup>

As a second condition, it has been claimed that the third State is able to grant effective legal (judicial) protection<sup>998</sup>. Regarding this issue, it is to be noticed that the third State where the patent has been granted is usually closest to the relevant facts and evidence (proximity to facts and evidence, "*Sach- und Beweisnähe*") and can therefore offer the (most) appropriate forum for proceedings when the validity of the patent is contested,<sup>999</sup> although cases are conceivable where another solution would seem preferable. Another opinion has put forth, in relation to immovables, that, for instance, witnesses domiciled in a Member State or documents placed in a Member State might be relevant pieces of evidence besides the importance of the place of registration in the third State, and that the aspect of proximity to facts and evidence of that

---

<sup>990</sup> These conditions are enumerated clearly, with reference to other authors, in Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 7.

<sup>991</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2b; Jayme 1988, p. 108 et seq.; Coester-Waltjen 1996, p. 105; Grolimund 2000, paras. 429 et seq., 507; Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 7; Kropholler 1988, pp. 241-242; Hess 2010, § 5, para. 12; De Lima Pinheiro 2012 (Magnus & Mankowski), Art 22 Brussels I Regulation, para. 10; Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 796; Heinze & Dutta (2005)25(3) IPRax 224, at pp. 227-228; Borrás & Hausmann 2012 (unalex Kommentar), vor Art. 22 Brüssel I-VO, para. 10.

<sup>992</sup> Coester-Waltjen 1996, p. 106.

<sup>993</sup> Jayme 1988, p. 109.

<sup>994</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2b.

<sup>995</sup> Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 6.

<sup>996</sup> Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 5.

<sup>997</sup> Schauwecker (2009)58(3) GRUR Int. 187, at p. 190.

<sup>998</sup> Hess 2010, § 5, para. 14; Grolimund 2000, paras. 429 et seq.; Borrás & Hausmann 2012 (unalex Kommentar), vor Art. 22 Brüssel I-VO, para. 11.

<sup>999</sup> As to Article 16(1) of the Brussels Convention, concerning immovables: Grundmann (1985)5(5) IPRax 249, at p. 252; Stoll (1999)19(1) IPRax 29, at pp. 29-30; cf. also Kropholler 2006, § 58 III 6.a).

third State would therefore be of minor relevance.<sup>1000</sup> Inasmuch as this objection is concerned, it is to be underlined that it is not convincing to conclude<sup>1001</sup> that the aspect of proximity to facts and evidence militates for the contrary. This aspect neither militates for an exclusive jurisdiction of the courts where the patent has been granted and registered, nor for the jurisdiction of other courts; it simply does not bear any relevance at all in this respect.

As an additional aspect concerning the condition of an effective legal (judicial) protection to be granted in the third State, it has even been put forth on the contrary, with regard to immovables,<sup>1002</sup> that court decisions rendered *outside* the “*Belegenheitsstaat*” (third State), i.e. decisions produced in a Contracting State/Member State, suffer from a lack of effectivity due to the idea that such decisions will not be recognised in the “*Belegenheitsstaat*”.<sup>1003</sup> However, this objection is not convincing. Although it cannot be denied that this consequence *may* occur, it is not sure that it *will* necessarily occur.<sup>1004</sup> Besides, parties should be given the possibility and responsibility to assess this risk and weigh it against the advantages of quick legal protection before a Member State court.<sup>1005</sup> After all, the judgment at least exists and is effective in the *forum* State,<sup>1006</sup> and the effects of such a judgment will have to be taken into account in subsequent proceedings.<sup>1007</sup> Furthermore, it is to be considered that assigning exclusive jurisdiction to the courts of the third State means that the possibilities of provisional measures are substantially restricted. This is even more severe as provisional measures of foreign courts are generally not recognised.<sup>1008</sup>

A third condition that has been set up consists in the requirement that a decision of the courts of the third State can be recognised and enforced in the Member State whose courts have been invoked, which will regularly be the defendant’s State of domicile.<sup>1009</sup> With regard to Article 16(1) of the Brussels Convention (Article 24(1) of the Brussels Ibis Regulation), the argument has been raised against a reflexive effect of the respective provision that the courts of a Contracting State (Member State) would have to assume international jurisdiction of the courts of a third State even if the judgment delivered in that third State did not fall under the scope of application of the Brussels Convention (Brussels Ibis Regulation).<sup>1010</sup> This might lead to the result that the judgment by a court of the third State eventually could not be recognised and executed in the Member State.<sup>1011</sup> Where it was not sure that a decision made in the concerned third State would be recognised in the Member State where infringement proceedings have been initiated,<sup>1012</sup> further complications could arise when a decision delivered in the concerned third State is recognised in the forum Member State where infringement proceedings have been initiated, but is not recognised in other Member States

---

<sup>1000</sup> As to Article 22(1) of the Brussels I Regulation, concerning immovables: Wenner 2002, p. 1022; cf. also Schröder 1971, p. 372.

<sup>1001</sup> Cf. Wenner 2002, p. 1023.

<sup>1002</sup> This argumentation applies to patents in the same way.

<sup>1003</sup> Cf. already Matthies 1955, p. 43 (with regard to § 24 of the German Code of Civil Procedure); also addressing the aspect of a higher effectivity of a decision in the “*Belegenheitsstaat*” with regard to immovables: Kropholler 2006, § 58 III 6.a).

<sup>1004</sup> Wenner 2002, p. 1024.

<sup>1005</sup> Wagner 2011 (Stein/Jonas – Kommentar zur Zivilprozessordnung), Art. 22 EuGVVO, para. 10.

<sup>1006</sup> Wenner 2002, p. 1024.

<sup>1007</sup> Wenner 2002, p. 1024; Geimer 2015, para. 933.

<sup>1008</sup> Wenner 2002, pp. 1024-1025; Schack 2010, para. 914.

<sup>1009</sup> Rechberger & Frauenberger-Pfeiler (2001) 6 ZZPInt 3, at p. 23; cf. also reference in Geroldinger 2014 (Burgstaller, Neumayr, Geroldinger & Schmaranzer), Art 22 EuGVO, para. 7, there fn. 15; Linke & Hau 2011, para. 199; Borrás & Hausmann 2012 (unalex Kommentar), vor Art. 22 Brüssel I-VO, para. 11.

<sup>1010</sup> Teixeira de Sousa (2003) 23(4) IPRax 320, at p. 322.

<sup>1011</sup> Teixeira de Sousa (2003) 23(4) IPRax 320, at p. 322.

<sup>1012</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2e.

(because no respective international agreement exists), while the forum Member State might potentially be obliged by an international agreement to recognise such decisions.<sup>1013</sup> Multiple constellations are conceivable in this respect which would make it impossible to simply grant exclusive jurisdiction to third States in general in cases where Article 24(4) would apply if a Member State was concerned.<sup>1014</sup>

In this context, concerning the condition of a reflexive application of Article 24(4) that a decision of the courts of the third State could be recognised and enforced in the Member State where the defendant is domiciled, it might be argued that the courts of that Member State, having jurisdiction according to Article 4, do not have to decline jurisdiction in favour of a court of a third State claiming exclusive jurisdiction, where such exclusive jurisdiction would exist if the court of the third State was a court of a Member State, for the *sole* reason that the judgment of the courts of the third State would be recognisable in the Member State. Otherwise, there would be *no* competent court in a Member State if a judgment of a court of a third State could be recognised and executed in that Member State.<sup>1015</sup> In this respect, it might be put forth that positive conflicts of competence (“*positive Kompetenzkonflikte*”) in the relationship with a third State which demands exclusive jurisdiction must generally be accepted and be solved by rules of *lis pendens* and recognition pursuant to national law.<sup>1016</sup>

Arguing in favour of a direct reflexive application of Article 24(4), it might be put forward that, in the absence of such a reflexive application, there would be the risk that a decision produced in a Member State would not be recognised in a third State, insofar as that third State concretely demands to exert an exclusive jurisdiction.<sup>1017</sup> As a consequence, “*hinkende Rechtsverhältnisse*” could come into existence.<sup>1018</sup> In this respect it might be argued that it would not seem to be sufficient to simply state that this danger is to be operated by the parties and not by the legislator<sup>1019</sup> and that the plaintiff may choose a forum which suits his interests,<sup>1020</sup> as has been proclaimed by *Mankowski* who is generally against a reflexive application of Article 24(4), although he admits that “a real danger of that kind [the danger that a decision produced in a Member State is not recognised in a third State] means a considerable incentive for the claimant against an action in a Member State.”<sup>1021</sup> However, several arguments can actually be brought forward against the danger of arising “*hinkende Rechtsverhältnisse*”. First, this risk is actually relativised by the fact that the recognition in that third State might not be decisive, because the winning claimant can have sufficient measures against the defendant in the defendant’s State of domicile to force him to undertake certain acts or omissions.<sup>1022</sup> This is a matter of “*Inlandsvollstreckung*”.<sup>1023</sup> On the contrary, enforcement against the defendant can then be even more effective than it would be if the claimant had to obtain a judgment in the third State, as, in particular, cross-border enforcement of orders to act in a certain way (“*Handlungsgebote*”) is difficult and problematic.<sup>1024</sup> Furthermore, cross-border enforcement (“*Auslandsvollstreckung*”) is not

---

<sup>1013</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 14.

<sup>1014</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2e.

<sup>1015</sup> Teixeira de Sousa (2003)23(4) IPRax 320, at p. 322.

<sup>1016</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2c.

<sup>1017</sup> Hausmann 1994 (Wieczorek & Schütze), Art. 16 EuGVÜ, para. 7; Audit 2005, p. 34.

<sup>1018</sup> Coester-Waltjen 1996, p. 105.

<sup>1019</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2d; Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 6.

<sup>1020</sup> Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 6.

<sup>1021</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2d.

<sup>1022</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2d.

<sup>1023</sup> Wenner 2002, p. 1024.

<sup>1024</sup> Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2d.

necessary in the case of a sentence to make a declaration either.<sup>1025</sup> It must also be emphasised that the argument of the potential danger that a decision produced in a Member State is not recognised in a third State, insofar as that third State concretely demands to exert an exclusive jurisdiction, is further relativised by the fact that it becomes relevant only if recognition and enforcement is sought in *that* respective non-Member State, whereas it would not be existent vis-à-vis other non-Member States. An *effet réflexe* would actually go beyond this scenario and extend even to cases where the judgment could be easily executed in the forum State or enforced in any other Member State.<sup>1026</sup> In view of this, it has been pointed out that “the potential danger of “*hinkende Rechtsverhältnisse*” does not justify to create mistaken rules of jurisdiction.”<sup>1027</sup>

Additionally, it has to be taken into consideration that a reflexive application of Article 24 would also affect Article 27, which refers to Article 24 when determining in which circumstances a court of a Member State declares of its own motion that it has no jurisdiction. This could pose “quite another obstacle and a high hurdle in the way of such effect.”<sup>1028</sup> It must therefore be underlined that, due to the severe consequences created, a reflexive application of Article 24 could only be justified in the event of a situation highly comparable to the very situation explicitly described in Article 24.

Furthermore, if Article 24(4) was applied by way of a reflexive application, Article 45(1)(e)(ii) which refers to Article 24 would have to be applied in the same way, too.<sup>1029</sup> According to Article 45(1)(e)(ii), the recognition of a judgment shall be refused, on the application of any interested party, if the judgment conflicts with Section 6 of Chapter II of the Brussels Ibis Regulation, i.e. Article 24 (which is the only article contained in Section 6). This could impede the recognition and enforcement of decisions of Member States courts and would therefore be in conflict with a fundamental principle of the Brussels Ibis Regulation.<sup>1030</sup>

Arguing in favour of a reflexive application of Article 24(4), it has been highlighted that this approach would encourage further European integration, because it would promote the identity of results of proceedings in Member States regardless of in which Member State proceedings have been initiated.<sup>1031</sup> However, the same would be true for the contrary view, because the results of proceedings initiated in Member States would also be identical if Article 24 was generally not applied by way of a reflexive application vis-à-vis third States. It might also be argued that a reflexive application of Article 24 entails the advantage that defendants would be treated in the same way regardless of whether they are domiciled in a Member State or in a third State, and that by way of a reflexive application of Article 24, defendants domiciled in Member States would thus no longer be discriminated against defendants domiciled in third States,<sup>1032</sup> considering that the spirit of the Brussels Ibis

<sup>1025</sup> Wenner 2002, p. 1024.

<sup>1026</sup> Magnus & Mankowski (2010) 109 ZVglRWiss 1, at p. 6.

<sup>1027</sup> Wenner 2002, p. 1025; regarding the ideal of “*äußerer Entscheidungseinklang*”: Schack 2010, para. 240.

<sup>1028</sup> Magnus & Mankowski (2010) 109 ZVglRWiss 1, at p. 6; cf. Fallon 2008, p. 248.

<sup>1029</sup> Cf. Mankowski 2011 (Rauscher), Art 22 Brüssel I-VO, para. 2e; cf. Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 35, para. 14.

<sup>1030</sup> Geimer 1983 (Geimer & Schütze, Internationale Urteilsanerkennung), p. 322; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 35 EuGVVO, paras. 63-65; Mankowski 2012 (Magnus & Mankowski), Art 35 Brussels I Regulation, para. 27.

<sup>1031</sup> As to Article 16 Brussels Convention cf. Grundmann (1985) 5(5) IPRax 249, at p. 251.

<sup>1032</sup> Droz 1972, para. 168.



Regulation is to protect EU citizens.<sup>1033</sup> However, this argumentation is not convincing because the decisive factor for Article 24 to be applicable is not the domicile of the defendant, but the State where the concerned patent has been granted. Whether the defendant is domiciled in a Member State or in a third State has no influence on the application of Article 24.

Last but not least, there are actually several further crucial arguments which militate against a reflexive application of Article 24(4) vis-à-vis courts of third States. The claimant who initiates proceedings in a Member State although the patent has been granted in or for a third State can act on the basis of comprehensible reasons. The defendant's interest to litigate in the third State does not deserve protection, because his interest in an adequate defence is sufficiently ensured in the State of domicile (Member State).<sup>1034</sup> It is a matter of fact that a reflexive application of Article 24 would also bring along consequential problems like the following: How exact would the equivalence between "internal" and "external" cases have to be?<sup>1035</sup> Must grounds for declining jurisdiction be identical, or is judicial discretion sufficient? The answer to the latter question would be decisive as to common law jurisdiction employing the *minimum contacts*-doctrine and the doctrine of *forum non conveniens*.<sup>1036</sup> And, finally, it must not be lost out of sight that the ECJ, in its *Coreck Maritime* decision, expressly denied a reflexive application of Article 17 of the Brussels Convention (Article 25 of the Brussels Ibis Regulation) in favour of the application of national law.<sup>1037</sup>

In light of the foregoing analysis, I am convinced that Article 24(4) should not be applied by way of a direct reflexive application either in case of patents granted in respectively for a third State. The contrary conception which argues that a reflexive application of Article 24(4) should be accepted even if parties have agreed on the jurisdiction of a Member State court (prorogation),<sup>1038</sup> because a prorogation lacks any legal force in case of an exclusive jurisdiction (cf. Article 25(4)),<sup>1039</sup> does not sufficiently take into consideration that conferring exclusive jurisdiction according to Article 24 is based on the mutual trust between the Member States and the idea of equivalence of the legal systems of the Member States, which cannot simply be extended to third States.<sup>1040</sup> This has become clear in the course of the reform of the Brussels I Regulation towards the present Brussels Ibis Regulation. Obviously, the European legislator, although being aware of this controversial issue, decided against extending the wording and scope of Article 24 such as to also explicitly confer exclusive jurisdiction to the courts of third States where the concerned patent has been granted in or for a third State.<sup>1041</sup>

---

<sup>1033</sup> Droz 1972, para. 167. This idea is certainly correct, and fits into the line of reasoning pursued by *Droz*; however, the latter aspect has no influence on the fact that *Droz*'s starting point seems to be wrong.

<sup>1034</sup> As to the parallel problem in connection with immovables and an eventual exclusive jurisdiction of the courts of the *Belegenheitsstaat*: Wenner 2002, p. 1026; Geimer 2015, para. 929.

<sup>1035</sup> Fentiman 2005 (International Civil Litigation), p. 102, referred to in: Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 6.

<sup>1036</sup> Cf. in detail Fentiman 2005 (International Civil Litigation), p. 102, referred to in: Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 6.

<sup>1037</sup> ECJ 9 November 2000, C-387/98, *Coreck Maritime GmbH v Handelsveem BV and Others*, [2000] ECR I-09337, para. 19 – *Coreck Maritime*.

<sup>1038</sup> Gaudemet-Tallon 2010, para. 150.

<sup>1039</sup> Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 7.

<sup>1040</sup> Thiel & Tschauner 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 22 VO (EG) No. 44/2001, para. 7.

<sup>1041</sup> In this respect, proponents of a reflexive application of Article 24 of the Brussels Ibis Regulation have underlined that according to Recital 24 3<sup>rd</sup> sentence of the Brussels Ibis Regulation, the fact that proceedings have been initiated before a court in a third State that would have, inversely, exclusive jurisdiction, may be considered a criterion of *discretion* in view of an eventual stay of proceedings (cf. Von Hein (2013)59(3) RIW

#### 2.4.2.4 Requirements as to the defence of invalidity

Having clarified that Article 24(4) is not to be taken into consideration if the concerned patent has been granted in or for a third State, I shall now turn to the issue which are the specific requirements for submitting a defence of invalidity of a patent in infringement proceedings.

##### 2.4.2.4.1 Must the defence of invalidity of the patent be admissible?

In its *GAT* decision, the ECJ recognised the comprehensive relevance of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation independently of the fact whether the aspect of the alleged invalidity of a patent is brought into play:

“In the light of the position of Article 16(4) [of the Brussels Convention] within the scheme of the Convention and the objective pursued, the view must be taken that the exclusive jurisdiction provided for by that provision should apply whatever the form of proceedings in which the issue of a patent’s validity is raised, be it by way of an action or a plea in objection (...) [underscore and content in brackets added].”<sup>1042</sup>

This conception has been confirmed and codified in the meanwhile by the European legislator through the creation of Article 24(4) of the Brussels Ibis Regulation, by supplementing the phrase “irrespective of whether the issue is raised by way of an action or as a defence” to the previous wording of Article 22(4) of the Brussels I Regulation.

However, the question remains if Article 24(4) might eventually be inapplicable *a priori* in the case that the defence of invalidity is *not admissible*. In this respect it is to be noticed that some EU Member States provide for the possibility that the nullity of a patent is claimed in infringement proceedings, while this possibility does not exist in other legal system like the German or Austrian system where even different authorities decide on infringement respectively nullity/invalidity of a patent.<sup>1043</sup> Dealing with the problem of a potential inadmissibility of the defence of invalidity, I shall first research the legal nature of that admissibility.

##### 2.4.2.4.1.1 Nature of the aspect of admissibility of the defence of invalidity of the patent

###### 2.4.2.4.1.1.1 Admissibility of the defence of invalidity: procedural law

On the one hand, it has been argued that the question of the admissibility of the defence of invalidity is to be qualified as procedural law. Consequently, it has been concluded that the strict separation between infringement and invalidity proceedings in Germany cannot be exported to other countries where such a separation does not exist,<sup>1044</sup> because the *lex fori* decides independently about procedural rules. *Vice versa*, German courts being concerned with patent infringement proceedings have also decided on the validity of the non-German

---

97, at pp. 101, 106). However, it should be borne in mind that Recital 24 of the Brussels Ibis Regulation merely contains a *discretionary* rule and has no binding effect at all.

<sup>1042</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 25 – *GAT*.

<sup>1043</sup> For instance, according to the German system, the *Bundesgerichtshof* is the highest instance as to patent *infringement* proceedings, whilst the *Bundespatentgericht* is the highest instance concerning proceedings with regard to the *validity/invalidity* of patents.

<sup>1044</sup> Adolphsen 2009, para. 435.

patent in question if a defence of invalidity had been raised by the defendant.<sup>1045</sup> While it is to be admitted that the latter decision is to be approved insofar as the strict separation between infringement and invalidity proceedings is based on the sole fact that a German patent is granted by an administrative act which shall not be overruled by a non-administrative court,<sup>1046</sup> this inconsequent treatment of comparable situations reveals the weakness of the procedural conception in question. At least, on the basis of that procedural perspective, the question of whether Article 24(4) might be inapplicable due to the inadmissibility of a defence of invalidity would not arise, because such a defence would not affect foreign patents and courts outside the State where the patent was granted, due to the autonomy of the *lex fori*.

#### 2.4.2.4.1.1.2 Admissibility of the defence of invalidity: substantive law

Besides the inconsistency of a procedural conception, it cannot be denied that the problem of the admissibility of the defence of invalidity of a patent shows a close connection with substantive patent law and is consequently rightly to be qualified as substantive law,<sup>1047</sup> bearing the consequence that the *lex loci protectionis* is decisive.<sup>1048</sup>

#### 2.4.2.4.1.2 Scope of Article 24(4)

Interestingly, neither Article 24(4) nor the rest of the Brussels Ibis Regulation contain any specific rules as to the problem of whether a defence of invalidity needs to be admissible for Article 24(4) to be applicable.<sup>1049</sup> The question to be posed therefore is whether the case-law of the ECJ may deliver some guidance.

In the *Shevill* decision, dealing with the interpretation of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), the ECJ expressly restricted the scope of the Brussels Convention (this jurisprudence being also relevant for the Brussels Ibis Regulation), stating that

“(…) the sole object of the [Brussels] Convention is to determine which court or courts have jurisdiction to hear the dispute by reference to the place or places where an event considered harmful occurred (...) [content in brackets added].”<sup>1050</sup>

and continuing that

“[the Brussels Convention] does not, however, specify the circumstances in which the event giving rise to the harm may be considered to be harmful to the victim, or the evidence which the plaintiff must adduce before the court seised to enable it to rule on the merits of the case [content in brackets added].”<sup>1051</sup>

<sup>1045</sup> Adolphsen 2009, paras. 436, 437.

<sup>1046</sup> Schauwecker 2009, p. 250.

<sup>1047</sup> Similar, but inconsistent: Schauwecker 2009, p. 250: “Zwar handelt es sich bei der Zulässigkeit der Ungültigkeitseinrede um eine ihrer Natur nach verfahrensrechtliche Frage; (...) sollte diese jedoch materiellrechtlich qualifiziert werden [underline added].”

<sup>1048</sup> Bukow 2003, p. 255; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 237; Schauwecker 2009, p. 250.

<sup>1049</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 237; Bukow 2003, p. 220.

<sup>1050</sup> ECJ 7 March 1995, C-68/93, Fiona Shevill and Others v Presse Alliance SA, [1995] ECR I-00415, para. 37 – *Shevill*.

<sup>1051</sup> ECJ 7 March 1995, C-68/93, Fiona Shevill and Others v Presse Alliance SA, [1995] ECR I-00415, para. 38 – *Shevill*.

This conception of the ECJ, underlining the importance and relevance of national law, beyond international jurisdiction, has been confirmed in the *Danvaern* decision, on the interpretation of Articles 6(3) and 22 of the Brussels Convention (Articles 8(3) and 30 of the Brussels Ibis Regulation), where the ECJ held, as to the treatment of defences:

“The defences which may be raised and the conditions under which they may be raised are determined by national law.”<sup>1052</sup>

But what can be derived from this case-law, for the initial question of whether a defence of invalidity needs to be admissible for Article 24(4) to be applicable, in view of the *GAT* decision? The ECJ distinctly established – in line with its *Duijnstee* decision – that pure infringement proceedings where no defence of invalidity of the concerned patent is raised are not affected by Article 24(4):

“If (...) the dispute does not concern the validity of the patent or the existence of the deposit or registration and these matters are not disputed by the parties, the dispute will not be covered by Article 16(4) of the [Brussels] Convention (*Duijnstee*, paragraphs 25 and 26). Such would be the case, for example, with an infringement action, in which the question of the validity of the patent allegedly infringed is not called into question [content in brackets added].”<sup>1053</sup>

In this respect the argument could be put forth that it cannot make a difference if no defence of invalidity of the concerned patent is raised at all, or if an inadmissible defence of invalidity is raised which, due to the inadmissibility, has no effect. The *effet utile* of Article 24(4) would not be impaired either, because the question of the existence of a patent is not affected in infringement proceedings where the invalidity defence is not effectively raised.

This being so, it is however also true that the ECJ, in its *GAT* decision (again in line with the *Duijnstee* decision), explicitly underlined its wish to avoid conflicts created by the fact that some legal systems provide the possibility for courts dealing with infringement proceedings to decide on the validity of patents with *erga omnes* effect:

“(...) In order to avoid the risk of contradictory decisions, it is therefore necessary to limit the jurisdiction of the courts of a State other than that in which the patent is issued to rule indirectly on the validity of a foreign patent to only those cases in which, under the applicable national law, the effects of the decision to be given are limited to the parties to the proceedings. Such a limitation would, however, lead to distortions, thereby undermining the equality and uniformity of rights and obligations arising from the Convention for the Contracting States and the persons concerned (*Duijnstee*, paragraph 13).”<sup>1054</sup>

Where the ECJ thus emphasises the importance and necessity of the equality and uniformity of rights and obligations based on the Brussels Convention (Brussels Ibis Regulation), in order to demonstrate that existing differences as to the effect of decisions (*inter partes* effect/*erga omnes* effect) may not affect jurisdiction, it is to be pointed out that both such different effects of decisions and the divergences as to a defence of invalidity of a patent are based on the different structures of patent systems, concerning the question of whether that defence can be raised before the same court where infringement proceedings have been initiated.<sup>1055</sup> Consequently, if the inadmissibility of a defence of invalidity had the effect that

---

<sup>1052</sup> ECJ 13 July 1995, C-341/93, *Danvaern Production A/S v Schuhfabriken Otterbeck GmbH & Co.*, [1995] ECR I-02053, para. 13 – *Danvaern*.

<sup>1053</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 16 – *GAT*.

<sup>1054</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 30 – *GAT*.

<sup>1055</sup> Schauwecker 2009, p. 254.

Article 24(4) would not be applicable, distortions which the ECJ obviously intends to avoid, would actually be provoked. As a consequence, although the *effet utile* of Article 24(4) would not be impaired (cf. above), the *effet utile* of the Brussels Ibis Regulation *in general* would be affected. For this reason, Article 24(4) should be considered applicable regardless of a defence of invalidity of a patent raised in infringement proceedings is admissible or not.

#### 2.4.2.4.2 Must the defence of invalidity of the patent be sufficiently substantiated?

In light of the finding that the admissibility of a defence of invalidity of a patent does not influence the applicability of Article 24(4), a subsequent question is to be treated: Must such a defence be sufficiently substantiated in order to be taken into account? In the course of the analysis, I will start with the reference for a preliminary ruling by the *Oberlandesgericht Düsseldorf* in the *GAT* case, and then turn to general considerations.

When raising its famous question as to the interpretation of Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation), the *Oberlandesgericht Düsseldorf* formulated *inter alia*:

“(…) irrespective of whether the court seised of the proceedings considers the plea to be substantiated or unsubstantiated (…).”<sup>1056</sup>

Interestingly, neither *Advocate General Geelhoed*, in his Opinion delivered on 16 September 2004, nor the ECJ in its decision from 13 July 2006, expressly treated this aspect of the admittedly extensive question of the *Oberlandesgericht Düsseldorf*. The Advocate General merely treated the aspect of the defendant’s acting in bad faith:

“(…) The court judging the infringement can (…) deal with the case itself where a defendant acts in bad faith.”<sup>1057</sup>

However, regardless of whether this standpoint should be followed, it is to be underlined at this stage that, in contrast to other authors who obviously do not undertake such a differentiation,<sup>1058</sup> the defendant’s acting in bad faith and an unsubstantiatedly raised defence of invalidity should rather *not* be equalised, because acting in bad faith *can be*, but *not necessarily is*, based on an unsubstantiated defence, where on the other hand the raise of a defence in an unsubstantiated way *can be*, but *not necessarily is*, an acting in bad faith either.<sup>1059</sup> Consequently, the lack of substantiation of a defence is not to be considered a subset of acting in bad faith, and *vice versa*. Rather, the picture of two overlapping circles seems most appropriate. In this regard, it is to be underlined that the acting in bad faith implies the subjective element of the (defendant’s) will, while the lack of a sufficient substantiation of a defence is an objective fact which can be examined and evaluated by the deciding court.

Given the fact that neither the Advocate General nor the ECJ have solved the indicated problem in *GAT*, I shall take recourse to other court decisions and general considerations.

---

<sup>1056</sup> OLG Düsseldorf 5 December 2002, 2 U 104/01, (2003)52(12) GRUR Int. 1030 – *GAT*.

<sup>1057</sup> Advocate General 16 September 2004, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 46 – *GAT*.

<sup>1058</sup> Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 797; Adolphsen (2007)27(1) IPRax 15, at p. 19.

<sup>1059</sup> Schauwecker 2009, p. 273.

In this respect, the *Knorr-Bremse* decision of the English *High Court of Justice (Chancery Division, Patents Court)*, rendered after the *GAT* decision of the ECJ, is of particular interest. In this case, the claimant was an English company which was part of the Knorr-Bremse Group (KBS), the world's largest manufacturer of brake systems. The defendant, a German company, was part of the Haldex Group (Haldex), another leading manufacturer of brake systems. Haldex initiated proceedings in Germany alleging infringement of two German patents which were the German national versions of two European Patents. The dispute was settled in a settlement agreement in 2006. Later, the claimant initiated proceedings for a declaration of non-infringement. Haldex applied for a stay of the proceedings on the ground that by the settlement agreement the parties had conferred exclusive jurisdiction on the *Landgericht Düsseldorf*. Notably, there was no pleaded claim for invalidity of the patents.

Referring to the judgement of *Laddie J. in Coin Controls*<sup>1060</sup>, subsequently approved by the *Court of Appeal in Fort Dodge*<sup>1061</sup>, *Lewison J.* held *inter alia*:

“It is clear in my judgment that Laddie J. held that where it is clear that validity “is to be” put in issue (i.e. in the future) the court should decide the application on the basis that validity is one of the issues in the case. It is not necessary for the allegation of invalidity to be formally pleaded. I respectfully agree. (...)”<sup>1062</sup>

The *High Court of Justice* thus repeatedly stated that the pure possibility that a defence of invalidity is raised suffices for rules of exclusive jurisdiction to be applicable. In view of this, it would not seem logical, but even contradictory, to demand that a defence which has actually been raised must be substantiated, because in the case of the unsubstantiated raise of a defence, the defendant has at least undertaken more as if he had raised no defence at all.<sup>1063</sup>

However, that jurisprudence has not been pursued by all courts. For instance, the *Rechtbank 's-Gravenhage*, in contrast to the English *High Court of Justice*, decided, in *Sisvel*, that a defence of invalidity of a patent must in fact be raised in order to be taken into account. In this case, the claimant was the Italian company *Societa Italiana Per Lo Sviluppo Dell'Elettronica S.I.S.V.E.L. SPA* (*Sisvel*). The defendants were *Sandisk Corporation* (*Sandisk*), an U.S. company, *Moduslink B.V.* (*Moduslink*), a Dutch company, and *UPS SCS (Nederland) B.V.* (*UPS*), another Dutch company. The dispute essentially concerned the alleged infringement of a European patent for several States. In the course of the proceedings, *Moduslink* announced to raise a defence of invalidity as to this European patent, but did *not* actually raise it. In this respect, the *Rechtbank 's-Gravenhage* held:

“Moduslink heeft aangekondigd de geldigheid van de buitenlandse octrooien bij wege van exceptie in deze procedure aan de orde te zullen stellen. Die aankondiging alleen is onvoldoende om reeds nu te concluderen dat de rechtbank onbevoegd is om van de vorderingen van Sisvel, voorzover die betrekking hebben op (dreigende) octrooi-inbreuk en zien op andere landen dan Nederland, kennis te nemen (...)”<sup>1064</sup>

<sup>1060</sup> High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suizo International (U.K.) Limited and Others*, [1997] F.S.R. 660 – *Coin Controls*.

<sup>1061</sup> High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222 – *Fort Dodge*.

<sup>1062</sup> High Court of Justice (Chancery Division – Patents Court) 7 February 2008, *Knorr-Bremse Systems for Commercial Vehicles LDT v Haldex Brake Products GmbH*, [2008] F.S.R. 30, 770 – *Knorr-Bremse*.

<sup>1063</sup> Schauwecker 2009, p. 277.

<sup>1064</sup> Rb. 's-Gravenhage 9 August 2006, Case No. 257421 / HA ZA 06-167, and Case No. 257423 / HA ZA 06, *Societa Italiana per lo Sviluppo dell'Elettronica S.I.S.V.E.L. SpA v Sandisk Corporation and Others*, NJF 2006, 540, para. 6.7 – *Sisvel*.

“(Moduslink has announced to raise a defence of invalidity as to the foreign patents in this proceeding. That mere announcement does not suffice to conclude already at this stage that the court does not have jurisdiction to take notice of the claims of Sisvel, inasmuch as they are related to (imminent) patent infringement and concern other States than the Netherlands (...).”<sup>1065</sup>

In light of the varying jurisprudence of different courts, it seems inevitable to take recourse to general, schematic considerations to solve the question of whether the unsubstantiated raise of a defence suffices to make Article 24(4) applicable. In the first place, it seems essential to determine the type of patent (validity) proceedings. In this respect, it is to be borne in mind that there are patent systems where the same courts have jurisdiction on infringement and validity proceedings, and patent systems where different courts are competent to decide on such proceedings. As to the second variant of systems, it is to be highlighted that numerous Member States treat proceedings concerning the existence of a patent as administrative proceedings.<sup>1066</sup> Remarkably, it is to be mentioned that the latter aspect also goes for States which, despite the general competence of courts dealing with infringement proceedings for validity issues, additionally provide for separate proceedings before special courts which specifically deal with the question of the validity of the patent in question.<sup>1067</sup> According to a general rule, administrative proceedings in the Member States are determined by the principle that the court examines and clarifies the facts *ex officio*. It is thus generally the invoked court which has to make sure that it founds its decision on substantiated facts. Consequently, the defendant at least does not bear the (full) burden of evidence in such proceedings, i.e. regarding a raised defence of invalidity of a patent that is subject to an infringement proceeding. *Inter alia* in its *GAT* decision, the ECJ has continuously emphasised the importance of

“(...) the principle of legal certainty, which is the basis of the [Brussels] Convention (...) [content in brackets added].”<sup>1068</sup>

This principle would be compromised if the requirements as to the substantiation of a defence of invalidity in infringement proceedings would be (considerably) higher than the requirements in pure nullity proceedings.

However, also with regard to such nullity proceedings, it is true that the party who claims the nullity of a patent may not simply affirm the nullity without any reasons, but has to conclusively bring forward the underlying facts which form the basis of the accusation of nullity. The deciding court must thus be enabled to actually make a decision. As a consequence, it is to be stated at a first level that a defence of invalidity of a patent raised in infringement proceedings *must* be substantiated.

Though, the subsequent question arises, on a second level, *before which court* a defence of nullity must be raised *in such a substantiated way*. In its *GAT* decision, the ECJ explicated that the courts of the State where a patent has been granted shall have exclusive jurisdiction, due to Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation), as to the question of validity of the patent. It is therefore logical that a substantiated defence is required before those courts, while a defence of invalidity of a patent does not have to meet the same level of substantiation before the courts of infringement proceedings. Otherwise, the danger would be provoked that the courts before which

---

<sup>1065</sup> Translation provided by the author of this thesis.

<sup>1066</sup> Schauwecker 2009, p. 273.

<sup>1067</sup> Schneider 2005, p. 178 et seq.

<sup>1068</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 28 – *GAT*.

infringement proceedings are brought might even be forced to deal with the question of invalidity in detail.<sup>1069</sup>

As a result, it is to be concluded that Article 24(4) is applicable regardless of the fact of whether, in the course of patent infringement proceedings, a substantiated defence of invalidity of the concerned patent is raised before the courts having jurisdiction for such infringement proceedings. However, the defence must then be raised in a sufficiently substantiated way before the courts having jurisdiction according to Article 24(4).

#### **2.4.2.4.3 Are there temporal restrictions as to the raise of a defence of invalidity?**

Furthermore, the question is to be answered whether a defence of invalidity can be raised at any time during infringement proceedings or if this procedural means is limited in temporal respect.

The *Oberlandesgericht Düsseldorf* which initially made a reference for a preliminary ruling to the ECJ, thus giving the starting shot for the later *GAT* decision of the ECJ, already addressed that problem when formulating *inter alia*:

“(…) irrespective of (…) when the plea is raised during the course of the proceedings.”<sup>1070</sup>

In his Opinion delivered on 16 September 2004, *Advocate General Geelhoed* favoured a solution according to which there should be no temporal restrictions as to the raise of a defence of invalidity, remarking that

“(…) it is immaterial when in the course of the proceedings its validity [i.e. the validity of the patent in question] is challenged (…) [content in brackets added].”<sup>1071</sup>

However, the General Advocate did not restrict himself to this statement, but nebulously continued as follows:

“(…) all this apart from the fact that, as far as possible, the Brussels Convention should be autonomously interpreted, independently of the procedural law of the Member States.”<sup>1072</sup>

On the basis of this perspective, the following problem arises: If the Brussels Convention, respectively the Brussels Ibis Regulation, is to be interpreted autonomously – this actually corresponds to the constant case-law of the ECJ – which rules shall be decisive if there are *no* relevant rules in the Brussels Convention (respectively Brussels Ibis Regulation)? As the problem *must* be solved, the answer can only be that rules of national procedural law come into play, despite the fact that the Advocate General’s expression “independently of the procedural law of the Member States” then seems at least mistakable, because it is not “independently of” but rather “due to the fact that the Brussels Convention (Brussels Ibis Regulation) does not contain a respective rule” that national law is decisive.<sup>1073</sup>

---

<sup>1069</sup> Schauwecker 2009, p. 277; Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 797.

<sup>1070</sup> OLG Düsseldorf 5 December 2002, 2 U 104/01, (2003)52(12) GRUR Int. 1030 – *GAT*.

<sup>1071</sup> Advocate General 16 September 2004, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 42 – *GAT*.

<sup>1072</sup> Advocate General 16 September 2004, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 42 – *GAT*.

<sup>1073</sup> Similar: Schauwecker 2009, p. 265 et seq.



Be that as it may, what is decisive in the end is the ultimate judgment of the ECJ. In this respect it is to be noticed however that the ECJ unfortunately has not explicitly analysed the problem of a potential temporal restriction of a defence of invalidity. Throughout the whole judgment, the ECJ actually mentioned this issue only once, stating that

“(…) in the light of the position of Article 16(4) within the scheme of the [Brussels] Convention and the objective pursued, the view must be taken that the exclusive jurisdiction provided for by that provision should apply whatever the form of proceedings in which the issue of a patent's validity is raised, be it by way of an action or a plea in objection, at the time the case is brought or at a later stage in the proceedings [underscore and content in brackets added].”<sup>1074</sup>

After a threefold argumentation for this evaluation, the ECJ laconically remarked in its final conclusion, even without mentioning the temporal aspect:

“In the light of the foregoing, the answer to the question referred must be that Article 16(4) of the Convention is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection [underscore added].”<sup>1075</sup>

It is exactly – and merely – this aspect which has been integrated in the amended wording of Article 24(4) of the Brussels Ibis Regulation.

At first glance, an isolated evaluation of the cited passages of the *GAT* decision might suggest that the ECJ did not recognise any temporal restrictions as to the raise of a defence of invalidity at all – in particular because it even did not mention this aspect in its final conclusion. However, it seems more convincing that the Brussels Convention respectively the Brussels Ibis Regulation does not contain such temporal restrictions, while this does not exclude the existence of such provisions in national laws. On the contrary, the temporal restrictions of the right to raise a defence as well as other aspects which have not been ruled by the European legislator principally fall into the scope of application of national procedural law,<sup>1076</sup> as far as the *effet utile* of the Brussels Ibis Regulation (Brussels Convention) is not compromised.<sup>1077</sup> In this respect, the ECJ pointed out, in *Duijnstee*:

“The principle of legal certainty in the Community legal order and the aims pursued by the [Brussels] Convention in accordance with Article 220 of the Treaty, on which it is based, require that the equality and uniformity of rights and obligations arising from the Convention for the Contracting States and the persons concerned must be ensured, regardless of the rules laid down in that regard in the laws of those States [underscore and content in brackets added].”<sup>1078</sup>

This idea has been constantly confirmed by the ECJ in subsequent decisions, such as the following:

“It should be noted, however, that the application of national procedural rules may not impair the effectiveness of the [Brussels] Convention. As the Court has held, in particular in its judgment of 15 November 1983 in Case 288/82 *Duijnstee v Goderbauer* [1983] ECR 3663, a court may not apply

<sup>1074</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 25 – *GAT*.

<sup>1075</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 31 – *GAT*.

<sup>1076</sup> Cf. again: ECJ 13 July 1995, C-341/93, Danvørn Production A/S v Schuhfabriken Otterbeck GmbH & Co., [1995] ECR I-02053, para. 13 – *Danvørn*; ECJ 7 March 1995, C-68/93, Fiona Shevill and Others v Presse Alliance SA, [1995] ECR I-00415, para. 38 – *Shevill*.

<sup>1077</sup> This corresponds to the constant case-law of the ECJ, cf. the following footnotes.

<sup>1078</sup> ECJ 15 November 1983, C-288/82, Ferdinand M. J. J. Duijnstee v Lodewijk Goderbauer, [1983] ECR 03663, para. 13 – *Duijnstee*.

conditions of admissibility laid down by national law which would have the effect of restricting the application of the rules of jurisdiction laid down in the Convention [underscores and content in brackets added].<sup>1079</sup>

“The answer to the referring court must accordingly be that the criteria for assessing whether the event in question is harmful and the evidence required of the existence and extent of the harm alleged by the victim of the defamation are not governed by the [Brussels] Convention but by the substantive law determined by the national conflict of laws rules of the court seised, provided that the effectiveness of the Convention is not thereby impaired [underline and content in brackets added].”<sup>1080</sup>

Ultimately, the ECJ continued this approach in its *GAT* decision when, by reference to *Duijnste*, warning against the

“(…) undermining (of) the equality and uniformity of rights and obligations arising from the [Brussels] Convention for the Contracting States and the persons concerned (*Duijnste*, paragraph 13) [content in brackets added].”<sup>1081</sup>

The applicability of national rules as to the determination of the point in time when preclusion comes into existence does not impair the *effet utile* of the Brussels Ibis Regulation, because such rules do not lead to a *general* preclusion of a defence of invalidity and thus do not *generally* preclude the application of Article 24(4). Rather, provisions as to the preclusion of defences are typically part of the national legal systems of the Member States. This applies even more as to the national patents of the Member States (as well as European patents), because rules of preclusion form part of the *lex fori* regardless of the fact in or for which State the concerned patent has been granted.<sup>1082</sup>

Besides it is to be underlined that the principle that a late assertion will not influence jurisdiction is generally inherent in the Brussels Ibis Regulation itself. In this respect, the interplay between Article 26(1) and Article 29 becomes relevant. Article 26(1) provides:

“(1) Apart from jurisdiction derived from other provisions of this Regulation, a court of a Member State before which a defendant enters an appearance shall have jurisdiction. This rule shall not apply where appearance was entered to contest the jurisdiction, or where another court has exclusive jurisdiction by virtue of Article 24.”

By Article 26(1), the general jurisdictional order can thus be omitted. This provision is complemented by Article 29(3) that states:

“(3) Where the jurisdiction of the court first seised is established, any court other than the court first seised shall decline jurisdiction in favour of that court.”

As a consequence, it can be derived that an assertion will only have effect on jurisdiction if it is brought forward *before* the jurisdiction of another court has been established. The exact point in time when preclusion comes into existence is, also in this context, to be determined by national procedural law (*lex fori*).<sup>1083</sup> This was expressly held by the ECJ in the case

---

<sup>1079</sup> ECJ 15 May 1990, C-365/88, *Kongress Agentur Hagen GmbH v Zeehaghe BV*, [1990] ECR I-01845, para. 20 – *Kongress Agentur Hagen*.

<sup>1080</sup> ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, para. 41 – *Shevill*.

<sup>1081</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 30 – *GAT*.

<sup>1082</sup> Schauwecker 2009, p. 267.

<sup>1083</sup> Staudinger 2011 (Rauscher), Art 24 Brüssel I-VO, para 22.

*Elefanten Schuh*, on the interpretation of Articles 17, 18 and 22 of the Brussels Convention, where the ECJ stated that

“(…) it follows from the aim of Article 18 [of the Brussels Convention] that if the challenge to jurisdiction is not preliminary to any defence as to the substance it may not in any event occur after the making of the submissions which under national procedural law are considered to be the first defence addressed to the court seised [underscore and content in brackets added].”<sup>1084</sup>

To conclude, the initial question posed at the beginning of this paragraph of whether a defence of invalidity can be raised at any time during infringement proceedings or whether this procedural means is limited in temporal respect, is to be answered in a differentiated way: while there are no such immediate restrictions within the provisions of the Brussels Ibis Regulation, provisions of national procedural law, constituting the *lex fori*, determine whether such a defence is precluded.

#### **2.4.2.4.4 Is the defence of invalidity of the patent excluded if the defendant acts in bad faith?**

As has been mentioned above, *Advocate General Geelhoed's Opinion* in *GAT* from 16 September 2004 contains – in contrast to the ECJ's subsequent decision – the following considerations concerning the defendant's acting in bad faith:

“The court judging the infringement can (...) deal with the case itself where a defendant acts in bad faith.”<sup>1085</sup>

In particular after the *GAT* decision (but actually in accordance with previous case-law and parts of legal doctrine), the idea that the defendant's acting in bad faith may void the defence of invalidity of the concerned patent with the consequence that Article 24(4) is not applicable was picked up in posterior court decisions. For instance, the *Hoge Raad*, in a decision from 30 November 2007, referred to the cited passage of *Advocate General Geelhoed's Opinion*, while not deciding the question as such:<sup>1086</sup>

“Of de rechter, niettegenstaande een nietigheidsverweer of -vordering, de inbreukprocedure mag voortzetten indien hij van oordeel is dat de verweerder te kwader trouw handelt en aldus misbruik van procesrecht maakt, zoals door de Advocaat-Generaal Geelhoed bepleit, kan thans in het midden blijven, nu [verweerder] c.s. een degelijke stelling in dit geding niet hebben betrokken.”<sup>1087</sup>

(“Whether the court may continue the infringement proceeding, despite a defence of invalidity or a claim of invalidity, if the court is of the opinion that the defendant acts in bad faith and thus misuses procedural law, as supported by Advocate General Geelhoed, does not have to be answered at present, as the defendants have not acted in such a manner in this procedure.”)<sup>1088</sup>

---

<sup>1084</sup> ECJ 24 June 1981, C-150/80, *Elefanten Schuh GmbH v Pierre Jacqmain*, [1981] ECR 01671, para. 16 – *Elefanten Schuh*.

<sup>1085</sup> Advocate General 16 September 2004, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 46 – *GAT*.

<sup>1086</sup> Imprecisely, because suggesting that the *Hoge Raad* decided that infringement proceedings were to be continued on the basis of the assumed validity of the concerned patent due to the raise of the invalidity defence in a *mala fide* manner: Schauwecker 2009, p. 268, there footnote 1001.

<sup>1087</sup> HR 30 November 2007, C02/228HR and C02/280HR, *Roche Nederland BV (Netherlands) and Others v Dr. F.J. Primus and Dr. M.D. Goldenberg*, NJ 2008, 77, para. 2.5.4 – *Roche Nederland*.

<sup>1088</sup> Translation provided by the author of this thesis.

As to the question of how to treat an invalidity defence raised in a *mala fide* manner, it is to be underlined that the ECJ has confirmed at several occasions the obligation to act in a *bona fide* manner, for instance:

“(…) (I)t would be contrary to good faith for the recipient of the confirmation to deny the existence of a jurisdiction conferred by consent, even if he had given no acceptance in writing [underscore added].”<sup>1089</sup>

“(…) In those circumstances, it would be contrary to good faith to deny the existence of a jurisdiction agreement [underscore added].”<sup>1090</sup>

“(…) It would therefore be a breach of good faith for a party who did not raise any objection subsequently to contest the application of the oral agreement (…) [underscore added].”<sup>1091</sup>

On the basis of this emphasis of the importance of an acting in good faith, one might put forth that a defence of invalidity should not be taken into consideration if that defence was raised in a *mala fide* manner, meaning that Article 24(4) would only be applicable if there is a certain minimum of doubts as to the validity of the patent subject to infringement proceedings.<sup>1092</sup>

On the other hand, it is to be taken into consideration that the ECJ rendered other judgments which suggest that a party's acting in bad faith does not influence the jurisdictional order provided by the Rome I Regulation (and the same applied to the Rome Convention). In particular, two cases shall be mentioned because they are of special interest in this respect.

In the *Gasser* case, which dealt with the interpretation of Article 21 of the Brussels Convention (which structurally corresponds to Article 29 of the Brussels Ibis Regulation, whereas the content of the provision has been modified), the ECJ decided that

“(…) an interpretation of Article 21 of the Brussels Convention whereby the application of that article should be set aside where the court first seised belongs to a Member State in whose courts there are, in general, excessive delays in dealing with cases would be manifestly contrary both to the letter and spirit and to the aim of the Convention.”<sup>1093</sup>

The ECJ reasoned this evaluation by stressing that

“(f)irst, the Convention contains no provision under which its articles, and in particular Article 21, cease to apply because of the length of proceedings before the courts of the Contracting State concerned”<sup>1094</sup>

and that

“(s)econd, it must be borne in mind that the Brussels Convention is necessarily based on the trust which the Contracting States accord to each other's legal systems and judicial institutions. It is that mutual trust which has enabled a compulsory system of jurisdiction to be established, which all the courts within the purview of the Convention are required to respect, and as a corollary the waiver by those States of the right to apply their internal rules on recognition and enforcement of foreign judgments in favour of a

---

<sup>1089</sup> ECJ 14 December 1976, C-25/76, *Galeries Segoura SPRL v Société Rahim Bonakdarian*, [1976] ECR 01851, para. 11 – *Segoura*.

<sup>1090</sup> ECJ 19 June 1984, C-71/83, *Partenreederei ms. Tilly Russ and Ernest Russ v NV Haven- & Vervoerbedrijf Nova and NV Goeminne Hout*, [1984] ECR 02417, para. 18 – *Tilly Russ*.

<sup>1091</sup> ECJ 11 July 1985, C-221/84, *F. Berghoefer GmbH & Co. KG v ASA SA*, [1985] ECR 02699, para. 15 – *Berghoefer*.

<sup>1092</sup> *Heinze & Roffael* (2006)55(10) GRUR Int. 787, at p. 797.

<sup>1093</sup> ECJ 9 December 2003, C-116/02, *Erich Gasser GmbH v MISAT Srl*, [2003] ECR I-14693, para. 70 – *Gasser*.

<sup>1094</sup> ECJ 9 December 2003, C-116/02, *Erich Gasser GmbH v MISAT Srl*, [2003] ECR I-14693, para. 71 – *Gasser*.

simplified mechanism for the recognition and enforcement of judgments. It is also common ground that the Convention thereby seeks to ensure legal certainty by allowing individuals to foresee with sufficient certainty which court will have jurisdiction [underscores added].”<sup>1095</sup>

Furthermore, in the *Turner* case, on the interpretation of the Brussels Convention as well, the ECJ held with regard to the procedural means of an anti-suit injunction, provided for in English procedural law:

“However, a prohibition imposed by a court, backed by a penalty, restraining a party from commencing or continuing proceedings before a foreign court undermines the latter court's jurisdiction to determine the dispute. Any injunction prohibiting a claimant from bringing such an action must be seen as constituting interference with the jurisdiction of the foreign court which, as such, is incompatible with the system of the Convention.”<sup>1096</sup>

As to the aspect of the defendant's (potential) acting in a *mala fide* manner, the ECJ explicitly explicated that

“(…) such interference cannot be justified by the fact that it is only indirect and is intended to prevent an abuse of process by the defendant in the proceedings in the forum State. In so far as the conduct for which the defendant is criticised consists in recourse to the jurisdiction of the court of another Member State, the judgment made as to the abusive nature of that conduct implies an assessment of the appropriateness of bringing proceedings before a court of another Member State. Such an assessment runs counter to the principle of mutual trust which (...) underpins the Convention and prohibits a court, except in special circumstances (...) from reviewing the jurisdiction of the court of another Member State [underline added].”<sup>1097</sup>

However, the crucial question is whether the ECJ's decisions in *Gasser* and *Turner* may actually have such a guiding effect, as it would seem to be the case at first glance, as to the problem which effects the defendant's acting in bad faith has. Remarkably, the ECJ explicitly founded its reasoning in both decisions on the aspect that the Brussels Convention (and the same goes for the Brussels Ibis Regulation to an even higher extent) has been constructed on the basis of the mutual trust of the Contracting States (concerning the Brussels Convention, respectively Member States concerning the Brussels Ibis Regulation) in their legal systems and judicial institutions. In this respect, it is to be underlined that one major difference between the constellation of the disregard of an invalidity defence in a *mala fide* manner and the disregard of a defence which is raised to bring proceedings before a court of a State where proceedings usually last a relatively long time, for exactly this reason (torpedo), consists in the circumstance that in the first constellation, it is *only* the defendant's bad faith which is criticised, whereas in the second constellation, the indirect criticism of another legal system and judicial system comes into play. In this light, neither the *Gasser* decision nor the *Turner* decision of the ECJ imply that an invalidity defence raised in bad faith (constellation 1) must not be taken into consideration.<sup>1098</sup>

Though, *besides* the *Gasser* and *Turner* decisions, it is generally doubtful anyway if subjective criteria should be taken into account when deciding whether the invalidity defence is to be excluded.<sup>1099</sup> In contrast to the objective criteria discussed above, the requirement to

---

<sup>1095</sup> ECJ 9 December 2003, C-116/02, *Erich Gasser GmbH v MISAT Srl*, [2003] ECR I-14693, para. 72 – *Gasser*.

<sup>1096</sup> ECJ 27 April 2004, C-159/02, *Gregory Paul Turner v Felix Fareed Ismail Grovit and Others*, [2004] ECR I-03565, para. 27 – *Turner*.

<sup>1097</sup> ECJ 27 April 2004, C-159/02, *Gregory Paul Turner v Felix Fareed Ismail Grovit and Others*, [2004] ECR I-03565, para. 28 – *Turner*.

<sup>1098</sup> Similar: Schauwecker 2009, p. 273.

<sup>1099</sup> Similar: Schauwecker 2009, p. 273.

prove that a potential infringer acts in bad faith when raising an invalidity defence would certainly lead to considerable legal uncertainty, due to the fact that no defined clear criteria have been developed yet which are considered abusive.<sup>1100</sup> Therefore, only objective criteria should be taken into account, as long as such a binding definition has not been created.<sup>1101</sup> In this context, it is to be emphasised (again) that the ECJ has also underlined the importance of legal certainty in its *Gasser* decision. This eventually harsh result can be attenuated to some extent if the objective restrictions as to a defence of invalidity are applied in a consequent way.

#### 2.4.2.4.5 Is the invalidity defence excluded if it is obviously unfounded?

A question to be differentiated from the problem of a sufficient substantiation of the invalidity defence which has already been discussed above, is whether a defence of invalidity of a patent must not be obviously unfounded in order to be taken into consideration. This concerns the constellation where, in contrast to the unsubstantiated raise of a defence, the defendant brings forward a defence on the basis of a *substantiated* reasoning, but where it is obvious due to other reasons that his defence will not be successful. At the beginning of the following analysis, it is to be highlighted again that the ECJ established in *GAT* that Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation) applies both as to a claim regarding the validity/invalidity of a patent, and a defence of invalidity of a patent, even if the decision has only *inter partes* effect,<sup>1102</sup> which has been codified in Article 24(4) of the Brussels Ibis Regulation in the meanwhile:

“In the light of the position of Article 16(4) [of the Brussels Convention] within the scheme of the Convention and the objective pursued, the view must be taken that the exclusive jurisdiction provided for by that provision should apply whatever the form of proceedings in which the issue of a patent's validity is raised, be it by way of an action or a plea in objection (...) [content in brackets added].”<sup>1103</sup>

Consequently, the courts where infringement proceedings have been initiated are deprived of jurisdiction as soon as the invalidity defence has been raised, and are therefore generally not competent any longer to evaluate the prospects of success of an invalidity defence raised if this requires an own decision on the validity of the patent in question. It follows from the foregoing that the invalidity defence should only be excluded, due to obvious unfoundedness, in a well-defined number of specific constellations to be discussed in the following paragraphs.

##### 2.4.2.4.5.1 Missing substantive entitlement

First, I shall analyse if a missing substantive entitlement of the defendant concerning the patent as to which the defence of invalidity is raised eventually leads to the result that Article 24(4) is not applicable despite of the raise of that defence.

As to European patents, Article 138 of the European Patent Convention states *inter alia*:

<sup>1100</sup> Adolphsen (2007)27(1) IPRax 15, at p. 19.

<sup>1101</sup> The elaboration of such a catalogue of criteria in order to identify when a defence of invalidity is raised in a *mala fide* manner might be undertaken and implemented in a revised version of the Brussels Ibis Regulation.

<sup>1102</sup> Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 797.

<sup>1103</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 25 – *GAT*.

“(1) Subject to Article 139 [of the European Patent Convention], a European patent may be revoked with effect for a Contracting State only on the grounds that:

(...) (e) the proprietor of the European patent is not entitled under Article 60, paragraph 1 [of the European Patent Convention] [content in brackets added].”

On the basis of this legal determination that the fact of substantive entitlement is decisive in the cited way, one might argue that the defence of invalidity of a patent raised by a defendant who himself lacks substantive entitlement, would not affect Article 24(4). In this respect, the question arises in how far the court before which infringement proceedings have been instituted may examine and decide who is entitled with regard to the concerned patent.

Again, I shall take recourse to jurisprudence rendered by the ECJ. In the *Duijnstee* case, the ECJ expressly denied the applicability of Article 24(4) with regard to the question of whether an employee or his employer is entitled to a patent:

“In a case such as the present, neither the validity of the patents nor the legality of their registration in the various countries is disputed by the parties to the main action. The outcome of the case in fact depends exclusively on the question whether Mr Goderbauer or the insolvent company BV Schroefboutenfabriek is entitled to the patent, which must be determined on the basis of the legal relationship which existed between the parties concerned. Therefore the special jurisdiction rule contained in Article 16(4) [of the Brussels Convention] should not be applied [content in brackets added].”<sup>1104</sup>

Before the *GAT* decision of the ECJ, it had therefore partly been put forth that disputes on the question of the substantive entitlement generally do not fall into the scope of application of Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation).<sup>1105</sup> This conception is supported by the provision of Article 60(3) of the European Patent Convention with regard to the applicant for a European patent:

“In proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right to a European patent.”

Correspondingly, also Article 61 of the European Patent Convention excludes, from the procedure of the grant of a European patent, disputes concerning the entitlement to the patent, and allocates actions against the applicant, by which the claim of granting of a European patent is brought forward, to the courts of the Contracting States of the European Patent Convention:<sup>1106</sup>

“(1) If by a final decision it is adjudged that a person other than the applicant is entitled to the grant of the European patent, that person may, in accordance with the Implementing Regulations:

- (a) prosecute the European patent application as his own application in place of the applicant;
- (b) file a new European patent application in respect of the same invention; or
- (c) request that the European patent application be refused.

(2) Article 76, paragraph 1, shall apply mutatis mutandis to a new European patent application filed under paragraph 1(b).”

However, the question arises in which way, if any, this conception can be upheld after the *GAT* decision in which the ECJ emphasised that Article 16(4) of the Brussels Convention

---

<sup>1104</sup> ECJ 15 November 1983, C-288/82, Ferdinand M. J. J. Duijnstee v Lodewijk Goderbauer, [1983] ECR 03663, para. 26 – *Duijnstee*.

<sup>1105</sup> Laubinger 2005, p. 110.

<sup>1106</sup> Laubinger 2005, p. 110 et seq.

(Article 22(4) of the Brussels I Regulation) is applicable if the defence of invalidity of a patent is raised on the ground of the question of the substantive entitlement to a patent,<sup>1107</sup> this jurisprudence having been confirmed by the reformulation of Article 24(4) of the Brussels Ibis Regulation which constitutes an obvious (confirming) reaction to the *GAT* decision of the ECJ. According to *GAT*, the court before which infringement proceedings have been instituted has no jurisdiction to examine whether the holder of the concerned patent is entitled to this patent, if the defendant has founded the defence of invalidity on this ground of invalidity.<sup>1108</sup> The court is not only deprived of the possibility to declare the patent void due to the missing substantive entitlement, but it is even prevented from examining if the defence of invalidity is justified on this ground. On the other hand, the ECJ explicitly stated, in *Duijnstee*, that the court before which infringement proceedings have been initiated *may* examine the entitlement to the concerned patent, if the validity of the patent as such is not disputed by the parties. However, the problem is that conferring such jurisdiction to a court to examine the defendant's entitlement to the concerned patent logically implies to give the court the competence to simultaneously decide on the (missing) entitlement of the claimant, and therefore, mediately, on the (in)validity of the concerned patent. In this respect, the *Duijnstee* decision and the *GAT* decision are to be considered contradictory. In this respect, it is not convincing to argue that both decisions could be harmonised by interpreting the *GAT* decision in the way that the examination of the defendant's missing substantive entitlement to the patent does not positively contain any statement on the actual substantive entitlement to the patent and thus the validity of the patent.<sup>1109</sup> On the basis of a rational consideration, it seems rather preferable to accept that the ECJ has, inasmuch as this problem is affected, modified its jurisprudence and overruled *Duijnstee*.

#### **2.4.2.4.5.2 Legally binding decision on the validity of the patent in the State where it has been granted**

Another constellation in which one might consider Article 24(4) not to be applicable despite the defendant's defence of invalidity of the patent while infringement proceedings have been instituted, due to the fact that the defence is obviously unfounded, is the existence of a legally binding decision on the validity of the concerned patent, confirming its validity, and based on the same ground of invalidity as well as the same reasoning and the same facts as the invalidity defence, by the administrative authority which has granted the patent or by a court in the State where the patent has been granted. Concerning European patents, decisions of the European Patent Office would be relevant. Article 99(2) of the European Patent Convention states as to the ambit of an opposition to a granted European patent:

“(2) The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.”

With regard to national patents, it is to be differentiated between systems in which the competent national authorities examine both the formal and substantive conditions of a patent before granting it – then legally binding decisions of these national authorities would be relevant – and other systems in which national authorities merely examine the formal conditions of a patent. Within States which follow the latter system, court decisions would become relevant in this context.

---

<sup>1107</sup> Schauwecker 2009, p. 284.

<sup>1108</sup> Schauwecker 2009, p. 284.

<sup>1109</sup> However, arguing in that way: Schauwecker 2009, p. 284 et seq.



However, it is to be pointed out that the defendant is not prevented, by such decisions of an administrative authority or a court, regardless of their legally binding effect, from instituting an invalidity action in the State where the patent has been granted, at least under the condition that the respective legal system provides that possibility.<sup>1110</sup>

Consequently, if the defence of invalidity would be excluded in the said conditions, the defendant would be restricted in his rights of effective legal protection, guaranteed by Article 6(1) of the European Convention on Human Rights which states *inter alia*:

“In the determination of his civil rights and obligations (...), everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law.”

It is highly doubtful if the defendant could be given the same possibilities to defend himself before the (foreign) court where infringement proceedings have been instituted. While one should expect the deciding court to manage to comprehend the foreign patent law and the foreign practice of staying proceedings,<sup>1111</sup> it is indeed to be emphasised that such an approach would lead to a different application of Article 24(4) on identical facts between the Member States.<sup>1112</sup> This would be distinctly contrary to the jurisprudence of the ECJ, which expressly warned, in its *GAT* decision, against

“(...) distortions, (...) undermining the equality and uniformity of rights and obligations arising from the Convention for the Contracting States and the persons concerned (...)”<sup>1113</sup>

This outcome is even more compelling as the legal effects of decisions significantly vary between decisions with *inter partes* effect (the decision on the validity of a patent by way of a preliminary question by the courts which have merely jurisdiction as to infringement proceedings, but not concerning validity proceedings) and decisions having *erga omnes* effect (for instance the opposition procedure before the European Patent Office). Furthermore, some Member States have installed specialised courts for decisions on the validity of patents, while civil courts are also or exclusively competent for (in)validity proceedings in other Member States.<sup>1114</sup>

For reasons of completeness and accuracy, it is to be underlined that the fact that the disregard of the defendant’s invalidity defence in infringement proceedings would effect the disregard of Article 24(4), conferring exclusive jurisdiction on the courts in the State where the patent has been granted, cannot be grounded on the reasoning of the ECJ in *GAT* that

“(...) the courts of the Contracting State in which the deposit or registration has been applied for or made is justified by the fact that those courts are best placed to adjudicate upon cases in which the dispute itself concerns the validity of the patent or the existence of the deposit or registration (...)”<sup>1115</sup>

and that

“(t)hat exclusive jurisdiction is also justified by the fact that the issue of patents necessitates the involvement of the national administrative authorities (...)”<sup>1116</sup>

---

<sup>1110</sup> This possibility exists in most European states, except Germany and Austria.

<sup>1111</sup> More sceptical: Schauwecker 2009, p. 281.

<sup>1112</sup> As to this aspect also: Schauwecker 2009, p. 281.

<sup>1113</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 30 – *GAT*.

<sup>1114</sup> Schneider 2005, p. 178 et seq.

<sup>1115</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 22 – *GAT*.

because both aspects are actually not affected if the court before which infringement proceedings have been instituted does not take into consideration an invalidity defence when there is already a legally binding decision on the validity of the patent in the State where it was granted. In this constellation, the disregard of the raised defence of invalidity would even mean, on the contrary, that the cited consideration would be taken serious, because the foreign court which decides on the infringement of the patent does not decide on the (in)validity of the concerned patent, but takes into consideration the (in)validity decision of the court in the State where the patent has been granted.<sup>1117</sup>

To conclude, it is to be postulated, on the basis of the foregoing paragraphs, that a defence of invalidity of a patent is to be taken into consideration once it has been raised, regardless of the question if it is obviously unfounded.

#### 2.4.2.5 Consequences of the defence of invalidity

Having analysed the requirements which are to be set up as to the defence of invalidity, I shall now turn to a subsequent issue: the question which consequences such a defence will effect exactly. As the consequences of the invalidity defence differ depending on whether it is raised in principal proceedings or in proceedings of interim relief, I will treat these constellations separately. I shall start with an analysis of the consequences of the invalidity defence raised in principal proceedings. The question of which consequences the raise of the invalidity defence has in provisional proceedings shall be analysed in detail when discussing cross-border interim relief.

Remarkably, the wording of Article 24(4) of the Brussels Ibis Regulation which has obviously been inspired by and created in reaction to the *GAT* decision of the ECJ has not delivered a definite clarification of this issue, but restricts itself to adhering to the wording of the ECJ in its *GAT* decision. Therefore, I shall take into consideration the previous legal situation under Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation, in particular the reference for a preliminary ruling by the *Oberlandesgericht Düsseldorf* which formed the starting point of the *GAT* case of the ECJ, the Opinion of the Advocate General, the *GAT* decision of the ECJ as such and relevant opinions in legal doctrine.

*Advocate General Geelhoed* traced, in his Opinion in the *GAT* case, three different possible variants of such consequences. He noted:

“(…) The court judging the infringement can transfer the case completely, it can stay the proceedings until the court of another Member State with jurisdiction under Article 16(4) [of the Brussels Convention] rules upon the validity of the patent, or it can deal with the case itself where a defendant acts in bad faith [content in brackets added].”<sup>1118</sup>

While it has been suggested that the Advocate General intended to grant the invoked court the free choice how to act in such a situation,<sup>1119</sup> I shall focus, in the following paragraphs, on the said eventualities and analyse their strengths and weaknesses, to ultimately conclude which solution should be chosen. At this place, it is to be stressed that the ECJ itself, in its *GAT*

---

<sup>1116</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 23 – *GAT*.

<sup>1117</sup> Schauwecker 2009, p. 280.

<sup>1118</sup> Advocate General 16 September 2004, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 46 – *GAT*.

<sup>1119</sup> Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 788.

decision, did not refer to the Advocate General's considerations, but rather avoided to take an explicit position.<sup>1120</sup>

#### 2.4.2.5.1 Complete transfer of the case by the infringement court to a court having jurisdiction according to Article 24(4)

According to the first possibility noted by the Advocate General, the court before which an infringement proceeding has been initiated, would have to transfer the case completely to the (locally competent) court of the State where or, in case of a European patent, for which the patent has been granted. As has been shown above, this solution has in particular been advocated by English courts before the *GAT* decision of the ECJ and has also been upheld after this decision. Besides, parts of legal doctrine have shared this conception.<sup>1121</sup>

First, it has been stressed that the *GAT* decision of the ECJ should be evaluated in the light of the reference for a preliminary ruling by the *Oberlandesgericht Düsseldorf* which expressly referred, in its question, to the problem of whether an infringement action as such – and not only the preliminary question of the validity of the patent – has as its object the validity of the patent with the consequence that Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation) is applicable in case that an invalidity defence was raised by the defendant.<sup>1122</sup>

“Ist Art. 16 Nr. 4 EuGVÜ dahin auszulegen, dass die nach dieser Vorschrift begründete ausschließliche Zuständigkeit der Gerichte des Vertragsstaates, in dessen Hoheitsgebiet die Hinterlegung oder Registrierung eines Patentbesitzes beantragt oder vorgenommen worden ist oder aufgrund eines zwischenstaatlichen Übereinkommens als vorgenommen gilt, nur dann besteht, wenn eine Klage (mit Wirkung erga omnes) auf die Nichtigerklärung des Patentbesitzes erhoben ist, oder hat eine Klage im Sinne der vorgenannten Vorschrift die Gültigkeit von Patenten schon dann zum Gegenstand, wenn in einem Patentverletzungsverfahren der Beklagte oder in einem Verfahren auf Feststellung der Nichtverletzung eines Patentbesitzes der Kläger den Einwand erhebt, das Patent sei nicht gültig bzw. nichtig und auch aus diesem Grunde liege keine Patentverletzung vor (...) [underscores added]?”<sup>1123</sup>

In this respect, it is instructive to have a look on the official English translation of this reference for a preliminary ruling which reads as follows:

“Is Article 16(4) of the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters (‘the Brussels Convention’) to be interpreted as meaning that the exclusive jurisdiction conferred by that provision on the courts of the Contracting State in which the deposit or registration of a patent has been applied for, has taken place or is under the terms of an international convention deemed to have taken place only applies if proceedings (with erga omnes effect) are brought to declare the patent invalid or are proceedings deemed to be concerned with the validity of patents within the meaning of the aforementioned provision where the defendant in a patent infringement action or the claimant in a declaratory action to establish that a patent is not infringed pleads that the patent is invalid or a nullity and that there is also no patent infringement for that reason (...) [underscores added]?”<sup>1124</sup>

In the English version, the German term “*Klage*” has not been translated as “*action*”, but the broader expression “*proceedings*” has been chosen. Although this fact could certainly be based on a mere minor impreciseness, it might also underline indirectly that the

<sup>1120</sup> This has been rightly criticised in legal doctrine, cf. among others Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 787.

<sup>1121</sup> Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 798; Bukow 2007, p. 69 et seq.; Kubis (2007)98(5) Mitt. 220, at p. 222; Torremans 2008, p. 71.

<sup>1122</sup> Bukow 2007, p. 69 et seq.

<sup>1123</sup> OLG Düsseldorf 5 December 2002, 2 U 104/01, (2003)52(12) GRUR Int. 1030 – *GAT*.

<sup>1124</sup> OLG Düsseldorf 5 December 2002, 2 U 104/01, (2003)52(12) GRUR Int. 1030 – *GAT*.

*Oberlandesgericht Düsseldorf* actually stressed in its reference for a preliminary ruling the possibility that the *whole* infringement proceeding could be affected by the application of Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation). However, it appears to go too far to conclude from the formulation of the discussed reference for a preliminary ruling that the *Oberlandesgericht Düsseldorf* itself assumed that Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) would be applicable to the whole infringement proceeding as soon as the invalidity defence has been raised.<sup>1125</sup> The court rather chose a neutral formulation that could be answered in the positive as well as in the negative. In addition, it would seem exaggerated to derive such a conception of the *Oberlandesgericht Düsseldorf* from the fact that it would otherwise have posed the additional question to the ECJ which are the jurisdictional consequences for infringement proceedings as such if only the validity aspect was to be decided by the courts having jurisdiction according to Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation).<sup>1126</sup>

Be that as it may: In the absence of a clear legal provision – as has already been mentioned, Article 24(4) of the Brussels Ibis Regulation does not deliver such clarity with regard to the concerned issue – it is ultimately the judgment of the ECJ which is decisive. Despite a certain correlation between a reference for a preliminary ruling and the respective judgment of the ECJ insofar as the ECJ may not decide more than is covered by the reference, this does not imply that the ECJ silently adopts (or even has to adopt) a specific understanding of legal constructions and consequences of the referring court. In light of this, the mere fact that the ECJ did not expressly decide on the legal consequences of the applicability of Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) does not strike for the interpretation that the court before which infringement proceedings have been initiated is fully deprived of jurisdiction when an invalidity defence is raised.<sup>1127</sup>

Furthermore, it has been concluded from the fact that the ECJ, in its *GAT* decision, did not treat, let alone take into account the variant eventualities indicated by the Advocate General of staying the proceedings until the court of another Member State with jurisdiction under Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) rules upon the validity of the patent, or dealing with the case itself where a defendant acts in bad faith, but merely pointed to the applicability of Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) and Article 17 of the Brussels Convention (Article 27 of the Brussels Ibis Regulation) also in the case of the raise of an invalidity defence, that Articles 16(4) and 17 of the Brussels Convention (Articles 24(4) and 27 of the Brussels Ibis Regulation) must be applied to the *complete* infringement proceeding.<sup>1128</sup> Again, it is to be stressed that the mere fact of the ECJ's silence with regard to the Advocate General's Opinion does not suffice to derive further consequences from it. What the ECJ had in mind when rendering its *GAT* decision must be established from what the ECJ has positively stated in this decision as well as in previous decisions. In this respect, it is to be noticed that the ECJ explicitly confirmed that other courts than the courts of the States where (or for which) patents have been granted can have jurisdiction where the validity of the concerned patent is not doubted:

---

<sup>1125</sup> Interpreting the reference for a preliminary ruling by the *Oberlandesgericht Düsseldorf* in this way: Schauwecker 2009, p. 290 et seq.; unclear in this respect: Bukow 2007, p. 69 et seq.

<sup>1126</sup> Arguing in that way though: Schauwecker 2009, p. 291.

<sup>1127</sup> Coming to the same evaluation in this respect: Schauwecker 2009, p. 291.

<sup>1128</sup> Luginbühl & Stauder (2006)10(12) sic! 876, at p. 878.

“If, on the other hand, the dispute does not concern the validity of the patent (...) and these matters are not disputed by the parties, the dispute will not be covered by Article 16(4) of the [Brussels] Convention (Duijnste, paragraphs 25 and 26). Such would be the case, for example, with an infringement action, in which the question of the validity of the patent allegedly infringed is not called into question [content in brackets added].”<sup>1129</sup>

Although it is true that not all alleged infringers will raise the issue of invalidity, some of them refraining from filing an invalidity action because of the costs involved in invalidity proceedings, others being contractually prevented from doing so, for instance if they are the patent holder’s licensees,<sup>1130</sup> it is nonetheless expectable that the defence of invalidity will frequently (or even usually) be raised. This matter of fact has been explicitly pronounced by the ECJ in its *Roche Nederland* decision, stating that it

“(…) is frequently the case in practice (...) (that) the validity of the patent would be raised indirectly.”<sup>1131</sup>

Therefore, a conception according to which the court before which infringement proceedings have been initiated completely loses jurisdiction would have the effect that the quoted passage of the *GAT* decision actually becomes senseless. Besides, it is to be considered that the fundamental jurisdictional principle of *actor sequitur forum rei*, codified in Article 4(1), would be severely compromised if the court invoked with regard to infringement proceedings completely lost jurisdiction as a consequence of a raised invalidity defence, because, due to the mentioned fact that such a defence is often raised in the course of infringement proceedings, a lot of extraterritorial patent infringement proceedings could not be decided by the courts of the State where the defendant is domiciled.<sup>1132</sup>

Additionally, it must be borne in mind that the principle of *perpetuatio fori* would be disregarded or even devalued<sup>1133</sup> if a court before which infringement proceedings have been brought would totally lose jurisdiction afterwards due to the pure fact of a defence raised by the defendant. This principle does not only apply to Article 4, but is also applicable to all other places of jurisdiction.<sup>1134</sup> According to this principle, a court will not lose jurisdiction by posterior incidents after the action has been submitted, because the claimant’s trust in that what he knew when submitting the action shall be protected.<sup>1135</sup> In particular, the defendant must not be enabled to deprive the claimant of the established place of jurisdiction.<sup>1136</sup> The ECJ has at several occasions confirmed this principle of *perpetuatio fori*. In its decision in *Danmarks Rederiforening*, on the interpretation of Article 5(3) of the Brussels Convention, the court held, also referring to previous case-law:

“(…) (I)t must be observed that, according to settled case-law, the strengthening of the legal protection of persons established in the Community by enabling the claimant to identify easily the court in which he may sue and the defendant reasonably to foresee in which court he may be sued, is one of the

---

<sup>1129</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 16 – *GAT*.

<sup>1130</sup> Gonzalez Beilfuss 2008, p. 86.

<sup>1131</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 40 – *Roche Nederland*.

<sup>1132</sup> Fawcett 2002, p. 145.

<sup>1133</sup> Schack 2009, p. 331; cf. Bukow 2007, p. 71: “Der Grundsatz der „perpetuatio fori“ wäre damit (...) entwertet.” However, despite his critical attitude, *Bukow* accepts this consequence as inevitable..

<sup>1134</sup> Mankowski 2011 (Rauscher), Art 2 Brüssel I-VO, para. 4.

<sup>1135</sup> Mankowski 2011 (Rauscher), Art 2 Brüssel I-VO, para. 4.

<sup>1136</sup> Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 788; Schack 2010, para. 451; Mankowski (2004)50(7) RIW 481, at p. 496; Mankowski 2005, p. 875.

objectives of the Brussels Convention (Case C-256/00 *Besix* [2002] ECR I-1699, paragraphs 25 and 26, and Case C-334/00 *Tacconi* [2002] ECR I-7357, paragraph 20).<sup>1137</sup>

“That objective would not be achieved if, after an action falling within Article 5(3) of the Brussels Convention is brought before the court of a Contracting State having jurisdiction, the suspension by the defendant of the tortious conduct giving rise to that action could have the effect of depriving the court seised of its jurisdiction, and of jurisdiction being assigned to a court in another Contracting State.”<sup>1138</sup>

In the *Susanne Staubitz-Schreiber* decision, on the interpretation of Article 3(1) of Council Regulation (EC) No 1346/2000 of 29 May 2000 on insolvency proceedings, the ECJ confirmed its jurisprudence as to the principle of *perpetuatio fori*, deciding as follows:

“In the fourth recital in the preamble to the Regulation, the Community legislature records its intention to avoid incentives for the parties to transfer assets or judicial proceedings from one Member State to another, seeking to obtain a more favourable legal position. That objective would not be achieved if the debtor could move the centre of his main interests to another Member State between the time when the request to open insolvency proceedings was lodged and the time when the judgment opening the proceedings was delivered and thus determine the court having jurisdiction and the applicable law.”<sup>1139</sup>

“Such a transfer of jurisdiction would also be contrary to the objective, stated in the second and eighth recitals in the preamble to the Regulation, of efficient and effective cross-border proceedings, as it would oblige creditors to be in continual pursuit of the debtor wherever he chose to establish himself more or less permanently and would often mean in practice that the proceedings would be prolonged.”<sup>1140</sup>

“Furthermore, retaining the jurisdiction of the first court seised ensures greater judicial certainty for creditors who have assessed the risks to be assumed in the event of the debtor's insolvency with regard to the place where the centre of his main interests was situated when they entered into a legal relationship with him.”<sup>1141</sup>

It is to be emphasised that a complete transfer of the case by the infringement court to a court having jurisdiction according to Article 24(4) would extend the competence of the latter court in an unjustified way, although provisions of exclusive jurisdiction should generally be interpreted in a restrictive way, because they structurally form exceptional rules.<sup>1142</sup>

If the court before which infringement proceedings have been brought was completely deprived of jurisdiction, the claimant could even suffer – contrary to the fundamental right guaranteed in Article 6(1) of the European Convention of Human Rights (ECHR) – a denial of justice if, for instance, the claim was already considered prescribed in the State of the court having jurisdiction in accordance with Article 24(4).<sup>1143</sup> Article 6(1) ECHR (Right to a fair trial) provides:

---

<sup>1137</sup> ECJ, 5 February 2004, C-18/02, Danmarks Rederiforening, acting on behalf of DFDS Torline A/S, v LO Landsorganisationen i Sverige, acting on behalf of SEKO Sjöfolk Facket För Service och Kommunikation, [2004] ECR I-01417, para. 36 – *DFDS Torline*.

<sup>1138</sup> ECJ, 5 February 2004, C-18/02, Danmarks Rederiforening, acting on behalf of DFDS Torline A/S, v LO Landsorganisationen i Sverige, acting on behalf of SEKO Sjöfolk Facket För Service och Kommunikation, [2004] ECR I-01417, para. 37 – *DFDS Torline*.

<sup>1139</sup> ECJ 17 January 2006, C-1/04, Susanne Staubitz-Schreiber, [2006] ECR I-00701, para. 25 – *Staubitz-Schreiber*.

<sup>1140</sup> ECJ 17 January 2006, C-1/04, Susanne Staubitz-Schreiber, [2006] ECR I-00701, para. 26 – *Staubitz-Schreiber*.

<sup>1141</sup> ECJ 17 January 2006, C-1/04, Susanne Staubitz-Schreiber, [2006] ECR I-00701, para. 27 – *Staubitz-Schreiber*.

<sup>1142</sup> Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 788.

<sup>1143</sup> Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 788.

## Article 6(1) ECHR

In the determination of his civil rights and obligations (...), everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law (...).

However, arguing in favour of the complete transfer of the case by the infringement court to a court having jurisdiction according to Article 24(4), it could be referred to Article 27 which provides:

“Where a court of a Member State is seised of a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 24, it shall declare of its own motion that it has no jurisdiction.”

In this respect, it could be put forth that Article 27 logically requires that the infringement action is *totally dismissed* and the case is *completely transferred* to the courts having jurisdiction with accordance to Article 24(4), because it would be contradictory to state first, according to the ECJ in *GAT*, that the courts having jurisdiction according to Article 24(4) generally have jurisdiction as to the validity issue, and to state afterwards that Article 27 justifies a dismissal only if the issue of the validity of the patent forms the principal issue<sup>1144 1145</sup>.

Particularly before<sup>1146</sup> the *GAT* decision of the ECJ, but also after it<sup>1147</sup>, Article 19 of the Brussels Convention/Article 25 of the Brussels I Regulation, the predecessors of Article 27 of the Brussels Ibis Regulation, have been referred to with regard to the question of how to interpret Article 16(4) of the Brussels Convention/Article 22(4) of the Brussels I Regulation. The ECJ has, in *GAT*, explicitly denied this conception:

“Article 19 of the [Brussels] Convention, which, in certain language versions, refers to a claim being brought 'principally', does not provide further clarity. Apart from the fact that the degree of clarity of the wording of that provision varies according to the particular language version, that provision, as the Commission has observed, does not confer jurisdiction but merely requires the court seised to examine whether it has jurisdiction and in certain cases to declare of its own motion that it has none [content in brackets added].”<sup>1148</sup>

In *GAT*, the ECJ “brings the very same article back in via the back door in paragraph 24 to back up its approach to the very same issue”<sup>1149</sup>, holding:

“(…) Where a court of a Contracting State is seised of a claim which is principally concerned with a matter over which the courts of another Contracting State have jurisdiction by virtue of Article 16 [of the Brussels Convention], it must declare of its own motion that it has no jurisdiction (Article 19 of the Convention). A judgment given which falls foul of the provisions of Article 16 does not benefit from

---

<sup>1144</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015): “The words ‘principally concerned’ have the effect that the court is not obliged to declare of its own motion that it has no jurisdiction if an issue which comes within the exclusive jurisdiction of another court is raised only as a preliminary or incidental matter.”

<sup>1145</sup> Bukow 2007, p. 69 et seq.; Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 797 et seq.; differently before the *GAT* decision: Bukow 2003, pp. 234-243.

<sup>1146</sup> Among others: Pertegás Sender 2002, paras. 4.40 et seq.

<sup>1147</sup> Torremans 2008, pp. 67-69.

<sup>1148</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 19 – *GAT*.

<sup>1149</sup> Torremans 2008, p. 67.

the system of recognition and enforcement under the Convention (first paragraph of Article 28 and second paragraph of Article 34 thereof) [content in brackets added].”<sup>1150</sup>

Despite that later reference to Article 19 of the Brussels Convention, it has been rightly stated that the ECJ made clear that Articles 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) and Article 19 of the Brussels Convention (Article 27 of the Brussels Ibis Regulation) must be *interpreted independently* from each other, although there is a connection between both provisions.<sup>1151</sup> This result is confirmed by the following consideration: While, according to the *GAT* decision, Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) is also applicable in the case of an invalidity defence (and not only in the case of an invalidity counter-claim), Article 19 of the Brussels Convention (Article 27 of the Brussels Ibis Regulation) merely affects a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation). According to this conception, Article 27 actually bears an independent meaning.

In this respect, it is to be noticed that the *Oberlandesgericht Düsseldorf*, in its reference for a preliminary ruling, took into consideration both the constellation of an invalidity defence raised during an infringement proceeding and the constellation of a separate declaratory action initiated by the defendant of the infringement proceeding, formulating:

“(…) where the defendant in a patent infringement action or the claimant in a declaratory action to establish that a patent is not infringed pleads that the patent is invalid or a nullity (…)?”<sup>1152</sup>

The ECJ likewise addressed both constellations when deciding that

“(…) Article 16(4) of the [Brussels] Convention is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection [content in brackets added].”<sup>1153</sup>

This jurisprudence of the ECJ has been codified in Article 24(4) of the Brussels Ibis Regulation.

It can be presumed from the formulation of the *Oberlandesgericht Düsseldorf*, and actually derived from the *GAT* decision of the ECJ and the present formulation in Article 24(4) of the Brussels Ibis Regulation, that an invalidity defence and a separate invalidity/nullity counter-claim are to be treated equally as to their jurisdictional consequences. However, it is not doubted that, in the case of a separate invalidity/nullity counter-claim, Article 24(4) merely affects that latter action and not the infringement action, and consequently the duty of the court according to Article 27 to declare that it is not competent to decide only concerns the invalidity/nullity counter-claim. In light of this, it is logical to proceed in the same way as to an invalidity defence raised in the framework of an infringement proceeding, i.e. to apply Article 24(4) and Article 27 only to the issue of validity of the concerned patent, leaving

---

<sup>1150</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 24 – *GAT*.

<sup>1151</sup> Schauwecker 2009, p. 293.

<sup>1152</sup> OLG Düsseldorf 5 December 2002, 2 U 104/01, (2003)52(12) GRUR Int. 1030 – *GAT*.

<sup>1153</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 31 – *GAT*.



jurisdiction for the remaining infringement proceeding to the court where the infringement proceeding has been initiated.<sup>1154</sup>

The insight that Article 27 is to be interpreted independently from Article 24 is also underlined by the Jenard Report (concerning the previous provisions of the Brussels Convention):

“The words 'principally concerned' have the effect that the court is not obliged to declare of its own motion that it has no jurisdiction if an issue which comes within the exclusive jurisdiction of another court is raised only as a preliminary or incidental matter [underscores added].”<sup>1155</sup>

Remarkably, the English version of the Jenard Report refers to the term “issue” which can be interpreted as being in contrast to the whole proceeding. Such an interpretation is supported by the comparison with other language versions of the Jenard Report such as the German, French or Dutch versions which read as follows:

“Aus den Worten ‘wegen einer Streitigkeit angerufen’ ergibt sich, daß dieses Gericht sich nicht von Amts wegen für unzuständig erklären darf, wenn ein Streitpunkt, der zur ausschließlichen Zuständigkeit eines anderen Gerichts gehört, lediglich als Vorfrage aufgeworfen wird [underscores added].”<sup>1156</sup>

“Il résulte des mots ‘saisi à titre principal’ que ce juge ne doit pas se déclarer d'office incompetent si la question qui relève de la compétence exclusive à un autre tribunal n'est soulevée qu'à titre d'exception [underscores added].”<sup>1157</sup>

“Uit de woorden ‘bij wie een geschil aanhangig is gemaakt’ volgt, dat deze rechter zich niet ambtshalve onbevoegd moet verklaren indien de vraag die tot de uitsluitende bevoegdheid van een ander gerecht behoort slechts als exceptie is opgeworpen [underscores added].”<sup>1158</sup>

Even more impressively than in the English version of the discussed passage of the report, these other language versions reveal the undertaken differentiation between *Streitigkeit* – *Streitpunkt*, *titre principal* – *question*, and *geschil* – *vraag*. In this light, it seems convincing to interpret Article 27 in the way that it only affects the issue that is actually covered by Article 24, i.e. it is only to this extent, namely as to the question of invalidity of the concerned patent, that the court seised must declare of its own motion that it has no jurisdiction.<sup>1159</sup>

Besides, it has been rightly highlighted that the *Roche Nederland* decision of the ECJ, which was rendered on the same day as the *GAT* decision and explicitly refers to it, is to be considered in this context.<sup>1160</sup> In *Roche Nederland*, the ECJ held:

“Finally, even assuming that the court seised by the defendant were able to accept jurisdiction on the basis of the criteria laid down by the national court, the consolidation of the patent infringement actions before that court could not prevent at least a partial fragmentation of the patent proceedings, since, as is frequently the case in practice and as is the case in the main proceedings, the validity of the patent would be raised indirectly. That issue, whether it is raised by way of an action or a plea in objection, is a

<sup>1154</sup> Schauwecker 2009, p. 295.

<sup>1155</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>1156</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:DE:PDF>> (lastly accessed on 1 June 2015).

<sup>1157</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:FR:PDF>> (lastly accessed on 1 June 2015).

<sup>1158</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:NL:PDF>> (lastly accessed on 1 June 2015).

<sup>1159</sup> Bukow 2003, pp. 207, 234-248; Schauwecker 2009, p. 294.

<sup>1160</sup> Schauwecker 2009, p. 295.

matter of exclusive jurisdiction laid down in Article 16(4) of the Brussels Convention in favour of the courts of the Contracting State in which the deposit or registration has taken place or is deemed to have taken place (GAT, paragraph 31) (...) [underscore added].”<sup>1161</sup>

The question to be answered is what the ECJ had in mind when using the term “partial fragmentation”. To be more precise, the question may be formulated as follows: Which constellation is conceivable in the given context where patent proceedings would be at least partially fragmented? In this respect, it seems reasonable that the ECJ had in mind the situation that the raise of an invalidity defence as well as the initiation of an invalidity/nullity counter-claim have the effect that the courts having jurisdiction according to Article 24(4) gain exclusive competence as to the validity issue, but the court before which the infringement proceeding has been initiated stays competent for the rest of the dispute beyond that validity issue.<sup>1162</sup>

To conclude, it is to be pointed out that *Advocate General Geelhoed’s* traced possibility of a complete transfer of the case by the infringement court to a court having jurisdiction according to Article 24(4), if the invalidity issue has been raised, is to be rejected.

#### **2.4.2.5.2 Decision by the infringement court assuming that the concerned patent is existent and valid**

Having denied the possibility of a complete dismissal of an infringement action in the case that the defendant raises the defence of the invalidity of the patent in question, I shall now examine if, respectively in which circumstances, the infringement court may decide on the infringement action, on the assumption that there is an existent and valid patent.<sup>1163</sup>

In the analysis, I shall again start from the *GAT* decision of the ECJ. The court formulated in a comprehensive way:

“In the light of the position of Article 16(4) [of the Brussels Convention] within the scheme of the Convention and the objective pursued, the view must be taken that the exclusive jurisdiction provided for by that provision should apply whatever the form of proceedings in which the issue of a patent's validity is raised, be it by way of an action or a plea in objection, at the time the case is brought or at a later stage in the proceedings [content in brackets added].”<sup>1164</sup>

This corresponds to the wording of Article 24(4) of the Brussels Ibis Regulation. The crucial question which arises in this context is the following: Does the *GAT* decision of the ECJ mean that the infringement court is completely barred from dealing with the validity issue – including simply assuming the *validity* of the concerned patent – or did the ECJ merely intend to avoid that the infringement court positively decides – the outcome of this decision being open – on the validity issue?

---

<sup>1161</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 40 – *Roche Nederland*.

<sup>1162</sup> Interpreting the quoted passage of the *Roche Nederland* decision in this way: *Forner Delaygua* 2008, p. 278: “On the contrary, this part of the reasoning assumes that there is a competent court to hear on the infringement other than an Article 22(4) court, although validity issue is not within the reach of the first court.”; *Schauwecker* 2009, p. 295.

<sup>1163</sup> It has already been stated that the disregard of an invalidity defence due to the fact that the defendant is considered to raise the defence in bad faith should not be permitted.

<sup>1164</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 25 – *GAT*.

It has been depicted as a (theoretical) possibility<sup>1165</sup> or even as an inevitable fact<sup>1166</sup> that, if infringement litigation takes place in a court not being competent according to Article 24(4) (respectively its predecessors), which does not stay the proceedings, validity cannot be settled and infringement should be decided on the assumption that there is an existent, valid right under another Member State law.

However, a closer analysis of the *GAT* decision of the ECJ reveals that the court did not intend to achieve that result.<sup>1167</sup> In this respect, it is to be noticed that the ECJ founded its decision as to the justification of exclusive jurisdiction according to Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation) on the idea of a sufficient link between the deciding court and the proceedings in fact and law:

“In relation to the objective pursued, it should be noted that the rules of exclusive jurisdiction laid down in Article 16 of the [Brussels] Convention seek to ensure that jurisdiction rests with courts closely linked to the proceedings in fact and law [content in brackets added].”<sup>1168</sup>

The ECJ then explicitly addressed two aspects to explain when such a close link exists:

“Thus, the exclusive jurisdiction in proceedings concerned with the registration or validity of patents conferred upon the courts of the Contracting State in which the deposit or registration has been applied for or made is justified by the fact that those courts are best placed to adjudicate upon cases in which the dispute itself concerns the validity of the patent (...). The courts of the Contracting State on whose territory the registers are kept may rule, applying their own national law, on the validity and effects of the patents which have been issued in that State. This concern for the sound administration of justice becomes all the more important in the field of patents since, given the specialised nature of this area, a number of Contracting States have set up a system of specific judicial protection, to ensure that these types of cases are dealt with by specialised courts [underscore added].”<sup>1169</sup>

“That exclusive jurisdiction is also justified by the fact that the issue of patents necessitates the involvement of the national administrative authorities (...) [underscore added].”<sup>1170</sup>

It is to be noticed that the ECJ generally referred to the jurisprudence upon cases in which the validity issue is concerned, and emphasised the essential involvement of the respective national administrative authorities. These considerations illustrate clearly the ECJ’s conception that Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) does not only confer exclusive jurisdiction on the respective courts with regard to the decision that a patent be invalid, but rather covers the whole process of dealing with a patent’s validity, i. e. including the mere assumption of the validity of the concerned patent. In this light, a decision of the court before which infringement proceedings have been initiated on the infringement action, on the assumption of an existent and valid patent, would form a violation of Article 24(4).<sup>1171</sup>

Similarly, the *Hoge Raad* held in a decision in the course of infringement proceedings concerning a European patent, rendered after the *GAT* decision of the ECJ:

---

<sup>1165</sup> Kur (2006)37(7) IIC 844, at p. 852.

<sup>1166</sup> Forner Delaygua 2008, p. 277.

<sup>1167</sup> This evaluation is also suggested by *Kur*, cf. Kur (2006)37(7) IIC 844, at p. 852.

<sup>1168</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 21 – *GAT*.

<sup>1169</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 22 – *GAT*.

<sup>1170</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 23 – *GAT*.

<sup>1171</sup> Differently: Schauwecker 2009, p. 287.

“Door de beslissing van het HvJ EG in het arrest GAT/Luk is m.i. het fundament weggenomen onder de opvatting dat de geadieerde rechter (...) mag uitgaan van de geldigheid van het buitenlandse deel van de octrooibundel zolang de daartoe bevoegde buitenlandse autoriteit niet heeft beslist dat het desbetreffende recht ongeldig of nietig is. Het enkele feit dat de verweerder het bestaan of de geldigheid van het uitsluitend recht betwist is volgens het HvJ EG al voldoende om de geadieerde rechter (...) onbevoegd te maken tot enigerlei beslissing die betrekking heeft op het geschil over de geldigheid of ongeldigheid van het buitenlandse deel van de octrooibundel. Oudere andersluidende opvattingen zijn door deze beslissing van het HvJ EG achterhaald.”<sup>1172</sup>

(“According to my opinion, the decision of the ECJ in GAT/Luk has taken away the basis of the conception that the deciding court (...) may assume the validity of the foreign part of the bundle of patents as long as the competent foreign authority has not decided that the respective right is invalid or a nullity. The mere fact that the defendant contests the existence or the validity of the exclusive right suffices, according to the ECJ, to deprive the deciding court (...) of jurisdiction as to any decision that concerns the dispute on the validity or the invalidity of the foreign part of the bundle of patents. Previous different conceptions have become obsolete as a consequence of this decision of the ECJ [underscore added].”)<sup>1173</sup>

But even if one denied a violation of Article 24(4) in this constellation, because the infringement court would simply respect the decision of the national administrative authority which granted the patent, there would be the problem that some EU Member States dispose of register systems in which patents are granted without a previous examination of the substantive conditions of patentability, bearing the consequence that there is actually *no* assumption of the validity of the concerned patent. In these systems, the task of examining the patentability, and thus the validity of a patent, is rather conferred on the courts in case of an initiated proceeding. Consequently, the sole assumption of the validity of a patent, by the infringement court, would be irreconcilable with the mentioned register systems.<sup>1174</sup>

Besides, the assumption of the validity of the patent in question would promote and even provoke *forum shopping* by the claimant who would be tempted not to sue the defendant in the State where or for which territory a patent was granted, but in another State where the defendant could not effectively raise the defence of invalidity of the patent. Admittedly, it is to be borne in mind that the provisions of the Brussels Ibis Regulation on exclusive jurisdiction, such as Article 24(4), are to be considered exceptions from the general provision of Article 4(1) and the provisions of special jurisdiction. It is also a fact that pure patent infringement proceedings are not affected by Article 24(4) which has been confirmed by the ECJ in its *GAT* decision concerning Article 16(4) of the Brussels Convention:

“If (...) the dispute does not concern the validity of the patent (...) and these matters are not disputed by the parties, the dispute will not be covered by Article 16(4) of the [Brussels] Convention (...). Such would be the case, for example, with an infringement action, in which the question of the validity of the patent allegedly infringed is not called into question [content in brackets added].”<sup>1175</sup>

However, as has been rightly criticised, such an approach would ultimately be contrary to the concept of the Brussels Ibis Regulation as a whole,<sup>1176</sup> because it would be based on the devaluation of particular provisions, providing an incentive to circumvent them. As a consequence, the *effet utile* of the Brussels Ibis Regulation would be seriously jeopardised.

---

<sup>1172</sup> HR 30 November 2007, C02/228HR and C02/280HR, Roche Nederland BV (Netherlands) and Others v Dr. F.J. Primus and Dr. M.D. Goldenberg, NJ 2008, 77, Conclusion, para. 2.15 – *Roche Nederland*.

<sup>1173</sup> Translation provided by the author of this thesis.

<sup>1174</sup> Agreeing in this respect: Schauwecker 2009, p. 287.

<sup>1175</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 16 – *GAT*.

<sup>1176</sup> Schauwecker 2009, p. 287.

Furthermore, it is to be underlined that depriving the defendant of the possibility to raise the defence of invalidity of the patent would at the same moment form a severe restriction of the defendant's rights in a proceeding and must be considered contrary to Article 6(1) ECHR which guarantees the right to a fair trial.

Having arrived at the conclusion that the infringement court may not simply assume that the patent in question is existent and valid despite a raised invalidity defence, I shall now turn to the examination whether this outcome should apply without exceptions or whether specific circumstances are conceivable in which the court before which infringement proceedings have been initiated should have jurisdiction to decide although the defendant has raised the validity issue. In this respect, it has been proposed by parts of legal doctrine to admit such an exception in the case that the raised invalidity defence is not decisive, because the allegation of an infringement of the concerned patent must be denied for other reasons, such as a right to use the patent granted to the alleged infringer.<sup>1177</sup> It has been put forward that the defendant's rights will actually not be jeopardised in this constellation because his invalidity defence will have no effect if the existence of a patent infringement is excluded for other reasons. In addition, it has also been underlined that the invalidity defence will usually be made under the condition (as a "last resort") that no other defence will effect that the accusation of a patent infringement is invalidated.<sup>1178</sup> Although, beyond dispute, these considerations provide a certain attraction, because they obviously attempt to find a balance between procedural reality and the jurisprudence of the ECJ, they should not be followed for several reasons.

First of all, it is not for sure that the invalidity defence is regularly raised as a "last resort". And even if this should be the case, then a different treatment of cases in which the invalidity defence has been raised as "last resort" and other cases in which only this defence has been raised should be avoided, because the defendant has the possibility to recall a defence. Should, where the defendant initially raised two defences, among those the invalidity defence, and in the course of the proceeding merely adheres to the invalidity defence, the infringement court lose jurisdiction at this moment, maybe after having almost rendered a decision? For reasons of clearness and procedural economy, the answer should definitely be in the negative, although it is admitted that the described constellation may resemble the constellation where initially no defence at all has been raised and the invalidity defence is then raised in the course of the infringement proceeding. In its *GAT* decision, the ECJ stated as to Article 16(4) of the Brussels Convention that

“(...) the exclusive jurisdiction provided for by that provision should apply (...) at the time the case is brought or at a later stage in the proceedings [underscore added].”<sup>1179</sup>

Secondly, it is to be pointed out that the ECJ, in its *GAT* decision, stated clearly that Article 24(4) is to be applied in *any* case where the defendant has raised the defence of invalidity of the concerned patent, and that this jurisprudence has been codified in Article 24(4) of the Brussels Ibis Regulation in the meanwhile. While it is true that an invalidity defence will finally have no effect if the accusation of patent infringement is invalidated by another defence, it stays a matter of fact that it has been raised and that its mere raise deprives the court before which infringement proceedings have been initiated of jurisdiction. The argumentation that the defence of invalidity, in the described constellation, is only raised due

---

<sup>1177</sup> Cf. Schauwecker 2009, p. 288. *Schauwecker* additionally mentions further constellations in which a patent infringement is excluded.

<sup>1178</sup> Schauwecker 2009, p. 287.

<sup>1179</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 25 – *GAT*.

to formal reasons, because defences are normally brought collectively, also in order to meet rules of preclusion,<sup>1180</sup> is not convincing, because it cannot override the explicit ruling of the ECJ in *GAT*, where the court merely referred to the raise of an invalidity defence independently of the reason why the defence has been raised, let alone set aside the clear text of Article 24(4) of the Brussels Ibis Regulation. In this respect, another viewpoint is to be considered irreconcilable with the ECJ's jurisprudence in *GAT*, respectively the clear will of the European legislator who, inspired by the *GAT* decision and in reaction to it, changed the wording of Article 22(4) of the Brussels I Regulation into the wording of Article 24(4) of the Brussels Ibis Regulation. The evaluation that the described situation would be comparable to the situation where no invalidity defence has been raised because the action failed for another reason,<sup>1181</sup> goes astray.

In summary, it is to be highlighted that the infringement court may not, without any exceptions, simply assume that the concerned patent exists and is valid, where the validity issue is raised by the defendant.

#### **2.4.2.5.3 Stay of the infringement proceedings until the court of another Member State with jurisdiction under Article 24(4) has ruled upon the validity of the patent**

Having denied both the possibility of a complete transfer of the case by the infringement court to a court having jurisdiction according to Article 24(4) and the solution that the infringement court renders a decision on the assumption that the concerned patent is existent and valid, I shall now analyse the third possibility proposed by *Advocate General Geelhoed*, according to which the infringement court would stay infringement proceedings until a court having jurisdiction according to Article 24(4) has decided the validity issue.

Remarkably, this solution has been advocated to a considerable extent both by legal doctrine<sup>1182</sup> and courts after the *GAT* decision of the ECJ. For instance, the *Rechtbank 's-Gravenhage* held in the *Sisvel* decision:

“(…) Moduslink [one of the defendants] heeft immers nog niet voor antwoord geconcludeerd en derhalve nog geen verweer ten principale gevoerd. Een beslissing omtrent de thans aan de orde gestelde grensoverschrijdende bevoegdheid kan pas daarna worden genomen. In verband daarmee zal die beslissing worden aangehouden tot de einduitspraak in de hoofdzaak [underscore and content in brackets added].”<sup>1183</sup>

“(…) Moduslink [one of the defendants] still has not replied to the action and therefore has not raised a defence concerning the principal proceeding. A decision as to the currently contested cross-border jurisdiction can only be rendered afterwards. In this context, that decision shall be stayed until the final judgment in the principal proceeding [underscore and content in brackets added].”<sup>1184</sup>

Similarly, the *Hoge Raad* has decided, in *Roche Nederland*:

<sup>1180</sup> Schauwecker 2009, p. 287.

<sup>1181</sup> Arguing in this way though: Schauwecker 2009, p. 287.

<sup>1182</sup> Among others: Szychowska 2008, p. 216; Wilderspin (2006)95(4) Rev. crit. DIP 777, at p. 795; Adolphsen (2007)27(1) IPRax 15, at p. 19.

<sup>1183</sup> Rb. ‘s-Gravenhage 9 August 2006, Case No. 257421 / HA ZA 06-167, and Case No. 257423 / HA ZA 06, *Societa Italiana per lo Sviluppo dell'Elettronica S.I.S.V.E.L. SpA v Sandisk Corporation and Others*, NJF 2006, 540, para. 6.7 – *Sisvel*.

<sup>1184</sup> Translation provided by the author of this thesis.

“(…) Art. 16, onder 4, EEX/EVEX, zoals deze bepaling door het HvJ EG wordt uitgelegd, brengt – ongeacht de woonplaats van de verweerder – mee dat de Nederlandse rechter geen uitspraak kan doen in een geschil over de geldigheid van het buitenlandse deel van de octrooibundel. In theorie laat de uitspraak van het HvJ EG de geadieerde Nederlandse rechter ruimte om de beslissing in de inbreukzaak aan te houden in afwachting van de onherroepelijke uitkomst van een elders te voeren procedure over de geldigheid van het uitsluitend recht. Na afloop kan de behandeling van de inbreukzaak worden hervat en kan de Nederlandse rechter, zich onvoorwaardelijk richtend naar de uitkomst van de procedure in het in art. 16, onder 4, EEX/EVEX aangewezen land (waarmee vast staat of het desbetreffende buitenlandse deel van de octrooibundel wel of niet geldig is), een oordeel geven over de vraag of de gestelde inbreuk heeft plaatsgevonden en wat daarvan de rechtsgevolgen zijn (...) [underscore added].”<sup>1185</sup>

“(…) Article 16(4) of the Brussels/Lugano Convention implies, according to the interpretation of this provision of the ECJ, notwithstanding the defendant’s place of domicile, that the Dutch court cannot render a judgment in a dispute on the validity of the foreign part of the bundle of patents. In theory, the decision of the ECJ leaves the possibility to the deciding Dutch court to stay infringement proceedings until the irrevocable outcome of a proceeding, on the validity of the exclusive right, which has to be conducted first. After finishing that, the treatment of the infringement proceedings can be resumed, and the Dutch court can, acting unconditionally in accordance with the outcome of the proceeding in the State determined by Article 16(4) of the Brussels/Lugano Convention (whereby it is certain whether the respective foreign part of the bundle of patents is valid or not), render a judgment on the issue of whether the alleged infringement took place and which are the legal consequences thereof (...) [underscore added].”<sup>1186</sup>

#### 2.4.2.5.3.1 On which legal basis can a stay of infringement proceedings be founded?

In the following paragraphs I shall first address the essential problem on which legal basis a court before which infringement proceedings have been initiated can/shall stay the proceedings until the validity issue, if and as soon as it has been raised, has been decided by a court having jurisdiction according to Article 24(4).

Due to the primacy in application of the provisions of the Brussels Ibis Regulation vis-à-vis provisions of the national (procedural) laws of the Member States, it is to be considered first whether the Brussels Ibis Regulation contains a rule that can serve as legal basis for the described constellation. In Section 9 (Lis pendens – related actions), the Brussels Ibis Regulation contains several provisions (Articles 29 to 34) dealing with constellations that might fit to the constellation in question. The goal of the following research is to find out if one of these provisions is applicable.

##### 2.4.2.5.3.1.1 Article 29

Section 9 of the Brussels Ibis Regulation starts with the provision of Article 29 that reads:

#### Article 29 of the Brussels Ibis Regulation

(1) Without prejudice to Article 31(2), 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.

<sup>1185</sup> HR 30 November 2007, C02/228HR and C02/280HR, Roche Nederland BV (Netherlands) and Others v Dr. F.J. Primus and Dr. M.D. Goldenberg, NJ 2008, 77, Conclusion, para. 2.16 – *Roche Nederland*.

<sup>1186</sup> Translation provided by the author of this thesis.

(2) In cases referred to in paragraph 1, upon request by a court seised of the dispute, any other court seised shall without delay inform the former court of the date when it was seised in accordance with Article 32.

(2) Where the jurisdiction of the court first seised is established, any court other than the court first seised shall decline jurisdiction in favour of that court.

As to the concerned constellation that the court before which infringement proceedings have been initiated first stays infringement proceedings until a court competent according to Article 24(4) has decided on the validity issue, it is obvious that Article 29 cannot serve as a legal basis. First of all, it is to be noticed that both proceedings in question are led by the same parties, but do not involve the same cause of action,<sup>1187</sup> even if this term is interpreted in a broad sense.<sup>1188</sup> Besides, Article 29 requires that two *actions* have been brought in the courts of different Member States. In this respect, Article 32 contains specific rules to define when a court is to be considered as seised:

#### **Article 32 of the Brussels Ibis Regulation**

(1) For the purposes of this Section, a court shall be deemed to be seised:

(a) at the time when the document instituting the proceedings or an equivalent document is lodged with the court, provided that the claimant has not subsequently failed to take the steps he was required to take to have service effected on the defendant, or

(b) if the document has to be served before being lodged with the court, at the time when it is received by the authority responsible for service, provided that the claimant has not subsequently failed to take the steps he was required to take to have the document lodged with the court.

The authority responsible for service referred to in point (b) shall be the first authority receiving the documents to be served.

(2) The court, or the authority responsible for service, referred to in paragraph 1, shall note, respectively, the date of the lodging of the document instituting the proceedings or the equivalent document, or the date of receipt of the documents to be served.

In the constellation in question, the raise of the defence of invalidity of the concerned patent does not imply that a nullity action has already been brought in the court having jurisdiction according to Article 24(4) in the moment when the invalidity defence is raised. Moreover, it is to be underlined that the legal consequence of Article 29 would be that only the court *first* seised would be entitled to make a decision. As a consequence, it would be the court before which infringement proceedings were initiated that would completely keep jurisdiction, Article 24(4) thus going astray, what would actually mean an irreconcilable conflict between Article 24(4) and Article 29. In addition to the latter argument, it is to be remarked that the intention of Article 29 is that the court seised after another court, in the situation described, shall grant time to the court seised first to examine if it has jurisdiction (Article 29(1)) and, if and once it has been established that the court first seised has jurisdiction, that the court secondly seised shall decline jurisdiction in favour of the court first seised. In contrast to this conception, which is based on the situation that *the whole case* shall be decided by one single court, the constellation as to a stay of infringement proceedings until the validity issue has

---

<sup>1187</sup> Adolphsen 2009, para. 456.

<sup>1188</sup> Leible 2011 (Rauscher), Art 27 Brüssel I-VO, para. 8.



been solved by a court being competent with accordance to Article 24(4) is characterised by the situation that it is not doubted that the principal proceedings as to the alleged infringement of the concerned patent are decided by the infringement court, whereas *only the validity issue* shall be decided by a court having jurisdiction according to Article 24(4).<sup>1189</sup>

#### 2.4.2.5.3.1.2 Article 30

As the stay of infringement proceedings, until the decision of the validity issue by the competent court, thus cannot be founded on Article 29, I shall now turn to an analysis of whether Article 30 can serve as a legal basis for that procedure. Article 30 provides:

##### Article 30 of the Brussels Ibis Regulation

(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.

(2) Where the action in the court first seised is pending at first instance, any other court may also, on the application of one of the parties, decline jurisdiction if the court first seised has jurisdiction over the actions in question and its law permits the consolidation thereof.

(3) For the purposes of this Article, 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.

Again, it is to be stated that, in the case of infringement proceedings where an invalidity defence has been raised, there is only one action – the infringement action. Structurally, it is incorrect to equalise an invalidity defence and a counter-claim such as a nullity/invalidity action, because the latter constitutes a *separate (individual)* procedural means, in contrast to an *accessory* defence which can only be raised in existing proceedings. However, this differentiation has sometimes been disregarded.<sup>1190</sup>

Another issue is whether the “actions” are related as Article 30(1) requires. In this respect, Article 30(3) is to be taken into consideration, defining actions to be related if there is such a connection “that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings”, resulting in a broad comprehension of Article 30.<sup>1191</sup> In this light, two actions are to be considered related if the decision on the one action prejudices the decision on the other action. An infringement action is founded if the patent has been declared a nullity; an invalidity/nullity proceeding therefore has prejudicial effect for the infringement proceeding.<sup>1192</sup> In contrast to Article 29, a defence raised by the defendant is also to be taken into account with regard to the evaluation of whether the actions are related according to Article 30, because it is sufficient for the application of Article 30 that it is simply “expedient” to hear and determine both actions together.<sup>1193</sup> However, comparably to the situation indicated with regard to Article 29, it is to

---

<sup>1189</sup> Schauwecker 2009, p. 297 et seq.

<sup>1190</sup> Cf. for instance Hölder 2004, pp. 172-174.

<sup>1191</sup> Leible 2011 (Rauscher), Art 28 Brüssel I-VO, para. 3; Bukow 2003, p. 272; Kropholler & Von Hein 2011, Art. 28 EuGVO, para. 3; Gaudemet-Tallon 2010, para. 341; Roth 2004, pp. 754-755; Fentiman 2012 (Magnus & Mankowski), Art 28 Brussels I Regulation, paras. 14-15.

<sup>1192</sup> Hölder 2004, p. 174; Schack 2010, para. 409; Droz 1972, para. 322.

<sup>1193</sup> Leible 2011 (Rauscher), Art 28 Brüssel I-VO, para. 3a; Knight (2008)27(4) C.J.Q. 454, at p. 457.

be underlined that Article 30 merely provides the opportunity that the court *secondly* seised may decline jurisdiction, whereas the infringement court is *first* seised in the constellation discussed here. As a result, Article 30 is not applicable due to its clear wording.<sup>1194</sup>

#### **2.4.2.5.3.1.3 Article 31(1)**

The last provision in Section 9 of the Brussels Ibis Regulation that could eventually serve as a legal basis for a stay of infringement proceedings is Article 31(1) that provides:

##### **Article 31 of the Brussels Ibis Regulation**

(1) Where actions come within the exclusive jurisdiction of several courts, any court other than the court first seised shall decline jurisdiction in favour of that court.

(...)

Apart from the fact that Article 31(1), similarly to Articles 29 and 30, tends to give jurisdiction to the court first seised, it is to be mentioned that a stay of infringement proceedings in the constellation in question cannot be based on Article 31(1) because this provision premises the existence of the exclusive jurisdiction of *several* courts, whereas there is *only one* exclusive jurisdiction in the discussed constellation, namely with regard to the courts of the State where the patent has been granted.<sup>1195</sup>

#### **2.4.2.5.3.1.4 Analogous application of Article 30 (as the provision of Section 9 of the Brussels Ibis Regulation that relatively fits best)**

In light of the fact that Section 9 (Lis pendens – related actions) of the Brussels Ibis Regulation does not contain a provision on which the stay of infringement proceedings, when an invalidity defence has been raised, can be founded by way of a direct application of such a provision, it has been proposed in legal doctrine to resort to an analogous application of Article 30 (respectively its predecessors under the Brussels Convention/Brussels I Regulation).<sup>1196</sup> While, for the reasons mentioned above, it is to be appreciated that an analogous application of Articles 29 or 31(1) (respectively its predecessors under the Brussels Convention/Brussels I Regulation) has not been brought into play, because these provisions concern constellations which are without any doubt completely different from the constellation concerned here, it is however doubtful, too, whether Article 30 can be applied by way of an analogy here. In order to argue for an analogous application of Article 30 to the constellation in question, it might be put forth that the *ratio legis* of Article 30 consists in the idea that in a situation where two proceedings are closely linked with each other, the outcome of the one proceeding shall be adapted to the outcome of the other proceeding. Besides, it could be considered that Article 30 intends to solve the conflict of two different places of jurisdiction in such proceedings which are closely linked with each other.<sup>1197</sup> Referring both to the jurisprudence of the ECJ according to which opposing judgments in such proceedings

<sup>1194</sup> Cf. Wadlow 1998, para. 3–128; Bukow 2003, p. 275; Schauwecker 2009, p. 298 et seq.

<sup>1195</sup> Adolphsen 2009, para. 456.

<sup>1196</sup> Bukow 2003, pp. 275–279.

<sup>1197</sup> Bukow 2003, p. 276.

are to be avoided, and to the Jenard Report which stated that Article 22 of the Brussels Convention (which structurally corresponds to Article 30 of the Brussels Ibis Regulation)

“(…) also serves to avoid the risk of conflicting judgments and thus to facilitate the proper administration of justice in the Community (…),”<sup>1198</sup>

it could be postulated that the goal of a proper administration of justice is so paramount that the fact that Article 30 actually brings along the legal consequence that the court *first* seised keeps jurisdiction, in contrast to the constellation in question in which the court secondly brought into play is primarily competent, is less important and does not constitute a principal obstacle for an analogous application of Article 30.<sup>1199</sup>

However, the crucial question is whether it is indeed justified to apply Article 30 by way of an analogy in the given context. More precisely, it is to be questioned: Are the preconditions for an analogy actually fulfilled? Analogy premises that a factual and legal situation A for which the legislator has not foreseen any legal provisions, is *comparable* to a situation B, which has been ruled by the legislator, to such an extent that it seems justified that the legal provisions as to situation B are also applied to situation A. But – and this is essential – such an approach is only possible where it can be excluded that the legislator has not made an intentional decision when not establishing rules as to situation A. In other words, an analogy is merely possible where it is clear that the legislator has simply “forgotten” to create a provision to rule a specific constellation. Concerning the question of comparability between the constellation ruled in Article 30 and the constellation in question, it is to be stated that Article 30 covers only civil proceedings and cannot be extended to proceedings relating to the infringement of a patent and proceedings as to the validity, i.e. existence, of a patent, which can be derived from Article 30(2) which explicitly premises actions “at first instance”. Besides, the Jenard Report points towards this direction when stating:

“(…) The proceedings must, however, be pending at the same level of adjudication, for otherwise the object of the proceedings would be different and one of the parties might be deprived of a step in the hierarchy of the courts.”<sup>1200</sup>

As a consequence, the constellation in question is actually *not comparable* to the constellation which is ruled in Article 30. It is already for this reason that there is no space for an analogous application of Article 30. Moreover, the further question of whether the gap of rules within Section 9 of the Brussels Ibis Regulation has not been intended by the legislator must be denied. With regard to the constellation in question, it is hardly conceivable that the European legislator has “forgotten” to create a provision for the constellation in question. First of all, it is to be underlined that the Brussels Ibis Regulation contains specific rules of jurisdiction for infringement proceedings (general provisions) and for invalidity proceedings (Article 24(4)). Second, the national procedural laws of the EU Member States contain specific provisions that rule exactly the concerned issue of a stay of infringement proceedings when an invalidity defence has been raised within these proceedings. Last but not least, it is a fact that this issue has already been discussed under the Brussels Convention and the Brussels I Regulation. Although Article 30 has been changed in comparison with its predecessor, Article 28 of the Brussels I Regulation, the wording of Article 30 has not been constructed in such a way as to (directly) cover the concerned constellation. In light of the foregoing, it must be concluded

---

<sup>1198</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 41, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>1199</sup> Bukow 2003, p. 276.

<sup>1200</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 41, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

that the European legislator thus intentionally has not created a provision within the framework of the Brussels Ibis Regulation for this constellation. In these circumstances, it is not possible to fill the existing legal gap by way of an analogous application of a provision of the Brussels Ibis Regulation. Any other acting would be against the clear will of the legislator.<sup>1201</sup> Last but not least, it has rightly been emphasised that an analogous application would also contravene the *first-in-time principle* that forms the basis of Articles 29, 30 and 31, as it is always the court *first* seised which shall primarily keep and exert jurisdiction.<sup>1202</sup> An exception from this fundamental principle cannot simply be construed by way of an analogous application of a provision of the Brussels Ibis Regulation.<sup>1203</sup>

To conclude, it is to be stated that Article 30 is not applicable in the discussed constellation by way of an analogy, either.

#### 2.4.2.5.3.1.5 Provisions of national (procedural) law

Having arrived at the conclusion that the Brussels Ibis Regulation does not contain any provision which can serve as a legal basis for the infringement court to stay proceedings if the defence of invalidity of the concerned patent has been raised by the defendant, meaning that Article 24(4) is applicable, and having analysed as well that an analogous application of Article 30 (as the provision of Section 9 of the Brussels Ibis Regulation that relatively fits best) is not possible either, the national law of the Member States remains as a last resort.

At first glance, one might be tempted to argue that Section 9 of the Brussels Ibis Regulation contains an exhaustive system of provisions dealing with aspects of *lis pendens* and that, consequently, recourse to provisions of national law of the Member States is blocked, in particular in the light of the fundamental *first-in-time principle* which forms the basis of Articles 29, 30 and 31, which might be undermined by such a recourse to provisions of national law. Indeed, it is to be underlined that the Brussels Ibis Regulation constitutes a closed system of jurisdictional rules *as far as it is applicable*.<sup>1204</sup> So, in case that a provision of the Brussels Ibis Regulation is applicable, the *first-in-time principle* is to be respected, and only the court secondly seised will have to, respectively may, stay proceedings brought before it until the other court will have made a decision. However, I have established above that Articles 29, 30 and 31(1) concern completely different constellations than the constellation in question, without any actual comparability, and that the European legislator intentionally did not create a provision for the constellation in question within the framework of the Brussels Ibis Regulation. Thus, the *first-in-time principle* is not applicable in the constellation concerned here, either. Logically, it therefore cannot be undermined by the application of rules of national law of the Member States.<sup>1205</sup> It is generally accepted that rules of national procedural law concerning jurisdiction will be applied where and as far as the Brussels Ibis Regulation is not applicable.<sup>1206</sup>

---

<sup>1201</sup> Coming to the same conclusion as to the Brussels I Regulation: Schauwecker 2009, p. 300. Since the reform of the Brussels I Regulation into the existing system of the Brussels Ibis Regulation has not brought a clear solution of this problem, the argumentation that the European legislator *intentionally* has not created a clarifying provision gains even more weight than before the creation of the Brussels Ibis Regulation.

<sup>1202</sup> Cf. Gebauer 2007, pp. 89-100.

<sup>1203</sup> As to the Brussels I Regulation: Schauwecker 2009, p. 301.

<sup>1204</sup> Mankowski 2011 (Rauscher), Vorbem Art 2 Brüssel I-VO, para. 17.

<sup>1205</sup> Schauwecker 2009, p. 303.

<sup>1206</sup> Mankowski 2011 (Rauscher), Vorbem Art 2 Brüssel I-VO, para. 17.

It is to be mentioned that the national laws of all Member States include rules as to the stay of patent infringement proceedings until a decision of the competent court on the validity of the concerned patent.<sup>1207</sup> The question to be answered is whether the issue of a stay of infringement proceedings is a matter of substantive law or procedural law. In the first case, the *lex causae* would be applicable, in the second case, the *lex fori* would apply according to the fundamental *forum regit processum-principle*.<sup>1208</sup> Partly, the national laws of the Member States contain general procedural provisions regarding the stay of proceedings until a specific aspect has been decided by the competent authority. For instance, Section 148 of the German Code of Civil Procedure<sup>1209</sup> provides:

#### **Section 148 of the German Code of Civil Procedure**

Das Gericht kann, wenn die Entscheidung des Rechtsstreits ganz oder zum Teil von dem Bestehen oder Nichtbestehen eines Rechtsverhältnisses abhängt, das den Gegenstand eines anderen anhängigen Rechtsstreits bildet oder von einer Verwaltungsbehörde festzustellen ist, anordnen, dass die Verhandlung bis zur Erledigung des anderen Rechtsstreits oder bis zur Entscheidung der Verwaltungsbehörde auszusetzen sei.

(Where the decision on a legal dispute depends either wholly or in part on the question of whether a legal relationship does or does not exist, and this relationship forms the subject matter of another legal dispute that is pending, or that is to be determined by an administrative agency, the court may direct that the hearing be suspended until the other legal dispute has been dealt with and terminated, or until the administrative agency has issued its decision.)<sup>1210</sup>

Under English law, the court has inherent power to grant a stay of any proceedings where it thinks fit to do so because the justice of the case so demands.<sup>1211</sup> Rule 3.1(2)(f) of the English Civil Procedure Rules provides with regard to the court's general powers of management:

#### **Rule 3.1(2)(f) of the English Civil Procedure Rules**

Except where these Rules provide otherwise, the court may –

(...)

(f) stay the whole or part of any proceedings or judgment either generally or until a specified date or event (...).<sup>1212</sup>

In French procedural law<sup>1213</sup>, Article 378 of the New Code of Civil Procedure reads as follows:

<sup>1207</sup> Cf. Treichel 2001, p. 45 et seq.; Schauwecker 2009, p. 301 et seq.; Dagg (2003)94(1) Mitt. 1, at p. 1 et seq.; Hölder 2004, p. 177.

<sup>1208</sup> Geimer 2015, para. 319; Schack 2010, paras. 45-50; Hölder 2004, pp. 174-177.

<sup>1209</sup> Cf. Reimann & Kreye 2003, pp. 587-597.

<sup>1210</sup> Translation provided by Samson-Übersetzungen GmbH, Dr. Carmen von Schöning, published on the website of the German Federal Ministry of Justice, at WWW <[http://www.gesetze-im-internet.de/englisch\\_zpo/englisch\\_zpo.html#p0581](http://www.gesetze-im-internet.de/englisch_zpo/englisch_zpo.html#p0581)> (lastly accessed on 1 June 2015).

<sup>1211</sup> Hölder 2004, p. 177, there fn. 1160; Layton & Mercer 2004, para. 9.028 and there fn. 52.

<sup>1212</sup> Legal text available at WWW <<http://www.justice.gov.uk/courts/procedure-rules/civil/rules/part03#3.1>> (lastly accessed on 1 June 2015).

<sup>1213</sup> Cf. Treichel 2001, p. 45 et seq.; cf. Mousseron, Raynard & Véron (1998)29(8) IIC 884, at p. 904.

### **Article 378 of the New Code of Civil Procedure**

La décision de sursis suspend le cours de l'instance pour le temps ou jusqu'à la survenance de l'événement qu'elle détermine.<sup>1214</sup>

(The decision to stay proceedings suspends the court before which proceedings have been brought for the time or until the occurrence of the event that it determines.)<sup>1215</sup>

Other national legal provisions contain special rules which specifically concern simultaneous patent infringement and invalidity/nullity proceedings. Some of these provisions have a pure procedural meaning, such as Article L. 614-15 of the French Code of Intellectual Property which provides:

### **Article L. 614-15 of the French Code of Intellectual Property**

Le tribunal saisi d'une action en contrefaçon d'un brevet français qui couvre la même invention qu'un brevet européen demandé par le même inventeur ou délivré à celui-ci ou à son ayant cause avec la même date de priorité surseoit à statuer jusqu'à la date à laquelle le brevet français cesse de produire ses effets aux termes de l'article L. 614-13 ou jusqu'à la date à laquelle la demande de brevet européen est rejetée, retirée ou réputée retirée, ou le brevet européen révoqué (...).<sup>1216</sup>

(The court before which infringement proceedings have been brought concerning a French patent that covers the same invention as a European patent claimed by the same inventor or granted to him or his legal successor with the same priority date stays proceedings until the moment when the French patent is not any longer effective with regard to Article L. 614-13 or until the moment when the claim of the European patent has been rejected, withdrawn or is considered withdrawn, or the European patent has been withdrawn (...).)<sup>1217</sup>

Besides, there are national provisions which concern substantive law, such as Article 83(3), (4) of the Dutch Patent Act 1995, reading:

### **Article 83(3), (4) of the Dutch Patent Act 1995**

(3) Indien de rechter meent, dat op de beslissing van een geschil van invloed kan zijn een rechtsvordering, die op grond van artikel 10, 75, 77 of 78 is of zou kunnen worden ingesteld, kan hij de behandeling van het aanhangige geschil met of zonder tijdsbepaling schorsen. Gelijke bevoegdheid bezit hij, indien op de beslissing inzake zulk een rechtsvordering een uit anderen hoofde ingestelde rechtsvordering van invloed kan zijn.

---

<sup>1214</sup> Legal text available at WWW

<[http://www.legifrance.gouv.fr/affichCode.do;jsessionid=C74904491A8E3D9BEF71DC99660DB782.tpdjo08v\\_2?idSectionTA=LEGISCTA000006149667&cidTexte=LEGITEXT000006070716&dateTexte=20121208](http://www.legifrance.gouv.fr/affichCode.do;jsessionid=C74904491A8E3D9BEF71DC99660DB782.tpdjo08v_2?idSectionTA=LEGISCTA000006149667&cidTexte=LEGITEXT000006070716&dateTexte=20121208)>

(lastly accessed on 1 June 2015).

<sup>1215</sup> Translation provided by the author of this thesis.

<sup>1216</sup> Legal text available at WWW

<[http://www.legifrance.gouv.fr/affichCode.do;jsessionid=56A1718872AABB3B2C187F56104C075F.tpdjo04v\\_1?idSectionTA=LEGISCTA000006191140&cidTexte=LEGITEXT000006069414&dateTexte=20130101](http://www.legifrance.gouv.fr/affichCode.do;jsessionid=56A1718872AABB3B2C187F56104C075F.tpdjo04v_1?idSectionTA=LEGISCTA000006191140&cidTexte=LEGITEXT000006069414&dateTexte=20130101)>

(lastly accessed on 1 June 2015).

<sup>1217</sup> Translation provided by the author of this thesis.

(4) De rechter kan de behandeling van een geschil ter zake van een Europees octrooi met of zonder tijdsbepaling schorsen, indien bij het Europees Octrooibureau tegen dat octrooi oppositie is ingesteld ingevolge artikel 99 van het Europees Octrooiverdrag.”<sup>1218</sup>

((3) If it appears to the court that a decision on a matter in dispute may be influenced by proceedings instituted or possibly to be instituted according to Articles 10, 75, 77 or 78, the court may stay the proceedings relating to the matter in dispute, with or without setting a time limit. The court may also act in this way if a decision relating to such proceedings may be affected by proceedings instituted on different grounds.

(4) The court may stay proceedings relating to a dispute in respect of a European patent, with or without setting a time limit, if notice has been given to the European Patent Office of opposition to that patent by virtue of Article 99 of the European Patent Convention.)<sup>1219</sup>

Explicitly with regard to Section 148 of the German Code of Civil Procedure, it has been argued that this provision is closely linked with the particularity of German patent law that the defendant cannot raise the defence of invalidity in infringement proceedings for substantive reasons, and that this provision constitutes, concerning patent law, an essential part of the *substantive* rules of German patent law.<sup>1220</sup> However, this evaluation is to be rejected. First, the situation that a court is bound by the decision of another authority which has to decide first is not a unique feature of patent law, but a general principle of civil procedural law.<sup>1221</sup> Second, it is to be underlined that the previous German particularity that the German infringement court was not allowed to decide on the validity of German patents, while it was allowed to decide – with *inter partes* effect – on the validity of foreign patents of (at least)<sup>1222</sup> all Member States (but also *could* stay proceedings) has been relativised by the *GAT* decision of the ECJ, where the ECJ held that infringement proceedings must *generally* be stayed when the defence of invalidity of the concerned patent is raised. Accordingly, the previous argumentation against the decisiveness of a German particularity as to the qualification of Section 148 of the German Code of Civil Procedure which stressed that it was not decisive whether a stay of infringement proceedings was mandatory concerning German patents, while it was voluntary with regard to non-German patents<sup>1223</sup>, has become obsolete.

Due to the fact that the national laws of all Member States include rules with regard to the stay of patent infringement proceedings until a decision of the competent court on the validity of the concerned patent has been rendered, there is no need for a substantive qualification either. Therefore, the issue of a stay of infringement proceedings should be considered a matter of procedural law.

To conclude, it is to be stated that a stay of infringement proceedings can and is to be based on provisions of national procedural law of the Member States.

---

<sup>1218</sup> Legal text available at WWW

<[http://wetten.overheid.nl/BWBR0007118/Hoofdstuk6/Artikel83/geldigheidsdatum\\_09-12-2012](http://wetten.overheid.nl/BWBR0007118/Hoofdstuk6/Artikel83/geldigheidsdatum_09-12-2012)> (lastly accessed on 1 June 2015).

<sup>1219</sup> Translation provided by the author of this thesis.

<sup>1220</sup> Stauder (1976)25(12) GRUR Int. 510, at p. 515; Stauder (1997)46(11) GRUR Int. 859, at p. 860; Stauder (1998)18(5) IPRax 317, at p. 321, there fn. 19; Kieninger (1998)47(4) GRUR Int. 280, at p. 281; cf. Kubis 1999, p. 225; cf. also Treichel 2001, p. 41.

<sup>1221</sup> Hölder 2004, p. 176.

<sup>1222</sup> Under the condition of accepting a reflexive effect of Article 24(4), this statement would be also relevant with regard to the courts of third States.

<sup>1223</sup> Arguing in this way before the *GAT* decision of the ECJ: Hölder 2004, pp. 176-177.

#### **2.4.2.5.3.2 Is there a time limit for the initiation of counter-proceedings (invalidity/nullity proceedings respectively revocation proceedings or opposition proceedings (European patent)?**

Having come to the conclusion that the national procedural rules of the Member States constitute the legal basis for a stay of infringement proceedings if the defendant has raised the defence of invalidity of the concerned patent, it is to be noticed that this approach as such does not guarantee that the defendant, after raising the invalidity defence, subsequently initiates invalidity proceedings before the courts being competent according to Article 24(4) immediately (promptly) after infringement proceedings have been stayed. However, it is evident that the defendant must not be enabled to permanently block the decision of the infringement court. In this respect, it is to be emphasised that a number of patent systems (like, for instance, the German patent system) do not grant, to the patent holder, the possibility to have the validity of the patent confirmed, as the validity is presumed.<sup>1224</sup> As a consequence, the defendant who has raised an invalidity defence should be obliged to initiate invalidity/nullity proceedings in a relatively short term afterwards. As there should be space for individual decisions, it does not seem reasonable to indicate an exact term. Regarding the question of whether the infringement court should have discretion with respect to the determination of the length of this term, the parallel rule concerning the Community trade mark could be taken into consideration. Article 100(7) of the Community trade mark Regulation<sup>1225</sup> provides:

##### **Article 100(7) of the Community trade mark Regulation**

The Community trade mark court hearing a counterclaim for revocation or for a declaration of invalidity may stay the proceedings on application by the proprietor of the Community trade mark and after hearing the other parties and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office within a time limit which it shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 104(3) shall apply.

Comparably to this situation with regard to the Community trade mark, the determination of the length of this term should also be open to the discretion of the court where infringement proceedings have been instituted.<sup>1226</sup> Additionally, it has rightly been pointed out that the defendant, instead of instituting invalidity/nullity proceedings, may also institute, given the period for objection is still running, revocation proceedings before the competent national authorities or opposition proceedings. With regard to a European patent, initiating opposition proceedings before the European patent office will also effect that infringement proceedings are stayed.<sup>1227</sup>

---

<sup>1224</sup> Schauwecker 2009, p. 311.

<sup>1225</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1-42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>1226</sup> Schauwecker 2009, p. 311.

<sup>1227</sup> Schauwecker 2009, p. 312 with reference to case-law.



### 2.4.2.5.3.3 Must the defendant institute counter-proceedings *in persona*?

An interesting question which arises in this respect is whether the defendant of the *respective* infringement proceeding must institute a nullity/invalidity action (or initiate revocation/opposition proceedings) *in persona*, or whether it is sufficient that a *third party* undertakes these steps.

#### 2.4.2.5.3.3.1 The insight of *Roche Nederland*

First, this consideration leads back to the *Roche Nederland* decision of the ECJ where the court, as has been treated in detail above, stated in essence that

“(…) Article 6(1) of the Brussels Convention must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.”<sup>1228</sup>

As the ECJ thus denied a close connection according to Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) in the addressed constellation, it can be derived that a stay of the concerned infringement proceedings will only be effected if and only insofar as the concerned defendants institute a nullity/invalidity action respectively initiate revocation proceedings, due to the fact that national patents exist independently from each other. As to defendants who do not act in this way, infringement proceedings will not be stayed. However, the situation is different with regard to opposition proceedings before the European Patent Office as Article 99(2) of the EPC provides:

#### Article 99(2) of the EPC

The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.”

#### 2.4.2.5.3.3.2 Constellations beyond *Roche Nederland*

However, further constellations are conceivable which are not affected by the *Roche Nederland* decision of the ECJ. They shall be subject to the subsequent paragraphs.

##### 2.4.2.5.3.3.2.1 Constellation 1: *Joint* infringement proceedings against several defendants; only one defendant institutes counter-proceedings

On the one hand, one might put forth that the fact that infringement proceedings have been initiated jointly against several defendants (A and B), on the basis of Article 8(1) in a situation where this provision is still applicable after *Roche Nederland*, should *per se* have the effect that the procedural acting of one defendant should also entail consequences for other *joint* defendants. However, such a conception would wrongly deny the procedural autonomy of defendants even if proceedings have been jointly initiated against them. It is to be noticed that

---

<sup>1228</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 41 – *Roche Nederland*.

the institution of counter-proceedings by one defendant could only have effect for other defendants under the condition of the same ground of nullity/invalidity and the same facts with regard to all those defendants, which is rather unlikely to be the case.<sup>1229</sup> In the concerned constellation, defendant B is not prevented from initiating counter-proceedings by the fact that defendant A has done so before. This result is confirmed by a study of the provisions of the European Patent Convention. Article 105 of the EPC explicitly rules the intervention of third parties in opposition proceedings after the expiration of the opposition period:

#### **Article 105 of the EPC**

(1) Any third party may, in accordance with the Implementing Regulations, intervene in opposition proceedings after the opposition period has expired, if the third party proves that

(a) proceedings for infringement of the same patent have been instituted against him, or

(b) following a request of the proprietor of the patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent.

(2) An admissible intervention shall be treated as an opposition.

Such a provision would not be necessary but actually senseless if the institution of opposition proceedings by defendant A would automatically have effect as to defendant B, too. If defendant A has initiated nullity/invalidity proceedings, B may intervene as well if the national procedural provisions provide for this possibility.

Moreover, Article 45 of the Brussels Ibis Regulation, containing provisions for the refusal of recognition of judgments, must be taken into consideration. Article 45(1)(c) of the Brussels Ibis Regulation provides:

#### **Article 45(1)(c) of the Brussels Ibis Regulation**

(1) On the application of any interested party the recognition of a judgment shall be refused:

(...)

(c) if the judgment is irreconcilable with a judgment given between the same parties in the Member State addressed.

Article 45(1)(c) of the Brussels Ibis Regulation also stresses the fact that the same parties are concerned, thus excluding third parties.<sup>1230</sup>

Last but not least, it is to be emphasised that the court before which infringement proceedings have been initiated is *not prevented* from staying the infringement proceedings also with regard to defendant B if defendant A has instituted counter-proceedings, if this complies with the national procedural rules of the *lex fori*. However, the court is *not forced* to stay infringement proceedings as to defendant B in this situation.<sup>1231</sup>

---

<sup>1229</sup> Schauwecker 2009, p. 313.

<sup>1230</sup> Schauwecker 2009, p. 314.

<sup>1231</sup> Schauwecker 2009, p. 314.

#### **2.4.2.5.3.2.2 Constellation 2: *Independent* infringement proceedings against several defendants; only one defendant institutes counter-proceedings**

Given that the institution of counter-proceedings by only one out of several defendants does not affect the relationship between the claimant and the other defendants of the infringement proceedings, resulting in the fact that each defendant must institute counter-proceedings in order to effect a stay of infringement proceedings, it is to be stated *a maiore ad minus* that the result must be the same in the case of independent infringement proceedings against several defendants. In this constellation, there is even less ground to award effect to the institution of counter-proceedings by one defendant to another defendant.

#### **2.4.2.5.3.4 *Must* the infringement court stay proceedings when a nullity/invalidity defence has been raised?**

##### **2.4.2.5.3.4.1 General considerations**

Above under 2.4.2.5.3.1.5, I have arrived at the conclusion that a stay of infringement proceedings *can* and *must* be based on provisions of national procedural law of the Member States. Problematically, the relevant legal provisions generally<sup>1232</sup> provide for the discretion of the deciding court whether infringement proceedings are stayed or not. For instance, this goes for Section 148 of the German Code of Civil Procedure<sup>1233</sup>, Rule 3.1(2)(f) of the English Civil Procedure Rules<sup>1234</sup>, Article 378 of the New Code of Civil Procedure<sup>1235</sup> or Article 83(3), (4) of the Dutch Patent Act 1995<sup>1236</sup>. Nonetheless, it is doubtful if such discretion is justified in the situation in question. In *GAT*, Advocate General Geelhoed had restricted himself to enumerate the potential options of the infringement court once a defence of invalidity has been raised<sup>1237</sup>:

“(…) The court judging the infringement can transfer the case completely, it can stay the proceedings until the court of another Member State with jurisdiction under Article 16(4) [of the Brussels Convention] rules upon the validity of the patent, or it can deal with the case itself where a defendant acts in bad faith [content in brackets added].”<sup>1238</sup>

Although the ECJ subsequently did not make a definite statement as to this question either, it is remarkable that the ECJ distinctively underlined the decision-making authority of the courts of the State where the patent in question has been granted as to the validity issue. Beyond that, the ECJ emphasised the need for and the significance of the principle of legal certainty, warning that

“(…) multiplying the heads of jurisdiction (...) would be liable to undermine the predictability of the rules of jurisdiction laid down by the [Brussels] Convention, and consequently to undermine the

---

<sup>1232</sup> There are exceptions such as Article L. 614-15 of the French Code of Intellectual Property, cf. fn. 1193.

<sup>1233</sup> Cf. fn. 1187.

<sup>1234</sup> Cf. fn. 1189.

<sup>1235</sup> Cf. fn. 1191.

<sup>1236</sup> Cf. fn. 1195.

<sup>1237</sup> Mistakably: Schauwecker 2009, p. 304.

<sup>1238</sup> Advocate General 16 September 2004, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 46 – *GAT*.

principle of legal certainty, which is the basis of the [Brussels] Convention (...) [content in brackets added].”<sup>1239</sup>

At least under the current regime of the Brussels Ibis Regulation,<sup>1240</sup> it would clearly be contrary to the fundamental principle of legal certainty if the infringement court was given discretion as to the decision on a stay of infringement proceedings. To guarantee the *effet utile* of the Brussels Ibis Regulation, a discretion potentially provided for by provisions of national procedural law should not be exerted (respectively is to be considered not to exist) with regard to the decision on a stay of infringement proceedings once an invalidity defence has been raised.<sup>1241</sup>

#### **2.4.2.5.3.4.2 Are the parties’ interests to be taken into account?**

##### **2.4.2.5.3.4.2.1 The claimant’s interests**

Having shown that the infringement court must not be granted discretion when deciding on the stay of proceedings once an invalidity defence has been raised, I shall now dedicate my research on the issue of whether the consideration of the claimant’s and the defendant’s interests might lead to the result that the infringement court can (or even has to) transfer the whole case, i.e. both with regard to the infringement and the validity issue, to a court being competent according to Article 24(4). At first glance, this idea might seem clearly inconsistent with the above finding that a complete transfer of the case by the infringement court to a court having jurisdiction according to Article 24(4), if the invalidity issue has been raised, is to be rejected. However, such an evaluation might be overhasty. It might turn out that the infringement court, where not being obliged to undertake *ex officio* a complete transfer of the case to a court being exclusively competent with accordance to Article 24(4), might do so upon request of the claimant. In this respect, the situation is conceivable that the claimant in infringement proceedings who initiated infringement proceedings before a court not having jurisdiction according to Article 24(4) in the course of which an invalidity defence has been raised, intends to have the case decided by one court in order to accelerate proceedings.<sup>1242</sup>

Again, the first issue to be solved consists in the tracing of an adequate legal basis on which such an approach can be founded. As has been analysed in detail above, Article 30 (concerning related actions) does not cover this constellation and actually would not justify a complete transfer of proceedings to the *second* court.

Besides, it has been proposed to take recourse to Article 27 (respectively its predecessors of the Brussels Convention/Brussels I Regulation) as a legal basis.<sup>1243</sup> In the course of the following analysis, I shall research whether this approach is actually convincing. For reasons of clarity, I shall restart with a look on the wording of Article 27 which provides:

---

<sup>1239</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 28 – *GAT*.

<sup>1240</sup> As shall be demonstrated in the following chapter, a different solution is conceivable when amending the Regulation.

<sup>1241</sup> Coming to the same conclusion: Schauwecker 2009, p. 304.

<sup>1242</sup> Schauwecker 2009, p. 305.

<sup>1243</sup> Schauwecker 2009, p. 305 et seq.

## Article 27 of the Brussels Ibis Regulation

Where a court of a Member State is seised of a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 24, it shall declare of its own motion that it has no jurisdiction.

As I have established above, Articles 24 and 27 must be *interpreted independently* from each other, which is also underlined by the Jenard Report (as to the respective provisions of the Brussels Convention). It has been demonstrated that Article 27 is to be interpreted in the way that it only affects the issue actually covered by Article 24, i.e. it is only to this extent, namely with regard to the invalidity issue, that the court seised *must* declare of its own motion that it has no jurisdiction. However, this might not necessarily imply that the infringement court is *a priori* prevented from declaring itself incompetent also for the infringement proceeding. For a closer research of another aspect of the relevant passage in the Jenard Report, I shall refer once again to the English, German, French and Dutch version of the report:

“The words ‘principally concerned’ have the effect that the court is not obliged to declare of its own motion that it has no jurisdiction if an issue which comes within the exclusive jurisdiction of another court is raised only as a preliminary or incidental matter [underscore added].”<sup>1244</sup>

“Aus den Worten ‘wegen einer Streitigkeit angerufen’ ergibt sich, daß dieses Gericht sich nicht von Amts wegen für unzuständig erklären darf, wenn ein Streitpunkt, der zur ausschließlichen Zuständigkeit eines anderen Gerichts gehört, lediglich als Vorfrage aufgeworfen wird [underscore added].”<sup>1245</sup>

“Il résulte des mots ‘saisi à titre principal’ que ce juge ne doit pas se déclarer d’office incompetent si la question qui relève de la compétence exclusive à un autre tribunal n’est soulevée qu’à titre d’exception [underscore added].”<sup>1246</sup>

“Uit de woorden ‘bij wie een geschil aanhangig is gemaakt’ volgt, dat deze rechter zich niet ambtshalve onbevoegd moet verklaren indien de vraag die tot de uitsluitende bevoegdheid van een ander gerecht behoort slechts als exceptie is opgeworpen [underscore added].”<sup>1247</sup>

The report clearly states, in all cited language versions, that the infringement court may not declare “of its own motion” (“*von Amts wegen*”, “*d’office*”, “*amtshalve*”) (*ex officio*), i.e. without a request of the claimant being necessary, that it has no jurisdiction. The question of whether the court is entitled to declare its incompetence for the rest of the proceedings, namely the infringement issue, is not answered by the Jenard Report. As a consequence, it is to be concluded that an approach according to which the infringement court can also declare itself incompetent for the infringement proceeding should be considered at least in line with Article 27. However, a conception according to which Article 27 is considered the legal basis for the power of the infringement court to completely transfer the whole case to the courts having jurisdiction with accordance to Article 24(4) would go too far, due to the clear wording of Article 27.<sup>1248</sup> Nonetheless, it is to be underlined that such an approach of the

<sup>1244</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>1245</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:DE:PDF>> (lastly accessed on 1 June 2015).

<sup>1246</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:FR:PDF>> (lastly accessed on 1 June 2015).

<sup>1247</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 39, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:NL:PDF>> (lastly accessed on 1 June 2015).

<sup>1248</sup> Differently: Schauwecker 2009, p. 305, who actually treats Article 25 of the Brussels I Regulation (Article 27 of the Brussels Ibis Regulation) as a legal basis for a complete transfer of infringement proceedings to the

infringement court at least corresponds to the *idea (ratio legis)* of Article 27. Although there is no *explicit* legal basis for a complete transfer of both infringement and invalidity proceedings to the courts having jurisdiction according to Article 24(4), it is to be concluded that such an approach can be based on an *overall view of jurisdictional rules* of the Brussels Ibis Regulation.

Besides, it is to be underlined that this result takes into account that the stay of proceedings is generally based on national procedural rules which mostly do not require the claimant's request for such a stay of proceedings. Therefore, demanding a request in order to ensure the *effet utile* of the Brussels Ibis Regulation would not be justified.<sup>1249</sup>

Additionally, it is to be underlined that the approach pursued here according to which the *complete transfer* of the proceedings provided that the claimant requests so, while infringement proceedings are stayed in the case of a lack of such a request, corresponds to the insight in line with the *GAT* decision of the ECJ that the application of Article 24(4) *principally* effects the stay of proceedings according to national law (as principal legal consequence) and that there is *no general duty* to dismiss proceedings (as exceptional legal consequence) *ex officio*. A variant conception according to which the stay of proceedings depends on the claimant's request<sup>1250</sup>, while in the absence of such a request the court would be obliged to dismiss the claim, would disregard that relationship (principle – exception).<sup>1251</sup>

#### **2.4.2.5.3.4.2.2 The defendant's interests**

Having analysed that the claimant may request proceedings to be totally transferred to the courts having jurisdiction according to Article 24(4), the question arises whether, respectively to which extent the defendant's interests are to be taken into consideration in this respect.

##### **2.4.2.5.3.4.2.2.1 Vis-à-vis the claimant's request for a transfer *in toto***

First of all, it is to be examined whether the defendant is impaired by the claimant's request for a transfer of proceedings *in toto* to the courts being competent according to Article 24(4). In light of the jurisdictional system of the Brussels Ibis Regulation the claimant is entitled to choose a forum provided by the rules of the Regulation. Instead of initiating infringement proceedings before another court, the claimant could institute infringement proceedings directly before the courts of the State where the defendant is domiciled, i. e. actually the very State, in principle, where proceedings in question shall be totally dealt with. As a consequence, it is justified to undertake such a complete transfer of proceedings upon the claimant's request. Besides, it is to be underlined that the result of proceedings bundled in the State where the patent has been granted generally corresponds to the defendant's interests, as it is the defendant himself who, by raising the defence of invalidity/nullity of the concerned patent, brings into play Article 24(4) which otherwise would not become relevant.<sup>1252</sup>

---

courts having jurisdiction with accordance to Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) upon request of the claimant, once the invalidity defence has been raised.

<sup>1249</sup> Schauwecker 2009, p. 307.

<sup>1250</sup> As to the decision of the Hoge Raad in *Roche Nederland*, it is unclear whether the court pursued this approach as the wording of the decision leaves open both conceptions, cf. HR 30 November 2007, C02/228HR and C02/280HR, *Roche Nederland BV (Netherlands) and Others v Dr. F.J. Primus and Dr. M.D. Goldenberg*, NJ 2008, 77, Conclusion, para. 2.16 – *Roche Nederland*.

<sup>1251</sup> Schauwecker 2009, p. 306.

<sup>1252</sup> Similar: Schauwecker 2009, p. 307.

