

Court of Justice EU, 12 July 2012, Solvay v Honeywell



v

Honeywell

PATENT LAW – PRIVATE INTERNATIONAL LAW - LITIGATION

Possibility of irreconcilable judgments (article 6 EEX Convention) if companies are each separately accused of infringement of same national part of European patent with same product

- that Article 6(1) of Regulation No 44/2001 must be interpreted as meaning that a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to 'irreconcilable judgments' resulting from separate proceedings as referred to in that provision. It is for the referring court to assess whether such a risk exists, taking into account all the relevant information in the file.

Exclusive jurisdiction regarding validity does not preclude special jurisdiction regarding interim measures

- that Article 22(4) of Regulation No 44/2001 must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of Article 31 of that regulation.

Source: curia.europa.eu

Court of Justice EU, 12 July 2012

(K. Lenaerts, J. Malenovský (Rapporteur), R. Silva de Lapuerta, E. Juhász and D. Šváby)

JUDGMENT OF THE COURT (Third Chamber)

12 July 2012 (*)

(Judicial cooperation in civil matters – Jurisdiction, recognition and enforcement of judgments – Regulation (EC) No 44/2001 – Action for infringement of a European patent – Special and exclusive jurisdiction – Article 6(1) – More than one defendant – Article 22(4)

– *Validity of the patent called into question – Article 31 – Provisional, including protective, measures)*

In Case C-616/10,

REFERENCE for preliminary ruling under Article 267 TFEU, from [the Rechtbank 's-Gravenhage \(Netherlands\), made by decision of 22 December 2010](#), received at the Court on 29 December 2010, in the proceedings

Solvay SA

v

Honeywell Fluorine Products Europe BV,

Honeywell Belgium NV,

Honeywell Europe NV,

THE COURT (Third Chamber),

composed of K. Lenaerts, President of the Chamber, J. Malenovský (Rapporteur), R. Silva de Lapuerta, E. Juhász and D. Šváby, Judges,

Advocate General: P. Cruz Villalón,

Registrar: K. Sztranc-Sławiczek, Administrator,

having regard to the written procedure and further to the hearing on 30 November 2011,

after considering the observations submitted on behalf of:

– Solvay SA, by W.A. Hoyng and F.W.E. Eijsvogels, advocaten,

– Honeywell Fluorine Products Europe BV, Honeywell Belgium NV and Honeywell Europe NV, by R. Ebbink and R. Hermans, advocaten,

– the German Government, by T. Henze and J. Kemper, acting as Agents,

– the Greek Government, by S. Chala, acting as Agent,

– the Spanish Government, by S. Centeno Huerta, acting as Agent,

– the European Commission, by A.-M. Rouchaud-Joët and R. Troosters, acting as Agents.

[after hearing the Opinion of the Advocate General at the sitting on 29 March 2012,](#)

gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation of Articles 6(1), 22(4) and 31 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 (OJ 2001 L 12, p. 1).

2 The reference was submitted in the course of proceedings between (i) Solvay SA, established in Belgium ('Solvay') and (ii) Honeywell Fluorine Products Europe BV, established in the Netherlands, and Honeywell Belgium NV and Honeywell Europe NV, both established in Belgium, (together 'the Honeywell companies'), regarding the alleged infringement by various parties of a European patent.

Legal context

The Munich Convention

3 The Convention on the Grant of European Patents, signed in Munich on 5 October 1973 ('the Munich Convention'), establishes, according to Article 1 thereof, 'a system of law, common to the Contracting States, for the grant of patents for invention'.

4 Outside the scope of the common rules on granting patents, a European patent continues to be governed by the national law of each of the Contracting States for which it has been granted. In that regard, Article 2(2) of the Munich Convention states:

'The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State ...'

5 As regards the rights conferred on the proprietor of a European patent, Article 64(1) and (3) of that convention provides::

'(1) A European patent shall ... confer on its proprietor from the date of publication of the mention of its grant, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

...

(3) Any infringement of a European patent shall be dealt with by national law.'

European Union law

6 Recitals 11, 12, 15 and 19 in the preamble to Regulation No 44/2001 state:

'(11) The rules of jurisdiction must be highly predictable and founded on the principle that jurisdiction is generally based on the defendant's domicile and jurisdiction must always be available on this ground save in a few well-defined situations in which the subject-matter of the litigation or the autonomy of the parties warrants a different linking factor. ...

(12) In addition to the defendant's domicile, there should be alternative grounds of jurisdiction based on a close link between the court and the action or in order to facilitate the sound administration of justice.

...

(15) In the interests of the harmonious administration of justice it is necessary to minimise the possibility of concurrent proceedings and to ensure that irreconcilable judgments will not be given in two Member States. ...

...

(19) Continuity between the [Brussels Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1972 L 299, p. 32; 'the Brussels Convention')] and this Regulation should be ensured, and transitional provisions should be laid down to that end. The same need for continuity applies as regards the interpretation of the Brussels Convention by the Court of Justice of the European Communities and the 1971 Protocol [on this interpretation by the Court, as revised and amended (OJ 1998 C 27, p. 28)] should remain applicable also to cases already pending when this Regulation enters into force.'

7 Under Article 2 of that regulation:

'1. Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.

2. Persons who are not nationals of the Member State in which they are domiciled shall be governed by the

rules of jurisdiction applicable to nationals of that State.'

8 Article 6(1), which is part of Section 2 of Chapter II of that regulation, entitled 'Special jurisdiction', provides:

'A person domiciled in a Member State may also be sued:

(1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings'.

9 According to Article 22(4) of that regulation:

'The following courts shall have exclusive jurisdiction, regardless of domicile:

...

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place. Without prejudice to the jurisdiction of the European Patent Office under the [Munich Convention], the courts of each Member State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State'.

10 Article 25 of that regulation is worded as follows:

'Where a court of a Member State is seised of a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 22, it shall declare of its own motion that it has no jurisdiction.'

11 Pursuant to Article 31 of that regulation:

'Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that State, even if, under this Regulation, the courts of another Member State have jurisdiction as to the substance of the matter.'

The dispute in the main proceedings and the questions referred for a preliminary ruling

12 On 6 March 2009, Solvay, the proprietor of European patent EP 0 858 440, brought an action in the Rechtbank 's-Gravenhage for infringement of the national parts of that patent, as in force in Denmark, Ireland, Greece, Luxembourg, Austria, Portugal, Finland, Sweden, Liechtenstein and Switzerland, against the Honeywell companies for marketing a product HFC-245 fa, manufactured by Honeywell International Inc. and identical to the product covered by that patent.

13 Specifically, Solvay accuses Honeywell Flourine Products Europe BV and Honeywell Europe NV of performing the reserved actions in the whole of Europe and Honeywell Belgium NV of performing the reserved actions in Northern and Central Europe.

14 In the course of its action for infringement, on 9 December 2009 Solvay also lodged an interim claim against the Honeywell companies, seeking provisional relief in the form of a cross-border prohibition against infringement until a decision had been made in the main proceedings.

15 In the interim proceedings, the Honeywell companies raised the defence of invalidity of the national parts of the patent concerned without, however, having brought or even declared their intention of bringing proceedings for the annulment of the national parts of that patent, and without contesting the competence of the Dutch court to hear both the main proceedings and the interim proceedings.

