Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

12 July 2012*

(Judicial cooperation in civil matters — Jurisdiction, recognition and enforcement of judgments — Regulation (EC) No 44/2001 — Action for infringement of a European patent — Special and exclusive jurisdiction — Article 6(1) — More than one defendant — Article 22(4) — Validity of the patent called into question — Article 31 — Provisional, including protective, measures)

In Case C-616/10,

REFERENCE for preliminary ruling under Article 267 TFEU, from the Rechtbank 's-Gravenhage (Netherlands), made by decision of 22 December 2010, received at the Court on 29 December 2010, in the proceedings

Solvay SA

v

Honeywell Fluorine Products Europe BV,

Honeywell Belgium NV,

Honeywell Europe NV,

THE COURT (Third Chamber),

composed of K. Lenaerts, President of the Chamber, J. Malenovský (Rapporteur), R. Silva de Lapuerta, E. Juhász and D. Šváby, Judges,

Advocate General: P. Cruz Villalón,

Registrar: K. Sztranc-Sławiczek, Administrator,

having regard to the written procedure and further to the hearing on 30 November 2011,

after considering the observations submitted on behalf of:

— Solvay SA, by W.A. Hoyng and F.W.E. Eijsvogels, advocaten,

— Honeywell Fluorine Products Europe BV, Honeywell Belgium NV and Honeywell Europe NV, by R. Ebbink and R. Hermans, advocaten,

— the German Government, by T. Henze and J. Kemper, acting as Agents,

* Language of the case: Dutch.

— the Greek Government, by S. Chala, acting as Agent,

— the Spanish Government, by S. Centeno Huerta, acting as Agent,

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

after hearing the Opinion of the Advocate General at the sitting on 29 March 2012,

gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation of Articles 6(1), 22(4) and 31 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).

2 The reference was submitted in the course of proceedings between (i) Solvay SA, established in Belgium ('Solvay') and (ii) Honeywell Fluorine Products Europe BV, established in the Netherlands, and Honeywell Belgium NV and Honeywell Europe NV, both established in Belgium, (together 'the Honeywell companies'), regarding the alleged infringement by various parties of a European patent.

Legal context

The Munich Convention

3 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'.

4 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 ...'

5 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.'

European Union law

6 Recitals 11, 12, 15 and 19 in the preamble to Regulation No 44/2001 state:

'(11) The rules of jurisdiction must be highly predictable and founded on the principle that jurisdiction is generally based on the defendant's domicile and jurisdiction must always be available on this ground save in a few well-defined situations in which the subject-matter of the litigation or the autonomy of the parties warrants a different linking factor. …

(12) In addition to the defendant's domicile, there should be alternative grounds of jurisdiction based on a close link between the court and the action or in order to facilitate the sound administration of justice.

…

(15) In the interests of the harmonious administration of justice it is necessary to minimise the possibility of concurrent proceedings and to ensure that irreconcilable judgments will not be given in two Member States. …

…

(19) Continuity between the [Brussels Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1972 L 299, p. 32; 'the Brussels Convention')] and this Regulation should be ensured, and transitional provisions should be laid down to that end. The same need for continuity applies as regards the interpretation of the Brussels Convention by the Court of Justice of the European Communities and the 1971 Protocol [on this interpretation by the Court, as revised and amended (OJ 1998 C 27, p. 28)] should remain applicable also to cases already pending when this Regulation enters into force.'

7 Under Article 2 of that regulation:

'1. Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.

2. Persons who are not nationals of the Member State in which they are domiciled shall be governed by the rules of jurisdiction applicable to nationals of that State.'

8 Article 6(1), which is part of Section 2 of Chapter II of that regulation, entitled 'Special jurisdiction', provides:

'A person domiciled in a Member 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, provided the claims 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 According to Article 22(4) of that regulation:

'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 Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the [Munich Convention], the courts of each Member State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State'.

10 Article 25 of that regulation is worded as follows:

'Where a court of a Member State is seised of a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 22, it shall declare of its own motion that it has no jurisdiction.'

11 Pursuant to Article 31 of that regulation:

'Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that State, even if, under this Regulation, the courts of another Member State have jurisdiction as to the substance of the matter.'

