

Newsletter
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Intellectual property

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Lovells' Intellectual Property practice advises, in the context of European Union, English, German, French, Italian, Dutch, Polish, Czech, Slovak, Croatian, Russian, Chinese (PRC mainland and Hong Kong), Singaporean, Vietnamese and international law (including WTO issues), in relation to all areas of intellectual property: trade marks, patents, design rights, copyright, and rights arising from IT. We also advise our clients in the fields of entertainment and the arts. Many of our lawyers have a scientific background, enhancing their understanding of the technical and commercial issues involved.

We offer a complete global domain name protection service including clearance searches, registration, watch and investigation covering all generic TLDs (top level domains) but also, importantly, most country TLDs in some 200 jurisdictions.

In protecting the intellectual property rights of our clients we act at all levels, from advising on, applying for, registering and enforcing rights through to devising strategies and the investigation of infringement and counterfeiting activities. In addition, we act in structuring, negotiating and drafting licences and technology transfer transactions and have considerable experience in IP disputes before the Industrial Property Offices and in IP litigation before the courts, especially in cross-border or multi-jurisdictional disputes.

Applications and registrations are not currently handled in all legal systems listed above. However, we offer a complete trade mark and design filing and prosecution service at the Community Trade Mark Office as well as trade mark, industrial design, appellations of origin and domain names searches, clearances, filing and prosecution services before the national Industrial Property Offices in France, Germany, Russia (together with all other CIS Member States), Croatia, Poland, Hungary, China,

Hong Kong, Singapore, Indo-China (Vietnam, Cambodia and Laos) and elsewhere in South-East Asia.

This newsletter is written in general terms and its application in specific circumstances will depend on the particular facts.

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Copyright and designs

Victory for Verizon in file-sharing dispute in USA

The US Court of Appeals for the District of Columbia has ruled unanimously that internet service providers are not obliged to identify customers who use the internet to download copyright-protected music. The Recording Industry Association of America had obtained a subpoena from the district court on behalf of its members, requiring Verizon Communications to disclose the identity of one of its subscribers who was downloading music without permission and re-distributing it. The individual used "peer-to-peer file-sharing" software, KaZaA.

Verizon appealed and the appeals court ruled that the 1998 Digital Millennium Copyright Act did not authorise the issue of a subpoena to an ISP which was merely acting as a conduit for the transmission of information sent by others. Furthermore, the court commented, this type of software was "not even a glimmer in anyone's eyes" when the law was enacted.

Caroline Clarke-Jervoise, London

Update on draft EU Enforcement Directive

The draft EU Directive on the enforcement of intellectual property rights (see our previous issue) has been approved by the Legal Affairs Committee of the European Parliament. The draft Directive deals with a number of issues relating to enforcement, which were not covered by the recent EU Copyright Directive. These are designed to

strengthen the means of dealing with counterfeiting and piracy throughout the EU.

Prior to giving its approval, the Legal Affairs Committee amended the draft Directive by extending its scope to cover all intellectual property rights infringements, rather than just infringements undertaken on a commercial level. It also replaced the criminal sanctions with civil ones. However, it is anticipated that, when the full session of the European Parliament votes on the amendments later in the month, the draft will be brought back more in line with the original proposals. The draft EU Directive is also being considered by the European Council of Ministers.

Richard Dickinson, London

Who owns design right: employer or employee?

Mr Justice Patten has recently ruled that, when deciding whether an employer or employee was the owner of design right under the Copyright Designs and Patents Act 1988 ("CDPA"), the issue of whether the design was made during normal office hours or with the benefit of materials provided at the employer's expense was not the ultimate determinant. Rather, the real question to be addressed was whether the creation of the design fell within the designer's duties as an employee.

The issue arose in *I-DESK Ltd v Time Computer Ltd*¹. The claimants alleged that the defendants were infringing their design right in their I-DESK product. The defendants admitted infringement but denied that the claimants owned the design right.

¹ (2003 EWHC 298), 16 December 2003, unreported

The claimants had purportedly taken an assignment of the design right in the "I-DESK" product from a Mr Steven Brooks. At the time he conceived the design, Mr Brooks was a full-time employee and director of a company called Millennium Workshops Ltd. The defendants claimed that the assignment from Mr Brooks to the claimants was not effective to give them title to the design right. Specifically, they said that, as Mr Brooks was an employee of Millennium at the time he had conceived the design, the design right belonged not to him but to his employer, Millennium, by virtue of s215(3) CDPA. This provides that "Where a design is created by an employee in the course of his employment, his employer is the first owner of any design right in that design". The defendants argued that, as Mr Brooks did not own the design right, he could not have assigned it to the claimants.

For their part, the claimants maintained that the design for the item in question was not part of the normal business of Mr Brooks' employer. The design was not created in the course of his employment and did not accordingly belong to his employer. They also led evidence that the design was made on Mr Brooks' own laptop outside his normal working hours.