#### 2.4.2.5.3.4.2.2.2 Defendant's personal interest in a transfer *in toto*

Another issue is whether there is a *personal* interest of the defendant in a complete transfer of both infringement and invalidity proceedings once the invalidity defence has been raised. Such an interest could be justified by the fact that the defendant must raise a separate nullity action in the case that infringement proceedings are stayed by the infringement court until the validity issue has been decided by a separate court having jurisdiction according to Article 24(4), while in the case of negotiating infringement proceedings before the courts being competent according to Article 24(4), the mere raise of the invalidity defence would suffice in numerous Member States.<sup>1253</sup> In this respect, it might be argued that the necessity of an invalidity action in the first case, which inevitably produces costs, might lead to the consequence that both the defendant's fundamental right to an effective defence, guaranteed by Article 6(1) of the European Convention of Human Rights (ECHR), and the *favor defensoris*-principle, laid down in Article 4(1) of the Brussels Ibis Regulation, are violated.<sup>1254</sup> Defendants of infringement proceedings might refrain from filing an invalidity action because of the costs involved in validity proceedings.<sup>1255</sup> It is actually conceivable that infringement proceedings are deliberately initiated before courts outside the State where the patent has been granted, in order to avoid that the defendant may raise an invalidity defence without initiating a separate nullity action.<sup>1256</sup> The consequence would be an incentive to institute infringement proceedings in States where nullity/invalidity of a patent must be dealt with separately from the infringement issue – the defendant being deprived of the invalidity defence in such proceedings – rather than before courts of States where the nullity/invalidity issue can be treated incidentally. That might result in disadvantages for the defendant of infringement proceedings and, at another level, might be considered contrary to the jurisdictional system of the Brussels Ibis Regulation that provides for the possibility of initiating infringement proceedings before courts of another State than the State for whose territory the concerned patent has been granted, but does not allow the complete privation of these proceedings from that State. It has therefore been questioned if the infringement court should be obliged – *ex officio* or upon the defendant's request – to completely dismiss proceedings, in cases in which national law provides for the possibility that the infringement court also decides on the existence of the concerned patent, and transfer them to the courts of the State where the patent has been granted, which are competent according to Article 7(2).<sup>1257</sup> In this respect, it is to be stated first that the defendant does not need more protection than he may pursue himself. In this light, a transfer *ex officio* should be excluded *a priori*. At the utmost a transfer upon the defendant's request might be discussed. Regarding this, it seems to go too far to interpret the defendant's raise of the invalidity defence as a request to transfer complete proceedings to the courts being competent according to Article 24(4) (on the assumption that the defendant chooses the defence which is easier for him).<sup>1258</sup>

However, several aspects clearly militate against the defendant's possibility to attain the complete transfer of proceedings by request. First of all, it is to be emphasised that the condition that the defendant, depending on the State where infringement proceedings have been instituted, must initiate a separate nullity/invalidity action or merely raise the invalidity defence, is based on the fact that the Brussels Ibis Regulation simply does not provide for

---

<sup>1253</sup> Schauwecker 2009, p. 308.

<sup>1254</sup> Cf. Wadlow 1998, para. 3–125.

<sup>1255</sup> Gonzalez Beilfuss 2008, p. 86.

<sup>1256</sup> Schauwecker 2009, p. 308.

<sup>1257</sup> This idea has been raised by Schauwecker, while finally rejecting it himself, cf. Schauwecker 2009, p. 308 et seq.

<sup>1258</sup> Though arguing in this direction: Schauwecker 2009, p. 309.

proper means for the treatment of parallel infringement and invalidity proceedings.<sup>1259</sup> If the defendant would be granted the opportunity to influence the allocation of jurisdiction in the relationship of the infringement court and the court having jurisdiction as to the validity issue according to Article 24(4), this would be against the ECJ's intention, expressly stated in its *GAT* decision, to avoid

“(…) distortions (…) undermining the equality and uniformity of rights and obligations arising from the [Brussels] Convention for the Contracting States and the persons concerned [content in brackets added]”<sup>1260</sup>

because patents would be treated differently depending on which system exists in the State where they have been granted. In States which provide for the possibility that an invalidity defence can also be decided by infringement courts (by way of an *inter partes* decision), proceedings would always have to be transferred to the courts having jurisdiction according to Article 24(4) once an invalidity defence has been raised. In contrast, infringement proceedings concerning patents granted in or for States which do not provide for the possibility that an invalidity defence may be treated by infringement courts (as it is the legal situation in Germany, for instance) could be conducted before the courts of another State.

Additionally, granting the defendant the opportunity to request to completely transfer proceedings to the courts having jurisdiction according to Article 24(4) would result in the situation that the principle elaborated above of a relationship between a stay of infringement proceedings as the rule and a transfer *in toto* (at the claimant's request) as the exception, would be undermined.

Besides, the argument that the defendant who must initiate invalidity proceedings would be severely impaired loses much of its importance when regarding that there are various procedural means to ease potential burdens, such as the possibility of the court to reduce costs for an economically weak party, grant legal aid or employ principles of equity.<sup>1261</sup>

Beyond that, with regard to the aspect of the alleged impairment of the *favor defensoris*-principle, it is to be emphasised that leaving the infringement court jurisdiction for the infringement proceedings already initiated regularly *does* take into account the defendant's interests, when this jurisdiction is based on Article 4(1), the *actor sequitur forum rei*-principle forming the strongest incorporation of the *favor defensoris*-principle.<sup>1262</sup>

As to the fear that infringement proceedings might be increasingly instituted in States where nullity/invalidity of a patent must be dealt with separately from the infringement issue, rather than before courts of States where the nullity/invalidity issue can be treated incidentally, I am not convinced that this fear is really justified. Besides the fact that in the case of a complete transfer of proceedings to one court a decision will expectably be rendered earlier, the claimant may also be more interested in a *inter partes* decision than in a decision with *erga omnes* effect if there is the danger that the patent will be declared void.<sup>1263</sup>

---

<sup>1259</sup> Schauwecker 2009, p. 310.

<sup>1260</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 30 – *GAT*.

<sup>1261</sup> Particularly as to provisions of German patent law: Schauwecker 2009, p. 309.

<sup>1262</sup> Contrary to Schauwecker (Schauwecker 2009, p. 309 et seq.), jurisdiction in this respect cannot only be founded on Article 4(1), but, depending on the constellation, also on Article 7(2) or Article 8(1).

<sup>1263</sup> Schauwecker 2009, p. 310.



For these reasons, the defendant should not be granted the possibility to effect a complete transfer of proceedings to the courts which have jurisdiction according to Article 24(4).

### **2.4.2.5.3.4.2.3 Conclusion**

To conclude, the infringement court must stay proceedings when a nullity/invalidity defence has been raised. Upon the claimant's request, proceedings are to be completely transferred to the courts being competent pursuant Article 24(4), while the defendant cannot influence the place of jurisdiction by raising the invalidity defence.

## **2.5 Cross-border interim relief**

### **2.5.1 Importance of interim relief with regard to intellectual property infringement**

In particular with regard to intellectual property litigation, provisional measures have been characterised as “the most important and effective weapon in international litigation”.<sup>1264</sup> IP rights holders are in general primarily interested in stopping the allegedly infringing activities and only then considering what other remedies should be sought.<sup>1265</sup>

The importance of interim relief is due to several aspects. First of all, it is to be noticed that many intellectual property disputes actually never go beyond the stage of the application for interlocutory relief, because they are already solved by way of ordering a preliminary injunction.<sup>1266</sup> This fact must be considered in light of the situation that only quick measures against acts of patent infringement will prevent the patent holder from suffering severe economic damage which would occur the longer the patent infringement continues.<sup>1267</sup> In this respect, it is to be borne in mind that international litigation is often characterised by a long duration of proceedings.<sup>1268</sup> As a result of this situation, the enforcement and realisation of substantive rights is delayed.<sup>1269</sup> Without the possibility to gain interim relief, principal proceedings in cases of patent infringement would eventually lose much of their importance or would ultimately become senseless because the patent holder would already be ruined before a final decision could be rendered, which proves the significance of interim relief for ensuring effective legal protection.<sup>1270</sup> This idea has been clearly expressed in Recital 22 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (hereinafter Enforcement Directive) that provides:

---

<sup>1264</sup> Pertegás Sender 2002, para. 3.128; as to the significance of interim relief cf. also Tsikrikas & Hausmann 2012 (unalex Kommentar), vor Art. 31 Brüssel I-VO, para. 1; cf. also McGuire 2014 (Burgstaller, Neumayr, Geroldinger & Schmaranzer), Art 31 EuGVO, para. 2 as to Article 31 of the Brussels I Regulation: “Die Regelung ist von erheblicher praktischer Bedeutung” (“The provision has considerable practical significance”).

<sup>1265</sup> Kono & Jurčys 2012, p. 112.

<sup>1266</sup> Adams (1995)17(10) E.I.P.R. 497; Pertegás Sender 2002, para. 3.128; Bertrams (1995)44(3) GRUR Int. 193, at p. 197; Hellstadius & Meier-Ewert (2005)36(3) IIC 313, at p. 323; cf. Kruger 2005, p. 312.

<sup>1267</sup> Kurtz 2004, p. 19; Hye-Knudsen 2005, p. 198; Schauwecker 2009, p. 167; Hellstadius & Meier-Ewert (2005)36(3) IIC 313, at p. 323; cf. Kruger 2005, p. 312.

<sup>1268</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 1; Tsikrikas & Hausmann 2012 (unalex Kommentar), vor Art. 31 Brüssel I-VO, para. 1.

<sup>1269</sup> Tsikrikas & Hausmann 2012 (unalex Kommentar), vor Art. 31 Brüssel I-VO, para. 1.

<sup>1270</sup> Tsikrikas & Hausmann 2012 (unalex Kommentar), vor Art. 31 Brüssel I-VO, para. 1, cf. also Pörnbacher 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 31 VO (EG) No. 44/2001, para. 1

## **Recital 22 of Directive 2004/48/EC**

It is also essential to provide for provisional measures for the immediate termination of infringements, without awaiting a decision on the substance of the case, while observing the rights of the defence, ensuring the proportionality of the provisional measures as appropriate to the characteristics of the case in question and providing the guarantees needed to cover the costs and the injury caused to the defendant by an unjustified request. Such measures are particularly justified where any delay would cause irreparable harm to the holder of an intellectual property right.

In this respect, it is to be added that a proceeding must be finished in an adequate term in order to meet the requirements of a “*Rechtsstaat*”, which is also guaranteed by Article 6(1) of the European Convention on Human Rights which states *inter alia*:

## **Article 6(1) of the European Convention on Human Rights**

In the determination of his civil rights and obligations (...), everyone is entitled to a fair and public hearing within a reasonable time (...).

However, as Article 6(1) of the European Convention on Human Rights is not sufficient for an effective protection of the requirement of an adequate term of proceedings, this requirement must be concretised and realised by further legal rules such as those of the Brussels Ibis Regulation which therefore must be considered in the light of underlying (procedural) principles.<sup>1271</sup> Furthermore, it is true that, for instance, the importance of the Dutch *kort geding* has increasingly developed into a quasi-principal proceeding, given that it is considered faster, more efficient and cheaper than a regular principal proceeding.<sup>1272</sup>

Notably, national laws provide for a broad diversity of measures of interim relief. Indeed, a certain amount of minimum standards for the WTO Member States have been established by Article 50 of the TRIPS Agreement which provides:

## **Article 50 of the TRIPS Agreement**

(1) The judicial authorities shall have the authority to order prompt and effective provisional measures:

(a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;

(b) to preserve relevant evidence in regard to the alleged infringement.

(2) The judicial authorities shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.

(3) The judicial authorities shall have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.

---

<sup>1271</sup> Cf. König 2012, p. 65.

<sup>1272</sup> Bertrams (1995)44(3) GRUR Int. 193, at p. 197.

(4) Where provisional measures have been adopted *inaudita altera parte*, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable period after the notification of the measures, whether these measures shall be modified, revoked or confirmed.

(5) The applicant may be required to supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

(6) Without prejudice to paragraph 4, provisional measures taken on the basis of paragraphs 1 and 2 shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority ordering the measures where a Member's law so permits or, in the absence of such a determination, not to exceed 20 working days or 31 calendar days, whichever is the longer.

(7) Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.

(8) To the extent that any provisional measure can be ordered as a result of administrative procedures, such procedures shall conform to principles equivalent in substance to those set forth in this Section.

On the European level, some harmonisation between the EU Member States has been created by the Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property law (Enforcement Directive), which prescribes rules for measures for preserving evidence (Article 7) and for provisional and precautionary measures (Article 9).

However, the national laws of the Member States – and even more among the States beyond the European Union – still show considerable differences regarding kind and coverage (scope) of provisional measures.<sup>1273</sup> For this reason, patent holders who tend to enforce their rights in different national legal systems can and must make a clever choice between the provisional measures available in those legal frameworks.<sup>1274</sup>

### **2.5.2 Interim relief within the scope of application of the Brussels Ibis Regulation**

In Section 10, the Brussels Ibis Regulation contains a specific rule, Article 35, on jurisdiction concerning provisional, including protective, measures which reads as follows:<sup>1275</sup>

---

<sup>1273</sup> Pansch 2003, pp. 1-2; Gassauer-Fleissner 2006, p. 263; Wannenmacher 2007, p. 233; Schauwecker 2009, p. 168 et seq.

<sup>1274</sup> Pansch 2003, pp. 82-83.

<sup>1275</sup> Article 31 of the Brussels I Regulation almost identically provided:

“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 State, even if, under this Regulation, the courts of another Member State have jurisdiction as to the substance of the matter.”

### Article 35 of the Brussels Ibis Regulation

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.

However, this does not mean that jurisdiction for provisional measures may not be based on Articles 4 and 7 to 26. These articles are applicable – jurisdiction based on these provisions not being subject to further preconditions<sup>1276</sup> – and are completed by provisions of national law via Article 35.<sup>1277</sup> This has been confirmed by the ECJ in its *Van Uden* and its *Mietz* decisions which both have been rendered with regard to the Brussels Convention. In *Van Uden*, the ECJ explicitly explicated:

“The first point to be made, as regards the jurisdiction of a court hearing an application for interim relief, is that it is accepted that a court having jurisdiction as to the substance of a case in accordance with Articles 2 and 5 to 18 of the [Brussels] Convention also has jurisdiction to order any provisional or protective measures which may prove necessary [content in brackets added].”<sup>1278</sup>

“Thus, the court having jurisdiction as to the substance of a case under one of the heads of jurisdiction laid down in the [Brussels] Convention also has jurisdiction to order provisional or protective measures, without that jurisdiction being subject to any further conditions (...) [content in brackets added].”<sup>1279</sup>

This jurisprudence has been referred to and confirmed in the *Mietz* decision, where the ECJ held:

“It is important to stress that it is not necessary for the court hearing an application for provisional or protective measures to have recourse to Article 24 of the Convention where it has, in any event, jurisdiction as to the substance of a case in accordance with Articles 2 and 5 to 18 of the Convention (see, to that effect, Case C-391/95 *Van Uden v Deco-Line* [1998] ECR I-7091, paragraph 19).”<sup>1280</sup>

The side-by-side existence of jurisdiction for provisional measures pursuant to Articles 4 and 7 to 26 on the one hand, and Article 35 in conjunction with national law on the other hand is also reflected by Recital 33 of the Brussels Ibis Regulation which mentions both kinds of jurisdiction:

### Recital 33 of the Brussels Ibis Regulation

(33) Where provisional, including protective, measures are ordered by a court having jurisdiction as to the substance of the matter, their free circulation should be ensured under this Regulation. (...) Where provisional, including protective, measures are ordered by a court of a Member State not having jurisdiction as to the substance of the matter, the effect of such measures should be confined, under this Regulation, to the territory of that Member State.

---

<sup>1276</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 15.

<sup>1277</sup> Kropholler & Von Hein 2011, Art. 31 EuGVO, paras. 10 et seq.; König 2012, p. 69; Pålsson 2000, p. 622 et seq.; Lindacher 2009, p. 257; differently: Schlosser 2009, Art. 31 EuGVVO, para. 17.

<sup>1278</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV*, trading as *Van Uden Africa Line*, v *Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 19 – *Van Uden*.

<sup>1279</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV*, trading as *Van Uden Africa Line*, v *Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 22 – *Van Uden*.

<sup>1280</sup> ECJ 27 April 1999, C-99/96, *Hans-Hermann Mietz v Intership Yachting Sneek BV*, [1999] ECR I-02277, paras. 40, 46 – *Mietz*.

The claimant may freely choose between those jurisdictions.<sup>1281</sup> In case that the national court has jurisdiction on the merits under one of the heads of jurisdiction set out in Articles 4 and 7 to 26, it may issue any injunction that may prove necessary, and the ECJ left the definition of such measures to the national law,<sup>1282</sup> which has already been addressed in the Jenard Report on the Brussels Convention as follows:

“In each State, application may (...) be made to the competent courts for provisional or protective measures to be imposed or suspended, or for rulings on the validity of such measures, without regard to the rules of jurisdiction laid down in the [Brussels] Convention. As regards the measures which may be taken, reference should be made to the internal law of the country concerned [content in brackets added].”<sup>1283</sup>

In accordance with the *Van Uden* and *Mietz* decisions of the ECJ cited above, I will pursue a *dualistic approach* when illustrating according to which rules provisional measures may be ordered in the framework of the Brussels Ibis Regulation, differentiating between provisional proceedings before a court being competent according to Articles 4 or 7 to 26 and, on the other hand, provisional proceedings on the basis of Article 35 in conjunction with national law.<sup>1284</sup> In contrast, some authors have undertaken a *tripartite approach*, making a further differentiation between *actual* and mere *fictitious/potential* jurisdiction on the merits.<sup>1285</sup> In the following paragraphs I shall first deal with this conceptional issue before then subjecting Article 35 to a deepened analysis.

### 2.5.2.1 Provisional proceedings before a court having jurisdiction according to Articles 4 or 7 to 26 (jurisdiction as to the substance/jurisdiction on the merits) and therefore having accessory jurisdiction for provisional measures

#### 2.5.2.1.1 Jurisdiction

First of all, it is to be stated that jurisdiction for provisional measures of the court of the principal proceedings (accessory jurisdiction for provisional measures)<sup>1286</sup> does not

<sup>1281</sup> Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 31, para. 8; Nagel & Gottwald 2013, § 17, para. 7; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, paras. 2, 14; differently: Schlosser 2009, Art. 31 EuGVVO, para. 17.

<sup>1282</sup> Szychowska 2008, p. 213; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 16.

<sup>1283</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>1284</sup> Similar for instance: Hye-Knudsen 2005, p. 199 et seq.

<sup>1285</sup> Heß & Vollkommer (1999)19(4) IPRax 220, at p. 221; Heß (2000)20(5) IPRax 370, at p. 373; Laubinger 2005, p. 94.

<sup>1286</sup> In this thesis, the wording “*accessory jurisdiction (for provisional measures)*” is used as a synonym for the jurisdiction for provisional measures of the courts which have jurisdiction on the merits. It is noteworthy that such “*accessory jurisdiction*” must not be confused with the notion of “*aanvullende bevoegdheidsregel*” which is contained in the Dutch text version of the *Van Uden* decision of the ECJ in context with jurisdiction according to Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation) (cf. ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 20 – *Van Uden*) and which, according to the terminology used in this thesis, is named “*independent jurisdiction*”. However, apart from the fact that “*aanvullend*” would rather be translated as “*additional*” – the English text version of the *Van Uden* decision in fact contains the words “*in addition*” and “*adds*” (cf. ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 20 – *Van Uden*) – the term of “*accessory jurisdiction*” is also used, *inter alia*, by the Commentary on the CLIP Principles (cf. for instance Heinze 2013 (CLIP Principles), Article 2:501, paras. 2:501.C02 and 2:501.C03).

prerequisite that principal proceedings have already been initiated.<sup>1287</sup> But, regarding the constellation that principal proceedings have actually been commenced, it has been discussed controversially whether provisional proceedings can only be initiated before *this* very court, or whether interim relief may also be sought before a court that *could have also been invoked* in principal proceedings (*fictitious/potential* jurisdiction on the merits).

#### 2.5.2.1.1.1 Conception 1: Requirement of factual jurisdiction on the merits

On the one hand, it might be argued indeed that, if a court has been invoked in principal proceedings on the basis of Articles 4 or 7 to 26, only this very court can be competent to decide on provisional measures, too. In this respect, it has been put forth that jurisdiction as to the decision on provisional measures is (logically) bound to the actual jurisdiction concerning principal proceedings. By choosing a court for provisional proceedings, the claimant is thus considered to have already used his right of choice.<sup>1288</sup> Following this conception, a court invoked afterwards shall of its own motion stay proceedings according to Article 29 which reads:

##### Article 29 of the Brussels Ibis Regulation

(1) Without prejudice to Article 31(2), 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.

(2) In cases referred to in paragraph 1, upon request by a court seised of the dispute, any other court seised shall without delay inform the former court of the date when it was seised in accordance with Article 32.

(3) Where the jurisdiction of the court first seised is established, any court other than the court first seised shall decline jurisdiction in favour of that court.

Proponents of such an understanding have underlined that only this conception would avoid a checkout of the different courts having jurisdiction in principal proceedings. It has been feared that the claimant could otherwise check out, with regard to provisional measures, the variant courts having jurisdiction as to principal proceedings in order to ultimately choose the court most favourable for him for actually instituting such principal proceedings.<sup>1289</sup> It has been stressed that, due to Article 29, a court invoked in principal proceedings after another court has already been invoked, cannot render a decision and that, as a consequence, there would be no need to secure a decision in principal proceedings which will never be rendered. This viewpoint has also been considered to be supported by the jurisprudence of the ECJ in its *Van Uden* decision where the ECJ explicated:<sup>1290</sup>

“Where the parties have validly excluded the jurisdiction of the courts in a dispute arising under a contract and have referred that dispute to arbitration, there are no courts of any State that have jurisdiction as to the substance of the case for the purposes of the Convention. Consequently, a party to such a contract is not in a position to make an application for provisional or protective measures to a

<sup>1287</sup> Laubinger 2005, p. 95; Wannenmacher 2007, p. 208 et seq.; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 31 EuGVVO, para. 7; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 18.

<sup>1288</sup> Wolf & Lange (2003)49(1) RIW 55, at p. 61.

<sup>1289</sup> Wolf & Lange (2003)49(1) RIW 55, at p. 61.

<sup>1290</sup> Pansch 2003, p. 69.

court that would have jurisdiction under the Convention as to the substance of the case [underscore added].”<sup>1291</sup>

According to this viewpoint, it might be concluded from the foregoing that, in accordance with Article 29, only such courts can decide on provisional measures which *actually exert* jurisdiction in principal proceedings,<sup>1292</sup> whereas this does not apply in the case that jurisdiction for provisional measures is based on Article 35. In that constellation, a court may decide on provisional measures even if it is deprived of jurisdiction concerning principal proceedings due to Article 29 which has also been confirmed by the ECJ in its *Van Uden* decision.<sup>1293</sup>

“In such a case, it is only under Article 24 [of the Brussels Convention] that a court may be empowered under the [Brussels] Convention to order provisional or protective measures [content in brackets added].”<sup>1294</sup>

In other words, proponents of this conception, although admitting that Article 29 of the Brussels Ibis Regulation (respectively its predecessor, Article 27 of the Brussels I Regulation) is not applicable as such to the constellation in question,<sup>1295</sup> still *extend the effects* of Article 29 of the Brussels Ibis Regulation (Article 27 of the Brussels I Regulation) which premises the existence of two principal proceedings, to the coincidence of principal proceedings and provisional proceedings,<sup>1296</sup> although Article 29 of the Brussels Ibis Regulation (Article 27 of the Brussels I Regulation) actually concerns a completely different situation and therefore lacks applicability at all.<sup>1297</sup>

This result has also been founded on the argument that the court before which principal proceedings have been initiated is particularly familiar with the subject-matter to decide and that for this reason the goal of procedural economy militates for considering only this court competent to decide on provisional measures as well.<sup>1298</sup>

#### 2.5.2.1.1.2 Conception 2: Sufficiency of “fictitious/potential” jurisdiction on the merits

Although some of the foregoing arguments seem persuasive at first glance, Conception 1 is ultimately not convincing for several reasons. Neither is it notionally required, nor is it justified.<sup>1299</sup> For a conception according to which, if principal proceedings have been initiated, only the very court before which those principal proceedings actually have been brought has jurisdiction as to provisional measures, would impose territorial and factual restrictions on all other courts which are provided with jurisdiction according to the Brussels Ibis Regulation. As a consequence, the jurisdiction system of the Brussels Ibis Regulation would be vitally

---

<sup>1291</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 24 – *Van Uden*.

<sup>1292</sup> Cf. P. Vlas (case note) HR 21 June 2002, C01/241HR, *Spray Network N.V. v Telenor Venture AS and Others*, NJ 2002, 563.

<sup>1293</sup> Pansch 2003, p. 70; Wannenmacher 2007, p. 277 et seq.

<sup>1294</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 25 – *Van Uden*.

<sup>1295</sup> Cf. for instance Wannenmacher 2007, p. 277.

<sup>1296</sup> As to a similar interpretation of that conception cf. Schauwecker 2009, p. 178.

<sup>1297</sup> Cf. in place of many others Stadler (1999)54(22) JZ 1089, at p. 1094; Hye-Knudsen 2005, p. 204; Kropholler & Von Hein 2011, Art. 27 EuGVO, para. 14.

<sup>1298</sup> Wannenmacher 2007, p. 279.

<sup>1299</sup> Lindacher 2009, p. 257; cf. also Tsirikas & Hausmann 2012 (unalex Kommentar), Art. 31 Brüssel I-VO, para. 19.

devaluated.<sup>1300</sup> In this respect, it is to be stressed that the factual proximity (“*Sachnähe*”) to a court which is competent according to the Brussels Ibis Regulation is not affected by the fact that another court which is also competent has been invoked.<sup>1301</sup> Although it is to be taken into account that interim relief can still be gained on the basis of Article 35, it cannot be excluded that Conception 1 would effect severe gaps as to legal protection.<sup>1302</sup> In this respect, it must be borne in mind that Article 35 intends to grant effective legal protection by offering the possibility of invoking the courts of other Member States. Best legal protection is however achieved by offering as many as possible places of jurisdictions.<sup>1303</sup> The idea of effective legal protection would be foiled if jurisdictions were restricted in the case that courts are invoked on the basis of provisions of the Brussels Ibis Regulation. As to the argument that it is necessary to avoid a checkout of the different courts having jurisdiction in principal proceedings, it must be emphasised that such a checkout would also be possible before the courts having jurisdiction according to national law.<sup>1304</sup> After all, the striking argument for also allowing jurisdiction to the courts which dispose of mere “*fictitious/potential*” jurisdiction on the merits is that the *Van Uden* decision of the ECJ which is in the first instance referred to when arguing against this conception as a matter of fact lacks comparability to the constellation in question. A closer analysis of the jurisprudence of the ECJ in its *Van Uden* decision reveals that the court actually decided on a constellation where the parties had excluded jurisdiction of Member States courts. The court decided that

“(w)here the parties have validly excluded the jurisdiction of the courts in a dispute arising under a contract and have referred that dispute to arbitration, there are no courts of any State that have jurisdiction as to the substance of the case for the purposes of the [Brussels] Convention. Consequently, a party to such a contract is not in a position to make an application for provisional or protective measures to a court that would have jurisdiction under the [Brussels] Convention as to the substance of the case [underscores and content in brackets added].”<sup>1305</sup>

Thus, this decision was expressly rendered on the basis that there is no jurisdiction of the courts according to the Brussels Convention, respectively Brussels Ibis Regulation at all. Remarkably, the ECJ did not, in its *Van Uden* decision, mention in any way that a court would lose jurisdiction to grant interim relief after principal proceedings have been initiated before another court competent according to the Brussels Ibis Regulation, due to the rule of Article 29.<sup>1306</sup> The reference to the *Van Uden* decision in the framework of the issue discussed here may therefore be characterised as a comparison of “apples to oranges”.

This result is confirmed by the uncontested fact that the *Van Uden* decision of the ECJ does not affect jurisdiction according to national provisions. However, it is not evident why the ECJ should intend to establish a more restricted approach as to jurisdiction according to the Brussels Convention (Brussels Ibis Regulation) than concerning jurisdiction on the basis of national provisions. Particularly in light of the concern of the ECJ to secure sufficient factual proximity, it is to be emphasised that courts being competent according to national law do not always bear the guarantee of such a sufficient factual proximity, due to the fact that such courts can also be competent with accordance to the rules of national jurisdiction of which the

<sup>1300</sup> Stadler (1999)54(22) JZ 1089, at p. 1095; Laubinger 2005, p. 95.

<sup>1301</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 17; U. Spellenberg and S. Leible (case note) ECJ 27 April 1999, C-99/96, Hans-Hermann Mietz v Intership Yachting Sneek BV, (1999)4 ZZPInt 221, at p. 228.

<sup>1302</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 17; Heß & Vollkommer (1999)19(4) IPRax 220, at p. 221 et seq.

<sup>1303</sup> Carl 2007, p. 259.

<sup>1304</sup> Carl 2007, p. 258.

<sup>1305</sup> ECJ 17 November 1998, C-391/95, Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another, [1998] ECR I-07091, para. 24 – *Van Uden*.

<sup>1306</sup> Carl 2007, p. 258.



Member States are to notify the Commission (Article 76(1)(a)) and which are excluded according to Article 5(2) when jurisdiction is based on the Brussels Ibis Regulation.<sup>1307</sup> Article 5(2) provides:

#### **Article 5(2) of the Brussels Ibis Regulation**

In particular the rules of national jurisdiction of which the Member States are to notify the Commission pursuant to point (a) of Article 76(1) shall not be applicable as against the persons referred to in paragraph 1 [i.e.: persons domiciled in a Member State, cf. Article 5(1)] [content in brackets added].

Consequently, jurisdiction according to national rules would be more consistent than jurisdiction on the basis of the Brussels Ibis Regulation, a result which cannot be intended by the ECJ.

#### **2.5.2.1.1.3 Conclusion**

As a consequence, it is to be concluded that, where courts have jurisdiction according to the Brussels Ibis Regulation, these courts remain competent unless specific rules, as Article 29 in the case of several principal proceedings, exclude this result. Courts having jurisdiction according to Articles 4 or 7 to 26 remain competent to decide on provisional measures regardless of whether principal proceedings have been initiated before another court according to the Brussels Ibis Regulation.

#### **2.5.2.1.2 Requirements of cross-border legal protection by way of interim relief**

In principle, jurisdiction for provisional measures rendered by the courts which also have jurisdiction with regard to principal proceedings according to the Brussels Ibis Regulation does not premise the fulfilment of further requirements. On the other hand, that jurisdiction does not go beyond jurisdiction concerning principal proceedings either.

In contrast to provisional measures rendered on the basis of Article 35 in conjunction with national law, recognition and enforcement of provisional measures rendered on the basis of the Brussels Ibis Regulation (respectively its predecessors) is principally possible which has been (indirectly) restated by the ECJ in *Van Uden*:

“Thus, the court having jurisdiction as to the substance of a case under one of the heads of jurisdiction laid down in the [Brussels] Convention also has jurisdiction to order provisional or protective measures, without that jurisdiction being subject to any further conditions (...) [content in brackets added].”<sup>1308</sup>

However, the ECJ has established several restrictions which must be fulfilled for cross-border recognition and enforcement of such provisional measures.

---

<sup>1307</sup> Carl 2007, p. 258.

<sup>1308</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 22 – *Van Uden*.

### 2.5.2.1.2.1 Grant of the right to a hearing

As to the right to a hearing, the ECJ already stated expressly in its *Denilauler* decision on the interpretation of Articles 24, 27, 34, 36, 46 and 47 of the Brussels Convention:

“Article 24 [of the Brussels Convention] does not preclude provisional or protective measures ordered in the State of origin pursuant to adversary proceedings – even though by default – from being the subject of recognition and an authorization for enforcement on the conditions laid down in Articles 25 to 49 of the [Brussels] Convention. On the other hand the conditions imposed by Title III of the [Brussels] Convention on the recognition and the enforcement of judicial decisions are not fulfilled in the case of provisional or protective measures which are ordered or authorized by a court without the party against whom they are directed having been summoned to appear and which are intended to be enforced without prior service on that party. It follows that this type of judicial decision is not covered by the simplified enforcement procedure provided for by Title III of the [Brussels] Convention (...) [content in brackets added].”<sup>1309</sup>

As a consequence, a provisional measure rendered in favour of a patent holder could only be recognised and enforced in another Member State if the alleged infringer had been granted the right to a hearing. *Ex parte*-decisions were thus excluded from recognition and enforcement. In this regard, it was irrelevant if the alleged infringer was subsequently given the opportunity of legal remedies, as the ECJ expressly held in its *Minalmet* decision on the interpretation of Article 27(2) of the Brussels Convention:

“It must be emphasized in that regard that (...) the proper time for the defendant to have an opportunity to defend himself is the time at which proceedings are commenced. The possibility of having recourse, at a later stage, to a legal remedy against a judgment given in default of appearance, which has already become enforceable, cannot constitute an equally effective alternative to defending the proceedings before judgment is delivered.”<sup>1310</sup>

“(...) As correctly pointed out by the national court, once a judgment has been delivered and has become enforceable, the defendant can obtain suspension of its enforcement, if suspension is appropriate, only under more difficult circumstances and may also find himself confronted by procedural difficulties. The possibility for a defaulting defendant to defend himself is thus considerably diminished.” (...) <sup>1311</sup>

“It follows from all the foregoing considerations that recognition in one contracting State of a judgment delivered in default of appearance in another contracting State must be refused where the document which instituted the proceedings was not duly served on the defendant, even if the defendant had notice of the judgment and did not have recourse to the available legal remedies.”<sup>1312</sup>

The jurisprudence of the ECJ in *Denilauler* which filled a legal gap under the Brussels Convention and the Brussels I Regulation, has in the meanwhile been codified in the Brussels Ibis Regulation. So, Article 2(a) provides that decisions on the grant of provisional measures are recognised and enforced in another Member State only if the defendant was given the right to a hearing, respectively if the judgment containing the provisional measure is served on the defendant before enforcement is sought. Article 2(a) of the Brussels Ibis Regulation rules:

---

<sup>1309</sup> ECJ 21 May 1980, C-125/79, *Bernard Denilauler v S.N.C. Couchet Frères*, [1980] ECR 01553, para. 17 – *Denilauler*.

<sup>1310</sup> ECJ 12 November 1992, C-123/91, *Minalmet GmbH v Brandeis Ltd*, [1992] ECR I-05661, para. 19 – *Minalmet*.

<sup>1311</sup> ECJ 12 November 1992, C-123/91, *Minalmet GmbH v Brandeis Ltd*, [1992] ECR I-05661, para. 20 – *Minalmet*.

<sup>1312</sup> ECJ 12 November 1992, C-123/91, *Minalmet GmbH v Brandeis Ltd*, [1992] ECR I-05661, para. 21 – *Minalmet*.

### **Article 2(a) of the Brussels Ibis Regulation**

For the purposes of this Regulation:

(a) (...) For the purposes of Chapter III, 'judgment' includes provisional, including protective, measures ordered by a court or tribunal which by virtue of this Regulation has jurisdiction as to the substance of the matter. It does not include a provisional, including protective, measure which is ordered by such a court or tribunal without the defendant being summoned to appear, unless the judgment containing the measure is served on the defendant prior to enforcement.

Since Article 2(a) of the Brussels Ibis Regulation at least requires that the judgment containing the provisional measure is served on the defendant prior to enforcement, Article 42(2)(c) of the Brussels Ibis Regulation demands proof about this vis-à-vis the competent enforcement authority:

### **Article 42(2)(c) of the Brussels Ibis Regulation**

(...)

(2) For the purposes of enforcement in a Member State of a judgment given in another Member State ordering a provisional, including a protective, measure, the applicant shall provide the competent enforcement authority with:

(...)

(c) where the measure was ordered without the defendant being summoned to appear, proof of service of the judgment.

Besides, in order to strengthen the protection of the defendant, Article 45(1)(b) of the Brussels Ibis Regulation provides:

### **Article 45(1)(b) of the Brussels Ibis Regulation**

(1) On the application of any interested party, the recognition of a judgment shall be refused:

(...)

(b) where the judgment was given in default of appearance, if the defendant was not served with the document which instituted the proceedings or with an equivalent document in sufficient time and in such a way as to enable him to arrange for his defence, unless the defendant failed to commence proceedings to challenge the judgment when it was possible for him to do so.

It is remarkable that the Brussels Ibis Regulation thus pursues an approach which is more in favour of the defendant against whom provisional measures are ordered, by rigorously excluding provisional measures from cross-border recognition and enforcement where the defendant has not been granted the right to a hearing, unless the judgment containing the provisional measure is served on the defendant prior to enforcement (cf. Article 2(a) of the Brussels Ibis Regulation).<sup>1313</sup> For Article 2(a) of the Brussels Ibis Regulation does not consider it sufficient that the defendant disposes of the opportunity of challenging the measure according to national law after enforcement has been accomplished.

---

<sup>1313</sup> Von Hein (2013)59(3) RIW 97, at p. 107 et seq.; Pohl (2013)33(2) IPRax 109, at p. 114.

Article 2(a) of the Brussels Ibis Regulation is consistent with Recital 33 2<sup>nd</sup> sentence of the Brussels Ibis Regulation which is supplemented by the 3<sup>rd</sup> sentence:

#### **Recital 33 of the Brussels Ibis Regulation**

(33) Where provisional, including protective, measures are ordered by a court having jurisdiction as to the substance of the matter, their free circulation should be ensured under this Regulation. However, provisional, including protective, measures which were ordered by such a court without the defendant being summoned to appear, should not be recognised and enforced under this Regulation unless the judgment containing the measure is served on the defendant prior to enforcement. This should not preclude the recognition and enforcement of such measures under national law. Where provisional, including protective, measures are ordered by a court of a Member State not having jurisdiction as to the substance of the matter, the effect of such measures should be confined, under this Regulation, to the territory of that Member State.

Although Recital 33 3<sup>rd</sup> sentence of the Brussels Ibis Regulation makes clear that *ex parte* measures of interim relief granted on the basis of accessory jurisdiction for provisional measures may be recognisable and enforceable pursuant to the national law of the Member States,<sup>1314</sup> it is to be noticed that this solution does not promote legal unification or at least harmonisation among the Member States.<sup>1315</sup> On the contrary, it considerably impedes, at the expense of the applicant of a provisional measure, the exploitation of the surprise effect of that measure.<sup>1316</sup>

While it is to be appreciated that the ECJ's jurisprudence in *Denilauler* as well as its codification in Articles 2(a), 42(2)(c) and 45(1)(b) of the Brussels Ibis Regulation intend to protect the debtor's rights by setting up the requirement of the debtor's right to a hearing, it is to be kept in mind as well that international interim relief may be deprived of its most important characteristic: its surprise effect.<sup>1317</sup> The claimant is thus practically forced to initiate separate proceedings in the Member States where the final decision shall ultimately be enforced.<sup>1318</sup> It has been rightly put forth that this consequence actually brings along the effect that cross-border interim relief has lost much of its effectivity.<sup>1319</sup> On the other hand, it must be considered that cross-border interim relief still has not become completely useless, because *ex parte*-decisions can be recognised once the right to a hearing will have been granted at a later stage of proceedings.<sup>1320</sup>

#### **2.5.2.1.2.2 Refusal of recognition and enforcement of provisional measures in case of irreconcilability with decisions in the State of enforcement**

As has already been mentioned, Article 29 of the Brussels Ibis Regulation (respectively its predecessors under the Brussels Convention and the Brussels I Regulation) is not applicable to the constellation of a coincidence of principal and provisional proceedings. As a consequence, a patent holder may simultaneously institute provisional proceedings before

---

<sup>1314</sup> Pohl (2013)33(2) IPRax 109, at p. 114; Domej (2014)78 RabelsZ 508, at p. 546.

<sup>1315</sup> Similar: Von Hein (2013)59(3) RIW 97, at p. 108.

<sup>1316</sup> Von Hein (2013)59(3) RIW 97, at p. 108; Domej (2014)78 RabelsZ 508, at p. 546.

<sup>1317</sup> Treichel 2001, p. 67 et seq.; Kropholler & Von Hein 2011, Art. 32 EuGVO, para. 22a.

<sup>1318</sup> Hye-Knudsen 2005, pp. 203-204.

<sup>1319</sup> Schauwecker 2009, p. 172.

<sup>1320</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 36; Lindacher 2009, p. 262.

several courts of Member States, and it may happen that these courts render conflicting decisions.

The ECJ decided on such a constellation in its *Italian Leather* case on the interpretation of Article 27 of the Brussels Convention which was based on the following facts: Italian Leather SpA, an Italian company selling upholstered furniture (hereinafter IT), sought interim relief both in Germany and in Italy to prevent WECO Polstermöbel GmbH & Co., a German company busy in the same economic field (hereinafter W) from marketing products with IT's brand name. The German courts refused the relief sought due to the fact that IT could not show that there was a risk of irreparable damage or of a definitive loss of rights as required by the German Code of Civil Procedure. On the contrary, the Italian courts found that the requirement of urgency specified by Italian law was satisfied and granted the relief sought. IT sought to enforce the judgment rendered by the Italian courts in Germany. At first instance, the enforcement order was granted. On appeal, the court concluded that the Italian and German judgments on interim measures were irreconcilable within the meaning of Article 27(3) of the Brussels Convention. On appeal to the *Bundesgerichtshof*, a reference for a preliminary ruling was made to the ECJ, on the interpretation of this provision which provides:

**Article 27(3) of the Brussels Convention**

A judgment shall not be recognized:

(...)

(3) if the judgment is irreconcilable with a judgment given in a dispute between the same parties in the State in which recognition is sought (...).

This provision corresponds to Article 34(3) of the Brussels I Regulation:

**Article 34(3) of the Brussels I Regulation**

A judgment shall not be recognised:

(...)

(3) if it is irreconcilable with a judgment given in a dispute between the same parties in the Member State in which recognition is sought (...).

In its decision, the ECJ affirmed a strict application of Article 27(3) of the Brussels Convention (Article 34(3) of the Brussels I Regulation) in the case of interim relief. Essentially, the court founded its decision on two aspects. First of all, the ECJ made clear that the wording of Article 27(3) of the Brussels Convention does not differentiate between both types of proceedings (principal proceedings/provisional proceedings):

“(...) (I)t is unimportant whether the judgments at issue have been delivered in proceedings for interim measures or in proceedings on the substance. As Article 27(3) of the Brussels Convention (...) refers to ‘judgments’ without further precision, it has general application (...).”<sup>1321</sup>

---

<sup>1321</sup> ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, [2002] ECR I-04995, para. 41 – *Italian Leather*.

Besides, the court confirmed its jurisprudence in the *Hoffmann* decision where the court had held that

“(i)n order to ascertain whether the two judgments are irreconcilable within the meaning of Article 27(3), it should be examined whether they entail legal consequences that are mutually exclusive”<sup>1322</sup>

and stated that

“(...) irreconcilability lies in the effects of judgments. (...)”<sup>1323</sup>

On this basis, the ECJ held that

“(...) on a proper construction of Article 27(3) of the Brussels Convention, a foreign decision on interim measures ordering an obligor not to carry out certain acts is irreconcilable with a decision on interim measures refusing to grant such an order in a dispute between the same parties in the State where recognition is sought.”<sup>1324</sup>

Additionally, the court made clear:

“(...) (W)here a court of the State in which recognition is sought finds that a judgment of a court of another Contracting State is irreconcilable with a judgment given by a court of the former State in a dispute between the same parties, it is required to refuse to recognise the foreign judgment.”<sup>1325</sup>

As a consequence, the State in which recognition is sought may not waive the enforcement of its own decision, as, according to the ECJ,

“(...) it would be contrary to the principle of legal certainty (...) to interpret Article 27(3) as conferring on the court of the State in which recognition is sought the power to authorise recognition of a foreign judgment when it is irreconcilable with a judgment given in that Contracting State.”<sup>1326</sup>

However, this conception has not remained uncontested: It has been feared that, due to the fact that Article 27 has, if any, only a limited scope of application as to interim proceedings, the danger of opposing decisions in the internal market constitutes a more significant threat for legal certainty.<sup>1327</sup>

Unlike the Brussels I Regulation where the recognition of a judgment rendered in a Member State in another Member State does not require any special procedure (Article 33(1) of the Brussels I Regulation), while its enforcement in another Member State requires its enforceability in the Member State of origin as well as a declaration of enforceability for the other Member State (Article 38(1) of the Brussels I Regulation), Article 36(1) of the Brussels Ibis Regulation contains a similar rule as Article 33(1) of the Brussels I Regulation at the

---

<sup>1322</sup> ECJ 4 February 1988, C-145/86, *Horst Ludwig Martin Hoffmann v Adelheid Krieg*, [1988] ECR 00645, para. 22 – *Hoffmann*; cf. B. Hess (case note) ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, (2005)25(1) IPRax 23, at p. 24.

<sup>1323</sup> ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, [2002] ECR I-04995, para. 44 – *Italian Leather*.

<sup>1324</sup> ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, [2002] ECR I-04995, para. 47 – *Italian Leather*.

<sup>1325</sup> ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, [2002] ECR I-04995, para. 52 – *Italian Leather*.

<sup>1326</sup> ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, [2002] ECR I-04995, para. 51 – *Italian Leather*.

<sup>1327</sup> *Wolf & Lange* (2003)49(1) RIW 55, at p. 58.

recognition level, but Article 39 of the Brussels Ibis Regulation generally abolishes the need of declaring the judgment enforceable:<sup>1328</sup>

#### **Article 39 of the Brussels Ibis Regulation**

A judgment given in a Member State which is enforceable in that Member State shall be enforceable in the other Member States without any declaration of enforceability being required.

However, Article 45(1)(c) and (d) of the Brussels Ibis Regulation (which is similar to Article 34(3), (4) of the Brussels I Regulation) provides for the possibility of a refusal of the recognition of a judgment rendered in another Member State. But in contrast to Article 34 of the Brussels I Regulation (“a judgment shall not be recognised”), Article 45 of the Brussels Ibis Regulation requires a party's application:

#### **Article 45(1)(c) and (d) of the Brussels Ibis Regulation**

(1) On the application of any interested party the recognition of a judgment shall be refused:

(...)

(c) if the judgment is irreconcilable with a judgment given between the same parties in the Member State addressed;

(d) if the judgment is irreconcilable with an earlier judgment given in another Member State or in a third State involving the same cause of action and between the same parties, provided that the earlier judgment fulfils the conditions necessary for its recognition in the Member State addressed.

As has been cited above, Article 2(a) of the Brussels Ibis Regulation determines that "for the purposes of Chapter III" of the Brussels Ibis Regulation dealing with recognition and enforcement, provisional measures shall be considered judgments *if they are issued by a Member State court which has jurisdiction for the substance of a matter according to the Brussels Ibis Regulation*:

#### **Article 2(a) of the Brussels Ibis Regulation**

For the purposes of this Regulation:

(a) (...) For the purposes of Chapter III, 'judgment' includes provisional, including protective, measures ordered by a court or tribunal which by virtue of this Regulation has jurisdiction as to the substance of the matter.(...)

Besides, according to Article 46 of the Brussels Ibis Regulation, the enforcement of a judgment rendered in another Member State shall be denied where, on the application of the defendant, the court accepts the existence of one of the grounds addressed in Article 45, thus including Article 45(c) and (d) of the Brussels Ibis Regulation:

---

<sup>1328</sup> Von Hein (2013)59(3) RIW 97, at p. 109.

## Article 46 of the Brussels Ibis Regulation

On the application of the person against whom enforcement is sought, the enforcement of a judgment shall be refused where one of the grounds referred to in Article 45 is found to exist.

The Brussels Ibis Regulation thus provides for extended possibilities for a refusal of enforcement of a judgment rendered in another Member State. It may happen that recognition and enforcement of a provisional measure of the court having jurisdiction for the substance of a case is denied in another Member State where courts (merely) have independent jurisdiction for provisional measures (in conjunction with national law), due to the fact that the decision is irreconcilable with an earlier judgment on the grant of interim relief rendered in that other Member State.<sup>1329</sup>

By creating Article 45(1)(c) and (d) and Article 2(a) of the Brussels Ibis Regulation, the European legislator codified (and restrictively modified) the jurisprudence of the ECJ in *Italian Leather*, clarifying that Article 45(1)(c) and (d) of the Brussels Ibis Regulation is (only) applicable to such provisional measures ordered by a court having accessory jurisdiction for provisional measures. In contrast, provisional measures ordered by a court on the basis of independent jurisdiction for provisional measures do not constitute a “judgment” within the meaning of Article 45 of the Brussels Ibis Regulation (cf. Article 2(a) of the Brussels Ibis Regulation), meaning that Article 45 of the Brussels Ibis Regulation is not applicable in the latter constellation. This means a considerable deviation from the jurisprudence of the ECJ in *Italian Leather* developed under the Brussels Convention (and still applicable under the Brussels I Regulation) which did not differentiate, with regard to Article 27(3) of the Brussels Convention/Article 34(3) of the Brussels I Regulation between accessory and independent jurisdiction for provisional measures.

### 2.5.2.2 Provisional proceedings before a court having jurisdiction according to Article 35

Before going into details as to which requirements must be considered in the framework of Article 35, some basic issues shall be addressed to illustrate the particular character and effect of Article 35, and to clarify the personal and territorial scope of application of this provision.

#### 2.5.2.2.1 Character and effect of Article 35

##### 2.5.2.2.1.1 Conception 1: Article 35 does not *per se* confer jurisdiction, but merely refers to national laws

On the one hand, it might be argued that Article 35 (respectively its predecessors) lacks the character of an autonomous head of jurisdiction,<sup>1330</sup> and merely refers to national laws.<sup>1331</sup> According to this opinion, Article 35 would not have any legal effect in the case that the

---

<sup>1329</sup> Domej (2014)78 RabelsZ 508, at p. 548, with reference to the *Italian Leather* decision of the ECJ (cf. ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, [2002] ECR I-04995 – *Italian Leather*).

<sup>1330</sup> Pörnbacher 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 31 VO (EG) No. 44/2001, para. 1.

<sup>1331</sup> Among others: Layton & Mercer 2004, para. 23.002; Gothot & Holleaux 1985, paras. 201 et seq.; Gaudemet-Tallon 2010, para. 311; Tsirikas & Hausmann 2012 (unalex Kommentar), Art. 31 Brüssel I-VO, para. 20.



national law of an invoked court does not provide a jurisdictional basis for the grant of a provisional measure.

Besides considering the brief wording of Article 35, such a viewpoint could also be based on the schematic location of Article 35 in Section 10 of the Brussels Ibis Regulation that does not belong to the sections of the Brussels Ibis Regulation which provide for the uniform jurisdiction rules.<sup>1332</sup> Article 5(1) – which actually does not mention Section 10 of the Brussels Ibis Regulation – reads:

**Article 5(1) of the Brussels Ibis Regulation**

(1) Persons domiciled in a Member State may be sued in the courts of another Member State only by virtue of the rules set out in Sections 2 to 7 of this Chapter [underscore added].

However, arguing against a conception according to which Article 35 *does not per se* confer jurisdiction but is merely effective in conjunction with national provisions, it may be referred to a sentence of the ECJ in its *Van Uden* decision where the court held *inter alia*:<sup>1333</sup>

“It follows that the granting of provisional or protective measures on the basis of Article 24 [of the Brussels Convention] is conditional on, *inter alia*, the existence of a real connecting link between the subject-matter of the measures sought and the territorial jurisdiction of the Contracting State of the court before which those measures are sought [content in brackets added].”<sup>1334</sup>

**2.5.2.2.1.2 Conception 2: Article 35 is an autonomous head of jurisdiction**

However, the better reasons militate for a conception according to which Article 35 is *per se* sufficient to allocate jurisdiction rather than merely constituting a mechanism to invoke national rules of jurisdiction in disputes which fall within the *ratione materiae* scope of the Brussels Ibis Regulation. According to this conception, Article 35 refers to the internal law of the forum only with regard to the measures which may be granted by the court, and not regarding the national rules of jurisdiction.<sup>1335</sup> It is noteworthy that legal writers advocating this opinion have also referred to the jurisprudence of the ECJ in *Van Uden*, interpreting it in a different way. So, it has been put forth that the ECJ implicitly confirmed that the use of Article 35 does not require the recourse to any national rule of jurisdiction, and that provisional proceedings can therefore be filed exclusively on the basis of Article 35, without any reference to a national (exorbitant) rule of international jurisdiction,<sup>1336</sup> as the court held:

“With regard more particularly to the fact that the national court has in this instance based its jurisdiction on one of the national provisions listed in the second paragraph of Article 3 of the [Brussels] Convention, it must be borne in mind that, in accordance with the first paragraph of that article, persons domiciled in a Contracting State may be sued in the courts of another Contracting State only by virtue of the rules set out in Sections 2 to 6 of Title II, that is to say Articles 5 to 18, of the [Brussels] Convention. Consequently, the prohibition in Article 3 [of the Brussels Convention] of

<sup>1332</sup> Cf. Szychowska 2008, p. 229 (although Szychowska finally advocates another conception).

<sup>1333</sup> Cf. again among others Gothot & Holleaux 1985, paras. 201 et seq.; Gaudemet-Tallon 2010, para. 311.

<sup>1334</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV*, trading as *Van Uden Africa Line*, v *Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 40 – *Van Uden*.

<sup>1335</sup> Pertegás Sender 2002, para. 3.138.

<sup>1336</sup> Pertegás Sender 2002, para. 3.139.

reliance on rules of exorbitant jurisdiction does not apply to the special regime provided for by Article 24 [of the Brussels Convention] [underscore and content in brackets added].<sup>1337</sup>

Apart from the foregoing, other paragraphs in the *Van Uden* decision reveal even more clearly that the ECJ actually favoured an autonomous interpretation of Article 35 (respectively Article 24 of the Brussels Convention). So the ECJ explicated:

“In addition, Article 24, in Section 9 of the [Brussels] Convention, adds a rule of jurisdiction falling outside the system set out in Articles 2 and 5 to 18 [of the Brussels Convention], whereby a court may order provisional or protective measures even if it does not have jurisdiction as to the substance of the case (...) [underscore and content in brackets added].”<sup>1338</sup>

Notably, the ECJ thus awarded to Article 35 *per se* the quality of adding a rule of jurisdiction, not mentioning rules of national law in this context. This significant role of Article 35 according to the ECJ ultimately becomes obvious in two further paragraphs of the *Van Uden* decision:

“(…) (T)he mere fact that proceedings have been, or may be, commenced on the substance of the case before a court of a Contracting State [of the Brussels Convention] does not deprive a court of another Contracting State of its jurisdiction under Article 24 of the Brussels Convention [underscore and content in brackets added].”<sup>1339</sup>

“(…) Where, as in the case in the main proceedings, the subject-matter of an application for provisional measures relates to a question falling within the scope *ratione materiae* of the Brussels Convention, the Convention is applicable and Article 24 thereof may confer jurisdiction on the court hearing that application even where proceedings have already been, or may be, commenced on the substance of the case (...) [underscore added].”<sup>1340</sup>

### 2.5.2.2.1.3 Conclusion

Apart from the fact that the jurisprudence of the ECJ is to be considered to be definitive as to this issue,<sup>1341</sup> a characterisation of Article 35 as an autonomous head of jurisdiction can also be founded on logical grounds. The fundamental reason underlying this conception is the need for a harmonisation of procedural rules governing the jurisdiction in provisional proceedings across the European Union.<sup>1342</sup> If Article 35 was to be interpreted as lacking an autonomous character, with the consequence that a national court would always have to look for a proper basis of jurisdiction in its national law, provisional measures could be ordered on the basis of an exorbitant head of jurisdiction in certain Member States, while in other Member States the national jurisdictional rules applying to provisional proceedings are much more restrictive and in some they do not exist at all. In contrast to this scenario, an autonomous understanding of Article 35 is appropriate to prevent an incoherent application of this provision which would be the consequence of divergent national laws.<sup>1343</sup>

<sup>1337</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 42 – *Van Uden*.

<sup>1338</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 20 – *Van Uden*.

<sup>1339</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 29 – *Van Uden*.

<sup>1340</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 34 – *Van Uden*.

<sup>1341</sup> It has partly been put forth that this issue has not been resolved yet and that a clarifying decision by the ECJ is still to be awaited, cf. Szychowska 2008, p. 230.

<sup>1342</sup> Szychowska 2008, p. 229.

<sup>1343</sup> Szychowska 2008, p. 229.

### 2.5.2.2.2 Personal and territorial scope of application of Article 35

Beyond this aspect of the autonomous nature of Article 35 addressed above, another issue discussed controversially is whether Article 35 is to be considered autonomous also with regard to all other provisions of Chapter II of the Brussels Ibis Regulation, i.e. also with regard to Article 6(1) which provides:

#### Article 6(1) of the Brussels Ibis Regulation

(1) If the defendant is not domiciled in a Member State, the jurisdiction of the courts of each Member State shall, subject to Article 18(1), Article 21(2) and Articles 24 and 25, be determined by the law of that Member State.

If this question should be answered in the positive, a court could also employ Article 35 to grant provisional measures against a defendant who is *not* domiciled in a Member State.

#### 2.5.2.2.2.1 Conception 1: Applicability of Article 35 vis-à-vis defendants domiciled in non-Member States

Interestingly, in particular Belgian courts have constantly favoured a conception according to which Article 35 (respectively its predecessors under the Brussels Convention and the Brussels I Regulation) is applicable also vis-à-vis defendants domiciled in a non-Member State (respectively a non-Contracting State under the Brussels Convention),<sup>1344</sup> even in opposition to the demand of the plaintiffs invoking the internal rules of jurisdiction according to Article 6(1).<sup>1345</sup> According to this conception, Article 35 of the Brussels Ibis Regulation (respectively its predecessors) constitutes a fully operative jurisdiction rule independent from Article 6(1) of the Brussels Ibis Regulation (respectively its predecessors), and jurisdiction in provisional proceedings can thus be founded if only the relief sought falls within the scope of application *rationae materiae* of the Brussels Ibis Regulation (respectively its predecessors), and if there is a connecting link between the measure and the territory of the State where the court is situated.<sup>1346</sup>

Parts of legal doctrine have supported this conception. Essentially, two lines of reasoning shall be subject to a closer analysis in this respect. On the one hand, starting from the fact that Article 5(1) of the Brussels Ibis Regulation which tends to harmonise the rules of jurisdiction applicable towards the defendants domiciled in the Member States, only mentions Sections 2 to 7 of Chapter II of the Brussels Ibis Regulation, and not Section 10 where Article 35 is located, it might be derived that Article 5 covers only the rules applicable in principal proceedings. On the assumption that Article 6 must be read in conjunction with Article 5 as it completes the idea expressed in this provision, it could be argued that the reach of Article 6 is also limited to Sections 2 to 7 of Chapter II of the Brussels Ibis Regulation. Consequently, following this argumentation, Article 35 would be left beyond the scope of application of Article 6, too, and would thus be independent.<sup>1347</sup>

<sup>1344</sup> Szychowska 2008, pp. 229-231 with references to Belgian case-law.

<sup>1345</sup> Szychowska 2008, p. 231 with references to Belgian case-law.

<sup>1346</sup> Szychowska 2008, p. 231.

<sup>1347</sup> Cf. Szychowska 2008, p. 233.

Furthermore, alleged parallels between Articles 29 and 30 on the one hand, and Article 35 on the other hand (respectively between the predecessors of these provisions) have been stressed in order to prove that the defendant's domicile is irrelevant as to the applicability of Article 35 (respectively its predecessors). Indeed, the ECJ held in its *Overseas Union Insurance* decision on the interpretation of *inter alia* Article 21 of the Brussels Convention (Article 29 of the Brussels Ibis Regulation) that this provision must be applied irrespective of the domicile of the defendant. *In concreto*, the court decided that

“(…) the wording of Article 21 [of the Brussels Convention], unlike the wording of other provisions of the [Brussels] Convention, makes no reference to the domicile of the parties to the proceedings. Moreover, Article 21 does not draw any distinction between the various heads of jurisdiction provided for in the [Brussels] Convention. In particular, it does not provide for any derogation to cover a case where, in accordance with the provisions of Article 4 of the [Brussels] Convention, a court of a Contracting State exercises its jurisdiction by virtue of the law of that State over a defendant who is not domiciled in a Contracting State.

Consequently, it appears from the wording of Article 21 that it must be applied both where the jurisdiction of the court is determined by the [Brussels] Convention itself and where it is derived from the legislation of a Contracting State in accordance with Article 4 of the [Brussels] Convention [content in brackets added].”<sup>1348</sup>

In this regard, one might conclude<sup>1349</sup> that the ECJ followed the same logic in its *Van Uden* decision when the court stated that

“(…) the prohibition in Article 3 [of the Brussels Convention] of reliance on rules of exorbitant jurisdiction does not apply to the special regime provided for by Article 24 [of the Brussels Convention] [content in brackets added].”<sup>1350</sup>

On this basis, it might be derived that the principal criterion of the ECJ regarding the application of Article 35 in the *Van Uden* case was not the domicile of the defendant, but the simple filing of an application for the interim relief before a Member State court.<sup>1351</sup> Even clearer, it might be concluded that the rule of applicability *rationae loci* set out in Article 5 is not to be considered as the rule of applicability of the Brussels Ibis Regulation as such, but only of the uniform rules of it, bearing the consequence that the Brussels Ibis Regulation applies wherever the defendant is domiciled, but if he is domiciled in the European Union, he may not be sued otherwise than by virtue of the uniform rules established in Sections 2 to 7 of Chapter II of the Brussels Ibis Regulation.<sup>1352</sup>

#### **2.5.2.2.2 Conception 2: Applicability of Article 35 merely vis-à-vis defendants domiciled in Member States**

The approach dealt with in the foregoing paragraphs, which noticeably has been repeatedly pursued by Belgian courts and may for this reason be called the “Belgian approach”, has remained rather unique, while the majority of legal commentators and Member States courts – if this issue has been found worthwhile for broad discussion and detailed analysis at all – have

---

<sup>1348</sup> ECJ 27 June 1991, C-351/89, *Overseas Union Insurance Limited and Others v New Hampshire Insurance Company*, [1991] ECR I-03317, paras. 13-14 – *Overseas Union Insurance*.

<sup>1349</sup> Cf. Szychowska 2008, p. 233.

<sup>1350</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 42 – *Van Uden*.

<sup>1351</sup> Szychowska 2008, p. 233.

<sup>1352</sup> Szychowska 2008, p. 234.

advocated an interpretation of Article 35 (respectively its predecessors) according to which this provision is not applicable vis-à-vis defendants who are domiciled in a third State.

For instance, the Dutch *Hoge Raad* decided in this way in the *Postech* case. The decision was based on the following facts: The plaintiff, the Dutch company Philips, sued several companies, amongst them Postech Corporation, established in Taiwan, Princo Corporation, established in Taiwan, and Princo Switzerland AG, established in Switzerland, for infringement of Philips' patent rights, after Dutch customs officials had detained a consignment of CD-R discs on their way from Taiwan to Switzerland. The defendants demanded the release of the CD-R discs due to the fact that they had merely been in transit via the Netherlands. The defendants put forth that the mere transit of goods could not be considered as patent infringement according to Dutch law. As to the issue of jurisdiction of Dutch courts to grant interim relief towards defendants being domiciled in third States, the *Hoge Raad* held:

“(…) Voorzover het hof [= Gerechtshof ‘s-Gravenhage] mocht hebben geoordeeld dat deze terughoudendheid geboden is op grond van het door het hof genoemde arrest van het HvJEG van 21 mei 1980 (Denilauler/Couchet Frères) heeft het hof uit het oog verloren dat de in dat arrest gegeven aanwijzing om bij het treffen van grensoverschrijdende voorlopige of bewarende maatregelen terughoudendheid te betrachten, niet geldt ten opzichte van Postech en Princo Taiwan, nu deze vennootschappen niet zijn gevestigd op het grond-gebied van een staat die partij is bij het EEX-Verdrag of van het EVEX, zodat ten aanzien van deze vennootschappen de regeling van het EEX-verdrag of het EVEX niet van toepassing is (...) [underscore and content in brackets added].”<sup>1353</sup>

“(…) As far as the court [= Gerechtshof ‘s-Gravenhage] may have judged that this restraint is necessary due to the order, as quoted by the court, of the ECJ from 21 May 1980 (Denilauler/Couchet Frères), the court has lost sight of the fact that the indication given in that order to practice restraint when taking cross-border temporary or conservatory measures does not apply to Postech and Princo Taiwan, because these companies are not established on the territory of a State being party to the Brussels Convention or the Lugano Convention, so that the arrangements of the Brussels Convention or the Lugano Convention do not apply to these companies (...) [underscore and content in brackets added].”<sup>1354</sup>

In legal doctrine as well, it has been postulated that Article 35 (respectively its predecessors) cannot be invoked where the defendant is not domiciled in the territory covered by the Brussels Ibis Regulation (Brussels Convention/Brussels I Regulation), except where the proceedings on the merits fall within the scope of the rules on exclusive (or protective) jurisdiction or submission, as these provisions apply regardless of the place where the defendant is domiciled.<sup>1355</sup>

As has been illustrated above, the *Van Uden* decision of the ECJ demonstrates quite clearly the court's interpretation of Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation) as an autonomous head of jurisdiction. In view of this, it seems comprehensible and logical to submit Article 35 to the same regime and to interpret it in the same way in the light of Article 5 as other common rules of jurisdiction of the Brussels Ibis Regulation. Such an understanding is also supported by Recitals 13 and 14 of the Brussels Ibis Regulation which, *in principle*,<sup>1356</sup> require the defendant's domicile in a Member State as a prerequisite for the common rules of jurisdiction of the Brussels Ibis Regulation to be applicable. Recitals 13 and 14 of the Brussels Ibis Regulation read as follows:

---

<sup>1353</sup> HR 19 March 2004, C02/110HR, Koninklijke Philips Electronics N.V. v Postech Corporation and Others, NJ 2007, 585, para. 3.4.3, with case note P. Vlas – *Postech*.

<sup>1354</sup> Translation provided by the author of this thesis.

<sup>1355</sup> Pertegás Sender 2002, para. 3.130.

<sup>1356</sup> Cf. Recital 14 2<sup>nd</sup> sentence for exceptions.

### Recitals 13 and 14 of the Brussels Ibis Regulation

(13) There must be a connection between proceedings to which this Regulation applies and the territory of the Member States. Accordingly, common rules of jurisdiction should, in principle, apply when the defendant is domiciled in a Member State.

(14) A defendant not domiciled in a Member State should in general be subject to national rules of jurisdiction applicable in the territory of the Member State of the court seised.

However, in order to ensure the protection of consumers and employees, to safeguard the jurisdiction of the courts of the Member States in situations where they have exclusive jurisdiction and to respect the autonomy of the parties, certain rules of jurisdiction in this Regulation should apply regardless of the defendant's domicile.

Noteworthy, Article 6(1) immediately refers to the national laws of the Member States, not requiring the detour via Article 35. Consequently, given that Article 6(1) is applicable, i.e. if the defendant is domiciled in a non-Member State, provisions of the Brussels Ibis Regulation as to jurisdiction are (subject to Articles 18(1), 21(2), 24 and 25) merely determined by the national laws of the Member States. So, the constellation discussed here lies outside the scope of application of Article 35.<sup>1357</sup>

Moreover, it is actually doubtful that Articles 5 and 6 are to be read in such a context that the reach of Article 6 is also limited to Sections 2 to 7 of Chapter II of the Brussels Ibis Regulation – as it is the case regarding Article 5 – with the effect that Article 35 would be left beyond the scope of application of Article 6, too, and would thus be independent. Indeed, Article 6, in contrast to Article 5, does not mention Sections 2 to 7 of Chapter II of the Brussels Ibis Regulation at all, which rather implies that Article 6 is generally applicable when the defendant is not domiciled in a Member State.

As to the jurisprudence of the ECJ in its *Overseas Union Insurance* case where the court held that Article 21 of the Brussels Convention (Article 29 of the Brussels Ibis Regulation) must be applied both where the jurisdiction of the court is determined by the Brussels Convention (Brussels Ibis Regulation) itself and where it is derived from the legislation of a Member State in accordance with Article 4 of the Brussels Convention (Article 6 of the Brussels Ibis Regulation), the crucial question is whether Articles 29 and 30 on the one hand and Article 35 on the other hand, are actually comparable to such an extent that judicial evaluations concerning one of these provisions may be applied to the others. It is noteworthy that even proponents of the opposite view have admitted that these provisions pursue different objectives, given that Articles 29 and 30 (respectively their predecessors) are aimed at limiting the risk of irreconcilable judgments being given in parallel proceedings, while Article 35 (respectively its predecessors) intends to avoid to cause loss to the parties as a result of the long delays which are inherent to any international litigation.<sup>1358</sup> In light of this, the line of reasoning pursued by the opposite opinion reveals its weak point at least regarding the following aspect: If the alleged parallels between Articles 29 and 30 on the one hand, and Article 35 on the other hand, thus turn out not to exist, respectively not to exist to the asserted extent, then it seems indeed highly doubtful, due to the opposing aims of these provisions, that the clear statement of the ECJ in *Overseas Union Insurance* as to the application of Article 21 of the Brussels Convention (Article 29 of the Brussels Ibis Regulation) may be employed with regard to Article 35. Besides, the jurisprudence of the ECJ in *Van Uden*, referred to by the opposite opinion, that

<sup>1357</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 6.

<sup>1358</sup> Conceding this fact: Szychowska 2008, p. 233.

“(…) the prohibition in Article 3 [of the Brussels Convention] of reliance on rules of exorbitant jurisdiction does not apply to the special regime provided for by Article 24 [of the Brussels Convention] [content in brackets added]”<sup>1359</sup>

does not necessarily militate for the conception that Article 35 is applicable regardless the place where the defendant’s domicile is located, but also makes sense on the basis of a conception according to which Article 35 is merely applicable if the defendant is domiciled in a Member State.

### 2.5.2.2.3 Conclusion

In view of the foregoing discussion, the conception of an interpretation of Article 35 according to which Article 35 merely applies vis-à-vis defendants domiciled in Member States is to be supported, because it corresponds best to the interpretation of the ECJ, revealed in its *Van Uden* decision, of Article 35 as an autonomous head of jurisdiction. Additionally, the schematic structure of the Brussels Ibis Regulation, in particular the fact that Article 6(1) immediately refers to the national laws of the Member States without Article 35 being involved regarding this reference, argues for such a conception of Article 35.

However, it should be pointed out that this result cannot be founded on the theoretical consideration that the application of Article 35 vis-à-vis defendants domiciled in non-Member States must be denied due to the fact that provisional proceedings are considered to be a sort of introduction to the principal proceedings which should regularly be initiated simultaneously or at least in a short time after the filing of the application for an interim relief, and that it would thus seem artificial to apply the Brussels Ibis Regulation in the provisional proceedings and the national rules in the proceedings on the merits.<sup>1360</sup> In this respect it is to be underlined that there is no justification for a continuous application of the Brussels Ibis Regulation on every stage of the proceedings.<sup>1361</sup> Additionally, as has already been stressed above, it is a matter of fact that many intellectual property disputes do not even reach the stage of principal proceedings, after provisional proceedings have been commenced.

Similarly, this finding cannot be grounded on the argument either that Article 35 *per se* requires the simultaneous application of the Brussels Ibis Regulation, in conformity with all the criteria of its applicability, because the wording of Article 35 reveals that the provisional measures may be applied for

“(…) even if, under this Regulation, the courts of another Member State have jurisdiction as to the substance of the matter”,

and thus eventually implies, by the use of the present tense, that Article 35 may be applied only if the dispute as to the principal proceedings could be simultaneously attached to the court of one of the Member States on the grounds set out by the Brussels Ibis Regulation. One might conclude then that the entire Brussels Ibis Regulation must be applicable, *rationae materiae* and *rationae loci*.<sup>1362</sup> Indeed, such an understanding of Article 35 could – at least in theory – be derived from the jurisprudence of the ECJ in its *De Cavel* case where the court

---

<sup>1359</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 42 – *Van Uden*.

<sup>1360</sup> Cf. Szychowska 2008, p. 234.

<sup>1361</sup> Szychowska 2008, p. 235.

<sup>1362</sup> Cf. Szychowska 2008, p. 234.

held *inter alia* with regard to Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation):

“(…) In fact that provision [Article 24 of the Brussels Convention] expressly envisages the case of provisional measures in a Contracting State where “under this Convention” the courts of another Contracting State have jurisdiction as to the substance of the matter and it cannot, therefore, be relied on to bring within the scope of the Convention provisional or protective measures relating to matters which are excluded therefrom [content in brackets added].”<sup>1363</sup>

However, it is at least possible as well to comprehend the wording of Article 35 with the reference to other rules of the Brussels Ibis Regulation as a reference also to Article 6. When applying the national rules in order to establish whether it has jurisdiction over a defendant domiciled in a third State, the court acts by virtue of Article 6, i.e. “under the Brussels Ibis Regulation” even though it borrows the jurisdictional rule from the national law.<sup>1364</sup>

### 2.5.2.2.3 Specific requirements of Article 35

As has been illustrated above, it is to be emphasised that interim relief is of utmost importance in order to grant effective legal protection. Therefore, at first glance, it might seem logical to interpret Article 35 in a broad way in order to confer jurisdiction to take provisional measures according to Article 35 in conjunction with national provisions to a multitude of national courts. However, such an approach would lose sight of the fact that the Brussels Ibis Regulation also implies further objectives which would certainly be foiled if national courts would be given too extensive competence to grant interim relief via Article 35. In this regard, it is to be noticed that the creators of the Brussels Ibis Regulation have emphasised, in its Recitals 15 and 16, the importance of legal predictability and the significance of the principle that the defendant’s domicile shall be primarily decisive as to the question of which court has jurisdiction, whereas other courts shall be competent only in case of a sufficient connection:

#### Recitals 15 and 16 of the Brussels Ibis Regulation

(15) The rules of jurisdiction should be highly predictable and founded on the principle that jurisdiction is generally based on the defendant’s domicile. Jurisdiction should always be available on this ground save in a few well-defined situations in which the subject-matter of the dispute or the autonomy of the parties warrants a different connecting factor. (...)

(16) In addition to the defendant’s domicile, there should be alternative grounds of jurisdiction based on a close connection between the court and the action or in order to facilitate the sound administration of justice. The existence of a close connection should ensure legal certainty and avoid the possibility of the defendant being sued in a court of a Member State which he could not reasonably have foreseen. (...)

As to interim relief granted according to Article 35, in particular, the ECJ explicitly stated in its *St. Paul Dairy* decision on the interpretation of Article 24 of the Brussels Convention, referring to the *Denlauler* and *Van Uden* decisions:

“The granting of this type of measure requires on the part of the court, in addition to particular care, detailed knowledge of the actual circumstances in which the measures are to take effect. Generally, the

---

<sup>1363</sup> ECJ 27 March 1979, C-143/78, *Jacques de Cavel v Luise de Cavel*, [1979] ECR 01055, para. 9 – *Cavel*.

<sup>1364</sup> Szychowska 2008, p. 235.



court must be able to make its authorisation subject to all conditions guaranteeing the provisional or protective character of the measure ordered (...) [underscore added].”<sup>1365</sup>

This limiting perspective is thus to be considered in the light of the general objectives that proceedings should be brought before a court which is particularly close to the facts (factual proximity), and that forum shopping should be reduced to a reasonable degree<sup>1366</sup> by providing predictable places of jurisdiction.<sup>1367</sup>

On this basis, the ECJ has developed, beyond the wording of Article 35 (respectively its predecessors), several restrictions as to the jurisdiction according to this provision which shall be subject to a deepened analysis in the following paragraphs.

#### **2.5.2.2.3.1 Which provisional measures fall under the scope of application of Article 35?**

One major difference between jurisdiction to take provisional measures, according to Articles 7 to 26 on the one hand, and Article 35 in conjunction with provisions of national law on the other hand, consists in the fact that in the second case a court may not automatically take all provisional measures provided by its national law. Rather, the term “provisional, including protective, measures” used in Article 35 is to be interpreted in an autonomous, European way, due to the general interest of a harmonised application of the provisions of the Brussels Ibis Regulation which could not be reached if national legal systems were decisive in this respect.<sup>1368</sup>

Like its predecessors, the Brussels Convention and the Brussels I Regulation, the Brussels Ibis Regulation does not specify in Article 35 or another Article which measures are to be considered “provisional, including protective, measures”. In any event, in contrast to the Brussels Convention and the Brussels I Regulation, Recital 25 of the Brussels Ibis Regulation at least vaguely outlines the term “provisional, including protective, measures” as follows:

##### **Recital 25 of the Brussels Ibis Regulation**

(25) The notion of provisional, including protective, measures should include, for example, protective orders aimed at obtaining information or preserving evidence as referred to in Articles 6 and 7 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights. It should not include measures which are not of a protective nature, such as measures ordering the hearing of a witness. This should be without prejudice to the application of Council Regulation (EC) No 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil and commercial matters.

Recital 25 of the Brussels Ibis Regulation contains several important statements. First, it underlines that evidence orders are not *a priori* excluded from the scope of provisional measures. However, for being considered as provisional measures, they must have a *protective* character. Measures which lack such a protective character (such as measures ordering the hearing of a witness), may be covered by Council Regulation (EC) No.

---

<sup>1365</sup> ECJ 28 April 2005, C-104/03, *St. Paul Dairy Industries NV v Unibel Exser BVBA*, [2005] ECR I-03481, para. 14 – *St. Paul Dairy*.

<sup>1366</sup> Cf. Tsirikas & Hausmann 2012 (unalex Kommentar), Art. 31 Brüssel I-VO, para. 26.

<sup>1367</sup> Cf. Schauwecker 2009, p. 181.

<sup>1368</sup> Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 31 EuGVVO, para. 34.

1206/2001 (Evidence Regulation)<sup>1369</sup>. However, given it has been discussed controversially whether the Evidence Regulation generally prevails over Article 35 of the Brussels Ibis Regulation (respectively its predecessors),<sup>1370</sup> it would have been desirable to formulate this “rule” in a more distinct way and to integrate it in the text of Article 35 of the Brussels Ibis Regulation.<sup>1371</sup> After all, it is to be underlined that the Brussels Ibis Regulation does not establish a general positive definition of “provisional, including protective, measures”.<sup>1372</sup>

In light of this, I shall analyse in which way the ECJ has constantly shaped the content of the term “provisional, including protective, measures” under the Brussels Convention<sup>1373</sup> and the Brussels I Regulation. It will become obvious that this jurisprudence of the ECJ has partly been picked up in Recital 25 of the Brussels Ibis Regulation.

In its *Reichert II* decision on the interpretation of Articles 5(3), 16(5) and 24 of the Brussels Convention, the court held:

“The expression ‘provisional, including protective, measures’ within the meaning of Article 24 [of the Brussels Convention] must (...) be understood as referring to measures which, in matters within the scope of the Convention, are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is sought elsewhere from the court having jurisdiction as to the substance of the matter [underscore and content in brackets added].”<sup>1374</sup>

Subsequently, referring to the *Reichert II* decision, this (attempt of a) definition has been confirmed in *Van Uden*<sup>1375</sup> and *St. Paul Dairy*<sup>1376</sup> by using the same wording. However, having a closer look on that definition, it becomes clear that, in truth, the formulation is quite vague.

It is noteworthy that the ECJ has until now merely decided that interim performance orders concerning contractual obligations may (under certain conditions) fall within the scope of that definition. So, the ECJ held in *Van Uden* as to interim payments of a contractual consideration:

---

<sup>1369</sup> Council Regulation (EC) No 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters, OJ L174 of 27 June 2001, pp. 1-24, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32001R1206&from=en>> (lastly accessed on 1 June 2015).

<sup>1370</sup> Cf. Mankowski (2005)60(23) JZ 1144, at pp. 1146-1148; Ubertaini (2008)57(10) GRUR Int. 807, at pp. 811-812; Heinze (2008)28(6) IPRax 480, at pp. 482-484; Hess & Zhou (2007)27(3) IPRax 183, at pp. 183-190; J. von Hein (case note) Advocate General 18 July 2007, C-175/06, Alessandro Tedesco v Tomasoni Fittings Srl and RWO Marine Equipment Ltd., (2008)8(1) EuLF I-34, at p. I-34; Von Hein (2013)59(3) RIW 97, at p. 108; cf. Tsirikas & Hausmann 2012 (unalex Kommentar), Art. 31 Brüssel I-VO, para. 16; arguing for a clear coexistence of the Evidence Regulation and Article 35 of the Brussels Ibis Regulation (respectively its predecessors) with separate scopes of application: Knöfel (2008)19(9) EuZW 267, at p. 268; Knöfel 2014 (Geimer & Schütze, Internationaler Rechtsverkehr), Art. 1 VO Nr. 1206/2001 (Beweisaufnahme-VO), para. 33.

<sup>1371</sup> Also denying the usefulness of Recital 25 3<sup>rd</sup> sentence of the Brussels Ibis Regulation: Von Hein (2013)59(3) RIW 97, at p. 108; less critical, approving the direction of Recital 25 3<sup>rd</sup> sentence of the Brussels Ibis Regulation: Domej (2014)78 RabelsZ 508, at p. 547.

<sup>1372</sup> Von Hein (2013)59(3) RIW 97, at p. 108.

<sup>1373</sup> Remarkably, the reports on the Brussels Convention contain no definition of “provisional measures” either, cf. Kropholler & Von Hein 2011, Art. 31 EuGVO, para. 5; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 8.

<sup>1374</sup> ECJ 26 March 1992, C-261/90, Mario Reichert and Others v Dresdner Bank AG, [1992] ECR I-02149, para. 34 – *Reichert II*.

<sup>1375</sup> ECJ 17 November 1998, C-391/95, Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another, [1998] ECR I-07091, para. 37 – *Van Uden*.

<sup>1376</sup> ECJ 28 April 2005, C-104/03, St. Paul Dairy Industries NV v Unibel Exser BVBA, [2005] ECR I-03481, para. 13 – *St. Paul Dairy*.

“However, an order for interim payment of a sum of money is, by its very nature, such that it may preempt the decision on the substance of the case. If, moreover, the plaintiff were entitled to secure interim payment of a contractual consideration before the courts of the place where he is himself domiciled, where those courts have no jurisdiction over the substance of the case under Articles 2 to 18 of the [Brussels] Convention, and thereafter to have the order in question recognised and enforced in the defendant's State, the rules of jurisdiction laid down by the [Brussels] Convention could be circumvented.

Consequently, interim payment of a contractual consideration does not constitute a provisional measure within the meaning of Article 24 [of the Brussels Convention] unless, first, repayment to the defendant of the sum awarded is guaranteed if the plaintiff is unsuccessful as regards the substance of his claim and, second, the measure sought relates only to specific assets of the defendant located or to be located within the confines of the territorial jurisdiction of the court to which application is made [underscores and content in brackets added].”<sup>1377</sup>

This jurisprudence has subsequently been confirmed in *Mietz*.<sup>1378</sup> In this light, the crucial question is whether this jurisprudence can also be extended to non-contractual liability. It has been rightly emphasised that interim performance orders also cover the constellations that a patent holder claims restitution of objects infringing the concerned patent, or requests the recall or the destruction<sup>1379</sup> of such objects, or requests the issue of information on the scope and the identity of involved persons as to an infringement.<sup>1380</sup> Besides, it is to be questioned if the jurisprudence of the ECJ also concerns interim injunctions which are considerably important in matters of intellectual property, because they often form the only way to secure a right until a decision in the principal proceeding has been taken.<sup>1381</sup> Last but not least, I shall research whether interim measures to obtain or secure evidence are affected by the said jurisprudence of the ECJ.<sup>1382</sup>

An analysis must start from the two aspects stressed by the ECJ in its *Van Uden* and *Mietz* decisions: first, the necessity for an interim payment of a contractual consideration to have the character of a provisional measure within the meaning of Article 35, that repayment is guaranteed, and second, that rules of jurisdiction shall not be circumvented. More generally, it may be derived from this jurisprudence that provisional measures within the meaning of Article 35 generally comprise only such measures which do not effect an irreversible anticipation of a decision in principal proceedings and also do not effect a circumvention of jurisdiction rules laid down in the Brussels Ibis Regulation. In this respect, it is to be stated that the danger that a decision in principal proceedings is anticipated by an interlocutory injunction, resulting in a potential circumvention of rules of jurisdiction as to principal proceedings, exists both with regard to contractual and non-contractual obligations.<sup>1383</sup> As a consequence, it seems justified to apply the cited jurisprudence of the ECJ in *Van Uden* and *Mietz* to non-contractual liability.<sup>1384</sup> This result is confirmed by the fact that the ECJ, in its

---

<sup>1377</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, paras. 46-47 – *Van Uden*.

<sup>1378</sup> ECJ 27 April 1999, C-99/96, *Hans-Hermann Mietz v Intership Yachting Sneek BV*, [1999] ECR I-02277, para. 42 – *Mietz*.

<sup>1379</sup> It is noteworthy that the destruction of objects by way of an interlocutory injunction is excluded in most Member States, because principal proceedings would be definitely anticipated otherwise. However, the Dutch *kort geding* procedure provides for the creation of consequences which would not be possible by way of interlocutory relief in other legal systems, cf. Pansch 2003, pp. 115-116.

<sup>1380</sup> Heinze 2007, p. 93.

<sup>1381</sup> Heinze 2007, p. 102.

<sup>1382</sup> Grabinski 2007, pp. 193-195; Heinze 2007, p. 102 et seq.; Wannemacher 2007, p. 144 et seq.; Treichel 2001, p. 58 et seq.

<sup>1383</sup> Heinze 2007, p. 94.

<sup>1384</sup> Heinze 2007, p. 94; Pålsson 2000, p. 627; Pansch 2003, p. 40, there fn. 168; Geimer 2010 (Geimer & Schütze, *Europäisches Zivilverfahrensrecht*), Art. 31 EuGVVO, para. 50.

*Van Uden* decision, referred to a decision on general Community law (Article 243 EC Treaty) affecting a non-contractual claim for damages. The court held:

“(…) (I)t is not possible to rule out in advance, in a general and abstract manner, that interim payment of a contractual consideration, even in an amount corresponding to that sought as principal relief, may be necessary in order to ensure the practical effect of the decision on the substance of the case and may, in certain cases, appear justified with regard to the interests involved (see, in the context of Community law, Case C-393/96 P(R) *Antonissen v Council and Commission* [1997] ECR I-441, paragraph 37).”<sup>1385</sup>

In light of this, it has partly been concluded that other injunctions than the injunction of an interim payment of damages would not fall under the ambit of this jurisprudence of the ECJ due to their irreversibility.<sup>1386</sup> However, given that not all interim injunctions mean an anticipation of a decision in the principal proceedings, and that protection of the defendant is possible in numerous cases,<sup>1387</sup> it is more convincing not to exclude interim injunctions from the discussed jurisprudence of the ECJ. Taking into consideration the formulation of the ECJ in *Van Uden* where the court stressed the general aspect that the outcome of principal proceedings should not be irreversibly anticipated, while, remarkably, not excluding specific forms of preliminary injunctions, no form of interlocutory injunctions should *per se* be excluded. Rather, it must be examined from case to case whether an unjustified interlocutory injunction is reversible, comparably to the constellation decided in *Van Uden* where the ECJ held that the repayment of an interim payment must be guaranteed.<sup>1388</sup> In this sense, “guarantee of repayment” should be interpreted as “guarantee of temporariness”.<sup>1389</sup>

As to interim measures concerning evidence, this notion comprises both interim measures to obtain evidence and interim measures to secure evidence.<sup>1390</sup> With regard to the question of whether such interim measures to obtain or secure evidence fall under the scope of Article 35, the jurisprudence of the ECJ in *St. Paul Dairy* is to be considered. In this case the ECJ explicated *inter alia*:

“(…) Article 24 of the [Brussels] Convention must be interpreted as meaning that a measure ordering the hearing of a witness for the purpose of enabling the applicant to decide whether to bring a case, determine whether it would be well founded and assess the relevance of evidence which might be adduced in that regard is not covered by the notion of 'provisional, including protective, measures' [underscores and content in brackets added].”<sup>1391</sup>

At first glance, it might be concluded from this judgment that evidentiary measures are principally governed exclusively by the rules on judicial cooperation in the taking of evidence. In the European context, this would mean that the rules of Council Regulation (EC) No 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil and commercial matters (Evidence Regulation) are decisive. In the international arena, the corresponding instrument would be the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters.<sup>1392</sup> However, Article 50(1)(b) TRIPS explicitly qualifies measures to preserve relevant evidence in regard to the alleged

<sup>1385</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 45 – *Van Uden*.

<sup>1386</sup> Willeitner 2003, p. 105 et seq.

<sup>1387</sup> Wannenmacher 2007, p. 166 et seq.

<sup>1388</sup> Schauwecker 2009, p. 185; Wannenmacher 2007, p. 167.

<sup>1389</sup> Wannenmacher 2007, p. 167.

<sup>1390</sup> Cf. Hess & Zhou (2007)27(3) IPRax 183.

<sup>1391</sup> ECJ 28 April 2005, C-104/03, *St. Paul Dairy Industries NV v Unibel Exser BVBA*, [2005] ECR I-03481, para. 25 – *St. Paul Dairy*.

<sup>1392</sup> Hague Convention of 18 March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters, available at WWW <<http://www.hcch.net/upload/conventions/txt20en.pdf>> (lastly accessed on 1 June 2015).

infringement as provisional measures. Also in light of this, it is doubtful whether that conception can be correct.<sup>1393</sup>

In order to show that another interpretation of the cited passage of the *St. Paul Dairy* decision of the ECJ is more convincing, the same passage shall be cited again, but underscored in a different way to illustrate the difference between both conceptions and highlight the actual context in which single parts of the decision must be understood:

“(…) Article 24 of the [Brussels] Convention must be interpreted as meaning that a measure ordering the hearing of a witness for the purpose of enabling the applicant to decide whether to bring a case, determine whether it would be well founded and assess the relevance of evidence which might be adduced in that regard is not covered by the notion of ‘provisional, including protective, measures’ [underscore and content in brackets added].”<sup>1394</sup>

Having a closer look on the cited passage reveals that the decisive part of this passage is the following: “(…) for the *purpose* of enabling the applicant to decide whether to bring a case, determine whether it would be well founded and assess the relevance of evidence which might be adduced in that regard”. This formulation referring to the *purpose* of such an interim measure actually makes clear the attitude of the ECJ that interim measures to obtain or secure evidence are not *per se* excluded from the ambit of Article 35, but only if the sole purpose of such measures consists in assessing the chances or risks of principal proceedings. Such an interpretation is indeed supported by another passage of the *St. Paul Dairy* decision where the ECJ also suggested that an interim measure to obtain or secure evidence falls under the scope of Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation)

“(…) only to the extent that the measure sought pursues the aims of that article.”<sup>1395</sup>

As a consequence, interim measures to obtain or secure evidence may constitute measures according to Article 35 of the Brussels Ibis Regulation if their purpose is to preserve evidence to be employed in principal proceedings, i.e. if they shall prevent the loss of that evidence in order to enforce a claim in principal proceedings respectively enforce such claim without considerable delay.<sup>1396</sup>

#### 2.5.2.2.3.2 The prerequisite of a “real connecting link”

While it has been analysed in the foregoing paragraphs that interim performance orders, interim injunctions and evidence orders can generally be decided by a court having jurisdiction according to Article 35, it has not been clarified yet whether such measures can also be decided, on the basis of Article 35, if the patent concerned was granted in or for another State than the State of the deciding court. In this respect, the ECJ suggested, in its *Denilauler* decision, the necessity of a geographical link between the deciding court and the assets affected by (interim) measures, formulating:

“The courts of the place or, in any event, of the Contracting State, where the assets subject to the measures sought are located, are those best able to assess the circumstances which may lead to the grant

---

<sup>1393</sup> Cf. Hess 2008, p. 298: “Pretending an exclusive character of the Evidence Regulation would clearly contradict the objective of the instrument conceived to improve the taking of evidence abroad.”

<sup>1394</sup> ECJ 28 April 2005, C-104/03, *St. Paul Dairy Industries NV v Unibel Exser BVBA*, [2005] ECR I-03481, para. 25 – *St. Paul Dairy*.

<sup>1395</sup> ECJ 28 April 2005, C-104/03, *St. Paul Dairy Industries NV v Unibel Exser BVBA*, [2005] ECR I-03481, para. 21 – *St. Paul Dairy*.

<sup>1396</sup> Schauwecker 2009, p. 186; Schlosser 2008 (Heidelberg Report), paras. 610-611, Heinze 2007, p. 112 et seq.

or refusal of the measures sought or to the laying down of procedures and conditions which the plaintiff must observe in order to guarantee the provisional and protective character of the measures ordered. The [Brussels] Convention has taken account of these requirements by providing in Article 24 [of the Brussels Convention] that application may be made to the courts of a Contracting State for such provisional, including protective, measures as may be available under the law of that State, even if, under the [Brussels] Convention, the courts of another Contracting State have jurisdiction as to the substance of the matter [underscore and content in brackets added].”<sup>1397</sup>

This idea of the requirement of a sufficient link between a provisional measure and jurisdiction of the deciding court has later been concretised in the *Van Uden* decision where the ECJ held explicitly:

“It follows that the granting of provisional or protective measures on the basis of Article 24 [of the Brussels Convention] is conditional on, *inter alia*, the existence of a real connecting link between the subject-matter of the measures sought and the territorial jurisdiction of the Contracting State of the court before which those measures are sought [underscore and content in brackets added].”<sup>1398</sup>

However, despite the setting up of the criterion of a “real connecting link” it is far from being clear what exactly is its meaning.<sup>1399</sup>

#### 2.5.2.2.3.2.1 Reference objects of the “real connecting link”

##### 2.5.2.2.3.2.1.1 Conception 1: Relevance of the “*Belegenheitsanknüpfung*”/“*Wirkungsort*”

On the one hand it might be argued that such a “real connecting link” must exist between the provisional measure and the State where the concerned patent was granted. In this respect, it could be reasoned that, regarding intellectual property rights, such a territorial link exists only in the State where the right was granted (“*Belegenheitsstaat*”), because the right can only be used in that State due to the principle of territoriality. As a consequence, any provisional measure concerning this right could only have effect in that State.<sup>1400</sup> Arguing for this conception, it has been put forth that the ECJ, when referring to the ability of the court to “assess the circumstances which may lead to the grant or refusal of the measures sought or to the laying down of procedures and conditions which the plaintiff must observe in order to guarantee the provisional and protective character of the measures ordered”<sup>1401</sup>, did not *explicitly* address the aspect of enforcement.<sup>1402</sup> Rather, the ECJ merely referred to the *factual proximity* of the measure and the court, without differentiating between securing and non-securing measures.<sup>1403</sup> Besides, it has been underlined that regarding some constellations (“*rechtsgestaltende Maßnahmen*”), there is no enforcement at all. A concept based on the relevance of the aspect of enforcement would thus go astray in these constellations.<sup>1404</sup>

---

<sup>1397</sup> ECJ 21 May 1980, C-125/79, *Bernard Denilauler v S.N.C. Couchet Frères*, [1980] ECR 01553, para. 16 – *Denilauler*.

<sup>1398</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 40 – *Van Uden*.

<sup>1399</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 24; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 31 EuGVVO, para. 11.

<sup>1400</sup> Hölder 2004, pp. 200-201; Willeitner 2003, p. 133 et seq.; Carl 2007, p. 263 et seq.

<sup>1401</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 39 – *Van Uden*.

<sup>1402</sup> Carl 2007, p. 263.

<sup>1403</sup> Carl 2007, p. 263.

<sup>1404</sup> Carl 2007, p. 263.

Additionally, in comparative respect, it has been referred to Article 20(1) of Council Regulation (EC) No 2201/2003 (Brussels IIbis Regulation)<sup>1405</sup> which provides:

**Article 20 of Council Regulation (EC) No 2201/2003**

(1) In urgent cases, the provisions of this Regulation shall not prevent the courts of a Member State from taking such provisional, including protective, measures in respect of persons or assets in that State as may be available under the law of that Member State, even if, under this Regulation, the court of another Member State has jurisdiction as to the substance of the matter.

It may be argued that the cited provision only determines that the persons or assets affected by the provisional measure must be situated in the State of the deciding court, and that Article 20(1) of the Brussels IIbis Regulation also concerns pure “*rechtsgestaltende Entscheidungen*” which cannot be enforced.<sup>1406</sup> As to provisional measures which aim at a payment, a local enforcement reference may not be decisive if assets are spread over numerous countries, because the totality of assets may not be determinable and can be transferred to another State as well.<sup>1407</sup> On the other hand, it is to be borne in mind that cases are conceivable in which enforcement of provisional measures abroad can make sense and that, in such cases, the restriction that enforcement may only be undertaken in the forum State would not be sensible. As to interim injunctions, it might happen that all assets are located in another State than the State where omission is owed.<sup>1408</sup>

**2.5.2.2.3.2.1.2 Conception 2: Relevance of the “*Vollstreckungsort*”**

Alternatively, one might argue as well (like the prevailing opinion in legal doctrine) that the criterion of a “real connecting link” should be understood in connection with the enforcement of the interim measure concerned, meaning that the courts of the Member States are competent pursuant to Article 35 to order provisional measures if these provisional measures can respectively shall be enforced in the forum State.<sup>1409</sup>

In this respect, it is to be emphasised that the ECJ, in its *Van Uden* decision, tended to avoid that a court that lacks sufficient *factual proximity* to the case orders enforceable provisional measures, which could subsequently be enforced abroad.<sup>1410</sup> Otherwise, Articles 7 to 26 of the Brussels Ibis Regulation, and the exclusion of exorbitant jurisdiction according to Article 5(2), might be circumvented. This underlying idea can be derived from the following formulation of the ECJ in *Van Uden*:

---

<sup>1405</sup> Council Regulation (EC) No 2201/2003 of 27 November 2003 concerning jurisdiction and the recognition and enforcement of judgments in matrimonial matters and the matters of parental responsibility, repealing Regulation (EC) No 1347/2000, OJ L338 of 23 December 2003, pp. 1-29, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32003R2201&rid=1>> (lastly accessed on 1 June 2015).

<sup>1406</sup> Carl 2007, p. 264.

<sup>1407</sup> Carl 2007, p. 263; Heß & Vollkommer (1999)19(4) IPRax 220, at p. 224 et seq.

<sup>1408</sup> Carl 2007, p. 264.

<sup>1409</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 24; Heinze 2007, p. 251; Gaudemet-Tallon 2010, para. 311; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 31 EuGVVO, para. 14; Czernich, Tiefenthaler & Kodek 2009, Art 31, para. 6; Schack 2010, para. 486; Heß & Vollkommer (1999)19(4) IPRax 220, at p. 224 et seq.; Wolf & Lange (2003)49(1) RIW 55, at p. 57; Wannenmacher 2007, p. 245; Pålsson 2000, p. 630; cf. also Hof van Cassatie 3 September 2000, (2001)50(1) GRUR Int. 73, at p. 74 – Sanac/Variantsystemen.

<sup>1410</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 23; Treichel (2001)50(8-9) GRUR Int. 690, at p. 702.

“(…) If, moreover, the plaintiff were entitled to secure interim payment of a contractual consideration before the courts of the place where he is himself domiciled, where those courts have no jurisdiction over the substance of the case under Articles 2 to 18 of the [Brussels] Convention, and thereafter to have the order in question recognised and enforced in the defendant’s State, the rules of jurisdiction laid down by the [Brussels] Convention could be circumvented [content in brackets added].”<sup>1411</sup>

Starting from this, it becomes clear that the ECJ equalised the aspects of *factual proximity* between a provisional measure and the State where it is enforced.

Furthermore, in its *Van Uden* decision, the ECJ set up the requirement that specific assets must be affected by the respective provisional measure having a territorial reference to the court deciding on the measure. As a consequence, only the courts of that Member State have jurisdiction according to Article 35 where the defendant disposes of sufficient assets.<sup>1412</sup> The ECJ expressly held:

“(…) Consequently, interim payment of a contractual consideration does not constitute a provisional measure within the meaning of Article 24 [of the Brussels Convention] unless (…) the measure sought relates only to specific assets of the defendant located or to be located within the confines of the territorial jurisdiction of the court to which application is made [underscore and content in brackets added].”<sup>1413</sup>

### **2.5.2.2.3.2.1.3 Conception 3: “Real connecting link” between the provisional measure and the applicable law**

However, the question arises if another interpretation of the jurisprudence of the ECJ in *Van Uden* is conceivable and preferable. In this respect, one might question if the requirement of a “real connecting link” should be understood in a *substantive* way rather than attributing a *procedural* meaning to it. In other words, could it be that the ECJ wanted to set up the requirement that there is “real connecting link” between the provisional measure and the applicable law? In fact, the English *Court of Appeal* granted a worldwide freezing order on the mere fact that there was a link to English law and English jurisdiction in the statutes of the company the shares of which had been sold, and “under the circumstances of jurisdiction of this court by agreement of the parties.”<sup>1414</sup>

The latter variant of interpretation could in fact be grounded on the wording of the English and French versions of the respective paragraph of the *Van Uden* decision of the ECJ which shall therefore be cited once again:

“It follows that the granting of provisional or protective measures on the basis of Article 24 [of the Brussels Convention] is conditional on, *inter alia*, the existence of a real connecting link between the subject-matter of the measures sought and the territorial jurisdiction of the Contracting State of the court before which those measures are sought [underscore and content in brackets added].”<sup>1415</sup>

---

<sup>1411</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 46 – *Van Uden*.

<sup>1412</sup> Carl 2007, p. 264; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 25; Geimer 2010 (Geimer & Schütze, *Europäisches Zivilverfahrensrecht*), Art. 31 EuGVVO, para. 14 (“the provisional measure must indicate domestic assets, in which enforcement is possible in the forum State”).

<sup>1413</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 47 – *Van Uden*.

<sup>1414</sup> Court of Appeal 12 June 2003, *Motorola Credit Corp n v Uzan And Others (No 2)*, [2003] EWCA Civ 752, [2004] 1 W.L.R. 113 – *Motorola Credit*, cited in: Schlosser 2008 (Heidelberg Report), para. 605.

<sup>1415</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 40 – *Van Uden*.



“Il s’ensuit que l’octroi de mesures provisoires ou conservatoires en vertu de l’article 24 est subordonné, notamment, à la condition de l’existence d’un lien de rattachement réel entre l’objet des mesures sollicitées et la compétence territoriale de l’Etat contractant du juge saisi [underscore added].”

It is noteworthy that the expressions “jurisdiction” and “*compétence*” do not exclusively, i.e. compellingly, have a procedural connotation, but can also refer to the applicable law, which becomes obvious when taking into consideration the Anglo-American terms “legislative/prescriptive jurisdiction” and “judicial/administrative jurisdiction”.<sup>1416</sup>

As a consequence, it would thus seem logical that only the courts of that State would have competence to order provisional measures according to Article 35 where the concerned patent was granted, because, due to the principle of territoriality, only the law of that State would be applicable to patent matters. This result could be based on the formulation of the above cited paragraph of the *Denilauler* decision where the ECJ emphasised that the requirement of a “real connecting link” was to ensure the suitability of the deciding court. In this respect, it would seem comprehensible that the courts of the State where the concerned patent was granted are most able to decide on provisional measures in patent matters because courts have best knowledge of their own national law, no foreign law must be applied, and no translations must be produced.

#### 2.5.2.2.3.2.1.4 Conclusion

However, Conception 3 is not convincing for several reasons. To begin with the above cited text versions of the *Van Uden* decision, it is to be underlined that the interpretation of a decision must not only take into consideration *specific* (single) language versions, but must be consistent regarding *all* official language versions. As to the cited passage of the *Van Uden* decision of the ECJ, it is to be emphasised that the latter interpretation would not be in line with the German and the Dutch text versions which read as follows:

“Daraus folgt, dass die Anordnung einstweiliger oder sichernder Maßnahmen nach Artikel 24 insbesondere voraussetzt, dass zwischen dem Gegenstand der beantragten Maßnahmen und der gebietbezogenen Zuständigkeit des Vertragsstaats des angerufenen Gerichts eine reale Verknüpfung besteht [underscore added].”

“Hieruit volgt, dat het toestaan van voorlopige of bewarende maatregelen krachtens artikel 24 met name afhankelijk is van de voorwaarde, dat er een reële band bestaat tussen het voorwerp van de gevraagde maatregelen en de op territoriale criteria gebaseerde bevoegdheid van de verdraagsluitende staat van de aangezochte rechter [underscore added].”

These text versions clearly demonstrate that the applicable law cannot be considered the reference point of the required “real connecting link”, because neither “*Zuständigkeit*” nor “*bevoegdheid*” have a substantive meaning, but solely refer to procedural law.

Besides this comparative argument and the general insight of Private International Law that procedural and substantive matters are principally to be considered independent from each other and should not be mingled,<sup>1417</sup> a closer analysis of the formulation of the respective paragraphs of the *Denilauler* and *Van Uden* decisions reveal that the ECJ, when referring to the suitability of the deciding court, did not refer to the suitability regarding the knowledge of

---

<sup>1416</sup> Schauwecker 2009, p. 189.

<sup>1417</sup> Cf. Schauwecker 2009, p. 192 with further references (there fn. 722).

the applicable law, but rather referred to the ability of the court to examine the specific conditions of the case. The ECJ formulated:

“The courts of the place or, in any event, of the Contracting State, where the assets subject to the measures sought are located, are those best able to assess the circumstances which may lead to the grant or refusal of the measures sought or to the laying down of procedures and conditions which the plaintiff must observe in order to guarantee the provisional and protective character of the measures ordered (...) [underscore added].”<sup>1418</sup>

“(…) (T)he Court held at paragraph 16 of *Denilauler* that the courts of the place – or, in any event, of the Contracting State – where the assets subject to the measures sought are located are those best able to assess the circumstances which may lead to the grant or refusal of the measures sought or to the laying down of procedures and conditions which the plaintiff must observe in order to guarantee the provisional and protective character of the measures authorised [underscore added].”<sup>1419</sup>

The intention of the ECJ was thus to ensure that jurisdiction according to Article 35 of the Brussels Ibis Regulation (respectively its predecessors) is conferred on the very court that is *factually* best able to ensure that provisional measures rendered keep their specific character as instruments of interim relief. The ECJ obviously considers those courts to be best suited where such provisional measures take effect.<sup>1420</sup>

In this respect, a second comparison may be helpful as well. In Article 20(1) of Council Regulation (EC) No 2201/2003 (Brussels Ibis Regulation)<sup>1421</sup>, the European legislator ruled, regarding provisional, including protective, measures:

#### **Article 20 of the Brussels Ibis Regulation**

(1) In urgent cases, the provisions of this Regulation shall not prevent the courts of a Member State from taking such provisional, including protective, measures in respect of persons or assets in that State as may be available under the law of that Member State, even if, under this Regulation, the court of another Member State has jurisdiction as to the substance of the matter.

As Article 20(1) of the Brussels Ibis Regulation thus restricts jurisdiction according to Article 20 of this Regulation in conjunction with national law to provisional measures concerning persons or assets being situated in the State of the deciding court, it seems sensible to interpret Article 35 of the Brussels Ibis Regulation in the same way.<sup>1422</sup>

However, the main argument for the correctness of a procedural meaning of the term “real connecting link” consists in a third comparison: a comparison between the jurisdiction to order provisional measures according to Articles 7 to 26 and the jurisdiction according to Article 35 in conjunction with national law. The jurisdiction of courts which have jurisdiction according to Articles 7 to 26, to order provisional measures as well, is based on the particular

---

<sup>1418</sup> ECJ 21 May 1980, C-125/79, *Bernard Denilauler v S.N.C. Couchet Frères*, [1980] ECR 01553, para. 16 – *Denilauler*.

<sup>1419</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 39 – *Van Uden*.

<sup>1420</sup> Heinze 2007, p. 246.

<sup>1421</sup> Council Regulation (EC) No 2201/2003 of 27 November 2003 concerning jurisdiction and the recognition and enforcement of judgments in matrimonial matters and the matters of parental responsibility, repealing Regulation (EC) No 1347/2000, OJ L338 of 23 December 2003, pp. 1-29, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32003R2201&rid=1>> (lastly accessed on 1 June 2015).

<sup>1422</sup> As to the Brussels I Regulation: Heinze 2007, p. 246.

*factual proximity* (“*Sachnähe*”) of such courts embedded in those provisions.<sup>1423</sup> This being so, it seems logical to demand that jurisdiction to order provisional measures on the basis of Article 35 in conjunction with national law must also be justified by particular considerations embedded in Article 35. Any other conception would clearly have to be qualified as contradictory. Regarding measures of interim relief, the decisive factor is their preliminary character, respectively the possibility and necessity to guarantee this character by way of their concrete nature.<sup>1424</sup> In this light, the aspect of the enforcement of the concerned interim measure constitutes an adequate criterion as to the question which Member States courts are competent to render provisional decisions with accordance to Article 35. In contrast, the aspect of *legal proximity* (“*Rechtsnähe*”) recedes, as the knowledge of the applicable law does not necessarily come along with the (best) ability to assess the circumstances eventually leading to the grant or refusal of interim measures, i.e. the ability to secure the provisional character of such measures. Furthermore, it must be underlined that the applicable law will only be examined in a summary way in interim proceedings. This aspect also demonstrates that the question of which law is applicable is not a decisive issue in proceedings of interim relief. Where the rules of exorbitant jurisdiction are not excluded when a court has jurisdiction according to Article 35, the factual link between the deciding court and the respective provisional measure(s) gains even more importance.

Last but not least, it is remarkable that the ECJ, when referring to the applicable law, used the wording “close connecting factor” instead of “real connecting factor”, for instance in its *Mines de Potasse* decision on the interpretation of Article 5(3) of the Brussels Convention:<sup>1425</sup>

“This freedom of choice was introduced having regard to the existence, in certain clearly defined situations, of a particularly close connecting factor between a dispute and the court which may be called upon to hear it, with a view of the efficacious conduct of the proceedings [underscore added].”<sup>1426</sup>

It should be expected that the ECJ would have used the same wording in its *Denilauler* and *Van Uden* decisions if the court had wanted to refer to the applicable law in the latter decisions as well. On the contrary, the choice of such different wording rather suggests that different aspects should be addressed.

As a consequence, a procedural conception is preferable vis-à-vis a conception which refers to the applicable law.<sup>1427</sup> Regarding the two variants which have been presented in this respect (Conceptions 1 and Conception 2), good arguments militate for both conceptions. Although the aspect of enforcement ultimately seems to be essential in order to guarantee the effectivity of provisional measures, it is true that a “real connecting link” may also exist between the provisional measure and the State where the concerned patent was granted. Both aspects should therefore be taken into consideration. I will show in the following paragraphs that a differentiation seems an adequate solution with regard to different types of provisional measures.

As to the enforcement criterion, it has been partly argued that it suffices that Article 35 (respectively its predecessors) can already serve as an adequate basis to take jurisdiction over a cross-border dispute where the requested measures will be *partially* enforceable in the

<sup>1423</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 17.

<sup>1424</sup> Schauwecker 2009, p. 191.

<sup>1425</sup> Schauwecker 2009, p. 190.

<sup>1426</sup> ECJ 30 November 1976, C-21/76, *Handelskwekerij G. J. Bier B.V. v Mines de Potasse d’Alsace S.A.*, [1976] ECR 01735, para. 11 – *Mines de Potasse*.

<sup>1427</sup> Cf. Schlosser 2008 (Heidelberg Report), para. 605.

forum State,<sup>1428</sup> “insofar as the connection with the territory of the seised court is not artificial or insignificant”.<sup>1429</sup> However, if jurisdiction according to Article 35 is based on the enforcement aspect and not already on the aspect that the concerned patent has been granted for the forum State, it is more convincing to demand that Article 35 confers jurisdiction only where the provisional measures in question are *fully* enforceable in the State of the issuing court, because the justification of conferring jurisdiction being inherent in Article 35 precisely consists in the *real possibility of enforcement in the forum State*.<sup>1430</sup>

#### **2.5.2.2.3.2.2 Specific meaning of the term “real connecting link” regarding different types of provisional measures**

Given that the aspects of both enforcement of a provisional measure, and identity of the forum State and the protection State may be decisive for establishing a “real connecting link” between the measure and the court, the subsequent question arises what this result exactly means with regard to the different provisional measures mentioned above, i.e. interim injunctions, interim performance orders and evidence orders. As there might be variances, I shall differentiate between these types of provisional measures in the following analysis.

##### **2.5.2.2.3.2.2.1 Interim injunctions**

Regarding interim injunctions, one might argue at first glance that (only) the courts of the State are competent according to Article 35 where the infringement has been undertaken and where such acting must therefore be omitted in the future.<sup>1431</sup> Although the *forum protectionis* will often be available already according to Article 7(2), this may not be the case where such infringement jurisdiction is excluded, for instance in case of exclusive jurisdiction or if a jurisdiction or an arbitration agreement has been concluded. Conferring jurisdiction to the courts of the State for which the concerned patent has been granted means to adequately take into consideration the plaintiff's interests in gaining interim relief without having to demonstrate the probability of enforcement in the granting State.

However, conferring jurisdiction for the order of an interim injunction according to Article 35 to the courts of the protection State (i.e. the State where the (committed) infringement must be omitted) can only be an *addendum* besides jurisdiction pursuant to Article 35 of the courts in the State where the interim injunction shall be enforced. This idea can be based on several arguments.

First of all, there is the inherent risk that the interim injunction cannot be enforced in the end in case that the defendant does not dispose of sufficient assets in the State where the patent was granted. As a consequence, merely referring to the place of infringement can turn out ineffective, because effective enforcement presupposes the existence of assets as adequate objects of enforcement.

Another problem connected with a conception allocating relevance, as to jurisdiction according to Article 35, (only) to the place of infringement, consists in the subsequent problem which State respectively which place should be relevant regarding the infringement

---

<sup>1428</sup> Pertegás Sender 2002, paras. 3.158-3.161.

<sup>1429</sup> Pertegás Sender 2007 (Magnus & Mankowski), Art 31 Brussels I Regulation, para. 29.

<sup>1430</sup> Cf. Schauwecker 2009, p. 202.

<sup>1431</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 25; Hölder 2004, pp. 200-201.

in question: the place of the *physical acting* or the place of the *effects* of the infringement. Regarding cross-border infringements, these places/States regularly fall apart. This problem can be illustrated by the following case:

Patent holder P holds a patent in State A. Infringer INF offers and sells a product which infringes P's patent, in State B (respectively via internet from state B). P wants to sue INF for patent infringement, and to apply for a provisional injunction. Can P proceed in this way before the courts of State A or State B on the basis of Article 35?

At first glance, one might argue that it is exactly this falling apart of the place of physical acting and the place of the effects of the infringement in such a case which underlines the benefit of a conception according to which (only) courts of the State shall have jurisdiction pursuant to Article 35 where the infringing act has been physically undertaken and must be omitted in the future. However, it is noteworthy that such a conception would mingle aspects of substantive law – the question of territoriality of the patent right – with procedural law – the question of jurisdiction according to Article 35. This approach would also ultimately lead to the consequence that one would refer to the applicable law which has already been rejected above. Last but not least, the insight that it will be decisive at the end of the day that an interim injunction, as any other interim measure, can be effectively enforced which presupposes that there is a sufficient financial basis for enforcement which is not necessarily the case at the place where the infringing act occurred, militates against a conception according to which only the courts of the State where the patent has been granted have jurisdiction pursuant to Article 35.

To conclude, concerning interim injunctions, the courts of the State should therefore be considered competent according to Article 35 where the defendant disposes of sufficient assets that the interim injunction can be enforced. Besides, courts of the State where the patent has been granted are *also* competent pursuant to Article 35.

#### 2.5.2.2.3.2.2 Interim performance orders

As to specific actings being imposed on the defendant by way of an interim performance order, the courts of the State should be considered competent pursuant to Article 35 where the defendant actually disposes of sufficient assets to secure the enforcement of the measure. To repeat, the ECJ expressly held in *Van Uden* as to interim payments of a contractual consideration:

“Consequently, interim payment of a contractual consideration does not constitute a provisional measure within the meaning of Article 24 [of the Brussels Convention] unless (...) the measure sought relates only to specific assets of the defendant located or to be located within the confines of the territorial jurisdiction of the court to which application is made [underscores and content in brackets added].”<sup>1432</sup>

Regarding fungible actings, the place of the *physical acting* should be decisive for a “real connecting link”.<sup>1433</sup> Applying the place of the *legal effects* of the acting would namely mingle aspects of substantive and procedural law, and should therefore be avoided.<sup>1434</sup>

<sup>1432</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 47 – *Van Uden*.

<sup>1433</sup> Schauwecker 2009, p. 198.

<sup>1434</sup> Cf. explications made with regard to interim injunctions.

With regard to interim measures concerning the restitution, the recall or the destruction of concrete objects infringing the concerned patent, it would seem most effective in matters of enforcement to refer to the State where these objects are situated.<sup>1435</sup>

### 2.5.2.2.3.2.2.3 Evidence orders

Also concerning measures to protect and obtain information and evidence (evidence orders), the decisive question is whether the concerned measure is enforceable in the forum State.<sup>1436</sup> In contrast to a judgment of the French *Cour d'appel de Versailles* rendered before the *Van Uden* judgment of the ECJ,<sup>1437</sup> a court outside the protection State may not order provisional measures to obtain or secure evidence to be enforced in another State than the forum State, be it the protection State or any other State.

### 2.5.2.2.3.2.3 Are cross-border interim measures generally excluded in case of legal or factual complexity of cases?

As to interim measures in patent cases, there is the problem that, on the one hand, patent cases may raise highly technical questions and require sufficient understanding of complicated foreign legal provisions which *per se* constitutes an ambitious challenge for a foreign judge. On the other hand, the situation is aggravated by the fact that interim proceedings have a summary character meaning that the case will not be examined in depth comparably with principal proceedings where full evidence may be taken. As a consequence, one might indeed question of whether cross-border provisional measures should be considered excluded if the matter to decide turns out to be too complex for a judicial decision by the foreign judge. While in particular Dutch courts formerly tended to grant cross-border interim injunctions rather generously,<sup>1438</sup> this practice has changed in the meantime. For instance, the Dutch *Gerechtshof 's-Gravenhage* suggested in its decision in *Hoffmann-La Roche AG v Organon Teknika B.V. and Others* that an incidental decision by means of a *kort geding* could be possible if the patent right is confirmed, and under the precondition that the case is not too complicated in factual and legal respect.<sup>1439</sup>

In this respect, one might put forth that Article 9(3) of the Enforcement Directive (similarly to Article 50 of the TRIPS Agreement) contains the obligation for Contracting States to provide for possibilities in national law to apply for provisional measures before a competent court, reading:

---

<sup>1435</sup> Schauwecker 2009, p. 198.

<sup>1436</sup> Cf. for instance Cf. Hof van Cassatie 3 September 2000, (2001)50(1) GRUR Int. 73, at p. 74 – *Sanac/Variantsystemen*; Cour de cassation 11 December 2001, (2002)91(2) Rev. crit. DIP 371, with case note H. Muir Watt (both judgments cited in: Schlosser 2008 (Heidelberg Report), paras. 580-581).

<sup>1437</sup> Cour d'appel de Versailles 19 April 1993, (1995)84(1) Rev. crit. DIP 80, with case note G. Couchez (cited in: Schlosser 2008 (Heidelberg Report), para. 581).

<sup>1438</sup> Cf. Bertrams (1995)44(3) GRUR Int. 193, at p. 193 et seq. with numerous references to relevant Dutch case-law; also: Brinkhof (1997)46(6) GRUR Int. 489; Wadlow 1998, para. 1–28: “(W)ithin a decade the grant of extraterritorial injunctions by the Hague District Court in all types of intellectual property cases would become a matter almost of routine, if not to foreign litigants, then at least to their Dutch advisers.”

<sup>1439</sup> *Gerechtshof 's-Gravenhage* 12 December 1996, *Hoffmann-La Roche AG v Organon Teknika B.V. and Others*, (1998)47(1) GRUR Int. 58, with case note D. Stauder.

### Article 9(3) of the Enforcement Directive

The judicial authorities shall, in respect of the measures referred to in paragraphs 1 and 2, have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the rightholder and that the applicant's right is being infringed, or that such infringement is imminent.

However, a closer look on both provisions reveals that they in fact merely contain the obligation to secure that patent rights can be effectively enforced in the granting State. Beyond this, neither Article 9(3) of the Enforcement Directive nor Article 50 of the TRIPS Agreement prescribe that cross-border interim measures must be available.<sup>1440</sup> The limited scope of the Enforcement Directive in this respect is underlined by its Recitals 8 and 11 which provide:

### Recitals 8 and 11 of the Enforcement Directive

(8) The disparities between the systems of the Member States as regards the means of enforcing intellectual property rights are prejudicial to the proper functioning of the Internal Market and make it impossible to ensure that intellectual property rights enjoy an equivalent level of protection throughout the Community. This situation does not promote free movement within the internal market or create an environment conducive to healthy competition.

(11) This Directive does not aim to establish harmonised rules for judicial cooperation, jurisdiction, the recognition and enforcement of decisions in civil and commercial matters, or deal with applicable law. There are Community instruments which govern such matters in general terms and are, in principle, equally applicable to intellectual property.

As neither Article 50 of the TRIPS Agreement nor the Enforcement Directive answer the raised question of whether cross-border interim measures are generally excluded in case of complexity of the case, it is necessary to resort to general considerations. Structurally, the question of whether rejecting an application for a cross-border provisional measure for the reason that the court is of the opinion that there is no sufficient claim (*“Maßnahmeanspruch”*) or ground to grant the measure (*“Maßnahmegrund”*), actually constitutes a matter of foundedness rather than a question of admissibility.<sup>1441</sup> As a consequence, legal or factual complexity of cases has no effect on the question of whether courts have jurisdiction to order provisional measures pursuant to Article 35.

### 2.5.2.2.3.2.4 Scope of jurisdiction in the case of multistate patent infringements

Having arrived at the conclusion that Article 35 generally confers jurisdiction to order provisional measures, regarding the infringement of foreign patents, to courts of the State where such measures shall be enforced (and additionally, in the case of interim injunctions, to the courts of the protection State), I shall now turn to the question of which competence is given to the deciding court in the case of multistate patent infringements.

Regarding jurisdiction pursuant to Article 35 of the courts of the State where provisional measures shall be enforced, it has been stated above that the *real possibility of enforcement in the forum State* is the precondition for a *comprehensive* jurisdiction according to Article 35 in

---

<sup>1440</sup> Schauwecker 2009, p. 194.

<sup>1441</sup> Cf. Heinze 2007, p. 203.

conjunction with national law. A provisional measure ordered by a court which is competent according to Article 35 on this basis can have effect in a multitude of other States where patent infringements have been committed, meaning that interim performance orders (e.g. to pay damages), interim injunctions or measures to protect and obtain information and evidence (evidence orders) can be taken, given that there are sufficient assets in the forum State to enable enforcement of these measures.<sup>1442</sup> As a further consequence, a court will only be competent on this basis *insofar as* there are sufficient assets in the forum State concerning which enforcement will be possible, meaning that a court may partly have jurisdiction only.<sup>1443</sup>

In this respect, the question arises whether this understanding of a comprehensive jurisdiction pursuant to Article 35 is contradictory to the more restricted scope of jurisdiction according to Article 7(2) to order provisional measures, which is limited to the State where the patent was granted. While a different scope of jurisdiction according to Articles 7(2) and 35 might seem illogical at first sight, a different treatment of these grounds of jurisdiction is indeed justified, on the basis of a twofold reasoning. First, it is to be borne in mind that the fact that courts which are competent according to Articles 7 to 26 can also order provisional measures, is based on the circumstance that Articles 7 to 26 *per se* imply a sufficient *factual proximity* between the measure and the deciding court.<sup>1444</sup> In the case of jurisdiction according to Article 35 of courts of a State where the provisional measure shall be enforced, such a *factual proximity* is only established by the fact that the provisional measure can be, respectively is to be enforced in the forum State.<sup>1445</sup> On the basis of the emphasis of the *factual proximity*, it is logical to refer, in a second step, to that criterion also with regard to the scope of jurisdiction. Due to the principle of territoriality, jurisdiction based on Article 7(2) is restricted to the courts of the State where, respectively for whose territory a patent has been granted, meaning that multiple infringing actings in different States must be treated independently. In this respect, there is no inner link between patent infringements in different States. In contrast to this situation, jurisdiction according to Article 35 with regard to courts of a State where the provisional measure shall be enforced, is not limited by the principle of territoriality, but by the different conditions of enforceability of the provisional measure. Courts of States where provisional measures can be enforced fulfil the requirement of such an inner link, i.e. a “real connecting link” as demanded by the ECJ. Besides, the broader scope of jurisdiction with regard to Article 35 is also justified by the fact that not all provisional measures may be taken on the basis of Article 35.

As to the further issue of whether multistate interim infringement proceedings against several defendants (respondents) may be connected, national procedural law is decisive via Article 35. In this respect, it is to be underlined that Article 8(1) does not cover this question,<sup>1446</sup> with the consequence that the restrictive interpretation of the prerequisite of a “close connection” adopted by the ECJ in its *Roche Nederland* decision is not relevant in this context.

---

<sup>1442</sup> Cf. Schauwecker 2009, p. 201 (while *Schauwecker* is of the opinion that jurisdiction according to Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation) is merely conferred on the courts of the State where the provisional measure shall be enforced, while, according to his opinion, courts of the protection State *per se* do not have jurisdiction pursuant to this provision).

<sup>1443</sup> Heinze 2007, p. 252, there fn. 338; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 25.

<sup>1444</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 17.

<sup>1445</sup> Cf. Schauwecker 2009, p. 203 (while *Schauwecker* generally interprets Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation) in a more restricted way than advocated in this thesis, cf. fn. 1375).

<sup>1446</sup> Kur (2006)37(7) IIC 844, at p. 853; differently: Szychowska 2008, pp. 218-220.



### 2.5.2.2.3.2.5 Recognition and enforcement of measures according to Article 35

Assuming that a “real connecting link” exists only between the provisional measure and the courts of the State where the measure is to be enforced (except from interim injunctions where it is arguable that a “real connecting link” is existent between the courts of the State where the measure is to be enforced *and* the courts of the protection State), measures respecting the requirement of such a “real connecting link” are by their nature generally unsuitable for being enforced abroad.<sup>1447</sup> This idea is reflected in Article 2(a) of the Brussels Ibis Regulation which confines recognition and enforcement according to the Brussels Ibis Regulation of orders of provisional measures to orders rendered by a court which by virtue of the Brussels Ibis Regulation has jurisdiction as to the substance of the matter (accessory jurisdiction):

#### Article 2(a) of the Brussels Ibis Regulation

(...)

(a) (...) For the purposes of Chapter III, ‘judgment’ includes provisional, including protective, measures ordered by a court or tribunal which by virtue of this Regulation has jurisdiction as to the substance of the matter.

The fact that provisional measures ordered on the basis of independent jurisdiction according to Article 35 of the Brussels Ibis Regulation in conjunction with national law are not enforceable in another Member State according to the Brussels Ibis Regulation – in contrast to provisional measures ordered on the basis of accessory jurisdiction – becomes even clearer in Recital 33 1<sup>st</sup> and 4<sup>th</sup> sentence of the Brussels Ibis Regulation that provides:

#### Recital 33 of the Brussels Ibis Regulation

(33) Where provisional, including protective, measures are ordered by a court having jurisdiction as to the substance of the matter, their free circulation should be ensured under this Regulation. (...) Where provisional, including protective, measures are ordered by a court of a Member State not having jurisdiction as to the substance of the matter, the effect of such measures should be confined, under this Regulation, to the territory of that Member State.

On the basis of this clear legal situation, it seems impossible *de lege lata* to accept exceptions from this rule, i.e. to admit recognition and enforcement, pursuant to the Brussels Ibis Regulation, of provisional measures ordered by a court on the basis of independent jurisdiction for provisional measures. In Chapter 3, I will consider however whether such exceptions should be admitted *de lege ferenda* in certain constellations.

It may be concluded that the Brussels Ibis Regulation pursues the approach of determining the “real connecting link” as referring to the place of (prospective) enforcement, respectively does not start at the question of admissibility of the provisional measure but consequently chooses an approach focused on its enforcement notwithstanding if there was a “real connecting link” justifying the order of the concerned measure.<sup>1448</sup>

---

<sup>1447</sup> Schlosser 2008 (Heidelberg Report), para. 621; Wolf (2000)11(1) EuZW 11, at p. 14.

<sup>1448</sup> Domej (2014)78 RabelsZ 508, at p. 543.

It is however to be underlined that Article 2(a) of the Brussels Ibis Regulation does not prohibit provisional measures, ordered on the basis of independent jurisdiction for interim relief, from having extraterritorial effect as long as these measures can be enforced *domestically*, which is indirectly confirmed by Recital 33 4<sup>th</sup> sentence (“under this Regulation”).<sup>1449</sup>

### 2.5.2.3 Raise of the invalidity defence in provisional proceedings

Having analysed the different variants of jurisdiction as to provisional measures, the question arises if, respectively to which extent the *GAT* decision of the ECJ becomes relevant in this respect. I shall analyse in the following paragraphs whether the raise of an invalidity defence in patent infringement proceedings has the effect that the court having jurisdiction with regard to provisional measures loses this jurisdiction in favour of the courts being competent according to Article 24(4). In contrast to some other authors as well as courts that do not undertake a differentiation between the different bases of jurisdiction for provisional measures, I shall pursue a split approach, because the result of the analysis might be different depending on the ground of jurisdiction.

#### 2.5.2.3.1 Raise of the invalidity defence in provisional proceedings before a court having jurisdiction according to Articles 4 or 7 to 26 (accessory jurisdiction)

##### 2.5.2.3.1.1 Overview

According to prevailing case-law having been produced after the *GAT* decision of the ECJ, Article 24(4) is not applicable regarding provisional measures, thus not depriving the court of jurisdiction according to Article 4 to decide on such provisional measures. For instance, the *Rechtbank ‘s-Gravenhage* decided in this way in *Bettacare*:

“(…) Uit genoemd arrest [GAT] (...) volgt naar voorlopig oordeel niet dat bij het voeren van een nietigheidsverweer in kort geding ten aanzien van het octrooi in het buitenland, zoals door H3 [the defendant] in deze procedure gedaan, de krachtens art. 2 EEX Verordening bevoegde Nederlandse voorzieningenrechter bevoegdheid zou verliezen wegens het bepaalde in art. 22 lid 4 EEX Verordening [content in brackets added].”<sup>1450</sup>

“(…) For the time being, it does not follow from that [GAT] decision that, in the case where an invalidity defence is raised in provisional proceedings, regarding the foreign patent, as done by H3 [the defendant] in this case, the Dutch court having jurisdiction as to these measures pursuant Article 2 of the Brussels I Regulation would lose jurisdiction due to the content of Article 22(4) of the Brussels I Regulation [content in brackets added].”<sup>1451</sup>

---

<sup>1449</sup> Heinze (2011)75 *RabelsZ* 581, at p. 614 et seq.; differently: Domej (2014)78 *RabelsZ* 508, at p. 545.

However, *Domej* who expressly refers to the wording of “confinement to the territory of that Member State” in Recital 33 4<sup>th</sup> sentence of the Brussels Ibis Regulation in order to argue that provisional measures, ordered on the basis of independent jurisdiction for interim relief, have no extraterritorial effect, overlooks that Recital 33 4<sup>th</sup> sentence of the Brussels Ibis Regulation merely applies to provisional measures ordered “under this Regulation”.

<sup>1450</sup> Rb. ‘s-Gravenhage 21 September 2006, *Bettacare Limited (UK) v H3 Products BV (Netherlands)* and Another, BIE 2006, 91, para. 4.20 – *Bettacare*.

<sup>1451</sup> Translation provided by the author of this thesis.

In another decision, *Fleuren*, the *Rechtbank 's-Gravenhage* chose an even broader formulation, not differentiating between provisional measures ordered on the basis of Article 35 in conjunction with provisions of national law and provisional measures ordered on the basis of jurisdiction according to the principal proceedings. In this decision, the court held:

“(…) Omdat Fleuren zich heeft beroepen op de nietigheid van EP 133, is de rechtbank, gelet op de uitspraak van het Hof van Justitie van de Europese Gemeenschappen van 3 juli 2006, zaak C-4/03, inzake GAT/LuK (...), niet bevoegd een grensoverschrijdend verbod toe te wijzen. Dit is anders voor zover een provisioneel inbreukverbod is gevraagd (...).”<sup>1452</sup>

“(…) As Fleuren [the defendant] raised the defence of invalidity of EP 133, the court is, by virtue of the judgment of the ECJ from 3 July 2006, case C-4/03 – GAT/LuK (...) deprived of jurisdiction as to a cross-border injunction. This is different inasfar as a provisional infringement injunction is claimed (...) [content in brackets added].”<sup>1453</sup>

This broad conception was later confirmed by the *Gerechthof 's-Gravenhage* in its decision in *Yellow Pages* where the court summarised:

“(…) Tezamen genomen moet (...) worden aangenomen dat de bevoegdheid om een dergelijke maatregel te gelasten ter zake van inbreuk in een andere lidstaat (of deze bevoegdheid nu is gegrond, zoals in casu, op artikel 2 EEX-Verordening of, voor zover dat al mogelijk zou zijn, op artikel 31 EEX-Verordening) niet wordt gedwarsboord door de exclusievebevoegdheidsregel van artikel 22 sub 4 EEX-Verordening (...).”<sup>1454</sup>

“(…) All in all, it must be held that (...) the jurisdiction to order such a measure for an infringement in another Member State (whether this jurisdiction is based on Article 2 or – if at all possible – on Article 31) is not affected by the rule of exclusive jurisdiction in Article 22(4) Brussels I Regulation (...).”<sup>1455</sup>

#### 2.5.2.3.1.2 Conception 1: Applicability of Article 24(4)

In contrast, parts of legal doctrine have argued for the applicability of Article 24(4) (respectively its predecessors) in the case that the defence of invalidity is raised in provisional proceedings before a court having jurisdiction according to Articles 4 or 7 to 26 (respectively their predecessors). The argumentation employed to support this conception varies.

First, it might be put forward that in case that a national court has jurisdiction according to Article 24(4) with regard to the principal proceeding, this implies that another court cannot have, regarding provisional measures, jurisdiction according to Articles 4 or 7 to 26 – in contrast to Article 35 in conjunction with provisions of national law – given it is characteristic for exclusive jurisdiction according to Article 24(4) to fully exclude recourse to general provisions of the Brussels Ibis Regulation.<sup>1456</sup> Following this approach, it could also be put forth that Article 24(4) has a mandatory effect independently from the type of proceedings.

---

<sup>1452</sup> Rb. 's-Gravenhage 7 March 2007, *Fleuren Presspack BV (Netherlands) v Vof Handelsonderneming Ruvo (Netherlands)*, and *Ruvo BV (Netherlands) v Fleuren Presspack BV (Netherlands)*, BIE 2007, 125, para. 4.1 – *Fleuren*.

<sup>1453</sup> Translation provided by the author of this thesis.

<sup>1454</sup> *Gerechthof 's-Gravenhage* 12 July 2011, *Yellow Page Marketing B.V. (YPM) v Yell Limited*, IER 2011, 61, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHSGR:2011:BR1364>>, para. 4.7.1 – *Yellow Pages*.

<sup>1455</sup> Translation provided by the author of this thesis.

<sup>1456</sup> Wannenmacher 2007, p. 233.

Besides, one might argue that the defendant, if Article 24(4) was not applicable where the invalidity defence is raised in provisional proceedings – meaning that the infringement court is competent to decide on the validity issue as well – would gain more than he could gain in the principal proceeding where that issue could obviously not be decided by the infringement court. That could be considered an imminent conflict between Articles 24(4) and 35.<sup>1457</sup>

With reference to the *GAT* decision of the ECJ, it has been stated that the ECJ held that the court before which infringement proceedings have been brought is generally barred from a decision on and even a treatment of the validity issue. In this respect, the relevant passage of the decision of the ECJ which has been referred to in literature<sup>1458</sup> and which I have already discussed above, reads as follows:

“In the light of the position of Article 16(4) within the scheme of the [Brussels] Convention and the objective pursued, the view must be taken that the exclusive jurisdiction provided for by that provision should apply whatever the form of proceedings in which the issue of a patent's validity is raised, be it by way of an action or a plea in objection, at the time the case is brought or at a later stage in the proceedings [underscore and content in brackets added].”<sup>1459</sup>

### 2.5.2.3.1.3 Conception 2: Inapplicability of Article 24(4)

However, regarding the jurisprudence of the ECJ, another decision is of considerable interest in this respect. In the *Solvay* case on the interpretation of Articles 6(1), 22(4) and 31 of the Brussels I Regulation, the ECJ also made some worthwhile explications regarding the applicability of Article 24(4) to provisional proceedings. Although the specific case concerned provisional proceedings on the basis of Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation), the court chose such a general explanation and reasoning that it seems justified to draw conclusions from this judgment for the case discussed here, too.<sup>1460</sup> In essence, the ECJ held:

“According to the referring court, the court before which the interim proceedings have been brought does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of the regulation would rule in that regard, and will refuse to adopt the provisional measure sought if it considers that there is a reasonable, non-negligible possibility that the patent invoked would be declared invalid by the competent court.

In those circumstances, it is apparent that there is no risk of conflicting decisions (...), since the provisional decision taken by the court before which the interim proceedings have been brought will not in any way prejudice the decision to be taken on the substance by the court having jurisdiction under Article 22(4) of Regulation No 44/2001. Thus, the reasons which led the Court to interpret widely the jurisdiction provided for in Article 22(4) of Regulation No 44/2001 do not require that, in a case such as that in the main proceedings, Article 31 of that regulation should be disapplied [underscores added].”<sup>1461</sup>

The idea that the court invoked in provisional proceedings actually does not render a decision on the validity of the concerned patent, but is restricted to an examination of how the court deciding in principal proceedings will decide that issue has already been pursued by national

<sup>1457</sup> Bisschop (2007)98(6) Mitt. 247, at p. 249.

<sup>1458</sup> For instance: Heinze 2007, p. 203.

<sup>1459</sup> ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, para. 25 – *GAT*.

<sup>1460</sup> This possibility is rashly, without any further analysis, denied by *Schauwecker*, cf. *Schauwecker* 2009, p. 322.

<sup>1461</sup> ECJ 12 July 2012, C-616/10, Solvay SA v Honeywell Fluorine Products Europe BV and Others, paras. 49-50, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

courts. In particular Dutch courts have constantly decided in this way. For instance, the *Gerechthof 's-Gravenhage* stated in *Yellow Pages*:

“(…) (D)e exclusieve-bevoegdheidsregel van artikel 22 sub 4 EEX-Verordening (vindt) geen toepassing omdat in het kader van een voorlopige maatregel geen beslissing over de geldigheid van het betrokken industriële-eigendomsrecht wordt gegeven. De Nederlandse rechter die oordeelt over een nietigheidsverweer in het kader van een voorlopige maatregel ter zake van inbreuk in het buitenland, geeft immers geen beslissing over de geldigheid van het buitenlandse industriële-eigendomsrecht. Hij geeft slechts een voorlopig oordeel in de vorm van een inschatting van de kans van slagen van het desbetreffende nietigheidsverweer onder de toepasselijke lex loci protectionis. Indien een redelijke, niet te verwaarlozen kans bestaat dat het betrokken industriële-eigendomsrecht door de buitenlandse rechter nietig zal worden geacht, wordt de voorlopige maatregel in de vorm van een inbreukverbod afgewezen [underscore added].”<sup>1462</sup>

“(…) (T)he rule of exclusive jurisdiction of Article 22(4) of the Brussels I Regulation does not apply because within the context of a provisional measure, no decision is rendered on the validity of the concerned industrial property right. After all, a Dutch court that judges on an invalidity defence in the context of a provisional measure regarding infringement of an industrial property right abroad, does not render a decision on the validity of the foreign industrial property right. It only renders a provisional decision in the form of an assessment of the chances of success of the invalidity defence under the applicable lex loci protectionis. If there is a reasonable, non-negligible chance that the industrial property right at issue will be found invalid by the foreign court, the provisional injunction will not be granted [underscore added].”<sup>1463</sup>

The *Gerechtshof 's-Gravenhage* referred to this jurisprudence in its later *Apple v Samsung* decision and also underlined its view that Article 24(4) is not applicable in provisional proceedings regardless of whether these provisional proceedings are based on accessory or independent jurisdiction for interim relief. The court explicated:

“(…) Voor zover de bevoegdheid om de voorlopige maatregel te treffen is gegrond op een bodembevoegdheidsbepaling, dwingt het arrest Solvay/Honeywell naar het voorlopig oordeel van dit hof niet tot herziening van de *Yellow Pages*-lijn. Dat geldt te meer gelet op de ratio van Solvay/Honeywell, neergelegd in rechtsoverwegingen 49 en 50 van dat arrest. Die ratio geldt immers in dit verband evenzeer. Dat betekent dat artikel 22 sub 4 EEX-verordening geen toepassing vindt in het geval dat de rechter op grond van bijvoorbeeld artikel 2 of 6 sub 1 bevoegd is om kennis te nemen van de vordering tot het treffen van een voorlopige maatregel ter zake van inbreuk in een andere lidstaat en deze vordering wordt begroet met een nietigheidsverweer. Daarbij geldt uiteraard wel dat het moet gaan om een procedure, waarin de rechter geen definitieve beslissing mag geven over de geldigheid van het ingeroepen octrooi, maar alleen mag evalueren hoe de op grond van artikel 22 sub 4 EEX-Verordening bevoegde rechter zich daarover zou uitspreken en de gevraagde voorlopige maatregel niet mag toekennen indien er naar zijn oordeel een redelijke en niet te verwaarlozen kans bestaat dat het ingeroepen octrooi door de bevoegde rechter nietig wordt verklaard (rechtsoverweging 49 Solvay/Honeywell; rechtsoverweging 4.7.2 *Yellow Pages*) [underscore added].”<sup>1464</sup>

“(…) Provided that jurisdiction for provisional measures is based on jurisdiction on the merits, the Solvay/Honeywell decision does not require, according to the temporary assessment of this court, to alter the *Yellow Pages*-approach. This applies even more due to the ratio of Solvay/Honeywell, laid down in paragraphs 49 and 50 of that decision. For this ratio applies in this context as well. This means that Article 22(4) of the Brussels I Regulation is not applicable in the case that the court has jurisdiction for instance according to Article 2 or 6(1) to decide on the claim to order a provisional measure with

<sup>1462</sup> Gerechtshof 's-Gravenhage 12 July 2011, *Yellow Page Marketing B.V. (YPM) v Yell Limited*, IER 2011, 61, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHSGR:2011:BR1364>>, para. 4.7.2 – *Yellow Pages*.

<sup>1463</sup> Translation provided by the author of this thesis.

<sup>1464</sup> Gerechtshof 's-Gravenhage 20 May 2014, *Apple Inc. v Samsung Electronics Co. Limited and Others*, IER 2014, 47, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHDHA:2014:1727>>, para. 20 – *Apple v Samsung*.

regard to an infringement in another Member State and a defence of invalidity is raised. This certainly applies only if the court is prevented from rendering a final decision with regard to the validity of the concerned patent, but may only evaluate how the court having jurisdiction according to Article 22(4) of the Brussels I Regulation would decide, and may not order the requested provisional measure if there is, according to its assessment, a reasonable, non-negligible possibility that the patent invoked would be declared invalid by the competent court (paragraph 49 Solvay/Honeywell; paragraph 4.7.2 Yellow Pages) [underscore added].”<sup>1465</sup>

Correspondingly, the *Rechtbank ‘s-Gravenhage* already held in *Bettacare*:

“(…) Zoals al eerder in kort geding is uitgemaakt door deze rechtbank voorafgaand aan het wijzen van bedoeld arrest GAT/LuK, kan de voorzieningenrechter naar Nederlands recht in een geval als dit slechts een voorlopig oordeel geven in de vorm van een inschatting van de kansen van het betreffende nietigheidsverweer – of dat nu Nederlands recht of buitenlands recht betreft maakt in die zin geen verschil – waarmee het exclusieve veld van art. 22 lid 4 EEX in kort geding voor wat betreft buitenlands recht in beginsel niet wordt betreden, omdat niets definitiefs omtrent de geldigheid naar buitenlands recht wordt vastgesteld [underscores added].”<sup>1466</sup>

“(…) As it has already been decided in provisional proceedings by this court before the cited GAT/LuK decision, the court having jurisdiction as to these measures may, according to Dutch law, merely render a provisional decision in the form of an assessment of the chances of success of the concerned invalidity defence – regardless in this sense whether Dutch or foreign law applies – whereby the field of exclusive jurisdiction according to Article 22(4) of the Brussels I Regulation is principally not affected regarding foreign law, because no definite decision on the validity according to foreign law is rendered [underscores added].”<sup>1467</sup>

Similarly, the *Rechtbank ‘s-Gravenhage* decided in *Fleuren*:

“(…) De rechtbank geeft bij de beoordeling van een provisionele vordering (...) slechts een voorlopig oordeel in de vorm van een inschatting van de kansen van het betreffende nietigheidsverweer. Daarmee wordt het exclusieve veld van art. 22, lid 4, EEXV wat buitenlands recht betreft in beginsel niet betreden, omdat geen definitieve vaststellingen omtrent de geldigheid naar buitenlands recht plaatsvinden [underscores added].”<sup>1468</sup>

“(…) When assessing a provisional request, the court (...) only renders a provisional decision in the form of an assessment of the chances of success of the concerned invalidity defence. Hereby, the field of exclusive jurisdiction according to Article 22(4) of the Brussels I Regulation is principally not affected regarding foreign law, because no definite decisions on the validity according to foreign law are rendered [underscores added].”<sup>1469</sup>

Apart from the limited scope of decision of the court which is invoked in provisional proceedings, further aspects also militate against the applicability of Article 24(4) in the case of provisional proceedings. Such aspects were, in remarkable clarity, underlined by the *Gerechthof ‘s-Gravenhage* in its cited *Yellow Pages* decision. First, the court emphasised the specific purpose and character of provisional measures and detected a certain incompatibility with the rule of exclusive jurisdiction of Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) as such, holding:

<sup>1465</sup> Translation provided by the author of this thesis.

<sup>1466</sup> Rb. ‘s-Gravenhage 21 September 2006, *Bettacare Limited (UK) v H3 Products BV (Netherlands)* and Another, BIE 2006, 91, para. 4.20 – *Bettacare*.

<sup>1467</sup> Translation provided by the author of this thesis.

<sup>1468</sup> Rb. ‘s-Gravenhage 7 March 2007, *Fleuren Presspack BV (Netherlands) v Vof Handelsonderneming Ruvo (Netherlands)*, and *Ruvo BV (Netherlands) v Fleuren Presspack BV (Netherlands)*, BIE 2007, 125, para. 4.1 – *Fleuren*.

<sup>1469</sup> Translation provided by the author of this thesis.

“(…) (D)eze exclusieve-bevoegdheidsregel (is) immers niet goed verenigbaar met het doel en het karakter van de voorlopige maatregel. Voorlopige maatregelen hebben, volgens vaste jurisprudentie van het Hof van Justitie over het EEX-Verdrag/Verordening, ten doel ‘een feitelijke of juridische situatie te handhaven ter bewaring van rechten waarvan de erkenning langs andere weg wordt gevraagd voor de rechter die van het bodemgeschil kennis neemt’ (…) [underscore added].”<sup>1470</sup>

“(…) (T)his rule of exclusive jurisdiction is not fully compatible with the purpose and the character of the provisional measure. Provisional measures, according to settled case-law of the Court of Justice on the Brussels Convention/Regulation, have the aim of ‘preserving a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case’ (…) [underscore added].”<sup>1471</sup>

In order to substantiate its conception that Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) is not applicable in provisional proceedings, the court then drew a comparison with the approach pursued regarding the Community trade mark and the Community design:

“(…) Een soortgelijke benadering is ook terug te vinden in een andere context, namelijk die van het Gemeenschapsmerk en het Gemeenschapsmodel. Artikel 104 lid 3 Verordening (EG) nr. 207/2009 inzake het Gemeenschapsmerk staat immers, met inachtneming van artikel 103 lid 2 van die verordening, kort gezegd toe om voorlopige en beschermende maatregelen ter zake van inbreuk in andere lidstaten te bevelen, ook al is bij een andere rechtbank voor het Gemeenschapsmerk de geldigheid van het Gemeenschapsmerk bij reconventionele vordering betwist. Zo ook artikel 91 lid 3 jo. 90 lid 3 van Verordening (EG) nr. 6/2002 inzake het Gemeenschapsmodel (…).”<sup>1472</sup>

“(…) A similar approach is also reflected in a different context, namely the context of the Community trade mark and the Community design. After all, Article 104(3) of Regulation (EC) No. 207/2009 on the Community trade mark allows, subject to Article 103(2) thereof, in short, to order provisional and protective measures for infringement in other Member States, although the validity of the Community trade mark is disputed by means of a counterclaim before another Community trade mark court. Similarly, see Article 91(3) in conjunction with Article 90(3) of Regulation (EC) No. 6/2002 on the Community Design (…).”<sup>1473</sup>

Despite the *structural* difference between the Community trade mark and the Community design on the one hand, and the European patent on the other hand, the latter being merely a bundle of national patents while the Community trade mark and the Community design are unified intellectual property rights, it is indeed doubtful if that structural distinction ultimately justifies a different treatment as to the treatment of the validity issue of the concerned rights.

Furthermore, the *Gerechtshof ‘s-Gravenhage* pointed out that no effective, i.e. immediate, legal protection granted by one single court (and not multiple courts), could be received if Article 24(4) was applicable in provisional proceedings:

“(…) Een beperktere benadering – in hier voege dat artikel 22 sub 4 EEX-Verordening wel toepassing kan vinden in het kader van een procedure tot het verkrijgen van een voorlopige maatregel ter zake van inbreuk in een andere lidstaat – zou betekenen dat naar aanleiding van een nietigheidsverweer eerst in een (bodem)procedure in het land van registratie moet worden geoordeeld over de geldigheid van het betrokken recht. Daarmee zou de rechthebbende feitelijk de mogelijkheid uit handen worden geslagen om zo een voorlopige maatregel te verkrijgen ter bewaring van zijn rechten. Die benadering zou tot het

<sup>1470</sup> Gerechtshof ‘s-Gravenhage 12 July 2011, *Yellow Page Marketing B.V. (YPM) v Yell Limited*, IER 2011, 61, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHSGR:2011:BR1364>>, para. 4.7.1 – *Yellow Pages*.

<sup>1471</sup> Translation provided by the author of this thesis.

<sup>1472</sup> Gerechtshof ‘s-Gravenhage 12 July 2011, *Yellow Page Marketing B.V. (YPM) v Yell Limited*, IER 2011, 61, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHSGR:2011:BR1364>>, para. 4.7.1 – *Yellow Pages*.

<sup>1473</sup> Translation provided by the author of this thesis.

voor de praktijk onwenselijke resultaat leiden dat de rechthebbende die zich geconfronteerd weet met inbreuken in meerdere landen, zich in al die landen tot de rechter moet wenden om evenzoveel voorlopige maatregelen te verkrijgen. Een dergelijke omslachtige gang van zaken verdraagt zich niet goed met het doel van voorlopige maatregelen, waarbij het er immers om gaat dat een feitelijke of juridische situatie snel kan worden gehandhaafd ter bewaring van rechten in afwachting van een beslissing ten gronde, zoals in de context van het intellectuele-eigendomsrecht ook wordt onderstreept door Richtlijn 2004/48/EG (...) [underscore added].”<sup>1474</sup>

“(…) A more limited approach – according to which Article 22(4) of the Brussels I Regulation may be applied in the context of a procedure for obtaining a provisional measure for infringement in another Member State – would mean that, following an invalidity defence, first a ruling should be obtained about the validity in proceedings (on the substance) in the country of registration. Therewith the possibility would have in fact been beaten out of the hands of the right holder so as to obtain a provisional measure to preserve his rights. This approach would lead to the result, which is undesirable for practice, that the right holder who is confronted with infringements in several countries, has to adjudicate the courts in all those countries in order to obtain as many provisional measures. Such a time-consuming state of affairs is not well compatible with the purpose of provisional measures, which is indeed to ensure that a factual or legal situation can quickly be preserved so as to safeguard rights pending a decision on the substance, as is underlined, in the context of intellectual property law, by Directive 2004/48/EC (...) [underscore added].”<sup>1475</sup>

On the basis of the foregoing, it is to be concluded that a conception according to which Article 24(4) is not applicable in provisional proceedings, meaning that courts having jurisdiction according to Articles 4 or 7 to 26 may also treat the validity issue in provisional proceedings, if the validity issue has been raised by the defendant, is not in conflict with the *GAT* decision of the ECJ, as the *Gerechthof ‘s-Gravenhage* rightly confirmed in *Yellow Pages*, because paragraph 25 of the *GAT* decision cited by opponents of that conception simply does not refer to the differentiation between principal and provisional proceedings:

“(…) Dat het Hof van Justitie in rov. 25 van het *GAT/LuK*-arrest spreekt over “ongeacht het procedurele kader waarin de kwestie van de geldigheid wordt opgeworpen” doet aan het voorgaande niet af. Deze zinsnede heeft immers betrekking op de daaropvolgende bijzin “of dit nu gebeurt bij wege van rechtsvordering of bij wege van exceptie, bij het aanhangig maken van het geschil of in een later stadium van de procedure”. ”<sup>1476</sup>

“(…) The fact that the ECJ, in paragraph 25 of the *GAT/LuK* judgment, speaks of “whatever the form of proceedings in which the issue of the validity is raised” does not detract from this. Actually, this sentence refers to the subsequent clause “be it by way of an action or a plea in objection, at the time the case is brought or at a later stage in the proceedings”. ”<sup>1477</sup>

The result that Article 24(4) is not applicable in provisional proceedings where jurisdiction is based on Article 4 et seq. might additionally be based on the assumption that cases of Article 24 presume a decision in principal proceedings, to be understood in opposition to provisional proceedings.<sup>1478</sup> To underline this thesis, one might be tempted at first glance to take reference to the Jenard Report, where, in the German text version, the following passage contains the word “*Hauptsache*” which can actually have the meaning of the opposite of “*vorläufiger Rechtsschutz*” (interim relief):

<sup>1474</sup> Gerechthof ‘s-Gravenhage 12 July 2011, *Yellow Page Marketing B.V. (YPM) v Yell Limited*, IER 2011, 61, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHSGR:2011:BR1364>>, para. 4.7.1 – *Yellow Pages*.

