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Cross-Border Injunctions – A French Perspective

1. The phenomenon of globalisation affected patents even before it reached the economy as a whole. The fact that the market for an industrial invention extends beyond the boundaries of a given State is at the very heart of international developments in this field, starting with the Paris Convention of 1883.¹ This phenomenon has become even more pronounced in recent years.² Indeed, although patents and other forms of industrial property have come about in response to this increasing globalisation, historically speaking such rights are intrinsically linked to the principle of territoriality. In order to cater for a multinational need we have seen the creation of instruments, and, more generally, national industrial property rights resulting from privileges granted by the ruling authorities at any given time, the scope of which corresponded to and still corresponds to the territories over which these authorities were able to confer the benefit of such rights. This is how the principle of territoriality of industrial property was born.³

2. This contradiction has brought about responses that have been broadly developed in the field of *obtaining* patents. The unification of patentability requirements and then application, examination and even

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1 J.P. LADAS, "International Protection of Industrial Property" (Éd. de Médecis 1933); M. PLAISANT, "Treaty of International Conventional Law Relating to Industrial Property" (Libr. Sirey 1949); Y. PLASSERAUD & F. SAVIGNON, "Genesis of Unionist Law" (Litec 1983).

2 "Indeed, over the last century, the development of national patent law has been intrinsically linked to the considerable upheavals that have marked the international history of inventions. For more than one hundred years, the need to ensure the preservation and marketing of industrial inventions beyond the boundaries of a national territory has become more pronounced and is restricted by the very principle of patents that, by their origin, are linked to the decision of a public authority. Even before transport and the effects of trade reach the sphere of international legal intervention, industrial property has succeeded in doing so." J.M. MOUSSERON, "Patents Treaty", Vol. 1: "Granting of Patents", point 56, at 53 (No. 30, Coll. CEIPI, Litec 1984).

3 R. PLAISANT, "The Principle of Territoriality of Patent Law in the Common Market", in "Patents and Trademarks with respect to Competition Law in Europe and the United States" 111 *et seq.* (Colloque Brussels 1967, Presses Univ. Brussels 1968); J. AZÉMA, "Free Movement of Goods and Intellectual Property Right", J.Cl.Conc.conso., Issue 490/1989.

grant procedures by the Strasbourg, Washington and Munich Conventions constitute the major milestones in this field.⁴ Suffice it to look at the success of these international procedures to measure the extent of the need to which they respond.⁵

3. These developments are less marked in relation to the *exploitation* of such rights.

4. As far as their *exploitation with regard to third parties* is concerned, contractual techniques and the possibility open to negotiators to submit agreements covering patents of different "*nationalities*" to a single law and thus avoid the "*fragmentation*" that characterised the treatment reserved for such patents under certain case law and doctrines still only 20 years ago now enable such patents to be submitted not only to a common micro-law – contractual provisions as a whole – but also to a macro-law, even if only of a national nature, as international conventions have paid no particular attention to these agreements, at least no more so than national legislation relating to industrial property.⁶

Intercepting problems relating to patents covering the same invention on distinct national territories at their very outset, either in the agreement that gives rise to such patents or that governs their implementation, has enabled many situations to be settled, some of which border on exploitation problems and relate to the right to the patent, for example. Accordingly, French case law has had no great difficulty in admitting that the French law relating to employees' inventions applies to all patents covering the same invention under the same employment agreement governed by French law.⁷ For similar reasons, the French courts admit that a French ruling delivered by a French court applying the *lex fori* to a claim in title invoking a contractual or even criminal offence can decide on the rights to the parallel patents covering the invention encroached in different national territories. This ruling, however, does not go so far as to enable national courts to give instructions to foreign

4 *Ibidem*, point 58 *et seq.*, at 56 *et seq.*

5 According to the latest statistics established in 1994, out of 86,894 patent applications for France: 16,030 were for national applications, 32,762 for PCT applications and 38,093 for European applications (1995 Dossiers Brevets 1).

6 The application of the Brussels Convention, presented hereinafter, to disputes over contractual agreements has been the subject of some case law. In litigation about an agreement for the exploitation of a French patent, the Brussels Convention enabled a German defendant to have the French courts declared noncompetent, granting jurisdiction to the Swiss courts of the defendant's domicile; the exception provided for by Arts. 16(4) and 2 of the Convention should be interpreted restrictively (Paris District Court, 29 January 1988, 1988 PIBD 436.111.277, 1988 Dossiers Brevets V, 9).

7 J.M. MOUSSERON, "Employee Inventions", point 232 *et seq.*, at 145 *et seq.* (No. 39, Coll. CEIPI, Litec 1995).

administrative authorities, for example, to change the name of the holder of the patent in question on their registers. Nonetheless, the loser of such an action in title may be ordered, subject to a fine, to undertake proceedings for the purpose of obtaining this end with the foreign authorities.⁸

5. However, the problem of *exploitation in regard to third parties* remains, *i.e.* the problem of infringement law.

6. The law governing *acts of infringement* still respects the aforementioned principle of territoriality of industrial property.⁹ A quick look back to the difficulties posed by the complex constructions employed in the last modifications to the Luxembourg Convention in relation to infringement of Community patents reminds us of the strong attachment to the principle of territoriality of patents.¹⁰ The act of infringing a patent, whether such results from an international application or even from a European grant,¹¹ is accordingly subject to the national law of the State in which the act of infringement occurs. It may sometimes be difficult to determine this State, notably when the act of infringement presents some cross-border characteristics. It should be noted in this respect that French law allows the joinder of actions for the recognition and penalising of infringement through introduction when the exporter

8 "It is established that the action in title may concern both French and foreign patents covering the infringed invention, subject to the national law and the intervention of the judicial authority of the State to which the foreign patents in question belong" (Paris District Court, 5 July 1995, 1995 PIBD 600.III.557) Likewise: Paris District Court, 12 May 1993, 1993 PIBD 551.III.547, 1994 Dossiers Brevets 1.2 confirmed by Paris Court of Appeal, 17 May 1995, 1995 PIBD 592.III.347, 1995 Dossiers Brevets IV.8.

9 Nonetheless, the doctrine of "the exhaustion of a right" conferred by a patent or a trade mark reflects the success with this rule of the community principle of free movement of goods within the European Union fixed by Arts. L.613-6 and L.713, Intellectual Property Code. V.G. BONET, "The Exhaustion of Intellectual Property Rights", in "The Future of Intellectual Property" 89 *et seq.* (IRPI Colloque 1992, Litec 1993); "Industrial Property and Free Movement of Products in the EEC", *Gaz. Pal.*, 25 March 1994, at 5; B. CASTELL, "The Exhaustion of Intellectual Rights in German, French and Community Law" (PUF 1989).

