

Cross-border injunctions against patent infringement could be about to make a comeback

What has happened?

An important reference will shortly be made to the European Union Court of Justice (“EUCJ”) by the District Court of The Hague in the Netherlands. It essentially asks whether the District Court can issue interlocutory cross-border injunctions for patent infringement under the provisions of Regulation 44/2001 on the Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters (the “Regulation”).

Potential impact

Details of the judgment are yet to emerge in English, and the exact questions to be referred to the EUCJ have not been decided. However, if the EUCJ agrees with the District Court, certain consequences may follow:

- Forum shopping could again become a feature of European patent litigation, in particular:
 - The Dutch ‘spider-in-the-web doctrine’, seeking interim cross-border injunctions in the Dutch courts, may be alive and well as a strategy;
 - So-called ‘Torpedo’ actions, where suits are strategically filed in countries with slow proceedings, may again become popular; and
- The complexity of European patent litigation may actually be reduced in some circumstances, because of the ability to obtain an interlocutory injunction covering a number of European countries in one court.

Whatever the exact scope of the referred questions, the Opinion of the Advocate General and then the implications of the decision of the EUCJ on this issue is likely to be deliberated upon for some time to come.

The Background

The referral arises from a case called *Solvay v Honeywell Fluorine Products Europe* (Case No. 09-2275). It concerns Solvay's patent for a method of preparing 1,1,1,3,3-pentafluoropropane, in force in a number of countries. Solvay alleges that its patents to this method are infringed in several countries by three Honeywell companies. One of these companies is Dutch and two are Belgian.

In respect of the Belgian defendants, Solvay argues that, because the Defendants infringe in more than one country, all infringements should be dealt with by the District Court to avoid irreconcilable decisions between the courts of various jurisdictions (further to Article 6(1) of the Regulation). In addition Solvay argues that Article 22(4) of the Regulation does not apply to proceedings in which only an interlocutory/interim injunction is sought.

The District Court agrees. It has decided that Article 2 of the Regulation gives it jurisdiction to rule the defendant based in the Netherlands (the Dutch Honeywell company) and also to rule on the infringement of foreign patents by that defendant. In order to avoid irreconcilable decisions in respect of the other defendants, under Article 6(1), the District Court says it follows that it must also be able to rule on the infringement of the same foreign patents by these foreign defendants (the Belgian Honeywell companies). The District Court has already decided in 2008 that Article 22(4) does not apply in the case of interlocutory injunctions (*Fort Vale v Pelican*).

Hadn't *Roche v Primus* settled this issue already?

Not according to the judgment of the District Court. In outline, in *Roche v Primus* (Case C-539/03) the defendants were infringing patents in their respective jurisdictions only. Therefore, the ECJ

(so named at the time) held that, further to Article 6(1) of the Regulation, the infringements must be litigated separately, in those respective jurisdictions. Whilst decisions on infringement of parallel patents in respective countries might be different, the different courts would not be ruling on the *same* infringement with exactly the same facts, as would be the case here. In *Roche v Primus* there was therefore not the same risk of irreconcilable decisions.

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