

Is cross-border relief in European patent litigation at an end?

Marc Döring and Francis van Velsen*

The ECJ decisions in *GAT v LuK* and *Roche v Primus* appear to have prohibited cross-border relief, bringing the Dutch and the German patents courts (which were willing to grant such relief in certain circumstances) in line with the English Patents Court (which has always refused to grant such relief). However, the decisions still enable the Dutch and German patents courts to continue to grant cross-border relief in certain circumstances. Whether they will do so remains to be seen.

Before the ECJ decisions, the Dutch Supreme Court considered that issues of infringement and validity of a European patent—which by virtue of the European Patent Convention (“EPC”) is construed (at least in theory) in the same way across EPC Member States¹—are separable. Accordingly Article 22(4) of the Brussels Regulation, which expressly reserves jurisdiction regarding patent validity to the courts of the country where the patent is registered, does not prevent a national court from determining the issue of infringement of a European patent for other EU Member States and, in appropriate circumstances, granting cross-border relief.

In *Roche v Primus* the Dutch Supreme Court only referred questions to the ECJ in respect of jurisdiction relating to the non-Dutch-based European Roche companies. In relation to the Dutch and the US-based Roche companies (ie the national and non-EU defendants), the Dutch Supreme Court held in accordance with the Dutch Code of Civil Procedure:

The mere fact that serious indications exist that a foreign part of the European patent is invalid, constitutes no reason for the court to hold back from a decision regarding infringement by a party against whom the court has (for that matter) determined to be competent: a granted patent is valid until it is revoked or invalidated.

Thus, the Dutch Supreme Court distinguished between those defendants in relation to which it considered the Brussels Regulation applicable (ie non-Dutch European defendants) and those in relation to which the Brussels Regulation is inapplicable but national law applies (ie non-EU defendants and proceedings between national parties). For example, following *Roche v Primus*, the Supreme Court ruled similarly in *Philips v Postech* on 19 March 2004 concerning non-EU-based defendants, saying

if the Dutch court has jurisdiction based on any (general) jurisdiction provision in respect of a claim regarding infringement of a foreign intellectual property right, it has in principle, if requested by the claimant, also jurisdiction to give a cross-border injunction with regard to acts committed by the defendant outside the Dutch territory. The same applies for interim injunction proceedings irrespective of the ground on which the jurisdiction is based.

The Dutch Court of Appeal in *Fokker v Parteuropa* on 24 March 2005 (after the Attorney-General’s Opinions in *GAT v LuK* and *Roche v Primus* were issued in September 2004) accepted cross-border jurisdiction against a national defendant, on the basis of the reasoning put forward by the Dutch Supreme Court in *Roche v Primus*, that so long as the patent in suit is in force, it is considered valid.

However, the ECJ in *GAT v LuK* confirms that Article 22(4) applies as soon as the validity of the foreign European patent is put in issue (irrespective of domicile or the location where the alleged wrongful act took place), preventing courts establishing cross-border jurisdiction over both EU defendants and non-EU defendants.

In contrast to the approach by the Dutch Court of Appeal/Supreme Court, the District Court of The Hague’s approach to determining cross-border

* Simmons & Simmons. E-mail: Marc.doring@simmons-simmons.com

¹ There are currently 31 EPC contracting states, including 24 of the 25 EU member states (Malta has not acceded).

On 13 July 2006, the long awaited decisions of the European Court of Justice (ECJ) were given in the cases of *GAT v LuK*¹ and *Roche v Primus*². To the disappointment of some, the ECJ appears to have prohibited cross-border relief, bringing the Dutch and the German patents courts (which were willing to grant such relief in certain circumstances) in line with the English patents court (which has always refused to grant such relief). However, the decisions are such that both the Dutch and German patents courts may continue to grant cross-border relief in certain circumstances. Whether they do so or not, will have to be seen. However, the decisions will undoubtedly provide further impetus for many in industry to call for a centralised European Patents Court to be established as soon as possible, enabling parties to litigate European patents on a Europe-wide basis.

This article reviews the background to the two ECJ decisions, the decisions themselves and their likely impact on the future availability of cross-border relief from the Dutch and German courts.