10 *Cf.* D.P. LACHAT, "The Competent Judge in the Field of Infringement of Community Patents" (Doctoral thesis, Strasbourg 1975); CEIPI, "Infringement of Community Patents" (CEIPI Coll. Strasbourg 1976), 1977 PIBD Special No. and Luxembourg Agreement of December 15, 1989, JOCE L 402 of 31 December 1989.

11 European Patent Convention of 5 October 1973 on the Grant of European Patents, Art. 2(2), which states that in each of the Contracting States for which it is granted, the European patent has the same effects and is subject to the same legal system as a national patent granted in this State, unless otherwise stated in the Convention.

of products infringing third party rights "pushes" the merchandise that the French importer "pulls".¹²

7. The same principle of territoriality of industrial property appeared to apply to *patent infringement actions*. As a result of work carried out by Pouillet and R. Plaisant,¹³ the solution was set forth by the French group of the IPPA, almost 40 years ago and undoubtedly before the Brussels Convention: "Any infringement of a French industrial property right is necessarily committed in France; accordingly, the French courts always have jurisdiction. The jurisdiction of the French courts excludes that of any foreign courts in relation to France and prevents enforcement of a foreign judgement in France."¹⁴

Abroad, some doctrinal opinions have excluded the need for such solutions.

The last extensive study on the question was carried out by M. Vivant:

Accordingly, in our opinion the fairest solution would be to introduce the distinction made by Ostertag between an action for impairment of title and an action for relief (P.I.1942.113). In the first case, the infringement action would fall under the exclusive jurisdiction of the national courts, but not in the second... On this basis, the action for infringement loses any sense of originality. All that is in issue is obtaining a sum of money ... "validating a debt ... and not obtaining recognition of an industrial property right" (*R. Plaisant*, "Rules of Conflict in Treaties" 192).¹⁵

It would seem that such a rule, at least certain aspects of it, is being questioned by the case law currently in formation. This case law can be considered as European since it is based on European texts and is characterised by the dual influence of both Dutch and French courts. We should pay particular attention to the reversal of roles, since the French courts are being seized to hear infringement actions, the outcome of which will call for the intervention of the Dutch courts for enforcement and, in certain extreme cases, the courts of other States within the European Union, followed perhaps by States outside the Union which are necessarily affected by this type of problem. It is useful to analyse both the content (I) and the scope (II) of this European case law in formation.

12 On the case law in this respect, *cf.* J.M. MOUSSERON, "Law of 1968-1978-1984-1990: Case Law 1969-1995", 1995 Dossiers Brevets V, point 104.

13 E. POUILLET, "Technical and Practical Treaty for Patents and Infringement", point 832, at 953 (5th ed. 1909); R. PLAISANT, "Rules of Conflict in Treaties" 180 (Doctoral thesis, Paris 1946).

14 REIBEL-PLAISANT, "Report", 1958 IPPA Directory 200. In this respect, after the Brussels Convention: J.M. MOUSSERON, comment under Paris District Court, 10 May 1971, 1972 JCP (C.I.) 10818. *Cf.* case law cited by M. VIVANT, "Courts and Patent Law" point 196, at 196, notes 88 to 71. (No. 10, Coll. CEIPI, Litec 1977).

15 M. VIVANT, *supra* note 14, points 217 and 216, at 199 and 198.

I. Content of European Case Law in Formation

8. The basic rule affirms the principle of territoriality of industrial property and confirms the exclusive jurisdiction of the courts in the State where the offence is committed to hear infringement actions brought to restrain or sanction such offence. This clashes with the construction of the Brussels Convention of 27 September 1968 on the Jurisdiction and Enforcement of Judgements in Civil and Commercial Matters which was extended by the Lugano Convention of 16 September 1988, with the same title and, practically the same content.¹⁶

9. Both international conventions are widely applied in a whole host of other sectors and, as their title indicates, provide for problems relating to the jurisdiction of the ruling court (A) and the *exequatur* of the enforcement court (B).

A. Jurisdiction of the Ruling Court

10. The jurisdiction of the courts of one of the Contracting States in disputes relating to patents and other industrial property which concern other States results from a principle, the scope of which has now been limited by many exceptions (1) and which were quick to be asserted yet slow to be applied (2).

1) From Principle to Exception

11. As the national law of the State where the act of infringement was performed was mandatory, similarly the only competent jurisdiction was that of the State where this act of infringement was committed.¹⁷ This

16 G. DROZ, "Jurisdiction and the Effect of Judgements in the Common Market" (study of the Brussels Convention of 27 September 1968) (No. 13, *Bibl.dr.int. privé*, Libr. Dalloz 1972); H. GAUDEMET-TALLON, "The Brussels and Lugano Conventions" (LGDJ 1993).

17 After observation of the situation prior to the entry into force of the Brussels Convention, Lagarde noted: "To summarise, before the entry into force of the Brussels Convention, I note that the French courts held that they had exclusive jurisdiction to deal with an action for infringement of a French patent; this is debatable but is borne out by case law and they might also recognise their possible jurisdiction to entertain actions for infringements of foreign patents ... I have found a certain number of judgements, relating to both trade marks (Seine District Court, 2 April 1963, 1964 *Clunet* 321, comment by SIALELLI) and patents (Lyon, 19 February 1931, 1933 *Ann.* 291). The most recent is a judgement of the Paris Court of Appeal, 4 May 1971 (1974 *Rev. Crit. Dr. Int. Privé* 110, with the extremely important comment by G. BONET) that states: "The granting of a patent is an act of concession emanating from public authorities whose intervention determines, in private international law, the solution to conflicts in such matters... A public service ... which may only operate in accordance with the (Contd. on page 889)

led to serious consequences with regard to the difficulty, the length, the dispersion and consequently the cost of such actions.

12. The question raised is whether this principle has been impaired by the European judicial machinery arising from the Brussels and Lugano Conventions and, more particularly, in the affirmative, when the national courts of one of the Contracting States can have jurisdiction over acts of infringement committed in the territories of other States of the European Union.

13. The answer lies in a text that has aroused little interest on the part of industrial property lawyers, the aforementioned Brussels Convention. Indeed, Art. 2 of the Convention sets out the basic jurisdictional rule: "Subject to the provisions of this Convention, persons domiciled in a Contracting State shall, whatever their nationality, be sued in the courts of that State". Article 5 of the same text sets out an additional jurisdictional rule: "A person domiciled in a Contracting State may, in another Contracting State, be sued... 3) in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred."

