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## Jurisdictional Battles in Both European Union Cross-Border Injunctions and United States Anti-Suit Injunctions

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# JURISDICTIONAL BATTLES IN BOTH EUROPEAN UNION CROSS-BORDER INJUNCTIONS AND UNITED STATES ANTI- SUIT INJUNCTIONS

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## INTRODUCTION

The Apple and Samsung litigation has resulted in more than twenty-two patent cases in six EU member states: twelve in Germany, two in the Netherlands, two in France, two in Italy, three in Spain, and one in the United Kingdom.<sup>1</sup> Although the disputes involve the same technologies, Apple and Samsung must litigate the issue in each country because patent rights can only be enforced within the country that granted the patent.<sup>2</sup> Patent battles, such as those between Apple and Samsung, require a patent owner “to pursue duplicative litigation on a ‘nation-by-nation’ basis, incurring significant costs and draining valuable judicial resources.”<sup>3</sup> This Comment investigates a method courts have used to consolidate patent litigation—the cross-border injunction.

To consolidate multi-national patent litigation and avoid duplicative litigation, EU national courts started to issue cross-border injunctions.<sup>4</sup> When infringement of patent rights occurs in multiple countries, a plaintiff has several options for initiating court proceedings: (1) initiate parallel proceedings in multiple jurisdictions; (2) sue the accused infringer in only one of the countries where infringement occurred—likely because the patent owner cannot afford to pursue an action in multiple countries; or (3) initiate infringement claims in one jurisdiction and use parallel patents to acquire a cross-border injunction.<sup>5</sup> Plaintiffs—usually the patent owner—often choose the third option to consolidate trials into a single jurisdiction because the costs

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<sup>1</sup> Florian Mueller, *List of 50+ Apple-Samsung Lawsuits in 10 Countries*, FOSS PATENTS (Apr. 28, 2012), <http://www.fosspatents.com/2012/04/list-of-50-apple-samsung-lawsuits-in-10.html>. The Netherlands court “granted cross-border injunctions against Dutch Samsung entities; the injunction against the Korean co-defendant was limited to the Netherlands as no cross-border [injunction] was requested.” Tobias Cohen Jehoram et. al., *Part 1: Patents, Trademarks and Design Rights*, THE NETHERLANDS: THE COUNTRY OF CROSS-BORDER INJUNCTIONS IN IP (DE BRAUW BLACKSTONE WESTBROEK), Feb. 4, 2013, <http://www.debrauw.com/News/LegalAlerts/Pages/LegalAlertTheNetherlandsTheCountryOfCross-BorderInjunctionsInIP.aspx>.

<sup>2</sup> John Gladstone Mills III, *A Transnational Patent Convention for the Acquisition and Enforcement of International Patent Rights*, 88 J. PAT. & TRADEMARK OFF. SOC’Y 958, 958 (2006).

<sup>3</sup> James Pooley & Vicki Huang, *Multi-National Patent Litigation: Management of Discovery and Settlement Issues and the Role of the Judiciary*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 45, 46 (2011).

<sup>4</sup> See Jochen Bühling, *Cross-Border Injunctions in Patent Infringement Cases: Paradise Lost?*, INTELLECTUAL ASSET MAGAZINE (Special Issue) 172 (2007).

<sup>5</sup> *Id.*

of simultaneously litigating in many countries can create enormous financial burdens, especially on small- or medium-sized enterprises.<sup>6</sup>

The European Court of Justice (ECJ) is the highest court in the EU and ensures that EU law is applied the same way throughout every EU Member State.<sup>7</sup> Recently, the ECJ held that an EU national court could grant a cross-border injunction via a provisional measure.<sup>8</sup> The ECJ did not preclude EU national courts from issuing cross-border injunctions and left it to the courts to interpret when the country has a connecting link to the case.<sup>9</sup> EU national courts, however, interpret patents differently and have different opinions on the extent to which a party should be enjoined from a particular activity.<sup>10</sup> As a result, EU national courts will encounter difficulties in uniformly deciding when to issue a cross-border injunction and when to enforce injunctions issued by other EU national courts.

Part I of this Comment provides the basis to understand procedures used to issue preliminary cross-border injunctions by examining those used in Germany. Germany is active in cross-border injunctions, and patent owners should continue to choose Germany as a forum to litigate patents. Part I then shifts to anti-suit injunctions in the United States. An anti-suit injunction has a multi-national impact similar to a cross-border injunction, and the U.S. Ninth Circuit case *Microsoft v. Motorola*<sup>11</sup> displays the framework courts apply in anti-suit injunction cases. The U.S. framework parallels issues in EU cross-border injunctions and could serve as a guide for EU national courts. Part II of this Comment details cross-border injunction precedent from the ECJ. A recent

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<sup>6</sup> See MARKET A TRIMBLE, GLOBAL PATENTS: LIMITS OF TRANSNATIONAL ENFORCEMENT 40 (2012); see also William A. Hoyng, *United Kingdom: Cross-Border Injunctions, Where are We and Where Should We Go?*, MONDAQ (JUNE 29, 2005), <http://www.mondaq.com/x/33412/trademark>. The European Commission estimated that litigation in all four member states where most patent litigation in the European Union occurs (Germany, France, the United Kingdom, and the Netherlands) can cost €10,000 to €1,950,000 if appealed. TRIMBLE, *supra*, at 40.

<sup>7</sup> Consolidated Version of the Treaty on European Union art. 19, Oct. 26, 2012, 2012 O.J. (C 326) 13; see generally *Court of Justice of the European Union*, EUROPA.EU, [http://europa.eu/about-eu/institutions-bodies/court-justice/index\\_en.htm](http://europa.eu/about-eu/institutions-bodies/court-justice/index_en.htm) (last visited Sept. 5, 2013).

<sup>8</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 49–51 (Judgment of the Court).

<sup>9</sup> See *id.* paras. 30, 51.

<sup>10</sup> See TRIMBLE, *supra* note 6, at 40 (“If there is anything predictable about fragmented enforcement, it is that different courts will likely interpret patents differently. . . .”); Severin de Wit, *Europe’s Patent Demise*, IPEG (Mar. 24, 2008), [http://ipeek.blogspot.com/2008/03/europes-patent-demise\\_24.html](http://ipeek.blogspot.com/2008/03/europes-patent-demise_24.html) (discussing how the Document Security Systems Inc. patent was held invalid in the United Kingdom and France yet valid in Germany and the Netherlands).

<sup>11</sup> *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 879 (9th Cir. 2012).

ECJ case, *Solvay v. Honeywell*,<sup>12</sup> has shed light on the jurisdictional provisions EU national courts can use to issue a cross-border injunction.<sup>13</sup> The decision, however, has left EU national courts with questions on when to issue a cross-border injunction.<sup>14</sup> Part III of this Comment examines the *Solvay* decision in respect to preliminary cross-border injunctions. Part III also analyzes the U.S. anti-suit injunction framework and how the ECJ's rationale in the *Solvay* decision fits in with the U.S. anti-suit injunction framework.

## I. BACKGROUND

Part I.A provides background on both the EU's patent application system and cross-border injunctions. Part I.B examines how Germany's bifurcated court system invites claims from patent owners seeking a cross-border injunction. Part I.C then outlines the framework the Ninth Circuit used when issuing an anti-suit injunction in *Microsoft v. Motorola*. This Comment will later apply the Ninth Circuit framework to some of the upcoming struggles EU national courts will face when issuing cross-border injunctions.

### A. *The EU's Patent Application System and Cross-Border Injunctions*

Patent protection in the EU is territorial.<sup>15</sup> EU Member States independently grant patent rights to the patent owner, and the patent owner enforces the patent in each corresponding EU national court.<sup>16</sup> For applicants to efficiently obtain patent protection in multiple jurisdictions, the European Patent Convention established a unified patent application system that consists of a centralized filing and granting procedure for European patents.<sup>17</sup> The European Patent Office processes the application, examines whether the subject matter is patentable, and grants a European patent.<sup>18</sup> The name "European patent" is a misnomer; the European patent does not result in a

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<sup>12</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 49–51 (Judgment of the Court).

<sup>13</sup> See generally *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616 (Judgment of the Court) (explaining how EU national courts need to analyze Articles 6(1), 22(4), 25, and 31 of Council Regulation 44/2001 when considering whether to issue a cross-border injunction).

<sup>14</sup> See *id.* paras. 49–52.

<sup>15</sup> Gretchen Ann Bender, *Clash of the Titans: The Territoriality of Patent Law vs. the European Union*, 40 IDEA 49, 57–58 (2000).

<sup>16</sup> *Id.* at 58.

<sup>17</sup> See Convention on the Grant of European Patents arts. 1–4, Oct. 5, 1973, 1065 U.N.T.S. 254.

<sup>18</sup> MARTA PERTEGÁS SENDER, CROSS-BORDER ENFORCEMENT OF PATENT RIGHTS § 1.18 (James Fawcett, ed., 2002).

unitary patent right, as the name suggests.<sup>19</sup> Instead, a European patent results in a bundle of separate national patents in the EU Member States that the patent owner designated on the application.<sup>20</sup> The bundle of patents is called parallel patents.

The purpose of creating a unified patent application system in Europe was to facilitate the burdensome task of *obtaining* patents in multiple countries, not to ease *post-issuance* procedures.<sup>21</sup> Therefore, it is not surprising that EU national courts have struggled with the post-issuance enforcement of parallel patents.<sup>22</sup> Jurisdictional procedures to simultaneously enforce parallel patents are not concretely in place.<sup>23</sup> As a result, a patent owner must litigate validity in every country in which the patent was ultimately granted.<sup>24</sup>

In an effort to consolidate trials in a cost and time effective way, EU national courts started to issue cross-border injunctions.<sup>25</sup> These courts issued cross-border injunctions on the reasoning that all parallel patents should be interpreted the same, regardless of the country in which the patent was issued.<sup>26</sup> Overall, a cross-border injunction allows a patent owner to initiate

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<sup>19</sup> Robert D. Swanson, *Implementing the EU Unified Patent Court: Lessons from the Federal Circuit 4* (Stanford–Vienna Transatlantic Tech. Law Forum, Working Paper No. 15, 2012), [https://www.law.stanford.edu/sites/default/files/child-page/188509/doc/slspublic/swanson\\_wp15.pdf](https://www.law.stanford.edu/sites/default/files/child-page/188509/doc/slspublic/swanson_wp15.pdf). As of December 2012, the European Parliament has supported the EU Council's draft resolutions for the creation of a unitary patent and a unified patent court. See Regulation 1257/2012 of the European Parliament and the Council of 17 December 2012 Implementing Enhanced Cooperation in the Area of the Creation of Unitary Patent Protection, 2012 O.J. (L 361) 1; Council Regulation 1260/2012 of 17 December 2012 Implementing Enhanced Cooperation in the Area of the Creation of Unitary Patent Protection with Regard to the Applicable Translation Arrangements, 2012 O.J. (L 361) 89. The unitary patent will not replace existing European patents but will instead provide an alternative. Regulation 1257/2012 pmb1., para. 7; Council, Notices From European Union Institutions, Bodies, Offices and Agencies, Agreement on a Unified Patent Court, 2013 O.J. (C 175) 1; see also *New European System Adopted*, EUBELIUS (Dec. 2012), <http://www.eubelius.be/en/spotlight/new-european-patent-system-adopted> (comparing existing territorial European patents to proposed unitary patents).

In February 2013, twenty-four EU Member States signed the agreement to establish a Unified Patent Court. *EPO Welcomes Historic Signing of the Unified Patent Court Agreement*, EUROPEAN PATENT OFFICE (Feb. 19, 2013), <http://www.epo.org/news-issues/news/2013/20130219.html>. The Unified Patent Court Agreement will enter into force once Germany, the United Kingdom, France, and ten additional countries ratify the agreement. *Id.* Only Austria has ratified the treaty. *Unitary Patent – Ratification Progress*, EUROPEAN COMMISSION (Sept. 25, 2013), [http://ec.europa.eu/internal\\_market/indprop/patent/ratification](http://ec.europa.eu/internal_market/indprop/patent/ratification).

<sup>20</sup> *New European System Adopted*, *supra* note 19; see also Convention on the Grant of European Patents, *supra* note 17, arts. 64, 66.

<sup>21</sup> SENDER, *supra* note 18, § 2.110 (emphasis added).

<sup>22</sup> See *id.*

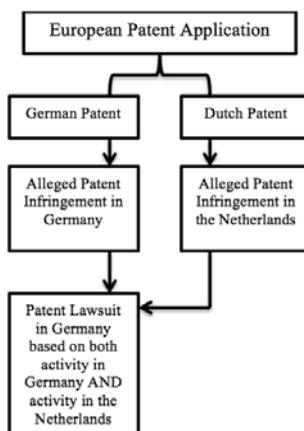
<sup>23</sup> See *id.* §§ 2.146, 6.16.

<sup>24</sup> See Mills, *supra* note 2, at 971.

<sup>25</sup> See Bühling, *supra* note 4, at 172.