Background

In the 1970s, the European Patent Convention (EPC) established a new system of patent law and a new patent granting authority for all contracting states, the European Patent Office (EPO). The EPO grants “European patents” under the EPC which, upon grant, take effect as separate national patents (and not as a single unitary right) in each of the contracting states designated by the patentee³. Once granted, it is open to parties to litigate

the validity and/or infringement of a European patent in each of the national courts of each of the designated contracting states – eg parties can litigate the European Patent (Germany) in the German courts, the European Patent (UK) in the UK courts and so on. Apart from decisions by the EPO regarding validity of a European patent in oppositions to the grant of the patent (filed within 9 months after grant), there is no centralised court which can decide issues of validity or infringement in respect of a European patent on a Europe-wide basis.

In accordance with the EPC, contracting states harmonised their national laws as to patentability so that, as far as possible, the national courts of each contracting state would approach the issue of the validity of granted European patents in the same way as the EPO⁴. The harmonised law also included rules as to the interpretation of patent claims. This in turn meant (at least in theory) that the law as to whether a product or process claimed by the patent falls within the claims of a patent for purposes of infringement was also substantially harmonised across the contracting states. However, absent a centralised court, over the last 30 years the law has received differing interpretations by the different national courts of the contracting states.

Further complexity is provided by the Brussels Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters now re-enacted by the ‘Brussels Regulation’ (Council Regulation (EC) No. 44/2001)⁵. The starting point in the Brussels Regulation is that a defendant should be sued in the EU member state where he is based (‘domiciled’) no matter where in the European

1 *Gesellschaft für Antriebstechnik mbH & Co KG v Lamellen und Kupplungsbau Beteiligungs KG*, Case C-4/03 on a request for a preliminary ruling by the Oberlandesgericht (Higher Regional Court) of Düsseldorf, Germany.

2 *Roche Nederland BV and others v Dr Frederick James Primus and another*, C-539/03 on a request for a preliminary ruling by the Hoge Raad (Supreme Court) of The Netherlands.

3 There are currently 31 EPC contracting states, including 24 of the 25 EU member states (Malta has not acceded to the EPC).

4 In addition to the EPC, a number of EU countries including The Netherlands, Germany and the UK have acceded to and ratified The Convention on the Unification of Certain Points of Substantive Law on Patents for Invention (‘Strasbourg Convention’ 1963).

5 Denmark is the only EU member state not to have ratified the Brussels Regulation, but the Brussels Convention continues to apply in relation to Denmark.

Union the wrongful act has taken place and irrespective of the defendant's nationality (Article 2). However, the defendant may alternatively be sued in the EU member state where the wrongful act (eg an alleged act of patent infringement) took place (Article 5(3)) irrespective of the defendant's domicile. Furthermore, Article 6(1) allows several defendants to be sued in the state of domicile of any one of them where there is a risk of "irreconcilable decisions". Once one court has been properly "seised" of a dispute (that is, the necessary formalities under national law for the commencement of proceedings have been complied with), all other courts in the European Union are obliged to decline jurisdiction (Article 27(1)), although notably they are permitted to grant interim relief in accordance with their own national laws where appropriate (Article 31). Finally, Article 22(4) expressly reserves jurisdiction regarding patent validity to the courts of the country where the patent is registered.

The practical effect of the EPC and Brussels Regulation is that patent litigation in Europe is often complex, and parties will often select countries in which to commence proceedings on the basis of the perceived advantages of local procedures and other tactical considerations, rather than any substantive consideration of the most objectively appropriate court (so-called 'forum shopping'). In particular, patentees and companies fearing infringement proceedings seek to exploit the jurisdictional rules of the Brussels Regulation to choose a court which will enable the dispute to be resolved rapidly (for the patentee) or slowly (by the putative infringer). In relation to the latter, in addition to commencing proceedings before the courts of a country whose procedures are slow, a putative infringer may also seek from that court a declaratory judgment of non-infringement not only of the local national patent but also of all foreign counterparts throughout Europe. If the patentee then brings infringement proceedings in any

other EU member state, the courts of that state must stay the proceedings (in accordance with Article 27(1), above) until the original court has made its own decision as to jurisdiction which might take many months or even years. Such a declaratory action is known as a "torpedo" action.

