

Jurisdiction over joint defendants

VERON, Pierre “Trente ans d’application de la Convention de Bruxelles à l’action en contrefaçon de brevet d’invention” J.D.I. 2001.805-830 ; BLUMER F. “Patent law and international private law on both sides of the Atlantic”, report presented at the WIPO Forum on private international law and intellectual property, Geneva 30-31 January 2001, p. 17 ; ROOX, K. Grensoverschrijdende maattegelen in octrooizaken : overzicht van Belgische rechtspraak (1997-2002) IR.DI.2002.257-274 ; EBBINK, R.E. Over artikel 6(1) EEX en internationale bevoegdheid, *Industriele Eigendomsrecht en Reclamerecht* 1998.241, FAWCETT, J.J. Multi-party litigation in private international law, *International & Comparative Law Quarterly*, 1995.744-770, O’SULLIVAN, G., Cross-border Jurisdiction in Patent Infringement Proceedings in Europe, *EIPR*, 1996.654-664, Brief for Amici Curiae Law Professors in Support of the Appellant filed in the *Voda v Cordis* case, now pending before the U.S. Court of Appeals for the Federal Circuit, WEGNER, C.,H., *Voda v Cordis: Trans-Border Patent Enforcement*, available at http://www.foley.com/files/tbl_s31Publications/FileUpload137/2989/Voda_Texas_Paper.pdf; DUTSON, S., *The infringement of foreign intellectual property rights – a restatement of the terms of engagement*, *Int’l. & Comp L.Q.*, 1998.659-679; LAYTON, A. & MERCER, H., *European Civil Practice*, Sweet & Maxwell, 2nd ed, 2004, GAUDEMMENT-TALLON, H. *Compétence et execution des jugements en Europe*, Règlement n° 44/2001, Conventions de Bruxelles et de Lugano, 3^{ème} éd

ECJ Judgment of July 13, 2006 in Case C-539/03 Roche Nederland e.a. v F. Primus and M. Goldenberg

1. The IP right holder is often faced with multiple infringers e.g. branches of its competitor or independent distributors established in several countries. In such situations the effective enforcement implies a joint simultaneous action against all of them. Is such a simultaneous action possible under the Brussels Convention/Regulation system on grounds of article 6.1.² This provision enables, under certain conditions, a person domiciled in a Member States to be sued as a co-defendant in the courts where another defendant is domiciled. The purpose of the present chapter is to present briefly how the conditions of application of article 6.1 were interpreted in the field of intellectual property.

I. Conditions for consolidation of proceedings under article 6.1

2. The first condition of application of article 6.1 is the connection between the claims directed towards each of the multiple defendants. This condition was established by the Court of Justice in the *Kalfelis*¹ ruling, where it was observed that:

“For article 6.1 of the [Brussels Convention/Regulation] to apply, a connection must exist between the various actions brought by the same plaintiff against different defendants. That connection, whose nature must be determined independently, must be of such a kind that it is expedient to determine the actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings.”

The Court insisted on the fact that the role of article 6.1 is to avoid inconsistent judgments being given in two proceedings carried out in different States. This purpose has been confirmed by the introduction of the criterion elaborated by the Court to the wording of article 6.1 during the transformation of the Convention into a Regulation.² On the other hand, the Court of Justice did not invoke other reasons for consolidation of proceedings which are present in several national legal orders and were pointed out in the legal writings. These other reasons are, as some authors observed, the fact that the concentration of the litigation is desirable in order to ensure that there is no unnecessary duplication of proceedings, thereby avoiding unnecessary expense, delay and inconvenience to the parties, which contributes to an efficient

¹ Judgment of September 27, 1988 in case 189/87 A. *Kalfelis v Schroeder* [1988] 5565.

² At present this provision reads as follows: “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 any one of them is domiciled, provided the claim 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”.

administration of justice. Moreover, justice to the plaintiff may also demand that the litigation is concentrated. Otherwise, if there are two separate actions both may fail because neither court has all the relevant persons and full facts before it.³

Even though the Court of Justice did not refer to them, these reasons for consolidation of proceedings imbued certain decisions of national courts relating to application of article 6.1 in the field of intellectual property. It was primarily a consequence of a practical need to concentrate the proceedings aimed at combating the infringement spread throughout several countries. Such a case law proved that there is a tension between the extensive interpretation of article 6.1, serving the interest of the plaintiff faced with multiple infringers, and the strict one, aimed solely at avoiding the irreconcilable judgments being given. This tension gave rise to three references for a preliminary ruling addressed to the Court of Justice. First of them did not even reach Luxembourg before the case was settled.⁴ The second has been withdrawn following the settlement of the parties.⁵ Finally, the third ended up with a ruling given on July 13, 2006 in the *Roche* case, which shall be presented hereinafter.

