

Where should I sue?

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One of the first questions that arise when a patentee is considering embarking on patent litigation is "Where should I sue?". The answer to this question depends on a variety of factors, such as the workload of the Courts, their experience in patent cases, the convenience of the patentee and, of course, the legal framework governing territorial jurisdiction. In principle, "forum shopping" is legitimate as long as the patentee shops from the supermarkets established in the law.

In this regard, Article 125.2 of the Spanish Patent Act establishes that *"The judge of first instance in the seat of the Higher Court of Justice of the Autonomous Community corresponding to the domicile of the plaintiff shall be competent and, where there are several, one may be permanently designated by the competent legal body"*. However, the third paragraph of the same article, which was introduced in 2001, adds that *"In the case of actions claiming the infringement of a patent right, competence shall also fall, at the claimant's discretion, to the court authority referred to in the previous paragraph in the Autonomous Region in which the infringement has been committed or its effects have been noted"*.

Over the last few years, several cases have sparked the debate as to whether according to the aforementioned paragraphs the patentee is free to choose from two alternative territorial forums or, on the contrary, whether the forum established in paragraph 3 is only applicable when the defendant does not have a domicile in Spain. In its Ruling of 13 June 2008, Barcelona Commercial Court number 4 clarified that the patentee is free to choose the jurisdiction of the Courts where the infringing acts cause "effects" as long as this does not circumvent, in fraud of law, mandatory norms on territorial jurisdiction. The Granada Commercial Court reached the same conclusion in its Ruling of 25 November 2009, where it rejected the allegations of a company based in Barcelona which had challenged the territorial jurisdiction of the Court alleging that the patent infringement action should have been filed before the Courts where the defendant is domiciled (i.e. Barcelona).

These two cases show that Spanish Commercial Courts are moving away from the inertia of the old days, where Spanish Courts would only accept territorial jurisdiction to hear patent cases provided the defendant had its domicile in their region. When deciding where I should sue, the Courts of any region where the acts of infringement cause effects is now an alternative forum.