For many years it has been argued (successfully, in certain cases, before the Dutch and German courts) that the rules of the Brussels Regulation allow a patentee to ask a single court in Europe to decide the issue of infringement of a European patent in all relevant EU countries, the patentee often seeking a cross-border injunction by way of relief – ie an injunction to restrain acts of infringement in all relevant EU countries in which the European patent has been granted. In the Netherlands, for example, the Dutch court ruled⁶ that it could grant a pan-European injunction when the company with the key responsibility for the infringing activity occurring in other EU member states was based in the Netherlands (or where the controlling company was entirely outside the EU, for example in the US) – the so-called 'spider in the web' doctrine. This view has also been shared by the Düsseldorf court. Patent lawyers and the national courts of EU member states have therefore long awaited an authoritative decision by the ECJ on the underlying jurisdictional questions relating to the above 'procedural games'. Until the most recent decisions, all the cases that had previously been referred to the ECJ settled prior to any Judgment being given.

Both [GAT-v-LuK](#) and [Roche-v-Primus](#) concerned attempts to avoid the need to litigate separately in each EU member state essentially the same issues in relation to alleged infringing activities. Accordingly, each case sought clarification of the operation of the Brussels Regulation, specifically Article 22(4) in the case of [GAT-v-LuK](#), and Article 6(1) in the case of [Roche-v-Primus](#). As mentioned above, the starting point of the Regulation is

that a defendant should be sued in the EU member state where he is domiciled, no matter where in the European Union the wrongful act has taken place (Article 2). However, the defendant also may be sued in the EU member state where the alleged act of patent infringement took place (Article 5(3)). Furthermore, Article 6(1) also allows in certain circumstances several defendants to be sued in the state of domicile of any one of them. Finally, Article 22(4) expressly reserves jurisdiction regarding patent validity to the courts of the country where the patent is registered.

Specifically, Article 6(1) reads:

“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;”

Thus the scope of this article depends on how the terms “closely connected” (in respect of the claim(s) against defendants domiciled in the country in which the action is commenced, on the one hand, and claim(s) against defendants not domiciled in the country in which the action is commenced, on the other hand), and “irreconcilable judgments” (in respect of the outcome of the potentially separate proceedings) are defined.

Article 22(4) reads:

“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.”

The question is would a declaratory action for non-infringement in which the claimant pleads invalidity of the patent as part of its case on non-infringement be proceedings “concerned with the ... validity of [the] patent” ?

Finally, Article 27 states that “related actions” involving the same cause of action and parties should only be brought in one member state court, the court in which the action is first commenced.

Article 27(1) reads:

“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.”

The ECJ decisions

GAT v LuK

GAT and LuK are both German companies competing in the field of motor vehicle technology. GAT offered to supply hydraulic shock absorbers to Ford-Werke AG, a German based motor vehicle manufacturer. LuK alleged that the said shock absorbers infringed two of its French patents.

GAT brought a declaratory action before the Landgericht (Regional Court), Düsseldorf to establish that it did not

infringe the French patents and, notably, pleaded invalidity of the French patents as part of its case on non-infringement. The Landgericht Düsseldorf considered that it had jurisdiction to adjudicate upon the action relating to the alleged infringement of the French patents as well as the claim to the alleged invalidity of those patents (which it determined in accordance with French patent law). Under German law (as in other European jurisdictions), if invalidity of any foreign patents is pleaded either by a claimant in a declaratory action (as here), or by means of a defence to an infringement action (rather than by way of a separate claim) any court ruling would have *inter partes* effect only, and would not affect the validity of the patent *erga omnes*. The Landgericht dismissed the action brought by GAT, finding that the patents were valid.

On appeal by GAT, the Oberlandesgericht (Higher Regional Court), Düsseldorf decided to stay the proceedings and referred the following question to the ECJ for a preliminary ruling:

“Should Article 16(4) of the Convention [equivalent to Article 22(4) of the Regulation – see above] ... 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 [in this case France], has taken place or is deemed to have taken place under the terms of an international convention **only** applies if proceedings (with *erga omnes* effect) are brought to declare the patent invalid **or** are proceedings 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 void and that there is also no patent infringement for that reason [as GAT had done in this case], irrespective of whether

the court seised of the proceedings considers the plea in objection to be substantiated or unsubstantiated and of when the plea in objection is raised in the course of proceedings?”

