

ECJ rules out European cross-border patent injunctions

13 July 2006 www.simmons-simmons.com

Today, the European Court of Justice ruled that cross-border injunctions are not available in patent infringement actions. The Court's judgments in the cases of [GAT v LuK](#)¹ and [Roche v Primus](#)² have been eagerly awaited in Europe to finally settle this issue.

The problem: Both cases concern European patents, which are granted centrally from a single application but which upon grant become a bundle of national patents, traditionally enforced separately in each state – a costly and complex exercise for litigants. The two cases both concern attempts to avoid the need to litigate separately in each state essentially the same issues in relation to alleged infringing activities.

The facts and their commercial relevance: In [GAT v LuK](#), the issue was whether the German courts could determine whether the German company GAT's proposed activities in France would infringe LuK's French patent, and whether a claim that the patent was invalid affected the German court's ability to do so. In [Roche v Primus](#), the issue was whether the Dutch courts could grant an injunction to the patentee Primus against infringement not only by the local Dutch Roche group company but

also by other Roche group companies in other EU states, who, Primus claimed, infringed equivalent local patents. If one state's courts could exercise jurisdiction to decide these matters beyond its borders, then the courts of other states would have to decline jurisdiction and instead wait for and then give effect to the first court's ruling. Importantly from a litigation tactics point of view, the knock-on effect would be that a litigant could pick either a fast or slow court to decide the matter as it wished, knowing that its opponent would then be unable to have the matter decided in another state on a different timescale; also this would allow smaller litigants such as Primus to take on large opponents such as Roche more cheaply via one central enforcement action.

Legal basis of today's decisions: The two cases sought clarification of the operation of the Brussels Convention on Jurisdiction, now re-enacted by the 'Brussels Regulation' (Council Regulation EC 44/2001). Under the Regulation, whilst the courts of one EU member state generally have jurisdiction over the extraterritorial activities of a locally based defendant, Article 22(4) expressly reserves jurisdiction regarding patent validity to the

courts of the country where the patent is registered. The central issue in [GAT v LuK](#) was whether patent infringement could ever practically be decided without reference to validity. The ECJ has ruled that it cannot. In [Roche v Primus](#), the central issue was whether the general provision in Article 6(1) of the Regulation, allowing several defendants to be sued in the state of domicile of any one of them, applies in cases of patent infringement. The ECJ has ruled that it does not, not least due to its ruling in [GAT v LuK](#) that infringement and validity are so intertwined as to be practically inseparable when determining the appropriate jurisdiction to rule on infringement.

Comment: The problems which [GAT v LuK](#) and [Roche v Primus](#) illustrate are inherent in a system where there is no central process for deciding infringement and, particularly, validity of European patents. With the EU Commission's proposals for a unitary 'Community patent' enforceable across the whole EU stalled, today's decisions of the ECJ will lend weight to calls for the Commission to now follow leading EU patent judges in supporting implementation of the European Patent Litigation Agreement³.

1 [Gesellschaft für Antriebstechnik mbH & Co KG v Lamell und Kupplungsbau Beteiligungs KG, Case C-4/03 on a request for a preliminary ruling by the Oberlandesgericht of Düsseldorf.](#)

2 [Roche Nederland BV and others v Dr Frederick James Primus and another, C-593/03 on a request for a preliminary ruling by the Hoge Radd der Nederlanden.](#)

3 See www.elexica.com/scripts/checklink.asp?area=Items&resource=D9iPanEuroInjunct.htm for more details.

For further information

A more detailed analysis of today's rulings will shortly appear on www.elexica.com. Or please contact any of the following for more details of the issues arising from these rulings:

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