<sup>26</sup> See *id.*

infringement proceedings against a defendant in a country based on not only that country's patent but also other parallel patents.<sup>27</sup> For example, a patent owner may initiate infringement proceedings against a defendant in a German court based on both the infringement of a German patent in Germany *and* infringement of parallel patents in the corresponding EU Member States. A patent owner could thus bring a claim against a defendant in a German court claiming that the defendant infringed both a German patent in Germany and a parallel Dutch patent in the Netherlands (see figure below). If the alleged infringing party does not voluntarily comply with the cross-border injunction, the court that granted the injunction can enforce the decision through a contempt order or similar measure, assuming the alleged infringer has assets or does business within its country.<sup>28</sup>



### B. Cross-Border Injunctions in Germany

Jurisdictional procedures vary depending on the EU Member State.<sup>29</sup> Because most patent litigation in the EU occurs in Germany,<sup>30</sup> the next section

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<sup>27</sup> *Id.*

<sup>28</sup> TRIMBLE, *supra* note 6, at 39.

<sup>29</sup> See, e.g., Jan Klink & Edwards Geldard, *Cherry Picking in Cross-Border Patent Infringement Actions*, 26 EUR. INTELL. PROP. REV. 493, 497 (2004) (comparing German and United Kingdom patent procedures).

<sup>30</sup> See Michael C. Elmer & Stacy D. Lewis, *Where to Win: Patent-Friendly Courts Revealed*, MANAGING INTELL. PROP. (Sept. 2010), <http://www.managingip.com/Article/2660946/Where-to-win-patent-friendly-courts-revealed.html> (explaining that from 1997 to 2009, 9200 patent cases were filed in Germany compared with 6166 in France, Italy, England, and the Netherlands combined); Christian Thiel, *Patent Litigation in*

of this Comment details the process for issuing a cross-border injunction in Germany.

### 1. Germany's Court System

Patent owners often choose to litigate in Germany because German court proceedings are fast and relatively inexpensive.<sup>31</sup> The *Landgericht* (District Court) in Mannheim typically issues first instance judgments within eight months, and the *Landgerichte* in Munich and Hamburg both issue first instance judgments within six to nine months.<sup>32</sup> Further, German patent enforcement proceedings are cost effective because the discovery process in Germany is less extensive, and German patent infringement cases do not have jury trials.<sup>33</sup> In addition to the benefits of fast and relatively inexpensive cases, experienced patent judges in Germany render high-quality decisions.<sup>34</sup>

Also appealing to patent owners, Germany has a bifurcated court system; infringement proceedings and revocation proceedings are separate.<sup>35</sup> The *Landgerichte* adjudicate infringement proceedings, and the *Bundespatentgericht* (Federal Patent Courts) are specialized patent courts for revocation proceedings.<sup>36</sup> Of the approximately 120 *Landgerichte*, the *Landgerichte* in Düsseldorf, Mannheim, Munich, Frankfurt, and Hamburg

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*Germany*, 21 CAL. BUS. L. PRAC. 13, 13 (2006) (stating that more than fifty percent of all patent litigation in Europe occurs in Germany).

<sup>31</sup> Christine Kanz, Stefan Richter & Reimann Osterrieth Köhler Haft, *Patent Litigation in Germany – Recent Developments*, FOCUS EUROPE, Summer 2012 (discussing recent developments in patent litigation in Germany in the European Investment Update).

<sup>32</sup> *Id.*

<sup>33</sup> ALEXANDER HARGUTH, MCDERMOTT WILL & EMERY, QUICK GUIDE FOR US COUNSEL: PATENT LITIGATION IN GERMANY 2 (2012), <http://www.mwe.com/files/Uploads/Documents/News/wp0312a.pdf#page=2> (explaining that the cost of litigating a case in Germany is between €40,000 and €180,000 depending on the complexity of the case). The cost of litigation for a patent infringement case in the United States is typically around \$2.6 million. ALAN W. KOWALCHYK, AM. ARBITRATION ASS'N, INTELLECTUAL PROPERTY ADR VS. LITIGATION: RESOLVING IP DISPUTES OUTSIDE OF COURT: USING ADR TO TAKE CONTROL OF YOUR CASE 1 (2006) (citing AM. INTELLECTUAL PROP. LAW ASS'N, REPORT OF THE ECONOMIC SURVEY I-109 (2005)) (showing a chart that outlines the median costs for plaintiffs of patent infringement litigation in the United States); see also Daniel Schimmel & Ila Kapoor, *Resolving Intellectual Property Disputes in Arbitration*, INTELL. PROP. & TECH L.J., Feb. 2009, at 5, 7 (describing patent litigation costs in the United States).

<sup>34</sup> Kanz et al., *supra* note 31.

<sup>35</sup> See STEFAN LUGINBUEHL, EUROPEAN PATENT LAW: TOWARDS A UNIFORM INTERPRETATION 28 (Cir. for Intellectual Prop. Law et al. eds. 2011).

<sup>36</sup> See Patentgesetz [Pat.G] [German Patent Act], May 5, 1936, BUNDESGESETZBLATT, Teil I [BGBl. I], §§ 65(1), 143(1), last amended by Gesetz vom July 31, 2009, [BGBl.] I, art. 1, at 2521; LUGINBUEHL, *supra* note 35, at 25–26.

have developed expertise in patent injunction proceedings.<sup>37</sup> Those courts account for four-fifths of all infringement proceedings in Germany.<sup>38</sup> For revocation proceedings, the *Bundespatentgericht* consists of panels of judges with technical expertise and hold exclusive authority over patent validity.<sup>39</sup>

Due to this bifurcation, invalidity is not a defense in infringement proceedings.<sup>40</sup> A defendant cannot raise validity as a counterclaim during infringement proceedings but rather must bring a validity suit in the *Bundespatentgericht* and hope that a *Landgericht* will stay the proceedings until validity is determined.<sup>41</sup> Alternatively, infringement and validity can be tried simultaneously.<sup>42</sup> Having two separate procedures—one for infringement and one for validity—risks delay and additional costs.<sup>43</sup> The ECJ's judgment in *Solvay v. Honeywell* provides a third option in cases involving multiple patents from different countries. Rather than staying infringement proceedings to wait for a validity determination or try infringement and validity separately and wait for the decisions to merge, German courts can issue a preliminary cross-border injunction in the infringement proceedings. This Comment will show how preliminary cross-border injunctions could become common following the ECJ judgment in *Solvay*.<sup>44</sup>

## 2. German Provisional Proceedings

A preliminary injunction acts as a way for patent owners to enforce their right to exclude a party from making, using, selling, offering for sale, or importing the patented invention during the main proceedings.<sup>45</sup> Speed is often imperative if an infringing product is on the market; therefore, patent owners may request that the court grant a preliminary injunction to prevent the alleged

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<sup>37</sup> LUGINBUEHL, *supra* note 35, at 26–27.

<sup>38</sup> *See id.* at 27.

<sup>39</sup> *See id.* at 26.

<sup>40</sup> Kanz et al., *supra* note 31; Klink & Geldard, *supra* note 29, at 499.

<sup>41</sup> ZIVILPROZESSORDNUNG [ZPO][CODE OF CIVIL PROCEDURE], Jan. 30, 1877, BUNDESGESETZBLATT [BGBL.] I, § 148 (Ger.); Klink & Geldard, *supra* note 29, at 499. A German court will only stay an infringement proceeding if it is convinced that a claim for revocation will be successful. *Id.*

<sup>42</sup> *See* German Patent Act § 81. A decision from a *Landgerichte* may be appealed to an *Oberlandesgericht* (Higher District Appellate Court). LUGINBUEHL, *supra* note 35, at 29. Both decisions from an *Oberlandesgericht* and a *Bundespatentgericht* may be appealed to the *Bundesgerichtshof* (Federal Supreme Court) in Karlsruhe. *Id.* at 30. Here, the validity and infringement merge. *Id.* at 30.

<sup>43</sup> Klink & Geldard, *supra* note 29, at 500.

<sup>44</sup> *See infra* Part II.E.

<sup>45</sup> *See* BARDEHLE PAGENBERG, PRELIMINARY INJUNCTION IN PATENT AND UTILITY MODEL CASES 5 (2011), [http://www.bardehle.com/fileadmin/contentdocuments/broschures/Preliminary\\_injunction\\_patent.pdf](http://www.bardehle.com/fileadmin/contentdocuments/broschures/Preliminary_injunction_patent.pdf).

infringer from performing the alleged infringing activity during the extent of the trial.<sup>46</sup> A preliminary injunction also enables a patent owner to leverage a favorable settlement in a relatively short period of time.<sup>47</sup>

Preliminary injunctions are granted through provisional measures.<sup>48</sup> In Germany, courts have the discretion to issue a hearing for a provisional measure.<sup>49</sup> After a claimant requests a preliminary injunction via a provisional measure, the German court will often informally give its assessment of the claim to the claimant.<sup>50</sup> When the court is unlikely to issue a preliminary injunction, the claimant has time to withdraw the claim.<sup>51</sup> If the court determines that the claim is valid, the court can issue a preliminary injunction without hearing opposing argument.<sup>52</sup> If the court has doubts about the merits of the claim, the court will order an in-person oral hearing to offer the opposing side an opportunity to dispute the claim.<sup>53</sup> A decision can be given within hours if the court determines that speed is essential.<sup>54</sup> But even on average the provisional measures are fast. The entire process from filing a claim to final verdict is less than one year.<sup>55</sup>

Provisional measures in German patent disputes occur in one of the twelve specialized *Landgerichte*.<sup>56</sup> The Düsseldorf court grants a preliminary injunction in fifty-nine percent of cases, one of the highest preliminary injunction win rates in the world.<sup>57</sup> The high win rate is likely why Düsseldorf accounts for approximately forty percent of all patent litigation in Germany.<sup>58</sup>

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<sup>46</sup> See *id.* at 4.

<sup>47</sup> See *id.*

<sup>48</sup> Each EU national court has different provisional proceedings. Felix Rödiger, *Cross-Border Litigation After GAT v. LuK and Roche v. Primus: The Future of the Italian Torpedo*, BIRD & BIRD (Jan. 1, 2009), <http://www.twobirds.com/en/news/articles/2012/cross-border-litigation-after-gat-v-luk-and-roche-v-primus-the-future-of-the-italian-torpedo> (declaring the spider-in-the-web-doctrine dead). Cross-referencing the U.S. provisional measure framework to provisional measures in the EU is beyond the scope of this Comment.

<sup>49</sup> See GERMAN CODE OF CIVIL PROCEDURE, *supra* note 41, at § 937(2).

<sup>50</sup> BARDEHLE PAGENBERG, *supra* note 45, at 5.

<sup>51</sup> *Id.*

<sup>52</sup> *Id.* at 6.

<sup>53</sup> *Id.*

<sup>54</sup> See GERMAN CODE OF CIVIL PROCEDURE, *supra* note 41, § 279; Klink & Geldard, *supra* note 29, at 497.

<sup>55</sup> BARDEHLE PAGENBERG, *supra* note 45, at 7 (showing both the timetable for a preliminary injunction following oral hearing and a preliminary injunction without oral hearing).

<sup>56</sup> *Id.* at 5.

<sup>57</sup> See Elmer & Lewis, *supra* note 30, at 38.

<sup>58</sup> See *id.* at 37.

The provisional process presents strategic considerations for a patent owner seeking a cross-border injunction, and the process also helps prevent parties from enforcing a preliminary injunction without true merit.<sup>59</sup> A German preliminary injunction is not self-enforcing.<sup>60</sup> The party seeking the injunction must post a security bond to cover potential damages should the infringement ruling be reversed on appeal.<sup>61</sup> The security bond's high cost creates potential liability, so many plaintiffs shy away from cross-border injunctions unless infringement and validity claims are strong.<sup>62</sup>

Ultimately, the relatively low cost and fast court proceedings in German courts makes Germany the "plaintiff's paradise" for patent infringement.<sup>63</sup> Because Germany is active in cross-border injunctions and will likely continue to be a forum patent owners choose to obtain a cross-border injunction, German courts especially need a framework to help decide when to issue a cross-border injunction.

### C. *Anti-Suit Injunctions in the United States*

The United States has established a framework when issuing anti-suit injunctions, which is an injunction that affects multiple nations similar to a cross-border injunction. Both cross-border injunctions and anti-suit injunctions have multi-national implications and function as a consolidation tool in cases involving multiple jurisdictions.<sup>64</sup> Cross-border injunctions act as a way for patent owners to enforce their patents internationally with a single court tract.<sup>65</sup> In contrast, an anti-suit injunction is a court order that forbids a party from suing in a foreign court or enforcing a foreign court's order if a foreign court has concurrent jurisdiction over the case.<sup>66</sup>

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<sup>59</sup> See also Christian Paul, et. al., *Pan-European Preliminary Injunctions in Patent Infringement Proceedings: Do We Still Need a European Unified Court System?*, JONES DAY (Aug. 2012), <http://www.jonesday.com/pan-european-preliminary-injunctions/>.

<sup>60</sup> E.g., *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 879 (9th Cir. 2012).

<sup>61</sup> *Id.*; see also GERMAN CODE OF CIVIL PROCEDURE, *supra* note 41, § 945.

<sup>62</sup> Paul, *supra* note 59.

<sup>63</sup> Anastasia Hancock, *Intellectual Development: Germany's Reputation as a World IP Hub is Growing as Firms Experience an Uptick in Cross-Border, Precedent-Setting Cases*, FOCUS EUROPE, Summer 2012, (statement of Oliver Jan Jügst, partner of Bird & Bird in European Investment Update) ("The speed of litigation, absence of a full blown defense of invalidity and the availability of injunctions certainly makes Germany a very attractive forum for patent litigation. Some people even call it the 'plaintiff's paradise.'").

