

Jurisdiction for a negative declaration in IP matters

FENTIMAN, R., *Tactical declarations and the Brussels Convention*, C.L.J. 1995.261-263; WAUTELET, P., *Le droit au procès équitable et l'égalité des armes : le cas de la litispendance dans les Conventions de Bruxelles et de Lugano in Caupain & De Leval, L'efficacité de la justice civile en Europe*, Larcier, 2000, p.101-129 ; VON MEHREN, A., *The Transmogrification of Defendants into Plaintiffs : Herein of Declaratory Judgments, Forum Shopping and Lis Pendens in Festschrift Ulrich für Drobnig, Mohr Siebeck, 1998 pp.409 ; WIDMER, P. and MAURENBRECHER, B., What's Negative about Negative Declaration ? in *The International Practice of Law – Liber Amicorum for T.Barans R.Karrer, Helbing & Lichteahn, 1988, p. 263; SCHLOSSER, P. : Jurisdiction and international judicial and administrative co-operation RCADI 2000 t. 284, PERTEGAS-SENDER, M., Cross-border enforcement of patent rights, Oxford University Press, 2002, esp. 3.182-3.188 and 4.81-4.152 ; CUNIBERTI, G., Action déclaratoire et droit judiciaire européen, J.D.I. 2004.77-87, LAYTON, A.&MERCER, H., *European Civil Practice*, Sweet&Maxwell, 2nd ed, 2004, esp. 15.076-15.098; PASSA, J., comment to judgment of District Court of Paris of August 11, 1997, *Petites Affiches*, June 10, 1998, No 69 p. 30 ; 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 ; FRANZOSI, M., *Worldwide patent litigation and the Italian Torpedo*, E.I.P.R. 1997.382-385 ; FRANZOSI, M., *Torpedoes are here to stay IIC 2002.154-163 ; DE LEVAL, G., Eléments de la procédure civile, 2nd ed.Larcier 2005 ; LUNDSTEDT, L., Jurisdiction and the Principle of Territoriality in Intellectual Property Law: Has the Pendulum Swung Too Far in the Other Direction? IIC 2001.125-141 ; GARDELLA, A., *Giurisdizione su illeciti senza danno: l'applicazione dell'art. 5, n. 3, Conv. Bruxelles, alle azioni preventive, in Int'l lis, 2004, p. 19-24; VANDERMEULEN, B., A pan-European patent litigation checklist, document of August 22, 2005 available at www.twobirds.com/english/publications/articles/A_panEuropean_patent_litigation_checklist.cfm; GRZEGORCZYK, P. *Jurysdykcja krajowa w sprawach dotyczących patentów europejskich, Kwartalnik Prawa Prywatnego, 2005.1059-1133; BESLER, M., Sprawy o ustalenie , że wskazana produkcja nie jest objęta określonym patentem in Naruszenia praw na dobrach niematerialnych, ed. SZYMANEK, T., Warsaw 2001, ŻYŻNOWSKI: Niektóre aspekty drogi sądowej w sprawach z zakresu własności przemysłowej, Przegląd Sądowy, 2002 Nr 9 p.3-33;. VERON, P., *Innovations apportées dans le contentieux de la propriété industrielle par le Règlement (CE) n° 44/2001 du Conseil du 22 décembre 2000 concernant la compétence judiciaire, la reconnaissance et l'exécution des décisions en matière civile et commerciale, par rapport à la Convention de Bruxelles du 27 septembre 1968, Rev. Droit Propriété. Intell. 2001.4-10, esp. 7; DE JONG, P., The Belgian Torpedo : From Self-propelled Armament to Jaded Sandwich EIPR 2005.75-81, ROOX, K. Grensoverschrijdende maartegelen in octrooizaken : overzicht van Belgische rechtspraak (1997-2002) IR.DI.2002.257-274.******

1. In several European countries there is a possibility to file a specific action in order to obtain a declaration from the court that the claimant is not liable for a damage suffered by other person. In some of them, for instance France and United Kingdom, such a specific actions are provided for by acts governing the intellectual property rights. Such claims are commonly called: "actions for a declaration of non-liability". In the intellectual property context it is more proper to talk about the "declaration of non-infringement". This denomination is, besides, more popular with practitioners and authors of relevant legal writings.

The potential of the declaratory claims and their role in the international litigation were revealed in the Court of Justice's *Tatry*¹ and *Gasser* rulings.² According to this case law an action for a declaration of non-liability and an action for damages have the same cause and object, which means that, if they are brought between the same parties before two different courts they fall within the *lis pendens* rule. In consequence, the court second seized shall, on its own motion, stay proceedings and wait for the decision of the court first seized. Moreover, this obligation is not called to question even when the proceedings before the court first seized risk to be excessively long. The practical implications of this mechanism are very important. As it was observed in the first comments to the *Tatry* judgment, "a potential defendant need only launch a tactical strike for a negative declaration in its preferred [Regulation] state", so as to take control over the proceedings.³ In other words, a prospective defendant may use an action for a negative declaration to establish his innocence, so as to prevent suits being brought against him in other countries.⁴ In intellectual

¹ Judgment of December 6, 1994 in case C-406/92 *The owners of the cargo lately laden on board the ship "Tatry" v the owners of the ship "Maciej Rataj"* [1994] I-5439.

