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International jurisdiction—cross-border declaration of non-infringement with respect to Article 5 (3) of the 1968 Brussels Convention

Dijkstra Plastics B.V. v Saier
Verpackungstechnik GmbH & Co KG
Tribunal de Grande Instance Paris
November 5, 2003

Facts: The German company Saier Verpackungstechnik (“Saier”) owns a European patent covering pot-shaped containers, in particular a bucket. The Dutch company Dijkstra Plastics manufactured and marketed buckets used for liquid products such as sauces in various European countries, including France.

Faced with the threat of a patent infringement action, Dijkstra Plastics took the lead and sued Saier in France before the *Tribunal de Grande Instance* (Court of First Instance) in Paris seeking a declaration of non-infringement. The case was not only based on the French part of Saier’s European patent 565 967, but also on the Austrian, Belgian, German, Liechtenstein, Luxembourg and Swiss counterparts.

Saier did not challenge the jurisdiction of the Court of Paris to rule on the French part of its European patent (Saier could hardly raise such a defence since it brought a counterclaim for infringement of that French part of the European patent). The disputed issue was to what extent the Court of Paris has jurisdiction in an action for a cross-border declaration of non-infringement under Article 5 (3) of the 1968 Brussels Convention (now Article 5 (3) of the Council Regulation (EC) No. 44/2001 of December 22, 2000), which gives jurisdiction to the court for the place where the wrongful act occurred.

Held: The 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.

The Court of Paris found that Article 5 (3) 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.

In dicta, the Court further mentioned that, according to the main rule of Article 2 of the Brussels Convention, only the court of the Member State where the defendant is domiciled has jurisdiction to make a cross-border decision.

Comment: This judgment is the first French decision on jurisdiction in an action for a cross-border declaration of non-infringement of a patent. According to Article 2 of the Brussels Convention, the courts of the Member State where the defendant is domiciled have general jurisdiction to rule on all disputes; this should include an action for a declaration of non-infringement, albeit with a cross-border effect.

When the declaratory judgment action only addresses the scope of the patent and does not raise any validity issue, Article 16 (4) of the Brussels Convention (now Article 22 (4) of the Regulation (EC) No. 44/2001), which relates to the validity of an intellectual property right and not to the infringement thereof, cannot be relied upon to challenge the jurisdiction of the defendant’s court of domicile.

The Court of Paris was therefore perfectly right in declining jurisdiction under Article 5 (3) of the Brussels Convention to rule on a cross-border declaration of non-infringement regarding the national parts of the European patent other than the French part.

This ruling mirrors the decision on the action for a declaration of non-infringement in the *Fiona Shevill v Press Alliance* case (European Court of Justice, March 7, 1995) which held that only the courts of the Member State where the defendant is domiciled may order compensation for all damage suffered.

As a result, it is not possible to request a court of a Member State other than the state of the defendant’s domicile to rule on a complaint for a pan-European declaration of non-infringement.

Several other European courts have judged along the same lines, taking the view that they had no jurisdiction under Article 5 (3) of the Brussels Convention to rule on a cross-border declaration of non-infringement (Court of Brussels, *Röhm Enzyme GmbH v DSM*, May 12, 2000, District Court of Milan, *Optigen S.r.l v Marchon Eyewear Inc. and Eschenbach Optik GmbH*, March 28, 2002, District court of Milan, *Dade v Chiron*, March 21, 2003, and District Court of Turin, *GPC v Filterwerk Mann*, May 13, 2003).

But what if a court is seized, under Article 5 (3) of the Brussels Convention, with an action for a declaration of non-infringement based on the national part of a European patent? In the authors' view, this court should normally decline jurisdiction. In fact, it should base its findings on the plaintiff's (i.e., the possible infringer's) contention that **no** harmful event occurred. Such a situation is not encompassed in Article 5 (3) of the Brussels Convention which requires that a harmful event occur or (according to the provision added by Article 5 (3) of the Council Regulation (EC) No. 44/2001) may occur. In addition, it is commonly accepted that Article 5 (3), which lays down special jurisdiction rules, is an exception to Article 2 and therefore must be interpreted restrictively. Thus, the plaintiff's very contention that its product is not infringing would imply that no harmful event took place and therefore that jurisdiction based on Article 5 (3) is excluded. It may happen however that the defendant, i.e. the patent owner, does not challenge jurisdiction based on Article 5 (3). He can have an interest as in the present case in filing a counterclaim for infringement before the court of the State where the possible infringer manufactures or sells possibly infringing products.

Even if a declaration of non-infringement is rightly seen as the "*mirror image*" of an infringement action as far as the object of the action is concerned, this is not true regarding the jurisdiction rules since they have different purposes: an infringement action is directed to the sanction of a harmful event, i.e. an act of infringement, whereas the declaration of non-infringement postulates the inexistence of any harmful event. For this reason, several European courts declined jurisdiction in cases based on "their" national parts of a European patent, on the grounds that no wrongful act had been committed in the Member State of the court at issue (*Tribunale of Salerno, Cavi v Siemens*, March 9, 1994; Court of Appeal of The Hague, *Evans Medical v Chiron*, January 22, 1998; Italian Supreme Court, *B.L. Macchine Automatiche v Windmoller & Holscher*, November 6, 2003).

In sum, from the authors' point of view, Article 5 (3) of the 1968 Brussels Convention does not give jurisdiction to the court of the place of the possible infringement in a declaratory judgment action, be it with a cross-border effect or not; an action for declaration of non-infringement should be brought only in the defendant's court of domicile under Article 2.

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