In summary, the issue to be considered by the ECJ was could the German courts determine whether GAT's proposed activities in France would infringe LuK's French patents, given that GAT had merely sought a declaration in an infraction that the French patents were invalid, or does the exclusive jurisdiction of Article 22(4) (see above) apply whenever, and however, the putative infringer has brought invalidity into issue?

The ECJ held that although the scope of Article 22(4) could not be established from its wording, Article 22 must be interpreted by reference to its objective and in the context of the rest of the Regulation. The ECJ held that given that Article 22(4) seeks to ensure that jurisdiction rests with those courts most closely linked to the proceedings in fact and law, the French courts (the courts of the member state in which the patents had been registered) would have exclusive jurisdiction whichever form of proceedings had been used to put the validity of the patents in issue (ie irrespective of whether the validity of the patent had been raised by the claimant in declaratory proceedings (as it had been by GAT), by way of a defence to an infringement action, or by the defendant having brought a claim for invalidity of the patent). The ECJ considered that to allow national courts the freedom to rule *inter partes* on validity of foreign patents would increase the risk of conflicting decisions and undermine the mandatory nature of Article 22(4).

Therefore, the ECJ decision confirms the fact that Article 22(4) applies as soon as validity of the foreign European patent(s) is put in issue (irrespective of domicile or the location where the alleged wrongful act took place), preventing courts establishing cross-border jurisdiction over both EU defendants and non-EU defendants.

Roche v Primus

The inventors and proprietors of a European patent relating to monospecific antibodies for carcinoembryonic antigens, Dr Primus and Dr Goldenberg, brought an action before the District Court of the Hague against Roche Nederland BV, a Dutch company, and eight other companies in the Roche group based in the United States, Belgium, Germany, France, the United Kingdom, Switzerland, Austria and Sweden, respectively.

Primus and Goldenberg (who were based in the US) claimed that all the Roche companies had infringed their patent by selling immuno-assay kits in each of the countries where the individual defendants are based. The eight Roche companies not based in the Netherlands contested the jurisdiction of the Dutch courts on the basis they did not infringe and contested the validity of the local patents. The court considered that it had jurisdiction but found against Primus and Goldenberg.

On appeal, the Dutch Court of Appeal set aside the first instance judgment and, *inter alia*, prohibited the non-Dutch Roche companies from infringing the patent in all the countries for which it was granted. The Hoge Raad (Dutch Supreme Court) subsequently stayed the proceedings and referred the following questions to the ECJ 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,

- 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?”

In summary, the issue raised by the Dutch Supreme Court was whether the Dutch courts could grant an injunction to patentees pursuant to Article 6(1) of the Regulation not only in respect of the infringement of a local patent but also for infringement by other companies of the corresponding patents in EU member states and, if so, what was the requisite relationship between the infringing companies (ie addressing the issues that the Dutch courts had considered in propounding the ‘spider in the web’ doctrine mentioned above)?

If one member state’s courts could exercise jurisdiction to decide these matters beyond its borders, then the courts of other member states would have to decline jurisdiction and wait for, and then give effect to, the first court’s ruling in accordance with Article 27 of the Brussels Regulation. As already discussed, from a litigation tactics point of view, the result would be that a litigant could pick either a fast or slow court to decide the matter as it wished, knowing that its opponent would then be unable to have the matter decided in another state on a different timescale; also this would allow smaller litigants such as Primus and Goldenberg to take on large opponents such as Roche more cheaply via one central enforcement action.

The ECJ took the questions together and considered whether Article 6(1) applies to patent infringement proceedings involving a number of companies in various contracting states in respect of acts committed in one or more of those states and, in particular, the situation where those companies, which belong to the same group, have acted in an identical or similar manner in accordance with a common policy elaborated by one of them. The ECJ reaffirmed the formulation in [Kalfelis](#)⁷ that for Article 6(1) to apply there must exist between the various actions brought by the same claimant against different defendants, a connection of such kind that it is expedient to determine the action together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings.

However, the ECJ did not consider it necessary to decide whether “irreconcilable judgments” resulting from potentially separate proceedings meant either (i) merely involving the risk of conflicting decisions, or (ii) entailing legal consequences which are mutually exclusive. The ECJ held that⁸:

“...even assuming that the concept of ‘irreconcilable’ judgments for the purposes of the application of Article 6(1) ... must be understood in the broad sense of contradictory decisions, there is no risk of such decisions being given in European patent infringement proceedings brought in different Contracting States involving a number of defendants domiciled in those States in respect of acts committed in their territory.”