² Judgment of 9 December 2003 in case C-116/02 *Erich Gasser GmbH v MISAT Srl* [2003] I-14693.

³ FENTIMAN, R., *Tactical declarations and the Brussels Convention*, C.L.J. 1995.261-261, esp. 261.

⁴ FRANZOSI, M., *Worldwide patent litigation and the Italian Torpedo*, E.I.P.R. 1997.382-385 ; PERTEGAS-SENDER, M., *Cross-border enforcement of patent rights*, Oxford University Press, 2002, p. 174, point 4.81.

property litigation this tactic was often used principally to block, in the overloaded courts, the cross-border proceedings in infringement undertaken in other countries.

The objective of the present Chapter is not, however, to analyze this mechanism but to answer the question which court has jurisdiction to declare the non-infringement of an intellectual property right under the Brussels I Regulation. The interest of the research lies in the fact that several decisions rendered in last years proved that the views the courts of different Member States have on this question are divergent.

The examination of the above-mentioned case law must be preceded by a short analysis of the nature and the objective of the negative declaration claim.

I. The legal basis, nature and objective of the claim for a declaration of non-infringement

2. A claim for a declaration of non-infringement may be brought on grounds of a provision of a general character allowing for such action not only in IP cases. This is, for instance, the case of Belgium, where article 18 of the Code of Civil Procedure serves for a legal basis for declaratory claims usually used not only in IP litigation, but also in unfair commercial practices matters. Those claims may have a preventive character which means that they may be brought before the commencement of any proceedings. Article 18 of the Belgian Code of Civil Procedure reads as follows :

“An action can be admitted where it was attempted, including where it was of declaratory nature, in order to prevent the violation of a right that had been seriously threatened.”⁵

According to Belgian procedural law claim for a declaration must fulfill two conditions of admissibility: the right must be subject to a serious and defined threat and the claimant must prove his interest in obtaining the declaration. In other words, the court shall not admit a claim seeking for a mere consultation.⁶ Similar solutions exist Italian and German law⁷, as well as in Polish law.⁸

⁵Article 18 “L’action peut être admise lorsqu’elle a été intentée, même à titre déclaratoire, en vue de prévenir la violation d’un droit gravement menacée.”

⁶ DE LEVAL, G., *Eléments de la procédure civile*, 2nd ed. Larcier 2005, p. 23, point 9.

⁷ FRANZOSI, M. op. cit. p.384; see also the ruling of Corte Suprema di Cassazione of 19 December 2003, *Macchine Automatiche e Windmoller & Holscher KG. PERTEGAS-SENDER, M.*, op. cit. p.175, point 4.82. This author mentions also Dutch cases in which a declaratory relief was granted.

⁸ The legal basis for such action is article 189 of the Polish Code of civil procedure, See also: GRZEGORCZYK, P. *Jurysdykcja krajowa w sprawach dotyczących patentów europejskich*, KPP, 2005.1059-1133, esp. 1117; ŻYŻNOWSKI, *Niektóre aspekty drogi sądowej w sprawach z zakresu własności przemysłowej*, Przegląd Sądowy, 2002, No. 9, p.3-33.

3. English,⁹ French,¹⁰ and Swedish¹¹ law give examples of provisions specifically shaped for the intellectual property litigation, in particular the patent matters.¹² This is also the case of the Community and international instruments relating to intellectual property rights, which contain several procedural rules relating to the claim for a declaration of non-infringement. In case of Community Trademark Regulation¹³ the existence and admissibility of those claims is governed by the national law.¹⁴ In the proposed Community Patent Regulation¹⁵ a claim in declaration of non-infringement is specifically provided for in article 34.¹⁶ The European Patent Litigation Agreement¹⁷ prepared by the European Patent Office in Munich also admits an application for a declaration of non-infringement, however, provisions governing such claim are scarce.
4. The above-mentioned provisions of French and English law, as well as article 34 of the Community Patent Regulation proposal better show the character of a negative declaration claim in intellectual property right infringement. One can notice that its objective is precisely to establish that an existing patent does not bar the exploitation of a specific activity. Two observations may be made with this respect. The first is that, even if a claim for a declaration of non-infringement is often presented as a mirror image of the infringement claim,¹⁸ it is not obvious that a claim for declaration of non-

⁹ Section 71 of the U.K. Patent Act 1977 available at http://www.patent.gov.uk/patent/reference/mpp/s60_71.pdf Declaration or declarator as to non-infringement

71.- (1) Without prejudice to the Court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the Court or the Comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown -

(a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and

(b) that the proprietor has refused or failed to give any such acknowledgment.