The dispute in the main proceedings and the questions referred for a preliminary ruling

12 On 6 March 2009, Solvay, the proprietor of European patent EP 0 858 440, brought an action in the Rechtbank 's-Gravenhage for infringement of the national parts of that patent, as in force in Denmark, Ireland, Greece, Luxembourg, Austria, Portugal, Finland, Sweden, Liechtenstein and Switzerland, against the Honeywell companies for marketing a product HFC-245 fa, manufactured by Honeywell International Inc. and identical to the product covered by that patent.

13 Specifically, Solvay accuses Honeywell Flourine Products Europe BV and Honeywell Europe NV of performing the reserved actions in the whole of Europe and Honeywell Belgium NV of performing the reserved actions in Northern and Central Europe.

14 In the course of its action for infringement, on 9 December 2009 Solvay also lodged an interim claim against the Honeywell companies, seeking provisional relief in the form of a cross-border prohibition against infringement until a decision had been made in the main proceedings.

15 In the interim proceedings, the Honeywell companies raised the defence of invalidity of the national parts of the patent concerned without, however, having brought or even declared their intention of bringing proceedings for the annulment of the national parts of that patent, and without contesting the competence of the Dutch court to hear both the main proceedings and the interim proceedings.

16 In those circumstances, the Rechtbank 's-Gravenhage decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'Regarding Article 6(1) of [Regulation No 44/2001]:

1. In a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another

Member State by virtue of their performance of reserved actions with regard to the same product, does the possibility arise of "irreconcilable judgments" resulting from separate proceedings as referred to in Article 6(1) of [Regulation No 44/2001]?

Regarding Article 22(4) of [Regulation No 44/2001]:

2. Is Article 22(4) of [Regulation No 44/2001] applicable in proceedings seeking provisional relief on the basis of a foreign patent (such as a provisional cross-border prohibition against infringement), if the defendant argues by way of defence that the patent invoked is invalid, taking into account that the court in that case does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of [that] Regulation would rule in that regard, and that the application for interim relief in the form of a prohibition against infringement shall be refused if, in the opinion of the court, a reasonable, non-negligible possibility exists that the patent invoked would be declared invalid by the competent court?

3. In order for Article 22(4) of [Regulation No 44/2001] to be applicable in proceedings such as those referred to in the preceding question, must the defence of invalidity be subject to procedural requirements in the sense that Article 22(4) of the regulation is only applicable if invalidity proceedings before the court having jurisdiction under Article 22(4) of [that] Regulation are already pending or are to be commenced within a period to be laid down by the court or at least that a summons in that regard has been or is being issued to the patent holder, or does it suffice if a defence of invalidity is merely raised and, if so, are requirements then laid down in respect of the content of the defence put forward, in the sense that it must be sufficiently substantiated and/or that the conduct of the defence must not be deemed to be an abuse of procedural law?

4. If question [2] is answered in the affirmative, does the court, after a defence of invalidity has been raised in proceedings such as those referred to in question 1, retain jurisdiction in respect of the infringement action with the result that (if the claimant so desires) the infringement proceedings must be stayed until the court having jurisdiction under Article 22(4) of [Regulation No 44/2001] has given a decision on the validity of the national part of the patent invoked, or that the claim must be refused because a defence that is essential to the decision may not be adjudicated, or does the court also lose its jurisdiction in respect of the infringement claim once a defence of invalidity has been raised?

5. If question [2] is answered in the affirmative, can Article 31 of [Regulation No 44/2001] confer on the national court jurisdiction to adjudicate on a claim seeking provisional relief on the basis of a foreign patent (such as a cross-border prohibition against infringement), and against which it is argued by way of defence that the patent invoked is invalid, or (should it be decided that the applicability of Article 22(4) of [that] Regulation does not affect the jurisdiction of the Rechtbank [s'-Gravenhage] to adjudicate on the infringement question) jurisdiction to adjudicate on a defence claiming that the foreign patent invoked is invalid?

6. If question [5] is answered in the affirmative, what facts or circumstances are then required in order to be able to accept that there is a real connecting link, as referred to in paragraph 40 of the judgment [in Case C-391/95 *Van Uden* [1998] ECR I-7091], between the subject matter of the measures sought and the territorial jurisdiction of the Contracting State of the court before which those measures are sought?'