<sup>64</sup> See Bühling, *supra* note 4, at 172; Teresa D. Baer, *Injunctions Against the Prosecution of Litigation Abroad: Towards a Transnational Approach*, 37 STAN. L. REV. 155, 156-57 (1984).

<sup>65</sup> See *supra* Part I.A.

<sup>66</sup> Baer, *supra* note 64, at 156-57.

*Microsoft v. Motorola* displays the framework used in anti-suit injunction cases. In *Microsoft*, the U.S. Ninth Circuit Court of Appeals issued an injunction preventing Motorola from enforcing a German court order in Germany.<sup>67</sup> Motorola sued Microsoft in the *Landgericht* in Mannheim, Germany several months into the U.S. case.<sup>68</sup> The Mannheim court granted a preliminary injunction that prevented Microsoft from offering, marketing, using, importing, or possessing the Xbox 360 throughout Germany and offering or supplying Windows 7, Internet Explorer 9, or Windows Media Player 12 in Germany.<sup>69</sup>

The injunction was quite expansive and disruptive to Microsoft, but the German injunction was not self-enforcing because Motorola would need to pay a security bond to enforce the judgment.<sup>70</sup> The U.S. court intervened and barred Motorola from enforcing the German injunction, stating that the anti-suit injunction would remain in effect until the U.S. court determined whether Germany's injunction was the appropriate remedy.<sup>71</sup>

While similar, anti-suit injunctions act differently than cross-border injunctions. A cross-border injunction enjoins infringing or alleged infringing activity.<sup>72</sup> An anti-suit injunction enjoins parties from filing suit in another jurisdiction.<sup>73</sup> Despite differences in the nature of each injunction, courts must weigh procedural fairness, substantive fairness, and comity for both forms of injunctions.<sup>74</sup>

The U.S. anti-suit injunction precedent provides a good framework to equitably balance these fairness factors.<sup>75</sup> This framework can help EU

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<sup>67</sup> See *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 875 (9th Cir. 2012).

<sup>68</sup> *Id.* at 879.

<sup>69</sup> *Microsoft*, 696 F.3d at 879.

<sup>70</sup> *Id.*

<sup>71</sup> *Id.* at 887–89.

<sup>72</sup> See *Bühling*, *supra* note 4, at 174.

<sup>73</sup> *Cole v. Cunningham*, 133 U.S. 107, 118–19 (1890); *Laker Airways Ltd. v. Sabena, Belgian World Airlines*, 731 F.2d 909, 926–27 (D.C. Cir. 1984) (stating that courts in the United States should allow “parallel proceedings on the same *in personam* claim” to continue simultaneously unless equitable principles make enjoining the parallel proceeding appropriate).

<sup>74</sup> See *Laker Airways*, 731 F.2d at 927; see also Baer, *supra* note 64, at 164. The ability to grant an anti-suit injunction is derived from the court's equitable powers. See *E. & J. Gallo Winery v. Andina Licores S.A.*, 446 F.3d 984, 989 (9th Cir. 2006).

<sup>75</sup> The framework synthesizes circuit splits in regard to the anti-suit injunction test. Compare *Kaepa, Inc. v. Achilles Corp.*, 76 F.3d 624, 626–27 (5th Cir. 1996) (granting an anti-suit injunction on the Fifth, Seventh, and Ninth Circuit's reasoning of the *Unterweser* factors), with *id.* at 632 (Garza, E., dissenting) (basing his dissent on precedent from the Second, Sixth, and D.C. Circuit's reasoning of comity).

national courts decide when to issue a cross-border injunction. In *Microsoft*, the Ninth Circuit evaluated an anti-suit injunction case using a tri-partite test.<sup>76</sup> First, the court must decide whether it has jurisdiction over the parties and whether the parties and issues are the same in both the U.S. and foreign cases; second, once the United States decides it has jurisdiction over the case, the court must determine whether it has the power to enjoin a party; third, the court must determine whether it should enjoin a party.<sup>77</sup> Given the multi-national impact the judgment would have on the parties, the court took the following factors into account: (1) whether the parties and issues are the same in both the domestic and foreign actions and whether the first action is dispositive of the action to be enjoined,<sup>78</sup> (2) analysis of the *Unterweser* factors,<sup>79</sup> and (3) “whether the injunction’s ‘impact on comity is tolerable.’”<sup>80</sup> The three-factor framework is only binding on the Ninth Circuit, but other courts are likely to consider the decision persuasive authority.

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<sup>76</sup> *Microsoft*, 696 F.3d at 881.

<sup>77</sup> See Baer, *supra* note 64, at 157–58 (describing the *Unterweser* test). The *Microsoft* case additionally considers comity in its analysis. *Microsoft*, 696 F.3d at 881 (citing *Gallo*, 446 F.3d at 991); see Laura M. Salava, *Balancing Comity with Antisuit Injunctions: Considerations Beyond Jurisdiction*, 20 J. LEGIS. 267, 267–68 (1994), for a discussion on circuit splits.

<sup>78</sup> Baer, *supra* note 64, at 157–58. The courts ask, “‘whether the issues are the same’ not in a technical or formal sense, but ‘in the sense that all the issues in the foreign action . . . can be resolved in the local action.’” *Microsoft*, 696 F.3d at 882–83 (quoting *Applied Med. Distribution Corp. v. Surgical Co. Bv.*, 587 F.3d 909, 915 (9th Cir. 2009)).

<sup>79</sup> The *Unterweser* factors are: “[whether the] foreign litigation . . . would (1) frustrate a policy of the forum issuing the injunction; (2) be vexatious or oppressive; (3) threaten the issuing court’s *in rem* or *quasi in rem* jurisdiction; or (4) where the proceedings prejudice other equitable considerations.” *Microsoft*, 696 F.3d at 882 (quoting *E. & J. Gallo Winery v. Andina Licores S.A.*, 446 F.3d 984, 990 (2009)) (quoting another source) (internal quotation marks omitted).

<sup>80</sup> *Microsoft*, 696 F.3d at 881–82 (quoting *Gallo*, 446 F.3d at 991); see also *Applied Med. Distribution Corp. v. Surgical Co. Bv.*, 587 F.3d 909, 919–20 (9th Cir. 2009). The party requesting an anti-suit injunction must establish grounds for a preliminary injunction. *Microsoft*, 696 F.3d at 883–84 (quoting *Gallo*, 446 F.3d at 990). Normally in preliminary injunction cases the party must demonstrate: (1) that it has a reasonable likelihood of success on the merits; (2) that it is likely to suffer irreparable harm in the absence of preliminary relief; (3) that the balance of hardships tips in its favor; and (4) that an injunction is in the public interest. *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350 (Fed. Cir. 2001) (citing *Reebok Int’l. Ltd. v. J. Baker, Inc.*, 32 F.3d 1552, 1555 (Fed. Cir. 1994)); see also *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 10 (2008); *Microsoft*, 696 F.3d at 883–84 (citing *Gallo*, 446 F.3d at 990). A reasonable likelihood of success is shown when: (1) the party will likely prove that the accused infringer infringes the patent; (2) the infringement will withstand challenges to validity and enforceability; and (3) the party can show a reasonable probability of success on the merits of infringement, validity, and enforceability. *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1364 (Fed. Cir. 1997).

## II. ARTICLES 6(1) AND 22(4) OF COUNCIL REGULATION 44/2001

Part II of this Comment examines ECJ precedent and provides the background to understand what EU national courts consider when issuing a cross-border injunction. Subpart II.A briefly overviews the history of both Council Regulation 44/2001 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters (Council Regulation 44/2001) and the ECJ's seminal case law. Subpart II.B examines Article 6(1) joinder actions in respect to cross-border injunctions. Subpart II.C then relates the ECJ precedent concerning Article 6(1) to the first factor of the U.S. anti-suit injunction framework. Subpart II.D looks at Article 22(4) exclusive jurisdiction for patent validity because EU national courts must avoid exclusive jurisdiction to issue a cross border injunction. National courts have done so using an interim proceedings caveat in Council Regulation 44/2001, such as an Article 31 provisional measure. Before analyzing Article 31, however, Subpart II.E applies Article 22(4) to Germany's provisional measure procedure to show how the ECJ's interpretation of Article 22(4) might impact EU national courts.

### A. *Overview of Council Regulation 44/2001 and ECJ Case Law*

Recognition of civil and commercial judgments in the EU was originally accomplished under the 1968 Brussels Convention.<sup>81</sup> Now, EU Member States abide by Council Regulation 44/2001.<sup>82</sup> The ECJ is the highest court in the EU and ensures that Council Regulation 44/2001 is applied uniformly in all EU national courts.<sup>83</sup>

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<sup>81</sup> See Convention de Bruxelles de 1968 Concernant la Compétence Judiciaire et l'exécution des Décisions en Matière Civile et Commerciale [Brussels Convention of 1968 on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters] 72/454/CEE, Sept. 27, 1968, 1972 J.O. (L 299) 32 (entered into force Feb. 1, 1973), translated in 1978 O.J. (L 304) 36, consolidated version including subsequent accession agreements and protocols at 1998 O.J. (C 27) 3 [hereinafter Brussels Convention]. The Brussels Convention was extended under the Lugano Convention. Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, 1988 O.J. (L 319) 9.

<sup>82</sup> See Council Regulation (EC) 44/2001 of December 22 December 2000 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters, 2001 O.J. (L 12) 1 [hereinafter Council Regulation 44/2001]. The revision of the Brussels Convention has now been adopted, effective January 2015. See Council Regulation 1215/2012, art. 81, of the European Parliament and of the Council of 12 December 2012 on Jurisdiction and the Recognition of Judgments in Civil and Commercial Matters, 2012 O.J. (L 351) [hereinafter Council Regulation 1215/2012]. Council Regulation 1215/2012 states that continuity between the Brussels Convention, Council Regulation 44/2001, and Council Regulation 1215/2012 should be ensured. See *id.* at pmbll., para. 34.

<sup>83</sup> Consolidated Version of the Treaty on European Union art. 19, Oct. 26, 2012, 2012 O.J. (C 326) 13.

On the same day in 2006, the ECJ decided two landmark cases regarding cross-border injunctions: *GAT v. LuK*<sup>84</sup> and *Roche v. Primus*.<sup>85</sup> The relevant Articles in dispute in *GAT* and *Roche* were:<sup>86</sup>

Article 6(1): 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 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.<sup>87</sup>

Article 22(4): The following courts shall have exclusive jurisdiction, regardless of domicile: in proceedings concerned with the registration or validity of patents, . . . the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.<sup>88</sup>

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<sup>84</sup> Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG* (*Gat v. Luk*), 2006 E.C.R. I-6523.

<sup>85</sup> Case C-539/03, *Roche Nederland v. Primus & Goldberg*, 2006 E.C.R. I-6569.

<sup>86</sup> The *GAT* and *Roche* decisions occurred prior to the passage of Council Regulation 44/2001. However, the Articles of the Brussels Convention at issue in *GAT* and *Roche* were implemented into Council Regulation 44/2001 with the Council Regulation stating that continuity between the Brussels Convention and the Council Regulation should be ensured. Council Regulation 44/2001, pmbl., para. 19. *GAT v. LuK* involved interpretation of Article 16(4) of the Brussels Convention. See *GAT v. LuK*, E.C.R. I-6529, para. 13. Article 16(4) of the Brussels Convention parallels Article 22(4) of Council Regulation 44/2001. Compare Council Regulation 44/2001, art. 22(4), with Brussels Convention, art. 16(4). *Roche* involved interpretation of Article 6(1) of the Brussels Convention. *Roche*, 2006 E.C.R. I-6569, para. 5. Article 6(1) of the Brussels Convention parallels Article 6(1) of Council Regulation 44/2001. Compare Council Regulation 44/2001, art. 6(1) with Brussels Convention, art. 6(1). The reader should note that this Comment's main text uses the Council Regulation 44/2001 articles.

<sup>87</sup> Council Regulation 44/2001, art. 6(1). The revision of the Brussels Convention has now been adopted, effective March 2015. See Council Regulation 1215/2012, art. 81. Article 6(1) of Council Regulation 44/2001 is identical to Article 8(1) of Council Regulation 1215/2012. Compare Council Regulation 44/2001, art. 6(1), with Council Regulation 1215/2012, art. 8(1). Council Regulation 1215/2012 states that continuity between the Brussels Convention, Council Regulation 44/2001, and Council Regulation 1215/2012 should be ensured. Council Regulation 1215/2012, pmbl. para. 34.

<sup>88</sup> Council Regulation 44/2001, art. 22(4). The revision of the Brussels Convention has now been adopted and will be effective March 2015. See Council Regulation 1215/2012. Article 24(4) of Council Regulation 44/2001 parallels Article 24(4) of Council Regulation 1215/2012. Compare Council Regulation 44/2001, art. 22(4), with Council Regulation 1215/2012, art. 24(4). Council Regulation 1215/2012 specifically states that continuity between the Brussels Convention, Council Regulation 44/2001 and Council Regulation 1215/2012 should be ensured. Council Regulation 1215/2012, pmbl. para. 34.

