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Court of Justice of the European Union Strengthens the Protection of Holders of European Patents in "Solvay", Case C- 616/10

Thorsten Bausch (Hoffmann Eitle) · Sunday, July 22nd, 2012

With its decision of 12 July 2012, Case C-616/10 – *Solvay* on the interpretation of Articles 6(1), 22 (4) and 31 of Regulation (EC) No. 44/2001 (Brussels I Regulation, “BR”) the European Court of Justice (“CoJ”) strengthened the protection of the holders of European patents to a certain extent, but also left important questions unanswered.

The plaintiff in that case, a Belgian cooperation, filed main infringement proceedings and provisional relief in the form of a cross-border prohibition against infringement until a decision had been rendered in the main proceedings against the Dutch company Honeywell Europe B.V. and its two Belgian company group members at the Rechtbank ‘s-Gravenhage in the Netherlands. The plaintiff asserted that the Dutch and the Belgian Honeywell companies were infringing the national parts of its EP 858 440 as in force in Denmark, Ireland, Greece, Luxemburg, Austria, Portugal, Finland, Sweden, Liechtenstein and Switzerland by marketing the product HFC-245fa. Specifically, the plaintiff accused the Dutch Honeywell Europe B.V. and the Belgian Honeywell N.V. of performing the protected actions throughout Europe and accused Honeywell Belgium N.V. of performing the protected actions in northern and central Europe.

In the interim proceedings concerning provisional relief, the Honeywell companies raised the defense of invalidity of the national parts of the patent concerned without, however, instituting proceedings for the cancellation of the national parts of said patent, or even declaring their intention to do so.

The Rechtbank ‘s-Gravenhage referred six questions to the CoJ on 22 December 2010 for a preliminary ruling with regard to Articles 6 (1), 22 (4) and 31 BR. The CoJ decided on the first two questions which basically have the following content: (1) Can jurisdiction against two or more defendants from several Member States be based on Article 6 (1) BR, if each defendant is accused of committing an infringement of the same national part of a European patent in force in yet another Member State with regard to the same product, since denying jurisdiction would cause a risk of “irreconcilable judgments” and: (2) can jurisdiction for provisional relief be assumed according to Art. 31 BR or is this jurisdiction clause unavailable due to the exclusive jurisdiction of courts regarding invalidity proceedings in the country where the patent is registered (Art. 22 (4) BR).

(1) With regard to the first question, Article 6 (1) BR requires that

- at least one defendant must be domiciled in the district of the court seized, but other defendants may be sued before that court if
- the claims against the other defendants are “closely connected” such that it would be expedient to hear and decide these together to avoid the risk of irreconcilable judgments
- in the context of the same situation of law and fact.

The CoJ reaffirmed its former decision “Roche Nederland” (C-539/03) in which it held that in the case of European patent infringement proceedings involving a number of companies established in various Member States with respect to 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 and which were committed in different Member States, are not the same (“Roche Nederland”, para. 27 and 31).

In “Solvay” the CoJ decided, however, that if co-defendants in the main proceedings are each separately accused of committing the same infringements with respect to the same products and if such infringements were committed in the same Member States in such a manner that they adversely affect the same national parts of the European patent at issue, the claims are connected and there is a risk of irreconcilable judgments. National courts could render contradicting judgments on the infringement of the same national parts.

The CoJ explained that if Art. 6 (1) BR were not to be applied, the Belgian and the Dutch court would each have to examine the alleged infringements in light of the different national legislation governing the various national parts of the European patent alleged to have been infringed. They would be called upon to assess whether, for instance, according to the same Finnish law the infringement of a Finnish part of a European patent by the Honeywell companies was the result of the marketing of an identical infringing product in Finland (para. 28).

The CoJ further referred to its established case law, i.e. that it is up to the national courts to assess whether there is a risk of irreconcilable judgments under consideration of the specific circumstances of the case.

(2) With regard to the second question, the CoJ had to decide whether jurisdiction for an interim claim seeking provisional relief in the form of a cross-border prohibition against infringement can be based on Article 31 BR even though a nullity plea was raised with regard to the foreign parts of the EP.

Article 31 BR stipulates that a court of a Member State may be asked to order provisional measures even if the courts of another Member State have jurisdiction as to the substance of the matter.

The CoJ pointed out that when interpreting Article 31 as a rule, Art. 22 (4) BR on exclusive jurisdiction with regard to proceedings concerned with the validity of patents, must be considered. However, if a final decision on the validity of the patent is not to be rendered but only an assessment as to how the foreign court having jurisdiction under Art. 22 (4) BR would rule in that regard, it is apparent in both circumstances that there is no risk of conflicting decisions. It is obvious that the provisional decision taken by the court before the interim proceedings were brought will not in any way prejudice the decision to be taken on the substance by the court having jurisdiction under Art. 22 (4) BR. As a result, “Article 22 (4) BR must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of

Article 31 BR.” (para.51).

Comment

With regard to the interpretation of Article 6 (1) BR, this decision does not overturn the controversial case law in “Roche Nederland”.

The legal situation in “Solvay” where jurisdiction with regard to co-defendants was assumed according to Article 6 (1) BR, is different from that at issue in “Roche Nederland”, in so far as the defendants in the main proceedings, i.e. a Dutch and two Belgian companies, are separately accused of marketing the same infringing products in the same Member States and hence infringing the same national parts of the European patents.