On the questions referred

The first question

17 By its first question, the referring court asks, in essence, whether Article 6(1) of Regulation No 44/2001 must be interpreted as meaning that a situation where two or more companies established in different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to 'irreconcilable judgments' resulting from separate proceedings as referred to in that provision.

18 First of all, it must be observed that Article 6(1) of Regulation No 44/2001 provides, in order to avoid irreconcilable judgments resulting from separate proceedings, that a defendant may be sued, where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together.

19 As regards its purpose, the rule of jurisdiction in Article 6(1) of Regulation No 44/2001 meets, in accordance with recitals 12 and 15 in the preamble to that regulation, the wish to facilitate the sound administration of justice, to minimise the possibility of concurrent proceedings and thus to avoid irreconcilable outcomes if cases are decided separately (see Case C-145/10 *Painer* [2011] ECR I-12533, paragraph 77).

20 Moreover, that special rule of jurisdiction must be interpreted in the light, first, of recital 11 in the preamble to Regulation No 44/2001, according to which the rules of jurisdiction must be highly predictable and founded on the principle that jurisdiction is generally based on the defendant's domicile and jurisdiction must always be available on this ground save in a few well-defined situations in which the subject-matter of the litigation or the autonomy of the parties warrants a different linking factor (see Case C-98/06 *Freeport* [2007] ECR I-8319, paragraph 36).

21 That special rule of jurisdiction, because it derogates from the principle stated in Article 2 of Regulation No 44/2001 that jurisdiction be based on the defendant's domicile, must be strictly interpreted and cannot be given an interpretation going beyond the cases expressly envisaged by that regulation (see *Painer*, paragraph 74 and the case-law cited).

22 In addition, that rule cannot be interpreted in such a way as to allow an applicant to make a claim against a number of defendants with the sole object of ousting the jurisdiction of the courts of the State where one of those defendants is domiciled (see, to that effect, Case 189/87 *Kalfelis* [1988] ECR 5565, paragraphs 8 and 9, and *Painer*, paragraph 78; Case C-51/97 *Réunion européenne and Others* [1998] ECR I-6511, paragraph 47; and *Painer*, paragraph 78).

23 Furthermore, the Court has held that it is for the national court to assess whether there is a connection between the different claims brought before it, that is to say, a risk of irreconcilable judgments if those claims were determined separately and, in that regard, to take account of all the necessary factors in the case-file (see *Freeport*, paragraph 41, and *Painer*, paragraph 83).

24 The Court has however stated in this connection that, in order for judgments to be regarded as at risk of being irreconcilable within the meaning of Article 6(1) of Regulation No 44/2001, it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the same situation of fact and law (see Case C-539/03 *Roche Nederland and Others* [2006] ECR I-6535, paragraph 26; *Freeport*, paragraph 40; and *Painer*, paragraph 79).

25 As regards the assessment of the existence of the same situation, the Court has ruled, first, that the existence of the same situation of fact cannot be inferred where the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same. Secondly, it has held that the same situation of law cannot be inferred 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 and those actions are brought against defendants domiciled in those States in respect of acts allegedly committed in their territory (see *Roche Nederland and Others*, paragraphs 27 and 31).

26 A European patent continues to be governed, as Articles 2(2) and 64(1) of the Munich Convention clearly show, by the national law of each of the Contracting States for which it has been granted. By the same token, any action for infringement of a European patent must, as is apparent from Article 64(3) of that convention, be examined in the light of the relevant national law in force in each of the States for which it has been granted (*Roche Nederland and Others*, paragraphs 29 and 30).

27 It follows from the specific features of a case such as that in the main proceedings that potential divergences in the outcome of the proceedings are likely to arise in the same situation of fact and law, so that it is possible that they will culminate in irreconcilable judgments resulting from separate proceedings.

28 As the Advocate General observed in point 25 of his Opinion, were Article 6(1) of Regulation No 44/2001 not applicable, two courts would each have to examine the alleged infringements in the light of the different national legislation governing the various national parts of the European patent alleged to have been infringed. They would, for instance, be called upon to assess according to the same Finnish law the infringement of the Finnish part of the European patent by the Honeywell companies as a result of the marketing of an identical infringing product in Finland.

