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One wheel after another or the forum shopping “French style”

Matthieu Dhenne (Ipsilon) · Thursday, December 31st, 2020

The “French style” (at least in patent law), which is generally characterized by the will to do everything at the same time (validity and infringement of the patent), takes a serious hit with a recent Paris Court of Appeal judgment: the Judges propose a fragmented approach to a pan-European infringement for which they only want to rule on the French part of a European patent [1].

In this case, Hutchinson, a company specializing in motor vehicle wheels, brought an infringement action before the Paris High Court (Tribunal Judiciaire), based on a patent No. EP 1 262 340 (“EP’340”) entitled “*vehicle wheel with improved inflation system*”. After an infringement seizure on French territory, the patentee had sued four companies before the Paris Court for infringement acts committed in France, Germany and the United Kingdom (Tyron, Global Wheel, L.A. VI, Dal).

The Paris Court of Appeal, confirming the Paris High Court, declined jurisdiction for acts committed in United Kingdom and Germany, thus considering itself competent only for acts committed in France. It was ruled that the legal and factual situations were not identical, as required by Article 8.1 of Regulation 1215/2012, known as “Brussels I bis”, and as interpreted by the Solvay judgment of the CJEU (C-616/10, because the patents and the products in question were not identical in the three countries, so that the judgments relating to the said applications were likely to be divergent, but not irreconcilable.

This decision seems surprising in several respects. As for its basis, first of all, article 8.1 of Brussels I bis, that concerns jurisdiction in the event of plurality of defendants, and which applies to persons domiciled in a Member State of the European Union. This text was therefore not intended to apply in Hutchinson case, since one of the co-defendants was not domiciled in a Member State, but in South Africa (Global Wheel). Knowing that, at any rate, the absence of identity of the patents was questionable: they were national parts of the same European title. We therefore find it difficult to see how divergent national decisions for these parties of the same title, and thus covering the same invention, might not be irreconcilable. All the more so since the alleged infringers belonged to the same distribution network: the incriminated products in France, the United Kingdom and Germany came from the same import source and the same offers on the Internet. Last but not least, this type of position undoubtedly favors forum shopping, with a view to seeking either the most conciliatory jurisdiction or (for FRAND disputes) the jurisdiction willing to rule only for one territory and not globally (as the English Judge did in Unwired Planet).

I am must finally admit to being rather perplexed by the actual trend of French case law, apparently

favorable to patentees lately, but which suggests that they should rather see if they can bring a case before the English Courts.

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[1] Paris Court of Appeal, November 24, 2020, RG N° 129/2020.

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