JUDGMENT OF THE COURT (First Chamber)

13 July 2006 *

In Case C-539/03,

Reference for a preliminary ruling under the Protocol of 3 June 1971 on the interpretation by the Court of Justice of the Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, from the Hoge Raad der Nederlanden (Netherlands), made by decision of 19 December 2003, received at the Court on 22 December 2003, in the proceedings

Roche Nederland BV and Others,

v

Frederick Primus,

Milton Goldenberg,

THE COURT (First Chamber),

composed of P. Jann (Rapporteur), President of the Chamber, K. Schiemann, K. Lenaerts, E. Juhász and M. Ilešič, Judges,

* Language of the case: Dutch.

Advocate General: P. Léger,
Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 27 January 2005,

after considering the observations submitted on behalf of:

— Roche Nederland BV and Others., by P.A.M. Hendrick, O. Brouwer, B.J. Berghuis and K. Schillemans, advocaaten,

— Drs Primus and Goldenberg, by W. Hoyng, advocaat,

— the Netherlands Government, by H.G. Sevenster and J.G.M. van Bakel, acting as Agents,

— the French Government, by G. de Bergues and A. Bodard-Hermant, acting as Agents,

— the United Kingdom Government, by E. O'Neill, acting as Agent, and M. Tappin, Barrister,

— the Commission of the European Communities, by A.-M. Rouchaud-Joët and R. Troosters, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 8 December 2005,

gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation of Article 6(1) of the Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters (OJ 1978 L 304, p. 36), as amended by the Convention of 9 October 1978 on the Accession of the Kingdom of Denmark, Ireland and the United Kingdom of Great Britain and Northern Ireland (OJ 1978 L 304, p. 1, and — amended version — p. 77), by the Convention of 25 October 1982 on the Accession of the Hellenic Republic (OJ 1982 L 388, p. 1), by the Convention of 26 May 1989 on the Accession of the Kingdom of Spain and the Portuguese Republic (OJ 1989 L 285, p. 1) and by the Convention of 29 November 1996 on the Accession of the Republic of Austria, the Republic of Finland and the Kingdom of Sweden (OJ 1997 C 15, p. 1) ('the Brussels Convention').

2 The reference was made in the course of proceedings between Roche Nederland BV and eight other companies in the Roche group, on the one hand, and Drs Primus and Goldenberg, on the other, in respect of an alleged infringement of the latter's rights in a European patent of which they are the proprietors.

Legal background

The Brussels Convention

3 Featuring in Title II, on the rules of jurisdiction, and Section I, entitled 'General Provisions', the first paragraph of Article 2 of the Brussels Convention states:

'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.'

4 According to the first paragraph of Article 3 of the Brussels Convention:

'Persons domiciled in a Contracting State may be sued in the courts of another Contracting State only by virtue of the rules set out in Sections 2 to 6 of this Title.'

5 Article 6 of the Brussels Convention, which appears in Section 2 of Title II, entitled 'Special jurisdiction', states:

'[A defendant domiciled in a Contracting State] may also be sued:

(1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled;

...'.

6 Article 16 of the Brussels Convention, which constitutes Section 5 of Title II thereof, entitled 'Exclusive jurisdiction', states:

'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;

...'.

7 Article Vd of the Protocol annexed to the Brussels Convention, which, pursuant to Article 65 of the latter, forms an integral part of the Convention, states:

'Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Contracting State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State which is not a Community patent by virtue of the

provisions of Article 86 of the Convention for the European Patent for the Common Market, signed at Luxembourg on 15 December 1975.'

8 Article 22 of the Brussels Convention, which appears in Section 8, entitled 'Lis pendens — related actions' of Title II thereof, provides that where related actions are brought in the courts of different Contracting States, any court other than the court first seised may, while the actions are pending at first instance, stay its proceedings or, under certain conditions, decline jurisdiction. According to the third paragraph of that provision:

'For the purposes of this article, actions are deemed to be related where they are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings.'

9 Under Article 27(3) of the Brussels Convention, which appears in Title III, concerning the rules on recognition and enforcement, and in Section I, entitled 'Recognition', a judgment is not to be recognised 'if the judgment is irreconcilable with a judgment given in a dispute between the same parties in the State in which recognition is sought'.

The Munich Convention

10 The Convention on the Grant of European Patents, signed in Munich on 5 October 1973 ('the Munich Convention'), establishes, according to Article 1 thereof, 'a system of law, common to the Contracting States, for the grant of patents for invention'.

11 Outside the scope of the common rules on granting patents, a European patent continues to be governed by the national law of each of the Contracting States for which it has been granted. In that regard, Article 2(2) of the Munich Convention states:

'The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State ...'.

12 As regards the rights conferred on the proprietor of a European patent, Article 64(1) and (3) of that convention provides:

'(1) A European patent shall ... confer on its proprietor from the date of publication of the mention of its grant, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

...

(3) Any infringement of a European patent shall be dealt with by national law.'

