

# EPLAW

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29 June 2009

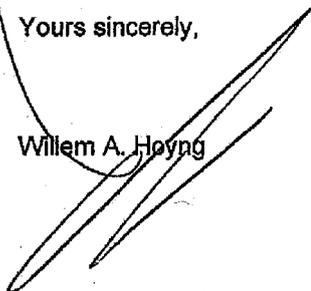
Dear Sirs,

Herewith I send you the observations of EPLAW.

Thank you for taking these in consideration.

Yours sincerely,

Willem A. Hoyng



## EUROPEAN PATENT LAWYERS ASSOCIATION (EPLAW)

### COMMENTS ON THE GREEN PAPER ON THE REVIEW OF COUNCIL REGULATION (EC) No 44/2001 ON JURISDICTION AND THE RECOGNITION AND ENFORCEMENT OF JUDGEMENTS IN CIVIL AND COMMERCIAL MATTERS (COM (2009) 175 FINAL, OF 21.04.2009)

#### I. EPLAW

EPLAW is an Association of experienced patent litigation lawyers in the European Community. It has rendered opinions regarding the future European Patent Court system and the Community patent. It has also submitted a statement regarding the Case C-403-GAT v. LUK<sup>1</sup>, before the judgement (July 13, 2006) had been rendered and after the Advocate General Geelhoed handed down his opinion (September 16, 2004)<sup>2</sup>.

#### II. Question 4

In the Green Paper, the Commission submits the following "Question 4" to the interested circles:

*What are the shortcomings in the current system of patent litigation you would consider to be the most important to be addressed in the context of Regulation 44/2001 and which of the above solutions do you consider appropriate in order to enhance the enforcement of industrial property rights for rightholders in enforcing and defending rights as well as the position of claimants who seek to challenge those rights in the context of the Regulation?*

EPLAW, in this statement, wants to comment only on that Question.

#### III. Amendments discussed in the Green Paper

1. The Green Paper refers to the present plans for a European Patent Litigation System for European patents and Community patents. EPLAW, from the start, has supported these initiatives, addressing, however, certain questions, which still must be solved in order to render the system ready and suitable for practice, notably a high quality of the judges of the system and the right for representation, before the future courts, for lawyers who have a broad legal education and, thus, are able to support these courts in the great variety of material and procedural legal rules to be applied.

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<sup>1</sup> [2007] ECR I-6509

<sup>2</sup> See EPLAW's Website "Resolutions" and "Yearbooks 2006-2008"

2. The Green Paper, in No. 4 para 2, raises the question, whether and how the communication and interaction between the courts seized in parallel infringement proceedings could be strengthened.

EPLAW is of the opinion, that there is no need for an express rule in Regulation (EC) No. 44/2001, since the parties themselves (at least the defendant) will inform the court about parallel proceedings not only regarding infringement, but also regarding validity.

3. The Green Paper, next, raises the question, whether is advisable to exclude the application of the rule on *lis pendens* in case of a negative declaratory action started before a (positive) infringement action in another member state. The ECJ has accepted the application of this rule in such circumstances.

Contrary to this practice of the ECJ, in the majority of the member states the "later" positive infringement action has prerogative over an earlier negative declaratory action.

EPLAW is of the opinion, that an express rule in Regulation (EC) No. 44/2001 changing the practice of the ECJ is recommendable. The legal interest of the defendant to start a negative declaratory action is based only on the fact, that the patent owner has not yet submitted the question of infringement to the courts. Once the patent owner has started a positive infringement action, such a legal interest on the side of the defendant ceases to exist. Since, according to the practice of the ECJ, all national courts are deemed to have the same quality, the defendant is not deprived of a right to be protected, if he is forced to cancel his negative declaratory action and to submit his arguments to the court seized with the positive infringement action. Such a rule would also be useful against "Torpedo"-practices.

4. The Green Paper, then, refers to several (other) solutions to counter "Torpedo"-practices. EPLAW follows the opinion expressed in the Green Paper that the problems may be dealt with by the creation of a unified patent litigation system. Presently, there seems to be no need for changes in this respect other than that advocated under III. 3. above.

5. The Green Paper, next, refers to the problem of a consolidation of proceedings against several infringers of the European patent where the infringers belong to a group of companies.

EPLAW proposes an amendment to Art. 5 of the Regulation (EC) No. 44/2001 to the effect, that, in a patent infringement action, the action may be brought against an enterprise deemed to infringe a European patent in a member state, where a patent

infringement action relating to the same European Patent against another enterprise, belonging to the same group of companies (parent-, daughter-, sister-relationship, to be defined in the Regulation) as the first-mentioned enterprise, has been started (consolidated action). Such an amendment seems to be necessary because of the decision of the ECJ the case *Roche v. Primus*<sup>3</sup>.

The amendment would save the patent owner the burden of having to start infringement proceedings, regarding the same European Patent, in a plurality of member states.

