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Intellectual Property Puts Article 6(1) Brussels I Regulation to the Test

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1. Introduction

The contrast between national intellectual property rights, which are still granted on the basis of the territoriality principle, and which, as a consequence, logically produce on the one hand parallel rights in several countries and on the other hand the international exploitation of such rights, results in a scenario where similar violations, mostly performed by defendants with a mutual relationship between them, give rise to claims based on similar national provisions on intellectual property. Article 2 of Brussels I Regulation allows for the separate prosecution of every defendant in the country where he or she resides. Although Article 5(3) provides for an alternative solution, the standard scenario involves a multitude of claims submitted country by country, apparently as a logical consequence of the territoriality principle.¹

Intellectual Property has been the object of considerable harmonization over the years, on the basis of both international treaties and European Union law. Without going too much into details, it is obvious that the combination of territorial (national) intellectual property rights and their exploitation beyond national boundaries raises questions related with the possible application of Article 6(1) of the Brussels I Regulation. A *forum connexitatis* offers in fact the possibility to pursue the infringement of what, from a commercial point of view, is often considered as a single right, rather than a bundle of parallel national intellectual property rights. Thus, the patent infringement performed in a uniform manner, for example by the commercialization of a copy of the patented product by related defendants, is pursued as a single case before a single court. Article 6(1) offers therefore an interesting opportunity in a number of intellectual property cases. However, Article 6(1) is principally targeted at defendants residing in different Member States acting with a common agenda,² and this is in contrast with the most common scenario of intellectual property rights infringement, which involves both parallel rights and defendants that act (individually) in a parallel fashion, whether or not they act within a group of companies.

Hopes that the recent reform of the Brussels I Regulation would bring clarification on this point, since the existing jurisprudence of the European Court of Justice was not generally supported by intellectual property doctrine and practitioners, have unfortunately not been fulfilled. Except for the fact that the concerned defendant is now expressly defined, nothing changes in the existing text of the Article 6(1) which now becomes Article 8(1).³ Legal practice must therefore continue to work with the following text of the new Article 8 (the new fragment is within parenthesis):

'[A person domiciled in a Member State] may also be sued:

1. where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings;

2.[...]'

¹ See J.J. Fawcett and P. Torremans, *Intellectual Property and Private International Law*, (2nd ed., 2011), Oxford: Oxford University Press, Ch. 5.

² For example: *Pearce v. Ove Arup Partnership Ltd* [2000] Ch 403 and *Chiron Corp. v. Evans Medical Ltd and Others* [1996] FSR 863.

³ See <http://register.consilium.europa.eu/pdf/nl/12/pe00/pe00056.nl12.pdf>.

Debating the causes of this *status quo* is not very useful for legal practice. Whether it is an absence of consensus on a modified text or a confirmation of the Court's interpretation of Article 6(1) is of limited interest. Legal practice must in fact continue working with the existing jurisprudence of the Court.⁴ This contribution attempts therefore to clarify the Court's current position.

2. The Starting Point: *Roche Nederland*

A lot has been written about *Roche Nederland*.⁵ At the very least, one can state that this judgment is controversial,⁶ but it is nonetheless the starting point of the debate. This was the first time that the Court had received a case aiming at the potential application of Article 6(1) of the Brussels I Regulation in a case concerning intellectual property rights. In short, Primus and Goldenberg had filed an application for a European patent; and they had obtained a patent, according to the European Patent Convention, as a bundle of national patents. They claimed that the Roche group had infringed their European patent. In practice the infringement was performed in each country, every time by the local branch of the Roche group, but the case was handled and coordinated by the group's central unit. Therefore, it would have been useful for Primus and Goldenberg to have the whole case treated by a single court. This was also possible because Dutch courts had developed for the purposes of Article 6(1) the so-called 'spider in the web' doctrine.⁷ The *Roche* case seemed to be a typical case. The spider's web of patent infringement had been weaved, or at least conceived, by the central unit of the group. The local branches merely carried out this strategy. Why not to entrust the coordinated infringement of the European patent to a single court, the court of the spider, whose competence was recognised by Article 6(1)?

