

## European Litigation in Industrial Property

*(Application of the Brussels and Lugano Conventions and of the Regulation (EU) N° 1215/2012 to actions for infringement)*

*Course for judges from EPC member states  
European Patent Academy • online • 25 June 2021*

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1

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## The three pillars of private international law

- Conflicts of courts (jurisdiction)
- Conflicts of laws (applicable law)
- International effects of judgments (recognition and enforcement)



2

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## Conflicts of jurisdictions and Conflicts of laws

With respect to conflicts of laws

- the conflicts of jurisdictions are prior
- the conflicts of jurisdictions are distinct
- the conflicts of jurisdictions are connected



3

3

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## Conflicts of jurisdiction: overall view

- Domestic law
- Community law
- General international conventions
- Special international conventions



4

4

## Conflicts of jurisdiction: domestic law

- France Art. 14 & 15 Civil Code
- Germany Art. 23 ZPO
- Netherlands Art. 1-14 WBR



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## Conflicts of jurisdiction: general international instruments

- bilateral (old fashion)
- multilateral
  - Brussels, 27 September 1968 (still applicable to certain territories)
  - Lugano, 16 September 1998, revised 30 October 2007 ("extends" Brussels Convention to Norway and Switzerland)
- EU Regulation N° 1215/2012, known as the "Brussels I Regulation (recast)"  
(replaces Regulation N° 44/2001 of 22 December 2000 since 10 January 2015)



6

6

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## Conflicts of jurisdiction: special international instruments

- Munich Convention of 5 October 1973 on the European Patent
- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark
- Unified Patent Court Agreement of 19 February 2013



7


7

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## Jurisdiction: Brussels and Lugano Conventions Regulation (EU) № 1215/2012

Applicable to civil and commercial matters

Art. Brussels Convention	Art. EU Regulation	Concerns
Art. 2	Art. 4	domicile of the defendant
Art. 5 (3)	Art. 7 (2)	place of the harmful event
Art. 6	Art. 8 (1)	domicile of one of the defendants
Art. 16 (4)	Art. 22 (4)	exclusive jurisdiction of national courts for certain IP rights
Art. 19	Art. 27	examination as to jurisdiction
Art. 21	Art. 29	<i>lis pendens</i>
Art. 24	Art. 35	provisional and protective measures



8


8

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## Jurisdiction: Brussels and Lugano Conventions Regulation EC Nº 1215/2012

Art. 2 BC / Art. 4 Regulation  
**Default rule: domicile of defendant**

*"... persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State"*



9

9

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## Jurisdiction: Brussels and Lugano Conventions Regulation EC Nº 1215/2012


Art. 5 (3) BC / Art. 7 (2) Regulation  
**Special jurisdiction (place of harmful event)**

*"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"*

"may occur" covers:

- ▶ preventive actions (where available)
- ▶ action for a declaration of non infringement ('negative Feststellungsklage')

CJEU Folien Fischer and Fofitec, C-133/11, 25 October 2012  
 see also UK Supreme Court, Actavis v. Eli Lilly, 12 July 2017  
 (although based on national UK law not on EU Regulation)



10

10


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## Jurisdiction: Brussels and Lugano Conventions Regulation EC Nº 1215/2012

Art. 6 BC / Art. 8 Regulation  
**Domicile of one of the defendants**

*"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"*



11

11


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## Jurisdiction: Brussels and Lugano Conventions Regulation EC Nº 1215/2012

Art. 16 (4) / Art. 22-4 of the Regulation  
**Exclusive jurisdiction for registered intellectual property rights**

*"The following courts shall have exclusive jurisdiction, regardless of the domicile of the parties: ...*

*4° in proceedings concerned with the registration or validity of patents, trademarks, 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 international convention deemed to have taken place."*



12


12

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## Jurisdiction: Brussels and Lugano Conventions, Regulation EC N° 1215/2012

Exception:  
Art. 19 BC / Art. 27 Regulation

*"Where a court of a Member State is seized 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."*

The French version is slightly different:  
 *"Le juge d'un état contractant, saisi à **titre principal** d'un litige pour lequel une juridiction d'un autre État membre est exclusivement compétente en vertu de l'article 24, se déclare d'office incompétent."*