(2) Subject to section 72 (5) below, a declaration made by the Comptroller under this section shall have the same effect as a declaration or declarator by the Court.

¹⁰ Section L. 615-9 of the French Intellectual Property Code :

Any person who can justify industrial exploitation on the territory of a Member State of the European Union, or effective and serious preparations to that end, may request the proprietor of a Patent to express his view as to the infringement of this Patent by such exploitation of which the description has been furnished to him.

2. If this person disagrees, with the answer he has received, or if the Patent holder has failed to answer within three months of the request, the person may serve summons on the Patent holder in order to have the Court decide whether or not the Patent is a bar to the exploitation concerned; such action does not prejudice an action for nullity of the Patent or a subsequent action for infringement, in the case of said exploitation not being carried out under the conditions specified in the description mentioned in the preceding paragraph⁷

¹¹ Swedish Patent Law (1967/837), Sec. 63. See also LUNDSTEDT, L., Jurisdiction and the Principle of Territoriality in Intellectual Property Law: Has the Pendulum Swung Too Far in the Other Direction? IIC 2001.125-141, esp.p.125.

¹² This was also the case of Polish law as well for patents and for trademarks, before the adoption of the new Industrial Property Act of June 30, 2000 (Official Journal of May 21, 2001).

¹³ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark O.J. L 011 of 14/01/1994 p.1 – 36.

¹⁴ According to article 92 of the Community Trademark Regulation, the community trademark court shall have exclusive jurisdiction for action for declaration of non-infringement, *if they are permitted under national law*. (emphasis added)

¹⁵ The most recent version of this proposal is the one dated March 8, 2004. This is the document of the Council of the European Union available at <http://register.consilium.eu.int/pdf/en/04/st07/st07119.en04.pdf>

¹⁶ According to this provision any person may bring proceedings against the patent proprietor or the beneficiary of an exclusive license in order to apply for a decision that the economic activity he is exercising or exercised, or making effective preparations to exercise or envisaging exercising does not affect the rights of the patent owner which are defined in articles 7, 8 and 19.

¹⁷ This Agreement provides, in its article 41, for the jurisdiction of the Court of First instance for the claims relating to the European Patent. Document dated February 16, 2004 is available at http://www.european-patent-office.org/epo/epla/pdf/agreement_draft.pdf

¹⁸ 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, esp. 826, CUONZO, G. Patent litigation in the post-torpedo era MIP, 2005

infringement is actually of delictual character.¹⁹ If there is any liability in question, it is not the liability of the defendant but rather the potential liability of the plaintiff. This may be a source of certain problems relating to the application of article 5.3 of the Brussels Convention/Regulation.²⁰ The second observation is that an approval of such action is based upon a presumption that the patent is valid. For this reason a claim for a declaration of non-infringement is often accompanied with a claim in invalidity.²¹ This may also lead to certain confusion as far as the competence of the courts is concerned.

5. Finally, it often happens that other types of claims are joint to a claim for a declaration on non-infringement. They have for the principal object to allow the plaintiff freely to perform all necessary acts of commercialization of the product in question (manufacture, offer for sale, have in stock or import the product) during the proceedings. In fact, these are also claims seeking for a declaration of non-infringement even if they are covered under a different denomination. For this reason, the notion of an action seeking a declaration of non-infringement was broadened to cover also such type of actions.²² Having presented the main features of the claim for a declaration of non-infringement we shall consider the question of international jurisdiction of courts for such a claim.

II. Asserting international jurisdiction for a negative declaration

(i) Exclusive jurisdiction

6. First should be taken into consideration the possibility of filing an action in declaration of non-infringement on grounds of article 22.4 of the Brussels I Regulation. This article provides for the exclusive jurisdiction in proceedings concerned with registration or validity of intellectual property rights in favor of the courts of the country where the IP rights has been registered.

Although it was suggested already the Jenard report²³ that the issues of registration and validity of rights should be dissociated from the issue of infringement of those rights, which the Court of Justice confirmed in the *Duijnstee* judgment,²⁴ the case law demonstrates a certain vacillation of national courts in this matter. In Belgium, for instance, in the *Röhm Enzyme*²⁵ case it was held that the issue of non-infringement is inherently linked to the issue of validity. Accordingly, only the judge competent for the issue of validity

<http://www.managingip.com/includes/supplements/PRINT.asp?SID=473491&ISS=12729&PUBID=199>; PERTEGAS-SENDER, M., op.cit. p. 178, point 4.94.

¹⁹ Contra PERTEGAS-SENDER op. cit. p.179 point 4.95.

²⁰ See ECJ judgment of September 27, 1988 in 189/87 Athanasios Kalfelis v Schroeder Bank e.a [1988] 5565, para 17 and point 8 infra.