<sup>1475</sup> Translation provided by the author of this thesis.

<sup>1476</sup> Gerechthof ‘s-Gravenhage 12 July 2011, *Yellow Page Marketing B.V. (YPM) v Yell Limited*, IER 2011, 61, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHSGR:2011:BR1364>>, para. 4.8 – *Yellow Pages*.

<sup>1477</sup> Translation provided by the author of this thesis.

<sup>1478</sup> Pansch 2003, pp. 41-42 in particular in conjunction with there fn. 179.



“Dieser Artikel stellt einen Katalog ausschließlicher Zuständigkeiten auf, die in dem Rechtsverkehr der sechs Staaten gelten. Grundsätzlich begründen die in Artikel 16 aufgezählten Streitsachen einen ausschließlichen Gerichtsstand nur dann, wenn das Gericht über sie als Hauptsache zu entscheiden hat [underscore added].”<sup>1479</sup>

However, in the given framework, it is more likely that the term “*Hauptsache*” in the cited passage is used as a differentiation vis-à-vis mere preliminary questions.<sup>1480</sup> This interpretation is also confirmed by a comparison with other language versions of the respective passage in the Jenard Report, as shall be illustrated by the English, the Dutch and the French text versions. So, the English text version uses the term “principal subject-matter”, reading:

“Article 16 lists the circumstances in which the six States recognize that the courts of one of them have exclusive jurisdiction. The matters referred to in this Article will normally be the subject of exclusive jurisdiction only if they constitute the principal subject-matter of the proceedings of which the court is to be seised [underscore added].”<sup>1481</sup>

Similarly, the Dutch text version contains the following formulation:

“Artikel 16 geeft een opsomming van de bevoegdheden welke in de betrekkingen tussen de zes landen als exclusief worden erkend. In beginsel vestigen de in artikel 16 opgesomde gevallen slechts exclusieve rechterlijke bevoegdheid wanneer het gerecht van het bodemgeschil kennis moet nemen [underscore added].”<sup>1482</sup>

The French text version confirms this interpretation as well:

“L'article 16 constitue un catalogue de compétences reconnues comme exclusives dans les rapports entre les six États. En principe, les matières énumérées à l'article 16 ne sont constitutives de compétence juridictionnelle exclusive que si le tribunal doit en connaître à titre principal [underscore added].”<sup>1483</sup>

As a consequence, a reference to the cited passage of the Jenard Report does not help to further support the result that Article 24(4) is not applicable in provisional proceedings where jurisdiction is based on Articles 4 or 7 to 26.

#### 2.5.2.3.1.4 Conclusion

Beside the jurisprudence of the ECJ in its *Solvay* decision, the better reasons militate for the inapplicability of Article 24(4) if the invalidity defence is raised in provisional proceedings before a court which is competent according to Articles 4 or 7 to 26.

---

<sup>1479</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 34, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:DE:PDF>> (lastly accessed on 1 June 2015).

<sup>1480</sup> Heinze 2007, p. 202, there fn. 115; cf. also in this sense Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 1.

<sup>1481</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 34, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>1482</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, at p. 34, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:NL:PDF>> (lastly accessed on 1 June 2015).

<sup>1483</sup> Jenard Report, OJ C59 of 5 March 1979, pp. 1-65, p. 34, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:FR:PDF>> (lastly accessed on 1 June 2015).

### 2.5.2.3.2 Raise of the invalidity defence in provisional proceedings before a court having jurisdiction according to Article 35

#### 2.5.2.3.2.1 Overview

Concerning provisional proceedings before a court being competent according to Articles 4 or 7 to 26, it has been discussed above that opinions vary with regard to the question of whether Article 24(4) is applicable. Opinions regarding this issue also varied as to the constellation that jurisdiction for provisional proceedings is based on independent jurisdiction (Article 35 of the Brussels Ibis Regulation respectively its predecessors), but, in contrast to the constellation of accessory jurisdiction, the *Solvay* decision of the ECJ which explicitly refers to that second constellation has brought a definitive statement of the ECJ concerning this issue. However, in order to embed the decision of the ECJ in the framework of existing opinions, differing conceptions shall be briefly discussed as well.

#### 2.5.2.3.2.2 Conception 1: Applicability of Article 24(4)<sup>1484</sup>

It could be argued, in favour of the applicability of Article 24(4) in provisional proceedings in question, that Article 35 – in contrast to Articles 4 or 7 to 26 – is not based on specific evaluations of the European legislator, but is only an additional way to found jurisdiction, and therefore could be considered to have a weaker character than Articles 4 or 7 to 26. In light of this, one might argue that it would not be justified not to apply Article 24(4) when jurisdiction for provisional measures is “merely” based on Article 35 in conjunction with national law.<sup>1485</sup>

Besides, as legal protection gained in provisional proceedings is often (or even regularly) more important than the principal proceeding in patent disputes, it would not make sense to preclude Article 35 from the rule of exclusive jurisdiction of Article 24(4).<sup>1486</sup>

In addition, it has been put forward that legal protection in provisional proceedings may not go further than in principal proceedings, which is said to be the case if Article 24(4) would not be applicable in the framework of Article 35, because then the court having jurisdiction according to Article 35 would be allowed to decide on the validity issue.<sup>1487</sup> Truly, there seems to be a certain contradiction insofar as a court being competent on the basis of Article 35 is allowed to treat the validity issue, in contrast to the infringement court in the principal proceedings, although the latter would dispose of much better opportunities to do so because it could resort to a full and refined evidence procedure.<sup>1488</sup>

However, to start with the latter idea, that position cannot be adhered to after the *Solvay* decision of the ECJ which has already been referred to above. The ECJ expressly formulated, with regard to Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation):

---

<sup>1484</sup> In favour of a differentiation of different legal situations affected by Article 16 of the Brussels Convention (Article 24 of the Brussels Ibis Regulation), but with regard to Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) in favour of its applicability in the constellation in question: Merkt 1993, p. 119 et seq.

<sup>1485</sup> Schauwecker 2009, p. 320.

<sup>1486</sup> Schauwecker 2009, p. 320.

<sup>1487</sup> Bisschop (2007)98(6) Mitt. 247, at p. 249.

<sup>1488</sup> Schauwecker 2009, p. 320.

“In the light of all the foregoing considerations, the answer to the second question is that Article 22(4) of Regulation No 44/2001 must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of Article 31 of that regulation [underscore added].”<sup>1489</sup>

#### **2.5.2.3.2.3 Conception 2: Temporary validity of provisional measures rendered by the infringement court**

In order to find a compromise between the conceptions of a clear applicability of Article 24(4) and its definite inapplicability, it has been proposed to assign the infringement court the competence to render provisional measures on the basis of Article 35, but to limit the validity of such measures in temporal respect until the defendant of the principal proceeding has started a nullity (counter-)claim in the State where the patent has been granted.<sup>1490</sup> However, it is obvious that this opinion is in conflict with the clear statement of the ECJ in its *Solvay* decision<sup>1491</sup>, too.

#### **2.5.2.3.2.4 Conception 3: Inapplicability of Article 24(4)**

After a reference for a preliminary ruling, by the Dutch *Hoge Raad* by order of 2 March 2001 in the case of *A.T. van der Plas v W.H. Guis*<sup>1492</sup>, searching to clarify that issue, had not been decided by the ECJ because the parties to the dispute had reached a settlement before the case came to a judgment, the ECJ ultimately clarified that issue in its *Solvay* decision. The court held that

“(…) Article 22(4) of Regulation No 44/2001 must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of Article 31 of that regulation.”<sup>1493</sup>

In *Apple v Samsung*, the *Gerechtshof ‘s-Gravenhage* referred to this distinct statement of the ECJ in *Solvay* and clarified that its jurisprudence expressed in *Yellow Pages* where the *Gerechtshof ‘s-Gravenhage* held *inter alia* that jurisdiction to order provisional measures in another Member State is not affected by Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation), regardless of whether jurisdiction for provisional measures is based on Article 2(1) of the Brussels I Regulation (Article 4(1) of the Brussels Ibis Regulation) or, “voor zover dat al mogelijk zou zijn” (provided that this should be possible), on Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation), is to be modified in view of the *Solvay* decision of the ECJ:

“(…) Voor zover het gaat om artikel 31 EEX-Verordening neemt het arrest *Solvay/Honeywell* de twijfel weg over de vraag of het mogelijk is om op grond van artikel 31 EEX-verordening een grensoverschrijdend voorlopig inbreukverbod te gelasten. Het Hof van Justitie EU oordeelde immers dat artikel 22 sub 4 EEX-Verordening, zoals uitgelegd in *GAT/LuK*, niet in de weg staat aan toepassing van artikel 31 EEX-Verordening in geval van een procedure als hiervoor omschreven. Dat oordeel heeft

<sup>1489</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 51, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

<sup>1490</sup> Joseph (2006)1(13) J.I.P.L.P. 850, at p. 857.

<sup>1491</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 51, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

<sup>1492</sup> HR 2 March 2001, C99/200HR, *A.T. van der Plas v W.H. Guis*, NJ 2003, 240, with case note P. Vlas.

<sup>1493</sup> ECJ 12 July 2012, C-616/10, *Solvay SA v Honeywell Fluorine Products Europe BV and Others*, para. 51, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*.

alleen betekenis wanneer een grensoverschrijdend inbreukverbod op grond van artikel 31 EEX-Verordening aan de orde is. Het arrest Solvay/Honeywell noopt dus in zoverre tot herziening van de Yellow Pages-lijn dat het desbetreffende voorbehoud in het Yellow Pages-arrest ('voor zover dat al mogelijk zou zijn') komt te vervallen [underscore added]."<sup>1494</sup>

("(...) With regard to Article 31 of the Brussels I Regulation, the Solvay/Honeywell decision dispels the doubts concerning the issue if it is possible to order a cross-border provisional injunction. For the ECJ held that Article 22(4) of the Brussels I Regulation, according to the interpretation in GAT/LuK, does not exclude the applicability of Article 31 of the Brussels I Regulation in the case of a proceeding as described. That decision is only significant when a cross-border injunction on the basis of Article 31 of the Brussels I Regulation is concerned. The Solvay/Honeywell decision thus requires to alter the Yellow Pages-approach in that the respective proviso in the Yellow Pages decision ('provided that this should be possible') becomes invalid [underscore added].")<sup>1495</sup>

Even before the definite statement of the ECJ in *Solvay*, this viewpoint could be derived from hints in earlier European case-law. In the *Van Uden* case, *inter alia* on the interpretation of Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation), *Advocate General Léger* expressly explicated in his Opinion:

"By allowing application to be made to the courts of a Contracting State, 'even if, under this Convention, the courts of another Contracting State have jurisdiction as to the substance of the matter', Article 24 [of the Brussels Convention] is intended to apply irrespective of which jurisdictional rule is laid down by the [Brussels] Convention for disposing of the substantive issues (...) [content in brackets added]."<sup>1496</sup>

The Advocate General thereby underlined the overwhelming importance of Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation) which would be impaired if this provision was overruled by Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation). The ECJ itself held in its *Van Uden* decision:

"It must therefore be concluded that where, as in the case in the main proceedings, the subject-matter of an application for provisional measures relates to a question falling within the scope *ratione materiae* of the [Brussels] Convention, the [Brussels] Convention is applicable and Article 24 thereof may confer jurisdiction on the court hearing that application even where proceedings have already been, or may be, commenced on the substance of the case and even where those proceedings are to be conducted before arbitrators [content in brackets added]."<sup>1497</sup>

Deciding in this way, the ECJ ruled that Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation) confers jurisdiction to grant provisional measures even where parties have submitted the dispute on the merits to arbitration. Analogically, Article 35 is still applicable where the dispute on the merits falls within the exclusive jurisdiction of a court by virtue of Article 24(4) of the Brussels Ibis Regulation.<sup>1498</sup>

---

<sup>1494</sup> Gerechtshof 's-Gravenhage 20 May 2014, *Apple Inc. v Samsung Electronics Co. Limited and Others*, IER 2014, 47, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHDHA:2014:1727>>, para. 21 – *Apple v Samsung*.

<sup>1495</sup> Translation provided by the author of this thesis.

<sup>1496</sup> Advocate General 10 June 1997, C-391/95, *Van Uden Maritime BV*, trading as *Van Uden Africa Line*, v *Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 121 – *Van Uden*.

<sup>1497</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV*, trading as *Van Uden Africa Line*, v *Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 34 – *Van Uden*.

<sup>1498</sup> *Pertegás Sender* 2002, para. 4.76; *Borrás & Hausmann* 2012 (*unalex Kommentar*), Art. 22 *Brüssel I-VO*, para. 77.

In its *Mietz* decision on the interpretation of, *inter alia*, Article 24 of the Brussels Convention (Article 35 of the Brussels Ibis Regulation), the ECJ again emphasised the significance of this provision, holding:

“It should, however, be noted that, even if Mr Mietz were allowed to prove that he ought to have been treated as a consumer within the meaning of Article 13 of the [Brussels] Convention, the court of origin could still have had jurisdiction to order provisional measures. Article 24 of the [Brussels] Convention expressly provides that a court has jurisdiction under its national law to grant an application for such measures, even if does not have jurisdiction as to the substance of the matter (...) [underscore and content in brackets added].”<sup>1499</sup>

Since the ECJ recognised the continuance<sup>1500</sup> of Article 35 of the Brussels Ibis Regulation (respectively its predecessors) towards jurisdiction over consumer contracts in provisional proceedings, it could be concluded that the same evaluation should apply vis-à-vis exclusive jurisdiction according to Article 24(4), due to the fact that Articles 17 and 18 on the one hand and Article 24 are comparable<sup>1501</sup> insofar as in both cases a prorogation is not admissible<sup>1502</sup> according to Article 25(4) which provides:

#### **Article 25(4) of the Brussels Ibis Regulation**

(...)

(4) Agreements or provisions of a trust instrument conferring jurisdiction shall have no legal force if they are contrary to Articles 15, 19 or 23, or if the courts whose jurisdiction they purport to exclude have exclusive jurisdiction by virtue of Article 24.

Additionally, it is to be stated that both Articles 17 and 18 (belonging to Section 4 of the Brussels Ibis Regulation) and Article 24 (located in Section 6 of the Brussels Ibis Regulation) are covered by Article 45(1)(e) which provides:

#### **Article 45 of the Brussels Ibis Regulation**

(1) On the application of any interested party the recognition of a judgment shall be refused:

(...)

(e) if the judgment conflicts with:

(i) Sections 3, 4 or 5 of Chapter II where the policyholder, the insured, a beneficiary of the insurance contract, the injured party, the consumer or the employee was the defendant; or

(ii) Section 6 of Chapter II.

Also, neither the disregard of jurisdiction over consumer contracts nor the disregard of exclusive jurisdiction according to Article 24 is relevant as to recognition, which can be derived from Article 45(3):

---

<sup>1499</sup> ECJ 27 April 1999, C-99/96, Hans-Hermann Mietz v Intership Yachting Sneek BV, [1999] ECR I-02277, paras. 45-46 – *Mietz*.

<sup>1500</sup> In legal doctrine, this phenomenon has appropriately been described as “*Autonomie der zweiten Spur des Eilrechtsschutzes*”, cf. Heinze 2007, p. 243.

<sup>1501</sup> Wannenmacher 2007, p. 212; Heinze 2007, p. 243.

<sup>1502</sup> In favour of consumers, Article 19(2) provides for an exception from this rule.

#### Article 45 of the Brussels Ibis Regulation

(...)

(3) Without prejudice to point (e) of paragraph 1, the jurisdiction of the court of origin may not be reviewed. The test of public policy referred to in point (a) of paragraph 1 may not be applied to the rules relating to jurisdiction.

Besides the cited European case-law, the majority of legal commentators have agreed with the conception that Article 24(4) (respectively its predecessors) is not applicable in the case of provisional proceedings where jurisdiction is based on Article 35 (respectively its predecessors).<sup>1503</sup> It is to be noticed that the national case-law which has been cited in conjunction with provisional proceedings before a court having jurisdiction according to Articles 4 or 7 to 26 actually does not distinguish between the different legal bases of provisional proceedings, effecting that the argumentation also applies in the constellation being discussed at this point.

The insight that the rule of Article 24(4) is not applicable when the invalidity defence is raised in provisional proceedings according to Article 35 may be based on different ways of reasoning which shall be discussed in the following paragraphs.

First of all, it is to be emphasised that the wording of Article 35 argues for the interpretation that jurisdiction on the basis of Article 35 is not affected by Article 24(4).<sup>1504</sup>

#### Article 35 of the Brussels Ibis Regulation

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.

By using the addition “even if”, the European legislator made clear that jurisdiction on the basis of Article 35 (in conjunction with national law) is independent from jurisdiction in the main proceeding. Interestingly, the wording “jurisdiction” does not differentiate between different kinds of jurisdiction. Due to this fact, it is to be concluded that “jurisdiction” in this sense also covers “exclusive jurisdiction” according to Article 24(4).<sup>1505</sup> There is no reason to deviate from this rule for the case that exclusive jurisdiction is relevant in principal proceedings.<sup>1506</sup>

---

<sup>1503</sup> Among many others (cf. also the following footnotes): Kropholler & Von Hein 2011, Art. 31 EuGVO, para. 14; Pertegás Sender 2002, para. 4.76; Pertegás Sender 2007 (Magnus & Mankowski), Art 31 Brussels I Regulation, para. 16; Szychowska 2008, p. 221; Torremans 2008, p. 71: “Interim measures jurisdiction can therefore not be taken away by simply raising the validity issue.”; Stauder 2005, p. 927; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 33; Gottwald 2013 (Münchener Kommentar zur ZPO), EuGVO Art. 31, para. 8; as to the parallel situation regarding Article 23: Carl 2007, p. 288; Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 22 EuGVVO, para. 29; Pålsson 2000, p. 631.

<sup>1504</sup> Wannenmacher 2007, p. 211; Kur (2006)37(7) IIC 844, at p. 853.

<sup>1505</sup> Wannenmacher 2007, p. 211.

<sup>1506</sup> Wannenmacher 2007, p. 211; cf. Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht), Art. 2 EuGVVO, para. 223, Art. 31 EuGVVO para. 21.

Apart from this argumentation, it is to be pointed out that the schematic position of Article 35 following Article 27 – Article 35 not being included in Article 27 – militates for the inapplicability of Article 24(4) in provisional proceedings based on Article 35.<sup>1507</sup>

Moreover, comparably to the argumentation concerning provisional proceedings before a court having jurisdiction in accordance with Articles 4 or 7 to 26, it is to be underlined that interim proceedings regarding provisional measures have temporary character, meaning that no definite decision is rendered on the validity of the concerned patent. The court before which provisional proceedings are brought will rather take a stand vis-à-vis the validity of the patent and will take into consideration the result with regard to the evaluation of the concerned interests. However, this “examination” is a mere prognosis of the outcome in principal proceedings and has no effect on the validity of the patent.<sup>1508</sup>

### 2.5.2.3.2.5 Conclusion

In view of the foregoing argumentation, both with regard to literal, schematic and structural aspects, and especially in light of the clear *Solvay* decision of the ECJ, Conception 3 should be followed. Conception 1 and Conception 2 are neither predetermined nor compulsory through the Brussels Ibis Regulation. On the contrary, they are irreconcilable with the *Solvay* decision of the ECJ and not justified, since their main argument, that legal protection granted in provisional proceedings may not go further than legal protection to be gained in principal proceedings, actually goes astray, because a court deciding in provisional proceedings only undertakes an *evaluation* of the concerned interests rather than rendering a *definite decision* and thus restricts itself to a prognosis of what will be the outcome of the principal proceeding. As a result, Article 24(4) is not applicable in provisional proceedings on the basis of Article 35. The court before which provisional proceedings are brought on the basis of Article 35 keeps jurisdiction in the case that the defendant raises the defence of invalidity of the concerned patent.

Besides the arguments discussed above, this insight argues even more for the result that the same should apply in the case that jurisdiction for provisional proceedings is based on Articles 4 or 7 to 26, because it would seem contradictory to grant courts being invoked on the basis of the “weaker” provision of Article 35 to deliver a prognosis of the outcome in principal proceedings, while courts acting on the basis of Articles 4 or 7 to 26 would be refused to do so.<sup>1509</sup> Both types of jurisdiction for provisional proceedings should thus be treated equally in that Article 24(4) is generally not applicable in constellations of provisional proceedings, while it is obvious that at least the schematic argument regarding Article 35, emphasising the schematic position of Article 35 following Article 27 – due to which Article 35 is not included in Article 27 – does not apply where jurisdiction for provisional proceedings is based on Articles 4 or 7 to 26.

---

<sup>1507</sup> Heinze 2007, p. 243.

<sup>1508</sup> Bertrams (1995)44(3) GRUR Int. 193, at p. 198; Mäder 1999, pp. 86-87 and p. 99 there fn. 307; Brinkhof (1997)46(6) GRUR Int. 489, at p. 496; Von Meibom & Pitz (1996)87(7) Mitt. 181, at p. 185 (=Von Meibom & Pitz (1997)19(8) E.I.P.R. 469, at p. 473).

<sup>1509</sup> Similar: Schauwecker 2009, p. 323, who however ambiguously mentions that the court before which provisional proceedings are brought on the basis of Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation) may undertake an examination of the validity of the concerned patent (“*Bestandsprüfung*”). However, as has been illustrated, such an examination is actually *not* undertaken by that court which is rather restricted to a pure *prognosis* of the outcome of a validity check in the main proceedings.

## CHAPTER 3



### **3. Reform of international jurisdiction with regard to patent infringement actions**

In the foregoing chapter, problems which currently arise with regard to patent infringement proceedings, in the framework of Articles 7(2), 8(1), 24(4) and 35 of the Brussels Ibis Regulation, have been identified and analysed. This chapter shall be dedicated to the consequential question in which way the Brussels Ibis Regulation should be amended in order to solve these problems. Besides, the additional issue shall be treated in which way the problems discussed with regard to the Brussels Ibis Regulation could respectively should be solved in an eventual Global Judgments Convention.

#### **3.1 Existing reform projects**

Apart from the Heidelberg Report which was created before the Brussels I Regulation was replaced by the Brussels Ibis Regulation, and the Commission Proposal 2010 which demonstrates the Commission's position with regard to a reform of the Brussels I Regulation, I shall primarily treat the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), the ALI Principles and the CLIP Principles in this chapter. Before undertaking a deepened analysis of relevant provisions of these sets of rules, I shall first deliver a brief overview.

##### **3.1.1 The Hague Judgments Convention and the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001)**

In order to prepare an International Convention on harmonised rules on international jurisdiction and the recognition of foreign judgments (Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters), the United States initiated the Hague Judgments project at the Hague Conference on Private International Law in early 1990.<sup>1510</sup> However, after intense negotiations had been led for more than a decade, it became clear that no consensus could be reached, due to the inability – or lack of political will to achieve a compromise<sup>1511</sup> – of the major negotiating parties, i.e. the United States and the European Union, to agree on fundamental concepts decisive for the content of the Convention. Some problems were based on the substantive differences between civil law and common law countries, like the European approach to establish predictable rules instead of the approach of the United States that may be characterised as more “tailored” to the circumstances of individual cases.<sup>1512</sup>

In the context of this thesis, it is remarkable that one of the main reasons for disagreements of the negotiating parties was strongly related to the problems regarding international jurisdiction in IP disputes.<sup>1513</sup> These issues which became of increasing interest were considered not be addressed in an adequate way.<sup>1514</sup> Besides, the initial great interest of the United States in the creation of the Hague Judgments Convention changed as the United States became the *situs* of more and more assets, with the effect that most judgments could be

---

<sup>1510</sup> Kono & Jurčys 2012, p. 11; with regard to an overview of the history of the Hague Conference Project of a Global Convention on Jurisdiction, Recognition, and Enforcement in Civil and Commercial Matters (the Hague Judgments Project) cf. Schulz 2005, pp. 39-44.

<sup>1511</sup> Dreyfuss 2009, p. 16.

<sup>1512</sup> Dreyfuss 2009, p. 15.

<sup>1513</sup> Kono & Jurčys 2012, p. 11.

<sup>1514</sup> Dreyfuss 2009, p. 16.

satisfied locally.<sup>1515</sup> After all, another significant reason for the failure of the Convention project consisted in the fact that most parts of the Draft Convention(s) were completed before the advent of e-commerce, effecting that no sufficient solutions could be delivered for problems generated in conjunction with such new media.<sup>1516</sup>

Although the envisaged Convention on harmonised rules on international jurisdiction and the recognition of foreign judgments could not be successfully finalised in the end, it is to be admitted that the discussions during the negotiations had a threefold positive effect. Apart from the consequence that the importance of matters related to jurisdiction in IP disputes was acknowledged as playing a significant role in the area of international commercial litigation, main problems related to IP litigation by different legal systems were carved out, and, last but not least, the Hague Judgments project facilitated further worldwide<sup>1517</sup> research initiatives on this subject.<sup>1518</sup>

In any event, two drafts of a convention were established. After a Preliminary Draft Convention had been published in 1999, the Hague Conference on Private International Law presented a refined version of a Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters in 2001. Although the latter Draft Convention never entered into force either,<sup>1519</sup> it could (and still can) at least serve as a source of inspiration how (IP) issues addressed in the drafts could be solved.

### 3.1.2 ALI Principles

In light of this situation, the three legal scholars *Rochelle C. Dreyfuss*, *Jane Ginsburg* and *François Dessemontet* established a working group in order to draft more specific provisions with regard to jurisdiction in intellectual property matters.<sup>1520</sup> While the working group initially intended to submit such a draft proposal to the Hague Conference, the initiative was later successfully transformed into another, more sophisticated, initiative under the auspices of the American Law Institute (ALI), when it turned out that the project of a Hague Judgments Convention would fail.<sup>1521</sup> The ALI Principles on Intellectual Property were finally adopted at the meeting of the ALI General Assembly in 2007. These Principles comprise a comprehensive set of rules with regard to various issues on international jurisdiction, applicable law and the recognition of judgments in IP disputes. The ALI

---

<sup>1515</sup> Dreyfuss 2009, p. 16.

<sup>1516</sup> Dreyfuss 2009, p. 16.

<sup>1517</sup> In this respect, the Transparency Principles and the Joint Japanese-Korean Proposal (Waseda Principles) may be mentioned which are not treated in this thesis. For further information cf. for instance Kono & Jurčys 2012, p. 12.

Additionally, the International Law Association (ILA) installed a Committee on Intellectual Property and Private International Law in 2010 in order to establish a forum on private international law issues raised in the context of intellectual property. The Committee treats jurisdiction, applicable law, recognition and enforcement of foreign judgments as well as the arbitrability of IP disputes. It is noteworthy that the Committee pursues a global approach when aiming to draft guidelines on the basis of results of other projects such as, in particular, the ALI Principles, CLIP Principles, Transparency Principles and Waseda Principles.

<sup>1518</sup> Kono & Jurčys 2012, pp. 33-34.

<sup>1519</sup> While no agreement could be reached on the Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters in 2001, the Hague Convention on Choice of Court Agreements (2005) was established as a kind of minimum solution which has however only a limited scope of application; with regard to the Hague Convention on Choice of Court Agreements (2005) cf. in detail Luginbühl & Wollgast (2006)55(3) GRUR Int. 208, at pp. 208-220; cf. also Luginbühl & Wollgast 2006, pp. 321-349.

<sup>1520</sup> Kono & Jurčys 2012, p. 11.

<sup>1521</sup> Kono & Jurčys 2012, p. 11.

Principles are intended to serve the courts as guidelines, meaning that courts can rely on the ALI Principles, wherever applicable, as long as their use is not against the law of the forum.<sup>1522</sup> With regard to the subject of this thesis, it is significant that one of the main objectives of the ALI Principles consists in restricting possible jurisdictional grounds in cross-border IP litigation, and facilitating coordination and consolidation of proceedings.<sup>1523</sup>

### 3.1.3 CLIP Principles

The CLIP project forms the European counterpart to the ALI initiative in the United States. Similar to the ALI Principles, but on an independent basis,<sup>1524</sup> the Max Planck Institute in Munich initiated a project on draft principles on jurisdiction in intellectual property which were published in 2004.<sup>1525</sup> The original objective of this initiative was to devise rules on jurisdiction in trans-border IP conflicts that would be inserted into the draft proposal for a Hague Convention on jurisdiction and recognition of foreign judgments in civil and commercial matters (Draft Hague Judgments Convention).<sup>1526</sup> Subsequently, that initiative developed into a joint project undertaken by the Max Planck Institute for Competition, Intellectual Property and Tax Law (Munich) and the Max Planck Institute for International and Foreign Law (Hamburg) in cooperation with foreign legal scholars, and was further conducted under the acronym “CLIP” (European Max Planck Group for Conflict of Laws in Intellectual Property).<sup>1527</sup> Members of the CLIP working group originated from six different countries on both sides of the Atlantic.<sup>1528</sup> Noteworthy, the CLIP Principles which were finalised in 2011 comprise the entire field of international jurisdiction, applicable law as well as the recognition and enforcement of foreign judgments in IP disputes.<sup>1529</sup>

## 3.2 Should, with regard to patent infringement cases, general rules of jurisdiction be applicable, or should the courts of the protection State have exclusive jurisdiction also in patent infringement disputes?

Before treating specific issues, one might raise the question of whether, due to their particular nature, patent infringement cases should fall within the scope of exclusive jurisdiction of the protection State rather than being subject to the general rules of jurisdiction.

### 3.2.1 Introduction

Although it is clear *de lege lata*, under the Brussels Ibis Regulation, that patent infringement proceedings cannot only be brought before the courts of the State where the concerned patent was granted, but also before courts of other States in case that these courts have jurisdiction

---

<sup>1522</sup> Dreyfuss 2009, p. 17.

<sup>1523</sup> Kono & Jurčys 2012, p. 11; Dreyfuss 2009, pp. 18-23.

<sup>1524</sup> The ALI project and the CLIP project proceeded *in parallel* with each other for a number of years which established an opportunity for mutual influence and inspiration, enhanced by the fact that two members of the CLIP group (*Graeme Dinwoodie* and *Annette Kur*) also served as advisers in the ALI project. As a consequence, there was an intense exchange of views which even continued when the ALI project had already been concluded, cf. Kur & Ubertazzi 2010, pp. 91-92.

<sup>1525</sup> Kono & Jurčys 2012, p. 12.

<sup>1526</sup> Kur 2009, p. 9.

<sup>1527</sup> Kur 2009, p. 9.

<sup>1528</sup> Kono & Jurčys 2012, p. 12.

<sup>1529</sup> Kur 2009, p. 9; Kono & Jurčys 2012, p. 12.

pursuant to the general rules of the Brussels Ibis Regulation,<sup>1530</sup> this position has also been contested. This has become obvious during the negotiations on a Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) where the totality of the European States except Switzerland finally advocated to confer exclusive jurisdiction, also regarding patent infringements, to the courts of the protection State, and consequently denied to that extent the applicability of general rules of jurisdiction.<sup>1531</sup> This opinion in favour of the exclusive jurisdiction of courts in the protection State for cases of patent infringement was also shared by the United States of America. Additionally, it is to be mentioned that English case-law and legal doctrine still deny jurisdiction of courts to decide on the infringement of foreign patents according to national procedural law, and at least partly argue in favour of a conception according to which exclusive jurisdiction pursuant to Article 24(4) of the Brussels Ibis Regulation *per se* covers patent infringement disputes as well, which has become obvious in the submissions of the French and United Kingdom Governments in the *GAT* case.<sup>1532</sup>

Having a look on the situation beyond the Atlantic, it is to be noted that the prevailing U.S. case-law generally holds that U.S. courts do not have jurisdiction over infringement claims involving foreign registered rights.<sup>1533</sup> In this respect, the decision of the *United States Court of Appeals for the Federal Circuit (CAFC)* in *Voda v Cordis*<sup>1534</sup> may serve for illustration, which is consistent with previous U.S. case-law. In this decision, the court stated that it was an abuse of the district court's discretion to exercise supplemental jurisdiction over the plaintiff's claims for foreign patent infringement although the court was seised with an infringement claim involving the equivalent U.S. patent. The defendant had notified the court that he intended to raise the defence of invalidity with regard to the foreign patents in order. However, this was not essential to the court's reasoning.<sup>1535</sup> In particular, the *Federal Court* held that the exercise of jurisdiction over foreign patent rights "would require us to define the legal boundaries of a property right granted by another sovereign and then determine whether there has been a trespass to that right."<sup>1536</sup> According to the *Federal Court*, this would be contrary to international IP treaties, comity, judicial economy, convenience and fairness.<sup>1537</sup>

<sup>1530</sup> Schauwecker 2009, p. 352.

<sup>1531</sup> Cf. Article 12(4) Alternative A and Article 12(5) Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001); Fawcett 2002, p. 150 et seq.; Hölder 2004, pp. 24-25; Kur (2001)50(11) GRUR Int. 908, at p. 908; Kur 2003, p. 829.

<sup>1532</sup> Referred to in the Opinion of the Advocate General, cf. Advocate General 16 September 2004, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, paras. 18-19 – *GAT*: "(...) The applicability of Article 16(4) of the Brussels Convention to infringement actions can prevent conflicting judgments and is therefore in the interests of legal certainty (...)."

<sup>1533</sup> Cf. United States Court of Appeals, Federal Circuit 29 April 1994, Case No. 93-1507, Mars Incorporated v Kabushiki-Kaisha Nippon Conlux, 24 F.3d 1368, available at WWW <<http://openjurist.org/print/522745>> – *Mars Incorporated*; United States Court of Appeals, Second Circuit 1 June 1956, Case No. 251, Docket 23831, Vanity Fair Mills v The T. Eaton Co. Limited and John David Eaton, 234 F.2d 633, available at WWW <<http://openjurist.org/print/78375>> – *Vanity Fair Mills*, referred to in Lundstedt (2008)77(2) NIR 122, at p. 136.

<sup>1534</sup> United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*, discussed and embedded in the existing jurisdictional framework in Schauwecker (2008)57(2) GRUR Int. 96, at pp. 96-101; cf. also Nuyts, Szychowska & Hatzimihail 2008, pp. 31-32; cf. also Pertegás Sender 2008, pp. 92-98. This judgment has been subject to criticism in legal doctrine, cf. for instance: Ginsburg 2010, p. 8: "an unfortunate decision".

<sup>1535</sup> Lundstedt (2008)77(2) NIR 122, at p. 136.

<sup>1536</sup> United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, para. 57, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

<sup>1537</sup> Lundstedt (2008)77(2) NIR 122, at p. 136.

At an academic level, it is interesting that there are however also tendencies in favour of an approach according to which extraterritorial jurisdiction as to cases of cross-border patent infringement should be existent. In this respect it is remarkable that, despite differences in structure and content, both reform projects in Europe (CLIP Principles) and the United States (ALI Principles) argue against exclusive jurisdiction for infringement proceedings of the courts of the protection State. On the contrary, both according to the ALI Principles and the CLIP Principles, courts should even have jurisdiction over invalidity questions raised in disputes concerning foreign rights provided the effects of the judgment are limited *inter partes*.<sup>1538</sup> And even in U.S. case-law, the scepticism vis-à-vis a conception pursuant to which U.S. courts should have jurisdiction for infringement proceedings concerning foreign patents is not unanimous: While the *U.S. Court of Appeals for the Federal Circuit* in *Voda v. Cordis* finally denied jurisdiction of U.S. courts over foreign patents concerning infringement actions, *Judge Newman* expressed her opposing attitude in a dissenting opinion.

In light of these heterogeneous opinions, it seems worthwhile to undertake a closer analysis whether or not the general jurisdictional rules should be applicable with regard to patent infringement cases. As the applicability of special rules which vary from general rules should principally be considered justified only if specific considerations require such exception, the question to be answered is whether specific (procedural) needs of patent law necessitate that specific jurisdictional rules apply to patent infringement disputes. In this respect, the relevant principles which form the basis of the general rules of jurisdiction according to the Brussels Ibis Regulation – in particular the protection of the defendant by the *actor sequitur forum rei*-principle (Article 4(1) of the Brussels Ibis Regulation) and party autonomy (Articles 25 and 26 of the Brussels Ibis Regulation) – must be confronted with each other and balanced against eventual specific interests relevant in the field of patent law.

### **3.2.2 Which specific interests relevant in the field of patent law are conceivable which would require to confer exclusive jurisdiction in patent infringement disputes to courts in the protection State?**

#### **3.2.2.1 “Gleichlauf” between jurisdiction and the applicable substantive patent law**

Advocates of the conception according to which the courts of the granting State should also have exclusive jurisdiction as to patent infringement disputes, have underlined that the application of foreign patent law will, due to the particular difficulty and complexity of the matter, create severe problems for the deciding court, and that for this reason, the question of whether a patent has been infringed must be decided by the courts of the protection State, meaning that the courts apply the law of the forum State.<sup>1539</sup> In this respect, it has been emphasised that these courts dispose of specific judges, ensuring special knowledge of the courts.<sup>1540</sup> Due to that special knowledge, it could be concluded that these courts constitute the most competent courts to decide. This situation would eventually be even more grave if the trial were to take place in the United States, in case that a jury would have to determine

<sup>1538</sup> Lundstedt (2007)76(4) NIR 348, at p. 364.

<sup>1539</sup> Cf. references at: Fawcett 2002, pp. 139, 153; Kur (2001)50(11) GRUR Int. 908, at p. 910; cf. United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, para. 69, available at WWW

<<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

<sup>1540</sup> United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, para. 69, available at WWW

<<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

the validity of foreign patents. In this regard, it has been doubted whether the members of a jury would be able to understand the highly complex technical issues involved.<sup>1541</sup>

However, considerable arguments militate against the latter conception. While it is true that, in cases of cross-border patent litigation, the court deciding on the infringement of a foreign patent will usually have to apply foreign patent law, because a patent is valid only in the granting State due to the principle of territoriality, the fact that a court has to apply foreign law *per se* constitutes no particularity of patent law, which would justify to deviate from general rules of jurisdiction. Rather, it is the very nature of private international law to provide for apt rules as to determine which law is applicable in cross-border cases, and to provide for adequate rules of jurisdiction for these constellations which are not specific to a certain area of law but generally occur in cross-border cases.<sup>1542</sup> On the contrary, it has rightly been emphasised that requiring a “*Gleichlauf*” between jurisdiction and applicable substantive law would finally mean to “shake the foundations” of private international law.<sup>1543</sup> This goes in particular for the provisions of the Brussels Ibis Regulation (as well as its predecessors) which are generally *not* based on the idea of legal proximity between jurisdiction and applicable law.<sup>1544</sup> In this regard, the Schlosser Report already stated clearly with regard to the Brussels Convention:

“Nowhere in the 1968 Convention is there recognition of a connection between the law applicable to a particular issue and the international jurisdiction of the courts over that issue (...).”<sup>1545</sup>

The problems occurring when applying foreign law are accepted for the purpose of an effective international enforcement of rights.<sup>1546</sup> Additionally, such problems are attenuated by establishing international conventions on the determination of the applicable law.<sup>1547</sup>

In particular, several aspects can be mentioned for reasoning that the alleged existence of particular complexity and difficulty of patent law does not justify to submit patent infringement proceedings to different procedural rules than other civil disputes. First of all, it is to be stressed that even if one admits that patent law shows a certain complexity, such complexity is owed to the fact that technical issues play an important role when it comes to the crucial question of whether the allegedly infringing product (or process) falls within the

---

<sup>1541</sup> Fawcett 2002, p. 154.

<sup>1542</sup> In German law, the notion of “private international law” comprises both “Internationales Privatrecht” regarding the question and providing rules as to the problem of which substantive law is applicable in case that several laws are concerned in cross-border cases, and “Internationales Zivilprozessrecht” dealing with the issue of jurisdiction and other procedural matters being affected when courts of several States are concerned.

<sup>1543</sup> Geimer 2015, paras. 883 and 1041-1070.

<sup>1544</sup> Cf. Hye-Knudsen 2005, p. 55; E. Gottschalk (case note) ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, (2007)62(6) JZ 300, at p. 302; differently: Ebner 2004, p. 184; ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 22 – *GAT* (as to validity actions): “(...) The courts of the Contracting State on whose territory the registers are kept may rule, applying their own national law, on the validity and effects of the patents which have been issued in that State (...)”.

<sup>1545</sup> Schlosser Report, OJ C59 of 5 March 1979, pp. 71-151, para. 175, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1979\\_059\\_R\\_0071\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1979_059_R_0071_01&rid=1)> (lastly accessed on 1 June 2015).

<sup>1546</sup> Schauwecker 2009, p. 362; cf. United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, *Jan K. Voda, M.D. v Cordis Corporation*, 476 F.3d 887, dissenting opinion filed by Circuit Judge Newman, paras. 95-100, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

<sup>1547</sup> Von Meibom & Pitz (1996)87(7) Mitt. 181, at p. 188 (=Von Meibom & Pitz (1997)19(8) E.I.P.R. 469, at p. 476).

scope of protection of the concerned patent.<sup>1548</sup> However, as this is not a legal but rather a technical issue,<sup>1549</sup> the decisive question is in which way technical judges are to be involved in the proceeding, rather than demanding an indispensable “*Gleichlauf*” between the deciding court and the applicable law.<sup>1550</sup> Apart from this, the existence of specialised courts militates against the need of exclusive jurisdiction of the courts of the granting State, because a specialised judge should be expected to cope with questions of foreign patent law being similar to the matters which he is accustomed to in the law of the forum State.<sup>1551</sup> Additionally, it must be underlined that, besides the fact that the difficulty involved in determining the validity of a patent registered abroad should not be exaggerated,<sup>1552</sup> the question of whether a subject matter is difficult and complex depends on the person that decides. Due to the relativity of such an evaluation, this criterion is not convincing.<sup>1553</sup> It is not justified to deny *a priori* the ability of a court to apply foreign law in the right way.<sup>1554</sup> Besides, it does not make sense to assume that the courts in the State where the patent has been registered would regularly have better access to the knowledge required to evaluate whether a patent is valid or not, which depends on an evaluation of the technical state of the art at the relevant priority date, because this knowledge is universal by its nature.<sup>1555</sup> Having a view on legal practice, it is to be borne in mind that courts constantly decide on foreign patents, for instance in validity proceedings because foreign patents must be considered when determining the state of the art; as a consequence, the existence of foreign patents is frequently put forth against the novelty of an invention<sup>1556</sup> and also in license disputes. The courts fairly cope with this challenge.<sup>1557</sup> Even if the courts of the granting State were generally conferred exclusive jurisdiction to decide on the infringement of a patent, this would not eliminate the constellation that foreign patents are put forth in validity proceedings in order to demonstrate that the patent that has allegedly been infringed lacks sufficient novelty.<sup>1558</sup>

After all, it is to be noticed that, if there actually exists “*Gleichlauf*” between jurisdiction and the applicable law in a specific case, this occurs accidentally by way of a reflex, but not in a targeted way.<sup>1559</sup> A conception of such an inevitable “*Gleichlauf*” would leave out of sight that the place of domicile of the defendant plays an overwhelming role as to international jurisdiction, while this criterion is less relevant with regard to the question which substantive law is applicable.<sup>1560</sup> Besides, if the question of jurisdiction was necessarily linked with the issue of which substantive law is applicable, problems would occur in case that several substantive laws are applicable with regard to different parts of the dispute. Should the dispute then be split up between different States? Obviously, this approach would be far from effective, because it would be costly and time-consuming, and therefore not manageable in practice, although the Rome I and Rome II Regulations have actually led to a considerable

<sup>1548</sup> Schauwecker 2009, p. 363.

<sup>1549</sup> Kur (2006)37(7) IIC 844, at p. 848.

<sup>1550</sup> Bukow 2007, p. 65; Hye-Knudsen 2005, p. 56; against such indispensable “*Gleichlauf*”, cf. also Von Meibom & Pitz (1996)87(7) Mitt. 181, at p. 188 (= Von Meibom & Pitz (1997)19(8) E.I.P.R. 469, at p. 476).

<sup>1551</sup> Ubertazzi 2012, p. 217.

<sup>1552</sup> Fawcett 2002, p. 153.

<sup>1553</sup> Geimer 2015, paras. 885-887.

<sup>1554</sup> Schack 2010, para. 247.

<sup>1555</sup> Kur (2006)37(7) IIC 844, at p. 848.

<sup>1556</sup> Law Professors’ Brief 2005, p. 8 et seq.

<sup>1557</sup> Thomas (1996)27 Law & Pol’y Int’l Bus. 277, at p. 342.

<sup>1558</sup> Schauwecker 2009, p. 364.

<sup>1559</sup> Schauwecker 2009, p. 362.

<sup>1560</sup> Kegel & Schurig 2004, pp. 439-440; as to the significance of the domicile for international jurisdiction, cf. Geimer 2015, paras. 1263-1322b.

level of legal unification within Europe.<sup>1561</sup> Moreover, the sole fact that the substantive law of one State is applicable cannot serve as justification for denying allocated jurisdiction of a court of another State.<sup>1562</sup> In this respect, the Brussels Ibis Regulation clearly states that existing jurisdiction must be exerted.<sup>1563</sup> This principle is also acknowledged by the ALI Principles which underline in § 103(2):

#### § 103(2) of the ALI Principles

A court shall not dismiss or suspend proceedings merely because the dispute raises questions of foreign law.

Moreover, it is to be underlined that it would be contradictory to pursue the approach of “*Gleichlauf*” only regarding patent infringement disputes, while refraining from doing so with regard to other civil and commercial disputes where the court applies foreign law.<sup>1564</sup> For instance, the courts of an EU Member State are not precluded from trying actions for infringement of a foreign copyright<sup>1565</sup> by the fact that the creation of the right is put in issue.<sup>1566</sup> In case that there is jurisdiction in relation to validity, the court may examine this issue as well, despite the fact that a foreign copyright is affected.<sup>1567</sup> Extending exclusive jurisdiction of the courts of the State where a patent has been granted also to disputes regarding the infringement of this patent would thus considerably wide the gap between patents and copyright. While it would be certainly possible to have such different rules for patents from those for copyright, provided that this can be justified, there actually is *no* compelling reason, meaning that no such justification for a different treatment exists.<sup>1568</sup> Where one of the reasons for not conferring exclusive jurisdiction in copyright cases is that of avoiding the proliferation of litigation, in favour of a consolidation of all the claims against an infringer under different laws in one single court, the need to prevent the proliferation of actions also exists with regard to patents, in particular European patents.<sup>1569</sup> Although an agreement on standards of patent law has not been achieved yet,<sup>1570</sup> a significant degree of harmonisation of patent law has already been established.<sup>1571</sup> Other areas of law which have been harmonised to a considerably less degree are not subject to discussions whether jurisdiction should be concentrated in one State.<sup>1572</sup> After all, it has rightly been emphasised

<sup>1561</sup> Similar: Schauwecker 2009, p. 362.

<sup>1562</sup> Schauwecker 2009, p. 362.

<sup>1563</sup> Mankowski 2011 (Rauscher), Vorbem Art 2 Brüssel I-VO, paras. 14-16b.

<sup>1564</sup> Cf. United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, dissenting opinion filed by Circuit Judge Newman, paras. 95-100, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*; Ubertazzi 2012, p. 218.

<sup>1565</sup> High Court of Justice (Chancery Division) 7 March 1997, Gareth Pearce v Ove Arup Partnership Ltd and Others, [1997] F.S.R. 641 – *Pearce I*; differently, but not on this point: Court of Appeal 21 January 1999, Gareth Pearce v Ove Arup Partnership Ltd, [1999] F.S.R. 525 – *Pearce II*.

<sup>1566</sup> Fawcett 2002, p. 153 et seq.

<sup>1567</sup> Fawcett 2002, p. 154.

<sup>1568</sup> Fawcett 2002, p. 158.

<sup>1569</sup> Fawcett 2002, p. 158 with further references.

<sup>1570</sup> Remarkably, severe efforts have been made in order to establish a Substantive Patent Law Treaty in the framework of the WIPO, even though until so far without success, cf. Straus & Klunker (2007)38(8) IIC 907, at p. 908 (= (2007)56(2) GRUR Int. 91, at pp. 91-92.)

<sup>1571</sup> Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 794; Blumer (2001)9 Tex. Intell. Prop. L.J. 329, at p. 397 et seq.; Thomas (1996)27 Law & Pol’y Int’l Bus. 277, at p. 341; Hellstadius & Meier-Ewert (2005)36(3) IIC 313, at p. 320; cf. Stauder 1973, at p. 518; Ubertazzi 2012, p. 217; Law Professors’ Brief 2005, p. 18 et seq.

<sup>1572</sup> Cf. Wadlow 1998, para. 2–122; cf. United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, dissenting opinion filed by Circuit Judge



that the differences in patent law today less concern questions of substantive law, but mostly affect the judicial system, for instance whether a jury applies, or whether courts comprise technical judges or not.<sup>1573</sup>

Last but not least, as a matter of fact, patent litigation – comparably with litigation in other fields of IP – is becoming increasingly international. The awareness of courts with regard to foreign law will necessarily be raised, and their own decisions will be influenced accordingly, because courts simply cannot escape from dealing with infringement occurring in other States, whether in the same or in related proceedings.<sup>1574</sup>

### 3.2.2.2 Sovereignty of the granting State

Besides the argument to establish “*Gleichlauf*” between jurisdiction and the applicable substantive patent law, advocates of the conception that the courts of the protection State should also have exclusive jurisdiction to decide on patent infringement have reasoned this conception by referring to the sovereignty of the State that has granted the concerned patent. In this respect, recourse has been made to the *Act of State*-doctrine and the principle of comity.

On the basis of the *Act of State*-doctrine it has been put forth that, since a patent is granted by national authorities, the grant forms a sovereign act of this State and therefore must be treated and acknowledged as such like other acts of public authority.<sup>1575</sup> According to this principle, courts must not declare void patents which have been granted by authorities of another State.

This conception is supplemented by the principle of comity. Due to fact that the effect of a patent is restricted to the territory of the granting State, it has been reasoned that the principle of comity<sup>1576</sup> further enjoins the court from assuming the existence of the patent, because this issue is a mere internal affair of the granting State.<sup>1577</sup> In this regard, it has been underlined that, in particular, the assumption of the validity of the patent would imply the increase of prices, on which only the granting State can decide. In this respect, the *High Court of Justice (Justice Aldous)* impressively explicated in *Plastus Kreativ*:

“(…) Although patent actions appear on their face to be disputes between two parties, in reality they also concern the public. A finding of infringement is a finding that a monopoly granted by the State is to be enforced. The result is invariably that the public have to pay higher prices than if the monopoly did not exist. If that be the proper result, then that result should, I believe, come about from a decision of a court situated in the State where the public have to pay the higher prices (...) [underscore added].”<sup>1578</sup>

Additionally, advocates of this conception have stressed that conferring exclusive jurisdiction to the courts of the granting State also with regard to infringement proceedings means to give

---

Newman, paras. 95-100, available at WWW

<<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

<sup>1573</sup> Hellstadius & Meier-Ewert (2005)36(3) IIC 313, at p. 320.

<sup>1574</sup> Hellstadius & Meier-Ewert (2005)36(3) IIC 313, at p. 320.

<sup>1575</sup> Herdegen 2011, § 37, para. 11; Stauder & Kur 2001, p. 152; Thomas (1996)27 Law & Pol’y Int’l Bus. 277, at pp. 315-316; cf. United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, majority opinion, para. 64, available at WWW

<<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

<sup>1576</sup> Herdegen 2011, § 14, para. 6.

<sup>1577</sup> Dreyfuss (2001) U. Ill. L. Rev. 421, at p. 441 et seq.; Chan (2008)18 Alb. L.J. Sci. & Tech. 1, at p. 36.

<sup>1578</sup> High Court of Justice (Chancery Division) 9 December 1994, *Plastus Kreativ AB v Minnesota Mining and Manufacturing Co*, [1995] R.P.C. 438, 447 – *Plastus Kreativ*.

full effect to the exclusive jurisdiction rule in relation to validity and to the policy reasons which justify this rule. It has been assumed that the maintenance of these policies is so important that they should apply even where validity is merely one part of the litigation, the other part being a claim for infringement.<sup>1579</sup>

However, this opinion is debated controversially.<sup>1580</sup> Advocates of the opposite opinion have rightly underlined that the sovereignty of the granting State is *not* affected, let alone impaired, if the extraterritorial infringement court examines the preliminary question raised by an invalidity defence of the alleged infringer, if the concerned patent is valid or not.<sup>1581</sup> The latter conception can be based on a number of arguments which shall be discussed in the following paragraph.

First of all, as has already been suggested above in conjunction with the “*Gleichlauf*” argument, there is no real justification for treating patent law in a different way than other areas of law. So, the question arises why another allocation of jurisdiction should apply as to patents than with regard to other rights. Each property right, i.e. not only intellectual property rights, is based on national legal provisions created by the respective State according to its conception of a legal order. The creation and the discontinuance of a right are also governed by legal provisions with regard to other types of property. If a particular link between property rights with a certain State was considered a decisive criterion for determining jurisdiction, a multitude of disputes concerning property rights which are allocated to a person by the rules of a certain legal system would have to be subject to exclusive jurisdiction of the courts of the respective State that created that legal system. However, this is neither the case nor are there serious attempts to establish such a system. Rather, general rules of jurisdictions are applicable as to the infringement of such property rights, with the *actor sequitur forum rei*-rule as a guiding principle.<sup>1582</sup>

While it might be true that a patent is more closely linked with the granting State than a non-intellectual property right insofar as the creation of the patent depends on its grant by an administrative authority of the granting State,<sup>1583</sup> this structural difference vis-à-vis other forms of property rights does not justify the application of different rules of jurisdiction. The relevant facts are not linked to any particular State but will entail a global evaluation of the technical state of the art at the relevant priority date.<sup>1584</sup> The fact that formal, respectively (if any) substantive requirements of patentability are examined by an administrative authority is undertaken for purposes of publicity and complexity of the matter, but is not owed to further economic policy considerations.<sup>1585</sup> This is illustrated by the fact that the applicant has a claim to gain a patent if the requirements for grant are fulfilled, the granting authority thus having no discretion whether or not to grant the patent applied for<sup>1586</sup> which could eventually be interpreted as peculiarities of the sovereignty of the granting State.<sup>1587</sup> Moreover, some States even do not undertake a substantive examination of a patent application but merely examine

---

<sup>1579</sup> Fawcett 2002, p. 154.

<sup>1580</sup> Arguing strongly against the *Act of State*-doctrine and the principle of comity as justifications for exclusive jurisdiction rules: Ubertazzi 2012, pp. 100-136.

<sup>1581</sup> In place of many others: Fezer & Koos 2010 (Staudinger), para. 1151.

<sup>1582</sup> Schauwecker 2009, p. 357.

<sup>1583</sup> Kraßer 2009, p. 425 et seq.

<sup>1584</sup> Kur (2006)37(7) IIC 844, at pp. 848-849; Lundstedt (2012)81(1) NIR 6, at p. 12.

<sup>1585</sup> Schauwecker 2009, p. 358.

<sup>1586</sup> Thomas (1996)27 Law & Pol’y Int’l Bus. 277, at p. 337 et seq.

<sup>1587</sup> United States Court of Appeals, Third Circuit 3 April 1979, Case No. 78-1845, *Mannington Mills, Inc. v Congoleum Corporation*, 595 F.2d 1287, paras. 28-29, available at WWW <<http://openjurist.org/print/208142>> – *Mannington Mills*.

formal aspects which could be interpreted.<sup>1588</sup> In these circumstances, it seems even less convincing to qualify the grant of patents as a peculiarity (embodiment) of the sovereignty of the granting State.<sup>1589</sup>

Moreover, it is to be underlined that the grant of a patent is less a governmental *act* than a governmental *reaction*,<sup>1590</sup> for it is up to private parties to initiate the process of patent prosecution by filing an application.<sup>1591</sup>

With regard to this nature of a patent, in particular *Torremans* has instructively pointed out that

“(…) patents have long lost the aura of acts of state and are increasingly instruments of commercial life, irrespective of the granting procedure. The involvement of national administrative authorities in patent law is therefore not necessarily more important than other form of state involvement in the economy and there is hardly any suggestion around that such involvement should necessarily lead to exclusive jurisdiction.”<sup>1592</sup>

So, intellectual property rights in general, and patents in particular, are actually to be considered as private rights, although in case of registered rights like patents, they come into existence by way of an administrative act.<sup>1593</sup> Admittedly, the court deciding on the infringement of a patent, by defining the scope of protection of the patent, will practically shape the patent. But this does not justify either to confer exclusive jurisdiction as to the evaluation whether or not a patent has been infringed to the courts of the granting State. In this respect, it is to be stressed that principles of private international law require that a court applying foreign law not only restricts itself to a literal application of that law, but also takes into consideration foreign case-law and methods of interpretation.<sup>1594</sup> Thus, a court applying foreign law in order to determine a patent will *idealiter* not arrive at another result than a court of the State where the patent has been granted. Varying decisions based on different legal evaluations may also occur between courts of the same State, and even between different chambers of one court.<sup>1595</sup> Consequently, the fact that conflicting decisions on the scope of a patent may occur between the courts of different States, does not justify to allocate jurisdiction in infringement matters merely to the courts of the granting State, because a decision on the infringement or non-infringement of a patent which does not create or extend

---

<sup>1588</sup> Schauwecker 2009, p. 358; Lundstedt (2012)81(1) NIR 6, at p. 12.

<sup>1589</sup> Cf. already Troller (1955)4(12) GRUR Int. 529, at pp. 531-532.

<sup>1590</sup> Thomas (1996)27 Law & Pol’y Int’l Bus. 277, at p. 337 et seq.

<sup>1591</sup> With regard to the U.S. patent case-law: United States Court of Appeals, Third Circuit 3 April 1979, Case No. 78-1845, *Mannington Mills, Inc. v Congoleum Corporation*, 595 F.2d 1287, paras. 28-29, available at WWW <<http://openjurist.org/print/208142>> – *Mannington Mills*: The court characterised such acts that would fall within the scope of the *Act of State*-doctrine as “a result of a considered policy determination by a government to give effect to its political and public interests matters that would have significant impact on American foreign relations” and made clear that “the granting of the patents per se, in substance *ministerial activity*, is not the kind of governmental action contemplated by the act of state doctrine”; United States District Court, S. D. New York 24 June 1981, *Forbo-Giubiasco S. A. v Congoleum Corp.*, 516 F.Supp 1210, 1217, available at WWW <[http://www.leagle.com/decision/19811726516FSupp1210\\_11550](http://www.leagle.com/decision/19811726516FSupp1210_11550)> – *Forbo-Giubiasco*; cf. United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, *Jan K. Voda, M.D. v Cordis Corporation*, 476 F.3d 887, dissenting opinion filed by Circuit Judge Newman, paras. 132-135, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*; literature: Chan (2008)18 Alb. L.J. Sci. & Tech. 1, at p. 38 et seq.; Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 795; Thomas (1996)27 Law & Pol’y Int’l Bus. 277, at p. 337 et seq.; Law Professors’ Brief 2005, p. 21 et seq.

<sup>1592</sup> Torremans 2008, p. 66.

<sup>1593</sup> Ubertazzi (2011)60(3) GRUR Int. 199, at p. 203; Ubertazzi 2012, p. 217.

<sup>1594</sup> Kegel & Schurig 2004, p. 503 et seq.

<sup>1595</sup> Referring to the *Federal Circuit*: Newman (1997)8 Fordham Intell. Prop. Media & Ent. L.J. 3, at p. 6.

the patent does not constitute an intrusion into/infringement of the sovereignty of the granting State, because, after all, the fact that a patent is granted by an administrative authority does not influence respectively alter the fact that disputes between *private parties* are affected.<sup>1596</sup> After all, neither the principle of comity<sup>1597</sup> nor the *Act of State*-doctrine are legally binding.<sup>1598</sup> In particular in respect of U.S. American case-law, it must be pointed out that the *CAFC* generously granted the extraterritorial application of U.S. American patent law.<sup>1599</sup> Remarkably, this constitutes a more severe intrusion into/infringement of the sovereignty of foreign States and would therefore have to provoke much stronger concerns with respect to the comity principle.<sup>1600</sup>

Additionally, it should be borne in mind that it is no particularity of patent law that a deciding judge will concretely define the exact scope of rights which have been vaguely formulated by the legislator in an abstract way.<sup>1601</sup> Neither in patent law, nor in other fields of law this means that the court will create new rights (extension of rights), but the court will merely determine the scope of a right which has already existed or granted before.<sup>1602</sup> This is owed to the fundamental principle of separation of powers.<sup>1603</sup>

Last but not least, it is to be underlined that even if particular considerations of sovereignty were affected with regard to patent infringement disputes, the granting States would have the possibility to waive, by way of arrangements on the European or international level, the right to decide exclusively on the question if patents granted by them for their territories are being infringed or not, and to allow each other to take such decisions.<sup>1604</sup>

To conclude, it is to be stated that the conception that the sovereignty of the granting State requires to allocate exclusive jurisdiction to the courts of the granting State also with regard to patent infringement disputes is not convincing. Neither the *Act of State*-doctrine nor the comity principle require such allocation of exclusive jurisdiction. On the contrary, conferring jurisdiction to foreign courts may even be in line with the interests of the patent granting State and can thus constitute an act of comity between sovereign States,<sup>1605</sup> for instance if assets of the alleged infringer are situated merely at his foreign domicile and the patent will be

---

<sup>1596</sup> Adolphsen (2007)27(1) IPRax 15, at p. 18; Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 795; Thomas (1996)27 Law & Pol'y Int'l Bus. 277, at p. 338; Law Professors' Brief 2005, p. 22; Hye-Knudsen 2005, pp. 51-52; Kraßer 2009, p. 611 et seq.; differently: High Court of Justice (Chancery Division) 9 December 1994, *Plastus Kreativ AB v Minnesota Mining and Manufacturing Co.*, [1995] R.P.C. 438, 447 – *Plastus Kreativ* (critically against these considerations of the High Court: Dutson (1998)47(3) I.C.L.Q. 659, at p. 678).

<sup>1597</sup> Herdegen 2011, § 14, para. 6.

<sup>1598</sup> Herdegen 2011, § 37, para. 11.

<sup>1599</sup> Cf. United States Court of Appeals, Federal Circuit 2 March 2005, Case No. 04-1234, *Eolas Technologies Incorporated and the Regents of the University of California v Microsoft Corporation*, 399 F.3d 1325, available at WWW <<http://openjurist.org/print/559194>> – *Eolas Technologies Incorporated*; cf. also United States Court of Appeals, Federal Circuit 2 August 2005, Case No. 03-1615, *Ntp, Inc. v Research in Motion, Ltd.*, 418 F.3d 1282, available at WWW <<http://openjurist.org/print/564309>> – *Ntp, Inc v Research in Motion, Ltd.*; United States Court of Appeals, Federal Circuit 13 July 2005, Case No. 04-1285, *AT&T Corp. v Microsoft Corp.*, 414 F.3d 1366, available at WWW <<http://openjurist.org/print/563685>> – *AT&T Corp. v Microsoft Corp.*, reversed Supreme Court, 30 April 2007, Case No. 05-1056, *Microsoft Corp. v AT&T Corp.*, 127 S. Ct. 1746 (2007), available at WWW <<http://caselaw.lp.findlaw.com/scripts/getcase.pl?court=US&vol=550&invol=437>> – *Microsoft Corp. v AT&T Corp.*

<sup>1600</sup> Law Professors' Brief 2005, 3.

<sup>1601</sup> Schauwecker 2009, p. 358.

<sup>1602</sup> Schauwecker 2009, p. 359.

<sup>1603</sup> Schauwecker 2009, p. 359.

<sup>1604</sup> Schauwecker 2009, p. 357.

<sup>1605</sup> Law Professors' Brief 2005, 3.

immediately enforceable only at that place.<sup>1606</sup> In this regard, it has rightly been underlined that, as a matter of fact, the possibility of recognition and execution in the State of domicile is not fully equal to the possibility to exert jurisdiction.<sup>1607</sup> Jurisdiction regarding the infringement of patents should thus not be restricted to the courts in the granting State, but subject to the general rules.

### **3.2.2.3 Interest of the courts of the granting State to have exclusive jurisdiction to decide in patent infringement disputes**

In particular in England, it has been feared that plaintiffs will take their patent litigation overseas, in particular to the Netherlands, encouraged by the fact that Dutch courts are prepared to grant cross-border injunctions in respect of foreign patents using the so-called *kort geding*-procedure, a shortened procedure reserved for provisional measures. In light of this, allocating exclusive jurisdiction to the courts of the granting State means to protect the interest of the court in maintaining its business (such as the English *Patents Court* which has traditionally been considered a venue for patent litigation in cases where the patent is registered in England).<sup>1608</sup>

Against the latter opinion, it is to be clearly emphasised that the interest of courts in one State in protecting their business from being lost to the courts in other States does not constitute an adequate interest in the framework of private international law.<sup>1609</sup>

### **3.2.2.4 Party interests**

#### **3.2.2.4.1 The plaintiff's perspective**

First of all, it is to be emphasised that, where the courts of the granting State have no exclusive jurisdiction as to patent infringement disputes, the plaintiff can sue an alleged patent infringer before the courts of the State where the defendant is domiciled. In this scenario, there is a good chance that the judgment will not have to be recognised and enforced in the protection State, because the defendant's assets will usually be situated at his place of domicile.<sup>1610</sup> Although cases are conceivable where enforcement abroad might be required (for instance as to the judgments to omit a specific acting), this fact does however not suffice as a justification for exclusive jurisdiction of the courts of the granting State. For the Brussels Ibis Regulation explicitly provides for detailed rules with regard to recognition and enforcement of foreign judgments, which demonstrates that the European legislator was aware of the problem of enforcement abroad. Even if enforcement abroad turns out, in an individual case, to be impossible, this principally should not lead to the result that general rules of jurisdiction according to the Brussels Ibis Regulation are not applied. Such a deviation from general rules would only be justified if enforcement abroad was *generally* impossible, i.e. not only in individual cases.<sup>1611</sup>

---

<sup>1606</sup> Schauwecker 2009, p. 360; Chan (2008) 18 Alb. L.J. Sci. & Tech. 1, at p. 42

<sup>1607</sup> Schauwecker 2009, p. 360.

<sup>1608</sup> Fawcett 2002, p. 154 et seq.

<sup>1609</sup> Similar: Fawcett 2002, p. 155.

<sup>1610</sup> Schauwecker 2009, p. 365.

<sup>1611</sup> Schauwecker 2009, p. 365.

On the contrary, conferring exclusive jurisdiction as to patent infringement disputes to the courts of the granting State would lead to considerable problems. The plaintiff would first have to sue the alleged patent infringer(s) in the protection State, and then enforce the foreign judgment in the State of domicile of the defendant which is more costly and time-consuming (cumbersome and intricate) than immediately suing the alleged patent infringer in his State of domicile. The situation would be even more grave in case of several alleged patent infringers being resident in various States. Then enforcement of the gained judgments must be undertaken in each defendant's State of domicile. This might turn out *considerably* costly and time-consuming.

After all, it falls within the plaintiff's sphere to choose the forum which he evaluates most suitable. If exclusive jurisdiction as to patent infringement proceedings was conferred to the courts of the granting State, the plaintiff would be deprived of this fundamental procedural right. The plaintiff then even would not have the opportunity of bringing an action in the State of the defendant's domicile, let alone the alternative under the tort rule of initiating proceedings in the place of the event giving rise to the damage and the place where the damage occurred. The policies justifying this important rule of private international law thus would be ignored if the courts of the granting State were allocated exclusive jurisdiction for patent infringement actions.<sup>1612</sup> And, as the plaintiff is generally interested in a fast enforcement of his patent right, he might also decide against suing an alleged patent infringer outside the protection State, because the invoked court will first have to determine and cope with the foreign law applicable.<sup>1613</sup> In practice, the plaintiff who will usually be well-advised by patent law specialists, will be able to choose the forum most favourable for him. For this reason, the fact that it is admittedly not excluded that the application of general rules of jurisdiction to patent infringement proceedings might potentially lead, from the plaintiff's perspective, to a less favourable forum, also does not militate against the applicability of these general jurisdictional rules (in favour of the exclusive jurisdiction of the courts of the granting State).<sup>1614</sup>

Consequently, taking into account the plaintiff's interests leads to the result that the courts of the granting State should not *per se*<sup>1615</sup> be given exclusive jurisdiction with regard to patent infringement proceedings.

#### 3.2.2.4.2 The defendant's perspective

Like in other cross-border civil disputes, it is probable, also with regard to cases of cross-border patent infringement, that the defendant is rather interested in having a case decided by a court of the State where he is domiciled, outside the protection State, than being obliged to defend himself before a foreign court in the State where the affected patent was granted.<sup>1616</sup> Likewise, the defendant will be rather interested in finding an arrangement with the plaintiff

---

<sup>1612</sup> Fawcett 2002, p. 155.

<sup>1613</sup> Kur (2001)50(11) GRUR Int. 908, at p. 910.

<sup>1614</sup> Schauwecker 2009, p. 365.

<sup>1615</sup> It must be borne in mind that, at this stage, the analysis concerns the question of whether the courts of the State where a patent was granted should *per se* have exclusive jurisdiction with regard to patent infringement actions. This question is to be differentiated from the subsequent question – to be treated afterwards – if there are specific circumstances in which and if so, to which extent, courts of the protection State which have exclusive jurisdiction as to the question of validity of the patent would also exclusively decide on infringement issues.

<sup>1616</sup> Cf. Stauder 1973, at p. 513.

on the place of jurisdiction, than having to accept, with regard to the infringement proceeding, the exclusive jurisdiction of the courts of the granting State.<sup>1617</sup>

From the defendant's perspective, it thus seems also preferable that general rules of jurisdiction are applicable to patent infringement proceedings rather than allocating exclusive jurisdiction to the courts of the granting State with regard to patent infringement disputes.

### 3.2.2.4.3 Special case: Multistate delicts

A special constellation to be considered is that of multistate delicts, meaning the case of alleged infringement of several patents granted in, respectively for various States. If infringement proceedings could only be initiated before the courts of the States where the patents have been granted, consolidation would not be possible, which would raise financial burdens, and would probably also effect a prolongation of litigation due to the necessity of parallel proceedings. This would neither be fair to the plaintiff, nor to the defendant who may well prefer to have trial of the infringement of all patents in one State.<sup>1618</sup> If, on the contrary, the proceedings could be consolidated before the courts of the State of domicile of the defendant, this would bring along cost and time advantages both for the defendant and the plaintiff. In addition, the courts of the State of domicile of the defendant have comprehensive authority to decide, meaning that the dispute could be settled in one proceeding.<sup>1619</sup>

Regarding the infringement of parallel European patents, it has been further put forth that the necessity of different (parallel) infringement proceedings is inconsistent with the protection given to persons who wish to register their rights, because European patents for a number of different States can be obtained by *one* single registration.<sup>1620</sup> However, this evaluation does not go far enough in this respect, because it ignores the fact that, although one registration is sufficient for gaining protection in several EPC Contracting States, this protection consists in a bundle of national patents which, after grant, have their individual fate, being independent from each other.

### 3.2.2.5 Judicial economy

Advocates of the conception that exclusive jurisdiction as to patent infringement disputes should be allocated to the courts of the granting State have also referred to judicial economy. However, the question arises of whether judicial economy indeed militates for or against this conception, respectively whether this question can be answered in a general way.

To begin, it has been put forth that conferring exclusive jurisdiction to the courts of the granting State for patent infringement disputes would effect a concentration of proceedings, because these courts also have exclusive jurisdiction with regard to validity actions and, accordingly, a one-stop solution would be available.<sup>1621</sup> Indeed, a concentration of

---

<sup>1617</sup> Schauwecker 2009, p. 364.

<sup>1618</sup> Fawcett 2002, p. 157.

<sup>1619</sup> In this respect, it is relevant that, in (patent) infringement proceedings, the scope of authority to decide which is allocated to courts differs between the various places of jurisdiction provided for in Article 7(2) of the Brussels Ibis Regulation.

Cf. also Schauwecker 2009, p. 365.

<sup>1620</sup> Fawcett 2002, p. 156.

<sup>1621</sup> Cf. Tilmann (2005)107(11) GRUR 904, at p. 907.

proceedings may generally save time and money,<sup>1622</sup> and could also favour legal certainty, because the risk of conflicting judgments produced by different courts, on the scope of the patent, would be avoided. This effect would correspond to the concept that a patent which grants a monopoly with respect to a certain product or process, can have only one scope, and not a different scope for validity than for infringement.<sup>1623</sup> The more courts are involved, the higher is the risk of irreconcilable judgments. Additionally, militating for conferring exclusive jurisdiction regarding patent infringement proceedings to the courts of the granting State, it has been pointed out that the courts in the granting State would eventually lack jurisdiction concerning national patents otherwise.<sup>1624</sup>

However, a closer look on the aspect of judicial economy reveals that things are less clear and a definite answer which solution serves the objective of judicial economy in a better way cannot be given so easily.

First of all, the argument that the courts in the granting State would eventually lack jurisdiction concerning national patents if general rules of jurisdiction were applicable to patent infringement, is not convincing, because such jurisdiction exists pursuant to the general provision of Article 7(2) of the Brussels Ibis Regulation on jurisdiction regarding torts.<sup>1625</sup> If considered necessary, a special provision on jurisdiction with regard to patent infringement could be established.<sup>1626</sup>

Beyond that, although it is true that the concentration of proceedings on the validity and proceedings on the infringement of patents *may*<sup>1627</sup> serve the goal of judicial economy, it is not convincing to conclude from this, without any alternative, that the concentration of both types of proceedings *must* be realised at the courts of the protection State.<sup>1628</sup> While it shall not be doubted here whether the courts of the granting State shall have exclusive jurisdiction as to patent validity proceedings – Article 24(4) of the Brussels Ibis Regulation explicitly submits this type of actions under the exclusive jurisdiction of the courts of the protection State, and there are obviously no serious attempts to alter this allocation of jurisdiction – a crucial question is which effect the invalidity defence in cross-border patent infringement proceedings should have. *De lege ferenda*, other ways to reach an effective allocation of jurisdiction are conceivable. In this respect, it would be possible, too, to oblige the infringement court to stay the infringement proceeding as soon as the defence of invalidity has been raised. Additionally, a provision could be created according to which the infringement courts and the courts in the protection State must coordinate their proceedings. Judicial economy indeed seems more likely to be achieved by consolidating multinational patent disputes, rather than by multiplying the proceedings as required by rules of exclusive jurisdiction.<sup>1629</sup> Alternatively, it is conceivable to grant the infringement court authority to decide on the validity of the concerned patent by way of a decision which has only *inter*

<sup>1622</sup> Tilmann (2005)107(11) GRUR 904, at p. 907; Fawcett 2002, p. 152.

<sup>1623</sup> Fawcett 2002, p. 152.

<sup>1624</sup> Fawcett 2002, p. 154.

<sup>1625</sup> Schauwecker 2009, p. 367.

<sup>1626</sup> According to my opinion, such a special provision is not required.

<sup>1627</sup> This positive effect will be relativised in the case of multistate delicts, i.e. in the constellation where several (parallel) patents are being infringed, a problem which commonly arises with regard to European patents.

<sup>1628</sup> Schauwecker 2009, p. 366; Fawcett 2002, p. 153; differently: cf. United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, majority opinion, paras. 73-76, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

<sup>1629</sup> Ubertaini 2012, p. 215.



*partes* effect and not *erga omnes* effect.<sup>1630</sup> In light of this, the question of which allocation of jurisdiction serves best judicial economy can only be answered after a decision on the exact scope of exclusive jurisdiction of the courts of the protection State.<sup>1631</sup> On the one hand, under the general jurisdiction rules in multistate delicts, the plaintiff could sue an alleged patent infringer for the infringement of all concerned patents at the general (as well as the agreed or accepted) place of jurisdiction, while, in case of exclusive jurisdiction for infringement matters of the courts of the granting State, he could then only sue the defendant for the infringement of the patent which was granted for the State where the respective court is situated (forum State). Consequently, in case of several (allegedly) infringed patents, several courts would have exclusive jurisdiction to decide on the infringement and validity of the respective patent. This would result in a fragmentation respectively a proliferation or even a multiplication rather than a concentration of proceedings.<sup>1632</sup> On the other hand, conferring exclusive jurisdiction to the courts of the State where the concerned patent has been granted, and forcing the extraterritorial court, invoked in infringement proceedings, to stay proceedings, would effect a split between the infringement issue and the validity issue. As a consequence, regardless of the outcome of the decision on exclusive jurisdiction of the courts of the granting State for patent infringement disputes, it is obvious that neither conferring exclusive jurisdiction for patent infringement proceedings to the courts of the granting State, nor applying the general rules of jurisdiction in cases of patent infringement will provide a more effective system of jurisdiction in *any* possible circumstance.

Besides, it is to be borne in mind that applying the general rules of jurisdiction would *not* mean that the courts of the granting State completely *lose* jurisdiction in infringement matters, but that further, additional options of jurisdiction would be created.<sup>1633</sup>

To conclude, it is to be stated that it depends on the concrete constellation affected whether judicial economy can be achieved, respectively strengthened by conferring exclusive jurisdiction to the courts of the granting State also for infringement proceedings, or by the application of the general jurisdiction rules with respect to cases of patent infringement. As a consequence, the aspect of judicial economy cannot serve as an argument why cases of patent infringement should be treated in a different way than other civil disputes according to which the general rules of jurisdiction undoubtedly apply. After all, due to the applicability of Article 7(2) of the Brussels Ibis Regulation, the application of the general rules of jurisdiction does not imply that the courts of the State where the concerned patent has been granted lose jurisdiction.

### 3.2.2.6 Indirect (mediate) solution of the torpedo problem

Advocates of the conception according to which courts of the protection State should have exclusive jurisdiction as to patent infringement proceedings have further argued that by conferring exclusive jurisdiction to these courts, the problem of torpedo actions, i.e. (counter-) actions for a declaration of non-infringement, initiated by the defendant of an infringement action (raised in the protection State) before a court in another State, in order to impair the action in the protection State, could be solved. Strengthening thus judicial economy and effective legal protection would actually correspond to the purpose of intellectual property law – including international intellectual property law – to have a share in creating and

<sup>1630</sup> Schauwecker 2009, p. 366.

<sup>1631</sup> Schauwecker 2009, p. 366.

<sup>1632</sup> Schauwecker 2009, p. 367; Fawcett 2002, p. 156 et seq.

<sup>1633</sup> Kur (2001)50(11) GRUR Int. 908, at p. 910.

maintaining an economic system which stimulates dynamic competition between enterprises by offering them incentives to invest in innovation and new products.<sup>1634</sup>

However, the latter opinion has been strongly criticised.<sup>1635</sup> First of all, the possibility to raise an action for a declaration of non-infringement is *per se* a legitimate procedural means which is provided for by the rules of the Brussels Ibis Regulation.<sup>1636</sup> In this respect, the approach to fundamentally demonise this instrument is not reconcilable with the idea of the Brussels Ibis Regulation. While it is true that the possibility to initiate an action for a declaration of non-infringement *can* be abused, this *eventuality* of abuse does not allow to deny any justification of this procedural means. In this respect, the approach of a direct (immediate) solution of the problem of abusively raised torpedo actions seems preferable vis-à-vis an indirect (mediate) solution accomplished by extending the rules of exclusive jurisdiction, because the latter approach would actually result in a mere circumvention of the problem.<sup>1637</sup> Noteworthy, the reform proposals contained in Article 21(6) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), § 213(4) of the ALI Principles and Article 2:701(1) of the CLIP Principles – while it is not necessary to discuss these proposals in detail at this point – provide for rules in order to adequately cope with torpedo actions. Notwithstanding the divergence of the concrete solutions contained in the mentioned reform proposals, this demonstrates that such direct solutions are conceivable.

Beyond that, even if the courts of the protection State were given exclusive jurisdiction as to patent infringement actions, the alleged infringer would still dispose of the possibility to delay (torpedo) proceedings raised against him, because the court invoked by that alleged infringer, before dismissing the action according to Article 27 of the Brussels Ibis Regulation, would first have to examine the existence of exclusive jurisdiction. In this respect, the ECJ held in its *Gasser* decision which concerned the (parallel) constellation of an agreement conferring jurisdiction:

“(…) A court second seised whose jurisdiction has been claimed under an agreement conferring jurisdiction must nevertheless stay proceedings until the court first seised has declared that it has no jurisdiction.”<sup>1638</sup>

This process may require some time.<sup>1639</sup>

To conclude, the conception according to which the problem of abusively raised torpedo actions can, respectively should be solved by conferring exclusive jurisdiction to the courts of the granting State with regard to patent infringement proceedings, is not convincing and is thus to be rejected.

### 3.2.2.7 Further considerations

In favour of conferring exclusive jurisdiction for patent infringement disputes to courts of the granting State, it has further been put forth that this would provide a level of certainty that is

---

<sup>1634</sup> Drexl 2015 (Münchener Kommentar zum BGB), Internationales Immaterialgüterrecht, para. 5, and there fn. 4.

<sup>1635</sup> Cf. Kur (2001)50(11) GRUR Int. 908, at p. 911 et seq.; Kur (2002)24(4) E.I.P.R. 175, at p. 179 et seq.

<sup>1636</sup> Cf. in detail Kur (2001)50(11) GRUR Int. 908, at p. 911 et seq.

<sup>1637</sup> Schauwecker 2009, p. 368.

<sup>1638</sup> ECJ 9 December 2003, C-116/02, Erich Gasser GmbH v MISAT Srl, [2003] ECR I-14693, para. 54 – *Gasser*.

<sup>1639</sup> Schauwecker 2009, p. 368.

lacking under the present law, because the initial question of whether an extraterritorial court invoked in patent infringement proceedings may examine the validity of the concerned patent when the invalidity defence has been raised, *a priori* could not become relevant in practice if the extraterritorial court lacked jurisdiction in patent litigation at all.<sup>1640</sup> However, this argument will become obsolete as soon as specific rules regarding the effect of an invalidity defence in patent infringement proceedings will have been established.

Besides, it has been suggested that the questions of validity and infringement are closely linked<sup>1641</sup> and therefore should be tried in the same State. In most States, this means the same specialised court.<sup>1642</sup> In this respect, one might consider the courts in the protection State as “best placed courts”, as the ECJ underlined in its *GAT* decision:

“Thus, the exclusive jurisdiction in proceedings concerned with the registration or validity of patents conferred upon the courts of the Contracting State in which the deposit or registration has been applied for or made is justified by the fact that those courts are best placed to adjudicate upon cases in which the dispute itself concerns the validity of the patent or the existence of the deposit or registration (*Duijnsteet*, paragraph 22) [underscore added].”<sup>1643</sup>

However, it has rightly been put forth that this argument fails, because the aim of the best placed court approach is not to determine the best placed court in an abstract way, but rather by considering the concrete elements of the relevant cases on the basis of international jurisdiction rules according to which more than one court has jurisdiction, which implies that the court seised must have discretionary powers to establish jurisdiction if it is best placed to decide according to the concrete elements of the case.<sup>1644</sup>

While the validity issue and the infringement issue are indeed closely linked with each other, it is to be stressed that this fact does not necessarily imply that both matters must be brought before the same court in the same State. Concentrating proceedings in the State with validity jurisdiction would effectively mean to elevate the validity issue in importance over infringement. Conversely, if proceedings were concentrated in the State with infringement jurisdiction, this would elevate infringement in importance over validity. The dilemma is that both solutions would not be in line with substantive law which does not consider one aspect more important than the other.<sup>1645</sup> In light of this, it has been argued that just due to the correct insight that there is a close link between the questions of validity and infringement of a patent, infringement and validity proceedings should *not* be concentrated in a single State, but, instead, split up between the State with validity jurisdiction and the State with infringement jurisdiction,<sup>1646</sup> with the possibility of a stay of infringement proceedings until the validity question has been decided.<sup>1647</sup>

---

<sup>1640</sup> Fawcett 2002, p. 152.

<sup>1641</sup> The aspects of validity and infringement of a patent have been described as being “two sides of the same coin”, cf. High Court of Justice (Chancery Division – Patents Court) 3 July 1996, *Chiron Corporation v Evans Medical Ltd and Others*, [1996] F.S.R. 863, at p. 872 – *Chiron Corporation*; cf. also High Court of Justice (Chancery Division – Patents Court) 23 January 1996, *Organon Teknika Ltd v Hoffmann La Roche AG*, [1996] F.S.R. 383, at 384 – *Organon Teknika*; High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, *Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another*, [1998] F.S.R. 222 – *Fort Dodge*.

<sup>1642</sup> Fawcett 2002, p. 153.

<sup>1643</sup> ECJ 13 July 2006, C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, [2006] ECR I-06509, para. 22 – *GAT*.

<sup>1644</sup> Ubertazzi 2012, pp. 215-216.

<sup>1645</sup> Fawcett 2002, p. 153.

<sup>1646</sup> Fawcett 2002, p. 153.

<sup>1647</sup> *Gerechtshof 's-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352, 361 – *Expandable Grafts Partnership II*.

Arguing in favour of exclusive jurisdiction for patent infringement disputes of the courts of the granting State, it has further been highlighted that, if jurisdiction for examining the validity issue and the infringement of a patent falls apart, two constellations are conceivable where *practical* problems may occur. These constellations referred to shall be illustrated by the following Cases 1 and 2.<sup>1648</sup>

#### Case 1:

P holds a patent granted in State A. P sues X before a court of State B which has infringement jurisdiction, but does not have validity jurisdiction. The court orders the infringement to cease in State A. P then tries to enforce this order in State A. Problematically, a court of State A which has validity jurisdiction, has previously held that the patent is void.

#### Case 2:

Again, P holds a patent granted in State A, and sues X before a court of State B which has infringement jurisdiction. In contrast to Case 1, this invoked court also has validity jurisdiction. The court rules that the patent is valid, and then orders the infringement to cease in State A. P tries to enforce this order in State A. Problematically, a court of State A which also has validity jurisdiction, has previously held that the patent is void.

In both constellations, the problem arises that the courts of State A and State B produced judgments which are irreconcilable with each other. Obviously, allocating the examination of the validity and the infringement of a patent to the same courts would avoid such conflict. However, as has already been suggested, the risk of irreconcilable judgments can also be met by adequately coordinating the litigation. Infringement proceedings can be stayed pending a decision abroad on the issue of validity.<sup>1649</sup>

Moreover, advocates of a regime of exclusive jurisdiction of courts of the protection State also regarding patent infringement actions have feared that, if foreign courts have jurisdiction to determine the validity of patents not registered in their State, this may lead to corruption, given that patents can be of enormous financial value. Additionally, it has been underlined that the wider the range of States in which the issue of validity can be tried the more likely it is that a person is able to bring an action in a State in respect of which there are concerns that the judges are open to bribery.<sup>1650</sup> Regarding this argument, it is to be underlined that, in particular within the European area of justice, it is no legitimate consideration to deny jurisdiction to foreign courts for the sole reason of an undetermined, vague fear of corruption. Although the standard may be lower in the context of an international convention, the principal idea is the same:<sup>1651</sup> Comity requires a respect for the ability of courts of other Contracting States.<sup>1652</sup>

---

<sup>1648</sup> The cases have been constructed according to: Fawcett 2002, p. 152.

<sup>1649</sup> Fawcett 2002, p. 152 et seq.

<sup>1650</sup> Fawcett 2002, p. 153.

<sup>1651</sup> Noteworthy, the focus of this thesis lies on the question in which way the Brussel Ibis Regulation should be amended. In second line, the question arises in which way an eventual Global Judgments Convention could, respectively should be constructed.

<sup>1652</sup> Fawcett 2002, p. 154.

As to the further eventual argument that, although the defendant in infringement proceedings is not obliged to raise the invalidity defence, he will frequently do so and this defence can always be raised in the future until the infringement dispute is finished, it is to be stated that such a view does not provide for an adequate solution for the case that infringement proceedings have been initiated, but no invalidity defence is raised by the defendant. Even if the invalidity defence is frequently raised, it remains the defendant's individual choice to raise it or not, which may not and should not be anticipated by assuming *a priori* that he will raise it.<sup>1653</sup> Jurisdiction cannot be determined on the basis of mere suspicions as to what defence might run, because it might turn out that the defendant will not at all raise that defence.<sup>1654</sup> Although it may occur that the issue of validity is raised in the course of the infringement proceeding, this does not alter the fact that this is merely a theoretical possibility.<sup>1655</sup>

Alternatively, English courts have adopted the opinion that it suffices as being equivalent to actually raising the defence, if the issue of validity has *not actually* been raised, that it is *clear that it is going to be raised*.<sup>1656</sup> However, in case that the invalidity defence cannot be deemed to be meant seriously, illustrated by the fact that the arguments in favour of this are inadequate, jurisdiction has been considered to be determined on the basis that there is a claim for infringement which does not raise the issue of invalidity.<sup>1657</sup> Besides, it has been stressed that, even if one accepted the mere possibility of the invalidity defence being raised for conferring exclusive jurisdiction for the infringement dispute to the courts of the granting State, the need to give effect to the validity rule and the policies underlying that rule would not be as strong if there was merely the *possibility* of the invalidity defence being raised, rather than a certainty.<sup>1658</sup> Moreover, the interests of the court in managing its business in relation to validity – even if such interests were to be recognised at all, which is actually doubtful – would lose considerable importance if the defendant of the infringement proceedings will eventually raise the invalidity defence, but has not actually raised it (where it is uncertain whether this defence will be raised at all).<sup>1659</sup>

Besides, it should be borne in mind that conferring exclusive jurisdiction for patent infringement proceedings to the courts of the State where the patent has been granted fully ignores the fact that patent infringement is a tort and under the Brussels Ibis Regulation, the normal position is that a plaintiff can bring a tort claim in the State in which the act or the injury occurred.<sup>1660</sup> The underlying reason is the crucial requirement of a meaningful

---

<sup>1653</sup> Fawcett 2002, p. 158.

<sup>1654</sup> Cf. High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suizo International (U.K.) Limited and Others*, [1997] F.S.R. 660, 677 – *Coin Controls*: “However, the fact that the defendant can challenge validity does not mean that he will.”

<sup>1655</sup> High Court of Justice (Chancery Division – Patents Court) 3 July 1996, *Chiron Corporation v Evans Medical Ltd and Others*, [1996] F.S.R. 863, at p. 872 – *Chiron Corporation*.

<sup>1656</sup> Cf. High Court of Justice (Chancery Division) 26 March 1997, *Coin Controls Limited v Suizo International (U.K.) Limited and Others*, [1997] F.S.R. 660, 678 – *Coin Controls*: “However, rather than waste the costs of requiring the defendants to plead invalidity here as a precursor to the claims being struck out, where, as here, it is plain that validity is to be put in issue, the court should take the course of striking out the relevant claims forthwith.”; agreeing: High Court of Justice (Chancery Division – Patents Court) 7 February 2008, *Knorr-Bremse Systems for Commercial Vehicles LDT v Haldex Brake Products GmbH*, [2008] F.S.R. 30, 770 – *Knorr-Bremse*: “It is clear in my judgment that Laddie J. held that where it is clear that validity “is to be” put in issue (i.e. in the future) the court should decide the application on the basis that validity is one of the issues in the case. It is not necessary for the allegation of invalidity to be formally pleaded. I respectfully agree. (...)”

<sup>1657</sup> *Gerechtshof 's-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352, 361 – *Expandable Grafts Partnership II*.

<sup>1658</sup> Fawcett 2002, p. 159.

<sup>1659</sup> Fawcett 2002, p. 159.

<sup>1660</sup> Fawcett 2002, p. 155.

connection<sup>1661</sup> between the place of the harmful event (i.e. the place of the event giving rise to the damage respectively the place where the damage occurred) and the forum State. In light of this, it has rightly been doubted whether there is such a meaningful connection between the place of patent infringement and the State of registration.<sup>1662</sup>

Furthermore, patent disputes can also be negotiated before an arbitral tribunal. In light of this, it seems inconsistent to confer exclusive jurisdiction upon State courts.<sup>1663</sup> Admittedly, this argument is relativised by the fact that, in practice, infringement disputes do not go to arbitration.<sup>1664</sup>

After all, it is remarkable that, within the system of the Brussels Ibis Regulation, the European legislator has limited the number and extent of the categories of exclusive jurisdiction. According to Article 24(4) of the Brussels Ibis Regulation, exclusive jurisdiction has been reserved for instances where exclusive jurisdiction has been evaluated indispensable. It is therefore necessary to draw these instances narrowly. Moreover, it is noteworthy that none of the grounds of exclusive jurisdiction according to Article 24 of the Brussels Ibis Regulation encompass a claim in tort. In light of this, allocating exclusive jurisdiction for patent infringement disputes to the courts of the granting State would seem somewhat inconsistent.<sup>1665</sup>

### 3.2.3 Conclusion

To conclude, neither considerations concerning the “*Gleichlauf*” between jurisdiction and the applicable substantive law, sovereignty of the granting State, court or party interests, judicial economy, the attempt to find a mediate solution for the torpedo problem, nor any other aspects are apt to justify to confer exclusive jurisdiction to the courts of the protection State for patent infringement proceedings.

Without going into details at this point, it is to be underlined that the Heidelberg Report produced in view of a reform of the Brussels I Regulation does not advocate to alter the current system of the Brussels I Regulation in this respect, but is in favour of a narrow interpretation of Article 22(4) of the Brussels I Regulation. Similarly, both the European and the American reform projects – the CLIP Principles and the ALI Principles<sup>1666</sup> – do not advocate to allocate exclusive jurisdiction to the courts of the granting State with regard to patent infringement disputes. At least U.S. American jurisprudence partly agrees with this conception<sup>1667</sup>, while the opposite opinion must not be lost out of sight.<sup>1668</sup>

---

<sup>1661</sup> Noteworthy, the basic form of a meaningful connection is seen, under Article 4(1) of the Brussels Ibis Regulation, between the defendant's domicile and the courts at this place.

<sup>1662</sup> Fawcett 2002, pp. 155-156.

<sup>1663</sup> Fawcett 2002, p. 156.

<sup>1664</sup> Fawcett 2002, p. 156.

<sup>1665</sup> Similar, as to the question if exclusive jurisdiction for patent infringement disputes should be conferred to the courts of the granting State by way of an international convention: Fawcett 2002, p. 157.

<sup>1666</sup> Kur & Uberrazzi 2010, p. 108.

<sup>1667</sup> United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, dissenting opinion filed by Circuit Judge Newman, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

<sup>1668</sup> United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, majority opinion, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*.

In light of the foregoing explications, it is to be concluded that patent infringement proceedings should be and remain subject to the general rules of jurisdiction. Besides rejecting any attempts to extend exclusive jurisdiction of the courts of the granting State to infringement proceedings, this also means that approaches according to which the courts of the granting State should be given exclusive jurisdiction for validity and non-exclusive jurisdiction for infringement<sup>1669</sup>, or, conversely, pursuant to which the courts with jurisdiction over infringement should be conferred an additional jurisdiction over validity<sup>1670</sup>, should not be pursued, because they vary from those general rules of jurisdiction laid down in the Brussels Ibis Regulation. With regard to an eventual future Global Judgments Convention, there is no reason for a deviation from this approach.

### **3.3. Application and construction of rules of jurisdiction as to cross-border patent infringement disputes**

#### **3.3.1 Jurisdiction regarding torts**

##### **3.3.1.1 Extraterritorial jurisdiction according to Article 7(2) of the Brussels Ibis Regulation**

As analysed in the foregoing chapter, the Brussels Ibis Regulation does not contain an explicit rule, particularly relevant in a case of patent infringement, whether the place where the damage occurred or may occur according to Article 7(2) can be situated outside the State where the concerned patent is protected or whether jurisdiction based on Article 7(2) is only conferred to courts of that protection State. While the jurisprudence of the ECJ does not provide for a clear solution of this issue either, it has been shown that good reasons strike for a differentiation, on the one hand, between jurisdiction of courts at the place of the event giving rise to the damage and at the place where the damage occurred, and, on the other hand, between product patents and process patents insofar as the place of the event giving rise to the damage is concerned. It has been concluded that, according to the current legal situation, an extraterritorial place of the event giving rise to the damage in terms of Article 7(2) *can* exist with regard to European process patents. In contrast, regarding product patents, a place of the event giving rise to the damage according to Article 7(2) can only be situated in the protection State. The place where the damage occurred concerning patent infringement actions must necessarily be located within the protection State, meaning that extraterritorial jurisdiction according to Article 7(2) is *per se* impossible in that constellation.

This being so, one might wonder whether another solution would be desirable or at least manageable in light of a superior (global) jurisdiction policy. Besides, independently from the answer to this query, the question arises whether the text of Article 7(2) should be clarified in order to eliminate the existing uncertainty which has led to a multitude of legal conceptions both in legal doctrine and case-law rendered by the ECJ and the courts of the Member States. As to the idea of such a clear rule within the framework of Article 7(2), it will be necessary to decide whether respectively in which way particularities of patent rights justify and require such specific rules.

---

<sup>1669</sup> Cf. Fawcett 2002, pp. 159-160.

<sup>1670</sup> Cf. Fawcett 2002, pp. 162-164.

### 3.3.1.2 Existing reform proposals

In the following, several reform proposals shall be referred to which contain divergent solutions regarding international jurisdiction as to torts. In 2001, the Hague Conference on Private International Law presented a refined version of a Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters which represents a development of the Preliminary Draft Convention from 1999. However, the Draft Convention from 2001 has not entered into force either because the participants could not agree on its exact content. However, the Draft Convention is of interest anyway because it demonstrates an alternative how to solve the issue in discussion. Second, I shall turn to the ALI project which ended in the creation of the ALI Principles. Third, relevant passages of the European counter-part to the ALI Principles, the Principles on Conflict of Laws in Intellectual Property (CLIP Principles) established by the Max-Planck working group, shall be subject to closer analysis when considering how the issue of international jurisdiction as to torts could be solved. In addition, I shall treat the Heidelberg Proposal which was developed in view of the reform of the Brussels I Regulation, and finally take into consideration the Commission Proposal 2010 for a revised version of the Brussels I Regulation which finally resulted in the present Brussels Ibis Regulation.<sup>1671</sup>

#### 3.3.1.2.1 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001)

Article 10 of the Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters elaborated by the Hague Conference on Private International Law (2001) (hereinafter Draft Hague Convention) provides for the following rule in Article 10(1):

##### **Article 10 of the Draft Hague Convention**

A plaintiff may bring an action in tort in the courts of the State -

- a) in which the act or omission that caused injury occurred, or
- b) in which the injury arose, unless the defendant established that the person claimed to be responsible could not reasonably foresee that the act or omission could result in an injury of the same nature in that State.

Remarkably, in contrast to the constant jurisprudence of the ECJ since its *Mines de Potasse* decision as to the interpretation of Article 5(3) of the Brussels Convention (Article 7(2) of the Brussels Ibis Regulation), according to which the place where the harmful event occurred or may occur covers both the place of the event giving rise to the damage and the place where the damage occurred, Article 10(1) of the Draft Hague Convention generally confers jurisdiction as to torts only to the courts at the place of the event giving rise to the damage (cf. Article 10(1)a).<sup>1672</sup> The courts at the place where the damage occurred are only conferred

---

<sup>1671</sup> According to Article 81 2<sup>nd</sup> sentence of the Brussels Ibis Regulation, the Regulation has been applicable since 10 January 2015, with the exception of Articles 75 and 76, which have already been applicable since 10 January 2014.

<sup>1672</sup> It is to be noted that the Draft Hague Convention, the ALI Principles and the CLIP Principles only contain rules as to international jurisdiction, in contrast to Article 7(2) of the Brussels Ibis Regulation which also affects territorial jurisdiction. As a consequence, the expressions “place where the harmful event occurred”, “place of the event giving rise to the damage” and “place where the damage occurred” relevant in the framework of



jurisdiction under the condition that the defendant does not establish that the alleged infringer could not reasonably recognise in advance that the infringing act or omission could lead to a comparable infringement in the court State. According to its formulation, Article 10 of the Draft Hague Convention does not provide for a specific rule as to patents respectively intellectual property on the whole, but generally covers tortious actions. Footnote 66 of the Draft Hague Convention concedes in this respect:

“(...) However, it was noted that the paragraph would have to remain under consideration in light of e-commerce and intellectual property issues, its relation to activity jurisdiction proposals and constitutional issues in one State (...)”

However, a problem which arose during the working process on the Draft Hague Convention consisted in the question of whether patent infringement cases should be covered by Article 10 at all or whether Article 12 of the Draft Hague Convention on exclusive jurisdiction should apply. Indeed, the majority of the States participating in the project of the Draft Hague Convention advocated the application of Article 12(4), Alternative A<sup>1673</sup> of the Draft Hague Convention to the constellation of patent infringement. Article 12(4), Alternative A of the Draft Hague Convention provides:

**Article 12(4), Alternative A of the Draft Hague Convention**

In proceedings in which the relief sought is a judgment on the grant, registration, validity, abandonment, revocation or infringement of a patent or a mark, the courts of the Contracting State of grant or registration shall have exclusive jurisdiction.

Consequently, if Article 12(4), Alternative A of the Draft Hague Convention was applicable to the constellation of patent infringement, the general provision of Article 10 of the Draft Hague Convention would not apply according to the principle of *lex specialis*. Only a minority of the States which participated in the project of the Draft Hague Convention favoured a solution according to which the general rules of jurisdiction according to the Draft Hague Convention would be applicable in certain constellations. In this respect, Article 12(5A), Alternative B of the Draft Hague Convention has been formulated as follows:

**Article 12(5A), Alternative B of the Draft Hague Convention**

In relation to proceedings which have as their object the infringement of patents, trademarks, designs or other similar rights, the courts of the Contracting State referred to in the preceding paragraph [or in the provisions of Articles [3 to 16]] have jurisdiction.

Given that the provision of Article 12(5A), Alternative B of the Draft Hague Convention was rejected by most of the participating States of the Convention project, apparently no specific considerations have been made as to the question if Article 10 of the Draft Hague Convention

---

Article 7(2) of the Brussels Ibis Regulation, are not fully adequate in the framework of the Draft Hague Convention, the ALI Principles and the CLIP Principles. However, for reasons of clearness, readability and a better comparability with Article 7(2) of the Brussels Ibis Regulation, the cited expressions will be also used with regard to the addressed reform proposals, avoiding to replace the term “place” with the term “State”.

<sup>1673</sup> Article 12 of the Draft Hague Convention contains several alternative formulations. The participating States could not agree on one solution which explains why the Convention has not entered into force.

could confer, without any restrictions, jurisdiction to courts to decide on the infringement of patents which have been granted for another State than the forum State.

### 3.3.1.2.2 ALI Principles

The ALI Principles imply, in § 204, general rules as to tortious jurisdiction in the case of infringement of intellectual property rights. The general character of § 204 of the ALI Principles is emphasised by the Reporters' Comment a. (Infringement actions generally) according to which

“(t)his provision seeks to restate the traditional criteria for jurisdiction over claims for the tort of infringement (place from which the harmful conduct originated; place of impact of the injury), and to adapt the traditional criteria to the digital environment. It does so without having the tests propounded turn on technologically specific factors, such as the “interactivity” of a website. It applies to violations of any intellectual property right covered by these Principles, including moral rights and claims of secondary liability [underscore added].”

The text of § 204 of the ALI Principles reads as follows:

#### § 204 of the ALI Principles

(1) A person may be sued in any State in which that person has substantially acted, or taken substantial preparatory acts, to initiate or to further an alleged infringement. The court’s jurisdiction extends to claims respecting all injuries arising out of the conduct within the State that initiates or furthers the alleged infringement, wherever the injuries occur.

(2) A person may be sued in any State in which its activities give rise to an infringement claim, if it reasonably can be seen as having directed those activities to that State. The court’s jurisdiction extends to claims respecting injuries occurring in that State.

(3) A person who cannot be sued in a WTO-member State through the application of §§ 201-204(1) may be sued in any State in which its activities give rise to an infringement claim if:

- (a) it reasonably can be seen as having directed those activities to that State, and
- (b) it solicits or maintains contacts, business, or an audience in that State on a regular basis, whether or not such activity initiates or furthers the infringing activity.

The court’s jurisdiction extends to claims respecting injuries arising out of conduct outside the State that relates to the alleged infringement in the State, wherever the injuries occur.

Similarly, at first glance, to Article 10(1) of the Draft Hague Convention, § 204(1) of the ALI Principles primarily confers jurisdiction to the courts at the place of the event giving rise to the damage. However, a closer look on § 204(1) of the ALI Principles reveals that this provision actually differs from Article 10(1) of the Draft Hague Convention in a considerable way: § 204(1) of the ALI Principles not only covers “substantial” acts to initiate or to further an alleged infringement which includes, according to the Reporters' Comment b. (“Substantially acted”), maintaining a manufacturing or distribution centre for patent-infringing components, but also – contrary to the situation with regard to Article 10(1) of the Draft Hague Convention (and Article 7(2) of the Brussels Ibis Regulation) – mere substantial preparatory acts, to initiate or to further an alleged infringement.<sup>1674</sup> The formulation of

---

<sup>1674</sup> Cf. Dessemontet 2010, p. 36.

§ 204(1) of the ALI Principles enables without any problem the existence of an extraterritorial place of the event giving rise to the damage which is, in particular,<sup>1675</sup> explicitly confirmed by the Reporters' Comments a. (Infringement actions generally) and b. ("Substantially acted") as follows:

"Section 204(1) addresses the case in which the forum is a staging area for the nonresident defendant's activities. The provision creates authority to hear all claims arising out of these activities, without geographic limitation [underscore added]."<sup>1676</sup>

"Section 204(1) recognizes that an infringement may originate in a State other than the one in which the defendant resides or has its principal place of business (although such a State remains competent as well) [underscore added]."<sup>1677</sup>

Besides, § 204(2)1 of the ALI Principles provides for jurisdiction of the courts at the place where the damage occurred. However, it is to be noted that such jurisdiction only exists under the condition that the alleged infringer has directed his infringing activities to the forum State. Remarkably, in contrast to the situation of jurisdiction according to § 204(1) of the ALI Principles, the authority to decide of a court having jurisdiction according to § 204(2)1 of the ALI Principles is territorially limited to claims regarding infringements occurring in the forum State (cf. § 204(2)2 of the ALI Principles). In light of this, the existence of an extraterritorial place where the damage occurred – and thus extraterritorial jurisdiction on this basis – would be excluded.

### 3.3.1.2.3 Principles on Conflict of Laws in Intellectual Property (CLIP Principles)

Like the ALI Principles, the CLIP Principles as their European counter-part contain general rules on conflict of laws as to intellectual property. With regard to the infringement of intellectual property rights, the CLIP Principles provide for detailed rules in Article 2:202 (Infringement) and Article 2:203 (Extent of jurisdiction over infringement claims). The provisions read as follows:

#### **Article 2:202: Infringement**

In disputes concerned with infringement of an intellectual property right, a person may be sued in the courts of the State where the alleged infringement occurs or may occur, unless the alleged infringer has not acted in that State to initiate or further the infringement and her/his activity cannot reasonably be seen as having been directed to that State.

#### **Article 2:203: Extent of jurisdiction over infringement claims<sup>1678</sup>**

(1) Subject to paragraph 2, a court whose jurisdiction is based on Article 2:202 shall have jurisdiction in respect of infringements that occur or may occur within the territory of the State in which that court is situated.

---

<sup>1675</sup> Additionally cf. The American Law Institute 2008 (ALI Principles), § 204, Illustration 2. and Reporters' Notes 3. on § 204(1).

<sup>1676</sup> The American Law Institute 2008 (ALI Principles), § 204, Comment a. on § 204(1).

<sup>1677</sup> The American Law Institute 2008 (ALI Principles), § 204, Comment b. on § 204(1).

<sup>1678</sup> Noteworthy, the clear wording of Article 2:203 of the CLIP Principles already indicates that the provision complements Article 2:202 of the CLIP Principles, but does not determine the extent of jurisdiction under Article 2:206 of the CLIP Principles. In contrast, Article 2:203 of the CLIP Principles also limits jurisdiction based on Article 2:204, and, indirectly, jurisdiction according to Article 2:208 and Article 2:209 of the CLIP Principles, which relate to infringement claims.

(2) In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court whose jurisdiction is based on Article 2:202 shall also have jurisdiction in respect of infringements that occur or may occur within the territory of any other State, provided that the activities giving rise to the infringement have no substantial effect in the State, or any of the States, where the infringer is habitually resident and

(a) substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the State in which the court is situated, or

(b) the harm caused by the infringement in the State where the court is situated is substantial in relation to the infringement in its entirety.

At least at first glance, the CLIP Principles might be considered to pursue a completely different approach than the ALI Principles. In contrast to the ALI Principles which principally confer jurisdiction to the courts in the State where the alleged infringer has substantially *acted* (or taken substantial preparatory acts), Article 2:202 of the CLIP Principles confers jurisdiction to the courts of the State where the alleged *infringement occurs or may occur* (while the alleged infringer may prove<sup>1679</sup> that he has not acted in that State to initiate or further the infringement and<sup>1680</sup> his activity cannot be reasonably seen as having been directed to that State). However, the Commentary on the CLIP Principles underlines that Article 2:202 of the CLIP Principles does not only focus on the effects of an infringing activity, but is based on a uniform concept of “infringement” according to which, as to intellectual property matters unlike general tort law, it is not appropriate to distinguish between physical actions taken in one State, such as manufacturing of infringing goods, and their effects, such as distribution of those goods to the public in a foreign market.<sup>1681</sup> Moreover, the Commentary emphasises that jurisdiction according to Article 2:202 shall be regularly vested in the courts where the alleged infringer has substantially acted as well as in those where the effect accrues.<sup>1682</sup>

As already suggested, Article 2:202 of the CLIP Principles contains an “escape clause” (“unless...”) in order to avoid that jurisdiction is established in countries where the infringement only occurs accidentally, and has only minimal effect, a result which could be grossly disproportional to the kind and effect of the alleged infringement. Jurisdiction according to Article 2:202 thus does not exist if the defendant has not acted in the forum State in initiation or furtherance of the infringement, and if the activities causing the infringement cannot reasonably be considered as having been directed to that State.<sup>1683</sup>

According to Article 2:203(1) of the CLIP Principles, a court having jurisdiction with accordance to Article 2:202 of the CLIP Principles shall, in principle, have jurisdiction only regarding infringements that occur or may occur within the territory of the State in which the forum is situated. As a consequence, extraterritorial jurisdiction in torts would *a priori* be impossible.

Remarkably, taking into account infringement carried out through ubiquitous media such as the internet, Article 2:203(2) of the CLIP Principles provides for another solution in certain

---

<sup>1679</sup> The wording of Article 2:202 of the CLIP Principles indicates that the burden for establishing the relevant elements lies on the defendant contesting jurisdiction.

<sup>1680</sup> The elements contained in the “escape clause” must exist cumulatively. In case that one element is missing, the escape clause does not produce any effect, meaning that infringement jurisdiction according to Article 2:202 of the CLIP Principles is existent.

<sup>1681</sup> Kur 2013 (CLIP Principles), Article 2:202, para. 2:202.C04.

<sup>1682</sup> Kur 2013 (CLIP Principles), Article 2:202, para. 2:202.C04.

<sup>1683</sup> Kur 2013 (CLIP Principles), Article 2:202, para. 2:202.C13. As the “escape clause” gains particular importance with regard to multistate delicts, it shall be subject to further discussion in that framework.

circumstances: (1) If such infringement activities have no substantial effect in the State, or any of the States, where the infringer is habitually resident and substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the forum State or (2) if such infringement activities have no substantial effect in the State, or any of the States, where the infringer is habitually resident and the harm caused by the infringement in the forum State is substantial in relation to the infringement in its entirety, then the court having jurisdiction according to Article 2:202 shall also have jurisdiction as to infringements that occur or may occur within the territory of any other State. In the mentioned restricted circumstances, Article 2:203 of the CLIP Principles thus establishes the possibility of extraterritorial jurisdiction in torts.

### 3.3.1.2.4 The Heidelberg Report on the Application of Regulation Brussels I

In light of the foregoing explications in particular with regard to § 204 of the ALI Principles and Article 2:203 of the CLIP Principles which intend to adequately take into consideration the constellation of infringement of intellectual property rights, it is astonishing that the Heidelberg Report on the Application of the Brussels I Regulation does not contain any proposal as to an amendment of Article 5(3) of the Brussels I Regulation in order to clarify the described uncertainties. Although, regarding general principles as to jurisdiction according to Article 5(3) of the Brussels I Regulation developed by the ECJ (autonomous interpretation; principle of ubiquity; meaning of the term “damages”), the Report admits that

“(t)here are some references to aspects where national courts have to look for a further concretisation of these principles”,<sup>1684</sup>

it does not doubt, based on a survey,<sup>1685</sup> that

“(...) national courts can and actually do work on the above mentioned principles developed in the case law of the ECJ”.<sup>1686</sup>

Actually, the reporters clearly hold:

“Based on this survey, it seems fair to state that the principles for an interpretation of Article 5(3) JR as developed in the ECJ case law may, of course, need some further concretisation if applied in national practice. However, there is no indication that such concretisation raises insurmountable problems or that the results reached do not adequately serve the needs of legal practice. Especially in internet cases, the courts seem to be on their way to develop reliable criteria for a localisation of torts, e. g. by asking which country a certain website is directed to.”<sup>1687</sup>

While the Report at least recognises that

“(w)hereas the above mentioned general aspects do not raise any fundamental problems, the situation is, to some extent, more complicated as far as multi-State cases are concerned”<sup>1688</sup>

the Report still concludes that

“(...) the reporters see no sufficient basis for recommending any amendments of Article 5(3) JR.”<sup>1689</sup>

---

<sup>1684</sup> Pfeiffer 2008 (Heidelberg Report), para. 194.

<sup>1685</sup> Pfeiffer 2008 (Heidelberg Report), paras. 195-198.

<sup>1686</sup> Pfeiffer 2008 (Heidelberg Report), para. 194.

<sup>1687</sup> Pfeiffer 2008 (Heidelberg Report), para. 199.

<sup>1688</sup> Pfeiffer 2008 (Heidelberg Report), para. 200.

The Heidelberg Report thus obviously does not recognise the jurisdictional problems detected and discussed above which arise in the tension between Article 5(3) of the Brussels I Regulation and intellectual property rights as such, respectively does not recognise any need for an adequate solution of these problems by way of an amendment of Article 5(3) of the Brussels I Regulation. This is confirmed by the fact that Chapter D. VII. 6. of the Heidelberg Report<sup>1690</sup> which explicitly delivers concluding recommendations concerning intellectual property rights, does not imply any recommendation as to Article 5(3) of the Brussels I Regulation.

### 3.3.1.2.5 The Commission Proposal 2010 for Reform of the Brussels I Regulation

The Commission Proposal 2010 provides in its Article 5(2) (which thematically corresponds to Article 5(3) of the Brussels I Regulation):

#### Article 5 of the Commission Proposal 2010

The following courts shall have jurisdiction:

(...)

(2) in matters relating to tort, delict or quasi-delict, the courts for the place where the harmful event occurred or may occur.

It is remarkable that Article 5(2) of the Commission Proposal 2010 is characterised by the approach of the European Commission to extend the jurisdiction rules of the Brussels I Regulation to defendants domiciled in a third State.<sup>1691</sup> For the Commission's intent was to generally extend the possibilities of companies and citizens to sue such third State defendants in the European Union because the special rules of jurisdiction would become available in these cases.<sup>1692</sup> In this respect, the Commission underlined its view that access to justice in the European Union was overall unsatisfactory in disputes involving defendants from outside the EU, jurisdiction then being covered by national law, while the Brussels I Regulation principally applied where the defendant is domiciled inside the EU. Further, the Commission stressed that the diversity of national law lead to unequal access to justice for EU companies in transactions with partners from third States because some could easily litigate in the EU, while others could not, even in situations where no other court guaranteeing a fair trial had jurisdiction.<sup>1693</sup> Besides, it was stressed that the application of the jurisdiction rules of the Brussels I Regulation to defendants domiciled in third States eliminates – in favour of EU defendants and third State defendants – existing legal uncertainties and injustice resulting from the co-existence of different sets of jurisdiction rules (the Brussels I Regulation and provisions of national law).<sup>1694</sup> Last but not least, the argument was put forth that a *universalisation*<sup>1695</sup> of grounds of jurisdiction by constructing the jurisdiction rules of the

---

<sup>1689</sup> Pfeiffer 2008 (Heidelberg Report), para. 204.

<sup>1690</sup> Schlosser 2008 (Heidelberg Report), para. 692.

<sup>1691</sup> Domej (2014)78 *RabelsZ* 508, at p. 521; with regard to the competence of the European Union for an extension of the jurisdiction rules of the Brussels I Regulation to third State defendants cf. Weber (2011)75 *RabelsZ* 619, at p. 622 et seq.

<sup>1692</sup> European Commission 2010 (Commission Proposal 2010), p. 8.

<sup>1693</sup> European Commission 2010 (Commission Proposal 2010), p. 3.

<sup>1694</sup> Bach (2011)44(4) *ZRP* 97, at p. 100.

<sup>1695</sup> Weller (2012)9(6) *GPR* 328, at p. 329.

Brussels I Regulation as *lois unificomes*<sup>1696</sup> would be consistent in light of parallel constructions of the Rome I Regulation<sup>1697</sup> and the Rome II Regulation<sup>1698</sup>. Others have evaluated the Commission's approach as going too far<sup>1699</sup>, and the Commission Proposal 2010 has even provoked fierce opposition by parts of legal doctrine.<sup>1700</sup>

In light of this approach, Article 4(2) of the Commission Proposal 2010 underlines:

**Article 4 of the Commission Proposal 2010**

(...)

(2) Persons not domiciled in any of the Member States may be sued in the courts of a Member State only by virtue of the rules set out in Sections 2 to 8 of this Chapter.

Accordingly, the wording structure of Article 5 of the Commission Proposal 2010 is different from Article 5 of the Brussels I Regulation insofar as Article 5 of the Commission Proposal 2010 does not begin with the phrase “a person domiciled in a Member State” (the following text of the paragraphs being adapted accordingly). However, like the Heidelberg Report, Article 5(2) of the Commission Proposal 2010 does not deliver any clarification let alone solution with regard to the uncertainties existing under the Brussels Convention/Brussels I Regulation in the context with the infringement of intellectual property rights which have been described and analysed above by reference to the Brussels Ibis Regulation.

Obviously, the Commission's approach to extend the jurisdiction rules of the Brussels I Regulation to defendants domiciled in a third State has not been implemented within the Brussels Ibis Regulation.<sup>1701</sup> That final change is based on the insight that jurisdiction rules are defined in a context of mutual trust between the EU Member States. While reciprocity between the Member States is ensured because the Regulation is directly applicable in the European Union, such trust and reciprocity does not exist vis-à-vis third States of which most apply discriminatory rules towards defendants located in the EU. Thus, realising the Commission's approach to widely grant special protection to defendants coming from third

---

<sup>1696</sup> Cf. Bach (2011)44(4) ZRP 97.

<sup>1697</sup> Regulation (EC) No 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I), OJ L177 of 4 July 2008, pp. 6-16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32008R0593&from=en>> (lastly accessed on 1 June 2015). Article 2 (Universal application) of this Regulation provides: “Any law specified by this Regulation shall be applied whether or not it is the law of a Member State.”

<sup>1698</sup> Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), OJ L199 of 31 July 2007, pp. 40-49, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32007R0864&from=EN>> (lastly accessed on 1 June 2015). Article 3 (Universal application) of this Regulation provides: “Any law specified by this Regulation shall be applied whether or not it is the law of a Member State.”

<sup>1699</sup> For instance: Mansel, Thorn & Wagner (2013)33(1) IPRax 1, at p. 8.

<sup>1700</sup> For instance, Briggs clearly expressed his disaffirmation towards the Commission's approach: “It cannot be said that the total effect will be to widen or narrow jurisdiction over such [third State] defendants; but it can be said that the unbending [i.e. unmoderated by any element of judicial discretion (cf. Briggs *ibid.*)] application of rules, which were designed for defendants with a European home, to defendants defined by the fact that they do not, is irrational.” (cf. Briggs (2011)2 L.M.C.L.Q. 157, at p. 160).

<sup>1701</sup> Noteworthy, Article 79 of the Brussels Ibis Regulation provides that the Commission, by 11 January 2022, shall represent a report on the application of this Regulation, and that that report shall include an evaluation of the possible need for a further extension of the rules on jurisdiction to defendants not domiciled in a Member State, taking into account the operation of this Regulation and possible developments at international level. Where appropriate, the report shall be accompanied by a proposal for amendment of this Regulation.

States would have meant to unilaterally favour such third State defendants, while defendants located in the EU would not necessarily enjoy such protection from third States.<sup>1702</sup>

Article 5(2) of the Commission Proposal 2010 does not clarify let alone solve the uncertainties in the context with the infringement of intellectual property rights described and analysed above which already existed under the Brussels I Regulation and are still existing under the Brussels Ibis Regulation.

### 3.3.1.3 Clarification through an amendment of Article 7(2)

In light of the current legal uncertainty and disagreement in legal doctrine and jurisprudence with regard to the issue of the existence or non-existence of an extraterritorial place of the event where the harmful event occurred in terms of Article 7(2) – i.e. the place of the event giving rise to the damage and the place where the damage occurred – the question however arises whether the text of Article 7(2) should be amended to deliver a definitive solution to this issue.

It has been shown in the foregoing chapter that the principle of territoriality, a principle of substantive law, has neither a direct nor an indirect effect on the issue of jurisdiction according to Article 7(2). Further, it has been reasoned that general considerations and principles militate for the result that Article 7(2) *de lege lata* establishes the *possibility* of an extraterritorial place of the event giving rise to the damage with regard to European process patents, while militating both against the possibility of an extraterritorial place of the event giving rise to the damage regarding product patents and, generally, against the existence of an extraterritorial place where the damage occurred, notwithstanding if product patents or process patents are concerned.

It is due to this reference to general ideas – the *ratio legis* of jurisdiction regarding torts – that it seems preferable not to create a totally separate tortious rule for the constellation of infringement of a patent, but, inasmuch as possible, to submit this constellation to Article 7(2). However, as both legal theory and, even more, legal practice have shown, it seems desirable and manageable to supplement Article 7(2) in terms of a clarification with regard to the infringement of intellectual property rights.<sup>1703</sup> As it is not sure that the ECJ and the European legislator would follow the “subtle differentiation” between product patents and process patents in this respect<sup>1704</sup> – although this differentiation is justified as has been reasoned above – it would seem more realistic and realisable in practical respect to treat product patents and process patents in an equal way. On this basis, it seems most convincing to fully deny the existence of an extraterritorial place of the event giving rise to the damage, because, at least as to product patents, extraterritorial jurisdiction is not justified. As illustrated above, the infringing acts of bringing into circulation, using, offering, importing and possessing such products for those purposes constitute acts of patent infringement that are independent from the manufacture of the concerned object.<sup>1705</sup> The pure fact of manufacture

---

<sup>1702</sup> Cadet (2013)24(6) EuZW 218, at p. 219.

<sup>1703</sup> Contrary to this conception, others have denied the necessity of such a clarification of Article 5(3) because, as proponents of such a perspective have suggested, the ECJ would probably not support the idea of an extraterritorial place where the harmful event occurred according to Article 5(3) (cf. Schauwecker 2009, pp. 405, 407). However, in the absence of a clarifying decision of the ECJ on this issue, an amendment of Article 5(3) seems strongly desirable unless necessary in order to create and ensure legal certainty.

<sup>1704</sup> This fear has been expressed by *Heinze*, cf. *Heinze* (2007)56(7) GRUR Int. 634, at p. 636 (“*feinsinnige Differenzierung*”).

<sup>1705</sup> Reichardt 2006, p. 130 et seq.



of a product does not establish such a particularly close connection that would be necessary to consider an extraterritorial place of manufacture as a place of the event giving rise to the damage in the sense of Article 7(2) concerning a patent infringement in the protection State.<sup>1706</sup>

In light of the foregoing considerations according to which the place of the event giving rise to the damage, with regard to the infringement of a patent, is to be considered necessarily situated in the forum State, this place would necessarily be identical with the place where the damage occurred which can only be located in the State where the patent is protected. For this reason, the need for a differentiation between “place of the event giving rise to the damage” and “place where the damage occurred” would fall away with regard to cross-border patent infringements.

A clarification of Article 7(2) which takes into account the foregoing criteria could be realised by way of adding the following sentence within Article 7(2):

*“As to the infringement of a patent, the harmful event solely occurs or may occur in the State where the patent is protected.”*

### 3.3.1.4 Extraterritorial jurisdiction according to a future Global Judgments Convention

In view of an envisaged Global Judgments Convention, it is to be borne in mind that a compromise between somewhat diverging conceptions would have to be found. On the one hand, the United States, besides Europe the most important potential Contracting State, favours a conception which is influenced by the constitutional *due process* principle and emphasises the aspects of *direction* of the acting and the existence of factual points of contact to the forum (*minimum contacts* doctrine). As has been shown above, § 204 of the ALI Principles clearly emphasises, in first line, the significance of the State of substantial acting respectively even taking substantial preparatory acts. Such a conception would seem hardly reconcilable with a wide provision such as Article 7(2). On the other hand, the CLIP Proposal in its final version also takes into account, in Article 2:202 of the CLIP Principles, the *direction* of the alleged infringer's activity, but insofar refers to the State where the alleged infringement occurred and, in contrast to § 204 of the ALI Principles, constructs the direction to that State as an *exceptio* to be raised by the alleged infringer.<sup>1707</sup>

When thinking about the concrete shape of a potential compromise, it is to be underlined that the majority of the States participating in the project of the Draft Hague Convention advocated a solution according to which the courts of the Contracting State where, respectively for whose territory a patent has been granted would have exclusive jurisdiction as to patent infringement proceedings.<sup>1708</sup> In light of this, and because § 204 of the ALI Principles – in particular due to the fact that even substantial preparatory acts shall be sufficient to found jurisdiction – would probably lead to legal uncertainty,<sup>1709</sup> it would seem desirable and also manageable to adopt Article 2:202 of the CLIP Principles, which clarifies that the place where the harmful event occurred can only be situated in the protection State.

---

<sup>1706</sup> Reichardt 2006, p. 131.

<sup>1707</sup> Kur (2012)61(10) GRUR Int. 857, at p. 860. However, this allegedly insuperable difference is attenuated by the fact that Article 2:202 of the CLIP Principles is based on the premise that the notion of “acting” as opposed to “directing activities to” shall be understood broadly according to the Commentary on the CLIP Principles.

<sup>1708</sup> Cf. Article 12(4), Alternative A of the Draft Hague Convention.

<sup>1709</sup> Schauwecker 2009, p. 407.

Additionally, similarly to the proposed amendment of Article 7(2), Article 2:202 of the CLIP Principles should be completed by the following sentence:

*“As to the infringement of a patent, the infringement solely occurs or may occur in the State where the patent is protected.”*

### 3.3.1.5 Particular problem: Tortious jurisdiction regarding multistate delicts

#### 3.3.1.5.1 Localisation of the places where the harmful event occurred

As has been discussed in the foregoing chapter, multistate delicts, i.e. cases where parallel patents granted in different States are (potentially) infringed through the *same* act by one (alleged) infringer, raise the question of whether, respectively in how far invoked courts at the place where the harmful event occurred which therefore have jurisdiction according to Article 7(2) are also authorised to decide on the infringement of such parallel (national respectively European) patents. One might argue that a restriction of the authority to decide at the level of jurisdiction is not justified, and that a restriction at the level of private international law respectively substantive law would be preferable in schematic respect. Furthermore, the latter approach would bring along the advantage that a judgment on the merits – other than a judgment on the admissibility relevant in terms of jurisdiction – would be rendered, which would prevent another court to decide on the same infringement which would consequently avoid conflicting decisions.<sup>1710</sup> However, the latter opinion presupposes that the legal system of the invoked court actually undertakes such a restriction at the level of private international law respectively substantive law. If it does not, the situation could arise that no restriction at all would be respected, potentially leading to the result that the invoked court could decide on any parallel infringements without any need of a link to the forum State, a result which cannot seriously be intended by anyone.<sup>1711</sup> Besides, there is the realistic danger that, if jurisdiction was widely allocated to the invoked courts, this would go along with the presumption of the alleged infringement, meaning that the levels of recognition and enforcement would be the only possible correcting factors.<sup>1712</sup> That result could only be avoided by not only unifying rules on jurisdiction, but simultaneously rules on private international law. While the Hague Convention project only established rules on jurisdiction, the ALI Principles as well as the CLIP Principles actually comprise both rules on jurisdiction and private international law. In this respect, it is also to be borne in mind that other legal systems do not undertake a clear differentiation between rules of jurisdiction on the one hand and the applicable law on the other hand. For instance, U.S. American courts extensively undertake the examination of substantive law in the framework of jurisdiction when analysing if there are sufficient *mimum contacts* between the case and the invoked court.<sup>1713</sup>

Generally, it must be borne in mind that tortious jurisdiction is to be considered as an exception to the general rule that jurisdiction is conferred to the courts at the place of domicile of the defendant, and must therefore be interpreted in a restrictive way, in order to avoid establishing a jurisdiction of choice of the *plaintiff* at his domicile. Furthermore, as has already been explicated in the foregoing chapter, there would not be a particularly close

---

<sup>1710</sup> Bettinger & Thum (1999)48(8-9) GRUR Int. 659, at p. 664 et seq.; also: Fezer & Koos 2010 (Staudinger), para. 1139.

<sup>1711</sup> Schauwecker 2009, p. 409.

<sup>1712</sup> Schauwecker 2009, p. 409.

<sup>1713</sup> Kur (2000)46(9) WRP 935, at p. 936.

connection between the alleged infringement and the forum – and thus no sufficient proximity to facts and evidence – in case that the court had jurisdiction to decide on any parallel infringement concerning foreign patent rights.

In practical regard, it is to be taken into account that the United States would presumably only accept a rule on jurisdiction regarding torts which requires a particular direction of the acting to the forum State, due to the *due process* principle and the *minimum contacts* doctrine addressed above.<sup>1714</sup> It is for this reason that § 204(2)1 of the ALI Principles provides:

“A person may be sued in any State in which its activities give rise to an infringement claim, if it reasonably can be seen as having directed those activities to that State.”

It has already been pointed out that Article 2:202 of the CLIP Principles, although constructed differently, also recognises, by way of an “escape clause”, the significance of the direction of an activity to a State regarding the issue of jurisdiction, when conceding the alleged infringer the possibility to argue, against jurisdiction of the courts at the State where the alleged infringement occurs or may occur, that

“(…) (he) has not acted in that State to initiate or further the infringement and her/his activity cannot reasonably be seen as having been directed to that State.”

As mentioned earlier, the Commentary on the CLIP Principles starts from the idea of a uniform concept of “infringement” for intellectual property matters.<sup>1715</sup> Consequently, the distinction made in the “escape clause” between the defendant “acting in”, or “directing activities to” the forum State, which is similar to that between “act” and “effect” used in tort law, is said to have no relevance for intellectual property claims in general, because the sole decisive aspect of determining jurisdiction lies in the question of whether there is an infringement – by way of an activity or by way of the effect of such an activity.<sup>1716</sup> This being so, the Commentary on the CLIP Principles points out that the distinction undertaken in the “escape clause” gains however significance insofar as it allows jurisdiction to be restricted in certain cases of “overspill”. Restrictions of that kind may be called for in case that an alleged infringer has no or only limited control over the territorial impact of the allegedly harmful activity, so that the effects of the initiating act are “dispersed” over different countries (a constellation which is known as “*Streudelikt*” in German law). Not exclusively, but typically, this is the case with regard to the divulgation of infringing content through analogue mass media like journals, newspapers and broadcasting, and digital mass media like the internet.<sup>1717</sup> Given the “escape clause”, according to the Commentary on the CLIP Principles, is merely meant to offer relief in the case of uncontrollable “dispersed effects”, i.e. as an exception to the rule,<sup>1718</sup> the notion of “acting” as opposed to “directing activities to” shall be understood

---

<sup>1714</sup> Cf. Borchers (2003)50 N.I.L.R. 401, at pp. 402-404; cf. Freer 2007, pp. 1-3.

<sup>1715</sup> Kur 2013 (CLIP Principles), Article 2:202, para. 2:202.C04.

<sup>1716</sup> Kur 2013 (CLIP Principles), Article 2:202, para. 2:202.C14.

<sup>1717</sup> Kur 2013 (CLIP Principles), Article 2:202, paras. 2:202.C14, 2:202.C17 and 2:202.N06.

<sup>1718</sup> It is noteworthy that a previous version of Article 2:202 of the CLIP Principles set forth that an infringement would only be held to occur in a State where the allegedly infringed right existed if (a) the defendant substantially acted there, or if (b) the activity by which the right was claimed to be infringed had substantial effect in, or was directed to, that State. This rule however provoked criticism because it appeared to be tailored to accidental “overspills” being characteristic of media-related infringements, whereas it did not provide an equitable result in cases in which the alleged infringement is caused by the dissemination of physical articles. It was argued that, in particular with regard to patent infringement cases, it is no exception that the proprietor is merely able to trace one single, or a few, infringing items on the market, although the dimensions of the infringement are much larger in reality, and that it would therefore be inappropriate to deny jurisdiction in such cases. Meeting this criticism, the wording of Article 2:202 was changed by deleting the “substantiality” criterion

in a broad sense. Therefore, if physical items are found in commerce that are claimed to infringe a right existing in the forum State, it shall regularly be assumed that the defendant has “acted” there, without the requirement of a certain level or number of such infringing items, meaning that jurisdiction shall be denied only if the defendant establishes that he has nothing to do with their proliferation.<sup>1719</sup> Besides, as to transit cases, where goods allegedly infringing intellectual property rights are transported though the territory of the forum State without being destined for importation, the Commentary on the CLIP Principles suggests that jurisdiction should be denied if it is clear enough that no infringement will be found under substantive law. Additionally, apart from the situation under substantive law, it has been pointed out that the wording of Article 2:202 of the CLIP Principles leaves some discretion for judges to deny jurisdiction under exceptional circumstances. In this regard, a court may deny jurisdiction based on the argument that the connecting factors are insufficient, if the transit routes could not be controlled or anticipated in detail by the alleged infringer, and if the effect remains minimal.<sup>1720</sup>

As a consequence, taking into account the findings with regard to § 204(2)1 of the ALI Principles and Article 2:202 of the CLIP Principles, tortious jurisdiction should be merely conferred on courts of States to which the alleged infringing activity has actually been directed. As to the question *in which way* the direction should be taken into consideration, the above explications as to Article 2:202 of the CLIP Principles contain valuable ideas which should be picked up.

### 3.3.1.5.2 Territorial scope of the authority to decide

It has been shown above that the current regime of Article 7(2) establishes the *possibility* that a court at the place of manufacture is also authorised to decide on the infringement of parallel patents granted in respectively for the territory of another State than the forum State in the case of European process patents. In contrast, such an extended authority to decide as to the infringement of parallel patents is to be denied regarding product patents and generally in cases of jurisdiction on the basis of the place where the damage occurred.

Both the ALI Principles and the CLIP Principles contain rules according to which the authority to decide is extended. As to the ALI Principles, § 204(1)2 generally – i.e. without any limitation to specific constellations – provides for a comprehensive authority to decide of the invoked court at the place where the alleged infringer has substantially acted, or taken substantial preparatory acts (place of the event giving rise to the damage):

#### § 204(1) of the ALI Principles

(1) A person may be sued in any State in which that person has substantially acted, or taken substantial preparatory acts, to initiate or to further an alleged infringement. The court’s jurisdiction extends to claims respecting all injuries arising out of the conduct within the State that initiates or furthers the alleged infringement, wherever the injuries occur.<sup>1721</sup>

---

concerning activities taken by the alleged infringer in the forum State, and by reversing the burden of pleading. It was thus made clear that jurisdiction of courts in a State where an infringement is found to occur can only be contested under exceptional circumstances (cf. Kur 2013 (CLIP Principles), Article 2:202, paras. 2:202.N14 and 2:202.N15 with further references).

<sup>1719</sup> Kur 2013 (CLIP Principles), Article 2:202, para. 2:202.C15.

<sup>1720</sup> Kur 2013 (CLIP Principles), Article 2:202, para. 2:202.C20.

<sup>1721</sup> Cf. also The American Law Institute 2008 (ALI Principles), § 204, Comment a. on § 204(1).

In contrast, the authority to decide of courts in the State where the damage occurred according to § 204(2)1 of the ALI Principles is territorially limited to claims regarding infringements occurring in the forum State (cf. § 204(2)2 of the ALI Principles):

#### **§ 204(2) of the ALI Principles**

(2) A person may be sued in any State in which its activities give rise to an infringement claim, if it reasonably can be seen as having directed those activities to that State. The court's jurisdiction extends to claims respecting injuries occurring in that State.

However, courts in the State where the damage occurred are conferred comprehensive authority to decide<sup>1722</sup> as well if the infringer cannot be sued in a WTO-member State for the total damage (cf. § 204(3) of the ALI Principles):

#### **§ 204(3) of the ALI Principles**

(3) A person who cannot be sued in a WTO-member State through the application of §§ 201-204(1) may be sued in any State in which its activities give rise to an infringement claim if:

- (c) it reasonably can be seen as having directed those activities to that State, and
- (d) it solicits or maintains contacts, business, or an audience in that State on a regular basis, whether or not such activity initiates or furthers the infringing activity.

The court's jurisdiction extends to claims respecting injuries arising out of conduct outside the State that relates to the alleged infringement in the State, wherever the injuries occur.

§ 204(3) of the ALI Principles thus furnishes the plaintiff who would otherwise have no fair forum in which to assert worldwide claims other places where it may be able to sue.<sup>1723</sup>

Interestingly, the approach chosen in § 204 of the ALI Principles, making a general differentiation between the scope of authority to decide at the place of the event giving rise to the damage on the one hand, and, on the other hand, at the place where the damage occurred, resembles, respectively corresponds to the jurisprudence of the ECJ in its *Shevill* decision.

In comparison with the ALI Principles, the CLIP Proposal provides, in some way, for a comprehensive authority to decide, which is however considerably more restricted than comprehensive authority to decide according to § 204 of the ALI Principles. In general, a court having jurisdiction with accordance to Article 2:202 of the CLIP Principles shall have jurisdiction only regarding infringements that occur or may occur within the territory of the State in which the forum is situated (cf. Article 2:203(1) of the CLIP Principles). Otherwise, general jurisdiction should prevail, meaning that claims concerning infringements occurring in other States should only be brought before the courts of general jurisdiction.<sup>1724</sup> Alternatively, such claims must be brought separately before the courts in those other

---

<sup>1722</sup> Dessemontet 2010, p. 36

<sup>1723</sup> The American Law Institute 2008 (ALI Principles), § 204, Comment d. on § 204(3).

<sup>1724</sup> Article 2:101 of the CLIP Principles provides, with regard to general jurisdiction, that subject to the CLIP Principles, a person may be sued in the courts of any State in which the person is habitually resident (Article 2:601).

States.<sup>1725</sup> It has rightly been emphasised that it is indeed one of the very objectives of Article 2:203 of the CLIP Principles to ensure that cross-border claims are not raised too easily in the forum of the plaintiff who already benefits from the strategic advantage of the first mover. While it might be argued that a grant of extraterritorial jurisdiction to the courts in the State from which the impugned activities originate is the most efficient way to stop the infringement in its entirety, it is to be stressed that there is always the possibility to bring such claims in the courts of general jurisdiction. In general, there is no pertinent reason why the plaintiff should be granted an additional choice in that regard.<sup>1726</sup> This corresponds to the principle of balance between the interests of all parties involved (as also emphasised in the Preamble).<sup>1727</sup> While the Commentary on the CLIP Principles acknowledges that it would have been an alternative solution to allow consolidation of judgments at the place from which the infringement in its entirety emanated (such as the State of manufacture of the infringing product), the Commentary clearly states that this potential solution has not been chosen for several reasons. First of all, it has rightly been underlined that, where it is not doubtful whether the prerequisites exist for assuming that the source of the infringement in its entirety can actually be located in that State, the place where the infringement in its entirety emanated will, in the majority of cases, be identical with the forum of general jurisdiction, in particular because the definition of habitual residence according to Article 2:101 of the CLIP Principles is rather broad.<sup>1728</sup> Besides, it is indeed questionable whether the fact that the defendant has set a cause in the forum State for the infringement which happened abroad does provide a sufficient nexus with the infringement in its entirety, given that the underlying reasons for establishing infringement jurisdiction outside the *forum rei* are the easy access to factual evidence and the fact that the courts will regularly be in a position to apply their own law, and both aspects are lacking in the constellation in question: The fact that a product is manufactured in one State is no evidence for an infringement occurring in other States, and, with regard to the infringements occurring abroad, the court will have to apply foreign law.<sup>1729</sup>

The foregoing explications applying in general, Article 2:203(2) of the CLIP Principles provides for a modified rule regarding disputes concerned with infringement carried out through ubiquitous media such as the internet, in order to adapt the addressed aspect of balance between the interests of all parties involved to that particular constellation. According to Article 2:203(2), a comprehensive authority of the court to decide shall exist in constellations of infringements through ubiquitous media such as the internet, given that the (allegedly) infringing acting has no substantial effect in the State(s) where the (alleged) infringer is domiciled, and that there is a sufficiently close connection between the infringement and the State where the court is situated:

**Article 2:203: Extent of jurisdiction over infringement claims**

(1) Subject to paragraph 2, a court whose jurisdiction is based on Article 2:202 shall have jurisdiction in respect of infringements that occur or may occur within the territory of the State in which that court is situated.

(2) In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court whose jurisdiction is based on Article 2:202 shall also have jurisdiction in respect of infringements that occur or may occur within the territory of any other State, provided that the activities

<sup>1725</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C03.

<sup>1726</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C08.

<sup>1727</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C06.

<sup>1728</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C07.

<sup>1729</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C07.

giving rise to the infringement have no substantial effect in the State, or any of the States, where the infringer is habitually resident and

(a) substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the State in which the court is situated, or

(b) the harm caused by the infringement in the State where the court is situated is substantial in relation to the infringement in its entirety.

The risk of widespread infringement being highly pertinent in such cases of infringement carried out through ubiquitous media such as the internet, the efficient enforcement of claims may be seriously hampered, for instance in case that the infringer does not have any production sites or a sizeable business establishment of any permanence where his habitual residence can be located. Moreover, whatever is needed for carrying out the infringement (in particular the server) can be swiftly moved, and can be set up without much difficulty in States that either do not provide for an adequate level of legal protection, or where the law remains on paper only and is not enforced in practice (“infringers’ havens”).<sup>1730</sup>

While it would have been possible to establish a provision according to which relief is granted in cases of infringement carried out through ubiquitous media by conferring jurisdiction on the courts at the place where the injured party has its habitual residence or its centre of interests,<sup>1731</sup> Article 2:203(2) of the CLIP Principles pursues a different approach in order to provide for a solution that adequately meets the requirements of intellectual property rights.

In this respect, the Commentary on the CLIP Principles distinctively points out that it would be inappropriate in the context of intellectual property litigation to grant extraterritorial jurisdiction to such courts: First, intellectual property cases regularly do not involve an element of personal harm or injury<sup>1732</sup>, and, second, in contrast to the typical situation in defamation cases and similar lawsuits with a private party claiming remedies from a media company, the relative strength of the parties involved in intellectual property disputes is usually equal on both sides, because the victim of the alleged patent infringement normally is a company or other commercial actor for which it does not *per se* constitute an unacceptable burden to litigate abroad in order to be able to claim extraterritorial relief.<sup>1733</sup> Besides, it must be borne in mind that the injured party's centre of interests will regularly be identical with the plaintiff's forum, which in the context of international jurisdiction is regarded as an exorbitant venue – another reason for the CLIP Principles to reject the solution to confer, with regard to cases concerning the infringement of intellectual property rights, jurisdiction on the courts at the place where the injured party has its habitual residence or its centre of interests.<sup>1734</sup>

Article 2:203(2) of the CLIP Principles rather pursues the approach to extend the jurisdiction according to Article 2:202 of the CLIP Principles, i.e. jurisdiction of the courts of the State where the alleged infringement occurs or may occur, under certain circumstances in order to

---

<sup>1730</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C09.

<sup>1731</sup> The ECJ adopted that solution with regard to the infringement of personality rights in its *eDate Advertising and Martinez* decision, cf. ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, *eDate Advertising GmbH v X (C-509/09)* and *Oliver Martinez and Robert Martinez v MGN Limited (C-161/10)*, [2011] ECR I-10269, para. 48 – *eDate Advertising and Martinez*.

<sup>1732</sup> Admittedly, this is different with regard to the extremely rare cases when the moral right of an author is concerned.

<sup>1733</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C10.

<sup>1734</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C10.

avoid an abusive conduct of the alleged infringer.<sup>1735</sup> In this respect, three qualifications must be fulfilled for such an extension of jurisdiction. First, Article 2:203(2) of the CLIP Principles solely applies in case of an infringement carried out through ubiquitous media such as the internet. Second, the impugned activities must not have substantial effect in the State or States, where the infringer is habitually resident. According to the Commentary on the CLIP Principles, this requirement is meant to address the core of what can typically be characterised as abuse: If the alleged infringer does not direct his business to the market in the State where he has taken up residence, this could be based on his attempt to evade an efficient pursuit of justice or to evade taxation.<sup>1736</sup> Third, even in case that an alternative forum can principally be established, the venue chosen by the plaintiff must conform to the positive requirement that it must be established that either substantial activities in furtherance of the infringement have been carried out in the forum State, or that the harm accruing in that State is substantial in relation to the infringement in its territory. This requirement has been added to ensure that the alternative forum has not been chosen arbitrarily.<sup>1737</sup>

Against Article 2:203(2) of the CLIP Proposal, more precisely against the possibility of extension of jurisdiction according to Article 2:202 of the CLIP Principles under certain conditions, it could be argued that, on the basis of the above proposal regarding an amendment of Article 7(2) according to which “as to the infringement of a patent, the harmful event solely occurs or may occur in the State where the patent is protected”, a central extraterritorial place of acting would *per se* lack a particularly close connection to facts and evidence with regard to a patent infringement which occurs in another State, and that this would apply both concerning singlestate delicts and multistate delicts.<sup>1738</sup> In this light, one might doubt both the necessity and justification of a provision according to which a court is conferred, under *whatever* conditions, jurisdiction with regard to infringements occurring within the territory of another State.

Besides, it has partly been doubted whether, in case that the central activity is undertaken in a State where the right is protected and infringed, courts should be conferred a comprehensive authority to decide. In this respect, it has been underlined that the infringer could easily manipulate jurisdiction by not directing his activity to this State and producing a noticeable effect in this State, or even by localising the central place of activity where no patent protection exists.<sup>1739</sup>

Furthermore, one might raise the question why, in the case of patent infringement actions – in contrast to other civil and commercial actions regarding torts – such a comprehensive authority to decide should be given to the courts.<sup>1740</sup> In this regard, it has been underlined that in most cases, the central place of acting will be identical with the place where the infringer is domiciled, and where courts already have comprehensive jurisdiction, without reference to Article 7(2) of the Brussels Ibis Regulation being necessary. Alternatively, comprehensive jurisdiction will exist according to Article 7(5) of the Brussels Ibis Regulation.<sup>1741</sup>

---

<sup>1735</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C11.

<sup>1736</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C12.

<sup>1737</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C12.

<sup>1738</sup> Schauwecker 2009, p. 412.

<sup>1739</sup> Schauwecker 2009, p. 412.

<sup>1740</sup> Schauwecker 2009, p. 412.

<sup>1741</sup> Schauwecker 2009, p. 412.



After all, it has been pointed out that Article 7(2) of the Brussels Ibis Regulation does not pursue the goal to consolidate several actions,<sup>1742</sup> in contrast to provisions such as Article 8(1) of the Brussels Ibis Regulation which clearly express this objective.<sup>1743</sup>

However, it is to be emphasised that the aggrieved party at least cannot be expected to sue the alleged infringer before the courts in the State of the alleged infringer's domicile, if the latter intendedly has resiled to a State where he aimed to escape from efficient litigation.<sup>1744</sup> In light of this, a provision such as Article 2:203(2) of the CLIP Principles is necessary to adequately take into consideration the interest of the allegedly aggrieved party. At the same time, thus achieving a balance between the interests of all parties involved,<sup>1745</sup> the interests of the alleged infringer are adequately respected, too, because Article 2:203(2) of the CLIP Principles confers such extended jurisdiction only in a limited number and only under well-defined circumstances (infringement carried out through ubiquitous media and existence of the infringer's domicile and substantial infringing activities in the forum State (a); infringement carried out through ubiquitous media and existence of the infringer's domicile and proportionally substantial harm in the forum State (b)). By these sophisticated criteria and relatively strict prerequisites<sup>1746</sup>, it should be manageable to prevent procedural abuse of the provision which could inadequately disadvantage one party. Actually, the solution laid down in Article 2:203(2) of the CLIP Principles takes into account the fundamental *actor sequitur forum rei* principle, which is codified in Article 4(1), in a considerably more distinctive way than the ECJ did in its *eDate Advertising and Martinez* decision. In this decision, the ECJ, by reference to *Shevill*<sup>1747</sup>, confirmed that

“(...) the plaintiff always has the option of bringing his entire claim before the courts either of the defendant's domicile or of the place where the publisher of the defamatory publication is established (Shevill and Others, paragraph 32)”<sup>1748</sup>

and thus formally strengthened the significance of jurisdiction of courts situated at the defendant's domicile. However, as this place and the place where the publisher of the defamatory publication is established, i.e. the place where the publication has been undertaken, will usually be identical, it has rightly been concluded that the factual extension of Article 4(1) of the Brussels Ibis Regulation which goes along with this jurisprudence gains only limited practical relevance.<sup>1749</sup> On the contrary, the ECJ further relativised the importance of the defendant's domicile as a place of jurisdiction when stating that

“(i)t (...) appears that the internet reduces the usefulness of the criterion relating to distribution, in so far as the scope of the distribution of content placed online is in principle universal. Moreover, it is not always possible, on a technical level, to quantify that distribution with certainty and accuracy in relation

<sup>1742</sup> Additionally, it is to be emphasised that consolidation of proceedings is also possible, according to Article 2:101 of the CLIP Principles, before the courts of general jurisdiction, i.e. in the State where the defendant is habitually resident (Article 2:601 of the CLIP Principles).

<sup>1743</sup> Schauwecker 2009, p. 412.

<sup>1744</sup> Kur (2012)61(10) GRUR Int. 857, at p. 860.

<sup>1745</sup> The Preamble of the CLIP Principles explicitly states, *inter alia*, that these Principles “recognise the need to consider and balance all interests involved, including the interests of owners of intellectual property rights, their contracting partners and other users of intellectual property, and the broader public interest, in particular in access to, and use of, information as well as other public interests”.

<sup>1746</sup> Kur (2012)61(10) GRUR Int. 857, at p. 860; Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C13.

<sup>1747</sup> ECJ 7 March 1995, C-68/93, Fiona Shevill and Others v Presse Alliance SA, [1995] ECR I-00415, para. 32 – *Shevill*.

<sup>1748</sup> ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, eDate Advertising GmbH v X (C-509/09) and Oliver Martinez and Robert Martinez v MGN Limited (C-161/10), [2011] ECR I-10269, para. 43 – *eDate Advertising and Martinez*.

<sup>1749</sup> Kur (2012)61(10) GRUR Int. 857, at p. 860.

to a particular Member State or, therefore, to assess the damage caused exclusively within that Member State.”<sup>1750</sup>

On this basis, the ECJ held that

“(…) given that the impact which material placed online is liable to have on an individual's personality rights might best be assessed by the court of the place where the alleged victim has his centre of interests, the attribution of jurisdiction to that court corresponds to the objective of the sound administration of justice (…).

The place where a person has his centre of interests corresponds in general to his habitual residence (…).”<sup>1751</sup>

The ECJ thus accepted a place of jurisdiction at the plaintiff's domicile.<sup>1752</sup> This is particularly problematic in view of Article 76(1)(a) of the Brussels Ibis Regulation<sup>1753</sup> in conjunction with Articles 5(2) and 6(2) of the Brussels Ibis Regulation which exclude the domicile of the plaintiff as an element which establishes jurisdiction. However, the ECJ itself – following the Advocate General<sup>1754</sup> – held in its later *Wintersteiger* decision that the extension of jurisdiction in favour of the place of the plaintiff's domicile (and for this reason problematic in view of Article 4(1)) shall not be relevant with regard to intellectual property rights:

“(…) (A)s the Advocate General pointed out (…), that assessment, made in the particular context of infringements of personality rights, does not apply also to the determination of jurisdiction in respect of intellectual property rights (…)

[underscore added].”<sup>1755</sup>

Besides, it is to be stressed in particular that, in contrast to the situation with regard to personality rights, intellectual property rights such as patents generally concern economic conflicts between enterprises and other commercial actors.<sup>1756</sup> In this respect, there is principally no particular need for protection in favour of one party which might justify to set aside basic principles of the division of procedural risks.<sup>1757</sup> Moreover, the principle of predictability which is in particular referred to by the ECJ regarding the infringement of

---

<sup>1750</sup> ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, *eDate Advertising GmbH v X* (C-509/09) and *Oliver Martinez and Robert Martinez v MGN Limited* (C-161/10), [2011] ECR I-10269, para. 46 – *eDate Advertising and Martinez*.