13

13

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Art. 2 BC / 4 Regulation


## Domicile of the defendant

Example #1  
**Infringement action concerning a patent of one country before the court of another country**

The German holder of an Italian patent may **theoretically** sue

- a German company
- in a German Court
- for infringement of its Italian patent

 **Unlikely scenario because exclusive jurisdiction as to validity of Italian courts (Art. 16 (4) BC/ 22(4) Regulation)**



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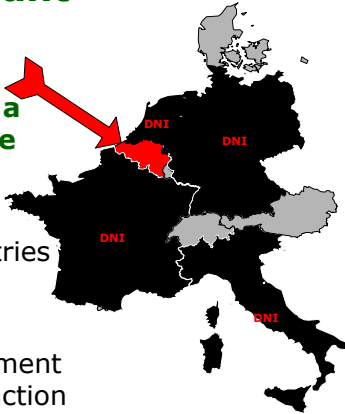
**Art. 2 BC / 4 Regulation**

## Domicile of the defendant

**Example #2**  
**Action for a declaration of non-infringement (DNI) concerning a patent of one country before the court of another country**

A competitor of a Belgian company owning patents in various EU countries may sue this company

- in a Belgian Court
- for a declaration of non-infringement of all its patents (provided this action is not based on the alleged invalidity of the patent, but only on non-infringement arguments)



15

15

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**Art. 5 (3) BC / 7 (2) Regulation**


## Place of the harmful event

**Example #3**  
**Litigation concerning a patent of one country before the court of this country**

The holder (for example a Dutch company) of a Dutch patent may sue

- an Italian company
- in a Dutch Court
- for infringement of the Dutch patent

**Very common scenario because Dutch court has jurisdiction as to validity (Art. 16 (4) BC/ 22(4) Regulation)**



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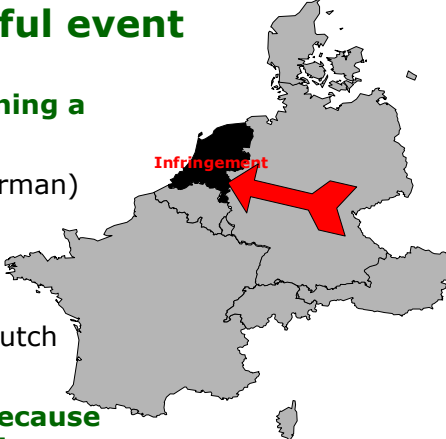
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**Art. 5 (3) BC / 7 (2) Regulation**  
**Place of the harmful event**

Example #4  
**Litigation abroad concerning a foreign right**

The holder (for example German) of a Dutch patent may sue

- a French company
- in a Dutch Court
- for infringement of the Dutch patent



**Very common scenario because Dutch court has jurisdiction as to validity (Art. 16 (4) BC/ 22(4) Regulation)**

17

17


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**Art. 5 (3) BC / 7 (2) Regulation**  
**Place of the harmful event**

Example #5: rights covering several countries

**Can the holder (for example Dutch) of a European patent covering several countries (F, IT, NL)**

- sue a German company
- in a Dutch Court
- for infringement of this European patent?



**Unlikely scenario because exclusive jurisdiction as to validity of national courts (Art. 16 (4) BC/ 22(4) Regulation)**

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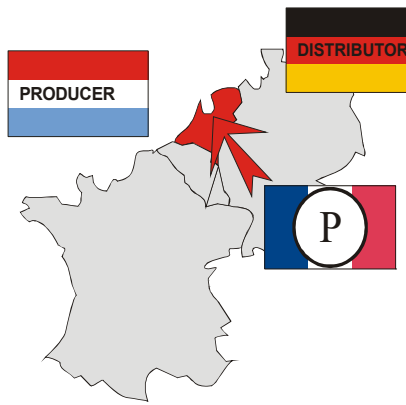
**Art. 6 BC / 8 (1) Regulation**

## Domicile of one of the defendants

Example #6

The holder (for example French) of a German patent can sue

- a Dutch company (producer)
- and a German company (distributor)
- in a Dutch Court
- for infringement of the German patent



