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Bundles of national rights

International entitlement to national IP rights


Exception:
EU Trademarks, Designs Rights and Plant Variety Rights
(in addition to national IPRs)

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Cross Border Measure

Court order that addresses activities outside the national territory of that court

Example:
Dutch court ordering a defendant not to infringe a European patent in The Netherlands and all other designated states

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Cross Border Measures

Dutch law

- Cross border measures are possible *Interlas (1989)*

Benelux law

- An injunction concerns all of the Benelux -
- Benelux Supreme Court in *Barbie* and *Renault/Reynolds*

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Cross Border Measures

Community-IP-rights:

- Competent EU-court generally authorized for entire EU f.i., articles 93-94 CTMR

Foreign law

- Historically: had come to grips with the concept

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IP Infringement

Applicable law:

lex loci protectionis - article 8 Rome II

Uniform law

- Benelux Trademarks and –Designs
- Community Trademarks, Designs and Plant Variety Rights

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IP Infringement

Applicable law:

- Harmonized law by EU Directives, but scope of protection has local implications (markets, ‘state of cultural heritage’, language issues)
- Impact TRIPs, Paris and Berne Convention?

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IP Infringement II

European Patent Law:

- Scope of protection harmonized by article 69 EPC + Protocol
- Technology is independent from culture or language

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Rome II – Applicable law

Mandatory application of “lex protectionis” for IP infringements.

Choice of law not permitted !!??

– Van Engelen: *Rome II and intellectual property rights: Choice of law brought to a standstill* - NIPR 2008, p. 440-448

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Cross border injunctions

1. European patents
2. Counterfeit products ('piracy'):
3. Community IPRs (trademarks, designs, plant variety rights)
4. Benelux trademarks and designs

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Which court ?



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Jurisdiction of courts - 2 tracks

Defendant has domicile within EU


- Jurisdiction Regulation (Brussels Convention)

Community IPRs

- Jurisdiction in line with Jurisdiction Regulation/ Brussels Convention

Defendant domiciled outside EU:

- National jurisdictional rules
- As from 2000: Dutch national law in line with EU Jurisdiction Regulation

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The Jurisdiction Regulation

Article 4 [2] : Place of domicile of defendant

Article 7(2) [5(3)] : Place of harmful event

Article 8(1) [6(1)] : Place of domicile of co- defendants

Article 24(4) Registration or validity of [22(4)] : registered IPRs

Article 25 [23] : Choice of forum

Article 35 [31] : Preliminary measures

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Article 4: Domicile of defendant

Main rule of jurisdiction

– Defendant is entitled to a “home game”

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Article 4: Domicile of defendant

As a matter of Dutch law court of the domicile of the defendant has cross border jurisdiction

As a matter of EU law: same for Community IPRs


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Article 98(1) EU Trademark Regulation

An EU trade mark court whose jurisdiction is based on Article 97(1) to (4) shall have jurisdiction in respect of:

(a) acts of infringement committed or threatened within the territory of any of the Member States;

(b) acts within the meaning of Article 9(3), second sentence, committed within the territory of any of the Member States

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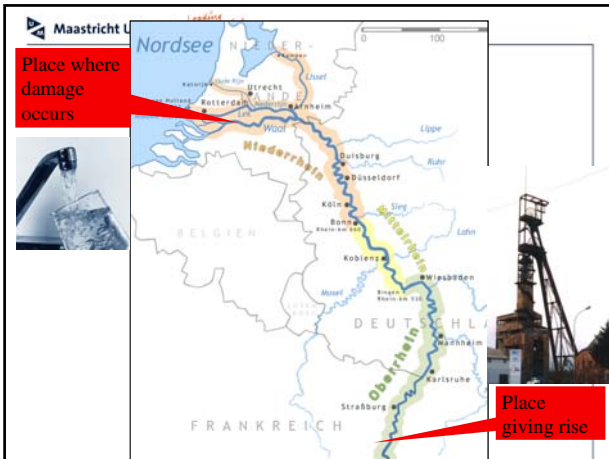
Article 7(2): Place of harmful event

Special jurisdiction

Can be more than one place

(i) place where damage occurs as well as

(ii) place giving rise to it



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Article 98(2) EU Trademark Regulation

An EU trade mark court whose jurisdiction is based on Article 97(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

97(5): place of infringement


[IPPT20190905, CJEU, AMS Neve v Heritage Audio](#)

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Article 8(1) : domicile of co-defendants


Special jurisdiction

Connection between the actions required and risk of irreconcilable judgments

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Art. 6(1) : domicile of co-defendant


- ECJ in ***Roche v Primus*** (2006)
 - Rejection of ‘**spider in the web**’-doctrine
 - Infringement of European patent does not amount to **same situation of law and fact**
 - *Disregards extensive harmonization of national patent law under EPC: patentability, validity and scope of protection*

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Art. 35 : Provisional measures

Special jurisdiction

Used in Solvay decision

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Art. 24(4) :Registered IPRs

Exclusive jurisdiction of national court for registration or validity issues

ECJ in ***GAT v LUK*** (2006)


- Irrespective of whether invalidity is a claim or a defense

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Preliminary injunctions

ECJ in Solvay v Honeywell, 12 July 2012 (IPPT20120712)

- Possibility of irreconcilable judgments (article 6) if companies are each separately accused of infringement of same national part of European patent with same product.




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Preliminary injunctions

ECJ in Solvay v Honeywell, 12 July 2012 (IPPT20120712)

- Exclusive jurisdiction regarding validity does not preclude special jurisdiction regarding interim measures



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Which law ?




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Jurisdiction – Applicable Law

Jurisdiction: which national court is competent to decide a case – Brussels Regulation

Applicable Law: Rome II Regulation

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Article 8 (1) - Rome II

The law applicable to a non-contractual obligation arising from an infringement of an intellectual property right shall be the law of the country for which protection is claimed.

Lex loci protectionis


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**EU Enforcement
Directive 2004**

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Article 1 – Subject-matter

This Directive concerns the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights.

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Article 3 – General obligation

1. [...]. Those measures, procedures and remedies shall be fair and equitable and shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

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Article 3 – General obligation

2. Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

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Article 6 - Evidence

1. [...] on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities

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Article 6 - Evidence

1. ... may order that such evidence be presented by the opposing party, subject to the protection of confidential information.

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Article 6 - Evidence

2. Under the same conditions, in the case of an infringement committed on a commercial scale Member States shall take such measures as are necessary to enable the competent judicial authorities to order,

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Article 6 - Evidence

2. where appropriate, on application by a party, the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information

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Article 7 – Preserving evidence

1 [...] order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information.

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Article 8 – Right of information

1 [...] in the context of proceedings concerning an infringement [...] the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person

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Article 9 – Provisional measures

1. (a) issue against the alleged infringer an interlocutory injunction intended to prevent any imminent infringement of an intellectual property right, or ...

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Article 9 – Provisional measures

2. In the case of an infringement committed on a commercial scale, ... circumstances likely to endanger the recovery of damages, may order the precautionary seizure of the movable and immovable property of the alleged infringer, including the blocking of his bank accounts and other assets.

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Article 9 – Provisional measures

4. Member States shall ensure that the provisional measures referred to in paragraphs 1 and 2 may, in appropriate cases, be taken **without the defendant having been heard**, in particular where any delay would cause irreparable harm to the rightholder.

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Article 13 – Damages

1. ... order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the rightholder damages appropriate to the actual prejudice suffered by him as a result of the infringement.

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Article 14 – Legal costs

Member States shall ensure that reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity does not allow this.