Yet, was the existence of a spider at the centre of the web of patent infringement the right starting point? According to the text of Article 6(1), the presence of a spider implies a link between the claims, doubtlessly a close link. However, this is not what Article 6(1) requires. Article 6(1) requires that the cases 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'. A risk of irreconcilable judgments is the *conditio sine qua non* to apply Article 6(1) which constitutes a derogation to Article 2 and takes away one or more defendants from the *forum* of their domicile. Different judges can rule differently on a particular case, even if their decision is grounded on the same facts and on the same law. But Article 6(1) does not have the purpose to prevent such divergence. The only risk that needs to be averted is that of contradictory judgments that are incompatible between them. This risk exists only if two judges of two countries decide, on each side, on the same factual and legal situation.⁸ If we take an example from the field of intellectual property rights, this risk exists if the defendant A, domiciled in X, together with the defendant B, domiciled in Y, manufactures in Z reproductions of an artwork by an author, without the author's authorization, and puts them on the market. If a judge in country X exerts her jurisdiction on the basis of Article 2 of the Brussels I Regulation over defendant A, and another judge in the country Y does the same in relation to defendant B, both judges would decide the same dispute. In this case there is the risk that the same activity performed together in the country Z by the two parties (and to which the law of

⁴ J.J. Fawcett and P. Torremans, *Intellectual Property and Private International Law*, above, para. 5.115 et seq.; for the national jurisprudence see M. Pertegas-Sender, *Cross-Border Enforcement of Patent Rights*, Oxford: Oxford University Press, paras. 3.19-3.55 and C. Gonzalez-Beilfuss, 'Is there any Web for the spider? Jurisdiction over co-defendants after Roche Nederland' in A. Nuyts (ed), *International Litigation in Intellectual Property and Information Technology*, Ch. 4, pp. 81-83.

⁵ Case C-539/03 *Roche Nederland BV et al v Frederick Primus and Milton Goldenberg* [2006] ECR I-6535.

⁶ J.J. Fawcett and P. Torremans, *Intellectual Property and Private International Law*, above, para. 11.05 et seq. and A. Kur, 'A Farewell to Crossborder Injunctions? The ECJ Decisions GAT v. LuK and Roche Nederland v. Primus and Goldenberg' 37(2006) *IIC*, pp. 844 – 855.

⁷ Court of Appeal of The Hague, *Expandable Grafts Partnership v. Boston Scientific BV* [1999] FSR 352.

⁸ Case C-539/03 *Roche Nederland BV et al v Frederick Primus and Milton Goldenberg* [2006] ECR I-6535 para. 26.

Z if probably applicable) is considered by one of the judges as an infringement and by the other judge as a perfectly lawful activity. These decisions would therefore be incompatible between them.⁹

The Court of Justice has ruled, in *Roche Nederland*, that the condition of the same factual situation was not met.¹⁰ According to the Court each branch operated in a separate country and the details of the patent infringement were different in each country. The infringing activity was also performed in different countries by each defendant. In other words, there was no joint activity in a particular country, and there were no overlapping infringing activities or defendants. There were purely parallel factual situations, territorial and national. In addition, the Court argued that this case was not even subject to the same law, because the European patent consists of a number of national patents and is granted as such. Each of these patents is subject to national patent law and these patents are independent from each other. This is certainly the case when patent infringement is expressly covered by national law.¹¹

If we are ready to follow the analysis of the Court on this point, there is no question of irreconcilable judgments. Every defendant must answer for her deeds in a specific factual and legal situation. There is no factual situation involving several defendants jointly, and every form of overlapping is avoided. The need for claims 'closely connected' cannot be demonstrated despite the similarities among national cases, and Article 6(1) is not applicable because the conditions required by the text of this article are not met.¹²

The 'spider in the web' doctrine argues that there is a supplementary factor to be considered, in addition to the web of coordinated activities: the planning by the spider. The *forum connexitatis* therefore is identified with the location where the spider is based. Given this additional factor, it is desirable to bring the cases before an individual judge because of the close link resulting from the coordination by the spider. However, in the analysis of the Court there is no room for this supplementary step. The Court is not able to go this far and it does not apply the 'spider in the web' doctrine because the requirements of the wording of Article 6(1) are not met.¹³

3. Freeport as a First Correction?

To be honest, the *Freeport*¹⁴ case has nothing to do with intellectual property rights. It was essentially about two connected cases against two defendants on the basis of different legal situations, namely the contractual responsibility on the one hand and the tortious liability on the other hand. And this was exactly the most criticised point of *Roche Nederland*. National patent law is largely harmonised and national rules on patent infringement are all translations in national law of Article 69 of the European Patent Convention and of the Protocol to this article. The strict application of the territoriality principle to a case concerning the infringement of a European patent on the basis that this cannot be a single legal situation is perhaps a little too simplistic. The *Freeport* case has given the Court the opportunity to re-examine the requirement of the single legal situation, and therefore this judgment becomes of crucial importance for our analysis.