**Unlikely scenario because exclusive jurisdiction as to validity of national (here, German courts (Art. 16 (4) BC/ 22(4) Regulation)**

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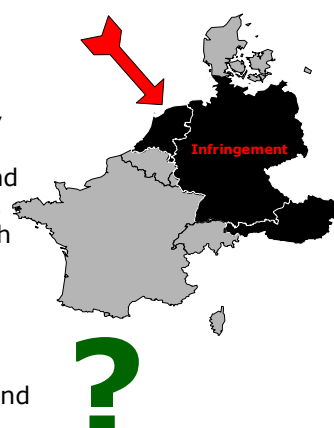
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**Art. 6 BC / 8 (1) Regulation**

## Domicile of one of the defendants

Example #7

- May the holder (for example Austrian) of a European Patent covering several countries (DE, AT, FR) sue
- a Japanese company (producer) and its European distributors (Austrian, which supply Austria, French, which supply France, Dutch which supply Germany)
- in a Dutch Court
- for infringement of the European Patent in Germany, Great-Britain and France?





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**Court of Appeal The Hague, 23 April 1998,  
Expandable Grafts Partnership v. Boston Scientific**

## The spider in the web

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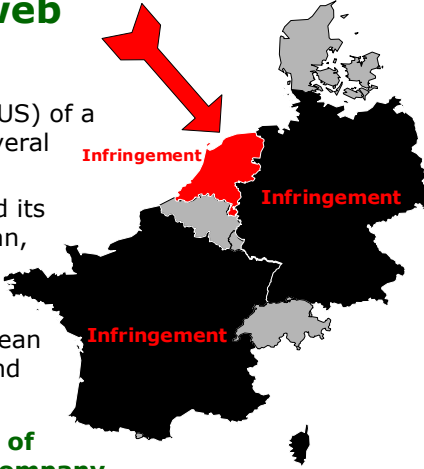

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**Court of Appeal The Hague, 23 April 1998,  
Expandable Grafts Partnership v. Boston Scientific**

## The spider in the web

Example #8

- May the holder (for example US) of a European Patent covering several countries (DE, FR, NL) sue
- a US company (producer) and its European distributors (German, French, Dutch)
- in a Dutch Court
- for infringement of the European Patent in Germany, France and Netherlands?
- **Answer of the Dutch court of appeal: only if the Dutch company is "the spider in the web"**

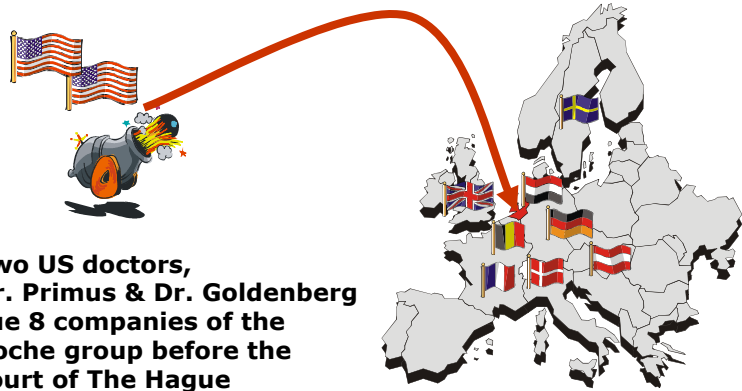
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**Roche v. Primus, CJEU C-539/03, 13 July 2006**

## The death of the spider in the web



**Two US doctors,  
Dr. Primus & Dr. Goldenberg  
sue 8 companies of the  
Roche group before the  
court of The Hague**

23

23

European litigation in IP

**Roche v. Primus, CJEU C-539/03, 13 July 2006**

## The Dutch judgments

- *Rechtsbank* (court of The Hague) accepts its jurisdiction but dismisses the infringement claim
- *Gerechtshof* (court of appeal) allows the appeal and grants a cross border injunction against the Roche companies
- *Hoge Raad* refers the case to the CJEU