<sup>1751</sup> ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, *eDate Advertising GmbH v X* (C-509/09) and *Oliver Martinez and Robert Martinez v MGN Limited* (C-161/10), [2011] ECR I-10269, paras. 48-49 – *eDate Advertising and Martinez*.

<sup>1752</sup> Other authors have expressed an even more distinctive criticism. *Kur*, for instance, concludes that the jurisprudence of the ECJ in *eDate Advertising and Martinez* even results in a reversion of the basic rule of Article 2(1) of the Brussels I Regulation (Article 4(1) of the Brussels Ibis Regulation), cf. *Kur* (2012)61(10) GRUR Int. 857, at p. 860.

<sup>1753</sup> Cf. Annex I of the Brussels I Regulation.

<sup>1754</sup> *Advocate General Cruz Villalón* explicated: “The approach in *Shevill* and *eDate Advertising* is not applicable to the case at issue. Both those judgments concern infringements of personality rights, which differ significantly from intellectual property rights which are protected on a territorial basis and are concerned with the commercial exploitation of a product. Therefore, the connecting criteria laid down in Article 5(3) [of the Brussels I Regulation] cannot be applied without distinction to situations of the kind in the aforementioned cases and the one in this case and instead the interpretation of the article must be adapted to the particular characteristics of intellectual property law”, cf. *Advocate General* 16 February 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 20, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CC0523&rid=3>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>1755</sup> ECJ 19 April 2012, C-523/10, *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, para. 24, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> (lastly accessed on 1 June 2015) – *Wintersteiger*.

<sup>1756</sup> *Kur* 2013 (CLIP Principles), Article 2:203, para. 2:203.C10.

<sup>1757</sup> *Kur* (2012)61(10) GRUR Int. 857, at p. 861.

personality rights, cannot serve as an argument in favour of establishing jurisdiction at the place of the plaintiff's domicile, because the place of domicile of the alleged infringer is equally predicable.<sup>1758</sup>

While it might be true that Article 2:203(2) of the CLIP Principles, while principally balancing the interests of all parties involved, has, as an undesirable side-effect, a tendency to privilege such plaintiffs who are resident in large and economically strong States and who will frequently be in a position to show that substantial harm was caused on the domestic market, a fact that might give them an advantage over plaintiffs who reside in countries where the size of market, and accordingly the harm produced, is regularly smaller,<sup>1759</sup> it should be taken into consideration that this effect is necessarily immanent in any solution attributing a certain relevance to the size of the market impact produced by the infringement in its entirety.<sup>1760</sup> After all, the basic adequacy of the solution chosen in Article 2:203(2) of the CLIP Principles cannot be put into question by the latter counterargument.<sup>1761</sup>

As to the argument of opponents of a rule such as Article 2:203(2) of the CLIP Principles, that the infringement of patents through ubiquitous media such as the internet merely concerns few particular cases,<sup>1762</sup> and that therefore no complex provision should be established for those cases,<sup>1763</sup> it is to be stated that this argument is not convincing. First of all, in view of a constant evolution of information technology, such cases of patent infringement through ubiquitous media such as the internet will probably gain more and more importance. Second, even if patent infringement through ubiquitous media represented only the minority of patent infringement cases, this does not *a priori* strike against the creation of a rule how to treat such cases.

When applied to the Brussels Ibis Regulation, it seems preferable to employ the wording of the Regulation and therefore replace the notion “habitually resident” with “domiciled” (cf. underscores) which, in practice, should not lead to different results. So, in addition to the amendment already proposed above, Article 7(2) should be supplemented by the following sentences according to the content of Article 2:203 of the CLIP Principles:

“(…) A court shall have jurisdiction in respect of infringements that occur or may occur within the territory of the State in which that court is situated. In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court shall also have jurisdiction in respect of infringements that occur or may occur within the territory of any other State, provided that the activities giving rise to the infringement have no substantial effect in the State, or any of the States, where the infringer is domiciled and

(a) substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the State in which the court is situated, or

(b) the harm caused by the infringement in the State where the court is situated is substantial in relation to the infringement in its entirety.”

A future Global Judgments Convention should contain a similar provision.

---

<sup>1758</sup> Kur (2012)61(10) GRUR Int. 857, at p. 861.

<sup>1759</sup> This eventual argument is also acknowledged, but rightly relativised by the Commentary on the CLIP Principles, cf. Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C10.

<sup>1760</sup> Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C13.

<sup>1761</sup> Clearly: Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C13.

<sup>1762</sup> The fact that the possibility (respectively the necessity) for the plaintiff to rely on the exceptional rule of Article 2:203(2) of the CLIP Principles, will only occur in rare cases due to the wide notion of general jurisdiction according to Article 2:101 of the CLIP Principles, is also admitted by the creators of the CLIP Principles, cf. Kur 2013 (CLIP Principles), Article 2:203, para. 2:203.C13.

<sup>1763</sup> Schauwecker 2009, p. 412.

### 3.3.1.6 Final comment and formulation proposal

To conclude and summarise, Article 7(2) should be formulated as follows:

#### Article 7(2)

A person domiciled in a Member State may, in another Member State, be sued:

(...)

(2) in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur. *As to the infringement of a patent, the harmful event solely occurs or may occur in the State where the patent is protected.* A court shall have jurisdiction in respect of infringements that occur or may occur within the territory of the State in which that court is situated. In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court shall also have jurisdiction in respect of infringements that occur or may occur within the territory of any other State, provided that the activities giving rise to the infringement have no substantial effect in the State, or any of the States, where the infringer is domiciled and

(a) substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the State in which the court is situated, or

(b) the harm caused by the infringement in the State where the court is situated is substantial in relation to the infringement in its entirety.

A future Global Judgments Convention should be considerably oriented towards Articles 2:202 (also supplemented by another sentence, written in italics) and 2:203 of the CLIP Principles. It would remain to be decided whether the wording “habitually resident” (cf. CLIP Principles) or “domiciled” (cf. Brussels Ibis Regulation) would be chosen. The provisions could be formulated as follows:

#### Article 2:202: Infringement

In disputes concerned with infringement of an intellectual property right, a person may be sued in the courts of the State where the alleged infringement occurs or may occur, unless the alleged infringer has not acted in that State to initiate or further the infringement and her/his activity cannot reasonably be seen as having been directed to that State. *As to the infringement of a patent, the infringement solely occurs or may occur in the State where the patent is protected.*

#### Article 2:203: Extent of jurisdiction over infringement claims

(1) Subject to paragraph 2, a court whose jurisdiction is based on Article 2:202 shall have jurisdiction in respect of infringements that occur or may occur within the territory of the State in which that court is situated.

(2) In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court whose jurisdiction is based on Article 2:202 shall also have jurisdiction in respect of infringements that occur or may occur within the territory of any other State, provided that the activities giving rise to the infringement have no substantial effect in the State, or any of the States, where the infringer is habitually resident [domiciled] and

(a) substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the State in which the court is situated, or

(b) the harm caused by the infringement in the State where the court is situated is substantial in relation to the infringement in its entirety.

### **3.3.2 Extension of jurisdiction at the place of domicile of one of several (alleged) infringers due to close connection of the claims**

#### **3.3.2.1 Identifying the crucial issue**

As it has been discussed above, the ECJ adopted a narrow interpretation of Article 6(1) of the Brussels Convention (Article 8(1) of the Brussels Ibis Regulation) in its *Roche Nederland* decision and ruled that this provision would not be applicable with respect to the infringement of parallel European patents in/for different Member States by different potential infringers, even where all potential infringers were part of the same group and acted pursuant to a groupwide policy formulated by one member of the group. The ECJ expressly denied the existence of a close connection between such infringement actions. Besides, it has been mentioned that the ECJ held in its *Solvay* decision, with regard to the constellation of infringement, by several companies from different Member States being sued before a court of one of those Member States, of the same national part of a European patent which is in force in yet another Member State, that Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) is applicable, which may be interpreted as an attenuation of the quite restrictive interpretation chosen in *Roche Nederland*.

Although it has been shown in the foregoing chapter that the restrictive interpretation taken by the ECJ in *Roche Nederland* as to the infringement of parallel European patents was not inevitable, i.e. another interpretation would have been possible *de lege scripta*,<sup>1764</sup> it must be recognised as a matter of fact, since the ECJ delivered its decision in *Roche Nederland* in this restrictive way, that an amendment of Article 8(1) (respectively its predecessors) as generally covering parallel patent infringement actions would require a reformulation of Article 8(1).<sup>1765</sup> Therefore the crucial question which shall be dealt with in the following paragraphs is the following: How should an amended version of Article 8(1) be constructed?

In particular, such a provision should make clear without any doubt in which circumstances infringement actions concerning the alleged infringement of different parts of a European patent (i.e. parallel European patents) are sufficiently closely connected so that the courts at the place of domicile of one infringer also have jurisdiction with regard to the other action(s) which concern patents granted within respectively for the territory of other States, where the patents are being infringed by different infringers. To put it in a nutshell, the criterion of the risk of irreconcilable judgments which is addressed in Article 8(1) should be formed more precisely, because it is exactly the fact that this criterion can currently be interpreted in various ways what produces legal uncertainty (respectively eventual misinterpretations which has become obvious in *Roche Nederland*).

---

<sup>1764</sup> In particular, the *spider-in-the-web* theory has been illustrated in Chapter 2 of this thesis.

<sup>1765</sup> As to Article 6(1) of the Brussels Convention/Brussels I Regulation: Schauwecker 2009, p. 378. In this respect, it is significant that Article 8(1) of the Brussels Ibis Regulation has *not* been formulated in a way that would make clear that the jurisprudence of the ECJ in *Roche Nederland* shall be abandoned. It may therefore be assumed that the European legislator accepted the interpretation of Article 6(1) of the Brussels Convention and did not favour another interpretation. Otherwise it would have been possible to formulate Article 8(1) of the Brussels Ibis Regulation in a different, respectively clarifying way.

Likewise, a future Global Judgments Convention should contain a similar provision which clearly covers parallel patent infringement actions. The clearer the formulation of such rules will be, the smaller will be the risk that inconsistent court decisions, eventually originating from different legal backgrounds and traditions, will ultimately thwart the clarifying effect of such a rule.

### **3.3.2.2 Existing reform proposals**

#### **3.3.2.2.1 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001)**

Originally, the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (1999) contained, in Article 14, a general provision which resembled to a certain extent Article 8(1) of the Brussels Ibis Regulation and did not imply specific rules with regard to intellectual property:

“(1) A plaintiff bringing an action against a defendant in a court of the State in which that defendant is habitually resident may also proceed in that court against other defendants not habitually resident in that State if

(a) the claims against the defendants habitually resident in that State and the other defendants are so closely connected that they should be adjudicated together to avoid the risk of inconsistent judgments (...).”

However, Article 14 was deleted in the Draft Hague Convention on the Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001). The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) thus does not help when searching for, respectively developing a clarifying rule as to the question raised above.

#### **3.3.2.2.2 ALI Principles**

Contrary to Article 14 of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (1999), § 206 (Personal Jurisdiction over Multiple Defendants) of the ALI Principles contains rules particularly dealing with intellectual property rights. § 206 reads:

“(1) A plaintiff bringing an action against a person in a State in which that person is resident may also proceed in that State against one or more nonresident defendants if the claims against the resident defendant and such other defendants are so closely connected that they should be adjudicated together to avoid a risk of inconsistent judgments, and if:

(a) there is a substantial, direct, and foreseeable connection between the forum's intellectual property rights at issue and each nonresident defendant; or  
(b) as between the forum and the States in which the added defendants are resident, there is no forum that is more closely related to the entire dispute.

(2) There is a risk of inconsistent judgments if it appears that the ensuing judgments:

(a) would impose redundant liability;

(b) would conflict in that the judgment in one case would undermine the judgment in another case;  
or

(c) would conflict in that a party would not be able to conform its behavior to both judgments.

(3) Subsection (1) does not apply to any defendant invoking an exclusive choice-of-court agreement with the plaintiff that conforms with § 202.

(4) If an action is brought in a State on the basis of this Section, then that court has jurisdiction with respect to injuries, wherever occurring, that arise out of the activities that allegedly create the risk of inconsistent judgments.”

Remarkably, the beginning of the text of § 206(1) of the ALI Principles is constructed very similarly to Article 8(1) of the Brussels Ibis Regulation, in that § 206(1) of the ALI Principles aims to avoid the risk of *inconsistent* judgments, and the purpose of Article 8(1) of the Brussels Ibis Regulation is to avoid the risk of *irreconcilable* judgments, which should be considered a rather linguistic subtlety which does not necessitate another legal consideration.

Nonetheless, in contrast to Article 8(1) of the Brussels Ibis Regulation, § 206(1) additionally implies, in (a) and (b), two requirements which must be fulfilled alternatively for a consolidation of proceedings against multiple defendants. While § 206(1)(a) concerns singlestate-delicts, i.e. the infringement of one or more intellectual property rights in one State by multiple infringers (defendants), § 206(1)(b) covers the constellation of multistate delicts where multiple infringers commit infringements of intellectual property rights in several States. Otherwise, § 206(1)(b) would lack an own scope of application besides § 206(1)(a).<sup>1766</sup> In the context of this work, it is thus § 206(1)(b) which is of particular interest.

Due to the both open and negative formulation of § 206(1)(b) of the ALI Principles which refers to the *inexistence* of another forum being more closely connected to the entire dispute than the forum in question, the provision covers diverse constellations. According to the Comments and Reporters' Notes on § 206 of the ALI Principles, § 206(1)(b) is, on the one hand, applicable to the so-called “*hub and spoke*” respectively “*spider in the web*” situation where multiple defendants agree among themselves to commit acts having infringing effects around the world, and are thus involved in conjoined activity. On the other hand, § 206(1)(b) of the ALI Principles covers instances where a patent holder is faced with parallel infringing activities where no particular actor is dominant and therefore no particular territory can be identified as the “hub” of the activity.<sup>1767</sup>

With accordance to the above addressed need for a clarification in which circumstances there is a risk of irreconcilable (inconsistent) judgments, § 206(2) of the ALI Principles contains an enumeration of three situations. While this attempt of a definition is to be welcomed at first glance, a second sight on § 206(2) of the ALI Principles reveals that exactly the constellation of interest here – the parallel infringement of European patents – is not covered by § 206(2) of the ALI Principles<sup>1768</sup> which shall be illustrated by the following sample cases:

---

<sup>1766</sup> Schauwecker 2009, p. 380.

<sup>1767</sup> The American Law Institute 2008 (ALI Principles), § 206, Comment d. (2) on § 206(1)(b) and Reporters' Notes 1. and 4. on § 206(1)(b).

<sup>1768</sup> Contradictorily, the Reporters' Notes still refer to the Roche Nederland decision of the ECJ when discussing jurisdiction available under similar circumstances in European law, cf. The American Law Institute 2008 (ALI Principles), § 206, Reporters' Notes 5. on § 206.

### Case 1:

P is the holder of parallel European patents on a certain machine for Germany and the Netherlands. Infringer 1 (INF 1), a German company, infringes the German part of the patent and Infringer 2 (INF 2), a Dutch company, commits an infringement of the Dutch part. INF 1 and INF 2 are part of the same group and act pursuant to a groupwide policy formulated by INF 2, the head of the group.

### Case 2:

P is the holder of parallel European patents on a certain machine for Germany and the Netherlands. Infringer 1 (INF 1), a German company, infringes the German part of the patent and Infringer 2 (INF 2), a Dutch company, commits an infringement of the Dutch part. Although INF 1 and INF 2 are part of the same group, they do not act on the basis of a groupwide policy, but independently from each other.

According to § 206(2)(a) of the ALI Principles, there is a risk of inconsistent judgments if it appears that the ensuing judgments would impose redundant liability. According to the Reporters' Notes on § 206 of the ALI Principles, the purpose of that rule is to convey unjustified cumulative liability, sometimes called “multiple liability” or “overlapping liability”.<sup>1769</sup> In Case 1, there is no risk of such redundant liability because INF 1 is liable only for the infringement of the German part of the patent, while the liability of INF 2 merely concerns the infringement of the Dutch part of the patent. As the issue of whether INF 1 and INF 2 are part of the same group and act on the basis of a groupwide policy, is not relevant in this respect, the same result applies to Case 2.

Further, there would be a risk of inconsistent judgments if the ensuing judgments conflicted in that the judgment in one case would undermine the judgment in another case (§ 206(2)(b) of the ALI Principles). Since, both concerning Case 1 and Case 2, the judgments against INF 1 and INF 2 deal with different infringements – as to INF 1 the infringement of the German part of the patent, and regarding INF 2 the infringement of the Dutch part of the patent – there is *a priori* no danger that the judgments could undermine each other. Besides, the Reporters' Notes suggest that § 206(2)(b) of the ALI Principles only applies to *singlestate* infringements<sup>1770</sup> when explicating:

“In the United States, principles of nonmutual issue preclusion and privity are often used to protect litigants from a second suit that undermines the resolution of an earlier dispute (...).”<sup>1771</sup>

Last but not least there would be a risk of inconsistent judgments if the ensuing judgments conflicted in that a party would not be able to conform its behaviour to both judgments (§ 206(2)(c) of the ALI Principles). According to the wording (“both judgments”), § 206(2)(c) of the ALI Principles presupposes that at least one of the concerned defendants is faced with two judgments. In this respect it is not clear in which way this provision is applicable in the sample cases, because INF 1 and INF 2 are merely faced with one action each. As a consequence, it is logically impossible that the ensuing judgments (against INF 1 and INF 2) conflict in that INF 1 or INF 2 would not be able to conform their behaviour to both judgments. Although this interpretation has rightly been characterised as “most contradictory”

---

<sup>1769</sup> The American Law Institute 2008 (ALI Principles), § 206, Reporters' Notes 2. (i) on § 206.

<sup>1770</sup> Schauwecker 2009, p. 381.

<sup>1771</sup> The American Law Institute 2008 (ALI Principles), § 206, Reporters' Notes 2. (ii) on § 206.



(“äußerst widersprüchlich”)<sup>1772</sup>, in particular because the Comments and the Reporters' Notes on § 206 of the ALI Principles explicitly refer to the constellation of parallel patent infringement proceedings and the *Roche Nederland* decision of the ECJ, the clear wording of § 206(2) of the ALI Principles does not allow another interpretation. As a consequence, it must be stated that, although it is to be appreciated that § 206 of the ALI Principles attempts to clarify the central issue in which circumstances there is a risk of irreconcilable (inconsistent) judgments, the chosen wording does not cover the constellation of the infringement of parallel patents through several infringers. Therefore, this approach should be rejected.

### 3.3.2.2.3 Principles on Conflict of Laws in Intellectual Property (CLIP Principles)

Like the ALI Principles, the CLIP Principles, in Article 2:206, provide for a specific rule on joint proceedings against multiple defendants. Similarly to § 206 of the ALI Principles (and Article 8(1) of the Brussels Ibis Regulation), Article 2:206 of the CLIP Principles refers to a particularly close connection between multiple claims against a number of defendants and the avoidance of the risk of “inconsistent”<sup>1773</sup> judgments as decisive criteria for the possibility of the extension of jurisdiction at the place of domicile of one of several (alleged) infringers to claims against other infringers.

Article 2:206 (Multiple defendants) of the CLIP Principles provides:

#### Article 2:206: Multiple defendants

(1) A person who is one of a number of defendants may also be sued in the courts of the State where any of the defendants is habitually resident, provided the claims are so closely connected that it is appropriate to hear and determine them together to avoid the risk of incompatible judgments resulting from separate proceedings.

(2) For the purposes of paragraph 1, a risk of incompatible judgments requires a risk of divergence in the outcome of the actions against the different defendants which arises in the context of essentially the same situation of law and fact. In particular in infringement disputes and subject to the individual circumstances of the case,

(a) disputes involve essentially the same factual situation if the defendants have, even if in different States, acted in an identical or similar manner in accordance with a common policy;

(b) disputes may involve essentially the same legal situation even if different national laws are applicable to the claims against the different defendants, provided that the relevant national laws are harmonised to a significant degree by rules of a regional economic integration organisation or by international conventions which are applicable to the disputes in question.

(3) If it is manifest from the facts that one defendant has coordinated the relevant activities or is otherwise most closely connected with the dispute in its entirety, jurisdiction according to paragraph 1 is only conferred on the courts in the State where that defendant is habitually resident. In other cases,

---

<sup>1772</sup> Schauwecker 2009, p. 381.

<sup>1773</sup> The change of terminology vis-à-vis Article 6(1) of the Brussels I Regulation (“incompatible judgments” instead of “irreconcilable judgments”) was chosen in order to avoid uncertainty and confusion about the meaning of “irreconcilable” as used in Article 6(1) of the Brussels I Regulation and Article 4:501(3) and (4) (Other grounds for non-recognition of foreign judgments) of the CLIP Principles. The term “irreconcilable judgments” used in Article 4:501(3) and (4) of the CLIP Principles is narrower than the notion of “incompatible judgments” used in Article 2:206(1) and (2) of the CLIP Principles, because Article 4:501 of the CLIP Principles refers only to judgments between the same parties; cf. Heinze 2013 (CLIP Principles), Article 2:206, paras. 2:206.C02, 2:206.C04.

jurisdiction is conferred on the courts in the State or States of habitual residence of any of the defendants, unless

(a) the contribution of the defendant who is habitually resident in the State where the court is located is insubstantial in relation to the dispute in its entirety or

(b) the claim against the resident defendant is manifestly inadmissible.

### 3.3.2.2.3.1 Avoidance of the risk of incompatible judgments

Similarly to § 206(2) of the ALI Principles, Article 2:206 of the CLIP Principles undertakes the approach to give an answer to the key question in which circumstances there is a risk of incompatible judgments which would be the prerequisite for the consolidation of proceedings against multiple defendants. According to Article 2:206(2)1 of the CLIP Principles, such a consolidation is only possible if a risk of divergence in the outcome of the actions against different defendants exists. This already implies that a joint hearing would help to save time or cost or otherwise foster judicial economy.<sup>1774</sup> Additionally, Article 2:206(2)1 of the CLIP Principles requires that the divergence in outcome must arise “in the context of essentially the same situation of law and fact.” The latter formulation has been chosen in reaction to the restrictive jurisprudence of the ECJ in *Roche Nederland*, where the ECJ, following *Advocate General Léger*, held:

“As the Advocate General observed, in point 113 of his Opinion, in order that decisions may be regarded as contradictory it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact [underscore added].”<sup>1775</sup>

Besides, the formulation chosen in Article 2:206(2)1 of the CLIP Principles adequately takes into consideration the *Painer* decision of the ECJ where the court, deviating from its restrictive jurisprudence in *Roche Nederland* without mentioning this decision,<sup>1776</sup> conceded by reference to its *Freeport* decision that

“(…) in assessing whether there is a connection between different claims, that is to say a risk of irreconcilable judgments if those claims were determined separately, the identical legal bases of the actions brought is only one relevant factor among others. It is not an indispensable requirement for the application of Article 6(1) of Regulation No. 44/2001 (...) [underscore added].”<sup>1777</sup>

It is in light of this jurisprudence of the ECJ in *Painer* which is clearly more liberal than the court's attitude expressed in *Roche Nederland* that it is to be considered that Article 2:206(2)2 of the CLIP Principles further contains, in (a) and (b), certain *guidelines* as to the interpretation of the chosen wording “essentially the same situation of law and fact”. In this regard, the official Commentary on the CLIP Principles emphasises the fact that, as the terms “in particular” and “subject to the individual circumstances of the case” suggest, Article 2:206(2)2(a) and (b) of the CLIP Principles does not deliver an exhaustive definition of the same factual and legal situation.<sup>1778</sup> Moreover, general principles of international jurisdiction, in particular the fundamental requirement of foreseeability of jurisdiction for any non-resident

<sup>1774</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C06.

<sup>1775</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 26 – *Roche Nederland*.

<sup>1776</sup> Kur (2012)61(10) GRUR Int. 857, at p. 861.

<sup>1777</sup> ECJ 1 December 2011, C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, [2011] ECR I-12533, para. 80 – *Painer*.

<sup>1778</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C07.

co-defendants who are joined to the action (which has again been underlined by the ECJ in *Painer*)<sup>1779</sup>, must be taken into consideration.<sup>1780</sup> This approach is completely in line with the jurisprudence of the ECJ in *Painer* where the ECJ stated:

“It is (...) for the referring court to assess, in the light of all the elements of the case, whether there is a connection between the different claims brought before it, that is to say a risk of irreconcilable judgments if those claims were determined separately [underscore added].”<sup>1781</sup>

### 3.3.2.3.2 The same factual situation

With regard to the requirement of the same factual situation, the ECJ held in *Roche Nederland* that

“(...) in the case of European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States, the existence of the same situation of fact cannot be inferred, since the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same.”<sup>1782</sup>

It is noteworthy that the court admitted in *Roche Nederland* by way of *obiter dictum* that concerning

“(...) defendant companies, which belong to the same group (and) have acted in an identical or similar manner in accordance with a common policy elaborated by one of them, (...) the factual situation would be the same.”<sup>1783</sup>

Taking into account this jurisprudence, Article 2:206(2)2(a) of the CLIP Principles provides that “essentially the same factual situation” shall be existent if the defendants have acted in an identical or similar manner, be it in the same State or in different States, and in accordance with a common policy.

The prerequisite of identical or at least similar behaviour is based on the fact that, in case of different behaviour, it will be doubtful whether infringement can be ascertained. While the co-defendants may undertake different acts, the infringement must be “identical or similar” in that it concerns *the same use of the invention* which is protected by the same or parallel patent right. In contrast, in case of a different use of an invention, a consolidation of actions will not be justified because already minor differences may mean that the behaviour of one of the co-defendants is non-infringing.<sup>1784</sup> Besides, in case of a different use of an invention, a consolidation of actions would not be foreseeable for the co-defendant who would be sued at the other defendant's place of domicile, which would disregard fundamental principles of procedural law. It is this need for legal certainty and predictability as to the jurisdiction of the courts which is the reason for the additional requirement stated in Article 2:206(2)2(a) of the CLIP Principles that the defendants must have acted in accordance with a common policy. If, otherwise, jurisdiction could be founded on mere parallel but unconcerted behaviour, a co-

<sup>1779</sup> ECJ 1 December 2011, C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, [2011] ECR I-12533, paras. 75, 81 – *Painer*.

<sup>1780</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C07.

<sup>1781</sup> ECJ 1 December 2011, C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, [2011] ECR I-12533, para. 83 – *Painer*.

<sup>1782</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 27 – *Roche Nederland*.

<sup>1783</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 34 – *Roche Nederland*.

<sup>1784</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C09 with further references.

defendant could be sued in the courts of another State where someone else, eventually by coincidence, may have committed the same act of infringement.<sup>1785</sup> The criterion of foreseeability must be fulfilled for each non-resident co-defendant, meaning that each of them must have known of the behaviour of the resident co-defendant and was in some way linked to his activities.<sup>1786</sup> While it could be put forth that it will be difficult or almost impossible for the plaintiff to prove the existence of such a common policy in order to assert jurisdiction,<sup>1787</sup> this objection might be alleviated by a presumption of a common policy in certain defined scenarios, such as corporate groups, joint infringement or an integrated chain of infringers (cf. below).<sup>1788</sup> In contrast to the ECJ who refers, in *Roche Nederland*, to a common policy elaborated by one of the co-defendants, the CLIP Principles pursue a less restricted approach: According to Article 2:206(2)2(a) of the CLIP Principles, it shall not be necessary that the common policy must have been elaborated by one of the co-defendants. In fact, there is no reason why constellations of parallel infringements committed according to a common policy should be excluded for the sole reason that no single directing entity has imposed such common policy, but rather all participants have consensually agreed to act in this way.<sup>1789</sup>

### 3.3.2.2.3.2.1 Corporate groups

Even according to the restrictive interpretation of Article 8(1) of the Brussels Ibis Regulation chosen by the ECJ in its *Roche Nederland* decision, the constellation of corporate groups where a parent company and its subsidiaries have in different countries infringed the same patent or parallel patents that protect the same object would be accepted as the same factual situation. As all co-defendants in this constellation form part of the same corporate group, the directors of these companies will usually act under the direction of a central managing authority and be aware of the parallel behaviour of their sister companies so that a “common policy” within the corporate group can be presumed.<sup>1790</sup> Due to the mentioned requirements of Article 2:206(2)2(a) of the CLIP Principles, the sister companies must have further acted in an identical or similar manner in accordance with a common policy. The actions of all those companies must thus be directed at a certain outcome.<sup>1791</sup>

The following sample cases (Case 3 and Case 4) may serve for illustration when consolidation of actions against co-defendants will be justified due to the fact that the defendants belong to a corporate group.

#### Case 3:

P holds a European product patent for the Netherlands, Germany and Belgium. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, Infringer 2 (INF 2), a German company being domiciled in Germany, and Infringer 3 (INF 3), a Belgian company being domiciled in Belgium, being all subsidiaries of the English company A, belong to the same corporate group. Acting according to a common

<sup>1785</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C10.

<sup>1786</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C10.

<sup>1787</sup> This possible objection is admitted by *Heinze*, cf. Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C10.

<sup>1788</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C10 with references to such presumptions developed by the ECJ as to different areas of substantive law.

<sup>1789</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C10.

<sup>1790</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C11.

<sup>1791</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C11.

policy determined by A, INF 1 manufactures a product which infringes the patent right of P, and delivers it to INF 2 and INF 3 who sell the product on the German and Belgian markets.

In this constellation the infringements undertaken by INF 1, INF 2 and INF 3 are “identical or similar” in that the same use of the invention is concerned which is protected by the same patent right. Additionally, INF 1, INF 2 and INF 3 acted in accordance with a common policy. The requirements of Article 2:206(2)2(a) of the CLIP Principles would thus be fulfilled.

#### Case 4:

As in Case 1, P holds a European product patent for the Netherlands, Germany and Belgium. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, Infringer 2 (INF 2), a German company being domiciled in Germany, and Infringer 3 (INF 3), a Belgian company being domiciled in Belgium, being all subsidiaries of the English company A, belong to the same corporate group. Acting according to a common policy determined by A, INF 1 manufactures a product which infringes the patent right of P, and delivers it to INF 2 and INF 3 in order to have the product sold by INF 2 and INF 3 on the German and Belgian markets. In contrast to the initial agreement among the corporate group, INF 2 and INF 3 do not sell the product delivered by INF 1, but replace it by another product acquired from the Chinese company C and sell this other product on the German and Belgian markets. This product infringes the patent right of P, too. Neither A nor INF 1 were aware of these activities of INF 2 and INF 3. Can actions against INF 1, INF 2 and INF 3 be consolidated at the seat of INF 1?

In this constellation, the infringements undertaken by INF 1 on the one hand, and INF 2 and INF 3 on the other hand, are not “identical or similar” in that a different use of the invention is concerned regardless of the fact that the same patent right is affected. Despite the existence of a common policy among the corporate group, a consolidation of actions against INF 1, INF 2 and INF 3 at the seat of INF 1 would not be possible on the basis of Article 2:206(2)2(a) of the CLIP Principles, because the infringing activities of INF 2 and INF 3 deviate from the agreement among the corporate group.

#### **3.3.2.2.3.2.2 Joint infringement**

As has been mentioned in the foregoing chapter, the constellation in which several parties have collaborated in carrying out a joint infringement is another example of “essentially the same factual situation”.<sup>1792</sup> In that constellation, it can be presumed that the co-defendants will be aware of the behaviour of the other co-defendants that form part of a common plan. Unlike the situation with regard to the scenario of corporate groups, such a formally legal connection is not required, but the existence of the common plan to infringe another one's patent is sufficient. As a consequence, the mere participation in such a plan already justifies

---

<sup>1792</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C12; Heinze 2007, p. 239; Franzosi (2009)4(4) J.I.P.L.P. 247, at p. 254; Fawcett & Torremans 2011, para. 5.143: “joint tortfeasors” infringing the same intellectual property right.

the consolidation of the actions against the co-defendants in the place where one of them is domiciled.<sup>1793</sup> The following sample case may serve for illustration of this scenario.

#### Case 5:

P holds a European product patent for the Netherlands and Germany. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, manufactures a product which infringes the patent right of P, and sells it in Germany with the support of Infringer 2 (INF 2), a German company domiciled in Germany.

In this constellation, the infringements undertaken by INF 1 and INF 2 are “identical or similar” in that the same use of the invention is concerned which is protected by the same patent right.

#### **3.3.2.2.3.2.3 Chain of infringers**

The third scenario of patent infringement cases mentioned in the foregoing chapter in which “essentially the same factual situation” is existent consists in the constellation of a successive chain of infringers. While each party may have a specific role in the chain and, as a consequence, undertakes a specific infringing activity, they all act “in an identical or similar manner” in that another one's patent right is used by the infringers at different levels of the same infringement chain.<sup>1794</sup> However, due to the clear wording of Article 2:206(2)2(a) of the CLIP Principles, a consolidation of actions against the infringers which form part of such an infringement chain, requires that the respective infringers have acted in accordance with a common policy. In this respect, it has rightly been pointed out in the Commentary on the CLIP Principles that the connection by a common policy must exist between the resident anchor defendant and the non-resident defendant.<sup>1795</sup> The following case may illustrate this scenario.

#### Case 6:

P holds a product patent for the Netherlands and Germany. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, manufactures a product which infringes the patent right of P. Infringer 2 (INF 2), a German company being domiciled in Germany, imports the product into Germany. Infringer 3 (INF 3), a German wholesaler domiciled in Germany, acquires the product from INF 2 in order to sell it to a German retailer. Infringer 4 (INF 4), a German retailer domiciled in Germany, acquires the product from INF 3 and sells it to a German end-user.

While INF 1, INF 2, and INF 3 are fully aware of all steps of the respective distribution chain and agree with it, INF 4 only knows INF 3 and does not dispose of any further information, because INF 3 refuses to inform INF 4 about the distribution chain as he fears that INF 4 could directly acquire such products from INF 2 for a

---

<sup>1793</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C12; Grabinski (2001)50(3) GRUR Int. 199, at p. 207.

<sup>1794</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C13.

<sup>1795</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C13.

lower price than INF 4 has to pay to INF 3. INF 1 and INF 2 do not know INF 4 and his business activities either.

Could infringement proceedings initiated by P against INF 1, INF 2, INF 3 and INF 4 be consolidated at the place of domicile of one of the infringers?

To answer this question, it is relevant whether INF 1, INF 2, INF 3 and INF 4 have acted in accordance with a common policy. The activities of INF 1, INF 2 and INF 3 who are fully aware of all steps of the distribution chain and agree with it, complement each other in setting up a distribution system. In such circumstances, it has been rightly underlined that a “common policy” may be assumed,<sup>1796</sup> in particular where two participants in the chain directly interact, with the result that they can be sued at the place of each other’s domicile.<sup>1797</sup> On this basis, infringement actions initiated by P against INF 1, INF 2 and INF 3 could be consolidated at the place of domicile of one of these co-defendants. In contrast to this, in case that one co-defendant has no information or control regarding the chain of supply beyond his immediate partner, holding him accountable in the courts where other participants in the distribution chain have their domicile would disregard the requirement of foreseeability.<sup>1798</sup> Therefore, INF 4 may not be sued at the place of domicile of INF 1 or INF 2. Reversely, INF 1 and INF 2 may not be sued at INF 4’s place of domicile either, because the presumption of a common policy between INF 1 and INF 2 on the one hand, and INF 4 on the other hand, fails due to the fact that both sides do not know each other and each other’s activities. In contrast, INF 4 and INF 3 know each other and each other’s activities. Therefore a consolidation of infringement actions against INF 3 and INF 4 at the place of domicile of INF 3 or INF 4 would be possible.

#### 3.3.2.2.3.2.4 Unconcerted parallel infringements

Besides, it is to be considered that it is conceivable that there are several chains of infringers which act independently from each other. Inasmuch as such different chains of infringers are concerned, a consolidation of actions against several defendants is not possible due to the absence of any activity in accordance with a common policy. Accounting the infringing acts of infringers who have acted in the framework of another chain of infringers would mean to clearly disregard the principle of foreseeability of jurisdiction in favour of each co-defendant who must be enabled to foresee that he can be sued in the forum where the anchor defendant’s domicile is situated.<sup>1799</sup> In this respect, recourse may be had to the above cited jurisprudence of the ECJ in *Roche Nederland* where the court suggested that

“(…) in the case of European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States, the existence of the same situation of fact cannot be inferred, since the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same [underscore added].”<sup>1800</sup>

<sup>1796</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C13; Rößler (2007)38(4) IIC 380, at pp. 393-394.

<sup>1797</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C13; Lüthi 2011, para. 899.

<sup>1798</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C13, referring to *Gerechtshof ‘s-Gravenhage* 23 August 2007, *Bacardi & Company Limited v Food Brokers B.V. and Others*, available at WWW <[http://oami.europa.eu/pdf/natcourt/Bacardi-Bat\\_Beverage.pdf](http://oami.europa.eu/pdf/natcourt/Bacardi-Bat_Beverage.pdf)>, para. 13 – *Bacardi*.

<sup>1799</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C14.

<sup>1800</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 27 – *Roche Nederland*.

Further, *Advocate General Trstenjak* insistently explicated in her Opinion in the *Painer* case:

“(…) A minimum requirement for a single factual situation must (…) be that it is at least clear to a defendant that he may be sued, as the co-defendant of an anchor defendant, under Article 6(1) of the [Brussels I] Regulation, at a court in the place where that anchor defendant is domiciled.

That minimum requirement is not satisfied where the facts on which the applicant bases its anchor claim and the other claim are such that the conduct of the anchor defendant and of the other defendant concerns the same or similar legal interests of the applicant and is similar in nature, but occurs independently and without knowledge of one another. In such a case of unconcerted parallel conduct, it is not sufficiently predictable for the other defendant that he can also be sued, under Article 6(1) of the [Brussels I] Regulation, at a court in the place where the anchor defendant is domiciled [underscore and content in brackets added].”<sup>1801</sup>

According to the principle of predictability, the existence of “essentially the same factual situation” thus requires that the infringements by the anchor defendant and the co-defendant do not occur independently and without any knowledge of one another.<sup>1802</sup>

The following sample case may serve for illustration.

#### Case 7:

P holds a product patent for the Netherlands and Germany. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, manufactures a product which infringes the patent right of P and sells it on the Dutch market. Infringer 2 (INF 2), a German company being domiciled in Germany, also manufactures such a product that infringes the patent right of P and sells it on the German market. INF 1 and INF 2 do not know each other and act completely independently from each other.

In this constellation, it would certainly be contrary to the principle of predictability of jurisdiction and thus irreconcilable with the principle of legal certainty if INF 1 could be sued together with INF 2 at INF 2's place of domicile or *vice versa*.

#### **3.3.2.2.3.2.5 Further constellations of “essentially the same situation of fact”**

According to the Commentary on the CLIP Principles, there shall additionally be room left for other constellations of “essentially the same situation of fact”. In this regard, the Commentary on the CLIP Principles explicitly mentions the scenario that a potential infringer of a patent right who plans a market entry in a specific market initiates an action for a declaration of non-infringement against both the patent holder and its exclusive licensee. The strict wording of Article 2:206(2)2(a) of the CLIP Principles would not effect that these actions can be consolidated, because the sued patent holder and his exclusive licensee have not acted in an identical or similar manner in accordance with a common policy. However, one should consider that the criteria of Article 2:206(2)2(a) of the CLIP Principles which focus on the

---

<sup>1801</sup> Advocate General 12 April 2011, C-145/10, *Eva-Maria Painer – Standard VerlagsGmbH and Others*, [2011] ECR I-12540, paras. 91-92 – *Painer*.

<sup>1802</sup> Cf. also Rößler (2007)38(4) IIC 380, at p. 393; Lüthi 2011, para. 864. The Commentary on the CLIP Principles adds that a (limited) consolidation for unconcerted parallel conduct is possible via infringement jurisdiction (Article 2:202 of the CLIP Principles) if both co-defendants have infringed the same national intellectual property right, cf. Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C14, there fn. 30.



activity of the co-defendants (as alleged infringers) are *per se* not suitable in the constellation of an action for a declaration of non-infringement, because in case of such an action brought by the alleged infringer, the focus of the dispute will lie on the activity of the plaintiff. Nonetheless, the Commentary on the CLIP Principles is to be confirmed in as much as one should recognise that the actions against the patent holder and the exclusive licensee concern (essentially) the same situation of fact: both actions deal with the central question of whether the plaintiff infringed the concerned patent.<sup>1803</sup> Such a broad interpretation can be founded on the broad and open wording of Article 2:206(2)2 of the CLIP Principles, according to which “the individual circumstances of the case” are to be taken into consideration. This formulation will enable the constellation of actions for a declaration of non-infringement to be covered by Article 2:206(2) of the CLIP Principles.

### 3.3.2.2.3.3 The same legal situation

To recall, Article 2:206(2)1 of the CLIP Principles provides that a risk of incompatible judgments the avoidance of which is the purpose of a consolidation of actions against multiple defendants according to Article 2:206 of the CLIP Principles, requires a risk of divergence in the outcome of the actions against different defendants arising in the context *not only* of essentially the same factual situation, *but also* essentially the same situation of law. Article 2:206(2)2(b) of the CLIP Principles deals with the issue in which circumstances there is (essentially) the same legal situation.

First of all, it is to be underlined that two different constellations can be distinguished in which the existence of the same situation of law can be excluded so that a consolidation of actions will not be possible. On the one hand, the divergence of applicable laws may exclude the same legal situation. On the other hand, it is conceivable that a divergence of the legal bases of the concerned actions may lead to this result.

#### 3.3.2.2.3.3.1 Divergence of applicable laws

Obviously in reaction to the different jurisprudence of the ECJ in *Roche Nederland* (but, remarkably, in line with the court's finding in *Painer*), Article 2:206(2)(b) of the CLIP Principles states that the fact that different national laws are applicable to the claims against the different defendants, does not *per se* mean that disputes do not involve “essentially the same legal situation”.

In its *Roche Nederland* decision, the ECJ restrictively held that

“(…) any action for infringement of a European patent must be examined in the light of the relevant national law in force in each of the States for which it has been granted.

It follows that, where infringement proceedings are brought before a number of courts in different Contracting States in respect of a European patent granted in each of those States, against defendants domiciled in those States in respect of acts allegedly committed in their territory, any divergences between the decisions given by the courts concerned would not arise in the context of the same legal situation [underscores added].”<sup>1804</sup>

<sup>1803</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C15.

<sup>1804</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 30-31 – *Roche Nederland*.

In contrast (without mentioning its finding in *Roche Nederland*, but referring to its *Freeport* decision), the ECJ stated in *Painer* in a remarkably more liberal way:

“(…) (I)n assessing whether there is a connection between two different claims, that is to say a risk of irreconcilable judgments if those claims were determined separately, the identical legal bases of the actions brought is only one relevant factor among others. It is not an indispensable requirement for the application of Article 6(1) of Regulation 44/2001 (…).”

Thus, a difference in legal basis between the actions brought against the various defendants, does not, in itself, preclude the application of Article 6(1) of Regulation 44/2001, provided however that it was foreseeable by the defendants that they might be sued in the Member State where at least one of them is domiciled (...) [underscores added].”<sup>1805</sup>

This finding is in line with the Opinion of *Advocate General Trstenjak* who underlined that inconsistencies between two judgments based on different substantive laws do *not necessarily* result from the applicable substantive law, but that

“(…) there may also be differences which can be attributed to the fact that two courts, which are applying an essentially comparable legal criterion, reach different conclusions because they appraise the facts differently [underline added].”<sup>1806</sup>

Furthermore, the Advocate General emphasised the fact that

“(…) even in a field which is not fully harmonised, certain minimum requirements may nevertheless have been harmonised. Even with actions to which different national laws are applicable, such a case may ultimately be governed by the same law in substance, the common requirements of Union law.”<sup>1807</sup>

Besides, *Advocate General Trstenjak* referred to the constellation of contingent liability when arguing against the need of the applicability of the same law to the anchor claim and the other claim. She reasoned:

“(…) In a case of contingent liability (alternative liability) in which one of the defendants is liable only where the other defendant is not liable, there is (...) a clear interest that the case is decided by the same court in order to avoid the risk of irreconcilable judgments. In such a case, the legal connection between both claims is not dependent on whether the same law is applicable to both claims.”<sup>1808</sup>

In line with the latter part of the Opinion, it is to be recognised that, in the constellation of alternative liability, there is indeed – regardless whether or not the same law applies to the concerned claims – a clear interest in having such a case decided by one court, because irreconcilable judgments would be rendered if one court decides that the defendant who is the primary liable party is not liable for whatever reason, while the other court decides that the second defendant, who is the secondary liable party, is not liable because, in its view, the primary liable party should have been held liable.<sup>1809</sup> Interestingly, the Commentary on the CLIP Principles refers to this passage of the Advocate General’s Opinion merely in

---

<sup>1805</sup> ECJ 1 December 2011, C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, [2011] ECR I-12533, paras. 80-81 – *Painer*.

<sup>1806</sup> Advocate General 12 April 2011, C-145/10, *Eva-Maria Painer – Standard VerlagsGmbH and Others*, [2011] ECR I-12540, para. 79 – *Painer*.

<sup>1807</sup> Advocate General 12 April 2011, C-145/10, *Eva-Maria Painer – Standard VerlagsGmbH and Others*, [2011] ECR I-12540, para. 80 – *Painer*. The ECJ explicitly endorsed this idea, cf. ECJ 1 December 2011, C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, [2011] ECR I-12533, para. 82 – *Painer*.

<sup>1808</sup> Advocate General 12 April 2011, C-145/10, *Eva-Maria Painer – Standard VerlagsGmbH and Others*, [2011] ECR I-12540, para. 83 – *Painer*.

<sup>1809</sup> Advocate General 12 April 2011, C-145/10, *Eva-Maria Painer – Standard VerlagsGmbH and Others*, [2011] ECR I-12540, para. 83, there fn. 33 – *Painer*.

conjunction with the discussion of the second constellation where essentially the same legal situation may lack, the constellation where several actions are founded on different legal bases (governed by the same law or different laws).

The formulation of Article 2:206(2)2(b) of the CLIP Principles according to which disputes may involve essentially the same legal situation even if different national laws are applicable to the claims against the different defendants, provided that the relevant national laws are harmonised to a significant degree by rules of a regional economic integration organisation or by international conventions which are applicable to the disputes in question, must not be misunderstood as to prescribe that as soon as significant harmonisation has taken place the criterion of “essentially the same legal situation” has to be affirmatively found. Article 2:206(2)2(b) of the CLIP Principles rather aims to clarify that the existence of different national laws being applicable to the claims is not *per se* an obstacle for consolidation under Article 2:206 of the CLIP Principles.<sup>1810</sup> Whether or not an achieved harmonisation is sufficient to overcome legal differences resulting from different national laws, will generally have to be evaluated on a case-to-case basis. However, in order to avoid courts having to undergo an extensive comparative law analysis in each case, and to strengthen legal certainty, the Commentary on the CLIP Principles proposes to presume that certain scenarios involve “essentially the same legal situations”.<sup>1811</sup> With regard to intellectual property rights, the Commentary on the CLIP Principles particularly mentions the constellations that the action concerns a uniform Community right<sup>1812</sup> or harmonisation has been reached under the European Patent Convention (EPC), provided that the case concerns parallel patents and focuses on issues which are intended to be interpreted uniformly, which is the case with regard to the scope of a European patent according to Article 69 of the EPC.<sup>1813</sup>

The following sample case may serve for illustration.

#### Case 8:

P holds a European product patent which is designated for the Netherlands and Germany. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, manufactures a product which infringes the patent right of P and sells it on the Dutch market. Infringer 2 (INF 2), a German company being domiciled in Germany, also manufactures such a product that infringes the patent right of P and sells it on the German market. P sues INF 1 and INF 2 for the infringement of his patent. In both actions, the scope of the patent is contested.

Independently of the question of whether both actions concern essentially the same factual situation – with regard to this issue cf. the explications made above – it is, in any case, to be stated that both actions affect essentially the same legal situation inasmuch as the issue of the scope of the European patent is concerned.

---

<sup>1810</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C18.

<sup>1811</sup> More sceptical, enumerating a multitude of aspects which have not been harmonised (yet), which results in the lack of “essentially the same legal situations”: Lange (2007)109(2) GRUR 107, at p. 112.

<sup>1812</sup> The Commentary on the CLIP Principles mentions the Community Trade Mark, the Community Design and the Community Plant Variety Right, cf. Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C18.

Specifically with regard to patent law, the future Unitary Patent can be added to this list.

<sup>1813</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C18.

### 3.3.2.2.3.2 Divergence of legal bases of actions

As mentioned earlier, a second constellation where the existence of essentially the same legal situation can be excluded is the constellation that the actions against several defendants are founded on different legal bases, for instance contract and tort, be it that the same law is applicable, be it that the actions are governed by different laws.<sup>1814</sup>

In its *Freeport* decision, the ECJ made clear that the assessment whether there is a close connection between the claims against the anchor defendant and the co-defendant, will be undertaken, if appropriate, by taking into account on which legal bases the concerned actions are founded:

“It is for the national court to assess whether there is a connection between the different claims brought before it, that is to say, a risk of irreconcilable judgments if those claims were determined separately and, in that regard, to take account of all the necessary factors in the case-file, which may, if appropriate yet without its being necessary for the assessment, lead it to take into consideration the legal bases of the actions brought before that court [underscores added].”<sup>1815</sup>

The Commentary on the CLIP Principles rightly mentions, as an example of a constellation in which the legal connection between two claims is so close that the requirement of “essentially the same legal situation” is likely to be fulfilled, the situation that the outcome of one claim depends on the outcome of another claim.<sup>1816</sup> In this respect, recourse shall be had again to *Advocate General Trstenjak's* Opinion in *Painer* where she explicated with regard to the constellation of contingent liability (alternative liability):

“(…) In a case of contingent liability (alternative liability) in which one of the defendants is liable only where the other defendant is not liable, there is (...) a clear interest that the case is decided by the same court in order to avoid the risk of irreconcilable judgments. In such a case, the legal connection between both claims is not dependent on whether the same law is applicable to both claims [underscore added].”<sup>1817</sup>

As has been stressed above, it is evident, in the constellation of alternative liability, that there is a strong interest of having such a case decided by one court, in order to avoid irreconcilable judgments which could arise if a court decides that the defendant who is the primary liable party is not liable for whatever reason, while another court decides that the other defendant, who is the secondary liable party, is not liable because, in its view, the primary liable party should have been held liable.<sup>1818</sup>

The following sample case may serve for illustration.

#### Case 9:

P holds a European product patent for the Netherlands. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, manufactures a product which allegedly infringes P's patent, and sells it to Infringer 2 (INF 2), an English wholesaler being domiciled in England. INF 2 sells the product on the English market. P sues INF 1 for

---

<sup>1814</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C19.

<sup>1815</sup> ECJ 11 October 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, [2007] ECR I-08319, para. 41 – *Freeport*.

<sup>1816</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C19.

<sup>1817</sup> Advocate General 12 April 2011, C-145/10, *Eva-Maria Painer – Standard VerlagsGmbH and Others*, [2011] ECR I-12540, para. 83 – *Painer*.

<sup>1818</sup> Advocate General 12 April 2011, C-145/10, *Eva-Maria Painer – Standard VerlagsGmbH and Others*, [2011] ECR I-12540, para. 83, there fn. 33 – *Painer*.

infringement of his patent before a Dutch court. Additionally, P sues INF 2 for infringement of his patent, too, before an English court.

In this constellation, the Dutch and the English court deciding independently from each other, it might happen that the invoked Dutch court decides that INF 1 is not liable for patent infringement, while the English court finds that INF 2 is not liable for infringement of P's patent either, because, according to the evaluation of the English court, INF 1 should have been held fully liable. The judgments are irreconcilable insofar as P will not be compensated at all, although the liability of INF 2 was denied on the only reason that solely INF 1 should have been held liable.

Besides cases of alternative liability, *Advocate General Trstenjak* explicated, in her Opinion in *Painer*, that

“(…) a sufficiently close legal connection exists in particular where the defendants are jointly and severally liable, [or where] co-owners or a community of rights [are affected] [underscore and content in brackets added].”<sup>1819</sup>

The Commentary on the CLIP Principles rightly mentions the further case that defendants in two different countries participate in a single form of infringement.<sup>1820</sup> In this respect, it is to be pointed out that *Advocate General Trstenjak* rightly emphasised that further constellations are conceivable in which a close connection between several actions exists:

“(…) It should be pointed out, finally, that the abovementioned examples of a sufficiently close connection should not be understood as an exhaustive list of cases in which there is a sufficient legal connection.”<sup>1821</sup>

### 3.3.2.2.3.4 The competent court according to Article 2:206(3) of the CLIP Principles

According to the main rule in Article 2:206(1) of the CLIP Principles, multiple co-defendants can be sued at the place of domicile of any co-defendant if the claims are sufficiently closely connected. Despite the positive aspects of that rule and its justification as described above, its strict application without any restriction would lead to overly broad jurisdiction over non-resident co-defendants in cases where the action against the anchor defendant would be manifestly inadmissible or where the action against the anchor defendant would concern only an insignificant part of the dispute.<sup>1822</sup> In this respect, it is to be borne in mind that consolidating several actions at the place of domicile of one defendant is an exception to the rule of *forum defensoris* (*actor sequitur forum rei* principle) according to which the courts at each defendant's domicile have jurisdiction as to the action concerning the defendant being domiciled in the forum State. Suing a defendant at another place than his domicile needs a particular justification. The consolidation of actions is therefore only justified in case that there is a sufficiently close connection between the actions.

---

<sup>1819</sup> Advocate General 12 April 2011, C-145/10, Eva-Maria Painer – Standard VerlagsGmbH and Others, [2011] ECR I-12540, para. 97 – *Painer*.

<sup>1820</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C20.

<sup>1821</sup> Advocate General 12 April 2011, C-145/10, Eva-Maria Painer – Standard VerlagsGmbH and Others, [2011] ECR I-12540, para. 99 – *Painer*.

<sup>1822</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C21.

On the other hand, it seems appropriate to confer jurisdiction with regard to several concerned actions on that court where one of several defendants has coordinated infringement activities in which other co-defendants are involved as well. Accordingly, a concentration should (only) be possible where the action against the anchor defendant is so strong and significant for the dispute in its entirety that it justifies pulling the non-resident defendants into that forum.<sup>1823</sup>

Article 2:206(3) of the CLIP Principles thus pursues the approach of combining these ideas in a twofold approach aiming to restrict the consolidation of proceedings and balancing the concerned interests.

#### **3.3.2.2.3.4.1 First restriction: Predominant role of one of the co-defendants**

According to Article 2:206(3)1 of the CLIP Principles, the courts of the State of domicile of one of several co-defendants who has manifestly coordinated the relevant (infringement) activities or is otherwise most closely connected with the dispute in its entirety shall be conferred jurisdiction. This restriction has obviously been inspired by the *spider-in-the-web* doctrine which has initially been developed by Dutch courts.<sup>1824</sup> However, in contrast to the original *spider-in-the-web* rule, Article 2:206(3)1 of the CLIP Principles is constructed in a more moderate and balanced way in that jurisdiction is only vested in the courts of the State where the coordinator of the activities is resident if it is *manifest* from the facts that he has coordinated the concerned (infringement) activities.<sup>1825</sup> In case of doubt whether there is a defendant who played such a predominant, coordinating role, a consolidation of actions will not be possible, meaning that each defendant will have to be sued before the courts of the State where he is domiciled.<sup>1826</sup> The chosen formulation takes into account a potentially sceptical and reluctant attitude of the ECJ towards the *spider-in-the-web* concept which could be based on the fact that legal uncertainty might be created as to whether, respectively by whom such activities are coordinated.<sup>1827</sup>

#### **3.3.2.2.3.4.2 Second restriction: No consolidation of actions in certain constellations where a connection is deemed not to be strong enough**

On the other hand, consolidation of proceedings against several defendants at the place of domicile of one co-defendant is not justified in case that the action against the anchor defendant is not strong and important enough in relation to the dispute in its entirety or if the claim against the resident defendant is obviously inadmissible. Therefore, Article 2:206(3)2(a) and (b) of the CLIP Principles contains a restriction of a consolidation on a second level, providing that jurisdiction by way of a consolidation of proceedings will not be conferred on courts in a State where only insubstantial contributions in relation to the dispute in its entirety have been made or where the claim against the resident defendant is manifestly inadmissible. In the first case, the undesirable effects of actual incompatible judgments are restricted because the contribution of the anchor defendant is insignificant.<sup>1828</sup> In the case of

<sup>1823</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C21.

<sup>1824</sup> Cf. in particular *Gerechtshof 's-Gravenhage* 23 April 1998, *Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others*, [1999] F.S.R. 352, 360 – *Expandable Grafts Partnership II*.

<sup>1825</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C22; Kur (2012)61(10) GRUR Int. 857, at p. 861.

<sup>1826</sup> Kur (2012)61(10) GRUR Int. 857, at p. 861.

<sup>1827</sup> Kur (2012)61(10) GRUR Int. 857, at p. 861. Although the *spider-in-the-web* doctrine had also been addressed in the reference for a preliminary ruling in the *Roche Nederland* case, the question of whether consolidation is only possible in the State where the “spider” is domiciled was left unanswered.

<sup>1828</sup> Basedow & Heinze 2011, p. 80 (concerning a similar issue in competition law).

procedural inadmissibility of the action against the anchor defendant, a risk of incompatible judgments is excluded because the action against the anchor defendant will be held inadmissible, and therefore will be rejected for procedural reasons, meaning that no judgment on the merits will be rendered and thus no conflicting judgments can be produced.<sup>1829</sup> The objective of the provision of Article 2:206(3)2(a) and (b) of the CLIP Principles is to exclude such cases from consolidation in which consolidation of actions serves the purpose to deprive one of the defendants of the jurisdiction of the courts of his State of domicile.<sup>1830</sup>

However, it has been discussed controversially by legal commentators – starting from the *Reisch Montage* decision of the ECJ – whether the admissibility of an action may be considered a prerequisite for a consolidation of several actions before the court where this action has been brought.

In its *Reisch Montage* decision, the ECJ stated that

“(…) Article 6(1) of Regulation No 44/2001 may be relied on in the context of an action brought in a Member State against a defendant domiciled in that State and a co-defendant domiciled in another Member State even when that action is regarded under a national provision as inadmissible from the time it is brought in relation to the first defendant.”<sup>1831</sup>

In order to reason its point of view, the ECJ in particular referred to the aspect of legal certainty by predictability

“(…) as to enable a normally well-informed defendant reasonably to foresee before which courts other than those of the State in which he is domiciled, he may be sued (…)”<sup>1832</sup>

and to the doctrine of an autonomous interpretation of the Brussels I Regulation (Brussels Ibis Regulation), which does not allow having recourse to national law:

“It is settled case-law that the provisions of the regulation must be interpreted independently, by reference to its scheme and purpose (…).”<sup>1833</sup>

However, as to the argumentation used by the ECJ based on the idea of legal certainty by predictability, it is to be stressed that the basic principle of legal certainty respectively predictability has been established *in favour of the defendant*. Consequently, it does not seem justified to apply this principle to found such jurisdiction of a court which is prejudicial for the defendant, because it concerns the jurisdiction of courts other than those at the place of domicile of the defendant.<sup>1834</sup>

---

<sup>1829</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C23; Coester-Waltjen 2008, p. 756; Althammer (2006)26(6) IPRax 558, at p. 560; Althammer (2008)28(3) IPRax 228, at p. 232; M. Würdinger (case note) ECJ 13 July 2006, C-103/05, *Reisch Montage AG v Kiesel Baumaschinen Handels GmbH*, (2006)11 ZZPInt 180, at p. 188; M. Würdinger (case note) ECJ 11 October 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, (2007)12 ZZPInt 221, at pp. 222-223; Thole (2009)122(4) ZZP 423, at pp. 440-441; differently (in favour of a potential consolidation of actions against multiple defendants even if the action against the anchor defendant is inadmissible): Knöfel (2006)26(5) IPRax 503, at p. 506; Roth 2008, p. 899.

<sup>1830</sup> Kur (2012)61(10) GRUR Int. 857, at p. 861.

<sup>1831</sup> ECJ 13 July 2006, C-103/05, *Reisch Montage AG v Kiesel Baumaschinen Handels GmbH*, [2006] ECR I-06827, para. 31 – *Reisch Montage*.

<sup>1832</sup> ECJ 13 July 2006, C-103/05, *Reisch Montage AG v Kiesel Baumaschinen Handels GmbH*, [2006] ECR I-06827, para. 25 – *Reisch Montage*.

<sup>1833</sup> ECJ 13 July 2006, C-103/05, *Reisch Montage AG v Kiesel Baumaschinen Handels GmbH*, [2006] ECR I-06827, para. 29 – *Reisch Montage*.

<sup>1834</sup> Leible 2011 (Rauscher), Art 6 Brüssel I-VO, para. 10f.

Besides, as to the second argument of the ECJ (no recourse to national law due to the doctrine of an autonomous interpretation), it should be borne in mind that the ECJ already decided in *Kalfelis* that national law will be relevant to examine whether, in the individual circumstances, there is a (real) risk of irreconcilable judgments, i.e. a (real) risk of contradiction, which is to be avoided:<sup>1835</sup>

“The rule laid down in Article 6(1) [of the Brussels Convention] therefore applies where the actions brought against the various defendants are related when the proceedings are instituted, that is to say where it is expedient to hear and determine them together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings. It is for the national court to verify in each individual case whether that condition is satisfied [content in brackets added].”<sup>1836</sup>

Additionally, the ECJ admitted, in *Réunion Européenne*, by reference to its earlier decision in *Kongress Agentur Hagen*<sup>1837</sup>, to have recourse to the *lex fori* as far as the *effet utile* of the Brussels Convention (Brussels Ibis Regulation) will not be impaired:

“(…) As regards procedural rules, reference must be made to the national rules applicable by the national court (Case C-365/88 Hagen [1990] ECR I-1845, paragraphs 18 and 19).

However, the application of national procedural rules may not impair the effectiveness of the [Brussels] Convention. A court may not apply conditions of admissibility laid down by national law which would have the effect of restricting the application of the rules of jurisdiction laid down in the [Brussels] Convention (Hagen, paragraph 20) [content in brackets added].”<sup>1838</sup>

After all, it must be considered that the distinct separation between the inadmissibility of an action pursuant to provisions of national law, and the issue of jurisdiction which is determined by the Brussels Ibis Regulation, has been set aside in the framework of Article 8(1) of the Brussels Ibis Regulation by the requirement of a close connection. The question of whether there is the risk of incompatible judgments can actually only be answered by having at least complementary recourse to provisions of national procedural and substantive law.<sup>1839</sup> This has also been recognised by the ECJ in its *Roche Nederland* decision when the court denied the existence of a connection between actions concerning the infringement of different parts of a European patent (as a bundle of national patents), because the potential infringement of each part of the European patent in the protection States must be examined by the respective national law of these States. In this respect, the court clearly explicated:

“In particular, it is apparent from Article 64(3) of the Munich Convention that any action for infringement of a European patent must be examined in the light of the relevant national law in force in each of the States for which it has been granted.

It follows that, where infringement proceedings are brought before a number of courts in different Contracting States in respect of a European patent granted in each of those States, against defendants domiciled in those States in respect of acts allegedly committed in their territory, any divergences between the decisions given by the courts concerned would not arise in the context of the same legal situation.

Any diverging decisions could not, therefore, be treated as contradictory.

<sup>1835</sup> Althammer (2008)28(3) IPRax 228, at p. 232.

<sup>1836</sup> ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565, para. 12 – *Kalfelis*.

<sup>1837</sup> ECJ 15 May 1990, C-365/88, Kongress Agentur Hagen GmbH v Zeehaghe BV, [1990] ECR I-01845 – *Kongress Agentur Hagen*.

<sup>1838</sup> ECJ 26 May 2005, C-77/04, Groupement d'intérêt économique (GIE) Réunion européenne and Others v Zurich España and Société pyrénéenne de transit d'automobiles (Soptrans), [2005] ECR I-04509, paras. 34-35 – *Groupement d'intérêt économique (GIE) Réunion européenne*.

<sup>1839</sup> Thole (2009)122(4) ZZZ 423, at pp. 440-441; Coester-Waltjen 2008, p. 755.



In those circumstances, even if the broadest interpretation of ‘irreconcilable’ judgments, in the sense of contradictory, were accepted as the criterion for the existence of the connection required for the application of Article 6(1) of the Brussels Convention, it is clear that such a connection could not be established between actions for infringement of the same European patent where each action was brought against a company established in a different Contracting State in respect of acts which it had committed in that State [underscores added].<sup>1840</sup>

Parts of legal doctrine have put forth, starting from the jurisprudence of the ECJ in *Reisch Montage*, that a consolidation of actions *generally* does not depend on the admissibility of the anchor action, however apart from the constellation that the anchor action is inadmissible for the very reason that the invoked court has no local or international jurisdiction with respect to the defendant allegedly being domiciled at the forum.<sup>1841</sup> This restriction is based on the consideration that Article 8(1) of the Brussels Ibis Regulation premises that one of several co-defendants is domiciled at the place where the invoked court is situated, whereas the plaintiff’s mere assertion that the defendant is domiciled at the forum is not sufficient.<sup>1842</sup> In this respect, it is to be emphasised that Article 8(1) of the Brussels Ibis Regulation does not only concern the international, but also the local jurisdiction with regard to an action raised against defendants not domiciled in the forum State, and also determines this jurisdiction synchronously with the local jurisdiction, to be determined by the *lex fori*, with regard to actions against defendants who have their domiciles at the place where the deciding court is located. Consequently, it would be contradictory to the goals of the Brussels Ibis Regulation of the sound administration of justice and local proximity between the deciding court and the facts (which has also been codified in Recital 16 of the Brussels Ibis Regulation)<sup>1843</sup> if another court was competent with accordance to Article 8(1) of the Brussels Ibis Regulation than the court at the place of domicile of the defendant domiciled in the forum State.<sup>1844</sup>

Other legal commentators have, in a more or less resolute way,<sup>1845</sup> rejected such a restrictive point of view, and have pointed out that it would go too far to generally apply Article 8(1) of the Brussels Ibis Regulation (respectively its predecessors) regardless of the inadmissibility of the anchor action. In regard of this, it is indeed to be recognised that the plaintiff could otherwise, by arbitrarily initiating proceedings before a court in a State where one defendant has his domicile, deprive the other defendants of the jurisdiction of the courts at their domicile and thus force them to be judged before a foreign court, while the plaintiff knows right from the start that no decision on the merits will be rendered against the anchor defendant because the action against him will be found inadmissible. In this constellation, it is to be underlined that actually no conflicting judgments can be produced.<sup>1846</sup> On the basis of the foregoing, it

<sup>1840</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 30-33 – *Roche Nederland*.

<sup>1841</sup> Geimer 2010 (Geimer & Schütze, *Europäisches Zivilverfahrensrecht*), Art. 6 EuGVVO, paras. 25-26; Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 16; Roth 2008, p. 899.

<sup>1842</sup> Geimer 2010 (Geimer & Schütze, *Europäisches Zivilverfahrensrecht*), Art. 6 EuGVVO, para. 26; Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 16.

<sup>1843</sup> Recital 16 of the Brussels Ibis Regulation provides: “In addition to the defendant’s domicile, there should be alternative grounds of jurisdiction based on a close connection between the court and the action or in order to facilitate the sound administration of justice. The existence of a close connection should ensure legal certainty and avoid the possibility of the defendant being sued in a court of a Member State which he could not reasonably have foreseen. This is important, particularly in disputes concerning non-contractual obligations arising out of violations of privacy and rights relating to personality, including defamation.”

<sup>1844</sup> Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 16.

<sup>1845</sup> Cautious: Muir Watt 2012 (Magnus & Mankowski), Art 6 Brussels I Regulation, para. 27a: “Although it is quite true that the text does not make this explicit, it is certainly arguable that an inadmissible claim is an overly flimsy basis to anchor another under Art. 6(1)!”

<sup>1846</sup> Leible 2011 (Rauscher), Art 6 Brüssel I-VO, para. 10e; Muir Watt 2012 (Magnus & Mankowski), Art 6 Brussels I Regulation, para. 27a.

has rightly been postulated that Article 8(1) of the Brussels Ibis Regulation (respectively its predecessors) should not be applicable if the anchor action is *ipso iure* obviously inadmissible.<sup>1847</sup> In light of these different positions, it seems that Article 2:206(3)2(b) of the CLIP Principles represents a reasonable compromise, when excluding a consolidation of proceedings (only) if the claim against the anchor defendant is *manifestly* inadmissible.

In general, Article 2:206(3)2(a) and (b) of the CLIP Principles have been constructed in a way to limit the potential for forum shopping in that these provisions contain strict requirements: consolidation of proceedings in a State is excluded only if the contribution of the resident defendant is *insubstantial in relation to the dispute in its entirety*, respectively if it is *manifest* that the claim against the resident defendant is inadmissible. Although it could be put forth that the introduction of vague terms such as “insubstantial in relation to the dispute in its entirety” and “manifestly inadmissible” entails the danger of legal uncertainty because they establish, in theory, the possibility of multiple interpretations which might lead to the result that any adept wording merely provides a pretended legal certainty and predictability, such criticism ultimately goes astray for several reasons. First of all, any wording finally establishes the possibility of an interpretation by the ECJ which means the chance of ultimate clarification. Further, as the Commentary on the CLIP Principles has rightly mentioned, a concept such as “manifestly inadmissible” has already been established in other areas of European law, such as Articles 92(1) and 119 of the ECJ's own rules of procedure, where it seems to be applied on a regular basis.<sup>1848</sup> Moreover, it is to be underlined that the problems which are currently hidden in Article 8(1) of the Brussels Ibis Regulation are equally virulent today.<sup>1849</sup> Last but not least, the expressions “manifestly inadmissible” and “insubstantial in relation to the dispute in its entirety” which admittedly need further interpretation bear the advantage of being objective criteria, in contrast to the subjective and therefore even more uncertain concept of “abuse of jurisdiction”.

### 3.3.2.2.4 The Heidelberg Report on the Application of Regulation Brussels I

Like the CLIP Principles, the Heidelberg Report on the Application of Regulation Brussels I advocates the amendment of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation), taking into consideration the ECJ's jurisprudence, especially its *Roche Nederland* decision. The creators of the Heidelberg Report proposed to redraft Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) by including a special provision relating to intellectual property matters as follows:

“(1a) where he is one of a number of defendants engaging in coordinated activities resulting, or threatening to result, in infringement of intellectual property rights whose contents are determined by the same rule of law enshrined in secondary Community legislation or in international conventions to which all EU Member States have adhered, in the courts of the country where the defendant coordinating the activities or otherwise having the closest connection with the infringement in its entirety is domiciled.”<sup>1850</sup>

In formal respect, it has rightly been annotated in legal doctrine that it would have been preferable to name this proposed amendment of the text of Article 6(1) of the Brussels I Regulation as “Article 6(1b)”, while renaming the original provision of Article 6(1) of the

<sup>1847</sup> Leible 2011 (Rauscher), Art 6 Brüssel I-VO, para. 10e.

<sup>1848</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C23, there in fn. 59.

<sup>1849</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C23.

<sup>1850</sup> Schlosser 2008 (Heidelberg Report), para. 692; Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 743.

Brussels I Regulation as “Article 6(1a)”.<sup>1851</sup> Nonetheless, such justified criticism should not be conceded too much importance.<sup>1852</sup>

The creators of the Heidelberg Report explicitly refer to the CLIP Proposal, explicating that

“(t)he proposal of the CLIP is to adopt, by explicit terms, the Dutch “spider in the web” theory and to include into Article 6 JR a special provision relating to intellectual property matters”,<sup>1853</sup>

whereas it is not true that the Heidelberg Report pleads for an *explicit adoption* of the CLIP Proposal.<sup>1854</sup> In any case, the proposal made by the Heidelberg Report differs significantly from the CLIP Proposal. This shall be subject to the following discussion.

In contrast to Article 2:206 of the CLIP Principles, the proposed amendment of Article 6(1) of the Brussels I Regulation contained in the Heidelberg Report does not imply any hints, let alone clarification, as to the question in which circumstances there is a risk of irreconcilable judgments resulting from separate proceedings which shall be avoided by a consolidation of proceedings. Rather, the amendment proposed in the Heidelberg Report consists in the creation of a special provision for constellations of infringement of intellectual property rights. While it is comprehensible to create a rule which (also) covers these constellations, this approach seems not to go far enough, because, *also beyond* intellectual property infringement proceedings, the question arises in which circumstances several actions can be consolidated at the place of domicile of one defendant, this being no specific issue of intellectual property law.<sup>1855</sup> Principally, it is to be underlined that special jurisdictional provisions are necessary and justified, with regard to specific constellations, only if applying the general rules in these constellations would lead to inadequate results, or if specific considerations regarding jurisdiction militate for the application of such special provisions.<sup>1856</sup> As the aspect of consolidating proceedings in order to avoid the risk of irreconcilable judgments resulting from separate proceedings is generally relevant regardless of the field of law concerned, it does not seem necessary, and therefore neither reasonable nor justified, to create a special provision with regard to intellectual property infringement proceedings. Furthermore, establishing a special provision concerning the constellation of proceedings with regard to the infringement of intellectual property rights, while not mentioning the criterion of the need for the avoidance of the risk of irreconcilable judgments resulting from separate proceedings, the proposal would have resulted in the existence of a fundamentally different structure of Article 6(1) of the Brussels I Regulation (respectively Article 6(1a) of the Brussels I Regulation in an adapted system) and the proposed provision of Article 6(1a) of the Brussels I Regulation (respectively Article 6(1b) of the Brussels I Regulation in an adapted system).<sup>1857</sup> The danger of such a schematic divergence consists in a newly created risk of an inconsistent interpretation of these provisions.

---

<sup>1851</sup> Schauwecker 2009, p. 383, there fn. 1434.

<sup>1852</sup> Schauwecker himself relativises his objection immediately, cf. Schauwecker 2009, p. 383, there fn. 1434.

<sup>1853</sup> Schlosser 2008 (Heidelberg Report), para. 692; Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 743.

<sup>1854</sup> Mistakably: Schauwecker 2009, p. 383, there fn. 1433. Besides, it is to be added that the reporters depict “(...) the alternative possibility of redrafting no. 1 itself in such a manner as to ensure that the seat of the primary responsible defendant becomes crucial”, cf. Schlosser 2008 (Heidelberg Report), para. 692; Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 743.

<sup>1855</sup> Cf. Torremans (2007)29(5) E.I.P.R. 195, at p. 198.

<sup>1856</sup> Schauwecker 2009, p. 384.

<sup>1857</sup> Schauwecker 2009, p. 384.

Another weakness of the proposal made in the Heidelberg Report consists in the fact that the term “contents” of intellectual property rights being infringed is unclear and thus needs to be interpreted. This establishes room for divergent interpretations as to the question which provisions are decisive for determining that “contents” and thus must be harmonised for a consolidation of proceedings.<sup>1858</sup>

In contrast to Article 2:206(2) of the CLIP Principles which employs an open wording that leaves room for exceptions and a consideration of the individual circumstances of the case<sup>1859</sup>, the corresponding amendment proposal made by the expert group of the Heidelberg Report strictly provides that a consolidation shall be possible if the same rule of law enshrined in secondary Community legislation or in international conventions is applicable with regard to the infringing activities concerned under the conditions described in the text proposal. Thus, the proposal contained in the Heidelberg Report is much less flexible than Article 2:206(2)2(b) of the CLIP Principles which provides for the possibility of a differentiated outcome of the decision on the consolidation of proceedings, using the negative formulation that disputes *may involve* essentially the same legal situation *even if different national laws are applicable to the claims against the different defendants*, provided that the relevant national laws are harmonised to a significant degree by rules of a regional economic integration organisation or by international conventions which are applicable to the disputes in question. The structure of the proposal contained in the Heidelberg Report is thus disadvantageous in comparison with Article 2:206 of the CLIP Principles in twofold respect: First, it does not take into account that the risk of irreconcilable judgments produced by different courts can also be existent where contents of intellectual property rights are determined by the same legal rule enshrined in secondary Community legislation or in international conventions. Second, the proposal of the Heidelberg Report does not take into consideration that, also in constellations where intellectual property rights have been harmonised by secondary Community legislation or by way of international conventions, the invoked court may find that the concerned actions should be decided differently because the underlying facts and legal considerations differ from each other.<sup>1860</sup>

Unlike Article 2:206(2)2(a) of the CLIP Principles which provides that disputes involve essentially the same factual situation – to be understood as one precondition for the existence of the risk of incompatible judgments as the prerequisite for a consolidation of proceedings against several defendants – if the defendants have acted in an identical or similar manner in accordance with a common policy,<sup>1861</sup> the amendment proposal contained in the Heidelberg Report is much more narrow and less flexible. While the *spider-in-the-web* constellation is *also* covered by the broad formulation of Article 2:206(2)2(a) of the CLIP Principles, the Heidelberg Report *only* covers this constellation which becomes obvious by the following wording:

“(…) where he is one of a number of defendants engaging in coordinated activities (…).”

As a consequence, the solution implied in Article 2:206(2)2(a) of the CLIP Principles brings along the advantage, in comparison with the proposal of the Heidelberg Report, to better cope with the *ratio* of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis

---

<sup>1858</sup> Schauwecker 2009, p. 385.

<sup>1859</sup> Cf. again the wording of Article 2:206(2)2 of the CLIP Proposal: “In particular”; “subject to the individual circumstances of the case”.

<sup>1860</sup> Schauwecker 2009, p. 385.

<sup>1861</sup> As analysed, this constellation described in Article 2:206(2)2(a) of the CLIP Principles is only one conceivable constellation where proceedings may be consolidated, and only subject to the individual circumstances of the case.

Regulation) which is to ensure that consolidating proceedings will merely take place in exceptional circumstances which requires a certain flexibility with regard to the circumstances. Otherwise, the basic rule of Article 4(1) of the Brussels Ibis Regulation (*forum defensoris; actor sequitur forum rei*) would be disregarded. Although it is true that parallel patent infringements will frequently be based on the policy and strategy of a mother company of a multinational corporate group while the single acts are carried out by the daughter companies in the States where they are situated,<sup>1862</sup> it is not convincing to consolidate actions *only* if the co-defendants belong to the same corporate group. In case of such a differentiation between defendants belonging to a corporate group, and those defendants who act without any corporate bond, strong incentives would be created to disguise intentional multiterritorial conduct in an effort to avoid jurisdiction. In this context, *General Advocate Léger* explicated distinctly in his Opinion in the *Roche Nederland* case:

“On the supposition that the defendant companies belong to the same group and that the infringements of which they are accused are identical or similar, it is not easy, either for the applicant or for the court, to establish whether such acts are the result of collusion between the companies in question or of a common policy defined within the group.

It is no different when it comes to determining the respective roles that the companies in question played in defining an alleged common policy with a view to identifying ‘the spider in the web’. That question may well prove to be a breeding ground for disputes among the parties, even among the defendants themselves (...) [underscores added].”<sup>1863</sup>

Besides, invoked courts would have to undertake an extensive and complex examination which would produce additional costs and prolong the term of proceedings. In this respect, the ECJ held in its *Roche Nederland* decision:

“It must be observed that the determination as to whether the criteria concerned are satisfied, which is for the applicant to prove, would require the court seised to adjudicate on the substance of the case before it could establish its jurisdiction. Such a preliminary examination could give rise to additional costs and could prolong procedural time-limits where that court, being unable to establish the existence of the same factual situation and, therefore, a sufficient connection between the actions, would have to decline jurisdiction and where a fresh action would have to be brought before a court of another State [underscore added].”<sup>1864</sup>

But also the requirement of coordinated activities as such, contained in the Heidelberg proposal, even if not realised by a corporate bond, seems to be unjustified. There is no reason for establishing such a special rule for matters of intellectual property rights in contrast to other legal matters.<sup>1865</sup> In contrast to the proposal in the Heidelberg Report, Article 2:206(2)2(a) of the CLIP Principles mentions the acting “in an identical or similar manner in accordance with a common policy” as a case in which, regularly, disputes involve essentially the same factual situation (to be understood as one precondition for a risk of incompatible judgments as a prerequisite for the consolidation of several proceedings). However, this provision does *not* contain an irrebuttable presumption that such acting “in an identical or similar manner in accordance with a common policy” inevitably results in the existence of

<sup>1862</sup> P. Schlosser (case note) ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, (2007)62(6) JZ 305, at p. 307.

<sup>1863</sup> Advocate General 8 December 2005, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 128-129 – *Roche Nederland*.

<sup>1864</sup> ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, para. 39 – *Roche Nederland*.

<sup>1865</sup> Schauwecker 2009, p. 388.

(essentially) the same factual situation,<sup>1866</sup> which becomes particularly obvious by the formulation “subject to the individual circumstances of the case” in Article 2:206(2)2 of the CLIP Principles, which leaves room for an individual consideration of the specific case concerned. For instance, it is conceivable that defendants acting in a coordinated way infringe parallel national patents in completely different ways without there being a risk of irreconcilable judgments if different courts decide on the respective infringement brought before them.

### **3.3.2.2.5 The Commission Proposal 2010 for Reform of the Brussels I Regulation**

In order to amend Article 6(1) of the Brussels I Regulation, Article 6(1) of the Commission Proposal 2010 provides:

#### **Article 6 of the Commission Proposal 2010**

A person may also be sued:

(1) where he is domiciled in a Member State and is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims 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.

As has already been suggested with regard to Article 5(2) of the Commission Proposal 2010, Article 6(1) of the Commission Proposal 2010 again reveals the conception pursued by the European Commission to extend the jurisdiction rules of the Brussels I Regulation to defendants domiciled in a third State in order to improve the functioning of the Regulation in the international legal order. Comparably to the change of formulation between the beginning of Article 5(3) of the Brussels I Regulation (“A person domiciled in a Member State may, in another Member State, be sued”) and the beginning of Article 5(2) of the Commission Proposal 2010 (“The following courts shall have jurisdiction”), there is a change in the wording between the beginning of Article 6(1) of the Brussels I Regulation (“A person domiciled in a Member State may also be sued”) and the beginning of Article 6(1) of the Commission Proposal 2010 (“A person may also be sued”). However, in contrast to Article 5(2) of the Commission Proposal 2010, Article 6(1) of the Commission Proposal 2010 ultimately does not effect any substantial change vis-à-vis Article 6(1) of the Brussels I Regulation, because Article 6(1) of the Commission Proposal 2010 – in some way inconsistent<sup>1867</sup> in light of the general approach to extend the jurisdiction rules of the Brussels I Regulation to defendants domiciled in a third State – also adds the phrase “is domiciled in a Member State and” to the wording of Article 6(1) of the Brussels I Regulation.<sup>1868</sup> Hence, the prerequisite that the defendant be domiciled in a Member State is merely formulated in another way respectively at another place within the provision.<sup>1869</sup> Thus, the unfavourable unequal treatment of, on the one hand, defendants domiciled in a Member State who may be sued at the place of domicile of one co-defendant in case of a close connection according to

---

<sup>1866</sup> In contrast, the predecessor provision of Article 2:206(2)2(a) of the CLIP Principles provided for an irrebuttable presumption of the existence of (essentially) the same factual situation.

<sup>1867</sup> Cf. Weller (2012)9(1) GPR 34, at p. 38.

<sup>1868</sup> Cf. Weller (2012)9(1) GPR 34, at p. 38.

<sup>1869</sup> Noteworthy, this is different from the situation in Article 6(2), (3) and (4) of the Commission Proposal 2010, where the changed beginning of the text (deletion of the phrase “domiciled in a Member State”) effects a change vis-à-vis Article 6(2), (3) and (4) of the Brussels I Regulation.

Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) (*forum connexitatis*) vis-à-vis, on the other hand, defendants domiciled in a third State which are not subject to this extensive jurisdiction, is maintained.<sup>1870</sup>

Beyond that, Article 6(1) of the Commission Proposal 2010 does not contain any clarification let alone solution of the problems discussed in the context of intellectual property rights, in particular patents.

### 3.3.2.3 Further considerations

#### 3.3.2.3.1 Consolidation of proceedings in the case of infringement of national patents

While both the *Roche Nederland* decision and the *Solvay* decision of the ECJ concerned the constellations of several European patents, the issue under which circumstances patent infringement actions against several defendants can be consolidated at the place of one of the defendants can also arise if several national patents are affected. With regard to the latter constellation, the open wording of Article 2:206(2)2(a) of the CLIP Principles proves once again preferable vis-à-vis the amendment proposal of the Heidelberg Report, because the latter proposal merely covers the situation of

“(…) infringement of intellectual property rights whose contents are determined by the same rule of law enshrined in secondary Community legislation or in international conventions to which all EU Member States have adhered (…) [underscore added].”

However, in the case of infringement of several national patents of EU Member States which have not been granted by the European Patent Organisation, but by national authorities, it is conceivable that a consolidation of actions against the respective infringers is justified as well, given that certain key issues of patent law like the issue of patentability of biotechnological inventions have been harmonised, and some countries have harmonised their national law to the EPC.<sup>1871</sup> The CLIP Proposal, expressly due to its open formulation, also covers this constellation and thus seems preferable in comparison with the Heidelberg Proposal. Even more, it seems adequate to treat the infringement of patents by several infringers as if several European patents were affected, where the laws of the States for which national patents have been granted are based on a common law providing guidelines.<sup>1872</sup> In contrast, the mere existence of a uniform PCT application does not suffice as to establish the same situation of law, because the international application with accordance to the PCT, while creating a certain uniformity of the patent as such,<sup>1873</sup> does *not* result in the applicability of the same national legal provisions.<sup>1874</sup>

#### 3.3.2.3.2 Restricting the places of jurisdiction where actions may be consolidated

On the one hand, § 206(1)(b) of the ALI Principles provides that a consolidation of actions against several defendants requires that “between the forum and the States in which the added defendants are resident, there is no forum that is more closely related to the entire dispute”,

---

<sup>1870</sup> Weller (2012)9(1) GPR 34, at p. 38 with further references.

<sup>1871</sup> Kraßer 2009, p. 90 et seq.

<sup>1872</sup> Schauwecker 2009, p. 386.

<sup>1873</sup> Kraßer 2009, p. 82 et seq.

<sup>1874</sup> Such a harmonisation has however been realised by Articles 27 et seq. of the TRIPS Agreement.

meaning that a consolidation of actions is *only* possible at the place which is most closely connected with the entire dispute. Despite that restrictive content, the provision is still formulated in an open way which leaves room for a flexible application, which is also accomplished by its negative formulation.

On the other hand, the amendment proposal as to Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) contained in the Heidelberg Report lacks any flexibility, providing that consolidation of actions is merely possible “in the courts of the State where the defendant coordinating the activities or otherwise having the closest connection with the infringement in its entirety is domiciled.”

As already discussed above, this formulation reveals a misconception of the underlying reason for the consolidation of actions against several co-defendants, because it is not a specific factual proximity that justifies consolidation, but the connection that exists between the claims/actions. As a consequence, all places of domicile of concerned defendants are equally suitable for consolidation of actions, because all of these places of jurisdiction are based on the *actor sequitur forum rei* principle.<sup>1875</sup> Besides, it is to be considered that such a restriction of the places of jurisdiction where actions may be consolidated would solely take place in favour of one defendant without any justification for such a privilege vis-à-vis the other defendants who would not be additionally protected. Besides, if there is indeed one defendant who has coordinated the infringing activities of the co-defendants, for instance a corporate group of several companies, this defendant will potentially dispose of the best financial resources and legal advice. In light of this, it would seem absurd to grant this very defendant the privilege to be sued at his place of domicile.<sup>1876</sup>

After all, it might be far from easy, and not possible without reference to rules of substantive law, to determine which defendant has actually coordinated the infringement activities, which might overburden the examination of jurisdiction. In this respect, *Advocate General Léger* shall be cited again who explicated in *Roche Nederland*:

“(…) (I)t is not easy, either for the applicant or for the court, to establish whether such acts are the result of collusion between the companies in question or of a common policy defined within the group.

It is no different when it comes to determining the respective roles that the companies in question played in defining an alleged common policy with a view to identifying ‘the spider in the web’. That question may well prove to be a breeding ground for disputes among the parties, even among the defendants themselves. To base the application of Article 6(1) of the Brussels Convention on the principle that the courts with jurisdiction are those in the State where the company that played a central role in defining the common policy at the root of the alleged infringements is established would, in my opinion, run counter to the requirements of predictability or certainty laid down by the Court for interpreting the jurisdictional rules established by the Convention [underscore added].”<sup>1877</sup>

Therefore, restricting the places of jurisdiction where actions may be consolidated to the courts of the State where the defendant coordinating the activities or otherwise having the closest connection with the infringement in its entirety is domiciled, results, at best, in a higher degree of knowledge before which courts proceedings *could* be negotiated, but not before which court proceedings *will* actually take place.<sup>1878</sup>

---

<sup>1875</sup> Schauwecker 2009, p. 391.

<sup>1876</sup> Schauwecker 2009, p. 392; Hölder 2004, p. 161.

<sup>1877</sup> Advocate General 8 December 2005, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, [2006] ECR I-06535, paras. 128-129 – *Roche Nederland*.

<sup>1878</sup> Hölder 2004, p. 162; Schauwecker 2009, p. 392.



As a consequence, a restriction of the places where actions may be consolidated in the case of actions against several co-defendants, to the place where the defendant coordinating the activities or otherwise having the closest connection with the infringement in its entirety is domiciled, as does the Heidelberg Report, is to be rejected.

In light of the foregoing, Article 2:206(3)1 of the CLIP Principles adopts a balancing position when providing that the consolidation of actions against several co-defendants at the courts of the State of domicile of one defendant who has coordinated the relevant infringement activities or is otherwise most closely connected with the dispute in its entirety, shall only be effected if these facts are *manifest*. Otherwise, i.e. if doubts remain whether there is a defendant who played such a predominant, coordinating role, Article 2:206(3)1 of the CLIP Principles does not apply, meaning that no consolidation of actions at the place of domicile of this defendant will take place.

### 3.3.2.3.3 The concept of “abuse of jurisdiction”

As to the concept of “abuse of jurisdiction” addressed above when discussing Article 2:206(3) of the CLIP Principles, it is to be underlined that, while the ECJ employed that concept in its *Reisch Montage* decision, where the court held, by reference to its decisions in *Kalfelis* and *Réunion Européenne*, that

“(…) the special rule on jurisdiction provided for in Article 6(1) of Regulation No 44/2001 cannot be interpreted in such a way as to allow a plaintiff to make a claim against a number of defendants for the sole purpose of removing one of them from the jurisdiction of the courts of the Member State in which the defendant is domiciled (...)”,<sup>1879</sup>

the ECJ later rejected<sup>1880</sup> that concept of “abuse of jurisdiction” (or eventually integrated it in the concept of close connection)<sup>1881</sup> in its *Freeport* decision. In this decision, the court stated that

“Article 6(1) of Regulation No 44/2001 applies where claims brought against different defendants are connected when the proceedings are instituted, that is to say, where it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings, without there being any further need to establish separately that the claims were not brought with the sole object of ousting the jurisdiction of the courts of the Member State where one of the defendants is domiciled [underscore added].”<sup>1882</sup>

As to the question raised in *Freeport* whether the proviso contained in Article 6(2) of the Brussels I Regulation (Article 8(2) of the Brussels Ibis Regulation), according to which a consolidation of actions on a warranty or guarantee or concerning any other third party proceedings be precluded in case that the original proceedings are instituted solely with the object of removing a defendant from the jurisdiction of the court which would be competent

<sup>1879</sup> ECJ 13 July 2006, C-103/05, *Reisch Montage AG v Kiesel Baumaschinen Handels GmbH*, [2006] ECR I-06827, para. 32 – *Reisch Montage*.

<sup>1880</sup> More reluctant: Corneloup & Althammer 2012 (unalex Kommentar), Art. 6 Brüssel I-VO, para. 38: “Im Ergebnis ist das Verhältnis der Aussagen des EuGH in der Rechtssache *Freeport/Arnoldsson* und in *Reisch Montage* im Hinblick auf den Rechtsmissbrauchseinwand nicht vollkommen aufeinander abgestimmt.”

<sup>1881</sup> This interpretation is suggested by the Commentary on the CLIP Principles, cf. Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C23, there in fn. 60. Similarly, *Leible* points out that there is *a priori* no connection between several actions in case that an action is raised for the sole purpose to deprive one defendant of the jurisdiction of the courts of his State of domicile, a separate ascertainment of an abuse of jurisdiction not being necessary in such a constellation, cf. *Leible* 2011 (Rauscher), Art 6 Brüssel I-VO, para. 9a.

<sup>1882</sup> ECJ 11 October 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, [2007] ECR I-08319, para. 54 – *Freeport*.

in his case, should be applicable to Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) as well, *Advocate General Mengozzi* took an approving attitude in his Opinion. He argued for an analogous application of that proviso with regard to Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation), also referring to (implications within) the jurisprudence of the ECJ:

“(…) (A)lthough the prohibition to which the applicability of the linking factor is subject under Article 6(2) of Regulation No 44/2001 is worded in such a way as to catch both instances of fraud and abuse of the right to select the court, I see no reason – linked in particular to the need for a uniform application and independent interpretation of the regulation's provisions – that would prevent it from applying to the cases regulated by Article 6(1) as well.

Extending the prohibition under Article 6(2) by analogy in that way – and this has, moreover, already been approved by implication by the Court [in *Reisch Montage*] – makes it possible, in particular, to preclude Article 6(1) being applied to situations which do not fall within its natural scope as well as to prevent the basis for jurisdiction which it lays down being relied on if that is designed to serve interests which do not merit protection [content in brackets added].”<sup>1883</sup>

However, in contrast to the Opinion of the Advocate General, the ECJ clearly held, by reference to the Commission:

“As the national court rightly pointed out, Article 6(1) of Regulation No 44/2001, unlike Article 6(2), does not expressly make provision for a case in which an action is brought solely in order to remove the party sued from the jurisdiction of the court which would be competent in his case. The Commission stated on that point that, when amending the Brussels Convention, the Member States had refused to include the proviso contained in Article 6(2) in Article 6(1), taking the view that the general condition that the claims be connected was more objective [underscore added].”<sup>1884</sup>

It is noteworthy that Article 2:206(3)2 of the CLIP Principles does not mention, as to further curtail a too broad extension of the possibility to consolidate proceedings, that the action against the anchor defendant is (obviously) unfounded respectively without any prospect of success. This issue was also raised in the *Freeport* case. Beside the question of whether Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) applies only provided it is established that the action against a defendant domiciled in the Member State of the court seised has not been brought solely with the object of removing another defendant from the jurisdiction of the court which could be competent in this case, the Swedish *Högsta domstolen* (Swedish Supreme Court) had raised, *inter alia*, the question to the ECJ, given the answer to the foregoing question was answered in the negative, whether the fact that the claimant is pursuing an objective of that nature affects the assessment of the likelihood of that action succeeding in the context of the analysis of the risk of irreconcilable judgments for which Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) provides.<sup>1885</sup> Concerning this third question, *Advocate General Mengozzi* held in his Opinion:

“As regards the third question, since it was submitted in the event that the second question was answered in the negative and I am proposing that the Court reply to that question in the affirmative, I shall merely point out that the assessment of the risk of irreconcilable judgments, which Article 6(1) of Regulation No 44/2001 requires of the court seised, must be made taking account of all the relevant factors.

---

<sup>1883</sup> Advocate General 24 May 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, [2007] ECR I-08319, paras. 64-65 – *Freeport*.

<sup>1884</sup> ECJ 11 October 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, [2007] ECR I-08319, para. 51 – *Freeport*.

<sup>1885</sup> Cf. Advocate General 24 May 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, [2007] ECR I-08319, para. 47 – *Freeport*.

Like the Commission, I consider that that assessment may also include an evaluation of the likelihood that the claim brought against the defendant who is domiciled in the forum Member State will succeed. However, that evaluation will be of real practical relevance for the purpose of excluding the risk of irreconcilable judgments only if that claim proves to be manifestly inadmissible or unfounded in all respects [underscore added].<sup>1886</sup>

The Advocate General thus not only recognised, as does Article 2:206(3)2(a) and (b) of the CLIP Principles, the scenario that the action against the anchor defendant is “manifestly inadmissible” as to exclude the consolidation of actions, but also the scenario that the anchor action is (manifestly) “unfounded in all respects”.

Unfortunately, the ECJ did not deliver a substantial answer to this question, because in the court's view, the question was referred on the premise that, for there to be connection between a number of claims, those claims should have the same legal basis, which did not apply in the concrete case. The court thus merely held laconically:

“As has been stated in answer to the first question, Article 6(1) of Regulation No 44/2001 may apply where actions brought against different defendants have different legal bases.

In view of that answer, there is no need to give a reply to the third question.”<sup>1887</sup>

As to this issue, diverse legal commentators have endorsed the conception that the applicability of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation) should be considered independent from the question of whether the anchor action is founded or not, because this examination in the framework of the examination of the admissibility of the action would mean to considerably restrict the *effet utile* of Article 6(1) of the Brussels I Regulation (Article 8(1) of the Brussels Ibis Regulation).<sup>1888</sup>

Other parts of legal doctrine have taken a different view and argued in favour of a conception according to which the consolidation of actions should (also) be excluded in further constellations beyond the (manifest) inadmissibility of the anchor action. In this respect, it has rightly been emphasised that it would not seem reasonable to preclude the consolidation of actions where the anchor action is obviously inadmissible – as the ECJ held in *Reisch Montage* – while allowing the consolidation of proceedings where the action against the anchor defendant is obviously unfounded.<sup>1889</sup> In fact, an action which is inadmissible or unfounded right from the beginning seems to form a quite weak basis for anchor jurisdiction according to Article 8(1) of the Brussels Ibis Regulation which constitutes an exception vis-à-vis jurisdiction pursuant to Article 4(1) of the Brussels Ibis Regulation.<sup>1890</sup>

However, as it is not sufficient that the anchor action simply *turns out* to be unfounded, different proposals have been brought forward in legal doctrine how to reach the result that an *obviously* unfounded action cannot serve as an anchor action.

---

<sup>1886</sup> Advocate General 24 May 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, [2007] ECR I-08319, paras. 69-70 – *Freeport*.

<sup>1887</sup> ECJ 11 October 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, [2007] ECR I-08319, paras. 57-58 – *Freeport*.

<sup>1888</sup> Kropholler & Von Hein 2011, Art. 6 EuGVO, para. 16; Roth 2008, p. 900; Coester-Waltjen 2008, p. 757 et seq.

<sup>1889</sup> M. Würdinger (case note) ECJ 11 October 2007, C-98/06, *Freeport plc v Olle Arnoldsson*, (2008)54(1-2) RIW 71, at p. 72.

<sup>1890</sup> Corneloup & Althammer 2012 (unalex Kommentar), Art. 6 Brüssel I-VO, para. 38.

To begin, it has been argued that the consolidation of several actions shall be possible if, on the basis of a limited scope of examination, the anchor actions is held founded, i.e. if the plaintiff succeeds in asserting conclusively that there is a claim against the defendant at the place where the action is brought which is connected with the plaintiff's claims against the other defendants.<sup>1891</sup> In German law, the anticipated examination of (elements of) the foundedness of an action in the framework of the examination of its admissibility is known under the term “*Lehre von den doppelrelevanten Tatsachen*”. According to this doctrine, establishing jurisdiction merely requires the conclusive assertion of the relevant facts if these facts are also relevant for the foundedness of the action. This doctrine was acknowledged early by the ECJ, in its *Effer* decision, where the court held, with regard to Article 5(1) of the Brussels Convention (Article 7(1) of the Brussels Ibis Regulation), that

“(…) the national court’s jurisdiction to determine questions relating to a contract includes the power to consider the existence of the constituent parts of the contract itself, since that is indispensable in order to enable the national court in which proceedings are brought to examine whether it has jurisdiction under the Convention. If that were not the case, Article 5(1) of the Convention would be in danger of being deprived of its legal effect, since it would be accepted that, in order to defeat the rule contained in that provision it is sufficient for one of the parties to claim that the contract does not exist. On the contrary, respect for the aims and spirit of the Convention demands that that provision should be construed as meaning that the court called upon to decide a dispute arising out of a contract may examine, of its own motion even, the essential preconditions for its jurisdiction, having regard to conclusive and relevant evidence adduced by the party concerned, establishing the existence or the inexistence of the contract (...) [underscore added].”<sup>1892</sup>

This approach of a (limited) examination of elements of substantive law within the framework of the examination of the admissibility of an action was also confirmed by *Advocate General Darmon* in his Opinion in *Shevill* where the Advocate General clearly explicated:

“(…) (A) dispute as to the existence of a contract does not preclude jurisdiction under Article 5(1) [of the Brussels Convention], even if the court is prompted, for the purposes of determining its own jurisdiction, to examine substantive issues.

What is involved here is the application of the hallowed rule that it is for each court to determine its own jurisdiction.

The outcome is necessarily the same where a court before which proceedings are brought pursuant to Article 5(3) [of the Brussels Convention] has to give a ruling on an objection of lack of competence raised by a defendant denying the existence of the tort. In order to be able to rule on that objection, the court has to verify, on the basis of the evidence adduced by the plaintiff, whether the defendant did or did not commit an act which might render him liable and giving rise to damage within the judicial district of the court [underscores and content in brackets added].”<sup>1893</sup>

Problematically, there is the high risk that a plaintiff, by an apt and clever reasoning, abusively claims the existence of facts which would result in the foundedness of the anchor action, in order to reach a consolidation of the actions concerned. Due to this evident potential of abuse<sup>1894</sup>, a certain restriction of consolidation should be provided. In this respect, it has partly been proposed that the plaintiff should be obliged to prove a degree of likelihood which

<sup>1891</sup> Althammer (2006)26(6) IPRax 558, at p. 562; Mäsch (2005)25(6) IPRax 509, at p. 513; Leible 2011 (Rauscher), Art 6 Brüssel I-VO, para. 10d; Stadler 2012 (Musielak), Artikel 6 EuGVVO, para. 3; Geier 2005, p. 90.

<sup>1892</sup> ECJ 4 March 1982, C-38/81, *Effer SpA v Hans-Joachim Kantner*, [1982] ECR 00825, para. 7 – *Effer*.

<sup>1893</sup> Advocate General 14 July 1994, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415, paras. 108-110 – *Shevill*.

<sup>1894</sup> Althammer (2006)26(6) IPRax 558, at p. 562; Mäsch (2005)25(6) IPRax 509, at p. 513.

exceeds an examination of the conclusiveness, i.e. to prove the preponderant likeliness of the foundedness of the anchor action.<sup>1895</sup>

Slightly more moderate than the foregoing opinion, others have denied a connection between several actions in the case that the anchor action, when being brought, *manifestly lacks any chance of success* (meaning that the action is *manifestly unfounded*<sup>1896</sup>) and therefore appears to be initiated *wantonly*.<sup>1897</sup> In such a constellation, when it is relatively clear right from the start of the proceedings that the action will be held unfounded, there is principally no risk of another conflicting judgment rendered by a court in another forum State.

As to the raised objection that the latter conception goes too far because the greater proportion of the examination of the foundedness of an action should not be anticipated when examining the admissibility of the action,<sup>1898</sup> it is to be admitted that the proposed examination whether the anchor action manifestly lacks any chance of success may create, in a way, some legal uncertainty because the existence respectively non-existence of the manifest absence of any chance of success will have to be evaluated by the invoked court. However, it should be borne in mind that the principle of prohibition of abusive behaviour is a general principle of Community law. Additionally, it is to be stressed that the ECJ has continuously underlined the necessity of a restrictive interpretation of the provisions of special jurisdiction contained in the Brussels Convention/Brussels I Regulation (Brussels Ibis Regulation).<sup>1899</sup>

### 3.3.2.3.4 “Concerted parallel infringements”

Several proposals have been made to ensure that the consolidation of actions will only be undertaken in case that the *defendants* are in some way connected with each other, respectively with the defendant where consolidation of actions shall be accomplished, be it, besides the *spider-in-the-web* constellation, by acting as co-perpetrators (“*Mittäter*”)<sup>1900</sup>, be it by acting as independent perpetrators (“*Nebentäter*”)<sup>1901</sup>.

It has been mentioned above that the Heidelberg Report *only* covers the *spider-in-the-web* constellation, while Article 2:206(2)2(a) of the CLIP Principles is constructed in a broader way which becomes obvious by the formulation that “disputes involve essentially the same factual situation if the defendants have, even if in different States, *acted in an identical manner in accordance with a common policy*”. But what if defendants have acted in an *identical manner*, which is however *not based on a common policy*, although being coordinated in some way, a constellation which could be described as “concerted parallel infringements”? With regard to the constellation of unconcerted parallel infringements, it has already been concluded above that a consolidation of actions will not be possible due to the

<sup>1895</sup> Althammer (2006)26(6) IPRax 558, at p. 562.

<sup>1896</sup> Cf. Schmaranzer 2014 (Burgstaller, Neumayr, Geroldinger & Schmaranzer), Art 6 EuGVO, para. 7; M. Würdinger (case note) ECJ 11 October 2007, C-98/06, Freeport plc v Olle Arnoldsson, (2007)12 ZZPInt 221, at p. 227. Würdinger emphasises that, according to his interpretation of Article 6(1) of the Brussels I Regulation, the *manifest unfoundedness* of the anchor action is to be determined objectively, whereas subjective elements (as an abusive intent of the plaintiff) should not be considered.

<sup>1897</sup> Althammer (2008)28(3) IPRax 228, at p. 232; Thole (2009)122(4) ZZP 423, at pp. 440, 442. Noteworthy, opinions vary as to the question of whether respectively to which extent subjective elements should be taken into consideration when considering the unfoundedness of the anchor action.

<sup>1898</sup> M. Würdinger (case note) ECJ 11 October 2007, C-98/06, Freeport plc v Olle Arnoldsson, (2008)54(1-2) RIW 71, at p. 72.

<sup>1899</sup> Thole (2009)122(4) ZZP 423, at pp. 440, 443.

<sup>1900</sup> Grabinski (2001)50(3) GRUR Int. 199, at p. 207.

<sup>1901</sup> Neuhaus (1996)87(9) Mitt. 257, at pp. 266-267.

principle of foreseeability of jurisdiction in favour of each co-defendant who must be enabled to foresee that he can be sued in the forum where the anchor defendant's domicile is situated.<sup>1902</sup> Should the same apply to “concerted parallel infringements”?

The following sample case shall serve for illustration of this constellation.

Case 10:

P holds a product patent for the Netherlands and Germany. Infringer 1 (INF 1), a Dutch company being domiciled in the Netherlands, manufactures a product which infringes the patent right of P and sells it on the Dutch market. Infringer 2 (INF 2), a German company being domiciled in Germany, also manufactures such a product that infringes the patent right of P and sells it on the German market. INF 1 and INF 2 act independently from each other, but know each other's infringements and coordinate them by not competing with each other in the States where they sell their products.

In comparison with the constellation in Case 7 presented above, INF 1 and INF 2, while committing patent infringements independently from each other, are nonetheless more closely connected in the constellation discussed here, in that INF 1 and INF 2 know each other, and their actings have been undertaken in a coordinated way. On this basis, it is clear to INF 1 and INF 2 that they may be sued, as co-defendants of the respective other defendant as anchor defendant, before a court at the place where the anchor defendant is domiciled. In this constellation, it is sufficiently predictable and foreseeable for INF 1 (respectively for INF 2) that he can also be sued before a court at the place where the other defendant as anchor defendant is domiciled. As a consequence, it would not be irreconcilable with the principle of legal certainty if INF 1 could be sued together with INF 2 at INF 2's place of domicile or *vice versa*.

In this context, it has been rightly emphasised that the underlying reason for consolidating actions at the place of domicile of one of several (alleged) infringers consists in the close connection between the claims rather than between the defendants.<sup>1903</sup> This interpretation was already adopted by *Advocate General Maduro* in his Opinion in *Glaxosmithkline* where the Advocate General declared that

“(…) the connection to which the application of Article 6(1) [of the Brussels I Regulation] is subject requires a finding of a link between the claims. That link must exist in order to ensure, regardless of the court seised, that it has a close relationship to the case, to ensure that that special jurisdiction is properly used for its intended purpose [content in brackets added].”<sup>1904</sup>

Although the aspects of a close connection between the claims/actions and between the defendants can be linked with each other – and will often be in line – in particular the constellation of “concerted parallel infringements” reveals that such a synchronisation is not *necessarily* existent. The sample case illustrates that a close connection between actions can exist where there is no close connection between the defendants, because a close connection between the actions merely requires the existence of essentially the same factual and legal

---

<sup>1902</sup> Heinze 2013 (CLIP Principles), Article 2:206, para. 2:206.C14.

<sup>1903</sup> Hölder 2004, p. 152; Schauwecker 2009, p. 389.

<sup>1904</sup> Advocate General 17 January 2008, C-462/06, *Glaxosmithkline* and *Laboratoires Glaxosmithkline v Jean-Pierre Rouard*, [2008] ECR I-03965, para. 31 – *Glaxosmithkline*.

situation.<sup>1905</sup> In light of this, the open wording of Article 2:206(2) of the CLIP Principles seems most suitable to cover also these cases, while being flexible enough to apply to various constellations.

### 3.3.2.4 Final comment and formulation proposal

To conclude, the detailed approach of Article 2:206 of the CLIP Principles principally provides for a workable solution of the constellation(s) of consolidation of actions against multiple defendants. In comparison with the less clear solution of § 206 of the ALI Principles, it therefore seems preferable.

Article 8(1) of the Brussels Ibis Regulation should thus be extended by using the more precise wording of Article 2:206 of the CLIP Principles, supplemented by another sentence (written in italics). For convenience, the wording should be adapted to the traditional wording of the Brussels Ibis Regulation, meaning that the notions “incompatible” and “habitually resident” should be replaced with the notions “irreconcilable” and “domiciled” (cf. underscores) which should not change their content. In order not to overburden Article 8, a new Article should be created in a recast of the Brussels Ibis Regulation (hereinafter Article 8bis).

#### Article 8bis

(1) A person domiciled in a Member State may also be sued, where he is one of a number of defendants, in the courts for the place where any one of them is *domiciled*, provided the claims 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.

(2) For the purposes of paragraph 1, a risk of irreconcilable judgments requires a risk of divergence in the outcome of the actions against the different defendants which arises in the context of essentially the same situation of law and fact. In particular in infringement disputes and subject to the individual circumstances of the case,

(a) disputes involve essentially the same factual situation if the defendants have, even if in different States, acted in an identical or similar manner in accordance with a common policy;

(b) disputes may involve essentially the same legal situation even if different national laws are applicable to the claims against the different defendants, provided that the relevant national laws are harmonised to a significant degree by rules of a regional economic integration organisation or by international conventions which are applicable to the disputes in question.

(3) If it is manifest from the facts that one defendant has coordinated the relevant activities or is otherwise most closely connected with the dispute in its entirety, jurisdiction according to paragraph 1 is only conferred on the courts in the State where that defendant is domiciled. In other cases, jurisdiction is conferred on the courts in the State or States of domicile of any of the defendants, unless

(a) the contribution of the defendant who is domiciled in the State where the court is located is insubstantial in relation to the dispute in its entirety or

(b) the claim against the domiciled defendant is manifestly inadmissible.

(c) *the claim against the domiciled defendant is manifestly unfounded.*

With regard to an eventual future Global Judgments Convention, the content of § 206 of the CLIP Principles should be adopted.

---

<sup>1905</sup> Schauwecker 2009, p. 389.

### 3.3.3 Exclusive jurisdiction

It has been pointed out in the foregoing chapter that the clear jurisprudence of the ECJ in particular in its *GAT* decision, which has unfortunately been confirmed and codified in Article 24(4) of the Brussels Ibis Regulation, requires an amendment of this provision, also because further relevant problems which already existed under Article 16(4) of the Brussels Convention, respectively Article 22(4) of the Brussels I Regulation, have not been solved by the European legislator when formulating Article 24(4) of the Brussels Ibis Regulation.

After briefly restating the crucial issues that should be subject of such an amendment, I shall discuss existing reform proposals with regard to the matters concerned. Finally, I shall make an own proposal in which way Article 24(4) of the Brussels Ibis Regulation could be amended.

#### 3.3.3.1 Identifying the crucial issues

##### 3.3.3.1.1 Reflexive application of Article 24(4) of the Brussels Ibis Regulation

As has been analysed in the foregoing chapter, it has been subject to controversial discussion whether Article 24(4) of the Brussels Ibis Regulation (respectively its predecessors) should be applied by way of a reflexive application regarding a patent granted in respectively for a State which is no Member State of the European Union. It has been reasoned that such a reflexive application of Article 24(4) is to be denied, be it by way of an *indirect*, be it by way of a *direct* application of this provision.

As there are good reasons why Article 24(4) does not cover cases concerning patents granted in respectively for third States, any reform of Article 24(4) should *not* extend this provision accordingly. Likewise, a future Global Judgments Convention should not contain such a provision either.

##### 3.3.3.1.2 Effect on jurisdiction of an invalidity defence raised before an extraterritorial infringement court

At the beginning of this chapter, it has been shown that the courts of the protection State should not be conferred exclusive jurisdiction as to patent infringement proceedings, but that general rules of jurisdiction should be applicable as to patent infringement actions. In light of this, it would be contradictory if an extraterritorial infringement court lost jurisdiction *in toto*, once a defence of nullity/invalidity has been raised by the alleged infringer.

However, it has been carved out above in Chapter 2 that, according to the interpretation of Article 16(4) of the Brussels Convention (Article 22(4) of the Brussels I Regulation) by the ECJ in its *GAT* decision and the clear wording of Article 24(4) of the Brussels Ibis Regulation which confirms and codifies this jurisprudence of the ECJ, the infringement court *must stay* proceedings, once a nullity/invalidity defence has been raised in patent infringement proceedings.<sup>1906</sup> It has however been elaborated, too, that, upon request of the claimant of the

---

<sup>1906</sup> Noteworthy, the ECJ held in its *Solvay* decision, that Article 22(4) of the Brussels I Regulation (Article 24(4) of the Brussels Ibis Regulation) must be interpreted as not precluding the application of Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation).



infringement action, proceedings are to be completely transferred to the courts being competent pursuant to Article 24(4), while the defendant cannot influence the place of jurisdiction by raising the invalidity defence.

Still, while the latter solution applies to the current legal situation under the Brussels Ibis Regulation, it is to be questioned, regardless of the existing legal framework, whether this solution is the *best solution conceivable*, taking adequately into consideration all concerned interests. If another solution turned out more appropriate, Article 24(4) could and should be amended accordingly. The following paragraphs shall therefore deal with the admissibility of an incidental decision on the validity of a patent, rendered by the extraterritorial infringement court, as an alternative solution, and a number of consequential issues which arise in this context.

### **3.3.3.1.2.1 Admissibility of an incidental decision, rendered by the extraterritorial infringement court, on the validity of a patent once an invalidity defence has been raised**

With regard to the constellation that an invalidity defence is raised before an extraterritorial infringement court during patent infringement proceedings, it might be argued that the sovereignty of the granting State is opposed to incidental decisions on the validity of the patent rendered by that court. Advocates of such a view might refer to the *Act of State*-doctrine and the principle of *comity*. However, it is to be underlined that the granting State cannot claim the worldwide unconditional recognition of the patent. It is noteworthy that the infringement courts of the granting State can also decide on the validity of the patent granted by the competent authority.<sup>1907</sup> In this respect, it is to be borne in mind that the ECJ has constantly emphasised the equivalence and equality of the national courts within the European area of justice. So, the ECJ already held in its *Gasser* decision by reference to its decision in *Overseas Union Insurance*, that

“(…) the court second seised is never in a better position than the court first seised to determine whether the latter has jurisdiction. That jurisdiction is determined directly by the rules of the Brussels Convention, which are common to both courts and may be interpreted and applied with the same authority by each of them (see, to that effect, *Overseas Union Insurance*, paragraph 23) [underscore added].”<sup>1908</sup>

As to the further aspect of mutual trust, which is also embodied in Recital 26 of the Brussels Ibis Regulation,<sup>1909</sup> the ECJ explicated that

“(…) the Brussels Convention is necessarily based on the trust which the Contracting States accord to each other's legal systems and judicial institutions. It is that mutual trust which has enabled a compulsory system of jurisdiction to be established, which all the courts within the purview of the Convention are required to respect, and as a corollary the waiver by those States of the right to apply

---

<sup>1907</sup> Heinze & Roffael (2006)55(10) GRUR Int. 787, at p. 795

<sup>1908</sup> ECJ 9 December 2003, C-116/02, *Erich Gasser GmbH v MISAT Srl*, [2003] ECR I-14693, para. 48 – *Gasser*; referred to in: ECJ 27 April 2004, C-159/02, *Gregory Paul Turner v Felix Fareed Ismail Grovit and Others*, [2004] ECR I-03565, para. 25 – *Turner*.

<sup>1909</sup> Recital 26 of the Brussels Ibis Regulation provides:

“(26) Mutual trust in the administration of justice in the Union justifies the principle that judgments given in a Member State should be recognised in all Member States without the need for any special procedure. In addition, the aim of making cross-border litigation less time-consuming and costly justifies the abolition of the declaration of enforceability prior to enforcement in the Member State addressed. As a result, a judgment given by the courts of a Member State should be treated as if it had been given in the Member State addressed.”

their internal rules on recognition and enforcement of foreign judgments in favour of a simplified mechanism for the recognition and enforcement of judgments (...) [underscore added].”<sup>1910</sup>

Beyond that, in registration systems (“*Registrierungssysteme*”), patents are even granted without being examined in substantive respect.<sup>1911</sup>

After all, the opposite opinion would disregard that the sovereignty of the State where a patent has been granted does not constitute any obstacle against incidental decisions by the extraterritorial infringement court, because the act of granting a patent is no act of public authority. Neither the *Act of State*-doctrine nor the comity principle can therefore serve as arguments against jurisdiction of the extraterritorial infringement court. This applies in particular if the extraterritorial infringement court is merely given authority to render an incidental decision which has only *inter partes* effect, and not *erga omnes* effect. With regard to such a decision *inter partes*, the finding on the validity of the concerned patent does not become *res iudicata* and the existence of the patent is not impaired *erga omnes*. As a consequence, even if the court holds the patent to be void, this does not mean that the granting State must alter the patent register; therefore, the participation of an authority of the granting State is not required.<sup>1912</sup>

Generally, rules on exclusive jurisdiction are to be interpreted in a restrictive way.<sup>1913</sup> As a consequence, exclusive jurisdiction in patent disputes must be constructed and interpreted in a way that does not impair the general rules of jurisdiction more than necessary. The plaintiff respectively the parties (in the case of a prorogation of jurisdiction according to Article 25 of the Brussels Ibis Regulation or in the case of entering an appearance (“*rügelose Einlassung*”) pursuant to Article 26(1) of the Brussels Ibis Regulation), is/are usually to be granted the possibility to choose among a certain amount of fora.<sup>1914</sup> In this respect, it is to be borne in mind that both parties can be interested in reaching a decision on the validity question in one single proceeding before the infringement court.<sup>1915</sup> Further, the courts in the protection State remain competent according to Article 7(2) of the Brussels Ibis Regulation. As a result, exclusive jurisdiction in patent disputes must be constructed and interpreted in a way that does not impair the general rules of jurisdiction more than necessary, which would however be the case if extraterritorial courts were prevented from rendering incidental decisions on the validity of a foreign patent.

Furthermore, the TRIPS Agreement and Article 3 of the Enforcement Directive<sup>1916</sup> particularly emphasise the obligation to ensure the availability of effective and procedurally

---

<sup>1910</sup> ECJ 9 December 2003, C-116/02, *Erich Gasser GmbH v MISAT Srl*, [2003] ECR I-14693, para. 72 – *Gasser*; referred to in: ECJ 27 April 2004, C-159/02, *Gregory Paul Turner v Felix Fareed Ismail Grovit and Others*, [2004] ECR I-03565, para. 24 – *Turner*.

<sup>1911</sup> Schauwecker 2009, p. 418.

<sup>1912</sup> Ebner 2004, p. 166.

<sup>1913</sup> This corresponds to the constant jurisprudence of the ECJ. Cf. Fawcett 2002, p. 164; Torremans 2008, p. 75. However, the ECJ started from this principle in its *GAT* decision when the court interpreted exclusive jurisdiction according to Article 22(4) of the Brussels I Regulation in a rather broad way.

<sup>1914</sup> Fawcett 2002, p. 165.

<sup>1915</sup> Wadlow 1998, para. 3–92.

<sup>1916</sup> Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Corrigendum), OJ L195 of 2 June 2004, pp. 16–25, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2004:195:0016:0025:EN:PDF>> (lastly accessed on 1 June 2015).

economic enforcement of intellectual property rights.<sup>1917</sup> In this regard, it is to be highlighted that the requirement of a (partly) proceeding in the respective protection State is more cumbersome, complicated and costly than having the case decided before one court in a consolidated proceeding.<sup>1918</sup>

At the national level, it is to be stressed that, besides the United States, the majority of the Member States of the European Union use a “*Verbundsystem*”, where (at least also) infringement courts have authority to examine the validity of a patent.<sup>1919</sup> Among the EU Member States, a “*Trennungssystem*”, meaning that the validity issue may only be examined by special authorities and courts, to be distinguished from the infringement courts, has been introduced merely in Germany and Austria, and has even been subject to criticism in these States.<sup>1920</sup> Besides, the exclusion of the invalidity defence before the infringement court according to German law lacks a statutory basis, and is only legitimated by the court practice.<sup>1921</sup> In light of the foregoing, it would seem contradictory to establish a “*Trennungssystem*” at the Community level.<sup>1922</sup>

As an argument against the admissibility of an incidental decision on the validity of a patent rendered by an extraterritorial court, one might put forward that the granting State is interested, based on a targeted promotion of innovation, in a comprehensive annulment (*ex tunc* and with *erga omnes* effect and not only *inter partes* effect) of a patent that does not fulfil the requirements for patentability.<sup>1923</sup> First of all, it has rightly been stressed that the latter argument would at the most argue against an incidental decision with *inter partes* effect, but not against an incidental decision with *erga omnes* effect<sup>1924</sup>. Beyond that, this argument would not sufficiently take into consideration that, in application/registration systems (“*Anmeldesysteme*”/“*Registrierungssysteme*”), the impairment of the freedom of competition by the existence of patents which actually do not fulfil the granting requirements is attributed only minor importance, and the patent is examined only in the case of an eventual infringement proceeding.<sup>1925</sup> As a consequence, it cannot be assumed that only partly non-recognition of such patents would be contrary to the interests of the granting State.<sup>1926</sup> In examination systems (“*Prüfsysteme*”), also as to validity proceedings with *erga omnes* effect, the focus does not lie on the public interest in the comprehensive annulment of patents which do not fulfil the granting requirements, but on the individual interests of the parties concerned. This understanding of an emphasis of individual interests is underlined by the fact that an individual person can be prevented from launching an invalidity action by an agreed no-challenge obligation which is particularly important in the framework of license contracts.<sup>1927</sup>

---

<sup>1917</sup> De Miguel Asensio (2007)16 AIDA 105, at pp. 118-119; P. Schlosser (case note) ECJ 13 July 2006, C-539/03, *Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg*, (2007)62(6) JZ 305, at p. 307.

<sup>1918</sup> Cf. Ebner 2004, p. 209; Luginbühl & Stauder (2006)10(12) sic! 876, at p. 878; Luginbühl 2005, p. 404 et seq.

<sup>1919</sup> Schneider 2005, p. 126 et seq., in particular p. 178 et seq.

<sup>1920</sup> Hölder 2004, pp. 181-184; Tilman (2005)107(11) GRUR 904, at p. 907; as to the issue of coordination between validity proceedings and infringement proceedings pursuant to German national law cf. Ahrens (2009)111(3-4) GRUR 196, at pp. 196-200.

<sup>1921</sup> Cf. Tilman (2005)107(11) GRUR 904, at p. 907.

<sup>1922</sup> Luginbühl & Stauder (2006)10(12) sic! 876, at p. 878.

<sup>1923</sup> Cf. Stauder & Kur 2001, p. 161.

<sup>1924</sup> Schauwecker 2009, p. 418.

<sup>1925</sup> Stauder (1975)24(3) GRUR Int. 86, at p. 87.

<sup>1926</sup> Schauwecker 2009, p. 418.

<sup>1927</sup> Kraßer 2009, p. 613 et seq.

Public interests are merely affected mediately (indirectly).<sup>1928</sup> On the basis of the foregoing, an extraterritorial infringement court cannot be banned from an examination of the validity of a patent with mere *inter partes* effect by reference to an imaginary public interest which even would not be the primary basis of a decision on the validity of that patent rendered in the protection State with *erga omnes* effect.<sup>1929</sup>

In light of the foregoing discussion, it is to be concluded that the extraterritorial infringement court should have authority to render an incidental decision on the validity of a patent concerned in patent infringement proceedings brought before that court.

### **3.3.3.1.2.2 Definition of the term “preliminary question”**

When an invalidity defence is raised in infringement proceedings, the (extraterritorial) infringement court deals with the validity issue as a “preliminary question” that must be answered as a prerequisite for being able to render a decision on the alleged infringement (because a void patent cannot be infringed). In particular English courts have expressed the view that infringement and validity are actually different sides of the same coin, and that it therefore cannot be said that the latter question arises incidentally.<sup>1930</sup> In light of this, it seems indispensable to integrate a definition of the constellation in which circumstances the validity issue is raised as an incidental matter, i.e. by way of a preliminary question.<sup>1931</sup> Thus, in order to avoid the risk of inconsistent interpretations in the EU Member States (respectively third States), the term “preliminary question” should be expressly defined in the Brussels Ibis Regulation (respectively an eventual future Global Judgments Convention).

### **3.3.3.1.2.3 Which effect (if any) should an incidental decision have?**

Since the extent of what becomes *res iudicata* with regard to incidental decisions on the validity of a patent differs among the Member States (no *res iudicata* at all, *inter partes* effect, or *erga omnes* effect), this aspect cannot be used when determining and defining the effect of incidental decisions according to the Brussels Ibis Regulation (and also concerning an eventual future Global Judgments Convention).

Four ways seem conceivable how the effect of incidental decisions on the validity of a patent, rendered by the infringement court when the invalidity defence has been raised, could be developed.

#### **3.3.3.1.2.3.1 Conception 1: Incidental decisions with *erga omnes* effect**

Arguing in favour of assigning *erga omnes* effect to incidental decisions on the validity of a patent, it could be put forth that the fact that private interests are concerned does not necessarily require that decisions with *erga omnes* effect are rendered *in the granting State*.<sup>1932</sup>

---

<sup>1928</sup> Schauwecker 2009, p. 419; Kraßer 2009, p. 611; similar: Hye-Knudsen 2005, pp. 51-52.

<sup>1929</sup> Schauwecker 2009, p. 419.

<sup>1930</sup> Cf. Fawcett 2002, p. 161 with further references.

<sup>1931</sup> Schauwecker 2009, p. 441.

<sup>1932</sup> In detail: Hye-Knudsen 2005, pp. 57-58.

Furthermore, also with regard to decisions with *inter partes* effect, there is the risk that the concerned patent is factually completely devalued in economic respect, because competitors will consider it void and disregard it, or at least could be willing to pay less license fees.<sup>1933</sup> And if the incidental decision of the extraterritorial court had only *inter partes* effect, this could have negative consequences for competition in general, because then merely one party does not have to pay a license fee and is thus privileged towards competitors who have to pay license fees. As a consequence, competitors could be pushed out of the market and barriers to market entry could be raised for new competitors.<sup>1934</sup>

Additionally, assigning *erga omnes* effect to the incidental decision of an extraterritorial infringement court would bring along the advantage of legal certainty, because it would avoid the risk of irreconcilable judgments.

Beyond that, it has been shown above that assigning *erga omnes* effect to incidental decisions on the validity of a patent rendered by an extraterritorial infringement court would also be reconcilable with the aspect of the sovereignty of the granting State.

### 3.3.3.1.2.3.2 Conception 2: Absence of *res iudicata* of incidental decisions

Alternatively, it could be argued that incidental decisions on the validity of a patent rendered by the extraterritorial infringement court should not become *res iudicata* at all.<sup>1935</sup> In this respect, it has been put forth that, even if the incidental decision had *inter partes* effect, the unsuccessful party would be deprived of the possibility to bring an invalidity action before the courts of the granting State, because the prior decision of the infringement court according to which the patent is not infringed, would have to be recognised by the courts of the protection State. The final decision on the validity of a patent shall however be reserved to the courts of the granting State.<sup>1936</sup> Furthermore, it has been stressed that a decision of the infringement court on the invalidity of the concerned patent, even if only having *inter partes* effect, factually limits the protection of the patent to a considerably higher extent than a decision<sup>1937</sup> by which the court merely denies infringement of the patent.

### 3.3.3.1.2.3.3 Conception 3: Incidental decisions with *inter partes* effect

However, better arguments militate for a limitation of *res iudicata* of the incidental decision to *inter partes* effect<sup>1938</sup> and only with regard to the respective infringement action in which the validity issue was brought up.<sup>1939</sup>

First of all, not allowing the unsuccessful party to initiate invalidity proceedings before the courts of the granting State, after the infringement court first seised has made a decision (with *inter partes* effect), does *not* constitute an inadequate result. In this respect, it is to be taken into consideration that, at least between the parties, conflicting decisions on the issue of validity of the patent are avoided (in the absence of an *erga omnes* effect of the decision on

<sup>1933</sup> Schauwecker 2009, p. 421; Dreyfuss (2001) U. Ill. L. Rev. 421, at p. 445

<sup>1934</sup> Schauwecker 2009, p. 421; Dreyfuss (2001) U. Ill. L. Rev. 421, at p. 445

<sup>1935</sup> This approach has been pursued in Article 12(6) Alternatives A and B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001).

<sup>1936</sup> Schauwecker 2009, p. 441 (differently: Bukow 2003, p. 215, there fn. 52).

<sup>1937</sup> Schauwecker 2009, p. 441.

<sup>1938</sup> Cf. Schack 2009, p. 331; cf. also Metzger 2009, pp. 252-253.

<sup>1939</sup> This approach is also pursued in the ALI Principles and in the CLIP Principles.

the validity of the patent, conflicting decisions remain possible if another plaintiff brings an action). Further, both the interests of the plaintiff and the defendant are sufficiently taken into account. On the one hand, the plaintiff bringing an infringement action will, for the sake of safety, prefer an infringement decision with *inter partes* effect, because, in the case of a decision with *erga omnes* effect, there is a high risk that the patent is held void vis-à-vis everybody which can mean a considerable impairment of the patentee's position. Besides, the plaintiff usually could have brought, by his own choice, infringement proceedings before the courts of the granting State because jurisdiction in tort will (also) be existent there. Therefore, it is reasonable that the court certainly could not allow amendment of a foreign patent, which would have eventually been possible if the plaintiff had brought an infringement action before the courts of the protection State.<sup>1940</sup> On the other hand, the defendant of the infringement action could have brought an invalidity action before the courts of the granting State in due time, having the consequence that the infringement court would have stayed the infringement proceeding until the decision of the court first seised. Proceeding in this way, the defendant could have even reached a decision with *erga omnes* effect in the granting State. The infringement court would then have made its decision on the basis of the invalidity of the patent held by the invalidity court. Moreover, if the infringement court, by way of a preliminary question, incidentally, with *inter partes* effect, decides that the concerned patent is void, and consequentially dismisses the infringement action, the alleged infringer will not be interested in additionally gaining a decision by the courts in the granting State having the same content, namely that the patent is void (although the latter decision would have *erga omnes* effect).<sup>1941</sup>

Besides, it is to be considered that *res iudicata* of the incidental decision on the validity of a patent rendered by an extraterritorial infringement court actually does not avoid a later decision on the validity of the patent by a court in the protection State between the same parties as in the infringement proceeding.<sup>1942</sup>

Numerous States, including States with a “*Verbundsystem*” where infringement courts may decide on the validity of patents, provide for specialised courts or administrative authorities for proceedings on the validity of patents with *erga omnes* effect.<sup>1943</sup> Thus, even national courts which are no specialised courts are not allowed to render such decisions with *erga omnes* effect.<sup>1944</sup> In light of this, it is noteworthy that not all States provide for specialised courts for proceedings on the validity of patents. It could thus happen that an ordinary civil court, inexperienced in patent matters, decides, with *erga omnes* effect, on the validity of a foreign patent. This seems contradictory, because (non-specialised) extraterritorial infringement courts could thus be privileged vis-à-vis non-specialised courts in the protection State.<sup>1945</sup>

Probably, the approach of assigning *erga omnes* effect to incidental decisions on the validity of a patent, rendered by extraterritorial infringement courts, could not be realised, because it is a commonly accepted principle that decisions on the validity of a patent with *erga omnes* effect can only be rendered by the courts of the granting State.<sup>1946</sup> This became also clear in

<sup>1940</sup> Cf. Bukow 2003, p. 215, there fn. 52; cf. Wadlow 1998, para. 3–145.

<sup>1941</sup> Cf. Bukow 2003, p. 215, there fn. 52.

<sup>1942</sup> Bukow 2003, p. 215, there fn. 52.

<sup>1943</sup> Schneider 2005, p. 126 et seq.

<sup>1944</sup> Dreyfuss (2001) U. Ill. L. Rev. 421, at p. 443

<sup>1945</sup> Schauwecker 2009, p. 422.

<sup>1946</sup> Fawcett & Torremans 2011, para. 1.69; referring to the Jenard Report: Wadlow 1998, para. 2–108; Bukow 2003, p. 224.

the framework of the negotiations on the Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters.

On the contrary, both the ALI Principles and the CLIP Principles advocate to restrict the incidental decision of an extraterritorial infringement court on the validity of the concerned patent to an *inter partes* effect.

The necessity of an exclusion of *erga omnes* effect of incidental decisions on the validity of a patent, rendered by the (extraterritorial) infringement court,<sup>1947</sup> also results from the fact that the extent of *res iudicata* of incidental questions significantly differs among the national laws of different States. First of all, two aspects with regard to *res iudicata* are to be differentiated: the aspect of *what* is concerned (which is in German law referred to as “*objektive Grenzen der Rechtskraft*”) and the aspect of *who* is concerned (in German law named “*subjektive Grenzen der Rechtskraft*”). As to the first question of what becomes *res iudicata*, most European States (as for instance Austria, Denmark, Finland, Germany, Italy, the Netherlands, Norway, Portugal, Spain, Sweden and Switzerland) provide that incidental decisions do not become *res iudicata* at all, but *res iudicata* only affects the decision on the claim raised.<sup>1948</sup> Differently, for instance in France<sup>1949</sup>, Belgium, Greece and the United Kingdom<sup>1950</sup>, also an incidental decision can become *res iudicata* with *inter partes* effect. Whereas in the United Kingdom this rule of “issue estoppel” is dogmatically considered a rule of evidence, its effect actually corresponds to *res iudicata*.<sup>1951</sup> Regarding the second question of who is concerned by *res iudicata*, it is a common principle in European States that an incidental decision, if admissible on the validity of a patent, decided by the infringement court, has only *inter partes* effect,<sup>1952</sup> while such an incidental decision has no effect vis-à-vis third parties. Apparently, France seems to be an exception to this rule. In the course of the creation of the Brussels Convention, one of the most significant changes of the 1978 Patent Act concerned the extent of a declaration of invalidity that prior to that date only took effect between the parties and has then be extended to take *erga omnes* effect.<sup>1953</sup> Although it has partly been put forward in French legal doctrine that in the case of a raised invalidity defence (*défense au fond* or *exception de nullité*) – in contrast to an invalidity counterclaim (*demande reconventionnelle*) – a decision rendered by the infringement court according to which the patent is held void only has *inter partes* effect as before the reform of patent law in 1978,<sup>1954</sup> several arguments militate against this conception. So, it has been stressed that both the *demande reconventionnelle*, the *défense au fond* and the *exception de nullité* are in fact of similar type, which results in the fact that the court's decision on either of these procedural means has *erga omnes* effect.<sup>1955</sup> In this respect, it is to be taken into consideration that Articles 63 and 64 of the French Code of Civil Procedure expressly provide that also the decision of a *demande reconventionnelle* constitutes an incidental decision:

---

<sup>1947</sup> Kur (2001)50(11) GRUR Int. 908, at p. 913.

<sup>1948</sup> Bukow 2003, p. 215.

<sup>1949</sup> Schack 2010, para. 1008.

<sup>1950</sup> Fawcett & Carruthers 2008 (Cheshire, North & Fawcett), p. 546; Schack 2010, para. 1009.

<sup>1951</sup> Bukow 2003, p. 215, there fn. 51.

<sup>1952</sup> As to the Netherlands, cf. for instance: Brinkhof (2000)31(6) IIC 706, at p. 718; as to the United Kingdom, cf. for instance: Cornish & Llewelyn (2000)31(6) IIC 627, at p. 644; Mangini (1983)42(4) GRUR Int. 226. at p. 233; as to Italy, cf. for instance: Mangini (1983)42(4) GRUR Int. 226. at p. 227 et seq.

<sup>1953</sup> Petit (2000)31(6) IIC 669, at p. 688, there fn. 91; Bukow 2003, p. 216, there fn. 55.

<sup>1954</sup> Cf. Vivant (1991)37(1) RIW 26, at p. 29.

<sup>1955</sup> Treichel 2001, p. 44 et seq., with further references.

**Article 63**

Les demandes incidentes sont : la demande reconventionnelle, (...).

**Article 64**

Constitue une demande reconventionnelle la demande par laquelle le défendeur originaire prétend obtenir un avantage autre que le simple rejet de la prétention de son adversaire.

**(Article 63**

Incidental actions are: the *demande reconventionnelle*, (...).

**Article 64**

A *demande reconventionnelle* constitutes the action by which the original defendant claims to gain a benefit other than a simple defence against the claim of his opponent.)<sup>1956</sup>

Where, before a French infringement court, nullity is alleged as a mere defence rather than a counterclaim, the court might however also simply dismiss the action for lack of infringement without expressly pronouncing nullity of the patent.<sup>1957</sup>

In the United States, in contrast, an incidental decision on the validity of the concerned patent rendered by the infringement court can have, under certain circumstances, *erga omnes* effect (“collateral estoppel”).<sup>1958</sup>

In light of the foregoing, a provision should be established according to which incidental decisions on the validity of the concerned patent shall have *inter partes* effect. Otherwise, there seems *a priori* no chance for an agreement on a solution embedded in an amended version of the Brussels Ibis Regulation, let alone in the framework of an eventual future Global Judgments Convention.

### 3.3.3.1.2.3.4 Conception 4: No definition of the effect of incidental decisions

Apart from the conceptions presented before, another approach could be to merely exclude recognition and enforcement of the incidental decision on the validity of a patent, without establishing any rule as to the effect of this incidental decision.<sup>1959</sup>

Problematically, this approach does not avoid that an incidental decision on the validity rendered by the extraterritorial infringement court gains *erga omnes* effect in the forum State. Such a far-reaching decision should however be reserved to the courts of the granting State. Besides, regarding the risk that incidental decisions on the validity of a patent could be conferred *erga omnes* effect, this approach will not be realisable in practice neither at the European level, embedded in an amended version of the Brussels Ibis Regulation, nor in the framework of a potential future Global Judgments Convention.

<sup>1956</sup> Translation provided by the author of this thesis.

<sup>1957</sup> Petit (2000)31(6) IIC 669, at p. 688; Treichel 2001, p. 43, there fn. 186.

<sup>1958</sup> Schack 2011, paras. 184-186; Wadlow 1998, para. 3-142; Schneider 2005, p. 207, there in fn. 759; Thomas (1996)27 Law & Pol’y Int’l Bus. 277, at p. 307 et seq.

<sup>1959</sup> This approach has been pursued in Article 10 of the Hague Convention on Choice of Court Agreements (2005).



### 3.3.3.1.2.3.5 Conclusion

An analysis of the conceivable possibilities regarding the effect of an incidental decision of an extraterritorial infringement court on the validity of a patent, reveals that, realistically, solely a conception according to which such an incidental decision on the validity of a patent has *inter partes* effect, and not *erga omnes*, seems to be justified and feasible in practice, and should therefore be envisaged and pursued.

### 3.3.3.1.2.4 Stay of infringement proceedings as an alternative to an incidental decision?

Having arrived at the conclusion that an extraterritorial infringement court should have jurisdiction to render an incidental decision on the validity of the patent with *inter partes* effect, once the defendant has raised a defence of invalidity of the patent concerned, a consequential question is whether the deciding court should be given the possibility, *alternatively*, to stay the infringement proceeding until the validity issue has been decided by the courts of the protection State.

On the one hand, one might argue that the mere fact that the defence of invalidity has been raised justifies the stay of infringement proceedings, because the admissibility of an incidental question would not be impaired and there might be good reasons why a stay of infringement proceedings would be more appropriate.<sup>1960</sup> So, one might think of the advantages of a consolidation of proceedings.

However, the better arguments militate for the opposite opinion. To begin, it is to be underlined that the parties' interests do not militate for the need of the possibility of staying infringement proceedings for the sole reason that an invalidity defence has been raised, without a court vested with exclusive jurisdiction on the validity issue having been invoked yet, because the plaintiff has the initial choice of bringing the infringement action before the courts of the granting State, and the defendant should not be given the opportunity to delay the infringement proceeding (torpedo tactic).<sup>1961</sup>

Furthermore, the possibility of staying infringement proceedings once a defence of invalidity is raised might, in practice, effect a complete devaluation of the solution that infringement courts render an incidental decision on the validity of the patent, because extraterritorial infringement courts might then always be tempted to stay proceedings due to the effort produced by the examination of the validity of a foreign patent, and due to a mistaken, misunderstood consideration of the interests of the granting State.<sup>1962</sup>

Beyond that, the possibility of staying infringement proceedings once a defence of invalidity has been raised would effect legal uncertainty.<sup>1963</sup> This result would be opposed to significant ideas of the Brussels Ibis Regulation which considers legal certainty and predictability as fundamental principles.

To conclude, the extraterritorial infringement court should *not* be given the possibility to stay the infringement proceeding, as an alternative for rendering an incidental decision, for the sole reason that a defence of invalidity of the concerned patent has been raised. However, a stay of

---

<sup>1960</sup> Schauwecker 2009, p. 423.

<sup>1961</sup> Schauwecker 2009, p. 423.

<sup>1962</sup> Schauwecker 2009, p. 423.

<sup>1963</sup> Schauwecker 2009, p. 423.

the infringement proceeding should be possible according to and in the framework of the general rules of jurisdiction provided for in the Brussels Ibis Regulation. With accordance to the national procedural rules as to the stay of proceedings applicable in EU Member States<sup>1964</sup>, it would be necessary that *a proceeding on the validity of the patent has already been initiated*, and that there is a sufficient chance that that proceeding will be successful which must be evaluated by the infringement court which stays the infringement proceeding.<sup>1965</sup>

However, while national procedural laws may imply, as a prerequisite of a stay of proceedings, formal requirements such as “serious doubts” as to the validity of the patent,<sup>1966</sup> such formal restrictions should not be integrated in an amended version of the Brussels Ibis Regulation, respectively an eventual future Global Judgments Convention. For it is conceivable that an extraterritorial, unspecialised infringement court does not have any “serious doubts” regarding the validity of the patent, but wants to stay the infringement proceeding because of the complexity and difficulty of the matter.<sup>1967</sup> The criteria for a stay thus cannot be defined *a priori* but should be in the discretion of the infringement court.<sup>1968</sup> Moreover, it could also be argued, although such “serious doubts” can be the reason for staying the infringement proceeding, that the infringement court then is convinced of the invalidity of the patent and should therefore render a decision, because it is highly probable that the patent will be declared void in a subsequent invalidity proceeding with *ex tunc* effect.<sup>1969</sup>

---

<sup>1964</sup> Cf. Dagg (2003)94(1) Mitt. 1, at p. 1 et seq.; with regard to a stay of proceedings according to German law cf. Reimann & Kreye 2003, pp. 587-597.

<sup>1965</sup> As a different solution, it has been proposed to treat the constellation in discussion at the level of coordination of proceedings, and to establish a rule within the framework of the Brussels I(bis) Regulation according to which the infringement court stays infringement proceedings in case that the defendant has raised the invalidity defence and subsequently initiates validity proceedings before the competent court in the protection State within a term to be determined by the infringement court. If validity proceedings are not initiated within this term, the invalidity defence will not be taken into consideration in the infringement proceeding according to this proposal. Such an approach was adopted by the Swiss *Handelsgericht Zürich* (cf. *Handelsgericht Zürich* 16 October 2006, (2007)56(3) GRUR Int. 258, at p. 259) and the Dutch *Hoge Raad* (cf. HR 30 November 2007, C02/228HR and C02/280HR, *Roche Nederland BV* (Netherlands) and Others v Dr. F.J. Primus and Dr. M.D. Goldenberg, NJ 2008, 77 – *Roche Nederland*), and has partly been advocated in the literature, too, cf. McGuire (2011)57(8) WRP 983, at pp. 989-993. In any event, this solution would at least ensure that an invalidity defence will only be effective if the competent court in the protection State is invoked within the time limit determined by the infringement court, which may prevent – at least to some extent – the abusive raise of the invalidity defence. However, despite certain advantages of this approach (ensuring the supremacy of the court at the place of registration concerning all issues of validity and effectiveness while simultaneously allowing for cross-border litigation in infringement disputes, cf. Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 18), good reasons militate against this solution. There would be no guarantee that there is a sufficient chance that the invalidity proceeding will be successful, and it is doubtful whether the infringement court will be able to evaluate the outcome of foreign invalidity proceedings. As a consequence, the defendant in infringement proceedings may – in order to delay these infringement proceedings – raise the invalidity defence although he actually does not intend to initiate invalidity proceedings afterwards. Although, according to this proposal, infringement proceedings continue after the time limit determined by the infringement court has expired, and additional costs have been produced, the defendant might accept this for economic reasons while the plaintiff might be severely harmed. Another problem might consist in the fact that, according to McGuire's proposal, the infringement court would have discretion with regard to the term within which invalidity proceedings must be initiated after the raise of the invalidity defence in the infringement proceeding. This would potentially result in considerable legal uncertainty, also because different infringement courts may determine different terms.

<sup>1966</sup> Cf. for instance § 148 of the German Code of Civil Procedure.

<sup>1967</sup> Schauwecker 2009, p. 442.

<sup>1968</sup> Schauwecker 2009, p. 442.

<sup>1969</sup> Schauwecker 2009, p. 442.

### **3.3.3.1.2.5 Additional rules as to related proceedings**

Article 30(1) of the Brussels Ibis Regulation provides that, where related actions are pending in the courts of different Member States, any court other than the court first seised may stay its proceedings. According to Article 30(3) of the Brussels Ibis Regulation, actions are deemed to be related for the purpose of Article 30 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. With regard to infringement proceedings and validity proceedings, Article 30 of the Brussels Ibis Regulation may become relevant in case that validity proceedings have been initiated before infringement proceedings. In particular, it seems important to complement Article 30 of the Brussels Ibis Regulation by an additional rule which clarifies which factors should be taken into consideration by the court which has to determine whether to stay proceedings, in order to ensure legal certainty and conformity of legal practice within the EU Member States.

### **3.3.3.1.2.6 Stay of infringement proceedings in case of a later brought invalidity action**

Besides, the question arises of whether a stay of infringement proceedings should also be enabled if an invalidity action is brought subsequently, i.e. at a point in time when infringement proceedings have already been initiated. Again, such a provision could be either integrated in the provision on exclusive jurisdiction in patent litigation (Article 24(4) of the Brussels Ibis Regulation) or could be integrated in the general provisions regarding a stay of proceedings.

### **3.3.3.1.2.7 Providing additional rules (besides the rules on the stay of infringement proceedings) with regard to the cooperation between the (extraterritorial) infringement court and the invalidity court**

In the case of patent infringement proceedings pending before an extraterritorial infringement court, and invalidity proceedings, concerning the same patent, pending before the courts of the granting State, be it that those validity proceedings have been brought before or after the infringement action has been initiated, it appears that the sole existence of rules as to a stay of proceedings does not suffice in order to take into adequate consideration the parties' interests and also the general aspect of judicial economy. Rather, rules are required as to establish in which way involved courts shall cooperate with each other in such simultaneously pending multistate proceedings. An amended version of the Brussels Ibis Regulation – and also an eventual future Global Judgments Convention – should therefore imply such rules.

### **3.3.3.1.2.8 Exclusion of recognition and enforcement of an incidental validity decision rendered by the infringement court if the patent has already been declared void by the courts of the granting State**

Regarding the exclusion of recognition of infringement decisions respectively non-infringement decisions, if, in the meanwhile, a court or an authority in the granting State declared the patent to be void, this decision having *erga omnes* and *ex tunc* effect, it is to be noticed that Article 45(1)(d) of the Brussels Ibis Regulation is *not* applicable, because the infringement decision and the invalidity decision do not involve the same cause of action. Article 45(1)(d) of the Brussels Ibis Regulation provides:

#### Article 45(1)(d) of the Brussels Ibis Regulation

(1) On the application of any interested party the recognition of a judgment shall be refused:

(...)

(d) if the judgment is irreconcilable with an earlier judgment given in another Member State or in a third State involving the same cause of action and between the same parties, provided that the earlier judgment fulfils the conditions necessary for its recognition in the Member State addressed.

However, Article 45(1)(c) of the Brussels Ibis Regulation applies.<sup>1970</sup> The provision provides:

#### Article 45(1)(c) of the Brussels Ibis Regulation

(1) On the application of any interested party the recognition of a judgment shall be refused:

(...)

(c) if the judgment is irreconcilable with a judgment given between the same parties in the Member State addressed.

It should not be considered indispensable that the decision of the court or authority is rendered in the course of a separate invalidity proceeding. In States where incidental decisions on the validity of a patent do not only have *inter partes* effect, but *erga omnes* effect,<sup>1971</sup> such decisions should also be recognised to be irreconcilable judgments in order to avoid a contradiction between internal and cross-border cases in these States.<sup>1972</sup>

#### 3.3.3.1.2.9 Contradiction between the incidental decision on the validity of a patent rendered by the extraterritorial infringement court (with *inter partes* effect), and a later decision on the validity of this patent produced by a court in the granting State (with *erga omnes* effect)

Conferring jurisdiction to an extraterritorial infringement court to decide, by way of an incidental decision with *inter partes* effect, on the validity of a patent, bears the risk that, after the infringement court has made such a decision on the validity of the patent, a court of the granting State subsequently renders a contrary decision, which is in principle possible due to the *inter partes* effect of the infringement decision. This problem can occur in two constellations. First, it is conceivable that the infringement court convicts an alleged infringer for patent infringement, but this patent is declared void in a later proceeding by a court of the granting State.<sup>1973</sup> On the other hand, it is possible that the infringement court dismisses the infringement action because it holds the patent to be void, while a court of the granting State subsequently decides that the concerned patent is valid.<sup>1974</sup> In both constellations, *res iudicata*

---

<sup>1970</sup> Admittedly, this opinion is not uncontested. Against the existence of irreconcilability pursuant to Article 27(3) of the Brussels Convention in this constellation: Ancel (2007)8(1) ERA Forum 27, at p. 32; with regard to Article 34(3) of the Brussels I Regulation, in favour of the existence of irreconcilability in this constellation: Fawcett & Torremans 2011, para. 19.30.

<sup>1971</sup> This conception exists in the United States; in Europe, such States are France, Italy and Spain.

<sup>1972</sup> Schauwecker 2009, p. 443.

<sup>1973</sup> Cf. Bukow 2003, p. 214 and there fn. 47;

Ancel (2007)8(1) ERA Forum 27, at p. 32; Hölder 2004, p. 177.

<sup>1974</sup> Bukow 2003, p. 214 and there fn. 47; De Miguel Asensio (2007)16 AIDA 105, at p. 141. However, it is to be conceded that this second constellation will occur considerably less frequently than the first constellation,

of the incidental decision of the infringement court seised first would *not* be opposed to a later decision on the validity of the patent, with *erga omnes* effect, rendered by the courts of the granting State.

Noteworthy, the risk of contradictory decisions does not only exist with regard to cross-border patent infringement proceedings, aroused by the possibility of incidental decisions on the validity of a patent rendered by an extraterritorial infringement court, but also exists at the national level both in States which have established a “*Trennungssystem*” (where the validity and the infringement of a patent are principally examined by different courts), and those which employ a “*Verbundsystem*” (where the courts having jurisdiction to decide on the infringement of a patent may also decide on its validity).<sup>1975</sup> In light of the fact that national law also admits the risk of irreconcilable judgments, it has rightly been underlined that it is not the *specific task* of international procedural law (as according to the Brussels Ibis Regulation) to avoid such dissonant decisions,<sup>1976</sup> but that this problem is to be solved according to the applicable provisions of national law. Consequently, a potential provision on the possibility of bringing an action for restitution respectively damages in case that the decision of the extraterritorial infringement court on the validity of the patent (with *inter partes* effect) is overruled as to the validity issue by a later decision on the validity of the patent, rendered by the courts of the granting State (with *erga omnes* effect), should not be integrated in the Brussels Ibis Regulation. Likewise, such a provision should not become part of an eventual future Global Judgments Convention.