⁹ See Ph. de Jong, O. Vrans and Ch. Ronse, 'Evoluties in het octrooirecht' [2011] 11 *TBH* and Zheng Sophia Tang, 'Multiple defendants in the European Jurisdiction Regulation' (2009) *European Law Review* 80.

¹⁰ Case C-539/03 *Roche Nederland BV et al v Frederick Primus and Milton Goldenberg* [2006] ECR I-6535 para. 27. See K. Szychowska, 'Quelques observations sous les arrêts de la Cour de justice dans les affaires C-4/03 GAT et C-539/3 Roche', [2007] 5 *RDC* 498-506.

¹¹ Case C-539/03 *Roche Nederland BV et al v Frederick Primus and Milton Goldenberg* [2006] ECR I-6535, paras. 29-31.

¹² Case C-539/03 *Roche Nederland BV et al v Frederick Primus and Milton Goldenberg* [2006] ECR I-6535, para. 33. See J.J. Brinkhof, 'HvJEG beperkt mogelijkheden van grensoverschrijdende verboden', (2006) *Bijblad Industriële Eigendom* 319-322.

¹³ Case C-539/03 *Roche Nederland BV et al v Frederick Primus and Milton Goldenberg* [2006] ECR I-6535, paras. 34-35.

¹⁴ Case C-98/06 *Freeport plc v Olle Arnoldsson* [2007] ECR I-8319.

The Court goes immediately to the point. The requirement of an identical legal situation is softened, one year only after *Roche Nederland*. The identity of the legal foundations of the claims, for example an identical provision on patent infringement in the national patent law, as in *Roche*, is not required.¹⁵ For the rest, the analysis of the Court appears familiar:

'38. It is not apparent from the wording of Article 6(1) of Regulation No 44/2001 that the conditions laid down for application of that provision include a requirement that the actions brought against different defendants should have identical legal bases.

39. As the Court has already held, for Article 6(1) of the Brussels Convention to apply, it must be ascertained whether, between various claims brought by the same plaintiff against different defendants, there is a connection of such a kind that it is expedient to determine those actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings (Kalfelis, paragraph 13).

40. The Court has had occasion to point out that, in order that decisions may be regarded as contradictory, it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact (Case C-539/03 *Roche Nederland and Others* [2006] ECR I-6535, paragraph 26).

41. It is for the national court to assess whether there is a connection between the different claims brought before it, that is to say, a risk of irreconcilable judgments if those claims were determined separately and, in that regard, to take account of all the necessary factors in the case-file, which may, if appropriate yet without its being necessary for the assessment, lead it to take into consideration the legal bases of the actions brought before that court.¹⁶

The emphasis is again on the risk of irreconcilable judgments. A simple divergence is not sufficient; and there must be a connection so close as to produce the risk of irreconcilable judgments. This requires an identical factual situation and a converging legal situation, even though the latter condition is equally satisfied if there is a different legal basis for each case. Moreover, the Court introduces some flexibility on this second condition. The national judge must consider every aspect, including an identical juridical basis, if that is the case, although this aspect is not decisive, and she must decide if there is a risk of irreconcilable judgments.¹⁷

Also the rules of national patent law that are only partially harmonised are no longer an obstacle. The *Roche Nederland* approach is clearly softened on this point¹⁸ and Article 6(1) would certainly be applicable today if two branches of Roche would jointly infringe a patent by performing the same activity in two different countries. Even a different legal basis, as the infringement of a patent in country A and a case of unfair competition based on the infringement of an exclusive right in country B, would not make a difference.¹⁹

4. The *Painer* Case: the Next Step?

¹⁵ See Zheng Sophia Tang, 'Multiple defendants in the European Jurisdiction Regulation' (2009) *European Law Review* 80.

¹⁶ Case C-98/06 *Freeport plc v Olle Arnoldsson* [2007] ECR I-8319, paras. 38-41.

¹⁷ Case C-98/06 *Freeport plc v Olle Arnoldsson* [2007] ECR I-8319, para. 54.