16 In those circumstances, the Rechtbank 's-Gravenhage decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'Regarding Article 6(1) of [Regulation No 44/2001]:

1. *In a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, does the possibility arise of "irreconcilable judgments" resulting from separate proceedings as referred to in Article 6(1) of [Regulation No 44/2001]?*

Regarding Article 22(4) of [Regulation No 44/2001]:

2. *Is Article 22(4) of [Regulation No 44/2001] applicable in proceedings seeking provisional relief on the basis of a foreign patent (such as a provisional cross-border prohibition against infringement), if the defendant argues by way of defence that the patent invoked is invalid, taking into account that the court in that case does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of [that] Regulation would rule in that regard, and that the application for interim relief in the form of a prohibition against infringement shall be refused if, in the opinion of the court, a reasonable, nonnegligible possibility exists that the patent invoked would be declared invalid by the competent court?*

3. *In order for Article 22(4) of [Regulation No 44/2001] to be applicable in proceedings such as those referred to in the preceding question, must the defence of invalidity be subject to procedural requirements in the sense that Article 22(4) of the regulation is only applicable if invalidity proceedings before the court having jurisdiction under Article 22(4) of [that] Regulation are already pending or are to be commenced within a period to be laid down by the court or at least that a summons in that regard has been or is being issued to the patent holder, or does it suffice if a defence of invalidity is merely raised and, if so, are requirements then laid down in respect of the content of the defence put forward, in the sense that it must be sufficiently substantiated and/or that the*

conduct of the defence must not be deemed to be an abuse of procedural law?

4. *If question [2] is answered in the affirmative, does the court, after a defence of invalidity has been raised in proceedings such as those referred to in question 1, retain jurisdiction in respect of the infringement action with the result that (if the claimant so desires) the infringement proceedings must be stayed until the court having jurisdiction under Article 22(4) of [Regulation No 44/2001] has given a decision on the validity of the national part of the patent invoked, or that the claim must be refused because a defence that is essential to the decision may not be adjudicated, or does the court also lose its jurisdiction in respect of the infringement claim once a defence of invalidity has been raised?*

5. *If question [2] is answered in the affirmative, can Article 31 of [Regulation No 44/2001] confer on the national court jurisdiction to adjudicate on a claim seeking provisional relief on the basis of a foreign patent (such as a cross-border prohibition against infringement), and against which it is argued by way of defence that the patent invoked is invalid, or (should it be decided that the applicability of Article 22(4) of [that] Regulation does not affect the jurisdiction of the Rechtbank ['s'-Gravenhage] to adjudicate on the infringement question) jurisdiction to adjudicate on a defence claiming that the foreign patent invoked is invalid?*

6. *If question [5] is answered in the affirmative, what facts or circumstances are then required in order to be able to accept that there is a real connecting link, as referred to in paragraph 40 of the judgment [in Case C-391/95 Van Uden [1998] ECR I-7091], between the subject matter of the measures sought and the territorial jurisdiction of the Contracting State of the court before which those measures are sought?'*

On the questions referred

The first question

17 By its first question, the referring court asks, in essence, whether Article 6(1) of Regulation No 44/2001 must be interpreted as meaning that a situation where two or more companies established in different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to 'irreconcilable judgments' resulting from separate proceedings as referred to in that provision.

18 First of all, it must be observed that Article 6(1) of Regulation No 44/2001 provides, in order to avoid irreconcilable judgments resulting from separate proceedings, that a defendant may be sued, where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together.

19 As regards its purpose, the rule of jurisdiction in Article 6(1) of Regulation No 44/2001 meets, in

accordance with recitals 12 and 15 in the preamble to that regulation, the wish to facilitate the sound administration of justice, to minimise the possibility of concurrent proceedings and thus to avoid irreconcilable outcomes if cases are decided separately ([see Case C-145/10 Painer \[2011\] ECR I-0000, paragraph 77](#)).

20 Moreover, that special rule of jurisdiction must be interpreted in the light, first, of recital 11 in the preamble to Regulation No 44/2001, according to which the rules of jurisdiction must be highly predictable and founded on the principle that jurisdiction is generally based on the defendant's domicile and jurisdiction must always be available on this ground save in a few well-defined situations in which the subject-matter of the litigation or the autonomy of the parties warrants a different linking factor ([see Case C-98/06 Freeport \[2007\] ECR I-8319, paragraph 36](#)).

21 That special rule of jurisdiction, because it derogates from the principle stated in Article 2 of Regulation No 44/2001 that jurisdiction be based on the defendant's domicile, must be strictly interpreted and cannot be given an interpretation going beyond the cases expressly envisaged by that regulation ([see Painer, paragraph 74 and the case-law cited](#)).

22 In addition, that rule cannot be interpreted in such a way as to allow an applicant to make a claim against a number of defendants with the sole object of ousting the jurisdiction of the courts of the State where one of those defendants is domiciled ([see, to that effect, Case 189/87 Kalfelis \[1988\] ECR 5565, paragraphs 8 and 9, and Painer, paragraph 78](#)).

23 Furthermore, the Court has held that it is for the national court to assess whether there is a connection between the different claims brought before it, that is to say, a risk of irreconcilable judgments if those claims were determined separately and, in that regard, to take account of all the necessary factors in the case-file ([see Freeport, paragraph 41, and Painer, paragraph 83](#)).

24 The Court has however stated in this connection that, in order for judgments to be regarded as at risk of being irreconcilable within the meaning of Article 6(1) of Regulation No 44/2001, it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the same situation of fact and law ([see Case C-539/03 Roche Nederland and Others \[2006\] ECR I-6535, paragraph 26; Freeport, paragraph 40; and Painer, paragraph 79](#)).

25 As regards the assessment of the existence of the same situation, the Court has ruled, first, that the existence of the same situation of fact cannot be inferred where the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same. Secondly, it has held that the same situation of law cannot be inferred where infringement proceedings are brought before a number of courts in different Contracting States in respect of a European patent granted in each of those States and those actions are brought against defendants domiciled in those States in respect of acts allegedly committed in their territory

([see Roche Nederland and Others, paragraphs 27 and 31](#)).

26 A European patent continues to be governed, as Articles 2(2) and 64(1) of the Munich Convention clearly show, by the national law of each of the Contracting States for which it has been granted. By the same token, any action for infringement of a European patent must, as is apparent from Article 64(3) of that convention, be examined in the light of the relevant national law in force in each of the States for which it has been granted ([Roche Nederland and Others, paragraphs 29 and 30](#)).

27 It follows from the specific features of a case such as that in the main proceedings that potential divergences in the outcome of the proceedings are likely to arise in the same situation of fact and law, so that it is possible that they will culminate in irreconcilable judgments resulting from separate proceedings.

28 As the Advocate General observed in point 25 of his Opinion, were Article 6(1) of Regulation No 44/2001 not applicable, two courts would each have to examine the alleged infringements in the light of the different national legislation governing the various national parts of the European patent alleged to have been infringed. They would, for instance, be called upon to assess according to the same Finnish law the infringement of the Finnish part of the European patent by the Honeywell companies as a result of the marketing of an identical infringing product in Finland.