Notably, the ECJ held that in order for decisions to be regarded as contradictory, it is not sufficient that there only be a divergence in the outcome of the dispute, but that the divergence must also arise in the context of the same situation of law and fact.

The ECJ held that in [Roche-v-Primus](#), which concerned European patent infringement proceedings involving a number of companies established in various member states in respect of acts committed in one or more of

those states, the existence of the same factual scenario could not be inferred, since the defendants were different and the infringements they were accused of, committed in different contracting states, were not the same. The ECJ held that possible divergences between decisions given by the courts of each member state would not arise in the context of the same factual situation and would not satisfy the requirement of “irreconcilable judgments” in [Kalfelis](#).

The ECJ warned that a different view would only encourage the practice of forum shopping which [Kalfelis](#) sought to prevent. Accordingly, the ECJ held that Article 6(1) does not provide jurisdiction in European patent infringement proceedings.

The Netherlands

The view taken by the English courts (as well as the German courts in Mannheim) is that issues of infringement and validity of a European patent are inseparable and therefore Article 22(4) of the Brussels Regulation prevents a national court from deciding the issue of infringement for other EU Member States whenever and however invalidity is raised (see [Coin Controls -v- Suzo](#)⁹).

However, the view of the Dutch Supreme Court (which the German courts in Düsseldorf have also tended to follow, see below) is that issues of infringement and validity of a European patent (which by virtue of the EPC is construed (at least in theory) in the same way across EPC member states (including all the EU countries save Malta)) are separable, and therefore Article 22(4) of the Brussels Regulation does not prevent a national court from deciding on the issue of infringement of a European patent for other EU member states and, in appropriate circumstances, granting a cross-border injunction.

⁷ [Kalfelis -v- Schröder Case 189/87](#)

⁸ [At paragraph 25 of the Judgment](#)

⁹ [Coin Controls Ltd -v- Suzo International \(UK\) Ltd & Others \[1997\] 3 ALL ER 45](#)

It is important to note that in the [Roche-v-Primus](#) case itself, the Dutch Supreme Court only referred questions to the ECJ in respect of jurisdiction relating to the non-Dutch based European Roche companies. In relation to the Dutch and the US based Roche companies (ie the national and non-EU defendants), the Dutch Supreme court held in accordance with the Dutch Code of Civil Procedure:

“The mere fact that serious indications exist that a foreign part of the European patent is invalid, constitutes no reason for the court to hold back from a decision regarding infringement by a party against whom the court has (for that matter) determined to be competent: a granted patent is valid until it is revoked or invalidated.”

Thus, the Dutch Supreme Court distinguished between those defendants in relation to which it considered the Brussels Regulation applied (ie non-Dutch European defendants) and those in relation to which the Brussels Regulation does not apply, but national law applies (ie non-EU defendants and proceedings between national parties). For example, following the [Roche-v-Primus](#) decision, the Supreme Court ruled similarly in the case of [Philips-v-Postech](#) on 19 March 2004 concerning non-EU based defendants. The Supreme Court held:

“[...] if the Dutch court has jurisdiction based on any (general) jurisdiction provision in respect of a claim regarding infringement of a foreign intellectual property right, it has in principle, if requested by the claimant, also jurisdiction to give a cross-border injunction with regard to acts committed by the defendant outside the Dutch territory. The same applies for interim injunction proceedings irrespective of the ground on which the jurisdiction is based.”

The Dutch Court of Appeal in [Fokker-v-Parteurosa](#) on 24 March 2005 (after the Attorney-General’s Opinion had been given in [GAT-v-LuK](#) and [Roche-v-Primus](#) in

September 2004) accepted cross-border jurisdiction against a national defendant, on the basis of the reasoning put forward by the Dutch Supreme Court in [Roche-v-Primus](#) (above), namely that so long as the patent in suit is in force, it is considered to be valid.

However, as previously mentioned, the ECJ decision in [GAT-v-LuK](#) confirms the fact that Article 22(4) applies as soon as the validity of the foreign European patent is put in issue (irrespective of domicile or the location where the alleged wrongful act took place), preventing courts establishing cross-border jurisdiction over both EU defendants and non-EU defendants.