3. The requirement of connection between claims has also as its objective to avoid an abusive use of the possibility set out in article 6.1.⁶ As it was observed already in the *Kalfelis* ruling and confirmed very recently by the Court of Justice in the *Reisch Montage* judgment,⁷: “*article 6.1 cannot be interpreted in such a way as to allow a plaintiff to make a claim against a number of defendants for the sole purpose of removing one of them from the jurisdiction of the courts of the Member States in which that defendant is domiciled.*” This second condition is corollary of the place of article 6.1 in the system of Brussels Convention/Regulation. In fact, this provision is an exception from the general rule set out in article 2, according to which the plaintiff is supposed to sue the defendant in the court of domicile of the latter. It was observed in the legal writings that the gist of this condition is not actually the connection between claims but rather a connection between the principal claim and the state where the litigation is pending.⁸ This stand is founded on the ‘special’ character of heads of jurisdictions contained in Section 2 of the Title II of the Brussels Convention, which are ‘*based on the existence of a particularly close connecting factor between the dispute and courts of the State of the defendant’s domicile.*’⁹ Accordingly, some authors considered that article 6.1 can be invoked against multiple defendants only before a court that has a particularly close connecting factor with the dispute.¹⁰ As it will be

³ FAWCETT, J.J., Multi-party litigation in Private International Law, *International & Comparative Law Quarterly*, 1995.744-770, esp.746, TOROLLER, A., Europäisierung des Patentrechts und Gerichtsstand, *GRUR Int.* 1955, 531, comp. HELDRICH, A., *Internationale Zuständigkeit und anwendbares Recht*, Berlin, 1969 106-129, referred to in PERTEGAS-SENDER, M., *Cross-border enforcement of patent rights*, Oxford University Press, 2002, p.18, point 2.09.

⁴ Reference of the Court of Appeal of October 27, 1997 in case *Fort Dodge Animal Health e.a. v AKZO Nobel*, [1998] F.S.R. 222.

⁵ *Boston Scientific e.a. v Cordis* case referred by the Court of Appeal (England and Wales) and registered with the number C-186/00 (O.J. C 233 of 12.8.2000, p. 15). It was removed from the role on November 9, 2000.

⁶ LAYTON, A. & MERCER, H., *European Civil Practice*, Sweet&Maxwell, 2nd ed, 2004, p.507 GAUDEMET-TALLON, H., *Compétence et execution des jugements en Europe, Règlement n° 44/2001, Conventions de Bruxelles et de Lugano*, 3^{ème} éd p.201

⁷ Judgment of July 13, 2006 in case C-103/05 *Reisch Montage AG*, not yet published, point 32. Available at <http://eur-lex.europa.eu>

⁸ PERTEGAS-SENDER, M, op. cit. p.98, point 3.46.

⁹ Judgment of January 11, 1990 in case C-220/88 *Dumez France and Taccoba v Hessische Landesbank*, [1990] I-49, point 17.

¹⁰ PERTEGAS-SENDER, M., *ibid.*

demonstrated hereinafter, such interpretation of article 6.1 played an important role in intellectual property litigation.

4. Before turning to the presentation of the application of article 6.1 in intellectual property litigation it is useful to distinguish, for the sake of clarity, two kinds of situations involving multiple defendants. The first one is the case of an infringement of a single IP right committed by several persons. The second group of cases, which is more representative for the patent litigation, relates to situations where several parallel IP rights are infringed by multiple defendants domiciled in respective countries.