29 In order to assess, in a situation such as that at issue in the main proceedings, whether there is a connection between the different claims brought before it and thus whether there is a risk of irreconcilable judgments if those claims were determined separately, it is for the national court to take into account, *inter alia*, the dual fact that, first, the defendants in the main proceeding are each separately accused of committing the same infringements with respect to the same products and, secondly, such infringements were committed in the same Member States, so that they adversely affect the same national parts of the European patent at issue.

30 In the light of the foregoing, the answer to the first question is that Article 6(1) of Regulation No 44/2001 must be interpreted as meaning that a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to 'irreconcilable judgments' resulting from separate proceedings as referred to in that provision. It is for the referring court to assess whether such a risk exists, taking into account all the relevant information in the file.

The second question

31 By its second question, the referring court asks whether Article 22(4) of Regulation No 44/2001 is applicable in proceedings seeking provisional relief on

the basis of a foreign patent, such as a provisional cross-border prohibition against infringement, if the defendants in the main proceedings argue by way of defence that the patent invoked is invalid, taking into account that the court in that case does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of that Regulation would rule in that regard, and that the application for interim relief in the form of a prohibition against infringement shall be refused if, in the opinion of the court, a reasonable, non-negligible possibility exists that the patent invoked would be declared invalid by the competent court.

32 It is apparent from the wording of the question referred for a preliminary ruling and the order for reference that the issue at the heart of the dispute in the main proceedings concerns a procedure for the adoption of an interim measure governed by the rule of jurisdiction set out in Article 31 of Regulation No 44/2001.

33 Consequently, the question asked must be construed as seeking to ascertain essentially whether Article 22(4) of Regulation No 44/2001 must be interpreted as precluding, in circumstances such as those at issue in the case in the main proceedings, the application of Article 31 of that regulation.

34 In this connection, it is apparent from Article 31 of Regulation No 44/2001 that the court of a Member State is authorised to rule on a claim for a provisional, including a protective, measure even if, under that regulation, the courts of another Member State have jurisdiction as to the substance of the matter.

35 Furthermore, as follows from Article 22(4) thereof, Regulation No 44/2001 lays down for a rule of exclusive jurisdiction according to which, in proceedings concerned with the registration or validity of patents, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place, have exclusive jurisdiction.

36 Concerning, first of all, the wording of Articles 22(4) and 31 of Regulation No 44/2001, it should be noted that those provisions are intended to regulate different situations and each has a distinct field of application. Thus, whilst Article 22(4) concerns the attribution of jurisdiction to rule on the substance in proceedings relating to a clearly defined area, Article 31 is designed to apply regardless of any jurisdiction as to the substance.

37 Moreover, those two provisions do not refer to one another.

38 As regards, secondly, the general scheme of Regulation No 44/2001, it is appropriate to point out that those provisions are included under Chapter II of Regulation No 44/2001, entitled 'Jurisdiction', and constitute 'special provisions' as opposed to the 'general provisions' in Section 1 of that chapter.

39 On the other hand, there is nothing to indicate that either of the provisions at issue can be regarded as

general or special in relation to the other. They fall within two different sections of the same Chapter II, namely Sections 6 and 10 respectively.

40 It follows from this that Article 31 is independent in scope from Article 22(4) of that regulation. As noted in paragraph 34 above, Article 31 applies where a claim for provisional, including protective, measures is brought before a court other than the court which has jurisdiction as to the substance, so that Article 22(4), which concerns the jurisdiction as to substance, cannot, as a rule, be interpreted so as to derogate from Article 31 and, consequently, cause it to be disapplied.

41 However, it is necessary to examine whether the interpretation given by the Court to Article 16(4) of the Brussels Convention leads to a different conclusion.

42 In so far as Regulation No 44/2001 now replaces, in the relations between Member States, the Brussels Convention, the interpretation provided by the Court in respect of the provisions of that convention is also valid for those of that regulation whenever the provisions of those Community instruments may be regarded as equivalent (see, inter alia, Case C-189/08 *Zuid-Chemie* [2009] ECR I-6917, paragraph 18; Case C-292/08 *German Graphics Graphische Maschinen* [2009] ECR I-8421, paragraph 27; and [Case C-406/09 *Realchemie Nederland* \[2011\] ECR I-0000, paragraph 38](#)).

43 Article 22(4) of Regulation No 44/2001, relevant to the examination of this question, reflects the same system as Article 16(4) of the Brussels Convention and is, moreover, drafted in almost identical terms. In the light of such similarity, it is necessary to ensure, in accordance with recital 19 in the preamble to this regulation, continuity in their interpretation (see, by analogy, Case C-167/08 *Draka NK Cables and Others* [2009] ECR I- 3477, paragraph 20; Case C-180/06 *Ilseinger* [2009] ECR I-3961, paragraph 58; and *Zuid-Chemie*, paragraph 19).

44 It must be pointed out in this connection that the Court, [in paragraph 24 of its judgment in Case C-4/03 *GAT* \[2006\] ECR I-6509](#), interpreted Article 16(4) of the Brussels Convention widely, in order to ensure its effectiveness. It held that, having regard to the position of that provision within the scheme of that convention and the objective pursued, the rules of jurisdiction provided for in that provision are of an exclusive and mandatory nature, the application of which is specifically binding on both litigants and courts.

45 The Court also considered that the exclusive jurisdiction provided for by Article 16(4) of the Brussels Convention should apply whatever the form of proceedings in which the issue of a patent's validity is raised, be it by way of an action or a defence, at the time the case is brought or at a later stage in the proceedings ([see *GAT*, paragraph 25](#)).

46 In addition, the Court has stated that to allow, within the scheme of the Brussels Convention, decisions in which courts other than those of the State in which a particular patent is issued rule indirectly on the validity of that patent would multiply the risk of conflicting

decisions which the convention seeks specifically to avoid ([see GAT, paragraph 29](#)).

47 Having regard to the wide interpretation given by the Court to Article 16(4) of the Brussels Convention, to the risk of conflicting decisions which that provision seeks to avoid, and, taking account of the similarity of the content of Article 22(4) of Regulation No 44/2001 and of Article 16(4) of the Brussels Convention, noted in paragraph 43 above, it must be held that the application of the rule of jurisdiction set out in Article 25 of Regulation No 44/2001, which refers expressly to Article 22 of that regulation, and of other rules of jurisdiction such as, *inter alia*, those provided for in Article 31 of that regulation, are capable of being affected by the specific binding effect of Article 22(4) of Regulation No 44/2001, mentioned above in paragraph 44.

48 Accordingly, it must be established whether the specific scope of Article 22(4) of Regulation No 44/2001, as interpreted by the Court, affects the application of Article 31 of that regulation in a situation such as that at issue in the main proceedings, which concerns an action for infringement in which the invalidity of a European patent has been raised, at an interim stage, as a defence to the adoption of a provisional measure concerning cross-border prohibition against infringement.

49 According to the referring court, the court before which the interim proceedings have been brought does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of the regulation would rule in that regard, and will refuse to adopt the provisional measure sought if it considers that there is a reasonable, non-negligible possibility that the patent invoked would be declared invalid by the competent court.

50 In those circumstances, it is apparent that there is no risk of conflicting decisions as mentioned in paragraph 47 above, since the provisional decision taken by the court before which the interim proceedings have been brought will not in any way prejudice the decision to be taken on the substance by the court having jurisdiction under Article 22(4) of Regulation No 44/2001. Thus, the reasons which led the Court to interpret widely the jurisdiction provided for in Article 22(4) of Regulation No 44/2001 do not require that, in a case such as that in the main proceedings, Article 31 of that regulation should be disappplied.