24

24

Roche v. Primus, CJEU C-539/03, 13 July 2006

## The death of the spider in the web

- *"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"*



25

25

Roche v. Primus, CJEU C-539/03, 13 July 2006

## The death of the spider in the web

*"Since neither the patent infringements of which the various defendants are accused nor the national law in relation to which those acts are assessed are the same there is no risk of irreconcilable decisions being given in European patent infringement proceedings brought in different Contracting States, since possible divergences between decisions given by the courts concerned would not arise in the context of the same factual and legal situation.*



*It follows that the connection required for Article 6(1) of the Brussels Convention to apply cannot be established between such actions."*

26

26

**Solvay v. Honeywell, CJEU C-616/10, 12 July 2012**

## **CJEU revives the spider in the web?**

*"Article 6(1) of Council Regulation (EC) N° 44/2001 of 22 December 2000 must be interpreted as meaning that a situation where two or more companies established in 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.*

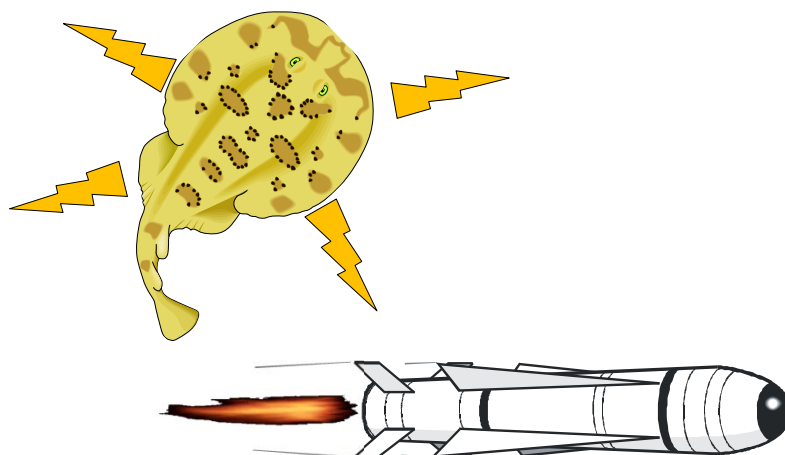


*It is for the referring court to assess whether such a risk exists, taking into account all the relevant information in the file."*

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27

## **The Italian and Belgian torpedoes**



28


28

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**Art. 21 BC /Art. 29 Regulation**  
***Lis pendens***

*“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 seized shall of its own motion stay its proceedings until such time as the jurisdiction of the court first seized is established.*

*Where the jurisdiction of the court first seized is established, any court other than the court first seized shall decline jurisdiction in favour of that court.”*



29

29


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**General Hospital and Epix v. Bracco and Byk Gulden**  
**An Italian torpedo**

General Hospital sues Bracco and Byk Gulden for patent infringement in DE, FR and UK

Bracco starts an action for invalidity of General Hospital’s patent in the court of Milano (IT)

Bracco argues that the DE, FR and UK case should be stayed until a final judgment is given by the Italian courts on the nullity action

30

30

General Hospital and Epix v. Bracco and Byk Gulden

## An Italian torpedo: the judgments

- UK Court of Appeal, January 27, 2000  
decides to stay the infringement action until the EPO has reached a final decision on the opposition by Bracco and Byk against General Hospital's European Patent
- *Landgericht* Düsseldorf, July 8, 1999  
decides to stay the infringement proceedings until the Milan Court has reached a final decision on its jurisdiction to decide over the non-infringement case; it also dismisses General Hospital petition for an interlocutory injunction for reasons based on the weakness of General Hospital patent
- Tribunal de Grande Instance of Paris, April 28, 2000  
decides **not** to stay the infringement proceedings because it feels the Italian proceedings is an evident abuse
- Case settled thereafter!



31

31

## Further developments regarding torpedoes

- ECJ, 9 December 2003, *Gasser v. Misat*  
The court seized with the infringement action cannot refuse to stay its proceedings for the mere reason that a previous action for declaration of non-infringement has been brought to a court established in a State in which the proceedings are usually very long
- ECJ, 27 April 2004, *Turner v. Grovit*  
A national jurisdiction cannot prohibit a party from starting actions in another jurisdiction, even if such actions are initiated to slow down proceedings



Conclusion: torpedoes still efficient!