II. Multiple defendants – single right

5. It may happen that a single IP right is infringed by multiple defendants domiciled both in the country where the intellectual property is protected and abroad. Take for instance, a U.K. patent infringed by a company with its seat in the U.K., which distributes the allegedly infringing product in this country, and by a Netherlands-based company charged with production and financing of the operation of both companies. One could also imagine a situation where the Belgian copyright is infringed by a Belgian distributor of a product and by an Italian company which manufactures the infringing products for the Belgian distributor. In such situation the claims against all the defendants are confined to the same factual circumstances and their liability is to be assessed under the same national law. The joinder of the defendants under article 6.1 seems thus to be well founded.¹¹ However, given the territorial scope of IP rights, such situations give rise to the problem of extraterritorial application of the substantive law of the court trying the case. A single IP right is protected in a single country. Therefore, according to the traditional approach, an act which is not committed within the territory of the country where the intellectual property rights has been created may not be considered as an infringement to this right.
6. Certain decisions seem however to have made a breach in such a strict understanding of the territoriality principle. Let us take an English ruling of 1997 in the *Coin Controls v Suzo*¹² case as an example. In this case four defendants, members of a group of companies, domiciled respectively in the U.K., in the Netherlands and in Germany, were accused of an infringement of U.K., German and Spanish patents. There was no patent registered in the Netherlands, however the defendant domiciled in this country, Suzo Holland, was the company primarily concerned with the development and the manufacture of the allegedly infringing product. Failing the patent in the Netherland there was no possibility to sue the manufacturer in his home country. However, the English court had been prepared to accept jurisdiction over the manufacturer and decided that: “*sufficiently arguable case had been made out on the pleadings that Suzo Holland was jointly liable with Suzo U.K. for the commercial activities which are alleged to infringe the U.K. patent. As such it is accepted that Suzo Holland is a proper party to the present proceedings, at least in respect of infringement of the U.K. patent.*”

¹¹ Comp. PERTEGAS-SENDER, M., p. 91 point 3.28; O’SULLIVAN, G., p. 657.

¹² High Court of Justice of March 26, 1997 in case *Coin Controls Limited v Suzo International (UK) limited and Others*, FSR 660, 672, IIC 1998.804-812 (summary).

7. In Belgium, the Brussels court assessed its jurisdiction over a Belgian defendant and an Italian co-defendant¹³ in a mixed copyright/design infringement case. The court considered that the Italian manufacturer of the allegedly infringing products participated in the importation of those products to Belgium and was, therefore, liable for the infringement of the Belgian copyright.¹⁴ The court so concluded because the Italian manufacturer's deliveries were made on order of Belgian distributor and, therefore, they were an essential condition for the sell of infringing goods in Belgium.
8. It is interesting to note that such a practice of augmenting of the scope of the national law so as to cover the foreign manufacturing appeared also recently in the case law of American Federal Circuit.¹⁵ In 2005 this Court concluded that infringement occurs under 35 U.S.C. § 271(a) where the "control and beneficial use" of a patented combination occurs within the United States-even when a component of that combination is physically located abroad.¹⁶
9. The issue briefly presented above is both a question of the scope of the application of the substantive law and the one of jurisdiction over multiple defendants. While the intellectual property rights are indisputably territorial in their scope, several decisions proved the necessity of a more nuanced approach to this tenet. The issue is worth to be fully analyzed in the further research, as the right holders are the more and more frequently faced with dispersed manufacturing facilities.

III. Multiple defendants – multiple rights

10. While the condition of connection between actions seems to be naturally fulfilled in case of the violation of the same national rights by several defendants, the joinder of multiple defendants under article 6.1 become more delicate when those defendants infringe several national rights. However, the courts in the Netherlands,¹⁷ in England¹⁸ and in Germany¹⁹ admitted that actions relating to infringement of a set of parallel national IP rights, namely parallel European patents, are sufficiently connected for the purpose of application of article 6.1.

¹³ Albeit, without referring to the Brussels Convention in force at the date of judgment.

¹⁴ The President of the Brussels Court of First Instance of March 1, 2000, nr. RR 99/9855/A in *Hermes v S.A. Prince of Wales e.a. «Qu'en revanche en fabriquant sur commande et en vendant des sacs et des ceintures à une société établie en Belgique et en expédiant la marchandise vers la Belgique, les 4^{ème} et 5^{ème} défendeurs [domiciled in Italy K.S.] ont participé à l'importation de produits argués de contrefaçon sur le territoire belge ; que leur participation était indispensable à la commercialisation en Belgique des produits en question»*,

¹⁵ This is a jurisdiction specialized in the patent cases.

¹⁶ *NTP, Inc. v. Research in Motion, Ltd.*, 392 F.3d 1336, 1370 (Fed. Cir. 2005) quoted in the Brief for Amici Curiae Law Professors in Support of the Appellant filed in the *Voda v Cordis* case, now pending before the U.S. Court of Appeals for the Federal Circuit, see similarly in *Eolas Techs. Inc. v Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005).

¹⁷ For example: Court of Appeal of the Hague of 16 January 1992 (*Wavin v Pipe Liners*) BIE 1993.44, President of the District Court of the Hague of 22 December 1994 in *Cordis v Cadsand Medica*) IER 1995.18, President of the District Court of the Hague of May 3, 1995 in *Bard v Medica* BIE 1996.300, President of the District Court of the Hague of May 26, 1997 *Unilever v Nestle* IER 1997.140, President of the District Court of the Hague December 2, 1997 *Cordis v Boston Scientific* IER 1998.66, District Court of the Hague of March 31, 1999 in *Scimed v Guidant* BIE 1999.445, Court of Appeal of the Hague of May 25, 2000 in *EKA/Nako* referred to in: *PERTEGAS-SENDER, M.*, op. cit. p. 91, footnote 37.