In “Roche Nederlands” (C-539/03), however, the ECJ decided that Article 6 (1) BR is not applicable to a bundle of infringement actions relating to different companies established in different Member States, since each infringed different national parts of an European patent governed by different laws.

(It would have been interesting to know which evidence was presented proving that all defendants are active in all/most of the countries with a national part of the EP).

The decision does not address the question of whether the Rechtbank s’ Gravenhage may proceed with (or stay) patent infringement proceedings, if the validity of the foreign patent is challenged in the main proceedings (which is obviously what happened, see [EPLAW Patent Blog of 20 April 2012](#)). According to the CoJ’s “GAT/LuK” judgment (C-04/03), if defendant raises a nullity plea in main proceedings with regard to a national part of an EP of another Member State, the national court seized may not decide on the validity issue under consideration of Article 22(4) BR. Details such as whether the court may proceed with the infringement action without considering the validity, whether a nullity action must be filed in the other Member State (within a certain time-lime set by the court seized in the infringement case), or whether the court shall stay or dismiss infringement proceedings, etc. are still unclear. In its reference for a preliminary ruling, the Rechtbank s’ Gravenhage asked questions as to the relationship of infringement and validity issues, but the COJ decided not to address these. If the Rechtbank s’ Gravenhage must in the end dismiss the entire actions related to the foreign parts of the EP, this CoJ decision would not have been of great help, in particular since according to the facts of the case, there is not a Dutch part of the EP (para. 12) (!).

With regard to cross-border provisional injunctions in patent matters the CoJ assumed jurisdiction according to Article 31 BR even though the defendant had lodged a plea of invalidity regarding all national parts of the EP. The CoJ considered that the national court would not render a final decision on the validity and would only make an assessment of the possible decision by the foreign competent court. This is a new and clear statement which insofar eases the restrictions to cross-border actions as imposed in “GAT/LuK”.

However, the CoJ did not decide on the controversially discussed requirement of a “real connecting link” between the subject-matter of the provisional measures sought and the territorial jurisdiction of the Member State of the court seized as referred to in paragraph 40 of its “Van Uden” judgment (C-391/95). Question 6 of the Rechtbank ‘s-Gravenhage was directed to the “real connecting link”, and the Advocate General suggested on how to decide on this issue (para. 52 et seq.), however this question remained unanswered. The CoJ has not had the opportunity so far to

explain what this condition means as regards to intellectual property. It is in particular unclear whether the “real connecting link” should be only a minimum territorial localization (Advocate General, para. 53) or whether it should significantly limit the broad scope of Article 31 BR.

First the CoJ should have clarified whether, if the provisional measure is filed at the court of main proceedings, a “real connecting link” is generally required. The decision “Van Uden” made no statements in this regard. In the case “Van Uden” the Dutch court seized in the provisional proceedings probably could have been also competent in main proceedings (at the place of performance, Article 5 (1) BR). However, competence in main proceedings of the Rechtbank ‘s – Gravenhage seems to be questionable under consideration of “GAT v LuK”, since only foreign parts of the EP are in dispute and the defendants had obviously raised nullity pleas in main proceedings. A clarification of whether the national court remains competent in the infringement matter would have been necessary.

Assuming that there is no competence in main proceedings, in particular with regard to the two Belgian defendants and since there is no Dutch part of the EP, can a “real connecting link” to the Dutch territory be assumed since they belong to the company group of the Dutch defendant? This seems to be a very weak territorial connection.

In the literature a “real connecting link” is to be assumed, for instance, if the provisional measure can be enforced under the law of the court seized (see also the suggestion of the [Advocate General](#) in para. 55). However, if the CoJ should accept this opinion to be found in the literature, it will need to impose this condition, since the national courts have to examine whether enforcement of the provisional measure is possible under their civil procedure law in order to apply Article 31 BR.

The CoJ answered only two out of six questions, since the last four questions were auxiliary questions to questions 1 and 2. However, it is quite obvious that the Rechtbank ‘s’ Gravenhage is in need of more guidance so as to be able to efficiently proceed with the case. In particular with regard to the application of Article 31 BR, the decision is incomplete and at a closer look, it appears that the Rechtbank ‘s’ Gravenhage might need to file a new reference for a preliminary ruling with regard to the requirement of the “real connecting link” so that greater clarity can be achieved.

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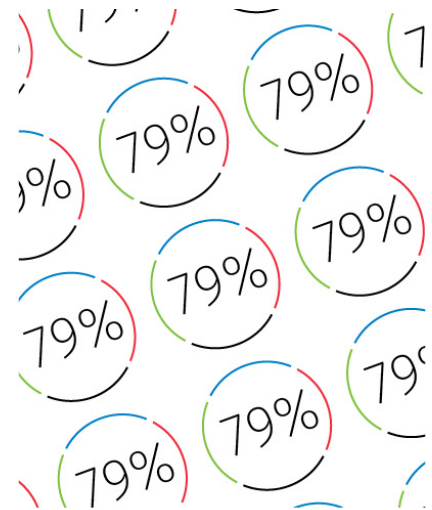
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