OPINION OF ADVOCATE GENERAL LÉGER

delivered on 8 December 2005 [1]

1. Is the holder of a European patent entitled, pursuant to Article 6(1) of the Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, [2] to bring an action for infringement against a number of companies established in various Contracting States and belonging to the same group before a single court, namely that in whose jurisdiction one of the said companies is established?

2. That, in essence, is the question raised by the Hoge Raad der Nederlanden (Supreme Court of the Netherlands) in connection with a dispute between on the one hand two individuals domiciled in the United States who are the holders of a European patent relating to a medical analysis process and corresponding equipment and on the other hand nine companies of the Roche pharmaceutical group established in the Netherlands, in other European countries and in the United States, arising out of the marketing by the latter of certain merchandise that allegedly infringes the rights of the holders of the patent in question.

3. A similar question was already referred to the Court some years ago by the Court of Appeal (England and Wales) (Civil Division), United Kingdom, as a result of cross-actions (for cessation of patent infringement, then for a declaration of non-infringement and for revocation of the patent involved) brought successively in Netherlands and British courts between on the one hand a company established under US law that held a European patent on medical equipment and on the other hand a number of companies established in the Netherlands, the United Kingdom and the United States. [3] However, ultimately, the Court did not rule on this point, as the case was removed from the register following an amicable settlement of the differences between the parties. [4]

1 — Original language: French.

2 — OJ 1972 L 299, p. 32. As amended by the Convention of 9 October 1978 on the Accession of the Kingdom of Denmark, of Ireland and of the United Kingdom of Great Britain and Northern Ireland (OJ 1978 L 304, p. 1, and — the amended text — 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'). A consolidated version of the Convention, as amended by these four accession conventions, is published in OJ 1998 C 27, p. 1.

3 — The case of *Boston Scientific and Others* (Case C-186/00).

4 — Order for removal from the register of 9 November 2000.

4. On the other hand, the Court is still seised of a question referred for a preliminary ruling by a German court, which, although very different, is not entirely unconnected with the present proceedings. [5] Whereas that earlier question has to do with a national patent and not a European one, does not relate to the conditions for applying Article 6(1) of the Brussels Convention and does not involve a number of defendants but concerns solely the scope of the exclusive jurisdictional rule laid down in Article 16(4) of that convention with regard to the registration or validity of patents, it is nevertheless likely to be of interest when examining the current question referred. In an action for patent infringement, it often happens that the validity of the patent is questioned (by the defendant in proceedings for infringement or by the applicant in an action for a declaration of non-infringement), so that it may be useful to examine the relationship between Article 16(4) and other jurisdictional rules contained in the Brussels Convention, such as those laid down in Article 6(1).

I — Legal background

A — *The Brussels Convention*

5. The Brussels Convention was adopted in 1968 on the basis of Article 220 of the EEC Treaty (which became Article 220 of the EC Treaty, now Article 293 EC). According to its preamble, its objective is to 'strengthen in the Community the legal protection of persons therein established'.

6. It is a 'double' convention, in the sense that it contains rules not only on recognition and enforcement but also on direct jurisdiction that are applicable in the Contracting State in which the judgment was given, that is to say as from the stage at which the judicial decision eligible for recognition and enforcement in another Contracting State is adopted.

7. The rules on direct jurisdiction are constructed around the principle enunciated in the first paragraph of Article 2 of the Brussels Convention, according to which, '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'. Hence, if a defendant is domiciled in a Contracting State, in principle the courts of that State have jurisdiction.

8. In keeping with that logic, the first paragraph of Article 3 of the Convention adds that 'persons domiciled in a Contract-

5 — I am thinking of Case C-4/03 *GAT*, pending before the Court, which gave rise to the Opinion of Advocate General Geelhoed delivered on 16 September 2004.

ing 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 ... Title [II]'.[6] These rules are of various types.

9. Some of them are optional. They allow the applicant to choose to bring proceedings in a court of a Contracting State other than that in which the defendant is domiciled.

10. This is true, in particular, of the special jurisdiction rule contained in Article 5(3) of the Convention, which provides that, in matters relating to tort, delict or quasi-delict, the defendant may be sued in the courts 'for the place where the harmful event occurred'.

11. It is also true, in particular, of the special jurisdiction rule set out in Article 6(1) of the Brussels Convention, according to which 'a person domiciled in a Contracting State [who should therefore in principle be sued in the courts of that State, in accordance with Article 2] 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'.

12. Other jurisdictional rules laid down by the Brussels Convention require proceedings to be brought in the courts of one Contracting State to the exclusion of any other. These provisions, termed 'exclusive' jurisdictional rules, include that set out in Article 16(4), according to which, '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 ... shall have exclusive jurisdiction, regardless of domicile'.

13. Following the entry into force of the Convention on the Grant of European Patents, signed at Munich on 5 October 1973,[7] a second paragraph was added to Article 16(4) of the Brussels Convention, under which, 'without prejudice to the jurisdiction of the European Patent Office under the [Munich] Convention ..., 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 ...'.[8]

6 — By contrast, under the first paragraph of Article 4 of the Brussels Convention, 'if the defendant is not domiciled in a Contracting State, the jurisdiction of the courts of each Contracting State shall, subject to the provisions of Article 16, be determined by the law of that State'.

7 — I shall examine this convention (hereinafter referred to as the 'Munich Convention') in greater detail below.

8 — These provisions were inserted into the Brussels Convention by Article V.d of the protocol annexed to the Convention of 9 October 1978 on the Accession of the Kingdom of Denmark, of Ireland and of the United Kingdom of Great Britain and Northern Ireland.

14. Because of the binding nature of the exclusive jurisdictional rules in Article 16 of the Brussels Convention, Article 19 of that convention requires that 'where a court of a Contracting State is seised of a claim which is principally concerned with a matter over which the courts of another Contracting State have exclusive jurisdiction by virtue of Article 16, it shall declare of its own motion that it has no jurisdiction'.

15. In the further development of the set of rules attributing jurisdiction, the Convention provides for certain procedural mechanisms to govern their implementation. These mechanisms, which relate to *lis pendens* and related actions, are intended to avoid conflicting decisions between the courts of different Contracting States.

16. For example, Article 21 of the Brussels Convention, which deals with *lis pendens*, provides that where proceedings involving the same cause of action and between the same parties are brought in the courts of different Contracting States, any court other than the court first seised is required to stay its proceedings until the jurisdiction of the court first seised has been established and then, if so, to decline jurisdiction in favour of that court.

17. As regards related actions, the first and second paragraphs of Article 22 of the Brussels Convention provide 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, on the application of one of the parties, decline jurisdiction if the law of that court permits the consolidation of related actions and the court first seised has jurisdiction over both actions. The third paragraph of that article stipulates that, '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'.

18. Within the overall logic of this set of rules conferring jurisdiction or the exercise thereof, Title III of the Brussels Convention established a simplified mechanism for the recognition and enforcement of judicial decisions. This mechanism, which applies to judgments given by the courts of one Contracting State for which recognition and enforcement are sought in another Contracting State, allows only a limited range of grounds for refusing recognition, which are listed exhaustively in the Convention. These include the ground set out in Article 27(3) for instances where the judgment given in the State of origin would be 'irreconcilable with a judgment given in a dispute between the same parties in the State in which recognition is sought', and that provided for in the first paragraph of Article 28 for cases where the exclusive jurisdictional rules set out in Article 16 have been disregarded by

the court in the State in which judgment has been given.

19. Lastly, Title VII of the Brussels Convention, dealing with the relationship between the latter and other international conventions, provides in Article 57(1) that 'this Convention shall not affect any conventions to which the Contracting States are or will be parties and which, in relation to particular matters, govern jurisdiction and the recognition and enforcement of judgments'.

B — *The Munich Convention*

20. The Munich Convention came into force on 7 October 1977. Thirty-one States are currently parties, including all those that were bound by the Brussels Convention at the relevant date for the dispute in the main proceedings. [9] The Community is not a party, but it may accede in connection with the plan to create a Community patent.