Accordingly, this establishes an alternative system of jurisdiction, and the holder of several patents covering different States in the European Union who is a victim of dispersed acts of infringement can bring differ-

(Contd. from page 888)

laws that institute the same, the disputes arising from this operation when a French patent is granted, are necessarily subject to the jurisdiction of French courts that ensure the preservation of national public order, which prevails over all other considerations... Accordingly, this court has jurisdiction to rule on the infringement of the invention which is to be protected by virtue of a patent issued by concession of the French State.'

This decision has been criticised, quite rightly in my opinion, by the only commentator to my knowledge who has given it any attention. It has been criticised, firstly for having confused 'invalidity' and 'infringement', as the grounds are exactly the same as those of the decision of the Supreme Court in 1936 and that of the Paris Court of Appeal in relation to invalidity; it has also been criticised for having confused the notion of 'public policy' and the notion of 'operation of a public service'. According to the entirely dominant and traditional conception, public policy is a mechanism that opposes the application of foreign laws which are judged to be inapplicable in a given State. It is not a mechanism for grounding jurisdiction" (V. BATIFFOL & P. LAGARDE, "International Private Law" 380, note 30^{bis} (Vol. II, 5th ed.) ("Application of the Enforcement Convention to Actions for Infringement of National Patents", "International Law and Actions for Infringement of Patents in the EEC" (4th Ind. Prop. Coll. Nice 1974, 1974 PIBD, special number, at 42, 44).

ent actions before the courts of the States where he suffers infringement. He may also bring one joint action before the courts of the State where the alleged infringer is domiciled.¹⁸

14. The Convention remains silent on the specific question of exploitation of intellectual rights and this could have posed a problem, thus begging the question of the general nature of the rules set forth therein. However, this is not the case, insofar as Art. 16 of the Convention, which relates particularly to industrial property disputes, grants certain courts exclusive jurisdiction, regardless of domicile:

The following courts shall have exclusive jurisdiction, regardless of domicile...

4) In proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Contracting State in which the deposit or registration has been applied for, has taken place, or is under the terms of an international convention deemed to have taken place.

This solution must be reconciled with the stated exceptions, notably “in proceedings which have as their object rights in rem in immovable property or tenancies of immovable property” where only the “courts of the Contracting State in which the property is situated” have jurisdiction.¹⁹ The solution is inspired by the line of thought developed in private international law in relation to the submission of patent problems to the *lex rei sitae*.²⁰ The first strand of the exception also includes the consideration of entries on public registers.²¹

What is most important to note is that, on the one hand, the question has been considered and that no gap or even tacit reservation is to be found in the Brussels Convention on this subject and that, on the other hand, it is not a general exception and it does not cover all aspects of industrial property rights (especially not literary or artistic rights), but concerns only proceedings concerned with the “registration or validity of patents, trade marks, designs or other similar rights...” The result of this is that any problems outside the scope of these strict domains escape

18 *A priori*, in the authors' opinion there is nothing to stop him from combining both possibilities, grouping certain claims before the courts of the defendant's domicile or those of one of the infringement territories, whilst maintaining other actions before courts of other infringement territories.

19 On the agreement of national rules in this respect, *cf.* G. DROZ, *supra* note 16, point 157, at 105 and note 1 *et seq.*

20 M. VIVANT, “Courts and Patent Law”, *supra* note 14, point 255 *et seq.*, at 238 *et seq.*; “The Brussels Convention of September 27, 1968 applied to Industrial Property”, 1989 Dossiers Brevets IV and J.-Cl. Brevets, Issue 560/1992 “International System”.

21 G. DROZ, *supra* note 16, point 157, at 105.

the exception²² and consequently remain governed by the basic jurisdictional rules set forth in Arts. 2 and 5 of the Brussels Convention. Indeed, it was clearly stated in the Jenard Report that: "For other actions, including patent infringement actions, the general rules of the Convention are applicable".²³

This has met with the approval of other commentators: "The rules of Art. 16 are only applicable in relation to registration and validity. Any other action, especially actions for infringement and unfair competition, shall remain within the scope of the general rules of the Convention." ²⁴

Therefore, it is clear that the simple presence of a patent in a dispute is not enough to exclude the intervention of a foreign jurisdiction which the normal machinery of the Convention leads to.²⁵

15. Consequently, several situations may arise:

- An act of infringement has been committed by a single tortfeasor. In this instance, the patentee has the choice (if such are different) between the courts of the domicile of the tortfeasor and the courts of the State where the act of infringement has occurred:

We should take into account the provisions of the Brussels Convention of September 27, 1968, which does not provide for rules contrary to the common law in relation to infringement. As soon as the conditions for the application of this convention are met, the action may be brought before the courts of the State where the tortfeasor is domiciled, which may be abroad.²⁶

- An act of infringement has been committed by more than one tortfeasor. In this instance, the patentee has the choice (if such are differ-

22 The European Court of Justice in Luxembourg has construed the derogation provided for in Art. 16 strictly and refused to apply it to a dispute over the right to an existing patent (15 November 1983, case 288/82 Vol. No. 3, 663).

23 C. JENARD, "Fundamental Principles of the EEC Convention on Jurisdiction and the Enforcement of Judgements", 1973 JCP I, 2593; S. LACHAT, "Jurisdiction in the Field of Patent Infringements in the EEC", 1974 JCP (CI) 11 484; M. VIVANT, *supra* note 14, point 185 *et seq.* at 166 *et seq.*

24 G. DROZ, *supra* note 16, point 161, at 106. On 3 January 1987, the Paris Court of Appeal restated, in relation to a contractual dispute, the limited character of the exception: "Article 16(4) of the Brussels Convention which confers exclusive jurisdiction upon the courts of the Contracting State in which the deposit or registration has been applied for is contrary to common law and must be interpreted restrictively." (1987 PIBD.412.III.196, 1988 Dossiers Brevets 1.1). *See also* Paris Court of Appeal, 29 January 1988, 1988 PIBD III. 277.

25 M. VIVANT, *supra* note 14, point 188, at 168 and notes 91, 92.

26 J. SCHMIDT-SZALEWSKI & J.-L. PIERRE, "Industrial Property Law", point 186, at 83 (Litec 1996).

ent) between the courts of the domiciles of the tortfeasors and the courts of the State where the act of infringement has occurred, *i.e.* the State of issue of the patent. Indeed Art. 6(1) of the Convention states: "A person domiciled in a Contracting State may also be sued where he is one of a number of defendants in the courts for the place where any one of them is domiciled".