The *GAT* and *Roche* decisions closed avenues taken by patent owners to obtain cross-border injunctions.<sup>89</sup> But in 2012, the ECJ decided a third case: *Solvay v. Honeywell*.<sup>90</sup> The *Solvay* decision re-opened the avenues closed by the *GAT* and *Roche* decisions.<sup>91</sup> In light of the ECJ's recent interpretation of Articles 6(1) and 22(4) in *Solvay*, EU national courts are expected to consolidate multi-national litigation through preliminary cross-border injunctions.<sup>92</sup>

### B. Article 6(1): Joinder

In cases involving multiple defendants, EU national courts must determine whether the parties can be joined in a single proceeding.<sup>93</sup> In *Roche*, Doctors Primus and Goldenberg, who were both domiciled in the United States, brought a suit in the Netherlands and claimed that Roche, a company established in the Netherlands, and eight other companies in the Roche group, of which were located across the world, infringed their European patent.<sup>94</sup> The Dutch court held that it had jurisdiction over all parties under Article 6(1) joinder.<sup>95</sup> The Roche companies not established in the Netherlands contested the court's jurisdiction.<sup>96</sup>

For Article 6(1) joinder to apply, there must be such a connection that it is expedient to try the defendants together to avoid irreconcilable judgments.<sup>97</sup>

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<sup>89</sup> See Rödiger, *supra* note 48; Severin de Wit, *Is There an After-Life for Pan European Injunctions?*, IPEG (Mar. 27, 2008), <http://www.ipeg.eu/is-there-an-after-life-for-pan-european-injunctions/> (stating that *GAT v. LuK* and *Roche* "choked the breath out of Cross Border Relief").

<sup>90</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616 (Judgment of the Court).

<sup>91</sup> Wouter Pors, *Holland: Cross-Border Patent Litigation Revival 'Solvay vs Honeywell'*, PATENTS UPDATE (Bird & Bird), Jan. 9, 2013, <http://www.twobirds.com/en/news/articles/2012/holland-crossborder-patent-litigation-revival—solvay-honeywell-0113>; see also John Allen, *EU Court Confirms Dutch Approach to Cross-Border Injunctions*, AIPPI E-NEWS, Sept. 2012, [https://www.aippi.org/enews/2012/edition26/John\\_Allen.html](https://www.aippi.org/enews/2012/edition26/John_Allen.html); Gualtiero Dragotti, *Cross-Border Remedies Through the Courts: Solvay v. Honeywell: Are Cross Border Patent Injunctions Viable (Again)?*, DLA PIPER (Dec. 6, 2012), <http://www.dlapiperoutsourcing.com/knowledge-centre/pages/2012/intellectual-property/emea/global-sourcing-portal-know-how-cross-border-remedies-december12.html>.

<sup>92</sup> See Pors, *supra* note 91.

<sup>93</sup> See John Allen, *EU Court Confirms Dutch Approach to Cross-Border Injunctions*, AIPPI E-NEWS (Sept. 2012), [https://www.aippi.org/enews/2012/edition26/John\\_Allen.html](https://www.aippi.org/enews/2012/edition26/John_Allen.html).

<sup>94</sup> *Roche*, 2006 E.C.R. I-6571, para. 2. The Roche group was established in Belgium, Germany, France, the United Kingdom, Switzerland, Austria, Sweden, and the United States. *Id.*

<sup>95</sup> *Id.* para. 21.

<sup>96</sup> *Id.* para. 15.

<sup>97</sup> *Id.* para. 20 (citing Case C-189/87, *Kalfelis v. Schröder*, 1988 E.C.R. I-5565, para. 13) ("[T]here must exist, between the various actions brought by the same plaintiff against different defendants, a connection of such a kind that it is expedient to determine the actions together in order to avoid the risk of irreconcilable

The ECJ in *Roche* determined that even if a broad interpretation of “irreconcilable judgments” were given, there was no risk of irreconcilable judgments because the cases would necessarily involve different facts and law.<sup>98</sup> The facts could never be the same because “the existence of the same situation of fact cannot be inferred, since the defendants are different and the infringements they are accused of, committed in different Contracting States, are not the same.”<sup>99</sup> Further, the ECJ stated that multiple defendants could never pass the irreconcilable judgments test because any parallel cases in different national jurisdictions could not contradict one another given that EU national courts apply different substantive law.<sup>100</sup> The facts and law between defendants would necessarily be different, so the Dutch court could not find such a connection between defendants.<sup>101</sup> As a result, Article 6(1) joinder would never apply in patent cases.<sup>102</sup>

The ECJ revisited Article 6(1) in *Solvay*.<sup>103</sup> *Solvay*, a company established in Belgium, brought an action in the Netherlands claiming that three Honeywell companies, one Dutch and two Belgian, infringed its patent when marketing the identical product in countries where the *Solvay* patent was valid.<sup>104</sup> *Solvay* sought provisional relief in the form of a preliminary cross-border injunction.<sup>105</sup> The Dutch court decided to stay the proceedings and refer jurisdictional questions to the ECJ.<sup>106</sup>

The ECJ was asked whether separate proceedings against multiple companies from different EU Member States, each separately accused of infringing the same part of a European patent, could result in irreconcilable judgments.<sup>107</sup> The Advocate General, in his opinion of the *Solvay* case,

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judgments resulting from separate proceedings.”). The requirement of a connection between parties is not expressly required in Article 6(1) but rather inferred. *Id.* para. 21 (citing *Kalfelis*, 1988 E.C.R. I-5565, para. 8); see also Council Regulation 44/2001, art. 6(1) (requirement explicitly placed in the redrafting of Article 6(1)).

<sup>98</sup> *Roche*, 2006 E.C.R. I-6579, para. 25.

<sup>99</sup> *Id.* para. 27.

<sup>100</sup> *Id.* paras. 27, 31.

<sup>101</sup> *Id.*

<sup>102</sup> See *id.* para. 33. See also LUGINBUEHL, *supra* note 35, at 96–97.

<sup>103</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616 (Judgment of the Court).

<sup>104</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 7–8, 13 (Mar. 29, 2012) (Opinion of Advocate General).

<sup>105</sup> *Id.* para. 8.

<sup>106</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, para. 16 (Judgment of the Court).

<sup>107</sup> *Id.* para. 16.

criticized the *Roche* decision by pointing out that the reasoning would render Article 6(1) ineffective in patent cases.<sup>108</sup> The Advocate General would not explicitly overturn the decision but instead adopt a more nuanced approach.<sup>109</sup> The defendants in *Solvay* were separately accused of infringing the same parts of the European patent<sup>110</sup> whereas in *Roche*, the defendants were separately accused of infringing different parts of the European patent.<sup>111</sup> Article 6(1) could thus apply—and parties joined—when multiple parties are alleged to infringe the same part of a European patent, assuming an identical situation of facts.<sup>112</sup>

The ECJ sided with the Advocate General and held that EU national courts can join two or more companies from different EU Member States, in proceedings pending before a court of one of those EU Member States, if the companies are separately accused of infringing the same part of a European patent.<sup>113</sup>

Overall, *Roche* was seen as preventing Article 6(1) joinder in multi-national patent litigation.<sup>114</sup> *Solvay* reframes the applicability of Article 6(1) joinder actions. In light of *Solvay*, multiple defendants can be joined via Article 6(1) in a multi-national patent infringement suit if the parties are alleged to infringe the same part of a European patent—such as an identical claim—using the same infringing activity.<sup>115</sup>

### *C. Analysis of Article 6(1) Contrasted with Factor One of the U.S. Anti-Suit Injunction Framework*

The first factor of the U.S. anti-suit injunction framework, whether the parties and the issues are the same and whether the first action is dispositive of

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<sup>108</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 18 (Opinion of Advocate General).

<sup>109</sup> *Id.* paras. 21–22.

<sup>110</sup> *Id.* para. 10.

<sup>111</sup> See *Roche*, 2006 E.C.R. I-6580, para. 27.

<sup>112</sup> *Solvay*, 2012 EUR-Lex CELEX LEXIS paras. 23–27 (Opinion of the Advocate General) (emphasis added).

<sup>113</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 28–30 (Judgment of the Court).

<sup>114</sup> See Rödiger, *supra* note 48 (declaring the spider-in-the web-doctrine dead); de Wit, *supra* note 89.

<sup>115</sup> See *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 30 (Judgment of the Court); *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 27 (Opinion of Advocate General) (“[I]f the condition of an identical situation of fact is met, be applicable to a bundle of infringement actions against different companies established in different Member States if they relate separately to acts carried out in the same Member State that infringe the same national part of a European patent governed by the same law.”).

the action to be enjoined, parallels the logic the ECJ applied in *Solvay*. A U.S. court will tilt in favor of issuing an anti-suit injunction if the parties and issues are the same and the first action is dispositive of the action to be enjoined.<sup>116</sup> EU cross-border injunction cases similarly ask whether the parties and the issues are the same under Article 6(1) joinder.<sup>117</sup> Parties in an Article 6(1) joinder case must have such a connection that it is expedient to try the defendants together to avoid irreconcilable judgments.<sup>118</sup> Such a connection is present when the parties and the cases involve the same issues of fact and law.<sup>119</sup>

In *Microsoft*, the Ninth Circuit used the first factor of the anti-suit injunction framework to ask whether the parties and issues are the same in the sense that all the issues in the foreign action can be resolved in the local action.<sup>120</sup> The court primarily sought an efficient, equitable, and expedient consolidation of litigation.

A U.S. court stated that the parties and issues can never be the same in a pure patent case because “[i]ntellectual property issues, in contrast [to contract cases], involve separate and independent rights arising from the unique laws of each nation.”<sup>121</sup> Similarly, the court in *Microsoft* stated that a U.S. court cannot issue an anti-suit injunction on the basis of patent validity or infringement, but a U.S. court could enjoin Motorola because the German patent claims at issue fell under the “contractual umbrella” of the contract signed in the United States.<sup>122</sup> Although the first factor is not typically met in U.S. patent cases, the

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<sup>116</sup> See *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 881–82 (9th Cir. 2012) (quoting *Applied Med. Distribution Corp. v. Surgical Co. Bv.*, 587 F.3d 909, 915 (9th Cir. 2009)).

<sup>117</sup> See, e.g., Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, para. 27 (July 12, 2012) (Judgment of the Court).

<sup>118</sup> See Council Regulation 44/2001, art. 6(1); see, e.g., *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616 para. 23 (Judgment of the Court).

<sup>119</sup> See *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 27 (Judgment of the Court). The ECJ’s analysis of irreconcilable judgments applies to Article 6(1) joinder rather than Article 31 provisional measures. See *id.* The “such a connection” language in Article 6(1) should not be confused with the “connected links between the subject matter of the provisional measures sought and to territorial jurisdiction of the court seised” within the Article 31 provisional measures analysis. See *infra* Part III.B, for an analysis of “connected link” in Article 31.

<sup>120</sup> *Microsoft*, 696 F.3d at 881–85.

<sup>121</sup> See *Black & Decker Corp. v. Sanyei Am. Corp.*, 650 F.Supp. 406, 409 (N.D. Ill. 1986). The U.S. approach parallels the reasoning that the ECJ gave in *Roche*. See *Roche*, 2006 E.C.R. I-6581, ¶ 31 (holding that European patent infringement cases involving different States and multiple defendants poses no risk of contradictory decisions because they would never arise in the same legal context).

<sup>122</sup> *Microsoft*, 696 F.3d at 883 (citing *Medtronic, Inc. v. Catalyst Research Corp.*, 518 F.Supp. 946, 955 (D.Minn. 1981), *aff’d*, 664 F.2d 660 (8th Cir. 1981)). The first factor was met in *Microsoft* because the

first factor could apply to cross-border injunctions in patent cases within the EU. In contrast to U.S. patent law, the ECJ in *Solvay* concluded that multiple patent actions, involving parallel patents, could involve the same issues of fact and law.<sup>123</sup> Patent litigation in the EU is unique due to parallel patents, so a party can infringe the same parts of multiple patents whereas patents between the United States and a country such as Germany are derived from separate patent applications entirely.

Considering the logic behind *Roche* and *Solvay*, the first factor, whether the issues and the parties are the same and whether the action is dispositive to the action to be enjoined, is consistent with the ECJ's Article 6(1) precedent.

*D. Article 22(4): Exclusive Jurisdiction for Patent Validity*

Before issuing a cross-border injunction in a patent case, an EU national court must determine whether it has jurisdiction to hear validity. Patent protection in the EU is territorial. EU member states independently grant patent rights to the patent owner, and the patent owner enforces the patent in each corresponding EU national court.<sup>124</sup> It is undesirable for a separate foreign court—other than the member state's court that granted the patent—to have the power to invalidate the patent.<sup>125</sup> Article 22(4) thus grants exclusive jurisdiction over validity to the country for which the patent was issued and thus allows only this country to invalidate the patent.<sup>126</sup>

The Netherlands controversially started hearing patent infringement cases involving both Dutch patents and patents from other EU member states, which was the start of cross-border injunctions.<sup>127</sup> To hear cases involving patents from other EU member states, Dutch courts had to avoid Article 22(4) exclusive jurisdiction for validity because essentially all defendants raise a

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underlying issue in both the U.S. and Germany actions involved the same contract terms, not because the actions involved the same patent or invention. *Id.*

<sup>123</sup> See *Solvay*, EUR-Lex CELEX 62010CJ0616, para. 27 (Judgment of the Court). *But see Roche*, 2006 E.C.R. I-6580, para. 27.

<sup>124</sup> See *Bender*, *supra* note 15, at 57–59.

<sup>125</sup> See *Hoyng*, *supra* note 6.

<sup>126</sup> See Council Regulation 44/2001 art. 22(4).