21. As indicated in its first article, the Convention created '... a system of law, common to the Contracting States, for the grant of patents for invention' and established a body for that purpose, the European Patent Office (the 'EPO'), which is responsible for the centralised grant of patents termed 'European', but the territorial scope of which varies according to the wishes of the persons applying for them. [10]

22. The common rules on the grant of such patents are both substantive (relating essentially to the definition of patentable inventions) and procedural, in that they govern the procedure for the grant of such patents by the EPO and any proceedings that may subsequently be brought before other organs of the organisation to oppose the grant of a patent. Such an action, which may be brought only within a certain period following the grant of the patent concerned and may be based only on certain grounds specified in the Munich Convention, may lead to the revocation of the patent or its

9 — At present, the parties to the Munich Convention are: the Kingdom of Belgium, the French Republic, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Federal Republic of Germany, the United Kingdom of Great Britain and Northern Ireland, the Swiss Confederation, the Kingdom of Sweden, the Italian Republic, the Republic of Austria, the Principality of Liechtenstein, the Hellenic Republic, the Kingdom of Spain, the Kingdom of Denmark, the Principality of Monaco, the Portuguese Republic, Ireland, the Republic of Finland, the Republic of Cyprus, the Republic of Turkey, the Republic of Bulgaria, the Republic of Estonia, the Slovak Republic, the Czech Republic, the Republic of Slovenia, the Republic of Hungary, the Republic of Romania, the Republic of Poland, the Republic of Iceland, the Republic of Lithuania and the Republic of Latvia.

10 — Under Article 3 of the Munich Convention, 'the grant of a European patent may be requested for one or more of the Contracting States'.

maintenance as amended by the holder during the opposition proceedings. [11]

23. Outside the scope of these common rules, a European patent continues to be governed by the national legislation of each of the Contracting States for which it has been granted. In effect, once granted, a European patent becomes 'a bundle of national patents'. [12]

24. Hence, under Article 2(2) of the Munich Convention, '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, unless otherwise provided in this Convention'.

25. Similarly, Article 64(1) of that convention provides that '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'. Paragraph 3 of that article adds that 'any infringement of a European patent shall be dealt with by national law'. [13]

26. This assimilation of a European patent to a national patent means not only that it is subject to the law applicable to a national patent as regards its protection in each Contracting State for which it is granted, but also in principle (unless opposition is filed at the EPO) that disputes concerning such a patent are subject to the jurisdiction of the national courts in each Contracting State concerned.

11 — Article 99(1) of the Munich Convention provides that within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the EPO of opposition to the European patent granted. Under Article 105(1) of the Convention, in the event of an opposition to a European patent being filed, any third party who proves that proceedings for infringement of the same patent have been instituted against him may, after the opposition period has expired, intervene in the opposition proceedings, if he gives notice of intervention within three months of the date on which the infringement proceedings were instituted. Pursuant to the same article, the right to intervene is also available to any third party who proves both that the proprietor of the patent has requested that he cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent. The Enlarged Board of Appeal of the EPO stated the purpose of this mechanism as follows in its decision of 11 May 1994 in the *Allied Colloids* case (G 1/94, OJ EPO 1994 787, paragraph 7): '... by relying on the centralised procedure before the EPO in cases where infringement and revocation proceedings otherwise would have to be simultaneously pursued before national courts, an unnecessary duplication of work can be avoided, reducing also the risk of conflicting decisions on the validity of the same patent ...'.

12 — This expression, which is commonly used to define the special nature of the European patent, has been sanctioned by the appeal bodies of the EPO. See, in particular, the decision of the Enlarged Board of Appeal of the EPO of 3 November 1992 in the *Spanset* case (G 4/91, OJ EPO 1993 707, paragraph 1).

13 — In a decision of 11 December 1989 in the *Mobil Oil III* case (G 2/88, OJ EPO 1990 93, paragraph 3.3), the Enlarged Board of Appeal of the EPO clarified the meaning of this provision as follows (my italics): '... the rights conferred on the proprietor of a European patent (Article 64(1) EPC) are the legal rights which the law of a designated Contracting State may confer upon the proprietor, for example, as regards *what acts of third parties constitute infringement* of the patent, and as regards *the remedies which are available in respect of any infringement*'.

27. This principle applies both to disputes about the infringement of a European patent and to those concerning the validity of such a patent, [14] with Article 138 of the Munich Convention specifying that the revocation of a European patent by a court in a Contracting State has effect only for the territory of that State, and not for that of other Contracting States, contrary to the situation where a patent is revoked by the EPO, as such a decision applies to the territory of all the Contracting States for which the patent had been granted.

28. In proceedings for infringement of a European patent and those concerned with its validity, the question may arise as to the precise extent of protection that should be afforded to such a patent, in other words what exactly is the technical object of the title to intellectual property that the patent constitutes. [15] Article 69 of the Munich Convention lays down the manner in which that question is to be examined. Paragraph 1 of that article states that the extent of protection conferred by a European patent (or a European patent application) must be determined in the light of the terms of the claims, while specifying that the description of the invention and the related drawings are nevertheless to be used to interpret such claims. [16] In order to prevent differences of treatment between the competent authorities of the many Contracting States, a Protocol on the Interpretation of Article 69 was appended to the Munich Convention. [17]

14 — This aspect was highlighted by the Enlarged Board of Appeal of the EPO in its *Spanset* decision. For the sake of clarity, I quote paragraph 1 of the decision in full below (my italics): 'When a European patent is granted, it has the effect in each designated Contracting State of a national patent granted by that State (Articles 2 and 64(1) EPC). It thus becomes *a bundle of national patents* within the individual jurisdictions of the designated States. Any alleged infringement of a granted European patent is dealt with by national law (Article 64(3) EPC). *Infringement proceedings may be commenced by the patent proprietor in any Contracting State for which the patent was granted, at any time after grant of the patent.*
Part V of the EPC (Articles 99 to 105) sets out an "opposition procedure", under which any person may file an opposition to a granted European patent at the EPO within nine months of its grant, and may thereby contend in centralised opposition proceedings before an Opposition Division of the EPO that the patent should be revoked, on one or more stated grounds. The effect of revocation is set out in Article 68 EPC. *Opposition proceedings therefore constitute an exception to the general rule set out in paragraph 1 above that a granted European patent is no longer within the competence of the EPO but is a bundle of national patents within the competence of separate national jurisdictions.*'

15 — This question makes it possible to determine the scope of the rights of the holder of a European patent in relation to alleged infringers. It also makes it possible to establish whether the patent in question is likely to be declared void on the ground that, pursuant to Article 138(1)(d) of the Munich Convention, the protection conferred by the patent has been extended.

16 — The European patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 of the Munich Convention). The claims must define the matter for which protection is sought; they must be clear and be supported by the description of the invention (Article 84 of the Convention). The claims, the description and the drawings, which must be attached to the patent application, are disclosed in a series of EPO publications (Articles 78(1), 93 and 98 of the Convention).

17 — The Protocol, which came into effect in 1978 (that is to say, one year after the Munich Convention came into force) contains the following provisions:
'Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.'

II — Facts and procedure in the main proceedings

29. Messrs Primus and Goldenberg, who are domiciled in the United States, are joint holders of a European patent granted to them in 1992 for 10 Contracting States, namely the Republic of Austria, the Kingdom of Belgium, the Swiss Confederation, the Federal Republic of Germany, the French Republic, the United Kingdom of Great Britain and Northern Ireland, the Principality of Liechtenstein, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands and the Kingdom of Sweden.

30. The patent relates first to an immunoassay method for determining carcinoembryonic antigen (CEA) in a serum or plasma sample and secondly to equipment used to titrate these antigens, called an 'immunoassay kit' or 'CEA kit'. The invention in question appears to be of great interest for the detection or indeed treatment of certain forms of cancer.

31. In 1997 the holders of this patent and the American company Immunomedics (which appears to hold an exclusive licence on this patent) [18] applied to the Rechtbank te 's-Gravenhage (Court of First Instance, The Hague, Netherlands) for interim measures [19] against the company Roche Nederland BV, established in the Netherlands, and eight other companies of the Roche group established in the United States, Belgium, Germany, France, the United Kingdom, Switzerland, Austria and Sweden. In this action for cessation of infringement, they accused the latter of having infringed their rights conferred by the European patent of which they are holders by marketing CEA kits under the name of Cobas Core CEA EIA.