- Several acts of infringement have been committed by a single tortfeasor in different countries. Lagarde observes:

In application of these texts, the tortfeasor who is domiciled in a Contracting State and who has committed an infringement in several States of the Union may be sued for infringement in the courts of his State of domicile, irrespective of the Contracting States in which his acts of infringement have occurred, or in the courts of one of the States where the act of infringement has been committed. The dissociation of infringement claims is in issue and may (must) be excluded.

First of all, the patentee may sue the tortfeasor in a court of the State of his domicile. This is the rule provided for by Art. 2 of the Convention. In this case, the court has jurisdiction to entertain all the acts which the infringer is accused of, irrespective of the State in which they have been committed and irrespective of the patent which has been infringed. Accordingly, in this case if, after having seized the court of the domicile of the tortfeasor, the patentee changes his mind and decides to institute proceedings in one of the States where the infringement has occurred, the jurisdiction of this court may be excluded.

The other possibility open to the patentee is to commence proceedings, not before the court of the tortfeasor's domicile, but before the court of one of the States where an act of infringement has been committed. In this case, the first court which has been seized, for example a Dutch court, since there has been an infringement in the Netherlands, may only entertain the acts of infringement which have been committed in the Netherlands. However the infringement which has occurred in Germany or France, does not, customarily, fall within the jurisdiction of the Dutch court as the Dutch court only has jurisdiction in its capacity as the court of the State where the tort has been committed and thus simply as a court ruling upon an action for the infringement of the Dutch patent. Accordingly, if the patentee commences proceedings in a State where an infringement has taken place and then subsequently decides to bring his case either before a court of another State where an infringement has taken place or before a court of the defendant's domicile, it will not be possible to exclude the jurisdiction of the second court, since the first court does not have jurisdiction over all the claims. In practical terms, this observation demonstrates that there is no point in a patentee bringing an infringement action in one State so as to obtain a ruling on infringements committed in another State.²⁷

²⁷ P. LAGARDE, *supra* note 17, at 47.

- Several acts of infringement have been committed by more than one tortfeasor: a combination of the preceding rules enables the patentee to commence proceedings before the court of the domicile of one of these tortfeasors for all the infringement claims. In this respect it is useful to refer to the *Fiona Shevill* judgement delivered by the European Court of Justice on 7 March 1995 (1996 D.61, G. Parleani, comment).

In this case it was held that when several acts of infringement have been committed by one or more persons in several States, a court that only has jurisdiction by virtue of the sole fact that it is one of the courts where one of the harmful events has occurred (Brussels Convention, Art. 5(3)) may only rule upon the harm caused in the State to which it belongs: it may not rule upon the harm caused in the other States. Furthermore, this solution is expressly provided for by the protocol on the Settlement of Disputes appended to the Community Patent Convention and the Community Trade Mark Regulations.

It is even possible that the European Court of Justice was influenced by the first of these texts since it was cited by Attorney General Darmon in his submissions on the *Fiona Shevill* case. Accordingly, this case law limits forum shopping by barring the more or less artificial institution of proceedings before a court which is somewhat peripheral to the objective centre of gravity of an international dispute.

However, bad practices are sometimes difficult to curb and people have already started to try and get around the *Fiona Shevill* judgement by invoking Art. 6 of the Brussels Convention (more than one defendant) and grouping the entire multinational claim before the court of the plaintiff's choice.

Such excesses are to be treated with caution: it is not unimaginable for defendants to be cited before a court for the sole purpose of justifying its jurisdiction. In order to avoid such abuse there should be a requirement for a certain connection to exist between the claims made against the different defendants: Is there an objective link between the acts which they are accused of? Are they liable to be considered as joint tortfeasors of the same tort? Is there any risk of bringing about incompatible judgements?

And if this objective link does exist, does it enable the formulation of any claims whatsoever – not necessarily connected claims – against the defendants being sued before a single court? Take the case of a French manufacturer of a product that is alleged to infringe a patent; he sells the product to different distributors, for example in Italy, Spain, the UK and the Netherlands. Naturally, the patentee may sue the Dutch distributor before The Hague District Court (Art. 2, Brussels Convention). He

may probably also be able to sue the French manufacturer before the same court (assuming that in Dutch law, the latter may be held liable for the infringement of the Dutch patent), pursuant to both Arts. 5(3) and 6(1). But once the French defendant has been sued before the Dutch court, can the plaintiff make any claim against him on the grounds of the infringement of the Italian, Spanish and British patents?

This problem has been the object of considerable debate before the Dutch courts and the matter has been referred to the European Court of Justice for an interlocutory ruling by the English Court of Appeal (27 October 1997, *Fort Dodge Animal Health Ltd v. Akzo Nobel BV* – this issue at 927).

The solution is the same in the case where the different defendants are accused of distinct acts of infringement. This was the situation in the *Tie-man* case referred to hereinafter, where the manufacturer acted in the Netherlands and the importer in France.

16. Consequently, Lagarde finishes by saying:

In conclusion, we may ascertain the following:

- 1) In all cases, the plaintiff, the patentee, may always, if he so wishes, sue the tortfeasor before the courts of the State of the patent, as it is always in the State of the patent where the infringements will have occurred. Therefore, here, we have a provision which provides full cover for the patentee if he does not want his action to be tried by the courts of a State which has not issued the patent.
- 2) But also, and this is the second strand of my conclusion, it may happen that the court ruling upon the patent infringement action is a court of a State other than that which has issued the patent. This is what will happen each time the patentee institutes proceedings before the court of the State where the defendant is domiciled....²⁸

In the different cases, a problem arises in relation to the connection²⁹ established between the acts of infringement in question and the per-

²⁸ *Id.*

²⁹ Compare P. MATHÉLY & G. DROZ, “Rappr. échanges”, 1974 Coll. Nice 35-36. Lagarde tackles a particular jurisdictional problem: “There is the classic problem of the conflict between the governing law clause concluded between the plaintiff and one of his co-defendants, for example between the patentee and one of his licensees, granting jurisdiction to a particular court and the rule that gives jurisdiction to the court of the state where another co-defendant is domiciled in order to hear the case brought against the former. In this event, the French case law that should apply to infringement proceedings tells us that the rule which gives jurisdiction to the court of the state where one of the co-defendants is domiciled shall prevail over the governing law clause concluded with another co-defendant, in the event that the case brought against the co-defendant whose court has been chosen by the plaintiff and the case involving the co-defendant benefitting from the clause are indivisible.” (*supra* note 17, at 46).

sons or entities committing the infringement, for example, in the case of companies belonging to the same group.