²¹ Note, however, as far as the Community trademark is concerned, that according to article 95.2 the validity of a Community Trademark may not be put in issue in an action for a declaration of non-infringement. A similar provision was inserted in the initial Community Patent Regulation proposal in article 34.2, which was deleted and does not appear in the latest version of the proposal dated March 8, 2004.

²² See for example Brussels Court of First Instance of October 8, 2003 in case no. 03/454/C Eurogenerics NV/Ratiopharm v Lundbeck, unreported, President of the Court of First Instance of Brussels of June 4, 2003 in case Synthron / Eurogenerics c SKB unreported; JONG, P., The Belgian Torpedo: From Self-Propelled Armament to Jaded Sandwich EIPR 2005.75-81, esp. 77.

²³ OJ 1979 C 59 p. 1, point 36 : “other action, including those for infringement of patents, are governed by the general rules of the Convention”.

²⁴ Judgment of November 15, 1983 in case 288/82 Ferdinand M.J.J. Duijnstee v Lodewijk Goderbauer [1983] 3663, points 23-25.

²⁵ Court of First Instance of Brussels, May 12, 2000 in case Röhm Enzyme GmbH v DSM NV and Basf Belgium NV e.a., BIE 2000.211; IR.DI. 2002.278-283 and 2002.321-327; see also a comment by STOROR, Susan “Europe: Disarming the Torpedo” in Patent World, September 2000.

has jurisdiction to rule upon the non-infringement. In consequence, when an action for a declaration of non-infringement brought before the court of one state concerns IP right registered in another state, the court seized has to dismiss it, because otherwise it would impede the rule of exclusive jurisdiction. This approach was criticized in legal writings for having confused the issue of validity with the infringement.²⁶ Eventually, few years later, the case law also took another course. An interesting example of such a new approach is the decision given by the Brussels Court of First instance in the *Novo Nordisk* judgment,²⁷ where the court expressly discussed the issue in the following terms:

“The result of combination of article 16 and article 19 of the Brussels Convention [22 and 25 of the Brussels I Regulation] is that the national judge has to declare that he has no jurisdiction to rule on the validity of the patent which has been deposited or registered in another Contracting State...

A declaration of non-infringement is however not necessarily subject to the existence of a valid patent. If the patent is invalid, there is obviously no infringement. On the contrary, it is not because a patent is seen be an exclusively competent court as valid that a complex factual situation necessarily results in the infringement of such patent.

Accordingly, the ‘mirror claim’ [that is, the declaratory claim of non-infringement] is not intrinsically connected to the prior issue of the patent’s registration or validity.”²⁸

This stand has been further confirmed in other judgments²⁹ and seems to be rooted in the Belgian case law.

Further research relating to this issue seems necessary for two reasons. First, it would be certainly interesting to investigate the case law of other Member States in this respect. Secondly, the eagerly awaited Court’s of Justice ruling in the *GAT* case³⁰ brought new elements of answer to the question being discussed here, if not completely changed the landscape. The Court held that article 16.4 of the Convention [22.4 of the Brussels I Regulation] applies always where a plaintiff in proceedings concerned with a declaration of non-infringement raises the argument of invalidity or nullity of the patent. Such a position of the Court seems to confirm the views of those national courts according to which the issues of validity and the (non)infringement are inextricably linked.

It should not be forgotten, however, that, as it was observed above, although a claim in invalidity of the patent is often raised in proceedings concerned with a declaration of non-infringement, it is not always the case. In consequence, other provisions of the Brussels I Regulation should also be examined so as to find out whether they may grant jurisdiction to decide upon a claim for a declaration of non-infringement.

(ii) Special jurisdiction

²⁶ PERTEGAS-SENDER, M., op. cit. p. 176, p. 4.87; VERON, P., op. cit. p. 827.

²⁷ Court of First Instance of Brussels, January 19, 2001 in case *Novo Nordisk e.a. v DSM AR/99/3766/A* and *Novo Nordisk e.a. v Basf 99/5633/A*. IR.DI. 2002.304.

²⁸ Translation provided by M. Pertegas-Sender in PERTEGAS-SENDER, M., op. cit. p. 177, p. 4.89.

²⁹ Namely in *Roche & Ors v The Wellcome Foundation Ltd e.a.* Brussels Court of first instance of June 8, 2000 and Brussels Court of Appeal of February 20, 2001 IR.DI. 2001.169-175

³⁰ ECJ of July 13, 2006 in case C-4/03 *GAT v LuK*, unpublished.

Article 5.3

7. The issue of applicability of article 5.3 to the declaration of non-infringement is particularly interesting because of the divergences existing in the decisions of Member States' courts relating to this question. The most abundant case law relates to the patent litigation, and in particular, the European patent infringement. It should be recalled here that the European patent is a bundle of national patents granted at the issue of uniform procedure and protecting the same invention commercialized in several countries. In this context the claims for a declaration of non-infringement were often brought not only with respect to the national part of the patent but also with respect to the foreign patents – parts of the same bundle of patents.