The main proceedings and the questions referred for a preliminary ruling

13 Drs Primus and Goldenberg, who are domiciled in the United States of America, are the proprietors of European patent No 131 627.

14 On 24 March 1997, they brought an action before the Rechtbank te s'-Gravenhage against Roche Nederland BV, a company established in the Netherlands, and eight other companies in the Roche group established in the United States of America, Belgium, Germany, France, the United Kingdom, Switzerland, Austria and Sweden ('Roche and Others'). The applicants claimed that those companies had all infringed the rights conferred on them by the patent of which they are the proprietors. That alleged infringement consisted in the placing on the market of immuno-assay kits in countries where the defendants are established.

15 The companies in the Roche group not established in the Netherlands contested the jurisdiction of the Netherlands' courts. As regards the substance, they based their arguments on the absence of infringement and the invalidity of the patent in question.

16 By judgment of 1 October 1997, the Rechtbank te s'-Gravenhage declared that it had jurisdiction and dismissed the applications of Drs Primus and Goldenberg. On appeal, the Gerechtshof te s'-Gravenhage (Regional Court of Appeal) set aside the judgment and, inter alia, prohibited Roche and Others from infringing the rights attached to the patent in question in all the countries designated in it.

17 The Hoge Raad (Supreme Court), hearing an appeal on a point of law, decided to stay the proceedings and refer the following questions to the Court for a preliminary ruling:

(1) 'Is there a connection, as required for the application of Article 6(1) of the Brussels Convention, between a patent infringement action brought by a holder of a European patent against a defendant having its registered office in the State of the court in which the proceedings are brought, on the one hand, and against various defendants having their registered offices in Contracting States other than that of the State of the court in which the proceedings are brought, on the other hand, who, according to the patent holder, are infringing that patent in one or more other Contracting States?

(2) If the answer to Question 1 is not or not unreservedly in the affirmative, in what circumstances is such a connection deemed to exist, and is it relevant in this context whether, for example,

— the defendants form part of one and the same group of companies?

— the defendants are acting together on the basis of a common policy, and if so is the place from which that policy originates relevant?

— the alleged infringing acts of the various defendants are the same or virtually the same?'

The questions referred for a preliminary ruling

18 By those questions, which it is appropriate to consider together, the national court asks essentially whether Article 6(1) of the Brussels Convention must be interpreted as meaning that it is to apply to European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States and, in particular, where those companies, which belong to the same group, have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.

19 By way of derogation from the principle laid down in Article 2 of the Brussels Convention, that a defendant domiciled in a Contracting State is to be sued in the courts of that State, in a case where there is more than one defendant, Article 6(1) of the Convention allows a defendant domiciled in one Contracting State to be sued in another Contracting State where one of the defendants is domiciled.

20 In the judgment in Case 189/87 *Kalfelis* [1988] ECR 5565, paragraph 12, the Court held that for Article 6(1) of the Brussels Convention to apply there must exist, between the various actions brought by the same plaintiff against different defendants, a connection of such a kind that it is expedient to determine the actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings.

21 The requirement of a connection does not derive from the wording of Article 6(1) of the Brussels Convention. It has been inferred from that provision by the Court in order to prevent the exception to the principle that jurisdiction is vested in the courts of the State of the defendant's domicile laid down in Article 6(1) from calling into question the very existence of that principle (*Kalfelis*, paragraph 8). That requirement was subsequently confirmed by the judgment in Case C-51/97 *Réunion Européenne and Others* [1998] ECR I-6511, paragraph 48, and was expressly enshrined in the drafting of Article 6(1) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1), which succeeded the Brussels Convention.

22 The formulation used by the Court in *Kalfelis* repeats the wording of Article 22 of the Brussels Convention, according to which actions are deemed to be related where they are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings. Article 22 was interpreted in Case C-406/92 *Tatry* [1994] ECR I-5439,

paragraph 58, to the effect that, in order to establish the necessary relationship between the cases, it is sufficient that separate trial and judgment would involve the risk of conflicting decisions, without necessarily involving the risk of giving rise to mutually exclusive legal consequences.

23 The scope given to the concept of 'irreconcilable' judgments by the judgment in *Tatry* in the context of Article 22 of the Brussels Convention is therefore wider than that given to the same concept in Case 145/86 *Hoffman* [1988] ECR 645, paragraph 22, in the context of Article 27(3) of the Convention, which provides that a judgment given in a Contracting State will not be recognised if it is irreconcilable with a judgment given in a dispute between the same parties in the State in which recognition is sought. In *Hoffmann*, the Court had held that, in order to ascertain whether two judgments are irreconcilable within the meaning of Article 27(3), it must be determined whether they entail legal consequences which are mutually exclusive.

24 Drs Primus and Goldenberg and the Netherlands Government argue that the broad interpretation of the adjective 'irreconcilable', in the sense of contradictory, which was given in *Tatry* in the context of Article 22 of the Brussels Convention, must be extended to the context of Article 6(1) of the Convention. Roche and Others and the United Kingdom Government, with whose arguments the Advocate General agreed in point 79 *et seq.* of his Opinion, submit, by contrast, that such a transposition is not permissible given the differences between the purpose and the position of the two provisions in question in the scheme of the Brussels Convention, and that a narrower interpretation must be preferred.