¹⁸ M. Polak, 'Als u begrijpt wat ik bedoel': het Hof van Justitie herinterpreteert zijn rechtspraak over rechterlijke bevoegdheid bij pluraliteit van verweerders, (2007) 12 *Ars Aequi* 990-995 and <http://www.arsaequi.nl/maandblad> (1er juil. 2008).

¹⁹ See J. Bomhoff, '*Freeport v Arnoldsson*: Article 6(1) of the Brussels I Regulation' cited by M. George on the blog Conflictoflaws.net (<http://conflictolaws.net/2007/freeport-v-arnoldsson-art-61-of-the-brussels-i-regulation/>).

The least you can say is that the Court of Justice performs a peculiar analysis in the *Painer* case.²⁰ Here the *Freeport* doctrine is applied to a case concerning intellectual property rights, but this is not in itself very interesting. More interesting, on the contrary, is what is missing from the analysis of the Court on this case.

The factual situation in *Painer* is relatively simple. Ms Painer is a photographer and she takes pictures of children in schools. She keeps her copyright on the images that she sells. In this capacity, she took a picture of Natascha Kampusch before her kidnapping. After the kidnapping the Austrian police used the picture of Natascha Kampusch in their search and have therefore diffused the picture, which allowed a press photo agency to offer this picture to some newspapers after the escape of Natascha Kampusch, at a time when new pictures were not yet available.

Ms Painer claims that the publication in the German and Austrian newspapers infringes her copyright. She sues both German and Austrian newspaper publishers before an Austrian court, on the basis of Article 6(1) Brussels I Regulation. It needs to be noted that some German publishers were not active in the Austrian market, despite the fact that all publishers performed the same activity in relation to the picture, that is the publication of the picture obtained by the agency (retouched with the ageing software of the police).

4.1. The Analysis of the European Court of Justice

The Court strongly emphasizes that copyright law, which protects the picture at hand, has been harmonised by different European directives. It is as if the Court sought to explain that the requirement of the same legal situation of *Roche Nederland* is almost met. However, immediately afterwards the Court cites *Freemont*, with the purpose of dismissing²¹ some minor divergences between national copyright laws (of Germany and Austria), because an identical juridical basis is no longer necessary.²²

At first the Court has ruled on the basis that these are identical cases of copyright infringement. However, the national judge had indicated a potential problem in the different national juridical bases:

'72 By its first question, the referring court asks, in essence, whether Article 6(1) of Regulation No 44/2001 must be interpreted as precluding its application if actions against several defendants for substantially identical copyright infringements are brought on national legal grounds which vary according to the Member States concerned.'²³

This problem is dismissed with a strong reference to *Freeport*:

'79 In that regard, the Court has stated that, in order for judgments to be regarded as irreconcilable within the meaning of Article 6(1) of Regulation No 44/2001, it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the same situation of fact and law (see *Freeport*, paragraph 40).

80 However, in assessing whether there is a connection between different claims, that is to say a risk of irreconcilable judgments if those claims were determined separately, the identical legal bases of the actions brought is only one relevant factor among others. It is not an indispensable requirement for the application of Article 6(1) of Regulation No 44/2001 (see, to that effect, *Freeport*, paragraph 41).

81 Thus, a difference in legal basis between the actions brought against the various defendants, does not, in itself, preclude the application of Article 6(1) of Regulation No 44/2001, provided

²⁰ Case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.* [2011] ECDR 6.

²¹ And since the difference is so negligible, this cannot become an important factor when the judge takes in consideration all factors.

²² Case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.* [2011] ECDR 6, paras. 72 et 82.

²³ Case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.* [2011] ECDR 6, para. 72.

however that it was foreseeable by the defendants that they might be sued in the Member State where at least one of them is domiciled (see, to that effect, *Freeport*, paragraph 47).²⁴

The predictability for the defendant of the venue of the prospective litigation is one of the foundations of the Brussels I Regulation, and it is therefore always present. But it is nonetheless interesting to note that the Court links this aspect specifically to a discretionary appreciation of the legal situation and to the absence of the requirement of an identical juridical basis. This discretionary appreciation is somehow dependant on the predictability of the competent court by the defendant. This last aspect is almost a *conditio sine qua non* for the discretionary application of Article 6(1).