The analysis shall start with an examination of article 5.3 whose wording was modified at the occasion of the transformation of the Convention into a Regulation. According to article 5.3 of the Brussels I Regulation

“A person domiciled in a Member State may, in another Member State be sued in matters relating to tort, delict or quasi delict, in the courts for the place where the harmful event occur or may occur.”

Words “may occur” were added in the Regulation and did not appear in the Convention, however already in its judgment in the *Henkel* case³¹ the Court of Justice have recognized the preventive actions as relating to tort, delict or quasi delict within the meaning of article 5.3 of the Convention.³² The question which must be answered here is whether a claim in declaration of non-infringement relates to tortious or delictual matters and is covered by article 5.3.

8. The Court of Justice held that the word “matters relating to tort, delict or quasi delict” are to be given an independent interpretation. It was underlined in the legal writings that several Court's decisions illustrate that an action may fall outside article 5.3 if it does not seek to establish the defendant's liability.³³ In fact, the views of the Court have been very clearly expressed in the *Kalfelis* decision in the following terms:

“In order to ensure uniformity in all Member States, it must be recognized that the concept of ‘matters relating to tort, delict or quasi delict’ covers all actions which seek to establish the liability of a defendant and which are not related to a contract within the meaning of article 5.1”³⁴

At the first sight it could be therefore concluded, that actions in declaration of non-infringement does not fall within the scope of article 5.3 because, as it was observed above, they do not seek to establish the

³¹ Judgment of October 1, 2002 in case C-167/00 Verein für Konsumenteninformation v K.H.Henkel, [2002] I-8111. Comments: MANKOWSKI, P. Entscheidungen zum Wirtschaftsrecht 2002 p.1047-1048, GARDELLA, A. Il Corriere giuridico 2004 p.19-23, BOGDAN, Michael: Juridisk Tidskrift vid Stockholms universitet 2002 p.410-416, KOBINA GABA, H. Rec Le Dalloz 2002 Jur. p.3200-3202, REMY-CORLAY, P. Rev.Crit.DIP 2003 p.690-698, LOOS, M.B.M.: Nederlands tijdschrift voor Europees recht 2003 p.68-70 and others.

³² It is submitted here that the Henkel ruling gives a perfect counterargument to all decisions of national courts according to which article 5.3, as an exception from the basic rule set forth in article 2, is to be interpreted restrictively. In fact, this judgment provides for an *extensive* interpretation of this provision. See also opinion of AG Jacobs delivered in this case on March 14, 2002, para 33.

³³ LAYTON, A.&MERCER, H., European Civil Practice, Sweet&Maxwell, 2nd ed, 2004, esp. page 470, point 15.078

³⁴ Judgment of September 27, 1988 in 189/87 Athanasios Kalfelis v Schroeder Bank e.a [1988] 5565, para 17.

liability of the defendant but rather the potential liability of the plaintiff. In fact, the plaintiff to such action seeks to establish that there is no infringement and consequently – no liability involved.

Contra

9. Many national courts proved reluctant to admit article 5.3 as a basis for the international jurisdiction for a negative declaratory claim. The most commonly used argument concerned the lack of the delictual character of such action. This kind of arguments underlined for instance the decision of the Court of Appeal of the Hague of January 22, 1998³⁵ in which this court held that:

“[the plaintiff] argues that an action for a declaration of non-infringement forms the mirror claim to a patent infringement action and that the jurisdiction rule in article 5.3 of the Brussels Convention, that applies to infringement action, should apply ‘be reflection’ to a declaration of non-infringement ...

This argument cannot be followed because, as previously stated, article 5.3 of the Brussels Convention can only apply to torts and therefore is not fit for analogous application in the present case”³⁶

In Italy the Supreme Court³⁷ also rejected article 5.3 as a legal basis for the negative declaration. The court pointed out the exceptional character of this provision and recalled that its “ratio” is the fact that the judge of the place where the damage occurs is better placed to appreciate the claim relating to it. This ratio is lacking in case of negative declarations as they do not presuppose the occurrence of the event giving rise to the damage.³⁸ The Supreme Court shared the opinion of the court of lower instance, which had recalled the interpretation of article 5.3 given in the *Kalfelis* decision (above). In a following decision the Court of Appeal of Milan pointed out again that the meaning of an action for a declaration of non-infringement is the assertion of legal, rather than illegal character of a conduct. For this reason such action falls out of the scope of article 5.3 of the Brussels I Regulation.³⁹

Belgian courts seem also to follow this approach. It should be first recalled that in a wave of anti-torpedo decision the courts in Belgium rejected article 5.3 as legal basis for jurisdiction for negative declarations concerned both with the national and foreign patents.⁴⁰ Admittedly in a recent *Senseo* litigation⁴¹ the Antwerp court accepted a claim for a declaration of non-infringement on grounds of article 5.3 of

³⁵ Court of Appeal of the Hague of January 22, 1998 in case *Evans Medical Ltd. v Chiron BIE* 1998.83, IER 1998.135.