¹⁸ *Coins Controls v Suzo*. See above in fnnt. XX

¹⁹ District Court (Landgericht) of Düsseldorf of January 16, 1996 (4 O 5/99) in case *Reinigungsmittel*; reported by *STAUDER, D., VON ROSPATT, P., and VON ROSPATT, M.*, op.cit. p.128. In this case a German plaintiff sued before the court of Düsseldorf a UK company distributing plaintiff's products in the United Kingdom and three managers of this company, among which only one was domiciled in Germany. The court assumed jurisdiction with respect to all defendants on grounds of articles 2 and 6.1 of the Brussels Convention.

11. The joinder of the claims against multiple defendants before one court was based on the belief that parallel patents are identical. The similarity of the rights, as well as the fact that the infringements dispersed over the territories of several countries were concerned with the same product, were more persuasive argument for the joinder of claims than the belief that parallel proceedings could lead to irreconcilable judgments. Such view was not shared by everyone. Several courts and authors insisted on the strict interpretation of article 6.1 given in the *Kalfelis* judgment.²⁰ Accordingly, they considered that parallel patents, even though stemming from a single European patent application, are separate rights protected under respective national laws and that, in consequence, decisions relating to them cannot be considered as irreconcilable. This conclusion would not be called into question even in the case when at the issue of two parallel proceedings relating to two national “divisional” parts of one European patent the court in one country finds the infringement and the court of another country considers that there is no infringement at all.
12. In the following lines shall be presented the arguments underpinning each of these divergent stands, as well as the consequences that they may entail. First we shall turn to the opinions according to which the joinder of the defendants accused of the infringement of several IP rights is possible. The opposite view shall be presented in the second turn.

A) Joinder of claims under article 6.1 is possible

13. It was in particular the Dutch courts which, since the beginning of '90, have proved creativity in the application of the rules allowing a joinder of the claims before one court. By a liberal interpretation of the condition of connection between the claims made against each of the defendants, they have developed an interesting pro-right holder case law, in particular in the context of European patent litigation. This was possible because the joinder of the claims in this domain was usually based on the provisions of the European Patent Convention.²¹ While the main purpose of this act was to create a common patent application and uniform grant procedure, it also imposed to all courts of contracting States the obligation of construing the national patents in the same way.²² The Dutch courts were, at the beginning, accompanied by English courts. The observations of an English judge,²³ give a good illustration of how the provisions of the EPC were used in order to justify the joinder of defendants under article 6.1 of the Brussels Convention :

“(…) what the European Patent Convention is creating is a “European Patent”. Although that patent is then granted in respect of individual countries and, in each, is treated like a national patent (EPC Article 64(1), nevertheless those national patent rights can be considered as cuttings taken from the European Patent stock and planted in the national soil.

(…) In this judgment I have accepted the argument that, absent an attack on validity, it would be possible in circumstances similar to those existing in this case to bring proceedings here for infringement of foreign patent. That is crucially dependent on the fact that UK and foreign patent

²⁰ O’SULLIVAN, G., op. cit. p.657, See also the Fort Dodge Animal Health v AKZO Nobel [1998] F.S.R. 222, p. 236.

²¹ The Convention on the Grant of European Patents (European Patent Convention) signed in Munich on 5 October 1973. www.european-patent-office.org.

²² PERTEGAS-SENDER, M., op.cit. p.91 point 3.29.

²³ High Court of Justice of March 26, 1997 Coin Controls v Suzo International Ltd and others, IIC 1998.804.

are identical. Proceedings regarding to them can therefore be regarded as related for the purpose of article 6(1).”