32. The order for reference shows that the eight companies established outside the Netherlands challenged the jurisdiction of the court seised and, as to the substance, denied any infringement and questioned the validity of the European patent concerned. [20]

33. In support of the plea of lack of jurisdiction, they argued, referring to the

18 — See paragraph 3 of the observations of the Netherlands Government and footnote 1 to the observations of the Commission of the European Communities.

19 — It appears that this action was brought under an emergency procedure termed 'kort geding', which may be initiated without the need to commence proceedings as to the substance. The characteristics of this procedure and the nature of some of the measures ordered in that context were examined by the Court in Case C-391/95 *Van Uden* [1998] ECR I-7091, paragraphs 43 to 47, and Case C-99/96 *Mietz* [1999] ECR I-2277, paragraphs 34 to 39 and 43. See also my Opinion in the *Van Uden* case, points 19 to 21 and 108 to 120.

20 — See pages 2 and 6 of the French version of the order for reference.

judgment of the Court in *Kalfelis*,[21] that the proper administration of justice does not, in the present case, require the simultaneous hearing and determination of actions in order to avoid the risk of irreconcilable judgments. In their view, a separate patent exists for each of the countries concerned, so that there is no risk of incompatibility between judgments.

34. By a judgment of 1 October 1997, the Rechtbank rejected that plea of lack of jurisdiction but dismissed the applicants' claims as to the substance.

35. Specifically, the Rechtbank held that, on the basis of Article 6(1) of the Brussels Convention, it had jurisdiction to hear actions against the companies established in the Contracting States other than the Netherlands. The court considered that it was also competent to hear the actions against the companies established in Switzerland and the United States on the basis of respectively Article 6(1) of the Convention of 16 September 1988 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters[22] and national law, in accordance with the first paragraph of Article 4 of the Brussels Convention.

36. With regard to Article 6(1) of the Brussels Convention, the Rechtbank rejected the defendants' argument that a separate patent existed for each country involved, on the ground that a European patent must be interpreted uniformly in all of those countries, pursuant to Article 69 of the Munich Convention, so that, in its view, it could not be found that an infringement had occurred in one country but not in the others. The court added that all the companies involved were part of the same group, so that the applications were linked, in accordance with the requirement established by the *Kalfelis* judgment. Lastly, it pointed out that, in any case, in the *Tatry* judgment[23] the Court of Justice had given to the concept of 'related actions' within the meaning of the third paragraph of Article 22 of the Brussels Convention a broad interpretation covering 'all cases where there is a risk of conflicting decisions, even if the judgments can be separately enforced and their legal consequences are not mutually exclusive'.[24] In the opinion of the Rechtbank, that applies in the present case, because the applications relate to alleged infringements of different patents but with an identical wording.

37. The applicants appealed against this judgment and broadened their claim in order to ask the court first to order the defendants to produce certain information, to recover all the infringing products from purchasers, and to destroy the preparations still held in stock

21 — Case 189/87 [1988] ECR 5565.

22 — OJ 1988 L 319, p. 9; the 'Lugano Convention'. This Convention is said to be 'parallel' to the Brussels Convention because it is almost identical in content. For example, Article 6(1) of the Convention exactly matches Article 6(1) of the Brussels Convention. The Lugano Convention is binding on all the Contracting States to the Brussels Convention as well as the Republic of Iceland, the Kingdom of Norway, the Swiss Confederation and the Republic of Poland.

23 — Case C-406/92 [1994] ECR I-5439.

24 — Ibid., paragraph 53.

and those that had been recovered and, secondly, to order the defendants to compensate them for the damage suffered or to forfeit to them the profit made by them as a result of the infringement of their patent. [25]

38. By judgment of 27 June 2002, the Gerechtshof te 's-Gravenhage (Regional Court of Appeal, The Hague) confirmed the ruling of the Rechtbank on the plea of lack of jurisdiction and the invalidity of the claims as to the substance.

39. Specifically, as to the substance, the Gerechtshof prohibited the defendants, on pain of penalty, from infringing the European patent in all the countries concerned, ordered them to provide the applicants with various items of evidence to determine the extent of the infringements at issue (quantities of the infringing products and the identities of the purchasers) and ordered them to compensate the applicants for their losses, which must be paid subsequently.

40. That judgment was declared to be provisionally enforceable, on condition that the applicants provided a security of EUR 2 million. [26]

41. The defendant companies lodged appeals in cassation with the Hoge Raad der Nederlanden. [27] Messrs Primus and Goldberg lodged a cross-appeal. [28]

III — The questions referred for a preliminary ruling

42. In the light of the arguments of the parties, which are essentially the same as those presented at the hearing at first instance, the Hoge Raad der Nederlanden decided to stay the proceedings and to 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 Contracting States?

25 — See pages 2 and 3 of the order for reference.

26 — See pages 3 and 4 of the order for reference.

27 — In order to make it easier to understand the situation of the parties to the dispute in the main proceedings, I shall continue to refer to the Roche group companies involved as 'defendants', despite their being applicants in the review proceedings.

28 — By the same token, I shall continue to refer to the holders of the patent involved as 'applicants', despite their being defendants in the review proceedings.

(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?'

IV — The meaning and scope of the questions referred

43. By these two questions, which need to be examined together, the referring court asks essentially whether Article 6(1) of the Brussels Convention should be interpreted as meaning that it is intended to be applied in an action for the infringement of a European patent involving a number of companies established in various Contracting States for acts allegedly committed on the territory of each of those States, in particular where the companies in question, belonging to the same group, allegedly acted in an identical or similar manner in accordance with a common policy supposedly laid down by one of their number.

44. As the national court points out, [29] its questions relate to the situation of the companies established in a number of Contracting States to the Brussels Convention apart from the company established in the Netherlands (that is to say, the companies established in Belgium, Germany, France, the United Kingdom, Austria and Sweden), and indirectly to the situation of the company established in Switzerland, a Contracting State to the Lugano Convention. As I have already indicated, the latter Convention extends almost all the rules laid down in the Brussels Convention to States other than those bound by that Convention (such as, in particular, Article 6(1)), so that the Court's interpretation of that article can be transposed to that of the corresponding article of the Lugano Convention.

45. As the referring court also indicates, the present referral therefore does not relate to

29 — Points 4.3.5 and 4.4 of the order for reference.

the situation of the company established in the United States, that is to say a non-signatory State (both to the Brussels Convention and to the Lugano Convention). In fact, pursuant to the first paragraph of Article 4 of the Brussels Convention, the situation of that company is, in principle, governed by the rules on jurisdiction applying in the Kingdom of the Netherlands, that is to say in the Contracting State of the court seised.

46. A further remark is called for with regard to the scope of the questions referred. From a reading of the order for reference, it appears that the main proceedings are, at the present stage, being conducted under an emergency procedure for the adoption of provisional or protective measures within the meaning of Article 24 of the Brussels Convention. [30] The referring court does not ask the Court for a preliminary ruling on the conditions for the application of Article 24, but only on those for the application of Article 6(1) of the Convention. It is generally accepted that a court having jurisdiction as to the substance of a case in accordance with Articles 2 and 5 to 18 of that convention also has jurisdiction to order any provisional or protective measures which may prove necessary, so that there is no reason to have recourse to Article 24. [31] Hence, in its questions referred for a preliminary ruling, the national court is in reality seeking to know whether the Netherlands courts have jurisdiction to hear the entire dispute in the main proceedings, at all the stages in the procedure, that is to say both as the court hearing an application for interim measures and as the court adjudicating on the substance.

47. It is also important to point out that the referring court does not ask the Court about the relationship between Article 6(1) and Article 16(4) of the Convention, which, I remind the Court, provides that 'in proceedings concerned with the registration or validity of patents ... 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 ... shall have exclusive jurisdiction, regardless of domicile'.