³⁶ Translation from Dutch provided by M. Pertegeas-Sender in PERTEGAS-SENDER, M., op. cit. p. 178 point 4.93.

³⁷ Corte Suprema di Cassazione of 19 December 2003, <http://www.lovells.com/NR/rdonlyres/1CC471D8-0E91-4F6C-B147-2EA40B23DA92/0/2850.pdf> p. 4 et <http://www.sib.it/itasib/novita/pat/290604.htm>; Reported in GRUR Int. 2005.264 with a critical comment of WURMNEST, W. See also other critical comments to such approach GRZEGORCZYK, P., op.cit. p. 1118-1119.

³⁸ A Belgian judge was more direct in his assessment stating in a decision relating to an application for a declaration of non-infringement based on article 5.3 that “A decision which is concerned with a non existence of a tort does not have any sense as the civil law judge is competent only to decide over a dispute. An application which tends to declare that any infringement have not been committed lacks interests.” Brussels Court of First Instance of May 12, 2000 in case *Rohm Enzyme v DSM*. IR.DI. 2002.321-327.

³⁹ Corte di Appello di Milano, March 2, 2004 in case *Optigen v Marchion* cited by CUONZO, G., Patent litigation in the post-torpedo era MIP, 2005.

<http://www.managingip.com/includes/supplements/PRINT.asp?SID=473491&ISS=12729&PUBID=199>

⁴⁰ *NV Roche & Ors v The Wellcome Foundation Ltd e.a.* Brussels Court of First Instance of June 8, 2000 and Brussels Court of Appeal of February 20, 2001 IR.DI. 2001.169-175, with a comment of S. Catoor. See also the Chapter relating to the Italian torpedo.

⁴¹ Court of First Instance of Antwerp of February 20, 2004 in case *NV Fortkoffiebranderij SA, SA Café Liègeois, NV Beyers Koffie S.A. v SaraLee / DE NV* IR.DI 2004.274. The decision was appealed, however the issue of jurisdiction has not been discussed by the Court of Appeal in its judgment of November 11, unpublished.

Brussels I Regulation, however it linked it to the issue of liability of the defendant for unjustified allegations of the patent infringement and unjustified seizure of plaintiff's allegedly infringing goods. The court held that the claim for a declaration of non-infringement constituted in these circumstances an integral part of the claim for damages.⁴² It was observed in legal writings⁴³ that the reasoning of the court in this case was hardly consistent with the European Court on Justice ruling in the *Turner* case.⁴⁴ After all, the alleged tort in the case in question consisted of the commencement of legal proceedings by the patentee. What indicates that the *Senseo* is rather a proof of hesitation than an overruling of the earlier case law is that only six weeks later the same Antwerp court changed its view and rejected an action for declaration of non-infringement brought on the basis of article 5.3 of the Brussels I Regulation on grounds of the lack of jurisdiction.⁴⁵

Other European courts also dismissed actions for a declaration of non-infringement, even if the argumentations underpinning their decisions were not always based on the fact that an action for declaration of non-infringement is not a matter relating to tort, delict or quasi-delict. The Swedish Supreme Court (Högsta Domstolen) in its decision of on June 14, 2000 in the case *Flootek AB v Kaldnes Miljoteknologi AS*⁴⁶ had to decide whether an action for a declaration that the exploitation of a certain technique did not violate certain patent rights comes within the scope of article 5.3. of the Lugano Convention.⁴⁷ The court first noted that it was an open question whether article 5.3 of the said Convention could be applied to actions for an injunction to prevent the imminent commission of a tort. Nevertheless, the court emphasized that such action differ greatly from an action for a declaration of non-infringement. The court observed precisely that the plaintiff's action for a negative declaration would not provide scope for determination of his potential liability to the defendant for damages. It added than, that plaintiff's action was not based on the fact that damage had already occurred.

Pro

10. Even if the abovementioned decisions seem to firmly reject article 5.3 as grounds for jurisdiction for a negative declaration concerned with both national and foreign patents, the question of application of this provision still remains opened because of several judicial decisions and arguments put forward in the legal writings. In France in a ruling of November 5, 2003 in *Dijkstra Plastics B.V. v Saier Verpackungstechnik GmbH & Co KG*⁴⁸ the District Court of Paris accepted jurisdiction to hear the action for a declaration of non-infringement based on the French part of the European patent under article 5.3 of the Brussels Convention considering that this is a claim relating to delict. The court found however that this provision

⁴² „La partie de l'action relative au constat de non-contrefaçon est un volet indissociable de l'action en dommages et intérêts.”

⁴³ DE JONG, P., The Belgian Torpedo : From Self-propelled Armament to Jaded Sandwich EIPR 2005.75-81, esp. 76.

⁴⁴ Judgment of April 27, 2004 in case C-59/02 *Turner v Harada* [2004].