We should consider whether the outcome is the same, which in our opinion it is, in the event different defendants are accused of distinct acts of infringement. This was the situation in the *Tieman* case set out below.

17. Contrary to our firm beliefs and despite the most eminent warnings evoked by Lagarde in the aforementioned study, infringement actions may escape the jurisdictional rules arising from the sacrosanct principle of territoriality of patents and other industrial property rights. Nonetheless, it has taken more than 20 years for the shift from assertion to application of this serious breach of the principle of territoriality to come about.

2) From Assertion to Application of the Exception

18. Until the dawn of the 1990s, we knew of no courts which had been requested to apply the aforementioned texts in the field of infringement of industrial property rights. However, there have been several recent judgements in this respect delivered by the President of the District Court of The Hague, which has national jurisdiction in the field of patents. First came *Philips v. Hemogram* (30 December 1991)³⁰ followed by a judgement of the same origin dated 7 August 1992 in the case *Tieman and Blind Equipment Europe v. KGS Corp.*, a Japanese Company and *Eurosensory* a French Company.³¹

The holder of different patents including European patent 237 090 designating, in particular, the Netherlands and France, had seen his patents infringed in both these countries. Pursuant to Dutch law, the law of one of the States in which the infringement occurred, the patentee was entitled to apply for an interim injunction to restrain the alleged tortfeasors before The Hague District Court. After two *kort gedding* procedures (summary proceedings), on 17 August 1992, the Dutch court ordered KGS, subject to a fine, "to cease offering or delivering to any third parties whatsoever (including Eurosensory) in any country whatsoever, to the exclusion of Japan, the Braille cells provided for in the basic agreement" and ordered Eurosensory, also subject to a fine, to refrain from infringing the European patent in the States which it had itself designated. The multinational character of the non-exploitation injunctions

30 District Court of The Hague, 30 December 1991, BIE, 16 October 1992, point 10, at 323.

31 District Court of The Hague (ref.), 7 August 1992, BIE, 16 December 1994, point 11, at 391. See also 5 January 1993 (*Rhône-Poulenc Rouer v. Pharmachemic*) hereafter and the District Court of The Hague, 3 February 1994 (*Applied Research System v. Organon*) and 7 December 1995 (*Chiron Corp.*) and 14 December 1995 (*Hoffmann-Laroche v. Sociétés Organon*).

delivered by the Dutch court is worthy of note. In future, we will be faced with problems relating to other sanctions in infringement cases, starting with the compensation of the patentee.

19. Therefore, a European court has responded positively to the question of whether an action relating to acts of infringement committed in different countries can be brought before the same European judge.³²

B. The “Exequatur” of the Enforcement Court

20. Consequently, problems relating to the enforcement of such judgements in the States in question have come about.

21. Articles 26 *et seq.* of the Brussels and Lugano Conventions deal with the *recognition* of such judgements³³ and lay down the rule: “A judgement given in a Contracting State shall be recognised in the other Contracting States without any special procedure being required”. Article 27 excludes certain judgements from this principle of automatic recognition: “A judgement shall not be recognised: 1. if such recognition is contrary to public policy in the state in which recognition is sought...”

Other exceptions are provided in the following paragraphs of the Convention but would not appear to concern industrial property matters.

22. In relation to the *enforcement* of judgements and the *Tieman* order for example, Arts. 31 *et seq.* of the Brussels Convention apply. The wording of Art. 31 is as follows: “A judgement given in a Contracting State and enforceable in that State shall be enforced in another Contracting state when, on the application of any interested party, it has been declared enforceable there.”³⁴ Article 34 continues: “The application may be refused only for one of the reasons specified in Arts. 27 and 28”. Accordingly, the French courts were only entitled to refuse to enforce the judgement of The Hague on the grounds that it was contrary to French public policy.

32 No French courts would appear to have ruled on the same problem today; however, this does not mean that such proceedings have not already been or soon will be instituted before the French courts.

33 Art. 25 of the said Convention introduces the following provisions: “For the purposes of this Convention, ‘judgement’ means any judgement given by a court or tribunal of a Contracting State, whatever the judgement may be called, including a decree, order decision or writ of execution, as well as the determination of costs or expenses by an officer of the court.”

34 The exception procedure is alleviated by the effect notably of Art. 34: “The court applied to shall give its decision without delay; the party against whom enforcement is sought shall not at this stage of the proceedings be entitled to make any submissions on the application.”

23. In the case in question, the patentees, Tieman and Blind Equipment, requested the French courts to enforce the judgement given in The Hague, and on 15 September 1992, the President of the Paris District Court ordered the enforcement of the judgement in application and approval of the Brussels Convention.

The French distributor Eurosensory took this judgement to the Paris Court of Appeal, which had jurisdiction to overrule decisions of the district court, and grounded its appeal on Arts. 36 *et seq.* of the Convention: "If enforcement is authorised, the party against whom enforcement is sought may appeal against the decision within one month of service thereof." The Paris Court of Appeal was therefore requested to overrule the enforcement order delivered by the district court or, failing this, to stay the proceedings under the terms of Art. 38 of the Brussels Convention until the Hague Court of Appeal had delivered its ruling and, finally, further, in the event the judgement of the district court was upheld, to hold Eurosensory harmless in an action in warranty up to an amount of ten million French francs.

On 28 January 1994,³⁵ by decision of the summary proceedings which made legal news in the Netherlands even before France, the Paris Court of Appeal: (1) rejected the application to stay proceedings, (2) along with the application to hold Eurosensory harmless in an action in warranty, and (3) above all upheld the enforcement order.

1) Refusal to Stay Proceedings

24. The court ruling on enforcement – in this case, the Paris Court of Appeal – was not bound to suspend proceedings pending the appeal lodged against the decision of the Dutch court as a result of the very terms of Art. 38 of the Brussels Convention: "The court with which the appeal under Art. 37(1) is lodged may, on the application of the appellant, stay the proceedings if an ordinary appeal has been lodged against the judgement in the State of origin or if the time for such appeal has not yet expired."

The conditions for the stay of proceedings would appear to be clear, but, in order to justify its refusal, the Paris Court of Appeal adopted a strict (perhaps too strict) interpretation of its capacity:

in view of the fact that the court seized of the appeal against the authorisation to enforce a judgement given in another Contracting State may only take into consideration, in its decision relating to an application to stay proceedings, elements which the appellant was not able to put before the court of the original State.³⁶

³⁵ 28 January 1994, BIE, 16 December 1996, point 12, at 355 and 1996 Dossiers Brevets I.