14. The possibility of consolidating the proceedings in one court became a formidable tool of enforcement of patent rights. Instead of commencing the proceedings in several countries the right holder could seise a single court with the claims relating to the infringement of a set of parallel rights. The extensive interpretation of article 6.1 served, therefore, perfectly the interest of the patent holder. The Dutch courts were particularly generous for the patent holders in this respect. In the early nineties they even happened to accept jurisdiction over multiple defendants even though the principal defendant was not domiciled in this country (i.e. on the basis of joint application of articles 5.3 and 6.1).²⁴ This was an incorrect application of article 6.1, because this provision permits the joinder of multiple defendants only in the courts for the place where one of them is domiciled. The liberal approach to the conditions of application of article 6.1 attracted numerous litigators to the Dutch courts and gave rise to an abundant case law. However, after several years of an extensive interpretation of the conditions of application of article 6.1, courts nuanced their approach, in order to curtail an excessive forum shopping that developed during the nineties. To do so, the courts used the second argument developed in the *Kalfelis* decision, according to which the joinder of the defendants may not serve the sole purpose of removing one of them from the jurisdiction of the courts of the Member States in which that defendant is domiciled.

(i) Application of the ‘safeguard clause’

15. First, in *Akzo v Webster*²⁵ the District Court of The Hague refused to assert jurisdiction over UK-based defendants when they were sued together with other companies from the Webster groups before the court of the Nederland-based branch. The court founded its decision of factual circumstances, as in that case 99.6 % of infringing activities were carried out in the United Kingdom. Following *Akzo v Webster*, a similar decision was given in another case,²⁶ where a German-based company sued in the Netherlands three defendants: a Belgian company that manufactures and commercializes the allegedly infringing products, a UK company distributing it in the United Kingdom and a Netherlands-based company that had bought 50 kilos of the allegedly infringing products through an intermediary. The President of the District Court of The Hague refused to assert jurisdiction on grounds of articles 2 and 6.1 as it considered that the action was brought in the Netherlands with the sole aim of ousting the jurisdiction of the Belgian courts. Another decision where the argument of abuse of right was upheld by the court so as to dismiss the joinder of actions is the Belgian decision in the *Roche v Glaxo Wellcome* litigation.²⁷ It should be noted that in this case the court had to consider the joinder of several claims for a declaration of non-infringement of the patent. The court found that the defendant domiciled in Belgium had nothing to do with the patent under discussion: it was not the owner of the patent, had not obtained a license of the patent, did not trade in any products based on the patent and did not compete with the plaintiff’s

²⁴ Court of Appeal of the Hague, January 16, 1992, BIE 1993.44. See more in PERTEGAS-SENDER, M., op.cit.

²⁵ District Court of The Hague of December 23, 1997, IER 1998.75, BIE 1999.55.

²⁶ President of the District Court of the Hague of November 26, 1997 in case Goldschmidt v Elzbieta, IER 1998.79.

²⁷ NV Roche & Ors v The Wellcome Foundation Ltd e.a. Brussels Court of First Instance of June 8, 2000.

products in respect of which the declaration for non-infringement was claimed. The court also observed that the plaintiff's writ of summons contained no claim at all against the defendant domiciled in Belgium and that the claim for revocation and declaration of non-infringement were directed exclusively against the first defendant patentee, who was domiciled in the United Kingdom. The court refused, therefore, to exercise its jurisdiction over the principal defendant on grounds of article 2 and, in consequence, to extend the jurisdiction over the 'co-defendants'.

16. The backdrop for the adoption of the decisions above was the belief that the forum shopping had gone too far.²⁸ They constituted a firm response to this phenomenon and were based on the argument that the principal claim to which other claims were joined did not have a sufficient connection with the territory of the State of the court seised. It should be observed that this argument as such does not call into question the possibility of consolidating the parallel proceedings relating to several patents before one court. In fact, it does not refute the idea that these parallel proceedings are sufficiently related between them for the purposes of article 6.1. It is based only on the affirmation that there is no sufficient connection between the principal claim and the forum. However, the views according to which the parallel proceedings concerned with several territorially protected rights are not related within the meaning of article 6.1, i.e. they cannot lead to irreconcilable judgments, were the more and more pronounced. Finally, they were sanctioned by the Court of Justice in its very recent decision in the *Roche* case. Before turning to this decision we shall present, in the following lines, the national case-law that developed in the late nineties and constituted a background for the Court's of Justice decision.

B) Joinder of claims under article 6.1 is impossible

17. As it was observed above, after a period of pro-right holder case law several courts took a more restrictive course and acknowledged that factual and legal identity between patent rights in different countries is not sufficient to confer the required degree of connection for the purpose of article 6.1. Both English and Dutch courts considered that a judgment on infringement in one country can never be irreconcilable with a judgment relating to the parallel right given in another country, as the effects of each decision are confined to the respective territory of the designated State. Moreover, it has been observed by the English Court of Appeal that the ambit of the national monopolies conferred by the patent is not necessarily identical, having regard to the possibility of amendments to the patent claim that may be done independently in the designated States after the grant.²⁹
18. The Dutch courts reserved, however, one situation in which a sufficient connection between claims exists in the meaning of article 6.1. The Court of Appeal of The Hague developed a nuanced solution which it called itself the "spider in the web" doctrine. In the *Expandable Grafts* decision of April 23, 1998³⁰ it held the following:

²⁸ See for instance the explanations of J. Brinkhof in DE RANITZ, R. J. Brinkhof in Conversation with Remco de Ranitz, EIPR 1999.143

²⁹ Court of Appeal of October 27, 1997 Fort Dodge Limited v Akzo Nobel N.V. [1998] F.S.R. 222

³⁰ Court of Appeal of the Hague of April 23, 1998 in case *Expandable Grafts*, Ethicon & Cordis Europe v Boston Scientific, [1999] F.S.R. 352,

“If, however, in the example discussed above the Dutch and the French defendants belong to the same group of companies, a different approach may be called for. Where several companies belonging to one group of companies are selling identical products in different national markets, this will have to be considered as on joint action based on a joint business plan. In such cases the proper administration of justice calls for the simultaneous hearing and settlements of cases, which is made by article 6.1 of the Brussels/Lugano Convention”³¹.

The Court of Appeal continued carefully its analysis and added, drawing an analogy with the solution upheld in the *Shevill*³² judgment, all the actions may be brought in their entirety in the courts for the domicile of the head office which is in charge of the business operations and/or from which the business plan originated. In other words, those claims may be joined only in the forum of, what the court called, the spider in the web.

19. Such an “attractively nuanced response to pre-planned Europe-wide infringement of patents”³³ appealed to courts not only in the Netherlands but also in Belgium. In 2001 Brussels Court of First Instance took into consideration the economic relationship between the defendant companies, which were members of the same group and accepted jurisdiction over them on grounds of articles 2 and 6.1.³⁴ Other Dutch and Belgian decisions may be given as an example of application of the “spider in the web” doctrine.³⁵ On the other hand, the same Belgian courts refused to extend their jurisdiction over multiple defendants on grounds of article 6.1 considering that there is no sufficient connection between claims relating to several divisional part of European patent. While it is true that those decisions were given in the context of the declarations of non-infringement and were intended to dismantle the “Belgian torpedo”, forthright affirmations of the Brussels Court of Appeal and Brussels Court of First Instance seem to have a larger scope:

“Il n'existe pas de rapport entre les différentes actions déclaratoires de non-contrefaçon des brevets nationaux respectifs émanant d'un brevet européen, chacun en ce qui concerne le territoire couvert, qu'une bonne administration de la justice imposerait qu'elles soient traitée simultanément afin d'éviter que les jugements irréconciliables ne soient rendus.”³⁶

“Il n'est pas non plus question de connexité au sens de l'article 6.1 de la Convention de Bruxelles : le simple fait que toutes les défenderesses appartiennent au même groupe de sociétés ou du moins à la même organisation de vente n'implique pas qu'elles seraient traitées dans tous les Etats membres de la même manière. Le brevet européen est composé d'un faisceau de brevets nationaux. Le brevet européen est composé d'autant de brevets nationaux qu'il y a de demandes introduites. Le jugement en ce qui concerne la déclaration de non-contrefaçon en Belgique, n'a aucune incidence sur ces mêmes questions de droit dans tous les Etats membres, chaque pris séparément.”³⁷

³¹ Translation into English from the Westlaw data basis.

³² Judgement of March 7, 1995 in case C-68/93 Fiona Shevill [1995] I-415.

³³ LAYTON&MERCER, p. 511, point 15.131.

³⁴ Brussels Court of First Instance of July 30, 2001 Sython v SKB IR.DI.2003.301;

³⁵ District Court of The Hague November 11, 1998, in case Augustine Medical v Medeco, BIE 1999.241; The Hague Court of Appeal of May 27, 2003, BIE 2004, 139; The Belgian decision was rendered in summary proceedings: more recently President of the Brussels Court of First Instance of October 24, 2004 in Medinol v Johnson& Johnson (unreported, referred to in DE JONG, P., The Belgian Torpedo: From Self-propelled Armament to Jaded Sandwich, EIPR 2005.75-81, esp. 80).

³⁶ Brussels Court of Appeal of February 20, 2001 in case Roche e.a. v Glaxo Wellcome, IRDI, 2001.168-175.

³⁷ Brussels Court of First Instance of January 19, 2001 in case Novo Nordisk v DSM, IRDI, 2002.304-312.