32



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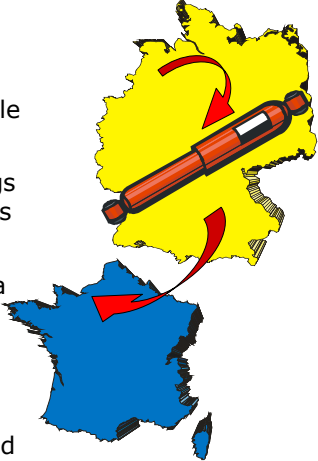

**Gat v. Luk, CJEU C-4/03, 13 July 2006**  
**CJEU “super-torpedo” sinks most cross-border patent cases**

Gat (Asdorf – DE) offers to Ford Werke (Köln – DE) mechanical damper springs for final sale in France

Luk (Bühl – DE) alleges that the springs would infringe two of its French patents

Gat starts an action against Luk before the *Landgericht* Düsseldorf for a declaration of non-infringement of the French patents

Gat alleges that its damper springs do not infringe Luk’s French patents because these patents are either invalid or not reproduced by Gat’s products

33

33


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**Gat v. Luk, CJEU C-4/03, 13 July 2006**  
**CJEU “super-torpedo” sinks most cross-border patent cases**

- *Landgericht* Düsseldorf
  - ▶ accepts jurisdiction to decide over Gat’s action for a declaration of non-infringement
  - ▶ accepts jurisdiction to decide on the validity of Luk’s French patents
  - ▶ Holds that Luk’s French patents are not invalid and dismisses Gat’s action

*Oberlandesgericht* Düsseldorf

- ▶ refers the case to the CJEU for a preliminary ruling



34

34

**Gat v. Luk, CJEU C-4/03, 13 July 2006**

## **CJEU “super-torpedo” sinks most cross-border patent cases**

*“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”*

### **Accordingly**

- only the court having exclusive jurisdiction may decide on the validity of a patent
- no other court can touch the issue of validity even incidentally



35

35

**Art. 24 BC / Art. 35 Regulation**

## **Provisional measures**

*“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”*



36


36

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**Solvay v. Honeywell, CJEU C-616/10, 12 July 2012**

**CJEU allows only cross-border preliminary injunctions patent cases**

- Solvay sues Honeywell in the court of The Hague for infringement of a patent for a refrigerant gas
- Solvay accuses Honeywell Flourine Products Europe BV and Honeywell Europe NV of acts of infringement in the whole of Europe and Honeywell Belgium NV of performing acts of infringement in Northern and Central Europe (overlapping territories)
- the Honeywell companies raise the defence of invalidity of the national parts of the patent concerned
- the court of The Hague refers the case to CJEU



37


37

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**Solvay v. Honeywell, CJEU C-616/10, 12 July 2012**

**CJEU allows only cross-border preliminary injunctions patent cases**

*“Article 22(4) of Regulation N° 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”*



38

38

Solvay v. Honeywell, CJEU C-616/10, 12 July 2012

## CJEU allows only cross-border preliminary injunctions patent cases

- Cross-border preliminary injunction possible on the basis of art. 4 (place of domicile of defendant) notwithstanding exclusive jurisdiction of 22 (4) and *Gat v. Luk*
- Article 22 (4) precludes cross-border injunction in proceedings on the merits if validity is "*raised*", but not cross-border preliminary injunction in preliminary injunction action



39

39

## Problems created by the current rules on jurisdiction for validity and infringement

Jurisdiction for validity and infringement given to national courts in parallel proceedings causes:

- *Forum shopping* strategies  
(choose the best court where to bring your case)
- Conflicting decisions  
(courts of various countries issue opposite rulings on the "same" patent)



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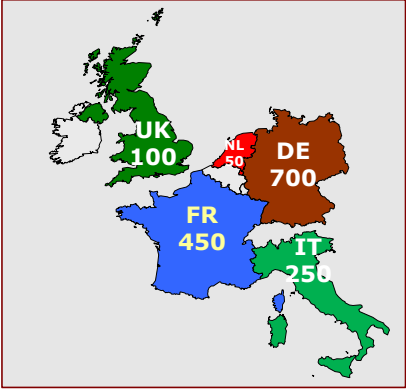
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## Patent litigation in Europe: figures

