

French Supreme Court embraces crossborder injunctions

In a decision of 29 June 2022 in a case between the French company Hutchinson which owns an EP patent (EP 340) in among others France, the UK and Germany and a UK company, a South African company and two French companies the Supreme Court overturned a judgement of the Court of Appeal of Paris which denied a crossborder injunction.

Facts of the case: Hutchinson is a French patentee owner of an European Patent in France and Germany and the UK.

The South African company, Global Wheel, delivers products to the UK company Tyron Runflat Limited which in turn sells the product to two French companies Dal and L.A. VI.

As the French companies also sold in the UK and Germany just like the UK company (the case dates from before Brexit) this is exactly the Solvay-Honeywell scenario and it can only be seen as a surprise (or unwillingness) that the Court of Appeal of Paris did not accept jurisdiction for the infringements in the UK and Germany.

With respect to the question of jurisdiction against the (non EU) South African company national French law is applicable (Art. 6 under 1 Bx Regulation). Art. 14 of the French Code in Civil Procedure states that the French court is competent if the plaintiff is French and there is a link with the forum in France (“un lien de rattachement de l’instance au territoire français”) or on the basis of the requirements of the good administration of justice. The Court of Appeal denied this but the Cour de Cassation ruled that (also) this was wrong.

This is a clear sign to the lower French courts that it should stop with finding all kind of excuses for refusing crossborder decisions with respect to patents.

It should be noted that no invalidity defence was raised by the defendants. The question what to do with such defence in main proceedings is open. In the past in the UK the court dismissed in such situation the whole case because of lack of jurisdiction (re: Coins Control). In the Netherlands the plaintiff is offered the possibility to withdraw the crossborder claim or have the case suspended until there is a decision in (foreign) invalidity actions. Another, more practical, proposed solution is that if the defendant does not start invalidity proceedings in the foreign countries within three months the infringement case will resume. However, this can all be avoided if the case is about a provisional or preliminary injunction. In that case the court can deal (on a provisional basis) with the validity of the foreign patents (see Solvay-Honeywell).

It is noted that under the UPC invalidity can only be raised by way of counterclaim. Such counterclaim with respect to the invalidity of EP’s for countries which are not UPC countries has to be dismissed as the UPC has no jurisdiction. However, the court could grant a conditional

injunction which will cease if and when the foreign court declares the patent invalid (see Rule 118 sub a of the Rules of Proceedings which in my view should also be applicable in this type of crossborder case). It is clear that the court should only grant such conditional injunction if it is of the opinion that there is no reasonable not to be ignored possibility that the foreign patent(s) is (are) invalid (compare ECJ re Solvay/Honeywell).

I think that this question can be dealt with in the infringement case as it is a defence with respect to the question whether or not a conditional injunction should be granted and does not ask the court to give a binding decision with respect to the validity of the foreign patents.

Of course also the UPC can grant preliminary injunctions (see art. 62 UPCA and Rules 205 and following).

As to some of the crossborder possibilities under the UPC see my article in the Van Nispen Festschrift¹.

Finally in a recent (after Brexit) case (Boston Scientific vs Cook) the UK Court issued an ex parte anti anti-suit injunction preventing Boston Scientific to ask the Dutch court for anti-suit injunction preventing Cook to ask the UK court to forbid Boston Scientific to ask the Dutch Court for an injunction extending to the EP valid in the UK. Boston Scientific withdrew thereafter their request for an injunction also covering the UK.

¹ Attached.