48. It is true that in the judgment in *Duijnstee* the Court gave a restrictive interpretation of these provisions by limiting the application of the exclusive jurisdictional rule they contain to proceedings concerned with the validity, existence or lapse of a patent or with an alleged right of priority by

30 — In Case C-261/90 *Reichert and Kockler* [1992] ECR I-2149, paragraph 34, the Court stated that these were 'measures which, in matters within the scope of the Convention, are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is sought elsewhere from the court having jurisdiction as to the substance of the matter'. The measures ordered in the judgment contested before the court of reference, or at least some of them, appear to meet that definition. This is true, in particular, of the measure prohibiting any direct infringement of the European patent concerned in any of the designated countries, since such a measure appears to be intended to preserve a factual or legal situation so as to safeguard the rights of the patent holder in relation to third parties pending their recognition by the court having jurisdiction as to the substance of the matter. The instruction to the defendants to furnish certain proof to the applicants, which is akin to a measure of inquiry, is counterbalanced by the obligation on the applicants to provide a security of EUR 2 million in order to maintain the provisional nature of the measures.

31 — See, in particular, *Van Uden*, paragraph 19, and *Mietz*, paragraph 40.

reason of an earlier deposit, to the exclusion of other proceedings, such as those for patent infringement. [32]

49. Nevertheless, it is legitimate to enquire as to the precise scope of this exclusion of proceedings for patent infringement from the field of application of Article 16(4) of the Brussels Convention.

50. More precisely, it may be asked whether this exclusion is general, so that the article in question is not intended to be applied even if, in proceedings for patent infringement, the validity of the patent concerned is contested.

51. In fact, the characterisation of an infringement of the rights of the patent holder necessarily implies that the patent in question is valid. However, most defendants in actions for infringement contest its validity. That is precisely the situation in the dispute in the main proceedings. [33] It follows that, in order to settle an infringement case, the court seised must very often rule on the validity of the patent concerned.

52. If the exclusive jurisdictional rule laid down in Article 16(4) of the Brussels Convention were applicable to such cases, only this rule would be applicable, to the exclusion of the other jurisdictional rules contained in the Convention, such as those in Article 6(1).

53. Consequently, the question whether Article 6(1) is applicable to patent infringement proceedings in which the validity of the patent concerned is contested (as in the dispute in the main proceedings) arises only if Article 16(4) of the Brussels Convention is not applicable to such a case.

54. It follows that the question whether Article 16(4) is applicable to the said case must be considered before that of the applicability of Article 6(1) of the Convention.

55. As I have already indicated, this preliminary question has been put to the Court in the *GAT* Case, which is currently pending. [34] The Court must therefore rule on this question before examining the one that is the subject of the present referral.

32 — Case 288/82 *Duijnstee* [1983] ECR 3663, paragraphs 23 to 25.

33 — The order for reference shows that the eight companies established outside the Netherlands, which are accused of infringements, did in fact dispute the validity of the European patent concerned. See point 32 of this Opinion.

34 — See point 4 of this Opinion.

56. One last point must be made to measure the scope of the questions from the national court. As several parties have pointed out, [35] the referral to the Court is part of a continuation of a recent jurisprudential trend that began in the Netherlands in the early 1990s and which has triggered a lively debate in the Contracting States, particularly in the United Kingdom, where it is viewed with serious misgivings and, as I have already indicated (in point 3 of this Opinion), led to an earlier reference for a preliminary ruling that ultimately did not come to judgment.

57. As this national jurisprudential trend is again at the root of the reference to the Court, there is some value in reviewing it briefly.

58. Initially, in the early 1990s, the Netherlands courts gave a broad interpretation to Article 6(1) of the Brussels Convention, to the point of applying it to all actions for the infringement of European patents in which a number of defendants (domiciled in the Netherlands and in other Contracting States) were accused of having committed identical or similar acts in each of these States.

35 — See the observations of the applicants (paragraphs 18 to 20), the defendants (paragraphs 50 to 56), the Netherlands Government (paragraph 12) and the United Kingdom Government (paragraphs 34 to 37).

59. Then at the end of the 1990s this case-law was applied only to cases in which the defendants were companies belonging to the same group and which had acted in accordance with a common policy allegedly formulated for the most part by the company established in the Netherlands. This new jurisprudential stance, known by the name of the theory of 'the spider in the web', therefore focuses on the respective roles of the defendants in the commission of the alleged acts. That theory, which was used by the Gerechtshof at The Hague in a fundamental judgment of 23 April 1998 in the case of *Expandable Grafts* v *Boston Scientific*, is the main inspiration behind the second question referred in the present case. This second question, which I have linked to the first by rewording them as a single question, has a direct impact on the possible maintenance of such national case-law.

60. Having thus elucidated the meaning and scope of the questions referred for a preliminary ruling, it is now time to analyse the questions together.

V — Analysis

61. Allow me to make some preliminary observations on counterfeiting before proceeding to the analysis proper of the questions from the national court.

A — *Preliminary observations on counterfeiting*

62. By its very nature, the protection of intellectual property rights has an international dimension, which has justified the adoption of several international conventions and a number of acts of derived Community law. This is only to be expected, as counterfeiting is a growing worldwide phenomenon.

63. This phenomenon affects in particular the interests of the holders of patents for inventions in the medical and pharmaceutical field. [36]

64. The cost of developing inventions in this field is generally very high, so that they must be exploited in many countries in order to earn a return on the investment. Apart from the risk to public health, counterfeiting is thus a particularly unfair competitive act that profits unduly from the efforts of the inventors where the rights of the latter are protected by a patent.

65. Although efforts to harmonise national legislative systems have been under way for several years, there is still significant disparity in the level of protection for patents for invention. Nor has this situation been lost on counterfeiters, who do not hesitate to adapt their behaviour accordingly in order to locate their activities in one country rather than another.

66. In these circumstances, it is to be hoped that the continuing disparity between national legislative systems with regard to the protection of patents for inventions is not coupled with a fragmentation of the procedures for safeguarding the rights of holders of European patents among the courts of the different Contracting States.

67. Though legitimate, this desire is not sufficient in itself, however, to justify a broad interpretation of the conditions for applying Article 6(1) of the Brussels Convention.

68. In my view, in the present state of Community and international law, Article 6(1) of the Brussels Convention is not

36 — According to the Commission's Green Paper of 15 October 1998 on combating counterfeiting and piracy in the single market (COM(98) 569 final, p. 4), the pharmaceutical industry is one of the sectors most affected by counterfeiting at the world level. In this sector, it is thought to account for 6% of total counterfeiting worldwide.

intended to be applied in an action for the infringement of a European patent involving a number of companies established in various Contracting States for acts allegedly committed on the territory of each of those States, even where the companies in question, belonging to the same group, allegedly acted in an identical or similar manner in accordance with a common policy supposedly laid down by one of their number.

69. Although this solution certainly seems rather unsatisfactory and finally reveals the limitations of the present system, it must serve for the moment, at least as at the date when the facts in the main proceedings occurred.

70. Several arguments militate in favour of a restrictive interpretation of the conditions for applying Article 6(1) of the Brussels Convention. They spring first from the nature of the connection required to apply that article; secondly from the conclusions to be drawn from this as regards actions for the infringement of European patents; thirdly from the effect that the exclusive jurisdictional rule laid down in Article 16(4) of the Convention has on the settlement of such disputes; and fourthly from the future prospects in this regard. I shall elaborate on each of these arguments in turn.

B — *The nature of the connection required for the application of Article 6(1) of the Brussels Convention*

71. In the *Kalfelis* judgment, the Court considered that 'the rule laid down in Article 6(1) ... applies where the actions brought against the various defendants are related when the proceedings are instituted, that is to say where it is expedient to hear and determine them together in order to avoid the risk of *irreconcilable* judgments resulting from separate proceedings'. [37]

72. The Court went further than the wording of Article 6(1) of the Brussels Convention, which does not require there to be any connection between the actions, in order to preserve the effectiveness of Article 2 of the Convention, which is the 'cornerstone' of the system it put in place. [38] In this way, it precluded a plaintiff from being 'at liberty 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 the defendants is domiciled'. [39]

37 — Paragraph 12 of the judgment; my italics.