51 In the light of all the foregoing considerations, the answer to the second question is that Article 22(4) of Regulation No 44/2001 must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of Article 31 of that regulation.

The third to sixth questions

52 Having regard to the answer provided to the second question, there is no need to answer the third to sixth questions.

Costs

53 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby rules:

1. 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, must be interpreted as meaning that a situation where two or more companies established in different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to ‘irreconcilable judgments’ resulting from separate proceedings as referred to in that provision. It is for the referring court to assess whether such a risk exists, taking into account all the relevant information in the file.

2. Article 22(4) of Regulation No 44/2001 must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of Article 31 of that regulation.

* Language of the case: Dutch.

OPINION OF ADVOCATE GENERAL CRUZ VILLALÓN

delivered on 29 March 2012 (1)

Case C-616/10

Solvay SA

v

Honeywell Fluorine Products Europe BV

Honeywell Belgium NV

Honeywell Europe NV

(Reference for a preliminary ruling from the Rechtbank 's-Gravenhage (Netherlands)) (Judicial cooperation in civil matters – Jurisdiction and the recognition and enforcement of judgments – Regulation (EC) No 44/2001 – Action for infringement of a European patent – Special and exclusive jurisdiction – Article 6(1) – More than one defendant – Article 22(4) – Validity of patent called into question – Article 31 – Provisional or protective measures)

1. The Rechtbank 's-Gravenhage (District Court, The Hague) (Netherlands), seised of actions for infringement of a European patent against companies established in different Member States, followed by a claim for provisional relief (a cross-border prohibition against infringement), is referring several questions to the Court of Justice for a preliminary ruling on the application 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 (2) to disputes relating to intellectual property rights.

2. The very specific questions from the referring court (3) encapsulate some of the main issues (4) raised by the application of that regulation to cross-border disputes concerning European patents (5) and thus provide an opportunity for the Court of Justice to clarify its most significant judgments on the matter in regard to Articles 6(1), (6) 22(4) (7) and 31 (8) of Regulation No 44/2001.

I – Legal framework

3. Pursuant to Article 3 of Regulation No 44/2001, and notwithstanding the principle established by Article 2 of that Regulation, persons domiciled in a Member State may be sued in the courts of another Member State only by virtue of the rules set out in Articles 5 to 24 of the Regulation.

4. Article 6 of Regulation No 44/2001 provides that a person domiciled in a Member State may be sued in another Member State:

‘...’

(1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings;

...’

5. Article 22 of Regulation No 44/2001 provides:

‘The following courts shall have exclusive jurisdiction, regardless of domicile:

...’

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place. Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State;

...’

6. Finally, Article 31 of Regulation No 44/2001 provides:

‘Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that State, even if, under this Regulation, the courts of another Member State have jurisdiction as to the substance of the matter.’

II – Facts in the main proceedings

7. On 6 March 2009, Solvay SA, a company established in Belgium and holding European patent EP 0 858 440, valid in more than one Member State, (9) brought an action in the Rechtbank ’s-Gravenhage in the Netherlands for infringement (10) of several

national parts of the patent, in particular against three companies originating from two different Member States, Honeywell Fluorine Products Europe BV, established in the Netherlands, and Honeywell Belgium NV and Honeywell Europe NV, established in Belgium, (11) for marketing a product manufactured by Honeywell International Inc. (HFC-245) that was identical to the product under the above patent.

8. In the course of the proceedings, on 9 December 2009 Solvay SA lodged an interim claim against the defendants in the main proceedings, seeking provisional relief in the form of a crossborder prohibition against infringement for the duration of the main proceedings. (12)

9. As the defendants in the main proceedings had raised the defence of invalidity of the national parts of the patent concerned in the interim proceedings, without, however, having brought or even declared their intention of bringing actions for invalidity, and contested the competence of the Dutch court to hear both the main proceedings and the interim proceedings, the Rechtbank ’s-Gravenhage decided to stay the proceedings and refer to the Court of Justice for a preliminary ruling a question on the interpretation of Article 6(1) of Regulation No 44/2001 and several questions on Articles 22(4) and 31 of Regulation No 44/2001.

III – The questions referred

10. The questions raised by the Rechtbank ’s-Gravenhage are as follows:

‘(1) Regarding Article 6(1) of Regulation No 44/2001:

In a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, does the possibility arise of “irreconcilable judgments” resulting from separate proceedings as referred to in Article 6(1) of the Regulation?

(2) Regarding Article 22(4) of Regulation No 44/2001:

(a) Is Article 22(4) of the Regulation applicable in proceedings seeking provisional relief on the basis of a foreign patent (such as a provisional cross-border prohibition against infringement), if the defendant argues by way of defence that the patent invoked is invalid, taking into account that the court in that case does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of the Regulation would rule in that regard, and that the application for interim relief in the form of a prohibition against infringement shall be refused if, in the opinion of the court, a reasonable, non-negligible possibility exists that the patent invoked would be declared invalid by the competent court?

(b) In order for Article 22(4) of the Regulation to be applicable in proceedings such as those referred to in the preceding question, must the defence of invalidity

be subject to procedural requirements in the sense that Article 22(4) of the Regulation is only applicable if invalidity proceedings before the court having jurisdiction under Article 22(4) of the Regulation are already pending or are to be commenced – within a period to be laid down by the court – or at least that a summons in that regard has been or is being issued to the patent holder, or does it suffice if a defence of invalidity is merely raised and, if so, are requirements then laid down in respect of the content of the defence put forward, in the sense that it must be sufficiently substantiated and/or that the conduct of the defence must not be deemed to be an abuse of procedural law?

(c) If question 1 is answered in the affirmative, does the court, after a defence of invalidity has been raised in proceedings such as those referred to in question 1, retain jurisdiction in respect of the infringement action with the result that (if the claimant so desires) the infringement proceedings must be stayed until the court having jurisdiction under Article 22 (4) of Regulation [No 44/2001] has given a decision on the validity of the national part of the patent invoked, or that the claim must be refused because a defence that is essential to the decision may not be adjudicated, or does the court also lose its jurisdiction in respect of the infringement claim once a defence of invalidity has been raised?

(d) If question 1 is answered in the affirmative, can Article 31 of Regulation [No 44/2001] confer on the national court jurisdiction to adjudicate on a claim seeking provisional relief on the basis of a foreign patent (such as a cross-border prohibition against infringement), and against which it is argued by way of defence that the patent invoked is invalid, or (should it be decided that the applicability of Article 22(4) of the Regulation does not affect the jurisdiction of the Rechtbank to adjudicate on the infringement question) jurisdiction to adjudicate on a defence claiming that the foreign patent invoked is invalid?

(e) If question 4 is answered in the affirmative, what facts or circumstances are then required in order to be able to accept that there is a real connecting link, as referred to in paragraph 40 of the Van Uden v Deco-Line judgment, between the subject-matter of the measures sought and the territorial jurisdiction of the Contracting State of the court before which those measures are sought?'