The reduced importance of the requirement of the same juridical basis is, according to the Court, the result of the strong harmonization of national legislation:

'82 That reasoning is stronger if, as in the main proceedings, the national laws on which the actions against the various defendants are based are, in the referring court's view, substantially identical.'²⁵

The more the national law is harmonised,²⁶ the stronger are the arguments in favour of the application of Article 6(1) Brussels I Regulation. It is striking that the Court refrains from making any reference to *Roche Nederland* on this point. The analysis of *Roche* is not openly abandoned, but neither is it used to support the analysis in *Painer*. However, in consideration of the importance that the Court places on the harmonization of national legislation in a scenario where a unique juridical basis is no longer an obligation, it is no longer possible to accept the argument in *Roche Nederland* that, despite a strong harmonization, the infringement of a European patent is based on independent national laws, and that for this only reason irreconcilable judgments are impossible.

The Court further goes back to the fundamental requirement of the close connection between cases and to the risk of irreconcilable judgments:

'83 It is, in addition, for the referring court to assess, in the light of all the aspects of the case, whether there is a connection between the different claims brought before it, that is to say a risk of irreconcilable judgments if those claims were determined separately. For that purpose, the fact that defendants against whom a copyright holder alleges substantially identical infringements of his copyright did or did not act independently may be relevant.'²⁷

At this point, there is a notable addition. In *Painer* the question why it was necessary to examine the claims jointly if the defendants did not act in mutual agreement cannot be avoided. According to the narrative of the facts in the judgment, the publishers of different newspapers have decided in full independence to purchase the contentious pictures and to publish them without the authorization of Ms Painer. This might suggest that the absence of every form of agreement or coordination, without mentioning the presence of a spider, is in itself sufficient to reject the application of Article 6(1), unless there is a common form of action. But not so in the analysis of the Court. The fact that the defendants have acted in an independent fashion is not decisive. The Court is satisfied with adding this argument, of a certain importance, to the list

²⁴ Case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.* [2011] ECDR 6, paras. 79-81.

²⁵ Case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.* [2011] ECDR 6, para. 82.

²⁶ See the analysis of the copyright judgment by V.-L. Benabou, 'Arrêt « Painer » : la protection par le droit d'auteur d'une photographie de portrait utilisée à des fins de recherche d'une personne disparue', (2012) 189 *JDE* 146-148 and M.-C. Janssens, 'Het Hof van Justitie over de auteursrechtelijke bescherming van foto's', (2012) 1 *Le droit des affaires - Het ondernemingsrecht* (D.A.-O.R.) 127.

²⁷ Case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.* [2011] ECDR 6, para. 83.

of the aspects that national courts have to consider to determine if there is a risk of irreconcilable judgments.²⁸

4.2. What the Court Omits to Say ... but what Forms an Essential Aspect of the Question

Advocate general Trstenjak had suggested that the Court could establish a somewhat different criterion to determine the application of Article 6(1).²⁹ Her conclusion starts from the idea that the *forum connexitatis* can only be declared competent for the claims that have a close connection with the principal claim. In other words, a principal claim is always present, and every other claim is connected to this claim by a close link. It is however not possible to link further claims to these attached claims that in turn would play the role of principal claim. This structure as well reinforces the aspect of predictability of the venue for the application of Article 6(1). In *Painer*, the principal claim concerned the newspaper published in Austria, the copyright infringement by this publication, and the reproduction in this publication of the pictures of Ms Painer by a defendant domiciled in Austria.³⁰ The 'other' claims were based on newspapers published in Germany. These latter claims need to have a close link with the principal claim. Moreover, the mutual relationship (or its absence) between the claims concerning newspapers published in Germany is immaterial. In this logic, a claim against a publisher based in Germany concerning the publication of a newspaper in Austria cannot serve as a principal claim with which the claim concerning a newspaper published in Germany, for example a local edition or a sister paper, has a close link. The text of Article 6(1) points clearly in this direction.³¹

The close nature of the link between the principal claim and the 'other' claims, according to the advocate general, must be demonstrated by the existence of a single factual situation. This somewhat different criterion softens the approach in *Roche Nederland*, but the main idea remains the predictability of the venue of proceedings for the defendant.³² Parallel behaviour is therefore not sufficient; the various behaviours should at least be aligned. The advocate general expresses this essential nuance in the following way:

'92. That minimum requirement is not satisfied where the facts on which the applicant bases its anchor claim and the other claim are such that the conduct of the anchor defendant and of the other defendant concerns the same or similar legal interests of the applicant and is similar in nature, but occurs independently and without knowledge of one another. In such a case of unconcerted parallel conduct, it is not sufficiently predictable for the other defendant that he can also be sued, under Article 6(1) of the regulation, at a court in the place where the anchor defendant is domiciled '33