38 — As the Court has stated, the importance of this jurisdictional rule lies in the fact that it makes it easier, in principle, for a defendant to defend himself (see, in particular, Case C-26/91 *Handte* [1992] ECR I-3967, paragraph 14, and Case C-412/98 *Group Josi Reinsurance* [2000] ECR I-5925, paragraph 35). It therefore helps to ensure the proper administration of justice. The Court has also stated that it is because of the guarantees given to the defendant in the original proceedings as far as respect for the rights of the defence are concerned that the Brussels Convention is very liberal in regard to the recognition and enforcement of judicial decisions (see, in particular, Case 125/79 *Denilauler* [1980] ECR 1553, paragraph 13).

39 — *Kalfelis*, paragraph 9.

73. The formula used by the Court in this judgment to depict the necessary connection between the actions matches that set out in the third paragraph of Article 22 of the Brussels Convention, which, I remind you, states that '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'.

74. Some years after the *Kalfelis* judgment, the Court gave a broad interpretation to this concept of connection within the meaning of the aforesaid Article 22. In the *Tatry* judgment, it held that 'in order to achieve proper administration of justice, that interpretation must be broad and cover all cases where there is a risk of *conflicting* decisions, even if the judgments can be separately enforced and their legal consequences are not mutually exclusive'. [40]

75. From this it concluded that 'on a proper construction of Article 22 of the [Brussels] Convention, it is sufficient, in order to establish the necessary relationship between, on the one hand, an action brought in a Contracting State by one group of cargo owners against a shipowner seeking damages for harm caused to part of the cargo carried in bulk under separate but identical contracts, and, on the other, an action in damages brought in another Contracting State against the same shipowner by the owners of another part of the cargo shipped under the same conditions and under contracts which are separate from but identical to those between the first group and the shipowner, 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'. [41]

76. In order to reach that conclusion, the Court rejected the objection that it was necessary to reserve for the expression 'irreconcilable judgments' used in the third paragraph of Article 22 of the Brussels Convention the same meaning as that given to the almost identical expression used in Article 27(3) of the Convention. [42]

77. In that regard, it based its ruling essentially on the notion that the objectives pursued by these two provisions are different.

40 — Paragraph 53 of the judgment; my italics.

41 — *Tatry*, paragraph 58.

42 — I would remind the Court that, under the aforesaid Article 27, a judgment given in one Contracting State is not recognised in another Contracting State (the State in which recognition is sought) if that 'judgment is *irreconcilable* with a judgment given in a dispute between the same parties in the State in which recognition is sought'; my italics.

78. It stated that whereas 'Article 27(3) of the [Brussels] Convention enables a court, by way of derogation from the principles and objectives of the Convention, to refuse to recognise a foreign judgment', [43] so that that article must be interpreted restrictively, 'the objective of the third paragraph of Article 22 of [that] Convention ... is ... to improve coordination of the exercise of judicial functions within the Community and to avoid conflicting and contradictory decisions, even where the separate enforcement of each of them is not precluded', so that this article has to be interpreted in a broad sense. [44]

79. One may ask whether it would not be appropriate to adopt a comparable reasoning to determine the nature of the connection required in order to apply Article 6(1) of the Brussels Convention.

80. In fact, although this article may be considered to pursue the same objective as Article 22 of the Brussels Convention on account of the mechanism for consolidating proceedings for which it provides, in my opinion the similarity ends there. In my view, there are two fundamental differences between the two articles. The first relates to their effect on the application of the general jurisdictional rule laid down in Article 2 of that convention, and the second relates to the means by which they are implemented.

81. It has to be acknowledged that the effect of the mechanism provided for in Article 6(1) of the Brussels Convention on the application of Article 2 thereof is particularly important. The creation of this mechanism rests on the notion that the jurisdiction of the courts of the Contracting State in which a defendant is domiciled is sufficiently strong to justify extending that jurisdiction to apply to co-defendants domiciled in other Contracting States. The end result of such a mechanism for extending jurisdiction is systematically to deprive the latter of their natural jurisdiction and thus paradoxically to prejudice the application of Article 2 to them.

82. In contrast to the situation with Article 6(1), the effect of the mechanism provided for in Article 22 of the Brussels Convention on the application of Article 2 thereof is not systematic.

83. Indeed, like Article 21 of the Brussels Convention on *lis pendens*, Article 22 is intended to be applied not only where the jurisdiction of the court second seised is determined by that convention, in particular

43 — *Tatry*, paragraph 55.
44 — Ibid.

by Article 2, but also where it derives from the legislation of a Contracting State, in accordance with Article 4 of that convention.[45] It follows that the mechanism provided for in Article 22 may have no effect whatsoever on the application of Article 2.

84. What is more, even if the jurisdiction of the court second seised were based on Article 2, it would not be certain that recourse to the mechanism set out in Article 22 of the Brussels Convention would lead to that court declining jurisdiction and would thus have the effect of depriving the defendant concerned of a court in the Contracting State in which he was domiciled.

85. It will be recalled that Article 22 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, either stay its proceedings or, on the application of one of the parties, decline jurisdiction if the law of that court permits the consolidation of related actions and the court first seised has jurisdiction over both actions. These provisions of the Convention give the court second seised a simple option, whereby it can also decide to adjudicate as to the substance without taking account of the parallel proceedings previously initiated in another Contracting State.[46]

86. Hence, if the court second seised is competent on the basis of Article 2 of the Brussels Convention because the defendant or one of the defendants is domiciled in the Contracting State where it officiates, that court may, pursuant to Article 22 of the Convention, decline to exercise its jurisdiction by deciding, on the application of one of the parties, not to proceed, it may stay proceedings pending delivery of the judgment by the court first seised, or it may settle the action immediately without staying its proceedings.

87. The removal of a defendant or one of the defendants from the jurisdiction of a court in the Contracting State in which he is domiciled as a result of the second court seised declining jurisdiction pursuant to Article 22 of the said Convention is therefore anything but systematic, contrary to the situation where there is recourse to Article 6(1), as we have already seen.

45 — See, to that effect, point 149 of my Opinion in Case C-281/02 *Owusu* [2005] ECR I-1383.

46 — See, to that effect, in particular, Gaudemet-Tallon, H., *Compétence et exécution des jugements en Europe*, L. G. D. J., Third edition, 2002, p. 277.

88. In my view, this difference between Articles 6(1) and 22 of the Brussels Convention as regards their effect on the scope of Article 2 of that convention justifies the different conditions of connectedness required for their respective application.

89. While it is easy to assert that a broad interpretation of the concept of connection within the meaning of Article 22 of the said Convention, in accordance with the *Tatry* judgment, is not likely to undermine the effectiveness of Article 2 thereof, the same cannot be said of the interpretation of the concept of connection in the context of the application of Article 6(1). It has to be recognised that, in this particular setting, a broad interpretation would inevitably lead to a significant reduction in the situations in which Article 2 would be applied (as far as the co-defendants are concerned).

90. According to settled case-law, the Court has always been at pains to interpret strictly the rules on special jurisdictions enumerated in Articles 5 and 6 of the Brussels Convention, as they constitute derogations from the general or fundamental principle that jurisdiction is vested in the courts of the State where the defendant is domiciled, as set out in Article 2 of that convention, which, let it be remembered, contributes greatly to ensuring the proper administration of justice. [47] As we have seen, in the *Kalfelis* judgment, this concern even led the Court to go further than the wording of Article 6(1) by making its application conditional on there being a connection between the actions. This settled case-law points towards a restrictive acceptation of the concept of related actions in order to circumscribe the application of Article 6(1) even more closely.

91. Another significant difference between the mechanism for consolidating proceedings provided for in Article 6(1) of the Brussels Convention and that laid down in Article 22 thereof derives from their respective means of implementation, and it strengthens my conviction that it is preferable not to transpose to the application of Article 6(1) the broad interpretation of the concept of 'related actions' within the meaning of Article 22 that the Court gave in the *Tatry* judgment.