³⁶ With the same hostility to prolonging proceedings by granting a stay of proceedings, cf. in very different cases: Paris, 24 March 1994, 1994 PIBD 573.III.445, 1994 Dossiers Brevets I.7 and 29 September 1995, 1995 PIBD 600.III.555, 1995 Dossiers Brevets III.10.

The Court found that the elements put before the Hague Court of Appeal had already been produced before the first instance court which had ruled thereon: "Accordingly, whereas the appellant has not furnished any new elements, which it was unable to submit to the court of the original State, there is no justification for granting a stay of proceedings."³⁷

25. In our opinion, some doubt still remains as to the interpretation given by French courts in cases where proceedings may be stayed before an appeal court pursuant to the Brussels Convention.

2) Application to Hold Eurosensory Harmless in an Action in Warranty

26. The French court is very discreet as to the reasons which led it to exclude the application in warranty formulated by the Company that was alleged to have committed acts of infringement. This application was admissible as no information to the contrary was given by the Paris Court of Appeal which limited itself to excluding any "necessity to subordinate the enforcement to the constitution of a warranty by the two Dutch companies, since such a measure is not justified."

This reasoning is somewhat scanty.

3) Enforcement of Foreign Judgements in France

27. Pursuant to Arts. 34 and 27 of the Brussels Convention, the appeal court had the possibility of refusing to *enforce* the judgement on the grounds that it was contrary to public policy. Naturally, public policy is to be construed as meaning international public policy.³⁸ On this point the court held: "It is not the role of the court seized to give its evaluation as to the compatibility of the foreign judgement with the public policy of its country, but rather to verify whether or not the recognition of this judgement is liable to undermine this public policy."

28. Accordingly, the question arose as to whether the principle of territoriality of patents forms part of such international public policy. In the affirmative, exclusive jurisdiction would lie with the local courts in actions for infringement of national patents. However, a negative reply to this question results directly from the aforementioned Art. 16(4) of the Brussels Convention.

Therefore, the appellant, Eurosensory, tackled this problem more indirectly, whilst almost circumventing it in invoking two grievances against the enforcement order.

³⁷ The court goes even further: "Consequently, reasonable doubt as to the outcome of the ordinary appeal lodged in the original State does not suffice to justify any stay of proceedings."

³⁸ P. LAGARDE, "Research on Public Policy in Private International Law" (No. 15, Bibl.dr.privé, LGDJ 1959).

29. Firstly it pleaded that “French law does not allow infringement to be sanctioned or an interim injunction to be ordered by way of summary proceedings, such as the Dutch *kort gedding*.”

The court rejected this claim:

Given, in particular, that, besides the verification of the conformity of the summons, Art. 27 of the Convention does not authorise the court to control the foreign proceedings with regard to the public policy in the given State; consequently, the appellant may not rely on the fact that, in French law, an injunction may not be ordered as a result of summary proceedings.

Here again, the Paris Court of Appeal is giving its strict application to the powers granted to it by the Brussels Convention and the situations in which it may intervene.

30. The second plea related to the reversal of the burden of proof. The judgement makes no distinction between the first and second plea and makes no ruling whatsoever upon the second.

II. Scope of the Case Law in Formation

31. If we accept the doctrine arising from this case law, its practical scope can be broken down into two sets of observations relating to the classic problems in private international law concerning the jurisdiction of the ruling court (A) and the law which it is to apply (B).

A. Jurisdiction of the Ruling Court

32. By and large the problem centres around how the court ruling on infringement proceedings should respond to the defendant’s claim for revocation of the patent,

33. When the court ruling on the infringement claim is the same as that ruling on the revocation claim there are no problems in this respect. This is the case³⁹ in France where, in most infringement

39 Supreme Court (Cass. civ.), 21 January 1936, 1937 S.I. 81, comment by J.P. NIBOYET; Paris, 17 December 1969, 1971 Clunet 99, comment by A. FRANÇON; Paris District Court Paris, 27 June 1969, 1970 D. Somm. 3.

There are two strands of reasoning in support of this doctrine: the first, which we assume has been set aside, is that the national courts could apply the public policy rules of other States. For Lagarde, this is “an excessive and dangerous statement” and he goes on to recall that every day “the courts are called upon to apply mandatory laws of other countries.” “The real reason”, he continues “which explains the exclusive jurisdiction conferred upon French courts to entertain actions to declare patents invalid, is (Contd. on page 900)

cases,⁴⁰ the first response of the defendant is to counter by claiming that the patent is invalid and ought to be revoked. The French courts ruling upon the principal claim for infringement of a French patent and the counterclaim for the revocation thereof will necessarily deal with the second claim before the first without question of any stay of proceedings, as it is the same court which hears both claims.

34. However, a problem arises when the claim for infringement and the claim for revocation are brought before different courts.

35. This is necessarily the case when the court that has jurisdiction to rule on the infringement has no jurisdiction over the claim for revocation. This is so in France when an infringement claim is brought before an arbitration tribunal and the defendant responds by a claim for revocation.⁴¹ Although arbitration tribunals have jurisdiction to deal with problems relating to infringement, they do not have jurisdiction to handle claims for revocation, which must be brought before a judicial authority. This solution is clearly set out in French law, even if it is set aside in some countries and debatable, and even contested in France by different legal observers.⁴² In such a case, the arbitration tribunal is often requested to stay proceedings until the judicial authority has delivered its judgement on the revocation claim. The arbitration tribunal can adopt this solution; although in doing so, it exposes its decision to what is often the slow machinery of judicial procedure, and thus the rapidity which more often than not causes the arbitration tribunal to be chosen to judge a suit in the first place is lost. Conversely, the arbitration tribunal may refuse to stay proceedings and continue hearing the case. The

(Contd. from page 899)

that expressed by the decree of the Paris Court of Appeal, the main grounds of which I have already cited: it must not be forgotten that the appreciation of the validity of a patent calls into question the operation of the public service which has issued this patent. Therefore, in this instance, we can understand that for the appreciation of the operation of the foreign public service in the organic sense of the term, only the courts of the State of this public service can be declared competent. In the same way, for example, we would not tolerate a situation where a foreign court appreciates the validity of a French naturalisation decree for example, or the regularity of a mortgage registration made in France for a French building. This explanation should lead us to reject the idea of absolute non-competence of foreign courts to entertain actions for infringements of French patents" (*supra* note 17, at 41).

40 D. STAUDER noted this response in 80% of infringement suits, *infra* note 44, at 108.

41 J.M. BURGUBURU & J.M. MOUSSERON, "The Arbitrator in Litigation relating to Licences", 1994 Dossiers Brevets II.

42 P. VÉRON, "Arbitration and Intellectual Property?", 1994 Dossiers Brevets I.

French courts have been called upon to decide whether such a refusal to stay proceedings is lawful and the *Deko*⁴³ case provides a positive response to this question.