In contrast to the approach by the Dutch Court of Appeal/Supreme Court, the District Court of The Hague’s approach to determining cross-border jurisdiction against national defendants (under Article 2 of the Brussels Regulation and national law) following the Attorney-General’s Opinion in [GAT-v- LuK](#) and [Roche-v-Primus](#) in September 2004 has been to assess whether the case in issue is ‘purely’ an infringement case, or whether the defendant had raised an invalidity defence. In the case of the latter, the District Court held that it only had jurisdiction to hear the case in respect of the Dutch patent and not its foreign counterparts. It is therefore likely to continue this practice, and consider Article 22(4) to be applicable irrespective of whether jurisdiction is based on the Brussels Regulation or national law contrary to the previous findings of the Dutch Supreme Court.

In accordance with the previous ECJ decision in [Shevill](#)¹⁰, in cases where an European defendant is being sued before the Dutch courts on the grounds that the infringement allegedly occurred in The Netherlands (ie under Article 5(3) of the Brussels Regulation), the District Court has continued to refuse to grant cross-border relief in respect of any alleged infringements carried out in respect of the foreign counterparts of the European patent¹¹.

¹⁰ [Shevill v Presse Alliance S.A.](#), Case C-68/93

¹¹ The position is the same in relation to non-European defendants where the Dutch court accepts jurisdiction based on article 5(3) of the Brussels Regulation.

Therefore, in summary, it would appear that following the recent ECJ decisions in [GAT-v-LuK](#) and [Roche-v-Primus](#), the Dutch courts are likely to continue to assume cross-border jurisdiction in certain situations, as follows:

| Basis for the Proceedings | Cross border relief possible against EU domiciled defendants? |
|---|---|
| <p>Article 2 Brussels Regulation</p> <p>Eg Dutch based company sued in the Netherlands for infringement of Dutch and German patents</p> | <p>Yes – unless and until invalidity of patents put in issue, then Dutch court will only consider infringement/validity of the Dutch patent (GAT-v-LuK) and any other enforceable non-EU European patents</p> |
| <p>Article 5(3) Brussels Regulation</p> <p>Eg German based company and US based company sued in the Netherlands for infringement of both Dutch and German patents</p> | <p>No</p> <p>Court will consider infringement by both companies in relation to the Dutch patent only (Shevill)</p> |
| <p>Article 6(1) Brussels Regulation</p> <p>Eg Dutch based company, German based company and US based company sued in the Netherlands in respect of infringement of both Dutch and German patents</p> | <p>No</p> <p>Article 6(1) does not provide the Dutch court with jurisdiction (Roche-v-Primus).</p> <p>Therefore, in this example, the Dutch court would have jurisdiction in respect of the Dutch based defendant under Article 2 (see above comments) and against the German and US defendants under Article 5(3) (see above comments).</p> |

The ECJ decisions also raise a number of further issues, as follows:

1 It appears that the ECJ decisions do not apply where proceedings are brought for a declaration of non-infringement under Article 2 (eg claim for non-infringement of Dutch based defendant's European (Dutch) patent in the Netherlands) including other foreign counterparts to that European patent, so long as the claimant does not seek to assert non-infringement on the basis that the patent is invalid (as in [GAT-v-LuK](#)).

Have the decisions therefore given encouragement to a possible Dutch 'torpedo', such that Article 27 would prevent other EU member states from assuming jurisdiction over any infringement proceedings commenced by the same defendant(s) in other EU members states in relation to any one of the foreign counterparts already issue in the Dutch proceedings? The answer is yes but unlike earlier torpedoes, this one is a swift one and therefore not likely to be used.

2 Article 31 allows parties to apply to courts of member states for "provisional including protective measures as may be available **under the law of that state**, even if the courts of another member state have jurisdiction..." (emphasis added). Accordingly, even where a [GAT-v-LuK](#) defence is raised and invalidity of the patent is put in issue, it would appear that parties will still be able to obtain preliminary relief (which may include a cross-border injunction) in the Dutch courts under Article 31 of the Brussels Regulation as Article 22(4) would appear only to apply to proceedings on the merits rather than interim proceedings.

