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French Judge Competent for Infringement Abroad: Private International Law vs. UPC?

Matthieu Dhenne (Ipsilon) · Friday, July 8th, 2022

In a decision dated June 29, 2022, the Cour de cassation (French Supreme Court) overturned the decision of the Paris Court of Appeal (Paris, November 24, 2020) which refused to assess acts of infringement committed abroad. The decision of the Supreme Court, which merely applies classical rules of private international law, leads one to wonder about the appropriateness of actions before the future UPC.

I had already mentioned (and criticized) the decisions, which had been rendered previously in this case (see here). The Court of Cassation has adopted the same approach as I by overturning the appeal decision in all respects.

As a reminder, the French company Hutchinson sued the English company Tyron Runflat (Tyron) and its South African supplier, Global Wheel, as well as the French companies Dal and L.A. VI, which resell their products, alleging infringement of its European patent in France, Great Britain and Germany.

In this case, the Paris High Court, confirmed by the Court of Appeal, refused to assess the acts of infringement, considering that although the patents in question were the same, the acts of infringement committed were not the same. Thus, this divergence of the factual situations could lead to irreconcilable decisions between the different jurisdictions, so that the French Judge was only competent for France.

Conversely, the Supreme Court recalled that The Court of Justice of the European Union (ECJ, 12 July 2012, aff. C-616/10) has ruled, with regard to Article 6(1) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, that is drafted in identical terms to the above-mentioned Article 8(1), that this text "*must be interpreted as meaning that a situation in which two or more companies established in different Member States are accused, each separately, in proceedings pending before a court of one of those Member States, of infringement of the same national part of a European patent, as in force in another Member State, by reason of reserved acts relating to the same product, is liable to lead to irreconcilable solutions if the cases were tried separately, within the meaning of that provision. It is for the national court to assess whether there is such a risk, taking into account all the relevant material in the case-file.*"

Therefore, according to the Supreme Court, by ruling in this way, when the Hutchinson company was invoking the infringements made by the French companies and the Tyron company, in France, in Germany and in Great Britain, to the same national parts of its European patent, concerning the same product, the Court of Appeal, which was responsible for investigating whether the fact of judging the infringement actions separately was not likely to lead to irreconcilable solutions, violated the above-mentioned text.

Moreover, with regard to the South African company, the Court recalled that according to article 14 of the Civil Code, a French plaintiff, as long as no ordinary criterion of jurisdiction is fulfilled in France, may validly seize the French court that he chooses because of a link of the proceedings to the French territory, or, failing that, according to the requirements of a good administration of justice.

However, in order to declare that the French judge does not have jurisdiction to hear acts of infringement committed outside French territory by the company Global Wheel, domiciled in South Africa, the decision of the Court of Appeal holds that the company Hutchinson does not demonstrate the relevance of the connection with the present proceedings, whereas the French judge does not have jurisdiction for the facts allegedly committed abroad by the company Tyron of which the company Global Wheel was the supplier and that the English and German courts have jurisdiction to judge the alleged acts of infringement of the national part of the litigious patent committed on their respective territories. In so ruling, the Court of Appeal violated the aforementioned text on grounds that are not sufficient to defeat the jurisdiction of the French courts based on the French nationality of the company Hutchinson.

Finally, the decision of the Court of Cassation only recalls international legal principles, which have always seemed to us to be self-evident, as Professor Chiariny reminded us (see here). More generally, similar jurisprudence exists in the Netherlands and in Germany, so that one may wonder: what use will the UPC have in this context?

More interestingly, starting a procedure in France, using parts of European patents to assess infringement elsewhere in Europe, will always be cheaper than a unitary patent, which is moreover based on a jurisdiction whose foundations remain fragile at the very least.

Without counting that beyond the price of the patent of a UPC procedure, it will also be necessary to count on risks: the systematic questioning of the institutional (conventional) defects of the system in itself (see here and here).

In short, with its jurisprudence of June 29, 2022, the Court of Cassation reminds us of the classical rules of private international law, but also leads us to think twice the recommendations that should be made to the companies in the future when they decide to engage an action of European scale (UPC or not?).

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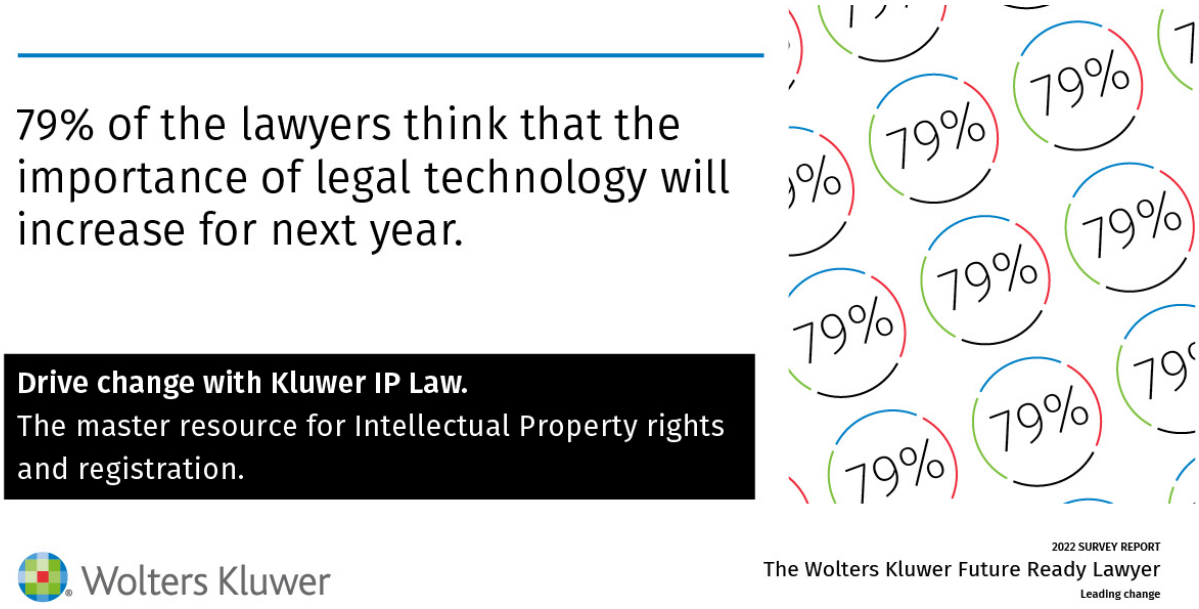

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