92. It is important to bear in mind that the option for the second court seised to decline jurisdiction pursuant to Article 22 of the Brussels Convention rests entirely with that court, and not with the applicant, who may only make application to that effect.

93. This decision by the court to decline jurisdiction over the case is necessarily

47 — See, in particular, *Kalfelis*, paragraph 19 ; Case C-364/93 *Marinari* [1995] ECR I-2719, paragraph 13 ; Case C-51/97 *Réunion européenne and Others* [1998] ECR I-6511, paragraph 29 ; and Case C-168/02 *Kronhofer* [2004] ECR I-6009, paragraphs 13 and 14.

inspired by considerations regarding the proper administration of justice, whether to avoid inconsistency between judicial decisions given in different Contracting States or possibly to allow the dispute to be settled by a court in another Contracting State that has already been seised and whose jurisdiction is established if it would be objectively better placed to hear it. [48]

94. From this point of view, the mechanism for consolidating proceedings set out in Article 6(1) of the Brussels Convention is significantly different from that provided for in Article 22 of the Convention.

95. The decision to apply Article 6(1) of the said Convention rests solely with the applicant, and not with the court. Furthermore, and correlatively, although that decision may be motivated by a legitimate concern for procedural economy, it may equally spring from considerations that are more questionable — when measured against the requirements associated with the proper administration of justice or the effective organisation of proceedings — than those that lead an applicant, by virtue of Article 5(3) of that convention, to bring his proceedings in the court of the place giving rise to the damage and/or the place where the damage occurred rather than in a court of the Contracting State where the defendant is domiciled.

96. Hence, the decision of the applicant to bring his action, pursuant to Article 6(1), in a court of a particular Contracting State (the State in which a defendant is domiciled) rather than those of one or several other Contracting States where the co-defendants or one of their number is domiciled may be taken purely in order to benefit from the application of a law, or even of case-law, that is more favourable to the protection of his own interests, to the detriment of those of the defendants, and not in order to meet an objective need from the point of view of proof or the effective organisation of the proceedings.

97. Actions for patent infringement lend themselves particularly to this type of 'forum shopping' because of the major disparities that still exist between national legislative systems in this respect, whether they be procedural (especially with regard to the obtaining and preservation of evidence, which often play a key role in such cases) or substantive (reprehensible acts, penalties,

48 — This would be the case, for example, where an action for liability in delict or quasi-delict were brought not only in a court of the Contracting State where the defendant or one of the defendants was domiciled (on the basis of Article 2 of the Brussels Convention) but also in a court of another Contracting State, where the harmful event and/or the damage occurred (on the basis of Article 5(3) of the Convention). From the point of view of the examination of evidence, the latter court would be better placed than the court of the Contracting State where the defendant or one of the defendants was domiciled to assess whether, in the circumstances of the case, the facts constituting liability were present. See, in this regard, Case 21/76 *Bier (Mines de potasse d'Alsace)* [1976] ECR 1735, paragraphs 15 to 17.

compensation measures),[49] even if in principle the substantive law applicable in such disputes is not the *lex fori* (that applicable in the Contracting State of the court seised) but the *lex loci protectionis* (that is to say, the law applicable in the Contracting State where the patent was granted, in other words the State in which protection of the patent holder's rights is foreseen and claimed), so that in theory the choice of jurisdiction does not affect the determination of the substantive law applicable (contrary to what is always the case for procedural law).[50]

98. In the context of the main proceedings, it may be assumed that the effectiveness of the 'kort geding' procedure and the state of Netherlands case-law since the beginning of the 1990s (which favoured a broad application of Article 6(1) of the Brussels Convention)[51] were factors in the decision of the holders of the patent involved (who are domiciled in the United States and not in the Netherlands) to bring their action in a Netherlands court (rather than a Belgian, German, French, British, Swiss, Austrian or Swedish court).[52]

99. Although it is difficult to criticise the plaintiff in an infringement action for indulging in 'forum shopping' in order best to defend his interests, nevertheless in my opinion, given the significant differences in logic between Articles 6(1) and 22 of the Brussels Convention, the requirements associated with the proper administration of justice that justify the consolidation of proceedings are not as stringent for the application of Article 6(1) as they are for that of Article 22.

100. In these circumstances, I am inclined to think that, as the defendants in the main proceedings and the United Kingdom Gov-

49 — As stated in the seventh recital in the preamble to Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 195, p. 16, corrected version):
'It emerges from the consultations held by the Commission ... that, in the Member States, and despite the TRIPS Agreement, there are still major disparities as regards the means of enforcing intellectual property rights. For instance, the arrangements for applying provisional measures, which are used in particular to preserve evidence, the calculation of damages, or the arrangements for applying injunctions, vary widely from one Member State to another. In some Member States, there are no measures, procedures and remedies such as the right of information and the recall, at the infringer's expense, of the infringing goods placed on the market.'
Although this directive (which the Member States must transpose before 29 April 2006) aims to approximate national legislative systems so as to ensure a high level of protection of intellectual property rights, it does not perform a complete harmonisation in this regard, so that there is a risk that some of the current disparities will persist, especially with regard to the penalty for unintentional infringement and the criminal prosecution of infringements.

50 — The rule stipulating the application of *lex loci protectionis*, which stems from the traditional territorial principle of intellectual property rights and occurs in several previous international agreements (such as the Paris Convention for the Protection of Industrial Property of 20 March 1883, WIPO Publication No 201), is foreseen in Article 8 of the proposal for a regulation of the European Parliament and the Council on the law applicable to non-contractual obligations ('ROME II') (proposal of 22 July 2003 under negotiation, COM(2003) 427 final), which is intended to be applied to infringements of intellectual property rights.

51 — See point 58 of this Opinion.

52 — With regard to the attractiveness of the Netherlands courts at the time of the facts in the main proceedings, see Véron, P., 'Trente ans d'application de la Convention de Bruxelles à l'action en contrefaçon de brevet d'invention', *Journal du droit international*, Éditions du juris-classeur, Paris, 2001, pp. 812 and 813.

ernment maintain, the conditions for applying Article 6(1) of the Convention should not be construed as broadly as those set by the *Tatry* judgment for the application of Article 22 of the Convention.

101. Hence, in my view, it would be preferable to adhere to the formula used by the Court in the *Kalfelis* judgment, which, I would remind you, makes the application of Article 6(1) subject to the condition that 'the actions brought against the various defendants are related when the proceedings are instituted, that is to say where it is expedient to hear and determine them together in order to avoid the risk of *irreconcilable* judgments [and not just *conflicting* ones within the meaning of the *Tatry* judgment] resulting from separate proceedings'. [53]

102. Moreover, it is interesting to note that neither the Court nor the Community legislature has departed from this formula for the application of Article 6(1) of the Brussels Convention or for that 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 that convention.

53 — *Kalfelis*, paragraph 12; my italics.

103. Indeed, in the judgment in *Réunion européenne and Others*, which came several years after the *Tatry* judgment, the Court based itself solely on the *Kalfelis* judgment and on the definition of the connection that the Court required in that judgment for the application of Article 6(1) of the Brussels Convention [54] in order to rule that 'two claims in one action for compensation, directed against different defendants and based in one instance on contractual liability and in the other on liability in tort or delict, cannot be regarded as connected'. [55]

104. Regulation No 44/2001, for its part, merely reiterates in identical terms the formula used by the Court in the *Kalfelis* judgment, without taking account of the developments stemming from the *Tatry* judgment. [56]

105. These recent items of case-law and legislation strengthen me in my belief that, as far as the application of Article 6(1) of the Brussels Convention is concerned, it is preferable to adhere to the definition of related actions adopted by the Court in the *Kalfelis* judgment.

54 — See *Réunion européenne and Others*, paragraph 48.

55 — Ibid., paragraph 50.

56 — This regulation is not applicable to the dispute in the main proceedings, as the latter stems from an action brought before that regulation came into force. Article 6(1) of the regulation provides that 'a person domiciled in a Member 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, 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'.

106. What concrete conclusions should be drawn from the nature of the connection required in order to apply Article 6(1) in actions for the infringement of European patents such as the one before the referring court? That is what we are about to see.