3 Would a [Gillette](#) or [Formstein](#) type defence (that the alleged infringement is identical to that disclosed in the prior art), be sufficient to raise invalidity of the patent, or are these considered only to be non-infringement (rather than invalidity) defences?

4 Although the ECJ in [GAT-v-LuK](#) held that Article 22(4) will apply whenever invalidity is put in issue, it did not comment on whether the 'strength' of the invalidity case was relevant. It will have to be seen whether the Dutch courts nevertheless continue to assess the 'seriousness' of any invalidity pleading, in accordance with their previous practice, when considering whether a case is purely an infringement case.

Therefore, although the ECJ appears to have prohibited cross-border relief, it may still be possible in certain circumstances before the Dutch courts.

Germany

In most European countries the court hearing a patent infringement claim will also take jurisdiction over issues of validity, whether raised as a defence or as a counterclaim or both, enabling the court to consider the scope of the claims once, for assessment of both infringement and validity. In Germany, however, validity of German patents is decided by way of separate court proceedings brought before the Federal Patents Court in Munich. This means that invalidity cannot be raised per se as a defence to an infringement claim. However, an infringement claim may be stayed or suspended pending the decision on validity by the Federal Patents Court (or where there are ongoing EPO Opposition proceedings). In Germany, the practice is generally to stay the infringement claim only if there is a strong case of invalidity. Since the procedures of the infringement courts (the Landgerichte) are often more rapid than those of the Federal Patents Court (the Bundespatentgericht), an injunction can be granted in Germany under a patent which is subsequently revoked.

Prior to the above ECJ decisions, the Düsseldorf court has granted a number of cross-border injunctions. In so doing, the Düsseldorf court divided the cases which concerned the Brussels Regulation into those which (i) only have a German based defendant (ie the court has jurisdiction under Article 2 of the Brussels Regulation); (ii) where there are several non-German based defendants in addition to, at least, one German based defendant (admissible under Article 6(1)); and (iii) the act complained of had taken place in Germany (admissible under Article 5(3)).

To date, cross-border relief has not been granted under article 5(3), but the Düsseldorf court has granted cross-border injunctions only if it has jurisdiction under Articles 2 or 6(1) (but only on the basis that the parties are sufficiently 'connected' in respect of the latter), or in relation to preliminary injunction proceedings. For example, the courts in Germany have held in certain, exceptional, circumstances that the filing of "torpedo" proceedings in another jurisdiction can be sufficient by itself to satisfy the German court to grant an interim injunction in Germany.

The Düsseldorf court has also taken the view that it can decide on the validity of any foreign counterparts in accordance with the appropriate foreign law. This is despite the fact that, as mentioned above, patent validity in Germany is subject to separate proceedings brought before the German Federal Patents Court. If a defendant raises the validity of any national patent(s) in the course of infringement proceedings, the German courts will only consider whether it should stay the infringement proceedings on the basis that the validity of the national patent(s) appear in doubt (for example, if 'strong' new prior art is raised by the defendant).

Conversely, the Mannheim court has taken the same position as the English courts finding that it does not have jurisdiction to hear a claim in which the defendant has been sued for patent infringement of the European patent in a country other than that which has granted the patent, if the validity of the foreign counterparts are put in issue.

It would appear that the possibility for the German courts to grant cross-border patent injunctions is now much more limited following the recent ECJ decisions.

However, similar to the position discussed above in connection with the Dutch courts, cross-border relief may still be possible in certain circumstances, and points 1 – 3 above would appear to apply equally to the German courts.

The decisions will certainly provide further impetus for many in industry to call for a centralised European Patents Court to be established as soon as possible, enabling parties to litigate European patents on a Europe-wide basis. Following the failed attempts by the European Commission in Brussels (the executive arm of the EU) to establish a new Community Patent (which upon grant would take effect throughout the EU as a single unitary patent and which could only be litigated in

specialised courts with jurisdiction for the whole of the EU), the Commission is now looking more positively at the proposals backed by many of Europe's leading IP Judges, known as the European Patent Litigation Agreement (EPLA). Having recognised the problems of the current patent litigation system in Europe, a working party drawn from a group of EPC contracting states have negotiated a draft agreement to create a single court system which will deal with all post-grant patent litigation concerning European Patents in those particular countries. Although a number of issues remain to be resolved, it is thought that we could see the EPLA proposals – and therefore a common litigation court – in force within two years.