<sup>127</sup> See Jaap Bremer, *The Revival of Cross-Border Injunctions* (Sep. 3, 2013 4:46 PM), <http://vlex.com/vid/the-revival-cross-border-injunctions-445399502> (citing HR 24 februari 1989, NJ 1992, 1597 m.nt. (Interlas/Lincoln) (Neth.)) (explaining that Dutch courts can issue cross-border relief in instances of illegal acts of a cross-border nature).

defense of validity in infringement proceedings.<sup>128</sup> The procedure would go as follows: the Netherlands would use provisional proceedings to decide issues of infringement while staying the issue of validity.<sup>129</sup> As a result, the court would retain jurisdiction over the main dispute and wait until the corresponding EU national court decided the issue of validity.<sup>130</sup> The national court would thus surrender the battle of Article 22(4) validity but win the war by retaining jurisdiction over the determination of patent infringement.<sup>131</sup>

The *GAT* case was even more controversial because an EU national court made a judgment on the validity of a foreign patent. In *GAT*, a German court held a French patent invalid.<sup>132</sup> Wanting the court's determination to be upheld, *GAT* argued that the German court did not infringe France's sovereignty when holding the patent invalid because the court only held the patent invalid for the case at issue, not for future cases.<sup>133</sup> The German higher regional court stayed the proceedings and referred the case to the ECJ.<sup>134</sup> On appeal, the ECJ rejected *GAT*'s argument and found that the intent of Article 22(4) was to "ensure that jurisdiction rests with courts closely linked to the proceedings in fact and law."<sup>135</sup> The ECJ provided three justifications for its ruling—allowing courts to bypass exclusive jurisdiction under Article 22(4) would: (1) "multiply[] the heads of jurisdiction," (2) "undermine the predictability of the rules of jurisdiction," and (3) "undermine the principle of legal certainty."<sup>136</sup> Following the *GAT* decision, it appeared that Article 22(4) would prevent cross-border injunctions, even in provisional proceedings.<sup>137</sup>

The ECJ revisited Article 22(4) in *Solvay* to clarify whether exclusive jurisdiction applies when validity is raised in provisional proceedings, such as

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<sup>128</sup> Bender, *supra* note 15, at 78–79.

<sup>129</sup> See Hoyng, *supra* note 6.

<sup>130</sup> See *id.*

<sup>131</sup> See Richard A. Kempner & Joe Fricker, *Can UK Courts Face the Dutch Challenge on Cross-Border Injunctions in Intellectual Property Cases?*, 7 EUR. INTELL. PROP. REV. 377, 377 (1996). See Heleen Bertrams, *The Cross-Border Prohibitory Injunction in Dutch Patent Law*, 26 INT'L REV. INDUS. PROP. & COPYRIGHT L. 618, 626, 630, 636 (1995) (advocating for more restraint on the part of the judge), for a discussion on the Netherlands' impact on cross-border enforcement.

<sup>132</sup> Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen and Kupplungsbau Beteiligungs KG (Gat v. Luk)*, 2006 E.C.R. I-6528, para. 10.

<sup>133</sup> *Id.* para. 13. The patent would remain valid in the patent register. *Id.*

<sup>134</sup> *Id.*

<sup>135</sup> *Id.* para. 21.

<sup>136</sup> *Id.* para. 28.

<sup>137</sup> See Rödiger, *supra* note 48.

a provisional cross-border injunction.<sup>138</sup> The Advocate General in his opinion on the *Solvay* case emphasized that keeping jurisdiction in the country the patent issued in is important because that EU national court should decide whether to invalidate its own patent.<sup>139</sup> The Advocate General's opinion—and ultimately the ECJ's—departed from *GAT* because the Court acknowledged that it is possible to raise validity in a case while not triggering exclusive jurisdiction under Article 22(4).<sup>140</sup> Although not specifically outlined in the Court's decision, the Advocate General provided four hypotheticals where the validity of the patent can arise in a patent infringement suit: (a) both the main proceedings and the interim proceedings, (b) only in the main proceedings, (c) only in the interim proceedings where the defendant may not have had the opportunity to raise the question of validity, and (d) only in the interim proceedings where the defendant may have had the opportunity but chose not to take advantage of it, such as when validity is not in dispute.<sup>141</sup>

Article 31 would still stand under hypotheticals (a) and (b), where validity was raised in the main proceedings and validity was raised both in the main proceedings and the interim proceedings.<sup>142</sup> Article 22(4) would apply in these situations, and an EU national court must declare that it does not have jurisdiction.<sup>143</sup> The EU national court where the suit was brought would surrender jurisdiction to the EU national court where the patent was granted.<sup>144</sup>

In the case of hypothetical (c), where validity was raised only in the interim proceedings and the defendant may not have had the opportunity to raise the question of validity, a national court could consider a provisional measure,

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<sup>138</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, para. 16 (Judgment of the Court).

<sup>139</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, EUR-Lex CELEX 62010CJ0616, para. 36 (Mar. 29, 2012) (Opinion of Advocate General).

<sup>140</sup> See *id.* paras. 34–37; *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 34 (Judgment of the Court).

<sup>141</sup> *Solvay*, 2012 EUR-Lex CELEX LEXIS paras. 38–40 (Opinion of the Advocate General).

<sup>142</sup> *Id.* para. 39; see Willem Hoyng, *Comments Willem Hoyng on Opinion AG in Solvay/Honeywell Case*, EPLAW PATENT BLOG (Apr. 20, 2012), <http://www.eplawpatentblog.com/eplaw/2012/04/comments-willem-hoyng-on-opinion-ag-in-solvayhoneywell-case-cross-border-in-preliminary-proceedings.html>. Willem Hoyng, counsel for *Solvay* and *Roche*, still contests that such a determination is improper because the *GAT v. LuK* case only held that the court must surrender jurisdiction in cases of invalidity, not infringement. *Id.* With this view, the court could either make a determination of infringement or stay the infringement proceedings while separate proceedings on validity occur in the proper jurisdictions. *Id.*

<sup>143</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 43 (Opinion of Mr. Advocate General).

<sup>144</sup> See Council Regulation 44/2001 art. 25 (“Where a court of a Member State is seised of a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 22, it shall declare of its own motion that it has no jurisdiction.”).

such as a preliminary cross-border injunction.<sup>145</sup> However, the provisional measure could only be adopted if, within a reasonable period, the court is also seized of the main proceedings.<sup>146</sup> Therefore, Article 22(4) would not necessarily prevent a cross-border injunction if the measure was purely provisional in nature.<sup>147</sup> Additionally, the Advocate General did not address whether *ex parte* decisions would fit within hypothetical (c).<sup>148</sup> According to hypothetical (c), Article 22(4) does not apply to *ex parte* decisions if the *ex parte* judgment is provisional in nature.<sup>149</sup>

In the case of hypothetical (d), where validity was raised only in the interim proceedings and the defendant may have had the opportunity to raise validity but chose not to take advantage of it, the court seized could decide on the provisional measure in accordance with its national law without triggering exclusive jurisdiction under Article 22(4).<sup>150</sup> Virtually every defendant in cross-border proceedings raises an invalidity defense, so in practice a defendant is extremely unlikely to have an opportunity to raise validity and choose not to take it. Where this situation could apply is when a validity defense is raised simply as a delay tactic<sup>151</sup> or if the patent in dispute was held valid in a previous suit.<sup>152</sup> In such instances, Article 22(4) would not prevent a cross-border injunction.

Ultimately, the ECJ sided with the Advocate General and seemingly took Article 31 even further because the Court did not specifically adopt the Advocate General's hypothetical system. The ECJ stated, "Article 31 is independent in scope from Article 22(4) . . . so that Article 22(4) . . . cannot, as a rule, be interpreted so as to derogate from Article 31 and, consequently, cause it to be disapplied."<sup>153</sup> "[T]he court before which the interim proceedings have been brought does not make a final decision on the validity of the patent invoked but makes an assessment as to how the court having jurisdiction under

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<sup>145</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 41 (Opinion of Advocate General); see *infra* Part III of this Comment for a discussion on Article 31 provisional measures.

<sup>146</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 41 (Opinion of Advocate General).

<sup>147</sup> *Id.*

<sup>148</sup> See *id.* paras. 38–43.

<sup>149</sup> See *infra* Part III.A (explaining that the ECJ interprets what constitutes a provisional measure broadly).

<sup>150</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 43 (Opinion of Advocate General).

<sup>151</sup> *Id.* para. 42.

<sup>152</sup> See BARDEHLE PAGENBERG, *supra* note 45, at 8–9.

<sup>153</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, para. 40 (Judgment of the Court).

Article 22(4) of the regulation would rule in that regard . . . .”<sup>154</sup> The national court would refuse to adopt the provisional measure sought if it considers that “there is a reasonable, non-negligible possibility” that the court having jurisdiction under Article 22(4) would invoke the patent. So, when the court finds that there is a reasonable, non-negligible possibility that the patent would be invoked, that court can grant an interim decision, such as a provisional cross-border injunction under Article 31.<sup>155</sup>

*Solvay* showed how exclusive jurisdiction under Article 22(4) is not always triggered when validity is raised in interim proceedings, such as a provisional measure.<sup>156</sup> Before discussing Article 31 provisional measures, this Comment first applies Article 22(4) to Germany procedure to show how the ECJ’s recent interpretation of Article 22(4) could make an impact in certain national procedures.

#### *E. Preliminary Cross-Border Injunctions in Germany*

Exclusive jurisdiction under Article 22(4) is not applicable when the patent’s validity is raised in interim proceedings of an infringement suit.<sup>157</sup> Given Germany’s bifurcated system, invalidity is not a defense in infringement proceedings.<sup>158</sup> Instead, the patent is presumed valid.<sup>159</sup> The defense of validity is thus arguably outside the realm of the main infringement proceedings; actually, validity is in a way irrelevant in German infringement proceedings. Using this logic, one can argue that Article 22(4) does not apply in German infringement proceedings.<sup>160</sup> Further, *ex parte* decisions could be interpreted to be exempt from Article 22(4) under both the ECJ’s decision and the Advocate General’s reasoning in hypothetical (c). If this proves accurate, German courts will become even more patent owner friendly because a patent owner could consolidate multi-national patent litigation into German courts without concerns over Article 22(4).

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<sup>154</sup> *Id.* para. 49.

<sup>155</sup> *See id.* para. 50.

<sup>156</sup> *See Solvay*, 2012 EUR-Lex CELEX LEXIS para. 30 (Opinion of Advocate General).

<sup>157</sup> *See Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 49–51 (Judgment of the Court); *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 51(b) (Opinion of Advocate General).

<sup>158</sup> *See supra* Part I.B.1; *see also* Klink & Geldard, *supra* note 29, at 499.

<sup>159</sup> *See* Klink & Geldard, *supra* note 29, at 499.

<sup>160</sup> *See* Rödiger, *supra* note 48.

Although the *Solvay* decision opened the door for the benefits of cross-border injunctions, the decision also presents EU national courts, such as Germany, with upcoming procedural difficulties.

Parties anticipating patent litigation in Germany may consider filing an anticipatory brief.<sup>161</sup> An anticipatory brief is a precautionary brief from a potential opponent to a claim.<sup>162</sup> A party submits an anticipatory brief without reference to any existing or pending proceedings in the court, and the court usually keeps the brief on file for six months.<sup>163</sup> The brief provides an avenue for a party to bring up validity and thus trigger Article 22(4) exclusive jurisdiction, an avenue that otherwise might not be available.<sup>164</sup> Further, a potential opponent to a claim can use anticipatory briefs to prevent the risk of a preliminary cross-border injunction being granted *ex parte* by ensuring that oral argument is heard.<sup>165</sup> The ability to use anticipatory briefs to ensure that Germany has exclusive jurisdiction under Article 22(4) is not an ideal solution, however, and is actually quite burdensome, especially for foreign parties.

To see how EU national courts can address this concern as well as the relations between one another, the next section of this Comment will look at the situations courts can rely on Article 31 and its language to issue a cross-border injunction.

### III. ARTICLE 31 OF COUNCIL REGULATION 44/2001

An EU national court having jurisdiction under either Article 6(1), Article 22(4), or any other article in Council Regulation 44/2001 also has jurisdiction to order an Article 31 provisional measure without being subject to any further conditions.<sup>166</sup> However, the ECJ was asked whether a national court can assert jurisdiction under Article 31 in the event that the court does not have jurisdiction under Article 6(1) or Article 22(4).<sup>167</sup> Article 31 is as follows:

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<sup>161</sup> Paul et al., *supra* note 59.

<sup>162</sup> BARDEHLE PAGENBERG, *supra* note 45, at 9.

<sup>163</sup> *Id.*

<sup>164</sup> See Paul et al., *supra* note 59; BARDEHLE PAGENBERG, *supra* note 45, at 9.

<sup>165</sup> BARDEHLE PAGENBERG, *supra* note 45, at 9.

<sup>166</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, para. 44 (Mar. 29, 2012) (Opinion of Advocate General); Case C-391/95, *Van Uden Maritime BV v. Kommanditgesellschaft*, 1998 E.C.R. I-7131, para. 22; Case C-99/96, *Hans-Hermann Mietz v. Intership Yachting Sneek BV*, 1999 E.C.R. I-2314, para. 41.