Number of new patent cases per year (rough estimate) in countries with  $\geq 50$  cases/year

Source: Harhoff  
[http://ec.europa.eu/internal\\_market/indprop/docs/patent/studies/litigation\\_system\\_en.pdf](http://ec.europa.eu/internal_market/indprop/docs/patent/studies/litigation_system_en.pdf)



Country	Number of new patent cases per year
UK	100
FR	450
DE	700
IT	250
NL	50

41

41

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## *Forum shopping in the current system:* points to consider

- Patentee or potential defendant?
- Place of business of the other party?
- Place of manufacture or marketing?
- Main markets for the products?
- Size of companies?

42

42

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**Conflicting judgments:**  
*Document Security Systems Inc.  
v. European Central Bank*



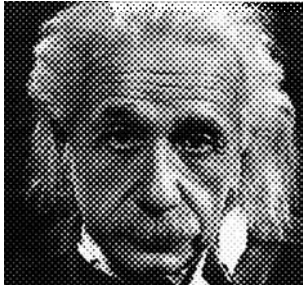
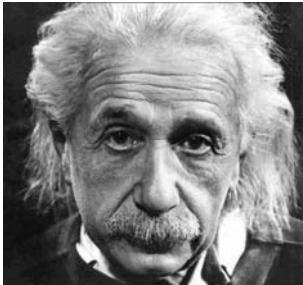
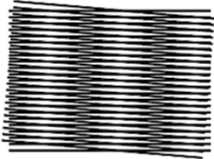
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European litigation in IP

**Conflicting judgments:**  
*Document Security Systems Inc.  
v. European Central Bank*

**The moiré effect**




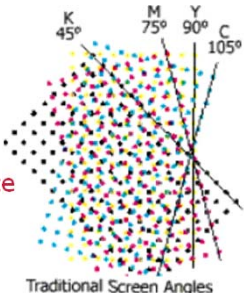
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## Conflicting judgments

*Document Security Systems / Banque centrale européenne (security)*

Traditional Screen Angles

- **United Kingdom: patent invalid**  
*High Court* 26 March 2007 EWCA 19 March 2008
- **Germany: patent valid 1<sup>st</sup> instance**  
*Bundespatentgericht* 27 mars 2007  
**patent invalid appeal**  
*Bundesgerichtshof* 8 July 2010
- **France: patent invalid**  
*Tribunal de grande instance de Paris*, 9 janvier 2008
- **The Netherlands: patent valid 1<sup>st</sup> instance**  
*Rechtbank La Haye* 12 mars 2008  
**patent invalid appeal**  
*Bundesgerichtshof* 21 December 2010
- **Spain: patent valid 1<sup>st</sup> instance**  
*Madrid court first instance* 2011  
**patent invalid appeal**  
*Madrid court of appeal* 2013

45

45


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## Document Security System v European Central Bank

### Outcome of the proceedings

Patent held invalid  
(1<sup>st</sup> instance & appeal)

Patent held  
valid 1<sup>st</sup> instance  
invalid appeal




46


46

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## Conflicting judgments Novartis / Johnson & Johnson (contact lenses)




- **The Netherlands: patent valid and infringed**  
*11 February 2009 Rechtbank The Hague*
- **France: patent valid and infringed**  
*25 March 2009 Tribunal de grande instance Paris affirmed by court of appeal 27 October 2010*
- **United Kingdom: patent invalid for insufficient description (but meeting novelty and inventive step requirements)**  
*High Court 10 July 2009*
- **Germany: patent invalid for lack of novelty (but meeting description requirement)**  
*Bundespatentgericht 10 December 2009*





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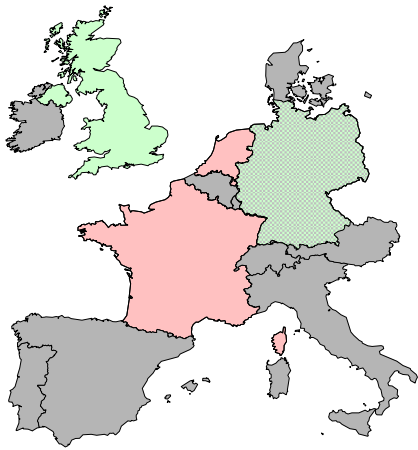
## Conflicting judgments Novartis / Johnson & Johnson (contact lenses)