20. Diverging opinions and case law relating to the application of article 6.1 in the context of the pan-European patent litigation ended up with three references for a preliminary ruling. Only in the third one – made by the Dutch Hoge Raad in the *Roche* case³⁸ - the Court of Justice could give its opinion.

IV. Court of Justice of July 13, 2006 in C-359/03 *Roche Nederland e.a.* : is there any web for the spider?

21. The reference for a preliminary ruling made by the Hoge Raad in the *Roche* case concerns the concept of the “spider in the web” exposed in the *Expandable Grafts* ruling and then confirmed by Dutch and followed by Belgian courts.
- In the *Roche* litigation two patent owners from the United States summoned nine companies of the Roche group³⁹ before the district court of The Hague and requested a cross-border injunction enjoining defendants from infringement of the European patent for a medical device in all countries where this patent is applicable. The companies of Roche group put forward the argument of the lack of jurisdiction of the Dutch courts but the district court asserted its jurisdiction and rejected the claim in respect of infringement of the patent. Primus appealed from this decision and The Hague Court of Appeals largely reversed the decision of the lower court. Roche then turned to the Supreme Court which, in the context of the debate in admissibility of the claims referred a question to the to the Luxembourg court.⁴⁰
22. First, the Advocate General P. Léger presented a thorough analysis of the issue in his opinion delivered in December 2005. He examined several provisions of the Brussels Convention. He started with a comparison of the condition of connection between claims under articles 6.1 and 22 (article 28 of the Brussels I Regulation).⁴¹ He also analyzed the nature of the European patent as set out by the provisions of the European Patent Convention. He paid attention to the fact that although the referring court did not

³⁸ The reference of the Dutch Supreme Court of December 13, 2003. The reference was registered as case C-539/03 (OJ C59 of 6.3.2004, p. 11). On December 8, 2005 Advocate General P. Léger delivered an opinion in this case.

³⁹ Based in the Netherlands, the United States, Belgium, Germany, France, the United Kingdom, Switzerland, Austria and Sweden.

⁴⁰ This question reads as follows: “A. Is there a connection, as required for the application of point 1 of Article 6 of the Brussels Convention, between a patent infringement action brought by a holder of a European patent against a defendant having its registered office in the State of the court in which the proceedings are brought, on the one hand, and against various defendants having their registered offices in Contracting States other than that of the State of the court in which the proceedings are brought, on the other hand, who, according to the patent holder, are infringing that patent in one or more other Contracting States?”

B. If the answer to Question A is not or not unreservedly in the affirmative, in what circumstances is such a connection deemed to exist, and is it relevant in this context whether, for example, the defendants form part of one and the same group of companies? the defendants are acting together on the basis of a common policy, and if so is the place from which that policy originates relevant?

the alleged infringing acts of the various defendants are the same or virtually the same.”

⁴¹ According to this provision

“1. Where related actions are pending in the courts of different Member States, any court other than the court first seized may stay its proceedings.

2. Where these actions are pending at first instance, any court other than the court first seized may also, on the application of one of the parties, decline jurisdiction if the court first seized has jurisdiction over the action in question and its law permits the consolidation thereof.

3. For the purposes of this article, actions are deemed to be related where they 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.” Comp. the view of the Advocate General with the *Expandable Grafts* decision, point 15 and a ruling of the High Court of Justice (Ch D) of May 24, 1991 in case *L.A. Gear Inc. v Gerald Whelan & Sons*, (Westlaw data basis).

specified whether its question related to the preliminary proceedings or the proceedings on the merits, the conclusions contained in the opinion applied to both types of the proceedings.⁴² Finally, he referred to the general context of the Dutch jurisprudence in which the question presented to the Court of Justice arose.

