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The “Italian torpedo” never ending saga

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In a recent ruling rendered in the General Hospital v Asclepion case, the Italian Supreme Court wrote the latest episode of the “Italian torpedo” never ending saga. In particular, the Supreme Court upheld the jurisdiction of the Italian Courts in respect of a cross-border Declaration of Non Infringement (DNI). This ruling overturns the earlier Supreme Court judgment in the BL Macchine Automatiche v Windmoeller case which had ruled out cross-border DNI claims, also known as “Italian torpedoes”. The above is probably sufficient news for the older readers of this blog but not for the younger ones.

Italian Torpedo

Italian torpedo was a popular defence in European patent litigation by which a company, under threat of infringement proceedings, filed a torpedo suit in Italy applying for a DNI in respect of both the Italian and the foreign corresponding patents (or Italian and foreign parts of the competitor’s European patent). The jurisdiction of the Italian courts was justified upon Article 5.3 of the Brussels Convention which established that “*a person domiciled in a Contracting State may, in another Contracting State, be sued … in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred*”. On the one hand, Italian courts accepted these kinds of claims. On the other hand, foreign courts (especially German courts) were willing to stay their own infringement proceedings, under Article 21 of the Convention, if the alleged infringer had already launched a cross-border DNI action in Italy. As a result, once the alleged infringer had filed a torpedo suit in Italy, the patentee was prevented from enforcing its patent in other European jurisdictions.

The Windmoeller case

In 2003, the Italian Supreme Court ruled that, in a torpedo case, Italian courts were not seized with jurisdiction (BL Macchine Automatiche v Windmoeller case). The rationale behind Windmoeller was that the plaintiff in a DNI action could not rely upon Article 5.3 Brussels Convention because – by bringing a DNI action – the plaintiff had already denied that a harmful event had occurred. The IP community welcomed Windmoeller as a big step forward for the effective protection of patents in Europe.

The General Hospital case

In September 2010, German company Asclepion Laser Technologies GmbH (Asclepion) filed a torpedo claim before the Court of Rome. In particular, Asclepion asked the Rome court to declare

that its MedioStar and RubyStar products do not infringe either the Italian or German parts of European patents EP 0 806 913 and EP 1 230 900 owned by The General Hospital Corporation (Massachusetts General Hospital) (MGH) and exclusively licensed to Palomar Medical Technologies Inc. (Palomar). After joining the Rome proceedings, in May 2011, MGH and Palomar filed an application with the Italian Supreme Court challenging the international jurisdiction of the Italian Courts for deciding infringement of the non-Italian parts of their European patents.

The Supreme Court handed down its judgment on 10 June 2013 and, unlike the Windmoeller ruling, it declared that "*in relation to the DNI of the European patents in suit sought by Asclepion, the Court of Rome has jurisdiction under Article 5.3 Council Regulation (EC) No 44/2001 for being the judge of the place where the harmful event may occur, both in respect of the German part as well as in respect of the Italian part*".

The recent Supreme Court ruling makes explicit reference to Folien Fisher, whereby the CJEU established that Article 5.3 Council Regulation (EC) No 44/2001 shall be interpreted "*as meaning that an action for a negative declaration seeking to establish the absence of liability in tort, delict, or quasi-delict falls within the scope of that provision*".

On the one hand, the decision states that "*determining whether the Brussels Convention or Council Regulation (EC) No 44/2001 shall apply (as both parties seem to argue) is irrelevant, provided that the relevant provisions in both the Brussels Convention and Council Regulation (EC) No 44/2001 are essentially identical*". On the other hand, however, it states that the Court of Rome is the judge of the place where the harmful event "*may occur*", somehow suggesting that the addition of the wording "*or may occur*" to Article 5.3 Council Regulation (EC) No. 44/2001 justifies a different interpretation in respect of that adopted in Windmoeller which had addressed Article 5.3 of the Brussels Convention, not containing said wording.

The DNI proceedings are now due to continue before the Court of Rome which – in respect of jurisdiction – will be bound to the findings of the Supreme Court.

Conclusions

Patent practitioners must be alerted: Italian torpedo is back as – based on the General Hospital ruling – Italian courts will have to accept DNI claims also in respect of foreign patents (or foreign parts of EPs).

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