29 In order to assess, in a situation such as that at issue in the main proceedings, whether there is a connection between the different claims brought before it and thus whether there is a risk of irreconcilable judgments if those claims were determined separately, it is for the national court to take into account, inter alia, the dual fact that, first, the defendants in the main proceeding are each separately accused of committing the same infringements with respect to the same products and, secondly, such infringments were committed in the same Member States, so that they adversely affect the same national parts of the European patent at issue.

30 In the light of the foregoing, the answer to the first question is that Article 6(1) of Regulation No 44/2001 must be interpreted as meaning that a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to 'irreconcilable judgments' resulting from separate proceedings as referred to in that provision. It is for the referring court to assess whether such a risk exists, taking into account all the relevant information in the file.

The second question

31 By its second question, the referring court asks whether Article 22(4) of Regulation No 44/2001 is applicable in proceedings seeking provisional relief on the basis of a foreign patent, such as a provisional cross-border prohibition against infringement, if the defendants in the main proceedings argue by way of defence that the patent invoked is invalid, taking into account that the court in that case does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of that Regulation would rule in that regard,

and that the application for interim relief in the form of a prohibition against infringement shall be refused if, in the opinion of the court, a reasonable, non-negligible possibility exists that the patent invoked would be declared invalid by the competent court.

32 It is apparent from the wording of the question referred for a preliminary ruling and the order for reference that the issue at the heart of the dispute in the main proceedings concerns a procedure for the adoption of an interim measure governed by the rule of jurisdiction set out in Article 31 of Regulation No 44/2001.

33 Consequently, the question asked must be construed as seeking to ascertain essentially whether Article 22(4) of Regulation No 44/2001 must be interpreted as precluding, in circumstances such as those at issue in the case in the main proceedings, the application of Article 31 of that regulation.

34 In this connection, it is apparent from Article 31 of Regulation No 44/2001 that the court of a Member State is authorised to rule on a claim for a provisional, including a protective, measure even if, under that regulation, the courts of another Member State have jurisdiction as to the substance of the matter.

35 Furthermore, as follows from Article 22(4) thereof, Regulation No 44/2001 lays down for a rule of exclusive jurisdiction according to which, in proceedings concerned with the registration or validity of patents, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place, have exclusive jurisdiction.

36 Concerning, first of all, the wording of Articles 22(4) and 31 of Regulation No 44/2001, it should be noted that those provisions are intended to regulate different situations and each has a distinct field of application. Thus, whilst Article 22(4) concerns the attribution of jurisdiction to rule on the substance in proceedings relating to a clearly defined area, Article 31 is designed to apply regardless of any jurisdiction as to the substance.

37 Moreover, those two provisions do not refer to one another.

38 As regards, secondly, the general scheme of Regulation No 44/2001, it is appropriate to point out that those provisions are included under Chapter II of Regulation No 44/2001, entitled ‘Jurisdiction’, and constitute ‘special provisions’ as opposed to the ‘general provisions’ in Section 1 of that chapter.

39 On the other hand, there is nothing to indicate that either of the provisions at issue can be regarded as general or special in relation to the other. They fall within two different sections of the same Chapter II, namely Sections 6 and 10 respectively.

40 It follows from this that Article 31 is independent in scope from Article 22(4) of that regulation. As noted in paragraph 34 above, Article 31 applies where a claim for provisional, including protective, measures is brought before a court other than the court which has jurisdiction as to the substance, so that Article 22(4), which concerns the jurisdiction as to substance, cannot, as a rule, be interpreted so as to derogate from Article 31 and, consequently, cause it to be disapplied.

41 However, it is necessary to examine whether the interpretation given by the Court to Article 16(4) of the Brussels Convention leads to a different conclusion.

42 In so far as Regulation No 44/2001 now replaces, in the relations between Member States, the Brussels Convention, the interpretation provided by the Court in respect of the provisions of that convention is also valid for those of that regulation whenever the provisions of those Community instruments may

be regarded as equivalent (see, inter alia, Case C-189/08 *Zuid-Chemie* [2009] ECR I-6917, paragraph 18; Case C-292/08 *German Graphics Graphische Maschinen* [2009] ECR I-8421, paragraph 27; and Case C-406/09 *Realchemie Nederland* [2011] ECR I-9773, paragraph 38).