⁴⁵ Antwerp Court of First Instance of April 9, 2004 in case *Möllers v Beumer*, unreported.

⁴⁶ Högsta Domstolen of 14 June 2000. IIC 2001.231, see also LUNDSTEDT, L., Jurisdiction and the Principle of Territoriality in Intellectual Property Law: Has the Pendulum Swung Too Far in the Other Direction? IIC 2001.125-141.

⁴⁷ The defendant was domiciled in Norway. There was no question of extra-territorial scope of the negative declaration claim.

⁴⁸ *Dijkstra Plastics B.V. v Saier Verpackungstechnik GmbH & Co KG* (TGI Paris, 5 November 2003); E. I.P.R. Issue 9 September 2004.N-151-152, with a comment of P. Véron expressing criticism toward this decision.

does not allow a court to issue a cross-border declaration of non-infringement and therefore declined jurisdiction to decide on the non-French parts of the patent.

The opinions expressed in the legal writings are favorable for the assertion of jurisdiction for a negative declaration on grounds of article 5.3. M. Pertegas-Sender considers for instance that although the plaintiff's claim is based on the non-existence of an infringement, the subject matter of the dispute undoubtedly relates to tort. She infers another argument from analogy with the Court's of Justice ruling in *Gubisch*⁴⁹ case, where the Italian court had been seized on the basis of article 5.1 with a claim for a declaration that a contract was void. Thirdly, she points out that the modification of the wording of article 5.3 operated during the transformation of the Convention into a Regulation entails a possibility of bringing an action concerned with a threatened tort. In her opinion this modification forecloses now the line of reasoning according to which article 5.3. does not apply to negative declaration claims as no unlawful act has occurred yet.⁵⁰

Interesting arguments were also presented by M. Franzosi who considers that the question whether the damage have already occurred or not is irrelevant. In his opinion the rule that jurisdiction can be established in the place of the alleged tort does not require that the existence of the tort is affirmed or even implied, because this is a rule of jurisdiction and not a rule of the merit. It implies therefore that such action has to be classified as a tort action, and not otherwise. The author follows that the action for declaration of non-infringement is not an action under contract or quasi-contract but an action in tort, as well as an action aimed at declaring a contract null, violable or utterly non-existent remains an action based on a contract.⁵¹

The issue of admissibility of claims for a negative declaration on grounds of article 5.3 should be further investigated, the more so because if it should be admitted that a claim for a negative declaration is a matter related to tort, delict or quasi-delict within the meaning of article 5.3, another question arises, namely the localization of the harmful event according to the *Bier/Shevill* rule.⁵² We shall leave this question for the further research and pass to the issue of admissibility of a claim in declaration of non-infringement in the interim proceedings.

⁴⁹ ECJ judgment of December 8, 1987 in case 144/86 *Gubisch v Palumbo* [1987] 4861.

⁵⁰ PERTEGAS-SENDER, M., op. cit. p.179 point 4.96-4.98, see also *ibid.* p. 107 points 3.68-3.72. Similarly DROZ, G., and GAUDEMONT-TALLON, H., who consider that this «hereux ajout apporté à l'art. 5.3 (...) permet des actions préventives bien utiles ». See: La transformation de la Convention de Bruxelles du 27.09.1968 en Règlement du Conseil concernant la compétence judiciaire, la reconnaissance et l'exécution des décisions en matière civile et commerciale Rev.Crit. DIP 2001.601-652, esp. p. 637.

⁵¹ FRANZOSI, M., *Torpedoes are here to stay* IIC 2002.154-163, esp. p. 157. See analogy with the judgment of the Court of Justice of March 4 1982 in case 38/81 *Effer v Kantner* [1982] 825 para 7, where the Court pointed out that "It follows from the provisions of the Convention (...) that, in the cases provided for in article 5.1 of the Convention, the national court's jurisdiction to determine questions relating to a contract includes the power to consider the existence of the constituent parts of the contract itself, since that is indispensable in order to enable the national court in which proceedings are brought to examine whether it has jurisdiction under the Convention. If that were not the case, article 5.1 of the Convention would be in danger of being deprived of its legal effect, since it would be accepted that, in order to defeat the rule contained in that provision is sufficient for one of the parties to claim that the contract does not exist".

⁵² Judgments of November 30, 1976 in case 21/76 *Bier BV v Mines de Potasse d'Alsace SA* [1976] 1735 and of March 7, 1995 in case C-68/93 *Fiona Shevill e.a. v Press Alliance* [1995]I-415. The first decision defines the place of the harmful event as both : the place where the event giving rise to a damage occurred and the place where the damage occurred. The second decision confines the jurisdiction of the court of the place where the damage occurred to the damage suffered in territory of the Member State of the country.

(iii) General principle

11. It goes without saying that a claim in declaration of non-infringement may be always brought on grounds of article 2 of Brussels I Regulation. We shall not further develop this question in the present preliminary paper. It is, however, to be noted that a large definition of the domicile of the company in article 60 of the Brussels I Regulation leaves s door open for forum shoppers.