The proposed rule should not be restricted to cases of a "coordinated policy" relating only to the seat of a defendant who is "coordinating the activities or otherwise having the closest connection with the infringement". The counter-argument that this may lead to forum shopping, is not convincing, since the patent owner already at present has the right to start the infringement proceedings against each of the companies of the "Group" in any forum available thus forcing the "Group" to join arguments against the actions at least behind the scenes. Moreover, under the practice of the ECJ, the courts of all member-states are deemed to have the same quality.

#### IV. Proposed change of Art. 22 (4) Regulation (EC) No. 44/2001

6. Art. 22 (4) of Regulation (EC) No. 44/2001, according to which the courts have exclusive jurisdiction regardless of domicile, following the English text, reads as follows:

*in proceedings concerned with the registration or validity of patents: The courts of the Member State in which the .... registration has been applied for, has taken place or is under the terms of a Community or an international convention deemed to have taken place.*

The English text of this rule differs from the German text which, in the material of parts, has the following wording:

*Klagen, welche die Eintragung oder die Gültigkeit von Patenten.... zum Gegenstand haben*

The French text has the same wording ("*pour objet*")

That the English text is containing an error in translation is clearly shown by Art. 22 (2) and (3) which, in the English text, contain the words:

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<sup>3</sup> Critical review regarding that decision in: *Kur*, IIC 2006, 844 ff.

*In proceedings which have as their object...*

7. Despite this clear case of wrong translation, the ECJ in the case C-403<sup>4</sup>, following the English text, has extended the scope of application of Art. 22 a (4) to a case, where the validity issue was raised only incidentally, as an argument against infringement, not in an action (or counter-action) for revocation.

8. The decision of the ECJ has been unanimously criticized<sup>5</sup>.

The argument of the ECJ, that the national courts of the registration are best suited to apply their own national law, is not convincing, since, in the field of patent law, the national law has been harmonized to a high degree and since, where European patents exist that are governed by the European Patent Convention, the rules regarding registration and validity in all contracting states are the same<sup>6</sup>.

The second argument of the ECJ, that the issue of patents necessitates the involvement of the national administrative authority, would be relevant for the *actus contrarius* only, if the plaintiff would seek the invalidation of the granted patent which is not the case, if the argument is only raised as an incidental question.<sup>7</sup>

The third argument of the ECJ, that, allowing for a non-validity argument (without raising an action or a counter-action for invalidity), would multiply the jurisdictions and undermine the predictability and legal certainty, is not convincing, since Court judgements on validity arguments, even if raised only incidentally, usually are well known in the technical field of the patent. Regarding legal certainty the ECJ, in constant practice, is of the opinion, that all national courts have the same quality.

9. In consequence of the ECJ decision in *GATv. Luk*, the majority of national courts today is of the opinion, that infringement actions on European patents in other states become inadmissible as soon as the invalidity of the patent has been asserted, even if only in the way of a defence argument.<sup>8</sup>

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<sup>4</sup> [2007] ECR I-6509, para 22

<sup>5</sup> *Heinzel/Roffaël*, GRUR Int. 2006, 787/791; *Kur*, 37 IIC (2006), 844/848; *Bukow*, Festschrift *Schilling* (2007), 59/66; *Adolphsen*, IPRax 2007, 15/18; *Kubis*, Mitt. 2007, 220/223; *Torremans*, 29 EIPR (2007), 195; *Bisschop*, Mitt. 2007, 247/249; *Warner/Middlemiss*, 28 EIPR (2006), 580; *Grabinski*, *Liber Amicorum Joseph Straus* (2008), 565/568

<sup>6</sup> *Grabinski*, 568

<sup>7</sup> *Grabinski*, 568

<sup>8</sup> Overview: *Grabinski*, 570

10. Only in the Netherlands, the Hoge Raad has decided, that the infringement court does not loose jurisdiction regarding the infringement claim, even if the validity of the patent is challenged by the defendant in whatever way. The court, according to the Hoge Raad, is at liberty to stay the infringement proceedings until the judgement has been rendered by the court in the country of registration, but only if the claimant wishes to do so.<sup>9</sup>
11. Taking into account, that interim injunctions regarding a European patent in another member state may still be granted by a court not being a court of the "country of registration"<sup>10</sup>, the arguments of the ECJ seem to be even less convincing.
12. The European Max Planck Group for Conflicts of Laws in Intellectual Property (CLIP) has proposed a new rule for Art. 22 (4), combining all alternatives presently existent in this rule<sup>11</sup>. In a subparagraph (b) this Group has proposed the following wording:

*(b) The provisions under lit. (a) do not apply where validity or registration arises in a context other than by principle claim or counter-claim. The decisions resulting from such proceedings do not affect the validity or registration of those rights as against third parties.*

13. EPLAW supports a rule to that effect, whether within the present wording of Art. 22 (4) or within a reworded version such as proposed by CLIP. Such a rule would greatly reduce parallel litigation in EU member countries and save the courts, the patent owners and the possible defendants time and money.

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<sup>9</sup> for a discussion: *Grabinski*, 571 f.

<sup>10</sup> *Grabinski* referring to the practice in the Netherlands and in Germany

<sup>11</sup> *Torremans*, 29 EIPR 2007, 195; *Grabinski*, 570