 Patent held invalid  
novel but insufficient description

 Patent held invalid  
sufficient description but not novel

 Patent held valid  
and infringed



48


48




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## Conflicting judgments

### MSD v generics EP 724 444 (finasteride for the treatment of androgenic alopecia)



- **United Kingdom:**  
 patent invalid 1<sup>st</sup> instance  
6 June 2007 High Court  
 patent valid and infringed appeal  
21 May 2008 EWCA
- **Germany :** patent invalid  
26 June 2008 Bundespatentgericht
- **France :** patent invalid  
28 September 2010 Tribunal de grande instance Paris affirmed by court of appeal 30 January 2015
- **Spain :** patent invalid  
Commercial court and court of appeal Madrid
- **The Netherlands :** patent valid and infringed  
23 April 2014 Rechtbank Den Haag
- **Italy:** patent valid in 1<sup>st</sup> instance and case settled on appeal




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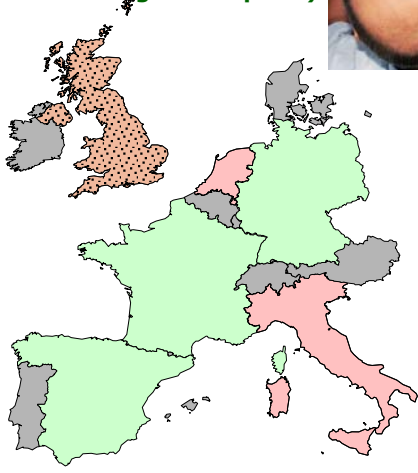
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## Conflicting judgments

### MSD/ Mylan (finasteride for the treatment of androgenic alopecia)



- Patent held invalid
- Patent held invalid (1<sup>st</sup> instance), valid and infringed (appeal)
- Patent held valid and infringed (1<sup>st</sup> instance, no appeal reported)






50

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## Conflicting judgments

**AstraZeneca (esomeprazole) EP 1 020 461**

- **United Kingdom:**  
patent valid 1<sup>st</sup> instance  
*15 July 2011 High Court Chancery Division*
- **Switzerland:**  
patent valid 1<sup>st</sup> instance  
*12 May 2014 Bundespatentgericht*
- **Italy:**  
patent valid 1<sup>st</sup> instance  
*23 April 2012 Tribunale Milano*  
patent valid and infringed 1<sup>st</sup> instance  
*11 February 2011 Tribunale Torino*



51

51

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## Conflicting judgments

**AstraZeneca (esomeprazole) EP 1 020 461**

- **The Netherlands:**  
patent valid 1<sup>st</sup> instance  
*6 June 2011 Rechtbank Den Haag*
- **France:**  
patent invalid  
*21 November 2014 Tribunal de grande instance Paris*
- **Germany:**  
patent not infringed 1<sup>st</sup> instance  
*17 December 2010 Landgericht Hamburg*
- **Sweden:**  
patent not infringed appeal  
*12 April 2011 Svea Hovrätt*




52




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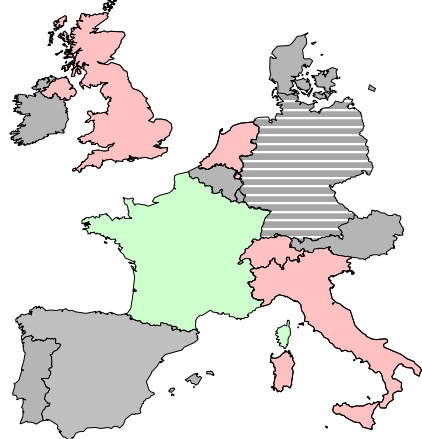
European litigation in IP

### Conflicting judgments

AstraZeneca (esomeprazole) EP 1 020 461



-  Patent held invalid (1<sup>st</sup> instance)
-  Patent held valid (1<sup>st</sup> instance)
-  Patent not infringed (1<sup>st</sup> instance)



53

53

**Pierre Véron** **Thank you**



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54

54