(iv) Interim negative declaration

12. It was observed in the legal writings that an interim negative declaration may have certain utility in practice. First, such declaration can be requested in summary proceedings in a local court even where action for final cross-border relief are pending abroad. The reason why the alleged infringer would take the trouble to seek a provisional declaration of non-infringement may well be the need for provisional confirmation by the local court that he is not performing any infringing activities.⁵³ It could be also useful in order to launch a torpedo, if the demand is composed of claims concerning national and foreign rights.⁵⁴
13. Are the interim negative declarations covered by the definition of the ‘provisional, including protective measures’ established in the *Reichert II* and further elaborated in the *Van Uden* judgments. ⁵⁵ ? According to this case law ‘provisional, including protective measures’ are measures which are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case. The Court ordering measures on the basis of Article 31 of the Regulation must take into consideration the need to impose conditions or stipulations such as to guarantee their provisional or protective character. ⁵⁶ Moreover, with reference to the *Denilauler* ruling, the Court has established in *Van Uden* an additional condition of application of the said article, which is the existence of a real connecting link 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. With this respect a Belgian decision of the President of the Court of First Instance of Brussels ⁵⁷ is to be mentioned. The court decided that a negative declaration accompanied with an authorization to carry on the commercialization of allegedly infringing medicines may not be applied for in the summary proceedings, because of the lack of the provisional character of such measures.⁵⁸ It seems however that

⁵³ PERTEGAS-SENDER, M., op.cit. p.147, point 3.185.

⁵⁴ See Chapter relating to the torpedo tactics. It has been observed there that Belgian law gives examples of application of article 24 of the Brussels Convention to cross-borer negative declarations.

⁵⁵ Judgments of March 26, 1992 in case C-261/90 *Reichert v Dresdner Bank* [1992] I-2149, para 34 and of November 17, 1998 in case C-351/95 *Van Uden Maritime BV c Deco Line* [1998] I-7091, para 37.

⁵⁶ *Van Uden*, para 41.

⁵⁷ Judgment of October 8, 2003 in case no. 03/454/C *Eurogenerics NV/Ratiopharm v Lundbeck*, unreported. See also a similar decision of the President of the Brussels Court of First Instance of October 19, 1999 in *Roche Group v Wellcome Group* IR.DI. 2002.334-335.

⁵⁸ The Court held further that such a preliminary measure would amount to an anti-suit injunction, prohibited under the Belgian Constitution.

such conclusion could not be generalized and that a properly construed negative declaration claim, limited in time until the final decision on the merits, is of a provisional character.

14. The second question that appears in the context of articles 24 BC/31 BR concerns the extraterritorial scope of measures. It is to be noted that the *Van Uden* judgment of the Court of justice seems to be a serious limit for the cross-border negative declarations. In case of such claim the “subject” of the measure i.e. a foreign intellectual property right is not located within the territorial competence of the court seized. An interesting analysis of this question was made by the President of the Court of First Instance of Brussels in the judgment of September 22, 2000 in the *Epic Medical Equipement Serivces and Hospitera v Delaware Nellcor Puritain Bennet*.⁵⁹ The President relied on the *Van Uden* judgment and held that it was actually the subject of the interim measure itself that should be linked with Belgian territory in order for Belgian courts to have jurisdiction in the matter. The court considered that the measure applied for was not just one interim measure that has to be partially executed in Belgium, but a series of separate interim measures that have to be practically executed, be it voluntarily or compulsorily, in the territory of different States. The judge draw from it a conclusion that such separate interim measures have no sufficient real link, within the meaning of *Van Uden*, with the Belgian territory, therefore Belgian courts had no jurisdiction as regards the extra-territorial claim in declaration on non-infringement.

III. Concluding remarks

15. A further study of the issue of jurisdiction for a negative declaration is necessary, in particular as far as the jurisdiction under article 5.3 is concerned. It is very important to examine in this respect the actual nature and objective of a claim for a declaration of non-infringement. As it was observed in legal writings, the decisions dismissing claims brought under this article comes principally from the “torpedo” countries and justification of such dismissal was rather a question of policy than purely legal argumentation.⁶⁰ The discussion remains opened. The study shall also asses the impact of the long and eagerly awaited Court’s of Justice ruling in the *GAT* case on the applicability of article 22.4 to claims in declaration of non-infringement

⁵⁹ Epic Medical Equipement Serivces and Hospitera v Delaware Nellcor Puritain Bennet Ing.Cons. 2000.292-301, Medtronic BV v Therex http://www.juridat.be/cgi_juris/jurf.pl. See also Chapter relating to the torpedo tactics.

⁶⁰ As some authors points out : “Nobody has so far thought of criticizing actions for non-infringement initiated in Germany or the Netherlands”, FRANZOSI, M., Torpedoes are here to stay IIC 2002.154-163, esp. p. 157.