However, the jurisdiction rules of the Brussels Ibis Regulation can at least *contribute* to avoid opposing judgments in the sense of a *general goal*. In this respect, the infringement court should have the *possibility* to stay the infringement proceeding in case that a proceeding on the validity of the concerned patent has already been initiated before a court of the granting State. Besides, international procedural law is affected if an infringement decision shall be recognised and enforced in another State, while the patent has been declared void in the meanwhile with *erga omnes* and *ex tunc* effect. It is at least a *general goal* of international procedural law to avoid the circulation of such opposing decisions in the protection State, and also in other States, because the underlying reason is not the protection of the sovereignty of the granting State, but the consideration of the defendant’s interests who has been wrongly convicted.

To conclude, it is to be stated that, while the defendant's interests are adequately taken into consideration and protected by the possibility that the infringement court may stay the infringement proceeding if a invalidity proceeding has been initiated before the courts of the protection State, it would go too far to confer to the defendant the possibility to wait for the result of the infringement proceeding and, if he is convicted by the infringement court, to initiate an invalidity proceeding in the protection State. As far as the infringement court does not stay the infringement proceeding and, after enforcement has already been undertaken, the patent is declared void by the courts of the protecting State, this situation does not differ from comparable situations occurring in pure national cases without any cross-border context. Accordingly, the Brussels Ibis Recognition does not and should not contain respective rules, but eventual chances of restitution are and should be governed by provisions of national

---

because only few States provide for the possibility that the patent holder has the validity of a patent positively declared in a court decision.

<sup>1975</sup> Cf. Bukow 2003, p. 214 and there fn. 47; Ancel (2007)8(1) ERA Forum 27, at p. 33; cf. Hölder 2004, pp. 177-178.

<sup>1976</sup> Ancel (2007)8(1) ERA Forum 27, at p. 33.

law.<sup>1977</sup> The same should apply with regard to the creation of an eventual future Global Judgments Convention.

### **3.3.3.1.2.10 Conclusion: How should exclusive jurisdiction as to the issue of validity of a patent be constructed?**

To conclude, exclusive jurisdiction regarding the issue of validity of a patent should be constructed in a way which does not exclude extraterritorial courts invoked in patent infringement proceedings from examining the validity of the concerned patent by way of an incidental decision which has *inter partes* effect. The mere fact that a defence of invalidity has been raised should not establish the possibility for the infringement court to stay the infringement proceeding, whereas a stay according to general rules of the Brussels Ibis Regulation should be possible in case that a validity proceeding has already been initiated in the granting State.

Both the possibility to defend against the enforcement of a decision on the infringement of a patent which is subsequently declared void with *erga omnes* and *ex tunc* effect, and the possibility to gain restitution after enforcement, are governed by the rules of national procedural law, if only one State is affected. The Brussels Ibis Regulation is not applicable to solve this issue. In contrast, the Brussels Ibis Regulation applies to the avoidance of cross-border recognition and enforcement of (non-)infringement decisions which subsequently become unjustified because the concerned patent is held valid/void with *erga omnes* and *ex tunc* effect by a court of the granting State.

### **3.3.3.2 Existing reform proposals**

Having identified the crucial issues to be solved with regard to Article 24(4) of the Brussels Ibis Regulation, and having analysed which requirements must be fulfilled, I shall now turn to a discussion and analysis of existing reform proposals in order to find out whether, respectively in which way and in how far these reform proposals deliver answers and solutions with regard to the addressed problematic issues. Besides giving an evaluation of the proposed solutions, I shall finally make an own proposal with regard to an amendment of Article 24(4) of the Brussels Ibis Regulation and corresponding rules on exclusive jurisdiction in patent matters in the framework of an eventual future Global Judgments Convention.

Remarkably, all presented reform proposals contain *several* provisions as to exclusive jurisdiction in patent disputes. This illustrates both the significance and the complexity of the topic.

#### **3.3.3.2.1 Hague Convention on Choice of Court Agreements (2005)**

According to Article 1(1) of the Hague Convention on Choice of Court Agreements (2005), this Convention applies in international cases to exclusive choice of court agreements concluded in civil or commercial matters. With regard to patent infringement, this means that the Hague Convention on Choice of Court Agreements (2005) would merely cover

---

<sup>1977</sup> Schauwecker 2009, p. 443.

contractual infringement actions. Besides, Article 2(2)(n) of the Hague Convention on Choice of Court Agreements (2005)<sup>1978</sup> clearly provides:

**Article 2(2)(n) of the Hague Convention on Choice of Court Agreements (2005)**

This convention shall not apply to the following matters -

(...)

(n) the validity of intellectual property rights other than copyright and related rights.

However, although the Hague Convention on Choice of Court Agreements (2005) thus excludes the matter of validity of a patent from its scope, a look on the Convention is still worthwhile when it comes to the question how to deal with incidental decisions. For the Convention, despite the exclusion of the issue of validity of patents from its scope, allows for the possibility to render an incidental decision on this matter. In this respect, Article 10 of the Hague Convention on Choice of Court Agreements (2005)<sup>1979</sup> only restricts (under certain conditions) the *recognition* and *enforcement* of the ruling on a preliminary question concerning this excluded matter, respectively of a judgment based on such a ruling:

**Article 10 of the Hague Convention on Choice of Court Agreements (2005)**

(1) Where a matter excluded under Article 2, paragraph 2, (...), arose as a preliminary question, the ruling on that question shall not be recognised or enforced under this Convention.

(2) Recognition or enforcement of a judgment may be refused if, and to the extent that, the judgment was based on a ruling on a matter excluded under Article 2, paragraph 2.

(3) However, in the case of a ruling on the validity of an intellectual property right other than copyright or a related right, recognition or enforcement of a judgment may be refused or postponed under the preceding paragraph only where –

(a) that ruling is inconsistent with a judgment or a decision of a competent authority on that matter given in the State under the law of which the intellectual property right arose; or

(b) proceedings concerning the validity of the intellectual property right are pending in that State.

(...).

**3.3.3.2.2 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001)**

Article 12(4) to (6) of the Draft Hague Convention implies three alternatives as to exclusive jurisdiction in the context of intellectual property (Alternative A, Alternative B and Alternative A and B). This indicates that, obviously, there was no consensus on the inclusion

---

<sup>1978</sup> For a detailed analysis of Article 2(2)(n) of the Hague Convention on Choice of Court Agreements (2005) cf. Luginbühl & Wollgast (2006)55(3) GRUR Int. 208, at pp. 210-212; cf. also Luginbühl & Wollgast 2006, pp. 327-331.

<sup>1979</sup> For a detailed analysis of Article 10 of the Hague Convention on Choice of Court Agreements (2005) cf. Luginbühl & Wollgast (2006)55(3) GRUR Int. 208, at pp. 215-216; cf. also Luginbühl & Wollgast 2006, pp. 338-340.

of intellectual property within the scope of the Convention or in respect of each of the proposals themselves.<sup>1980</sup> The three alternative solutions read as follows:

#### **Article 12(4) to (6) of the Draft Hague Convention**

[Alternative A

(4) In proceedings in which the relief sought is a judgment on the grant, registration, validity, abandonment, revocation or infringement of a patent or a mark, the courts of the Contracting State of grant or registration shall have exclusive jurisdiction.

(5) In proceedings in which the relief sought is a judgment on the validity, abandonment, or infringement of an unregistered mark [or design], the courts of the Contracting State in which rights in the mark [or design] arose shall have exclusive jurisdiction.]

[Alternative B

(5A) In relation to proceedings which have as their object the infringement of patents, trademarks, designs or other similar rights, the courts of the Contracting State referred to in the preceding paragraph [or in provisions of Articles [3 to 16]] have jurisdiction.]

Alternatives A and B

[(6) Paragraphs (4) and (5) shall not apply where one of the above matters arises as an incidental question in proceedings before a court not having exclusive jurisdiction under those paragraphs. However, the ruling in that matter shall have no binding effect in subsequent proceedings, even if they are between the same parties. A matter arises as an incidental question if the court is not requested to give a judgment on that matter, even if a ruling on it is necessary in arriving at a decision.]

Alternative A and Alternative B differ from each other with regard to the question of whether proceedings concerning the infringement of registered IP rights should fall within the scope of exclusive jurisdiction rules.<sup>1981</sup> As to the constellation of a patent infringement dispute, the courts of the Contracting State where the patent has been granted would have exclusive jurisdiction for infringement proceedings pursuant to Alternative A. According to Alternative B, courts which have jurisdiction according to Articles 3 to 16 of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) can also hear claims concerning infringement of registered IP rights, i.e. including patents.<sup>1982</sup>

Regardless of whether patent infringement claims fall within the scope of the exclusive jurisdiction provision or not, such exclusive jurisdiction rules would not be applicable in case that one of the matters mentioned in Alternatives A or B arises as an incidental question in the proceedings of a court having no exclusive jurisdiction according to Article 12 of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001).<sup>1983</sup> It is noteworthy that Article 12(6) Alternatives A and B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) provides that an incidental decision on the validity of a patent does not become *res iudicata* at all, i.e. does not even have *inter partes* effect. By this provision, the extent of exclusive

<sup>1980</sup> Cf. footnote 80 to Article 12 of the Draft Hague Convention; cf. also Kono & Jurčys 2012, p. 34.

<sup>1981</sup> Kono & Jurčys 2012, p. 34.

<sup>1982</sup> Kono & Jurčys 2012, p. 34.

<sup>1983</sup> Kono & Jurčys 2012, p. 34.



jurisdiction should be limited to the cases where the validity issue arises as the main issue of the proceedings.<sup>1984</sup> Beyond that, Article 12(6) Alternatives A and B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) comprises a definition of an incidental question.

However, no agreement could be achieved at all between the delegations that tried to establish the Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001). As a consequence, the Convention did not enter into force but remained in the stadium of a draft.

### **3.3.3.2.3 ALI Principles**

#### **3.3.3.2.3.1 General orientation – Solution via subject-matter jurisdiction instead of possibility of incidental decisions**

The ALI Principles contain several rules as to the relationship between exclusive jurisdiction in patent matters when the validity of the patent is concerned, and patent infringement proceedings. These rules are in particular embodied in § 211(2), § 212(4) and § 213(2) and (3) of Part II. Jurisdiction, Chapter 2. Jurisdiction over the Subject Matter, of the ALI Principles.

The localisation of these provisions under the heading of “Jurisdiction over the Subject Matter” reveals that the ALI Principles approach the issue indirectly from the angle of subject-matter jurisdiction,<sup>1985</sup> rather than providing for the possibility of the infringement court to render an incidental decision on the validity of the concerned patent. Accordingly, the ALI Principles contain no definition of such incidental decisions, let alone rules as to the above raised questions in conjunction with such incidental decisions rendered by the infringement court.

The fundamental conception of the ALI Principles is that each State controls the reach of authority of its courts over the subject-matter of disputes. However, for the sake of efficiency<sup>1986</sup>, the rules on adjudicatory authority are broad enough to encompass foreign claims. In cases where such authority is unavailable, the ALI Principles provide a mechanism for cooperative adjudication.<sup>1987</sup> Such provisions are contained in § 221, § 222 and § 223 of Part II. Jurisdiction, Chapter 3. Jurisdiction over Simplification: Coordinating Multiterritorial Actions, of the ALI Principles. The latter rules on coordination of proceedings shall be discussed at a later point.

I shall start my analysis of the ALI Principles with the relevant rules contained in § 211(2), § 212(4) and § 213(2) and (3) of the ALI Principles. § 211 of the ALI Principles provides:

#### **§ 211. Subject-Matter Jurisdiction over Claims**

(1) Except as provided in subsection (2), a court is competent to adjudicate claims arising under foreign laws pertaining to the subject-matter of these Principles. However, with respect to each asserted claim,

---

<sup>1984</sup> Kono & Jurčys 2012, p. 34; Nygh/Pocar Report, p. 70.

<sup>1985</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.N14; Kono & Jurčys 2012, pp. 36-37.

<sup>1986</sup> The approach of the ALI Principles is strongly influenced by efficiency considerations. Cf. in detail: Kono & Jurčys 2012, pp. 36-37.

<sup>1987</sup> The American Law Institute 2008 (ALI Principles), § 211, Comment a. on § 211.

the court must have subject-matter jurisdiction under its local law and personal jurisdiction under §§ 201-207.

(2) A judgment holding registered rights granted under the laws of another State invalid is effective only to resolve the dispute between or among the parties to the action.

While § 211 of the ALI Principles is based on the conception that issues regarding the validity of a patent should in principle be adjudicated in the courts of the State in which the patent was granted, the ALI Principles still admit, in § 211(2), an exception as to the adjudication of matters involving patents of a foreign State, because separating adjudication of validity from infringement may have substantive ramifications.<sup>1988</sup> Accordingly, it has been underlined that separate resolutions can prevent a court from hearing all of the evidence relevant to the action and from using its understanding of how a technology is utilised to inform its decision on the scope of the right. Besides, bifurcating validity and infringement can increase the parties' costs. In light of this, the ALI Principles permit adjudication, while confining its effect to the parties to that litigation (cf. § 211(2) of the ALI Principles).<sup>1989</sup> Noteworthy, the ALI Principles do not start from the general rule of preclusion law that decisions holding a patent valid cannot bind third parties. Thus, when the validity of a patent is upheld, an exclusion equivalent to that of § 211(2) is not required.<sup>1990</sup>

The limit on jurisdiction implied in § 211(2) of the ALI Principles (*inter partes* effect) is enforced by § 413(2) of the ALI Principles on the level of recognition and enforcement. § 413 of the ALI Principles provides:

#### **§ 413. Declarations of Validity, Invalidity, Infringement, and Ownership of Rights**

(1) Except as provided in subsection (2), declarations by a foreign court of validity, invalidity, infringement, or ownership of intellectual property rights shall be recognized and enforced by the enforcement court.

(2) If a court in one State declares that a right registered in another State is invalid, the declaration is effective only to resolve the dispute between or among the parties to the litigation.

Another provision, being of particular interest with regard to an (invalidity) defence, is § 212(1) and (4) of the ALI Principles:

#### **§ 212. Subject-Matter Jurisdiction over Counterclaims. Supplemental Claims and Defenses**

(1) A court may determine all claims and defenses among the parties arising out of the transaction, occurrence, or series of transactions or occurrences on which the original claim is based, regardless of the territorial source of the rights at issue or of the party that asserts them. However, with respect to each asserted claim, the court must have subject-matter jurisdiction under its local law and personal jurisdiction under §§ 201-207.

(...)

(4) A court has authority to consider defenses related to the invalidity of registered rights. In a dispute in which a court in one State has determined that a right registered in another State is invalid, the judgment is effective only to resolve the dispute between or among the parties to that action.

---

<sup>1988</sup> The American Law Institute 2008 (ALI Principles), § 211, Comment b. on § 211.

<sup>1989</sup> The American Law Institute 2008 (ALI Principles), § 211, Comment b. on § 211.

<sup>1990</sup> The American Law Institute 2008 (ALI Principles), § 211, Reporters' Notes 1. on § 211.

Noteworthy, § 212(1) of the ALI Principles adopts a transactional approach to determine the appropriate scope of litigation. This approach will be subject to a closer analysis below.

§ 212(4) of the ALI Principles contains a special rule on the authority of a court to consider an invalidity defence raised in a patent infringement proceeding.<sup>1991</sup> As to the situation that the court of one State declares a patent granted in respectively for another State invalid, § 212(4) of the ALI Principles clearly states that that decision has only *inter partes* effect and merely concerns the dispute in which the validity issue was raised. This rule in § 212(4) of the CLIP Principles is similar to the rule set out in § 211(2) of the CLIP Principles, when the claim is raised in the first instance by the plaintiff.

Another provision of considerable interest in this context is § 213(2) and (3) of the ALI Principles which provides:

### § 213. Declaratory Judgments

(...)

(2) Except as provided in subsection (3), an action to obtain a declaration of the invalidity of a registered right may be brought only in the State of registration.

(3) An action to declare the invalidity of the rights registered in two or more States may be brought in the State or States in which the defendant is resident, but the judgment will be effective only to resolve the dispute between or among the parties to the action.

§ 213(2) of the ALI Principles reflects the general conception that issues concerning the validity of a patent should be adjudicated in the courts in the granting State. While the ALI Principles do not generally prohibit the adjudication of matters involving a foreign State's patent, these adjudications receive special treatment.<sup>1992</sup> In case that the sole objective of the litigation is a declaration of invalidity of a patent under the law of a particular State, § 213(2) of the ALI Principles requires adjudication of the case in the courts in that State. On the other hand, where patents under the laws of multiple States are involved, § 213(3) of the ALI Principles permits the suit only in the right holder's residence(s), but provides that the decision has only *inter partes* effect.<sup>1993</sup> In this respect, § 213(3) of the ALI Principles resembles the provision of § 212(4) of the ALI Principles.<sup>1994</sup> In light of the foregoing explications as to § 211(2), § 212(4) and § 213(3) of the ALI Principles, it becomes obvious that the ALI Principles apply this solution to any determination of invalidity. This rule has rightly been characterised as a compromise: While courts are reluctant to second-guess the acts of foreign public authorities, the rule brings along efficiency gains. Moreover, separating adjudication of validity from infringement may have substantive ramifications because it prevents a court from hearing all of the evidence relevant to the action and from using its understanding of how a technology is utilised to inform its decision on the scope of the patent. Moreover, bifurcating validity and infringement can also increase parties' costs.<sup>1995</sup> Therefore,

---

<sup>1991</sup> In contrast to an invalidity defence, a counterclaim for invalidity appears not to fall within the scope of § 212(4) of the ALI Principles. As a consequence, counterclaims must principally be brought in the courts of the State where the patent has been granted (§ 213(2) of the ALI Principles), cf. Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.N14, there fn. 58.

<sup>1992</sup> The American Law Institute 2008 (ALI Principles), § 213, Comment b. on § 213(2) and (3).

<sup>1993</sup> The American Law Institute 2008 (ALI Principles), § 213, Comment b. on § 213(2) and (3).

<sup>1994</sup> The American Law Institute 2008 (ALI Principles), § 212, Comment h. on § 212(4).

<sup>1995</sup> The American Law Institute 2008 (ALI Principles), § 213, Comment c. on § 213(3).

§ 213(3) of the ALI Principles provides for the possibility that a court in one State may adjudicate the validity of a patent granted in, respectively for another State, but only to clarify the rights of the parties between or among themselves.

### 3.3.3.2.3.2 Additional rules as to related proceedings

The ALI Principles contain, in § 221, § 222 and § 223 of Part II. Jurisdiction, Chapter 3. Jurisdiction over Simplification: Coordinating Multiterritorial Actions, rules with regard to the *coordination* of actions brought before different courts.

To get an idea of the structure of this approach, it is worthwhile having a look on § 221(1) and (2) of the ALI Principles in particular which provides:

#### § 221. Coordination Authority of the Court First Seized with an Action Involving the Party Seeking Coordination

(1) Any party engaged in actions involving the same transaction, occurrence, or series of transactions or occurrences in the courts in different States may move to have the actions coordinated through cooperation or consolidation under these Principles. The motion shall be timely submitted and specify the actions to be coordinated.

(a) If the parties in all the actions are the same, the motion should be made in the court first seized.

(b) If the parties in all the actions are not the same, the motion should be made in the court first seized with an action involving the moving party.

(c) Where permitted by local law, the court first seized may consider coordination on its own motion, while affording the parties an opportunity to be heard in the matter.

(2) If the court designated by subsection (1) finds that some or all of the claims in the specified actions in other courts arise out of the same transaction, occurrence, or series of transactions or occurrences as the claims before the court, the court shall assert coordination authority over those actions and decide, in accordance with § 222, whether the actions will proceed through cooperation or consolidation or a combination of the two.

In contrast to the system used in the Brussels Ibis Regulation which differentiates between “actions involving the same cause of action and between the same parties” (cf. Article 29 of the Brussels Ibis Regulation) and “related actions” (cf. Article 30 of the Brussels Ibis Regulation),<sup>1996</sup> the ALI Principles adopt a rather broad concept of actions arising from the “same transaction” to determine the appropriate scope of litigation.<sup>1997</sup> Slightly varying in the formulation, this transactional approach refers to “actions involving the same transaction, occurrence, or series of transactions or occurrences”.<sup>1998</sup> As the Commentary on the ALI Principles has stressed, this transactional approach is to be understood in light of the goals of

---

<sup>1996</sup> This system has been adopted by the CLIP Principles.

<sup>1997</sup> Interestingly, the ALI Principles anyway use the term “related actions”, in particular in § 222 and § 223, but with another connotation, based on the fact that there is no clear differentiation comparable to the relationship between Articles 27 and 28 of the Brussels I Regulation.

<sup>1998</sup> This approach is also different from the approach pursued within the CLIP Principles which differentiate between “congruent” proceedings (Article 2:701 of the CLIP Principles) and “related” proceedings (Articles 2:702 and 2:703 of the CLIP Principles), the latter also covering the relationship between patent infringement proceedings and patent invalidity proceedings.

the ALI Principles to ensure efficiency and fairness. A narrow scope of authority would require parties pursuing claims and enforcing judgments to proceed before several courts simultaneously, which would undermine both objectives. The question of whether there is the same transaction, occurrence, or series of transactions or occurrences, depends on the relationship between the operative facts and the relatedness of the issues in the dispute in time, space, origin, and motivation. However, the ultimate question affects the convenience of trial and the expectations of the parties in light of evolving practices in transnational litigation.<sup>1999</sup> § 221 of the ALI Principles avoids the “cause of action”-terminology – as employed by the Brussels Ibis Regulation – because the “cause of action”-terminology can be confusing and has been considered having proved ambiguous in the United States.<sup>2000</sup> Notably, the “same transaction”-concept goes beyond pure parallelism in order to bring before the court first seised all actions that, from efficiency and fairness perspectives, should be tried in a coordinated way.<sup>2001</sup>

§ 221(1)1 of the ALI Principles gives the *parties* of actions brought before the courts in different States the opportunity to move to have actions coordinated or consolidated, if the actions involve the same transaction, occurrence, or series of transactions or occurrences (cf. § 221(1)1 of the ALI Principles). Besides, provided that local law so admits, the court first seised has authority to consider coordination on its own motion (*ex officio*) (cf. § 221(1)2(c) of the ALI Principles). This is due to the insight that the efficiencies that can be achieved are as much in the interest of the parties as they are an interest of the judicial system.<sup>2002</sup>

As to the question of when a court is seised, § 221(4) of the ALI Principles, actually being adapted from Article 30 of the Brussels I Regulation (Article 32 of the Brussels Ibis Regulation),<sup>2003</sup> provides:

**§ 221. Coordination Authority of the Court First Seised with an Action Involving the Party Seeking Coordination**

(...)

(4) A court is “seised”:

(a) when the document instituting the action, or an equivalent document, is filed with the court, provided that the plaintiff subsequently takes the required steps to provide notice to the defendant; or

(b) if the document has to be served before being filed with the court, when it is served or received by the authority responsible for service, whichever is earlier, provided that the plaintiff subsequently files the document with the court.

Both with regard to cooperation and consolidation, the parties must be heard (cf. § 221(1)2(c) of the ALI Principles). As a consequence, the main role of the court is to sensibilise the parties of the possibilities meaning to make them aware that these possibilities exist.<sup>2004</sup>

<sup>1999</sup> The American Law Institute 2008 (ALI Principles), § 212, Comment d. on § 212(1).

<sup>2000</sup> The American Law Institute 2008 (ALI Principles), § 221, Comment c. on § 221 and Reporters' Notes 2. on § 221.

<sup>2001</sup> The American Law Institute 2008 (ALI Principles), § 221, Comment c. on § 221.

<sup>2002</sup> The American Law Institute 2008 (ALI Principles), § 221, Comment c. on § 221.

<sup>2003</sup> The American Law Institute 2008 (ALI Principles), § 221, Reporters' Notes 5. on § 221.

<sup>2004</sup> The American Law Institute 2008 (ALI Principles), § 221, Comment c. on § 221.

The other court or courts seised must stay actions brought before them which are within the consolidation (cf. § 223 of the ALI Principles). But things may be different if actions for a declaratory relief come into play. In this respect, § 213(4) and § 221(5)(b) of the ALI Principles are to be taken into consideration. These provisions read as follows:

**§ 213. Declaratory judgments**

...

(4) A court exercising jurisdiction under this Section may not exercise coordination authority under § 221.

**§ 221. Coordination Authority of the Court First Seized with an Action Involving the Party Seeking Coordination**

...

(5) A court seised with a coercive action seeking substantive relief is “first seized” when:

...

(b) no other court had previously been seized with a coercive action seeking substantive relief (...).

Thus, in case that the action before the first court is for declaratory relief which includes a declaration of non-infringement of a patent, this court has no authority to consolidate. Rather, the court seised with the coercive action is considered as “first seized” and therefore has authority to coordinate. As a consequence, an action for a declaration of non-infringement of a patent does not take priority over a subsequent action aimed at enforcing the patent.<sup>2005</sup> However, it is to be noticed that declarations on the invalidity of a patent are not covered by that rule. Consequently, the courts before which such actions are brought do have authority to coordinate.<sup>2006</sup>

**3.3.3.2.3.3 The ALI Principles' response to the stated need for a provision about the possibility of staying infringement proceedings in case of a later brought invalidity action**

Like the Brussels Ibis Regulation, the ALI Principles do not address the constellation of subsequent invalidity proceedings when an infringement action concerning the same patent has already been initiated before another court.

**3.3.3.2.3.4 The ALI Principles' response to the stated need for additional rules (besides the rules on the stay of infringement proceedings) with regard to the cooperation between the (extraterritorial) infringement court and the invalidity court**

According to § 221(2) of the ALI Principles, the court shall assert coordination authority over the concerned actions and decide, in accordance with § 222, whether the actions will proceed through cooperation or consolidation or a combination of the two. If the court chooses cooperation, then each court involved decides on the respective action which has been

---

<sup>2005</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.N04.

<sup>2006</sup> Cf. Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.N04.

brought before it. If consolidation is chosen as adequate mode of coordination, the designated court has discretion – informed by the parties – to find a court well suited to resolve the entire dispute.<sup>2007</sup> According to the distinct wording of § 221(2) of the ALI Principles (“cooperation or consolidation or a combination of the two”) which is picked up in § 222(1)1 of the ALI Principles, it is also possible to combine the two approaches of cooperation and consolidation. As becomes clear with regard to the wording of § 221(2) of the ALI Principles (“in accordance with § 222”), § 221(2) must be read in conjunction with § 222 of the ALI Principles which contains further rules as to cooperation among courts. In this respect, it is particularly § 222(3) of the ALI Principles that should be taken into account. This provision provides:

**§ 222. Coordination Among Courts and Consolidation of Territorial Claims by the Court First Seized**

(...)

(3) If the court determines that cooperative resolution of all or of part of the dispute is appropriate, the court shall so inform all courts involved in the coordination and order the parties to draw up a plan for resolving the dispute in a just and expeditious manner.

The reason for providing for the possibility of cooperation between courts is the insight that this instrument is an effective way to move towards global dispute resolution, the involved courts having a strong interest in saving resources, avoiding inconsistent adjudication and judgments that will not be fully enforced in practice.<sup>2008</sup> It has rightly been suggested in the Reporters' Notes on § 222 of the ALI Principles that the parties in patent disputes have substantial incentives to cooperate, where foreign courts (and in some cases, domestic courts) have no authority to render a decision on the validity of the patent. In such cases, litigation may actually best be situated in each State in which the patents have been granted. Simultaneously, substantial benefits could however be achieved if, before any trial commences, the parties agree to take the inventor's testimony a single time, choose to focus their disputes on the same embodiments of the accused device, and stipulate to the documents and practices that constitute the prior art, or agree to be bound by that single court's factual determinations.<sup>2009</sup> Patent judges are considered to already dispose of a longstanding practice of meeting to share expertise in patent adjudication. Besides, while courts could still arrive at different decisions on validity or infringement, there is in fact no real inconsistency because the laws applied are different, and, frequently, exploitation in one territory is unaffected by exploitation in another State.<sup>2010</sup>

Another provision to be taken into consideration as to cooperation between involved courts is § 223(2) of the ALI Principles which reads:

**§ 223. Disposition of the Dispute by Other Court or Courts Seized with the Action**

(...)

(2) If the court designated determines that the dispute should be adjudicated cooperatively, courts in which related actions are pending shall consult with the parties, the court first seized, and other courts in

<sup>2007</sup> The American Law Institute 2008 (ALI Principles), § 221, Comment b. on § 221.

<sup>2008</sup> The American Law Institute 2008 (ALI Principles), § 222, Reporters' Notes 1. on § 222.

<sup>2009</sup> The American Law Institute 2008 (ALI Principles), § 222, Reporters' Notes 1. on § 222.

<sup>2010</sup> The American Law Institute 2008 (ALI Principles), § 222, Reporters' Notes 1. on § 222.

which related actions are pending, to determine the scope of each court's authority and the timing of each court's proceedings.

If the dispute is coordinated through cooperation, § 223(2) of the ALI Principles instructs the courts to facilitate that approach,<sup>2011</sup> which also provides for the active exchange of information between courts.<sup>2012</sup>

### **3.3.3.2.4 Principles on Conflict of Laws in Intellectual Property (CLIP Principles)**

The CLIP Principles provide, in Article 2:401 (Registration and invalidity) and Article 2:402 (Obligation of other courts) for detailed jurisdiction rules with regard to exclusive jurisdiction. Being of significant meaning also for the constellation that an invalidity defence is raised in patent infringement proceedings, the CLIP Principles contain further provisions with regard to the coordination of proceedings, and recognition and enforcement. These additional rules, as far as being relevant in the given context, shall be presented and discussed later. First, Articles 2:401 and 2:402 of the CLIP Principles shall be subject to a closer analysis.

Articles 2:401 and 2:402 of the CLIP Principles read as follows:

#### **Article 2:401: Registration and invalidity**

(1) In disputes having as their object a judgment on the grant, registration, validity, abandonment or revocation of a patent, a mark, an industrial design or any other intellectual property right protected on the basis of registration, the courts in the State where the right has been registered or is deemed to have been registered under the terms of an international Convention shall have exclusive jurisdiction.

(2) Paragraph 1 does not apply where validity or registration arises in a context other than by principal claim or counterclaim. The decisions resulting from such disputes do not affect the validity or registration of those rights as against third parties.

#### **Article 2:402: Obligation of other courts**

Where a court of a State is seised of a claim which has as its object a matter over which the courts of another State have exclusive jurisdiction by virtue of Article 2:401, it shall declare of its own motion that it has no jurisdiction.

### **3.3.3.2.4.1 Admissibility and definition of the circumstances of an incidental decision, rendered by the extraterritorial infringement court, on the validity of a patent once an invalidity defence has been raised**

Article 2:401(1) of the CLIP Principles implies a confirmation of the rule that, in principle, exclusive jurisdiction with regard to a decision on the validity of a patent, is assigned to the courts of the State where the patent has been granted.<sup>2013</sup> However, in contrast to Article 24(4) of the Brussels Ibis Regulation, according to which this provision is applicable “in proceedings *concerned with* the (...) validity of patents”, Article 2:401(1) of the CLIP Principles restricts the scope of exclusive jurisdiction to “disputes *having as their object* a

<sup>2011</sup> The American Law Institute 2008 (ALI Principles), § 223, Comment a. on § 223.

<sup>2012</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.N02.

<sup>2013</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C01.



judgment on the (...) validity (...) of a patent”. The background of this wording in Article 2:401(1) of the CLIP Principles is to make clear that exclusive jurisdiction is justified (only) in those scenarios that are *essentially* concerned with validity etc., where the validity issue etc. is at the heart of the case and constitutes the real object of the litigation, i.e. where the decision on validity made by a foreign court jeopardises the validity of the patent which is at stake in the proceedings.<sup>2014</sup> Consequently, Article 2:401(1) of the CLIP Principles does not cover cases that only marginally touch on the validity issue etc., the real object of the litigation being in fact different.<sup>2015</sup> As has been emphasised by the Commentary on the CLIP Principles, it already follows from this interpretation of the wording of Article 2:401(1) of the CLIP Principles that exclusive jurisdiction according to Article 2:401(1) does not exist as long as the decision only deals with validity as an incidental matter, to the effect that the ruling – in its final outcome – only resolves the actual dispute between the parties, in contrast to a decision having *erga omnes* effect, which would be the case with regard to proceedings brought before the competent authorities in the granting State.<sup>2016</sup> Beyond that, Article 2:401(2)1 of the CLIP Principles sets out explicitly – and thus explicitly provides for the possibility of an incidental decision on this matter and defines the circumstances when such an incidental decision is made – that the rule of exclusive jurisdiction according to Article 2:401(1) does not apply in case that the validity issue is raised in a context other than by principal claim or counterclaim. As a consequence, exclusivity does not prevail in cases where the validity issue is brought by way of a defence in infringement proceedings.<sup>2017</sup> In establishing such a legal regime, Article 2:401 of the CLIP Principles aims to reconcile the need to facilitate efficient cross-border litigation with the principle of territoriality of IP rights.<sup>2018</sup>

### 3.3.3.2.4.2 Definition of the effect of an incidental decision

As to the effect of an incidental decision on the validity of the concerned patent, Article 2:401(2)2 of the CLIP Principles explicitly precludes that incidental decisions have *erga omnes* effect: such decisions do not affect the validity of the concerned patent as against third parties, meaning that the decision on validity of the patent will not become *res iudicata* for third parties or for the registry. Rather, such incidental decisions are limited to resolving the infringement dispute as between the parties. The decision does not even have a binding effect between the parties for other purposes beyond the scope of the respective infringement proceeding in which the validity issue was raised.<sup>2019</sup> However, Article 2:401(2) of the CLIP Principles does *not* imply that the seised court *must* render such an incidental decision on the validity of the concerned patent. In contrast, *if validity proceedings have already been brought in the granting State in the meanwhile*, the court also has discretion not to make a decision on the validity at all, but to stay the infringement proceedings according to Article 2:703(1) of the CLIP Principles if this seems to be the better alternative in view of the

<sup>2014</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C07; cf. Hof van Cassatie 1 October 2010, X v Universitair Medisch Centrum Utrecht and Others, [2011] 1 Tijdschrift@ipr.be (<http://www.ipr.be>), 73.

<sup>2015</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C07.

<sup>2016</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C07.

<sup>2017</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C09, and there fn. 13: The Commentary on the CLIP Principles suggests that the somehow repetitive formulation of Article 2:401(1) and (2) of the CLIP Principles might be owed to the fact that the ECJ, as to the interpretation of a corresponding formulation in Article 16(4) of the Brussels Convention, interpreted the applicability of exclusive jurisdiction in a rather broad way, cf. ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509, paras. 18-19 – *GAT*.

<sup>2018</sup> Kono & Jurčys 2012, p. 43.

<sup>2019</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C10.

cooperation of proceedings.<sup>2020</sup> In exercising this discretion, the infringement court may, *inter alia*, consider whether the invalidity actions are well founded.<sup>2021</sup>

Noteworthy, Article 2:401 of the CLIP Principles also applies in case of an action for a declaration of non-infringement, because Article 2: 602 of the CLIP Principles provides:

**Article 2:602: Declaratory actions**

Subject to Article 2:401, an action for a declaratory judgment may be based on the same ground on jurisdiction as a corresponding action seeking substantive relief.

As a consequence, the seised court has authority to render an incidental decision on the validity of the concerned patent with *inter partes* effect.

Article 2:402 of the CLIP Principles<sup>2022</sup> supplements Article 2:401 of the CLIP Principles in order to give effect to the exclusive jurisdiction clause. As one or more parties may accidentally – or even deliberately – ignore the exclusive jurisdiction clause, Article 2:402 of the CLIP Principles provides that the infringement court will declare of its own motion (*ex officio*) that it has no jurisdiction if an invalidity defence is raised in the course of the infringement proceeding.<sup>2023</sup>

**3.3.3.2.4.3 Stay of infringement proceedings as an alternative to an incidental decision?**

Section 7 of Part 2 of the CLIP Principles, which deals with the coordination of proceedings, starts from the situation that at least two proceedings have to be coordinated. This logically requires that the rules contained in Section 7 (Articles 2:701 to 2:706 of the CLIP Principles) prerequisite that at least two proceedings have already come into play, while it does not suffice that a second (or further) proceeding *will eventually* be initiated. Rather, the decisive element for a stay of proceedings according to the rules of the CLIP Principles<sup>2024</sup> is that another court *has actually been seised*. The rules of Section 7 of Part 2 of the CLIP Principles are applicable to parallel proceedings that are pending simultaneously without a judgment having been given in either of the proceedings yet (*lis pendens*), but also apply if one of the proceedings has already resulted in a judgment, irrespective of whether this judgment is final or subject to appeal (cf. Article 2:704(1) of the CLIP Principles: “are or have been pending”).<sup>2025</sup>

In light of this, the mere fact that an invalidity defence is raised does not suffice for staying infringement proceedings. Rather, the infringement court has authority to decide on the invalidity of the concerned patent by way of an incidental decision having *inter partes* effect and only for the scope of the respective infringement proceeding in which the validity issue was raised (cf. Article 2:401(2)2 of the CLIP Principles). A stay requires that two (or more)

---

<sup>2020</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C10.

<sup>2021</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.C11.

<sup>2022</sup> It is noteworthy that the ALI Principles do not contain any provision corresponding to Article 2:402 of the CLIP Principles.

<sup>2023</sup> Torremans 2013 (CLIP Principles), Article 2:402, para. 2:402.C01.

<sup>2024</sup> The relevant provisions (which will be discussed in detail later, as far as being relevant in the given context) are, in particular, Articles 2:702, 2:703 and 2:704 of the CLIP Principles.

<sup>2025</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:700, para. 2:700.C04.

proceedings before different courts have actually come into play. This is not accomplished by the mere raise of an invalidity defence, but only when the courts are actually *seised*.

As to the time when a court is deemed to be seised, Article 2:706 of the CLIP Principles provides:

**Article 2:706: Time when a court is deemed to be seised**

For the purposes of the Principles, a court shall be deemed to be seised:

(1) at the time when the document instituting the proceedings or an equivalent document is lodged with the court, provided that the plaintiff has not subsequently failed to take the steps she/he was required to take to have service effected on the defendant, or

(2) if the document has to be served before being lodged with the court, at the time when it is received by the authority responsible for service, provided that the plaintiff has not subsequently failed to take the steps she/he was required to take to have the document lodged with the court.

By providing for the two alternatives (1) and (2) for determining when a court is deemed to be seised, Article 2:706 of the CLIP Principles takes into account that domestic laws of procedure – already within the European Union, let alone worldwide – differ from each other as to this issue. While in some jurisdictions, for instance the Netherlands, the defendant must first be served before a case can be lodged, there are other States, for instance England, where a case must be lodged prior to service on the defendant. In each case, the exact time when a court is deemed to be seised is to be determined by the *lex fori*.<sup>2026</sup>

Noteworthy, both alternatives (1) and (2) require that the plaintiff takes further steps. Otherwise, the respective court will not be deemed to be seised. This construction is meant to avoid that actions are brought early for sole tactical reasons, in the way that a party proceeds to lodge a case in a court (without subsequent service) just to make sure that, in case that eventually pending negotiations fail, he benefits in a parties' race to the courts.<sup>2027</sup>

As to multistate proceedings which are of particular importance in the context of this work, it is to be underlined that such proceedings start to exist in the moment when two courts of different States are definitively seised of an action. This does not require that the defendants have already been able to put forth their arguments.<sup>2028</sup>

#### **3.3.3.2.4.4 Additional rules as to related proceedings**

Noteworthy, the constellation that an invalidity defence is raised in infringement proceedings is not covered by Article 2:701 of the CLIP Principles which contains rules as to congruent proceedings (situation of *lis alibi pendens*). This becomes clear when having a look on the wording of this provision that provides:

---

<sup>2026</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:706, para. 2:706.C02.

<sup>2027</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:706, para. 2:706.C02.

<sup>2028</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:706, para. 2:706.C01.

### **Article 2:701: Congruent proceedings**

(1) Where proceedings involving the same cause of action and between the same parties are brought in the courts of different States, any court other than the court first seised shall stay its proceedings unless

- (a) the court later seised has exclusive jurisdiction under these Principles, or
- (b) it is manifest that the judgment from the court first seised will not be recognised under these Principles.

(2) Any court other than the court first seised may terminate the stay of its proceedings if

- (a) the proceedings in the court first seised do not proceed within a reasonable time, or
- (b) the court first seised has decided not to hear the case.

(3) Provisional and protective measures do not involve in the same cause of action as main proceedings.

Article 2:701(1) of the CLIP Principles makes clear that this provision which aims at preventing recognition problems arising if two (or more) judgments are irreconcilable, that is: have binding legal effects which are mutually exclusive,<sup>2029</sup> is only applicable if two or more proceedings involve the same subject-matter, and if there is an identity of parties.<sup>2030</sup> While the same parties may be involved with regard to the constellation of an infringement action and an invalidity action brought before the courts of the granting State, infringement and validity proceedings do not involve the same subject-matter. Even in the case that the same patent is affected, a dispute concerned with an infringement of that patent and disputes having as their object a judgment in the grant, registration, validity, abandonment or revocation of that patent do not involve the same cause of action. Rather, infringement and validity proceedings regarding one patent are *related* proceedings pursuant to Article 2:702 of the CLIP Principles (if validity proceedings are initiated first) or Article 2:703 (in the case of subsequent validity proceedings).<sup>2031</sup>

Article 2:702 of the CLIP Principles contains detailed rules with regard to “related proceedings”:

### **Article 2:702: Related proceedings**

(1) Where related proceedings are pending in the courts of different States, any court other than the court first seised may stay its proceedings.

(2) In determining whether to stay proceedings according to paragraph 1, the court or the courts later seised shall take all relevant factors into account, in particular

- (a) which court seised is best placed to adjudicate the fullest scope of the related proceedings under these Principles;
- (b) which State has the closest connection to the dispute;
- (c) the procedural efficiency of centralised adjudication versus procedural efficiency of cooperation in multistate proceedings.

---

<sup>2029</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:701, para. 2:701.C01.

<sup>2030</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:701, para. 2:701.C03.

<sup>2031</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:701, paras. 2:701.C09 and 2:701.C19.

(3) For the purposes of this Section, proceedings are deemed to be related where they are so closely connected that it is appropriate to hear and determine them together in order to avoid the risk of inconsistent holdings or judgments.

Article 2:702 of the CLIP Principles<sup>2032</sup> must be construed in conjunction with Article 2:704 of the CLIP Principles which will be discussed below.

Interestingly, Article 2:702(3) of the CLIP Principles defines the circumstances in which (infringement and invalidity) proceedings are related: according to this provision, the relevant factor is a connection between the proceedings that is so close that “it is appropriate to hear and determine them together in order to avoid the risk of inconsistent holdings or judgments.” This objective may be achieved by way of cooperation only, or by way of cooperation combined with consolidation of actions. The court second seised will first have to determine whether the case before it is related to the case brought before the first court. Then it will have to assess how to exercise its discretion to stay. This implies an assessment of the degree of connection between the proceedings on the basis of claim documents in particular, but may also involve defences raised.<sup>2033</sup>

It has been emphasised that the concept of “inconsistent holdings or judgments” employed in Article 2:702(3) of the CLIP Principles differs from the concept of “irreconcilable judgments” used in Article 2:701 of the CLIP Principles in two respects: First of all, Article 2:702 of the CLIP Principles is not restricted to mutually exclusive judgments, i.e. judgments competing for recognition or enforcement. It is indeed sufficient that the judgments are inconsistent, rather than even irreconcilable as in Article 2:701 of the CLIP Principles. The concerned proceedings neither have to involve the same parties, nor must the subject-matter of the proceedings coincide.<sup>2034</sup> Second, Article 2:702 of the CLIP Principles covers not only judgments, i.e. final judicial decrees or decisions,<sup>2035</sup> but also the reasoning leading to orders (conclusions of law and findings of fact).<sup>2036</sup>

In addition, it is noteworthy that the concept of “inconsistent holdings or judgments” according to Article 2:702 of the CLIP Principles is broader than the concept of “incompatible judgments” deployed in Article 2:206 of the CLIP Principles, meaning that the application of Article 2:702 requires a lesser degree of closeness between the proceedings than Article 2:206. This is justified by the differing effects of those provisions: while Article 2:206 provides for a special head of jurisdiction and enables the consolidation of several proceedings, Article 2:702 gives the court discretionary power, not to consolidate proceedings

---

<sup>2032</sup> Article 2:704 of the CLIP Principles likewise concerns Article 2:701 of the CLIP Principles (“congruent proceedings”) and Article 2:703 of the CLIP Principles (“a special case of related proceedings”). However, as Article 2:701 of the CLIP Principles does not cover the constellation of infringement and validity proceedings regarding one patent, because those are *related* proceedings, in contrast to congruent proceedings pursuant to Article 2:701 of the CLIP Principles, and Article 2:703 of the CLIP Principles actually constitutes a specific form of related proceedings, it appears reasonable to introduce Article 2:704 of the CLIP Principle at this point.

<sup>2033</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:701, para. 2:701.C09; Court of Appeal 6 March 2008, *Research in Motion UK Ltd v Visto Corp*, [2008] EWCA Civ 153, at para. 37, [2008] F.S.R. 20, at para. 37 – *Research in Motion*.

<sup>2034</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C03.

<sup>2035</sup> Article 4:101 of the CLIP Principles contains a detailed definition of the term “judgment”. The provision reads as follows: “For the purposes of these Principles, judgment means any judgment given by a court or tribunal of any State, irrespective of the name given by that State to the proceedings which gave rise to the judgment or of the name given to the judgment itself, such as decree, order, decision or writ of execution. It also includes provisional, including protective, measures and the determination of costs or expenses by an officer of the court.”

<sup>2036</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C03.

*ex ante*, but, *ex post*, to stay proceedings brought before it when closely connected proceedings have already been initiated before another court.<sup>2037</sup>

In the context of this thesis, it is remarkable that the Commentary on the CLIP Principles explicitly considers the constellation that an action for infringement of a patent is brought in one court while (an action for revocation or) a declaration of invalidity of the same patent is already pending before another court, to fall within the scope of Article 2:702 of the CLIP Principles as actions that do not have the same subject-matter but are sufficiently closely connected to be regarded as “related actions”.<sup>2038</sup>

As has been suggested above, Article 2:702(1) of the CLIP Principles – in contrast to the *lis alibi pendens* rule of Article 2:701(1) of the CLIP Principles – gives any court other than the court first seised *discretion* to stay its proceedings. Accordingly, a court other than the court first seised which finds that proceedings are related does not have to stay its proceedings. It can rather decide *whether* to stay, either of its own motion or upon application by parties, depending on what the *lex fori* is.<sup>2039</sup> On the whole, the court second seised can choose among three options: First, the court can stay its proceedings in order to enable a consolidation of the proceedings. In this respect, it is to be taken into consideration that parties could be motivated to consolidate the proceedings before the court first seised. Second, the court later seised has the possibility to temporarily stay its proceedings and consider the other findings in its own decision subsequently (cf. Article 2:704(1) of the CLIP Principles).<sup>2040</sup> Third, the court second seised can continue its proceedings in order to actively cooperate with the court first seised (cf. Article 2:704(2) and (3) of the CLIP Principles). All three options are means to hear and determine the proceedings together – by whatever court – since this is appropriate (cf. Article 2:702(3) of the CLIP Principles).<sup>2041</sup> Coordinating the proceedings, the court must take into account to prejudice neither the interest of a party to effectively enforce its rights, nor the interest of its opponent to defend against raised claims. If the court first seised has no jurisdiction to hear the action pending in the second court, a stay of proceedings by the second court would prejudice the plaintiff in the second proceeding.<sup>2042</sup>

Article 2:702(2) of the CLIP Principles provides for a non-exhaustive enumeration of factors that the court or the courts later seised shall take into consideration in determining whether to stay proceedings. In this respect, in particular the factors “fullest scope”, “closest connection” and “procedural efficiency” are to be taken into account.<sup>2043</sup> As to the constellation of a coincidence of an infringement proceeding and an validity proceeding that is already pending, the following two sample cases shall be presented for illustration:

---

<sup>2037</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C04.

<sup>2038</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C05.

<sup>2039</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C09.

<sup>2040</sup> Beyond that, it has been suggested that the outcome of the first case might cause parties to not pursue litigation in the court second seised to final judgment. Further, the mere fact that courts have authority to stay proceedings for the purpose of consolidation may encourage parties to concentrate their actions *ex ante* or settle the entire dispute, cf. Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C09.

<sup>2041</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C09.

<sup>2042</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C10.

<sup>2043</sup> With regard to a detailed comment on the three factors enumerated in Article 2:702(2)(a)-(c) of the CLIP Principles, cf. Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, paras. 2:702.C11-2:702.C16.

### Case 1:

A validity proceeding with regard to a patent is pending before a court in State A. An infringement proceeding is then initiated before a court in State B. Under the applicable law the validity can only be challenged by counterclaim.

### Case 2:

A validity proceeding with regard to a patent is pending before a court in State A. An infringement proceeding is then initiated before a court in State B. Under the applicable law the validity can be challenged either by counterclaim or by invalidity defence.

What should the court second seised do?

In Case 1, the court should stay the infringement proceeding unless there are special grounds for continuing the hearing, because the counterclaim would be congruent with the invalidity proceeding. As this invalidity proceeding was brought first, the infringement court would have to stay the counterclaim proceeding with accordance to Article 2:701(1) of the CLIP Principles.<sup>2044</sup>

In contrast to Case 1, the foregoing argumentation does not (fully) apply to Case 2. As far as the possibility of raising a *counterclaim* is concerned, one might tend to employ the same reasoning as in Case 1 and conclude that the court second seised should stay the infringement proceedings because an eventually raised counterclaim would be congruent with the invalidity proceeding. On the other hand, it is to be taken into consideration that in Case 2 the counterclaim is not the only way to challenge the validity of the concerned patent, but there is also the possibility to raise an invalidity defence. As has been discussed above, the infringement court would then have authority to decide on the validity of the concerned patent by way of an incidental decision with *inter partes* effect. While a stay of infringement proceedings is *possible* according to Article 2:702(1) of the CLIP Principles – being subject to the discretion of the infringement court that takes all relevant factors into account, in particular those mentioned in Article 2:702(2)(a)-(c) of the CLIP Principles – it would go too far to conclude that the infringement proceeding should usually be stayed, also in this constellation, when there is a validity proceeding pending. For there is no need for depriving the infringement court of exercising its jurisdiction where there is the possibility that the infringement court renders an incidental decision on the validity of the concerned patent, even though this only has *inter partes* effect. Only if either party seeks to have the validity issue decided by way of a decision with *erga omnes* effect, the infringement court may stay its proceedings on parties' application.

It goes without saying that Article 2:702 of the CLIP Principles does not intend to enable courts to simply avoid hearing a case over which they have jurisdiction in principle.<sup>2045</sup> Another interpretation would disregard the elaborate system of jurisdiction, and coordination of proceedings according to Section 7 of Part 2 of the CLIP Principles in general, and Article 2:702 of the CLIP Principles in particular. If a court was free not to deal with the case without

---

<sup>2044</sup> Case 1 constructed according to: Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C15.

<sup>2045</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C10.

any further considerations, there would actually be no need to create detailed rules (as embodied in Article 2:702(2)(a)-(c) of the CLIP Principles) to be taken into account in particular when the court decides on a stay of its proceeding. Staying the proceeding simply because the court avoids hearing it, would mean not to exercise any discretion at all, and would therefore be contrary to the idea of Article 2:702 of the CLIP Principles.

The subsequent question of how a stay may be terminated, is determined by the *lex fori*. The plaintiff can in any case withdraw the action, for instance in order to consolidate all proceedings in the court first seised.<sup>2046</sup>

### **3.3.3.2.4.5 Stay of infringement proceedings in case of a later brought invalidity action**

As to the raised issue that an extraterritorial infringement court before which infringement proceedings have been brought should have the possibility to stay these infringement proceeding if an invalidity action is brought subsequently before the courts of the State of protection, Article 2:703(1) of the CLIP Principles provides that the infringement court is enabled to stay the infringement proceeding, while it can still order provisional and protective measures as long as the infringement proceeding is stayed (cf. Article 2:703(2) of the CLIP Principles). Article 2:703 of the CLIP Principles reads:

#### **Article 2:703: Subsequent validity proceedings**

(1) If proceedings having as their object the grant, registration, validity, abandonment or revocation of a patent, a mark, an industrial design or any other intellectual property right protected on the basis of registration are brought in the State of registration after related proceedings in a court of another State concerned with that intellectual property right, the court first seised may stay its proceedings.

(2) Where the court first seised stays the proceedings, it may order provisional and protective measures for the duration of the stay according to Article 2:501.

In contrast to the provision of Article 2:702 of the CLIP Principles that is applicable to the constellation that invalidity proceedings have been initiated before the courts of the granting State and an infringement action is brought subsequently before another (extraterritorial) court, Article 2:703 of the CLIP Principles affects the converse constellation that an infringement proceeding has already been brought when, subsequently, an invalidity action is initiated before the courts of the granting State. However, it would not be appropriate to consider Article 2:703 of the CLIP Principles as a provision completely different from Article 2:702 of the CLIP Principles. As both Article 2:702 and Article 2:703 of the CLIP Principles concern related proceedings, Article 2:703 of the CLIP Principles could (and should) rather be characterised as “a special case of related proceedings”.<sup>2047</sup> Therefore, it is possible – and necessary in order to ensure the internal harmony and parallel interpretation of the provisions of the CLIP Principles, respectively the provisions to be employed in an amended version of the Brussels Ibis Regulation and an eventual future Global Judgments Convention – to have recourse to the definition of “related proceedings” contained in Article 2:702(3) of the CLIP Principles also in the framework of Article 2:703 of the CLIP Principles. As a consequence,

---

<sup>2046</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:702, para. 2:702.C10.

<sup>2047</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C01.



Article 2:703 of the CLIP Principles also requires a risk of inconsistent holdings or judgments.<sup>2048</sup>

Further, like Article 2:702(1) of the CLIP Principles, Article 2:703(1) of the CLIP Principles gives discretion to the infringement court to decide whether or not to stay its proceeding. The “mere” difference between both provisions is whether the infringement court has been seised second (then Article 2:702 of the CLIP Principles applies) or first (then Article 2:703 of the CLIP Principles is applicable). Where, in the case of subsequent invalidity proceedings when an infringement proceeding is already pending, the infringement court being first seised has discretion to stay the infringement proceeding,<sup>2049</sup> the court *may* choose this way in order to wait for a decision on the validity of the concerned patent, before finally rendering a decision on infringement.<sup>2050</sup> Due to the specific relationship between Article 2:702 and Article 2:703 of the CLIP Principles, it may be referred, with regard to the discretion the court has to exercise when deciding whether or not to stay the infringement proceeding, to the explications made regarding 2:702(2) of the CLIP Principles. The *lex fori* is decisive as to the question of whether the court stays on its own motion or the stay requires an application by the parties.<sup>2051</sup>

In case that the invalidity proceeding appears to be wholly frivolous, the infringement court before which infringement proceedings are pending may decide against staying its proceedings.<sup>2052</sup> Another aspect which may be taken into account is that of procedural efficiency of a stay (cf. Article 2:702(c) of the CLIP Principles), including an adequate consideration of parties' interests in the first action. In this respect, particular consideration should be given to the interest of the plaintiff to have the dispute decided in a reasonable time.<sup>2053</sup>

According to Case 1 and Case 2 presented above, concerning the constellation of a coincidence of an infringement proceeding and an invalidity proceeding that is already pending, two further sample cases shall be discussed with regard to the discretion of the infringement court in the constellation of a coincidence of an infringement proceeding and an invalidity proceeding being initiated later than the infringement proceeding.

### Case 3:

An infringement proceeding with regard to a patent is pending before a court in State A. An invalidity proceeding is then initiated before a court in State B. Under the applicable law the validity can only be challenged by counterclaim.

---

<sup>2048</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C04.

<sup>2049</sup> Again, the fact that the court has discretion constitutes a strong parallel to Article 2:702 of the CLIP Principles. The existence of discretion in both constellations is based on the fact that both provisions deal with related proceedings. In this respect, it becomes comprehensible that Article 2:703 of the CLIP Principles can indeed be understood as a special case of related proceedings. At the same time, this fact illustrates a decisive difference in comparison with the *lis alibi pendens* rule of Article 2:701(1) of the CLIP Principles according to which “any court other than the court first seised *shall stay* its proceedings (...)”, while discretion only exists with regard to an eventual termination of the stay of proceedings (cf. Article 2:701(2) of the CLIP Principles: “Any court other than the court first seised *may terminate the stay* of its proceedings (...)”).

<sup>2050</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C03.

<sup>2051</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C03.

<sup>2052</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C04.

<sup>2053</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C04.

#### Case 4:

An infringement proceeding with regard to a patent is pending before a court in State A. An invalidity proceeding is then initiated before a court in State B. Under the applicable law the validity can be challenged either by counterclaim or by invalidity defence.

What should the infringement court, being first seised, do? In parallel to Case 1, the infringement court should stay the infringement proceeding in Case 3, unless there are special grounds for continuing the hearing, because the counterclaim would be congruent with the invalidity proceeding. The invalidity proceeding would in this respect be the first one seised, because a counterclaim has not been raised (yet) in the infringement proceeding. If a counterclaim proceeding was initiated then, the infringement court would have to stay the counterclaim proceeding with accordance to Article 2:701(1) of the CLIP Principles.<sup>2054</sup> With regard to Case 4 (constructed in parallel to Case 2), it is to be pointed out that the foregoing argumentation does not (fully) apply. As far as the possibility of raising a *counterclaim* is concerned, one might again take recourse to the solution of Case 3 that the infringement court should stay the infringement proceedings because an eventually raised counterclaim would be congruent with the invalidity proceeding. But, as has been analysed with regard to Case 2, it must be considered that in Case 4 the counterclaim does not constitute the only procedural means to challenge the validity of the concerned patent, but that there is also the possibility to raise an invalidity defence. As has been discussed above, the infringement court would then have authority to decide on the validity of the concerned patent by way of an incidental decision with *inter partes* effect. A stay of the infringement proceeding being *possible* according to Article 2:702(1) of the CLIP Principles – subject to the discretion of the infringement court that takes all relevant factors into account, in particular those mentioned in Article 2:702(2)(a)-(c) of the CLIP Principles – it is to be emphasised again that it would go too far to conclude that the infringement proceeding should usually be stayed also in this constellation. As has already been underlined, there is no need for depriving the infringement court of exercising its jurisdiction where there is the possibility that the infringement court renders an incidental decision on the validity of the concerned patent, even though this only has *inter partes* effect.

It is to be noticed that the discretion to stay proceedings according to Article 2:703(1) of the CLIP Principles comprises the possibility of the staying court to resume proceedings. After the court before which the invalidity action is brought has held that the patent is void, a continuation of the stayed infringement proceeding may be appropriate, even if the validity decision may be subject to further appeal.<sup>2055</sup> According to Article 2:704(1)(b) of the CLIP Principles, the finding on the validity respectively invalidity of the patent should be taken into account by the infringement court.<sup>2056</sup> According to the idea of Article 2:701(2) of the CLIP Principles, the stay of proceedings might also be terminated if the validity proceedings do not proceed within reasonable time (cf. Article 2:701(2)(a) of the CLIP Principles), or if the validity court has decided not to hear the case (cf. Article 2:701(2)(b) of the CLIP Principles).<sup>2057</sup>

---

<sup>2054</sup> Case 3 constructed according to: Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C04.

<sup>2055</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C06.

<sup>2056</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C06.

<sup>2057</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:703, para. 2:703.C06.

### **3.3.3.2.4.6 The CLIP Principles' response to the stated need for additional rules (besides the rules on the stay of infringement proceedings) with regard to the cooperation between the (extraterritorial) infringement court and the invalidity court**

It has been pointed out above that there is a need, besides the existence of provisions as to the stay of proceedings, for rules establishing in which way the (extraterritorial) infringement court and the invalidity court shall cooperate with each other.

Indeed, the CLIP Principles contain a provision regarding this subject, Article 2:704 of the CLIP Principles, which reads:

#### **Article 2:704: Cooperation in multistate proceedings**

(1) If congruent or related proceedings are or have been pending in different States, the courts seised may, subject to applicable procedural law, take into account

- (a) evidence produced in another proceeding,
- (b) a finding of another court on the validity or invalidity of an intellectual property right,
- (c) any other finding of another court relevant for the pending proceeding.

(2) In order to facilitate cooperation, prevent inconsistent holdings and judgments and promote efficiency in multistate proceedings, the courts seised should cooperate with each other. In particular, they should take all appropriate measures to provide information to the courts seised as to the status of their proceeding and their findings. The courts concerned may proceed to an exchange of views.

(3) These means of cooperation must not be carried out in a way as to prejudice the rights of the parties to the proceedings. The courts should clearly inform the parties as to their intention to cooperate and keep them informed of each step they intend to take.

It has been discussed above that, if an infringement action is brought before an (extraterritorial) infringement court when an invalidity proceeding is already pending, the infringement court has discretion to stay its proceedings (cf. Article 2:702(1) of the CLIP Principles). If it stays its proceedings temporarily, it may however take evidence or other findings of the invalidity court (first seised) into account in its final judgment (cf. Article 2:704 (1) of the CLIP Principles). It is to be underlined that, as the wording of Article 2:704(1) of the CLIP Principles (“are or have been pending”) reveals, this option does not depend on the procedural status of the invalidity proceeding.<sup>2058</sup> According to Article 2:704(2) of the CLIP Principles, the infringement court staying its proceedings should inform the invalidity court as to the status of the infringement proceeding, i.e. about its decision to stay (suspend) infringement proceedings.<sup>2059</sup>

Instead of staying infringement proceedings, the infringement court may also continue, or resume the proceedings. Also regarding this constellation, Article 2:704(2) of the CLIP Principles applies, providing that the courts seised should cooperate with each other, including the provision of information to the other court seised regarding the status of the respective proceeding and the finding, and the exchange of views before reaching a decision.<sup>2060</sup> In schematic respect, it is to be noticed that Article 2:704(1) and Article 2:704(2)

<sup>2058</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C03.

<sup>2059</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C03.

<sup>2060</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C04.

of the CLIP Principles provide for a graded system of cooperation between the courts involved in multistate proceedings.<sup>2061</sup> On a first grade, Article 2:704(1) of the CLIP Principles determines that all courts, i.e. including the court first seised, have *discretion* (cf. the wording of Article 2:704(1) of the CLIP Principles: “may take into account”) to take into consideration any finding of law and fact of another court, provided the respective court considers it relevant for its pending proceeding. Although this does not imply that foreign findings or judgments have binding force, it has been rightly emphasised that equal persuasive power should generally be assigned to all courts hearing (congruent or) related actions on the basis of the CLIP Principles.<sup>2062</sup> As a consequence, the courts seised should discuss relevant foreign findings and reason why they decide in a different way.<sup>2063</sup>

Whereas Article 2:704(1)(c) of the CLIP Principles contains a general clause (“any (other) finding of another court relevant for the pending proceeding”), Article 2:704(1)(a) and (b) of the CLIP Principles names two significant examples of such findings of another court that may be considered. Article 2:704(1)(a) of the CLIP Principles allows a court to take into account evidence produced in another proceeding. This may comprise substantial and well-documented expert opinions produced in another proceeding, which can mean a considerable advantage for the parties saving costs and time.<sup>2064</sup> According to Article 2:704(1)(b) of the CLIP Principles, the courts involved may take into account a finding of another court on the validity or invalidity of a patent. In this respect, it is to be noticed that this provision does not contain a restriction as to the type or effect of that finding on the validity or invalidity of the concerned patent. As a consequence, Article 2:704(1)(b) of the CLIP Principles applies both with regard to incidental decisions on the validity of the concerned patent, with *inter partes* effect, rendered by the infringement court, and with regard to validity decisions of the courts of the granting State which have *erga omnes* effect. However, a final decision of the latter courts will probably have greater persuasive authority than an incidental holding of a court in a third State.<sup>2065</sup>

Article 2:704(2) of the CLIP Principles, going beyond Article 2:704(1), provides for an “active cooperation” between the courts, meaning that the courts actually communicate with each other.<sup>2066</sup> According to Article 2:704(2) 2<sup>nd</sup> sentence of the CLIP Principles, the courts involved should, on a second grade, take all appropriate measures to provide information to

---

<sup>2061</sup> All sections of Article 2:704 of the CLIP Principles, i.e. Article 2:704(1), Article 2:704(2) and Article 2:704(3), contain rules as to cooperation in multistate proceedings. The difference between Article 2:704(1) and Article 2:704(2) (merely) consists in the *intensity* of such cooperation. In this respect, the wording of Article 2:704(2) (1<sup>st</sup> sentence) of the CLIP Principles (“(...) the courts should cooperate with each other”) is misleading and mistakable, because the fact that this formulation is contained only in Article 2:704(2) and not in Article 2:704(1) might suggest that Article 2:704(1) does not deal with cooperation. However, this is obviously not the case. The latter conception is also in line with the heading of Article 2:704 (“Cooperation in multistate proceedings”) which is without any doubt assigned to the whole article.

<sup>2062</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C05.

<sup>2063</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C05.

<sup>2064</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C07.

<sup>2065</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C08.

<sup>2066</sup> The Commentary on the CLIP Principles uses the term “active cooperation” with regard to cooperation according to Article 2:704(2) of the CLIP Principles (cf. Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C10), but does not employ a corresponding term as to cooperation according to Article 2:704(1) of the CLIP Principles. For schematic reasons, and as it would obviously appear rather bizarre to denote cooperation according to Article 2:704(1) of the CLIP Principles as “passive”, another term could be chosen. In order to express the different degrees of intensity of cooperation, I propose to qualify cooperation with accordance to Article 2:704(1) of the CLIP Principles as “indirect cooperation”, cooperation according to Article 2:704(2) 2<sup>nd</sup> sentence of the CLIP Principles as “direct cooperation” and cooperation according to Article 2:704(2) 3<sup>rd</sup> sentence as “enhanced cooperation”. Besides, the term “active cooperation” could remain as a general term for “direct cooperation” and “enhanced cooperation”.

the courts seised as to the status of their proceeding and their findings. This provision is based on the insight that courts will only be able to take appropriate steps to coordinate proceedings if they know about the status of other (congruent and) related proceedings, and findings of other courts can only be taken into account if they are known to the deciding court.<sup>2067</sup>

On a third grade, Article 2:704(2) 3<sup>rd</sup> sentence of the CLIP Principles provides for a real two-way communication between the courts involved, by stating that the courts *may* proceed to a non-binding exchange of views. While preserving the autonomous power of each court, because such an exchange of views is discretionary, direct contact between the courts seised would be accomplished.<sup>2068</sup>

Noteworthy, Article 2:704 of the CLIP Principles contains several limits as to avoid that concerned interests are impaired. First of all, the possibility of the courts to take into account findings of another court relevant for the pending proceeding exists only subject to applicable procedural law (cf. Article 2:704(1) of the CLIP Principles). As a consequence, any communication between courts must be undertaken in accordance with the locally applicable procedural law.<sup>2069</sup> In general, Article 2:704(3) 1<sup>st</sup> sentence of the CLIP Principles further provides that the means of cooperation must not be carried out in a way that would prejudice the procedural and other rights of the parties to the proceeding. Therefore, cooperation of the courts must also be in accordance with other relevant norms such as contained in the law of protection of personal data and business secrets.<sup>2070</sup> The involved courts must also clearly inform the parties as to their intention to cooperate and keep them informed of each step they intend to take (cf. Article 2:704(3) 2<sup>nd</sup> sentence of the CLIP Principles).

#### **3.3.3.2.4.7 Exclusion of recognition and enforcement of an incidental validity decision rendered by the infringement court if the patent has already been declared void by the courts of the granting State**

Article 4:501(3) of the CLIP Principles basically coincides with Article 34(3) of the Brussels I Regulation (and thus at least roughly corresponds to Article 45(1)(c) of the Brussels Ibis Regulation). The provision reads as follows:

##### **Article 4:501: Other grounds for non-recognition of foreign judgments**

A judgment shall not be recognised or enforced if:

(...)

(3) it is irreconcilable with a judgment given in the requested State between the same parties.

Besides this provision, the CLIP Principles do not imply any other Article that definitively excludes the recognition and enforcement of an incidental decision of the infringement court on the validity of a patent, if this patent has already been declared void in the granting State. Obviously, the Commentary on the CLIP Principles however starts from the idea that irreconcilability in the sense of Article 4:501(3) of the CLIP Principles exists between the incidental decision of the extraterritorial infringement court according to which the patent is

---

<sup>2067</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C11.

<sup>2068</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C12.

<sup>2069</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C13.

<sup>2070</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:704, para. 2:704.C13.

valid, and the decision in the granting State holding that the patent is void, because exactly this constellation has been chosen as an example for irreconcilability according to Article 4:501(3) of the CLIP Principles: “A situation of irreconcilable judgments for the purposes of Article 4:501(3) may arise if the successful plaintiff in an infringement action seeks to enforce the judgment in the State of registration of the intellectual property right where the other party has obtained a judgment revoking the right.”<sup>2071</sup>

#### **3.3.3.2.4.8 Contradiction between the incidental decision on the validity of a patent rendered by the extraterritorial infringement court (*inter partes* effect), and a subsequent decision on the validity of this patent produced by a court in the granting State (*erga omnes* effect)**

In accordance with the opinion advocated in this thesis, the CLIP Principles do not contain any rules with regard to this issue, but leave it to the national procedural law of the *lex fori* to provide for respective rules.

#### **3.3.3.2.5 The Heidelberg Report on the Application of Regulation Brussels I**

As to the question which consequences should be assigned to the raise of an invalidity defence in patent infringement proceedings, the Heidelberg Report on the Application of Regulation Brussels I restricts itself to “suggest four possible solutions”:<sup>2072</sup> 1.) limiting the *res iudicata* effect of an infringement decision;<sup>2073</sup> 2.) taking a patent for valid as long as it has not been annulled by the competent court;<sup>2074</sup> 3.) vesting the courts seised with infringement proceedings with proper power to monitor the interdependence of infringement proceedings and proceedings aimed at the declaration of invalidity of patents;<sup>2075</sup> 4.) vesting the courts seised with proper power to grant provisional relief independently of any invalidity objection.<sup>2076</sup>

However, the Heidelberg Report finally refrains from focusing on one definitive approach regarding an amendment of Article 22(4) of the Brussels I Regulation, but restricts itself to the following vague proposal: “Article 22(4) of the Brussels I Regulation should be amended to the result that in infringement proceedings, a defence based on the alleged invalidity of the registered right vests the court only with the discretionary power to stay the proceedings for a limited period of time, which may be extended.”<sup>2077</sup>

#### **3.3.3.2.6 The Commission Proposal 2010 for Reform of the Brussels I Regulation**

According to Article 22(4) of the Commission Proposal 2010, Article 22(4) of the Brussels I Regulation should be reformulated as follows:

---

<sup>2071</sup> De Miguel Asensio 2013 (CLIP Principles), Article 4:501, para. 4:501.C20, with reference to Fawcett & Torremans 2011, para. 19.30.

<sup>2072</sup> Schlosser 2008 (Heidelberg Report), para. 669; in fact, the enumerated solutions partly contain several “sub-proposals”.

<sup>2073</sup> Schlosser 2008 (Heidelberg Report), paras. 669-670.

<sup>2074</sup> Schlosser 2008 (Heidelberg Report), para. 671.

<sup>2075</sup> Schlosser 2008 (Heidelberg Report), para. 672.

<sup>2076</sup> Schlosser 2008 (Heidelberg Report), para. 673.

<sup>2077</sup> Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 746.

#### Article 22(4) of the Commission Proposal 2010

The following courts shall have exclusive jurisdiction:

(...)

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or similar rights required to be deposited or registered, irrespective of whether the issue is raised by way of an action or as a defence, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed in Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State.

In line with the Commission's general approach to extend the jurisdiction rules of the Brussels I Regulation to defendants domiciled in a third State – and taking into account that the applicability of exclusive jurisdiction pursuant to Article 22 of the Brussels I Regulation, already under current law, is not dependent on the parties' domiciles<sup>2078</sup> – the words “regardless of domicile” in the first sentence of Article 22 of the Brussels I Regulation have been deleted in Article 22 of the Commission Proposal 2010.

As to the controversial issue of whether Article 22 of the Brussels I Regulation (Article 24 of the Brussels Ibis Regulation) has an reflexive effect (*effet réflexe*), it is noteworthy that neither Article 22 nor the Recitals of the Commission Proposal 2010 address this topic.<sup>2079</sup> Legal commentators who support the conception of such a reflexive effect, referring to the arguments discussed in the foregoing chapter,<sup>2080</sup> have put forth that the European Union would lose a chance to regulate legal transactions with third States in a more adequate way than today.<sup>2081</sup> However, others have rightly argued by way of a *conclusio a contrario* that “(i)f the EU legislature does not seize upon an opportunity where Third State relations are one of the issues at the forefront to establish such an *effet réflexe*, such *effet* is unwarranted for and not intended to exist.”<sup>2082</sup>

Obviously, Article 22(4) of the Commission Proposal 2010 incorporates the essence of the *GAT* decision of the ECJ when confirming that Article 22(4) is applicable regardless of the fact if the validity issue is raised as an action or as a defence. Besides, both wording and content of Article 22(4) of the Commission Proposal 2010 widely correspond to Article 22(4) of the Brussels I Regulation (apart from formal changes like a change in wording from “Community instrument” to “instrument of the Union”).

Beyond that, Article 22(4) of the Commission Proposal 2010 does not establish any clarification let alone solution of the problems discussed in the context of intellectual property rights, in particular patents.

---

<sup>2078</sup> Weller (2012)9(1) GPR 34, at p. 38.

<sup>2079</sup> Weller (2012)9(1) GPR 34, at p. 38.

<sup>2080</sup> Weber (2011)75 *RabelsZ* 619, at pp. 632 et seq., 644.

<sup>2081</sup> Hau 2011, p. 631.

<sup>2082</sup> Cf. Magnus & Mankowski (2011)110 *ZVglRWiss* 252, at pp. 270-271. Impressively, the authors consider the Commission Proposal 2010 respectively the non-mentioning of a reflexive effect as the “final nail in the coffin” (Magnus & Mankowski (2011)110 *ZVglRWiss* 252, at p. 271).

### 3.3.3.3 Final comment and formulation proposal

Any reform proposal must be evaluated in light of the extent to which it achieves to solve existing problematic issues. Although the ALI Principles and the CLIP Principles may often lead to comparable solutions, one disadvantage of the ALI Principles – in the European framework – is the approach of the ALI Principles via subject-matter jurisdiction which does not correspond to the legal traditions of most European States. On the other hand, an evaluation of the presented reform proposals regarding a reform of Article 24(4) of the Brussels Ibis Regulation leads to the result that the CLIP Principles deliver adequate solutions for the raised problems that seem, at the same time, balanced, realisable and workable in practice.<sup>2083</sup> In particular, Articles 2:401 and 2:402 of the CLIP Principles manage to provide for a balanced solution that respects the need for a ground of exclusive jurisdiction when validity and registration issues are to be decided with *erga omnes* effect, as well as the need for consolidation and avoiding unwarranted disruption of infringement cases which have merely *inter partes* effect so as to resolve the actual dispute between the parties.<sup>2084</sup> In particular, giving the infringement court first seised the possibility to stay its proceedings is an adequate and effective means to cope with, respectively eliminate the current problem of a parties' race to court. An amendment of the provisions of exclusive jurisdiction in the Brussels Ibis Regulation should therefore pick up the solutions contained in Articles 2:401 and 2:402 of the CLIP Principles. Article 24(4) of the Brussels Ibis Regulation should therefore be supplemented according to the latter provisions of the CLIP Principles, completed by a further sentence (written in italics in the formulation proposal below), as follows:

#### Exclusive jurisdiction

##### Article 24

The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties:

(...)

(4) in proceedings having as their object a judgment on the grant, registration, validity, abandonment or revocation of a patent, a mark, an industrial design or any other intellectual property right protected on the basis of deposit or registration, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction in proceedings having as their object a judgment on the grant, registration, validity, abandonment or revocation of any European patent granted for that Member State.

*Sentences 1 and 2 do not apply where validity or registration arises in a context other than by principal claim or counterclaim.* The decisions resulting from such proceedings do not affect the validity or registration of those rights as against third parties.<sup>2085</sup>

Where a court of a Member State is seised of a claim which has as its object a matter over which the courts of another Member State have exclusive jurisdiction by virtue of sentences 1 and 2, it shall declare of its own motion that it has no jurisdiction.<sup>2086</sup>

---

<sup>2083</sup> Cf. Torremans 2008, pp. 74-77.

<sup>2084</sup> Torremans 2013 (CLIP Principles), Article 2:401, para. 2:401.N01; Magnus & Mankowski (2010)109 ZVglRWiss 1, at p. 17; Kubis (2007)98(5) Mitt. 220, at p. 223.

<sup>2085</sup> Corresponding to Article 2:401(2) of the CLIP Principles.



The content of Article 2:702(2) of the CLIP Principles should be integrated in Article 30 of the Brussels Ibis Regulation. With regard to Articles 2:703 and 2:704 of the CLIP Principles which have been discussed above, equally clear provisions should be integrated in the Brussels Ibis Regulation.<sup>2087</sup> In this respect, one should integrate the content of the complete Section 7 of the CLIP Principles in Chapter II of the Brussels Ibis Regulation which would also ensure the internal balance of these provisions. As Article 4:501(3) of the CLIP Principles corresponds to Article 45(1)(c) of the Brussels Ibis Regulation, the latter provision should be left untouched.

With regard to an eventual future Global Judgments Convention, the content of all provisions of the CLIP Principles discussed in the framework of this Chapter should be adopted.<sup>2088</sup>

### **3.3.4 Cross-border interim relief**

#### **3.3.4.1 Identifying the crucial issues**

##### **3.3.4.1.1 Should the courts of the granting State have exclusive jurisdiction regarding provisional measures?**

Before treating several academic proposals which have been made with regard to an amendment of the provisions on cross-border interim relief, the question arises whether, in particular in such matters of interim relief, a patent-specific provision should be established that excludes extraterritorial jurisdiction regarding provisional measures. For, due to a certain complexity and difficulty of patent law, one might prefer to localise both accessory and independent jurisdiction for provisional measures in the granting State.<sup>2089</sup> However, the better arguments militate against the latter conception. First, as has already been shown above, it is simply not justified to qualify patent law as extraordinarily complex and difficult, because this is merely a relative evaluation. It is admitted that the specific conditions of provisional proceedings – there is a need for a quick decision, while there are limited means to reach a decision – effect that this argument is stronger with regard to provisional proceedings than regarding proceedings on the merits. But this also goes for other fields of law where there is no discussion about conferring exclusive jurisdiction for provisional measures to the courts of a specific State.<sup>2090</sup> Further, limiting jurisdiction for the grant of provisional measures to the courts of the protection State would in the majority of cases require the recognition and enforcement in the defendant's State of domicile or in another State where the defendant disposes of enforceable assets; as a consequence, quick interim relief would be considerably hampered or even be made impossible.<sup>2091</sup> Additionally, it is to be highlighted that, if extraterritorial jurisdiction regarding provisional measures was

---

<sup>2086</sup> Corresponding to Article 2:402 of the CLIP Principles.

<sup>2087</sup> Noteworthy, the Brussels Ibis Regulation does not contain specific rules regarding cooperation such as Article 2:704 of the CLIP Principles.

<sup>2088</sup> The exact wording and choice of provisions of such an eventual future Global Judgments Convention would depend on its envisaged scope. If required, the whole complex of provisions of the CLIP Principles could be adopted to establish a complete set of rules. In any case, the provisions proposed in this thesis, corresponding to those provisions proposed for an amended version of the Brussels Ibis Regulation, should be considered as a minimum set of rules.

<sup>2089</sup> Schauwecker 2009, p. 414 et seq.

<sup>2090</sup> Schauwecker 2009, p. 415.

<sup>2091</sup> Schauwecker 2009, p. 415.

excluded, legal protection against patent infringements would be considerably impaired, because frequently only measures of interim relief enable an effective proceeding against the infringer.<sup>2092</sup> After all, the fact that courts outside the protection State *may* grant provisional measures does not inevitably mean that those courts will necessarily order provisional measures in view of a foreign patent. The invoked court will rather decide on the basis of a comprehensive balancing of interests whether or not it orders such provisional measures.<sup>2093</sup>

To conclude, a conception according to which jurisdiction to grant interim relief should be reserved to the courts of the State where the concerned patent has been granted is to be rejected. On the contrary, like regarding provisional proceedings in other fields of law, provisional proceedings in patent matters should be subject to the jurisdiction rules concerning interim relief of the Brussels Ibis Regulation (respectively a future Global Judgments Convention), and there should be no specific rule with regard to interim relief in patent matters which determines that only the courts of the protection State have jurisdiction for provisional measures in patent disputes.

#### **3.3.4.1.2 Explicit codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures**

The current system under the Brussels Ibis Regulation according to which jurisdiction for provisional measures can either be grounded on jurisdiction as to the substance of a case pursuant to Articles 4 and 7 to 26 of the Brussels Ibis Regulation (accessory jurisdiction), or on Article 35 of the Brussels Ibis Regulation in conjunction with the different national rules on jurisdiction for provisional measures (independent jurisdiction), seems sound in principle and should therefore be preserved.<sup>2094</sup> For this scheme builds on the concept of procedural justice which is enshrined in the jurisdiction rules of Articles 4 and 7 to 26 of the Brussels Ibis Regulation, complemented by the idea of quick and effective interim relief under the national rules where the measure is to be enforced.<sup>2095</sup>

However, for reasons of clarity and legal certainty, the current system under the Brussels Ibis Regulation providing for both accessory and independent jurisdiction for provisional measures should be *expressly* codified within the text of the Brussels Ibis Regulation.<sup>2096</sup> Similarly, an eventual future Global Judgments Convention should contain such a clarifying provision.

#### **3.3.4.1.3 Clarification of the requirements regarding accessory jurisdiction**

Under the current regime of the Brussels Ibis Regulation, the requirements for accessory jurisdiction for the grant of provisional measures have partly been defined by the ECJ in several decisions. In order to strengthen legal certainty and clarity, it seems desirable to integrate these judicial findings in the text of the Brussels Ibis Regulation (as well as an eventual future Global Judgments Convention).

---

<sup>2092</sup> Schauwecker 2009, p. 415.

<sup>2093</sup> Hölder 2004, p. 150.

<sup>2094</sup> Heinze (2011)75 RabelsZ 581, at p. 606.

<sup>2095</sup> Heinze (2011)75 RabelsZ 581, at p. 606.

<sup>2096</sup> Cf. also: Heinze (2011)75 RabelsZ 581, at p. 606.

#### 3.3.4.1.4 Definition of the real connecting link-criterion

As has been mentioned above, courts which lack jurisdiction as to the substance of the case may grant provisional measures based on Article 35 of the Brussels Ibis Regulation as an independent ground of jurisdiction. However, in order to prevent a proliferation of jurisdiction, the ECJ developed the criterion of a “real connecting link” between the subject-matter of the interim measure and the territorial jurisdiction of the forum State.<sup>2097</sup> There is a need for such a restriction of jurisdiction in view of ensuring that the courts having jurisdiction under Article 35 of the Brussels Ibis Regulation are best able to assess the circumstances under which a measure is granted and which conditions are required in order to guarantee the provisional character of the measures authorised.<sup>2098</sup> Additionally, there is a need for quick enforcement of provisional measures.<sup>2099</sup> However, it turned out difficult in practice to determine in which circumstances such a “real connecting link” is existent. As has been discussed in the foregoing chapter, several conceptions have been developed to answer this question. I have concluded that jurisdiction for provisional measures according to Article 35 of the Brussels Ibis Regulation is generally conferred to the courts situated in a State where the provisional measure shall be enforced. In case of interim injunctions, jurisdiction for provisional measures pursuant to Article 35 of the Brussels Ibis Regulation is additionally conferred to the courts of the protection State.

In comparable respect, it is interesting that the Pocar Report on the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, signed in Lugano on 30 October 2007, although ultimately denying the need for a clarifying provision, at least confirmed, in the context of the 2007 Lugano Convention, that the criterion of a “real connecting link” requires “further clarification”:

“In consideration of that judgment by the Court of Justice [in the *Van Uden* case], the *ad hoc* working party discussed whether it was necessary for Article 31 [of the 2007 Lugano Convention] to codify the principles set out there, and concluded that it was not, among other things because of the further clarification that they might require if incorporated into a legislative text, particularly with respect to the nature of the factor connecting the subject-matter of the measure and the territorial jurisdiction of the court, which in the judgment was defined exclusively with reference to the specific case at issue [underline and content in brackets added]”.<sup>2100</sup>

For reasons of clarity and thus legal certainty, a definition of the real connecting link-criterion should be included in the text of the Brussels Ibis Regulation. The same goes for an eventual future Global Judgments Convention.

#### 3.3.4.1.5 Definition of provisional, including protective, measures

Under the current regime of the Brussels Ibis Regulation, Article 35 of the Brussels Ibis Regulation mentions “provisional, including protective, measures”, but does not contain a

---

<sup>2097</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 40 – *Van Uden*.

<sup>2098</sup> ECJ 21 May 1980, C-125/79, *Bernard Denilauler v S.N.C. Couchet Frères*, [1980] ECR 01553, para. 16 – *Denilauler*; ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 39 – *Van Uden*.

<sup>2099</sup> Cf. ECJ 28 April 2005, C-104/03, *St. Paul Dairy Industries NV v Unibel Exser BVBA*, [2005] ECR I-03481, para. 12 – *St. Paul Dairy*.

<sup>2100</sup> Pocar Report, OJ C319 of 23 December 2009, pp. 1-56, para. 127, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2009:319:0001:0056:EN:PDF>> (lastly accessed on 1 June 2015).

clear definition of which measures are comprised. Recital 25 of the Brussels Ibis Regulation merely outlines the term “provisional, including protective, measures” in a vague way. As a consequence, legal practitioners are forced to have recourse to the jurisprudence of the ECJ when trying to find out whether the kind of measure envisaged in a specific case falls within the scope of application of Article 35 of the Brussels Ibis Regulation. In this respect, in order to strengthen legal certainty and predictability, it seems preferable to codify within the Articles of the Brussels Ibis Regulation (for instance in Article 35), which measures are to be considered “provisional, including protective, measures” according to the Brussels Ibis Regulation. Likewise, an eventual future Global Judgments Convention should explicitly define provisional measures.

#### **3.3.4.1.6 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State**

As has been discussed in the foregoing chapter, the ECJ explicitly held in its *Denilauler* decision<sup>2101</sup> that provisional measures rendered in favour of a patent holder could only be recognised and enforced in another Member State if the alleged infringer has been granted the right to a hearing. As a consequence, *ex parte*-decisions could neither be recognised nor be enforced, even if the alleged infringer subsequently disposed of the opportunity of legal remedies, as the ECJ clarified in its *Minalmet* decision.<sup>2102</sup> As illustrated in the foregoing chapter, too, the jurisprudence of the ECJ in *Denilauler* has in the meanwhile been codified (and modified) in the framework of Articles 2(a) and 42(2)(c) and 45(1)(b) of the Brussels Ibis Regulation. For reasons of legal certainty and clarity, a comparable set of rules (i.e. rules excluding *ex parte*-decisions from being recognised and enforced, unless the judgment containing the measure is served on the defendant prior to enforcement) should also form part of an eventual future Global Judgments Convention.

#### **3.3.4.1.7 Creation of clear rules regarding the coordination of several, including preliminary, proceedings**

In order to mitigate the danger of irreconcilable decisions in preliminary proceedings, an amended version of the Brussels Ibis Regulation should further imply definite rules with regard to the coordination of several, including preliminary, proceedings. The same goes for an eventual future Global Judgments Convention.

#### **3.3.4.1.8 Refusal of recognition of provisional measures when irreconcilable with other judgments**

In its *Italian Leather* decision, the ECJ held that Article 27(3) of the Brussels Convention (Article 34(3) of the Brussels I Regulation) is applicable in the case of interim proceedings, meaning that a judgment on interim relief shall not be recognised if it is irreconcilable with a judgment given in a dispute between the same parties in the Member State in which recognition is sought. It has been made clear above that, by establishing Article 45(1)(c) and (d) and Article 2(a) of the Brussels Ibis Regulation, the European legislator codified (and

<sup>2101</sup> ECJ 21 May 1980, C-125/79, *Bernard Denilauler v S.N.C. Couchet Frères*, [1980] ECR 01553, para. 17 – *Denilauler*.

<sup>2102</sup> ECJ 12 November 1992, C-123/91, *Minalmet GmbH v Brandeis Ltd*, [1992] ECR I-05661, paras. 19-21 – *Minalmet*.

restrictively modified) the jurisprudence of the ECJ in *Italian Leather*, clarifying that Article 45(1)(c) and (d) of the Brussels Ibis Regulation is (only) applicable to such provisional measures ordered by a court which has accessory jurisdiction for provisional measures. As a consequence, provisional measures ordered by a court on the basis of independent, i.e. non-accessory, jurisdiction do not constitute “judgments” within the meaning of Article 45 of the Brussels Ibis Regulation (cf. Article 2(a) of the Brussels Ibis Regulation), meaning that Article 45 of the Brussels Ibis Regulation is not applicable in the latter constellation. Such a clarifying provision should also be integrated in the text of an eventual future Global Judgments Convention.

### 3.3.4.1.9 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures

It has been stated in the foregoing chapter that measures granted under Article 35 of the Brussels Ibis Regulation, on the basis of a “real connecting link”, are by their very nature generally unsuitable for being enforced abroad, this insight being codified in Article 2(a) of the Brussels Ibis Regulation (in conjunction with Recital 33 4<sup>th</sup> sentence of the Brussels Ibis Regulation).<sup>2103</sup> While it has been concluded that, on the basis of this clear legal situation, it seems impossible *de lege lata* to accept exceptions to this rule, i.e. to admit recognition and enforcement of provisional measures ordered by a court on the basis of independent jurisdiction for provisional measures in another Member State, I shall now turn to the question of whether such exceptions should be admitted *de lege ferenda* in certain constellations.<sup>2104</sup>

On the assumption that the *enforceability* of provisional measures is the decisive criterion as to the question of whether provisional measures shall have effect in another Member State, and that also provisional measures granted on the basis of independent jurisdiction shall therefore have effect in another Member State if there is a “real connecting link” between the forum State and the State where the measure is to be enforced, one might demand to abolish, respectively amend, Article 2(a) of the Brussels Ibis Regulation according to which only such provisional measures are considered as judgments within the meaning of the rules of recognition and enforcement of the Brussels Ibis Regulation which have been ordered by a court on the basis of accessory jurisdiction pursuant to the Brussels Ibis Regulation. On this basis, one might admit two exceptions to the rule that measures granted under Article 35 of the Brussels Ibis Regulation, on the basis of a “real connecting link”, are by their very nature generally unsuitable for being enforced abroad.<sup>2105</sup> First, one might assume that there is no territorial limitation of provisional measures ordered on the basis of independent jurisdiction to be enforced in another Member State if assets have been transferred across the border after

---

<sup>2103</sup> To summarise, these exceptions are as follows: First, the constellation where assets have been transferred across the border after the provisional measure has been issued (restriction: violation of public policy (*ordre public*), in particular in case of disregard of essential principles of procedural law). Second, it should be regarded sufficient for a foreign court to have jurisdiction according to Article 35 that there is, at the time of the application for the provisional measure, a prognosis that the object in which enforcement shall be undertaken is probably located in the State of the deciding court.

<sup>2104</sup> Noteworthy, this question is to be distinguished from the aspect that, as has been discussed in Chapter 2, Article 2(a) of the Brussels Ibis Regulation does not prohibit provisional measures, ordered on the basis of independent jurisdiction for interim relief, from having extraterritorial effect as long as these measures can be enforced *domestically*, which is indirectly confirmed by Recital 33 4<sup>th</sup> sentence (“under this Regulation”).

<sup>2105</sup> Similar, with regard to the legal situation under the Brussels I Regulation: Schauwecker 2009, p. 199 et seq. However, *Schauwecker* interprets the term “real connecting link” in a slightly different way than interpreted in this thesis, by *solely* referring to the enforcement criterion for *all* kinds of provisional measures, i.e. including interim injunctions.

the provisional measure has been issued.<sup>2106</sup> However, this would not mean that evidence gained by a court competent on the basis of Article 35 may not be used in principal proceedings initiated before a court of another Member State.<sup>2107</sup> The only restriction to introduce evidence gained abroad, into domestic civil proceedings, would be a violation of public policy (*ordre public*), in particular in case of disregard of essential principles of procedural law. In this respect, Article 45(1)(a) of the Brussels Ibis Regulation provides:

#### Article 45

(1) On the application of any interested party the recognition of a judgment shall be refused:

(a) if such recognition is manifestly contrary to public policy (*ordre public*) in the Member State addressed (...).

As a consequence, evidence which has been gained in such circumstances may not be used in domestic civil proceedings (prohibition of exploitation). However, as Article 45 of the Brussels Ibis Regulation constitutes an exception to the rule of mutual recognition of judgments and is thus to be interpreted in a restrictive way,<sup>2108</sup> it is to be underlined that the mere fact that the foreign law on evidence differs from domestic law does not suffice for the application of Article 45 of the Brussels Ibis Regulation.<sup>2109</sup> Besides, Article 45(3) of the Brussels Ibis Regulation must be taken into account, according to which public policy is not violated if a foreign court has decided (on a provisional measure to obtain or secure evidence) without having jurisdiction:

#### Article 45(3) of the Brussels Ibis Regulation

(...)

(3) Without prejudice to point (e) of paragraph 1, the jurisdiction of the court of origin may not be reviewed. The test of public policy referred to in point (a) of paragraph 1 may not be applied to the rules relating to jurisdiction.

Besides, it may be put forth, since provisional measures have been harmonised to some extent by Articles 7 and 9 of the Enforcement Directive, that a prohibition of exploitation of such evidence in another State will only be justified in extremely exceptional cases.<sup>2110</sup> Second, it could be assumed that it is sufficient for a foreign court to have jurisdiction according to Article 35 of the Brussels Ibis Regulation that there is, at the time of the application for the provisional measure, a prognosis that the object in which enforcement shall be undertaken is probably located in the forum State.<sup>2111</sup> Due to the principle of *perpetuatio fori* which is inherent to the Brussels Ibis Regulation, the subsequent shortfall of the possibility of enforcement would neither affect the jurisdiction of the invoked court, nor would it influence the cross-border recognition and enforcement of the provisional measure.<sup>2112</sup> However, the foregoing considerations actually do not take into account that it is not merely the fact of

<sup>2106</sup> Schlosser 2008 (Heidelberg Report), para. 621.

<sup>2107</sup> Cf. Schlosser 2008 (Heidelberg Report), para. 610: "Once the information is legally acquired, it can be used anywhere subject only to restrictions made by the court which ordered the information to be provided."

<sup>2108</sup> Kropholler & Von Hein 2011, Art. 22 EuGVO, para. 7.

<sup>2109</sup> Geimer 2015, para. 2962.

<sup>2110</sup> Schauwecker 2009, p. 200 et seq.

<sup>2111</sup> Heinze 2007, p. 249; Willeitner 2003, p. 130 et seq.; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 25a.

<sup>2112</sup> Heinze 2007, p. 249; Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 25a.

whether a provisional measure is *enforceable* abroad or not which is decisive for the question of whether a provisional measure shall be enforced abroad or not. For it is actually the idea of mutual trust in the administration of justice that forms the basis for the mutual recognition of judgments throughout the European Union. This idea is reflected by Recital 26 of the Brussels Ibis Regulation which provides:

**Recital 26 of the Brussels Ibis Regulation**

Mutual trust in the administration of justice in the Union justifies the principle that judgments given in a Member State should be recognised in all Member States without the need for any special procedure. In addition, the aim of making cross-border litigation less time-consuming and costly justifies the abolition of the declaration of enforceability prior to enforcement in the Member State addressed. As a result, a judgment given by the courts of a Member State should be treated as if it had been given in the Member State addressed.

In particular with regard to provisional measures, the laws of the Member States however differ to a considerable extent.<sup>2113</sup> This fact seems to be the actual reason why only orders of provisional measures based on accessory jurisdiction, i.e. excluding provisional measures based on independent jurisdiction, are considered as judgments within the meaning of the Regulation's provisions of recognition and enforcement, and are consequently attributed effect also in other Member States. In light of this, a conception which is merely based on the enforcement criterion with the consequence that provisional measures should have *a priori* effect in another Member State given that such measures are enforceable in that State is not convincing. Therefore, Article 2(a) of the Brussels Ibis Regulation should be maintained.

**3.3.4.1.10 Creation of a clarifying provision of whether Article 24(4) of the Brussels Ibis Regulation is applicable where an invalidity defence is raised in provisional proceedings?**

With regard to the issue of which effect should be attributed to an invalidity defence in provisional proceedings, i.e. in which way, if any, Article 24(4) of the Brussels Ibis Regulation is considered applicable, I have *inter alia* explicated in the framework of a proposal for a reformulation of Article 24(4) of the Brussels Ibis Regulation:

Sentences 1 and 2 do not apply where validity or registration arises in a context other than by principal claim or counterclaim. The decisions resulting from such disputes do not affect the validity or registration of those rights as against third parties.

This formulation also comprises the situation where an invalidity defence is raised in provisional proceedings, having the equal effect that the rules of exclusive jurisdiction do not apply. Therefore, if Article 24(4) of the Brussels Ibis Regulation was amended in this way, a further mentioning in the framework of Article 35 of the Brussels Ibis Regulation would not be required.

---

<sup>2113</sup> Cf. Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 8.

### **3.3.4.2 Existing reform proposals**

#### **3.3.4.2.1 The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001)**

The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) treats provisional and protective measures in its Article 13. The provision reads as follows:

##### **Article 13 Provisional and protective measures**

###### **[Alternative A]**

- (1) A court seised and having jurisdiction under Articles [in the white list] to determine the merits of the case has jurisdiction to order provisional and protective measures.
- (2) A court of a Contracting State [may] [has jurisdiction to], even where it does not have jurisdiction to determine the merits of a claim, order a provisional and protective measure in respect of property in that State or the enforcement of which is limited to the territory of that State, to protect on an interim basis a claim on the merits which is pending or to be brought by the requesting party in a Contracting State which has jurisdiction to determine that claim under Articles [in the white list].
- (3) Nothing in this Convention shall prevent a court in a Contracting State from ordering a provisional and protective measure for the purpose of protecting on an interim basis a claim on the merits which is pending or to be brought by the requesting party in another State.
- (4) In paragraph 3, a reference to a provisional and protective measure means
  - (a) a measure to maintain the status quo pending determination of the issues at trial; or
  - (b) a measure providing a preliminary means of securing assets out of which an ultimate judgment may be satisfied; or
  - (c) a measure to restrain conduct by a defendant to prevent current or imminent future harm.]

###### **[Alternative B]**

A court which is or is about to be seised of a claim and which has jurisdiction under Articles [3 to 15] to determine the merits may order provisional and protective measures, intended to preserve the subject-matter of the claim.]

It is to be noticed that Article 13 of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) provides for two alternative solutions, and even within Alternative A and Alternative B, the existence of alternative text in brackets reveals that the delegations working on the formulation of the convention could not agree on a final wording.

In addition, a third and a fourth variant with further sub-variants are implied in Article 1(2) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) which mentions a number of areas which shall not be subject to the Convention. So, Article 1(2)(k) of the Draft Hague Convention provides:



## Article 1 Substantive scope

(...)

(2) The Convention does not apply to –

(...)

(k) **Alternative A**

[provisional and protective measures other than interim payment orders;]

### **Alternative B**

[provisional or protective measures [other than those mentioned in Articles 13 and 23A];].

First of all, it is to be noticed that, for logical reasons, Article 1(2)(k) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) would be deleted if Article 13, Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) was adopted.<sup>2114</sup> Advocates of the solution according to Article 1(2)(k), Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) intend to exclude provisional and protective measures from the scope of the Convention but to ensure that jurisdiction for interim payment orders remains subject to the list of prohibited jurisdictions. This conception involves the inclusion of a provision in the chapter on recognition and enforcement to clarify that interim payment orders will not be recognised or enforced under the Convention.<sup>2115</sup> In contrast, the conception embodied in Article 1(2)(k), Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is primarily inspired by the idea of generally excluding provisional and protective measures from the scope of the Convention which is expressed clearly by the wording “provisional or protective measures” and by refraining from a reference to interim payments, or at least by the idea of limiting jurisdiction as to provisional measures. In this respect, Article 13, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is linked with Article 1(2)(k), Alternative B of the Draft Hague Convention, because Article 13(3) of the Draft Hague Convention provides for such a limited jurisdiction.<sup>2116</sup> In Article 1(2)(k), Alternative B of the Draft Hague Convention, the words in brackets (“other than those mentioned in Article 13 and 23A”) constitute a further sub-variant for those who favour a restricted provision for jurisdiction and recognition and enforcement in respect of provisional and protective measures.<sup>2117</sup>

The multitude of alternative text versions illustrates the fact that no consensus could be reached, and explains why the convention has remained in the state of a draft convention. While not having entered into force, a look on Article 13 of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) may still be worthwhile in view of a final formulation of a provision on provisional measures in an

---

<sup>2114</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 1, fn. 8. *Vice versa*, Article 13 would be deleted in case that Article 1(2)(k), Alternative A of the Draft Hague Convention was adopted. Moreover, it would be deleted if Article 1(2)(k), Alternative B of the Draft Hague Convention was adopted without the reference to Articles 13 and 23A, cf. Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 13, fn. 89.

<sup>2115</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 1, fn. 9.

<sup>2116</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 13, fn. 97.

<sup>2117</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 1, fn. 10.

amended version of the Brussels Ibis Regulation respectively an eventual future Global Judgments Convention.

#### **3.3.4.2.1.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures**

Article 13(1) and (2), Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) explicitly provides that jurisdiction to grant provisional measures is vested, on the one hand, with the courts which have jurisdiction on the merits of the matter (Article 13(1)) and, on the other hand, under certain, defined conditions, with the courts of other States (Article 13(2), (3)). In particular, Article 13(3) is intended to overcome any restrictions imposed on the exercise of jurisdiction by the courts of Contracting States by the list of prohibited jurisdictions (cf. Article 18 of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001)). According to Article 13(3), Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), provisional and protective measures could also be granted under national law without the restrictions imposed by the said list of prohibited jurisdictions.<sup>2118</sup>

Noteworthy, one major difference between Alternative A and Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is that Alternative B which is substantially shorter than Alternative A merely determines that a court which is or is about to be seised of a claim and which has jurisdiction under the relevant provisions to determine the merits thereof may order provisional measures.

Already at this point, it is to be stated that Alternative B seems to be too restrictive as it does not provide for a legal basis for jurisdiction to grant provisional measures which is independent from jurisdiction on the merits. In this respect, Alternative B does not cope with the importance of provisional relief independently of legal protection granted through principal proceedings.

#### **3.3.4.2.1.2 The Draft Hague Convention's response to the stated need for a clarification of the requirements regarding accessory jurisdiction for provisional measures**

Interestingly, Article 13(1), Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) refers to a court "seised and having jurisdiction" for the merits. This implies that the respective court must have already been seised.<sup>2119</sup> In contrast, Article 13, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) uses the formulation "a court which is or is about to be seised of a claim" which suggests that the concerned court does not need to have (already) been seised, meaning that potential (fictitious) jurisdiction is also covered and sufficient.

#### **3.3.4.2.1.3 Limitation of independent jurisdiction for provisional measures**

---

<sup>2118</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 13, fn. 95.

<sup>2119</sup> Norrgård 2005, p. 39.

Consistently with the conception that jurisdiction for provisional measures is merely vested in the courts which are competent for the substance of a matter, Article 13, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) does not contain any definition of a “real connecting link”, with regard to independent jurisdiction for provisional measures, between the subject-matter of the interim measure and the territorial jurisdiction of the forum State. In contrast, Article 13(2), Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) indeed requires a certain “connecting link” between the subject-matter of the interim measure and the territorial jurisdiction of the forum State, by restricting jurisdiction to order a provisional and protective measure (a) in respect of property in that State or (b) the enforcement of which is limited to the territory of that State.<sup>2120</sup> In both cases, the purpose of the measure must be to protect, on an interim basis, a claim on the merits that is pending or is to be brought by the requesting party in a Contracting State having jurisdiction to determine that claim.<sup>2121</sup> Article 13(2), Alternative B of the Draft Hague Convention, in favour of foreign plaintiffs who seek to “freeze” assets within the jurisdiction in aid of litigation pending elsewhere, is intended to provide such States with jurisdiction to grant interim relief based on the existence of property in the forum State and limited to the territory of the forum State which, according to their national laws, do not provide for jurisdiction to grant provisional and protective measures unless the court was seised of jurisdiction to determine the merits of the case.<sup>2122</sup> To summarise, Article 13, Alternative A of the Draft Hague Convention pursues a broad twofold approach which does not merely focus on the enforcement criterion.

#### 3.3.4.2.1.4 Definition of provisional, including protective, measures

Article 13(4), Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) contains a list of measures which shall be considered “provisional and protective” measures in the sense of Article 13, Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001). Noteworthy, the description “provisional and protective” is meant to be cumulative, meaning that both criteria must be fulfilled.<sup>2123</sup> These are measures to maintain the *status quo* pending determination of the issues at trial, measures providing a preliminary means of securing assets out of which an ultimate judgment may be satisfied, and measures to restrain conduct by a defendant to prevent current or imminent future harm. In contrast, Article 13, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) does not imply such a detailed list of measures covered by this Article. However, it at least states that only such “provisional and protective measures” shall be covered which are “intended to preserve the subject-matter of the claim”. As a consequence, measures whose purpose is not the preservation of the subject-matter of the claim are excluded.<sup>2124</sup> In this respect, it has rightly been suggested that it is uncertain whether preliminary injunctions fall within the requirement of preservation of the subject-matter, because it could be argued that preliminary injunctions enjoining infringement *enforce* rights and thus do not *preserve* rights.<sup>2125</sup> Due to that uncertainty, the vague, indirect

---

<sup>2120</sup> Norrgård 2005, p. 39.

<sup>2121</sup> Norrgård 2005, p. 39.

<sup>2122</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 13, fn. 94.

<sup>2123</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 13, fn. 92.

<sup>2124</sup> Norrgård 2005, p. 40.

<sup>2125</sup> Norrgård 2005, p. 40.

definition of Article 13, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is not convincing.

#### **3.3.4.2.1.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another State**

As has been shown above, the Brussels Ibis Regulation – in contrast to the Brussels Convention and the Brussels I Regulation – contains explicit provisions (Articles 2(a), 42(2)(c) and 45(1)(b) of the Brussels Ibis Regulation) according to which the right to a hearing of the defendant is ensured, by providing that provisional measures rendered in favour of a patent holder can only be recognised and enforced in another Member State if the alleged infringer has been granted the right to a hearing, unless the judgment containing the measure is served on the defendant prior to enforcement. Nonetheless, I shall also take into consideration whether respectively in which way the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) deals with this issue, because a future reform of the Brussels Ibis Regulation might also choose another solution.

Article 23A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) provides with regard to the recognition and enforcement of provisional and protective measures:

#### **[Article 23A Recognition and enforcement of provisional and protective measures**

##### **[Alternative A**

(1) A decision ordering a provisional and protective measure, which has been taken by a court seised with the claim on the merits, shall be recognised and enforced in Contracting States in accordance with Articles [25, 27-34].

(2) In this article a reference to a provisional or protective measure means –

- (a) a measure to maintain the status quo pending determination of the issues at trial; or
- (b) a measure providing a preliminary means of securing assets out of which an ultimate judgment may be satisfied; or
- (c) a measure to restrain conduct by a defendant to prevent current or imminent future harm.]

##### **[Alternative B**

Orders for provisional and protective measures issued in accordance with Article 13 shall be recognised and enforced in the other Contracting States in accordance with Articles [25, 27-34].]

Article 23A, Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is to be read in conjunction with Article 13, Alternative A. Article 23A, Alternative B refers to Article 13, Alternative B. It is to be underlined that both Article 23A, Alternative A and Article 23A, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) premise that the court which has rendered a decision on a provisional measure has done so on the basis of jurisdiction being accessory to jurisdiction on the merits, while the

recognition or enforcement of decisions on provisional measures delivered on the basis of independent jurisdiction is *a priori* excluded also according to Article 23A, Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001).<sup>2126</sup>

While the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) does not imply a specific provision according to which a decision on the grant of provisional measures shall not be recognised or enforced in another State in case that the defendant was not given the right to a hearing, it is to be noticed that the recognition or enforcement of such an *ex parte* decision would certainly be refused according to Article 28 of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) which provides for certain procedural guarantees (cf. Article 28(1)(c) to (e) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001):

#### **Article 28 Grounds for refusal of recognition or enforcement**

(1) Recognition or enforcement of a judgment may be refused [only] if –

(...)

[(c) the [judgment results from] proceedings [in the State of origin were] incompatible with fundamental principles of procedure of the State addressed, [including the right of each party to be heard by an impartial and independent court];]

(d) the document which instituted the proceedings or an equivalent document, including the essential elements of the claim, was not notified to the defendant in sufficient time and in such a way as to enable him to arrange for his defence [, or was not notified in accordance with [an applicable international convention] [the domestic rules of law of the State where such notification took place]], unless the defendant entered an appearance and presented his case without contesting the matter of notification in the court of origin, provided that the law of that court permits objection to the matter of notification and the defendant did not object;

(e) the judgment was obtained by fraud in connection with a matter of procedure;

(...).

In particular on the basis of Article 28(1)(c) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), it may be assumed that the decision on the grant of provisional measures while depriving the defendant of his right to a hearing will mean to disregard fundamental principles of procedure of the State addressed, even if the right to a hearing was not explicitly mentioned.<sup>2127</sup>

---

<sup>2126</sup> As to Article 23A, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), it is to be stressed again that this provision refers to Article 13, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) which already excludes independent jurisdiction for provisional measures. Accordingly, the issue of recognition and enforcement does not arise.

<sup>2127</sup> Noteworthy, the text “including the right of each party to be heard by an impartial and independent court” in Article 28(1)(c) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is placed into brackets, meaning that no consensus on this formulation could be reached.

In light of the foregoing, it is remarkable that no consensus could be reached on the continued inclusion of Article 28(1)(c) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), and the deletion of this sub-paragraph has been proposed due to several reasons. It has been put forth that this sub-paragraph would encourage attacks on the impartiality and independence of the court by the losing party in an attempt to delay enforcement. Besides, it has been suggested that it would be contrary to the need for mutual trust and confidence among the courts of Contracting States.<sup>2128</sup>

Compared with Articles 2(a), 42(2)(c) and 45(1)(b) of the Brussels Ibis Regulation, it is to be assumed that according to both alternatives contained in Article 23A in conjunction with Article 28(1)(c) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), recognition and enforcement of provisional measures requires *inter alia* that the defendant was granted the right to a hearing. However, the approach chosen in the Brussels Ibis Regulation is more refined and better takes into consideration the interests of the parties concerned. For instance, Article 2(a) of the Brussels Ibis Regulation rightly restricts the ambit of this provision (“unless the judgment containing the measure is served on the defendant prior to enforcement”).

#### **3.3.4.2.1.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings**

While the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) does not contain a specific provision on the coordination of several preliminary proceedings, Article 13(3), Alternative A of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) at least makes clear that the fact that principal proceedings regarding the same claim on the merits which shall be protected by provisional measures, have already been initiated or shall be initiated before the court of a certain State, does not prevent a court of another State from ordering such provisional measures as well. In other words, there is no *lis pendens* effect in this constellation, given that provisional measures according to Article 13(4) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) are affected. In case of a measure which does not fall within the scope of application of Article 13(4) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), e.g. in the case of interim payment, there might be *lis pendens* effect.<sup>2129</sup> Article 13, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), in contrast to Alternative A, does not contain a comparable provision.

#### **3.3.4.2.1.7 The Draft Hague Convention’s approach of refusal of recognition of provisional measures when irreconcilable with other judgments**

It has been stated above that Articles 2(a) and 45(1)(c) and (d) of the Brussels Ibis Regulation, codifying the *Italian Leather* decision of the ECJ, clarify that the recognition of an order of provisional measures can be refused for irreconcilability with a judgment given between the same parties in the Member State addressed (cf. Article 45(1)(c) of the Brussels Ibis Regulation), or for irreconcilability with an earlier judgment given in another Member State or in a third State involving the same cause of action and between the same parties, provided

---

<sup>2128</sup> Hague Conference on Private International Law 2001 (Draft Hague Convention 2001), Article 28, fn. 157.

<sup>2129</sup> Norrgård 2005, p. 40.

that the earlier judgment fulfils the conditions necessary for its recognition in the Member State addressed (cf. Article 45(1)(d) of the Brussels Ibis Regulation), if the deciding court acted on the basis of *accessory* jurisdiction for provisional measures.

In a way similar to Article 45(1)(c) and (d) of the Brussels Ibis Regulation, Article 28(1)(b) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) provides:

**Article 28 Grounds for refusal of recognition or enforcement**

(1) Recognition or enforcement of a judgment may be refused [only] if –

(a) proceedings between the same parties and having the same subject matter are pending before a court of the State addressed, if first seised in accordance with Article 21;

(b) the judgment is inconsistent with a judgment rendered, either in the State addressed or in another State, provided that in the latter case the judgment is capable of being recognised or enforced in the State addressed;

(...).

It has already been mentioned above that, according to the explicit rule in Article 23A(1), Alternative A and Article 23A, Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), a decision ordering a provisional and protective measure shall be recognised and enforced in other Contracting States if the court which has rendered the decision on the provisional measure has done so on the basis of jurisdiction being *accessory* to jurisdiction on the merits. The latter restriction corresponds to the approach of the Brussels Ibis Regulation. Compared with Article 45(1)(c) and (d) of the Brussels Ibis Regulation, it is to be stated that Article 28(1)(a) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) concerns a different situation because its prerequisites that proceedings between the same parties and having the same subject-matter *are pending*, while Article 45 of the Brussels Ibis Regulations concerns the constellation where a decision has already been rendered. Consequently, a comparison between Article 28(1)(a) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) on the one hand, and Article 45(1)(c) and (d) of the Brussels Ibis Regulation on the other hand, would be a comparison of “apples to oranges”.

The question then arises whether Article 28(1)(b) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is more worthwhile. However, in opposition to Article 45(1)(c) and (d) of the Brussels Ibis Regulation which contains specific requirements (in particular the following: Article 45(1)(c): “judgment given between the same parties”; Article 45(1)(d): “earlier judgment given involving the same cause of action and between the same parties, provided that the earlier judgment fulfils the conditions necessary for its recognition in the Member State addressed”), Article 28(1)(b) of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) is constructed in a considerably less differentiated way (“judgment rendered, either in the State addressed or in another State, provided that in the latter case the judgment is capable of being recognised or enforced in the State addressed”). For this reason, the approach chosen in Article 45(1)(c) and (d) of the Brussels Ibis Regulation in conjunction with Article 2(a) of the Brussels Ibis Regulation is preferable, also because it distinguishes

between “the Member State addressed”, “another Member State” and “a third State” (which is not possible in the framework of a Convention which has no “Member States”).

The elaborate differentiation chosen in Article 45(1)(c) and (d) of the Brussels Ibis Regulation should also be applied in the framework of an eventual future Global Judgments Convention. However, as Contracting States (i.e. not Member States) would be concerned, the wording would have to be adapted (“Contracting State” in place of “Member State”).

#### **3.3.4.2.1.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures**

Article 23A, Alternative A and Alternative B of the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) merely refers to provisional measures rendered by a court on the basis of accessory jurisdiction, and thus *a priori* excludes recognition and enforcement of provisional measures ordered on the basis of independent jurisdiction for interim relief. Although achieved in a different way, this result corresponds to the result achieved via Article 2(a) of the Brussels Ibis Regulation.

#### **3.3.4.2.1.9 The Draft Hague Convention’s indirect contribution to the creation of a clarifying provision of the effect of an invalidity defence being raised in provisional proceedings (applicability of Article 24(4) of the Brussels Ibis Regulation)**

The Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001) does not imply any specific provision as to the question which are the effects on jurisdiction when an invalidity defence is raised in provisional proceedings. In light of this, the Draft Hague Convention cannot be referred to in view of a clarification of the effect of an invalidity defence raised in provisional proceedings. In any case, it is to be borne in mind that the issue discussed controversially of whether Article 24(4) of the Brussels Ibis Regulation applies also to provisional proceedings based on Article 35 of the Brussels Ibis Regulation does not arise under the (potential) regime of the Draft Hague Convention, because the latter merely admits accessory jurisdiction for provisional measures.

#### **3.3.4.2.2 ALI Principles**

The ALI Principles contain, in Chapter 2 on Jurisdiction over the Subject Matter, a special provision on provisional and protective measures: § 214 of the ALI Principles. The provision reads as follows:

##### **§ 214. Provisional and Protective Measures**

(1) A court has jurisdiction to order any provisional or protective measures consistent with its authority under §§ 201-207 and §§ 221-223 of these Principles.

(2) The courts in any States in which intellectual property rights are registered or in which tangible property is located have jurisdiction to order any provisional or protective measures with respect to that property. The measure shall be limited to the territory of that State.

(3) A person having custody or control of goods in transit, even if not an infringer by the law of the State in which the goods are temporarily located, may be the subject of an action for an order of



temporary detention of the goods while the true owner or owners are identified and joined to the proceedings.

#### **3.3.4.2.2.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures**

Similarly to the current system of the Brussels Ibis Regulation pursuant to which jurisdiction to grant provisional relief can be based on the jurisdiction accessory to jurisdiction on the merits, and on independent jurisdiction for provisional measures, the ALI Principles pursue a two-tier approach. According to § 214(1) of the ALI Principles, courts that are competent according to §§ 201 to 207 and §§ 221 to 223 of the ALI Principles also have jurisdiction to grant provisional or protective measures. If such authority is provided by local law, § 214(1) of the ALI Principles gives a court with appropriate jurisdiction over a defendant plenary authority to order provisional or protective measure, including *ex parte* relief and the issuance of transborder injunctions.<sup>2130</sup>

On the other hand, in order to give parties the flexibility to protect their interests in jurisdictions other than the one in which the action is pending or will be filed,<sup>2131</sup> § 214(2) of the ALI Principles creates additional jurisdiction for “the courts in any State in which intellectual property rights are registered or in which the tangible property is located”. In contrast to the situation pursuant to § 214(1) of the ALI Principles, measures taken under § 214(2) of the ALI Principles are limited to the territory of the State where the deciding court is situated, meaning that courts have authority, according to § 214(2) of the ALI Principles, only with respect to local property, tangible and intellectual.<sup>2132</sup>

#### **3.3.4.2.2.2 The ALI Principles' response to the stated need for a clarification of the requirements regarding accessory jurisdiction for provisional measures**

§ 214 of the ALI Principles does not imply any specific definition of requirements of jurisdiction for the grant of provisional measures being accessory to the court's jurisdiction on the merits, but solely refers to the court's “authority under §§ 201-207 and §§ 221-223 of these Principles”.

#### **3.3.4.2.2.3 Limitation of independent jurisdiction for provisional measures**

The case-law of the ECJ being less relevant for the ALI Principles, *topoi* of European law of civil procedure such as the “real connecting link” criterion developed by the ECJ cannot be expected to form the guidelines of the ALI Principles.<sup>2133</sup> Consequently, the ALI Principles do not define the “real connecting link” criterion. In light of this, it is however all the more remarkable that § 214 of the ALI Principles comes to similar results.

Similarly to the jurisprudence of the ECJ according to which jurisdiction for provisional measures being independent from the jurisdiction for the substance of the case is restricted by

---

<sup>2130</sup> The American Law Institute 2008 (ALI Principles), § 214, Comment a. on § 214(1).

<sup>2131</sup> The American Law Institute 2008 (ALI Principles), § 214, Comment b. on § 214(2).

<sup>2132</sup> The American Law Institute 2008 (ALI Principles), § 214, Comment b. on § 214(2).

<sup>2133</sup> It is however to be emphasised that the Comments and Reporters' Notes on the ALI Principles also refer to the jurisprudence of the ECJ and the Brussels I Regulation.

the requirement of a “real connecting link” between the subject-matter of the interim measure and the territorial jurisdiction of the forum State, § 214(2) of the ALI Principles limits such independent jurisdiction in several ways. First, it is limited to the courts in States in which intellectual property rights are registered or in which tangible property is located (cf. § 214(2)1 of the ALI Principles). Second, § 214(2)1 of the ALI Principles also restricts such jurisdiction to *that* property. Third, § 214(2)2 of the ALI Principles stipulates that “the measure shall be limited to the territory of that State”.

#### **3.3.4.2.2.4 Definition of provisional, including protective, measures**

Like under the current regime of the Brussels Ibis Regulation, § 214 of the ALI Principles does not provide for a definition of “provisional and protective measures”. Interestingly, § 214(3) of the ALI Principles however contains a specific provision on protective seizures, providing that a person having custody or control of goods in transit (i.e. tangible goods shipped from one State, across another State, to be sold in a third State where the sale infringes intellectual property rights in that third State), be it an infringer or not according to the law of the State in which the goods are temporarily located, may be the subject of an action for an order of temporary detention of these goods. The goods can thus be seized where they are found, even if they were merely passing through on their way to sale in another State.<sup>2134</sup>

#### **3.3.4.2.2.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another State**

Although the ALI Principles do not expressly exclude the recognition and enforcement of provisional measures which have been granted by way of an *ex parte* decision, it is to be taken into consideration that *ex parte* provisional measures are subject to application of the grounds of non-recognition and enforcement established in § 403(1)(a)-(d) of the ALI Principles which provides for certain procedural guarantees.<sup>2135</sup> The wording of § 403(1)(a)-(d) of the ALI Principles is as follows:

##### **§ 403. Judgments Not To Be Recognized or Enforced**

(1) The enforcement court shall not recognize or enforce a judgment if it determines that:

- (a) the judgment was rendered under a system that does not provide impartial tribunals or procedures compatible with fundamental principles of fairness;
  - (b) the judgment was rendered in circumstances that raise substantial and justifiable doubt about the integrity of the rendering court with respect to the judgment in question;
  - (c) the judgment was rendered without prior notice reasonably calculated to inform the defendant of the pendency of the proceeding in a timely manner;
  - (d) the judgment was obtained by fraud that had the effect of depriving the defendant of adequate opportunity to present its case to the rendering court;
- (...).

---

<sup>2134</sup> The American Law Institute 2008 (ALI Principles), § 214, Comment d. on § 214(3).

<sup>2135</sup> De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.N04.

These rules intend, for the sake of fundamental fairness, to ensure generally recognised procedural guarantees, such as an impartial tribunal, both in general and regarding the rights at issue, proper and timely notice, an opportunity to be heard and assurances that the judgment was not obtained by fraud.<sup>2136</sup> It may be assumed that the decision on the grant of provisional measures while depriving the defendant of his right to a hearing will mean to disregard procedural guarantees in the sense of § 403(1)(a)-(d) of the ALI Principles. Although not explicitly excluding the recognition and enforcement of provisional measures which have been granted by way of an *ex parte* decision, it is therefore probable that the ALI Principles will reach this result.

### **3.3.4.2.2.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings**

In the context of rules on exclusive jurisdiction, the provisions of §§ 222 and 223 of the ALI Principles have already been presented. § 214(2) of the ALI Principles can be regarded as an exception from the rules requiring courts to suspend proceedings pending adjudication in the coordination court or the consolidation court because they provide other tribunals with authority over the dispute.<sup>2137</sup> With regard to provisional measures to preserve evidence or the *status quo*, time is frequently of the essence. For this reason, the court best situated to achieve those goals is generally the court where the intellectual property or the physical goods are located.<sup>2138</sup>

### **3.3.4.2.2.7 The ALI Principles' approach of refusal of recognition of provisional measures when irreconcilable with other judgments**

The ALI Principles contain, in § 403(2)(d), a provision that is similar to Article 45(1)(c) and (d) of the Brussels Ibis Regulation and could therefore serve for orientation in view of an alternative approach. § 403(2)(d) of the ALI Principles reads:

#### **§ 403. Judgments Not To Be Recognized or Enforced**

(...)

(2) The enforcement court need not recognize or enforce a judgment if it determines that:

(...)

(d) the judgment is inconsistent with the judgment of the court designated by § 221, or the actions were coordinated in accordance with § 222 and the judgment is inconsistent with the judgment of the court of consolidation or of the courts that cooperated in resolving the dispute.

The wording of § 403(2)(d) of the ALI Principles however reveals that the provision is closely related to the specific principles of coordinating proceedings laid down in §§ 221 et seq. of the ALI Principles.<sup>2139</sup> For this reason, despite similar results may be reached, § 403(2)(d) of the ALI Principles seems less appropriate to serve as an alternative for Article 45(1)(c) and (d) of the Brussels Ibis Regulation. After all, in contrast to Article 45(1)(c) and (d) in

<sup>2136</sup> The American Law Institute 2008 (ALI Principles), § 403, Comment b. on § 403(1).

<sup>2137</sup> The American Law Institute 2008 (ALI Principles), § 214, Comment c. on § 214(2).

<sup>2138</sup> The American Law Institute 2008 (ALI Principles), § 214, Comment c. on § 214(3).

<sup>2139</sup> The American Law Institute 2008 (ALI Principles), § 403, Comment g. on § 403(2).

conjunction with Article 2(a) of the Brussels Ibis Regulation, § 403(2)(d) of the ALI Principles does not explicitly mention provisional measures, and therefore would actually mean to “go one step backwards” in times of the Brussels Convention/Brussels I Regulation when the applicability of Article 27(3) of the Brussels Convention/Article 34(3) of the Brussels I Regulation to the constellation of several decisions on provisional measures rendered by different courts was merely determined through the jurisprudence of the ECJ (*Italian Leather*) without this being reflected in the wording of the Brussels Convention/Brussels I Regulation.

### **3.3.4.2.2.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures**

With regard to the issue under which circumstances provisional measures are recognisable and enforceable, § 401(4) of the ALI Principles provides:

#### **§ 401. Foreign Judgments to Be Recognized or Enforced**

(...)

(4) For purposes of this Part IV of the Principles, a provisional or protective order rendered in accord with § 214(1) shall be considered a judgment entitled to recognition and enforcement.

Remarkably, § 401(4) of the ALI Principles solely refers to provisional or protective orders rendered according to § 214(1) of the ALI Principles, i.e. on the basis of accessory jurisdiction for interim relief, while not mentioning provisional or protective orders having been rendered pursuant to § 214(2) of the ALI Principles. As a consequence, provisional measures granted on the basis of § 214(2) of the ALI Principles, i.e. on the basis of independent jurisdiction for interim relief, are not entitled to recognition and enforcement abroad. This result reflects the statement in § 214(2) of the ALI Principles according to which provisional or protective measures granted on the basis of § 214(2) of the ALI Principles are limited to the territory of the rendering State.<sup>2140</sup> As recognition and enforcement of provisional measures ordered on the basis of independent jurisdiction for interim relief is thus *a priori* excluded according to the ALI Principles, these Principles reach results which are similar to the results according to the Brussels Ibis Regulation (cf. Article 2(a) of the Brussels Ibis Regulation).

### **3.3.4.2.2.9 The ALI Principles' indirect contribution to the creation of a clarifying provision on the effect of an invalidity defence being raised in provisional proceedings (applicability of Article 24(4) of the Brussels Ibis Regulation)**

The ALI Principles do not contain any specific provision as to the question of which are the effects on jurisdiction when an invalidity defence is raised in provisional proceedings. Presumably, the general rules as to coordination of proceedings will apply which have been demonstrated above when treating exclusive jurisdiction.

---

<sup>2140</sup> De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.N04.

### 3.3.4.2.3 Principles on Conflict of Laws in Intellectual Property (CLIP Principles)

As to the addressed problematic issues regarding provisional measures, it is to be noticed that the CLIP Principles contain several provisions concerning different aspects. While Article 2:501 of the CLIP Principles implies jurisdiction rules for provisional measures and provides for a definition of provisional measures, Article 2:705 of the CLIP Principles deals with the coordination of proceedings for provisional measures. Besides, Article 4:301 of the CLIP Principles rules the recognition and enforcement of measures of interim relief.<sup>2141</sup> As the CLIP Principles merely deal with jurisdiction, applicable law and recognition and enforcement, other issues such as the question under which conditions provisional measures may be granted, who can be the addressee of such provisional measures and further aspects are – subject to international and supranational harmonisation (Article 50 TRIPS) – governed by the applicable national law.<sup>2142</sup>

I shall begin my presentation and analysis of relevant provisions of the CLIP Principles as to provisional measures with Article 2:501 of the CLIP Principles, analysing step by step in how far the CLIP Principles manage to deliver appropriate solutions to the problematic issues concerning provisional measures indicated above.

Article 2:501 of the CLIP Principles stipulates:

#### **Article 2:501: Provisional, including protective, measures**

- (1) A court having jurisdiction in accordance with Articles 2:101 to 2:401 also has jurisdiction to order any provisional, including protective, measures.
- (2) Provisional, including protective, measures may also be ordered by the courts of a State
  - (a) where the measure is to be enforced, or
  - (b) for which protection is sought.
- (3) Provisional, including protective, measures are measures which are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case. Such measures may include
  - (a) orders to prevent an (imminent or continuing) infringement of an intellectual property right from occurring;
  - (b) orders to preserve relevant evidence in regard to the alleged infringement;
  - (c) orders to seize goods suspected of infringing an intellectual property right;
  - (d) orders to seize, attach or prevent the dissipation or removal from the jurisdiction of assets to safeguard enforcement of the judgment on the merits; and
  - (e) orders directing a party to provide information about the location of assets which are subject of an order under lit. (d).

---

<sup>2141</sup> While it is to be underlined that provisional and protective measures adopted by a foreign court can, in principle, be recognised and enforced under the CLIP Principles, Article 4:301 of the CLIP Principles admits only cross-border enforcement of such provisional measures which were adopted by a court having jurisdiction on the merits in accordance with the relevant provisions of Part 2 of the CLIP Principles (i.e. according to Article 2:501(1) of the CLIP Principles. Cf. De Miguel Asensio 2010, p. 269.

<sup>2142</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C01.

### 3.3.4.2.3.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures

Noteworthy, Article 2:501(1) and (2) of the CLIP Principles picks up as a starting point the two-tier system of jurisdiction regarding provisional measures that is also acknowledged under the Brussels Ibis Regulation. As has been shown in the foregoing chapter, a court which has jurisdiction as to the substance of a case also has accessory jurisdiction to order any provisional or protective measures that may prove necessary. While the text of the Brussels Ibis Regulation is somewhat vague in this respect, the ECJ affirmed such accessory jurisdiction in its *Van Uden* decision:

“The first point to be made, as regards the jurisdiction of a court hearing an application for interim relief, is that it is accepted that a court having jurisdiction as to the substance of a case in accordance with Articles 2 and 5 to 18 of the [Brussels] Convention also has jurisdiction to order any provisional or protective measures which may prove necessary [underscore and content in brackets added].”<sup>2143</sup>

“Thus, the court having jurisdiction as to the substance of a case under one of the heads of jurisdiction laid down in the [Brussels] Convention also has jurisdiction to order provisional or protective measures, without that jurisdiction being subject to any further conditions (...) [underscore and content in brackets added].”<sup>2144</sup>

On the other hand, courts lacking jurisdiction as to the substance of the case may order provisional measures based on Article 35 of the Brussels Ibis Regulation as an independent ground of jurisdiction, under the condition of, *inter alia*,

“(...) the existence of a real connecting link between the subject-matter of the measures sought and the territorial jurisdiction of the Contracting State [of the Brussels Convention, respectively Member State with regard to the Brussels Ibis Regulation] of the court before which those measures are sought [underscore and content in brackets added].”<sup>2145</sup>

In accordance with the current system of the Brussels Ibis Regulation, Article 2:501(1) and (2) of the CLIP Principles distinguishes between jurisdiction that is accessory to jurisdiction for the substance of the case (Article 2:501(1) of the CLIP Principles), and jurisdiction being independent from the jurisdiction for the substance of the case (Article 2:501(2) of the CLIP Principles).<sup>2146</sup> However, the CLIP Principles do not merely reformulate, but develop the current two-tier system of the Brussels Ibis Regulation by proposing a number of amendments and clarifications.<sup>2147</sup> So, Article 2:501 of the CLIP Principles goes beyond the current system of the Brussels Ibis Regulation in that the wording of Article 2:501(1) and (2) of the CLIP Principles clearly distinguishes between accessory and independent jurisdiction, without the need for having recourse to the ECJ's jurisprudence for clarification as under the Brussels Convention/Brussels I Regulation, and actually still under the Brussels Ibis Regulation which only addresses the side-by-side existence of jurisdiction for provisional measures pursuant to Articles 4 and 7 to 26 of the Brussels Ibis Regulation on the one hand, and Article 35 of the Brussels Ibis Regulation in conjunction with national law on the other hand, in its Recital 33.

---

<sup>2143</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 19 – *Van Uden*.

<sup>2144</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 22 – *Van Uden*.

<sup>2145</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 40 – *Van Uden*.

<sup>2146</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C02.

<sup>2147</sup> Heinze 2010, p. 74.

### 3.3.4.2.3.2 Clarification of the requirements regarding accessory jurisdiction for provisional measures (Article 2:501(1) of the CLIP Principles)

As to jurisdiction for provisional measures being accessory to jurisdiction for the substance of the case, Article 2:501(1) of the CLIP Principles clarifies the conditions under which such jurisdiction is existent.

First of all, Article 2:501(1) of the CLIP Principles makes clear that this accessory jurisdiction for ordering provisional measures does not depend on any further conditions such as the possibility of enforcing the measures in the forum State.<sup>2148</sup> This clearly reflects that Article 2:501(1) of the CLIP Principles intends to take into consideration the above cited jurisprudence of the ECJ in its *Van Uden* decision.<sup>2149</sup> The clarification within the text of Article 2:501(1) of the CLIP Principles might prove useful for a better understanding of the provision.<sup>2150</sup>

Provided that the jurisdiction for the substance of the case on which accessory jurisdiction is founded allows for provisional measures, it is thus possible to grant orders with extraterritorial effect on the basis of Article 2:501(1) of the CLIP Principles. Due to the accessory nature of jurisdiction pursuant to Article 2:501(1) of the CLIP Principles, it must be considered that such jurisdiction cannot be broader than the jurisdiction for the substance of the case.<sup>2151</sup>

Moreover, the wording “court having jurisdiction in accordance with Articles 2:101 to 2:401” provides for further clarification. Besides the rather unproblematic constellation where a court has already been seised with an action on the merits (according to Articles 2:101 to 2:401), it has been shown in the foregoing chapter that it is discussed controversially in which way the constellation is to be treated where no court has been seised yet. As has been mentioned earlier, parts of legal doctrine have put forth that accessory jurisdiction regarding provisional measures requires that jurisdiction on the merits does not only *potentially* exist, but that it has *factually* been exerted. By using the formulation “court having jurisdiction in accordance with Articles 2:101 to 2:401” instead of “court seised in accordance with Articles 2:101 to 2:401”, Article 2:501(1) of the CLIP Principles clarifies that potential/fictitious jurisdiction on the merits suffices for jurisdiction regarding provisional measures. In other words, Article 2:501(1) of the CLIP Principles is available before any proceedings on the merits have been started.<sup>2152</sup> Another problematic constellation could arise where an action on the merits has already been brought before a *different* court which, as a consequence of the *lis pendens* rules, results in the exclusion of jurisdiction on the substance of the court from which provisional relief is requested. The broad wording of Article 2:501(1) of the CLIP Principles however ensures that jurisdiction under Article 2:501(1) of the CLIP Principles will persist after an action on the merits has been initiated in a different court.<sup>2153</sup>

This being true, it has been suggested that, in case that proceedings on the merits have already been initiated in a specific court, it is reasonable – in order to reduce the risk of conflicting provisional measures – to subject provisional measures granted by any other court to the same

---

<sup>2148</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C03.

<sup>2149</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, paras. 19, 22 – *Van Uden*.

<sup>2150</sup> Heinze 2010, p. 75.

<sup>2151</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C03.

<sup>2152</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C05.

<sup>2153</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C05.

restrictions that apply for measures based on Article 2:501(2) of the CLIP Principles. Schematically, this means to apply Article 4:301(1) of the CLIP Principles<sup>2154</sup> which provides:

**Article 4:301: Provisional, including protective, measures**

(1) Provisional, including protective, measures adopted by a foreign court shall not be recognised and enforced if there is no ground of jurisdiction under Part 2 of these Principles, which would have allowed the foreign court to decide on the merits.

This scenario shall be illustrated by the following sample case:

Case 1:

P, a Dutch company, holds a European patent for France. X, an English company being domiciled in England, allegedly infringes P's patent. X initiates, in the Netherlands where P is domiciled, an action on the merits against P, for a declaration of non-infringement holding that P's patent in France is not being infringed by X. Subsequently, P seeks a preliminary injunction against X from the French courts.

French courts have jurisdiction to grant provisional relief according to Article 2:501(1) of the CLIP Principles in connection with Article 2:202 of the CLIP Principles (place of infringement), even before proceedings on the merits have been initiated. In this respect, it is not relevant that jurisdiction on the merits of the French courts is excluded pursuant to Article 2:701 of the CLIP Principles, because the same cause of action is already pending in the Netherlands. But, due to Article 4:301(1) of the CLIP Principles<sup>2155</sup>, any provisional measure issued by the French courts may not be subject to recognition and enforcement.<sup>2156</sup>

**3.3.4.2.3.3 Definition of the real connecting link-criterion with regard to independent jurisdiction for interim relief (Article 2:501(2) of the CLIP Principles)**

In contrast to the current situation under the Brussels Ibis Regulation where the issue which connection must exist between the subject-matter of the interim measure and the territorial jurisdiction of the forum State is merely (if any) clarified by the jurisprudence of the ECJ, it is noteworthy that Article 2:501(2) of the CLIP Principles implies a *normative* answer to this crucial question. The CLIP Principles thereby pursue a twofold approach that corresponds to the conception advocated in this thesis: Article 2:501(2) of the CLIP Principles provides that, besides courts having jurisdiction for the substance of the case, provisional relief may also be granted, on the one hand, by the courts of a State where the measure is to be enforced (Article 2:501(2)(a) of the CLIP Principles), or, on the other hand, by the courts of a State for which protection is sought (*forum protectionis*, Article 2:501(2)(b) of the CLIP Principles). While not mentioning explicitly the criterion of a “real connecting link”, Article 2:501(2) of the

<sup>2154</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C05; cf. also: Garber 2011, at p. 99 et seq.

<sup>2155</sup> Article 4:301(1) of the CLIP Principles shall be subject of further more detailed discussion at a later point.

<sup>2156</sup> This sample case has been inspired by the a similar sample case in the Commentary on the CLIP Principles, cf. Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C05, there Illustration 3.



CLIP Principles achieves the goal to define this criterion in an intellectual property-specific manner.<sup>2157</sup>

### 3.3.4.2.3.1 Jurisdiction of the courts of a State where the measure is to be enforced

Article 2:501(2)(a) of the CLIP Principles confers jurisdiction to courts where the provisional measure is to be enforced. This solution is based on the insight that provisional measures, in order to be effective, should be available due to the particular need for quick, immediate enforcement.<sup>2158</sup> It has been rightly put forth that this need can be best met if the court where the provisional measure can be enforced has jurisdiction to grant immediate relief, meaning that lengthy proceedings to enforce foreign judgments can thus be avoided.<sup>2159</sup> As has been explicated in the foregoing chapter, it is both required and sufficient that there is a certain probability that enforcement in the forum State can be achieved, to be demonstrated at the time when the proceedings are commenced.<sup>2160</sup>

While the enforcement criterion is easy to apply in case that the measures concerned relate to specific goods, assets or evidence – then the courts of the State have jurisdiction regarding the grant of interim relief where the goods, assets and evidence are located regardless of whether this State is the protection State<sup>2161</sup> – things are more difficult if *in personam* orders such as interim injunctions are concerned.<sup>2162</sup>

The following sample case may serve for illustration of this scenario.

#### Case 2:

P, a Dutch company, holds a European patent for the Netherlands and Germany. X, an English company being domiciled in England, allegedly infringes the Dutch and the German part of P's European patent. X disposes of shops and an account in the Netherlands. In order to obtain quick legal protection, P seeks interim relief, namely:

- (1) interim injunctions for both the Netherlands and Germany;
- (2) an order to block X's account in the Netherlands in order to secure the recovery of damages;
- (3) an order to inspect evidence located in France where X undertook respective business activities.

On which legal basis/bases and by which courts can such provisional measures be granted?

For a structured approach, it is necessary to distinguish between the measures sought.

---

<sup>2157</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C06.

<sup>2158</sup> Heinze 2010, p. 75; Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C08 with further references.

<sup>2159</sup> Heinze 2010, p. 75.

<sup>2160</sup> Leible 2011 (Rauscher), Art 31 Brüssel I-VO, para. 25a.

<sup>2161</sup> Cf. with regard to evidence orders: Hof van Cassatie 3 September 2000, (2001)50(1) GRUR Int. 73, at p. 74 – *Sanac/Variantsystemen*; Cour de cassation 11 December 2001, (2002)91(2) Rev. crit. DIP 371, at p. 372, with case note H. Muir Watt.

<sup>2162</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C08.

#### Ad (1) Interim injunctions for both the Netherlands and Germany

According to Article 2:501(1) of the CLIP Principles, English courts have jurisdiction for such interim injunctions because they also have jurisdiction on the substance pursuant to Article 2:101 of the CLIP Principles (*forum defensoris*), because X is domiciled in England. Besides, Dutch courts and German courts have jurisdiction to order such interim injunctions because the respective places of infringement are located in the Netherlands and Germany (cf. Article 2:202 of the CLIP Principles). However, unlike the jurisdiction of the English courts that is not restricted, the jurisdiction of the Dutch courts and German courts is limited to the infringements that occur or may occur within the territory of the respective State (cf. Article 2:203(1) of the CLIP Principles). Dutch courts therefore may not issue an interim injunction to stop infringement in Germany; the same applies to German courts vis-à-vis infringement in the Netherlands.

Besides, interim injunctions can also be ordered on the basis of Article 2:501(2)(a) of the CLIP Principles, i.e. by the courts of the State where these interim injunctions are to be enforced. In the sample case, this leads to the jurisdiction of both English and Dutch courts: English courts are competent because X is present in England which means that the enforcement of an English injunction can be ensured by the court's power of contempt. Dutch courts have jurisdiction because X disposes of assets in the Netherlands which can be subject to enforcement.

#### Ad (2) Order to block X's account in the Netherlands in order to secure the recovery of damages

As to jurisdiction according to Article 2:501(1) of the CLIP Principles, the same applies as explicated with regard to interim injunctions for both the Netherlands and Germany.

Regarding jurisdiction based on Article 2:501(2)(a) of the CLIP Principles, Dutch courts have jurisdiction because the place of enforcement of the Dutch bank account is located in the Netherlands. Besides, English courts have jurisdiction to order a freezing injunction that, as an *in personam* measure, is enforceable against an English-resident defendant even if the assets are located abroad.

#### Ad (3) Order to inspect evidence located in France where X undertook respective business activities

As to jurisdiction according to Article 2:501(1) of the CLIP Principles, the same applies as explicated with regard to interim injunctions for both the Netherlands and Germany.

With regard to jurisdiction pursuant to Article 2:501(2)(a) of the CLIP Principles, the place of enforcement is France only as the place where the evidence is located. Consequently, French courts are competent to grant an order to inspect evidence in France.

### **3.3.4.2.3.3.2 Jurisdiction of the courts of a State for which protection is sought**

As has been mentioned above, the CLIP Principles pursue the approach to acknowledge not only a “real connecting link” between the State of the court which decides on provisional

measures and the State where these provisional measures are to be enforced, but expand jurisdiction to order provisional measures to courts of a State for which protection is sought (*forum protectionis*, Article 2:501(2)(b) of the CLIP Principles). In comparison with Article 2:501(2)(a) of the CLIP Principles, the justification for Article 2:501(2)(b) of the CLIP Principles, the additional jurisdiction of courts in the State of protection, is less obvious.<sup>2163</sup> By offering the right holder this further option, the CLIP Principles tempt to facilitate to obtain interim relief without having to demonstrate the probability of enforcement in the granting State as according to Article 2:501(2)(a) of the CLIP Principles.<sup>2164</sup> Although, as has been concluded in the foregoing chapter, the *forum protectionis* will often be available already pursuant to the rules of infringement jurisdiction (Article 2:202 in connection with Article 2:501(1) of the CLIP Principles),<sup>2165</sup> it has been highlighted that constellations are conceivable where infringement jurisdiction according to Article 2:202 of the CLIP Principles is excluded, for instance if there is exclusive jurisdiction or if a jurisdiction or an arbitration agreement has been concluded.<sup>2166</sup>

In order to illustrate such a situation, the following sample cases shall be presented.<sup>2167</sup>

#### Case 3a:

X, an English company being domiciled in England, holds a patent in the United States. P, a Dutch company being domiciled in the Netherlands, is one of X's competitors. In order to impair P's reputation, X writes letters to several U.S. customers alleging that P's products infringe X's patent (which is actually not true). In order to protect his reputation and ensure that X stops writing, P seeks an injunction from the Dutch courts against X to stop X from writing such untrue letters.

#### Case 3b:

The constellation corresponds to the facts of Case 3a except that X also writes letters to several Dutch customers alleging that P's products infringe X's U.S. patent.

Do the Dutch courts have jurisdiction for interim relief?

Both regarding Case 3a and Case 3b, English courts have jurisdiction according to Article 2:101 of the CLIP Principles, since the place of domicile of the defendant (X) is located in England. Jurisdiction according to Article 2:202 of the CLIP Principles is vested with the courts in the United States because the place of infringement is located there. Dutch courts have no jurisdiction for interim relief on the basis of Article 2:501(1) of the CLIP Principles. Jurisdiction of the Dutch courts for interim relief cannot be based on Article 2:501(2)(a) of the CLIP Principles either because X has no domicile and does not dispose of any assets in the

---

<sup>2163</sup> Heinze 2010, p. 75.

<sup>2164</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C09.

<sup>2165</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C09, with reference to: OGH 16 December 2010, 17 Ob 13/10a, (2011)60(5) GRUR Int. 450, at p. 452.

<sup>2166</sup> Heinze 2010, p. 75; Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C09.

<sup>2167</sup> A similar case was decided by the Austrian Supreme Court in OGH 16 December 2010, 17 Ob 13/10a, (2011)60(5) GRUR Int. 450. A part of the constellation discussed here (Case 3a) is also mentioned in the Commentary of the CLIP Principles, cf. Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C09.

Netherlands; consequently, enforcement of an injunction cannot be realised in the Netherlands.

However, Case 3a and Case 3b differ from each other with regard to the question of whether the Dutch courts have jurisdiction for interim relief according to Article 2:501(2)(b) of the CLIP Principles. In Case 3a, Article 2:501(2)(b) of the CLIP Principles does not assign jurisdiction for interim relief to the Dutch courts either because X's behaviour only relates to the U.S. market and has no effects in the Netherlands. As the claim is based on unfair competition rather than intellectual property law, Article 2:501(2)(b) of the CLIP Principles is applied only *mutatis mutandis* (cf. Article 1:101(3)(c) of the CLIP Principles). As a consequence, it is not decisive that the State of protection is the United States, but rather that the behaviour is directed to the U.S. market and has effects only in the United States.<sup>2168</sup> In contrast, in Case 3b, as X has also written to several Dutch customers alleging that P's products infringe X's U.S. patent, the Netherlands are, in this respect, the State for which protection is sought, although no Dutch patent is affected. Accordingly, the Dutch courts have jurisdiction for interim relief under Article 2:501(2)(b) of the CLIP Principles. It is to be noticed however that this only affects X's letters to Dutch customers; as to X's letters addressed to U.S. customers, Dutch courts lack jurisdiction, because letters to U.S. customers are not directed to and do not have any effects on the Dutch market (cf. Case 3a).

### **3.3.4.2.3.3 Conclusion regarding the twofold approach of Article 2:501(2) of the CLIP Principles**

According to the Commentary on the CLIP Principles<sup>2169</sup>, the broad twofold (indirect) definition of a "real connecting link" in Article 2:501(2)(a) and (b) of the CLIP Principles is to avoid legal uncertainty regarding the interpretation of this criterion. Unfortunately, Article 2:501(2) of the CLIP Principles is silent with regard to the problematic question addressed in the foregoing chapter as to the specific meaning of the "real connecting link" criterion with regard to different types of provisional measures (interim injunctions, interim performance orders, evidence orders). The approach of the CLIP Principles thus tends to circumvent this crucial question by constructing jurisdiction pursuant to Article 2:501(2) of the CLIP Principles in an extensive way, conferring jurisdiction to a relatively broad range of courts. However, this broad, comprehensive conception brings along the advantage that there may be a higher chance that this approach is taken into consideration in the framework of legislative reforms because it may find more approval since it combines several conceptions. Conferring independent jurisdiction for provisional measures to the courts of a State where the measure is to be enforced, or for which protection is sought is not contradictory, but rather *extends* the number of (potentially) competent courts and leaves room for a flexible application of the provision, i.e. determination whether the courts of a certain State have independent jurisdiction for provisional measures. As a consequence, this means *inter alia* that it is possible to differentiate, in jurisdictional respect, between the different types of provisional measures as proposed in this thesis.

### **3.3.4.2.3.4 Definition of provisional, including protective, measures**

Given the different national conceptions of provisional measures, the CLIP Principles contain a specific definition to clarify the scope of Article 2:501 of the CLIP Principles. In particular,

---

<sup>2168</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C09, there fn. 30.

<sup>2169</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C07.

this aims to avoid a possible circumvention of the jurisdiction rules for the substance of the case by resorting to interim payment orders being available in certain jurisdictions.<sup>2170</sup>

#### 3.3.4.2.3.4.1 General definition and non-exhaustive list of examples

In determining respectively defining the notion of “provisional, including protective, measures”, Article 2:501(3) of the CLIP Principles proceeds in two steps. First of all, Article 2:501(3)1 of the CLIP Principles generally defines such measures as “measures which are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case”. This definition is clearly inspired by the jurisprudence of the ECJ in *Reichert II* where the court held:

“The expression ‘provisional, including protective, measures’ within the meaning of Article 24 [of the Brussels Convention] must therefore be understood as referring to measures which, in matters within the scope of the Convention, are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is sought elsewhere from the court having jurisdiction as to the substance of the matter [content in brackets added].”<sup>2171</sup>

As has been shown in the foregoing chapter, the ECJ, referring to its *Reichert II* decision, subsequently confirmed this (attempt of a) definition in *Van Uden*<sup>2172</sup> and *St. Paul Dairy*<sup>2173</sup> by using the same wording.

In a second step, Article 2:501(3)2 of the CLIP Principles provides for a non-exhaustive list of examples which qualify as provisional measures for the purposes of the CLIP Principles, whereby the content of this list is inspired by Article 50(1) of the TRIPS Agreement<sup>2174</sup> and Articles 7 and 9 of the EU Enforcement Directive and attempts to enumerate the most significant measures in intellectual property litigation.<sup>2175</sup>

#### 3.3.4.2.3.4.2 The measures mentioned in Article 2:501(3)2 of the CLIP Principles

First of all, Article 2:501(3)2(a) of the CLIP Principles mentions orders to prevent an (imminent or continuing) infringement of an intellectual property right from occurring. Although there should be no doubt that such orders – commonly designated as interim injunctions – constitute typical measures of interim relief, the benefit of mentioning those measures within the list in Article 2:501(3)2 of the CLIP Principles is to make clear without any doubt that such negative injunctions do not fall under the strict regime which governs positive interim performance orders.<sup>2176</sup>

---

<sup>2170</sup> Heinze 2010, p. 76.

<sup>2171</sup> ECJ 26 March 1992, C-261/90, *Mario Reichert and Others v Dresdner Bank AG*, [1992] ECR I-02149, para. 34 – *Reichert II*.

<sup>2172</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 37 – *Van Uden*.

<sup>2173</sup> ECJ 28 April 2005, C-104/03, *St. Paul Dairy Industries NV v Unibel Exser BVBA*, [2005] ECR I-03481, para. 13 – *St. Paul Dairy*.

<sup>2174</sup> Heinze 2010, p. 76; cf. also: De Miguel Asensio 2010, p. 269.

<sup>2175</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C12.

<sup>2176</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C13; Kropholler & Von Hein 2011, Art. 31 EuGVO, para. 7.

According to Article 2:501(3)2(b) of the CLIP Principles, orders to preserve relevant evidence with regard to the alleged infringement are also considered as provisional measures for the purposes of the CLIP Principles. As the Commentary on the CLIP Principles explicitly emphasises that the CLIP Principles have adopted the view that courts at the place where evidence is located should be allowed to directly *secure* this evidence by way of provisional measures without having to take a lengthy detour via the rules of judicial assistance,<sup>2177</sup> it is an interesting question of whether this means that provisional measures to obtain evidence are *a priori* excluded from the scope of Article 2:501(3)2(b) of the CLIP Principles. According to the interpretation purported in this thesis, the term “preserve” may generally comprise both “obtain” and “secure”.