<sup>167</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, para. 16 (Judgment of the Court). The Advocate General provided an opinion of the question, but the ECJ did

“Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that State, even if, under the Regulation, the courts of another Member State have jurisdiction as to the substance of the matter.”<sup>168</sup>

A. *Article 31 Provisional Measures in Solvay v. Honeywell*

Three elements must be met to hold jurisdiction under Article 31: (1) that the provisional measure falls within the scope of Council Regulation 44/2001, (2) that the provisional measure be provisional in nature, and (3) that the measure has “a real connecting link between the subject-matter of the provisional measures sought and the territorial jurisdiction of the EU Member State of the court seised.”<sup>169</sup>

First, Article 31 requires that a provisional measure fall within the scope of Council Regulation 44/2001—that it be restricted to civil and commercial matters.<sup>170</sup> A measure is held “civil or commercial” not by the inherent nature of the provisional measure but rather by the nature of the rights that the measure safeguards.<sup>171</sup> A provisional cross-border injunction sought to prevent patent infringement unquestionably fits within the scope of Article 31.<sup>172</sup>

Second, Article 31 requires that a provisional measure be provisional in nature.<sup>173</sup> A provisional measure is meant to preserve a factual or legal situation for the dispute to be resolved in a main proceeding.<sup>174</sup> A measure is

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not find a need to answer this specific question in its decision. *Compare id.* para. 52, with *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, (Opinion of the Advocate General). The Advocate General’s opinion provides insight on how the ECJ might rule on the subject in future cases. *Id.* paras. 22–29.

<sup>168</sup> Council Regulation 44/2001 art. 31. The revision of the Brussels Convention has now been adopted, effective March 2015. *See* Council Regulation 1215/2012. Article 31 of Council Regulation 44/2001 parallels Article 35 of Council Regulation 1215/2012. *Compare* Council Regulation 44/2001 art. 31, with Council Regulation 1215/2012, art. 35. Council Regulation 1215/2012 specifically states that continuity between Council Regulation 44/2001 and Council Regulation 1215/2012 should be ensured. *See* Council Regulation 1215/2012 pmb1., para. 34.

<sup>169</sup> *See Solvay*, 2012 EUR-Lex CELEX LEXIS paras. 47–49 (Opinion of Advocate General).

<sup>170</sup> *Id.* para. 47.

<sup>171</sup> *Id.*; *Van Uden Maritime*, 1998 E.C.R. I-7133, para. 33 (citing Case C-261/90 Reichert v. Dresdner Bank 1992 E.C.R. I-2149, para. 32).

<sup>172</sup> *See Solvay*, 2012 EUR-Lex CELEX LEXIS para. 47 (Opinion of Advocate General).

<sup>173</sup> *Id.* para. 48; Case C-104/03, *St Paul Dairy Indus. NV v. Unibel Exser BVBA*, 2005 E.C.R. I-3481, para. 13.

<sup>174</sup> *See Reichert*, 1992 E.C.R. I-2149, para. 34; *see also* Andrew Dickinson, *Provisional Measures in the “Brussels I” Review: Disturbing the Status Quo?*, 6 J. OF PRIVATE INT’L L. 519, 519 (2010) (citing Council Regulation 44/2001 art. 31).

provisional in nature if the measure was made after the main action has started, irrespective of what forum the main action has started in.<sup>175</sup> A provisional measure must also be for a limited period, and it must expire after a specified period of time.<sup>176</sup>

The ECJ has interpreted “provisional measure” broadly. The ECJ determined that the *kort geding* procedure in the Netherlands is provisional in nature despite the fact that most judgments by the *kort geding* are not followed by subsequent proceedings.<sup>177</sup> Both parties in a *kort geding* orally explain their written claims to the court, and the judge may hear witnesses or ask for expert testimony (although expert testimony rarely occurs).<sup>178</sup> Oral argument usually lasts half a day, and decisions are usually issued in writing within two weeks.<sup>179</sup> The entire procedure lasts about two to three months.<sup>180</sup> Although the procedure is provisional, parties in ninety-five percent of cases accept the decision of the *kort geding* as a final judgment and do not typically initiate further proceedings afterwards.<sup>181</sup> Nonetheless, the ECJ has determined that the *kort geding* procedure is provisional in nature.<sup>182</sup>

Third, and most importantly, the measure must have “a real connecting link between the subject-matter of the provisional measures sought and the territorial jurisdiction of the EU Member State of the court seised.”<sup>183</sup> Little guidance was given to help EU national courts decide what constitutes a “connecting link.”<sup>184</sup>

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<sup>175</sup> See *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 52 (Opinion of Advocate General) (explaining that the *ratione temporis* was potentially fulfilled because the preliminary application was made after the main action had started) (emphasis added).

<sup>176</sup> *Id.* paras. 48–49.

<sup>177</sup> See *Hans–Hermann Mietz*, 1999 E.C.R. I-2313, para. 38; see also CHRISTOPHER WADLOW, ENFORCEMENT OF INTELLECTUAL PROPERTY IN EUROPEAN AND INTERNATIONAL LAW 16 (Sweet & Maxwell 1998).

<sup>178</sup> See LUGINBUEHL, *supra* note 35, at 68; see also Bertrams, *supra* note 131, at 626–28 (on the *kort geding* procedure).

<sup>179</sup> See LUGINBUEHL, *supra* note 35, at 68.

<sup>180</sup> Xandra Kramer, *Provisional and Protective Measures: Article 24 Brussels Convention (= Article 31 Brussels Regulation)*, May 18–20, 2000, at 4, available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1129709](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1129709).

<sup>181</sup> *Id.*

<sup>182</sup> See *Hans–Hermann Mietz*, 1999 E.C.R. I-2313, para. 38.

<sup>183</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 50 (Opinion of Advocate General) (citing Case C-391/95, *Van Uden Maritime BV v. Kommanditgesellschaft*, 1998 E.C.R. I-7131, para. 40).

<sup>184</sup> See *id.* paras. 52–54; Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 49–51 (Judgment of the Court).

### B. *Connecting Link*

The determination of what constitutes a connecting link was left up to EU national courts.<sup>185</sup> The Advocate General gave two interpretations. First, the EU national court is not closely connected to the subject matter of the provisional measures sought when the provisional measure does not have an effect in its territory.<sup>186</sup> In reality, however, virtually every case will have at least a minimum effect. Second, the Advocate General stated:

[A connecting link] is more a condition of minimum territorial localisation of the provisional measure sought. The existence of a real connecting link should thus be considered chiefly in the light of the enforcement procedures of the Member State of the court seised.<sup>187</sup>

The Advocate General essentially said that an EU national court has the discretion to issue a preliminary cross-border injunction via an Article 31 provisional measure to the extent the EU national court can enforce its judgment.<sup>188</sup>

A preliminary cross-border injunction is only effective if other nations comply with the judgment because a court order has no effect if it cannot be enforced.<sup>189</sup> Enforcement may seem problematic when the conduct occurs in multiple countries.<sup>190</sup> However, enforcement is not problematic when only the country of the litigation is involved.<sup>191</sup> An EU national court does not necessarily have to rely on a separate country to assist in the enforcement of its judgment. The EU national court that granted the injunction can enforce its judgment through a contempt order or similar measure, assuming the alleged infringer has assets or does business within the country.<sup>192</sup> For example, the United States was able to enforce its anti-suit injunction judgment in the *Microsoft* case because both parties involved in the dispute were U.S.

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<sup>185</sup> *See id.* para. 54.

<sup>186</sup> *Id.* para. 55.

<sup>187</sup> *Id.* para. 53.

<sup>188</sup> *See id.* paras. 53–54.

<sup>189</sup> *See* Marketa Trimble, *Cross-Border Injunctions in U.S. Patent Cases and their Enforcement Abroad*, 13 MARQ. INTELL. PROP. L. REV. 331, 332 (2006).

<sup>190</sup> *See id.*

<sup>191</sup> *See id.*

<sup>192</sup> TRIMBLE, *supra* note 6, at 39.

companies and had assets in the United States.<sup>193</sup> Because an EU national court can use similar enforcement mechanisms and can ultimately enforce a cross-border dispute without reliance on a separate country,<sup>194</sup> the existence of the connecting link is not necessarily best considered chiefly in light of the enforcement procedures of the court seized.

The ECJ and the Advocate General provided very little additional guidance for EU national courts. Virtually every case has at least a minimum effect, and enforcement is not necessarily problematic for all multi-national injunctions. The *Solvay* decision thus left an open question for EU national courts to decide.

### C. *The Unterweser Factors Can Help Define Article 31 “Connecting Links”*

EU national courts can only grant a provisional cross-border injunction if the EU national court has a “connecting link” to the subject matter of the case.<sup>195</sup> The ECJ has not provided a framework to evaluate Article 31 cross-border injunction cases. However, the United States does have a set of factors to determine whether the U.S. court is justifiably connected to a case with multi-national implications.<sup>196</sup> In the United States, an increasing concern in determining whether a U.S. court can justifiably request an anti-suit injunction is whether such an action would upset international comity.<sup>197</sup> Both anti-suit injunctions and cross-border injunctions have multi-national implications and function as a consolidation tool in cases involving multiple jurisdictions.<sup>198</sup> Despite differences in what activity is being enjoined, the factors that courts must weigh when deciding whether to issue a judgment with multi-national implications are the same.

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<sup>193</sup> See *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 881 (9th Cir. 2012) (“[B]oth parties are U.S. corporations and the facts at issue in the contract dispute took place within the United States.”). The Court could similarly enforce its judgment if Motorola was a foreign company but had assets in the United States or was a U.S. company without assets in the country. See *id.* (quoting *Gallo*, 446 F.3d at 989) (“A federal district court with jurisdiction over the parties has the power to enjoin them from proceeding with an action in the courts of a foreign country. . . .”) (internal quotation marks omitted).

<sup>194</sup> For example the court can enjoin a party or its assets within its country.

<sup>195</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 50 (Opinion of Advocate General).

<sup>196</sup> *Microsoft Corp.*, 696 F.3d at 881–82.

<sup>197</sup> See, e.g., Trevor C. Hartley, *Comity and the Use of Antisuit Injunctions in International Litigation*, 35 AM. J. COMP. L. 487, 487 (1987) (examining the use of anti-suit injunctions and considering whether they involve a threat to good relations with foreign countries).

<sup>198</sup> See Bühling, *supra* note 4, at 172.

In Part II.C, this Comment discussed the first factor of the U.S. anti-suit injunction framework, which is whether the parties and the issues are the same and whether the first action is dispositive of the action to be enjoined. The second factor of the U.S. anti-suit injunction framework, the *Unterweser* factors, can help EU domestic courts define what constitutes a connecting link between the subject matter of the provisional measures sought and the territorial jurisdiction of the court seized. The *Unterweser* factors are: “[whether the] foreign litigation . . . would (1) frustrate a policy of the forum issuing the injunction; (2) be vexatious or oppressive; (3) threaten the issuing court’s *in rem* or *quasi in rem* jurisdiction; or (4) where the proceedings prejudice other equitable considerations.”<sup>199</sup> A U.S. court will tilt in favor of issuing an anti-suit injunction if at least one of the *Unterweser* factors is met.<sup>200</sup>

### *I. The First Unterweser Factor*

The first *Unterweser* factor is whether the foreign litigation would frustrate a policy of the forum issuing the injunction.<sup>201</sup> The first *Unterweser* factor can help EU national courts define what constitutes a “connecting link” because the factor allows EU national courts to balance policy on a case-by-case basis; a stronger policy concern, the closer the connection between the court and the subject matter.

The ECJ in *Solvay* sought to avoid the risk of irreconcilable judgments.<sup>202</sup> The Ninth Circuit in *Microsoft* similarly issued an anti-suit injunction to avoid the risk of inconsistent judgments.<sup>203</sup> The Ninth Circuit in *Microsoft* was concerned that the integrity of the U.S. decision would become lessened because the German action might result in a judgment before the U.S. action.<sup>204</sup> Further, the Ninth Circuit also issued the anti-suit injunction for another policy reason—to retain control of reasonable and nondiscriminatory

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<sup>199</sup> *Zapata Off-Shore Co. v. M/S Bremen (In re Unterweser Reederei)*, 428 F.2d 888, 890 (5th Cir. 1970), *aff’d en banc*, 446 F.2d 907, *rev’d*, 407 U.S. 1 (1972).

<sup>200</sup> *See Zapata Off-Shore Co.*, 407 U.S. at 15 (finding that forum clauses should be enforced unless there is a strong showing that enforcement would be unreasonable or unjust).

<sup>201</sup> *In re Unterweser Reederei*, 428 F.2d at 890.

<sup>202</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616 para. 30 (Judgment of the Court).

<sup>203</sup> *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 886 (9th Cir. 2012).

<sup>204</sup> *See id.* The court’s reasoning is slightly flawed because (1) the anti-suit injunction only prevented enforcement of a preliminary injunction in Germany, not the outcome of the case, and (2) the preliminary judgment was already issued in Germany, so the court’s actions would in no way avoid a judgment.