11. The applicant and defendants in the main proceedings, the Federal Republic of Germany, the Hellenic Republic, the Kingdom of Spain and the Commission have submitted written observations. Representatives of Solvay SA and Honeywell Fluorine Products Europe BV and agents for the Kingdom of Spain and the Commission were heard at the hearing on 30 November 2011.

IV – Analysis

12. It must be observed from the outset that, in so far as Regulation No 44/2001 now replaces, in relations between the Member States, (13) the Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters, (14) the interpretation given by the Court as regards the

Convention also applies to the regulation, where its provisions and those of the Brussels Convention may be treated as equivalent. (15) Moreover, it is clear from recital 19 in the preamble to Regulation No 44/2001 that continuity in interpretation between the Brussels Convention and that regulation should be ensured.

A – The main action and the interpretation of Article 6(1) of Regulation No 44/2001

13. By its first question, the referring court asks the Court, in essence, whether it can declare itself competent on the basis of Article 6(1) of Regulation No 44/2001. To be more precise, it is seeking clarification as to whether, in view of the fact that it is seised of actions against an undertaking established in the Netherlands and two undertakings established in Belgium, there is a possibility of irreconcilable judgments which would justify its jurisdiction on the basis of that provision.

14. Article 6(1) of Regulation No 44/2001 provides for the possibility for an applicant to sue several defendants before the court where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings. (16)

15. The Court established the requirement for such a connecting link in its interpretation of Article 6(1) of the Brussels Convention (17) and it was then incorporated in the wording of Article 6(1) of Regulation No 44/2001 (18) in order to ensure that the exception to the principle of jurisdiction of the courts of the Member State in which the defendant is domiciled could not call the very existence of that principle into question.

16. The Court has also explained that, for decisions to be regarded as contradictory, it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact. (19)

17. It is, moreover, for the national court to assess, in the light of all the necessary factors in the case-file, whether there is a connection between the different claims brought before it, that is to say, a risk of irreconcilable judgments if those claims were determined separately. (20)

18. In its judgment in Roche Nederland and Others, however, the Court found that parallel actions for infringement in different Member States, which, in accordance with Article 64(3) of the Munich Convention, must be examined in the light of the national law in force, (21) are not in the context of the same legal situation (22) and hence any divergences between decisions cannot be treated as contradictory. (23)

19. In other words, it appears that, in principle, the conditions for application of Article 6(1) of Regulation No 44/2001 cannot be met when the actions for infringement are based on a European patent.

20. From that point of view the Court's case-law in Roche Nederland and Others has been strongly criticised, (24) in that it considerably reduces the scope

of Article 6(1) of Regulation No 44/2001 (25) in the field of industrial property. (26) It is widely considered (27) to weaken the protection of holders of European patents (28) and also to be incompatible with Article 69 of the Munich Convention. (29)

21. Should the position therefore be that the issue raised by the present case ultimately comes down to a decision either to uphold or to overturn the case-law in Roche Nederland and Others?

22. I do not think so. It seems to me that, as the Federal Republic of Germany, the Kingdom of Spain and the Commission have all argued, it is possible to adopt a more nuanced approach, carefully circumscribing the scope of the case-law in Roche Nederland and Others.

23. In fact, the legal situation at issue in the main proceedings is different from that at issue in Roche Nederland and Others, in so far as the defendants in the main proceedings, established in the Netherlands and Belgium, are separately accused of marketing the same infringing products in the same Member States and hence infringing the same 'national parts of the European patent' as are applicable in the latter Member States.

24. To determine the relevance of those arguments, it may be useful to consider the situation that would arise if Article 6(1) of Regulation No 44/2001 were to be declared inapplicable. The Dutch referring court would be competent to deal with the action against the defendant in the main proceedings established in the Netherlands, and a Belgian court would have to be seised by the applicant in the main proceedings of an infringement action against the two defendants in the main proceedings established in Belgium, in accordance with Article 2 of the Regulation. (30)

25. The two courts would each have to examine the alleged infringements in the light of the different national legislation governing the various 'national parts of the European patent' alleged to have been infringed by applying the *lex loci protectionis* principle. (31) They would, for instance, be called upon to assess according to the same Finnish law the infringement of the Finnish part of the European patent by the three defendants in the main proceedings by the marketing of an identical infringing product in Finland.

26. It is true that, in those circumstances, they would be required to give decisions in the context of the same legal situation, the infringement of the same national part of a patent defining the scope of that patent's protection in the same terms, (32) but might deliver diametrically opposite judgments.

27. In other words, Article 6(1) of Regulation No 44/2001 would not be applicable to a bundle of infringement actions relating to different companies established in different Member States, since they concern acts carried out in different Member States that infringe different national parts of a European patent governed by different laws. (33) On the other hand it might, if the condition of an identical situation of fact is met, be applicable to a bundle of infringement actions against different companies established in different Member States if they relate separately to acts carried

out in the same Member State that infringe the same national part of a European patent governed by the same law. (34)

28. It should, however, be pointed out that the special rules on jurisdiction in Regulation No 44/2001 are to be interpreted by the national court (35) having regard for the principle of legal certainty, which is one of the objectives of the regulation; that implies that Article 6(1) of Regulation No 44/2001 is to be interpreted 'in such a way as to enable a normally well-informed defendant reasonably to foresee before which courts, other than those of the State in which he is domiciled, he may be sued'. (36)

29. In those circumstances, I propose that the Court answer the first question from the referring court by ruling that Article 6(1) of Regulation No 44/2001 is to be interpreted as meaning that it is applicable in an action for infringement of the European patent involving several companies established in different Member States when the actions relate separately to acts carried out in the same Member State that infringe the same national part of a European patent governed by the same law.

B – The interim proceedings

30. In its second series of questions the referring court asks, in essence, whether the fact that a defence of invalidity of a patent has been raised in interim proceedings for a cross-border prohibition against infringement, in parallel to main proceedings for infringement, is sufficient, and, if so, under what formal or procedural conditions, for Article 22(4) of Regulation No 44/2001 to become applicable, with the result that, firstly, the court dealing with the case has to decline jurisdiction for the main proceedings on the basis of Article 25 of Regulation No 44/2001 and, secondly, as a consequence, it is required to consider its competence to adjudicate on the interim proceedings on the basis of Article 31 of Regulation No 44/2001.

1. Interpretation of Article 22(4) of Regulation No 44/2001

31. The first series of questions regarding the scope of the provisions of Article 22(4) of Regulation No 44/2001 are to be considered in the light of the grounds and the operative part of the GAT judgment. (37)

32. In that judgment, the Court ruled that, having regard to its objective and its position within the scheme of the Convention, (38) Article 16(4) of the Brussels Convention was to be interpreted as meaning that the rule of exclusive jurisdiction laid down in that article concerns all actions relating to the registration or validity of a patent, whether the question is raised through an action or a plea in objection, and irrespective of the stage of the proceedings in which it is raised.