Article 2:501(3)2(c) and (d) of the CLIP Principles mention diverse conservatory measures. On the one hand, these are orders to seize goods suspected of infringing an intellectual property right (c) covering both *in rem* orders, such as attachment or arrest, as well as personal orders restraining the defendant from dealing in certain assets, such as freezing injunctions.<sup>2178</sup> These measures are based on the idea that an order to seize or deliver up goods which are allegedly infringing an intellectual property right serves the purpose of preventing the movement of these goods in the channels of commerce. On the other hand, orders to seize, attach or prevent the dissipation or removal from the jurisdiction of assets to safeguard enforcement of the judgment on the merits are covered (d). Such orders safeguard the enforcement of monetary (damages) judgments.<sup>2179</sup> The provisions of Article 2:501(3)2(c) and (d) of the CLIP Principles were obviously inspired by Article 9(1)(b) and (2) of Directive 2004/48/EC<sup>2180</sup>, providing:

**Article 9 of Directive 2004/48/EC**

(1) Member States shall ensure that the judicial authorities may, at the request of the applicant:

(...)

(b) order the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.

(2) In the case of an infringement committed on a commercial scale, the Member States shall ensure that, if the injured party demonstrates circumstances likely to endanger the recovery of damages, the judicial authorities may order the precautionary seizure of the movable and immovable property of the alleged infringer, including the blocking of his/her bank accounts and other assets. To that end, the competent authorities may order the communication of bank, financial or commercial documents, or appropriate access to the relevant information.

In addition, Article 2:501(3)2(e) of the CLIP Principles clarifies that orders directing a party to provide information about the location of assets which are subject of an order under Article 2:501(3)2(d) of the CLIP Principles (attachment order or freezing order), i.e. ancillary

<sup>2177</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C14.

<sup>2178</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C15.

<sup>2179</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C15.

<sup>2180</sup> Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Corrigendum), OJ L195 of 2 June 2004, pp. 16-25, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2004:195:0016:0025:EN:PDF>> (lastly accessed on 1 June 2015).

disclosure orders, are also considered to be provisional measures for the purposes of the CLIP Principles.<sup>2181</sup>

In light of the detailed list of measures contained in Article 2:501(3) of the CLIP Principles, it is remarkable that orders for positive interim performance (such as interim payment orders) have not been included as examples for provisional measures. According to the Commentary on the CLIP Principles, this is essentially due to the fact that – although it has partly been put forth that such measures constitute measures of interim relief – orders for positive interim performance may effectively pre-empt the decision on the merits and therefore may be used to circumvent the jurisdiction rules for actions on the substance of the case. As a consequence, such orders are not considered as provisional measures according to Article 2:501 of the CLIP Principles, unless the enforcement of the order is subject to the applicant's lodging of an adequate security to ensure repayment of the sum awarded, including compensation for a prejudice suffered if the applicant is unsuccessful concerning the substance of his claim.<sup>2182</sup> This corresponds to the jurisprudence of the ECJ in its *Van Uden* decision where the court held:

“Consequently, interim payment of a contractual consideration does not constitute a provisional measure within the meaning of Article 24 [of the Brussels Convention] unless, first, repayment to the defendant of the sum awarded is guaranteed if the plaintiff is unsuccessful as regards the substance of his claim and, second, the measure sought relates only to specific assets of the defendant located or to be located within the confines of the territorial jurisdiction of the court to which application is made [underscore and content in brackets added].”<sup>2183</sup>

### **3.3.4.2.3.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State**

Inspired by the *Denilauler* decision of the ECJ as to the necessity of prior hearing of the adverse party for provisional measures to be recognised and enforced in another Member State, and at least effecting the same result as Articles 2(a), 42(2)(c) and 45(1)(b) of the Brussels Ibis Regulation, Article 4:301(2) of the CLIP Principles provides:

#### **Article 4:301: Provisional, including protective, measures**

(...)

(2) Provisional, including protective, measures adopted without prior hearing of the adverse party and enforceable without prior service of process to that party shall not be recognised or enforced.

In schematic respect, it is to be noticed that Article 4:301(2) of the CLIP Principles seems to be in conformity with the grounds for non-recognition established in Article 4:501(1) of the CLIP Principles, which provides:

#### **Article 4:501: Other grounds for non-recognition of foreign judgments**

A judgment shall not be recognised or enforced if:

---

<sup>2181</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C15.

<sup>2182</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C16.

<sup>2183</sup> ECJ 17 November 1998, C-391/95, *Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another*, [1998] ECR I-07091, para. 47 – *Van Uden*.

(1) the document which instituted the proceedings or an equivalent document was not notified to the defendant in sufficient time and in such a way as to enable her/him to arrange for her/his defence, unless the defendant entered an appearance and presented her/his case without contesting notification in the court of origin, provided that the law of the State of origin permitted notification to be contested.

In this respect, it is to be noticed that, where the defendant was not granted the right to a hearing, the document which instituted the proceedings was not notified to the defendant in sufficient time and in such a way as to enable the defendant to arrange for his defence.<sup>2184</sup>

By excluding the recognition and enforcement of such foreign provisional measures where the defendant was not granted the right to a hearing, the CLIP Principles take into account the paramount significance of ensuring adequate protection of rights of the defendant.<sup>2185</sup> However, due to the fact that Article 4:301(2) of the CLIP Principles aims at providing adequate protection of the rights of the defendant, it may be considered that recognition and enforcement is not excluded in case that the provisional measure concerned is confirmed after the defendant has been served with the judgment and given the opportunity to appear and seek its discharge in due time.<sup>2186</sup>

The latter idea corresponds to the last sentence of Article 2(a) of the Brussels Ibis Regulation (“unless the judgment containing the measure is served on the defendant prior to enforcement”).

### **3.3.4.2.3.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings in order to mitigate the danger of irreconcilable decisions**

Section 7 of the CLIP Principles on the coordination of proceedings includes several provisions which deal with provisional and protective measures. These provisions shall be subject to a closer analysis in the following paragraphs.

#### **3.3.4.2.3.6.1 Proceedings on the substance and preliminary proceedings**

In conjunction with rules concerning congruent proceedings on the merits, Article 2:701(3) of the CLIP Principles clarifies that these rules do *not* apply to provisional and protective measures, because main proceedings never involve the same cause of action as provisional and protective measures:<sup>2187</sup>

#### **Article 2:701: Congruent proceedings**

(...)

(3) Provisional and protective measures do not involve the same cause of action as main proceedings.

---

<sup>2184</sup> De Miguel Asensio 2010, p. 270.

<sup>2185</sup> Heinze 2010, p. 75; De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.C11.

<sup>2186</sup> De Miguel Asensio 2010, pp. 270, 271; De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.C11, with reference to a decision of the Dutch *Hoge Raad* where this court held enforceable under the Brussels I Regulation a German decision on the determination of costs based on a provisional measure that had been granted *ex parte*, given that both decisions had been served on the defendant who had the opportunity to challenge them after service, cf. HR 7 November 2008, 07/12641, *Realchemie Nederland B.V. v Fa. Feinchemie Schwebda GmbH* (Germany), RvdW 2008, 1020.

<sup>2187</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:705, para. 2:705.C01.



Article 2:701(3) corresponds to the legal situation under the Brussels Ibis Regulation according to which the requirement to stay proceedings, in the case of “congruent” actions according to Article 29 of the Brussels Ibis Regulation, does not prevent the court second seised from ordering provisional and protective measures.<sup>2188</sup>

Besides, where the court first seised stays (infringement) proceedings in the case that validity proceedings are instigated subsequently before a court in the State of registration (cf. Article 2:703(1) of the CLIP Principles), Article 2:703(2) of the CLIP Principles makes clear that this does not limit the authority of the court first seised to grant provisional and protective measures as long as the proceedings first brought are stayed:

**Article 2:703: Subsequent validity proceedings**

(...)

(2) Where the court first seised stays the proceedings, it may order provisional and protective measures for the duration of the stay according to Article 2:501.

**3.3.4.2.3.6.2 Several preliminary proceedings**

A provision of unique nature is Article 2:705 of the CLIP Principles, which specifically regulates the situation that *several* preliminary proceedings before different courts have been initiated. Article 2:705 of the CLIP Principles provides:

**Article 2:705: Congruent and related preliminary proceedings**

(1) Where proceedings having as their object provisional or protective measures according to Article 2:501 and involving the same cause of action between the same parties are brought in the courts of different States under these Principles, any court other than the court first seised may stay its proceedings.

(2) Where related proceedings have as their object provisional or protective measures according to Article 2:501, the courts seised may cooperate according to Article 2:704.

It is noteworthy that the creation of a separate provision regarding congruent and related preliminary proceedings means a distinct deviation from the rules of the Brussels Ibis Regulation.<sup>2189</sup> As such an additional rule serves the goal of legal certainty and clarity, it should be integrated in an amended version of the Brussels Ibis Regulation, and also become part of an eventual future Global Judgments Convention.

**3.3.4.2.3.7 The CLIP Principles' approach of refusal of recognition of provisional measures when irreconcilable with other judgments**

Similarly to Article 45(1)(c) and (d) of the Brussels Ibis Regulation, Article 4:501(3) and (4) of the CLIP Principles provides:

---

<sup>2188</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:701, para. 2:701.N12, with reference to High Court of Justice (Chancery Division – Patents Court) 17 December 2009, *Mölnlycke Health Care AB v BSN Medical Ltd*, [2009] EWHC 3370 (Pat), para. 39 – *Mölnlycke Health Care AB v BSN Medical Ltd*.

<sup>2189</sup> Van Eechoud & Peukert 2013 (CLIP Principles), Article 2:705, para. 2:705.N01.

#### **Article 4:501: Other grounds for non-recognition of foreign judgments**

A judgment shall not be recognised or enforced if:

(...)

(3) it is irreconcilable with a judgment given in the requested State between the same parties;

(4) it is irreconcilable with a judgment given in another State between the same parties and having the same cause of action, provided that this judgment fulfils the conditions necessary for its recognition in the requested State and it was given earlier or its recognition has already been declared in the requested State.

While the Commentary on the CLIP Principles mentions the case of several provisional measures granted by the courts of different States as one constellation covered by Article 4:501 of the CLIP Principles,<sup>2190</sup> the CLIP Principles do not explicitly address this scenario (neither in Article 4:501(2), (3) of the CLIP Principles, nor in any other provision).

#### **3.3.4.2.3.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures**

As to the question under which circumstances provisional measures are recognisable and enforceable, Article 4:301(1) of the CLIP Principles differentiates between provisional measures adopted by a court competent to reach a decision on the merits and those adopted by a court lacking such jurisdiction:

#### **Article 4:301: Provisional, including protective, measures**

(1) Provisional, including protective, measures adopted by a foreign court shall not be recognised and enforced if there is no ground of jurisdiction under Part 2 of these Principles, which would have allowed the foreign court to decide on the merits.

While Article 4:301(1) of the CLIP Principles is drafted in negative terms, the provision establishes that only provisional measures adopted in accordance with Article 2:501(1) of the CLIP Principles (i.e. regarding provisional measures ordered by a court having jurisdiction over the merits in accordance with the relevant provisions of Part 2 of the CLIP Principles) – in contrast to provisional measures granted pursuant to Article 2:501(2) of the CLIP Principles – may be recognised and enforced abroad.<sup>2191</sup> As a consequence, provisional measures ordered by the courts of another State, even if under the specific rule on jurisdiction over provisional and protective measures of the CLIP Principles, shall lack enforceability.<sup>2192</sup> By excluding measures based solely on Article 2:502(2) of the CLIP Principles from the liberal recognition and enforcement regime of Part 3 of the CLIP Principles, Article 4:301(1) of the CLIP Principles tries to balance, on the recognition and enforcement level, the plaintiff's advantage of expanded jurisdiction for provisional measures pursuant to Article 2:501(2) of the CLIP Principles.<sup>2193</sup> The effect of measures based on Article 2:501(2) of the CLIP Principles is limited to the State in which the measures were granted.<sup>2194</sup>

---

<sup>2190</sup> De Miguel Asensio 2013 (CLIP Principles), Article 4:501, para. 4:501.C22.

<sup>2191</sup> De Miguel Asensio 2010, p. 269.

<sup>2192</sup> De Miguel Asensio 2010, pp. 269, 270.

<sup>2193</sup> Heinze 2010, p. 75.

<sup>2194</sup> Heinze 2010, p. 75.

Due to the accessory character of jurisdiction based on Article 2:501(1) of the CLIP Principles, it is limited to the extent of the jurisdiction of the court to rule over the merits.<sup>2195</sup> As a consequence, determining whether provisional measures are recognisable and enforceable requires to apply the jurisdiction provisions of Part 2 of the CLIP Principles to establish if the court adopting the measures (potentially) has direct jurisdiction over the merits of the case.<sup>2196</sup> In this respect, it can be taken into consideration that the jurisdiction of the court that adopted the provisional measures was excluded as a result of *lis pendens* (Article 2:701 of the CLIP Principles) since an action on the merits had already been initiated before a competent court.<sup>2197</sup> Noteworthy, the fact that provisional measures adopted by a court having jurisdiction according to Article 2:501(2) of the CLIP Principles (and not being competent according to Article 2:501(1) of the CLIP Principles) are not subject to recognition and enforcement in another State due to Article 4:301(1) of the CLIP Principles, does not impair the possibility that such measures can still have extraterritorial effect so long as the court issuing the measure with extraterritorial effect can *enforce* it *domestically*. The latter can be the case if the defendant is present in this jurisdiction or disposes of assets there.<sup>2198</sup>

### **3.3.4.2.3.9 The CLIP Principles' indirect contribution to the creation of a clarifying provision of the effect of an invalidity defence in provisional proceedings (applicability of Article 24(4) of the Brussels Ibis Regulation)**

While the wording of Article 2:501(1) and (2) of the CLIP Principles does not inevitably require a differentiation, the Commentary on the CLIP Principles clearly advocates the opinion that the question of which effects the raise of the invalidity defence in provisional proceedings has, depends on the manner of jurisdiction which the invoked court has. While, according to the Commentary on the CLIP Principles, jurisdiction under Article 2:501(1) of the CLIP Principles shall be excluded if the subject-matter of the dispute falls under the exclusive jurisdiction of another court<sup>2199</sup> – which is the case when an invalidity defence is raised in patent infringement proceedings – jurisdiction according to Article 2:501(2) of the CLIP Principles shall also apply in case that another court has exclusive jurisdiction as to the substance of the case.<sup>2200</sup> In order to justify this differentiation, the Commentary on the CLIP Principles strongly refers to the character of jurisdiction under Article 2:501(1) of the CLIP Principles as jurisdiction which is *accessory* to jurisdiction on the merits.

However, as has been underlined in the foregoing chapter, this argumentation is not mandatory. Although it is to be admitted that excluding jurisdiction under Article 2:501(1) of the CLIP Principles if another court has exclusive jurisdiction on the merits, for instance when an invalidity defence is raised in patent infringement proceedings, does not mean a denial of the right to effective judicial protection, because jurisdiction under Article 2:501(2) of the CLIP Principles is not affected by exclusive jurisdiction,<sup>2201</sup> the mere fact that jurisdiction for provisional measures can still be grounded on Article 2:501(2) of the CLIP Principles cannot justify to discard Article 2:501(1) of the CLIP Principles as another ground of jurisdiction. For jurisdiction according to Article 2:501(1) of the CLIP Principles exists *independently* from Article 2:501(2) of the CLIP Principles.

<sup>2195</sup> De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.C04.

<sup>2196</sup> De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.C05.

<sup>2197</sup> De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.C05.

<sup>2198</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C10.

<sup>2199</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C04.

<sup>2200</sup> Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C10.

<sup>2201</sup> Putting forth this argument: Heinze 2013 (CLIP Principles), Article 2:501, para. 2:501.C04.

Despite of – or due to – the admittedly distinct position of the Commentary on the CLIP Principles with regard to this issue,<sup>2202</sup> the crucial question of whether Article 24(4) of the Brussels Ibis Regulation is applicable when an invalidity defence is raised in provisional proceedings could certainly have been answered in a clearer way than it has been accomplished in Article 2:501(1) and (2) of the CLIP Principles. If a differentiation between the two types of jurisdiction – accessory and independent jurisdiction for provisional measures – was actually intended, this should have been formulated explicitly not only in the Commentary on the CLIP Principles, but in the text of Article 2:501 of the CLIP Principles itself.

#### **3.3.4.2.4 The Heidelberg Report on the Application of Regulation Brussels I**

The Heidelberg Report proposes to maintain Article 31 of the Brussels I Regulation (as Article 31(1)) and supplement it by two new paragraphs ((2) and (3)). The amended version which shall be cited as “Heidelberg Proposal” reads as follows:<sup>2203</sup>

##### **Article 31 of the Heidelberg Proposal**

(1) 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 State, even if, under this Regulation, the courts of another Member State have jurisdiction as to the substance of the matter.

(2) In the case of an order for interim performance the court shall make the enforcement of the order dependent on the providing of a bank guarantee (on conditions to be specified by the court) for repayment or damages due whenever the applicant should be finally unsuccessful in the proceedings for the substance of the matter. In order to avoid unusual hardship, however, the court may grant the applicant an exception.

(3) The court vested with jurisdiction for, and seized by either party with the substance of the matter has power to discharge, to modify or to adapt to its own legal system any provisional measure granted by a court of another Member State.

##### **3.3.4.2.4.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures**

Although in particular Article 31(3) of the Heidelberg Proposal implies a differentiation of jurisdiction for provisional measures which is accessory to the jurisdiction for the substance, and independent jurisdiction for provisional measures, this differentiation is merely formulated indirectly and therefore may not effect the degree of legal certainty which could be reached by way of a clear, direct formulation.

<sup>2202</sup> Cf.: Heinze 2013 (CLIP Principles), Article 2:501, paras. 2:501.C04 and 2:501.C10.

<sup>2203</sup> Besides, the Heidelberg Report proposes to supplement Article 1(2)(d) of the Brussels I Regulation (which mostly corresponds to Article 1(2)(d) of the Brussels Ibis Regulation) in the following way (text in italics to be supplemented to the wording of the Brussels I Regulation):

“(2) The Regulation shall not apply to:

...

(d) arbitration *not including provisional measures not affected, under the law of the Member State, by an arbitration agreement.*”

Due to the fact that arbitration law is not subject of this thesis, this part of the Heidelberg Proposal shall not be treated.

#### **3.3.4.2.4.2 Clarification of the requirements regarding accessory jurisdiction**

Like Article 35 of the Brussels Ibis Regulation (and likewise Article 31 of the Brussels I Regulation), Article 31 of the Heidelberg Proposal does not define under which circumstances jurisdiction being accessory to jurisdiction for the substance of the case is existent. As a consequence, recourse must be had to the jurisprudence of the ECJ.

#### **3.3.4.2.4.3 Definition of the real connecting link-criterion**

Likewise, the Heidelberg Proposal does not contain a definition of the real connecting link-criterion set up by the ECJ in its *Van Uden* decision. In this respect, Article 31 of the Heidelberg Proposal does not result in an amendment of the situation under the Brussels I(bis) Regulation, meaning that uncertainties as to which are the precise circumstances when there is a real connecting link are not eliminated by the Heidelberg Proposal.

Instead, the Heidelberg Report suggests, as a substitute for the real connecting link-criterion, that the court seised with the substance shall have a coordination authority “to discharge, to modify or to adapt to its own legal system any provisional measure granted by a court of another Member State”.<sup>2204</sup>

#### **3.3.4.2.4.4 Definition of provisional, including protective, measures**

Furthermore, the Heidelberg Proposal contains no definition of which measures fall within the scope of Article 31 of the Heidelberg Proposal.

#### **3.3.4.2.4.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State**

Although the Heidelberg Report explicitly recognises as “reasonable” the requirement set up in *Denilauler* by the ECJ that “for the purpose of enforcement abroad, the respondent must have had a previous opportunity to comment the application for granting the provisional or protective order”,<sup>2205</sup> the Heidelberg Proposal refrains from codifying this requirement and, consequently, misses the chance to procure an enhanced level of legal certainty.

#### **3.3.4.2.4.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings in order to mitigate the danger of irreconcilable decisions**

While the Heidelberg Proposal does not contain specific provisions with regard to the coordination of several preliminary proceedings, Article 31(3) of the Heidelberg Proposal rules the interaction of the court seised or to be seised for the substance of the matter with the court(s) issuing provisional matters. In this respect, Article 31(3) of the Heidelberg Proposal provides that the court having jurisdiction for the substance and already being seised, is empowered to discharge, to modify or to adapt to its own legal system any provisional measure granted by a court of another Member State.

---

<sup>2204</sup> Schlosser 2008 (Heidelberg Report), para. 654.

<sup>2205</sup> Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 734.

In this regard, the Heidelberg Report focuses on the fact that the trans-border effectiveness of protective measures can be viewed in two ways, which are interlinked, but are nonetheless to be distinguished:<sup>2206</sup> On the one hand, the applicant's interests in avoiding the frustration of his rights are to be taken into account and to be balanced against the (opposing) interests of the defendant. The applicant's interests are respected if the invoked court grants effective provisional measures. This view may occasionally amount to something like a jurisdiction by necessity for provisional measures. On the other hand, the cooperation between the two (or more) judiciaries must be considered. Given the court addressed by the applicant has the primary task of assisting the court seised with the substance of the matter in finding a just and effective solution, the court of provisional measures may so “lend remedies” to the court of the main proceedings. The latter view implies that the court seised, or to be seised, with the substance of the matter, must always have power to lift or to modify the measure ordered by the foreign court or to substitute it by a measure available under its own laws.<sup>2207</sup>

#### **3.3.4.2.4.7 The Heidelberg Proposal's missing approach of refusal of recognition of provisional measures when irreconcilable with other judgments**

The Heidelberg Proposal does not mention provisional measures to be subject to Article 34(3) of the Brussels I Regulation (Article 45(1)(c) of the Brussels Ibis Regulation), as the ECJ held (with regard to Article 27(3) of the Brussels Convention) in *Italian Leather* (which means that a judgment on interim relief shall not be recognised if it is irreconcilable with a judgment given in a dispute between the same parties in the Member State in which recognition is sought). In this respect, the Heidelberg Proposal does not represent an amendment in comparison with the *status quo* under the Brussels I(bis) Regulation and therefore does not deliver a solution which could serve as an alternative to the approach pursued in the Brussels Ibis Regulation (cf. Articles 2(a) and 45(1)(c) of the Brussels Ibis Regulation).

#### **3.3.4.2.4.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures**

Article 31(2) of the Heidelberg Proposal provides that an order for interim performance shall only be enforceable in case of a bank guarantee given by the applicant, on conditions to be specified by the deciding court and with the possibility of an exception from this requirement if the court finds it an unusual hardship for the applicant, for repayment or damages due whenever the applicant should be finally unsuccessful in the principal proceedings.

In contrast to the Brussels Ibis Regulation, the ALI Principles and the CLIP Principles which limit recognition and enforcement of provisional measures by differentiating between the different types of jurisdiction for provisional measures (accessory and independent jurisdiction), the Heidelberg Proposal pursues an alternative approach by setting up the requirement that the applicant who benefits from the provisional order must – in general – provide for a guarantee for the “repayment” of the amount ordered to be paid in the interim. The mere existence of a substantive claim for compensation is not considered a sufficient guarantee.<sup>2208</sup> Given the fact that not only provisional “payment” may be ordered and that

---

<sup>2206</sup> Schlosser 2008 (Heidelberg Report), para. 628.

<sup>2207</sup> Schlosser 2008 (Heidelberg Report), paras. 631-633, with reference to Court of Appeal 12 June 2003, *Motorola Credit Corpn v Uzan And Others* (No 2), [2003] EWCA Civ 752, [2004] 1 W.L.R. 113 – *Motorola Credit*.

<sup>2208</sup> Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 735.

bank guarantees are not always available for the applicant, the issuing court is given discretion to specify details of guarantee.<sup>2209</sup> Under equitable considerations, it must not cover all the amounts later probably due under compensation concepts and the duration of the guarantee may be limited subject to later prolongation.<sup>2210</sup> As it may be too hard or even impossible for the applicant to provide a bank guarantee, let alone a guarantee with an indefinite duration, Article 31(2)2 of the Heidelberg Proposal provides for the possibility of an exception from the general prerequisite of a bank guarantee.<sup>2211</sup>

#### **3.3.4.2.4.9 Creation of a clarifying provision of whether Article 24(4) of the Brussels Ibis Regulation is applicable where an invalidity defence is raised in provisional proceedings**

The Heidelberg Proposal does not include any clarification of whether Article 24(4) of the Brussels Ibis Regulation applies in the case that an invalidity defence is raised in provisional proceedings. The Heidelberg Proposal thus misses the chance to codify – and clarify – the jurisprudence of the ECJ in its *Solvay* case where the court only decided this question with regard to jurisdiction based on Article 31 of the Brussels I Regulation (Article 35 of the Brussels Ibis Regulation) and did not make a decision as to the question if the same goes for the constellation that jurisdiction for provisional measures is grounded on the jurisdiction for the substance of the case (accessory jurisdiction).

#### **3.3.4.2.5 The Commission Proposal 2010 for Reform of the Brussels I Regulation**

##### **3.3.4.2.5.1 Codification of the existing two-tier system of accessory and independent jurisdiction for provisional measures**

In contrast to the Brussels Ibis Regulation, the proposal of the European Commission for a reform of the Brussels I Regulation from 2010 (hereinafter Commission Proposal 2010) clearly distinguishes between accessory jurisdiction and independent jurisdiction for provisional measures, by establishing two separate provisions, Articles 35 and 36 of the Commission Proposal 2010, which read as follows:

##### **Article 35 of the Commission Proposal 2010**

Where the courts of a Member State have jurisdiction as to the substance of a matter, those courts shall have jurisdiction to issue provisional, including protective measures as may be available under the law of that State.

##### **Article 36 of the Commission Proposal 2010**

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 State, even if the courts of another State or an arbitral tribunal have jurisdiction as to the substance of the matter.

As Article 36 of the Commission Proposal 2010 allows other States than the State in which courts have jurisdiction as to the substance of a case to order provisional measures in

---

<sup>2209</sup> Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 736.

<sup>2210</sup> Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 736.

<sup>2211</sup> Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report), para. 736.

accordance with their national law,<sup>2212</sup> the Regulation and national law “go side by side”.<sup>2213</sup> Noteworthy, this evaluation is not shared unanimously. For instance, *Hess* has evaluated the structure of Articles 35 and 36 of the Commission Proposal 2010 as a “hierarchisation”, meaning that Article 35 of the Commission Proposal 2010 precedes Article 36 of the Commission Proposal 2010.<sup>2214</sup> However, the latter understanding is not (necessarily) supported by the text of Articles 35 and 36 of the Commission Proposal 2010. Besides, as *Hess* himself admits, the court having jurisdiction for provisional measures pursuant to Article 35 of the Commission Proposal 2010 is not allocated authority to discharge provisional measures granted by a court of another Member State,<sup>2215</sup> as Article 20(2) of Council Regulation (EC) No 2201/2003 of 27 November 2003 concerning jurisdiction and the recognition and enforcement of judgments in matrimonial matters and the matters of parental responsibility (hereinafter *Brussels Ibis Regulation*), repealing Regulation (EC) No 1347/2000,<sup>2216</sup> provides correspondingly.<sup>2217</sup>

#### **Article 20 Provisional, including protective, measures**

(1) In urgent cases, the provisions of this Regulation shall not prevent the courts of a Member State from taking such provisional, including protective, measures in respect of persons or assets in that State as may be available under the law of that Member State, even if, under this Regulation, the court of another Member State has jurisdiction as to the substance of the matter.

(2) The measures referred to in paragraph 1 shall cease to apply when the court of the Member State having jurisdiction under this Regulation as to the substance of the matter has taken the measures it considers appropriate.

While it has been put forth that a “non-substance” court may not order additional, cross-border interim relief, for instance a “worldwide freezing injunction” to support foreign principal proceedings, this statement is not supported by the text of the Commission Proposal 2010; “non-substance” courts would indeed have authority to order such a measure. A different question is whether such a measure could be recognised and enforced which is however to be considered separately, notwithstanding the jurisdiction issue.

#### **3.3.4.2.5.2 Clarification of the requirements regarding accessory jurisdiction**

Compared with the wording of Article 35 of the *Brussels Ibis Regulation* (which corresponds to Article 31 of the *Brussels I Regulation*), the Commission Proposal 2010 delivers no further clarification regarding the requirements with regard to accessory jurisdiction. As a consequence, recourse must be had to the jurisprudence of the ECJ.

<sup>2212</sup> It has been underlined that, according to the Commission Proposal 2010, national rules of jurisdiction would solely be relevant for interim relief (Article 36 of the Commission Proposal 2010), cf.: Domej (2014)78 *RabelsZ* 508, at p. 521.

<sup>2213</sup> Magnus & Mankowski (2011)110 *ZVglRWiss* 252, at p. 289.

<sup>2214</sup> Hess (2011)31(2) *IPRax* 125, at p. 130.

<sup>2215</sup> Cf. Article 31(3) of the Heidelberg Proposal for such an approach with regard to a reform of Article 31 of the *Brussels I Regulation*.

<sup>2216</sup> Council Regulation (EC) No 2201/2003 of 27 November 2003 concerning jurisdiction and the recognition and enforcement of judgments in matrimonial matters and the matters of parental responsibility, repealing Regulation (EC) No 1347/2000, OJ 2003 L 338/1, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2003:338:0001:0029:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>2217</sup> Hess (2011)31(2) *IPRax* 125, at p. 130.



The Commission Proposal 2010 leaves unclear what is the meaning of “jurisdiction as to the substance of a matter” (instead of the wording “proceedings as to the substance [which] are pending”).<sup>2218</sup> The wording of Article 35 of the Commission Proposal 2010 may suggest that jurisdiction under Article 35 of the Commission Proposal 2010 should also be available before any proceedings on the merits have been initiated.<sup>2219</sup> However, parts of legal doctrine have contested this view and proposed to restrict jurisdiction based on Articles 2 to 24 of the Brussels I Regulation (Articles 4 to 26 of the Brussels Ibis Regulation) to cases where the court is actually seised of proceedings.<sup>2220</sup> Furthermore, the wording of Article 35 of the Commission Proposal 2010 does not reveal whether jurisdiction under Article 35 of the Commission Proposal 2010 persists after an action on the merits has been brought before a different court. Does “jurisdiction as to the substance” according to Article 35 of the Commission Proposal 2010 merely require that the respective court has (potential) jurisdiction on the merits in accordance with Sections 1 to 7 of Chapter II of the Brussels I Regulation<sup>2221</sup> (Brussels Ibis Regulation), or is it necessary that this jurisdiction is not excluded by the *lis pendens* rule (Article 27 of the Brussels I Regulation/Article 29 of the Brussels Ibis Regulation respectively Article 29 of the Commission Proposal 2010) given that the action on the merits is pending in a different court?<sup>2222</sup> On the one hand, a reference to the *Van Uden* decision where the ECJ did not mention the *lis pendens* rule, and the thought that it would not seem reasonable to allow that jurisdiction based on Article 36 of the Commission Proposal 2010 in conjunction with national law which is available even where proceedings on the merits have already been commenced elsewhere, is more robust than jurisdiction according to the rules of the Brussels Ibis Regulation itself, may militate for the conception that potential jurisdiction on the merits suffice for jurisdiction for interim relief. On the other hand, it could also be put forward that the respective court must actually be seised with the action on the merits, because the price for the more liberal jurisdiction rule in Article 36 of the Commission Proposal 2010 is that provisional measures based on this provision can, under the Commission Proposal 2010, only be enforced in the Member State granting the measure (Article 2(a) and Recital 25 of the Commission Proposal 2010) which reduces the risk of conflicting provisional measures and allocates the sole authority to issue cross-border provisional relief to the court seised with the substance.<sup>2223</sup>

### 3.3.4.2.5.3 Definition of the real connecting link-criterion

The Commission Proposal 2010 contains no definition of the real connecting link-criterion developed by the ECJ in its *Van Uden* decision, which may be owed to the admitted difficulty to define this criterion,<sup>2224</sup> and thus misses the chance to strengthen legal certainty and clarity by including (a solution of) this crucial issue into the text of the Regulation.

### 3.3.4.2.5.4 Definition of provisional, including protective, measures

Similarly to Recital 25 of the Brussels Ibis Regulation, Recital 22 of the Commission Proposal 2010 outlines vaguely the term “provisional, including protective, measures”:

<sup>2218</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290.

<sup>2219</sup> Heinze (2011)75 RabelsZ 581, at p. 607.

<sup>2220</sup> Cf. in place of others Dickinson (2010)30(3) IPRax 203, at p. 208.

<sup>2221</sup> Sections 1 to 8 under the Commission Proposal 2010.

<sup>2222</sup> Cf. Heinze (2011)75 RabelsZ 581, at p. 608.

<sup>2223</sup> Heinze (2011)75 RabelsZ 581, at p. 608.

<sup>2224</sup> Heinze (2011)75 RabelsZ 581, at p. 608 et seq.

### **Recital 22 of the Commission Proposal 2010**

The notion of provisional, including protective measures should be clarified. They should include, in particular, protective orders aimed at obtaining information or preserving evidence, thus covering search and seizure orders as referred to in Article 6 and 7 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights. They should not include measures which are not of a protective nature, such as measures ordering the hearing of a witness for the purpose of enabling the applicant to decide whether to bring a case.

However, in contrast to Recital 25 of the Brussels Ibis Regulation, Recital 22 of the Commission Proposal 2010 explicitly postulates the need for a clarification of “provisional, including protective, measures”. Another major difference<sup>2225</sup> between the respective recitals of the Brussels Ibis Regulation and the Commission Proposal 2010 consists in the fact that Recital 22 of the Commission Proposal 2010 is not supplemented, like Recital 25 of the Brussels Ibis Regulation, by a “rule” with regard to the relationship between the Brussels Ibis Regulation and Council Regulation (EC) No 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil and commercial matters determining that the latter Regulation remains applicable (Evidence Regulation) (cf. Recital 25 3<sup>rd</sup> sentence of the Brussels Ibis Regulation).

Like the Brussels Ibis Regulation, the Commission Proposal 2010 does not introduce a full, but merely a partial definition of “provisional, including protective, measures”.<sup>2226</sup> In any case, Article 2(b) of the Commission Proposal 2010 at least provides that certain evidence measures shall be included:

### **Article 2(b) of the Commission Proposal 2010**

For the purposes of this Regulation:

(...)

(b) 'provisional, including protective measures' shall include protective orders aimed at obtaining information and evidence.

With regard to evidence orders, it is noteworthy that Article 2(b) of the Commission Proposal 2010 thus covers only such measures which – at least partly – have the purpose of preserving evidence or information, such as search and seizure orders under Directive 2004/48/EC<sup>2227</sup>.<sup>2228</sup> This conception brings along several advantages: First of all, it introduces a European concept of evidentiary measure into the Brussels Regulation which is in line with EU legislation in other fields. Second, this conception shows clearly that the Evidence Regulation can no longer be considered as *lex specialis* for evidentiary measures. Last but not least, the conception ensures that the court where the evidence is located has jurisdiction to immediately secure that

---

<sup>2225</sup> Besides, there are minor formulation differences between the recitals, for instance as to the inclusion of protective orders aimed at obtaining information or preserving evidence (Recital 22 of the Commission Proposal 2010: “in particular”; Recital 25 of the Brussels Ibis Regulation: “for example”): However, these differences should not be considered crucial with regard to the content.

<sup>2226</sup> Heinze (2011)75 RabelsZ 581, at p. 603; Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 291; Weller (2012)9(1) GPR 34, at p. 43.

<sup>2227</sup> Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (revised version), OJ L195 of 2 June 2004, pp. 16-25, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32004L0048R%2801%29&from=EN>> (lastly accessed on 1 June 2015).

<sup>2228</sup> Heinze (2011)75 RabelsZ 581, at p. 605.

evidence, without the need for taking recourse to the Evidence Regulation.<sup>2229</sup> It is remarkable that such a clarification concerning protective orders aimed at obtaining information and evidence (Article 2(b) of the Commission Proposal 2010) has been codified neither in Article 2 nor in any other Article of the Brussels Ibis Regulation where this idea is merely mentioned in Recital 25 1<sup>st</sup> sentence of the Brussels Ibis Regulation.

### **3.3.4.2.5.5 Grant of the right to a hearing before rendering provisional measures as a prerequisite for the recognition and enforcement in another Member State**

In contrast to Article 2(a) of the Brussels Ibis Regulation, which provides that decisions on the grant of provisional measures are recognised and enforced in another Member State only if the defendant was given the right to a hearing, respectively if the judgment containing the provisional measure is served on the defendant before enforcement is sought, the Commission Proposal 2010 considers it sufficient that the defendant disposes of the subsequent opportunity of challenging the measure according to national law. In this respect, Article 2(a) of the Commission Proposal 2010 provides:

#### **Article 2(a) of the Commission Proposal 2010**

(...)

(a) (...) For the purposes of Chapter III, the term 'judgment' includes provisional, including protective measures ordered by a court which by virtue of this Regulation has jurisdiction as to the substance of the matter. It also includes measures ordered without the defendant being summoned to appear and which are intended to be enforced without prior service of the defendant if the defendant has the right to challenge the measure subsequently under the national law of the Member State of origin.

Where Article 2(a) of the Commission Proposal 2010 at least requires that the defendant has the right to *subsequently* challenge the measure under the law of the Member State of origin, Article 42(2)(b)(ii) of the Commission Proposal 2010 ensures this right of the defendant at the enforcement level:

#### **Article 42(2)(b)(ii) of the Commission Proposal 2010**

(...)

(2) For the purposes of enforcement in another Member State of a judgment ordering a provisional, including protective measure, the applicant shall provide the competent enforcement authorities with:

(...)

(b) the certificate in the form set out in Annex I issued by the court of origin, containing a description of the measure and certifying

(...)

(ii) where the measure is ordered without the defendant being summoned to appear and is intended to be enforced without prior service of the defendant, that the defendant has the right to challenge the measure under the law of the Member State of origin.

---

<sup>2229</sup> Heinze (2011)75 RabelsZ 581, at p. 605.

Article 2(a) of the Commission Proposal 2010 is in line with Recital 25 4<sup>th</sup> sentence of the Commission Proposal 2010:

**Recital 25 4<sup>th</sup> sentence of the Commission Proposal 2010**

The removal of intermediate measures requires an adaptation of the free circulation of provisional, including protective measures. Where such measures are ordered by a court having jurisdiction as to the substance of a dispute, their free circulation should be ensured. Where, however, such measures are adopted by a court not having jurisdiction as to the substance, the effect of such measures should be confined to the territory of that Member State. Furthermore, the free circulation of measures ordered *ex parte* should be allowed if accompanied by appropriate safeguards.

It is remarkable that the Commission Proposal 2010 thus pursues an approach which – in comparison with the approach pursued by the Brussels Ibis Regulation – is more in favour of the applicant of provisional measures. For Article 2(a) of the Commission Proposal 2010 considers it sufficient that the defendant disposes of the opportunity of challenging the measure according to national law of the Member State of origin after enforcement has been accomplished, while Article 2(a) of the Brussels Ibis Regulation rigorously excludes provisional measures from cross-border recognition and enforcement where the defendant has not been granted the right to a hearing, unless the judgment containing the measure is served on the defendant prior to enforcement.<sup>2230</sup>

Interestingly, the approach of the Commission Proposal 2010 is consistent with Articles 7(1) and 9(4) of Directive 2004/48/EC<sup>2231</sup> according to which Member States are explicitly required to introduce *ex parte* relief:

**Article 7(1) of Directive 2004/48/EC**

(1) (...) Those measures (to preserve relevant evidence) shall be taken, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the rightholder or where there is a demonstrable risk of evidence being destroyed.

Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed.

**Article 9(4) of Directive 2004/48/EC**

(...)

(4) Member States shall ensure that the provisional measures (...) may, in appropriate cases, be taken without the defendant having been heard, in particular where any delay would cause irreparable harm to the rightholder. In that event, the parties shall be so informed without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable time after notification of the measures, whether those measures shall be modified, revoked or confirmed.

---

<sup>2230</sup> Von Hein (2013)59(3) RIW 97, at p. 107 et seq.; Pohl (2013)33(2) IPRax 109, at p. 114.

<sup>2231</sup> Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (revised version), OJ L195 of 2 June 2004, pp. 16-25, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32004L0048R%2801%29&from=EN>> (lastly accessed on 1 June 2015).

Additionally, the approach pursued by the Commission Proposal 2010 is in line with the more flexible jurisprudence of both the ECJ and the ECHR with regard to the interpretation of the right to be heard in the context of provisional measures.<sup>2232</sup> So, the ECJ held in its *Eurofood* decision on the interpretation of Council Regulation (EC) No 1346/2000 of 29 May 2000 on insolvency proceedings:

“Concerning more particularly the right to be notified of procedural documents and, more generally, the right to be heard, (...) these rights occupy an eminent position in the organisation and conduct of a fair legal process. In the context of insolvency proceedings, the right of creditors or their representatives to participate in accordance with the equality of arms principle is of particular importance. Though the specific detailed rules concerning the right to be heard may vary according to the urgency for a ruling to be given, any restriction on the exercise of that right must be duly justified and surrounded by procedural guarantees ensuring that persons concerned by such proceedings actually have the opportunity to challenge the measures adopted in urgency [underscore added].”<sup>2233</sup>

Similarly, the ECHR stated in its *Micallef* decision that

“(...) the Court accepts that in exceptional cases – where, for example, the effectiveness of the (interim) measure sought depends upon a rapid decision-making process – it may not be possible immediately to comply with all of the requirements of Article 6. Thus, in such specific cases, while the independence and impartiality of the tribunal or the judge concerned is an indispensable and inalienable safeguard in such proceedings, other procedural safeguards may apply only to the extent compatible with the nature and purpose of the interim proceedings at issue (...) [underscore added].”<sup>2234</sup>

Noteworthy, the Commission Proposal 2010 limits the eventual cross-border effects of an order of provisional measures at the level of enforcement. In this respect, Article 44(3) of the Commission Proposal 2010 provides:

#### **Article 44(3) of the Commission Proposal 2010**

(...)

(3) Where a protective measure was ordered without the defendant having been summoned to appear and enforced without prior service of the defendant, the competent authority may, on application by the defendant, suspend the enforcement if the defendant has challenged the measure in the Member State of origin.

Noteworthy, according to the Commission Proposal 2010, the suspension of the enforcement of an *ex parte* order of provisional measures depends on the application *by the defendant*, meaning that the grant of the right to a hearing before rendering provisional measures is not *per se* a prerequisite for the recognition and enforcement in another Member State. This idea – the requirement of the defendant's application for the suspension – may appear at first glance, in a way, similar to Article 45(1)(b) of the Brussels Ibis Regulation according to which the refusal of recognition of a judgment depends on a party's *application*. However, a closer look reveals that there are considerable differences between those provisions: while Article 45(1)(b) of the Brussels Ibis Regulation concerns the recognition level, Article 44(3) of the Commission Proposal 2010 comes into play at the enforcement level (due to the fact that the Commission Proposal 2010 is based on the abolition of the exequatur procedure, cf. explications below). Further, while Article 45(1)(b) of the Brussels Ibis Regulation becomes

<sup>2232</sup> Heinze (2011)75 RabelsZ 581, at p. 615.

<sup>2233</sup> ECJ 2 May 2006, C-341/04, *Eurofood IFSC Ltd*, [2006] ECR I-03813, para. 66 – *Eurofood*.

<sup>2234</sup> ECHR 15 October 2009, Application no. 17056/06, *Micallef v Malta*, available at [http://hudoc.echr.coe.int/sites/eng/pages/search.aspx#{%22appno%22:\[%2217056/06%22\],%22itemid%22:\[%22001-95031%22\]}](http://hudoc.echr.coe.int/sites/eng/pages/search.aspx#{%22appno%22:[%2217056/06%22],%22itemid%22:[%22001-95031%22]}), para. 86 – *Micallef*.

effective on the application of “*any interested party*”, Article 44(3) of the Commission Proposal 2010 explicitly requires an application of the *defendant*.

A comparison between the Commission Proposal 2010 and the Brussels Ibis Regulation reveals that the Brussels Ibis Regulation pursues an approach which is more in favour of the defendant in provisional proceedings than the Commission Proposal 2010, by rigorously precluding provisional measures from cross-border recognition and enforcement where the defendant has not been granted the right to a hearing, unless the judgment containing the measure is served on the defendant prior to enforcement.<sup>2235</sup>

### **3.3.4.2.5.6 Creation of clear rules regarding the coordination of several, including preliminary, proceedings**

Unlike the Brussels Ibis Regulation according to which there is no “hierarchisation”<sup>2236</sup> between the court having jurisdiction for the substance of the case and the court having independent jurisdiction for provisional measures, meaning that principal proceedings and provisional proceedings, respectively several provisional proceedings before different courts may be brought without any coordination,<sup>2237</sup> the Commission Proposal 2010 pursues a cooperative approach. According to Article 31 of the Commission Proposal 2010, the possible conflict over provisional measures when proceedings before the court of substance and a “non-substance” court are pending shall be solved by interaction in the form of cooperation between the two courts.<sup>2238</sup> This is to ensure that all circumstances of the case are taken into account when a provisional measure is granted.<sup>2239</sup> Article 31 of the Commission Proposal 2010 reads as follows:

#### **Article 31 of the Commission Proposal 2010**

If proceedings as to the substance are pending before a court of a Member State and the courts of another Member State are seised with an application for provisional, including protective measures, the courts concerned shall cooperate in order to ensure proper coordination between the proceedings as to the substance and the provisional relief.

In particular, the court seised with an application for provisional, including protective measures shall seek information from the other court on all relevant circumstances of the case, such as the urgency of the measure sought or any refusal of a similar measure by the court seised as to the substance.

While the idea of cooperation between the involved courts may seem a desirable solution (which would argue for a general duty of cooperation to be introduced), it has rightly been doubted that the Commission Proposal 2010 establishes a solution which is manageable in practice.<sup>2240</sup> First of all, cooperation between courts premises that those courts know of the other proceeding.<sup>2241</sup> Second, different languages can impede an effective cooperation of the courts.<sup>2242</sup> In this regard, it has been proposed that a separate standard form for provisional

---

<sup>2235</sup> Von Hein (2013)59(3) RIW 97, at pp. 107-108; Pohl (2013)33(2) IPRax 109, at p. 114.

<sup>2236</sup> Cf. Hess (2011)31(2) IPRax 125, at p. 130.

<sup>2237</sup> Domej (2014)78 RabelsZ 508, at p. 548.

<sup>2238</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290; Hess (2011)31(2) IPRax 125, at p. 130.

<sup>2239</sup> European Commission 2010 (Commission Proposal 2010), p. 10.

<sup>2240</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290.

<sup>2241</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290.

<sup>2242</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290.

measures could be developed or that some further questions are added to the standard form of Annex I.<sup>2243</sup> Finally, due to the need for quick interim relief, it might be impossible or at least impractical to establish contacts between the courts before ordering the provisional measure.<sup>2244</sup>

While not explicitly mentioned in the text of Article 35 of the Commission Proposal 2010, the court of substance should be considered to have the power not only to issue provisional measures, but also to discharge such measures which does not comprise the discharge of measures issued by “non-substance” courts.<sup>2245</sup> As has already been mentioned, the Commission Proposal 2010 does not contain a provision according to which the court being competent on the basis of Article 35 of the Commission Proposal 2010 to order provisional measures would have authority, comparably to the situation under the Brussels Ibis Regulation, to discharge provisional measures granted by a court of another Member State.<sup>2246</sup>

### **3.3.4.2.5.7 The approach of the Commission Proposal 2010 of refusal of *enforcement* of provisional measures when irreconcilable with other judgments**

Under the Brussels Ibis Regulation, the recognition of a judgment given in a Member State, in another Member State, occurs without any special procedure being required (Article 36(1) of the Brussels Ibis Regulation),<sup>2247</sup> and its enforcement in another Member State (merely) requires that this judgment is enforceable in the Member State of origin, without any declaration of enforceability being required (Article 39 of the Brussels Ibis Regulation).<sup>2248</sup>

One of the most important and progressive issues addressed by the Commission Proposal 2010 is the proposed abolition of the exequatur procedure for all judgments covered by the scope of the Regulation (with the exception of judgments in defamation and compensatory collective redress cases), without any possibility of opposing the recognition of a judgment given in a Member State.<sup>2249</sup> In this respect, Article 38 of the Commission Proposal 2010 provides:

---

<sup>2243</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290, proposing, for instance: urgent: yes/no; very urgent: yes/no etc. (cf. there fn. 205).

<sup>2244</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290.

<sup>2245</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290; Dickinson (2010)30(3) IPRax 203, at p. 208; differently: Article 31(3) of the Heidelberg Proposal.

<sup>2246</sup> Hess (2011)31(2) IPRax 125, at p. 130.

<sup>2247</sup> This corresponds to the legal situation under the Brussels I Regulation, cf. Article 33(1) of the Brussels I Regulation: “A judgment given in a Member State shall be recognised in the other Member States without any special procedure being required.”

<sup>2248</sup> This legal *status quo* under the Brussels Ibis Regulation as to enforcement considerably differs from the previous legal situation under the Brussels I Regulation according to which enforcement of a judgment given in a Member State, in another Member State, required not only enforceability in the Member State of origin, but also a *declaration of enforceability* on the application of any interested party. Article 38(1) of the Brussels I Regulation reads: “A judgment given in a Member State and enforceable in that State shall be enforced in another Member State when, on the application of any interested party, it has been declared enforceable there.”

<sup>2249</sup> As a compensation for the abolition of the exequatur procedure, the Commission Proposal 2010 provides for certain remedies in favour of the defendant by which he could prevent in exceptional circumstances that a judgment given in one Member State takes effect in another Member State: The defendant would be able to contest the judgment in the Member State of origin if he was not properly informed about the proceedings in that State (Article 45 of the Commission Proposal 2010). Furthermore, the defendant would dispose of an extraordinary remedy in the Member State of enforcement which would enable the defendant to contest any other procedural defects which might have arisen during the proceedings before the court of origin and which may have infringed his right to a fair trial (Article 46 of the Commission Proposal 2010). Additionally, the defendant would be enabled to stop the enforcement of the judgment if it is irreconcilable with another judgment

### **Article 38 of the Commission Proposal 2010**

(1) Subject to the provisions of this Chapter, a judgment given in a Member State shall be recognised in the other Member States without any special procedure being required and without any possibility of opposing its recognition.

(2) A judgment given in one Member State which is enforceable in that State shall be enforceable in another Member State without the need for a declaration of enforceability.

As has been mentioned above, Article 2(a) of the Commission Proposal 2010 determines that “for the purposes of Chapter III” of the Commission Proposal 2010 which deals with recognition, enforceability and enforcement, provisional measures are to be considered judgments if they are issued by a Member State court which has jurisdiction for the substance of a matter according to the Brussels Regulation:

### **Article 2(a) of the Commission Proposal 2010**

(...)

(a) (...)

For the purposes of Chapter III, the term 'judgment' includes provisional, including protective measures ordered by a court which by virtue of this Regulation has jurisdiction as to the substance of the matter. (...)

It is remarkable that Article 2(a) of the Commission Proposal 2010, in this respect, corresponds to Article 2(a) of the Brussels Ibis Regulation, which reads:

### **Article 2(a) of the Brussels Ibis Regulation**

(...)

(a) (...)

For the purposes of Chapter III, ‘judgment’ includes provisional, including protective, measures ordered by a court or tribunal which by virtue of this Regulation has jurisdiction as to the substance of the matter. (...)

On the basis of the approach of the Commission Proposal 2010 to abolish the exequatur procedure, the aspect of a refusal of recognition of an order of provisional measures has become obsolete, because then there would be no possibility at all of opposing the recognition of the order of provisional measures of the court in another Member State.

However, at the enforcement level, Article 43 of the Commission Proposal 2010 provides that the defendant can stop the enforcement of the judgment if it is irreconcilable with another judgment which has been issued in the Member State of enforcement or, in certain conditions, in another State:

---

which has been issued in the Member State of enforcement or, in certain conditions, in another country (Article 43 of the Commission Proposal 2010); cf.: European Commission 2010 (Commission Proposal 2010), p. 6; Von Hein (2013)59(3) RIW 97, at p. 108 et seq.; Weller (2012)9(1) GPR 34, at p. 35.



### Article 43 of the Commission Proposal 2010

The competent authority in the Member State of enforcement shall, on application by the defendant, refuse, either wholly or in part, the enforcement of the judgment if

- (a) it is irreconcilable with a judgment given in a dispute between the same parties in the Member State of enforcement;
- (b) it is irreconcilable with an earlier judgment given in another Member State or in a third State involving the same cause of action and between the same parties provided that the earlier judgment fulfils the conditions necessary for its recognition in the Member State of enforcement.

The grounds for refusal of enforcement mentioned in Article 43 of the Commission Proposal 2010 correspond to the grounds for refusal of recognition pursuant to Article 45(1)(c) and (d) of the Brussels Ibis Regulation (respectively the grounds for non-recognition according to Article 34(3) and (4) of the Brussels I Regulation<sup>2250</sup>). However, it is to be noticed that non-enforcement according to Article 43 of the Commission Proposal 2010 depends on the defendant's application, while refusal of recognition according to Article 45(1)(c) and (d) of the Brussels Ibis Regulation is dependent on the application of any interested party.<sup>2251</sup>

Noteworthy, the Commission Proposal 2010 does not deliver an answer to the question how to solve a possible conflict in the constellation where a court which lacks jurisdiction on the substance has already issued a provisional measure when a provisional measure of the court of substance which is irreconcilable with the first measure shall be enforced in the State of the first court.<sup>2252</sup> Should the defendant, on the basis of Article 43(a) of the Commission Proposal 2010, be entitled to apply for refusal of the enforcement of the provisional measure rendered by the court of substance? As the court of substance will, in comparison with the “non-substance” court, likely be in a better position to assess the required kind and necessity of provisional measures, one may argue that it would be preferable to concede priority to provisional measures ordered by the court of substance given they satisfy the requirements for recognition and enforcement.<sup>2253</sup> In comparison with the Commission Proposal 2010, the Brussels Ibis Regulation provides for extended possibilities for a refusal of enforcement (besides the possibility of refusal of recognition) of a judgment rendered in another Member State. It may happen that recognition and enforcement of a provisional measure of the court having jurisdiction for the substance of a case is denied in another Member State where courts (merely) have independent jurisdiction for provisional measures (in conjunction with national law), due to the fact that the decision is irreconcilable with an earlier judgment on the grant of interim relief rendered in that other Member State.<sup>2254</sup>

---

<sup>2250</sup> Cf. Weller (2012)9(1) GPR 34, at p. 35.

<sup>2251</sup> In contrast to both the Commission Proposal 2010 and the Brussels Ibis Regulation, non-recognition pursuant to Article 34(3) and (4) of the Brussels I Regulation occurred *ex officio*.

<sup>2252</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290; the authors rightly suggest that Article 31 of the Commission Proposal 2010 which deals with the duty of cooperation may be useful but presumably remains ineffective.

<sup>2253</sup> Magnus & Mankowski (2011)110 ZVglRWiss 252, at p. 290 et seq.

<sup>2254</sup> Domej (2014)78 RabelsZ 508, at p. 548, with reference to the *Italian Leather* decision of the ECJ (cf. ECJ 6 June 2002, C-80/00, *Italian Leather SpA v WECO Polstermöbel GmbH & Co.*, [2002] ECR I-04995 – *Italian Leather*).

### 3.3.4.2.5.8 Recognition and enforcement of provisional measures ordered according to rules of independent jurisdiction for provisional measures

Almost identically with the Brussels Ibis Regulation, the Commission Proposal 2010 provides that provisional measures can, according to the rules of the Brussels Ibis Regulation, only be recognised and enforced in other Member States if they were ordered by a court having jurisdiction as to the substance of the case according to the Brussels Regulation. If the court which ordered the provisional measure had no jurisdiction on the substance of the matter pursuant to the Brussels Regulation, recognition and enforcement in another Member State shall be excluded, meaning that measures issued by “non-substance” courts remain valid only in the territory of the forum State, and cannot be enforced outside.<sup>2255</sup> Comparably to Article 2(a) of the Brussels Ibis Regulation, Article 2(a) of the Commission Proposal 2010 stipulates in this regard:

#### Article 2(a) of the Commission Proposal 2010

(...)

(a) (...) For the purposes of Chapter III, the term 'judgment' includes provisional, including protective measures ordered by a court which by virtue of this Regulation has jurisdiction as to the substance of the matter. (...).

Article 2(a) of the Commission Proposal 2010 is consistent with Recital 25 2<sup>nd</sup> and 3<sup>rd</sup> sentence of the Commission Proposal 2010:

#### Recital 25 2<sup>nd</sup> and 3<sup>rd</sup> sentence of the Commission Proposal 2010

The removal of intermediate measures requires an adaptation of the free circulation of provisional, including protective measures. Where such measures are ordered by a court having jurisdiction as to the substance of a dispute, their free circulation should be ensured. Where, however, such measures are adopted by a court not having jurisdiction as to the substance, the effect of such measures should be confined to the territory of that Member State. Furthermore, the free circulation of measures ordered *ex parte* should be allowed if accompanied by appropriate safeguards.

Remarkably, Recital 25 2<sup>nd</sup> and 3<sup>rd</sup> sentence of the Commission Proposal 2010 is very similar to Recital 33 1<sup>st</sup> and 4<sup>th</sup> sentence of the Brussels Ibis Regulation:

#### Recital 33 1<sup>st</sup> and 4<sup>th</sup> sentence of the Brussels Ibis Regulation

Where provisional, including protective, measures are ordered by a court having jurisdiction as to the substance of the matter, their free circulation should be ensured under this Regulation. (...) Where provisional, including protective, measures are ordered by a court of a Member State not having jurisdiction as to the substance of the matter, the effect of such measures should be confined, under this Regulation, to the territory of that Member State.

---

<sup>2255</sup> Magnus & Mankowski (2011) 110 ZVglRWiss 252, at p. 290; differently, since apparently even denying jurisdiction of these courts to order a measure of cross-border interim relief such as a “worldwide freezing injunction” in order to support a foreign proceeding on the substance: Hess (2011) 31(2) IPRax 125, at p. 130.

Comparably to the Brussels Ibis Regulation, this approach pursued in the Commission Proposal 2010 may be interpreted as being based on an understanding of the “real connecting link” as referring to the place of (prospective) enforcement, while avoiding a definition by simply denying enforcement under Chapter III.<sup>2256</sup> Alternatively, one might conclude that the Commission Proposal 2010 does not start at the question of admissibility of the provisional measure but consequently chooses an approach focused on its enforcement notwithstanding if there was a “real connecting link” justifying the order of the concerned measure.<sup>2257</sup> In any event, the exclusion of cross-border enforcement of provisional measures based on Article 36 of the Commission Proposal 2010 (independent jurisdiction for provisional measures) shifts the real connecting link to the enforcement level, which makes it less important to define this requirement at the level of jurisdiction.<sup>2258</sup> This approach brings along both disadvantages and advantages.

On the one hand, it has been underlined that this approach may encourage a transfer of assets outside the forum State once provisional relief is applied for on the basis of Article 36 of the Commission Proposal 2010, because the eventual measure will not reach beyond the borders of this State.<sup>2259</sup> With regard to the Brussels I Regulation, it has also been put forth in this respect that, in case that provisional measures based on independent jurisdiction were excluded from cross-border enforcement according to the rules of the Brussels I Regulation, the effectiveness of the regime of the Brussels I Regulation would be impeded in general by encouraging evasive action and a multiplicity of legal proceedings, which would go along with an increase of costs and a reduction of the prospect of a final judgment being successfully enforced.<sup>2260</sup> Second, it has been put forward that the Commission Proposal 2010 effects that a court not having jurisdiction over the substance of the case could no longer (effectively) “lend its remedies” to another court,<sup>2261</sup> because the measure based on Article 36 of the Commission Proposal 2010 would not enjoy recognition and enforcement under Chapter III of the Brussels I Regulation. As a consequence, the applicant would either have to seek cross-border provisional relief from the courts having jurisdiction as to the substance of the case (Article 35 of the Commission Proposal 2010), or, alternatively, would have to apply for local relief in every jurisdiction where enforcement was necessary (Article 36 of the Commission Proposal 2010).<sup>2262</sup>

However, despite these flaws linked with the solution established by the Commission Proposal 2010, there are, on the other hand, several arguments which militate in favour of the latter approach. First of all, it is consistent with other European instruments, notably the Brussels Ibis Regulation and the Community Regulations on unitary IP rights<sup>2263</sup> which

<sup>2256</sup> Heinze (2011)75 *RabelsZ* 581, at p. 611.

<sup>2257</sup> Cf. Domej (2014)78 *RabelsZ* 508, at p. 543.

<sup>2258</sup> Heinze (2011)75 *RabelsZ* 581, at p. 613.

<sup>2259</sup> Heinze (2011)75 *RabelsZ* 581, at p. 611 et seq.

<sup>2260</sup> Dickinson (2010)30(3) *IPRax* 203, at p. 212.

<sup>2261</sup> Under the Brussels I Regulation, given the existence of a real connecting link, the court which lent its remedies could issue provisional measures on the basis of Article 31 of the Brussels I Regulation. This practice could be useful if a jurisdiction had developed specific forms of provisional relief which the court having jurisdiction for the substance of the case did not possess. Such measures could then be enforced in other Member States under Chapter III of the Brussels I Regulation. (cf. Heinze (2011)75 *RabelsZ* 581, at p. 612 with further references).

<sup>2262</sup> Heinze (2011)75 *RabelsZ* 581, at p. 612.

<sup>2263</sup> Cf. Article 103(2) of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1-42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015); Article 90(3) of the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, OJ L3 of 5 January 2002, pp. 1-24, available at WWW <[http://eur-](http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:EN:PDF)

contain the same rule. Second, as to the addressed risk of a transfer of assets, this risk may be countered by the fact that *ex parte* measures can be granted in the enforcement State, and parallel provisional measures can be taken by the court which has jurisdiction for the substance of the case, these measures enjoying cross-border enforcement pursuant to Article 2(a) of the Commission Proposal 2010.<sup>2264</sup> Besides, it has been pointed out that cross-border enforcement necessarily leads to a separation of the remedy from its enforcement context; as a consequence, specific effects of the measure may be impeded.<sup>2265</sup> Moreover, the ECJ has taken the position, in its *Purrucker* decision on the interpretation of Council Regulation (EC) No 2201/2003 of 27 November 2003 concerning jurisdiction and the recognition and enforcement of judgments in matrimonial matters and the matters of parental responsibility, repealing Regulation (EC) No 1347/2000 (Brussels Ibis Regulation) that

“(…) to accept the recognition and enforcement of measures within the scope of Article 20 of Regulation No 2201/2003 in all other Member States, including the State which has substantive jurisdiction, would, in addition, create a risk of circumvention of the rules of jurisdiction laid down by that regulation and of forum shopping, which would be contrary to the objectives pursued by that regulation (….) [underscore added].”<sup>2266</sup>

The risk of forum shopping and circumvention of rules of jurisdiction is even more relevant in a system where exequatur proceedings are abolished, meaning that several courts may issue cross-border measures which circulate freely in all Member States which increases the risk of contradictory orders at the enforcement stage.<sup>2267</sup> This issue is suggested in Recital 25 1<sup>st</sup> sentence of the Commission Proposal 2010:

#### **Recital 25 1<sup>st</sup> sentence of the Commission Proposal 2010**

The removal of intermediate measures requires an adaptation of the free circulation of provisional, including protective measures. Where such measures are ordered by a court having jurisdiction as to the substance of a dispute, their free circulation should be ensured. Where, however, such measures are adopted by a court not having jurisdiction as to the substance, the effect of such measures should be confined to the territory of that Member State. Furthermore, the free circulation of measures ordered *ex parte* should be allowed if accompanied by appropriate safeguards.

After all, Article 2(a) of the Commission Proposal 2010, like Article 2(a) of the Brussels Ibis Regulation, seems not to prohibit provisional measures, ordered on the basis of independent jurisdiction for interim relief, from having extraterritorial effect as long as these measures can be enforced domestically, for instance due to the fact that the defendant is present in this jurisdiction,<sup>2268</sup> although it is to be noticed that Recital 25 of the Commission Proposal 2010 contains no comparably clear statement as Recital 33 4<sup>th</sup> sentence of the Brussels Ibis Regulation according to which the effect of provisional measures ordered by courts on the basis of independent jurisdiction for interim relief is confined, *under this Regulation*, to the territory of the forum Member State. In any event, the exclusion of provisional measures

---

[lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:en:PDF](http://lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:en:PDF)> (lastly accessed on 1 June 2015), amended by Council Regulation (EC) No 1891/2006 of 18 December 2006, OJ L386 of 29 December 2006, pp. 14-16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32006R1891&from=EN>> (lastly accessed on 1 June 2015).

<sup>2264</sup> Heinze (2011)75 RabelsZ 581, at p. 612.

<sup>2265</sup> Heinze (2011)75 RabelsZ 581, at p. 612.

<sup>2266</sup> ECJ 15 July 2010, C-256/09, Bianca Purrucker v Guillermo Vallés Pérez, [2010] ECR I-07353, para. 91 – *Purrucker*.

<sup>2267</sup> Heinze (2011)75 RabelsZ 581, at p. 612.

<sup>2268</sup> Heinze (2011)75 RabelsZ 581, at p. 612 et seq.

based on Article 36 of the Commission Proposal 2010 from cross-border enforcement under the rules of the Brussels Regulation seems not to pre-empt the recognition and enforcement under more favourable national rules at least as long as recognition and enforcement is not fully harmonised by European rules which might be concluded from an analogy from *Purrucker*<sup>2269</sup> where the ECJ held:

“The fact that measures falling within the scope of Article 20 of Regulation No 2201/2003 do not qualify for the system of recognition and enforcement provided for under that regulation does not, however, prevent all recognition or all enforcement of those measures in another Member State (...). Other international instruments or other national legislation may be used, in a way that is compatible with the regulation [underscore added].”<sup>2270</sup>

### **3.3.4.2.5.9 Creation of a clarifying provision of whether Article 24(4) of the Brussels Ibis Regulation is applicable where an invalidity defence is raised in provisional proceedings**

The Commission Proposal 2010 contains no provision, neither in the context of provisions on exclusive jurisdiction nor in the context of provisions of interim relief, that could be referred to in order to clarify whether Article 24(4) of the Brussels Ibis Regulation applies where an invalidity defence is raised in provisional proceedings. Consequently, recourse must be had to the jurisprudence of the ECJ, in particular the court's decision in the *Solvay* case, which did not mean any amelioration vis-à-vis the situation under the Brussels I Regulation.

### **3.3.4.3 Final comment and formulation proposal**

Compared with Articles 7(2), 8(1) and 24(4) of the Brussels Ibis Regulation, Article 35 of the Brussels Ibis Regulation has already established considerable amendments in comparison with the legal situation under the Brussels Convention respectively the Brussels I Regulation, by codifying crucial jurisprudence of the ECJ in the text of the Brussels Ibis Regulation. As to remaining problematic issues, the same as has been stated above in the framework of the aforementioned Articles also applies in this context: Any reform proposal must pass the “stress test” of whether it delivers adequate solutions for problems existing under present law.

In comparison with the mentioned and analysed reform proposals, the elaborate solutions proposed by the CLIP Principles principally seem appropriate to adequately regulate the subject of interim relief. In particular, the broad formulation of the CLIP Principles effects that this proposal may combine a lot of opinions and thus raises the chances of acceptance and realisation. Although, as has been concluded in the foregoing chapter, the criterion of enforceability of a provisional measure should be considered the primary, i.e. the essential criterion when it comes to the question of whether a court having no jurisdiction as to the substance of a matter may order a provisional measure, the approach of the CLIP Principles to refer, on the one hand, to enforceability and, on the other hand, to the place of protection seems convincing in *practical* respect, because those criteria do not exclude each other, and the number of courts having jurisdiction to order provisional measures is merely enlarged. Another advantage of the CLIP Proposal is the adequate definition of provisional measures.

An amendment of the set of rules concerning interim relief in the Brussels Ibis Regulation should therefore pick up the solutions contained in the CLIP Proposal. Article 2(a) of the

---

<sup>2269</sup> Heinze (2011)75 *RabelsZ* 581, at p. 614 et seq.

<sup>2270</sup> ECJ 15 July 2010, C-256/09, *Bianca Purrucker v Guillermo Vallés Pérez*, [2010] ECR I-07353, para. 92 – *Purrucker*.

Brussels Ibis Regulation which includes rules similar to Article 4:301(1) and (2) of the CLIP Principles should be maintained. While, as to the protection of the defendant's right to a hearing, Article 2(a) of the Brussels Ibis Regulation (“(...) unless the judgment containing the measure is served on the defendant prior to enforcement”) at first glance seems to be more liberal (i.e. more in favour of the applicant) than Article 4:301(2) of the CLIP Principles (“(...) shall not be enforced.”), it is to be considered that recognition and enforcement according to Article 4:301(2) of the CLIP Principles, since this provision aims at providing *adequate* (and not overly) protection of the rights of the defendant, is not excluded if the provisional measure concerned is confirmed after the defendant has been served with the judgment and given the opportunity to appear and seek its discharge in due time.<sup>2271</sup> As both provisions are thus comparable, Article 2(a) of the Brussels Ibis Regulation which has already entered into force should be maintained.

Similarly, since Article 45(1)(c) and (d) of the Brussels Ibis Regulation should generally lead to similar results as reached according to Article 4:501(3) and (4) of the CLIP Principles (with the difference that non-recognition and non-enforcement according to Article 4:501 of the CLIP Principles applies *ex officio*, while pursuant to Article 45(1) of the Brussels Ibis Regulation that consequence depends on the application of any interested party), it seems reasonable to adhere to Article 45 of the Brussels Ibis Regulation which has already entered into force.

To conclude, Article 35 of the Brussels Ibis Regulation should be reformulated according to Article 2:501 of the CLIP Principles as follows:

#### **Provisional, including protective, measures**

##### **Article 35**

(1) A court having jurisdiction as to the substance of a matter also has jurisdiction to order any provisional, including protective, measures.

(2) Provisional, including protective, measures may also be ordered by the courts of a Member State

(a) where the measure is to be enforced, or

(b) for which protection is sought.

(3) Provisional, including protective, measures are measures which are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case. Such measures may include

(a) orders to prevent an (imminent or continuing) infringement of an intellectual property right from occurring;

(b) orders to preserve relevant evidence in regard to the alleged infringement;

(c) orders to seize goods suspected of infringing an intellectual property right;

(d) orders to seize, attach or prevent the dissipation or removal from the jurisdiction of assets to safeguard enforcement of the judgment on the merits; and

---

<sup>2271</sup> De Miguel Asensio 2010, pp. 270, 271; De Miguel Asensio 2013 (CLIP Principles), Article 4:301, para. 4:301.C11.

(e) orders directing a party to provide information about the location of assets which are subject of an order under lit. (d).

Article 2(a) and Article 45(1)(c) and (d) of the Brussels Ibis Regulation should apply. With regard to Articles 2:705 and 2:704 of the CLIP Principles which have been discussed above, equally clear provisions should be integrated in the Brussels Ibis Regulation, but, since they concern the coordination of proceedings in general, should be part of a separate section of Chapter II of the Brussels Ibis Regulation. As has already been proposed above in the framework of exclusive jurisdiction, a clear solution would be to integrate the content of the complete Section 7 of the CLIP Principles in Chapter 2 of the Brussels Ibis Regulation which would also ensure the internal balance of these provisions.

As to an eventual future Global Judgments Convention, the content of the discussed provisions of the CLIP Proposal should be adopted.<sup>2272</sup> As to Article 4:301(1) and (2) of the CLIP Principles, it is to be stated that in light of the paramount importance of ensuring adequate protection to the rights of the defendant, such a restrictive approach as pursued in Article 4:301(1) and (2) of the CLIP Principles seems in particular justified in view of a scheme intended to be applicable to decisions rendered by States all over the world.<sup>2273</sup> Thus, the CLIP Principles could in this point serve as an orientation for an eventual Global Judgments Convention, while it does not prevent the establishment of a more liberal approach, as drafted above, between States belonging to a regional integration organization or agreeing on a convention.<sup>2274</sup> Despite the so-called *favor recognitionis* principle according to which the most favourable regime applies (cf. Article 4:103 of the CLIP Principles) and the fact that Article 50(2) of the TRIPS Agreement provides that courts shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, Member States are not obliged to recognise foreign decisions rendered under these circumstances.<sup>2275</sup>

---

<sup>2272</sup> The exact wording and choice of provisions of such an eventual future Global Judgments Convention would depend on its envisaged scope. If required, the whole complex of provisions of the CLIP Principles could be adopted to establish a complete set of rules.

<sup>2273</sup> De Miguel Asensio 2010, p. 270.

<sup>2274</sup> De Miguel Asensio 2010, p. 270.

<sup>2275</sup> De Miguel Asensio 2010, p. 270.

## CHAPTER 4



## 4. The creation of a European patent with unitary effect and a Unified Patent Court as an alternative in order to avoid existing jurisdictional problems?

### 4.1 Introduction

Having treated, in Chapter 2 and Chapter 3, international jurisdiction in patent infringement proceedings with regard to national patents and European patents, i.e. bundles of national patents, I shall turn in this chapter to the issue of international jurisdiction with regard to proceedings concerning the infringement of what has initially been named a Community Patent or EU Patent and which is today denominated a “European patent with unitary effect”. Afterwards, the so-called Unified Patent Court shall be discussed.

Aiming at the creation of a uniform patent regime within the European Union, one of the biggest single markets worldwide, the European Parliament and the European Council agreed on the so-called “patent package” consisting of three components: a Regulation creating a European patent with unitary effect (hereinafter Regulation 1257/2012)<sup>2276</sup>, a Regulation establishing a language regime applicable to the European patent with unitary effect (hereinafter Regulation 1260/2012)<sup>2277</sup> and an international agreement among Member States establishing a single and specialised patent judiciary, named “Unified Patent Court” (hereinafter UPC Agreement)<sup>2278</sup>, which sits outside of the EU institutional framework. However, the question remains whether every player on the playing field of patent law in Europe will benefit from the new system.

Although the creation of such substantive and procedural instruments are closely linked with each other in practice – the future development of a European patent with unitary effect depends upon agreeing on a corresponding system for patent litigation that is both compatible with EU law and meets the needs of practitioners<sup>2279</sup> – I shall discuss both elements separately in order to be able to analyse their particularities in more detail. Before that, I shall give a brief overview of what has been achieved over the past decades with regard to the creation of a sort of uniform patent within Europe. It is noteworthy that attempts to establish such a uniform patent have been linked with the idea of creating a single European patent court in order to avoid jurisdictional problems which can arise in cross-border disputes.

---

<sup>2276</sup> Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection, OJ L361 of 31 December 2012, pp. 1-8, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0001:0008:en:PDF>> (lastly accessed on 1 June 2015).

<sup>2277</sup> Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, OJ L361 of 31 December 2012, pp. 89-92, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0089:0092:en:PDF>> (lastly accessed on 1 June 2015).

<sup>2278</sup> Council of the European Union, Agreement on a Unified Patent Court, OJ C175 of 20 June 2013, pp. 1-40, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2013:175:0001:0040:EN:PDF>> (lastly accessed on 1 June 2015).

<sup>2279</sup> Peers (2011)7(2) E.C.L. Review 229, at p. 230; Poore (2011)33(7) E.I.P.R. 409, at p. 412.

## 4.2 The long march towards a uniform patent in Europe and an adequate litigation system

The creation of a sort of uniform patent granting protection in the territories of all EU Member States, to be supplemented by a special court dealing with proceedings with regard to such a patent, is no idea that has been developed recently. On the contrary, efforts to install such an instrument, since the fragmentation of patent protection is costly and considered detrimental to the achievement of economic growth through innovation,<sup>2280</sup> have been – without success – undertaken since the 1960s.<sup>2281</sup> In order to embed the most recent developments as to this subject into their historical framework, and thus to make comprehensible their significance, I shall start my considerations with a summary of what has been undertaken and realised so far. Noteworthy, developments in this area, since their hesitant beginnings, have enormously accelerated.

In 1975, the plans for a uniform patent for the European Communities were negotiated, but finally failed in the phase of ratification by the national parliaments. Another convention on a Community patent signed by twelve States of the European Communities in 1989 was merely ratified by seven amongst them, thus missing the sufficient number of ratifications to put the Convention into effect. One decade later, the European Commission developed a proposal to create a Community Patent, by a Regulation, which, remarkably, should not replace national patents but rather serve as an additional option for applicants to choose. However, the proposal was not successful as no agreement could be found on the language issue, i.e. the question in which languages a patent application must be translated.

In procedural respect, a first approach to establish a single European patent court was the European Patent Litigation Agreement (EPLA), under discussion since 1999. This proposal was supported by a group of patent judges from different European national jurisdictions, and many of its mechanisms have been adopted in later proposals. Nonetheless, the EPLA would apply only to European patents as a protocol to the European Patent Convention, thus being entirely separate from the Single Community Patent. In January 2007, the legal division of the European Parliament gave its opinion that the EPLA would be unlawful as a matter of European Community law as it would violate the EU's exclusive jurisdiction governing such matters.

As to the creation of a Community Patent, particularly the lack of an agreement on the translation regime was the reason for the failure of a further approach of the Member States in 2003. Resolutely, the Commission launched a Communication from 3 April 2007<sup>2282</sup> that contained three options in order to create an integrated system for patent litigation within the European Union. On 4 December 2009, the Member States unanimously adopted the Council conclusions on an “Enhanced patent system for Europe” and a general approach on a draft regulation on the EU patent including its main features.<sup>2283</sup> Nonetheless, agreement on the translation regime again could not be achieved, and the Member States merely affirmed the need for a separate regulation as to this matter.

---

<sup>2280</sup> Koutrakos (2011)36(3) E.L. Rev. 319, at p. 320.

<sup>2281</sup> A good overview of the attempts and different steps to create such a uniform patent is delivered by *Kolle*, cf. *Kolle* 2006, pp. 45-53. As to the longsome and tedious process towards a uniform patent cf. *Pagenberg* (2007)38(7) IIC 805, at pp. 805-825.

<sup>2282</sup> European Commission 2007 (Communication).

<sup>2283</sup> Cf. *Haberl & Schallmoser* (2010)2(2) GRUR-Prax 23, at pp. 23-24.

On 2 July 2010, the Commission submitted a proposal, dated from 30 June 2010, on the translation arrangements for the European Union patent to the Council.<sup>2284</sup> As still no unanimous agreement on the translation arrangements could be realised – Italy and Spain were not prepared to agree to these translation arrangements – initially twelve Member States expressed their wish to establish an enhanced cooperation in the area of creation of unitary patent protection. “Enhanced cooperation”, established by the Lisbon Treaty which entered into force on 1 December 2009, means a legislative procedure available to a minimum of nine Member States under the Treaty of European Union (TEU) according to which EU-wide systems can be established in certain areas falling outside the exclusive competences of the EU, in the case that unanimous agreement between all Member States cannot be reached. The agreements made in this way only bind the involved states, other Member States being allowed to join at any stage before or after an enhanced cooperation has been launched.<sup>2285</sup> Thirteen of the remaining fifteen Member States – except Spain and Italy – followed this example. The European Parliament agreed on this approach on 15 February 2011.<sup>2286</sup>

On 8 March 2011, the ECJ, acting due to a request of the Council from June 2009, delivered its Opinion 1/09 on the compatibility of the draft agreement for setting up a patent court with exclusive jurisdiction for both European patents and future EU patents with unitary effect (hereinafter Patent Court), concluding that the envisaged system was not compatible with the provisions of European Union law.<sup>2287</sup> The court held *inter alia* that the establishment of a unified patent litigation system as planned in this draft agreement would be in breach of the rules of the Treaty on European Union (TEU) and the Treaty on the Functioning of the European Union (TFEU). To put it in a nutshell, the ECJ founded its reasoning mainly on three arguments.<sup>2288</sup> First, the ECJ pointed out that the Patent Court would exist outside the institutional and judicial framework of the European Union, because it would not be part of the judicial system provided for in Article 19(1) TEU, but would rather have the legal nature of an organisation with a distinct personality under international law. Second, the ECJ underlined that, according to Article 15 of the draft agreement, the Patent Court would be vested with exclusive jurisdiction in respect of a significant number of actions brought by individuals in the field of patents. As a consequence, the courts of the contracting States, including the courts of the Member States of the European Union, would lose these competences and only retain those powers which are not subject to the exclusive jurisdiction of the Patent Court. Besides, the ECJ stressed that, in accordance with Article 14a of the draft agreement, the Patent Court would have the duty to interpret and apply European Union law, as the draft agreement confers on that court the main part of the jurisdiction *ratione materiae* held, normally, by the national courts. As a consequence, the Patent Court would have jurisdiction to determine a pending dispute in the light of fundamental rights and general principles of European Union law, or even to examine the validity of an act of the European Union. In this respect, the ECJ held that the Member States are not entitled to confer the jurisdiction to resolve such disputes on a court created by an international agreement, because otherwise they could not fulfil their task to implement European Union law and the obligation to refer questions for a preliminary ruling in the field concerned. According to the draft agreement the power to refer questions for a preliminary ruling is reserved to the Patent Court, meaning national courts are deprived of this competence. The ECJ decided that Article

<sup>2284</sup> European Commission 2010 (Proposal Translation Arrangements).

<sup>2285</sup> Concerning the specific requirements for enhanced cooperation cf. Article 20 TEU; for detailed information on the instrument of enhanced cooperation, cf. Lamping (2011)42(8) IIC 879.

<sup>2286</sup> European Parliament 2011 (Legislative Resolution).

<sup>2287</sup> ECJ 8 March 2011, C-1/09 (Opinion), Request submitted by the Council of the European Union, [2011] ECR I-01137.

<sup>2288</sup> Kant (2012)30(2) NIPR 193, at pp. 194-195.

267 TFEU, aiming to ensure that law has the same effect in all Member States, requires a direct cooperation between the national courts of the Member States and the ECJ. Based on the foregoing, the establishment of the Patent Court would be in breach of the rules of the EU Treaty and the FEU Treaty also for this reason. The ECJ explicitly underlined that the situation of the Patent Court envisaged by the draft agreement would differ from that of the Benelux Court of Justice which was the subject of the *Parfums Christian Dior* case,<sup>2289</sup> because that court is a court common to a number of Member States, situated within the judicial system of the European Union, its decisions being subject to mechanisms capable of ensuring the full effectiveness of the rules of the European Union. Additionally, the ECJ stressed that the creation of the Patent Court as planned in the draft agreement, would not guarantee (or even prevent) an effective protection of rights of individuals, because it would be in contrast to the (effective realisation of the) principle that a Member State is obliged to make good damages caused to individuals as a result of breaches of European Union law for which it is responsible, and to the objective of the provisions of Articles 258 TFEU to 260 TFEU, providing the opportunity of bringing a case before the Court to obtain a declaration that the Member State concerned has failed to fulfil its obligations. If a decision of the Patent Court were to be in breach of European Union law, that decision could not be the subject of infringement proceedings nor could it give rise to any financial liability on the part of one or more Member States.

Despite this Opinion of the ECJ – or eventually just meant as a clear reaction to it – the Council authorised the launch of enhanced cooperation with the participation of 25 Member States two days later, on 10 March 2011.<sup>2290</sup>

On 13 April 2011, the Commission presented proposals on how to implement such cooperation.<sup>2291</sup> On 27 June 2011, the Council agreed a general approach on the Commissions proposals: two draft regulations concerning European patents with unitary effect and translation arrangements.<sup>2292</sup> Subsequently, a provisional agreement on both draft regulations was reached by the Council and the Parliament in December 2011.

Already in June 2011, Spain and Italy had made an application to the ECJ to have the decision of the Council from 10 March 2011 annulled.<sup>2293</sup> The actions were founded on several grounds. It was put forth that the decision involved misuse of powers because the pursued enhanced cooperation was claimed not to further the objectives of the EU, but rather to exclude Member States from negotiations when the objectives could be attained by means of a special agreement as provided for in the EPC. Additionally, it was claimed that the procedure violates the jurisdictional system of the EU for the reason that it does not provide any dispute resolution system. Furthermore, it was criticised that the undertaken approach of

<sup>2289</sup> ECJ 4 November 1997, C-337/95, *Parfums Christian Dior SA and Parfums Christian Dior BV v Evora BV*, [1997] ECR I-06013, paras. 21-23 – *Parfums Christian Dior*.

<sup>2290</sup> Council of the European Union 2011 (Council Decision of March 2011). It is to be noted that enhanced cooperation in this field generally affects the creation of unitary patent protection, in spite of the fact that the initial reason for choosing the approach of enhanced cooperation was the translation issue. As a consequence, Spain and Italy do not participate at all in the project of a unitary patent.

<sup>2291</sup> European Commission 2011 (Press Release).

<sup>2292</sup> Council of the European Union 2011 (Council Proposal 2011).

<sup>2293</sup> With regard to Spain: Action brought on 3 June 2011, C-274/11, *Kingdom of Spain v Council of the European Union*, OJ C219 of 23 July 2011, pp. 12-13, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:219:0012:0013:EN:PDF>> (lastly accessed on 1 June 2015); with regard to Italy: Action brought on 10 June 2011, C-295/11, *Italian Republic v Council of the European Union*, OJ C232 of 6 August 2011, pp. 21-22, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:232:0021:0022:EN:PDF>> (lastly accessed on 1 June 2015).

enhanced cooperation was contrary to the EU treaties, because the procedure is not a last resort, involves areas that should be excluded (for the reason that these areas fall within the exclusive competence of the EU), infringes the principle of non-discrimination and undermines the internal market.

Nonetheless, on 28 June 2012, the heads of state or government of 25 Member States participating by way of enhanced cooperation agreed on the seat of the central division of the court of first instance of the unified patent court.<sup>2294</sup>

The Council approved the agreement together with certain amendments on 10 December 2012.<sup>2295</sup> On 11 December 2012, *Advocate General Bot* issued his opinion in which he proposed to dismiss the cases initiated by Spain and Italy.<sup>2296</sup> Remarkably, also on 11 December 2012, the European Parliament confirmed the institutional agreement.<sup>2297</sup> The two Regulations were signed on 17 December 2012<sup>2298</sup> and published on 31 December 2012. They entered into force on 20 January 2013,<sup>2299</sup> but they shall only apply from 1 January 2014 or the date of entry into force of the UPC Agreement, whichever is the later.<sup>2300</sup> As the UPC Agreement has not entered into force yet, both Regulations are still not applicable.

On 19 February 2013, the UPC Agreement was signed by 24 EU Member States (Bulgaria followed on 5 March 2013), except Poland and Spain,<sup>2301</sup> but including Italy.<sup>2302</sup> According to Article 89(1) of the UPC Agreement, it will enter into force on 1 January 2014 or on the first day of the fourth month after it is ratified by 13 Member States, including France, Germany, and the United Kingdom, or on the first day of the fourth month after the date of entry into force of the amendments to Regulation (EU) No 1215/2012 (Brussels Ibis Regulation) concerning its relationship with the UPC Agreement, whichever is the latest. As these conditions have not been fulfilled yet, the UPC Agreement still has not entered into force.

Noteworthy, the ECJ, on 16 April 2013, dismissed the actions brought by Spain and Italy, denying all grounds put forth by the plaintiffs.<sup>2303</sup>

On 22 March 2013, Spain brought two further actions<sup>2304</sup> which, in essence, sought to demonstrate the unlawfulness of Regulation 1215/2012 and Regulation 1260/2012. However, the ECJ dismissed both actions on 5 May 2015.<sup>2305</sup>

---

<sup>2294</sup> Council of the European Union 2012 (Conclusions 2012), p. 2.

<sup>2295</sup> Council of the European Union 2012 (Press Release 10-11 December 2012), pp. 2 and 9-10.

<sup>2296</sup> Advocate General 19 April 2012, Joined Cases C-274/11 and C-295/11, Kingdom of Spain (C-274/11), Italian Republic (C-295/11) v Council of the European Union, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0274&rid=1>> (lastly accessed on 1 June 2015).

<sup>2297</sup> European Parliament 2012 (Resolution of 11 December 2012).

<sup>2298</sup> Council of the European Union 2012 (Press Release 17 December 2012), p. 1.

<sup>2299</sup> Article 18(1) Regulation 1257/2012; Article 7(1) Regulation 1260/2012.

<sup>2300</sup> Article 18(2) Regulation 1257/2012; Article 7(2) Regulation 1260/2012.

<sup>2301</sup> Croatia became an EU Member State subsequently. Until now it has not signed the UPC Agreement either.

<sup>2302</sup> Council of the European Union 2013 (Press Release 19 February 2013), p. 1.

<sup>2303</sup> ECJ 16 April 2013, Joined Cases C-274/11 and C-295/11, Kingdom of Spain (C-274/11) and Italian Republic (C-295/11) v Council of the European Union, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0274&rid=1>> (lastly accessed on 1 June 2015).

<sup>2304</sup> Action brought on 22 March 2013, C-146/13, Kingdom of Spain v European Parliament and Council of the European Union, OJ C171 of 15 June 2013, pp. 15-16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62013CN0146&qid=1435728914354&from=EN>> (lastly accessed on 1 June 2015); Action brought on 22 March 2013, C-147/13, Kingdom of Spain v Council of the European Union, OJ C171 of 15 June 2013, p. 16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62013CN0147&qid=1435728914354&from=EN>> (lastly accessed on 1 June 2015).

Already on 6 May 2014, Regulation 542/2014 was adopted. By this Regulation which has been developed from a proposal of the European Commission launched on 26 July 2013, the European legislator intended to adapt the Brussels Ibis Regulation and ensure its coordination with the UPC Agreement.<sup>2306</sup>

### 4.3 European patent with unitary effect

#### 4.3.1 Which are the basic features of such a patent?

The so-called European patent with unitary effect as it is named within Regulation 1257/2012 and Regulation 1260/2012, is being developed as a third option beside national patents and classical European patents as illustrated above. Notably, it will be impossible to have the same patent granted as a unitary patent and a “classical” European patent.<sup>2307</sup> The question of whether simultaneous protection via a unitary patent and a national patent is possible will have to be clarified in national provisions.<sup>2308</sup>

The procedure including the grant of the patent will be the same as for “classical” European patents. In structural respect, the only, but decisive difference between a classical European patent and a European patent with unitary effect (hereinafter unitary patent) is the fact that the unitary patent will ensure uniform protection for an invention in the territory of the 26 EU Member States that have created the unitary patent by way of enhanced cooperation,<sup>2309</sup> as an agreement between all Member States could not be found.<sup>2310</sup> Noteworthy, the protection conferred by a classical European patent as a bundle of national patents – even if national patents for each Member State have been obtained – is not coextensive with the protection by a European patent with unitary effect. For, due to the unitary character of the territory of protection with regard to the unitary patent, acts committed by the same infringer in the EU, even if these acts are distributed over the territory of several Member States, can be aggregated for the infringement analysis.<sup>2311</sup> Moreover, also regarding contributory infringement, the same activity can be found indirectly infringing or not depending on the unitary or fragmented character of the European patent enforced.<sup>2312</sup>

According to Article 9(1)(g) of Regulation 1257/2012, a request for unitary effect by a proprietor of a European patent is to be submitted no later than one month after the mention of the grant is published in the European Patent Bulletin, i.e. the periodical publication provided

---

[content/EN/TXT/PDF/?uri=CELEX:62013CN0147&qid=1435729039478&from=EN](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62013CN0147&qid=1435729039478&from=EN) > (lastly accessed on 1 June 2015).

<sup>2305</sup> ECJ 5 May 2015, C-146/13, Kingdom of Spain v European Parliament and Council of the European Union, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62013CJ0146&rid=6>> (lastly accessed on 1 June 2015); ECJ 5 May 2015, C-147/13, Kingdom of Spain v Council of the European Union, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62013CJ0147&rid=6>> (lastly accessed on 1 June 2015).

<sup>2306</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 871.

<sup>2307</sup> Article 4(2) of Regulation 1257/2012.

<sup>2308</sup> Luginbühl (2013)62(4) GRUR Int. 305, at p. 307.

<sup>2309</sup> On 30 September 2015, Italy has joined the unitary patent and has become the 26th Member State of the enhanced cooperation on unitary patent protection.

<sup>2310</sup> It is to be noted that Member States which do not participate in enhanced cooperation now can join later according to Article 20(1) TEU. This currently concerns Spain and Croatia, while Italy has in the meanwhile become a member of the enhanced cooperation on unitary patent protection, cf. fn. 2309.

<sup>2311</sup> Romandini & Klicznik (2013)44(5) IIC 524, at pp. 534-535.

<sup>2312</sup> Romandini & Klicznik (2013)44(5) IIC 524, at p. 536.

for in Article 129 of the EPC (cf. Article 2(f) of Regulation 1257/2012). Such a request must be submitted together with a full translation of the patent specification into English, if the EPO prosecution was undertaken in German or French. If the patent specification was in English, it must be translated into any other official language of an EU Member State. Despite being exclusively meant for information purposes, these translations shall be published by the EPO.

Pursuant to Article 4(1) of Regulation 1257/2012, the unitary patent will be effective in all participating Member States on the date of publication by the EPO of the mention of the grant of the European patent in that European Patent Bulletin, meaning that the patent will thus take effect retroactively from the mention of the grant.

### **4.3.2 Evaluation of the unitary patent**

Multiple arguments may be put forth for and against the creation of the European patent with unitary effect. In the following paragraphs, I shall consider some major lines of argumentation under discussion, together with a personal evaluation of this subject.

#### **4.3.2.1 Unification of patent protection in the European Union?**

First of all, it may be underlined that the European patent with unitary effect will finally establish uniform patent protection providing an equal standard of protection within the European Union, i.e. within the territory of the participating Member States. So, Article 3(2) of Regulation 1257/2012 provides:

##### **Article 3(2) of Regulation 1257/2012**

A European patent with unitary effect shall have a unitary character. It shall provide uniform protection and shall have equal effect in all the participating Member States.

At a political level, one may clearly appreciate the creation of a European patent with unitary effect as a means to strengthen the European Union and its idea of common rules and the creation of a common economic and social entity by ensuring uniform patent protection in this respect.<sup>2313</sup> Besides the fact that not political, but economic interests, i.e. the interests of industry – which are not necessarily identical with pure political interests – should be considered decisive for the question of whether to create a unitary patent,<sup>2314</sup> the text of Article 3(2) of Regulation 1257/2012 however leads to another major problem of the unitary patent: As not all EU Member States participate in the creation of the unitary patent, this instrument actually adds to territorial fragmentation of patent law in Europe, rather than consolidating it.<sup>2315</sup> While it is true that Member States not participating can join later,<sup>2316</sup> it is a matter of fact that there is fragmentation until they do. At an abstract level, this development means an alarming fragmentation of the Internal Market. Additionally, the lack of patent

---

<sup>2313</sup> Kollé 2006, p. 53.

<sup>2314</sup> Kollé 2006, p. 53; likewise, the interests of industry should be considered decisive with regard to the question of how an adequate European patent judiciary should look like, cf. Jacob 2005, p. 323.

<sup>2315</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 1; Jaeger (2013)44(4) IIC 389, at p. 390; Zawadzka (2014)45(4) IIC 383, at p. 397.

<sup>2316</sup> Article 20(1) TEU.

protection in major European markets such as Spain which (currently) does not participate in enhanced cooperation provokes disadvantages for innovation in these territories.<sup>2317</sup>

The Draft Regulation preceding Regulation 1257/2012 contained detailed provisions as to the infringement of unitary patents. Article 6 of the Draft Regulation contained a definition of direct infringement and Article 7 of the Draft Regulation defined indirect or contributory infringement. Additionally, limitations regarding the effects of the unitary patents were defined in Article 8 of the Draft Regulation. These rules had been constructed similar to legal provisions on infringement in most Member States based on the original Community Patent Convention. Essentially due to the wish of many practitioners who wanted to limit, at all costs, the competence of the ECJ to decide on cases regarding the unitary patent because of the reproach that the ECJ is not a specialist patent court which is feared to provoke lengthy delays into patent litigation trials and decisions of poor quality, Articles 6 to 8 of the Draft Regulation were removed from the final version of Regulation 1257/2012.<sup>2318</sup>

Regulation 1257/2012 thus neither contains unified substantive rules with regard to the prerequisites for patentability, nor regarding the scope of protection, nor concerning the treatment of patents as an object of property.<sup>2319</sup> Rather, Article 5(3) of Regulation 1257/2012 provides, at the level of private international law:

#### **Article 5(3) of Regulation 1257/2012**

The acts against which the patent provides protection (...) and the applicable limitations shall be those defined by the law applied to European patents with unitary effect in the participating Member State whose national law is applicable to the European patent with unitary effect as an object of property in accordance with Article 7.

Article 7 of Regulation 1257/2012 contains rules concerning the national law applicable to a European patent with unitary effect as an object of property, where the major aspect to be considered is that the patent shall be treated in its entirety and in all participating Member States as a national patent of the participating Member State in which the patent has unitary effect, and further prerequisites mainly referring to the residence or principal place of business respectively place of business of the applicant or the location of the headquarters of the European Patent Organisation (Munich), thus ultimately referring to German law as fallback solution. These further prerequisites are arranged in a hierarchy.

National law in this respect is planned to be unified by way of the UPC Agreement. In this respect, Articles 25 to 27 of the UPC Agreement actually contain rules which are similar to Articles 6 of the Draft Regulation. Article 25 of the UPC Agreement provides, as to direct infringement of patents:

#### **Article 25 of the UPC Agreement**

A patent shall confer on its proprietor the right to prevent any third party not having the proprietor's consent from the following:

---

<sup>2317</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 1.

<sup>2318</sup> Tilmann (2013)115(2) GRUR 157, at p. 157.

<sup>2319</sup> Haberl & Schallmoser (2013)5(1) GRUR-Prax 1, at p. 2; in this respect, it has been underlined that, in particular, substantive law as to entitlement is needed, cf. Brandi-Dohrn (2012)43(4) IIC 372, at p. 387.



- (a) making, offering, placing on the market or using a product which is the subject matter of the patent, or importing or storing the product for those purposes;
- (b) using a process which is the subject matter of the patent or, where the third party knows, or should have known, that the use of the process is prohibited without the consent of the patent proprietor, offering the process for use within the territory of the Contracting Member States in which that patent has effect;
- (c) offering, placing on the market, using, or importing or storing for those purposes a product obtained directly by a process which is the subject matter of the patent.”

Correspondingly to Article 7 of the Draft Regulation, Article 26 of the UPC Agreement provides as to indirect infringement of patents:

#### **Article 26 of the UPC Agreement**

- (1) A patent shall confer on its proprietor the right to prevent any third party not having the proprietor's consent from supplying or offering to supply, within the territory of the Contracting Member States in which that patent has effect, any person other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or should have known, that those means are suitable and intended for putting that invention into effect.
- (2) Paragraph 1 shall not apply when the means are staple commercial products, except where the third party induces the person supplied to perform any of the acts prohibited by Article 25.
- (3) Persons performing the acts referred to in Article 27(a) to (e) shall not be considered to be parties entitled to exploit the invention within the meaning of paragraph 1.

Article 27 of the UPC Agreement finally contains a detailed enumeration of specific exemptions from infringement.

In light of the fact that Articles 6 to 8 of the Draft Regulation were replaced by provisions in Articles 25 to 27 of the UPC Agreement, i.e. by different law than EU law, it has been criticised that the unitary patent created by Regulation 1257/2012 actually lacks content and shape based on EU law.<sup>2320</sup> It is also not clear by what means national laws are to be aligned. Although it is to be admitted that substantive patent law in Europe has already been subject to certain harmonisation, there are variations, for instance in relation to experimental use (as referred to in Article 27(b) of the UPC Agreement). Consequently, different patents may grant different protection since national laws vary. Remarkably, Articles 25 to 27 of the UPC Agreement also set out rights which a patent confers on its proprietor, whereby these rights do not refer to national law.

Moreover, while it is true that, on the basis of the set of rules in Articles 5 and 7 of Regulation 1257/2012, merely one national law would be applicable in all participating Member States, different national laws could be applicable to different unitary patents, which might thwart any attempts of unification of patent protection in the European Union.<sup>2321</sup> For instance, this problem becomes evident regarding non-European companies which eventually have plenty of places of business throughout the European Union. Then the question arises whether all their unitary patents should be governed by the same national law or not, and whether these companies shall be given free choice which law they choose.

<sup>2320</sup> Jaeger (2013)24(1) EuZW 15, at p. 16.

<sup>2321</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 2.

Furthermore, it is to be underlined that the unitary patent would merely form an alternative to classical European patents, i.e. patents granted by the EPO (where a further differentiation must be undertaken between such national patents granted within the system of the Uniform Patent Court Agreement and those for which the Uniform Patent Court has no jurisdiction), and national patents granted by national authorities. The envisaged coexistence of all such patent systems seems rather contrary to a unifying approach.<sup>2322</sup>

#### 4.3.2.2 Facilitation of patent protection?

Another aspect which has been underlined by those in favour of a unitary patent is that it will facilitate patent protection for inventors (comprising individuals, companies and institutions), because one single patent application must be filed only with the European Patent Office, there being no need to validate it in each participating State. Besides, high-quality machine translation systems – available online and free of charge – are being developed for all languages of the European Union by the EPO together with Google.<sup>2323</sup> Nowadays, the EPO already provides a machine translation service regarding 13 languages (Danish, Dutch, German, Finnish, French, Greek, Hungarian, Italian, Norwegian, Polish, Portuguese, Spanish and Swedish to English), and has announced to offer that service also with regard to 32 languages in total, including all EU languages and major non-European languages such as Russian, Chinese, Japanese and Korean.<sup>2324</sup> However, it is not sure whether such high-quality translations (which guarantee an appropriate quality of translations of complex professional terminology of patent documents) will be available within the transitional period,<sup>2325</sup> although the EPO and Google have already entered, into their long-term agreement to collaborate on such machine translations of patents, in March 2011. One might however be sceptical regarding the quality of such machine translations, which is a severe obstacle for a proper understanding of the invention and the determination of the scope of the protection resulting from the patent.<sup>2326</sup> Problematically, Article 6(2) of Regulation 1260/2012 provides that the text of such translations shall have no legal effect, but shall serve for information purposes only. In the absence of any legal effect of machine translation, it will not be possible, in patent infringement proceedings, to refer to such translation in order to exclude illegality of the infringement committed.<sup>2327</sup> And, at least in the initial period, machine translations will require “support” by human translators.<sup>2328</sup>

In this respect, one may consider the unitary patent as simpler and less burdensome than current patent protection at the European level, which is determined by complex validation and expensive translation requirements. Besides, with regard to national patents respectively ordinary European patents without unitary effect which constitute in fact a bundle of national patents, it has been put forth that there is the need of parallel or successive patent disputes in

---

<sup>2322</sup> However, the benefit of such a coexistence of several options has also been highlighted, cf. for instance Torremans 2009, p. 206 (while *Torremans* mingles the substantive and the procedural level (highlighted by the author of this thesis) when stating: “What is really needed is a *Community Patent* as a single right than can be subject of a single invalidation and a single infringement proceeding in an efficient way. Even *EPLA* would then become a second best solution. (...) Various options should remain open and the appropriate one can then be chosen by the parties. Cross-border litigation is then the appropriate approach in a number of scenarios.”)

<sup>2323</sup> Luginbühl (2013)62(4) GRUR Int. 305, at p. 308.

<sup>2324</sup> Cf. Zawadzka (2014)45(4) IIC 383, at p. 392. The unburdened access to the latter Asian languages realistically takes into consideration the progressive state-of-the-art of technology being developed in Asia.

<sup>2325</sup> Cf. Zawadzka (2014)45(4) IIC 383, at p. 392.

<sup>2326</sup> Zawadzka (2014)45(4) IIC 383, at p. 392.

<sup>2327</sup> Zawadzka (2014)45(4) IIC 383, at p. 392.

<sup>2328</sup> Zawadzka (2014)45(4) IIC 383, at p. 392.

several States which provokes high costs and the eventual creation of diverging decisions.<sup>2329</sup> While the latter aspects reveal benefits for the patent holder arising from the European patent with unitary effect, it is true that unitary patents will also provide competitors with a higher degree of legal certainty. Alleged infringers will not any longer – as this is the case with regard to ordinary European patents – run the risk of being exposed to multiple damage claims for an economically unitary activity carried out in the EU for the sole reason that the use of the invention was distributed in more than one State.<sup>2330</sup>

However, it remains to be seen whether patent protection via the unitary patent actually effects a simplified patent protection. In contrast to former proposals of an EU patent to be considered as an autonomous instrument, the European patent with unitary effect has a hybrid structure<sup>2331</sup> between international law, EU law, and national law, possibly forming a new *sui generis* right, provoking therefore both doubts on the legal quality of the patent protection afforded, and regarding the cross effects between these different layers of law. As to the establishment of high-quality machine translation systems, it is to be noted that such a service could also be installed as to classical European patents, and therefore does not necessarily argue for the creation of a unitary patent.

Besides, it has even been put forth that for economically developing States, granting a European patent with unitary effect might effect a so-called patent blockade as a result of rapid growth in the number of patent monopolies.<sup>2332</sup>

#### 4.3.2.3 Reduction of costs?

As to the unitary patent as an additional substantive means of patent protection, it has often been underlined that the unitary patent shall lead to a cost reduction regarding patent protection in the European Union. While patent protection in the territory of the 28 EU Member States by means of a “classical” European patent produces costs of about 36.000 € today, costs of a unitary patent are expected to be reduced to an amount of 6.500 € during a transitional period of maximum twelve years,<sup>2333</sup> and finally even reach a mark of about 5.000 €. <sup>2334</sup> The reason for the present high sum of 36.000 € to be calculated for the whole territory of the European Union is mainly based on translation costs<sup>2335</sup> and further validation costs (fees of local patent agents and fees of local patent offices). It has been announced that the unitary patent will produce fewer costs, because, in contrast to the situation regarding classical European patents, no further translations will be necessary beyond those required by the EPO before granting the patent. However, it has been underlined that eventual litigation costs must also be taken into consideration.<sup>2336</sup> During the transitional period, additional translation requirements will produce certain costs, because a request for unitary effect must

---

<sup>2329</sup> Cf. Trüstedt (2010)59(12) GRUR Int. 1039, at p. 1041.

<sup>2330</sup> Romandini & Klicznik (2013)44(5) IIC 524, at p. 536.

<sup>2331</sup> Jaeger compares the European patent with unitary effect with a figure created by Hieronymus Bosch who included bizarre figures composed of parts of other creatures into his pictures, cf. Jaeger (2013)24(1) EuZW 15, at p. 17. With regard to a comparison between the European patent with unitary effect and the EU's systems for trade marks, designs and plant variety protection, Jaeger underlines the “systemic change – or rather, breach? – that it brings about in EU IP law”, cf. Jaeger (2013)44(4) IIC 389, at p. 390.

<sup>2332</sup> Referring to the example of Poland: Zawadzka (2014)45(4) IIC 383, at p. 388.

<sup>2333</sup> It is noteworthy that the transitional period may be terminated earlier if an independent expert committee states that high quality machine translations are available for all official languages of the European Union.

<sup>2334</sup> EU Focus 2013, 304, 1, at p. 2.

<sup>2335</sup> Explicitly underlining the aspect of high translations costs: Artelsmair 2005, p. 20.

<sup>2336</sup> Stjerna (2012)103(2) Mitt. 54, at p. 55.

be submitted together with a full translation of the patent specification into English if the patent was granted in German or French. If the EPO prosecution was in English, a request for unitary effect will have to be translated to another official EU language. After the transitional period, such additional costs are expected to be avoided by the establishment of high-quality machine translation systems.

Small and medium-sized enterprises (SMEs), natural persons, non-profit-organisations, universities and public research organisations which have their residence or principal place of business within the territory of one of the 28 EU Member States have been considered to benefit from the new translation regime being applicable to the unitary patent, because they will get a compensation of all translation costs up to a ceiling in case that the application was filed in one of the official languages of the European Union being not an official language of the EPO (i.e. another language than English, French or German).<sup>2337</sup> However, one might still fear that the costs of translations could constitute an insurmountable barrier with regard to SMEs. Although it is admitted that Article 5 of Regulation 1260/2012 provides for a system of partial reimbursement, available for SMEs, for natural persons, non-profit organizations, higher schools and public research institutes whose place of residence or headquarters or the main place of business is situated in a Member State, neither the sum or reimbursement nor the ceiling has yet been determined.<sup>2338</sup> As a consequence, a serious comparison of costs seems impossible at the moment.

After granting the patent, only a single renewal fee will have to be paid to the EPO each year, eliminating the need for separate maintenance fees to be paid to the national patent offices. This is considered to lead to further cost reduction. The official renewal fee is expected to equal the current renewal costs in five EU Member States but has yet to be determined. Renewal fees shall be progressive throughout the term of the unitary patent protection.<sup>2339</sup>

Besides, it is hoped that protection by means of a unitary patent will indirectly raise the effectiveness of patent protection, because, due to the fact that the national validation of classical European patents currently produces prohibitive costs, many inventors only obtain patent protection in a small number of countries which makes inventions less valuable.

At the international level, it is to be considered that a patent costs about 2000 € in the United States of America and about 600 € in China,<sup>2340</sup> economic areas which form two major competitors of the European Union respectively its Member States.<sup>2341</sup>

In this regard, it must nonetheless be borne in mind that the comparison between the grant of patents for the United States or China, on the one hand, and all the States of the European Union via a unitary patent lacks general justification, because it presumes without further analysis that European inventors long for EU-wide protection of their inventions. However, such a view disregards that, in particular, SMEs might only be active in a small number of Member States, and therefore might only be interested in obtaining patent protection for the territories of these States rather than attaining pan-EU protection – through classical European

---

<sup>2337</sup> Article 5(2) of Regulation 1260/2012. Interestingly, such a reduced fee programme has been offered by the United States and Canada for years. In this light, it seems indeed reasonable and justified to offer such a programme within the European Union as well in order to secure the European market position in global competition.

<sup>2338</sup> Zawadzka (2014)45(4) IIC 383, at p. 391.

<sup>2339</sup> Article 12(1)(a) of Regulation 1257/2012.

<sup>2340</sup> EU Focus 2013, 304, 1, at p. 2.

<sup>2341</sup> These countries provide for the grant of a uniform patent within their respective territories.

patents.<sup>2342</sup> In these circumstances, a unitary patent, even if it might be cheaper than a classical European patent granted for *all* EU Member States, might ultimately turn out to be the more costly alternative where only protection for some States is required,<sup>2343</sup> this being aggravated by the fact that the cheap translation arrangements will enter into force only after a long transitional term.

As another disadvantage of the unitary patent as to the cost issue, it must be emphasised that, in contrast to the situation concerning classical European patents, a unitary patentee will not have the possibility to choose the jurisdictions in which he wants to obtain protection, and, as a consequence, there will be no possibility to reduce the initial costs of the grant of the patent, by selecting a subset. Additionally, it will not be possible to (subsequently) opt out protection for specific participating Member States in order to reduce the amount of renewal fees.<sup>2344</sup>

Admittedly, it is to be pointed out that the unitary patent envisaged at present is constructed as an *alternative* to classical European patents, meaning that the latter will still be available, giving inventors the opportunity to choose which sort of patent they wish to gain. In light of this, one may at least expect that industry will appreciate to have a further option of patent protection, regardless whether respectively to which extent this option will be chosen.<sup>2345</sup>

After all, it has been rightly highlighted that earlier assessments and economic studies were necessarily founded on the expectation of the introduction of a real European Union Patent, i.e. a patent that would be unitary and harmonised for *all* of the European Union. In light of this, it has been stressed – since the European patent with unitary effect will only be valid within the territories of the participating Member States – that there is now “a strong need for new appraisals, which will incorporate the agreed-upon conditions of the unitary patent package, which does not cover all of the EU and falls short of the objectives set out in the beginning.”<sup>2346</sup>

#### 4.3.2.4 Compliance with EU law?

It has already been underlined above that the unitary patent as envisaged by Regulation 1257/2012 and Regulation 1260/2012 has a unique structure based on European law as well as on international and national law. Apart from the aspects of doubtful effectiveness of such an unproved structure, it has been doubted that there is a sufficient legal basis for a unitary patent of that kind.

##### 4.3.2.4.1 Article 118 TFEU versus Article 114 TFEU

Generally, the Treaty on the Functioning of the European Union (TFEU) provides for two possibilities how patent protection within the European Union could be made more effective: Article 114 TFEU provides for a possibility for the approximation (harmonisation) of national laws of the Member States, which have as their object the establishment and the functioning

---

<sup>2342</sup> Kolle 2006, p. 54; Zawadzka (2014)45(4) IIC 383, at p. 390.

<sup>2343</sup> Cf. Zawadzka (2014)45(4) IIC 383, at p. 390. This aspect is not taken into consideration by those who, as a matter of principle, advocate a cheap unitary patent which grants identical protection throughout the whole European Union, cf. Nooteboom 2003, p. 585.

<sup>2344</sup> Pagenberg (2012)114(6) GRUR 582, at p. 583.

<sup>2345</sup> Kolle 2006, p. 54.

<sup>2346</sup> Kupzok (2014)36(7) E.I.P.R. 418, at p. 427.

of the internal market, whereas Article 118 TFEU even provides for the possibility to create European intellectual property rights to provide uniform protection of intellectual property rights throughout the European Union and for the setting up of Union-wide authorisation, coordination and supervision arrangements. The crucial question is: on which of these provisions can respectively should the European patent with unitary effect (or being given a different name) be founded?

#### 4.3.2.4.1.1 Article 114 TFEU

Article 114(1) TFEU provides:

##### Article 114(1) TFEU

Save where otherwise provided in the Treaties, the following provisions shall apply for the achievement of the objectives set out in Article 26. The European Parliament and the Council shall, acting in accordance with the ordinary legislative procedure and after consulting the Economic and Social Committee, adopt the measures for the approximation of the provisions laid down by law, regulation or administrative action in Member States which have as their object the establishment and functioning of the internal market.

Concerning intellectual property law, the European legislator has created a multitude of Directives based on Article 114 TFEU in order to equalise differences between national legal systems.<sup>2347</sup> However, it is to be underlined that such harmonisation can only effect a minimum standard of protection, whereas the major obstacle for a free and unhampered internal market consisting in the territorial limitation of the effects of intellectual property rights such as patents (principle of territoriality)<sup>2348</sup> rather than the difference between the existing legal systems, can only be overcome by a right having equal effect throughout the whole territory of the European Union.<sup>2349</sup> This idea is impressively stated in Recital 2 of the Community trade mark Regulation<sup>2350</sup> which states *inter alia*:

---

<sup>2347</sup> Cf. for instance the following Directives: Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Codified version), OJ L299 of 8 November 2008, pp. 25-33, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32008L0095&from=GA>> (lastly accessed on 1 June 2015); Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions, OJ L213 of 30 July 1998, pp. 13-21, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:31998L0044&from=EN>> (lastly accessed on 1 June 2015); Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, OJ L289 of 28 October 1998, pp. 28-33, available at WWW <[http://eur-lex.europa.eu/resource.html?uri=cellar:399f8f58-0b0e-4252-a0a8-8c8600f55c5e.0008.02/DOC\\_1&format=PDF](http://eur-lex.europa.eu/resource.html?uri=cellar:399f8f58-0b0e-4252-a0a8-8c8600f55c5e.0008.02/DOC_1&format=PDF)> (lastly accessed on 1 June 2015); Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (revised version), OJ L195 of 2 June 2004, pp. 16-25, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32004L0048R%2801%29&from=EN>> (lastly accessed on 1 June 2015).

<sup>2348</sup> This consideration does not apply to copyright law.

<sup>2349</sup> Wichard 2011 (Calliess/Ruffert), Art. 118 AEUV, paras. 6, 8; Stieper 2012 (Grabitz, Hilf & Nettesheim), Art. 118 AEUV, para. 8.

<sup>2350</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1-42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015).

## Recital 2 of the Community trade mark Regulation

It is desirable to promote throughout the Community a harmonious development of economic activities and a continuous and balanced expansion by completing an internal market which functions properly and offers conditions which are similar to those obtaining in a national market. In order to create a market of this kind and make it increasingly a single market, (...) legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community (...). For those purposes, trade marks enabling the products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers, should feature amongst the legal instruments which undertakings have at their disposal.

In light of this, Article 114 TFEU is to be considered an inappropriate legal basis for the creation of a unitary patent, because it is *a priori* insufficient to reach the envisaged goal, i.e. an effective patent protection throughout the territory of the European Union.

### 4.3.2.4.1.2 Article 118 TFEU

On the other hand, the European legislator has created, by the Lisbon Treaty, Article 118 TFEU in order to allocate a legal basis for a real unification of intellectual property rights within the EU framework. Community intellectual property rights being established before had to be based on the general provision of ex-Article 308 EC (which is now Article 352 TFEU).<sup>2351</sup> In fact, the creation of Article 118 TFEU has been evaluated as a declaration of intent to ultimately create a unified patent for the European Union.<sup>2352</sup> Article 118(1) TFEU provides:

#### Article 118(1) TFEU

(1) In the context of the establishment and functioning of the internal market, the European Parliament and the Council, acting in accordance with the ordinary legislative procedure, shall establish measures for the creation of European intellectual property rights to provide uniform protection of intellectual property rights throughout the Union and for the setting up of centralised Union-wide authorisation, coordination and supervision arrangements.

---

<sup>2351</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ L11 of 14 January 1994, pp. 1-36, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:31994R0040&from=EN>> (lastly accessed on 1 June 2015), newly codified by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L78 of 24 March 2009, pp. 1-42, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF>> (lastly accessed on 1 June 2015); Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights, OJ L227 of 1 September 1994, pp. 1-30, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:31994R2100&from=EN>> (lastly accessed on 1 June 2015), amended by Council Regulation (EC) No 15/2008 of 20 December 2007, OJ L8 of 11 January 2008, p. 2, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32008R0015&from=GA>> (lastly accessed on 1 June 2015); Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, OJ L3 of 5 January 2002, pp. 1-24, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:en:PDF>> (lastly accessed on 1 June 2015), amended by Council Regulation (EC) No 1891/2006 of 18 December 2006, OJ L386 of 29 December 2006, pp. 14-16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32006R1891&from=EN>> (lastly accessed on 1 June 2015).

<sup>2352</sup> Stieper 2012 (Grabitz, Hilf & Nettesheim), Art. 118 AEUV, para. 3; Pernice and Hindelang (2010)21(11) EuZW 407, at p. 412.

It has however been discussed controversially<sup>2353</sup> in legal doctrine whether Regulation 1257/2012 meets the requirements of Article 118(1) TFEU. Doubts have been based on several reasons.<sup>2354</sup> First, it has been criticised that the European patent with unitary effect is a hybrid construction consisting of European and international law, because the grant and scope of protection are determined by the EPC which is no European law, and the design of the unitary effect is determined by the UPC Agreement, an international agreement, i.e. no European law either.<sup>2355</sup> European law determines protection conferred by the European patent with unitary effect only to a very limited extent, since such rules which should originally be contained in the Regulation (cf. Articles 6 to 8 of the draft Regulation)<sup>2356</sup> have instead been integrated in the UPC Agreement. Also for this reason, one might doubt that the European patent with unitary effect actually constitutes a uniform European intellectual property right.<sup>2357</sup> In this respect, it has been put forth that “European intellectual property rights” within the meaning of Article 118(1) TFEU must be exclusively determined by EU law including its features such as primacy and uniformity.<sup>2358</sup> On the basis of this conception, a European system of protection would be manageable only by way of a Regulation which rules all essential aspects to be considered.<sup>2359</sup> As to a unitary patent, this would mean that such a Regulation would have to contain rules as to the aspects of patentability, exclusivity and property.<sup>2360</sup> Proponents of this conceptions have put forth that uniform protection meant as inherent to the intellectual property right to be created via Article 118(1) TFEU can only be guaranteed if both the object and the content of the protection and the conditions for that protection are defined by the same authority that creates the right in question.<sup>2361</sup> Besides, it has been criticised that the European patent with unitary effect will not create *uniform* protection within the European Union, because it will only grant protection for the territory of the participating Member States.<sup>2362</sup>

Although the mentioned arguments put forth by those who are of the opinion that Regulation 1257/2012 does not meet the requirements of Article 118(1) TFEU cannot be totally dismissed, it seems that none of these arguments ultimately proves that the construction chosen by the European legislator (combination of Regulation 1257/2012 (supplemented by Regulation 1260/2012) and the UPC Agreement) is irreconcilable with Article 118(1) TFEU. First of all, it must be underlined that the wording of Article 118(1) TFEU does *not* expressly require that European intellectual property rights such as the European patent with unitary effect are solely established by European law.<sup>2363</sup> In this respect, it is remarkable that the European legislator chose the open wording “European” intellectual property rights and did not employ the notion “EU intellectual property rights”.<sup>2364</sup>

<sup>2353</sup> Götting (2014)22(2) ZEuP 231, at p. 365.

<sup>2354</sup> Ohly (2012)4 ZGE/IPJ 419, at p. 431; Lamping (2011)42(8) IIC 879, at pp. 911-913.

<sup>2355</sup> Cf. Ohly (2012)4 ZGE/IPJ 419, at p. 431.

<sup>2356</sup> Götting (2014)22(2) ZEuP 231, at p. 365.

<sup>2357</sup> Cf. Ohly (2012)4 ZGE/IPJ 419, at p. 431.

<sup>2358</sup> De Visscher (2012)61(3) GRUR Int. 214, at p. 220; Wichard 2011 (Calliess/Ruffert), Art. 118 AEUV, para. 9.

<sup>2359</sup> Stieper 2012 (Grabitz, Hilf & Nettesheim), Art. 118 AEUV, para. 24; cf. Jaeger (2013)44(4) IIC 389, at p. 390.

<sup>2360</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 5.

<sup>2361</sup> De Visscher (2012)61(3) GRUR Int. 214, at p. 221; disagreeing and suggesting the contrary: Tilmann (2013)115(2) GRUR 157, at p. 157.

<sup>2362</sup> Cf. Ohly (2012)4 ZGE/IPJ 419, at p. 431.

<sup>2363</sup> Cf. Eck (2014)63(2) GRUR Int. 114, at p. 116.

<sup>2364</sup> Ohly (2012)4 ZGE/IPJ 419, at p. 431; differently: Ullrich 2012, p. 41: “Article 118 para. 1 TFEU, however, expressly grants the authority only to create European Union rights of intellectual property, meaning that their substance must be determined by Union law.”; cf. also: Jaeger (2013)44(4) IIC 389, at p. 390, who also refers to the wording of Article 118(1) TFEU to argue that only such measures to realise the internal market can be based



It therefore seems that Article 118(1) TFEU merely *allows* that the EU act creating an EU intellectual property right implies rules of substantive law with regard to the validity and the scope of protection, but does not necessarily require it.<sup>2365</sup>

With regard to the (limited) territorial scope of the European patent with unitary effect (limitation to the territory of the participating Member States), it has been rightly stressed that, if enhanced cooperation is also possible with regard to the creation of European intellectual property rights, this logically means that such rights are not valid for the whole territory of the European Union. After all, this issue should preferably be resolved in the framework of Article 20 TEU.<sup>2366</sup> Furthermore, it is to be underlined that Article 5 of Regulation 1257/2012 provides that the effects of the European patent with unitary effect are almost completely determined by EU law and the EPC and the UPC Agreement, and that the provisions of the UPC Agreement partly even effect more unification than being established with regard to Community trade marks through the Community trade mark Regulation.<sup>2367</sup> Article 5 of Regulation 1257/2012 constitutes a compromise in that it leaves open the question of the incorporation of the rules of substantive patent law into the EU law, which in practice means to leave open the crucial question of competence conferred to the ECJ in such matters (depending on the interpretation of Article 5 of Regulation 1257/2012).<sup>2368</sup>

#### 4.3.2.4.2 Conclusion

To conclude, it is to be emphasised that Article 118(1) TFEU should be considered as a sufficient legal basis for the construction of the European patent with unitary effect by way of a combination of EU law (Regulation 1257/2012 and Regulation 1260/2012) and international law (EPC and UPC Agreement).

#### 4.4 Unified patent court (UPC)

Having dealt with the unitary patent in the foregoing paragraphs, I shall now proceed to have a look on its procedural counterpart, the envisaged Unified Patent Court (UPC). In this regard, it is to be emphasised that the establishment of the unitary patent and of the UPC are not *necessarily* linked with each other.<sup>2369</sup> So, Italy first merely signed the UPC Agreement, but initially opted out of the enhanced cooperation procedure leading to the adoption of Regulation 1257/2012 and Regulation 1260/2012 which institute the unitary patent. However, others have considered the creation of a unified patent judiciary that has jurisdiction where the unitary patent is affected an essential element of a unified patent system within the European

---

on Article 118 TFEU which create “European intellectual property rights” in the meaning of an autonomous system of protection that provides unified rules for the creation, the scope of protection and limits of the respective right and grant EU-wide protection to the holder of this right. It seems however that the references made by *Jaeger* (Stieper 2012 (Grabitz, Hilf & Nettesheim), Art. 118 AEUV, para. 16; Wichard 2011 (Calliess/Ruffert), Art. 118 AEUV, paras. 9-10; Fischer 2013 (Lenz & Borchardt), Art. 118 AEUV, para. 2) do not necessarily confirm *Jaeger*'s opinion.

<sup>2365</sup> Kraßer 2011, pp. 9-10.

<sup>2366</sup> Ohly (2012)4 ZGE/IPJ 419, at p. 432.

<sup>2367</sup> Ohly (2012)4 ZGE/IPJ 419, at p. 432.

<sup>2368</sup> Götting (2014)22(2) ZEuP 231, at p. 365.

<sup>2369</sup> *Jaeger*, Hilty, Drexler & Ullrich (2009)40(7) IIC 817, at pp. 819, 820, 822. This conception is not undisputed. For instance, the former German Federal Minister of Justice Leutheusser-Schnarrenberger postulated in 2010 that the existence of a (unitary) patent and a (unified) patent judiciary constitute an “inseparable total package” (“*untrennbares Gesamtpaket*”), cited in Trüstedt (2010)59(12) GRUR Int. 1039, at p. 1039; Tilmann (2012)13(1) ERA Forum 87, at p. 100.

Union.<sup>2370</sup> In any event, the substantive benefits effected by the unitary patent may be backed up and reinforced by the establishment of a uniform litigation system, where this mutually reinforcing beneficial effect of the unitary patent and unitary litigation comes about irrespective of whether both are established at the same time or litigation is set up first and only later incorporates the unitary patent when created.<sup>2371</sup>

#### 4.4.1 Which are the basic features of the UPC?

The envisaged UPC will form a centralised court for litigation concerning both classical European patents and European patents with unitary effect. It is to be emphasised that the UPC will have jurisdiction only in respect of designations of European patents for any of the signatories of the UPC Agreement. On the other hand, it will not have jurisdiction regarding designations of the European patent for any of the other EPC contracting States. The UPC will thus be a court common to the participating EU Member States and subject to the same obligations under EU law as any of their national courts. Consequently, the UPC must refer, where necessary, questions on the interpretation of EU law to the ECJ.<sup>2372</sup>

Regarding civil litigation related to infringement and validity issues for both classical European patents and unitary patents, the UPC will be given exclusive jurisdiction. The UPC will also have jurisdiction with regard to a supplementary protection certificate,<sup>2373</sup> i.e. a *sui generis* intellectual property right extending the exclusive right after expiration of the patent upon which it is based (in order to compensate for the loss of effective patent term caused by the delay in obtaining marketing authorisation), regardless if such a right has been issued for a product protected by a classical European patent or a unitary patent. The UPC Agreement does not comprise any substantive provisions concerning laws ancillary to patent protection, such as to confidentiality (for instance with respect to prior disclosures) and licensing. Apparently, these matters will continue to be governed by national Member State laws, which are not closely harmonised.

In structural respect, it is noteworthy that the envisaged structure of the UPC resembles the respective court systems in the United States and Japan with decentralised entry instances and a joint appeal court.<sup>2374</sup> The UPC will have three tiers: it will comprise a Court of First Instance (containing local and regional divisions, and a central division located in Paris<sup>2375</sup>,

---

<sup>2370</sup> Nooteboom 2003, p. 569.

<sup>2371</sup> Jaeger, Hilty, Drexler & Ullrich (2009) 40(7) IIC 817, at p. 822.

<sup>2372</sup> Although numerous stakeholders have sought to ensure that substantive patent validity and infringement laws are not the subject of EU law, in order to avoid having the ECJ decide substantive questions of patentability and infringement, it remains to be seen if the EU will though assume competence over questions of patent infringement. The ECJ will continue to interpret the SPC Regulations and the Biotech Directive. Beyond this, the court will also have to interpret Regulation 1257/2012 and Regulation 1260/2012.

<sup>2373</sup> Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products, OJ L152 of 16 June 2009, pp. 1-10, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:152:0001:0010:en:PDF>> (lastly accessed on 1 June 2015), implies a system for the provision of supplementary protection certificates for medicinal products in the European Union. At present, the system allows for the grant by national patent offices of supplementary protection certificates for national patents and for European patents designated for the respective State. The issue of whether respectively in how far it is problematic that Regulation 1257/2012 does not imply any provisions as to supplementary protection certificates shall not be discussed in this thesis.

<sup>2374</sup> Tilman (2013) 115(2) GRUR 157, at p. 158.

<sup>2375</sup> Paris: cases involving physics, electronics, computer sciences, paper and textiles (IPC classes B, D, E and G and H).

while specialised sections of this central division will be located in Munich<sup>2376</sup> and London<sup>2377</sup>), a Court of Appeal and a Registry located in Luxembourg. All panels of the court are planned to be composed of legally qualified judges, also including technically qualified judges. The personnel will be characterised by a multinational composition. The divisions of the Court of First Instance will be composed of a panel of three judges, while the Court of Appeal will consist of a panel of five judges. Besides, a patent mediation and arbitration centre will have its seat in Lisbon and Ljubljana. Budapest will host a training facility for judges.

Generally, infringement cases regarding classical European patents and European patents with unitary effect shall be initiated before the local division hosted by the Member State where the alleged infringement has occurred or may occur. If there is no such local division in that State, proceedings shall be brought before the regional division in which this Member State participates. In case of (alleged) infringement in more than one participating Member State, the claimant will have a choice of local (or regional) divisions where proceedings may be initiated.

Alternatively, proceedings shall begin at the local division hosted by the Member State where the defendant has his residence or place of business, respectively at the regional division in which this Member State participates.

With regard to (direct) revocation actions, infringement actions if the Member State does not host a local division nor participates in a regional division, actions for declaration of non-infringement and actions concerning administrative decisions of the EPO, proceedings *must* be initiated before the central division.

In some constellations, proceedings may be brought or referred by a local/regional division to the central division. This is possible where the defendant has his residence in a third State, where both parties agree, in cases of counterclaims for revocation of patents where an infringement action has been initiated before the local (or regional) division, or in cases in which a (direct) action for revocation has already been brought before the central division. However, it is to be noticed that in these cases, the court initially invoked shall have discretion to hear both the infringement and revocation together (according to legal system in many EU Member States) or to refer the revocation counterclaim to the central division and suspend or proceed with the infringement proceedings (with accordance to the legal situation in Germany).

It is noteworthy that actions regarding classical European patents can still be initiated before the national courts during a transitional period of seven years, if those patents have been opted out before an action has been brought before the UPC. The Administrative Committee, a decision-making body within the court system formed by one representative per participating Member State, may prolong this transitional period for another seven years. Persons filing applications for European patents within the transitional period may decide to opt these patents out of the exclusive jurisdiction of the UPC. That means that the UPC will have non-exclusive competence over classical European patents within the transitional period which will become exclusive competence as soon as the transitional period has expired (if no opt-out has been declared). It is to be noticed that once an action has been brought in the UPC in relation to a given patent, the opt-out is no longer available. Conversely, if an opt-out has

---

<sup>2376</sup> Munich: cases involving mechanical engineering (IPC section F).

<sup>2377</sup> London: cases involving chemistry, pharmaceuticals, metallurgy and human necessities (IPC sections A and C).

been declared and proceedings have been initiated in a national court, it will not any longer be possible to revoke the opt-out.

At present, detailed Rules of Procedure of the Unified Patent Court (hereinafter Rules of Procedure respectively Draft Rules of Procedure) are being elaborated.<sup>2378</sup> They will have to be adopted by the Court's Administrative Committee, made up of one member for each participating Member State. Ultimately, they will be the subject of a public consultation, the commencement of which is yet to be announced.

#### **4.4.2 Evaluation of the UPC**

##### **4.4.2.1 Creation of legal certainty?**

In the first instance, advocates of the UPC have put forth that the creation of such a unified and specialised jurisdiction in patent matters will, at least concerning the participating Member States, provide a single forum for patent litigation. As a consequence, the risk of an unnecessary duplication or even multiplication of parallel proceedings before the various courts of the Member States is hoped to be avoided. This shall strengthen legal certainty, as the risk of inconsistent (i.e. conflicting) outcomes of parallel proceedings will be prevented and consistency of interpretation will be secured.<sup>2379</sup>

However, also in procedural respect, it is to be stated that not all Member States participate in the UPC Agreement, which ultimately leads to fragmentation of jurisprudence between participating and non-participating Member States.<sup>2380</sup> A decision of the UPC could merely have, if any, influencing (but not binding) effect on national courts of EPC Contracting States that do not participate in the UPC Agreement. And even concerning the group of participating Member States, it is to be noticed that several authorities would have jurisdiction according to the matter concerned.<sup>2381</sup> So, five constellations can be identified. National courts or administrative bodies would be competent in proceedings regarding nationally granted patents. The EPO's Board of Appeal would have jurisdiction concerning administrative appeals for European patents. National courts of EU Member States not ratifying the UPC Agreement or not participating in enhanced cooperation as well as those of all non-EU EPO Contracting States would be competent for cases on infringement and validity of national and classical European patents. Finally, as to cases concerning infringement and validity of classical European and unitary patents, the UPC would have jurisdiction for those Member States which have ratified the UPC Agreement. Besides these rules of competence, the ECJ as highest instance interpreting the law of the European Union, would have jurisdiction in respect of preliminary references from the UPC as to infringement of unitary patents.<sup>2382</sup>

---

<sup>2378</sup> The Rules of Procedure will structurally form a hybrid of common law and civil law elements, meaning detailed paper-based arguments and witness evidence, court-appointed experts, technical judges and no automatic right to cross-examination. As to a summarising overview, cf. Grabinski (2013)62(4) GRUR Int. 310, at pp. 310-321; at present, the 17<sup>th</sup> draft of Rules of Procedure is the most recent version of this set of rules. Cf. the 17<sup>th</sup> draft of Rules of Procedure of the Unified Patent Court from 31 October 2014, available at WWW <[http://www.unified-patent-court.org/images/documents/UPC\\_Rules\\_of\\_Procedure\\_17th\\_Draft.pdf](http://www.unified-patent-court.org/images/documents/UPC_Rules_of_Procedure_17th_Draft.pdf)> (lastly accessed on 1 June 2015).

<sup>2379</sup> Brandi-Dohrn (2012)43(4) IIC 372, at p. 388; Kazi (2011)33(8) E.I.P.R. 538, at p. 539; Rodriguez (2012)34(6) E.I.P.R. 402, at p. 408.

<sup>2380</sup> Cf. Jaeger (2013)44(4) IIC 389, at p. 390.

<sup>2381</sup> Cf. also Ullrich (2015)46(1) IIC 1, at pp. 2-3.

<sup>2382</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 2 et seq.

Problematically, the consequence of this split jurisdiction is a separate jurisdiction applicable to related patents, which might be considered as a severe obstacle towards a unification in European patent litigation which, as a consequence, might create legal *uncertainty*.<sup>2383</sup> To illustrate this situation one may think of the constellation of three identically worded patents (Patent A, Patent B and Patent C), Patent A being granted as a unitary patent, Patent B being granted as a European patent designating Italy, and Patent C being granted as a national patent in Spain. So which courts would then be ultimately competent to deal with infringement actions with regard to these patents? With regard to Patent A, the ECJ would have ultimate jurisdiction. Concerning Patent B, the Appeal Division of the UPC would ultimately be competent. And as to Patent C, the Spanish Supreme Court would be the last court instance to decide on the infringement of the Spanish national patent.

As it does not seem probable that all national courts will align their jurisprudence on that of the UPC, but will rather find themselves in competition both with the UPC and among themselves, problems arising from such judicial competition will have to be faced. These might not only concern the efficiency of case management or the technical quality of decision-making, but also create divergences with regard to the interpretation, respectively the application of substantive law.<sup>2384</sup>

Besides, it has been criticised that the rules of choice of jurisdiction have become considerably complex<sup>2385</sup> and complicated which effects intransparency.<sup>2386</sup> It has been warned against the fact that the UPC Agreement does not contain any method how to consolidate different layers of substantive rules which might be developed in the five enumerated branches, and simply adds another enforcement layer.<sup>2387</sup> This might further establish legal uncertainty.<sup>2388</sup>

Also, the relationship between the UPC Agreement which confers exclusive jurisdiction to the UPC, and contractual jurisdiction provisions which allocate exclusive jurisdiction to national courts or arbitral panels, might turn out problematic. Although the UPC Agreement would principally prevail concerning matters for which the UPC is granted exclusive jurisdiction, the question remains to be answered how to deal with constellations where the UPC Agreement expressly confers exclusive jurisdiction to the UPC for part of the proceedings, while there are other parts which are not affected by the UPC Agreement. Shall the UPC be granted a sort of annex competence for these further matters? The UPC Agreement does not answer this issue and thus does not provide for legal certainty. In this context, it has also been criticised that, due to the strict limitation of the UPC's competence to litigation on infringement and revocation of patents (including only counterclaims concerning license defences, cf. Article 32(1)(a)-(h) of the UPC Agreement) combined with the technical orientation of the composition of the UPC, leave this court ill equipped for deciding on other matters such as contract law and property law which may arise as incidental points. The same goes for the treatment of broader contextual questions which have become more relevant for patent protection, such as issues of competition law, European and international trade law, human rights law and rules of market regulation.<sup>2389</sup>

<sup>2383</sup> Cf. Jaeger (2013)44(4) IIC 389, at p. 390.

<sup>2384</sup> Ullrich (2015)46(1) IIC 1, at p. 3.

<sup>2385</sup> Jaeger (2013)44(4) IIC 389, at p. 390.

<sup>2386</sup> Pagenberg (2012)114(6) GRUR 582, at p. 583.

<sup>2387</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 3.

<sup>2388</sup> Jaeger (2013)44(4) IIC 389, at p. 390.

<sup>2389</sup> Ullrich (2015)46(1) IIC 1, at p. 3.

However, legal certainty might be strengthened by the role of the ECJ. As has already been mentioned, the UPC would be obliged to refer questions to the ECJ on the interpretation of Regulation 1257/2012 and Regulation 1260/2012. Decisions of the ECJ in this respect would have binding effect for the UPC. In this respect, it is noteworthy that Article 5 of Regulation 1257/2012 (indirectly) refers to Article 25 of the UPC Agreement. While parts of legal doctrine have argued that the ECJ is only competent to give a preliminary ruling on the interpretation of Article 5 of Regulation 1257/2012 as such and not regarding Article 25 of the UPC Agreement, because Article 25 of the UPC Agreement is no European law,<sup>2390</sup> it is to be emphasised that Article 25 of the UPC Agreement in fact reproduces the content of Article 28(1) of the TRIPS Agreement, providing:

#### Article 28(1) of the TRIPS Agreement

(1) A patent shall confer on its owner the following exclusive rights:

- (a) where the subject matter of a patent is a product, to prevent third parties not having the owner's consent from the acts of: making, using, offering for sale, selling, or importing for these purposes that product;
- (b) where the subject matter of a patent is a process, to prevent third parties not having the owner's consent from the act of using the process, and from the acts of: using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.

Noteworthy, the ECJ made clear in its *Merck* decision that the TRIPS Agreement forms an integral part of the EU legal order.<sup>2391</sup> In light of this, one might argue that, as the EU adopted Regulation 1257/2012, this legislation should be regarded as sufficient to lead to the conclusion that the sphere of patents falls within the scope of EU law.<sup>2392</sup> In view of the creation of legal certainty, it has been suggested that the UPC will ask the ECJ which construction of the rules regulating direct infringement applicable to the European patent with unitary effect is consistent with Article 28(1) of the TRIPS Agreement and which is not.<sup>2393</sup> It has been rightly highlighted that, on the basis of the acquired jurisdiction over the TRIPS patent provision, the ECJ will have a position to prevent further fragmentation of the rules applicable to European and national patents and the case-law related to them, the national courts then having the possibility to refer question to the ECJ when applying domestic rules on national patents corresponding to the TRIPS provisions.<sup>2394</sup> With regard to the mentioned criticism that the European patent with unitary effect and the UPC have not managed to provide methods to ensure a consistent construction of patent law in the European Union, the

<sup>2390</sup> Haedicke (2013)62(7) GRUR Int. 609, at p. 616; critically with regard to this opinion: Grünberger & Podszun (2015)12(2) GPR 79, at p. 80.

<sup>2391</sup> Romandini & Klicznik (2013)44(5) IIC 524, at p. 537.

<sup>2392</sup> Romandini & Klicznik (2013)44(5) IIC 524, at pp. 537-538; differently: Jaeger (2013)44(4) IIC 389, at pp. 390-391: *Jaeger* seems to assume that the ECJ has no such jurisdiction. This becomes clear when *Jaeger* states that the reason for constructing the European patent with unitary effect in such a way that the existence and validity of a European patent with unitary effect depend on the EPO decision (i.e. a non-EU law act) to grant the patent bundle, and that substantive provisions as to patent protection are contained in the UPC Agreement, an international Treaty (i.e. a non-EU law act as well), and are not included in Regulation 1257/2012, is that the ECJ's jurisdiction in interpreting patent law should be avoided. Also assuming this intent of the European legislator: Grünberger & Podszun (2015)12(2) GPR 79, at p. 79; Götting (2014)22(2) ZEuP 231, at p. 365; Haedicke (2013)62(7) GRUR Int. 609, at p. 610 and p. 614; Stjerna (2012)103(2) Mitt. 54, at p. 56; Eck (2014)63(2) GRUR Int. 114, at p. 116.

<sup>2393</sup> Romandini & Klicznik (2013)44(5) IIC 524, at p. 538.

<sup>2394</sup> Romandini & Klicznik (2013)44(5) IIC 524, at p. 538.

jurisdiction of the ECJ over TRIPS patent provisions, acquired through the adoption of Regulation 1257/2012, may mitigate this deficiency.<sup>2395</sup>

#### 4.4.2.2 Effectiveness of the UPC?

First of all, the effectiveness of the UPC might be impaired by the existence of the transitional period addressed above, during which a holder of a European patent (but not a unitary patent) may at any time opt out of the exclusive competence of the UPC, then having the possibility to opt back into the exclusive competence of the UPC at any time, even after the expiration of the transitional period, apparently without penalty. This situation could provoke “regime shopping” during the transitional period, deciding whether to go with the new system or opt out initially and continue to use national courts for European patents.

Concerning the UPC as such, as pointed out above, local divisions of the UPC can be established in each participating Member State regardless of the number of patent proceedings negotiated in these States. In this respect, it has been warned against the risk that the quality and effectiveness of the UPC could suffer from the existence of inexperienced courts, industry eventually being reluctant to consign its patents (in particular the most valuable ones) to a judicial system that has not been tested and therefore appears unpredictable.<sup>2396</sup> This problem could however be avoided if the number of courts were to be restricted to a certain number, having the consequence that these courts would then be able to gather considerable expertise in the field of patent law.<sup>2397</sup> In this respect, it is remarkable that some States indeed deliberately provide only for a limited number of courts (respectively only one court) for patent disputes in order to benefit from the courts' experience and knowledge.<sup>2398</sup> Besides, the number of patent cases within the European Union varies a lot among the Member States, most patent cases being negotiated in Germany, France, the UK and the Netherlands.<sup>2399</sup> It is therefore doubtful whether it will be possible to actually guarantee a high quality of the personnel of the UPC which shall be built up on a broad geographical basis. In practice, it will be necessary to have judges be educated by existing experienced infringement judges where the problem will have to be faced that such education will be necessary performed primarily in a foreign language.

Moreover, the importance of local/regional divisions has more and more been reduced in favour of the central division which means a change from the principle of a decentralised jurisdiction being determined by local/regional divisions, easily accessible for users and negotiating in local procedural language. As a consequence, the relationship between the divisions of jurisdiction among the first instance of the UPC as being envisaged at present is to be characterised as imbalanced.<sup>2400</sup> If the defendant is domiciled outside the territory of a participating Member State, the action can be initiated before the central division, where the applicable language is not the local language of proceedings, but the language of the patent. In the case of a defendant domiciled within a participating EU Member State and an (alleged) infringement in the territory of more than three local divisions, the defendant may demand that the total proceeding is referred to the central division, effecting that the local division is deprived of jurisdiction and the procedural language changes as well. Even if proceedings are

---

<sup>2395</sup> Romandini & Klicznik (2013)44(5) IIC 524, at p. 538.

<sup>2396</sup> Franzosi (2004)35(4) IIC 416, at p. 419.

<sup>2397</sup> Pagenberg (2012)114(6) GRUR 582, at p. 585.

<sup>2398</sup> Stauder 2006, p. 351.

<sup>2399</sup> Feldges 2007, pp. 113, 115 and there fn. 24.

<sup>2400</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 4.

negotiated before the local division initially invoked, the language chosen by the claimant shall be changed into the language of the patent on demand of the defendant for reasons of fairness.<sup>2401</sup> It has been put forth that these rules effect a considerable discrimination of claimants, in particular SMEs which are eventually deprived of their local jurisdiction and forced to negotiate before a foreign central division including translation requirements, eventually after having already litigated before another court. In this respect, it is actually to question why the defendant should benefit from such an extended protection on expense of the claimant, given that an effective defence does not require that it is performed in the defendant's language, translations being available already at present.<sup>2402</sup>

Due to the complicated system of different branches of competences of the divisions of the UPC illustrated above, the constellation is conceivable that a local (or regional) division deals with the alleged infringement of a unitary patent and the central division hears revocation (cf. Article 32 of the UPC Agreement). This bifurcation may lead to numerous problems and obstacles. First, it is conceivable that proceedings before those divisions are led in different languages which would pose additional translation requirements. Besides, it has also rightly been put forward that such a bifurcated approach could provoke continued forum shopping.<sup>2403</sup> In light of the multitude of local and regional divisions to be expected, which will contain panels of judges drawn from different legal traditions, it is important to note that forum shopping might indeed become an important issue. It is probable that there will be scope for local variations in procedure and application of the law, depending on the national practice to which those judges are accustomed. Some divisions might be more inclined to use their discretion to split off invalidity counterclaims from infringement, and procedural speed might vary between the divisions. Other aspects which might become crucial in this respect are the relative ease of obtaining a preliminary injunction (and any order to seise stock from the defendant to preserve it until trial) or an order to preserve evidence of infringement. Furthermore, the claimant might be given the undue advantage to benefit from an injunction, although the patent might subsequently turn out to be invalid. With regard to bifurcation, it has been put forth that bifurcated cases seem to be plagued by invalid patents, and that the bifurcated system might allow owners of such patents to extract rents from industry without the prospect of having their own patent revoked.<sup>2404</sup>

Further, it has been put forth that there is the risk that the existence of the system of the European patent with unitary effect and the UPC might result in increased activities of "patent trolls".<sup>2405</sup> These entities purchase and hide a patent until it appears economically indispensable. Then the patent holder either asks high licensing fees or files for injunctions.<sup>2406</sup> As the costs of fighting a potential infringement may often be higher than the costs of paying the licensing fee, many companies will prefer to take a license as the cheaper alternative. Where the proprietor holds a predominant position on a certain market, such

---

<sup>2401</sup> Pagenberg (2012)114(6) GRUR 582, at p. 584.

<sup>2402</sup> Pagenberg (2012)114(6) GRUR 582, at p. 584.

<sup>2403</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 4.

<sup>2404</sup> Rodriguez (2012)34(6) E.I.P.R. 402, at p. 404. The underlying problem is that the patentee may argue for a narrow interpretation of his claim when defending it but an expansive interpretation when asserting infringement, cf. Kitchin J. in: High Court of Justice (Chancery Division – Patents Court) 26 March 2007, *European Central Bank v Document Security Systems Incorporated*, [2007] EWHC 600 (Pat), para. 88 – *European Central Bank*, referred to in: Kazi (2011)33(8) E.I.P.R. 538, at p. 541.

<sup>2405</sup> Although the problem of "patent trolls" so far is mostly discussed in the United States, such practice appears to be a universal phenomenon, and some EU Member States are actually witnessing increasing "patent troll" activities in their territories, cf. Malaga (2014)45(6) IIC 621, at p. 643.

<sup>2406</sup> Malaga (2014)45(6) IIC 621, at p. 641.



behaviour may be considered abusive.<sup>2407</sup> A “patent troll” might be even more encouraged to abuse the patent in case of a European patent with unitary effect in combination with the UPC, because it will be possible in this system to influence, with a single injunction, competitors in all participating Member States.<sup>2408</sup> Admittedly, this situation is however a double-edged sword in that the patent holder will be more exposed to invalidity actions as well, because the other market actors will be strongly tempted to challenge the competitor's patent with a single hit.<sup>2409</sup>

#### 4.4.2.3 Reduction of costs?

First of all, it is to be taken into consideration that the UPC could make it easier, in comparison with the current EPO system, for patent holders to pursue infringers even in small countries where litigation would have been overly expensive in proportion with the achieved result. Further, it may at present not always be financially viable to file multiple patent infringement claims in multiple countries, because the bundle of national patents resulting from a European patent – even in cases of EU-wide infringement – can be enforced only on a strictly national basis, which effects high litigation costs. As a consequence, infringers may eventually never be forced to pay for the intellectual property they misappropriated. In contrast, it is more affordable to sue that same infringer in the UPC for infringement in several countries.

As parties may be represented, before the UPC, either by authorised lawyers or by European Patent Attorneys who dispose of an appropriate litigation certificate, patent holders will have the possibility to work with the same attorney both before the EPO and the UPC. As a consequence, cost associated with litigation may possibly be reduced.<sup>2410</sup>

Nonetheless, it is noteworthy that, despite the widespread hope that the creation of the UPC shall contribute to a further reduction of costs, the court fees have not been determined yet.<sup>2411</sup> An Administrative Committee is considered to do so once the UPC has been set up. Due to these circumstances, a serious evaluation of these costs and their comparison with procedural costs currently produced is simply not manageable at this moment. Whereas it is planned to establish the UPC as a self-financing court with balanced finances, specific tools being envisaged to guarantee proper access to the court (which should be important for SMEs), and to eventually grant legal aid to natural persons in the case of need, there are several aspects to be considered which entail the risk that the establishment of the UPC as envisaged by the UPC Agreement might actually lead to *higher* costs.

On the one hand, establishing a multitude of local divisions before which both infringement and invalidity of a patent may be negotiated, and, on the other hand, strengthening the central division of the Court of First Instance which shall also have jurisdiction to decide on the infringement and invalidity of patents according to the UPC Agreement, it has been

---

<sup>2407</sup> Malaga (2014)45(6) IIC 621, at p. 641. Additionally, it has been suggested that such abusive behaviour is also supported by the fact that, as a consequence of abandoning the patent translations, it will be much easier for a potential “patent troll” to “hide” the patent against a major group of competitors. Moreover, the fact that the translation of claims has no official status, may establish an incentive to abuse a proprietor's dominant position through an abuse of a process, by either submitting an inaccurate version or delaying the submission, cf. Malaga (2014)45(6) IIC 621, at p. 642.

<sup>2408</sup> Malaga (2014)45(6) IIC 621, at p. 642.

<sup>2409</sup> Malaga (2014)45(6) IIC 621, at p. 642.

<sup>2410</sup> Kazi (2011)33(8) E.I.P.R. 538, at p. 539; Rodriguez (2012)34(6) E.I.P.R. 402, at p. 408.

<sup>2411</sup> Ullrich (2015)46(1) IIC 1, at p. 3.

underlined that this would bring along a prolongation of proceedings and therefore an increase of procedural costs in comparison with a system where infringement and invalidity issues cannot be negotiated before the same court (as it is the case in Germany).<sup>2412</sup>

Concerning the enforcement of a unitary patent, a counterclaim initiated against a unitary patent would bring along the (costly) risk of voiding the patent with effect for all 26 Member States.<sup>2413</sup> In this respect, potential advantages produced by the unitary patent would finally be compensated by a considerably increased risk of losing patent protection for the whole territory of the participating EU Member States in the course of single-action revocations (rather than requiring separate revocations in each European State, as it is presently the case). In light of this, organisations/entities with high value patents, in particular pharmaceutical companies, could therefore (at least initially) shy away from the system as it presents a significant risk, avoid unitary patents in favour of national patents and opt their European patents out of the UPC system until they are convinced of the quality of this system. Some of these patentees may decide to withdraw their opt-out at a later moment. Industries which rely on several rights beside patents (such as trade marks and designs) might benefit from the new system as attractive with relatively little risk. For instance, this might be true for household consumer products or the automotive industry.

It may be expected that the extent of the required personnel and infrastructure of the UPC – qualified judges for the UPC will have to be found and trained, and a completely new court system will have to be established including a working administrative body – would be greater than for the present system(s), and therefore more expensive. In this respect, it is also conceivable that the use of the court once litigation has started produces further costs. Due to the fact that there are less courts available than under the current system, additional travel costs of parties which have to travel to distant courts might to be added. Moreover, translation services necessary during litigation might produce further costs. As the European Union has already announced not to finance the UPC, the court will have to be self-funding. This can be realised by the creation of funds from patent issue fees and from the cost of issuing proceedings. Additionally, Member States will probably contribute to the start-up costs of the UPC.<sup>2414</sup> However, it is unclear to which extent such financing will be realised, and according to which proportion Member States will undertake payments.