C — *The conclusions to be drawn from the nature of the connection required in order to apply Article 6(1) of the Brussels Convention as regards actions for the infringement of European patents such as the one before the referring court*

107. If, as I suggest, the Court adheres to the definition of related actions adopted by the Court in the *Kalfelis* judgment, a simple answer springs immediately to mind: Article 6(1) of the Brussels Convention is not intended to apply to actions for the infringement of European patents such as the one before the referring court where the connection required for its application is not present.

108. In an action for the infringement of a European patent involving a number of defendants domiciled in various Contracting States for alleged infringements committed by each of them in each Contracting State where each of them is domiciled, it is undoubtedly possible that, unless such an action is consolidated at the court of the State in which one of the defendants is domiciled, diverging decisions will be given for the various defendants (by the courts of the various Contracting States in which these defendants are domiciled), for example as to the description of the infringements of which they are accused, the adoption of measures to preserve evidence or the determination of the amount of compensation for the damage suffered by the applicant.

109. Nevertheless, in this scenario, however divergent such decisions may be, they are not necessarily mutually irreconcilable or incompatible. First, as the defendants concerned by each of these decisions are different, the decisions may be enforced separately and simultaneously for each of them. Secondly, the legal consequences of these decisions are not mutually exclusive, because in this scenario each of the courts seised rules only on the alleged infringements of the rights of the patent holder in each of the Contracting States over which these courts have jurisdiction, so that the legal consequences of each of these decisions cover a different territory.

110. It follows that the connection required by the Court in the *Kalfelis* judgment is not present. In accordance with that case-law, Article 6(1) of the Brussels Convention is

therefore not intended to be applied to this scenario.

111. In my view, in any case, the same would also be true even if, contrary to my analysis, the *Tatry* case-law with regard to Article 22 of that convention were transposed to Article 6(1).

112. Along with the United Kingdom Government and the Commission, I consider that, in an action for the infringement of a European patent, it would be an exaggeration to speak of a risk of conflicting decisions within the meaning of the *Tatry* judgment.

113. I have difficulty imagining that a judgment could be considered to conflict with another solely because there was a simple divergence in the solution of the dispute, that is to say in the outcome of the proceedings. For there to be conflict between decisions, I believe that such a divergence must arise in the context of the same situation of law and fact. It is only in that case that one can imagine there to be a conflict between decisions, since courts have reached diverging or even diametrically opposed judgments on the basis of the same situation of law and fact. [57]

114. As I have already indicated, [58] outside the scope of the common rules laid down in the Munich Convention on the Grant of European Patents, such a patent continues to be governed by the national legislation of each of the Contracting States for which it has been granted. Once granted, a European patent becomes 'a bundle of national patents'.

115. Hence, under Article 2(2) of the Munich Convention, '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, unless otherwise provided in this Convention'.

116. Similarly, Article 64(1) of the Convention provides that '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'. Paragraph 3 of that article adds that 'any infringement of a European patent shall be dealt with by national law'.

57 — See, to that effect, points 28 and 29 of the Opinion of Advocate General Tesauro in the *Tatry* case.

58 — See points 23 and 25 of this Opinion.

117. It is clear from the combination of these provisions of the Munich Convention that an action for the infringement of a European patent brought against a number of defendants domiciled in various Contracting States for acts allegedly committed on the territory of each of those States must be examined by reference to the national legislation on this matter in each of those States for which the patent concerned has been granted.

118. As I have already indicated, however, major disparities still exist within the European Union between national legislative systems with regard to counterfeiting, whether they be procedural (especially with regard to the obtaining and preservation of evidence, which often play a key role in such cases) or substantive (reprehensible acts, penalties, compensation measures), and it should be remembered that in principle the substantive law applicable in such disputes is the *lex loci protectionis* (that is to say, the law applicable in the Contracting State in which protection of the patent holder's rights is foreseen and claimed).

119. It must therefore be found that, in the context of actions for the infringement of European patents such as the one before the referring court, any divergences between decisions given in different Contracting States do not arise in the same situation of law.

120. This finding cannot be called into question by the existence of common guidelines used by the States party to the Munich Convention to determine, in accordance with Article 69 of that convention, the extent of the protection conferred by a European patent. [59] In spite of the value that the laying-down of such guidelines as a result of the adoption of the Protocol on the Interpretation of Article 69 may have for actions for the infringement of European patents, it remains a fact that the protocol in question relates solely to the *substantive* scope of the protection conferred by a particular European patent, in other words the *technical* object of the industrial property that the said patent constitutes. That is a not the same as the question of the *legal* scope of the rights conferred on the holder of a European patent, which continues to be governed by different national legislative systems.

121. It follows that, as the French Government has pointed out, where a number of courts in various Contracting States are seised of such an action, by definition the divergent decisions that may result cannot be described as contradictory. Without the risk of conflicting decisions, it is therefore not appropriate, if one takes one's cue from the *Tatry* judgment, to apply Article 6(1) of the Brussels Convention.

59 — See point 28 of this Opinion.

122. In my opinion, this conclusion even applies in the situation (set out by the referring court in its second question) where the defendant companies belong to the same group and allegedly act in an identical or similar manner in accordance with a common policy supposedly laid down by one of their number, so that the factual situation would be one and the same.

123. This potential unity or homogeneity of factual situations in no way affects the diversity of legal situations resulting from the current disparity in national legislative systems regarding counterfeiting.

124. After all, to accept that Article 6(1) of the Brussels Convention is intended to be applied in such a situation for the sole reason that the factual situation is the same would not be satisfactory, in my opinion, in relation to the objectives of the Convention, which are to strengthen the legal protection of persons established in the Community and to provide legal certainty.

125. Strengthening the legal protection of persons established in the Community means that the common rules on jurisdiction laid down by the Brussels Convention at the same time allow 'the plaintiff *easily* to identify the court before which he may bring an action and the defendant *reasonably* to foresee the court before which he may be sued'. [60] The Court has described these rules as being designed 'to guarantee *certainty* as to the allocation of jurisdiction among the various national courts before which proceedings in a particular case may be brought'. [61] Only jurisdictional rules that meet these requirements are capable of guaranteeing respect for the principle of legal certainty, which, in accordance with settled case-law, [62] is one of the objectives of that convention.

126. In accordance with this logic, the Court has held that 'the principle of legal certainty requires, in particular, that the jurisdictional rules which derogate from the general rule laid down in Article 2 of the Brussels Convention should be interpreted in such a way as to enable a normally well-informed defendant reasonably to foresee before which courts, other than those of the State in which he is domiciled, he may be sued'. [63]

60 — See, in particular, Case C-125/92 *Mulox IBC* [1993] ECR I-4075, paragraph 11; Case C-269/95 *Benincasa* [1997] ECR I-3767, paragraph 26; Case C-334/00 *Tacconi* [2002] ECR I-7357, paragraph 20; Case C-18/02 *DFDS Torline* [2004] ECR I-1417, paragraph 36; and also *Kronhofer*, paragraph 20, and *Owusu*, paragraph 40.

61 — See, in particular, Case C-288/92 *Custom Made Commercial* [1994] ECR I-2913, paragraph 15; Case C-256/00 *Besix* [2002] ECR I-1699, paragraph 25; and *Owusu*, paragraph 39.

62 — See, in particular, Case 38/81 *Effer* [1982] ECR 825, paragraph 6; *Custom Made Commercial*, paragraph 18; Case C-440/97 *GIE Groupe Concorde and Others* [1999] ECR I-6307, paragraph 23; *Besix*, paragraphs 24 to 26; Case C-80/00 *Italian Leather* [2002] ECR I-4995, paragraph 51; and *Owusu*, paragraph 38.

63 — *Owusu*, paragraph 40 and the case-law cited.

127. In my opinion, to make the application of Article 6(1) of the Brussels Convention dependent on the actions being associated with the same factual situation, in accordance with the various criteria of association referred to by the referring court, would not be sufficient to ensure the predictability of the jurisdictional rules laid down in that convention.