33. Without going back to the *raison d'être* of those provisions, it may be emphasised that that solution was justified by three series of considerations relating to the basis and purpose of the system established by the Brussels Convention: (39) firstly, the binding nature of the exclusive jurisdiction established by Article 16(4) of the Brussels Convention; (40) next, the need to avoid

multiplying the heads of jurisdiction, in order to ensure the predictability of the rules of jurisdiction, and consequently legal certainty, (41) and, lastly, the need to avoid multiplying the risk of conflicting decisions, which the Brussels Convention sought specifically to avoid. (42)

34. The Federal Republic of Germany, the Hellenic Republic, the Kingdom of Spain and the Commission, endorsing in that respect some of the points made by the referring court, agree, in substance, that courts seised of an interim application, as in the main proceedings, are not ruling on the merits or the existence of the infringement (subject-matter of the main proceedings) or on the validity of the patent (defence raised in the interim proceedings); on the contrary, they normally confine themselves to consideration of whether the conditions for granting the interim measure sought have been fulfilled. Since any examination of the validity of a patent is *prima facie* and does not lead to any final decision, there is therefore no risk of conflicting decisions.

35. However, that view has to be discussed particularly in the light of paragraph 30 of the GAT judgment, in which the Court has commented very specifically on the issue of the effects of decisions on the applicability of Article 16(4) of the Brussels Convention. It was argued that, since the effects of a decision ruling indirectly on the validity of a patent were limited to the parties to the proceedings under German law (*inter partes effect*), there could be no risk of conflicting decisions. The Court rejected that argument in terms that were both very general and very radical.

36. Emphasising that the effects associated with such a decision are determined by national law and that, in several Contracting States, the decision to annul a patent has *erga omnes effect*, it took the view that ‘in order to avoid the risk of contradictory decisions, it is therefore necessary to limit the jurisdiction of the courts of a State other than that in which the patent is issued to rule indirectly on the validity of a foreign patent to only those cases in which, under the applicable national law, the effects of the decision to be given are limited to the parties to the proceedings’. It ruled that that was not possible, since ‘such a limitation would ... lead to distortions, thereby undermining the equality and uniformity of rights and obligations arising from the Convention for the Contracting States and the persons concerned’. (43)

37. Should it therefore be considered that the GAT judgment, requires the referring court to decline jurisdiction in the circumstances of the main proceedings? In my view, the answer should be more nuanced and should take account of procedural reality.

38. It must be stressed that only three situations are likely to arise, depending on whether the validity of the patent has been called into question in both the main proceedings and the interim proceedings (hypothesis (a)), or only in the main proceedings (hypothesis (b)) or only in the interim proceedings (hypothesis (c)).

39. In hypotheses (a) and (b) the GAT case-law is applicable; the court seised must therefore, in

accordance with Article 25 of Regulation No 44/2001, decline jurisdiction for the main proceedings and consider the possibility of granting the provisional measure applied for on the basis of Article 31 of Regulation No 44/2001.

40. In hypothesis (c), there are two possible scenarios. The defendant may not have had the opportunity to raise the question of the validity of the patent in the main proceedings, for instance because the provisional measure was adopted before the main action started (44) (situation (c1)). It is also possible that the defendant did have that opportunity but did not consider it appropriate to take advantage of it (situation (c2)); that seems to correspond to the situation in the main proceedings, which is for the referring court to determine.

41. In situation (c1), the court seised must be able to consider the application for a provisional or protective measure and grant it if appropriate, but in full compliance with the GAT case-law. That means that such a provisional measure can be adopted only if, within a reasonable period, the court seised is also seised of main proceedings relating to the measure applied for, an action for infringement under an application for prohibition of infringement, in the context of which compliance with the GAT case-law can be ensured, and hence strictly on the condition that it does not have any final effect.

42. In situation (c2), on the other hand, the argument derived in the interim proceedings from the invalidity of the patent in question cannot, in principle, lead the court seised to decline jurisdiction for the main proceedings in accordance with Article 25 of Regulation No 44/2001. In that situation, it may be assumed that the argument derived from the invalidity of the patent in question is a delaying tactic; it is for the defendant to establish that it has brought proceedings for a declaration of invalidity before the competent court. The court seised may therefore adopt the provisional measure applied for in accordance with its national law, provided that it is competent for the substance.

43. Accordingly, I suggest to the Court that it rule that Article 22(4) of Regulation No 44/2001 is to be interpreted as meaning that the rule of exclusive jurisdiction that it lays down is not applicable when the validity of a patent is raised only in interim proceedings, in so far as the decision likely to be adopted at the end of those proceedings does not have any final effect.

2. Interpretation of Article 31 of Regulation No 44/2001

44. The opinion on this point is delivered only in the alternative, in the event that the Court decides that the referring court is not competent to hear the action on the substance, in accordance with Article 22(4) of Regulation No 44/2001, or is not competent to hear the whole of the action on the substance, in accordance with Article 6(1) of the Regulation.

45. In fact, as indicated by settled case-law, (45) the court having jurisdiction as to the substance of a case

under one of the heads of jurisdiction laid down in the Brussels Convention, and subsequently in Regulation No 44/2001, also has jurisdiction to order provisional or protective measures, without that jurisdiction being subject to any further conditions. (46)

46. It is apparent from the Court's case-law that Article 31 of Regulation No 44/2001, like Article 24 of the Brussels Convention before it, constitutes an autonomous right of jurisdiction, (47) complementary to the rights of jurisdiction established in Articles 2 to 24 of Regulation No 44/2001. (48) None the less, in so far as that article provides for an exception to the system of jurisdiction established by Regulation No 44/2001, it must be strictly interpreted, (49) the exercise of 'provisional jurisdiction' being subject to certain conditions laid down in the Court's case-law, relating to the nature of the rights to be protected and the purpose and subject-matter of the measures sought. (50)

47. The provisional measures must, firstly, fall within the scope of Regulation No 44/2001, restricted to the notion of civil and commercial matters. In view of the diverse range of such measures in the various Member States, that categorisation is to be determined not by their inherent nature but by the nature of the rights that they safeguard. (51) That is without any doubt the case with infringement actions, to which the general rules of Regulation No 44/2001 apply, (52) and with provisional applications for a cross-border prohibition against infringement, such as that in the main proceedings. (53)

48. The measures capable of being adopted on the basis of Article 31 of Regulation No 44/2001 must, moreover, be of a provisional nature, that is to say be intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is sought elsewhere from the court having jurisdiction as to the substance of the matter. (54) That chiefly implies that a provisional measure adopted on the basis of Article 31 of Regulation No 44/2001 is for a limited period.

49. The Court has emphasised in very general terms that the court called upon to authorise such a measure must act with 'particular care ... and detailed knowledge of the actual circumstances in which the measure is to take effect', which means that it must 'place a time-limit on its order' and, more generally, 'make its authorisation subject to all conditions guaranteeing the provisional or protective character of the measure ordered', (55) normally until a decision is taken on the substance.

50. Moreover, and specifically for the purpose of ensuring that measures adopted on the basis of Article 31 of Regulation No 44/2001 are of a provisional or protective nature, in *Van Uden*, (56) the Court laid down an additional condition, namely the existence 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 seised, (57) a point very specifically referred to in the last question referred by the national court.

51. Until now the Court has not directly had the opportunity to explain what those two conditions meant as regards intellectual property rights.

52. Since the preliminary application in question in the main proceedings was made after a main action had started, so that the condition of restriction of the scope of the measure adopted *ratione temporis* may be considered to be potentially fulfilled, I shall look in particular at the condition of existence of a real connecting link.