43 Article 22(4) of Regulation No 44/2001, relevant to the examination of this question, reflects the same system as Article 16(4) of the Brussels Convention and is, moreover, drafted in almost identical terms. In the light of such similarity, it is necessary to ensure, in accordance with recital 19 in the preamble to this regulation, continuity in their interpretation (see, by analogy, Case C-167/08 *Draka NK Cables and Others* [2009] ECR I-3477, paragraph 20; Case C-180/06 *Ilsinger* [2009] ECR I-3961, paragraph 58; and *Zuid-Chemie*, paragraph 19).

44 It must be pointed out in this connection that the Court, in paragraph 24 of its judgment in Case C-4/03 *GAT* [2006] ECR I-6509, interpreted Article 16(4) of the Brussels Convention widely, in order to ensure its effectiveness. It held that, having regard to the position of that provision within the scheme of that convention and the objective pursued, the rules of jurisdiction provided for in that provision are of an exclusive and mandatory nature, the application of which is specifically binding on both litigants and courts.

45 The Court also considered that the exclusive jurisdiction provided for by Article 16(4) of the Brussels Convention should apply whatever the form of proceedings in which the issue of a patent's validity is raised, be it by way of an action or a defence, at the time the case is brought or at a later stage in the proceedings (see *GAT*, paragraph 25).

46 In addition, the Court has stated that to allow, within the scheme of the Brussels Convention, decisions in which courts other than those of the State in which a particular patent is issued rule indirectly on the validity of that patent would multiply the risk of conflicting decisions which the convention seeks specifically to avoid (see *GAT*, paragraph 29).

47 Having regard to the wide interpretation given by the Court to Article 16(4) of the Brussels Convention, to the risk of conflicting decisions which that provision seeks to avoid, and, taking account of the similarity of the content of Article 22(4) of Regulation No 44/2001 and of Article 16(4) of the Brussels Convention, noted in paragraph 43 above, it must be held that the application of the rule of jurisdiction set out in Article 25 of Regulation No 44/2001, which refers expressly to Article 22 of that regulation, and of other rules of jurisdiction such as, inter alia, those provided for in Article 31 of that regulation, are capable of being affected by the specific binding effect of Article 22(4) of Regulation No 44/2001, mentioned above in paragraph 44.

48 Accordingly, it must be established whether the specific scope of Article 22(4) of Regulation No 44/2001, as interpreted by the Court, affects the application of Article 31 of that regulation in a situation such as that at issue in the main proceedings, which concerns an action for infringement in which the invalidity of a European patent has been raised, at an interim stage, as a defence to the adoption of a provisional measure concerning cross-border prohibition against infringement.

49 According to the referring court, the court before which the interim proceedings have been brought does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under Article 22(4) of the regulation would rule in that regard, and will refuse to adopt the provisional measure sought if it considers that there is a reasonable, non-negligible possibility that the patent invoked would be declared invalid by the competent court.

50 In those circumstances, it is apparent that there is no risk of conflicting decisions as mentioned in paragraph 47 above, since the provisional decision taken by the court before which the interim proceedings have been brought will not in any way prejudice the decision to be taken on the substance by the court having jurisdiction under Article 22(4) of Regulation No 44/2001. Thus, the

reasons which led the Court to interpret widely the jurisdiction provided for in Article 22(4) of Regulation No 44/2001 do not require that, in a case such as that in the main proceedings, Article 31 of that regulation should be disapplied.

51 In the light of all the foregoing considerations, the answer to the second question is that Article 22(4) of Regulation No 44/2001 must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of Article 31 of that regulation.

The third to sixth questions

52 Having regard to the answer provided to the second question, there is no need to answer the third to sixth questions.

Costs

53 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 (Third Chamber) hereby rules:

1. **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, must be interpreted as meaning that a situation where two or more companies established in different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to 'irreconcilable judgments' resulting from separate proceedings as referred to in that provision. It is for the referring court to assess whether such a risk exists, taking into account all the relevant information in the file.**

2. **Article 22(4) of Regulation No 44/2001 must be interpreted as not precluding, in circumstances such as those at issue in the main proceedings, the application of Article 31 of that regulation.**

[Signatures]