128. On the supposition that the defendant companies belong to the same group and that the infringements of which they are accused are identical or similar, it is not easy, either for the applicant or for the court, to establish whether such acts are the result of collusion between the companies in question or of a common policy defined within the group.

129. It is no different when it comes to determining the respective roles that the companies in question played in defining an alleged common policy with a view to identifying 'the spider in the web'. That question may well prove to be a breeding ground for disputes among the parties, even among the defendants themselves. To base the application of Article 6(1) of the Brussels Convention on the principle that the courts with jurisdiction are those in the State where the company that played a central role in defining the common policy at the root of the alleged infringements is established would, in my opinion, run counter to the requirements of predictability or certainty laid down by the Court for interpreting the jurisdictional rules established by the Convention.

130. In the light of these various factors, I consider that Article 6(1) of the Brussels Convention is not intended to be applied in an action for the infringement of a European patent involving a number of companies established in various Contracting States for acts allegedly committed on the territory of each of those States, even where the companies in question, belonging to the same group, allegedly acted in an identical or similar manner, in concert or in accordance with a common policy supposedly laid down by one of their number.

131. The effect that the exclusive jurisdictional rule laid down in Article 16(4) of that convention has on the settlement of actions for the infringement of European patents strengthens my confidence in this analysis. This is what I shall now examine briefly in an elaboration of my comments on this point as to the meaning and scope of the questions referred.

D — *The effect of the exclusive jurisdictional rule laid down in Article 16(4) of the Brussels Convention on the settlement of actions for the infringement of European patents*

132. Even if in the *GAT* case the Court were to rule that Article 16(4) of the Brussels Convention is not intended to apply to an action for the infringement of a European patent in which the validity of the patent concerned is disputed, that article would not be stripped of all effect on the settlement of such an action.

133. As illustrated by the case of *Boston Scientific and Others*, which led to an earlier reference for a preliminary ruling that was eventually withdrawn, [64] it can happen that proceedings for revocation of a European patent are instigated before or after an action for the infringement of the patent in question has been brought. In those circumstances, the operation of Article 16(4) inevitably leads to the fragmentation of the action relating to the said patent, which cannot be overcome by having recourse to the mechanism set out in Article 22 of the Brussels Convention regarding related actions.

134. Hence, where proceedings to revoke a European patent are instituted (in the courts of the various Contracting States for which the patent in question has been granted, in accordance with Article 16(4) of the Brussels Convention) before an action for infringement of the same patent is brought (in the case of a number of defendants, in the courts of the State in which one of them is domiciled, on the supposed basis of Article 6(1) of the said Convention) for acts allegedly committed in each of the said States, [65] it is highly likely that, if the claim for revocation of the patent is raised as a defence plea, the court seised of the latter action (on the supposition that it has jurisdiction on the supposed basis of Article 6(1), which I dispute) will decide, in accordance with Article 22 of the Convention, to stay its proceedings (pending delivery of the judgments relating to the validity of the patent in question in each of these Contracting States) or may decline jurisdiction over the action (which would therefore pass to the various courts seised of the proceedings for revocation of the patent).

135. It follows that in this situation recourse to Article 6(1) of the Brussels Convention in order to consolidate an action for the infringement of a European patent in the courts of the State in which one of the defendants is domiciled, and hence avoid the delays and costs inherent in the splitting of such a dispute between the courts of different Contracting States, would not be a great help.

64 — See point 3 of this Opinion.

65 — This corresponds to a well-known strategy know as a 'torpedo', in which an undertaking that feels vulnerable to an action for infringement initiates proceedings for revocation of the patent concerned in order to delay possible proceedings for infringement.

136. The same would apply in the converse situation, in which an action for the infringement of a European patent were instituted (in the courts of the State in which one of the defendants was domiciled, on the supposed basis of Article 6(1)) for acts allegedly committed in each of the Contracting States for which the patent in question had been granted, before proceedings for revocation of the patent were brought (in the courts of the various Contracting States for which the patent had been granted, in accordance with Article 16(4) of the Brussels Convention).

137. In this scenario, it is also highly likely that the court first seised (of the action for infringement in which a claim for revocation of a European patent was raised) will decide (on the supposition that it has jurisdiction on the supposed basis of Article 6(1), which I dispute) to stay its proceedings pending delivery of the judgments relating to the validity of the patent in question, it being clear that the courts subsequently seised of the actions for revocation of the patent would not be entitled, on the basis of Article 22 of the Brussels Convention, to decline jurisdiction for such actions, since pursuant to Article 16(4) thereof they have exclusive jurisdiction to hear them.

138. Here too, recourse to Article 6(1) of the Brussels Convention in order to consolidate an action for the infringement of a European patent in the courts of the State in which one of the defendants is domiciled, and hence avoid the delays and costs inherent in the splitting of such a dispute between the courts of different Contracting States, would not be a great help.

139. These different scenarios highlight the limitations of the present system for allocating jurisdiction for actions for the infringement of European patents. However, this situation is likely to change in future as a result of negotiations that are currently under way, both within the Community and within the European Patent Organisation.

E — *The future prospects regarding the jurisdictional rules on actions for the infringement of European patents*

140. A number of negotiations are under way with a view to centralising patent litigation.

141. The first negotiations have been undertaken within the European Patent Organisation following an intergovernmental confer-

ence held in Paris in June 1999. A working party was formed to produce a draft agreement on the establishment of a European patent litigation system. [66] The work carried out in this forum culminated, in February 2004, in the adoption of such a draft agreement, which is due to be debated at a future intergovernmental conference.

142. Building on these negotiations and those that had already been conducted within the Community, [67] on 1 August 2000 the Commission submitted a proposal for a Council regulation on the Community patent. [68] It is proposed that the Court be granted jurisdiction over all actions relating to the infringement and validity of the future Community patent, which would be granted by the EPO for all the territories of the Member States of the Community. To that end, a proposal for a Council decision conferring jurisdiction on the Court in disputes relating to the Community patent and a proposal for a Council decision establishing the Community Patent Court and concerning appeals before the Court of First Instance of the European Communities were presented by the Commission at the end of 2003. [69]

143. In my view, it is solely in the framework of these negotiations that it is appropriate to improve the current system for allocating jurisdiction for actions for the infringement of European patents.

144. To sum up these various expositions, in my opinion the answer to the questions referred for a preliminary ruling should be that Article 6(1) of the Brussels Convention should be interpreted as meaning that it is not intended to be applied in an action for the infringement of a European patent involving a number of companies established in various Contracting States for acts allegedly committed on the territory of each of those States, even where the companies in question, belonging to the same group, allegedly acted in an identical or similar manner in accordance with a common policy supposedly laid down by one of their number.

66 — The draft agreement can be found at the EPO website (http://www.european-patent-office.org/epo/epla/index.htm).

67 — Two international agreements between the Member States have been adopted but have never come into force. They are the 76/76/EEC Convention for the European Patent for the Common Market, signed in Luxembourg on 15 December 1975 (OJ 1976 L 17, p. 1), and the 89/695/EEC Agreement relating to Community patents, done at Luxembourg on 15 December 1989 (OJ 1989 L 401, p. 1).

68 — OJ 2000 C 337 E, p. 278.

69 — See COM(2003) 827 final and COM(2003) 828 final respectively.

VI — Conclusion

145. In the light of all the foregoing considerations, I propose that the Court reply as follows to the questions submitted for a preliminary ruling by the Hoge Raad der Nederlanden:

'Article 6(1) of the Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, as amended by the Convention of 9 October 1978 on the Accession of the Kingdom of Denmark, of Ireland and of the United Kingdom of Great Britain and Northern Ireland, by the Convention of 25 October 1982 on the Accession of the Hellenic Republic, by the Convention of 26 May 1989 on the Accession of the Kingdom of Spain and the Portuguese Republic 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, should be interpreted as meaning that it is not intended to be applied in an action for the infringement of a European patent involving a number of companies established in various Contracting States for acts allegedly committed on the territory of each of those States, even where the companies in question, belonging to the same group, allegedly acted in an identical or similar manner in accordance with a common policy supposedly laid down by one of their number.'