The item which Mr Brooks had designed was a desk for use in schools and colleges, into which the components for a computer were built in such a way that all the wiring and connections were contained away from the working surface in conduits and the computer itself was integrated in a metal cassette under a fixed desk top. Millennium's main business at the time when Mr Brooks conceived the design was in designing and manufacturing fitted furniture. The claimants alleged that the I-DESK was sufficiently different from the usual kind of fitted furniture manufactured by Millennium that designing it was not part of Mr Brooks' duties as an employee.

The court agreed with the defendants. Mr Brooks was a full time employee of Millennium and was involved in the design of its furniture. Whilst the I-DESK was not the normal type of item designed by Mr Brooks, it was not sufficiently distinct from the design work carried out in the regular course of his employment to take the design outside the "course

of employment" for the purposes of s215(3) CDPA. In deciding who was the first owner of the rights in the design, details of whether the design was made during normal office hours or with the benefit of materials provided at the employer's expense, were no more than evidential points.

Patten J also approved the following words of Laddie J in *Ultraframe UK Limited v Fielding*²:

"As a rough and ready rule of thumb, if designs are created and paid for by another, the statutory rights under the [CDPA] should belong to that other. I can see no reason when the other is a company, why there should be a different outcome simply because the designer is also the managing director of the company and majority or sole shareholder".

Stephen Bennett, London

Belgium: Consumer watchdog sues over copy-protection

A Belgian consumer watchdog is bringing an action against four of the world's largest music companies in an attempt to stop their copy-protection of CDs. Test-Achats argues that BMG, EMI, Sony and Universal Music, by using technical means to make their CDs impossible to copy, are infringing consumers' basic rights to enjoy their property. Copy-protection in some cases prevents CDs from being played in car stereos and computers. Furthermore, copying for private purposes is not illegal in Belgium.

Most of the recording industry produce copy-protected CDs, in the interests of protecting their copyright particularly against piracy, so this case is being watched with interest.

Caroline Clarke-Jervoise, London

2 (2003] RPC 435

Copying design of part can breach design right

In our August 2003 issue, we reported on a decision of the Patents County Court relating to design right in foldaway umbrella cases³. Fulton's design was for a box-shaped case with distinctive stitching and a 4cm slit at one end. The defendant, Totes, had initially made an exact copy of Fulton's design. In an attempt to avoid infringement, Totes then changed its cases by replacing the slit in Fulton's design with a cut out section. Judge Fysh QC, found that despite this change, by copying the design of part of the case - ie the case minus the slit section - Totes had infringed Fulton's design right in that part of the case.

Totes appealed. It argued that it was wrong in law to say that there was separate design right in part of the design of the case. Such design right as there was in Fulton's design existed in the whole of Fulton's case design, slit included, and Totes' "cut away" case design was, it maintained, a different, non-infringing, design.

The Court of Appeal dismissed Totes' argument. Proprietors can claim design right in any or all aspects of the shape or configuration of a part or of the whole of their articles. While this appears to confer extremely broad protection which allows proprietors to "trim" their design right claim to that part of the design which has been copied, with the risk that defendants will not know in what aspect protection is claimed until they receive the claim form, design right is not a monopoly right but is intended to prevent copying. Copyists know what they have copied from the design right owner and thus the risk they run of infringing the latter's rights.

Additionally, while a copyist may create a different design in copying part of another's design, this cannot justify the copying. Copying is only permitted to enable an article which must fit or must match other articles to do so and the legislation provides for this by excluding 'must fit' and 'must match' features from the definition of design right. Here, Totes had copied an aspect of the design of

part of Fulton's umbrella case (in fact, the court said, Totes had copied nearly all of it) and thereby infringed Fulton's design right in that part of the design. The Court therefore dismissed the appeal.

Diane Hamer, London

EU Commission acts over failures over public lending right

The European Commission has decided to take formal steps to compel six EU Member States to implement the EC directive on rental and lending rights⁴. The 1992 Directive gave EU countries until 1 July 1994 to ensure that their national legislation gave authors and other rightholders an exclusive lending right and the right to authorise or prohibit the public lending of certain works.

The Commission has now formally requested information from France, Ireland, Italy, Luxembourg, Portugal and Spain as to why they have failed to implement the Directive properly into national law. This is the first stage in the infringement procedure provided for by Article 226 of the EC Treaty.

Caroline Clarke-Jervoise, London

³ *A Fulton Company Ltd v Totes Isotoner (UK) Ltd*, [2003] EWCA 1514

⁴ The Directive on the Rental and Lending Right and on certain rights related to copyright (No 92/100)

Trade marks and passing off

What's in a name?

Advocate General Ruiz-Jarabo Colomer has recently gone some way towards clarifying the extent to which someone may register and use a surname as a trade mark.

Nichols plc attempted to register NICHOLS as a trade mark for automatic vending machines and products sold in such machines. It did not claim that the mark had acquired distinctiveness through use. In accordance with its usual practice, the UK Trade Marks Registry refused to register the mark on the basis that "Nichols", and similar names, is a common surname in the London telephone directory. Nichols appealed, and Jacob J decided to refer the matter to the ECJ. Earlier this month, the Advocate General issued his opinion on the reference.