This is exactly one of the problems in *Painer*. The publishers of the different newspapers have behaved in an identical way, but no alignment appears among these behaviours. In *Roche Nederland*, the Court has rejected the application of Article 6(1) arguing the absence of a single factual situation. There, it was question of coordinated actions by companies belonging to the same group. But according to the Court the presence of different defendants for different claims was sufficient, in the sense that for each claim there is a different defendant and that the infringing acts differ somewhat from country to country. It is therefore clear that the strict requirement of *Roche Nederland* is not met in *Painer*. This is why it is even more

²⁸ Case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.* [2011] ECDR 6, para. 83.

²⁹ Conclusions of Advocate General Trstenjak in case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.*, [2011] ECDR 13, para. 86.

³⁰ Article 2 of the Brussels I Regulation remains the fundamental principle, and in derogation to this principle another defendant may likewise be brought before a *forum connexitatis* determined on the basis of Article 2.

³¹ Conclusions of Advocate General Trstenjak in case C-145/10 *Eva-Maria Painer v Standard Verlags GmbH et al.*, [2011] ECDR 13, paras. 87-90.

³² Conclusions of Advocate General Trstenjak in case C-145/10 above, para. 01.

³³ Conclusions of Advocate General Trstenjak in case C-145/10 above, para. 92.

surprising that the Court did not make the effort to explain why it did not follow either this approach, or the somewhat softer approach proposed by the advocate general. By both arguments Article 6(1) would not be applicable to *Painer*. The court prefers not to reach this conclusion and reduces the requirement of a single factual situation to one of the factors that a court must consider in the evaluation of the risk of irreconcilable judgments. This is moreover achieved by a little added sentence, without any motivation or clarification. It would have been at least interesting to know whether the Court considers sufficient the argument that in *Painer* the infringing acts were identical and took place in part in the same jurisdiction. Has the requirement of an identical factual situation survived because of the risk that the same acts performed in Austria are judged in a different and irreconcilable way respectively by a German tribunal and by an Austrian tribunal, although for different defendants? Or are we then just dealing with an acceptable form of divergence? Or does the court now assess the risk of incompatibility in one step in which both factors indicating the same facts and proofs relating to the legal basis are taken into account? The ruling of the Court of Justice does not give any clarification on this point, despite the clear way indicated by the conclusions of the advocate general. Conversely, there is no longer a place for the strict line of *Roche Nederland*.

The advocate general considers a legal link sufficiently close between the claims as a second distinct condition for the application of Article 6(1). She clearly follows on this point the softer line of *Freeport*:

'98. In cases in which comparable claims are made and the requirements under the applicable law are essentially comparable, application of Article 6(1) of Regulation No 44/2001 is suggested, first of all, by the fact it is possible to avoid inconsistencies which could result from a different appraisal of the facts by two courts. In so far as common stipulations under Union law are concerned, this is also supported by the avoidance of legal inconsistencies. Considerations of procedural economy also indicate the existence of such a connection. However, in such cases the requirement that the anchor claim and the other claim arise in the context of a single factual situation is of crucial importance. The risk of a different appraisal of the facts and a different legal assessment can justify a transfer of jurisdiction under Article 6(1) of the regulation only where this is predictable for the defendant.'³⁴

The expression 'crucial importance' has perhaps been incorrectly interpreted by the Court as an invitation to leave the final evaluation to the national jurisdiction. This is clearly not the line along which the advocate general has built her reasoning. A 'crucial importance' for her leads rather to a *conditio sine qua non*. The decisive character of this aspect clearly points towards a first precondition which is distinct and cannot be compensated by another one!

One thing is clear. After *Painer*, neither the first nor the second condition established in *Roche Nederland* remains intact. If *Freeport* softened the second condition, *Painer* does the same thing to the first condition.

This is even more important if one considers that these two conditions are no longer followed by a separate evaluation (or prediction) of the danger of irreconcilable judgments in the specific case.³⁵ The existence of a single factual situation and of a sufficient juridical concordance is on this point sufficient because it is only a question of a *risk* of irreconcilable judgments. This risk cannot be tested in absolute terms and therefore one needs to fall back on the two above-mentioned conditions as clear indicators of the existence of such a risk.³⁶

5. The *Solvay* Case: Clarity at Last?

³⁴ Conclusions of Advocate General Trstenjak in case C-145/10 above, para. 98.