Again, as explicated earlier in conjunction with the unitary patent, it is to be pointed out that such an increase of costs may be justified in the case of the actual need for patent protection for the territory of all participating Member States. In contrast, particularly SMEs which realistically do not require patent protection for that complete territory, expectably will not benefit but rather suffer from this development.

---

<sup>2412</sup> Pagenberg (2012)114(6) GRUR 582, at p. 584.

<sup>2413</sup> Pagenberg (2012)114(6) GRUR 582, at p. 583; from the perspective of companies doing business in Europa, eventually infringing patents, pan-European injunctions constitute a serious danger which is even intensified if there is stock which could be seised (at a preliminary injunction stage until trial) or stock which could be destroyed (if held to infringe at trial). Some businesses may think of moving their manufacturing or distribution centres to countries not covered by the UPC in order to keep their stock out of reach of patentees.

<sup>2414</sup> Rodriguez (2012)34(6) E.I.P.R. 402, at p. 408.

#### 4.4.2.4 Compliance with EU law?

##### 4.4.2.4.1 Compliance with primary EU law

It is noteworthy that the UPC Agreement, in contrast to previous proposals, tends to place the position of the UPC *within* the legal system of the European Union. Rather than creating a separate court outside the EU system, various States among EU Member States will establish the court by an agreement.<sup>2415</sup> Neither the EU itself nor countries outside the European Union will be signatories. The UPC shall be subject to the same obligations under EU law as any national court of the Contracting Member States<sup>2416</sup> and shall apply EU law in its entirety, respecting its primacy.<sup>2417</sup> Additionally, the UPC Agreement specifies that the UPC, as a court common to the Contracting Member States and as part of their judicial system, shall cooperate with the ECJ to ensure the proper application and uniform interpretation of EU law in the same way as the national courts of EU Member States. In particular, the UPC shall request preliminary rulings from the ECJ on the interpretation of the Treaties or the validity and interpretation of acts of the institutions, bodies, offices, or agencies of the EU in accordance with Article 267 TFEU, in the same manner as national courts.<sup>2418</sup> The UPC Agreement also explicitly stipulates that the Contracting Member States are jointly and severally liable for damage resulting from an infringement of EU law by the Court of Appeal, in accordance with EU law concerning non-contractual liability of Member States for damage caused by their national courts breaching EU law.<sup>2419</sup> These provisions reveal clearly the European legislator's intent to meet the concerns of the ECJ expressed in its Opinion 1/09.

##### 4.4.2.4.2 Compliance with the Brussels Ibis Regulation

Another issue is to ensure that the UPC Agreement is fully compliant with the Brussels Ibis Regulation.<sup>2420</sup> In this respect, it is noteworthy that Article 89(1) of the UPC Agreement explicitly refers to amendments to the Brussels Ibis Regulation concerning the relationship between the Regulation and the UPC Agreement as a precondition for the entry into force of the UPC Agreement:

###### Article 89 of the UPC Agreement

(1) This Agreement shall enter into force on 1 January 2014 or on the first day of the fourth month after the deposit of the thirteenth instrument of ratification or accession in accordance with Article 84, including the three Member States in which the highest number of European patents had effect in the year preceding the year in which the signature of the Agreement takes place or on the first day of the fourth month after the date of entry into force of the amendments to Regulation (EU) No. 1215/2012 concerning its relationship with this Agreement, whichever is the latest.

---

<sup>2415</sup> Given the clear wording of Article 118 TFEU, which makes no reference to the creation of a common court system, it has been argued that it is probably not possible to create such a common court by means of EU legislation, cf. in detail: Peers (2011)7(2) E.C.L. Review 229, at p. 262.

<sup>2416</sup> Article 1(2) of the UPC Agreement.

<sup>2417</sup> Article 20 of the UPC Agreement.

<sup>2418</sup> Article 21 of the UPC Agreement.

<sup>2419</sup> Article 22(1) of the UPC Agreement.

<sup>2420</sup> With regard to the parallel issue of the coordination between the UPC Agreement and the 2007 Lugano Convention cf. De Miguel Asensio (2014)45(8) IIC 868, at pp. 873-874.

In order to ensure compliance between the UPC Agreement and the Brussels Ibis Regulation, and in order to address the particular issue of jurisdiction rules vis-à-vis defendants in non-European Union States, the Commission issued a proposal for a regulation amending the Brussels Ibis Regulation (hereinafter Commission Proposal 2013)<sup>2421</sup>.<sup>2422</sup> Since, as has been rightly suggested in the Commission Proposal 2013, the Protocol modifying the 1965 Treaty of the Benelux Court of Justice raises identical issues as the UPC Agreement,<sup>2423</sup> a further objective of the Commission Proposal 2013 was to ensure compliance between the modified Treaty of 31 March 1965 concerning the establishment and statute of a Benelux Court of Justice (hereinafter BC)<sup>2424</sup> and the Brussels Ibis Regulation,<sup>2425</sup> and also to address the lack of common jurisdiction rules vis-à-vis defendants in non-European Union States.<sup>2426</sup> In the Commission Proposal 2013, the following issues in the Brussels Ibis Regulation were addressed in order to guarantee the combined and coherent application of the UPC Agreement.<sup>2427</sup>

According to the Explanatory Memorandum of the Commission Proposal 2013, the Commission stresses the need to clarify in the text of the Brussels Ibis Regulation that the UPC constitutes a “court” within the meaning of the Brussels Ibis Regulation. Second, the need is pointed out in the Explanatory Memorandum of the Commission Proposal 2013 to clarify the operation of the jurisdiction rules applicable in relation to the UPC concerning Member State defendants. Third, the Commission expresses its will in the Explanatory Memorandum to establish uniform rules for the international jurisdiction vis-à-vis third State defendants in proceedings against such defendants brought in the UPC where national law is applicable because the Brussels Ibis Regulation does not itself provide for such rules. Fourth, the Explanatory Memorandum of the Commission Proposal 2013 underlines that the operation of the rules on *lis pendens* and related actions in relation to the UPC on the one hand and the national courts of Member States which are not Contracting Party to the respective international agreements on the other hand must be determined. Additionally, it is stressed in the Explanatory Memorandum that the operation of these rules during the transitional period referred to in Article 83(1) of the UPC Agreement must be defined. Fifth, the Commission proposed to clarify the operation of the rules on recognition and enforcement in the relations between Member States which are and those which are not Contracting Parties to the respective international agreements. According to the Commission, the envisaged amendments should be combined in four new provisions: Articles 71a to 71d of the Brussels Ibis Regulation.

<sup>2421</sup> European Commission 2013 (Commission Proposal 2013).

<sup>2422</sup> European Commission 2013 (Commission Proposal 2013), p. 2.

<sup>2423</sup> European Commission 2013 (Commission Proposal 2013), p. 4.

<sup>2424</sup> The Benelux Court of Justice constitutes a court common to Belgium, Luxembourg, and the Netherlands.

The court was set up to ensure the uniform application of rules common to the Benelux Member States concerning various matters such as intellectual property (particularly certain types of rights relating to trademarks, models and designs). Up to today, the Benelux Court of Justice mainly gives preliminary rulings on the interpretation of these rules. On 15 October 2012, Belgium, Luxembourg, and the Netherlands have signed a Protocol which modifies the Treaty of 31 March 1965 in that the possibility has been created to extend the competences of the Benelux Court of Justice to include jurisdictional competences in specific matters which come within the scope of the Brussels I Regulation. This possibility may be executed by a revision of the separate agreements between the Benelux Member States on specific matters. This revision will effectively transfer jurisdiction from the national courts to the Benelux Court of Justice which forms the basis for the need of an amendment of the Brussels Ibis Regulation in its relationship with the revised Treaty (cf. European Commission 2013 (Commission Proposal 2013), pp. 2-3).

<sup>2425</sup> Due to the subject of this thesis, I will focus on the UPC and leave aside the BC in the following analysis, although it should be underlined that the Commission Proposal 2013 and Regulation No. 542/2014 concern both courts.

<sup>2426</sup> European Commission 2013 (Commission Proposal 2013), p. 3.

<sup>2427</sup> European Commission 2013 (Commission Proposal 2013), p. 3.

By way of Regulation 542/2014<sup>2428</sup>, the European legislator followed the Commission Proposal 2013 and added the new provisions of Articles 71a to 71d to the set of rules of the Brussels Ibis Regulation, but undertook several changes compared with the proposed wording of these articles according to the Commission Proposal 2013. In the following paragraphs, Articles 71a to 71d of the Brussels Ibis Regulation pursuant to the Commission Proposal 2013 shall be discussed and compared with the corresponding Articles according to Regulation 542/2014. The decisive question to be answered is whether respectively to which extent the said provisions accomplish to bring in line the UPC Agreement with the rules of the Brussels Ibis Regulation without any structural breaks. For a better readability and understanding, and in order to illustrate existing differences between the Commission Proposal 2013 and Regulation 542/2014, the relevant provisions shall be presented by way of a synopsis.

#### **4.4.2.4.2.1 Treatment of the UPC as a court of a Member State**

Originally, the UPC was constructed as a court outside the EU structure. This provoked fierce criticism, because the UPC – while being outside the EU structure – would interpret and apply EU law. The ECJ addressed this constellation as a violation of the principles of the EU system of judicial review. Although being based on the example of the BC (the latter being specifically recognised by the Treaties), there are considerable structural differences between the BC and the UPC: The jurisdiction of the UPC is not limited to preliminary references – in contrast to the jurisdiction of the BC<sup>2429</sup>, and the UPC is fully detached from the national legal systems.<sup>2430</sup>

It was in view of this criticism that the Commission elaborated a proposal how to integrate the UPC in the existing EU structure. Pursuing this objective, the Commission chose the way to clarify in the text of the Brussels Ibis Regulation that the UPC be considered a “court” within the meaning of the Brussels Ibis Regulation. In this regard, the Commission Proposal 2013 provides for such a clarification in its Article 71a which has been adopted in Article 71a of Regulation 542/2014 by slightly varying the wording which has not effected any change of content or meaning. The provisions read as follows:

---

<sup>2428</sup> Regulation 542/2014 of the European Parliament and of the Council of 15 May 2014 amending Regulation (EU) No 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice, OJ L163 of 29 May 2014, pp. 1-4, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32014R0542&from=EN>> (lastly accessed on 1 June 2015).

<sup>2429</sup> Article 6 of the Treaty setting up the Benelux Court.

<sup>2430</sup> Hilty, Jaeger, Lamping & Ullrich 2012, p. 6; Lock (2011)36(4) E.L. Rev. 576, at p. 587.

**Article 71a**

(1) For the purposes of this Regulation, a court common to several Member States (a “common court”) shall be a court of a Member State when, pursuant to the agreement establishing it, it exercises jurisdiction in civil and commercial matters within the meaning of this Regulation.

(2) For the purposes of this Regulation, the following shall each be a common court:

(a) the Unified Patent Court established by the Agreement on a Unified Patent Court signed on 19 February 2013 (the “UPC Agreement”);

(b) the Benelux Court of Justice established by the Treaty of 31 March 1965 concerning the establishment and statute of a Benelux Court of Justice (the “Benelux Agreement”).

**Article 71a**

(1) For the purposes of this Regulation, a court common to several Member States as specified in paragraph 2 (a ‘common court’) shall be deemed to be a court of a Member State when, pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of this Regulation.

(2) For the purposes of this Regulation, the following shall be a common court:

(a) the Unified Patent Court established by the Agreement on a Unified Patent Court signed on 19 February 2013 (the ‘UPC Agreement’);

(b) the Benelux Court of Justice established by the Treaty of 31 March 1965 concerning the establishment and statute of a Benelux Court of Justice (the ‘Benelux Court of Justice Treaty’).

As has been mentioned above, the UPC will be divided into divisions situated in several States (cf. Article 7 of the UPC Agreement). As a consequence, it may occur that a defendant is sued before a division which is not situated in the Member State of the court designated according to the Brussels Ibis Regulation. This shall be illustrated by the following sample cases 1 and 2:

Case 1:

P, a Dutch company having its seat in the Netherlands, holds a European patent with unitary effect on a product in the field of chemistry. X, an Austrian company having its seat in Austria, infringes P's patent by manufacturing and selling an identical product in Austria. P wonders where it can initiate patent infringement proceedings against X.

According to the general jurisdiction rules of the Brussels Ibis Regulation, X would expect to be sued at his domicile on the basis of Article 4(1) of the Brussels Ibis Regulation. However, the UPC Agreement provides for deviating, broader rules in Article 33 of the UPC Agreement. In Case 1, P can sue X before the local division hosted by Austria as the Contracting Member State where the defendant has its “residence” (if there is such a local division), respectively before the regional division in which Austria participates (if there is such a regional division) (cf. Article 33(1)(b) of the UPC Agreement). Additionally, pursuant to Article 33(1)(a) of the UPC Agreement, P can sue X before the local division hosted by the Contracting Member State where the infringement has occurred or may occur, or the regional division in which that Contracting Member State participates. But what does the term “infringement” mean in this context? Is it the *act of infringement* or the result of such an act? In light of the fact that a European patent with unitary effect has unitary effect in *all* participating Member States by virtue of Regulation 1257/2012 (cf. Article 2(c) of Regulation

1257/2012), an interpretation according to which the term “infringement” within the meaning of Article 33(1)(a) of the UPC Agreement refers to the result of an infringing act would not make sense, because then Article 33(a) of the UPC Agreement would *a priori* confer jurisdiction to the local divisions of all Contracting Member States. This provision must therefore rather be interpreted to refer to the local division hosted by the Contracting Member State where the *infringing act* has occurred or may occur, respectively the regional division in which that Contracting Member State participates. This interpretation also correlates with the provision of substantive law of Article 8(2) of the Rome II Regulation<sup>2431</sup>:

**Article 8**  
**Infringement of intellectual property rights**

(...)

(2) In the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable shall, for any question that is not governed by the relevant Community instrument, be the law of the country in which the act of infringement was committed.

In Case 1, Article 33(1)(a) of the UPC Agreement would thus lead to the local division hosted by Austria (if there is such a local division), respectively the regional division in which Austria participates (if there is such a regional division), because the infringing act (manufacture) has been committed in Austria.

Besides, P and X may agree to proceed before the divisions of their choice, including the central division which has its seat in Paris, with sections in London and in Munich (Article 7(2)1 of the UPC Agreement). However, Article 7(2)2 of the UPC Agreement provides that the cases before the central division shall be distributed in accordance with Annex II of the UPC Agreement. As the concerned patent concerns a product in the field of chemistry, the London section of the central division of the UPC would be competent (cf. Annex II of the UPC Agreement).

Case 2:

The situation shall essentially be as illustrated in Case 1, apart from the fact that P's patent is infringed by Y, a Spanish company which has its seat in Spain and manufactures an identical product in Spain. P wonders where it can initiate patent infringement proceedings against Y.

The decisive difference between Case 1 and Case 2 is the fact that Y, in contrast to X, has its seat in a State which is no Contracting Member State in the meaning of Article 2(c) of the UPC Agreement, because Spain does not take part in the UPC Agreement. According to Article 33(1)(b) 4<sup>th</sup> sentence of the UPC Agreement, actions against defendants having their residence, or principal place of business (...) outside the territory of the Contracting Member

---

<sup>2431</sup> Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), OJ L199 of 31 July 2007, pp. 40-49, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32007R0864&from=EN>> (lastly accessed on 1 June 2015).

States shall be brought before the local or regional division in accordance with Article 33(1)(a) of the UPC Agreement or before the central division. Consequently, P can sue Y before the local division hosted by the Netherlands (if there is such a local division), respectively the regional division in which the Netherlands participate (if there is such a regional division), or before the central division. As the concerned patent concerns a product in the field of chemistry, the London section of the central division of the UPC would be competent (cf. Annex II of the UPC Agreement in conjunction with Article 7(2) of the UPC Agreement).

It is to be noticed that Article 71(1) of the Brussels Ibis Regulation allows conventions on particular matters which already exist, but does not allow any such new conventions like the UPC Agreement.<sup>2432</sup> Article 71(1) of the Brussels Ibis Regulation reads as follows:

#### **Article 71 of the Brussels Ibis Regulation**

(1) This Regulation shall not affect any conventions to which the Member States are parties and which, in relation to particular matters, govern jurisdiction or the recognition or enforcement of judgments.

In order to ensure that the Brussels Ibis Regulation is also fully applicable where proceedings are brought before the UPC, it was necessary to clarify that the UPC is considered a “court” of a Member State in the meaning of the Brussels Ibis Regulation. Noteworthy, the European legislator defined the term “court” neither in the Brussels I Regulation nor in the Brussels Ibis Regulation (although Article 2 of the Brussels Ibis Regulation contains a list of definitions); in particular, neither Article 3 nor Article 71a of the Brussels Ibis Regulation contain a real definition of the notion of “court”.<sup>2433</sup> Article 3 of the Brussels Ibis Regulation merely includes certain specific authorities within the concept of “court” for purposes of the operation of the Brussels Ibis Regulation,<sup>2434</sup> which however should not be relevant with regard to patent disputes.<sup>2435</sup> At least, Recital 11 of the Brussels Ibis Regulation provides for some clarification, stating:

#### **Recital 11 of the Brussels Ibis Regulation**

For the purposes of this Regulation, courts or tribunals of the Member States should include courts or tribunals common to several Member States, such as the Benelux Court of Justice when it exercises jurisdiction on matters falling within the scope of this Regulation. Therefore, judgments given by such courts should be recognised and enforced in accordance with this Regulation.

However, it has been rightly underlined that a recital does not have binding nature and thus cannot ensure with a sufficient degree of legal certainty compliance of the UPC Agreement with the Brussels Ibis Regulation, particularly Article 71 thereof.<sup>2436</sup> By explicitly mentioning the UPC in Article 71a as a “common court”, the European legislator makes clear that the international jurisdiction of the UPC will be determined by the Brussels Ibis Regulation. This clarification serves in particular to ensure legal certainty and predictability for defendants who

---

<sup>2432</sup> European Commission 2013 (Commission Proposal 2013), p. 4.

<sup>2433</sup> Mankowski (2014)11(6) GPR 330, at p. 331; Luginbühl & Stauder (2014)63(10) GRUR Int. 885, at p. 886.

<sup>2434</sup> European Commission 2013 (Commission Proposal 2013), p. 5.

<sup>2435</sup> Luginbühl & Stauder (2014)63(10) GRUR Int. 885, at p. 886.

<sup>2436</sup> European Commission 2013 (Commission Proposal 2013), p. 5.



eventually would expect to be sued in a specific Member State pursuant to the rules of the Brussels Ibis Regulation, by making clear that they may be sued before a division of the UPC which is located in another Member State than the national courts designated according to the “ordinary” rules of the Brussels Ibis Regulation.<sup>2437</sup>

#### **4.4.2.4.2.2 Operation of the jurisdiction rules applicable in relation to the UPC concerning Member State defendants**

It is noteworthy that Article 71b of Regulation 542/2014, while using the broad notion of “jurisdiction”, actually merely affects international jurisdiction,<sup>2438</sup> and does not concern local jurisdiction. This is due to logical reasons: With regard to a court which is considered to be common to several Contracting Member States, local jurisdiction *cannot* exist.<sup>2439</sup> Despite the fact that coordination of the rules conferring international jurisdiction to the UPC and the provisions on the internal allocation of competence within the UPC may be problematic, the Brussels Ibis Regulation cannot provide for respective rules touching the internal allocation of competence within the UPC because this subject lies beyond the scope of the Regulation.<sup>2440</sup>

Correspondingly, Recital 5 of Regulation 542/2014 provides:

##### **Recital 5 of Regulation 542/2014**

The amendments to Regulation (EU) No. 1215/2012 provided for in this Regulation with regard to the Unified Patent Court are intended to establish the international jurisdiction of that Court and do not affect the internal allocation of proceedings among the divisions of that Court nor the arrangements laid down in the UPC Agreement concerning the exercise of jurisdiction, including exclusive jurisdiction, during the transitional period provided for in that Agreement.

In regard of the mentioned need to clarify the operation of the jurisdiction rules applicable in relation to the UPC concerning Member State defendants, addressed by the Commission, Article 71b(1) of the Commission Proposal 2013 contains such a clarifying rule that also forms part of Regulation 542/2014. In essence (apart from minor changes regarding the wording), Article 71b of the Commission Proposal 2013 has been adopted as Article 71b of Regulation 542/2014, providing:

---

<sup>2437</sup> European Commission 2013 (Commission Proposal 2013), p. 5.

<sup>2438</sup> Mankowski (2014)11(6) GPR 330, at p. 334; De Miguel Asensio (2014)45(8) IIC 868, at p. 872.

<sup>2439</sup> Mankowski (2014)11(6) GPR 330, at p. 334.

<sup>2440</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 872.

**Article 71b**

The jurisdiction of a common court shall be determined as follows:

(1) The common court shall have jurisdiction where, under this Regulation, the courts of a Member State party to an agreement establishing a common court have jurisdiction in a matter governed by that agreement.

(...)

**Article 71b**

The jurisdiction of a common court shall be determined as follows:

(1) a common court shall have jurisdiction where, under this Regulation, the courts of a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument;

(...)

Article 71b of the Commission Proposal 2013/ Regulation 542/2014 has been constructed corresponding to Article 71 of the Brussels Ibis Regulation which provides with regard to other international conventions on particular matters:<sup>2441</sup>

**Article 71**

(1) This Regulation shall not affect any conventions to which the Member States are parties and which, in relation to particular matters, govern jurisdiction or the recognition or enforcement of judgments.

(2) With a view to its uniform interpretation, paragraph 1 shall be applied in the following manner:

(a) this Regulation shall not prevent a court of a Member State which is party to a convention on a particular matter from assuming jurisdiction in accordance with that convention, even where the defendant is domiciled in another Member State which is not party to that convention. The court hearing the action shall, in any event, apply Article 28 of this Regulation;

(b) judgments given in a Member State by a court in the exercise of jurisdiction provided for in a convention on a particular matter shall be recognised and enforced in the other Member States in accordance with this Regulation.

Where a convention on a particular matter to which both the Member State of origin and the Member State addressed are parties lays down conditions for the recognition or enforcement of judgments, those conditions shall apply. In any event, the provisions of this Regulation on recognition and enforcement of judgments may be applied.

Accordingly, Article 71b of the Commission Proposal 2013/ Regulation 542/2014 prescribes that the UPC will have jurisdiction any time when a national court of one of the Contracting Member States would have jurisdiction according to the rules of the Brussels Ibis Regulation.<sup>2442</sup> On the other hand, this statement also implies, *a contrario*, that the UPC will lack jurisdiction when no national court of a Contracting Member State has jurisdiction based on the rules of the Brussels Ibis Regulation. This will be the case if, according to the Brussels

<sup>2441</sup> In the Explanatory Memorandum of the Commission Proposal 2013, it has been rightly suggested that similar clarifications have been undertaken, for instance, in Articles 64 and 67 of the 2007 Lugano Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, cf. European Commission 2013 (Commission Proposal 2013), p. 5.

<sup>2442</sup> European Commission 2013 (Commission Proposal 2013), p. 5.

Ibis Regulation, courts of a non-Contracting Member State would have jurisdiction.<sup>2443</sup> It is noteworthy that international jurisdiction of the common court according to Article 71b(1) of the Commission Proposal 2013/ Regulation 542/2014 merely requires that a national court of *any* Contracting State of the UPC Agreement would have international jurisdiction. There is no requirement that the national courts of a specific Contracting State must have hypothetical international jurisdiction pursuant to the Brussels Ibis Regulation.<sup>2444</sup>

For illustration, I shall again refer to Case 1 presented above and then proceed to Case 3 und Case 4.

#### Case 1:

P, a Dutch company having its seat in the Netherlands, holds a European patent with unitary effect on a product in the field of chemistry. X, an Austrian company having its seat in Austria, infringes P's patent by manufacturing an identical product in Austria and selling it in the Netherlands.

According to Article 4(1) of the Brussels Ibis Regulation, Austrian courts would have jurisdiction because X has its seat in Austria. Besides, pursuant to Article 7(2) of the Brussels Ibis Regulation, Dutch courts would have jurisdiction because the place where the damage occurred would be situated in the Netherlands. As a consequence, the courts of at least one Member State party to the UPC Agreement (here: both Austria and the Netherlands) would have jurisdiction under the Brussels Ibis Regulation. Therefore the UPC has jurisdiction in this case (cf. Article 71b(1) of Regulation 542/2014).

#### Case 3:

P, a Dutch company having its seat in the Netherlands, holds a European patent with unitary effect on a product in the field of chemistry. Y, a Spanish company having its seat in Spain, infringes P's patent by manufacturing an identical product in Spain and selling it in the Netherlands.

Pursuant to Article 4(1) of the Brussels Ibis Regulation, Spanish courts would have jurisdiction because Y's seat is located in Spain. According to Article 7(2) of the Brussels Ibis Regulation, Dutch courts would have jurisdiction because the place where the damage occurred would be situated in the Netherlands. As in Case 1, the courts of at least one Member State party to the UPC Agreement (here: the Netherlands) would have jurisdiction under the Brussels Ibis Regulation. In this respect it does not matter that Spain is a Member State but no Contracting State to the UPC Agreement. As in Case 1, the UPC has jurisdiction pursuant to Article 71b(1) of Regulation 542/2014.

---

<sup>2443</sup> European Commission 2013 (Commission Proposal 2013), p. 5.

<sup>2444</sup> Mankowski (2014)11(6) GPR 330, at p. 336.

#### Case 4:

P, a Dutch company having its seat in the Netherlands, holds a European patent with unitary effect on a product in the field of chemistry. Z, a Russian company having its seat in Russia, infringes P's patent by manufacturing an identical product in Russia and selling it in the Netherlands.

In contrast to Cases 1 and 3, Article 4(1) of the Brussels Ibis Regulation does not apply in Case 4,<sup>2445</sup> because Russia where Z has its seat is no Member State. According to Article 6(1) of the Brussels Ibis Regulation, the jurisdiction of the courts of each Member State would be determined by the law of that Member State, because the constellation described does not touch upon matters of Articles 18(1), 21(2), 24 or 25 of the Brussels Ibis Regulation. Article 7(2) of the Brussels Ibis Regulation does not apply either<sup>2446</sup> because it also requires that the defendant is domiciled in a Member State. As a consequence, the UPC does not have jurisdiction according to Article 71b(1) of Regulation 542/2014 in Case 4. However, this result does not exclude that jurisdiction of the UPC can be grounded on another legal basis. This shall be discussed in the following paragraphs.

Article 71b(1) complements Article 71a in that it explicitly stipulates that a “common court” shall not only be considered to be a court of a Contracting Member State (cf. Article 71a), but that it shall have jurisdiction to the same extent as national courts of Contracting Member States in a matter governed by the UPC Agreement. At a closer look, one might argue that Article 71b(1) would not be necessary beside Article 71a, because its content is actually implied in Article 71a. However, this might be owed to the Commission's severe intent “to create full transparency on the combined and coherent application”<sup>2447</sup> of the UPC Agreement and the Brussels Ibis Regulation. It has been rightly highlighted that, with regard to the UPC, many heads of jurisdiction of the Brussels Ibis Regulation do not apply, because they do not fall within the scope of application of the UPC Agreement. Beyond Articles 7(5) and 8(3) of the Brussels Ibis Regulation, Article 71b(1) of Regulation 542/2014 primarily concerns Articles 4(1), 7(2) and 8(1) of the Brussels Ibis Regulation.<sup>2448</sup>

---

<sup>2445</sup> At this point, suffice it to state that Article 4(1) of the Brussels Ibis Regulation does not apply immediately. The question of whether Article 4(1) of the Brussels Ibis Regulation is applicable by reference to another provision will be treated subsequently.

<sup>2446</sup> At this point, it is sufficient to state that Article 7(2) of the Brussels Ibis Regulation does not apply immediately. The question of whether Article 7(2) of the Brussels Ibis Regulation is applicable by reference to another provision will be treated subsequently.

<sup>2447</sup> European Commission 2013 (Commission Proposal 2013), p. 5.

<sup>2448</sup> Mankowski (2014)11(6) GPR 330, at p. 336.

#### **4.4.2.4.2.3 Creation of uniform jurisdiction rules vis-à-vis third State defendants**

Article 71b(2) and (3) of the Commission Proposal 2013 respectively Article 71b(2) and (3) of Regulation 542/2014 have been constructed according to the Commission's intent to establish uniform rules for the international jurisdiction vis-à-vis third State defendants in proceedings against such defendants brought in the UPC where *national law* is applicable, because the Brussels Ibis Regulation does not itself provide for such rules. With regard to those legal situations which are not governed by uniform jurisdiction rules (such uniform jurisdiction rules already exist, for instance, with regard to exclusive jurisdiction concerning proceedings on the registration and validity of patents, in contrast to patent infringement proceedings), Article 71b(2) and (3) of the Commission Proposal 2013 respectively Article 71b(2) and (3) of Regulation 542/2014 aim at providing an adequate solution for the addressed issues by completing the jurisdiction rules of the Brussels Ibis Regulation for matters falling within the competence of the UPC where third State defendants are affected. Article 71(b)(2) and Article 71(b)(3) are constructed in such a way that Article 71(b)(3) *complements* Article 71(b)(2).

While the content of Article 71b(2) of the Commission Proposal 2013 has been adopted in Article 71b(2) of Regulation 542/2014, by merely slightly amending the wording, Article 71b(3) of Regulation 542/2014 deviates from Article 71b(3) of the Commission Proposal 2013 in that the requirements for an action relating to an infringement of a European patent giving rise to damage within the Union, against a defendant domiciled in a non-Member State, before a common court have been altered. Articles 71b(2) and (3) of the Commission Proposal 2013 and of Regulation 542/2014 read as follows:

**Article 71b**

The jurisdiction of a common court shall be determined as follows:

(...)

(2) Where the defendant is not domiciled in a Member State, and this Regulation does not otherwise confer jurisdiction over him, the provisions of Chapter II shall apply as if the defendant was domiciled in a Member State. Article 35 shall apply even if the courts of non-Member States have jurisdiction as to the substance of the matter.

(3) Where the defendant is not domiciled in a Member State and no court of a Member State has jurisdiction under this Regulation, the defendant may be sued in the common court if:

(a) property belonging to the defendant is located in a Member State party to the agreement establishing the common court;

(b) the value of the property is not insignificant compared to the value of the claim;

(c) the dispute has a sufficient connection with any Member State party to the agreement establishing the common court.

**Article 71b**

The jurisdiction of a common court shall be determined as follows:

(...)

(2) where the defendant is not domiciled in a Member State, and this Regulation does not otherwise confer jurisdiction over him, Chapter II shall apply as appropriate regardless of the defendant's domicile.

Application may be made to a common court for provisional, including protective, measures even if the courts of a third State have jurisdiction as to the substance of the matter;

(3) where a common court has jurisdiction over a defendant under point 2 in a dispute relating to an infringement of a European patent giving rise to damage within the Union, that court may also exercise jurisdiction in relation to damage arising outside the Union from such an infringement.

Such jurisdiction may only be established if property belonging to the defendant is located in any Member State party to the instrument establishing the common court and the dispute has a sufficient connection with any such Member State.

Noteworthy, Article 31 of the UPC Agreement declares applicable the Brussels Ibis Regulation or the Lugano Convention for determining international jurisdiction of the UPC:

**Article 31 of the UPC Agreement**

The international jurisdiction of the Court shall be established in accordance with Regulation (EU) No. 1215/2012 or, where applicable, on the basis of the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters ('Lugano Convention').

Insofar as the Brussels Ibis Regulation respectively the Lugano Convention determine jurisdiction by reference to provisions implied in these sets of rules, Article 31 of the UPC Agreement does not raise a problem. But problems arise in case that the Brussels Ibis Regulation or the Lugano Convention determine jurisdiction by reference to the national law of the Member State where proceedings are initiated. In this respect, the essential rule contained in Article 6 of the Brussels Ibis Regulation<sup>2449</sup> is to be borne in mind which provides:

<sup>2449</sup> Article 4 of the Lugano Convention contains a similar set of rules.

## Article 6 of the Brussels Ibis Regulation

(1) If the defendant is not domiciled in a Member State, the jurisdiction of the courts of each Member State shall, subject to Article 18(1), Article 21(2) and Articles 24 and 25, be determined by the law of that Member State.

(2) As against such a defendant, any person domiciled in a Member State may, whatever his nationality, avail himself in that Member State of the rules of jurisdiction there in force, and in particular those of which the Member States are to notify the Commission pursuant to point (a) of Article 76(1), in the same way as nationals of that Member State.

Referring to the national law of the forum Member State, Article 6 of the Brussels Ibis Regulation (and the same applies to Article 4 of the Lugano Convention) does not determine which rules should apply to determine the jurisdiction of courts that are common to several Member States such as the UPC.<sup>2450</sup> A further problem to be solved arises from the fact that the UPC is divided into several divisions; in this respect, the Commission has rightly highlighted that referring to different national laws for the several divisions of the UPC would create unequal access to justice in a unified jurisdictional system which could hardly be justified.<sup>2451</sup>

### 4.4.2.4.2.3.1 Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014

According to the clear rule codified in Article 71(b)(2) 1<sup>st</sup> sentence of Regulation 542/2014, the UPC shall, in proceedings against third State defendants, have jurisdiction as if these defendants were domiciled in a Member State, which is effected by stating that Chapter II of the Brussels Ibis Regulation (containing jurisdiction rules) shall be applicable. This implies the application of special jurisdiction according to Articles 7 and 8 of the Brussels Ibis Regulation. Remarkably, this is not in line with the clear wording of Article 7 of the Brussels Ibis Regulation which refers to “a person domiciled in a Member State”. However, despite this structural break, it is to be accepted that the European legislator, when creating Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014, intended to create a special provision – which precedes the general rule in Article 7 of the Brussels Ibis Regulation.<sup>2452</sup> It is noteworthy that Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 thus picks up the initial idea contained in the Commission Proposal 2010 to widely extend jurisdiction rules to third State defendants, and even goes beyond it by also referring to Article 8(1) of the Brussels Ibis Regulation in Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014, while Article 6(1) of the Commission Proposal 2010 did not imply an extension to third State defendants.<sup>2453</sup> From the European perspective, Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 provides adequate jurisdiction rules, also because patent protection does not depend on the fact whether the defendant is domiciled in a Member State or in a third State.<sup>2454</sup> Others have criticised that the approach pursued by the European legislator in Article 71b of Regulation 542/2014 does not go far enough, and that the preservation of different rules governing access to justice in the Member States with respect to disputes involving third State defendants in matters governed by the Brussels Ibis Regulation remains a significant failure in the evolution of the Brussels

<sup>2450</sup> European Commission 2013 (Commission Proposal 2013), p. 6.

<sup>2451</sup> European Commission 2013 (Commission Proposal 2013), p. 6.

<sup>2452</sup> Mankowski (2014)11(6) GPR 330, at p. 336.

<sup>2453</sup> Mankowski (2014)11(6) GPR 330, at p. 336, and there fn. 22.

<sup>2454</sup> Mankowski (2014)11(6) GPR 330, at p. 336.

Regulation, effecting distortions between the jurisdiction rules and the provisions on recognition and enforcement of judgments provided for by the Brussels Ibis Regulation.<sup>2455</sup>

To illustrate the functioning of Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014, I shall reconsider Case 4.

#### Case 4:

P, a Dutch company having its seat in the Netherlands, holds a European patent with unitary effect on a product in the field of chemistry. Z, a Russian company having its seat in Russia, infringes P's patent by manufacturing an identical product in Russia and selling it in the Netherlands.

It has been stated above that the UPC does not have jurisdiction according to Article 71b(1) of Regulation 542/2014, because Z's seat is not situated in a Member State. As the Brussels Ibis Regulation does not otherwise confer jurisdiction over him either (apart from, eventually, Article 71b which is being analysed instantly here), Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 provides that Chapter II of the Brussels Ibis Regulation (jurisdiction rules) shall apply regardless of the defendant's domicile. According to the wording of Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014, jurisdiction of the UPC concerning an infringement action against Z could eventually be based on Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 in conjunction with Article 4(1) of the Brussels Ibis Regulation, or on Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 in conjunction with Article 7(2) of the Brussels Ibis Regulation. Pursuant to Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 in conjunction with Article 7(2) of the Brussels Ibis Regulation, Dutch courts would have jurisdiction because the place where the damage occurred would be situated in the Netherlands. But what about jurisdiction pursuant to Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 in conjunction with Article 4(1) of the Brussels Ibis Regulation? Article 4(1) of the Brussels Ibis Regulation confers jurisdiction to “the courts of that *Member State*” (where the defendant is domiciled). But in the case of a defendant domiciled outside the European Union – like Z in Case 4 – this prerequisite of Article 4(1) of the Brussels Ibis Regulation is not fulfilled. Case 4 thus demonstrates that the reference to Chapter II of the Brussels Ibis Regulation contained in Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 *cannot* comprise Article 4(1) of the Brussels Ibis Regulation for logical reasons.<sup>2456</sup> The wording of Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 should therefore be amended by explicitly providing that Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 does not refer to Article 4(1) of the Brussels Ibis Regulation.

#### **4.4.2.4.2.3.2 Article 71b(2) 2<sup>nd</sup> sentence of Regulation 542/2014**

According to Article 71b(2) 2<sup>nd</sup> sentence of Regulation 542/2014, the UPC shall have authority to order provisional, including protective, measures even if the courts of a third State have jurisdiction for the substance of the matter. Consequently, access to justice before the UPC for defendants domiciled in an EU Member State and third State defendants will be equally ensured in this respect, and independently of which instance or division within the

---

<sup>2455</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 874.

<sup>2456</sup> Mankowski (2014)11(6) GPR 330, at p. 336.



UPC is seised of a claim.<sup>2457</sup> In contrast to the text of Article 71b(2) 2<sup>nd</sup> sentence of Regulation 542/2014, the wording of Article 71b(2) 2<sup>nd</sup> sentence of the Commission Proposal 2013 explicitly refers to the applicability of Article 35 of the Brussels Ibis Regulation. However, these variant formulations should not effect a different evaluation of both provisions with regard to their content. Similarly to Article 35 of the Brussels Ibis Regulation, jurisdiction of the common court to order provisional, including protective, measures can, vis-à-vis third State defendants, be based on two pillars: accessory jurisdiction for interim relief where there is jurisdiction on the merits (Article 71b(2) 1<sup>st</sup> sentence) and independent jurisdiction for interim relief according to the rules of procedure of the common court (Article 71b(2) 2<sup>nd</sup> sentence).<sup>2458</sup> However, in contrast to the situation with regard to Article 35 of the Brussels Ibis Regulation, provisional measures must be provided for by the rules of procedure of the common court (and not by the procedural law of the Contracting State where the common court has been established). Besides, jurisdiction according to Article 71b(2) 2<sup>nd</sup> sentence is only effective against jurisdiction for principal proceedings of courts of third States, but cannot have such effect vis-à-vis Member States courts.<sup>2459</sup> However, this effect can be reached via Article 71b(2) 1<sup>st</sup> sentence. In this respect, it has been rightly underlined that Article 71b(2) 2<sup>nd</sup> sentence and Article 35 of the Brussels Ibis Regulation are parallel provisions which complement each other.<sup>2460</sup> As with regard to Article 35 of the Brussels Ibis Regulation, Article 71b(2) 2<sup>nd</sup> sentence does not define “provisional, including protective, measures”. As a consequence, identical problems will occur as with regard to Article 35 of the Brussels Ibis Regulation: legal uncertainty and a lack of sufficient predictability. To resolve this problem, the European legislator should, first, implement a definition of the notion of “provisional, including protective, measures” into Article 35 of the Brussels Ibis Regulation and, second, implement a reference to Article 35 into Article 71b (2) 2<sup>nd</sup> sentence (as already contained in the Commission Proposal 2013).

#### 4.4.2.4.2.3.3 Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014

It is noteworthy that – contrary to the relationship between Article 71b(2) of the Commission Proposal 2013 and Article 71b(2) of Regulation 542/2014 – Article 71b(3) of Regulation 542/2014 significantly differs from Article 71b(3) of the Commission Proposal 2013 which will be carved out in the following paragraphs.<sup>2461</sup>

Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 *complements* Article 71b(2) of Regulation 542/2014 insofar as the authority of the UPC regarding a third State defendant is extended in that the court, in case of an infringement of a European patent, may not only exercise jurisdiction concerning damage arising *within* the European Union, *but also* regarding damage that arises *outside* the European Union from such an infringement. In this respect, Recital 7 1<sup>st</sup> sentence of Regulation 542/2014 provides:

<sup>2457</sup> European Commission 2013 (Commission Proposal 2013), p. 6.

<sup>2458</sup> Mankowski (2014)11(6) GPR 330, at p. 337.

<sup>2459</sup> Mankowski (2014)11(6) GPR 330, at p. 337.

<sup>2460</sup> Mankowski (2014)11(6) GPR 330, at p. 337.

<sup>2461</sup> Cf. De Miguel Asensio (2014)45(8) IIC 868, at p. 876: “This provision evolved significantly during the legislative process.”

#### **Recital 7 1<sup>st</sup> sentence of Regulation 542/2014**

A common court should be able to hear disputes involving defendants from third States on the basis of a subsidiary rule of jurisdiction in proceedings relating to an infringement of a European patent giving rise to damage both inside and outside the Union. (...)

In structural respect, it is noteworthy that Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 seems to constitute no separate head of jurisdiction, but rather seems to determine the scope of the court's authority to decide.<sup>2462</sup> However, others seem to classify Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 as a ground of jurisdiction.<sup>2463</sup> In any event, as this provision extends the reach of single enforcement to cover infringements outside the European Union by defendants not domiciled in a Member State, and thus offers patentees the possibility to claim enforcement without having to litigate in the State of infringement, the rationale behind Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 might be to enhance a key advantage that the UPC may offer to become an alternative forum to the US for major patent litigation.<sup>2464</sup>

The significance of Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 becomes obvious in conjunction with Article 7(2) of the Brussels Ibis Regulation in the case of (patent) infringements in several States. A comprehensive authority to decide regarding infringements in all concerned States principally exists only before the courts of the State where the defendant is domiciled (Article 4(1) of the Brussels Ibis Regulation), and at the place of the event giving rise to the damage (Article 7(2) of the Brussels Ibis Regulation). Jurisdiction at the place where the damage occurred in principle merely confers authority to decide on infringements which have occurred in the forum State (mosaic principle).<sup>2465</sup> However, in the case of third State defendants, Article 4(1) of the Brussels Ibis Regulation does not apply, and the application of 7(2) of the Brussels Ibis Regulation is only possible via Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014. As Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 directly refers to Article 71b(2) 1<sup>st</sup> sentence of Regulation 542/2014 (“where a common court has jurisdiction over a defendant under point 2”), the rules developed by the ECJ<sup>2466</sup> in the framework of Article 7(2) of the Brussels Ibis Regulation (respectively its predecessors) with regard to the scope of authority to decide, apply in the constellation of Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 where the UPC has jurisdiction over a third State defendant in a dispute concerning an infringement of a European patent giving rise to the damage within the European Union. On the basis of jurisdiction at the place of the event giving rise to the damage (Article 7(2) of the Brussels Ibis Regulation), it seems that the UPC could have unrestricted jurisdiction over the whole infringement, without the need for a supplementary rule, if the place where the event giving rise to an infringement of a European patent, which also produces damage outside the Union, is located in a Contracting State of the UPC Agreement.<sup>2467</sup>

---

<sup>2462</sup> Mankowski (2014)11(6) GPR 330, at p. 337.

<sup>2463</sup> Miguel Asensio (2014)45(8) IIC 868, at pp. 881-882: “Granting additional jurisdiction to the UPC over the infringement of third-State (although European) patents, on the basis that the defendant has assets unrelated to the infringement in a Contracting State to the UPC, should generally be regarded not only as an exorbitant ground for jurisdiction but also as inappropriate for disputes over the infringement of patent rights.” I respectfully disagree with this opinion.

<sup>2464</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 879.

<sup>2465</sup> Cf. explications in Chapter 2 of this thesis.

<sup>2466</sup> Cf. in particular ECJ 7 March 1995, C-68/93, *Fiona Shevill and Others v Presse Alliance SA*, [1995] ECR I-00415 – *Shevill*: “mosaic principle”.

<sup>2467</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 880.

The true purpose of Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 seems to consist in extending the court's authority to decide, *beyond* the rules with regard to the authority to decide mentioned above, *at the place where the damage occurred* in respect of damage which arises *outside* the European Union.<sup>2468</sup> From the European perspective, this extension of jurisdiction of the UPC may provide for an enhanced protection with regard to European patents and European patents with unitary effect by ensuring an adequate judiciary also for deciding on such *extra*-Union damage. It should however be borne in mind that this happens at the expense of courts of those EPC Contracting States which are no EU Member States.<sup>2469</sup> In Chapter 2 of this thesis, I have arrived at the conclusion that only the place where the patent right has been infringed ("*Ort der Rechtsgutverletzung*") is to be considered the place where the damage occurred according to Article 7(2) of the Brussels Ibis Regulation. As a consequence, the place of the event giving rise to the damage and the place where the damage occurred will regularly coincide. This fact may relativise the importance of the extension of the authority to decide pursuant to Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 which refers to jurisdiction at the place where the damage occurred, where the invoked court has also jurisdiction because the forum is situated at the place of the event giving rise to the damage, and therefore has corresponding broad authority to decide.

In light of the clear jurisprudence of the ECJ in *Roche Nederland* that in the case of infringing several national parts of an ordinary European patent, there are actually *several* infringements, it is suggested that, while the wording of Article 71b(3) of Regulation 542/2014 refers to "an infringement", it can be established that proceedings concerning at the same time the infringement of a European patent within the European Union and outside the European Union actually cover *different* infringements. In light of this, the extension of the jurisdiction of the UPC to adjudicate a patent infringement outside the European Union according to Article 71b(3) of Regulation 542/2014, where the UPC has no jurisdiction under Chapter II of the Brussels Ibis Regulation, seems controversial.<sup>2470</sup>

#### 4.4.2.4.2.3.4 Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014

However, in order to avoid proliferation of jurisdiction according to Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014,<sup>2471</sup> Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014 sets up two conditions that must be fulfilled for such jurisdiction: first, property belonging to the

<sup>2468</sup> Mankowski (2014)11(6) GPR 330, at pp. 337-338; Luginbühl & Stauder (2014)63(10) GRUR Int. 885, at p. 888.

<sup>2469</sup> Mankowski (2014)11(6) GPR 330, at p. 338.

<sup>2470</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 880.

<sup>2471</sup> According to the schematic place of Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014 behind Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014, and also under (3), one should conclude that it refers only to Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014 and not to the whole Article 71b of Regulation 542/2014, although a purely literal interpretation of Article 71b of Regulation 542/2014 would also justify the latter alternative (the notion of "such jurisdiction" in Article 71b(3) 2<sup>nd</sup> sentence could in theory refer to "the jurisdiction" at the beginning of Article 71b or to the term "jurisdiction" in Article 71b(3) 2<sup>nd</sup> sentence). Likewise: *Mankowski*, cf. Mankowski (2014)11(6) GPR 330, at p. 338. However, I respectfully disagree with *Mankowski's* opinion that Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014 has the effect to establish jurisdiction ("Art. 71b Nr. 3 UA 2 wirkt im Ergebnis zuständigkeitsbegründend, obwohl er auf den ersten Blick Einschränkungen durch zusätzliche Voraussetzungen zu normieren scheint. Ohne diese zusätzlichen Voraussetzungen würde jedoch überhaupt keine Erweiterung der Zuständigkeit stattfinden, und Art. 71b Nr. 3 wäre neben Art. 71b Nr. 2 i.V.m. Art. 7 Nr. 2 überflüssig und ohne eigenen Sinn", cf. Mankowski (2014)11(6) GPR 330, at p. 338). In my opinion, Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014 *restricts* Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014 that actually extends jurisdiction as already discussed. Extension of jurisdiction is thus only effected by Article 71b(3) 1<sup>st</sup> sentence of Regulation 542/2014, but not by Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014.

defendant must be located in any UPC Contracting Member State and, second, the dispute must have a sufficient connection with any such Member State. In contrast to Article 71b(3) of Regulation 542/2014, Article 71b(3) of the Commission Proposal 2013, first, does not contain a clear differentiation between damage arising within the European Union and damage that arises outside the Union. In comparison with Article 71b(3) of Regulation 542/2014, it is remarkable, second, that Article 71b(3)(a) to (c) of the Commission Proposal 2013, on the one hand, at first glance seems to be more restrictive as it contains three conditions (and not only two as Article 71b(3) of Regulation 542/2014) to be fulfilled for jurisdiction, but on the other hand to some extent less restrictive with regard to the exact content of the conditions set up. In contrast to Article 71b(3) of Regulation 542/2014, Article 71b(3)(a) to (c) of the Commission Proposal 2013 not only requires the existence of property belonging to the defendant in a UPC Contracting Member State (a), and the existence of a sufficient connection between the dispute with a Member State party to the UPC Agreement (c), but also sets up the requirement that the value of the property is not insignificant compared to the value of the claim (b). This requirement indeed lacks in Article 71b(3) of Regulation 542/2014. By way of an isolated consideration, one might therefore arrive at the conclusion that Article 71b(3) of the Commission Proposal 2013 is more restrictive than Article 71b(3) of Regulation 542/2014 in this respect. However, a closer look reveals that the requirement of value of the property has been integrated in Recital 7 3<sup>rd</sup> sentence of Regulation 542/2014:

**Recital 7 3<sup>rd</sup> sentence of Regulation 542/2014**

(...) In establishing its jurisdiction, the common court should have regard to the value of the property in question, which should not be insignificant and which should be such as to make it possible to enforce the judgment, at least in part, in the Member States parties to the instrument establishing the common court.

Although a recital does not have binding character like a legal provision, it should be assumed that Article 71b(3) of Regulation 542/2014 and Article 71b(3) of the Commission Proposal 2013 would arrive at the same results. Nevertheless, for the sake of legal certainty and predictability, the value criterion should be integrated in the wording of Article 71b(3) of Regulation 542/2014 in the framework of a future reform of the Brussels Ibis Regulation.

Notwithstanding these differences between Article 71b(3) of the Commission Proposal 2013 and Article 71b(3) of Regulation 542/2014, it is to be remarked that the European legislator intended to create, for disputes involving defendants domiciled outside the European Union, an *additional* forum<sup>2472</sup> at the place where assets are located, in order to balance the absence of the defendant in the European Union.<sup>2473</sup>

Arguing in favour of this approach to establish an additional asset-based forum, in order to ensure the jurisdiction of the UPC in situations where the extended jurisdiction rules of the Brussels Ibis Regulation would not provide for jurisdiction and where such jurisdiction may be appropriate, the Commission has put forth that such a rule also exists in a sizeable group of Member States,<sup>2474</sup> which may suggest that there is already experience in applying such a rule. Besides, it has been underlined by the Commission that establishing an asset-based

<sup>2472</sup> Cf. Recital 7 2<sup>nd</sup> sentence of Regulation 542/2014: “subsidiary jurisdiction”.

<sup>2473</sup> European Commission 2013 (Commission Proposal 2013), p. 6; cf. also Mankowski (2014)11(6) GPR 330, at p. 338.

<sup>2474</sup> European Commission 2013 (Commission Proposal 2013), p. 6.

forum brings along the advantage that a judgment can be enforced in the State where it was issued, which may avoid eventual difficulties which might arise with regard to cross-border recognition and enforcement.<sup>2475</sup> However, while the existence of property belonging to the defendant, within the forum, may also be one of the traditional bases of jurisdiction under national law, it has not been applied to cases of infringement of foreign intellectual property rights.<sup>2476</sup> Also by reference to the solutions proposed in the CLIP Principles and the ALI Principles, as well as in other model provisions concerning international jurisdiction over intellectual property litigation drafted in other regions of the world<sup>2477</sup>, Article 71b(3) 2<sup>nd</sup> sentence of Regulation 542/2014 has therefore been considered as inappropriate.<sup>2478</sup> Furthermore, in typical situations, there is the risk that a judgment rendered by the UPC on the basis of Article 71b(2) in conjunction with Article 71b(3) of Regulation 542/2014 will not be recognised or enforced in the non-EU State of infringement, in particular because the decision would not comply with the standard of review of the jurisdiction of the deciding court.<sup>2479</sup>

Moreover, the argument brought forward by the Commission that creating an additional asset-based forum “fits better in the general philosophy of the Brussels Ibis Regulation than other rules of subsidiary jurisdiction such as those provided in the Community trade mark Regulation and the Community designs Regulation (...) which allow proceedings against third States defendants to be brought, in particular, before the courts of the Member State where the plaintiff is domiciled (*forum actoris*)”<sup>2480</sup>, is not convincing. Deviating from Article 25 the Commission Proposal 2010<sup>2481</sup>, the European legislator did refrain from establishing a general asset-based forum in the Brussels Ibis Regulation, and thus clearly expressed its negative attitude towards such a rule. By integrating an asset-based forum into the system of the Brussels Ibis Regulation “through the back door” via Article 71b(3) of Regulation 542/2014, the European legislator created a structural break in the Brussels Ibis Regulation.<sup>2482</sup>

As to the Commission's reference to similar rules in the Community trade mark Regulation and the Community designs Regulation, one could argue that creating a *forum actoris* in clearly defined constellations in case of third State defendants could bring along the benefit to ensure harmony (“*Gleichklang*”) between the treatment of European patents with unitary effect on the one hand, and Community trade marks and Community designs on the other hand. Both the Community trade mark Regulation and the Community designs Regulation contain a complete set of rules on jurisdiction vis-à-vis third State defendants, comprising the rule of a *forum actoris* applicable under specific circumstances. The respective rules of those Regulations are Article 97(2) of the Community trade mark Regulation and Article 82(2) of the Community designs Regulation. Article 97(2) of the Community trade mark Regulation reads as follows:

<sup>2475</sup> European Commission 2013 (Commission Proposal 2013), p. 6.

<sup>2476</sup> Fawcett & Torremans 2011, para. 6.89.

<sup>2477</sup> In this respect, the Waseda Proposal and the Korean KOPILA Principles shall be mentioned, cf. Jurčys (2012)3(3) JIPITEC 174, at p. 177.

<sup>2478</sup> De Miguel Asensio (2014)45(8) IIC 868, at pp. 881-882.

<sup>2479</sup> De Miguel Asensio (2014)45(8) IIC 868, at pp. 882-883; cf. also De Miguel Asensio 2010, p. 274.

<sup>2480</sup> European Commission 2013 (Commission Proposal 2013), pp. 6-7.

<sup>2481</sup> Article 25 of the Commission Proposal 2010 provided:

“Where no court of a Member State has jurisdiction in accordance with Articles 2 to 24, jurisdiction shall lie with the courts of the Member State where property belonging to the defendant is located, provided that  
(a) the value of the property is not disproportionate to the value of the claim; and  
(b) the dispute has a sufficient connection with the Member State of the court seised.”

<sup>2482</sup> Cf. also Mankowski (2014)11(6) GPR 330, at pp. 338-339.

#### **Article 97 International jurisdiction**

(...)

(2) If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

Correspondingly, Article 82(2) of the Community designs Regulation provides as to Community designs:

#### **Article 82(2) of the Community designs Regulation**

(...)

(2) If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

However, it has been rightly put forth in legal doctrine that a comparison between jurisdiction for the Community trade mark and the Community design on the one hand, and the European patent with unitary effect on the other hand seems inappropriate due to the different functions that those rules fulfil.<sup>2483</sup> While the cited rules of the Trade Mark Regulation and the Design Regulation basically confer jurisdiction to the courts of Member States of the Regulation in situations that clearly (and on other grounds) should fall within the international jurisdictions of the EU Member States, Article 71b(3) of Regulation 542/2014 determines the extent of jurisdiction of the UPC in situations where there is no similar connection with the Contracting State to the UPC Agreement.<sup>2484</sup> As to Article 97(2) of the Community trade mark Regulation (and a corresponding reasoning applies to the respective provisions of the Community designs Regulation) there is no doubt, since the proceedings refer to the infringement and validity of Community trade marks, that the courts of one or several Member States must have international jurisdiction to adjudicate such disputes. As a consequence, Article 97(2) of the Community trade mark Regulation has essentially the function to allocate jurisdiction among the Member States.<sup>2485</sup>

#### **4.4.2.4.2.3.5 Creation of additional fragmentation due to jurisdiction of the UPC with regard to patent disputes concerning States not participating in the UPC Agreement**

According to Article 1 of the UPC Agreement, the UPC has jurisdiction with regard to disputes relating to European patents and European patents with unitary effect. But how to deal with those situations in which the courts of a Member State have jurisdiction according to the Brussels Ibis Regulation to adjudicate not only claims with respect of the infringement by the defendant of a European patent but also concerning the infringement by the defendant of patents granted in non-European States?<sup>2486</sup> As the UPC does not have jurisdiction with

---

<sup>2483</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 877.

<sup>2484</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 877.

<sup>2485</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 877.

<sup>2486</sup> This question has also been raised by *De Miguel Asensio*, cf. De Miguel Asensio (2014)45(8) IIC 868, at pp. 875-876.

regard to such patents granted for non-European States, the national courts of the Contracting Member States remain competent in this respect, to the extent that jurisdiction is conferred to them under the Brussels Ibis Regulation, the Lugano Convention or national law according to Article 6 of the Brussels Ibis Regulation.<sup>2487</sup> As a consequence, separate proceedings before separate courts will have to be led. Also, according to Article 32 of the UPC Agreement, the national courts of the Contracting Member States will remain competent for actions concerning patents and supplementary protection certificates which do not fall within the exclusive competence of the UPC.<sup>2488</sup> The foregoing examples demonstrate that the implementation of the UPC Agreement has effected an additional fragmentation with regard to cross-border litigation of patent proceedings.<sup>2489</sup> Unfortunately, Regulation 542/2014 does not address, let alone resolve those issues which are based on the scope of the jurisdiction of the UPC with respect to patent disputes regarding States that do not participate in the UPC Agreement.<sup>2490</sup> In opposition to this situation, an additional forum as envisaged in the Commission Proposal 2013 would determine the extent of the international jurisdiction of the UPC regarding disputes involving third State defendants with respect to, for instance, the infringement of European patents outside the European Union.<sup>2491</sup>

#### **4.4.2.4.2.4 Application of the rules on *lis pendens* and related actions in relation to the UPC and the national courts of Member States which are not Contracting Parties to the UPC Agreement (Article 71c(1) of Regulation 542/2014)**

With regard to the question of how to treat the situation that proceedings are initiated both before the UPC and before a court of a Member State which does not take part in the UPC Agreement, Article 71c(1) of the Commission Proposal 2013 declares applicable the rules on *lis pendens* and related actions according to the Brussels Ibis Regulation. The provision has been adopted as Article 71c(1) of Regulation 542/2014, undertaking a minor adaptation of the wording.

Article 71c(1) of the Commission Proposal 2013 and Article 71c(1) of Regulation 542/2014 read as follows:

##### **Commission Proposal 2013**

##### **Article 71c**

(1) Articles 29 to 32 shall apply when proceedings are brought in a common court and in a court of a Member State not party to the agreement establishing that common court.

##### **Regulation 542/2014**

##### **Article 71c**

(1) Articles 29 to 32 shall apply where proceedings are brought in a common court and in a court of a Member State not party to the instrument establishing that common court.

Apart from minor changes, Article 71c(1) of the Commission Proposal 2013 and Article 71c(1) of Regulation 542/2014 are formulated in the same way. As to their content, there are no differences between the provisions. Article 71c(1) of Regulation 542/2014 makes clear that the rules on *lis pendens* and related actions of the Brussels Ibis Regulation are applicable with

<sup>2487</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 876.

<sup>2488</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 876.

<sup>2489</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 875.

<sup>2490</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 875.

<sup>2491</sup> De Miguel Asensio (2014)45(8) IIC 868, at pp. 877-878.

regard to the relationship between the UPC and the courts of non-Contracting Member States. The UPC will be treated like a national court for the purpose of *lis pendens*, notwithstanding which of the courts – the UPC or the “normal” national court – has been seised first.<sup>2492</sup> Therefore the provisions of Articles 29 to 32 of the Brussels Ibis Regulation are not reviewed, but their application is merely extended to cover proceedings brought in the UPC.<sup>2493</sup>

But how to treat the constellation of two proceedings, both of them being brought before the UPC, whereas different divisions are invoked? Does Article 71c(1) of Regulation 542/2014 apply? Referring to the wording of Article 71c(1) of Regulation 542/2014, this provision does not cover that constellation. However, it could be argued that Articles 29 to 32 of the Brussels Ibis Regulation should be applied in the constellation of two actions brought before the UPC as well, because there is no adequate alternative solution.<sup>2494</sup> I respectfully disagree with this opinion, because in my view, the mutual relationship between several actions brought before the UPC, which affects the internal allocation of competence within the UPC, is a matter to be governed by the UPC Agreement, and not by the Brussels Ibis Regulation. It seems that rules such as Article 33(2) of the UPC Agreement provide for adequate solutions in this respect.<sup>2495</sup> Article 33(2) of the UPC Agreement reads as follows:

#### **Article 33(2) of the UPC Agreement**

(2) If an action referred to in Article 32(1)(a), (c), (f), (g) or (h) is pending before a division of the Court of First Instance, any action referred to in Article 32(1)(a), (c), (f), (g) or (h) between the same parties on the same patent may not be brought before any other division.

If an action referred to in Article 32(1)(a) is pending before a regional division and the infringement has occurred in the territories of three or more regional divisions, the regional division concerned shall, at the request of the defendant, refer the case to the central division.

In case an action between the same parties on the same patent is brought before several different divisions, the division first seized shall be competent for the whole case and any division seized later shall declare the action inadmissible in accordance with the Rules of Procedure.

Noteworthy, Article 71c(1) of Regulation 542/2014 only refers to Articles 29 to 32 of the Brussels Ibis Regulation, and does not mention Articles 33 and 34 of the Brussels Ibis Regulation. However, this should be dispensable, because Articles 33 and 34 of the Brussels Ibis Regulation concern *lis pendens* conflicts between Member States courts and third States courts, whereas both with regard to classical European patents and regarding European patents with unitary effect, such conflicts should not arise due to the principle of territoriality.<sup>2496</sup>

---

<sup>2492</sup> Mankowski (2014)11(6) GPR 330, at p. 339.

<sup>2493</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 872.

<sup>2494</sup> Mankowski (2014)11(6) GPR 330, at p. 339.

<sup>2495</sup> Likewise: De Miguel Asensio (2014)45(8) IIC 868, at p. 872; Luginbühl & Stauder (2014)63(10) GRUR Int. 885, at p. 891.

<sup>2496</sup> Mankowski (2014)11(6) GPR 330, at p. 340. In opposition to this evaluation, others have put forth that Articles 33 and 34 of the Brussels Ibis Regulation may be applicable to situations in which the jurisdiction of the UPC is based on Article 4 or on Articles 7 or 8 of the Brussels Ibis Regulation, cf. De Miguel Asensio (2014)45(8) IIC 868, at p. 873.



#### 4.4.2.4.2.5 Application of the rules on *lis pendens* and related actions in relation to the UPC and the national courts of Member States which are Contracting Parties to the UPC Agreement, during the transitional period (Article 71c(2) of Regulation 542/2014)

While the UPC will have exclusive jurisdiction also with regard to classical European patents after expiration of the transitional period of seven years from the entry into force of the UPC Agreement, Article 83(1) of the UPC Agreement provides that the UPC shall have only non-exclusive jurisdiction before the transitional period has expired. As a consequence, during the transitional period,<sup>2497</sup> an action for infringement or for revocation may still be brought before national courts of the Member States. Those courts have jurisdiction according to the rules of the Brussels Ibis Regulation. In particular, Article 24(4) of the Brussels Ibis Regulation is to be taken into account according to which national courts of the Member States have exclusive jurisdiction for revocation actions concerning European patents registered in that Member State. In light of the possibility of such parallel proceedings – before the UPC or before the “normal” national court of a Member State party to the UPC Agreement – it becomes obvious that an additional rule was required with regard to the relationship between the cited jurisdiction rules during the transitional period, in order to allow for the non-exclusive jurisdiction provided for in Article 83(1) of the UPC Agreement.<sup>2498</sup> Such a rule has been established by Article 71c(2).

#### Commission Proposal 2013

##### Article 71c

(...)

(2) Articles 29 to 32 shall apply where during the transitional period referred to in Article 83(1) of the UPC Agreement proceedings are brought in the Unified Patent Court and in a court of a Member State party to the UPC Agreement.

#### Regulation 542/2014

##### Article 71c

(...)

(2) Articles 29 to 32 shall apply where, during the transitional period referred to in Article 83 of the UPC Agreement, proceedings are brought in the Unified Patent Court and in a court of a Member State party to the UPC Agreement.

The establishment of Article 71c(2) is required because Article 83 of the UPC Agreement provides for a seven-year transitional period after the date of entry into force of the UPC Agreement during which an action for infringement or for revocation of a European patent may still be brought before the national courts or authorities. According to Article 71c(2) of Regulation 542/2014, the rules on *lis pendens* and related actions are applicable in this period regarding proceedings brought before the UPC and before a court of a Contracting Member State. As to the change of the text from Article 71c(2) of the Commission Proposal 2013 (“Article 83(1) of the UPC Agreement”) to Article 71c(2) of Regulation 542/2014 (“Article 83 of the UPC Agreement”), it is to be stated that the latter version is preferable because rules on the transitional period addressed in Article 71c(2) are contained in *all* paragraphs of Article 83 of the UPC Agreement.

As to the relationship between actions before the UPC and national courts during the transitional period, Article 71c(2) of the Commission Proposal 2013 contains a clarifying rule which has also been modified in Article 71c(2) of Regulation 542/2014. The European

<sup>2497</sup> After the transitional period has expired, Article 71c(2) of Regulation 542/2014 will have become obsolete, due to Article 32 of the UPC Agreement which will then confer exclusive jurisdiction to the UPC.

<sup>2498</sup> Peers (2011)7(2) E.C.L. Review 229, at p. 264.

legislator amended Article 71c(2) of the Commission Proposal 2013 in that Article 71c(2) of Regulation 542/2014 *not only* refers to Article 83(1) of the UPC Agreement – as does the Commission Proposal 2013 – but to *all* parts of Article 83 of the UPC Agreement.

With regard to actions for a declaration of non-infringement, it is noteworthy that Article 33(6) of the UPC Agreement provides:

**Article 33(6) of the UPC Agreement**

(6) An action for declaration of non-infringement as referred to in Article 32(1)(b) pending before the central division shall be stayed once an infringement action as referred to in Article 32(1)(a) between the same parties or between the holder of an exclusive licence and the party requesting a declaration of non-infringement relating to the same patent is brought before a local or regional division within three months of the date on which the action was initiated before the central division.

Article 33(6) of the UPC Agreement explicitly addresses the constellation that an action for a declaration of non-infringement is raised before the central division of the UPC. In this constellation, a *lis pendens* conflict cannot arise. If, on the other hand, an action for a negative declaration is raised before a national court of a Contracting State – which is possible during the transitional period – a *lis pendens* conflict can come into existence (cf. Article 71c(2) of Regulation 542/2014). In this respect, it has been rightly criticised that the European legislator has not solved the well-known torpedo problem.<sup>2499</sup>

**4.4.2.4.2.6 Operation of the rules on recognition and enforcement in relation between Member States which have ratified the UPC Agreement and the Member States that have not ratified the UPC Agreement**

In order to determine the regime of recognition and enforcement of judgments rendered, on the one hand, by courts of Member States that have ratified the UPC Agreement, and, on the other hand, courts of Member States which have not ratified that Agreement, the Commission proposed to implement Article 71d into the Brussels Ibis Regulation.<sup>2500</sup> The text of Article 71d of the Commission Proposal 2013 was (with minor changes regarding the wording) adopted as Article 71d of Regulation 542/2014. However, a clarifying sentence was added in Article 71d of Regulation 542/2014 regarding the recognition and enforcement of a judgment rendered by the UPC in another Contracting Member State. Article 71d of the Commission Proposal 2013 and Article 71d of Regulation 542/2014 read as follows:

---

<sup>2499</sup> Mankowski (2014)11(6) GPR 330, at p. 340.

<sup>2500</sup> De Miguel Asensio (2014)45(8) IIC 868, at p. 873.

**Article 71d**

In matters of recognition and enforcement, this Regulation shall apply to the recognition and enforcement of

(a) judgments given by the Unified Patent Court or the Benelux Court of Justice which need to be recognised and enforced in Member States which are not Contracting Parties to the UPC or Benelux Agreements; and

(b) judgments given by the courts of Member States which are not Contracting Parties to the UPC or Benelux Agreements which need to be recognised and enforced in Member States Contracting Parties to such Agreements.

**Article 71d**

This Regulation shall apply to the recognition and enforcement of:

(a) judgments given by a common court which are to be recognised and enforced in a Member State not party to the instrument establishing the common court; and

(b) judgments given by the courts of a Member State not party to the instrument establishing the common court which are to be recognised and enforced in a Member State party to that instrument.

However, where recognition and enforcement of a judgment given by a common court is sought in a Member State party to the instrument establishing the common court, any rules of that instrument on recognition and enforcement shall apply instead of the rules of this Regulation.

In formal respect, it is to be regretted that the European legislator did not properly subdivide the Article. At first glance, Article 71d seems to contain (a) and (b) which consists of two sentences. However, the content of the last sentence (“However, where recognition and enforcement (...) this Regulation”) obviously concerns not only (b), but Article 71d in total. Then it would have been logical – and helpful indeed for reasons of a better readability, to add (1) and (2) in front of the first sentence (“This Regulation shall apply to the recognition and enforcement of: (...)”) and the last sentence (“However, where recognition and enforcement (...) this Regulation”). It is to be hoped that a future reform of the Brussels Ibis Regulation will take this into consideration. For the sake of structural clarity, I will use this subdivision in the following paragraphs.

Article 71d has been constructed similarly to Article 71 of the Brussels Ibis Regulation with respect to other international conventions on particular matters, and Articles 64 and 67 of the 2007 Lugano Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters. Article 71(1)d(a) of Regulation 542/2014 ensures that judgments of the UPC are recognised and enforced, in non-Contracting Member States (i.e. those Member States which have not ratified the UPC Agreement), according to the rules of the Brussels Ibis Regulation. In this respect, decisions of the UPC are treated as decisions of national courts. This is a logical consequence<sup>2501</sup> of the fact that Member States which have ratified the UPC Agreement differ from non-Contracting Member States insofar as common courts such as the UPC are part of their judicial system. However, this does not impair their status as Member States. There would be no justification to recognise decisions of “normal”

<sup>2501</sup> The content of Article 71d(1) of Regulation 542/2014 is already implied in, respectively can already be derived from Article 71a of Regulation 542/2014. This has been rightly stated by Mankowski, cf. Mankowski (2014)11(6) GPR 330, at p. 341.

national courts, but to deny respectively impede recognition of decisions rendered by such common courts as the UPC.<sup>2502</sup>

*Vice versa*, Article 71d(1)(b) of Regulation 542/2014 clarifies that the regime of the Brussels Ibis Regulation applies to the recognition and enforcement of judgments rendered by the courts of a Member State which has not ratified the UPC Agreement, in a Contracting Member State. While this provision is not relevant as far as national courts in the Contracting Member States have jurisdiction for recognition and enforcement, the rule may gain relevance as far as the UPC should have jurisdiction for recognition and enforcement in Contracting Member States.

Due to the principle that a more specific provision precedes a general provision (*lex specialis-principle*), Article 71d(2) of Regulation 542/2014 stipulates that the UPC Agreement instead of the Brussels Ibis Regulation is applicable for recognition and enforcement of a judgment rendered by the UPC, where recognition and enforcement of such a judgment is sought in a Member State that has ratified the UPC Agreement. This applies even if the UPC Agreement provided less favourable recognition and enforcement rules than the Brussels Ibis Regulation.<sup>2503</sup> With regard to the recognition and enforcement of decisions of the UPC in Member States which have *not* ratified the UPC Agreement, the Brussels Ibis Regulation remains applicable, because then there is no more specific rule to be applied. The scope of Article 71d(2) of Regulation 542/2014 is in line with Recital 3 of Regulation 542/2014 which provides:

#### **Recital 3 of Regulation 542/2014**

It is necessary to regulate the relationship of Regulation (EU) No 1215/2012 with the UPC Agreement (...) by way of amendments to that Regulation.

Article 71d(2) of Regulation 542/2014 ensures the independence of the UPC Agreement beside the general rules of the Brussels Ibis Regulation, while adequately embedding it into the existing legal framework. This also means to strengthen the Brussels Ibis Regulation insofar as it is made clear that the Brussels Ibis Regulation keeps a well-defined scope of application.

#### **4.4.2.4.2.7 Conclusion**

On the basis of the foregoing paragraphs, it is to be stated that the European legislator, in principle, amended the Brussels Ibis Regulation (by creating Articles 71a to 71d) in such a way as to ensure compliance between the UPC Agreement and the Brussels Ibis Regulation. Minor further amendments concerning the wording and structure of the provisions which have been indicated above should however be undertaken.

---

<sup>2502</sup> Mankowski (2014)11(6) GPR 330, at p. 341: “(...) wäre ein nicht zu rechtfertigender Systembruch.”

<sup>2503</sup> Mankowski (2014)11(6) GPR 330, at p. 341.

#### 4.4.2.5 The UPC's democratic deficit

Moreover, it has been questioned whether the UPC is based on a sufficient democratic foundation. It has been underlined that, while the UPC Agreement has been submitted to the European Parliament, it has never been deliberated by it, because Member States have concluded the UPC Agreement as an international non-EU instrument.<sup>2504</sup> National parliaments will only have the possibility to ratify the UPC Agreement – or refuse it as a whole block, but will neither have the possibility to deliberate on the provisions of the Agreement, nor have the possibility to refuse parts of it.<sup>2505</sup> In light of this, it has been emphasised that the UPC Agreement constitutes “an instrument essentially made by the European and international patent communities themselves.”<sup>2506</sup> It seems unclear how this democratic deficit can be overcome.<sup>2507</sup> However, although this view cannot be totally dismissed, it is to be underlined that national parliaments at least have to ratify the UPC Agreement and thus have considerable influence on whether the UPC Agreement will enter into force.

#### 4.5 Final considerations

From an overall perspective, the creation of the UPC ultimately means the disempowering of national court systems, because patent litigation is entrusted into a new – and untested – court system. Its structure and its rules of procedure will constitute a compound of rules from various European jurisdictions with different legal traditions and background. It is noteworthy that the Rules of Procedure of the UPC will form the first code of civil procedure on a European level. It seems too early today to definitely determine whether the “patent package”, comprising the European patent with unitary effect and the Unified Patent Court will actually keep the promise of all the benefits that are praised by its advocates. In this respect, it seems appropriate to adopt a differentiated view. For large companies which need protection in all European jurisdictions, a European patent with unitary effect might be preferable, while national patents respectively classical European patents might be the cheaper alternative for others which only need patent protection for the territory of a limited number of Member States. The “patent package” will have to prove that the amount of annual fees to be paid is attractive enough in order to make holders of classical European patents change towards unitary patents,<sup>2508</sup> and that it significantly reduces the costs of protection and enforcement. Otherwise, the system will not be accepted by practitioners.<sup>2509</sup>

---

<sup>2504</sup> Ullrich (2015)46(1) IIC 1, at p. 4.

<sup>2505</sup> Ullrich (2015)46(1) IIC 1, at p. 4.

<sup>2506</sup> Ullrich (2015)46(1) IIC 1, at p. 4.

<sup>2507</sup> Cf. also Ullrich (2015)46(1) IIC 1, at p. 4: “Overcoming that democratic deficit will be the true challenge for the UPC.”

<sup>2508</sup> Luginbühl (2013)62(4) GRUR Int. 305, at p. 309.

<sup>2509</sup> Cf. Haberl & Schallmoser (2013)5(1) GRUR-Prax 1, at p. 4.

## CONCLUSION

## CONCLUSION

### I

As set out in the Introduction to this thesis, patent holders have to face multiple problems existing at different levels: international procedural law (in particular international jurisdiction), choice of law and substantive law. This thesis restricts itself to primarily treat procedural issues, in particular with regard to jurisdiction, when analysing existing problems concerning cross-border patent disputes according to the Brussels Ibis Regulation. However, it does not stop at this point, but, on the basis of the foregoing, considers existing reform proposals and finally delivers own formulation proposals which could (and should) be taken into account in the framework of a future recast of the Brussels Ibis Regulation.

### II

It is noteworthy that the existence of a patent system is generally recognised in both common law and civil law countries. However, there are significant differences. This becomes obvious as to the fundamental question of how the existence of patents is to be justified. While the most prominent rationale being developed under common law in order to justify a strong, effective patent system is the idea that the grant of patent monopolies effects *public benefits*, civil law rather tends to emphasise the protection of *private interests*.

As to different types of patents, it is noteworthy that, in Europe, a patentee may currently choose between a national patent and a European patent (these alternatives will be completed by the European patent with unitary effect, which is however not available yet), and both common law and civil law systems provide for the possibility to grant a patent on a product or on a process. This conception of a differentiation between product patents and process patents has also been adopted at the European level.

While there are differences concerning underlying conceptions, it is to be stressed that the principle of territoriality applies both in civil law and common law legal systems. In the framework of this thesis, the question arises which role is to be attributed to this principle with regard to the issue of international jurisdiction, i.e. whether courts should have jurisdiction to decide on the infringement of a foreign patent. While, for instance, English, French, Dutch and German courts initially held that they are not competent to decide on the infringement of a foreign patent, this attitude has significantly changed during the last decades. Even English courts have given up their negative attitude towards a decision in proceedings on the infringement of a foreign patent at least in relation to proceedings within the scope of the Brussels Convention (Brussels Ibis Regulation). Due to the fact that exclusive jurisdiction according to Article 24(4) of the Brussels Ibis Regulation (respectively its predecessors) merely affects validity actions, it can be concluded *a contrario* that infringement actions do not fall within the scope of exclusive jurisdiction. As a consequence, Member States courts may not deny international jurisdiction for infringement actions in case of the infringement of a foreign patent as far as the Brussels Ibis Regulation is applicable. The principle of territoriality, as a principle of substantive law, does not lead to another result, because it merely affects the substantive limitation of the patent, but does not determine in which State patent disputes are to take place.

### III

The Brussels Ibis Regulation applies regardless of which type of patent (national patent, European patent or (future) European patent with unitary effect) is concerned. Within the system of the Brussels Ibis Regulation, jurisdiction for patent infringement proceedings can always be based on Article 4(1) of the Brussels Ibis Regulation. Other eventual heads of jurisdiction for cross-border patent infringement proceedings are (on the assumption that the respective prerequisites are fulfilled) Articles 7(2) and 8(1) of the Brussels Ibis Regulation. In case that the defendant raises the defence of invalidity of the concerned patent, Article 24(4) of the Brussels Ibis Regulation determines that the courts of the protection State have exclusive jurisdiction with regard to a decision on the validity of the patent. Finally, concerning cross-border interim relief, Article 35 of the Brussels Ibis Regulation contains a specific provision.

### IV

As the *domicile of the defendant* constitutes the *decisive* factor in the jurisdiction system of the Brussels Ibis Regulation, Article 4(1) of the Brussels Ibis Regulation also applies to infringement actions concerning patents which are granted by and for non-Member States. Courts of the State where the domicile of the defendant is situated thus having international jurisdiction for patent infringement proceedings according to Article 4(1) of the Brussels Ibis Regulation, and it is to be underlined that this competence is comprehensive, meaning that the issue may be decided under consideration of all relevant aspects and concerning all actions.

### V

The infringement of a patent constitutes a tort according to Article 7(2) of the Brussels Ibis Regulation. With regard to an action for a negative declaration, it was discussed controversially by courts and legal commentators whether this type of action falls within the scope of Article 7(2) of the Brussels Ibis Regulation (respectively its predecessors), before the ECJ, in its *Folien Fischer* decision, ultimately decided it does. This result is convincing, because neither the wording nor the purpose of Article 7(2) of the Brussels Ibis Regulation justify a different treatment of an action for damages against the alleged infringer of a patent by the presumed victim on the one hand and an action for a declaration of non-infringement against the presumed victim by the alleged infringer on the other hand. Rather, the decisive factor for jurisdiction according to Article 7(2) of the Brussels Ibis Regulation is whether there is a particularly close connecting factor between the dispute and the deciding court. The previous question of whether Article 5(3) of the Brussels Convention is applicable to a preventive action for an injunction, was clarified by the European legislator, by extending the wording of the provision (“... or may occur”) which is also contained in Article 7(2) of the Brussels Ibis Regulation. Article 7(2) of the Brussels Ibis Regulation is however not applicable to competing contractual actions.

It has been discussed controversially whether courts outside the protection State can have jurisdiction with accordance to Article 7(2) in the case of patent infringement, i.e. whether Article 7(2) can serve as the legal basis for extraterritorial jurisdiction in patent infringement proceedings. According to the prevailing opinion in legal doctrine and case-law of the Member States, the place where the harmful event occurred or may occur is always situated in the State where the patent has been granted, having the effect that a choice according to the *Mines de Potasse* decision of the ECJ does not exist concerning patent infringement proceedings. Other legal scholars advocate the possibility of extraterritorial jurisdiction on the



basis of Article 7(2) also with regard to patent infringement proceedings. As to the question of whether an extraterritorial place of the event giving rise to the damage is conceivable, it is to be borne in mind that the principle of territoriality is a principle of substantive law. However, one might wonder whether this principle has also (indirect) effect on jurisdiction. The jurisprudence of the ECJ is not clear in this respect. In particular, the *Shevill* jurisprudence of the ECJ cannot be transferred *in toto* to the constellation of cross-border patent infringement cases. However, this result does not mean that certain findings of this jurisprudence – in particular with regard to the issue of the scope of cognition of the courts at the place of the event giving rise to the damage and at the place where the damage occurred may be relevant with regard to cross-border patent infringement cases. In the absence of a clear attitude of the ECJ regarding the question of whether the place of the event giving rise to the damage is to be determined independently from the *lex causae*, it is necessary to revert to general considerations and principles. On the basis of such an analysis, it is however to be stated that the principle of territoriality has neither a direct nor an indirect effect on the determination of the place of the event giving rise to the damage according to Article 7(2) of the Brussels Ibis Regulation. Consequently, the substantive principle of territoriality constitutes no obstacle against the existence of an extraterritorial place of the event giving rise to the damage pursuant to Article 7(2) of the Brussels Ibis Regulation. The existence of an extraterritorial place of the event giving rise to the damage according to Article 7(2) of the Brussels Ibis Regulation requires that the conditions of accountability and a particularly close connection between the infringing act and the invoked court are fulfilled. As to the possibility of an extraterritorial place of the event giving rise to the damage at the place of manufacture with regard to a European patent, a differentiation between product patents and process patents seems reasonable and justified. For, concerning product patents, the infringing acts of bringing into circulation, using, offering, importing and possessing of such products for the enumerated purposes constitute acts of patent infringement which are independent from the manufacture of the concerned object. The mere fact of manufacture of a product *as such* does not establish a particularly close connection that would be necessary for establishing jurisdiction pursuant to Article 7(2). In opposition, regarding process patents, an extraterritorial place of the event giving rise to the damage can exist at the place of manufacture if the concerned product is *directly (immediately)* manufactured through the protected process (cf. Article 64(2) of the EPC). This conception also takes into account the importance of the basic rule of Article 4(1) of the Brussels Ibis Regulation which implies that Article 7(2) of the Brussels Ibis Regulation as an exception of this rule must be interpreted restrictively.

In a number of recent decisions, the ECJ made clear that the mere fact that a tort – for instance the infringement of a patent – has been committed by several perpetrators, does not justify to ground international jurisdiction of a court in the State where one of the infringers acted according to Article 7(2), with regard to *all* infringers, but solely concerning the very infringer who actually acted in this State.

With regard to the question of whether an extraterritorial place where the damage occurred or may occur according to Article 7(2) of the Brussels Ibis Regulation is conceivable and where it could be situated, diverse conceptions have been developed. Due to the fact that the ECJ decided that only initial damage constitutes “damage” within the meaning of Article 7(2) of the Brussels Ibis Regulation, it is most convincing that only the place where the patent right has been infringed (“*Ort der Rechtsgutverletzung*”) is to be considered the place where the damage occurred according to Article 7(2) of the Brussels Ibis Regulation. Otherwise the clear differentiation between initial and consequential damage which has been purported by the ECJ would be disregarded.

Concerning the territorial scope of the authority to decide of a court pursuant to Article 7(2) of the Brussels Ibis Regulation, it is to be underlined that, although the *Shevill* decision of the ECJ is not applicable as such to the constellation of cross-border patent infringement proceedings, considerations made by the ECJ in this decision as to the territorial scope of authority to decide of the courts at the place of the event giving rise to the damage and at the place where the damage occurred can be transferred to that constellation. With regard to the place of the event giving rise to the damage, those in favour of a wide interpretation of the term “place of the event giving rise to the damage” according to Article 7(2) of the Brussels Ibis Regulation, who are of the opinion that the place of manufacture generally suffices to establish such a place of the event giving rise to the damage have – consistently – argued that a court at the place of manufacture can also decide on parallel infringements, i.e. also on infringements concerning patents granted for another State than the forum State, because all these infringements originate at the place of manufacture. According to this view, the acts of manufacture and bringing into circulation of the concerned products are actually part of the same uniform act. However, as already mentioned, a differentiation between product patents and process patents seems preferable. Only in the case of process patents, a court at the place of manufacture should also be authorised to decide on the infringement of parallel patents granted in respectively for the territory of another State than the forum State. Such authority to decide serves procedural economy, and – in case of a European patent – the common issue of the uniform determination of the extent of protection of the patent (Article 69 of the EPC) can be decided by one court. As to the place where the damage occurred, i.e. the place where the patent right is being infringed, the invoked court has only authority to decide on this very infringement whereas it does not have authority to decide on *parallel* infringements, i.e. infringement of patents granted in respectively for another State than the forum State.

## VI

With regard to Article 8(1) of the Brussels Ibis Regulation, the ECJ clarified, in *Ellen Mirjam Sapir*, the controversial issue of whether this provision is applicable vis-à-vis third State defendants by denying this question.

In *Roche Nederland*, the ECJ set up strict prerequisites for the existence of a “close connection”. In its *Solvay* decision, the ECJ however attenuated its restrictive jurisprudence developed in *Roche Nederland*. As a consequence, constellations are still conceivable in which consolidation according to Article 8(1) is possible. Despite certain deficiencies and uncertainties with regard to the reasoning of the ECJ in its *Solvay* decision, it can be assumed that regarding the infringement of European patents through the same product in the same States by several companies having their seat in different States, there is the same situation of fact and of law, which may lead to irreconcilable judgments if several courts render a decision. As a consequence, Article 8(1) of the Brussels Ibis Regulation principally applies in this constellation. Beyond the constellation considered by the ECJ in *Solvay*, certain further constellations are and remain conceivable where consolidation of actions against several infringers with regard to cross-border patent infringements can be based on Article 8(1) of the Brussels Ibis Regulation.

## VII

As to Article 24(4) of the Brussels Ibis Regulation (respectively its predecessors), the question of what effect the raise of the defence of invalidity of a patent in infringement proceedings has was answered differently. In its *GAT* decision, the ECJ made clear that Article 16(4) of the Brussels Convention (Article 24(4) of the Brussels Ibis Regulation) is to

be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection.

Regarding the question of whether Article 24(4) of the Brussels Ibis Regulation is applicable in case of patents granted by respectively for a third State, parts of legal doctrine have advocated a *reflexive application*. As there are good reasons not to follow this approach, and also in light of the fact that the European legislator when recasting the Brussels I Regulation did not allocate reflexive effect to Article 24(4) of the Brussels Ibis Regulation, the conception of such a reflexive effect is to be rejected.

With regard to requirements concerning a defence of invalidity, it is to be underlined that Article 24(4) of the Brussels Ibis Regulation is applicable regardless of the defence of invalidity of a patent raised in infringement proceedings is admissible. Further, Article 24(4) of the Brussels Ibis Regulation is applicable regardless of the fact of whether, in the course of patent infringement proceedings, the defence of invalidity of the concerned patent is raised before the courts having jurisdiction for such infringement proceedings. However, the defence must then be raised in a sufficiently substantiated way before the courts having jurisdiction according to Article 24(4). While there are no immediate temporal restrictions within the provisions of the Brussels Ibis Regulation, provisions of national procedural law, constituting the *lex fori*, determine whether such a defence is precluded. As to the question of whether the defence of invalidity of the patent is precluded if the defendant acts in bad faith, it is generally doubtful if subjective criteria should be taken into account. Therefore, in principle, only objective criteria should be taken into consideration. A defence of invalidity of a patent is to be taken into consideration once it has been raised, regardless of the question if it is obviously unfounded.

Once an invalidity defence has been raised in infringement proceedings, the question arises which are the concrete effects on the infringement proceedings. On the basis of a deepened analysis, it is to be stated that the infringement court does not have to completely transfer the case to a court having jurisdiction according to Article 24(4) of the Brussels Ibis Regulation. Where the validity issue is raised by the defendant, the infringement court may not, without any exceptions, simply assume that the concerned patent exists and is valid either. The infringement court rather has to stay infringement proceedings until the validity issue has been decided by a competent court. As the Brussels Ibis Regulation does not contain a provision which can serve as legal basis for such a stay, a stay of infringement proceedings in this constellation is to be based on provisions of national procedural law of the Member States.

Comparably to the situation with regard to the Community trade mark, the determination of the length of the term until counter-proceedings should be open to the discretion of the court where infringement proceedings have been instituted. Additionally, the defendant, instead of instituting invalidity/nullity proceedings, may also institute, given the period for objection is still running, revocation proceedings before the competent national authorities or opposition proceedings. With regard to a European patent, initiating opposition proceedings before the European patent office will also effect that infringement proceedings are stayed.

In case of several defendants, each defendant must, in principle, institute counter-proceedings *in persona*, due to the procedural autonomy of each defendant. Nonetheless, the court before which infringement proceedings have been initiated *is not prevented* from staying the infringement proceedings also with regard to another defendant if one defendant has instituted

counter-proceedings, if this complies with the national procedural rules of the *lex fori*. However, the court is *not forced* to stay infringement proceedings as to the other defendant in this situation.

When a nullity/invalidity defence has been raised, the infringement court must stay proceedings. However, upon the claimant's request, proceedings are to be completely transferred to the courts being competent pursuant Article 24(4), while the defendant cannot influence the place of jurisdiction by raising the invalidity defence.

## VIII

As quick relief is essential, provisional measures are of utmost importance in particular with regard to intellectual property litigation. IP rights holders are in general primarily interested in stopping the allegedly infringing activities and only then considering what other remedies should be sought.

According to the system of the Brussels Ibis Regulation, interim relief can be based on two different bases. On the one hand, courts which have jurisdiction on the merits also have *accessory* jurisdiction to order provisional measures. Besides, Article 35 of the Brussels Ibis Regulation provides for an autonomous head of jurisdiction for provisional measures. The plaintiff may freely choose between those jurisdiction. Courts having jurisdiction according to Articles 4 or 7 to 26 of the Brussels Ibis Regulation remain competent to decide on provisional measures regardless of whether principal proceedings have been initiated before another court according to the Brussels Ibis Regulation.

In the meanwhile, the European legislator codified, in Article 2(a) of the Brussels Ibis Regulation, the jurisprudence of the ECJ in *Denilauler*, according to which a provisional measure rendered in favour of a patent holder could only be recognised and enforced in another Member State if the alleged infringer had been granted the right to a hearing. By creating Article 45(1)(c) and (d) and Article 2(a) of the Brussels Ibis Regulation, the European legislator further codified (and restrictively modified) the jurisprudence of the ECJ in *Italian Leather*, clarifying that Article 45(1)(c) and (d) of the Brussels Ibis Regulation is (only) applicable to such provisional measures ordered by a court having accessory jurisdiction for provisional measures. In contrast, provisional measures ordered by a court on the basis of independent jurisdiction for provisional measures do not constitute a “judgment” within the meaning of Article 45 of the Brussels Ibis Regulation (cf. Article 2(a) of the Brussels Ibis Regulation), meaning that Article 45 of the Brussels Ibis Regulation is not applicable in the latter constellation.

The Brussels Ibis Regulation does not establish a general positive definition of “provisional, including protective, measures”. Case-law, especially jurisprudence produced by the ECJ, is therefore important to determine which measures are to be considered as provisional measures within the meaning of Article 35 of the Brussels Ibis Regulation. As to evidence orders, such interim measures to obtain or secure evidence may constitute measures according to Article 35 of the Brussels Ibis Regulation if their purpose is to preserve evidence to be employed in principal proceedings, i.e. if they shall prevent the loss of that evidence in order to enforce a claim in principal proceedings respectively enforce such claim without considerable delay.

As Article 35 of the Brussels Ibis Regulation (respectively its predecessors) is formulated in a broad way, the ECJ suggested, in its *Denilauler* decision, the necessity of a geographical link between the deciding court and the assets affected provisional measures. The problem

however consists in determining the specific meaning of such a “real connecting link”. In this respect, it is proposed to differentiate between different types of provisional measures. Regarding interim injunctions, the courts of the State should be considered competent according to Article 35 where the defendant disposes of sufficient assets that the interim injunction to omit can be enforced. Besides, courts of the State where the patent has been granted are *also* competent pursuant to Article 35. With regard to interim performance orders concerning the restitution, the recall or the destruction of concrete objects infringing the concerned patent, it would seem most effective in matters of enforcement to refer to the State where these objects are situated. Also concerning evidence orders, the decisive question is whether the concerned measure is enforceable in the forum State. A court outside the protection State may not order provisional measures to obtain or secure evidence to be enforced in another State than the forum State, be it the protection State or any other State.

Structurally, the question of whether rejecting an application for a cross-border provisional measure for the reason that the court is of the opinion that there is no sufficient claim or ground to grant the measure, constitutes a matter of foundedness rather than a question of admissibility. As a consequence, legal or factual complexity of cases has no effect on the question of whether courts have jurisdiction to order provisional measures pursuant to Article 35 of the Brussels Ibis Regulation.

Comprehensive jurisdiction pursuant to Article 35 of the Brussels Ibis Regulation under the condition that the provisional measure it is actually possible that the provisional measure is enforceable in the forum State is not contradictory to the more restricted scope of jurisdiction according to Article 7(2) of the Brussels Ibis Regulation to order provisional measures, which is limited to the State where the patent was granted. A different treatment of these grounds of jurisdiction is justified, because the fact that courts which are competent according to Articles 7 to 26 of the Brussels Ibis Regulation can also order provisional measures, is based on the circumstance that Articles 7 to 26 *per se* imply a sufficient *factual proximity* between the measure and the deciding court. In the case of jurisdiction according to Article 35 of the Brussels Ibis Regulation of courts of a State where the provisional measure shall be enforced, such a *factual proximity* is only established by the fact that the provisional measure can be respectively is to be enforced in the forum State. On the basis of the emphasis of the *factual proximity*, it is then logical to refer to that criterion also with regard to the scope of jurisdiction. Due to the principle of territoriality, jurisdiction based on Article 7(2) of the Brussels Ibis Regulation is restricted to the courts of the State where respectively for which territory a patent has been granted, meaning that multiple infringing actings in different States must be treated independently. In this respect, there is no inner link between patent infringements in different States. In contrast to this situation, jurisdiction according to Article 35 of the Brussels Ibis Regulation with regard to courts of a State where the provisional measure shall be enforced, is not limited by the principle of territoriality, but by the different conditions of enforceability of the provisional measure. Courts of States where provisional measures can be enforced fulfil the requirement of such a link, i.e. a “real connecting link” as demanded by the ECJ. Besides, the broader scope of jurisdiction with regard to Article 35 of the Brussels Ibis Regulation is also justified by the fact that not all provisional measures may be ordered on the basis of Article 35 of the Brussels Ibis Regulation.

Where the defence of invalidity of a patent is raised in provisional proceedings, the question arises of whether Article 24(4) of the Brussels Ibis Regulation applies, with the consequence that the court before which provisional proceedings have been initiated must stay proceedings. While the ECJ expressly clarified in its *Solvay* case that Article 24(4) of the Brussels Ibis Regulation (respectively its predecessor) does not apply to provisional proceedings based on

Article 35 of the Brussels Ibis Regulation (respectively its predecessor), the court has not decided if the same applies in case of accessory jurisdiction for provisional measures. On the basis of an analysis of the different conceptions, it is submitted that the better reasons militate for the inapplicability of Article 24(4) of the Brussels Ibis Regulation also in this situation.

## IX

When considering a reform of the problematic issues in the framework of the Brussels Ibis Regulation analysed in this thesis, it is worthwhile to take into account existing reform projects. In particular, the ALI Principles and the CLIP Principles deliver a valuable incitation and source of inspiration in which way problems within the Brussels Ibis Regulation might be solved.

On the basis of a deepened analysis, it is to be stressed that neither considerations concerning the “*Gleichlauf*” between jurisdiction and the applicable substantive law, sovereignty of the granting State, court or party interests, judicial economy, the attempt to find a mediate solution for the torpedo problem, nor any other aspects are apt to justify to confer exclusive jurisdiction to the courts of the protection State for patent infringement proceedings. Patent infringement proceedings should rather be and remain subject to the general rules of jurisdiction. Besides rejecting any attempts to extend exclusive jurisdiction of the courts of the granting State to infringement proceedings, this also means that approaches according to which the courts of the granting State should be given exclusive jurisdiction for validity and non-exclusive jurisdiction for infringement, or, conversely, pursuant to which the courts with jurisdiction over infringement should be conferred an additional jurisdiction over validity, should not be pursued, because they vary from those general rules of jurisdiction laid down in the Brussels Ibis Regulation. With regard to an eventual future Global Judgments Convention, there is no reason for a deviation from this approach.

## X

As to jurisdiction regarding torts, the crucial question arising in cross-border (patent infringement) disputes is whether respectively under which circumstances extraterritorial jurisdiction is conceivable. On the basis of an analysis of relevant proposals contained in the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), the ALI Principles, the CLIP Principles, the Heidelberg Report on the Application of Regulation Brussels I (Heidelberg Report) and the Commission Proposal 2010 for Reform of the Brussels I Regulation (Commission Proposal 2010), I propose the following amendment of Article 7(2) of the Brussels Ibis Regulation which also takes into consideration the particular problem of tortious jurisdiction regarding multistate delicts and contains explicit rules regarding the territorial scope of a court’s authority to decide:

### Article 7(2)

A person domiciled in a Member State may, in another Member State, be sued:

(...)

(2) in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur. *As to the infringement of a patent, the harmful event solely occurs or may occur in the State where the patent is protected.* A court shall have jurisdiction in respect of infringements that occur or may occur within the territory of the State in which that court is situated. In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court shall also have jurisdiction in respect of infringements that occur or may occur within the territory of any other State,

provided that the activities giving rise to the infringement have no substantial effect in the State, or any of the States, where the infringer is domiciled and

(a) substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the State in which the court is situated, or

(b) the harm caused by the infringement in the State where the court is situated is substantial in relation to the infringement in its entirety.

An eventual future Global Judgments Convention should be considerably oriented towards Articles 2:202 (also supplemented by another sentence, written in italics) and 2:203 of the CLIP Principles. It would remain to be decided whether the wording “habitually resident” (cf. CLIP Principles) or “domiciled” (cf. Brussels Ibis Regulation) would be chosen. The provisions could be formulated as follows:

#### **Article 2:202: Infringement**

In disputes concerned with infringement of an intellectual property right, a person may be sued in the courts of the State where the alleged infringement occurs or may occur, unless the alleged infringer has not acted in that State to initiate or further the infringement and her/his activity cannot reasonably be seen as having been directed to that State. *As to the infringement of a patent, the infringement solely occurs or may occur in the State where the patent is protected.*

#### **Article 2:203: Extent of jurisdiction over infringement claims**

(1) Subject to paragraph 2, a court whose jurisdiction is based on Article 2:202 shall have jurisdiction in respect of infringements that occur or may occur within the territory of the State in which that court is situated.

(2) In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court whose jurisdiction is based on Article 2:202 shall also have jurisdiction in respect of infringements that occur or may occur within the territory of any other State, provided that the activities giving rise to the infringement have no substantial effect in the State, or any of the States, where the infringer is habitually resident [domiciled] and

(a) substantial activities in furtherance of the infringement in its entirety have been carried out within the territory of the State in which the court is situated, or

(b) the harm caused by the infringement in the State where the court is situated is substantial in relation to the infringement in its entirety.

## **XI**

An amendment of Article 8(1) of the Brussels Ibis Regulation should, in particular, clarify without any doubt in which circumstances infringement actions concerning the alleged infringement of different parts of a European patent (i.e. parallel European patents) are sufficiently closely connected so that the courts at the place of domicile of one infringer also have jurisdiction with regard to the other action(s) which concern patents granted within respectively for the territory of other States, where the patents are being infringed by different infringers. To put it in a nutshell, the criterion of the risk of irreconcilable judgments which is addressed in Article 8(1) of the Brussels Ibis Regulation should be rendered more precisely, since the fact that this criterion can currently be interpreted in various ways produces legal uncertainty. Likewise, an eventual future Global Judgments Convention should contain a

similar provision which clearly covers parallel patent infringement actions. On the basis of an analysis of relevant proposals contained in the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), the ALI Principles, the CLIP Principles, the Heidelberg Report and the Commission Proposal 2010, I propose to amend the content of Article 8(1) of the Brussels Ibis Regulation as follows, creating a new Article (hereinafter Article 8bis) for convenience, in order not to overburden Article 8(1) of the Brussels Ibis Regulation:

#### **Article 8bis**

(1) A person domiciled in a Member State may also be sued, where he is one of a number of defendants, in the courts for the place where any one of them is *domiciled*, provided the claims 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.

(2) For the purposes of paragraph 1, a risk of irreconcilable judgments requires a risk of divergence in the outcome of the actions against the different defendants which arises in the context of essentially the same situation of law and fact. In particular in infringement disputes and subject to the individual circumstances of the case,

(a) disputes involve essentially the same factual situation if the defendants have, even if in different States, acted in an identical or similar manner in accordance with a common policy;

(b) disputes may involve essentially the same legal situation even if different national laws are applicable to the claims against the different defendants, provided that the relevant national laws are harmonised to a significant degree by rules of a regional economic integration organisation or by international conventions which are applicable to the disputes in question.

(3) If it is manifest from the facts that one defendant has coordinated the relevant activities or is otherwise most closely connected with the dispute in its entirety, jurisdiction according to paragraph 1 is only conferred on the courts in the State where that defendant is domiciled. In other cases, jurisdiction is conferred on the courts in the State or States of domicile of any of the defendants, unless

(a) the contribution of the defendant who is domiciled in the State where the court is located is insubstantial in relation to the dispute in its entirety or

(b) the claim against the domiciled defendant is manifestly inadmissible.

(c) *the claim against the domiciled defendant is manifestly unfounded.*

With regard to an eventual future Global Judgments Convention, the content of § 206 of the CLIP Principles should be adopted.

## **XII**

With regard to an amendment of exclusive jurisdiction according to Article 24(4) of the Brussels Ibis Regulation, it is to be stated that the extraterritorial infringement court should have authority to render an incidental decision on the validity of a patent concerned in patent infringement proceedings brought before that court.

For the sake of legal certainty, it seems indispensable to integrate a definition of the constellation in which circumstances the validity issue is raised as an incidental matter, i.e. by way of a preliminary question. Thus, in order to avoid the risk of inconsistent interpretations in the EU Member States (respectively third States), the term “preliminary question” should



be expressly defined in the Brussels Ibis Regulation (respectively an eventual future Global Judgments Convention). On the basis of an analysis of conceivable possibilities regarding the effect of an incidental decision of an extraterritorial infringement court on the validity of a patent, solely a conception according to which such an incidental decision on the validity of a patent has *inter partes* effect, and not *erga omnes* effect, seems to be justified and feasible in practice, and should therefore be envisaged and pursued.

The extraterritorial infringement court should not be given the possibility to stay the infringement proceeding, as an alternative for rendering an incidental decision, for the sole reason that a defence of invalidity of the concerned patent has been raised. However, a stay of the infringement proceeding should be possible according to and in the framework of the general rules of jurisdiction provided for in the Brussels Ibis Regulation. With accordance to the national procedural rules as to the stay of proceedings applicable in EU Member States, it would be necessary that a proceeding on the validity of the patent has already been initiated, and that there is a sufficient chance that that proceeding will be successful which must be evaluated by the infringement court which stays the infringement proceeding. However, while national procedural laws may imply, as a prerequisite of a stay of proceedings, formal requirements such as “serious doubts” as to the validity of the patent, such formal restrictions should not be integrated in an amended version of the Brussels Ibis Regulation, respectively an eventual future Global Judgments Convention. For it is conceivable that an extraterritorial, unspecialised infringement court does not have any “serious doubts” regarding the validity of the patent, but wants to stay the infringement proceeding because of the complexity and difficulty of the matter. The criteria for a stay thus cannot be defined *a priori* but should be in the discretion of the infringement court. Besides, although such “serious doubts” can be the reason for staying the infringement proceeding, the infringement court, in this situation, is convinced of the invalidity of the patent and should therefore render a decision, because it is highly probable that the patent will be declared void in a subsequent invalidity proceeding with effect *ex tunc*.

Article 30 of the Brussels Ibis Regulation which may become relevant in case that validity proceedings have been initiated before infringement proceedings, should be complemented by an additional rule which clarifies which factors should be taken into consideration by the court which has to determine whether to stay proceedings, in order to ensure legal certainty and conformity of legal practice within the EU Member States.

Moreover, a provision should be integrated in the Brussels Ibis Regulation which provides that the infringement court *may* stay infringement proceedings in case that an *invalidity action* is brought subsequently, i.e. at a point in time when infringement proceedings have already been initiated.

In the case of patent infringement proceedings pending before an extraterritorial infringement court, and invalidity proceedings, concerning the same patent, before the courts of the granting State, be it that those validity proceedings have been brought before or after the infringement action has been initiated, it appears that the sole existence of rules as to a stay of proceedings does not suffice in order to take into adequate consideration the parties' interests and also the general aspect of judicial economy. Rather, rules are required as to establish in which way involved courts shall cooperate with each other in such simultaneously pending multistate proceedings. An amended version of the Brussels Ibis Regulation – and also an eventual future Global Judgments Convention – should therefore imply such rules.

Regarding the exclusion of recognition of infringement decisions respectively non-infringement decisions, if, in the meanwhile, a court or an authority in the granting State declared the patent to be void, this decision having *erga omnes* and *ex tunc* effect, Article 45(1)(c) of the Brussels Ibis Regulation is applicable.

Conferring jurisdiction to an extraterritorial infringement court to decide, by way of an incidental decision with *inter partes* effect, on the validity of a patent, bears the risk that, after the infringement court has made such a decision on the validity of the patent, a court of the granting State subsequently renders a contrary decision, which is in principle possible due to the *inter partes* effect of the infringement decision. This problem can occur in two constellations. First, it is conceivable that the infringement court convicts an alleged infringer for patent infringement, but this patent is declared void in a later proceeding by a court of the granting State. On the other hand, it is possible that the infringement court dismisses the infringement action because it holds the patent to be void, while a court of the granting State subsequently decides that the concerned patent is valid. In both constellations, *res iudicata* of the incidental decision of the infringement court seised first would *not* be opposed to a later decision on the validity of the patent, with *erga omnes* effect, rendered by the courts of the granting State. Noteworthy, the risk of contradictory decisions does not only exist with regard to cross-border patent infringement proceedings, aroused by the possibility of incidental decisions on the validity of a patent rendered by an extraterritorial infringement court, but also exists at the national level both in States which have established a “*Trennungssystem*” (where the validity and the infringement of a patent are principally examined by different courts), and those which employ a “*Verbundsystem*” (where the courts having jurisdiction to decide on the infringement of a patent may also decide on its validity). In light of the fact that national law also admits the risk of irreconcilable judgments, it is to be underlined that it is not the *specific task* of international procedural law (as according to the Brussels Ibis Regulation) to avoid such dissonant decisions, but that this problem is to be solved according to the applicable provisions of national law. Consequently, a potential provision on the possibility of bringing an action for restitution respectively damages in case that the decision of the extraterritorial infringement court on the validity of the patent (with *inter partes* effect) is overruled as to the validity issue by a later decision on the validity of the patent, rendered by the courts of the granting State (with *erga omnes* effect), should not be integrated in the Brussels Ibis Regulation. Similarly, such a provision should not become part of an eventual future Global Judgments Convention. However, the jurisdiction rules of the Brussels Ibis Regulation can at least *contribute* to avoid opposing judgments in the sense of a *general goal*. In this respect, the infringement court should have the *possibility* to stay the infringement proceeding in case that a proceeding on the validity of the concerned patent has already been initiated before a court of the granting State. Besides, international procedural law is affected if an infringement decision shall be recognised and enforced in another State, while the patent has been declared void in the meanwhile with *erga omnes* and *ex tunc* effect. It is at least a *general goal* of international procedural law to avoid the circulation of such opposing decisions in the protection State, and also in other States, because the underlying reason is not the protection of the sovereignty of the granting State, but the consideration of the defendant’s interests who has been wrongly convicted. While the defendant’s interests are adequately taken into consideration and protected by the possibility that the infringement court may stay the infringement proceeding if a invalidity proceeding has been initiated before the courts of the protection State, it would go too far to confer to the defendant the possibility to wait for the result of the infringement proceeding and, if he was convicted by the infringement court, to initiate an invalidity proceeding in the protection State. As far as the infringement court does not stay the infringement proceeding and, after enforcement has already been undertaken, the patent is declared void by the courts of the protecting State, this

situation does not differ from comparable situations occurring in pure national cases without any cross-border context. Accordingly, the Brussels Ibis Recognition does not and should not contain respective rules, but eventual chances of restitution are and should be governed by provisions of national law. The same should apply with regard to the creation of an eventual future Global Judgments Convention.

Exclusive jurisdiction regarding the issue of validity of a patent should thus be constructed in a way which does not exclude extraterritorial courts invoked in patent infringement proceedings from examining the validity of the concerned patent by way of an incidental decision which has *inter partes* effect. The mere fact that a defence of invalidity has been raised should not establish the possibility for the infringement court to stay the infringement proceeding, whereas a stay according to general rules of the Brussels Ibis Regulation should be possible in case that a validity proceeding has already been initiated in the granting State.

Both the possibility to defend against the enforcement of a decision on the infringement of a patent which is subsequently declared void with *erga omnes* and *ex tunc* effect, and the possibility to gain restitution after enforcement, are governed by the rules of national procedural law, if only one State is affected. The Brussels Ibis Regulation is not applicable to solve this issue. In contrast, the Brussels Ibis Regulation applies to the avoidance of cross-border recognition and enforcement of (non-)infringement decisions which subsequently become unjustified because the concerned patent is held valid/void with *erga omnes* and *ex tunc* effect by a court of the granting State.

On the basis of an analysis of relevant proposals contained in the Hague Convention on Choice of Court Agreements (2005), Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), the ALI Principles, the CLIP Principles, the Heidelberg Report and the Commission Proposal 2010, I propose the following amendment of Article 24(4) of the Brussels Ibis Regulation:

### **Exclusive jurisdiction**

#### **Article 24**

The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties:

(...)

(4) in proceedings having as their object a judgment on the grant, registration, validity, abandonment or revocation of a patent, a mark, an industrial design or any other intellectual property right protected on the basis of deposit or registration, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction in proceedings having as their object a judgment on the grant, registration, validity, abandonment or revocation of any European patent granted for that Member State.

*Sentences 1 and 2 do not apply where validity or registration arises in a context other than by principal claim or counterclaim.* The decisions resulting from such proceedings do not affect the validity or registration of those rights as against third parties.

Where a court of a Member State is seised of a claim which has as its object a matter over which the courts of another Member State have exclusive jurisdiction by virtue of sentences 1 and 2, it shall declare of its own motion that it has no jurisdiction.

The content of Article 2:702(2) of the CLIP Principles should be integrated in Article 30 of the Brussels Ibis Regulation. Moreover, the content of Articles 2:703 and 2:704 of the CLIP Principles should be integrated in the Brussels Ibis Regulation. In this respect, one should preferably integrate the content of the complete Section 7 of the CLIP Principles in Chapter II of the Brussels Ibis Regulation which would also ensure the internal balance of these provisions. As Article 4:501(3) of the CLIP Principles corresponds to Article 45(1)(c) of the Brussels Ibis Regulation, the latter provision should be left untouched. With regard to an eventual future Global Judgments Convention, the content of all provisions of the CLIP Principles discussed in the framework of this chapter should be adopted.<sup>2510</sup>

### XIII

With regard to an amendment of the provisions of the Brussels Ibis Regulation concerning interim relief, a conception according to which jurisdiction to grant interim relief should be reserved to the courts of the State where the concerned patent has been granted is to be rejected. On the contrary, like regarding provisional proceedings in other fields of law, provisional proceedings in patent matters should be subject to the jurisdiction rules concerning interim relief of the Brussels Ibis Regulation (respectively a future Global Judgments Convention), and there should be no specific rule with regard to interim relief in patent matters which determines that only the courts of the protection State have jurisdiction for provisional measures in patent disputes.

For reasons of clarity and legal certainty, the current system under the Brussels Ibis Regulation providing for both accessory and independent jurisdiction for provisional measures should be *expressly* codified within the text of the Brussels Ibis Regulation. Similarly, an eventual future Global Judgments Convention should contain such a clarifying provision.

Under the current regime of the Brussels Ibis Regulation, the requirements for accessory jurisdiction for the grant of provisional measures have partly been defined by the ECJ in several decisions. In order to strengthen legal certainty and clarity, it seems desirable to integrate these judicial findings in the text of the Brussels Ibis Regulation, and also in the text of an eventual future Global Judgments Convention.

For reasons of clarity and thus legal certainty, a definition of the real connecting link-criterion should be included in the text of the Brussels Ibis Regulation. The same goes for an eventual future Global Judgments Convention.

Moreover, it seems preferable to codify within the Articles of the Brussels Ibis Regulation (for instance in Article 35), which measures are to be considered “provisional, including protective, measures” according to the Brussels Ibis Regulation. Likewise, an eventual future Global Judgments Convention should explicitly define provisional measures.

Comparably to the codification (and modification), in Articles 2(a) and 42(2)(c) and 45(1)(b) of the Brussels Ibis Regulation, of the jurisprudence of the ECJ in *Denilauler*, a comparable set of rules (i.e. rules excluding *ex parte*-decisions from being recognised and enforced,

---

<sup>2510</sup> The exact wording and choice of provisions of such an eventual future Global Judgments Convention would depend on its envisaged scope. If required, the whole complex of provisions of the CLIP Principles could be adopted to establish a complete set of rules. In any case, the provisions proposed in this thesis, corresponding to those provisions proposed for an amended version of the Brussels Ibis Regulation, should be considered as a minimum set of rules.

unless the judgment containing the measure is served on the defendant prior to enforcement) should also form part of an eventual future Global Judgments Convention.

In order to mitigate the danger of irreconcilable decisions in preliminary proceedings, an amended version of the Brussels Ibis Regulation should further imply definite rules with regard to the coordination of several, including preliminary, proceedings. The same goes for an eventual future Global Judgments Convention.

An eventual future Global Judgments Convention should contain provisions which are comparable to Article 45(1)(c) and (d) and Article 2(a) of the Brussels Ibis Regulation, where the European legislator codified (and restrictively modified) the jurisprudence of the ECJ in *Italian Leather*, clarifying that Article 45(1)(c) and (d) of the Brussels Ibis Regulation is (only) applicable to such provisional measures ordered by a court having accessory jurisdiction for provisional measures. As a consequence, provisional measures ordered by a court on the basis of independent, i.e. non-accessory, jurisdiction do not constitute a “judgment” within the meaning of Article 45 of the Brussels Ibis Regulation (cf. Article 2(a) of the Brussels Ibis Regulation), meaning that Article 45 of the Brussels Ibis Regulation is not applicable in the latter constellation.

In particular with regard to provisional measures, the laws of the Member States differ to a considerable extent. This fact seems to be the actual reason why only orders of provisional measures based on accessory jurisdiction, i.e. excluding provisional measures based on independent jurisdiction, are considered as judgments within the meaning of the Regulation's provisions of recognition and enforcement, and are consequently conferred effect also in other Member States. In light of this, a conception which is merely based on the enforcement criterion with the consequence that provisional measures should have *a priori* effect in another Member State given that such measures are enforceable in that State is not convincing. Therefore, Article 2(a) of the Brussels Ibis Regulation should be maintained.

With regard to the issue of which effect should be allocated to an invalidity defence in provisional proceedings, i.e. in which way, if any, Article 24(4) of the Brussels Ibis Regulation is considered applicable, I have *inter alia* explicated in the framework of a proposal for a reformulation of Article 24(4) of the Brussels Ibis Regulation:

Sentences 1 and 2 do not apply where validity or registration arises in a context other than by principal claim or counterclaim. The decisions resulting from such disputes do not affect the validity or registration of those rights as against third parties.

This formulation also comprises the situation where an invalidity defence is raised in provisional proceedings, having the equal effect that the rules of exclusive jurisdiction do not apply. Therefore, a further mentioning in the framework of Article 35 of the Brussels Ibis Regulation is not required.

Compared with Articles 7(2), 8(1) and 24(4) of the Brussels Ibis Regulation, Article 35 of the Brussels Ibis Regulation has already established considerable amendments in comparison with the legal situation under the Brussels Convention respectively the Brussels I Regulation, by codifying crucial jurisprudence of the ECJ in the text of the Brussels Ibis Regulation.

On the basis of an analysis of relevant proposals contained in the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), the ALI Principles, the CLIP Principles, the Heidelberg Report and the Commission Proposal 2010, I propose the following amendment of Article 35 of the Brussels Ibis Regulation:

## **Provisional, including protective, measures**

### **Article 35**

(1) A court having jurisdiction as to the substance of a matter also has jurisdiction to order any provisional, including protective, measures.

(2) Provisional, including protective, measures may also be ordered by the courts of a Member State

(a) where the measure is to be enforced, or

(b) for which protection is sought.

(3) Provisional, including protective, measures are measures which are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case. Such measures may include

(a) orders to prevent an (imminent or continuing) infringement of an intellectual property right from occurring;

(b) orders to preserve relevant evidence in regard to the alleged infringement;

(c) orders to seize goods suspected of infringing an intellectual property right;

(d) orders to seize, attach or prevent the dissipation or removal from the jurisdiction of assets to safeguard enforcement of the judgment on the merits;  
and

(e) orders directing a party to provide information about the location of assets which are subject of an order under lit. (d).

Article 2(a) and Article 45(1)(c) and (d) of the Brussels Ibis Regulation should apply. With regard to Articles 2:705 and 2:704 of the CLIP Principles, equally clear provisions should be integrated in the Brussels Ibis Regulation. As has already been proposed above in the framework of exclusive jurisdiction, a clear solution would be to integrate the content of the complete Section 7 of the CLIP Principles in Chapter II of the Brussels Ibis Regulation which would also ensure the internal balance of these provisions. As to an eventual future Global Judgments Convention, the content of the discussed provisions of the CLIP Proposal should be adopted.<sup>2511</sup> The CLIP Principles could in this point serve as an orientation for an eventual Global Judgments Convention, while the establishment of a more liberal approach would remain possible.

## **XIV**

Regarding the envisaged creation of a European patent with unitary effect and a Unified Patent Court, the European Parliament and the European Council agreed, by way of enhanced cooperation, on the so-called “patent package” consisting of three components: a Regulation creating a European patent with unitary effect (Regulation 1257/2012), a Regulation establishing a language regime applicable to the European patent with unitary effect (Regulation 1260/2012) and, in order to establish a single and specialised patent judiciary, named “Unified Patent Court” (UPC), sitting outside of the EU institutional framework, an international agreement among Member States (UPC Agreement). Previous efforts to

---

<sup>2511</sup> The exact wording and choice of provisions of such an eventual future Global Judgments Convention would depend on its envisaged scope. If required, the whole complex of provisions of the CLIP Principles could be adopted to establish a complete set of rules.

establish a “Community patent” had constantly failed, in particular due to the fact that no consent could be reached with regard to the question into which languages a patent application must be translated.

## XV

The European patent with unitary effect has been developed as a third option beside national patents and classical European patents as illustrated above. Notably, it will be impossible to have the same patent granted as a unitary patent and a classical European patent.<sup>2512</sup> The question of whether simultaneous protection via a unitary patent and a national patent is possible will have to be clarified in national provisions.

On the basis of an evaluation of the European patent with unitary effect which takes into consideration the aspect of whether this patent effects a unification of patent protection in the European Union, facilitates patent protection, reduces costs and is in line with EU law, it is to be concluded that doubts remain whether the European patent with unitary effect will cope with the high expectations that have been expressed in particular by European Union institutions. For instance, it needs to be taken into consideration that, as not all EU Member States participate in the creation of the unitary patent, this instrument actually adds to territorial fragmentation of patent law in Europe, rather than consolidating it. Moreover, it remains to be seen whether patent protection via the unitary patent actually effects a simplified patent protection, because the European patent with unitary effect has a complicated hybrid structure between international law, EU law, and national law. In respect of an eventual reduction of costs, it is to be underlined that, in particular, SMEs might only be active in a small number of Member States, and therefore might only be interested in obtaining patent protection for the territories of these States rather than attaining pan-EU protection – through classical European patents which might be cheaper at the end of the day. In these circumstances, a unitary patent, even if it might be cheaper than a classical European patent granted for *all* EU Member States, might ultimately turn out to be the more costly alternative where only protection for some States is required,<sup>2513</sup> this being aggravated by the fact that the cheap translation arrangements will enter into force only after a long transitional term.

With regard to the crucial question of whether the European patent with unitary effect is founded on a sufficient legal basis, it has been discussed controversially in legal doctrine whether Regulation 1257/2012 meets the requirements of Article 118(1) TFEU. Doubts have been based on several reasons. First, it has been criticised that the European patent with unitary effect is a hybrid construction consisting of European and international law, because the grant and scope of protection are determined by the EPC which is no European law, and the design of the unitary effect is determined by the UPC Agreement, an international agreement, i.e. no European law either. European law determines protection conferred by the European patent with unitary effect only to a very limited extent, since such rules which should originally be contained in the Regulation (cf. Articles 6 to 8 of the draft Regulation) have instead been integrated in the UPC Agreement. Also for this reason, one might doubt that the European patent with unitary effect actually constitutes a uniform European intellectual property right. In this respect, it has been put forth that “European intellectual property rights” within the meaning of Article 118(1) TFEU must be exclusively determined

---

<sup>2512</sup> Article 4(2) of Regulation 1257/2012.

<sup>2513</sup> Cf. Zawadzka (2014)45(4) IIC 383, at p. 390. This aspect is not taken into consideration by those who, as a matter of principle, advocate a cheap unitary patent which grants identical protection throughout the whole European Union, cf. Nooteboom 2003, p. 585.

by EU law including its features such as primacy and uniformity. On the basis of this conception, a European system of protection would be manageable only by way of a Regulation which rules all essential aspects to be considered. As to a unitary patent, this would mean that such a Regulation would have to contain rules as to the aspects of patentability, exclusivity and property. Proponents of this conception have put forth that uniform protection meant as inherent to the intellectual property right to be created via Article 118(1) TFEU can only be guaranteed if both the object and the content of the protection and the conditions for that protection are defined by the same authority that creates the right in question. Besides, it has been criticised that the European patent with unitary effect will not create *uniform* protection within the European Union, because it will only grant protection for the territory of the participating Member States. Although the mentioned arguments put forth by those who are of the opinion that Regulation 1257/2012 does not meet the requirements of Article 118(1) TFEU cannot be totally dismissed, it seems that none of these arguments ultimately proves that the construction chosen by the European legislator (combination of Regulation 1257/2012 (supplemented by Regulation 1260/2012) and the UPC Agreement) is irreconcilable with Article 118(1) TFEU. First of all, it must be underlined that the wording of Article 118(1) TFEU does *not* expressly require that European intellectual property rights such as the European patent with unitary effect are solely established by European law. In this respect, it is remarkable that the European legislator chose the open wording “European” intellectual property rights and did not employ the notion “EU intellectual property rights”. In light of this, I arrive at the conclusion that Article 118(1) TFEU should be considered as a sufficient legal basis for the construction of the European patent with unitary effect by way of a combination of EU law (Regulation 1257/2012 and Regulation 1260/2012) and international law (EPC and UPC Agreement).

## XVI

The UPC will form a centralised court for litigation concerning both classical European patents and European patents with unitary effect. The UPC will have jurisdiction only in respect of designations of European patents for any of the signatories of the UPC Agreement. On the other hand, it will not have jurisdiction regarding designations of the European patent for any of the other EPC contracting States. The UPC will thus be a court common to the participating EU Member States and subject to the same obligations under EU law as any of their national courts. Consequently, the UPC must refer, where necessary, questions on the interpretation of EU law to the ECJ.

An evaluation of the UPC, taking into account the aspect of whether the creation of the UPC will foster legal certainty, establish an effective judiciary, reduce costs, and be in line with EU law, also reveals (as with regard to the European patent with unitary effect) that a differentiated view is required.

As to the aspect of legal certainty, it is to be borne in mind that not all Member States participate in the UPC Agreement, which ultimately leads to fragmentation of jurisprudence between participating and non-participating Member States. The consequence of this split jurisdiction is a separate jurisdiction applicable to related patents, which might be considered as a severe obstacle towards a unification in European patent litigation which, in the end, might even create legal *uncertainty*. However, legal certainty might be strengthened by the role of the ECJ. As the UPC would be obliged to refer questions to the ECJ on the interpretation of Regulation 1257/2012 and Regulation 1260/2012, decisions of the ECJ in this respect would have binding effect for the UPC.



Regarding the effectiveness of the UPC, it is possible that the latter might be impaired by the existence of the transitional period, during which a holder of a European patent (but not a unitary patent) may at any time opt out of the exclusive competence of the UPC, and would then have the possibility to opt back into the exclusive competence of the UPC at any time, even after the expiration of the transitional period, apparently without penalty.

While it may at present not always be financially viable to file multiple patent infringement claims in multiple countries, because the bundle of national patents resulting from a European patent – even in cases of EU-wide infringement – can be enforced only on a strictly national basis, which effects high litigation costs, it might be more affordable to sue that same infringer in the UPC for infringement in several countries. However, as the court fees of the UPC have not been determined yet, this question cannot be answered at this point in time.

With regard to the question of whether the creation of the UPC is in line with EU law, one should differentiate between compliance with primary EU law and compliance with the Brussels Ibis Regulation.

Regarding the requirement of compliance with primary EU law, it is noteworthy that the UPC Agreement, in contrast to previous proposals, tends to place the position of the UPC *within* the legal system of the European Union. Rather than creating a separate court outside the EU system, various States among EU Member States will establish the court by an agreement. Neither the EU itself nor countries outside the European Union will be signatories. The UPC shall be subject to the same obligations under EU law as any national court of the Contracting Member States and shall apply EU law in its entirety, respecting its primacy. Additionally, the UPC Agreement specifies that the UPC, as a court common to the Contracting Member States and as part of their judicial systems, shall cooperate with the ECJ to ensure the proper application and uniform interpretation of EU law in the same way as the national courts of EU Member States. In particular, the UPC shall request preliminary rulings from the ECJ on the interpretation of the Treaties or the validity and interpretation of acts of the institutions, bodies, offices, or agencies of the EU in accordance with Article 267 TFEU, in the same manner as national courts. The UPC Agreement also explicitly stipulates that the Contracting Member States are jointly and severally liable for damage resulting from an infringement of EU law by the Court of Appeal, in accordance with EU law concerning non-contractual liability of Member States for damage caused by their national courts breaching EU law.

In order to ensure compliance between the UPC Agreement and the Brussels Ibis Regulation, and in order to address the particular issue of jurisdiction rules vis-à-vis defendants in non-European Union States, the European legislator, based on a proposal submitted by the Commission (Commission Proposal 2013), added the new provisions of Articles 71a to 71d to the set of rules of the Brussels Ibis Regulation, by way of Regulation 542/2014. On the basis of a deepened analysis, it is to be concluded that the European legislator, in principle, amended the Brussels Ibis Regulation in such a way as to ensure compliance between the UPC Agreement and the Brussels Ibis Regulation. Minor further amendments concerning the wording and structure of the provisions which have been indicated in this thesis should however be undertaken.

Although the view that the UPC lacks a sufficient democratic foundation, because the UPC Agreement has only been submitted to the European Parliament, but has never been *deliberated* by the European Parliament, cannot be totally dismissed, it is to be underlined that national parliaments at least have to ratify the UPC Agreement.

From an overall perspective, the creation of the UPC ultimately means the disempowering of national court systems, because patent litigation is entrusted into a new – and untested – court system. Its structure and its rules of procedure will constitute a compound of rules from various European jurisdictions with different legal traditions and background. It is noteworthy that the Rules of Procedure of the UPC will form the first code of civil procedure on a European level.

It is noteworthy that the creation of the European patent with unitary effect does not mean that the discussed problems concerning cross-border patent disputes with regard to ordinary European patents (and national patents) will disappear, because, at least during the transitional period, the problem must be solved that there are still ordinary European patents without unitary effect, besides national patents which remain available. Even when the transitional period will have expired after seven years, other patents which are still in existence then will make it necessary to provide rules according to which potential cross-border disputes can be solved.

## SUMMARY

## SUMMARY

### Cross-border patent infringement litigation within the European Union

In our modern industrial society, intellectual property (“IP”) rights, and in particular patents, constitute for many companies and individuals the core assets they own, and which form the basis for any business activity. In light of this, adequate protection of IP rights is of crucial importance for such entities. In the international arena, patent holders have to face diverse problems. Due to the territorially restricted character of (national) patents, the latter are only valid in and for the State where they have been granted. Where another entity infringes several of such patents, there is not only one infringement, but each patent infringement is considered separately. Further, it might well happen that a patent holder suffers from infringement of his patent(s) by several infringers. Regularly, he will then be interested in consolidating proceedings against the concerned infringers.

Within the European legal framework, the Brussels Ibis Regulation, being also applicable to cross-border patent infringement proceedings, provides for specific rules with regard to the addressed situations (which are merely to be understood as examples). Although being constantly shaped by the jurisprudence of the ECJ, and being developed from the Brussels Convention via the Brussels I Regulation to the Brussels Ibis Regulation, a deeper analysis of the matter reveals that the respective rules of the Brussels Ibis Regulation still contain considerable deficiencies when it comes to the question to what extent adequate patent protection and enforcement is ensured.

This thesis primarily aims to propose in which way such deficiencies within the system of the Brussels Ibis Regulation can be healed.

However, this requires, first, to outline the (legal) framework in order to be able to evaluate *whether there actually is* a deficiency. Besides, it is essential to clearly demonstrate which deficiencies exist. On this basis, one should never ignore present (legal) developments which potentially offer alternative solutions.

Following these principles, this thesis is divided into four chapters. Chapter 1 briefly deals with certain fundamental aspects which are relevant for cross-border patent infringement proceedings. Different concepts of a patent – from the common law and the civil law perspective – are mentioned and embedded in their historical environment, followed by a presentation of different ways of justification for the existence of patents. Further, the different types of patents – national patents, classical (ordinary) European patents, and European patents with unitary effect (which are to be established) are outlined, as well as the existing patent categories of product patents and process patents (which will play a role in the further course of the thesis). Last but not least, Chapter 1 also treats the crucial question of whether the principle of territoriality, a principle of substantive law, is also relevant for international jurisdiction in cross-border patent infringement disputes. In this respect, approaches of several European States (United Kingdom, France, Germany and the Netherlands) are considered. While the courts of all these States originally held that they are not competent to decide on the infringement of a foreign patent, this attitude has significantly changed during the last decades. Even English courts have given up their negative attitude towards a decision in proceedings on the infringement of a foreign patent at least in relation to proceedings within the scope of the Brussels Convention (Brussels Ibis Regulation).

Chapter 2 analyses in detail which deficiencies with regard to jurisdiction rules of the Brussels Ibis Regulation being relevant for cross-border patent infringement proceedings, exist at present. After shortly addressing Article 4(1) of the Brussels Ibis Regulation which contains the fundamental principle of *actor sequitur forum rei*, Chapter 2 undertakes a deepened analysis of Article 7(2) of the Brussels Ibis Regulation. In essence, Chapter 2 first states that Article 7(2) of the Brussels Ibis Regulation is also applicable to an action for a declaration of non-infringement. One focus of Chapter 2 lies on the question of the determination of the place of the infringing event in terms of Article 7(2) of the Brussels Ibis Regulation. On the basis of an extended analysis, Chapter 2 concludes that the existence of an extraterritorial place of the event giving rise to the damage according to Article 7(2) of the Brussels Ibis Regulation requires that the conditions of accountability and a particularly close connection between the infringing act and the invoked court are fulfilled, whereas, as to European patents, a differentiation between product patents and process patents should be made. With regard to the question of whether an extraterritorial place where the damage occurred according to Article 7(2) of the Brussels Ibis Regulation is conceivable and where it is to be located, Chapter 2 concludes that only the place where the patent right has been infringed (“*Ort der Rechtsgutverletzung*”) is to be considered such a place. Regarding the territorial scope of authority to decide of a court pursuant to Article 7(2) of the Brussels Ibis Regulation, Chapter 2 underlines that only in the case of process patents, a court at the place of manufacture should also be authorised to decide on the infringement of parallel patents granted in respectively for the territory of another State than the forum State. As to the place where the damage occurred, i.e. the place where the patent right is being infringed, the invoked court has only authority to decide on this very infringement, but not concerning *parallel* infringements.

Having treated Article 7(2) of the Brussels Ibis Regulation, Chapter 2 points out that the criterion of a “close connection” according to Article 8(1) of the Brussels Ibis Regulation may also constitute a crucial problem regarding cross-border patent infringement proceedings. Despite specific jurisprudence of the ECJ, it has not been fully clarified yet under which circumstances there is such a “close connection”.

Chapter 2 then turns to a detailed discussion of relevant problems in the framework of exclusive jurisdiction according to Article 24(4) of the Brussels Ibis Regulation. After treating the controversial question of whether Article 24(4) should be applied by way of a reflexive application vis-à-vis third State defendants (which is denied in this thesis), Chapter 2 analyses the consequences of the *GAT* decision of the ECJ. Further issues addressed in detail are which requirements exist as to the defence of invalidity and which consequences an invalidity defence effects *in concreto*.

The last Article of the Brussels Ibis Regulation treated in Chapter 2 is Article 35 of the Brussels Ibis Regulation (cross-border interim relief). Chapter 2 makes clear that Article 35 is not the only possible legal basis for provisional measures contained in the Brussels Ibis Regulation, but that also courts which have jurisdiction on the merits have (accessory) jurisdiction to order provisional measures. Chapter 2 then treats in details both accessory jurisdiction to order provisional measures and jurisdiction according to Article 35 of the Brussels Ibis Regulation (in conjunction with national law), and analyses which problems are existing (or have – partly – been solved by the ECJ). One aspect of particular importance which affects both accessory jurisdiction and jurisdiction according to Article 35 of the Brussels Ibis Regulation is the question if Article 24(4) of the Brussels Ibis Regulation is applicable when the invalidity defence is raised in provisional proceedings. While the ECJ has denied this question, in its *Solvay* decision, as to Article 35 of the Brussels Ibis Regulation,

the question has remained unanswered as to accessory jurisdiction. On the basis of an analysis which also takes into consideration national case law of Member States, this thesis arrives at the conclusion that both types of provisional proceedings should be treated equally in this respect.

On the basis of the insight that general rules of jurisdiction (according to the Brussels Ibis Regulation) should apply also with regard to cross-border patent infringement proceedings, and in light of the analysis of the current deficiencies within the system of the Brussels Ibis Regulation undertaken in Chapter 2, Chapter 3 develops proposals as to an amendment of the respective provisions. This approach is undertaken also by reference to existing reform proposals which are compared with each other in order to find out – if the content of the reform proposals differs – which way to solve a problem seems most appropriate. In particular, this thesis treats relevant solutions of the ALI Principles and the CLIP Principles, but also takes into consideration the Draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (2001), the Heidelberg Report on the Application of Regulation Brussels I (Heidelberg Report) and the Commission Proposal 2010 for Reform of the Brussels I Regulation (Commission Proposal 2010). However, Chapter 3 does not stop at a mere comparison of existing reform proposals, but develops own formulation proposals.

Chapter 4 finally considers the creation of the European patent with unitary effect and the Unified Patent Court (UPC) as an alternative to the present system of national patents and ordinary European patents without a special “European” patent judiciary. After briefly presenting the history of the creation of a uniform patent in Europe, Chapter 4 discusses the main features of the European patent with unitary effect and of the UPC, and undertakes an evaluation of several aspects. While concluding that Article 118(1) TFEU should be considered as a sufficient legal basis for the construction of the European patent with unitary effect by way of a combination of EU law (Regulation 1257/2012 and Regulation 1260/2012) and international law (EPC and UPC Agreement), it is at least doubtful whether a unitary patent will actually be an attractive alternative to an ordinary European patent, primarily due to the fact that it is still unclear which costs will be produced. Regarding the UPC, Chapter 4 in particular underlines that the European legislator has successfully amended the Brussels Ibis Regulation, by Regulation 542/2014, in order to ensure compliance between the UPC Agreement and the Brussels Ibis Regulation. Only minor further amendments concerning the wording and structure of the provisions should be undertaken. However, doubts remain as to the questions of whether the creation of the UPC effects legal certainty, whether it will work effectively, and whether it will effect a reduction of costs.

## SAMENVATTING

## **SAMENVATTING**

### **Grensoverschrijdende octrooi-inbreukprocedures binnen de Europese Unie**

In onze moderne geïndustrialiseerde samenleving vormen intellectuele eigendomsrechten (“ie-rechten”), en in het bijzonder octrooien, voor veel bedrijven en particulieren de meest essentiële bezittingen en zijn zij de basis voor veel bedrijfsactiviteiten. In het licht hiervan is adequate bescherming van ie-rechten voor deze bedrijven van eminent belang. In de internationale arena worden octrooihouders met diverse problemen geconfronteerd. Als gevolg van het territoriaal beperkte karakter van (nationale) octrooien zijn deze slechts geldig in en voor het grondgebied van het land waar zij zijn verleend. Als een andere partij inbreuk maakt op meerdere van dergelijke octrooien, dan betreft dit niet één enkele inbreuk, maar moet de inbreuk op elk van deze octrooien afzonderlijk worden gezien. Bovendien is het goed denkbaar dat de octrooihouder te maken krijgt met een inbreuk op zijn octrooi(en) door meerdere partijen. Doorgaans zal hij dan de procedures tegen de betrokken inbreuk makende partijen willen samenvoegen.

Binnen de Europese juridische kaders voorziet de Brussel Ibis-Verordening, die ook van toepassing is op grensoverschrijdende octrooi-inbreukprocedures, in specifieke regels voor de aangeduide situaties (die louter als voorbeelden moeten worden begrepen). Hoewel zij voortdurend worden aangescherpt door de jurisprudentie van het Hof van Justitie van de EU (“HvJ EU”), en zij zich ontwikkelden van het EEX-Verdrag via de Brussel I-Verordening naar de Brussel Ibis-Verordening, laat een grondigere analyse van deze kwestie zien dat de betreffende regels uit de Brussel Ibis-Verordening nog altijd aanzienlijke tekortkomingen vertonen als het gaat om de vraag in welke mate een adequate octrooibescherming en -handhaving worden gewaarborgd.

Dit proefschrift is er hoofdzakelijk op gericht voorstellen te doen voor de manier waarop deze tekortkomingen binnen het systeem van de Brussel Ibis-Verordening kunnen worden opgelost.

Hiervoor is het echter noodzakelijk eerst de (juridische) kaders uiteen te zetten om te kunnen beoordelen of er daadwerkelijk tekortkomingen zijn. Daarnaast is het essentieel om duidelijk te laten zien welke tekortkomingen er bestaan. Bovendien mag men nooit de ogen sluiten voor de huidige (juridische) ontwikkelingen die mogelijk alternatieve oplossingen bieden.

Ter uitvoering van het voorgaande is dit proefschrift in vier hoofdstukken onderverdeeld. In hoofdstuk 1 wordt kort aandacht geschonken aan enkele fundamentele aspecten van grensoverschrijdende octrooi-inbreukprocedures. Verschillende visies op een octrooi – vanuit common law- en civil law-perspectief – komen aan de orde en worden ingebed in hun historische context, waarna verschillende rechtvaardigingen voor het bestaan van octrooien worden uiteengezet. Vervolgens worden de verschillende soorten octrooien – nationale octrooien, klassieke (reguliere) Europese octrooien en Europese octrooien met eenvormige werking (die nog moeten worden ingevoerd) – besproken, alsmede de bestaande octrooi-categorieën van productoctrooien en werkwijze-octrooien (die in het verdere verloop van het proefschrift een rol zullen spelen). En last but not least is er in hoofdstuk 1 aandacht voor de cruciale vraag of het territorialiteitsbeginsel, een beginsel uit het materiële recht, ook relevant is voor de internationale rechtsmacht in grensoverschrijdende octrooi-inbreukgeschillen. In dit verband worden benaderingen van verschillende Europese landen (Verenigd Koninkrijk, Frankrijk, Duitsland en Nederland) gezien. Terwijl de rechters zich in



al deze landen oorspronkelijk onbevoegd achtten te oordelen over de inbreuk op een buitenlands octrooi, is deze houding de laatste decennia aanzienlijk veranderd. Zelfs de Engelse rechter heeft zijn negatieve houding ten aanzien van een beslissing in een procedure over de inbreuk op een buitenlands octrooi opgegeven, tenminste voor zover de procedure valt binnen het toepassingsgebied van het EEX-Verdrag (de Brussel Ibis-Verordening).

Hoofdstuk 2 bevat een gedetailleerde analyse van de vraag welke tekortkomingen er op dit moment bestaan met betrekking tot de rechtsmachtregels uit de Brussel Ibis-Verordening die gelden voor octrooi-inbreukprocedures. Na een korte behandeling van artikel 4 lid 1 van de Brussel Ibis-Verordening, waarin het fundamentele uitgangspunt *actor sequitur forum rei* is neergelegd, wordt in hoofdstuk 2 een diepgaande analyse gegeven van artikel 7 sub 2 van de Brussel Ibis-Verordening. In essentie stelt hoofdstuk 2 in de eerste plaats dat artikel 7 sub 2 van de Brussel Ibis-Verordening ook van toepassing is indien om een verklaring voor recht wordt gevraagd dat er van een inbreuk geen sprake is. Een belangrijk aandachtspunt in hoofdstuk 2 is de vraag naar de bepaling van de plaats van het inbreukmakende feit in de zin van artikel 7 sub 2 van de Brussel Ibis-Verordening. Op basis van een uitgebreide analyse wordt de conclusie getrokken dat indien de plaats van het schadebrengende feit volgens artikel 7 sub 2 van de Brussel Ibis-Verordening buiten het grondgebied is gelegen, er wordt verlangd dat aan de voorwaarden van toerekenbaarheid en een bijzonder nauwe band tussen het inbreukmakende handelen en de aangezochte rechter is voldaan, terwijl, als het gaat om Europese octrooien, onderscheid zou moeten worden gemaakt tussen productoctrooien en werkwijze-octrooien. Met betrekking tot de vraag of het denkbaar is dat de plaats waar de schade intreedt volgens artikel 7 sub 2 van de Brussel Ibis-Verordening buiten het grondgebied kan zijn gelegen en hoe deze dient te worden bepaald, wordt in hoofdstuk 2 de conclusie getrokken dat alleen de plaats waar inbreuk wordt gemaakt op het octrooirecht (“Ort der Rechtsgutverletzung”) als zodanig kan worden beschouwd. Op het vlak van de territoriale reikwijdte van de rechtsmacht van de rechter krachtens artikel 7 sub 2 van de Brussel Ibis-Verordening wordt in hoofdstuk 2 onderstreept dat alleen in geval van werkwijze-octrooien de rechter van de plaats van productie ook rechtsmacht zou moeten hebben om te oordelen over de inbreuk op parallelle octrooien, toegekend in respectievelijk voor het grondgebied van een ander land dan dat van de rechter. De aangezochte rechter in het land waar de schade intreedt, te weten het land waar inbreuk op het octrooirecht wordt gemaakt, is enkel bevoegd te oordelen over die betreffende inbreuk, maar niet ten aanzien van parallelle inbreuken.

Nadat artikel 7 sub 2 van de Brussel Ibis-Verordening is behandeld, maakt hoofdstuk 2 duidelijk dat het criterium van de “nauwe band” uit artikel 8 sub 1 van de Brussel Ibis-Verordening ook een lastig probleem zou kunnen vormen in grensoverschrijdende octrooi-inbreukzaken. In weerwil van specifieke jurisprudentie van het HvJ EU, is nog altijd niet volledig opgehelderd onder welke omstandigheden er sprake is van een dergelijke “nauwe band”.

In hoofdstuk 2 wordt vervolgens uitvoerig aandacht besteed aan de problemen die met betrekking tot de exclusieve bevoegdheid volgens artikel 24 sub 4 van de Brussel Ibis-Verordening bestaan. Na bespreking van de controversiële vraag of artikel 24 sub 4 van de Brussel Ibis-Verordening in het kader van de reflexwerking ook jegens verweerders uit derde landen zou moeten worden toegepast (welke vraag in dit proefschrift ontkennend wordt beantwoord), volgt in hoofdstuk 2 een analyse van de gevolgen van de GAT-uitspraak van het HvJ EU. Verder komt uitvoerig aan de orde welke vereisten er bestaan voor een (on)geldigheidsverweer en welke gevolgen een (on)geldigheidsverweer in concreto teweeg brengt.

Het laatste artikel van de Brussel Ibis-Verordening dat in hoofdstuk 2 wordt behandeld is artikel 35 van de Brussel Ibis-Verordening (grensoverschrijdende voorlopige en bewarende maatregelen). Hoofdstuk 2 maakt duidelijk dat artikel 35 niet de enige mogelijke juridische grondslag vormt voor voorlopige maatregelen onder de Brussel Ibis-Verordening, maar dat ook de rechter die bevoegd is om van het bodemgeschil kennis te nemen (aanvullende) rechtsmacht bezit om voorlopige maatregelen uit te vaardigen. In hoofdstuk 2 wordt vervolgens uitvoerig aandacht besteed aan zowel de aanvullende rechtsmacht tot het uitvaardigen van voorlopige maatregelen als de rechtsmacht krachtens artikel 35 van de Brussel Ibis-Verordening (in samenhang met nationaal recht), en wordt geanalyseerd welke problemen er bestaan (of – gedeeltelijk – zijn opgelost door het HvJ EU). Een aspect dat in het bijzonder van belang is en dat raakt aan zowel de aanvullende rechtsmacht als de rechtsmacht krachtens artikel 35 van de Brussel Ibis-Verordening, is de vraag of artikel 24 sub 4 van de Brussel Ibis-Verordening van toepassing is indien in de procedure tot een voorlopige voorziening een (on)geldigheidsverweer wordt gevoerd. Terwijl deze vraag met betrekking tot artikel 35 van de Brussel Ibis-Verordening ontkennend is beantwoord door het HvJ EU in zijn Solvay-beslissing, is deze vraag onbeantwoord gebleven ten aanzien van de aanvullende rechtsmacht. Op grond van een analyse waarbij ook nationale jurisprudentie uit de lidstaten in ogenschouw is genomen, wordt in dit proefschrift de conclusie getrokken dat beide typen procedures tot voorlopige maatregelen in dit opzicht gelijk zouden moeten worden behandeld.

Op basis van de overtuiging dat de algemene rechtsmachtbepalingen (volgens de Brussel Ibis-Verordening) ook van toepassing zouden moeten zijn op grensoverschrijdende octrooi-inbreukzaken en in het licht van de analyse uit hoofdstuk 2 ten aanzien van de huidige tekortkomingen in het systeem van de Brussel Ibis-Verordening, worden in hoofdstuk 3 voorstellen gedaan tot aanpassing van de desbetreffende bepalingen. Dit gebeurt onder meer door verwijzing naar bestaande voorstellen tot herziening, die met elkaar worden vergeleken om erachter te komen – wanneer de inhoud van de herzieningsvoorstellen verschilt – wat de meest geschikte manier lijkt te zijn om een probleem op te lossen. In het bijzonder worden in dit proefschrift de betreffende oplossingen uit de ALI Principles en de CLIP Principles behandeld, maar ook wordt aandacht besteed aan het ontwerp Haags Bevoegdheids- en Executieverdrag betreffende burgerlijke en handelszaken (2001), het Heidelberg Report on the Application of Regulation Brussels I (Heidelberg Rapport) en het Commissievoorstel uit 2010 voor een herziening van de Brussel I-Verordening (Commissievoorstel 2010). Hoofdstuk 3 is echter niet beperkt tot het enkel vergelijken van bestaande herzieningsvoorstellen, maar daarin worden ook nieuw ontwikkelde voorstellen geformuleerd.

In hoofdstuk 4 worden ten slotte de instelling van het Europese octrooi met eenvormige werking en het Eengemaakt Octrooigerecht (EOG) beschouwd als alternatief voor het huidige systeem van nationale octrooien en reguliere Europese octrooien zonder een speciale Europese octrooierechter. Na een korte uiteenzetting van de geschiedenis van de instelling van een eenvormig octrooi in Europa, komen in hoofdstuk 4 de belangrijkste kenmerken van het Europese octrooi met eenvormige werking en van het EOG aan de orde, en worden deze aan een evaluatie onderworpen. Hoewel wordt geconcludeerd dat moet worden aangenomen dat artikel 118 lid 1 van het Verdrag betreffende de werking van de Europese Unie (VWEU) een toereikende juridische grondslag biedt voor de instelling van het Europese octrooi met eenvormige werking door een combinatie van EU-recht (Verordening 1257/2012 en Verordening 1260/2012) en internationaal recht (Europees Octrooiverdrag en Overeenkomst betreffende een eengemaakt octrooigerecht), moet op zijn minst worden betwijfeld of een eenvormig octrooi daadwerkelijk een aantrekkelijk alternatief voor een regulier Europees octrooi zal zijn, voornamelijk vanwege het feit dat het nog altijd onduidelijk is welke kosten

hiermee gepaard zullen gaan. Met betrekking tot het EOG wordt in hoofdstuk 4 in het bijzonder onderstreept dat de Europese wetgever erin is geslaagd door middel van Verordening 542/2014 de Brussel Ibis-Verordening aan te passen, om de onderlinge afstemming tussen de Overeenkomst betreffende een eengemaakt octrooigerecht en de Brussel Ibis-Verordening te waarborgen. Slechts op ondergeschikte punten zouden de formulering en structuur van de bepalingen nog verder moeten worden aangepast. Er blijven echter twijfels bestaan ten aanzien van de vragen of de instelling van het EOG de rechtszekerheid zal vergroten, of het effectief zal kunnen functioneren en of het een reductie van kosten teweeg zal brengen.