53. That condition, which has been criticised, (58) is interpreted in various ways. (59) Some take the view that that requirement is a restriction on the extraterritorial effect of the provisional measures adopted. Others believe that the condition implies that the measure adopted produces its effects, at least partially, in the Member State of the court seised. Hence the condition in no way acts as a restriction on the scope *ratione loci* of the measure adopted; on the contrary, the measure can produce its effects in Member States other than the State of the court seised and thus have extraterritorial scope. (60) It is more a condition of minimum territorial localisation of the provisional measure sought. The existence of a real connecting link should thus be considered chiefly in the light of the enforcement procedures of the Member State of the court seised. (61)

54. Indeed, it seems to me that it may be accepted that the court of a Member State that is hypothetically not competent to deal with the substance of the case can declare itself competent to authorise a provisional measure based on Article 31 of Regulation No 44/2001 only in so far as that measure has an effect in the territory of the Member State concerned and can be enforced there. It is for that same court to assess whether that real connecting link exists, since it is in the best position to do so.

55. Accordingly, I suggest that the Court rule that Article 31 of Regulation No 44/2001 is to be interpreted as meaning that a national court may not authorise a provisional measure having no effect in its territory, which it is incumbent on that court to decide.

V – Conclusion

56. In conclusion, I propose that the Court answer the questions referred by the *Rechtbank 's-Gravenhage* by ruling,

1. principally:

(a) 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 is to be interpreted as meaning that it applies in an action for infringement of the European patent involving several companies established in different Member States when the actions relate separately to acts carried out in the same Member State and infringe the same national part of a European patent governed by the same law.

(b) Article 22(4) of Regulation No 44/2001 is to be interpreted as meaning that the rule of exclusive jurisdiction that it lays down is not applicable when the validity of a patent is raised only in interim

proceedings, in so far as the decision likely to be adopted at the end of the proceedings has no final effect.

2. In the alternative:

Article 31 of Regulation No 44/2001 is to be interpreted as meaning that a national court cannot authorise a provisional measure that produces no effect in its territory, which it is incumbent on the court to decide.

1 – Original language: French.

2 – OJ 2001 L 12, p. 1.

3 – These questions were, moreover, raised very shortly after the publication by the European Commission of a proposal for a regulation of the European Parliament and of the Council on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Recast) of 14 December 2010 (COM(2010) 748 final), ('the proposal for a recast of Regulation No 44/2001'). For a discussion of the proposal, see Heinze, C. A., 'Choice of Court Agreements, Coordination of Proceedings and Provisional Measures in the Reform of the Brussels I Regulation', *Rabels Zeitschrift für ausländisches und internationales Privatrecht*, 2011, Vol. 75, p. 581.

4 – Issues raised by the Commission in its report to the European Parliament, the Council and the European Economic and Social Committee on the application of Council Regulation (EC) No 44/2001 of 21 April 2009 (COM(2009) 174 final, point 3.4). See also Green Paper on the review of Regulation No 44/2001 of 21 April 2009 (COM(2009) 175 final, points 4 and 6) and European Parliament Resolution of 7 September 2010 on the implementation and review of Regulation No 44/2001 (OJ 2011 C 308 E, p. 36, point 22).

5 – See, in particular, Fernández Arroyo, D., *Compétence exclusive et compétence exorbitante dans les relations privées internationales*, RCADI, 2006, Vol. 323, in particular p. 95, points 80 et seq; Leible, S. and Ohly, A. (ed.), *Intellectual Property and Private International Law*, Mohr Siebeck, 2009; Schauwecker, M., *Extraterritoriale Patentverletzungsjurisdiktion – Die internationale Zuständigkeit der Gerichte außerhalb des Patenterteilungsstaates für Verletzungsverfahren*, Carl Heymanns Verlag, 2009; Nourissat C. and Treppoz E., *Droit international privé et propriété intellectuelle – Un nouveau cadre pour de nouvelles stratégies*, Lamy, *Axe Droit*, 2010; Winkler, M., *Die internationale Zuständigkeit für Patentverletzungstreitigkeiten*, Peter Lang, 2011.

6 – Case C-539/03 Roche Nederland and Others [2006] ECR I-6535.

7 – Case C-4/03 GAT [2006] ECR I-6509.

8 – Case C-391/95 Van Uden [1998] ECR I-7091.

9 – Specifically, Denmark, Ireland, Greece, Luxembourg, Austria, Portugal, Finland and Sweden. Switzerland and Liechtenstein should also be included.

10 – 'The main proceedings'.

11 – 'The defendants in the main proceedings'.

12 – 'The interim proceedings'.

13 – In the case of the Kingdom of Denmark, see the Agreement between the European Community and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, signed at Brussels on 19 October 2005 (OJ 2005 L 299, p. 62).

14 – OJ 1972 L 299, p. 32, 'the Brussels Convention'.

15 – See, in particular, Case C-292/08 German Graphics Graphische Maschinen [2009] ECR I-8421, paragraph 27, and Case C-406/09 Realchemie Nederland [2011] ECR I-0000, paragraph 38.

16 – Case 189/87 Kalfelis [1988] ECR 5565, paragraph 12; Case C-51/97 Réunion européenne and Others [1998] ECR I-6511, paragraph 48; and Roche Nederland and Others, paragraph 20.

17 – Kalfelis, paragraph 12.

18 – As the Court pointed out in Roche Nederland and Others, paragraph 21.

19 – Roche Nederland and Others, paragraph 26; Case C-98/06 Freeport [2007] ECR I-8319, paragraph 40; and Case C-145/10 Painer [2011] ECR I-0000, paragraph 79.

20 – Freeport, paragraph 41, and Painer, paragraph 83.

21 – Paragraph 30.

22 – Paragraph 31.

23 – Paragraphs 32 and 35.

24 – See, in particular, European Max-Planck Group on Conflict of Laws in Intellectual Property (CLIP), *Intellectual Property and the Reform of Private International Law: Sparks from a Difficult Relationship*, IPRax, 2007, No 4, p. 284; points 78 to 85, and the case-law cited in point 78 of the Opinion delivered by Advocate General Trstenjak in Painer; see also Muir Watt, H., 'Article 6', in Magnus, U. and Mankowski, P., *Brussels I Regulation*, 2nd ed., Sellier, European Law Publishers, 2012, p. 313, No 25a; Noorgård, M., 'A Spider without a Web? Multiple Defendants in IP Litigation', in Leible, S. and Ohly, A. (ed.), p. 211; Gonzalez Beilfuss, C., 'Is there any Web for the Spider? Jurisdiction over Co-defendants after Roche Nederland', in Nuyts, A. (ed.), *International Litigation in Intellectual Property and Information Technology*, Kluwer Law International, p. 79.

25 – Some critical authors, however, were able to acknowledge that that case-law had ended years of insecurity and helped to improve harmonisation in Europe. See, to that effect, Kur, A., 'Are there any Common European Principles of Private International Law with regard to Intellectual Property', in Leible, S. and Ohly, A., *op. cit.*, pp. 1 and 2.

26 – In particular, Hess, B. et al., *Report on the Application of Regulation Brussels I in the Member States (Study JLS/C4/2005/03)*, Ruprecht-Karls-Universität Heidelberg, September 2007, No 204, p. 104 ('Heidelberg Report').