³⁵ Conclusions of Advocate General Trstenjak in case C-145/10 above, para. 100.

³⁶ *Contra* Case C-539/03 *Roche Nederland BV et al v Frederick Primus and Milton Goldenberg* [2006] ECR I-6535, para. 32.

The litigation between *Solvay* and *Honeywell* appeared to provide an ideal opportunity to clarify the matter. Since both *Freeport* and *Painer* had departed from the guiding line established by the Court in *Roche Nederland*, it was interesting to see the matter again considered in a case regarding a European patent, after a case without relation to intellectual property (*Freeport*) and another case concerning copyright (*Painer*).

Solvay sued in the Netherlands a Dutch company of the Honeywell group for the infringement of a European patent.³⁷ The infringement involved the sale in certain European countries of a product identical to the product protected by the patent. A similar activity had been performed in a number of European countries by two companies of the Honeywell group, based in Belgium. Solvay argued that the principal claim was directed against a Dutch company on the basis of Article 2 of the Brussels I Regulation and claimed that there was a close relation with the claims against the two Belgian companies, which are part of the same group and which performed the same activity. Solvay further stated that on the basis of such close relation Article 6(1) was applicable to determine the competence of the sole Dutch judge as a *forum connexitatis*.³⁸

The application of the *Freeport* approach regarding the condition of an identical juridical basis was foreseeable, because national rules on patents have been harmonised as much as – or even more than – copyright rules, whereas the directives have left more room for different national approaches. And the existence of the same facts is perhaps more plausible if one supposes that companies of the same group align their behaviour between them and perform the same infringing activity by selling the product concerned in different European countries. Thus, *Solvay* could have followed this line and have extended the application of Article 6(1) to a scenario such as in *Roche*. It could have.

A first part of the ruling rehearses the well-known arguments in relation to Article 6(1). One can recognise the softened approach of *Freeport*, as well as clear references to *Painer*. But then a paragraph that refers to *Freeport*, *Painer*, and *Roche Nederlands*, in order to make the same points, takes the Court back to *Roche Nederland*.³⁹ The way in which a European patent is treated by *Roche Nederland* is simply repeated, without discussion. Thus, the Court chooses the easier way by arguing that *Solvay* is an exception to *Roche Nederland*, on the basis of the specific factual situation of *Solvay*. Or, in the common law terminology: '*Solvay* is distinguished from *Roche Nederland*'. The Court reckons that the two Honeywell companies, Dutch and Belgian, are active on the Finnish market. If Article 6(1) were not applied, we would have two rulings relative to the same activity in Finland.⁴⁰ This suggests that, according to the Court, there would be a real risk of irreconcilable judgments. The overlapping activities in Finland make the difference with the *Roche Nederland* scenario, where each company was only active in one country. And on the basis of the risk of irreconcilable judgments Article 6(1) applies to this exceptional situation.⁴¹

Obviously, *Solvay* represents a revival of the *Roche Nederland* doctrine. The rulings in *Freeport* and *Painer* are clearly important, but the Court is not prepared to give up completely the *Roche Nederland* approach. In this sense, *Solvay* does not provide the clarifications one could have hoped for.⁴²

One of the interesting aspects of *Solvay*⁴³ is that, despite the fact that only a limited part of the claims against each defendant refers to the same activity in the same country, the whole case is brought before a

³⁷ Case C-616/10 *Solvay SA/Honeywell et al.* [2012] ECR I-0000, CJEU 12 Jul. 2012, See the annotations of G. Sorreaux in [2012] 9 TBH 941.

³⁸ On the judgment in the Netherlands see Ph. de Jong, O. Vrins and Ch. Ronse, 'Evoluties in het octrooirecht' [2011] 11 TBH.

³⁹ Case C-616/10 *Solvay SA/Honeywell et al.* [2012] ECR I-0000, CJEU 12 Jul. 2012, paras. 19-26.

⁴⁰ Case C-616/10 *Solvay SA/Honeywell et al.* [2012] ECR I-0000, CJEU 12 Jul. 2012, para. 28.

⁴¹ See G. Cuniberti, 'ECJ rules on separate proceedings and interim relief' (2012) Conflictoflaws.net (<http://conflictflaws.net/2012/ecj-rules-on-separate-proceedings-and-interim-relief/>).

⁴² Case C-616/10 *Solvay SA/Honeywell et al.* [2012] ECR I-0000, CJEU 12 Jul. 2012, para. 28.