(“RAND”)<sup>205</sup> license terms.<sup>206</sup> RAND terms provide many benefits for consumers including interoperability, lower product costs, and increased price competition.<sup>207</sup> Motorola was only enforcing two of the approximately one hundred patents involved in the dispute, and Motorola sought injunctive relief in Germany to enter a “holdup” settlement before the U.S. court could fully adjudicate the issue.<sup>208</sup> The court believed that Motorola initiated the German suit only as a means to increase pressure on Microsoft to settle for unreasonable license terms while the U.S. litigation was still ongoing.<sup>209</sup>

Policy concerns, such as the issue of RAND licensing in the *Microsoft* case, are taken on a case-by-case basis and could differ depending on U.S. policy.<sup>210</sup> Because the courts can flexibly decide cases while retaining control over policy considerations, the first *Unterweser* factor is consistent with the ECJ’s determination that EU national courts ultimately should decide what constitutes a connecting link.<sup>211</sup>

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<sup>205</sup> Also termed FRAND (fair, reasonable, and non-discriminatory terms and conditions).

<sup>206</sup> See *Microsoft*, 696 F.3d at 885. U.S. courts have recognized that the Federal Trade Commission has implied that injunctive relief is unavailable for patent infringement governed by RAND. Certain Wireless Comm’n Devices, Portable Music & Data Processing Devices, Computers & Components Thereof, Inv. No. 337-TA-745, USITC (June 6, 2012) (FTC Third-party Statement of Interest), available at <http://www.ftc.gov/os/2012/06/1206ftcwirelesscom.pdf>. Following the Ninth Circuit verdict, David Howard, Microsoft deputy general counsel stated, “[i]t continues to be our hope that Google and Motorola live up to their promises to standards organizations.” See Janet I. Tu, *Ninth Circuit Turns Down Motorola’s Appeal in Patent Battle with Microsoft*, SEATTLE TIMES: MICROSOFT PRIO (Sept. 28, 2012, 6:09 PM), [http://seattletimes.com/html/microsoftpri0/2019291927\\_ninth\\_circuit\\_turns\\_down\\_motorolas\\_appeal\\_against.html](http://seattletimes.com/html/microsoftpri0/2019291927_ninth_circuit_turns_down_motorolas_appeal_against.html).

<sup>207</sup> *Microsoft*, 696 F.3d at 876; see *Apple, Inc. v. Motorola Mobility, Inc.*, 2011 WL 7324582, at 1 (W.D. Wis. June 7, 2011).

<sup>208</sup> *Microsoft*, 696 F.3d at 886. Typically, a holdup occurs when a patent owner threatens an injunction after the alleged infringer made investment to develop and bring a product to market. See *Amicus Curiae Brief of Intel Corp. in Support of Appellee Microsoft Corp. and Affirmance of the District Court’s Order at 9, Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 879 (9th Cir. 2012) (No. 12-35352). The anti-suit injunction was successful in reaching a license agreement between Microsoft and Motorola for standard essential patents. See *Microsoft*, 696 F.3d at 886.

<sup>209</sup> See *Microsoft*, 696 F.3d at 886. When a patent, such as the one Motorola held, consists of but one part, albeit an essential part, of a complex product, the holder of the essential patent can demand unreasonably high royalties. *Id.* at 876. Standard-setting organizations try to prevent patent holdups by requiring holders of essential patents to license their IP rights on RAND terms. *Id.*

<sup>210</sup> See, e.g., *Laker Airways Ltd. v. Sabena, Belgian World Airlines*, 731 F.2d 909, 938 (D.C. Cir. 1984) (refusing to recognize a British injunction restraining Laker’s U.S. action as a violation of public policy), for another U.S. anti-suit injunction case.

<sup>211</sup> See *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 52–55 (Opinion of Advocate General).

## 2. *The Second Unterweser Factor*

The second *Unterweser* factor is whether the foreign litigation would be vexatious or oppressive.<sup>212</sup> The *Laker Airways v. Sabena, Belgian World Airlines* opinion suggests that an anti-suit injunction used to prevent merely duplicative litigation is generally both unwarranted and unnecessary,<sup>213</sup> and “a showing of harassment, bad faith, or other strong equitable circumstances should ordinarily be required” before a U.S. court issues an anti-suit injunction.<sup>214</sup>

In *Microsoft*, the Ninth Circuit found the foreign litigation vexatious because “the timing of the filing of the German Action raise[d] concerns of forum shopping and duplicative and vexatious litigation.”<sup>215</sup> The Ninth Circuit defined “vexatious” as “without reasonable or probable cause or excuse; harassing; annoying.”<sup>216</sup> The Ninth Circuit in *Microsoft* did not find the German litigation vexatious simply because the Germany case was filed after the U.S. case; rather, the court perceived the foreign litigation as vexatious because the litigation was merely leverage for settlement on unfavorable licensing terms.<sup>217</sup>

The procedures for provisional measures in Germany are efficient, and the speed German courts can grant a provisional measure—injunctions granted between two to six months—creates the possibility of abuse.<sup>218</sup> Further, Article 22(4) is not applicable when the validity of a patent is raised in the interim proceedings and not in the main proceedings.<sup>219</sup> Especially in Germany, when infringement proceedings and revocation proceedings are separate,<sup>220</sup> and *ex*

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<sup>212</sup> *Zapata Off-Shore Co. v. M/S Bremen (In re Unterweser Reederei)*, 428 F.2d 888, 890 (5th Cir. 1970), *aff’d en banc*, 446 F.2d 907, *rev’d*, 407 U.S. 15 (1972).

<sup>213</sup> See *Laker Airways*, 731 F.2d at 928; R.W.R., Notes, *Antisuit Injunctions and International Comity*, 71 VA. L. REV. 1039, 1051–52 (1985).

<sup>214</sup> *Laker Airways*, 731 F.2d at 928 n.54.

<sup>215</sup> *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 886 (9th Cir. 2012) (quoting E. & J. Gallo Winery v. Andina Licores S.A., 446 F.3d 984, 990 (2009)). The court’s view essentially categorizes the Germany action as “vexatious” because the lawsuit was filed after the U.S. case was filed and the foreign preliminary injunction was decided prior to the U.S. case being decided. *Id.*

<sup>216</sup> *Id.* (quoting BLACK’S LAW DICTIONARY 1701 (9th ed. 2009)).

<sup>217</sup> *Microsoft*, 696 F.3d at 886; see also Part III.C.1.

<sup>218</sup> BARDEHLE PAGENBERG, *supra* note 45, at 7; Kanz et al., *supra* note 31; see also Part I.B.

<sup>219</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 56(1)(b) (Opinion of Advocate General).

<sup>220</sup> LUGINBUEHL, *supra* note 35, at 28.

*parte* decisions are available,<sup>221</sup> exclusive jurisdiction under Article 22(4) might not necessarily apply.<sup>222</sup>

Similarly, provisional measures in the Netherlands give rise to the possibility of abuse. Provisional judgments in *kort geding* procedures are typically granted within two to three months, oral argument only lasts half a day, and the use of witness and expert testimony rarely occurs.<sup>223</sup>

If EU national courts implement the second *Unterweser* factor into the analysis of whether the court has a connecting link between the subject matter of the provisional measures sought and the territorial jurisdiction of the court seized, EU national courts could help prevent some of the vexatious or oppressive litigation possible in jurisdictions such as Germany and the Netherlands where expedient provisional measures place time restraints on defendant parties.

### 3. *The Third Unterweser Factor*

The third *Unterweser* factor is whether the foreign litigation threatens the issuing court's *in rem* or *quasi in rem* jurisdiction.<sup>224</sup> The third factor gives priority to the first court seized, also known as the first-in-time rule.<sup>225</sup> EU Member States already adhere to a first-in-time rule.<sup>226</sup> Article 27 of Council Regulation 44/2001 states that "any court other than the court first seized shall of its own motion stay its proceedings until such time as the jurisdiction of the court first seized is established" or "decline jurisdiction in favour of that court."<sup>227</sup> Therefore, EU national courts must abide by a first-in-time rule if an

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<sup>221</sup> BARDEHLE PAGENBERG, *supra* note 45, at 6.

<sup>222</sup> See Rödiger, *supra* note 48 (declaring the spider-in-the web-doctrine dead); *see also* Part II.E.

<sup>223</sup> See LUGINBUEHL, *supra* note 35, at 68.

<sup>224</sup> Zapata Off-Shore Co. v. M/S Bremen (*In re Unterweser Reederei*), 428 F.2d 888, 890 (5th Cir. 1970), *aff'd en banc*, 446 F.2d 907, *rev'd*, 407 U.S. 15 (1972); *see* Penn Gen. Casualty Co. v. Pennsylvania, 294 U.S. 189, 195 ("[T]he court first assuming jurisdiction over the property may maintain and exercise that jurisdiction to the exclusion of the other."); *Princess Lida of Thurn & Taxis v. Thompson*, 305 U.S. 456, 467 (1939) (affirming that state court's *quasi in rem* proceedings were exclusive).

<sup>225</sup> See *Globalsantafe Corp. v. Globalsantafe.com*, 250 F.Supp. 2d 610, 624 (2003) (citing *SEC v. Banner Fund Int'l*, 211 F.3d 602, 611 (D.C. Cir. 2000)). *But see* *Hawes v. Network Solutions, Inc.*, 337 F.3d 377, 379 (4th Cir. 2003) (granting jurisdiction in a domain name dispute where the plaintiff brought a U.S. action following a French court's ruling on the issue).

<sup>226</sup> See Council Regulation 44/2001, arts. 27–30 (*Lis Pendens*–Related Actions).

<sup>227</sup> *Id.* art. 27.

existing case is “so closely connected.”<sup>228</sup> As a result, the third *Unterweser* factor is consistent with EU civil procedure.

Important to note, priority in timing is not dispositive in U.S. cases and is only one factor that should be considered.<sup>229</sup> *Cargill v. Hartford Accident & Indemnity Company* presents a unique case where both a U.S. case and an English case were filed on the same day.<sup>230</sup> Rather than focusing on priority of filing, the U.S. court issued an anti-suit injunction stating, “adjudication of the same issue in two separate actions will result in unnecessary delay, substantial inconvenience and expense to the parties and witnesses, and . . . could result in inconsistent rulings or a race to judgment.”<sup>231</sup> As is evident in the *Cargill* court’s reasoning, the timing of filing is important, but timing cannot be the sole test.<sup>232</sup>

#### 4. *The Fourth Unterweser Factor*

The fourth *Unterweser* factor is whether the foreign litigation would prejudice other equitable considerations.<sup>233</sup> A U.S. court held in favor of an anti-suit injunction in part because without an anti-suit injunction, the parties’ forum selection clause would become null.<sup>234</sup> The court also discussed compelling reasons for upholding an international agreement, saying it is equitable to enforce a contract that the parties freely negotiated and entered.<sup>235</sup> Equity considerations, such as the issue of upholding international agreements,

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<sup>228</sup> *Id.* art. 28(3).

<sup>229</sup> Justice Marshall issued the first-to-file rule: “In all cases of concurrent jurisdiction, the Court which first has possession of the subject matter must decide it.” *Smith v. McIver*, 22 U.S. 532, 535 (1824). However, many courts have rejected this rule. *See also* George A. Bermann, *The Use of Anti-Suit Injunctions in International Litigation*, 28 COLUM. J. TRANSNAT’L L. 589, 610–11 (1990) (“A . . . mechanical rule [of first-in-time] takes too little account of the conflicting interests and policies likely to be at issue in the international cases. Moreover, the criticism . . . [is] that it encourages the proverbial race to the courthouse.”).

<sup>230</sup> *See Cargill, Inc. v. Hartford Accident & Indem. Co.*, 531 F.Supp. 710, 713 (D. Minn. 1982).

<sup>231</sup> *See id.* at 715 (citing *Seattle Totems Hockey Club, Inc. v. Nat’l Hockey League*, 652 F.2d 852, 856 (9th Cir. 1981)).

<sup>232</sup> *Id.* (“It would be vexatious to *Cargill* and a waste of judicial resources to require adjudication . . . in two separate forums.”).

<sup>233</sup> *See Zapata Off-Shore Co. v. M/S Bremen (In re Unterweser Reederei)*, 428 F.2d 888, 890 (5th Cir. 1970), *aff’d en banc*, 446 F.2d 907, *rev’d*, 407 U.S. 15 (1972).

<sup>234</sup> *E. & J. Gallo Winery v. Andina Licores S.A.*, 446 F.3d 984, 992 (2009). Although Gallo Winery brought a claim in front of an Ecuador court prior to a case being brought before a U.S. court, the U.S. court issued an anti-suit injunction preventing Gallo Winery from litigating in Ecuador. *Id.* The contract at issue contained a forum selection clause stating that all disputes would fall under U.S. law. *Id.* at 987.

<sup>235</sup> *Id.* at 992 (citing *Zapata Off-Shore Co.*, 407 U.S. at 12–14).

are taken on a case-by-case basis.<sup>236</sup> Similar to the first *Unterweser* factor, the fourth *Unterweser* factor is consistent with the ECJ's determination that EU national courts should ultimately decide what constitutes a connecting link.<sup>237</sup> The factor allows EU national courts to balance equity on a case-by-case basis.

To conclude Part III.C, the benefit of the *Unterweser* factors is that they not only allow courts to remain flexible, but also provide an underlying structure to the decision-making process that balances both procedural fairness and substantive fairness. When applied to EU cross-border injunctions, the factors provide much needed guidance but also allow EU national courts flexibility when determining whether the court has a connecting link between the subject matter of the provisional measures sought and the territorial jurisdiction of the court seized. The first and fourth factors allow EU national courts to balance policy and equity on a case-by-case basis; stronger policy or equity concerns yield a closer connection between the court and the subject matter of the case. The second factor can help EU national courts ensure that parties do not abuse provisional proceedings in a vexatious or oppressive way. The third factor preserves the integrity of the first suit filed and is consistent with EU civil procedure.