## TABLE OF CASES

### European Court of Human Rights

ECHR 15 October 2009, Application no. 17056/06, *Micaleff v Malta*, available at WWW <[http://hudoc.echr.coe.int/sites/eng/pages/search.aspx#{%22appno%22:\[%2217056/06%22\],%22itemid%22:\[%22001-95031%22\]}>](http://hudoc.echr.coe.int/sites/eng/pages/search.aspx#{%22appno%22:[%2217056/06%22],%22itemid%22:[%22001-95031%22]}) – *Micaleff*

### Court of Justice of the European Union

ECJ 6 October 1976, C-12/76, *Industrie Tessili Italiana Como v Dunlop AG*, [1976] ECR 01473 – *Tessili*

ECJ 30 November 1976, C-21/76, *Handelskwekerij G. J. Bier B.V. v Mines de Potasse d’Alsace S.A.*, [1976] ECR 01735 – *Mines de Potasse*

ECJ 14 December 1976, C-24/76, *Estasis Salotti di Colzani Aimo et Gianmario Colzani v Rüwa Polstereimaschinen GmbH*, [1976] ECR 01831 – *Salotti*

ECJ 14 December 1976, C-25/76, *Galleries Segoura SPRL v Société Rahim Bonakdarian*, [1976] ECR 01851 – *Segoura*

ECJ 14 December 1977, C-73/77, *Theodorus Engelbertus Sanders v Ronald van der Putte*, [1977] ECR 02383 – *Sanders*

ECJ 27 March 1979, C-143/78, *Jacques de Cavel v Luise de Cavel*, [1979] ECR 01055 – *Cavel*

ECJ 21 May 1980, C-125/79, *Bernard Denilauler v S.N.C. Couchet Frères*, [1980] ECR 01553 – *Denilauler*

ECJ 24 June 1981, C-150/80, *Elefanten Schuh GmbH v Pierre Jacqmain*, [1981] ECR 01671 – *Elefanten Schuh*

ECJ 4 March 1982, C-38/81, *Effer SpA v Hans-Joachim Kantner*, [1982] ECR 00825 – *Effer*

ECJ 15 November 1983, C-288/82, *Ferdinand M. J. J. Duijnstee v Lodewijk Goderbauer*, [1983] ECR 03663 – *Duijnstee*

ECJ 19 June 1984, C-71/83, *Partenreederei ms. Tilly Russ and Ernest Russ v NV Haven- & Vervoerbedrijf Nova and NV Goeminne Hout*, [1984] ECR 02417 – *Tilly Russ*

ECJ 11 July 1985, C-221/84, *F. Berghoefer GmbH & Co. KG v ASA SA*, [1985] ECR 02699 – *Berghoefer*

ECJ 8 December 1987, C-144/86, *Gubisch Maschinenfabrik KG v Giulio Palumbo*, [1987] ECR 04861 – *Gubisch*

ECJ 4 February 1988, C-145/86, Horst Ludwig Martin Hoffmann v Adelheid Krieg, [1988] ECR 00645 – *Hoffmann*

ECJ 27 September 1988, C-189/87, Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst und Co. and Others, [1988] ECR 05565 – *Kalfelis*

ECJ 11 January 1990, C-220/88, Dumez France and Another v Hessische Landesbank (Helaba) and Others, [1990] ECR I-00049 – *Dumez*

ECJ 15 May 1990, C-365/88, Kongress Agentur Hagen GmbH v Zeehaghe BV, [1990] ECR I-01845 – *Kongress Agentur Hagen*

ECJ 27 June 1991, C-351/89, Overseas Union Insurance Limited and Others v New Hampshire Insurance Company, [1991] ECR I-03317 – *Overseas Union Insurance*

ECJ 26 March 1992, C-261/90, Mario Reichert and Others v Dresdner Bank AG, [1992] ECR I-02149 – *Reichert II*

ECJ 17 June 1992, C-26/91, Jakob Handte & Co. GmbH v Traitements Mécano-chimique des Surfaces SA (TMCS), [1992] ECR I-03967 – *Handte*

ECJ 12 November 1992, C-123/91, Minalmet GmbH v Brandeis Ltd, [1992] ECR I-05661 – *Minalmet*

ECJ 29 June 1994, C-288/92, Custom Made Commercial Ltd v Stawa Metallbau GmbH, [1994] ECR I-02913 – *Custom Made*

ECJ 6 December 1994, C-406/92, The owners of the cargo lately laden on board the ship ‘Tatry’ v The owners of the ship ‘Maciej Rataj’, [1994] ECR I-05439 – *Tatry*

ECJ 7 March 1995, C-68/93, Fiona Shevill and Others v Presse Alliance SA, [1995] ECR I-00415 – *Shevill*

ECJ 13 July 1995, C-341/93, Danværn Production A/S v Schuhfabriken Otterbeck GmbH & Co., [1995] ECR I-02053 – *Danværn*

ECJ 19 September 1995, C-364/93, Antonio Marinari v Lloyds Bank plc and Zubaidi Trading Company, [1995] ECR I-02719 – *Marinari*

ECJ 4 November 1997, C-337/95, Parfums Christian Dior SA and Parfums Christian Dior BV v Evora BV, [1997] ECR I-06013 – *Parfums Christian Dior*

ECJ 27 October 1998, C-51/97, Réunion Européenne SA and Others v Spliethoff’s Bevrachtungskantoor BV, and the Master of the vessel Alblasgracht V002, [1998] ECR I-06511 – *Réunion Européenne*

ECJ 17 November 1998, C-391/95, Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another, [1998] ECR I-07091 – *Van Uden*

ECJ 27 April 1999, C-99/96, Hans-Hermann Mietz v Intership Yachting Sneek BV, [1999] ECR I-02277 – *Mietz*  
 U. Spellenberg and S. Leible (case note) ECJ 27 April 1999, C-99/96, Hans-Hermann Mietz v Intership Yachting Sneek BV, (1999)4 ZZPInt 221

ECJ 5 October 1999, C-420/97, Leathertex Divisione Sintetici SpA v Bodetex BVBA, [1999] ECR I-06747 – *Leathertex*

ECJ 13 July 2000, C-412/98, Group Josi Reinsurance Company SA v Universal General Insurance Company (UGIC), [2000] ECR I-05925 – *Josi Reinsurance*

ECJ 9 November 2000, C-387/98, Coreck Maritime GmbH v Handelsveem BV and Others, [2000] ECR I-09337 – *Coreck Maritime*

ECJ 19 February 2002, C-256/00, Besix SA v Wasserreinigungsbau Alfred Kretzschmar GmbH & Co. KG (WABAG), Planungs- und Forschungsgesellschaft Dipl. Ing. W. Kretzschmar GmbH & Co. KG (Plafog), [2002] ECR I-01699 – *Besix*

ECJ 6 June 2002, C-80/00, Italian Leather SpA v WECO Polstermöbel GmbH & Co., [2002] ECR I-04995 – *Italian Leather*  
 B. Hess (case note) ECJ 6 June 2002, C-80/00, Italian Leather SpA v WECO Polstermöbel GmbH & Co., (2005)25(1) IPRax 23

ECJ 11 July 2002, C-96/00, Rudolf Gabriel, [2002] ECR I-06367 – *Gabriel*

ECJ 17 September 2002, C-334/00, Fonderie Officine Meccaniche Tacconi SpA v Heinrich Wagner Sinto Maschinenfabrik GmbH (HWS), [2002] ECR I-07357 – *Tacconi*

ECJ 1 October 2002, C-167/00, Verein für Konsumenteninformation v Karl Heinz Henkel, [2002] ECR I-08111 – *Henkel*

ECJ, 5 February 2004, C-18/02, Danmarks Rederiforening, acting on behalf of DFDS Torline A/S, v LO Landsorganisationen i Sverige, acting on behalf of SEKO Sjöfolk Facket För Service och Kommunikation, [2004] ECR I-01417 – *DFDS Torline*

ECJ 9 December 2003, C-116/02, Erich Gasser GmbH v MISAT Srl, [2003] ECR I-14693 – *Gasser*

ECJ 27 April 2004, C-159/02, Gregory Paul Turner v Felix Fareed Ismail Grovit and Others, [2004] ECR I-03565 – *Turner*

ECJ 10 June 2004, C-168/02, Rudolf Kronhofer v Marianne Maier and Others, [2004] ECR I-06009 – *Kronhofer*

ECJ 20 January 2005, C-27/02, Petra Engler v Janus Versand GmbH, [2005] ECR I-00481 – *Engler*

ECJ 1 March 2005, C-281/02, Andrew Owusu v N.B. Jackson and Others, [2005] ECR I-01383 – *Owusu*

ECJ 28 April 2005, C-104/03, St. Paul Dairy Industries NV v Unibel Exser BVBA, [2005] ECR I-03481 – *St. Paul Dairy*

ECJ 26 May 2005, C-77/04, Groupement d'intérêt économique (GIE) Réunion européenne and Others v Zurich España and Société pyrénéenne de transit d'automobiles (Soptrans), [2005] ECR I-04509, paras. 34-35 – *Groupement d'intérêt économique (GIE) Réunion européenne*

ECJ 17 January 2006, C-1/04, Susanne Staubitz-Schreiber, [2006] ECR I-00701 – *Staubitz-Schreiber*

ECJ 7 February 2006, C-1/03 (Opinion), Request made by the Council of the European Union, [2006] ECR I-01145

ECJ 2 May 2006, C-341/04, Eurofood IFSC Ltd, [2006] ECR I-03813 – *Eurofood*

ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509 – *GAT*

E. Gottschalk (case note) ECJ 13 July 2006, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, (2007)62(6) JZ 300

ECJ 13 July 2006, C-103/05, Reisch Montage AG v Kiesel Baumaschinen Handels GmbH, [2006] ECR I-06827 – *Reisch Montage*

M. Würdinger (case note) ECJ 13 July 2006, C-103/05, Reisch Montage AG v Kiesel Baumaschinen Handels GmbH, (2006)11 ZZPInt 180

ECJ 13 July 2006, C-539/03, Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg, [2006] ECR I-06535 – *Roche Nederland*

P. Schlosser (case note) ECJ 13 July 2006, C-539/03, Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg, (2007)62(6) JZ 305

ECJ 11 October 2007, C-98/06, Freeport plc v Olle Arnoldsson, [2007] ECR I-08319 – *Freeport*

M. Würdinger (case note) ECJ 11 October 2007, C-98/06, Freeport plc v Olle Arnoldsson, (2007)12 ZZPInt 221

M. Würdinger (case note) ECJ 11 October 2007, C-98/06, Freeport plc v Olle Arnoldsson, (2008)54(1-2) RIW 71

ECJ 23 October 2007, C-440/05, Commission of the European Communities v Council of the European Union, [2007] ECR I-09097

ECJ 2 October 2008, C-372/07, Nicole Hassett v South Eastern Health Board and Cheryl Doherty v North Western Health Board, [2008] ECR I-07403 – *Hassett*

ECJ 28 April 2009, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, [2009] ECR I-03571 – *Apostolides*

G. de Baere (case note) ECJ 28 April 2009, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, (2010)47(4) C.M.L. Rev. 1123

H.P. Meidanis (case note) ECJ 28 April 2009, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, (2009)34(6) E.L. Rev. 963

ECJ 16 July 2009, C-189/08, Zuid-Chemie BV v Philippo's Mineralenfabriek NV/SA, [2009] ECR I-06917 – *Zuid-Chemie*

ECJ 15 July 2010, C-256/09, Bianca Purucker v Guillermo Vallés Pérez, [2010] ECR I-07353 – *Purucker*

ECJ 8 March 2011, C-1/09 (Opinion), Request made by the Council of the European Union, [2011] ECR I-01137

ECJ 25 October 2011, Joined Cases C-509/09 and C-161/10, eDate Advertising GmbH v X (C-509/09) and Oliver Martinez and Robert Martinez v MGN Limited (C-161/10), [2011] ECR I-10269 – *eDate Advertising and Martinez*

ECJ 1 December 2011, C-145/10, Eva-Maria Painer v Standard VerlagsGmbH and Others, [2011] ECR I-12533 – *Painer*

ECJ 16 February 2012, Joined Cases C-72/10 and C-77/10, criminal proceedings against Marcello Costa (C-72/10) and Ugo Cifone (C-77/10), available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0072&rid=1>> – *Marcello Costa and Ugo Cifone*

ECJ 19 April 2012, C-523/10, Wintersteiger AG v Products 4U Sondermaschinenbau GmbH, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0523&rid=2>> – *Wintersteiger*

ECJ 12 July 2012, C-616/10, Solvay SA v Honeywell Fluorine Products Europe BV and Others, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CJ0616&rid=1>> – *Solvay*

ECJ 25 October 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0133&rid=2>> – *Folien Fischer*

R. Magnus (case note) ECJ 25 October 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, (2013) LMK 341419

B. Sujecki (case note) ECJ 25 October 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, (2012)23(24) EuZW 952

C. Vanleenhove (case note) ECJ 25 October 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, (2013)31(1) NIPR 25

ECJ 11 April 2013, C-645/11, Land Berlin v Ellen Mirjam Sapir and Others, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0645&rid=1>> – *Ellen Mirjam Sapir*



ECJ 16 April 2013, Joined Cases C-274/11 and C-295/11, Kingdom of Spain (C-274/11) and Italian Republic (C-295/11) v Council of the European Union, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CJ0274&rid=1>>

ECJ 16 May 2013, C-228/11, Melzer v MF Global UK Ltd, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62011CJ0228&qid=1433446011290&from=EN>> – *Melzer*

R. Wagner (case note) ECJ 16 May 2013, C-228/11, Melzer v MF Global UK Ltd, (2013)24(14) EuZW 544

ECJ 3 October 2013, C-170/12, Peter Pinckney v KDG Mediatech AG, available at WWW <http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0170&rid=5> – *Pinckney*

ECJ 3 April 2014, C-387/12, Hi Hotel HCF SARL v Uwe Spoering, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0387&rid=3>> – *Hi Hotel*

ECJ 5 June 2014, C-360/12, Coty Germany GmbH, formerly Coty Prestige Lancaster Group GmbH v First Note Perfumes NV, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0360&rid=4>> – *Coty Germany*

ECJ 22 January 2015, C-441/13, Pez Hejduk v EnergieAgentur.NRW GmbH, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62013CJ0441&rid=3>> – *Pez Hejduk*

ECJ 5 May 2015, C-146/13, Kingdom of Spain v European Parliament and Council of the European Union, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62013CJ0146&rid=6>>

ECJ 5 May 2015, C-147/13, Kingdom of Spain v Council of the European Union, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62013CJ0147&rid=6>>

## Opinions of the Advocate General

Advocate General 10 November 1976, C-21/76, Handelskwekerij G. J. Bier B.V. v Mines de Potasse d'Alsace S.A., [1976] ECR 01735 – *Mines de Potasse*

Advocate General 13 July 1994, C-406/92, The owners of the cargo lately laden on board the ship 'Tatry' v The owners of the ship 'Maciej Rataj', [1994] ECR I-05439 – *Tatry*

Advocate General 14 July 1994, C-68/93, Fiona Shevill and Others v Presse Alliance SA, [1995] ECR I-00415 – *Shevill*

Advocate General 10 June 1997, C-391/95, Van Uden Maritime BV, trading as Van Uden Africa Line, v Kommanditgesellschaft in Firma Deco-Line and Another, [1998] ECR I-07091 – *Van Uden*

Advocate General 15 January 2004, C-168/02, Rudolf Kronhofer v Marianne Maier and Others, [2004] ECR I-06009 – *Kronhofer*

Advocate General 16 September 2004, C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, [2006] ECR I-06509 – *GAT*

Advocate General 8 December 2005, C-539/03, Roche Nederland BV and Others v Frederick Primus and Milton Goldenberg, [2006] ECR I-06535 – *Roche Nederland*

Advocate General 24 May 2007, C-98/06, Freeport plc v Olle Arnoldsson, [2007] ECR I-08319 – *Freeport*

Advocate General 18 July 2007, C-175/06, Alessandro Tedesco v Tomasoni Fittings Srl and RWO Marine Equipment Ltd., [2007] ECR I-07929 – *Tedesco*  
J. von Hein (case note) Advocate General 18 July 2007, C-175/06, Alessandro Tedesco v Tomasoni Fittings Srl and RWO Marine Equipment Ltd., (2008)8(1) EuLF I-34

Advocate General 17 January 2008, C-462/06, Glaxosmithkline and Laboratoires Glaxosmithkline v Jean-Pierre Rouard, [2008] ECR I-03965 – *Glaxosmithkline*

Advocate General 18 December 2008, C-420/07, Meletis Apostolides v David Charles Orams and Linda Elizabeth Orams, [2009] ECR I-03571 – *Apostolides*

Advocate General 12 April 2011, C-145/10, Eva-Maria Painer – Standard VerlagsGmbH and Others, [2011] ECR I-12540 – *Painer*

Advocate General 16 February 2012, C-523/10, Wintersteiger AG v Products 4U Sondermaschinenbau GmbH, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62010CC0523&rid=3>> – *Wintersteiger*

Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 19, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> – *Folien Fischer*

## **Australia**

High Court of Australia 20 January 1905, Potter v. Broken Hill Pty. Co. Ltd., [1905] VLR 612, 618 – *Potter*

## **Austria**

OGH 16 December 2010, 17 Ob 13/10a, (2011)60(5) GRUR Int. 450

## **Belgium**

Hof van Cassatie 3 September 2000, (2001)50(1) GRUR Int. 73 – *Sanac/Variantsystemen*

Hof van Cassatie van België 1 October 2010, X v Universitair Medisch Centrum Utrecht and Others, [2011] 1 Tijdschrift@ipr.be (<http://www.ipr.be>), 73

Rechtbank van eerste aanleg te Brussel 12 May 2000, 2000/857/A, (2001)32(5) IIC 571 (= (2001)50(2) GRUR Int. 170) – *Röhm Enzyme*

## France

Cour de cassation 11 December 2001, (2002)91(2) Rev. crit. DIP 371, with case note H. Muir Watt

Cour d'appel d'Orléans 6 May 2003, (2004)93(1) Rev. crit. DIP 139, with case note H. Gaudemet-Tallon

Cour d'appel de Versailles 19 April 1993, (1995)84(1) Rev. crit. DIP 80, with case note G. Couchez

TGI Paris 4 May 1971, (1974)63 Rev. crit. DIP 110, with case note G. Bonet – *Yema*

TGI Paris 5 November 2003 (unreported), (2004)26(9) E.I.P.R. N151, with case note P. Véron

## Germany

RG 18 June 1890, Case No. 107/90 I, (1890)19(32-33) JW 280 – *Lampen*

RG 8 July 1930, Case No. 542/29 II, (1931)60(6-7) JW 428 – *Vacuum Oil*

RG 6 June 1934, Case No. I. 243/33, (1934)39(11) GRUR 657 – *Geschwindigkeitsmesser*

BGH 2 October 1956, I ZR 9/54, (1957)59(5) GRUR 215 – *Flava/Erdgold*

BGH 24 July 1957, I ZR 21/56, (1958)60(4) GRUR 189 – *Zeiß*

BGH 17 March 1994, I ZR 304/91, (1994)96(7) GRUR 530 – *Beta*

BGH 14 December 2006, I ZR 11/04, (2007)56(10) GRUR Int. 864 – *Aufarbeitung von Fahrzeugkomponenten*

BGH 1 February 2011, KZR 8/10, (2011)60(6) GRUR Int. 544 (= (2011)32(20) ZIP 975) – *Trägermaterial für Kartenformulare I*

P. Mankowski (case note) BGH 1 February 2011, KZR 8/10, (2011)27(8) EWiR 253

M. Weller (case note) BGH 1 February 2011, KZR 8/10, (2011) LMK 318709

BGH 29 January 2013, KZR 8/10, (2013)13(5) GRUR-RR 228 – *Trägermaterial für Kartenformulare II*

BPatG 16 October 1973, 32 W (pat) 82/72, BPatGE 17, 181

OLG Bremen 17 October 1991, 2 U 34/91, (1992)38(3) RIW 231

OLG Dresden 28 July 2009, 14 U 1008/08, IPRspr. 2009 No. 196, 504 (= InstGE 11, 163)

OLG Düsseldorf 25 March 1966, 2 U 93/65, (1968)17(3) GRUR Int. 100 – *Kunststofflacke*

OLG Düsseldorf 22 July 1999, 2 U 127/98, (2001)21(4) IPRax 336 – *Schussfadengreifer II*

OLG Düsseldorf 30 September 1999, 2 W 60/98, (2000)49(8-9) GRUR Int. 776 – *Impfstoff III*

OLG Düsseldorf 5 December 2002, 2 U 104/01, (2003)52(12) GRUR Int. 1030 – *GAT*

OLG Hamburg 14 January 2010, 3 U 133/08, cited in Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 17, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> – *Folien Fischer*

OLG Hamm 29 January 1936, 3 U 143/35, (1936)41(9) GRUR 744 – *Einbruchkerbmaschine*

OLG München 25 October 2001, 6 U 5508/00, InstGE 2, 61

LG Bremen 28 March 1991, 12 O 729/89, (1991)37(5) RIW 416

LG Düsseldorf 18 March 1958, (1958)7(8/9) GRUR Int. 430 – *Hohlkörper*

LG Düsseldorf 27 October 1966, 4 O 127/63, (1968)17(3) GRUR Int. 101 – *Frauenthermometer*

LG Düsseldorf 1 February 1994, 4 O 193/87, LG Düsseldorf Entscheidungen 1998(1)1 – *Kettenbandförderer III*

LG Düsseldorf 16 January 1996, 4 O 5/95, LG Düsseldorf Entscheidungen 1996(1)1 – *Reinigungsmittel für Kunststoffverarbeitungsmaschinen*

LG Düsseldorf 25 August 1998, 4 O 165/97, (1999)48(5) GRUR Int. 455 – *Schussfadengreifer I*

LG Düsseldorf 25 March 1999, 4 O 198/97, (1999)48(8-9) GRUR Int. 775 – *Impfstoff II*

LG Düsseldorf 31 May 2001, 4 O 128/00, (2001)50(11) GRUR Int. 983 – *Schwungrad*

LG Frankfurt 25 March 2010, 2-03 O 580/08, IPRspr. 2010 No. 220, 561 (=(2010)41(5) AfP 509)

LG Hamburg 9 May 2008, 315 O 410/07, cited in Advocate General 19 April 2012, C-133/11, Folien Fischer AG and Fofitec AG v Ritrama SpA, para. 16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62011CC0133&rid=4>> – *Folien Fischer*

LG Leipzig 27 May 2008, 5 O 757/06, IPRspr. 2008 No. 96, 314 (= InstGE 9, 167)

LG München I 20 September 2000, 21 O 5046/99, InstGE 1, 236

LG München I 23 October 2008, 7 O 17209/07, InstGE 10, 178

## Italy

Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 264 – *Verpackungsmaschine II*

W. Wurmnest (case note) Corte di Cassazione (Unified Civil Senates) 19 December 2003, Case No. 19550, (2005)54(3) GRUR Int. 265

Tribunale di Bologna 16 September 1998, I ZR 236/97, (2000)49(11-12) GRUR Int. 1021 – *Verpackungsmaschine I*

D. Stauder (case note) Tribunale di Bologna 16 September 1998, I ZR 236/97, (2000)49(11-12) GRUR Int. 1022

Tribunale di Milano 21 March 2002 (unreported), (2004)26(6) E.I.P.R. N91

L. Adami and M. Franzosi (case note) Tribunale di Milano 21 March 2002 (unreported), (2004)26(6) E.I.P.R. N91

Tribunale di Milano 26 March 2007, Case No. 3773, (2008)3(1) J.I.P.L.P. 6

I. Betti (case note) Tribunale di Milano 26 March 2007, Case No. 3773, (2008)3(1) J.I.P.L.P. 6

## Netherlands

HR 24 November 1989, Focus Veilig BV (Interlas) (Netherlands) v The Lincoln Electric Co. (US) and Others, NJ 1992, 404 – *Interlas*

HR 2 March 2001, C99/200HR, A.T. van der Plas v W.H. Guis, NJ 2003, 240, with case note P. Vlas

HR 21 June 2002, C01/241HR, Spray Network N.V. v Telenor Venture AS and Others, NJ 2002, 563, with case note P. Vlas

HR 19 March 2004, C02/110HR, Koninklijke Philips Electronics N.V. v Postech Corporation and Others, NJ 2007, 585, with case note P. Vlas – *Postech*

HR 30 November 2007, C02/228HR and C02/280HR, Roche Nederland BV (Netherlands) and Others v Dr. F.J. Primus and Dr. M.D. Goldenberg, NJ 2008, 77 – *Roche Nederland*

HR 7 November 2008, 07/12641, Realchemie Nederland B.V. v Fa. Feinchemie Schwebda GmbH (Germany), RvdW 2008, 1020

Gerechtshof 's-Gravenhage 12 December 1996, Hoffmann-La Roche AG v Organon Teknika B.V. and Others, (1998)47(1) GRUR Int. 58, with case note D. Stauder

Gerechtshof 's-Gravenhage 22 January 1998, Evans Medical Ltd v Chiron Corporation, [2001] E.N.P.R. 9 – *Evans Medical*

Gerechtshof 's-Gravenhage 23 April 1998, Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others, [1999] F.S.R. 352 – *Expandable Graft Partnership II*

Gerechtshof 's-Gravenhage 23 August 2007, Bacardi & Company Limited v Food Brokers B.V. and Others, available at WWW <[http://oami.europa.eu/pdf/natcourt/Bacardi-Bat\\_Beverage.pdf](http://oami.europa.eu/pdf/natcourt/Bacardi-Bat_Beverage.pdf)> – *Bacardi*

Gerechtshof 's-Gravenhage 12 July 2011, Yellow Page Marketing B.V. (YPM) v Yell Limited, IER 2011, 61, available at WWW <<http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHSGR:2011:BR1364>> – *Yellow Pages*

Gerechtshof 's-Gravenhage 20 May 2014, Apple Inc. v Samsung Electronics Co. Limited and Others, IER 2014, 47, available at WWW <http://uitspraken.rechtspraak.nl/inziendocument?id=ECLI:NL:GHDHA:2014:1727> – *Apple v Samsung*

Rb. Amsterdam 25 January 1926, Luft-Verkehrs-Ges. m. b. H. (Germany) v A. H. G. Fokker (Netherlands), with case note C.D. Salomonson, (1928)33(1) GRUR 25 – *Fokker*

Rb. Amsterdam 13 May 1975, Eurotex Italia (Italy) v C. Rensel (Netherlands), NJ 1976, 323 with case note J.C. Schultsz, and (1975)22 N.I.L.R. 206 with case note J.P. Verheul

Rb. 's-Gravenhage 5 January 1993, Rhône Poulenc Rorer SA (France) and Others v Pharmachemie BV (Netherlands) and Others, IER 1993, 15 – *Rhône Poulenc*

Rb. 's-Gravenhage 29 October 1997, Case No. 97/1367, Julio Cesar Palmaz and Others v Boston Scientific BV and Others, and Case No. 97/1368, Expandable Grafts Partnership and Others v Boston Scientific B.V. and Others, [1998] F.S.R. 199 – *Expandable Grafts I*

Rb. 's-Gravenhage 20 May 1998, Baxter International Inc. v Pharmacia & Upjohn AB and Others, IER 1998, 31

Rb. 's-Gravenhage 15 July 1998, Augustine Medical Inc. v Mallinckrodt Medical BV and Others, IER 1998, 40

Rb. 's-Gravenhage 29 September 1999, DSM NV and Another v Orffa Nederland Feed BV and Others, IER 2000, 8

Rb. 's-Gravenhage 16 February 2000, SciMed Life Systems Inc (USA) v Arterial Vascular Engineering BV and Others, BIE 2004, 9 – *Ballon katheter I*

Rb. 's-Gravenhage 19 June 2002, Freelift BV (Netherlands) and Freelift Limited (UK) v Stannah Stairlifts Limited and Stannah Lift Services Limited (UK), NJkort 2002, 60 – *Freelift*

Rb. 's-Gravenhage 9 August 2006, Case No. 257421 / HA ZA 06-167, and Case No. 257423 / HA ZA 06, Societa Italiana per lo Sviluppo dell'Elettronica S.I.S.V.E.L. SpA v Sandisk Corporation and Others, NJF 2006, 540 – *Sisvel*

Rb. 's-Gravenhage 21 September 2006, Bettacare Limited (UK) v H3 Products BV (Netherlands) and Another, BIE 2006, 91 – *Bettacare*

Rb. 's-Gravenhage 7 March 2007, Fleuren Presspack BV (Netherlands) v Vof Handelsonderneming Ruvo (Netherlands), and Ruvo BV (Netherlands) v Fleuren Presspack BV (Netherlands), BIE 2007, 125 – *Fleuren*

Rb. Middelburg 24 April 1987, Case No. KG40/1987, De Stichting Natuur en Milieu and Others (Netherlands) v NV Verenigde Energiebedrijven van het Scheldeland EBES (Belgium), NJ 1989, 744

Rb. Rotterdam 20 February 1978, Mesch-Vermögensanlage GmbH-Emissions KG (Germany) v Orspan SA (Spain), NJ 1978, 621, with case note J.C. Schultsz

Rb. Utrecht 15 October 2003, Case No. 152725, Rost Chemicals BV (Netherlands) v NV De Craene (Belgium) and Others, NJF 2004, 73 – *Rost Chemicals*

## **Sweden**

Högsta Domstolen 14 June 2000, Ö 2095-99, (2001)32(2) IIC 231 (= (2001)50(2) GRUR Int. 178) – *Flootek*

## **Switzerland**

BGer 23 October 2006, 4C.210/2006, (2007)56(6) GRUR Int. 534

BGer 13 March 2007, 4C.318/2006, (2008)28(6) IPRax 544

Handelsgericht Zürich 16 October 2006, (2007)56(3) GRUR Int. 258

## **United Kingdom**

Supreme Court 27 July 2011, Lucasfilm Ltd v Ainsworth, [2011] UKSC 39, [2011] F.S.R. 41 – *Lucasfilm v Ainsworth II*

House of Lords 8 September 1893, The British South Africa Company v The Companhia de Moçambique and Others, [1893] A.C. 602 (= [1891] All ER Rep 640) – *Moçambique*

House of Lords 27 October 1970, American Cyanamid Company (Dann's) Patent, [1970] F.S.R. 443 – *American Cyanamid Company (Dann's) Patent*

House of Lords 19 November 1986, Spiliada Maritime Corporation v Cansulex Ltd, [1986] 3 W.L.R. 972, [1987] A.C. 460 – *Spiliada*

Outer House (Scotland) 13 December 1988, James Burrough Distillers plc v Speymalt Whisky Distributors Ltd., [1989] S.L.T. 561 – *James Burrough Distillers*

Court of Appeal, and House of Lords 9 May 1991, Asahi Kasei Kogyo KK's Application, [1991] R.P.C. 485 – *Asahi Kasei Kogyo KK's Application*

Court of Appeal 27 June 1991, Mölnlycke AB and Another v Procter & Gamble Limited and Others (No. 4), [1992] R.P.C. 21 – *Mölnlycke AB and Another v Procter & Gamble Limited and Others*

Court of Appeal 21 January 1999, Gareth Pearce v Ove Arup Partnership Ltd, [1999] F.S.R. 525 – *Pearce II*

Court of Appeal 12 June 2003, Motorola Credit Corp v Uzan And Others (No 2), [2003] EWCA Civ 752, [2004] 1 W.L.R. 113 – *Motorola Credit*

Court of Appeal 6 March 2008, Research in Motion UK Ltd v Visto Corp, [2008] EWCA Civ 153, [2008] F.S.R. 20 – *Research in Motion*

Court of Appeal 16 December 2009, Lucasfilm Ltd v Ainsworth, [2009] EWCA Civ 1328, [2010] F.S.R. 10 – *Lucasfilm v Ainsworth I*

High Court of Justice (Exchequer Chamber) 23 June 1870, Phillips v Eyre, [1870-71] L.R. 6 Q.B. 1 – *Phillips and Eyre*

High Court of Justice (Chancery Division) 22 April 1986, Def Lepp Music and Others v Stuart-Brown and Others, [1986] R.P.C. 273 – *Def Lepp Music*

High Court of Justice (Chancery Division) 2 February 1990, Tyburn Productions Limited v Doyle, [1990] R.P.C. 185 – *Tyburn*

High Court of Justice (Chancery Division) 24 May 1991, L.A. Gear Incorporated v Gerald Whelan & Sons Limited, [1991] F.S.R. 670 – *L.A. Gear*

High Court of Justice (Chancery Division) 9 December 1994, Plastus Kreativ AB v Minnesota Mining and Manufacturing Co, [1995] R.P.C. 438 – *Plastus Kreativ*

High Court of Justice (Chancery Division – Patents Court) 23 January 1996, Organon Teknika Ltd v Hoffmann La Roche AG, [1996] F.S.R. 383, (1996)19(4) I.P.D. 19031 – *Organon Teknika*

High Court of Justice (Chancery Division – Patents Court) 3 July 1996, Chiron Corporation v Evans Medical Ltd and Others, [1996] F.S.R. 863 – *Chiron Corporation*

High Court of Justice (Chancery Division) 7 March 1997, Gareth Pearce v Ove Arup Partnership Ltd and Others, [1997] F.S.R. 641 – *Pearce I*

High Court of Justice (Chancery Division) 26 March 1997, Coin Controls Limited v Suzo International (U.K.) Limited and Others, [1997] F.S.R. 660 – *Coin Controls*

High Court of Justice 14 and 16 October 1997, and Court of Appeal 27 October 1997, Fort Dodge Animal Health Limited and Others v AKZO Nobel N.V. and Another, [1998] F.S.R. 222 – *Fort Dodge*

High Court of Justice (Chancery Division – Patents Court) 29 January 1999, Sepracor Inc. v Hoechst Marriion Roussel Limited and Others, [1999] F.S.R. 746 – *Sepracor*



High Court of Justice (Chancery Division – Patents Court) 26 March 2007, *European Central Bank v Document Security Systems Incorporated*, [2007] EWHC 600 (Pat) – *European Central Bank*

High Court of Justice (Chancery Division – Patents Court) 7 February 2008, *Knorr-Bremse Systems for Commercial Vehicles LDT v Haldex Brake Products GmbH*, [2008] EWHC 156 (Pat), [2008] F.S.R. 30 – *Knorr-Bremse*

High Court of Justice (Chancery Division – Patents Court) 17 December 2009, *Mölnlycke Health Care AB v BSN Medical Ltd*, [2009] EWHC 3370 (Pat), [2010] I.L.Pr. 9 – *Mölnlycke Health Care AB v BSN Medical Ltd*

Darcy v. All(e)in (1602) Co Rep 84b, 1 W.P.C. 1

Clothworkers of Ipswich Case (1614) Godbolt 252

## United States

Supreme Court 28 February 1979, Case No. 77-1413, *Jane Aronson v Quick Point Pencil Company*, 440 U.S. 257, 99 S.Ct. 1096, available at WWW <<http://openjurist.org/print/31032>> – *Aronson v Quick Point Pencil Company*

Supreme Court 15 May 2006, Case No. 05-130, *eBay Inc. et al. v MercExchange, L.L.C.*, 547 U.S. 388, available at WWW <<http://openjurist.org/547-us-388-ebay-inc-v-mercexchange-llc>> – *eBay Inc. et al. v Mercexchange, L.L.C.*

Supreme Court 30 April 2007, Case No. 05-1056, *Microsoft Corp. v AT&T Corp.*, 127 S. Ct. 1746 (2007), available at WWW <<http://caselaw.lp.findlaw.com/scripts/getcase.pl?court=US&vol=550&invol=437>> – *Microsoft Corp. v AT&T Corp.*

United States Court of Appeals, Second Circuit 1 June 1956, Case No. 251, Docket 23831, *Vanity Fair Mills v The T. Eaton Co. Limited and John David Eaton*, 234 F.2d 633, available at WWW <<http://openjurist.org/print/78375>> – *Vanity Fair Mills*

United States Court of Appeals, Third Circuit 3 April 1979, Case No. 78-1845, *Mannington Mills, Inc. v Congoleum Corporation*, 595 F.2d 1287, available at WWW <<http://openjurist.org/print/208142>> – *Mannington Mills*

United States Court of Appeals, Federal Circuit 29 April 1994, Case No. 93-1507, *Mars Incorporated v Kabushiki-Kaisha Nippon Conlux*, 24 F.3d 1368, available at WWW <<http://openjurist.org/print/522745>> – *Mars Incorporated*

United States Court of Appeals, Federal Circuit 2 March 2005, Case No. 04-1234, *Eolas Technologies Incorporated and the Regents of the University of California v Microsoft Corporation*, 399 F.3d 1325, available at WWW <<http://openjurist.org/print/559194>> – *Eolas Technologies Incorporated*

United States Court of Appeals, Federal Circuit 13 July 2005, Case No. 04-1285, AT&T Corp. v Microsoft Corp., 414 F.3d 1366, available at WWW <<http://openjurist.org/print/563685>> – *AT&T Corp. v Microsoft Corp.*

United States Court of Appeals, Federal Circuit 2 August 2005, Case No. 03-1615, Ntp, Inc. v Research in Motion, Ltd., 418 F.3d 1282, available at WWW <<http://openjurist.org/print/564309>> – *Ntp, Inc v Research in Motion, Ltd*

United States Court of Appeals, Federal Circuit 1 February 2007, Case No. 05-1238, Jan K. Voda, M.D. v Cordis Corporation, 476 F.3d 887, available at WWW <<https://law.resource.org/pub/us/case/reporter/F3/476/476.F3d.887.05-1238.html>> – *Voda v Cordis*

United States District Court, S. D. New York 24 June 1981, Forbo-Giubiasco S. A. v Congoleum Corp., 516 F.Supp 1210, available at WWW <[http://www.leagle.com/decision/19811726516FSupp1210\\_11550](http://www.leagle.com/decision/19811726516FSupp1210_11550)> – *Forbo-Giubiasco*

## BIBLIOGRAPHY

**Adams (1995)17(10) E.I.P.R. 497**

J. N. Adams, 'Choice of forum in patent disputes' (1995)17(10) E.I.P.R. 497

**Adolphsen (2006)11 ZZPInt 137**

J. Adolphsen, 'Das Territorialitätsprinzip im europäischen Patentrecht – Zugleich eine Besprechung der neuesten Rechtsprechung des EuGH' (2006)11 ZZPInt 137

**Adolphsen (2007)27(1) IPRax 15**

J. Adolphsen, 'Renationalisierung von Patentstreitigkeiten in Europa' (2007)27(1) IPRax 15

**Adolphsen 2009**

J. Adolphsen, *Europäisches und internationales Zivilprozessrecht in Patentsachen* (2<sup>nd</sup> edn Carl Heymanns Verlag GmbH, Köln, München 2009)

**Ahrens (2009)111(3-4) GRUR 196**

H.-J. Ahrens, 'Die Koordination der Verfahren zur Schutzentziehung und wegen Verletzung von registrierten Rechten des Geistigen Eigentums' (2009)111(3-4) GRUR 196

**Almeida Cruz/Desantes Real/Jenard Report**

M. de Almeida Cruz, M. Desantes Real and P. Jenard, Report on the Convention on the accession of the Kingdom of Spain and the Portuguese Republic to the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters and to the Protocol on its interpretation by the Court of Justice with the adjustments made to them by the Convention on the accession of the Kingdom of Denmark, of Ireland and of the United Kingdom of Great Britain and Northern Ireland and the adjustments made to them by the Convention on the accession of the Hellenic Republic, OJ C189 of 28 July 1990, pp. 35-56, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1990\\_189\\_R\\_0035\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1990_189_R_0035_01&rid=1)>

**Althammer (2006)26(6) IPRax 558**

C. Althammer, 'Die Anforderungen an die „Ankerklage“ am forum connexitatis (Art.6 Nr.1 EuGVVO)' (2006)26(6) IPRax 558

**Althammer (2008)28(3) IPRax 228**

C. Althammer, 'Die Auslegung der Europäischen Streitgenossenzuständigkeit durch den EuGH – Quelle nationaler Fehlinterpretation?' (2008)28(3) IPRax 228

**Ancel (2007)8(1) ERA Forum 27**

M.-E. Ancel, 'L'arrêt *GAT*: une occasion manquée pour la défense de la propriété industrielle en Europe – The *GAT* judgment: a missed opportunity for the defence of industrial property in Europe' (2007)8(1) ERA Forum 27

**Arnold (1990)12(7) E.I.P.R. 254**

R. Arnold, 'Can one sue in England for infringement of foreign intellectual property rights?' (1990)12(7) E.I.P.R. 254

**Artelsmair 2005**

G. Artelsmair, 'A Comprehensive Patent System Needed for Europe' in A. Kur, S. Luginbühl and E. Waage (eds), »... und sie bewegt sich doch!« – *Patent Law on the Move, Festschrift für Gert Kolle und Dieter Stauder zum 65. Geburtstag am 25. April 2005 und 20. Oktober 2005* (Carl Heymanns Verlag KG, Köln, Berlin, München 2005)

**Audit 2005**

B. Audit, 'Le critère d'application des conventions judiciaires multilatérales' in *Le droit international privé: esprit et méthodes; Mélanges en l'honneur de Paul Lagarde*, pp. 19-35 (Editions Dalloz, Paris 2005)

**Auer 2014 (Geimer & Schütze, Internationaler Rechtsverkehr)**

S. Auer in R. Geimer and R.A. Schütze (eds), *Internationaler Rechtsverkehr in Zivil- und Handelssachen; Loseblatt-Handbuch mit Texten, Kommentierungen und Länderberichten* (48<sup>th</sup> update Verlag C.H. Beck oHG, München 2014)

**Austin (2009)40(4) IIC 393**

G. W. Austin, 'The Concept of "Justiciability" in Foreign Copyright Infringement Cases' (2009)40(4) IIC 393

**Bach (2011)44(4) ZRP 97**

I. Bach, 'Drei Entwicklungsschritte im europäischen Zivilprozessrecht – Kommissionsentwurf für eine Reform der EuGVVO' (2011)44(4) ZRP 97

**Bacher & Melullis 2006 (Benkard – Patentgesetz)**

K. Bacher and K.-J. Melullis in *Benkard – Patentgesetz, Gebrauchsmustergesetz* (10<sup>th</sup> edn Verlag C.H. Beck oHG, München 2006)

**Bainbridge 2012**

D. Bainbridge, *Intellectual Property* (9<sup>th</sup> edn Pearson Education Limited, Harlow 2012)

**Basedow 1982 (Hb-IZVR)**

J. Basedow in H.-J. Herrmann, J. Basedow and J. Kropholler, *Handbuch des Internationalen Zivilverfahrensrechts Band I* (J.C.B. Mohr (Paul Siebeck), Tübingen 1982)

**Basedow & Heinze 2011**

J. Basedow and C. Heinze, 'Kartellrechtliche Schadensersatzklagen im europäischen Gerichtsstand der Streitgenossenschaft (Art. 6 Nr. 1 EuGVO)' in S. Bechtold, J. Jickeli and M. Rohe (eds), *Recht, Ordnung und Wettbewerb, Festschrift zum 70. Geburtstag von Wernhard Möschel*, pp. 63-84 (1<sup>st</sup> edn Nomos Verlagsgesellschaft, Baden-Baden 2011)

**Behr (1992)41(8-9) GRUR Int. 604**

V. Behr, 'Internationale Tatortszuständigkeit für vorbeugende Unterlassungsklagen bei Wettbewerbsverstößen' (1992)41(8-9) GRUR Int. 604

**Bently & Sherman 2001**

L. Bently and B. Sherman, *Intellectual Property Law* (Oxford University Press, Oxford 2001)

**Berger (2005)54(6) GRUR Int. 465**

C. Berger, 'Die internationale Zuständigkeit bei Urheberrechtsverletzungen in Internet-Websites aufgrund des Gerichtsstands der unerlaubten Handlung nach Art. 5 Nr. 3 EuGVO' (2005)54(6) GRUR Int. 465

**Bertrams (1995)44(3) GRUR Int. 193**

H. Bertrams, 'Das grenzüberschreitende Verletzungsverbot im niederländischen Patentrecht' (1995)44(3) GRUR Int. 193

**Bettinger & Thum (1999)48(8-9) GRUR Int. 659**

T. Bettinger and D. Thum, 'Territoriales Markenrecht im Global Village – Überlegungen zu internationaler Tatortzuständigkeit, Kollisionsrecht und materiellem Recht bei Kennzeichenkonflikten im Internet' (1999)48(8-9) GRUR Int. 659

**Bisschop (2007)98(6) Mitt. 247**

K. Bisschop, 'Aktuelles aus den Niederlanden – Cross Border lebt' (2007)98(6) Mitt. 247

**Bitter (2008)28(2) IPRax 96**

A.-K. Bitter, 'Auslegungszusammenhang zwischen der Brüssel I-Verordnung und der künftigen Rom I-Verordnung' (2008)28(2) IPRax 96

**Blumer (2001)9 Tex. Intell. Prop. L.J. 329**

F. Blumer, 'Jurisdiction and Recognition in Transatlantic Patent Litigation' (2001)9 Tex. Intell. Prop. L.J. 329

**Borchers (2003)50 N.I.L.R. 401**

P. J. Borchers, 'Tort and Contract Jurisdiction via the Internet: The 'Minimum Contacts' Test and the Brussels Regulation Compared' (2003)50 N.I.L.R. 401

**Bornkamm 2000**

J. Bornkamm, 'Grenzüberschreitende Unterlassungsklagen im Urheberrecht?' in J. Schwarze (ed), *Rechtsschutz gegen Urheberrechtsverletzungen und Wettbewerbsverstöße in grenzüberschreitenden Medien*, pp. 127-141 (1<sup>st</sup> edn Nomos Verlagsgesellschaft, Baden-Baden 2000)

**Borrás 2008**

A. Borrás, 'Interactions between Community Instruments and International Conventions (Including the Draft New Lugano Convention) in Intellectual Property Matters' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 237-255 (Kluwer Law International, Alphen aan den Rijn 2008)

**Borrás & Hausmann 2012 (unalex Kommentar)**

A. Borrás and R. Hausmann in T. Simons and R. Hausmann (eds), *unalex Kommentar, Brüssel I-Verordnung – Kommentar zur VO (EG) 44/2001 und zum Übereinkommen von Lugano* (IPR Verlag GmbH, München 2012)

**Bossung (2002)51(6) GRUR Int. 463**

O. Bossung, 'Unionspatent statt Gemeinschaftspatent – Entwicklung des europäischen Patents zu einem Patent der Europäischen Union' (2002)51(6) GRUR Int. 463

**Bragiel (1999)2 I.P.Q. 135**

E. Bragiel, “A funny thing happened on the way to the forum” – actionability in the United Kingdom of infringements of intellectual property committed abroad’ (1999)2 I.P.Q. 135

**Brandi-Dohrn (2012)43(4) IIC 372**

M. Brandi-Dohrn, ‘Some Critical Observations on Competence and Procedure of the Unified Patent Court’ (2012)43(4) IIC 372

**Briggs (2011)2 L.M.C.L.Q. 157**

A. Briggs, ‘The Brussels *Ibis* Regulation appears on the horizon – *Brussels Ibis Regulation*’ (2011)2 L.M.C.L.Q. 157

**Briggs & Rees 2009**

A. Briggs and P. Rees (ed), *Civil Jurisdiction and Judgments* (5<sup>th</sup> edn informa, London 2009)

**Brinkhof BIE 1991, 66**

J.J. Brinkhof, ‘Inbreuken met een internationaal karakter op industriële eigendomsrechten’ BIE 1991, 66

**Brinkhof (1994)16(8) E.I.P.R. 360**

J.J. Brinkhof, ‘Could the President of the District Court of The Hague take measures concerning the infringement of foreign patents?’ (1994)16(8) E.I.P.R. 360

**Brinkhof (1997)46(6) GRUR Int. 489**

J.J. Brinkhof, ‘Geht das grenzüberschreitende Verletzungsverbot im niederländischen einstweiligen Verfügungsverfahren zu weit?’ (1997)46(6) GRUR Int. 489

**Brinkhof (2000)31(6) IIC 706**

J.J. Brinkhof, ‘The Enforcement of Patent Rights in the Netherlands’ (2000)31(6) IIC 706

**Buchner (2005)54(12) GRUR Int. 1004**

B. Buchner, ‘Rom II und das Internationale Immaterialgüter- und Wettbewerbsrecht’ (2005)54(12) GRUR Int. 1004

**Bukow 2003**

J. Bukow, *Verletzungsklagen aus gewerblichen Schutzrechten – Die internationale Zuständigkeit nach dem EuGVÜ bzw. der EuGVVO* (Verlag Dr. Kovač, Hamburg 2003)

**Bukow 2007**

J. Bukow, ‘Die Entscheidung GAT/LUK und ihre Konsequenzen – Vom Ende der “Cross-Border-Injunctions”’ in M. Grosch and E. Ullmann (eds), *Gewerbliche Schutzrechte und ihre Durchsetzung, Festschrift für Tilmann Schilling zum 70. Geburtstag am 29. Juli 2007*, pp. 59-71 (Carl Heymanns Verlag GmbH, Köln, Berlin, München 2007)

**Cadet (2013)24(6) EuZW 218**

F. Cadet, ‘Main features of the revised Brussels I Regulation’ (2013)24(6) EuZW 218

**Carl 2007**

I. Carl, *Einstweiliger Rechtsschutz bei Torpedoklagen* (Peter Lang GmbH, Frankfurt am Main 2007)

**Chan (2008)18 Alb. L.J. Sci. & Tech. 1**

E. Chan, 'Asserting Foreign Patent Claims in U.S. Federal Courts: What's Left after *Voda v. Cordis?*' (2008)18 Alb. L.J. Sci. & Tech. 1

**Coester-Waltjen 1996**

D. Coester-Waltjen, 'Die Bedeutung des EuGVÜ und des Luganer Abkommens für Drittstaaten' in A. Heldrich and T. Uchida, *Festschrift für Hideo Nakamura zum 70. Geburtstag am 2. März 1996*, pp. 89-115 (Seibunda Verlag, Tokyo 1996)

**Coester-Waltjen 2008**

D. Coester-Waltjen, 'Konnexität und Rechtsmissbrauch – zu Art.6 Nr.1 EuGVVO' in D. Baetge, J. von Hein and M. von Hinden, *Die richtige Ordnung – Festschrift für Jan Kropholler zum 70. Geburtstag*, pp. 747-758 (Mohr Siebeck, Tübingen 2008)

**Cohen (1997)19(7) E.I.P.R. 379**

L. J. Cohen, 'Intellectual property and the Brussels Convention: an English perspective' (1997)19(7) E.I.P.R. 379

**Collins 1993 (Dicey and Morris)**

L. Collins and others (eds), *Dicey and Morris on the Conflict of Laws, Vol. 2* (12<sup>th</sup> edn Sweet & Maxwell Limited, London 1993)

**Collins 2006 (Dicey and Morris)**

L. Collins and others (eds), *Dicey and Morris on the Conflict of Laws, Vol. 2* (14<sup>th</sup> edn Sweet & Maxwell Limited, London 2006)

**Corneloup & Althammer 2012 (unalex Kommentar)**

S. Corneloup and C. Althammer in T. Simons and R. Hausmann (eds), *unalex Kommentar, Brüssel I-Verordnung – Kommentar zur VO (EG) 44/2001 und zum Übereinkommen von Lugano* (IPR Verlag GmbH, München 2012)

**Cornish (1996)45(4) GRUR Int. 285**

W.R. Cornish, 'Intellectual Property Infringement and Private International Law: Changing the Common Law Approach' (1996)45(4) GRUR Int. 285

**Cornish & Llewelyn (2000)31(6) IIC 627**

W. Cornish and D. Llewelyn, 'Articles – The Enforcement of Patents in the United Kingdom' (2000)31(6) IIC 627

**Cornish & Llewelyn 2003**

W. Cornish and D. Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (5<sup>th</sup> edn Sweet & Maxwell Limited, London 2003)

**Council of the European Union 2011 (Council Decision of March 2011)**

Council of the European Union, Council Decision of 10 March 2011, authorising enhanced cooperation in the area of the creation of unitary patent protection (2011/167/EU), OJ L76 of 22 March 2011, pp. 53-55, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:076:0053:0055:en:PDF>>

**Council of the European Union 2011 (Non-Paper 2011)**

Council of the European Union, Non-Paper ‘Creating a Unified Patent Litigation System - Orientation debate’, 10630/11, Brussels 26 May 2011, available at WWW  
<<http://register.consilium.europa.eu/pdf/en/11/st10/st10630.en11.pdf>>

**Council of the European Union 2011 (Council Proposal 2011)**

Council of the European Union, ‘Proposal for a Regulation of the Council and the European Parliament implementing enhanced cooperation in the area of the creation of unitary patent protection, and Proposal for a Council Regulation implementing enhanced cooperation in the area of unitary patent protection with regard to the applicable translation arrangements - General Approach’, 11328/11, Brussels 23 June 2011, available at WWW  
<<http://register.consilium.europa.eu/pdf/en/11/st11/st11328.en11.pdf>>

**Council of the European Union 2012 (Conclusions 2012)**

Council of the European Union, Conclusions, EUCO 76/12, Brussels 29 June 2012, available at WWW  
<[http://www.consilium.europa.eu/uedocs/cms\\_data/docs/pressdata/en/ec/131388.pdf](http://www.consilium.europa.eu/uedocs/cms_data/docs/pressdata/en/ec/131388.pdf)>

**Council of the European Union 2012 (Press Release 10-11 December 2012)**

Council of the European Union, Press Release, 17410/12, Brussels 10-11 December 2012, available at WWW  
<[http://www.consilium.europa.eu/uedocs/cms\\_data/docs/pressdata/en/intm/134226.pdf](http://www.consilium.europa.eu/uedocs/cms_data/docs/pressdata/en/intm/134226.pdf)>

**Council of the European Union 2012 (Press Release 17 December 2012)**

Council of the European Union, Press Release, 17824/12, Brussels 17 December 2012, available at WWW <<http://register.consilium.europa.eu/pdf/en/12/st17/st17824.en12.pdf>>

**Council of the European Union 2013 (Press Release 19 February 2013)**

Council of the European Union, Press Release, 6590/13, Brussels 19 February 2013, available at WWW <<http://register.consilium.europa.eu/pdf/en/13/st06/st06590.en13.pdf>>

**Czernich, Tiefenthaler & Kodek 2009**

D. Czernich, S. Tiefenthaler and G.E. Kodek, *Europäisches Gerichtsstands- und Vollstreckungsrecht; EuGVVO, Lugano Übereinkommen, VO Zuständigkeit in Ehesachen („Brüssel IIa-VO“); Kurzkomentar* (3<sup>rd</sup> edn LexisNexis, Wien 2009)

**Dagg (2003)94(1) Mitt. 1**

N. Dagg, “‘TO STAY... OR NOT TO STAY’ – Ein europäischer Blick auf die Aussetzungspraxis in Patentrechtsstreitigkeiten während anhängiger EPA-Einspruchsverfahren’ (2003)94(1) Mitt. 1

**De Jong (2005)27(2) E.I.P.R. 75**

P. de Jong, ‘The Belgian torpedo: from self propelled armament to jaded sandwich’ (2005)27(2) E.I.P.R. 75

**De Lima Pinheiro 2012 (Magnus & Mankowski)**

L. de Lima Pinheiro in U. Magnus and P. Mankowski (eds), *European Commentaries on Private International Law – Brussels I Regulation* (2<sup>nd</sup> edn sellier european law publishers GmbH, Munich 2012)



**De Miguel Asensio (2007)16 AIDA 105**

P.A. De Miguel Asensio, 'Cross-Border Adjudication of Intellectual Property Rights and Competition between Jurisdictions' (2007)16 AIDA 105

**De Miguel Asensio 2010**

P.A. de Miguel Asensio, 'Recognition and Enforcement of Judgments in Intellectual Property Litigation: The CLIP Principles' in J. Basedow, T. Kono and A. Metzger (eds), *Intellectual Property in the Global Arena – Jurisdiction, Applicable Law, and the Recognition of Judgements in Europe, Japan and the US*, pp. 239-292 (Mohr Siebeck, Tübingen 2010)

**De Miguel Asensio 2013 (CLIP Principles)**

P. de Miguel Asensio in European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP) (ed), *Conflict of Laws in Intellectual Property – The CLIP Principles and Commentary* (1<sup>st</sup> edn Oxford University Press, Oxford 2013)

**De Miguel Asensio (2014)45(8) IIC 868**

P.A. De Miguel Asensio, 'Regulation (EU) No. 542/2014 and the International Jurisdiction of the Unified Patent Court' (2014)45(8) IIC 868

**De Vecchi Lajolo (2013)16(7) MMR 422**

V. De Vecchi Lajolo, "'Torpedoklagen" bei Persönlichkeitsrechtsverletzungen im Internet – Forum shopping in der Wahl des Gerichtsstands' (2013)16(7) MMR 422

**De Visscher (2012)61(3) GRUR Int. 214**

F. de Visscher, 'European Unified Patent Court: Another More Realistic and More Equitable Approach Should be Examined' (2012)61(3) GRUR Int. 214

**Dessemontet 2010**

F. Dessemontet, 'The ALI Principles: Intellectual Property in Transborder Litigation' in J. Basedow, T. Kono and A. Metzger (eds), *Intellectual Property in the Global Arena – Jurisdiction, Applicable Law, and the Recognition of Judgements in Europe, Japan and the US*, pp. 31-48 (Mohr Siebeck, Tübingen 2010)

**Dickinson (2010)30(3) IPRax 203**

A. Dickinson, 'Provisional Measures in the "Brussels I" Review – Disturbing the Status Quo?' (2010)30(3) IPRax 203

**Domej (2008)28(6) IPRax 550**

T. Domej, 'Negative Feststellungsklagen im Deliktsgerichtsstand' (2008)28(6) IPRax 550

**Domej (2014)78 RabelsZ 508**

T. Domej, 'Die Neufassung der EuGVVO – Quantensprünge im europäischen Zivilprozessrecht' (2014)78 RabelsZ 508

**Drexel 2015 (Münchener Kommentar zum BGB)**

F.J. Säcker, R. Rixecker and H. Oetker (eds), *Münchener Kommentar zum Bürgerlichen Gesetzbuch, Band 11: Internationales Privatrecht II, Internationales Wirtschaftsrecht, Einführungsgesetz zum Bürgerlichen Gesetzbuche (Art. 25-248)* (6<sup>th</sup> edn Verlag C. H. Beck oHG, München 2015)

**Dreyfuss (2001) U. Ill. L. Rev. 421**

R. C. Dreyfuss, 'An Alert to the Intellectual Property Bar: The Hague Judgments Convention' (2001) U. Ill. L. Rev. 421

**Dreyfuss 2009**

R. Dreyfuss, 'The American Law Institute Project on Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes' in S. Leible and A. Ohly (eds), *Intellectual Property and Private International Law*, pp. 15-30 (Mohr Siebeck, Tübingen 2009)

**Droz 1972**

G.A.L. Droz, *Compétence judiciaire et effets des jugements dans le Marché Commun – Etude de la Convention de Bruxelles du 27 Septembre 1968* (Jurisprudence Générale Dalloz, Paris 1972)

**Droz (1990)79(1) Rev. crit. DIP 1**

G.A.L. Droz, 'La Convention de San Sebastian alignant la Convention de Bruxelles sur la Convention de Lugano' (1990)79(1) Rev. crit. DIP 1

**Dutson (1998)47(3) I.C.L.Q. 659**

S. Dutson, 'The infringement of foreign intellectual property rights – a restatement of the terms of engagement' (1998)47(3) I.C.L.Q. 659

**Ebbink 2006**

R. Ebbink, 'A Fire-Side Chat On Cross-Border Issues (before the ECJ in GAT v. LuK)' in D. Beier, L. Brüning-Petit and C. Heath (eds), *Festschrift für Jochen Pagenberg zum 65. Geburtstag*, pp. 255-262 (Carl Heymanns Verlag KG, Köln, Berlin, München 2006)

**Ebner 2004**

M. Ebner, *Markenschutz im internationalen Privat- und Zivilprozessrecht* (Carl Heymanns Verlag KG, Köln, Berlin, München 2004)

**Eck (2014)63(2) GRUR Int. 114**

M. Eck, 'Europäisches Einheitspatent und Einheitspatentgericht – Grund zum Feiern?' (2014)63(2) GRUR Int. 114

**EGPIL (2009)29(3) IPRax 283**

European Group for Private International Law (EGPIL), 'Proposed Amendment of Regulation 44/2001 in Order to Apply it to External Situations (Bergen, 21 September 2008)' (2009)29(3) IPRax 283

**EU Focus 2013, 304, 1**

EU Focus (Newspaper of the Delegation of the European Union to the United States), 'Unitary patent regime finally agreed', 2013, 304, 1

**European Commission 2007 (Communication)**

Commission of the European Communities, 'Communication from the Commission to the European Parliament and the Council – Enhancing the patent system in Europe' COM(2007) 165 final, Brussels 3 April 2007, available at WWW  
<<http://register.consilium.europa.eu/pdf/en/07/st08/st08302.en07.pdf>>

**European Commission 2010 (Proposal Translation Arrangements)**

European Commission, 'Proposal for a Council Regulation (EU) on the translation arrangements for the European Union patent' COM(2010) 350 final – CNS(2010) 0198, Brussels 30 June 2010, available at WWW  
<<http://register.consilium.europa.eu/pdf/en/10/st11/st11805.en10.pdf>>

**European Commission 2010 (Commission Proposal 2010)**

European Commission, 'Proposal for a Regulation of the European Parliament and of the Council on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Recast)' COM(2010) 748 final – COD(2010) 0383, Brussels 14 December 2010, available at WWW <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=COM:2010:0748:FIN:EN:PDF>

**European Commission 2011 (Press Release)**

European Commission, 'Commission proposes unitary patent protection to boost research and innovation', Press Release, Brussels 13 April 2011, available at: WWW  
<[http://europa.eu/rapid/press-release\\_IP-11-470\\_en.htm](http://europa.eu/rapid/press-release_IP-11-470_en.htm)>

**European Commission 2013 (Commission Proposal 2013)**

European Commission, 'Proposal for a Regulation of the European Parliament and of the Council amending Regulation (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters' COM(2013) 554 final – COD(2013) 0268, Brussels 26 July 2013, available at WWW  
[http://ec.europa.eu/justice/civil/files/com\\_2013\\_554\\_en.pdf](http://ec.europa.eu/justice/civil/files/com_2013_554_en.pdf)

**European Parliament 2011 (Legislative Resolution)**

European Parliament, 'Legislative Resolution on the draft Council decision authorising enhanced cooperation in the area of the creation of unitary patent protection', 15 February 2011, available at WWW <<http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//NONGML+TA+P7-TA-2011-0054+0+DOC+PDF+V0//EN>>

**European Parliament 2012 (Resolution of 11 December 2012)**

European Parliament, 'Resolution on jurisdictional system for patent disputes', Strasbourg 11 December 2012, available at WWW  
<<http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//TEXT+TA+P7-TA-2012-0476+0+DOC+XML+V0//EN>>

**Fallon 2008**

M. Fallon, 'L'applicabilité du règlement "Bruxelles I" aux situations externes après l'avis 1/03', in *Vers de nouveaux équilibres entre ordres juridiques – Liber amicorum Hélène Gaudemet-Tallon*, pp. 241-264 (Editions Dalloz, Paris 2008)

**Fawcett 2002**

J. Fawcett, 'Special Rules of Private International Law for Special Cases: What Should We Do About Intellectual Property' in J. Fawcett (ed), *Reform and Development of Private International Law – Essays in Honour of Sir Peter North*, pp. 137-166 (Oxford University Press, Oxford 2002)

**Fawcett & Carruthers 2008 (Cheshire, North & Fawcett)**

J.J. Fawcett and J.M. Carruthers, *Cheshire, North & Fawcett, Private International Law* (14<sup>th</sup> edn Oxford University Press Inc., New York 2008)

**Fawcett & Torremans 1998**

J.J. Fawcett and P. Torremans (eds), *Intellectual Property and Private International Law* (1<sup>st</sup> edn Oxford University Press, Oxford 1998)

**Fawcett & Torremans 2011**

J.J. Fawcett and P. Torremans (eds), *Intellectual Property and Private International Law* (2<sup>nd</sup> edn Oxford University Press, Oxford 2011)

**Feldges 2007**

J. Feldges, 'Die Durchsetzung von Patenten in europäischen Streitigkeiten', in M. Grosch and E. Ullmann (eds), *Gewerbliche Schutzrechte und ihre Durchsetzung, Festschrift für Tilmann Schilling zum 70. Geburtstag am 29. Juli 2007*, pp. 111-123 (Carl Heymanns Verlag GmbH, Köln, Berlin, München 2007)

**Fentiman (1997)56(3) C.L.J. 503**

R. Fentiman, 'Intellectual Property and the Brussels Convention' (1997)56(3) C.L.J. 503

**Fentiman 2005 (Intellectual Property and Private International Law)**

R. Fentiman, 'Choice of Law and Intellectual Property' in J. Drexler and A. Kur (eds), *Intellectual Property and Private International Law – Heading for the Future*, pp. 129-148 (Hart Publishing, Oxford and Portland, Oregon 2005)

**Fentiman 2005 (International Civil Litigation)**

R. Fentiman, 'National Law and the European Jurisdiction Regime' in A. Nuyts and N. Watté (eds), *International Civil Litigation in Europe and Relations with Third States*, pp. 83-128 (Etablissements Emile Bruylant, S.A., Bruxelles 2005)

**Fentiman 2008**

R. Fentiman, 'Justiciability, Discretion and Foreign Rights' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 151-179 (Kluwer Law International, Alphen aan den Rijn 2008)

**Fentiman 2012 (Magnus & Mankowski)**

R. Fentiman in U. Magnus and P. Mankowski (eds), *European Commentaries on Private International Law – Brussels I Regulation* (2<sup>nd</sup> edn Sellier European Law Publishers GmbH, Munich 2012)

**Fezer 2009**

K.-H. Fezer, *Markenrecht – Kommentar zum Markengesetz, zur Pariser Verbandsübereinkunft und zum Madrider Markenabkommen; Dokumentation des nationalen, europäischen und internationalen Kennzeichenrechts* (Verlag C.H. Beck oHG, München 2009)

**Fezer & Koos 2010 (Staudinger)**

K.-H. Fezer and S. Koos, *J. von Staudingers Kommentar zum Bürgerlichen Gesetzbuch mit Einführungsgesetz und Nebengesetzen – Internationales Wirtschaftsrecht* (Dr. Arthur L. Sellier & Co. – Walter de Gruyter GmbH & Co. KG, Berlin 2010)

**Fischer 2013 (Lenz & Borchardt)**

H.G. Fischer in C.O. Lenz and K.-D. Borchardt (eds), *EU-Verträge – Kommentar* (6<sup>th</sup> edn Bundesanzeiger Verlag GmbH, Köln 2013)

**Floyd & Purvis (1995)17(3) E.I.P.R. 110**

C. Floyd and I. Purvis, 'Can an English court restrain infringement of a foreign patent?' (1995)17(3) E.I.P.R. 110

**Foerste 2004**

U. Foerste, 'Zum Gerichtsstand für negative Feststellungsklagen' in R. Bork, T. Hoeren and P. Pohlmann (eds), *Recht und Risiko, Festschrift für Helmut Kollhosser zum 70. Geburtstag Bd II: Zivilrecht*, pp. 141-155 (Verlag Versicherungswirtschaft GmbH, Karlsruhe 2004)

**Forner Delaygua 2008**

J.J. Forner Delaygua, 'The Impact of the Enforcement Directive on the Brussels I Regime' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 257-288 (Kluwer Law International, Alphen aan den Rijn 2008)

**Franzosi (1997)19(7) E.I.P.R. 382**

M. Franzosi, 'Worldwide patent litigation and the Italian torpedo' (1997)19(7) E.I.P.R. 382

**Franzosi (2002)33(2) IIC 154**

M. Franzosi, 'Torpedoes Are Here to Stay' (2002)33(2) IIC 154

**Franzosi (2004)35(4) IIC 416**

M. Franzosi, 'A Community Patent: Three Suggestions for Two Difficulties' (2004)35(4) IIC 416

**Franzosi (2009)4(4) J.I.P.L.P. 247**

M. Franzosi, 'GAT abd Roche – idola fori, teatri, specus: Regulation 864/2007 makes cross-border patent litigation possible' (2009)4(4) J.I.P.L.P. 247

**Franzosi & Tilman (2005)96(2) Mitt. 55**

M. Franzosi and W. Tilmann, 'Vorlagefragen des Hoge Raad und des OLG Düsseldorf' (2005)96(2) Mitt. 55

**Freer 2007**

R.D. Freer, *American and European Approaches to Personal Jurisdiction Based Upon Internet Activity*, Emory University School of Law, Public Law & Legal Theory Research Paper Series, Research Paper No. 07-15, 2007, available at WWW <<http://ssrn.com/abstract=1004887>>

**Fumagalli 2010**

L. Fumagalli, 'Litigating Intellectual Property Rights Disputes Cross-Border: Jurisdiction and Recognition of Judgments under the Brussels I Regulation' in S. Bariatti (ed), *Litigating Intellectual Property Rights Disputes Cross-border: EU Regulations, ALI Principles, CLIP Project*, pp. 15-37 (Casa Editrice Dott. Antonio Milani (CEDAM), Milano 2010)

**Garber 2011**

T. Garber, *Einstweiliger Rechtsschutz nach der EuGVVO – Die internationale Zuständigkeit für die Erlassung einstweiliger Maßnahmen und deren Anerkennung und Vollstreckung nach der EuGVVO* (NWV Neuer Wissenschaftlicher Verlag, Wien, Graz 2011)

**Gardella 2008**

A. Gardella, 'Torpedoes and Actions for Negative Declarations in International IP Law Litigation' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 182-206 (Kluwer Law International, Alphen aan den Rijn 2008)

**Gassauer-Fleissner 2006**

C. Gassauer-Fleissner, 'Die Rolle Österreichs in multinationalen Patentverletzungsfällen' in D. Beier, L. Brüning-Petit and C. Heath (eds), *Festschrift für Jochen Pagenberg zum 65. Geburtstag*, pp. 263-288 (Carl Heymanns Verlag KG, Köln, Berlin, München 2006)

**Gaudemet-Tallon 2010**

H. Gaudemet-Tallon, *Compétence et exécution des jugements en Europe – Règlement 44/2001, Conventions de Bruxelles (1968) et de Lugano (1988 et 2007)* (4<sup>th</sup> edn LGDJ, Paris 2010)

**Gebauer 2007**

M. Gebauer, 'Lis Pendens, Negative Declaratory-Judgment Actions and the First-in-Time Principle' in E. Gottschalk, R. Michaels, G. Rühl and J. von Hein (eds), *Conflict of Laws in a Globalized World*, pp. 89-100 (Cambridge University Press, New York 2007)

**Gebauer (2013)21(4) ZEuP 870**

M. Gebauer, 'Negative Feststellungsklage am Gerichtsstand der unerlaubten Handlung' (2013)21(4) ZEuP 870

**Geier 2005**

E. Geier, *Die Streitgenossenschaft im internationalen Verhältnis* (Haupt Verlag, Bern 2005)

**Geimer 1983 (Geimer & Schütze, Internationale Urteilsanerkennung)**

R. Geimer in R. Geimer and R.A. Schütze, *Internationale Urteilsanerkennung, Kommentar, Band I, 1. Halbband: Das EWG-Übereinkommen über die gerichtliche Zuständigkeit und die Vollstreckung gerichtlicher Entscheidungen in Zivil- und Handelssachen* (C. H. Beck'sche Verlagsbuchhandlung (Oscar Beck), München 1983)

**Geimer 2010 (Geimer & Schütze, Europäisches Zivilverfahrensrecht)**

R. Geimer in R. Geimer and R.A. Schütze, *Europäisches Zivilverfahrensrecht – Kommentar zur EuGVVO, EuEheVO, EuZustellungsVO, EuInsVO, EuVTVO, zum Lugano-Übereinkommen und zum nationalen Kompetenz- und Anerkennungsrecht* (3<sup>rd</sup> edn Verlag C. H. Beck oHG, München 2010)

**Geimer 2015**

R. Geimer, *Internationales Zivilprozessrecht* (7<sup>th</sup> edn Verlag Dr. Otto Schmidt KG, Köln 2015)

**Geller (2000)49(8-9) GRUR Int. 659**

P.E. Geller, 'Internationales Immaterialgüterrecht, Kollisionsrecht und gerichtliche Sanktionen im Internet' (2000)49(8-9) GRUR Int. 659

**Geroldinger 2014 (Burgstaller, Neumayr, Geroldinger & Schmaranzer)**

A. Geroldinger in A. Burgstaller, M. Neumayr, A. Geroldinger and G. Schmaranzer (eds), *Internationales Zivilverfahrensrecht* (17<sup>th</sup> update LexisNexis Verlag ARD Orac GmbH & Co KG, Wien 2014)

**Ginsburg 2010**

J. Ginsburg, 'Jurisdiction and Recognition of Judgments under the ALI Principles' in S. Bariatti (ed), *Litigating Intellectual Property Rights Disputes Cross-border: EU Regulations, ALI Principles, CLIP Project*, pp. 3-13 (Casa Editrice Dott. Antonio Milani (CEDAM), Milano 2010)

**Glöckner (2005)51(7) WRP 795**

J. Glöckner, 'Ist die Union reif für die Kontrolle an der Quelle?' (2005)51(7) WRP 795

**Gonzalez Beilfuss 2008**

C. Gonzalez Beilfuss, 'Is There Any Web for the Spider? Jurisdiction over Co-defendants after Roche Nederland' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 79-88 (Kluwer Law International, Alphen aan den Rijn 2008)

**Gothot & Holleaux 1985**

P. Gothot and D. Holleaux, *La Convention de Bruxelles du 27 Septembre 1968 – Compétence judiciaire et effets des jugements dans la CEE* (Editions Jupiter, 1985)

**Götting (2014)22(2) ZEuP 231**

H.-P. Götting, 'Das EU-Einheitspatent' (2014)22(2) ZEuP 231

**Gottwald 2002**

P. Gottwald, 'Internationale Zuständigkeit kraft "business activities" im geplanten Haager Übereinkommen über Zuständigkeit und ausländische Urteile in Zivil- und Handelssachen' in R.A. Schütze (ed), *Einheit und Vielfalt des Rechts – Festschrift für Reinhold Geimer zum 65. Geburtstag*, pp. 231-253 (Verlag C.H. Beck oHG, München 2002)

**Gottwald 2013 (Münchener Kommentar zur ZPO)**

W. Krüger and T. Rauscher (eds), *Münchener Kommentar zur Zivilprozessordnung mit Gerichtsverfassungsgesetz und Nebengesetzen, Band 3: §§ 1025-1109, EGZPO, GVG, EGGVG, UklaG, Internationales und Europäisches Zivilprozessrecht* (4<sup>th</sup> edn Verlag C. H. Beck oHG, München 2013)

**Grabinski (1998)100(11) GRUR 857**

K. Grabinski, 'Kann und darf die Bestimmung des Schutzbereichs eines europäischen Patents in verschiedenen Ländern zu unterschiedlichen Ergebnissen führen?' (1998)100(11) GRUR 857

**Grabinski (2001)50(3) GRUR Int. 199**

K. Grabinski, 'Zur Bedeutung des Europäischen Gerichtsstands- und Vollstreckungsübereinkommens (Brüsseler Übereinkommens) und des Lugano-Übereinkommens in Rechtsstreitigkeiten über Patentverletzungen' (2001)50(3) GRUR Int. 199

**Grabinski 2003**

K. Grabinski, 'Angst vor dem Zitterrochen? – Zur Verfahrensaussetzung nach Art. 27, 28 VO (EG) Nr. 44/2001 in Patentverletzungsstreitigkeiten vor deutschen Gerichten' in E. Keller, C. Plassmann and A. von Falck (eds), *Festschrift für Winfried Tilmann*, pp. 461-473 (Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München 2003)

**Grabinski 2007**

K. Grabinski, 'Grenzüberschreitende Beweisaufnahme im deutschen Patentverletzungsverfahren unter besonderer Berücksichtigung der Verordnung (EG) Nr. 1206/2001', in M. Grosch and E. Ullmann (eds), *Gewerbliche Schutzrechte und ihre Durchsetzung, Festschrift für Tilmann Schilling zum 70. Geburtstag am 29. Juli 2007*, pp. 191-205 (Carl Heymanns Verlag GmbH, Köln, Berlin, München 2007)

**Grabinski (2013)62(4) GRUR Int. 310**

K. Grabinski, 'Der Entwurf der Verfahrensordnung für das Einheitliche Patentgericht im Überblick' (2013)62(4) GRUR Int. 310

**Grolimund 2000**

P. Grolimund, *Drittstaatenproblematik des europäischen Zivilverfahrensrechts* (Mohr Siebeck, Tübingen 2000)

**Grünberger (2009)108 ZVglRWiss 134**

M. Grünberger, 'Das Urheberrechtsstatut nach der Rom II-VO' (2009)108 ZVglRWiss 134

**Grünberger & Podszun (2015)12(2) GPR 79**

M. Grünberger & R. Podszun, 'Die Entwicklung des Immaterialgüterrechts im Recht der Europäischen Union in den Jahren 2013/14 – Teil 2' (2015)12(2) GPR 79

**Grundmann (1985)5(5) IPRax 249**

S. Grundmann, 'Zur internationalen Zuständigkeit der Gerichte von Drittstaaten nach Art. 16 EuGVÜ' (1985)5(5) IPRax 249

**Haberl & Schallmoser (2010)2(2) GRUR-Prax 23**

A. Haberl and K. Schallmoser, 'EU-Patent und einheitliches Europäisches Patentgerichtssystem – Rat einigt sich auf wesentliche Vorgaben' (2010)2(2) GRUR-Prax 23

**Haberl & Schallmoser (2013)5(1) GRUR-Prax 1**

A. Haberl and K. Schallmoser, 'Auf der Zielgeraden zu einem neuen Europäischen Patentwesen' (2013)5(1) GRUR-Prax 1

**Haedicke (2013)62(7) GRUR Int. 609**

M. Haedicke, 'Rechtsfindung, Rechtsfortbildung und Rechtskontrolle im Einheitlichen Patentsystem' (2013)62(7) GRUR Int. 609

**Hague Conference on Private International Law 2001 (Draft Hague Convention 2001)**

Hague Conference on Private International Law, Commission II, Jurisdiction and Foreign Judgments in Civil and Commercial Matters, Nineteenth Session, Summary of the Outcome of the Discussion in Commission II of the First Part of the Diplomatic Conference 6-20 June 2001, Interim Text, available at WWW

<[http://www.hcch.net/upload/wop/jdgm2001draft\\_e.pdf](http://www.hcch.net/upload/wop/jdgm2001draft_e.pdf)>

**Hau 2011**

W. Hau, 'Gegenwartsprobleme internationaler Zuständigkeit' in H. Kronke and K. Thorn (eds), *Grenzen überwinden – Prinzipien bewahren; Festschrift für Bernd von Hoffmann zum 70. Geburtstag am 28. Dezember 2011*, pp. 617-633 (Verlag Ernst und Werner Gieseking GmbH, Bielefeld 2011)



**Hau & Eichel (2015)12(2) GPR 95**

W. Hau & F. Eichel, 'Internationales Privat- und Zivilverfahrensrecht – Zur Entwicklung des Internationalen Zivilverfahrensrechts in der Europäischen Union in den Jahren 2013 und 2014' (2015)12(2) GPR 95

**Hausmann 1994 (Wieczorek & Schütze)**

R. Hausmann in B. Wieczorek and R.A. Schütze (eds), *Zivilprozeßordnung und Nebengesetze, Großkommentar, Erster Band, 1. Teilband* (3<sup>rd</sup> edn Walter de Gruyter & Co., Berlin 1994)

**Hausmann (2003)3(5/6) EuLF 277**

R. Hausmann, 'Infringements of industrial property rights in European international private law and procedural law' (2003)3(5/6) EuLF 277

**Heinze 2007**

C. Heinze, *Einstweiliger Rechtsschutz im europäischen Immaterialgüterrecht* (Mohr Siebeck, Tübingen 2007)

**Heinze (2007)56(7) GRUR Int. 634**

C. Heinze, 'Internationale Zuständigkeit im Gerichtsstand der unerlaubten Handlung bei Verletzung europäischer Patente' (2007)56(7) GRUR Int. 634

**Heinze (2008)28(6) IPRax 480**

C. Heinze, 'Beweissicherung im europäischen Zivilprozessrecht' (2008)28(6) IPRax 480

**Heinze 2010**

C. Heinze, 'A Framework for International Enforcement of Territorial Rights: The CLIP Principles on Jurisdiction' in J. Basedow, T. Kono and A. Metzger (eds), *Intellectual Property in the Global Arena – Jurisdiction, Applicable Law, and the Recognition of Judgements in Europe, Japan and the US*, pp. 53-76 (Mohr Siebeck, Tübingen 2010)

**Heinze (2011)75 RabelsZ 581**

C. Heinze, 'Choice of Court Agreements, Coordination of Proceedings and Provisional Measures in the Reform of the Brussels I Regulation' (2011)75 RabelsZ 581

**Heinze 2013 (CLIP Principles)**

C. Heinze in European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP) (ed), *Conflict of Laws in Intellectual Property – The CLIP Principles and Commentary* (1<sup>st</sup> edn Oxford University Press, Oxford 2013)

**Heinze & Dutta (2005)25(3) IPRax 224**

C. A. Heinze and A. Dutta, 'Ungeschriebene Grenzen für europäische Zuständigkeiten bei Streitigkeiten mit Drittstaatenbezug' (2005)25(3) IPRax 224

**Heinze & Roffael (2006)55(10) GRUR Int. 787**

C. A. Heinze and E. Roffael, 'Internationale Zuständigkeit für Entscheidungen über die Gültigkeit ausländischer Immaterialgüterrechte' (2006)55(10) GRUR Int. 787

**Hellstadius & Meier-Ewert (2005)36(3) IIC 313**

Å. Hellstadius and W. Meier-Ewert, 'Jurisdiction and Choice of Law in Intellectual Property Matters – Perspectives for the Future (EU and World-Wide)' (2005)36(3) IIC 313

**Herdegen 2011**

M. Herdegen, *Völkerrecht* (10<sup>th</sup> edn Verlag C.H. Beck oHG, München 2011)

**Herr & Grunwald (2011)22(9) EuZW 321**

J. Herr and M. Grunwald, 'Schwerer Rückschlag für die europäische Patentgerichtsbarkeit' (2011)22(9) EuZW 321

**Heß (2000)20(5) IPRax 370**

B. Heß, 'Die begrenzte Freizügigkeit einstweiliger Maßnahmen im Binnenmarkt II – weitere Klarstellungen des Europäischen Gerichtshofs' (2000)20(5) IPRax 370

**Hess 2008**

B. Hess, 'Preservation and Taking of Evidence in Cross-Border Proceedings – Comparative Remarks in the Context of IP Litigation' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 289-301 (Kluwer Law International, Alphen aan den Rijn 2008)

**Hess 2010**

B. Hess, *Europäisches Zivilprozessrecht* (C.F. Müller Verlag, Heidelberg 2010)

**Hess (2011)31(2) IPRax 125**

B. Hess, 'Die Reform der EuGVVO und die Zukunft des Europäischen Zivilprozessrechts' (2011)31(2) IPRax 125

**Hess, Pfeiffer, Schlosser & Weller 2008 (Heidelberg Report)**

B. Hess, T. Pfeiffer, P. Schlosser and M. Weller in B. Hess, T. Pfeiffer and P. Schlosser (eds), *The Brussels I-Regulation (EC) No 44/2001 – The Heidelberg Report on the Application of Regulation Brussels I in 25 Member States (Study JLS/C4/2005/03)* (Verlag C.H. Beck oHG, München 2008)

**Heß & Vollkommer (1999)19(4) IPRax 220**

B. Heß and G. Vollkommer, 'Die begrenzte Freizügigkeit einstweiliger Maßnahmen nach Art. 24 EuGVÜ' (1999)19(4) IPRax 220

**Hess & Zhou (2007)27(3) IPRax 183**

B. Hess and C. Zhou, 'Beweissicherung und Beweisbeschaffung im europäischen Justizraum' (2007)27(3) IPRax 183

**Hess 1987**

C. Hess, *Rechtsfolgen von Patentverletzungen im Europäischen Patentrecht* (Duncker & Humblot GmbH, Berlin 1987)

**Hilty, Jaeger, Lamping & Ullrich 2012**

R.M. Hilty, T. Jaeger, M. Lamping and H. Ullrich, 'The Unitary Patent Package: Twelve Reasons for Concern', Max Planck Institute for Intellectual Property and Competition Law Research Paper No. 12-12, available at: WWW  
<<http://pubman.mpdl.mpg.de/pubman/faces/viewItemFullPage.jsp?itemId=escidoc:1621166>>

**Hölder 2004**

N. Hölder, *Grenzüberschreitende Durchsetzung Europäischer Patente* (Berliner Wissenschafts-Verlag GmbH, Berlin 2004)

**Huber (1995)50(12) JZ 603**

P. Huber, 'Fragen zur Rechtshängigkeit im Rahmen des EuGVÜ – Deutliche Worte des EuGH' (1995)50(12) JZ 603

**Hye-Knudsen 2005**

R. Hye-Knudsen, *Marken-, Patent- und Urheberrechtsverletzungen im europäischen Internationalen Zivilprozessrecht* (Mohr Siebeck, Tübingen 2005)

**Illmer 2011 (Huber)**

M. Illmer in P. Huber (ed), *Rome II Regulation* (sellier. European law publishers GmbH, München 2011)

**Jacob 2005**

R. Jacob, 'The Perfect Patent Court' in A. Kur, S. Luginbühl and E. Waage (eds), »... und sie bewegt sich doch!« - *Patent Law on the Move, Festschrift für Gert Kolle und Dieter Stauder zum 65. Geburtstag am 25. April 2005 und 20. Oktober 2005*, pp. 313-323 (Carl Heymanns Verlag KG, Köln, Berlin, München 2005)

**Jaeger (2013)24(1) EuZW 15**

T. Jaeger, 'Hieronymus Bosch am Werk beim EU-Patent? – Alternativen zur Einheitspatentlösung' (2013)24(1) EuZW 15

**Jaeger (2013)44(4) IIC 389**

T. Jaeger, 'Shielding the Unitary Patent from the ECJ: A Rash and Futile Exercise' (2013)44(4) IIC 389

**Jaeger, Hilty, Drexler & Ullrich (2009)40(7) IIC 817**

T.T. Jaeger, R.M. Hilty, J. Drexler, and H. Ullrich 'Comments of the Max Planck Institute for Intellectual Property, Competition and Tax Law on the 2009 Commission Proposal for the Establishment of a Unified European Patent Judiciary' (2009)40(7) IIC 817

**Jayme 1988**

E. Jayme, 'Das Europäische Gerichtsstands- und Vollstreckungsübereinkommen und die Drittländer – Das Beispiel Österreichs' in F. Schwind (ed), *Europarecht – Internationales Privatrecht – Rechtsvergleichung*, pp. 97-123 (Verlag der Österreichischen Akademie der Wissenschaften, Wien 1988)

**Jayme & Kohler (1995)15(6) IPRax 343**

E. Jayme and C. Kohler, 'Europäisches Kollisionsrecht 1995 – Der Dialog der Quellen' (1995)15(6) IPRax 343

**Jayme & Kohler (2004)24(6) IPRax 481**

E. Jayme and C. Kohler, 'Europäisches Kollisionsrecht 2004: Territoriale Erweiterung und methodische Rückgriffe' (2004)24(6) IPRax 481

**Jenard Report**

P. Jenard, Report on the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, OJ C59 of 5 March 1979, pp. 1-65, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:1979:059:FULL:EN:PDF>>

**Jenard/Möller Report**

P. Jenard and G. Möller, Report on the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters done at Lugano on 16 September 1988, OJ C189 of 28 July 1990, pp. 57-121, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1990\\_189\\_R\\_0057\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1990_189_R_0057_01&rid=1)>

**Jestaedt 2008**

B. Jestaedt, *Patentrecht* (2<sup>nd</sup> edn Carl Heymanns Verlag GmbH, Köln, München 2008)

**Jooris (1996)18(3) E.I.P.R. 127**

E. Jooris, 'Infringement of foreign copyright and the jurisdiction of English courts' (1996)18(3) E.I.P.R. 127

**Joseph (2006)1(13) J.I.P.L.P. 850**

P. Joseph, 'The rise and fall of cross-border jurisdiction and remedies in IP disputes' (2006)1(13) J.I.P.L.P. 850

**Jurčys (2012)3(3) JIPITEC 174**

P. Jurčys, 'International Jurisdiction in Intellectual Property Disputes: CLIP, ALI Principles and other Legislative Proposals in a Comparative Perspective' (2012)3(3) JIPITEC 174

**Kaess 2013 (Busse – Patentgesetz)**

T. Kaess in *Busse – Patentgesetz, unter Berücksichtigung des Europäischen Patentübereinkommens und des Patentrechtsabkommens, mit Patentkostengesetz, Gebrauchsmustergesetz und Gesetz über den Schutz der Topographien von Halbleitererzeugnissen, Gesetz über Arbeitnehmererfindungen und Gesetz über internationale Patentübereinkommen (Kommentar)* (7<sup>th</sup> edn Walter de Gruyter GmbH, Berlin/Boston 2013)

**Kant (2012)30(2) NIPR 193**

M.C.A. Kant, 'A specialised Patent Court for Europe? – An analysis of Opinion 1/09 of the Court of Justice of the European Union from 8 March 2011 concerning the establishment of a European and Community Patents Court and a proposal for an alternative solution' (2012)30(2) NIPR 193

**Karet (1998)3 I.P.Q. 317**

I. Karet, 'Intellectual property litigation – jurisdiction in Europe' (1998)3 I.P.Q. 317

**Kazi (2011)33(8) E.I.P.R. 538**

I. Kazi, 'Will we ever see a single patent system covering the EU, let alone spanning the Atlantic or Pacific' (2011)33(8) E.I.P.R. 538

**Kegel & Schurig 2004**

G. Kegel and K. Schurig, *Internationales Privatrecht* (9<sup>th</sup> edn Verlag C.H. Beck oHG, München 2004)

**Keller 2006**

E. Keller, 'Patentverletzungen durch Handlungen im patentfreien Ausland' in H.-J. Ahrens, J. Bornkamm and H. P. Kunz-Hallstein (eds), *Festschrift für Eike Ullmann*, pp. 449-464 (juris GmbH, Saarbrücken 2006)

**Keukenschrijver 2013 (Busse – Patentgesetz)**

A. Keukenschrijver in *Busse – Patentgesetz, unter Berücksichtigung des Europäischen Patentübereinkommens und des Patentrechtsabkommens, mit Patentrechtsabkommensgesetz, Gebrauchsmusterrechtsgesetz und Gesetz über den Schutz der Topographien von Halbleitererzeugnissen, Gesetz über Arbeitnehmererfindungen und Gesetz über internationale Patentübereinkommen (Kommentar)* (7<sup>th</sup> edn Walter de Gruyter GmbH, Berlin/Boston 2013)

**Kieninger (1998)47(4) GRUR Int. 280**

E.-M. Kieninger, ‘Internationale Zuständigkeit bei der Verletzung ausländischer Immaterialgüterrechte: Common Law auf dem Prüfstand des EuGVÜ’ (1998)47(4) GRUR Int. 280

**Kiethe (1994)47(4) NJW 222**

K. Kiethe, ‘Internationale Tatortzuständigkeit bei unerlaubter Handlung – die Problematik des Vermögensschadens’ (1994)47(4) NJW 222

**Knaak (2007)56(5) GRUR Int. 386**

R. Knaak, ‘Internationale Zuständigkeiten und Möglichkeiten des forum shopping in Gemeinschaftsmarkensachen – Auswirkungen der EuGH-Urteile Roche Niederlande und GAT/LUK auf das Gemeinschaftsmarkenrecht’ (2007)56(5) GRUR Int. 386

**Knight (2008)27(4) C.J.Q. 454**

C.J.S. Knight, ‘Complicating simplicity: the “court first seised” and “related actions” in Article 28’ (2008)27(4) C.J.Q. 454

**Knöfel (2006)26(5) IPRax 503**

O. Knöfel, ‘Gerichtsstand der prozessübergreifenden Streitgenossenschaft gemäß Art. 6 Nr. 1 EuGVVO?’ (2006)26(5) IPRax 503

**Knöfel (2008)19(9) EuZW 267**

O. Knöfel, ‘Vier Jahre Europäische Beweisaufnahmeverordnung – Bestandsaufnahme und aktuelle Entwicklungen’ (2008)19(9) EuZW 267

**Knöfel 2014 (Geimer & Schütze, Internationaler Rechtsverkehr)**

O.L. Knöfel in R. Geimer and R.A. Schütze (eds), *Internationaler Rechtsverkehr in Zivil- und Handelssachen; Loseblatt-Handbuch mit Texten, Kommentierungen und Länderberichten, Band II* (48<sup>th</sup> update Verlag C.H. Beck oHG, München 2014)

**Kohler 2000**

C. Kohler, ‘Die Revision des Brüsseler und des Luganer Übereinkommens über die gerichtliche Zuständigkeit und die Vollstreckung gerichtlicher Entscheidungen in Zivil- und Handelssachen – Generalia und Gerichtsstandsproblematik’ in P. Gottwald (ed), *Revision des EuGVÜ – Neues Schiedsverfahrensrecht*, pp. 1-35 (Verlag Ernst und Werner Gieseking GmbH, Bielefeld 2000)

**Kohler (2009)29(3) IPRax 285**

C. Kohler, ‘Erstreckung der europäischen Zuständigkeitsordnung auf drittstaatsverknüpfte Streitigkeiten – Tagung der Europäischen Gruppe für Internationales Privatrecht in Bergen’ (2009)29(3) IPRax 285

**Kolle 2006**

G. Kolle, 'Braucht Europa ein Gemeinschaftspatent?' in D. Beier, L. Brüning-Petit and C. Heath (eds), *Festschrift für Jochen Pagenberg zum 65. Geburtstag*, pp. 45-56 (Carl Heymanns Verlag KG, Köln, Berlin, München 2006)

**König 2012**

B. König, 'Einstweilige Maßnahmen (einstweilige Verfügungen) und die Brüssel I-Verordnung' in B. König and P.G. Mayr (eds), *Europäisches Zivilverfahrensrecht in Österreich III*, pp. 65-81 (MANZ'sche Verlags- und Universitätsbuchhandlung GmbH, Wien 2012)

**Kono & Jurčys 2012**

T. Kono and P. Jurčys, 'General Report' in T. Kono (ed), *Intellectual Property and Private International Law – Comparative Perspectives*, pp. 1-216 (Oxford and Portland, Oregon 2012)

**Kortmann 2005**

K. Kortmann, *Die Neuordnung der europäischen Patentgerichtsbarkeit – Entwicklungen und Perspektiven der Streitregelung auf dem Gebiet des europäischen Patentrechts* (Verlag Dr. Kovač, Hamburg 2005)

**Koutrakos (2011)36(3) E.L. Rev. 319**

P. Koutrakos, 'The Court of Justice as the guardian of national courts – or not?' (2011)36(3) E.L. Rev. 319

**Kraßer 2009**

R. Kraßer, *Patentrecht – Ein Lehr- und Handbuch zum deutschen Patent- und Gebrauchsmusterrecht, Europäischen und Internationalen Patentrecht* (6<sup>th</sup> edn Verlag C.H. Beck, München 2009)

**Kraßer 2011**

R. Kraßer, *Effects of an inclusion of regulations concerning the content and limits of the patent holder's rights to prohibit in an EU regulation for the creation of unitary European patent protection* (18 October 2011), published on the blog of EPLAW: WWW  
<<http://www.eplawpatentblog.com/2011/October/Opinion%20Prof%20Kraßer%20EN.pdf>>

**Kropholler 1988**

J. Kropholler, 'Problematische Schranken der europäischen Zuständigkeitsordnung gegenüber Drittstaaten' in A. Heldrich and H. J. Sonnenberger, *Festschrift für Murad Ferid zum 80. Geburtstag am 11. April 1988*, pp. 239-250 (Verlag für Standesamtswesen GmbH & Co.KG, Frankfurt am Main 1988)

**Kropholler 2006**

J. Kropholler, *Internationales Privatrecht* (6<sup>th</sup> edn Mohr Siebeck, Tübingen 2006)

**Kropholler & Von Hein 2011**

J. Kropholler and J. von Hein, *Europäisches Zivilprozessrecht – Kommentar zu EuGVVO, Lugano-Übereinkommen 2007, EuVTVO, EuMVVO und EuGFVO* (9<sup>th</sup> edn Verlag Recht und Wirtschaft GmbH, Frankfurt am Main 2011)

**Kruger 2005**

T. Kruger, 'Provisional and Protective Measures' in A. Nuyts and N. Watté (eds), *International Civil Litigation in Europe and Relations with Third States*, pp. 311-341 (Etablissements Emile Bruylant, S.A., Bruxelles 2005)

**Kubis 1999**

S. Kubis, *Internationale Zuständigkeit bei Persönlichkeits- und Immaterialgüterrechtsverletzungen* (Verlag Ernst und Werner Giesecking GmbH, Bielefeld 1999)

**Kubis (2007)98(5) Mitt. 220**

S. Kubis, 'Patentverletzungen im europäischen Prozessrecht – Ausschließliche Zuständigkeit kraft Einrede?' (2007)98(5) Mitt. 220

**Kühnen 2012**

T. Kühnen, *Handbuch der Patentverletzung* (6<sup>th</sup> edn Wolters Kluwer Deutschland GmbH, Köln 2012)

**Kupzok (2014)36(7) E.I.P.R. 418**

A. Kupzok, 'Law and economics of the unitary patent protection in the European Union: the rebels' viewpoint' (2014)36(7) E.I.P.R. 418

**Kur (2000)46(9) WRP 935**

A. Kur, 'Territorialität versus Globalität – Kennzeichenkonflikte im Internet' (2000)46(9) WRP 935

**Kur (2001)50(11) GRUR Int. 908**

A. Kur, 'Immaterialgüterrechte in einem weltweiten Vollstreckungs- und Gerichtsstandsübereinkommen – Auf der Suche nach dem Ausweg aus der Sackgasse' (2001)50(11) GRUR Int. 908

**Kur (2002)24(4) E.I.P.R. 175**

A. Kur, 'International Hague Convention on Jurisdiction and Foreign Judgments: a way forward for I.P.?' (2002)24(4) E.I.P.R. 175

**Kur 2003**

A. Kur, 'Optionen für ein internationales Gerichtsstands- und Vollstreckungsübereinkommen im Bereich des Immaterialgüterrechts' in E. Keller, C. Plassmann and A. von Falck (eds), *Festschrift für Winfried Tilmann*, pp. 827-842 (Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München 2003)

**Kur (2006)37(7) IIC 844**

A. Kur, 'A Farewell to Cross-Border Injunctions? The ECJ Decisions *GAT v. LuK* and *Roche Nederland v. Primus and Goldenberg*' (2006)37(7) IIC 844

**Kur 2009**

A. Kur, 'Are there any Common European Principles of Private International Law with regard to Intellectual Property?' in S. Leible and A. Ohly (eds), *Intellectual Property and Private International Law*, pp. 1-14 (Mohr Siebeck, Tübingen 2009)

**Kur (2012)61(10) GRUR Int. 857**

A. Kur, 'Die Ergebnisse des CLIP-Projekts – zugleich eine Einführung in die deutsche Fassung der Principles on Conflict of Laws in Intellectual Property' (2012)61(10) GRUR Int. 857

**Kur 2013 (CLIP Principles)**

A. Kur in European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP) (ed), *Conflict of Laws in Intellectual Property – The CLIP Principles and Commentary* (1<sup>st</sup> edn Oxford University Press, Oxford 2013)

**Kur & Ubertazzi 2010**

A. Kur and B. Ubertazzi, 'The ALI Principles and the CLIP Project: A Comparison' in S. Bariatti (ed), *Litigating Intellectual Property Rights Disputes Cross-border: EU Regulations, ALI Principles, CLIP Project*, pp. 89-147 (Casa Editrice Dott. Antonio Milani (CEDAM), Milano 2010)

**Kurtz 2004**

C. Kurtz, *Grenzüberschreitender einstweiliger Rechtsschutz im Immaterialgüterrecht* (1<sup>st</sup> edn V&R unipress GmbH, Göttingen 2004)

**Lamping (2011)42(8) IIC 879**

M. Lamping, 'Enhanced Cooperation – A Proper Approach to Market Integration in the Field of Unitary Patent Protection' (2011)42(8) IIC 879

**Lange (2000)46(9) WRP 940**

P. Lange, 'Der internationale Gerichtsstand der unerlaubten Handlung nach dem EuGVÜ bei Verletzungen von nationalen Kennzeichen' (2000)46(9) WRP 940

**Lange (2007)109(2) GRUR 107**

P. Lange, 'Der internationale Gerichtsstand der Streitgenossenschaft im Kennzeichenrecht im Lichte der "Roche/Primus"-Entscheidung des EuGH' (2007)109(2) GRUR 107

**Laubinger 2005**

T. Laubinger, *Die internationale Zuständigkeit der Gerichte für Patentstreitsachen in Europa – Vom nationalen Patent über das europäische Patent zum Gemeinschaftspatent* (Feldhaus Verlag GmbH & Co. KG, Hamburg 2005)

**Law Professors' Brief 2005**

Brief for Amici Curiae Law Professors in Support of the Appellee, *Jan K. Voda, M.D. v Cordis Corporation*, No. 05-1238 (Fed. Cir. July 29, 2005)

**Layton & Mercer 2004**

A. Layton and H. Mercer (eds), *European Civil Practice*, Volume 1 (2<sup>nd</sup> edn Sweet & Maxwell Limited, London 2004)

**Leible 2011 (Rauscher)**

S. Leible in T. Rauscher (ed), *Europäisches Zivilprozess- und Kollisionsrecht – EuZPR / EuIPR, Kommentar* (sellier. european law publishers GmbH, München 2011)



**Leistner 2009**

M. Leistner, 'The Law Applicable to Non-Contractual Obligations Arising from an Infringement of National or Community IP Rights' in S. Leible and A. Ohly (eds), *Intellectual Property and Private International Law*, pp. 97-121 (Mohr Siebeck, Tübingen 2009)

**Leitzen (2004)53(12) GRUR Int. 1010**

M. Leitzen, 'Comeback des "Torpedo"?' (2004)53(12) GRUR Int. 1010

**Lindacher 2009**

W. F. Lindacher, 'Einstweiliger Rechtsschutz in Wettbewerbssachen unter dem Geltungsregime von Brüssel I' in R. Stürner, H. Matsumoto, W. Lücke and M. Deguchi (eds), *Festschrift für Dieter Leipold zum 70. Geburtstag*, pp. 251-263 (Mohr Siebeck, Tübingen 2009)

**Linke & Hau 2011**

H. Linke and W. Hau, *Internationales Zivilverfahrensrecht* (5<sup>th</sup> edn Verlag Dr. Otto Schmidt KG, Köln 2011)

**Lock (2011)36(4) E.L. Rev. 576**

T. Lock, 'Taking national courts more seriously? Comment on Opinion 1/09' (2011)36(4) E.L. Rev. 576

**Loussouarn, Bourel & Vareilles-Sommières 2013**

Y. Loussouarn, P. Bourel and P. de Vareilles-Sommières, *Droit international privé* (10<sup>th</sup> edn Editions Dalloz, Paris 2013)

**Luginbühl 2005**

S. Luginbühl, 'Die schrittweise Entmündigung der nationalen Gerichte in grenzüberschreitenden Patentstreitigkeiten durch den EuGH' in A. Kur, S. Luginbühl and E. Waage (eds), »... und sie bewegt sich doch!« - *Patent Law on the Move, Festschrift für Gert Kolle und Dieter Stauder zum 65. Geburtstag am 25. April 2005 und 20. Oktober 2005*, pp. 389-408 (Carl Heymanns Verlag KG, Köln, Berlin, München 2005)

**Luginbühl 2009**

S. Luginbühl, 'The Future of Centralised Patent Litigation in Europe: Between the EPLA and the EU Patent Judiciary' in S. Leible and A. Ohly (eds), *Intellectual Property and Private International Law*, pp. 231-250 (Mohr Siebeck, Tübingen 2009)

**Luginbühl (2010)59(2) GRUR Int. 97**

S. Luginbühl, 'Die neuen Wege zur einheitlichen Auslegung des Europäischen Patentrechts' (2010)59(2) GRUR Int. 97

**Luginbühl 2011**

S. Luginbühl, *European Patent Law – Towards a Uniform Interpretation* (Edward Elgar Publishing Limited, Cheltenham (UK) and Edward Elgar Publishing, Inc., Northampton (Massachusetts, USA) 2011)

**Luginbühl (2013)62(4) GRUR Int. 305**

S. Luginbühl, 'Das europäische Patent mit einheitlicher Wirkung (Einheitspatent)' (2013)62(4) GRUR Int. 305

**Luginbühl & Stauder (2006)10(12) sic! 876**

S. Luginbühl and D. Stauder, 'Der Europäische Gerichtshof setzt den grenzüberschreitenden Entscheidungen in Patentsachen ein vorläufiges Ende' (2006)10(12) sic! 876

**Luginbühl & Stauder (2014)63(10) GRUR Int. 885**

S. Luginbühl and D. Stauder, 'Die Anwendung der revidierten Zuständigkeitsregeln nach der Brüssel I-Verordnung auf Klagen in Patentsachen' (2014)63(10) GRUR Int. 885

**Luginbühl & Wollgast 2006**

S. Luginbühl and H. Wollgast, 'IP Rights In The Hague Convention On Choice Of Court Agreements' in D. Beier, L. Brüning-Petit and C. Heath (eds), *Festschrift für Jochen Pagenberg zum 65. Geburtstag*, pp. 321-349 (Carl Heymanns Verlag KG, Köln, Berlin, München 2006)

**Luginbühl & Wollgast (2006)55(3) GRUR Int. 208**

S. Luginbühl and H. Wollgast, 'Das neue Haager Übereinkommen über Gerichtsstandsvereinbarungen: Aussichten für das geistige Eigentum' (2006)55(3) GRUR Int. 208

**Lundstedt (2001)32(2) IIC 124**

L. Lundstedt, 'Jurisdiction and the Principle of Territoriality in Intellectual Property Law: Has the Pendulum Swung Too Far in the Other Direction?' (2001)32(2) IIC 124 (= (2001)50(2) GRUR Int. 103)

**Lundstedt (2007)76(4) NIR 348**

L. Lundstedt, 'Jurisdiction and enforcement outside of the Brussels System with a focus on IPR' (2007)76(4) NIR 348

**Lundstedt (2008)77(2) NIR 122**

L. Lundstedt, 'In the Wake of GAT/LuK and Roche/Primus' (2008)77(2) NIR 122

**Lundstedt (2012)81(1) NIR 6**

L. Lundstedt, 'Transborder Patent Entitlement and Ownership Disputes: Which Forum has Jurisdiction?' (2012)81(1) NIR 6

**Lundstedt & Maunsbach (2003)72(3) NIR 212**

L. Lundstedt and U. Maunsbach, 'Jurisdiction and Applicable Law: A Swedish Perspective on Cross-border Enforcement of Intellectual Property Rights' (2003)72(3) NIR 212

**Lüthi 2011**

B.C. Lüthi, *System der internationalen Zuständigkeit im Immaterialgüterrecht* (Dike Verlag AG, Zürich/St. Gallen 2011)

**Malaga (2014)45(6) IIC 621**

M. Malaga, 'The European Patent with Unitary Effect: Incentive to Dominate?' (2014)45(6) IIC 621

**Mäder 1999**

A. Mäder, *Die Anwendung des Lugano-Übereinkommens im gewerblichen Rechtsschutz – Ausgehend von Art. 16 Nr. 4 LugÜ* (Stämpfli Verlag AG, Bern 1999)

**Mäsch (2005)25(6) IPRax 509**

G. Mäsch, 'Vitamine für Kartellopfer – Forum shopping im europäischen Kartelldeliktsrecht' (2005)25(6) IPRax 509

**Magnus & Mankowski (2010)109 ZVglRWiss 1**

U. Magnus and P. Mankowski, 'Brussels I on the Verge of Reform – A Response to the Green Paper on the Review of the Brussels I Regulation' (2010)109 ZVglRWiss 1

**Magnus & Mankowski (2011)110 ZVglRWiss 252**

U. Magnus and P. Mankowski, 'The Proposal for the Reform of Brussels I – Brussels Ibis *ante portas*' (2011)110 ZVglRWiss 252

**Mangini (1983)42(4) GRUR Int. 226**

V. Mangini, 'Die rechtliche Regelung des Verletzungs- und Nichtigkeitsverfahrens in Patentsachen in den Vertragstaaten des Münchner Patentübereinkommens' (1983)42(4) GRUR Int. 226

**Mankowski (2004)50(7) RIW 481**

P. Mankowski, 'Entwicklungen im Internationalen Privat- und Prozessrecht 2003/2004 (Teil 1)' (2004)50(7) RIW 481

**Mankowski 2005**

P. Mankowski, 'Internationale Zuständigkeit und anwendbares Recht – Parallelen und Divergenzen' in S. Lorenz, A. Trunk, H. Eidenmüller, C. Wendehorst and J. Adolff (eds), *Festschrift für Andreas Heldrich zum 70. Geburtstag*, pp. 867-897 (Mohr Siebeck, Tübingen 2010)

**Mankowski (2005)60(23) JZ 1144**

P. Mankowski, 'Selbständige Beweisverfahren und einstweiliger Rechtsschutz in Europa' (2005)60(23) JZ 1144

**Mankowski 2011 (Rauscher)**

P. Mankowski in T. Rauscher (ed), *Europäisches Zivilprozess- und Kollisionsrecht – EuZPR / EuIPR, Kommentar* (sellier. european law publishers GmbH, München 2011)

**Mankowski 2012 (Magnus & Mankowski)**

P. Mankowski in U. Magnus and P. Mankowski (eds), *European Commentaries on Private International Law – Brussels I Regulation* (2<sup>nd</sup> edn sellier european law publishers GmbH, Munich 2012)

**Mankowski (2014)11(6) GPR 330**

P. Mankowski, 'Die neuen Regeln über gemeinsame Gerichte in Artt. 71a-71d Brüssel Ia-VO' (2014)11(6) GPR 330

**Mansel, Thorn & Wagner (2013)33(1) IPRax 1**

H.-P. Mansel, K. Thorn and R. Wagner, 'Europäisches Kollisionsrecht 2012: Voranschreiten des Kodifikationsprozesses – Flickenteppich des Einheitsrechts' (2013)33(1) IPRax 1

**Mansel, Thorn & Wagner (2014)34(1) IPRax 1**

H.-P. Mansel, K. Thorn and R. Wagner, 'Europäisches Kollisionsrecht 2013: Atempause im status quo' (2014)34(1) IPRax 1

**Martiny 1984**

D. Martiny in *Handbuch des Internationalen Zivilverfahrensrechts Band III/2* (J.C.B. Mohr (Paul Siebeck), Tübingen 1984)

**Matthies 1955**

H. Matthies, *Die deutsche internationale Zuständigkeit* (Vittorio Klostermann, Frankfurt am Main 1955)

**McGuire (2011)57(8) WRP 983**

M.-R. McGuire, 'GAT/LuK Revisited: Die internationale Zuständigkeit in Patentstreitigkeiten vor dem Hintergrund der EuGVO-Reform' (2011)57(8) WRP 983

**McGuire 2014 (Burgstaller, Neumayr, Geroldinger & Schmaranzer)**

A. Geroldinger in A. Burgstaller, M. Neumayr, A. Geroldinger and G. Schmaranzer (eds), *Internationales Zivilverfahrensrecht* (17<sup>th</sup> update LexisNexis Verlag ARD Orac GmbH & Co KG, Wien 2014)

**Meier-Beck (1999)101(5) GRUR 379**

P. Meier-Beck, 'Aktuelle Fragen des Patentverletzungsverfahrens' (1999)101(5) GRUR 379

**Merkt 1993**

O. Merkt, *Les mesures provisoires en droit international privé* (Huber Druck AG, Entlebuch 1993)

**Mes 2005**

P. Mes, *Patentgesetz – Gebrauchsmustergesetz* (2<sup>nd</sup> edn Verlag C.H. Beck oHG, München 2005)

**Metzger 2009**

A. Metzger, 'Jurisdiction in Cases Concerning Intellectual Property Infringements on the Internet – Brussels-I-Regulation, ALI-Principles and Max-Planck Proposals' in S. Leible and A. Ohly (eds), *Intellectual Property and Private International Law*, pp. 251-268 (Mohr Siebeck, Tübingen 2009)

**Miller, Burkill, Birss & Campbell 2011 (Terrell)**

R. Miller, G. Burkill, C. Birss & D. Campbell (eds), *Terrell on the Law of Patents* (17<sup>th</sup> edn Sweet & Maxwell Limited, London 2011)

**Mousseron, Raynard & Véron (1998)29(8) IIC 884**

J.-M. Mousseron, J. Raynard and P. Véron, 'Cross-Border Injunctions – A French Perspective' (1998)29(8) IIC 884

**Muir Watt 2012 (Magnus & Mankowski)**

H. Muir Watt in U. Magnus and P. Mankowski (eds), *European Commentaries on Private International Law – Brussels I Regulation* (2<sup>nd</sup> edn sellier european law publishers GmbH, Munich 2012)

**Munzinger & Traub (2006)108(1) GRUR 33**

P.J.A. Munzinger and F. Traub, 'Weniger ist Mehr – oder: Deutscher Sonderweg bei Gemeinschaftsgerichten?' (2006)108(1) GRUR 33

**Musger 2012**

G. Musger, 'Aktuelle Rechtsprechung zur Brüssel I-Verordnung' in B. König and P.G. Mayr (eds), *Europäisches Zivilverfahrensrecht in Österreich III*, pp. 11-29 (MANZ'sche Verlags- und Universitätsbuchhandlung GmbH, Wien 2012)

**Nagel & Gottwald 2013**

H. Nagel and P. Gottwald, *Internationales Zivilprozessrecht* (7<sup>th</sup> edn Verlag Dr. Otto Schmidt KG, Köln 2013)

**Neuhaus (1996)87(9) Mitt. 257**

W. Neuhaus, 'Das Übereinkommen über die gerichtliche Zuständigkeit und die Vollstreckung gerichtlicher Entscheidungen in Zivil –und Handelssachen vom 27.9.1968 (EuGVÜ) und das Luganer Übereinkommen vom 16.9.1988 (LugÜ), soweit hiervon Streitigkeiten des gewerblichen Rechtsschutzes betroffen werden' (1996)87(9) Mitt. 257

**Newman (1997)8 Fordham Intell. Prop. Media & Ent. L.J. 3**

P. Newman, 'On Global Patent Cooperation' (1997)8 Fordham Intell. Prop. Media & Ent. L.J. 3

**Nooteboom 2003**

E. Nooteboom, 'Die Arbeiten zur Schaffung einer Gemeinschaftspatentgerichtsbarkeit' in E. Keller, C. Plassmann and A. von Falck (eds), *Festschrift für Winfried Tilmann*, pp. 567-585 (Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München 2003)

**Norrgård 2005**

M. Norrgård, 'Provisional Measures and Multiple Defendants in the MPI Proposal' in J. Drexler and A. Kur (eds), *Intellectual Property and Private International Law – Heading for the Future*, pp. 35-54 (Hart Publishing, Oxford and Portland, Oregon 2005)

**Norrgård 2009**

M. Norrgård, 'A Spider Without a Web? Multiple Defendants in IP Litigation' in S. Leible and A. Ohly (eds), *Intellectual Property and Private International Law*, pp. 211-230 (Mohr Siebeck, Tübingen 2009)

**Nuyts 2008**

A. Nuyts, 'Suing At the Place of Infringement: The Application of Article 5(3) of Regulation 44/2001 to IP Matters and Internet Disputes' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 105-130 (Kluwer Law International, Alphen aan den Rijn 2008)

**Nuyts, Szychowska & Hatzimihail 2008**

A. Nuyts, K. Szychowska and N. Hatzimihail, 'Cross-Border Litigation in IP/IT Matters in the European Union: The Transformation of the Jurisdictional Landscape' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 1-47 (Kluwer Law International, Alphen aan den Rijn 2008)

**Nygh/Pocar Report**

P. Nygh and F. Pocar, Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters, pp. 2-128, available at WWW  
<<http://www.hcch.net/upload/wop/jdgmpl11.pdf>>

**Ohl (1961)63(10) GRUR 521**

A. Ohl, 'Der Sitz des Rechtsinhabers als Gerichtsstand der unerlaubten Handlung bei Streitigkeiten wegen Verletzung gewerblicher Schutzrechte' (1961)63(10) GRUR 521

**Ohly (2012)4 ZGE/IPJ 419**

A. Ohly, 'Auf dem Weg zum Einheitspatent und zum Einheitlichen Patentgericht – Licht am Ende des Tunnels oder Tunnel am Ende des Lichts?' (2012)4 ZGE/IPJ 419

**Osterrieth 2010**

C. Osterrieth, *Patentrecht* (4<sup>th</sup> edn Verlag C.H. Beck oHG, München 2010)

**Otte 1998**

K. Otte, *Umfassende Streitentscheidung durch Beachtung von Sachzusammenhängen – Gerechtigkeit durch Verfahrensabstimmung?* (J.C.B. Mohr (Paul Siebeck), Tübingen 1998)

**Otte (2001)21(4) IPRax 315**

K. Otte, 'Internationale Zuständigkeit und Territorialitätsprinzip – Wo liegen die Grenzen der Deliktzuständigkeit bei Verletzung eines europäischen Patents?' (2001)21(4) IPRax 315

**Pagenberg (2007)38(7) IIC 805**

J. Pagenberg, 'Another Year of Debates on Patent Jurisdiction in Europe and No End in Sight?' (2007)38(7) IIC 805

**Pagenberg (2011)113(1) GRUR 32**

J. Pagenberg, 'Das zukünftige europäische Patentgerichtssystem – Status Quo nach den Anträgen der Generalanwälte' (2011)113(1) GRUR 32

**Pagenberg (2012)114(6) GRUR 582**

J. Pagenberg, 'Die EU-Patentrechtsreform – zurück auf Los?' (2012)114(6) GRUR 582

**Pålsson 2000**

L. Pålsson, 'Interim Relief under the Brussels and Lugano Conventions' in J. Basedow and others (eds), *Private Law In The International Arena – Liber Amicorum Kurt Siehr*, pp. 621-638 (T.M.C.Asser Press, The Hague 2000)

**Pansch (2000/01)1(5) EuLF 353**

R. Pansch, 'Der Gerichtsstand der unerlaubten Handlung bei der grenzüberschreitenden Verletzung gewerblicher Schutzrechte' (2000/01)1(5) EuLF 353

**Pansch 2003**

R. Pansch, *Die einstweilige Verfügung zum Schutze des geistigen Eigentums im grenzüberschreitenden Verkehr* (Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München 2003)

**Pavana Kumar (2009)97(7) Current Science 1009**

K.V.N. Pavana Kumar, 'Issues in cross-border patent infringement: a European story' (2009)97(7) Current Science 1009

**Peers (2011)7(2) E.C.L. Review 229**

S. Peers, 'The constitutional implications of the EU patent' (2011)7(2) E.C.L. Review 229

**Peinze 2002**

A. Peinze, *Internationales Urheberrecht in Deutschland und England* (J.C.B. Mohr (Paul Siebeck), Tübingen 2002)

**Pernice and Hindelang (2010)21(11) EuZW 407**

I. Pernice and S. Hindelang, 'Potenziale europäischer Politik nach Lissabon – Europapolitische Perspektiven für Deutschland, seine Institutionen, seine Wirtschaft und seine Bürger' (2010)21(11) EuZW 407

**Pertegás Sender 2002**

M. Pertegás Sender, *Cross-Border Enforcement of Patent Rights* (Oxford University Press Inc., New York 2002)

**Pertegás Sender 2008**

M. Pertegás Sender, 'The Appropriate Venue for Cross-Border Patent Disputes: Heading (Far) West?' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 89-104 (Kluwer Law International, Alphen aan den Rijn 2008)

**Pertegás Sender 2012 (Magnus & Mankowski)**

M. Pertegás Sender in U. Magnus and P. Mankowski (eds), *European Commentaries on Private International Law – Brussels I Regulation* (2<sup>nd</sup> edn sellier european law publishers GmbH, Munich 2012)

**Petit (2000)31(6) IIC 669**

L. Petit, 'The Enforcement of Patent Rights in France' (2000)31(6) IIC 669

**Pfeiffer 2008 (Heidelberg Report)**

T. Pfeiffer in B. Hess, T. Pfeiffer and P. Schlosser (eds), *The Brussels I-Regulation (EC) No 44/2001 – The Heidelberg Report on the Application of Regulation Brussels I in 25 Member States (Study JLS/C4/2005/03)* (Verlag C.H. Beck oHG, München 2008)

**Piltz (1979)32(21) NJW 1071**

B. Piltz, 'Die Zuständigkeitsordnung nach dem EWG-Gerichtsstands- und Vollstreckungsübereinkommen' (1979)32(21) NJW 1071

**Piotraut 2004**

J.-L. Piotraut, *Droit de la propriété intellectuelle* (Ellipses Édition Marketing S.A., Paris 2004)

**Pitz (2001)50(1) GRUR Int. 32**

J. Pitz, 'Torpedos unter Beschuss' (2001)50(1) GRUR Int. 32

**Pocar Report**

F. Pocar, Explanatory Report on the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, OJ C319 of 23 December 2009, pp. 1-56, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2009:319:0001:0056:EN:PDF>>

**Pohl (2013)33(2) IPRax 109**

M. Pohl, 'Die Neufassung der EuGVVO – im Spannungsfeld zwischen Vertrauen und Kontrolle' (2013)33(2) IPRax 109

**Poore (2011)33(7) E.I.P.R. 409**

A. Poore 'The European Union patent system: off course or on the rocks?' (2011)33(7) E.I.P.R. 409

**Pörnbacher 2014 (Geimer & Schütze, Internationaler Rechtsverkehr)**

K. Pörnbacher in R. Geimer and R.A. Schütze (eds), *Internationaler Rechtsverkehr in Zivil- und Handelssachen; Loseblatt-Handbuch mit Texten, Kommentierungen und Länderberichten* (48<sup>th</sup> update Verlag C.H. Beck oHG, München 2014)

**Queirolo 2012 (Magnus & Mankowski)**

I. Queirolo in U. Magnus and P. Mankowski (eds), *European Commentaries on Private International Law – Brussels I Regulation* (2<sup>nd</sup> edn sellier european law publishers GmbH, Munich 2012)

**Reber (2005)49(3) ZUM 194**

U. Reber, 'Die internationale gerichtliche Zuständigkeit bei grenzüberschreitenden Urheberrechtsverletzungen – Ein internationaler Überblick' (2005)49(3) ZUM 194

**Rechberger & Frauenberger-Pfeiler (2001)6 ZZPInt 3**

W.H. Rechberger and U. Frauenberger-Pfeiler, 'Der österreichische Oberste Gerichtshof und der räumlich-persönliche Anwendungsbereich des EuGVÜ/LGVÜ' (2001)6 ZZPInt 3

**Reichardt 2006**

S. Reichardt, *Internationale Zuständigkeit im Gerichtsstand der unerlaubten Handlung bei Verletzung europäischer Patente* (Peter Lang GmbH – Europäischer Verlag der Wissenschaften, Frankfurt am Main 2006)

**Reid 1999**

B.C. Reid, *A Practical Guide to Patent Law* (3<sup>rd</sup> edn Sweet & Maxwell Limited, London 1999)

**Reimann & Kreye 2003**

T. Reimann and B. Kreye, 'Weiteres zur Aussetzung des Patentverletzungsverfahrens' in E. Keller, C. Plassmann and A. von Falck (eds), *Festschrift für Winfried Tilmann*, pp. 587-597 (Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München 2003)

**Rodriguez (2012)34(6) E.I.P.R. 402**

V. Rodriguez, 'From national to supranational enforcement in the European patent system' (2012)34(6) E.I.P.R. 402

**Rogge & Grabinski 2006 (Benkard – Patentgesetz)**

R. Rogge and K. Grabinski in *Benkard – Patentgesetz, Gebrauchsmustergesetz* (10<sup>th</sup> edn Verlag C.H. Beck oHG, München 2006)

**Romandini & Klicznik (2013)44(5) IIC 524**

R. Romandini and A. Klicznik, 'The Territoriality Principle and Transnational Use of Patented Inventions – The Wider Reach of a Unitary Patent and the Role of the CJEU' (2013)44(5) IIC 524



**Rößler (2007)38(4) IIC 380**

M. Rößler, 'The court of jurisdiction for joint parties in international patent disputes' (2007)38(4) IIC 380

**Roth 2004**

H. Roth, 'Schranken der Aussetzung nach § 148 ZPO und Art. 28 EuGVO' in H.-P. Mansel, T. Pfeiffer, H. Kronke, C. Kohler and R. Hausmann (eds), *Festschrift für Erik Jayme*, Band I, pp. 747-756 (Sellier. European Law Publishers GmbH, München 2004)

**Roth 2008**

H. Roth, 'Das Konnexitätserfordernis im Mehrparteiengerichtsstand des Art.6 Nr.1 EuGVO' in D. Baetge, J. von Hein and M. von Hinden, *Die richtige Ordnung – Festschrift für Jan Kropholler zum 70. Geburtstag*, pp. 885-903 (Mohr Siebeck, Tübingen 2008)

**Sack (2000)46(3) WRP 269**

R. Sack, 'Das internationale Wettbewerbs- und Immaterialgüterrecht nach der EGBGB-Novelle' (2000)46(3) WRP 269

**Schaafsma 2009**

S.J. Schaafsma, *Intellectuele Eigendom in het Conflictenrecht* (Kluwer, Deventer 2009)

**Schaafsma 2011**

S.J. Schaafsma, 'Philips/Postech en het grensoverschrijdend verbod. Qua patet orbis' in Th.M. de Boer and Others (eds), *Strikwerda's conclusies. Opstellen aangeboden aan mr. L. Strikwerda ter gelegenheid van zijn afscheid als advocaat-generaal bij de Hoge Raad der Nederlanden*, pp. 431-444 (Kluwer, Deventer 2011)

**Schacht (2012)114(11) GRUR 1110**

H. Schacht, 'Neues zum internationalen Gerichtsstand der Streitgenossen bei Patentverletzungen' (2012)114(11) GRUR 1110

**Schack (2000)3(3) MMR 135**

H. Schack, 'Internationale Urheber-, Marken- und Wettbewerbsrechtsverletzungen im Internet – Internationales Zivilprozessrecht' (2000)3(3) MMR 135

**Schack (2003)23(2) IPRax 141**

H. Schack, 'Zum auf grenzüberschreitende Sendevorgänge anwendbaren Urheberrecht' (2003)23(2) IPRax 141

**Schack 2009**

H. Schack, 'Die Entwicklung des europäischen Internationalen Zivilverfahrensrechts – aktuelle Bestandsaufnahme und Kritik' in R. Stürner, H. Matsumoto, W. Lüke and M. Deguchi (eds), *Festschrift für Dieter Leipold zum 70. Geburtstag*, pp. 317-334 (Mohr Siebeck, Tübingen 2009)

**Schack 2010**

H. Schack, *Internationales Zivilverfahrensrecht* (5<sup>th</sup> edn Verlag C.H. Beck oHG, München 2010)

**Schack 2011**

H. Schack, *Einführung in das US-amerikanische Zivilprozessrecht* (4<sup>th</sup> edn Verlag C.H. Beck oHG, München 2011)

**Schade (2010)41(7) IIC 806**

J. Schade, 'Is the Community (EU) Patent Behind the Times? – Globalisation Urges Multilateral Cooperation' (2010)41(7) IIC 806

**Scharen 2012 (Benkard – Europäisches Patentübereinkommen)**

U. Scharen in J. Ehlers and U. Kinkeldey (eds), *Benkard – Europäisches Patentübereinkommen* (2<sup>nd</sup> edn Verlag C.H. Beck oHG, München 2012)

**Schauwecker (2008)57(2) GRUR Int. 96**

M. Schauwecker, 'Zur internationalen Zuständigkeit bei Patentverletzungsklagen – Der Fall Voda v. Cordis im Lichte europäischer und internationaler Entwicklungen' (2008)57(2) GRUR Int. 96

**Schauwecker 2009**

M. Schauwecker, *Extraterritoriale Patentverletzungsjurisdiktion – Die internationale Zuständigkeit der Gerichte außerhalb des Patenterteilungsstaates für Verletzungsverfahren* (Carl Heymanns Verlag GmbH, Köln, München 2009)

**Schauwecker (2009)58(3) GRUR Int. 187**

M. Schauwecker, 'Die Entscheidung GAT gegen LuK und drittstaatliche Patente' (2009)58(3) GRUR Int. 187

**Schlosser Report**

P. Schlosser, Report on the Convention on the Association of the Kingdom of Denmark, Ireland and the United Kingdom of Great Britain and Northern Ireland to the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters and to the Protocol on its interpretation by the Court of Justice, OJ C59 of 5 March 1979, pp. 71-151, available at WWW <[http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC\\_1979\\_059\\_R\\_0071\\_01&rid=1](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOC_1979_059_R_0071_01&rid=1)>

**Schlosser 2008 (Heidelberg Report)**

P. Schlosser in B. Hess, T. Pfeiffer and P. Schlosser (eds), *The Brussels I-Regulation (EC) No 44/2001 – The Heidelberg Report on the Application of Regulation Brussels I in 25 Member States (Study JLS/C4/2005/03)* (Verlag C.H. Beck oHG, München 2008)

**Schlosser 2009**

P.F. Schlosser, *EU-Zivilprozessrecht – EuGVVO, AVAG, VTVO, MahnVO, BagatellVO, HZÜ, EuZVO, HBÜ, EuBVO* (3<sup>rd</sup> edn Verlag C.H. Beck oHG, München 2009)

**Schmaranzer 2014 (Burgstaller, Neumayr, Geroldinger & Schmaranzer)**

G. Schmaranzer in A. Burgstaller, M. Neumayr, A. Geroldinger and G. Schmaranzer (eds), *Internationales Zivilverfahrensrecht* (17<sup>th</sup> update LexisNexis Verlag ARD Orac GmbH & Co KG, Wien 2014)

**Schneider 2005**

M. Schneider, *Die Patentgerichtsbarkeit in Europa – Status quo und Reform* (Carl Heymanns Verlag KG, Köln, Berlin, München 2005)

**Schröder 1971**

J. Schröder, *Internationale Zuständigkeit – Entwurf eines Systems von Zuständigkeitsinteressen im zwischenstaatlichen Privatverfahrensrecht aufgrund rechtshistorischer, rechtsvergleichender und rechtspolitischer Betrachtungen* (Westdeutscher Verlag GmbH, Opladen 1971)

**Schulz 2005**

A. Schulz, 'The Hague Project of a Global Judgments Convention and IP Rights: Recent Developments' in J. Basedow, J. Drexler, A. Kur and A. Metzger (eds), *Intellectual Property in the Conflict of Laws*, pp. 39-56 (Mohr Siebeck, Tübingen 2005)

**Simotta 2008 (Fasching – Kommentar zu den Zivilprozeßgesetzen)**

D.-A. Simotta in H.W. Fasching and A. Konecny (eds), *Kommentar zu den Zivilprozeßgesetzen; 5. Band/1. Teilband* (2<sup>nd</sup> edn Manzsche Verlags- und Universitätsbuchhandlung, Wien 2008)

**Spellenberg (1980)15(4) EuR 329**

U. Spellenberg, 'Das Europäische Gerichtsstands- und Vollstreckungsübereinkommen als Kern eines europäischen Zivilprozeßrechts' (1980)15(4) EuR 329

**Stadler (1999)54(22) JZ 1089**

A. Stadler, 'Erlass und Freizügigkeit einstweiliger Maßnahmen im Anwendungsbereich des EuGVÜ' (1999)54(22) JZ 1089

**Stadler 2012 (Musiellak)**

A. Stadler in H.-J. Musiellak (ed), *Kommentar zur Zivilprozessordnung mit Gerichtsverfassungsgesetz* (9<sup>th</sup> edn Verlag Franz Vahlen GmbH, München 2012)

**Stauder 1973**

D. Stauder, 'Gerichtliche Zuständigkeit für Klagen aus ausländischen Patenten' in H.P. Kunz, A. v. Mühlendahl, D. Stauder and H. Ullrich (eds), *Gewerblicher Rechtsschutz – Urheberrecht – Wirtschaftsrecht, Mitarbeiterfestschrift zum 70. Geburtstag von Eugen Ulmer mit Beiträgen aus dem deutschen, ausländischen und internationalen Recht*, pp. 509-520 (Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München 1973)

**Stauder (1975)24(3) GRUR Int. 86**

D. Stauder, 'Zur Gestaltung des künftigen Patentverletzungsverfahrens in Europa' (1975)24(3) GRUR Int. 86

**Stauder (1976)25(11) GRUR Int. 465**

D. Stauder, 'Die Anwendung des EWG-Gerichtsstands- und Vollstreckungsübereinkommens auf Klagen im gewerblichen Rechtsschutz und Urheberrecht' (1976)25(11) GRUR Int. 465

**Stauder (1976)25(12) GRUR Int. 510**

D. Stauder, 'Die Anwendung des EWG-Gerichtsstands- und Vollstreckungsübereinkommens auf Klagen im gewerblichen Rechtsschutz und Urheberrecht – Zweiter Teil – Besondere Gerichtsstandsregeln für Klagen im gewerblichen Rechtsschutz' (1976)25(12) GRUR Int. 510

**Stauder (1997)46(11) GRUR Int. 859**

D. Stauder, 'Grenzüberschreitender Rechtsschutz für europäische Patente – I. Teil: Eine Zwischenbilanz' (1997)46(11) GRUR Int. 859

**Stauder (1998)18(5) IPRax 317**

D. Stauder, 'Grenzüberschreitende Verletzungsverbote im gewerblichen Rechtsschutz und das EuGVÜ' (1998)18(5) IPRax 317

**Stauder (2003)3(5/6) EuLF 286**

D. Stauder, 'Cross-border infringements in the field of European Patents' (2003)3(5/6) EuLF 286

**Stauder 2005**

D. Stauder, 'Die internationale Zuständigkeit in Patentverletzungsklagen – "Nach drei Jahrzehnten"' in A. Ohly and others (eds), *Perspektiven des Geistigen Eigentums und Wettbewerbsrechts, Festschrift für Gerhard Schricker zum 70. Geburtstag*, pp. 917-928 (Verlag C.H. Beck, München 2005)

**Stauder 2006**

D. Stauder, 'Zur Mediationsfähigkeit patentrechtlicher Konflikte' in D. Beier, L. Brüning-Petit and C. Heath (eds), *Festschrift für Jochen Pagenberg zum 65. Geburtstag*, pp. 351-361 (Carl Heymanns Verlag KG, Köln, Berlin, München 2006)

**Stauder & Kur 2001**

D. Stauder and A. Kur, 'Extraterritoriale Jurisdiktion und Streitbeilegung' in G. Schricker, T. Dreier & A. Kur (eds), *Geistiges Eigentum im Dienst der Innovation*, pp. 151-177 (Nomos Verlagsgesellschaft, Baden-Baden 2001)

**Staudinger 2011 (Rauscher)**

A. Staudinger in T. Rauscher (ed), *Europäisches Zivilprozess- und Kollisionsrecht – EuZPR / EuIPR, Kommentar* (sellier. european law publishers GmbH, München 2011)

**Stieper 2012 (Grabitz, Hilf & Nettesheim)**

M. Stieper in E. Grabitz, M. Hilf and M. Nettesheim (eds), *Das Recht der Europäischen Union Band II: EUV/AEUV* (49th update Verlag C.H. Beck oHG, München 2012)

**Stjerna (2012)103(2) Mitt. 54**

I.B. Stjerna, 'Die Beratungen zum "Einheitspatent" und der zugehörigen Gerichtsbarkeit – Auf dem Weg ins Desaster' (2012)103(2) Mitt. 54

**Stoll (1999)19(1) IPRax 29**

H. Stoll, 'Dinglicher Gerichtsstand, Vertragsstatut und Realstatut bei Vereinbarungen zum Miteigentümerverhältnis' (1999)19(1) IPRax 29

**Straus & Klunker (2007)38(8) IIC 907**

J. Straus and N.-S. Klunker, 'Harmonisation of International Patent Law' (2007)38(8) IIC 907 (= (2007)56(2) GRUR Int. 91)

**Sujecki (2012)61(1) GRUR Int. 18**

B. Sujecki, 'Torpedoklagen im europäischen Binnenmarkt' (2012)61(1) GRUR Int. 18

**Sydow (2001)103(8) GRUR 689**

G. Sydow, 'Die Ausdifferenzierung des Gerichtssystems der EU – Zur Struktur der künftigen europäischen Patentgerichtsbarkeit' (2001)103(8) GRUR 689

**Szychowska 2008**

K. Szychowska, 'Jurisdiction to Grant Provisional Measures in Intellectual Property Matters' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 207-236 (Kluwer Law International, Alphen aan den Rijn 2008)

**Ten Wolde & Henckel (2013)3(2) IJPL 195**

M.H. ten Wolde and K.C. Henckel, 'The ECJ's Interpretation of Article 5(3) Brussels I Regulation: A Carefully Balanced System of Jurisdictional Rules?' (2013)3(2) IJPL 195

**Ten Wolde/Knot & Weller 2012 (unalex Kommentar)**

M. ten Wolde/J.-G. Knot and M. Weller in T. Simons and R. Hausmann (eds), *unalex Kommentar, Brüssel I-Verordnung – Kommentar zur VO (EG) 44/2001 und zum Übereinkommen von Lugano* (IPR Verlag GmbH, München 2012)

**Teixeira de Sousa (2003)23(4) IPRax 320**

M. Teixeira de Sousa, 'Der Anwendungsbereich von Art.22 Nr.1 S.2 EuGVVO' (2003)23(4) IPRax 320

**Tetzner (1976)78(12) GRUR 669**

V. Tetzner, 'Die Verfolgung der Verletzung ausländischer Patente vor deutschen Gerichten unter Berücksichtigung des EWG-Gerichtsstands- und Vollstreckungs-Abkommens' (1976)78(12) GRUR 669

**The American Law Institute 2008 (ALI Principles)**

The American Law Institute, *Intellectual Property – Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes* (American Law Institute Publishers, St. Paul (Minnesota, USA) 2008)

**Thiel & Tschauner 2014 (Geimer & Schütze, Internationaler Rechtsverkehr)**

S. Thiel and H. Tschauner in R. Geimer and R.A. Schütze (eds), *Internationaler Rechtsverkehr in Zivil- und Handelssachen; Loseblatt-Handbuch mit Texten, Kommentierungen und Länderberichten* (48<sup>th</sup> update Verlag C.H. Beck oHG, München 2014)

**Thole (2009)122(4) ZZP 423**

C. Thole, 'Missbrauchskontrolle im Europäischen Zivilverfahrensrecht – Zur Problematik der sog. Zuständigkeitserschleichung' (2009)122(4) ZZP 423

**Thole (2013)66(17) NJW 1192**

C. Thole, 'Aktuelle Entwicklungen bei der negativen Feststellungsklage' (2013)66(17) NJW 1192

**Thomas (1996)27 Law & Pol'y Int'l Bus. 277**

J. R. Thomas, 'Litigation Beyond the Technological Frontier: Comparative Approaches to Multinational Patent Enforcement' (1996)27 Law & Pol'y Int'l Bus. 277

**Tilman (2003)52(5) GRUR Int. 381**

W. Tilman, 'Gemeinschaftspatent mit einem zentralen Gericht' (2003)52(5) GRUR Int. 381

**Tilman (2005)107(11) GRUR 904**

W. Tilman 'Neue Überlegungen im Patentrecht' (2005)107(11) GRUR 904

**Tilmann (2012)13(1) ERA Forum 87**

W. Tilmann, 'Moving towards completing the European Patent System: an Overview of the draft Agreement on a Unified Patent Court' (2012)13(1) ERA Forum 87

**Tilmann (2013)115(2) GRUR 157**

W. Tilmann, 'Durchbruch: die Entscheidungen zum Einheitspatent und zum Europäischen Patentgericht' (2013)115(2) GRUR 157

**Tilmann & von Falck (2000)102(7) GRUR 579**

W. Tilmann and A. von Falck, 'EU-Patentrechtsharmonisierung II: Forum-Shopping und Torpedo' (2000)102(7) GRUR 579

**Torremans (2007)29(5) E.I.P.R. 195**

P. L. C. Torremans, 'Exclusive jurisdiction and cross-border IP (patent) infringement: suggestions for amendment of the Brussels I Regulation' (2007)29(5) E.I.P.R. 195

**Torremans 2008**

P.L.C. Torremans, 'The Widening Reach of Exclusive Jurisdiction: Where Can You Litigate IP Rights after GAT?' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, pp. 61-77 (Kluwer Law International, Alphen aan den Rijn 2008)

**Torremans 2009**

P.L.C. Torremans, 'The Way Forward for Cross-Border Intellectual Property Litigation: Why GAT Cannot Be the Answer' in S. Leible and A. Ohly (eds), *Intellectual Property and Private International Law*, pp. 191-210 (Mohr Siebeck, Tübingen 2009)

**Torremans 2013 (CLIP Principles)**

P. Torremans in European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP) (ed), *Conflict of Laws in Intellectual Property – The CLIP Principles and Commentary* (1<sup>st</sup> edn Oxford University Press, Oxford 2013)

**Treichel (2001)50(8-9) GRUR Int. 690**

P. Treichel, 'Die französische Saisie-contrefaçon im europäischen Patentverletzungsprozeß – Zur Problematik der Beweisbeschaffung im Ausland nach Art. 24 EuGVÜ' (2001)50(8-9) GRUR Int. 690

**Treichel 2001**

P. Treichel, *Die Sanktionen der Patentverletzung und ihre gerichtliche Durchsetzung im deutschen und französischen Recht* (Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München 2001)

**Trimble 2012**

M. Trimble, *Global Patents – Limits of Transnational Enforcement* (Oxford University Press Inc., New York 2012)

**Tritton 2008**

G. Tritton and others, *Intellectual Property in Europe* (3<sup>rd</sup> edn Sweet & Maxwell Limited, London 2008)

**Tritton & Tritton (1987)9(12) E.I.P.R. 349**

C. Tritton and G. Tritton, 'The Brussels Convention and Intellectual property' (1987)9(12) E.I.P.R. 349

**Troller 1952**

A. Troller, *Das internationale Privat- und Zivilprozeßrecht im gewerblichen Rechtsschutz und Urheberrecht* (Verlag für Recht und Gesellschaft AG, Basel 1952)

**Troller (1955)4(12) GRUR Int. 529**

A. Troller, 'Europäisierung des Patentrechts und Gerichtsstand' (1955)4(12) GRUR Int. 529

**Trüstedt (2010)59(12) GRUR Int. 1039**

L. Trüstedt, 'Die Zukunft der Patentgerichtsbarkeit in Europa' (2010)59(12) GRUR Int. 1039

**Tsikrikas & Hausmann 2012 (unalex Kommentar)**

D. Tsikrikas and R. Hausmann in T. Simons and R. Hausmann (eds), *unalex Kommentar, Brüssel I-Verordnung – Kommentar zur VO (EG) 44/2001 und zum Übereinkommen von Lugano* (IPR Verlag GmbH, München 2012)

**Ubertazzi (2008)57(10) GRUR Int. 807**

B. Ubertazzi, 'Die EG-Beweisaufnahmeverordnung und die "Beschreibung" einer Verletzung des geistigen Eigentums' (2008)57(10) GRUR Int. 807

**Ubertazzi (2011)60(3) GRUR Int. 199**

B. Ubertazzi, 'Intellectual Property Rights and Exclusive (Subject-Matter) Jurisdiction' (2011)60(3) GRUR Int. 199

**Ubertazzi 2012**

B. Ubertazzi, *Exclusive Jurisdiction in Intellectual Property* (Mohr Siebeck, Tübingen 2012)

**Uhl 2000**

L. Uhl, *Internationale Zuständigkeit gemäß Art. 5 Nr. 3 des Brüsseler und Lugano-Übereinkommens* (Peter Lang GmbH – Europäischer Verlag der Wissenschaften, Frankfurt am Main 2000)

**Ullmann (2001)103(10-11) GRUR 1027**

E. Ullmann, 'Die Verwarnung aus Schutzrechten – mehr als eine Meinungsäußerung?' (2001)103(10-11) GRUR 1027

**Ullrich 2012**

H. Ullrich, 'Select from within the system: The European patent with unitary effect', Max Planck Institute for Intellectual Property and Competition Law Research Paper No. 12-11, available at: WWW <[http://www.ip.mpg.de/fileadmin/user\\_upload/SSRN12-11.pdf](http://www.ip.mpg.de/fileadmin/user_upload/SSRN12-11.pdf)>

**Ullrich (2015)46(1) IIC 1**

H. Ullrich, 'The European Patent and Its Courts: An Uncertain Prospect and an Unfinished Agenda' (2015)46(1) IIC 1

**Van Eechoud & Peukert 2013 (CLIP Principles)**

M. van Eechoud and A. Peukert in European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP) (ed), *Conflict of Laws in Intellectual Property – The CLIP Principles and Commentary* (1<sup>st</sup> edn Oxford University Press, Oxford 2013)

**Véron (2001)128(3) J.D.I. 805**

P. Véron, 'Trente ans d'application de la Convention de Bruxelles à l'action en contrefaçon de brevet d'invention' (2001)128(3) J.D.I. 805

**Véron (2004)35(6) IIC 638**

P. Véron, 'ECJ Restores Torpedo Power' (2004)35(6) IIC 638

**Vivant 1977**

M. Vivant, *Juge et Loi du Brevet* (Librairies Techniques, Libraire de la Cour de cassation, Paris 1977)

**Vivant (1991)37(1) RIW 26**

M. Vivant, 'Das Europäische Gerichtsstands- und Vollstreckungsübereinkommen und die gewerblichen Schutzrechte' (1991)37(1) RIW 26

**Von Hein (2005)25(1) IPRax 17**

J. von Hein, 'Deliktischer Kapitalanlegerschutz im europäischen Zuständigkeitsrecht' (2005)25(1) IPRax 17

**Von Hein (2013)59(3) RIW 97**

J. von Hein, 'Die Neufassung der Europäischen Gerichtsstands- und Vollstreckungsverordnung (EuGVVO)' (2013)59(3) RIW 97

**Von Meibom & Pitz (1996)87(7) Mitt. 181 (= Von Meibom & Pitz (1997)19(8) E.I.P.R. 469)**

W. von Meibom and J. Pitz, 'Grenzüberschreitende Verfügungen im internationalen Patentverletzungsverfahren' (1996)87(7) Mitt. 181 (= W. von Meibom and J. Pitz, 'Cross-border injunctions in international patent infringement proceedings' (1997)19(8) E.I.P.R. 469)

**Von Meibom & Pitz (1998)47(10) GRUR Int. 765**

W. von Meibom and J. Pitz, 'Die europäische "Transborderrechtsprechung" stößt an ihre Grenzen' (1998)47(10) GRUR Int. 765

**Wadlow 1998**

C. Wadlow, *Enforcement of Intellectual Property in European and International Law – The New Private International Law of Intellectual Property in the United Kingdom and the European Community* (Sweet & Maxwell Ltd, London 1998)

**Wagner 2011 (Stein/Jonas – Kommentar zur Zivilprozessordnung)**

G. Wagner in *Stein/Jonas – Kommentar zur Zivilprozessordnung, Band 10: EuGVVO, GVG* (Mohr Siebeck, Tübingen 2011)

**Wagner & Janzen (2010)30(4) IPRax 298**

R. Wagner and U. Janzen, 'Das Lugano-Übereinkommen vom 30.10.2007' (2010)30(4) IPRax 298



**Wannenmacher 2007**

K. Wannenmacher, *Einstweilige Maßnahmen im Anwendungsbereich von Art. 31 EuGVVO in Frankreich und Deutschland: Eine Betrachtung ausgesuchter Verfahren des einstweiligen Rechtsschutzes im internationalen Zivilverfahrensrecht – gerichtliche Zuständigkeit, Anerkennung und Vollstreckung* (Peter Lang GmbH, Frankfurt am Main 2007)

**Weber (2011)75 RabelsZ 619**

J. Weber, 'Universal Jurisdiction and Third States in the Reform of the Brussels I Regulation' (2011)75 RabelsZ 619

**Weller (2012)9(1) GPR 34**

M. Weller, 'Der Kommissionsentwurf zur Reform der Brüssel I-VO' (2012)9(1) GPR 34

**Weller (2012)9(6) GPR 328**

M. Weller, 'Der Ratsentwurf und der Parlamentsentwurf zur Reform der Brüssel I-VO' (2012)9(6) GPR 328

**Wenner 2002**

C. Wenner, 'Grundstückseigentum im Ausland – Gerichtsstand im Inland? Ein Beitrag zu § 24 ZPO und Art. 22 Nr. 1 EuGVO' in K. Brüggemann, P.M. Oppler and C. Wenner (eds), *Festschrift für Walter Jagenburg zum 65. Geburtstag*, pp. 1013-1026 (Verlag C.H. Beck oHG, München 2002)

**Wichard 2011 (Callies/Ruffert)**

J.C. Wichard in C. Callies and M. Ruffert (eds), *EUV/AEUV – Das Verfassungsrecht der Europäischen Union mit Europäischer Grundrechtecharta (Kommentar)* (4<sup>th</sup> edn Verlag C.H. Beck oHG, München 2011)

**Wilderspin (2006)95(4) Rev. crit. DIP 777**

M. Wilderspin, 'La compétence juridictionnelle en matière de litiges concernant la violation des droits de propriété intellectuelle – Les arrêts de la Cour de justice dans les affaires C-4/03, GAT c. LUK et C-539/03, Roche Nederland c. Primus et Goldberg' (2006)95(4) Rev. crit. DIP 777

**Willeitner 2003**

V. Willeitner, *Vermögensgerichtsstand und einstweiliger Rechtsschutz im deutschen, niederländischen und europäischen Internationalen Zivilverfahrensrecht* (Peter Lang GmbH, Frankfurt am Main 2003)

**Wilson 2002**

C. Wilson, *Intellectual Property Law in a Nutshell* (1<sup>st</sup> edn Sweet & Maxwell Limited, London 2002)

**Winkler 2011**

M. Winkler, *Die internationale Zuständigkeit für Patentverletzungsstreitigkeiten* (Peter Lang GmbH – Internationaler Verlag der Wissenschaften, Frankfurt am Main 2011)

**Wittwer & Fussenegger (2013)21(4) ZEuP 812**

A. Wittwer and A. Fussenegger, 'EuGH-Rechtsprechung zur EuGVVO aus den Jahren 2011 und 2012' (2013)21(4) ZEuP 812

**Wolf (2000)11(1) EuZW 11**

C. Wolf, 'Die Anerkennungsfähigkeit von Entscheidungen im Rahmen eines niederländischen kort geding-Verfahrens nach dem EuGVÜ – zugleich eine Anmerkung zum Urteil des EuGH vom 27. 4. 1999 in der Rs. C-99/96 – Hans-Hermann Mietz/Internship Yachting Sneek BV (EuZW 1999, 727)' (2000)11(1) EuZW 11

**Wolf & Lange (2003)49(1) RIW 55**

C. Wolf and S. Lange, 'Das Europäische System des einstweiligen Rechtsschutzes – doch noch kein System? – Anmerkung zu EuGH, Urteil vom 6. 6. 2002 – Rs. C-80/00, RIW 2002, 708 – Italian Leather' (2003)49(1) RIW 55

**Wukoschitz (2009)40(2) AfP 127**

M. Wukoschitz, "'Forum Shopping" durch Feststellungsklage?' (2009)40(2) AfP 127

**Zawadzka (2014)45(4) IIC 383**

Z. Zawadzka, 'The Unitary Patent Protection – A Voice in the Discussion from the Polish Perspective' (2014)45(4) IIC 383

**Zigann 2002**

M. Zigann, *Entscheidungen inländischer Gerichte über ausländische gewerbliche Schutzrechte und Urheberrechte* (VVF Verlag V. Florentz GmbH, München 2002)

## **FURTHER MATERIAL**

Action brought on 3 June 2011, C-274/11, Kingdom of Spain v Council of the European Union, OJ C219 of 23 July 2011, pp. 12-13, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:219:0012:0013:EN:PDF>>

Action brought on 10 June 2011, C-295/11, Italian Republic v Council of the European Union, OJ C232 of 6 August 2011, pp. 21-22, available at WWW <<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:232:0021:0022:EN:PDF>>

Action brought on 22 March 2013, C-146/13, Kingdom of Spain v European Parliament and Council of the European Union, OJ C171 of 15 June 2013, pp. 15-16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62013CN0146&qid=1435728914354&from=EN>>

Action brought on 22 March 2013, C-147/13, Kingdom of Spain v Council of the European Union, OJ C171 of 15 June 2013, p. 16, available at WWW <<http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62013CN0147&qid=1435729039478&from=EN>>



## CURRICULUM VITAE

Michael Christian Alexander Kant was born in Cologne, Germany on 7 March 1980. After successfully finishing grammar school in 1999, he did his military service in the combat troops (tanks) from July 1999 till April 2000, and, in the framework of a voluntary reserve duty training, as a military translator (English – German) from May 2000 till July 2000.

Between 2000 and 2007, Michael Kant successfully finished his law study at the University of Passau, Germany with the First Legal State Exam. During his study, Michael Kant had successfully completed a Foreign Legal Language Education in French Law and Language (including a stay at a language school in Paris) and in English Law and Language. In order to intensify his knowledge in private international law, Michael Kant complemented his study with an LL.M. programme in International and Comparative Private Law at the University of Groningen, the Netherlands between 2007 and 2008 which he successfully finished with two master's theses (“The Transfer of Ownership of Immovables in the European Context” and “The Treatment of Pre-contractual Liability in German Private International Law”).

After his LL.M. study in Groningen, the Netherlands, Michael Kant returned to Germany and successfully finished the German “*Rechtsreferendariat*”, including *inter alia* a three-months practical working period at the Dutch-German Chamber of Commerce in The Hague, with the Second Legal State Exam in Düsseldorf, Germany in 2010.

Immediately after acquiring his LL.M. degree, Michael Kant began his research for a doctoral thesis on “Cross-Border Patent Infringement Litigation within the European Union” under the supervision of prof. mr. dr. M.H. ten Wolde.

Michael Kant works as a lawyer in the law department of the Chamber of Commerce and Industry of Trier, Germany since 2011.

The following academic contributions have been published:

- M.C.A. Kant, *The Transfer of Ownership of Immovables in the European Context*, Ulrik Huber Institute for Private International Law, Comparative Private (International) Law Series, Prof. dr. M.H. ten Wolde LL.M. (ed), Hephaestus Publishers, Groningen 2008
- M.C.A. Kant, ‘A specialised Patent Court for Europe? – An analysis of Opinion 1/09 of the Court of Justice of the European Union from 8 March 2011 concerning the establishment of a European and Community Patents Court and a proposal for an alternative solution’ (2012)30(2) NIPR 193

- Mathijs H. ten Wolde and Michael C.A. Kant, Translation of the Burgerlijk Wetboek Boek 10, Internationaal Privaatrecht, from Dutch to German (Title 1 to Title 7), (2013)66(5) StAZ (Das Standesamt) 155
- Mathijs H. ten Wolde and Michael C.A. Kant, Translation of the Burgerlijk Wetboek Boek 10, Internationaal Privaatrecht, from Dutch to German (Title 1, Title 8 to Title 15), (2013)33(6) IPRax 584