27 – The Commission itself highlighted the difficulties arising from that case-law in its report of 21 April 2009 on the application of Regulation No 44/2001 (point 3.4). The Green Paper on the review of Regulation No 44/2001 at first adopts a very cautious approach to the

issue, also taking account of Roche Nederland and Others, paragraphs 36 to 38. In any event, it must be observed that it did not propose any amendment to Article 6 of Regulation No 44/2001 in its proposal for recasting of Regulation No 44/2001, even though its aim was merely to identify a number of deficiencies of the current system and to remedy them pending the creation of the unified litigation system for European and Community patents. See, on that point, Opinion 1/09 of 8 March 2011, Opinion delivered pursuant to Article 218(11) TFEU ECR I-0000, in which the Court held that the envisaged agreement creating a unified patent litigation system ('European and Community Patents Court') is not compatible with the provisions of the TEU and TFEU.

28 – Heidelberg Report, p. 338, No 825 et seq.

29 – Heidelberg Report, p. 340, No 833 et seq.

30 – The advisability of bringing actions based on Article 5(3) of Regulation No 44/2001 was not discussed in that case and is not therefore considered in this Opinion.

31 – See, on that point, points 97 and 118 of the Opinion of Advocate General Léger in Roche Nederland and Others.

32 – See, to that effect, Blumer, F., 'Patent Law and International Private Law on both Sides of the Atlantic', World Intellectual Property Organisation (WIPO) Forum on Private International Law and Intellectual Property, Geneva, 30 and 31 January 2001 (WIPO/PIL/01/3).

33 – In Roche Nederland and Others, paragraph 33, the Court in fact took the view that a connection could not be established 'between actions for infringement of the same European patent where each action was brought against a company established in a different Contracting State in respect of acts which it had committed in that State'.

34 – It should be pointed out that the Court has ruled that Article 6(1) of Regulation No 44/2001 was applicable despite the fact that the actions to be consolidated did not have an identical legal basis. See *Freeport*, paragraphs 31 to 47.

35 – Case C-103/05 *Reisch Montage* [2006] ECR I-6827, paragraph 24.

36 – See *Reisch Montage*, paragraph 25; see also, in regard to Article 5(1) of the Brussels Convention, Case C-26/91 *Handte* [1992] ECR I-3967, paragraph 18; Case C-440/97 *GIE Groupe Concorde and Others* [1999] ECR I-6307, paragraph 24; and Case C-256/00 *Besix* [2002] ECR I-1699, paragraphs 24 to 26; on the forum non conveniens claim, Case C-281/02 *Owusu* [2005] ECR I-1383, paragraph 40; on Article 24 of the Brussels Convention, Case C-104/03 *St Paul Dairy* [2005] ECR I-3481, paragraph 19.

37 – Paragraphs 13 to 31.

38 – Paragraphs 20 to 24.

39 – For the *raison d'être* of those provisions, reference will be made to the numerous works of legal literature.

40 – Paragraphs 26 and 27.

41 – Paragraph 28.

42 – Paragraph 29.

43 – On the subject of Regulation No 44/2001, see Case C-420/07 *Apostolides* [2009] ECR I-3571, paragraph 41.

44 – Although that might appear an absurd hypothesis, in the case of interim proceedings assumed as such, one might say by their nature, to be added to parallel main proceedings, it may none the less occur, as I shall emphasise below.

45 – Van Uden, paragraphs 22 and 48, and Case C-99/96 *Mietz* [1999] ECR I-2277, paragraph 41.

46 – It should be noted that those provisions are incorporated in a new provision in the proposal for a recast of Regulation No 44/2001, namely Article 35.

47 – Van Uden, paragraph 42. See, in particular, *Pertegás Sender, M.*, 'Article 24 of the Brussels Convention: a particular Reading for Patent Infringement Disputes?', in Fentiman, R. et al., *L'espace judiciaire européen en matières civile et commerciale*, Bruylant, 1999, p. 277; *Pertegás Sender, M.*, *Cross-Border Enforcement of Patent Rights*, Oxford University Press, p. 130, No 3.138.

48 – On that provision, see the report by Mr P. Jenard on the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, signed in Brussels on 27 September 1968 (OJ 1979 C 59, p. 1, in particular p. 42), and the explanatory report by Professor Fausto Pocar on the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, signed in Lugano on 30 October 2007 (OJ 2009 C 319, p. 1, paragraph 124).

49 – On Article 24 of the Brussels Convention, see *St Paul Dairy*, paragraph 11.

50 – Van Uden, paragraph 46, and *Mietz*, paragraph 47.

51 – Case 143/78 *de Cavel* [1979] ECR 1055, paragraph 8; Case C-261/90 *Reichert and Kockler* [1992] ECR I-2149, paragraph 32; Van Uden, paragraph 33; and *Realchemie Nederland*, paragraph 40.

52 – Case 288/82 *Duijnste* [1983] ECR 3663, paragraph 23.

53 – Although the Court ruled that it was for the referring court to verify whether that is in fact the case. See *St Paul Dairy*, paragraph 10.

54 – *Reichert and Kockler*, paragraph 34; Van Uden, paragraph 37; and *St Paul Dairy*, paragraph 13.

55 – Case 125/79 *Denilauler* [1980] ECR 1553, paragraphs 15 and 16; *Reichert and Kockler*, paragraph 33; and Van Uden, paragraph 38.

56 – Paragraph 40.

57 – It should be explained that, even though the Court did not formally and explicitly refer to that condition in its subsequent judgments, it did mention it in *Mietz*, paragraph 42.

58 – Notably by the Commission, echoing the legal literature, in its report on the application of Regulation No 44/2001 (cited above) and in its Green Paper on the review of Regulation No 44/2001 (cited above). In its resolution of 7 September 2010 (cited above), the European Parliament 'urges that a recital be introduced in order to overcome the difficulties posed by [that]

requirement'. For an overall view, see Dickinson, A., 'Provisional Measures in the "Brussels I" Review: Disturbing the Status Quo?' in *Journal of Private International Law*, 2010, Vol. 6, No 3, p. 519.

59 – See, in particular, Pertegás Sender, M., 'Cross-Border Enforcement of Patent Rights', *op. cit.*, paragraph 3.158; Janssens, M.-C., 'International Disputes Involving Intellectual Property Rights: How to Take the Hurdles of Jurisdiction and Applicable Law', in Dirix, E., and Leleu, Y.- H., *The Belgian report at the XVIIIth Congress of Washington of the International Academy of Comparative Law*, Bruylant, 2011, No 46, pp. 611 and 640.

60 – The Court, moreover, pointed that out in Case C-256/09 *Purrucker* [2010] ECR I-7349, paragraph 85, referring on that point to the explanatory report by Dr Alegria Borrás on the Convention, drawn up on the basis of Article K.3 of the Treaty on European Union, on Jurisdiction and the Recognition and Enforcement of Judgments in Matrimonial Matters (OJ 1998 C 221, p. 27, paragraph 59). See also *Denilauler*, paragraph 17.

61 – The proposal for a recast of Regulation No 44/2001 (cited above, paragraph 3.1.5, recital 25) provides that the free circulation of provisional measures ordered by a court having jurisdiction as to the substance should be ensured, whereas the effects of provisional measures adopted by a court not having jurisdiction as to the substance should be confined to the territory of the Member State concerned. See also Article 99 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) and Article 103 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).