Dutch court on the basis of Article 6(1).⁴⁴ Even the claims that are not irreconcilable are brought before the *forum connexitatis*. The emphasis appears to be put on the defendant. If there is a risk, all claims against the defendant are brought before the *forum connexitatis*. This has obviously the advantage to avoid a fragmentation between different claims. Additional proceedings in the *forum connexitatis* for part of the claims are in fact not an ideal solution.

6. Conclusion

Perhaps it is a pity that the text of Article 6(1) Brussels I Regulation was not changed, except that it is now Article 8(1). Few certainties remain when the jurisprudence of the European Court of Justice is analysed in detail. An attempt at clarification by the legislator would have been welcome, even though this is never a guarantee of success.

It is still true that Article 6(1) provides the option to join all parties and all claims in the *forum connexitatis*, when two defendants act jointly in one or more countries, although the defendants are domiciled in different countries. An elementary example is provided by the infringement of a European patent in a country implicating the acts of two defendants, respectively as the manufacturer and the distributor of the infringing product. And *Solvay* likewise specifies that Article 6(1) applies to all scenarios where two or more defendants infringe the same intellectual property right in the same country by acting in an identical way. This type of overlap necessarily produces a risk of irreconcilable judgments, and Article 6(1) averts this risk.

Leaving that aside, every certainty and predictability has disappeared. Parallel rights and parallel claims that do not overlap remain in a state of confusion when one examines in detail the approach of the Court of Justice. The risk of irreconcilable judgments remains the criterion for the application of Article 6(1); and in the assessment of this risk the two requirements of a single factual and single legal situation remain the principal factors. However, the strict requirement of a single factual situation established by *Roche Nederland* is questioned by *Painer*. A certain form of coordinated action between the defendants is no longer indispensable, and even less a form of coordinated action. This is merely one of the factors that a tribunal has to consider to determine if Article 6(1) can be applied. The same applies in relation to the strict requirement of the same legal basis. After *Freeport*, this requirement has likewise been softened and the existence of the same legal basis is only a factor that the tribunal will have to consider. The central factor is now the balance that has to be struck by the national judge. This obviously makes the test flexible, but it is yet uncertain whether there are still two requirements that have to be individually met, on the basis of two separate balancing acts performed by national judges, or whether a single assessment which considers both factual and legal factors needs now to be performed. Obviously, the application of a uniform law and the risk that two judges apply this uniform law in a different way are very important factors in the application of Article 6(1).

The Court has constantly reminded us that Article 6(1) has not the aim to exclude a mere divergence and that the application of Article 6(1) needs a greater and more relevant risk. However, the question has to be asked whether the combined effect of *Painer* and *Freeport* does not open wide the door to the application of Article 6(1) in cases where there is but a mere risk of divergence. Was the only real risk in *Painer* not the divergent application of copyright law, strongly harmonised (the same infringing acts in Austria, to which Austrian law applies, could be judged differently by a German judge against a defendant domiciled in Germany than by an Austrian judge against a defendant domiciled in Austria)?

This greater flexibility thanks to the balancing action performed by the national judge has also the drawback that the legal predictability, and hence also the legal certainty, two factors that the Court

⁴³ See also G. Grassie and R. Buchan, 'Does Solvay remove the need for a Unified Patent Court (UPC) in Europe?' (2012) 41(9) *CIPAJ* 512-515.

⁴⁴ Case C-616/10 *Solvay SA/Honeywell et al.* [2012] ECR I-0000, CJEU 12 Jul. 2012, paras. 29-30.

considers crucially important, in the Brussels I Regulation in general and in Article 6(1) in particular, are practically totally lost.

The introduction of this flexibility and of the balancing exercise are not the cause of the current problems. Going back to the strict approach of *Roche Nederland* is pointless and it would cause more problems than it solves. Nevertheless, it needs to be noted that the flexibility is only acceptable inasmuch as the application of Article 6(1) is predictable. And there must be a real risk of incompatible judgments, not only a risk of divergence. This result can be obtained by keeping the two conditions separate and by applying them cumulatively. *Freeport* can provide guidance on the approach, under condition of a single legal situation. When it comes to the question of the requirement of a single factual situation, a minimum alignment between the actions of the defendants can be required as a *conditio sine qua non*. This would avert the risk of a simple divergence and ensure some predictability. We do not need a spider and its web, but at least some link should exist.



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