36. This question arises in the event of competition between two judicial authorities.⁴⁴ In this instance, what is at issue is whether, for example, the court, be it Dutch or any other – which has jurisdiction to adjudicate on the infringement of a French patent as well as a European patent designating France – or any other country – may have jurisdiction over the claim for revocation of the patents supporting the infringement action. In this respect, Art. 19 of the Convention states: “Where a court of a Contracting State is seized of a claim which is principally concerned with a matter over which the courts of another Contracting State have exclusive jurisdiction by virtue of Art. 16, it shall declare of its own motion that it has no jurisdiction.”

Upon first sight, this would appear to oblige the court ruling upon infringement to declare that an action for revocation is inadmissible since such an action would appear to be reserved for the courts of the State which issued the patent pursuant to Art. 19.⁴⁵ Nonetheless, more detailed reading of the Convention brings to light some important nuances in relation to its domain content.

37. It is interesting to look at the *domain* of the rule laid down by Art. 19, which in fact only applies if the court is seized of a claim which is *principally concerned* with the infringement.

First of all, it must be stressed that the French wording of the Brussels Convention "*à titre principal*" conveys a different, more procedural meaning than the English text "principally concerned". "*A titre principal*" is usually opposed, in procedural law, to "*à titre incident*", in order to oppose the claim brought by the plaintiff in the summons to counter-claim brought by the defendant (or even to additional claims brought by the plaintiff later in the litigation). In this respect Lagarde observes:

43 Paris, 24 March 1994.

44 In relation to national dissociation between authorities in charge of infringement and authorities in charge of revocation, cf. "Coll. of European Patents Courts", part 5, "Problems relating to Procedural Law" (Munich 1982) and, particularly, V. MANGINI, "Regulations Concerning Infringement Actions and Nullity in the Contracting States of the Convention on European Patents" and D. STAUDER, "The Legal Signification of the Nullity Procedure in Federal Germany, France, Great Britain and Italy", 1983 PIBD, special release, at 85 *et seq.*

45 P. LAGARDE states that "the weight of case law, in terms of authority and if not quantity, has confirmed the exclusive jurisdiction of French courts in proceedings concerned with the validity of French patents." (*supra* note 17, at 40 referring to Supreme Court, 21 January 1936, 1937 S.I. 81, comment by J.P. NIBOYET.

Article 19 does not cover the case where the court of a Contracting State is seized of a claim which is purely incidental to a matter subject to the exclusive jurisdiction of another court. Consequently, the inverse argument would lead us to conclude that in this event the court is not obliged to decline jurisdiction.⁴⁶

It is necessary to examine the meaning to be given to the formula “where a court of a Contracting State is seized of a claim which is principally concerned with a matter” and accordingly to decide how to qualify the response of a defendant, who, when accused of infringement, counters by invoking the invalidity of the patent. J. Foyer and M. Vivant observe:

If the way the invalidity of the patent is invoked bears all the hallmarks of a counterclaim, we would tend to consider that it constitutes a principal claim, which has simply been made in “response” to another claim for which the machinery of Art. 19 could not apply *a contrario*. If the invalidity is only invoked in defence (for example it is argued that there cannot be any infringement as there is no valid patent), then Art. 19 interpreted *a contrario* could apply. The logic of this rule constituted from an overall judicial point of view would lead us to conclude that the foreign court could only declare the patent in question to be invalid, but could not revoke it with legal effect.⁴⁷

In our opinion, the counterclaim is the usual way of obtaining the revocation of a patent and even the only procedural form, excluding the case where the said patent has already been revoked with *erga omnes* effect, which, since the 1978 reform, is equivalent to revocation.⁴⁸

38. In relation to the *content* of Art. 19, Vivant observes:

At least three interpretations may be proposed for Art. 19. The first is very probably excessive and consists in saying that the court which must decline jurisdiction when it is seized of a claim which is principally concerned with a given matter may not, conversely, decline jurisdiction when it is seized of an incidental claim. This would be a plausible argument. However, without going to such extremes, we could also simply say that the court is only obliged to decline jurisdiction when it is seized of a claim which is principally concerned with a given matter. If this is not the case, the obligation disappears – without necessarily giving rise to the inverse obligation – and the court will have to appreciate whether it could entertain the matter pursuant to Art. 16 of the Convention. This is the interpretation provided by M. Droz which has already been mentioned by the reporter and adopted by Professor Lagarde.

46 P. LAGARDE, *supra* note 17, at 50.

47 J. FOYER & M. VIVANT, "Patent Law" 61 (Coll. Thémis, PUF 1991).

48 J.M. MOUSSERON, *supra* note 2, point 1023, at 978 referring to P. ROUBIER, "Industrial Property Law" point 200, at 336 (Vol. 1, Libr. Sirey 1950) and M. KESSLER, "Infringement Actions" point 218 *et seq.* (Doctoral thesis, Montpellier 1980).

Finally, the third interpretation suggested by M. Tuppin insists less on the fact that the court's noncompetence is related to whether it is seized of a claim which is principally concerned with a given matter, but rather on the fact that this noncompetence is, in this instance, automatically proclaimed. If the court were seized of an incidental claim, it would no longer have this possibility. However it would still be bound to declare its noncompetence if this question were raised by one of the parties. Thus, there would be a kind of shift in the nature of the rule which would change from its usual nature as a community public policy rule into a rule of private interest when raised as an incidental matter. It is not sure whether this was the intention of the authors of the Convention. It is up to case law to decide upon the interpretation to be given to this Article, although it would seem that the second, by virtue of its flexibility, is most in line with European integration.⁴⁹

In the event the court in infringement proceedings admits the claim for revocation, it may "consult" the courts of the State of issue of the patent.⁵⁰

49 M. VIVANT, *supra* note 14, point 189, at 169.

50 Lagarde observes: "Convention law provides us with some serious tools. And I would like to draw to your attention a Convention of the Council of Europe dated June 7, 1968, which was ratified by France (Decree of October 11, 1972, Rev. crit, dr. Int. Privé, 1972-758), and by Belgium and which, I believe is in the process of being ratified by Germany and will soon enter into force in all the Contracting States of the Common Market and which concerns information on foreign law. This convention states that a court of a Contracting State that is seized of a claim which must be submitted to a foreign law may formulate a request for information from the official foreign authorities. This is not simply an abstract request, as the convention states (Art. 4) that the request for information must be accompanied by a description of the facts necessary for both the comprehension and the formulation of an exact and precise response; and the Convention also adds that all necessary documents may be submitted to the official foreign authority which will thus be in a position to formulate a precise response, which, naturally, will not be binding upon the court which formulated the request, but will provide it with considerable assistance. The second observation ... is that if the court seized of the infringement proceedings really does not believe that it is capable of reaching a valid decision on the preliminary questions relating to the validity of the patent, despite all the information which it has been given, I believe that the Brussels Convention may be interpreted as not preventing the court seized of the infringement proceedings from declining jurisdiction in favour of the courts of the State which issued the patent. What is certain is that the Convention does not oblige the court seized of infringement proceedings to decline jurisdiction on the interlocutory question, but it does not prohibit it from doing so. Consequently, the court is given a certain amount of discretion, and in my opinion, this is a wise solution." (*supra* note 17, at 50).