23. While the Advocate General admitted that the patent infringement is a particularly noxious for the market, he did not consider that at the time being the Community, nor the international instruments, give a proper legal basis for a joinder of claims against multiple infringers of the divisional parts of same European patent. Not only had he opposed to the ‘spider in the web’ concept, which in fact was already restrictive compared to the pre-Expandable Grafts case law, but he affirmed that there is simply no web at all. In the Advocate General’s view the principal rule of the Convention/Regulation system (“la clé de voûte”) is article 2, protective for the defendant.
24. Advocate General stuck to the restrictive interpretation of article 6.1 given in the *Kalfelis* decision and considered that for the judgments to be conflicting or contradictory, and the more so – irreconcilable – the proceedings leading to them must be placed in the same legal and factual context, which is not the case of the bundle of national patents. Advocate General considered that differences between respective national legislations relating to the protection of patent rights are too important to be overcome by a simple application of common interpretation directives set out in article 69 of the European Patent Convention. Therefore the similarity of factual circumstances of infringements committed in respective countries when they are a consequence of a parallel action undertaken by several companies belonging to a group and coordinated by a parent company would not be sufficient to justify the joinder of parallel claims neither under article 6.1, nor even under article 22.⁴³
25. Finally, Advocate General Léger referred to article 16.4 of the Brussels Convention, exposed above, to observe that whatever the interpretation of article 6.1 would be, it does not play the decisive role in the cross-border enforcement of intellectual property rights given the fact that the concentration of the proceedings before one court on grounds of this provision can be easily frustrated if the defendants raise the argument of the nullity/invalidity of the patent.⁴⁴ He concluded therefore that the actual system of litigation present important shortcomings which cannot be overcome by a simple interpretation of the Brussels Convention rules. The only way to resolve the problem is the creation of a brand new litigation system.
26. The argumentation of Advocate General proved to be persuasive in a judgment of the Brussels Court of Appeal of February 14, 2006 in case *Steps Holding v Clazificio Franzoni and D. Berenbaum*.⁴⁵ In this case the Netherlands based plaintiff brought an action in infringement of a European patent, first in the summary and then in the main proceedings, against two defendants: one domiciled in Belgium and the other in Italy, asking for a cross-border injunction against both of them. The Court of Appeal not only rejected

⁴² See point 46 of the opinion.

⁴³ Ibid. point 120 to 128.

⁴⁴ See in this respect the twin decision of the Court of Justice given the same day that the Roche decision (13 July 2006) in case C-4/03 GAT v LuK

⁴⁵ Unreported.

cross-border jurisdiction on the basis of article 6.1 against the Italian defendant, but also referred to the opinion of Advocate General Léger that was handed down two months earlier.

27. Seven months after the opinion the Court of Justice largely endorsed the views of its Advocate General. Apart from the arguments relating to the interpretation of article 22 of the Brussels Regulation, the Court actually repeated the reasoning of M. P. Léger. Therefore, it concluded that article 6.1 of the Convention must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.
28. This decision, as well as the *GAT* decision given on the same day, even though received with a certain disappointment, was interpreted as a signal from the Court that there is much to be done in the field of the patent litigation in Europe in order to allow the consolidation of proceedings in one court.⁴⁶ It has also been noticed in the United States, where at present somehow similar questions are being considered by the Court of Appeal for the Federal Circuit in the *Voda v Cordis* case.⁴⁷
29. Certain questions arise as also to the interpretation of the *Roche* decision in a larger context of the intellectual property litigation in general. How the criterion of 'irreconcilable judgments' should be understood in the context of the litigation of rights which are territorially limited? It is still possible to consolidate the proceedings relating to two different rights when each of the multiple defendants is accused of the infringement of each of the separate right in question?⁴⁸ Is it really necessary to consolidate the proceedings while different territorially protected rights are in question? Which criteria shall be upheld in order to permit the joinder of the defendants: an abstract one, founded on the need to avoid irreconcilable judgments, or rather those present in national legal orders⁴⁹ which refer more to the procedural economy and interests of the parties? The further study to be executed within the framework of the project is an excellent opportunity to answer these questions.

⁴⁶ PERTEGAS-SENDER, M., GIELEN, Ch., Cross-border Patent Enforcement: Back to square one? NautaDutilh Flash Info of July 13, 2006; BARRACLOUGH, E., ECJ blocks cross-border patent litigation, *Managing IP* of July 17, 2006, available at: <http://www.managingip.com/default.asp?page=9&PubID=198&SID=641601&ISS=22150&LS=EMS100586>; Two alternative solutions are now on the agenda, the Community Patent and the European Patent Litigation Agreement.

⁴⁷ American comment available at <http://ip-updates.blogspot.com/2006/07/ecj-limits-cross-border-patent.html>. See more in, WEGNER, C., H., *Voda v Cordis: Trans-Border Patent Enforcement*, available at http://www.foley.com/files/tbl_s31Publications/FileUpload137/2989/Voda_Texas_Paper.pdf; Brief for Amici Curiae Law Professors in Support of the Appellant filed in the *Voda v Cordis* case, now pending before the U.S. Court of Appeals for the Federal Circuit, available in the Westlaw data basis.

⁴⁸ Comp. with High Court of Justice of March 7, 1997 in case *Pearce v Ove Arup Limited and Others*, 1997 WLR 779, IIC 1998.833-841 (summary).

⁴⁹ See in England: FAWCETT, J.J., Multi-party litigation in Private International Law, *International & Comparative Law Quarterly*, 1995.744-770.