*D. Comity Can Help Define the Limits EU National Courts Should Take When Issuing a Preliminary Cross-Border Injunction Via an Article 31 Provisional Measure*

The third factor of the U.S. anti-suit injunction framework, whether the injunction's impact on comity is tolerable, can help define limits EU national courts should take when issuing a preliminary cross-border injunction via an Article 31 provisional measure. Some interpret the "connecting link" in Article 31 to be a limit on an EU national court's use of provisional measures.<sup>238</sup> EU national courts could otherwise abuse its Article 31 powers.<sup>239</sup> Under this interpretation, EU national courts must decline jurisdiction in certain situations.<sup>240</sup>

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<sup>236</sup> See *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 887 (9th Cir. 2012) ("Nevertheless, our cases along with instructive authority from other circuits, do provide some objective guidance as to factors that may inform our comity inquiry in the anti-suit injunction context.")

<sup>237</sup> See Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 29, 40–43 (Mar. 29, 2012) (Opinion of Advocate General).

<sup>238</sup> See *Dickinson*, *supra* note 176, at 546.

<sup>239</sup> See *id.*

<sup>240</sup> See *id.*

An anti-suit injunction is above all not an issue of jurisdiction but one of comity.<sup>241</sup> U.S. courts generally apply comity in cases involving multi-national litigation.<sup>242</sup> A U.S. court is not obligated to recognize foreign injunctions but may choose to do so voluntarily out of comity.<sup>243</sup> A court should enforce foreign courts' judgments, and the issue should not be "tried afresh" if a foreign court provides a fair trial.<sup>244</sup> Comity is based on the principal that a foreign court will enforce the U.S. court's decision with the expectation that the U.S. court will reciprocate when the situation reverses in the future.<sup>245</sup> Comity is an elusive concept<sup>246</sup> but ultimately recognizes international duty, convenience, and the rights of persons under the protection of the law.<sup>247</sup> It is neither a legal obligation nor mere courtesy and good will.<sup>248</sup> Best stated: "[C]omity serves our international system like the mortar which cements together a brick house. No one would willingly permit the mortar to crumble or be chipped away for fear of compromising the entire structure."<sup>249</sup>

The *Microsoft* case shows how U.S. courts balance comity. In *Microsoft*, the Ninth Circuit upheld a temporary injunction blocking enforcement of Motorola's German patent infringement judgment.<sup>250</sup> Such a judgment could

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<sup>241</sup> See E. & J. Gallo Winery v. Andina Licores S.A., 446 F.3d 984, 989 (2009) (quoting *Seattle Totems Hockey Club*, 652 F.2d at 855); see also Baer, *supra* note 64, at 156, 163 (arguing that U.S. courts should adopt a comity-based approach for anti-suit injunctions because comity is a "paramount concern").

<sup>242</sup> Mark G. Douglas & Nicholas C. Kamphaus, *Cross-Border Bankruptcy Battleground: The Importance of Comity (Part II)*, JONES DAY (May/June 2010), <http://www.jonesday.com/cross-border-bankruptcy-battleground-the-importance-of-comity-part-ii-05-31-2010/> (analyzing comity in cross-border bankruptcy cases involving significant differences in law among nations). But see *Compare Kaepa, Inc., v. Achilles Corp.*, 76 F.3d 624, 627 (5th Cir. 1996) ("[The Fifth Circuit] decline[s] . . . to require a district court to genuflect before a vague and omnipotent notion of comity every time that it must decide whether to enjoin a foreign action.").

<sup>243</sup> R.W.R., *supra* note 213, at 1053 (citing *Somportex Ltd. v. Phila. Chewing Gum Corp.*, 453 F.2d 435, 440-41 (3d Cir. 1971) (explanation of comity)).

<sup>244</sup> *Hilton v. Guyot*, 159 U.S. 113, 202-03 (1895). The trial should not be tried afresh when "a full and fair trial abroad before a court of competent jurisdiction, conducting the trial upon regular proceedings, after due citation or voluntary appearance of the defendant, and under a system of jurisprudence likely to secure an impartial administration of justice between the citizens of its own country and those of other countries, and there is nothing to show either prejudice in the court, or in the system of laws under which it was sitting, or fraud in procuring the judgment, or any other special reason why the comity of this nation should not allow it full effect . . ." *Id.* at 202.

<sup>245</sup> See Trimble, *supra* note 189, at 346.

<sup>246</sup> *Quaak v. Klynveld Peat Marwick Goerdeler Bedrijfsrevisoren*, 361 F.3d 11, 18 (1st Cir. 2004).

<sup>247</sup> *Hilton*, 159 U.S. at 164.

<sup>248</sup> *Id.* at 163-64.

<sup>249</sup> *Laker Airways Ltd. v. Sabena, Belgian World Airlines*, 731 F.2d 909, 937 (D.C. Cir. 1984).

<sup>250</sup> *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 889 (9th Cir. 2012).

be said to infringe the sovereignty of Germany.<sup>251</sup> Weighing comity prior to issuing an injunction with multi-national impact, however, can help alleviate the problematic nature of the court's order. Comity was tolerable in the *Microsoft* case because the German action was filed after the U.S. action, the anti-suit injunction did not affect Motorola's ability to pursue its claims in the German courts, and the court had a strong interest because both parties were U.S. corporations and the contract dispute took place within the United States.<sup>252</sup>

Comity is consistent with the policies underlying preliminary cross-border injunctions via an Article 31 provisional measure. EU national courts suggest consolidating trials into a single jurisdiction because the costs of litigating in many countries simultaneously can create enormous burdens, especially on small- or medium-sized enterprises.<sup>253</sup> However, EU national courts issuing cross-border injunctions must be mindful of the sovereignty of other nations involved.<sup>254</sup> The two justifications used in U.S. precedent for comity that apply most directly to cross-border injunctions in the EU are: (1) comity weighs in favor of an anti-suit injunction when both parties are domiciled in the court's jurisdiction and the contract dispute took place within the country of the court;<sup>255</sup> and (2) comity weighs in favor of an anti-suit injunction where there is no indication that the foreign government is involved in the litigation.<sup>256</sup> First, comity stands for the proposition that an EU Member State should have control over both the parties domiciled within its territory and the disputes that occur within its territory.<sup>257</sup> This factor is consistent with multi-national patent litigation in the EU because EU national courts tend to have a "connected link" in cases where the defendant is domiciled in the EU national court's jurisdiction.<sup>258</sup> Second, a court is likely to upset comity when the foreign

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<sup>251</sup> See Reply Brief of Defendants-Appellants at 3, *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, (9th Cir. 2012) (No. 12-35352) ("[T]he injunctive relief Motorola has been enjoined from pursuing in Germany concerns German patents, issued under German law, as practiced within Germany.").

<sup>252</sup> *Microsoft*, 696 F.3d at 888.

<sup>253</sup> See TRIMBLE, *supra* note 6, at 40–41.

<sup>254</sup> See Rüdiger Pansch, *The Proper Forum for Illicit Acts in Cases of Cross-Border Infringement of Proprietary Commercial Rights*, 5 EUR. LEGAL F. 353, 362 (2000) ("The international recognition of judgments in Europe is based on the principle of trust in the jurisprudence of neighbouring States.").

<sup>255</sup> *Microsoft*, 696 F.3d at 888.

<sup>256</sup> E. & J. Gallo Winery v. Andina Licores S.A., 446 F.3d 984, 994 (2009).

<sup>257</sup> See Council Regulation 44/2001, arts. 2–5.

<sup>258</sup> See Case C-68/93 Shevill v. Presse Alliance SA, 1995 E.C.R. I-00450 para. 32 ("[P]laintiff always has the option of bringing his entire claim before the courts either of the defendant's domicile or of the place where the publisher of a defamatory publication is established").

countries involved raise opposition to the cross-border injunction through express statements or supplementary briefs.<sup>259</sup>

In sum, the U.S. anti-suit injunction factors can help solve the open question of what constitutes a “connecting link” for Article 31 provisional measures in European preliminary cross-border injunction cases. The U.S. anti-suit injunction factors serve as a tri-partite test: first, the court must decide whether it has jurisdiction over the parties and whether the parties and issues are the same in both the U.S. and foreign cases; second, once the United States decides it has jurisdiction over the case, the court must determine whether it has the power to enjoin a party; and third, the court must determine whether it should enjoin a party.<sup>260</sup> The first factor, whether the parties and the issues are the same and whether the first action is dispositive of the action to be enjoined, parallels the logic the ECJ applies to Article 6(1) joinder cases. The second factor, the *Unterweser* factors, allows EU national courts to remain flexible and decide what constitutes a “connecting link” on a case-by-case basis. The third factor, comity, can help EU national courts find limits to issue preliminary cross-border injunctions in a balanced way. EU national courts have an open question of what constitutes a “connecting link.” The U.S. anti-suit injunction framework can help bridge this gap and help EU national courts equitably determine what constitutes a “connecting link.”

## CONCLUSION

Patent owners often choose to consolidate trials into a single jurisdiction because the costs of litigating in many countries simultaneously can create enormous burdens, especially on small- or medium-sized enterprises.<sup>261</sup> Patent owners can consolidate cases using cross-border injunctions. Following *Solvay*, the ECJ has held that EU civil procedure allows an EU national court to issue a cross-border injunction in at least two ways: (1) joinder<sup>262</sup> and (2)

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<sup>259</sup> See Brief for the Government of Canada as Amicus Curiae in Support of the Petition at 11, *Research in Motion, Ltd. v. NTP, Inc.*, 418 F.3d 1282 (2005) (No. 05-763) (citing *F. Hoffman-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155 (2004)); *Murray v. Schooner Charming Betsy*, 6 U.S. 64 (1804); *Hartford Fire Ins. Co. v. California*, 509 U.S. 764 (1993); RESTATEMENT (THIRD) OF FOREIGN RELATIONS LAW OF THE UNITED STATES §§ 403(1), 403(2)(g) (1986).

<sup>260</sup> See Baer, *supra* note 64, at 157–58 (describing the *Unterweser* test); *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 881 (9th Cir. 2012) (citing *Gallo*, 446 F.3d at 991) (listing comity as a factor also).

<sup>261</sup> See TRIMBLE, *supra* note 6, at 40–41.

<sup>262</sup> See Council Regulation 44/2001, art. 6(1).

provisional measures.<sup>263</sup> Further, *Solvay* showed how exclusive jurisdiction for validity under Article 22(4) does not necessarily apply in interim cases, such as an Article 31 provisional measure.<sup>264</sup>

An EU national court can issue a preliminary cross-border injunction via an Article 31 provisional measure when the court has a connecting link between the subject matter of the provisional measures sought and the territorial jurisdiction of the court seized.<sup>265</sup> The ECJ left the determination of what constitutes a connecting link up to EU national courts.<sup>266</sup> Little has been said as to what constitutes a “connecting link.” U.S. anti-suit injunction cases, when applied to cross-border injunction cases, can help EU national courts decide when to issue a cross-border injunction and establish reasonable limits.

The Ninth Circuit in *Microsoft* evaluated an anti-suit injunction case using a set of factors. The factors are: (1) whether the parties and issues are the same in both the domestic and foreign actions and whether the first action is dispositive of the action to be enjoined, (2) analysis of the *Unterweser* factors, and (3) whether the injunction’s impact on comity is tolerable.<sup>267</sup> The first factor, whether the parties and the issues are the same and whether the first action is dispositive of the action to be enjoined, parallels the logic the ECJ applies to Article 6(1) joinder cases. The second factor, the *Unterweser* factors, allows European courts to balance policy and equity on a case-by-case basis and remain flexible when determining whether the court has a connecting link. The third factor, whether comity is tolerable, can help EU national courts find limits for issuing preliminary cross-border injunctions in a balanced way.

The *Solvay* decision most importantly found that under Article 31 of Council Regulation 44/2001, an EU national court can have jurisdiction for a provisional cross-border injunction in a patent case.<sup>268</sup> Because the ECJ left

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<sup>263</sup> See Council Regulation 44/2001, art. 31.

<sup>264</sup> See Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, paras. 49–51 (Judgment of the Court).

<sup>265</sup> Case C-616/10, *Solvay S.A. v. Honeywell Fluorine Prods.*, 2012 EUR-Lex CELEX 62010CJ0616, para. 50 (Mar. 29, 2012) (Opinion of Advocate General) (citing Case C-391/95, *Van Uden Maritime BV v. Kommanditgesellschaft*, 1998 E.C.R. I-7131 para. 40).

<sup>266</sup> See *id.* para. 29.

<sup>267</sup> *Microsoft Corp. v. Motorola, Inc.*, 696 F.3d 872, 881 (9th Cir. 2012). (citing *Gallo*, 446 F.3d at 991) (explaining that the three-factor framework replaces the first factor of the preliminary cross-border injunction framework); see also *Applied Med. Distribution Corp. v. Surgical Co. Bv.*, 587 F.3d 909, 913 (9th Cir. 2009).

<sup>268</sup> *Solvay*, 2012 EUR-Lex CELEX 62010CJ0616, para. 49–51 (Judgment of the Court).

provisional cross-border injunctions up to national courts,<sup>269</sup> the question that these courts must ask is to what extent the courts should have jurisdiction under Article 31 of Council Regulation 44/2001 and what limits the courts should take.

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<sup>269</sup> See *id.* paras. 47–51.

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