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The FRAND Lectures (Part 2): which Judge can order a cross-border injunction?

Matthieu Dhenne (Ipsilon) · Monday, February 15th, 2021

For the second time, I will have the pleasure and the Honor of welcoming Professor Anne-Catherine Chiariny. Professor Chiariny teaches Patent Law and International Private Law at the University of Montpellier. She is notably the author of a famous doctoral thesis on international patent litigation awarded by the Prix Pierre Véron and published in 2006 and the Prix Montesquieu in 2007 (you can order it [here](#)) and has kindly accepted to offer us two brief lectures on issues relating to FRAND litigation in an global context: which Judge can fix a global rate (Part 1)? Which judge can order a cross-border injunction (Part 2)?

Professor Chiariny, who answered to the first question two weeks ago, will address today the second one. Although the issue is less topical than the one dealt with the week before, the cross-border injunction is nonetheless a fundamental and recurrent question in FRAND litigation. Often the Netherlands, known for this practice, is considered as its preferred field (see recently [here](#) for instance). We will see hereafter that however this strategy is not specific to the “other cheese country” and can prosper just as well in the other countries of the European Union.

Let's leave room for the Professor's analysis.

“The question put to me today by Matthieu concerns whether a judge, particularly a French judge, could issue cross-border injunctions.

Cross-border injunctions are the result of a bold interpretation – at the origin of the Brussels Convention of 27 September 1978 – of the Brussels I Bis Regulation and of a daring practice of Dutch judges, which started in the field of trademark infringement in the late 1970s ^[1], which led to a real development of Euro-injunctions, which was later extended to patent litigation by the President of the exclusively competent Court of The Hague ^[2].

In the case of acts of infringement “organised” by several companies acting in co-operation and if the decision-making centre is in the Netherlands ^[3] and a portfolio of national securities is involved, the holder may obtain from the Dutch judge a single and rapid decision, following a rapid provisional proceeding (called Kort Geding), in which the defendant(s) cannot obtain the nullity of the rights against them.

Would it then be possible for a judge from another Member State – a French Judge for instance

who, since 2018 seems more inclined to issue interim injunctions in internal disputes^[4] – to issue cross-border injunctions, as the Dutch judge (see, until recently, the case of *Novartis v. MyLan*^[5]), in particular in *FRAND* cases?

Undoubtedly, against a defendant domiciled in the European Union in compliance with the *Brussels I Regulation*.

Thus, if the court of the Member State has jurisdiction on the merits (in particular under Articles 4 and 7(2) of the *Brussels I Bis Regulation*, i.e. respectively the place of domicile of the defendant and the place of the damage), it has in principle the broadest jurisdiction to issue such injunctions on the provisional and the merits against a defendant^[6]. In addition, the court may issue such an injunction to all defendants who have jointly committed infringing acts in relation to the same national title, where its jurisdiction is based on Article 8-1 of the *Brussels I Bis Regulation*^[7]. On the other hand, when the acts relate to different national parts of the same portfolio, by companies, according to a common policy, which individually operate on distinct markets, the forum of the domicile of one of the co-defendants cannot be usefully seized in view of the very controversial *Roche decision*^[8] which correlatively rules out the possibility of obtaining such a pan-European injunction except in front of the Dutch judge (!), as seen previously in the *Novartis Dutch case*.

The interest in seeking such injunctions is naturally reinforced by the fact that the decision of a court in a Member State, issuing a cross-border injunction, will be automatically effective in the other Member States (Art. 36 *et seq.* *Brussels I Bis*). According to *Brussels I Bis*, a decision enforceable in the country of origin automatically entails the authorization to proceed to the precautionary measures provided for by the law of the requested Member State^[9].

As for the provisional court without jurisdiction on the merits, seized on the basis of Article 35 of the *Brussels I Bis Regulation*, it can in principle only issue such an injunction, according to its national Law, if there is a genuine link between the subject matter of the measure sought and the territorial jurisdiction of the Contracting State, although this requirement is not included in the *Brussels I Bis Regulation*. The decision must be enforceable in that State where the infringement took place, although it may relate to a defendant domiciled in another State. In this case, it is not a real cross-border injunction but this forum may prove useful especially when the provisional court of the place of the infringement, although not seized of the action on the merits, will be reputed for its particular diligence and its short procedural deadlines.

It should be added that article 24-4 of the *Brussels I Bis Regulation* does not apply in the context of a provisional proceeding as long as the court seized does not rule on the validity of the right and it seems valid. It is only when the invalidity of the titles is contested during the proceedings on the merits that the judge seized of the action for infringement must stay the ruling when he is not the judge of the title^[10].

On the other hand, the effectiveness of a judgment given under a national rule of international jurisdiction – in particular by the French court which would have jurisdiction because of the existence of infringing acts in France – against a defendant domiciled in a non-EU Member State will be more uncertain, especially if the latter were to be executed in this state requiring compliance with his *exequatur procedure*. Moreover, the practice of anti-suit injunctions, which is common in Common Law countries, is likely to seriously delay the resolution of the dispute.

However, such a practice cannot be formulated within the European Union since the Turner judgment^[11], under the principle of mutual trust. Note that since Brexit, British courts have regained their freedom to accommodate these anti-suit injunctions. Hence the development of anti-suit and anti-anti-suit^[12]... which will not be able to appease the numerous judicial battles in this area.”

Eventually, in the light of Professor Chiariny’s analysis, one conclusion clearly emerges: contrary to popular belief, cross-border injunctions is not exclusive to the Netherlands and is no less conceivable in other European countries.

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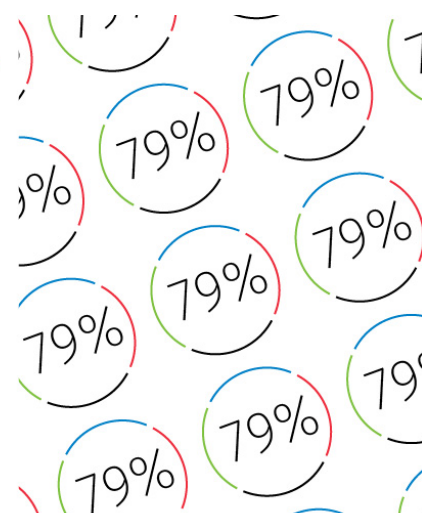
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