In our sectors, in practice we are witnessing requests for opinions in the field of trade marks (J. RAYNARD, "The domain of opinions", in "The Inflation of Opinions" (Colloque Montpellier 1996)).

39. In the event the action for revocation is formulated as a principal claim before another court, as well as in the event the court ruling on the infringement refuses to deal with such an action, the question arises as to whether or not it will have the right to, and whether or not it will exercise the right to, stay the infringement proceedings until the national courts of the reserved States applying their national law have given their opinion on the revocation suit. In every case, this stay of proceedings depends on the procedural rules of the court in question. For example we know that French courts must stay proceedings for the infringement of a French patent when the corresponding European patent designating France is subject to opposition proceedings before the European Patent Office. Likewise, we know that French courts may stay proceedings when the French patent upon which the infringement claim is based is accompanied by a European claim which does not designate France.⁵¹ Accordingly, in each case the question will be whether the procedural laws of the State whose national courts are solicited by the applicant in infringement proceedings provide for and impose or enable such a stay of proceedings on the initiative of the defendant who has requested revocation before another court.

If the national courts of the Contracting States know and widely practice this stay of proceedings, the introduction of a unified procedure for infringement will be immediately followed by an explosion in revocation proceedings and this initial simplification will be followed by subsequent complications. Indeed, whenever the national courts of the Contracting States are seized of claims for revocation, there is no great interest, in our opinion, in subsequently having all problems relating to infringement brought before one single court. The benefit of calling upon Dutch case law will be considerably diminished. However, the inverse attitude rejecting the stay of proceedings would have the opposite effect and justify this Dutch case law.

B. Law Applicable by the Ruling Court

40. Once the scope of its jurisdiction has been broadened, the court ruling on the infringement shall have to decide what law it is to apply. The coincidence between the *nationality* of the competent court and the applicable law required by the principle of territoriality of industrial property does not survive the extension of the jurisdiction of the court hearing the infringement case and, *a fortiori*, the claim for revocation. The scope of jurisdiction of a national court and that of the applicability of the national law of this court are no longer necessarily superimposed. Is there any need to recall that a national court may apply foreign laws?

51 Cf. cited case law in J.M. MOUSSERON, "Case Law 1968-1995", *supra* note 12, at point 128.2.

41. Firstly, regarding the law applicable to any actions for revocation that the court ruling on infringement may entertain, nobody maintains that a national court ruling on revocation can apply its own law to examine the validity of foreign patents; only the national laws of the patents in question may be applied.⁵²

The corresponding problem arises in relation to the evaluation of the infringement and how it is to be sanctioned. It is generally admitted that the law applicable to infringement is the law of the State in which the infringement has taken place. However, the French law on infringement is far from being standardised.⁵³ The court of the defendant's domicile or of one of the territories where the infringement has occurred must deal with each case (or family of cases) of infringement, each time applying the internal law of the State where the infringement has been committed.

42. This poses problems as to the dissociation of substantive and procedural laws and, more particularly, as to whether an action claiming an interim injunction to restrain infringement of a patent should be construed to fall within the scope of procedural or infringement law.⁵⁴ There are diverging opinions on this point.

Some maintain that applications for interim injunctions to restrain infringements are merely procedural steps and fall within the scope of the law of the court that is seized of the matter. If this is the case then it may come about that an interim injunction to restrain infringement of a national patent may be sought for a patent whose national law does not provide for such measures. It should be recalled that this was the case for French patents before the reform of 1984.

52 Cf. in this respect, G. BONET, comment under Paris District Court, 4 May 1971, Rev.crit. D.I.P., at 111 and 118.

53 Cf. CEIPI, "Infringement and Community Patents" (Coll. CEIPI 1976), 1977 PIBD, special number.

54 The interest of *forum shopping* is perfectly illustrated in this instance if we note its slow development even if some extra movement has been recorded recently for interim injunction proceedings to restrain infringement although only 30 applications have been made in 10 years, including only five which have been judged favourably; whereas the Dutch courts receive more applications for interim injunctions to restrain infringement than they do principal applications and they entertain them in much greater numbers. In a judgement given in The Hague on 5 January 1993 upon the initiative of the French firm Rhône-Poulenc Rouer it was stated: "This – low acceptance in French case law – is in stark contrast with the Dutch situation and the number of interim injunction suits is higher than that of trials on the merits of a case ... in contrast to the French situation, no trial on the merits of the case has to be pending and the success rate is higher than 60 %" (District Court of The Hague (ref.) 5 January 1993 (case Rhône-Poulenc Rouer, *supra* note 31)).

Others maintain that interim injunctions to restrain infringements fall within the scope of infringement law and thus the national law of the State where the infringement has occurred. Consequently, in the case of Eurosensory, the interim injunction to restrain infringement fell within the scope of the French law that did not provide for any such procedure before 1984, and then from 1984 on introduced such a procedure subject to strict rules of application which were subsequently relaxed by the 1990 reform. The requirement for the competent national courts to apply different national laws in response to applications for interim injunctions will make the court's and consequently the defendant's task more difficult.

43. Likewise, we should ascertain whether or not the interim injunction action and the principal action for infringement should be construed as independent – as in Dutch law – or rather as subordinate – as in French law. Some have difficulty in accepting that the Brussels Convention that dealt with procedural problems, both in terms of the jurisdiction of courts and the enforcement of their judgements, could alter the substantive rules applicable to national or European patents submitted to national rules in infringement matters.

44. The results (progress) that we have seen in relation to interim measures in infringement cases or that we are likely to see in relation to final infringement judgements or even revocation of patents must not overshadow the need to call upon distinct national rules that are still applicable in these cases.

Accordingly, nothing is less certain than the massive shift of patent disputes at present and perhaps other industrial property disputes in the future to the hospitable territories of the Princes of Orange.