25 However, it does not appear necessary in this case to decide that issue. It is sufficient to observe that, even assuming that the concept of 'irreconcilable' judgments for the purposes of the application of Article 6(1) of the Brussels Convention must be understood in the broad sense of contradictory decisions, there is no risk of such decisions being given in European patent infringement proceedings brought in

different Contracting States involving a number of defendants domiciled in those States in respect of acts committed in their territory.

26 As the Advocate General observed, in point 113 of his Opinion, in order that decisions may be regarded as contradictory it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact.

27 However, in the situation referred to by the national court in its first question referred for a preliminary ruling, that is in the case of European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States, the existence of the same situation of fact cannot be inferred, since the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same.

28 Possible divergences between decisions given by the courts concerned would not arise in the context of the same factual situation.

29 Furthermore, although the Munich Convention lays down common rules on the grant of European patents, it is clear from Articles 2(2) and 64(1) of that convention that such a patent continues to be governed by the national law of each of the Contracting States for which it has been granted.

30 In particular, it is apparent from Article 64(3) of the Munich Convention that any action for infringement of a European patent must be examined in the light of the relevant national law in force in each of the States for which it has been granted.

31 It follows that, where infringement proceedings are brought before a number of courts in different Contracting States in respect of a European patent granted in each of those States, against defendants domiciled in those States in respect of acts allegedly committed in their territory, any divergences between the decisions given by the courts concerned would not arise in the context of the same legal situation.

32 Any diverging decisions could not, therefore, be treated as contradictory.

33 In those circumstances, even if the broadest interpretation of 'irreconcilable' judgments, in the sense of contradictory, were accepted as the criterion for the existence of the connection required for the application of Article 6(1) of the Brussels Convention, it is clear that such a connection could not be established between actions for infringement of the same European patent where each action was brought against a company established in a different Contracting State in respect of acts which it had committed in that State.

34 That finding is not called into question even in the situation referred to by the national court in its second question, that is where defendant companies, which belong to the same group, have acted in an identical or similar manner in accordance with a common policy elaborated by one of them, so that the factual situation would be the same.

35 The fact remains that the legal situation would not be the same (see paragraphs 29 and 30 of this judgment) and therefore there would be no risk, even in such a situation, of contradictory decisions.

36 Furthermore, although at first sight considerations of procedural economy may appear to militate in favour of consolidating such actions before one court, it is clear that the advantages for the sound administration of justice represented by such consolidation would be limited and would constitute a source of further risks.

37 Jurisdiction based solely on the factual criteria set out by the national court would lead to a multiplication of the potential heads of jurisdiction and would therefore be liable to undermine the predictability of the rules of jurisdiction laid down by the Convention, and consequently to undermine the principle of legal certainty, which is the basis of the Convention (see Case C-256/00 *Besix* [2002] ECR I-1699, paragraphs 24 to 26, Case C-281/02 *Owusu* [2005] ECR I-1383, paragraph 41, and Case C-4/03 *GAT* [2006] ECR I-6509, paragraph 28).

38 The damage would be even more serious if the application of the criteria in question gave the defendant a wide choice, thereby encouraging the practice of forum shopping which the Convention seeks to avoid and which the Court, in its judgment in *Kalfelis*, specifically sought to prevent (see *Kalfelis*, paragraph 9).

39 It must be observed that the determination as to whether the criteria concerned are satisfied, which is for the applicant to prove, would require the court seised to adjudicate on the substance of the case before it could establish its jurisdiction. Such a preliminary examination could give rise to additional costs and could prolong procedural time-limits where that court, being unable to establish the existence of the same factual situation and, therefore, a sufficient connection between the actions, would have to decline jurisdiction and where a fresh action would have to be brought before a court of another State.

40 Finally, even assuming that the court seised by the defendant were able to accept jurisdiction on the basis of the criteria laid down by the national court, the consolidation of the patent infringement actions before that court could not prevent at least a partial fragmentation of the patent proceedings, since, as is frequently the case in practice and as is the case in the main proceedings, the validity of the patent would be raised indirectly. That issue, whether it is raised by way of an action or a plea in objection, is a matter of exclusive jurisdiction laid down in Article 16(4) of the Brussels Convention in favour of the courts of the Contracting State in which the deposit or registration has taken place or is deemed to have taken place (*GAT*, paragraph 31). That exclusive jurisdiction of the courts of the granting State has been confirmed, as regards European patents, by Article Vd of the Protocol annexed to the Brussels Convention.

41 Having regard to all of the foregoing considerations, the answer to the questions referred must be that Article 6(1) of the Brussels Convention must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.

Costs

42 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (First Chamber) hereby rules:

Article 6(1) of the Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, as amended most recently by the Convention of 29 November 1996 on the Accession of the Republic of Austria, the Republic of Finland and the Kingdom of Sweden, must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them.

[Signatures]