In the High Court, Jacob J had commented that the real question was whether a fairly common surname should be regarded as devoid of distinctive character unless and until it had become distinctive through use. Until such distinctiveness had been acquired, the judge thought that such marks could not act as a badge of origin and would, in any event, provide such wide protection that the proprietor would gain an unfair advantage in the marketplace.

Accordingly, the Court referred five questions to the ECJ. The first three questions referred to the circumstances under which a common surname could be registered as a trade mark under Article 3(1)(b) EC Trade Marks Harmonisation Directive⁵ (the "Directive") (the equivalent provision in English law is s 3 Trade Marks Act 1994 (the "Act")). The remaining two linked questions concerned the interplay between the registrability criteria and the

"own name" defence to trade mark infringement set out in Article 6(1) of the Directive (s 11(2) of the Act) that permits a person to use his own name and address, provided that such use is in accordance with honest practices in industrial and commercial matters. The extent of the "own name" defence has been the matter of some debate for several years.

The Advocate General commented that the Directive clearly envisages that surnames are capable of being registered as trade marks. Nothing in the Directive states that a surname can not be registered as a trade mark. For a surname to be registrable as a trade mark, it must be distinctive of the goods and services for which it is sought to be registered. This will depend on whether the relevant consumer considers that the mark acts as a badge of origin. How common a surname is one of the factors that should be taken into consideration, but should not be a decisive factor.

However, the Advocate General decided that the fact the "own name" defence might limit the scope of protection afforded to a trade mark did not affect the registrability of a surname. As a result, the Advocate General declined to consider the final question, which concerned the operation of the "own name" defence.

English lawyers will be keen to see whether the ECJ decides to follow the Advocate General's opinion since this reference had been seen as providing an opportunity to settle the debate concerning the extent and scope of the "own name" defence. If the Court does agree with the Advocate General, then it is likely that UK Trade Mark Registry examination practice in relation to surnames will change.

Sahira Khwaja, London

⁵ 89/104, art 2

⁶ *Nestlé Waters France v OHIM*, (Case T-305/02), 3 December 2003

New EU decision on registration of 3D marks

In a recent decision⁶ on the registration of a three dimensional shape mark, the EU Court of First Instance has reviewed the requirement for a trade mark to have "distinctive character".

One of the absolute grounds under the Community Trade Mark Regulation for refusal of registration of a trade mark is that it is "devoid of any distinctive character". The requirement for a trade mark to have "distinctive character" goes to the heart of the function of a trade mark which is that the trade mark must enable a consumer to identify the origin of the goods or services. A sign that is commonly used in the trade for particular goods or services would not have "distinctive character".

This particular case concerned an application by Nestlé Waters France for a Community Trade mark for a three dimensional plastic bottle shown below:



The description of the three dimensional mark was as follows:

"The bottle comprises a main section with, at its base, a recess, in the shape of a slightly truncated cone with, in its flat section a stylised star in relief. In the lower part of the main section, which is nearly cylindrical from bottom to top, there is an initial series of wavy grooves and in the upper part, which is of slightly smaller diameter and bobbin-shaped, there are spiralling grooves which form lozenges when seen through the bottle. The top section, which is in the shape of a slightly

truncated cone, ends in a cylindrical neck with a blue cap".

Registration was sought in class 32 for mineral waters and other non-alcoholic beverages. The Community Trade Mark Office, OHIM, refused to register the bottle as a trade mark. OHIM considered the bottle to be devoid of any distinctive character because the shape of the bottle was a common shape used for the goods in question. Indentations such as grooves and lines on the surface of a bottle are also commonly used in the trade. The Nestlé bottle was only a variant of an ordinary packaging shape and incapable of operating as an indicator of origin.

Nestlé appealed and argued that, for a sign to have "distinctive character", it was enough that it was neither common nor necessary. The shape and overall decoration of the Nestlé bottle gave it a distinctive character. Interestingly, Nestlé said that the shape of the bottle and the decoration on its upper part was aimed to bring to mind the upper part of a woman's body draped in a light veil although it did concede that a consumer, when first faced with the bottle, was unlikely to perceive this symbolism.

The Court agreed that it was common ground that operators in the bottled water market were faced with technical packaging and labelling requirements for that market. For several years certain operators in the market had sought to differentiate their goods from those of competitors by using different shapes of packaging. The average consumer had become capable of perceiving the shape of packaging of the goods as an indication of their commercial origin.

The overall impression produced by the Nestlé bottle had to be considered. Although the shape and various indentations were features of other bottles currently available on the market, particular note had to be taken of the manner in which the various elements were put together. A sign consisting of a combination of elements, each of which individually was devoid of any distinctive character, could be distinctive provided that the way in which the various elements were combined indicated that the sign was greater than the mere sum of its constituent parts.

The Court decided that the combination of the various markings on the bottle made it very specific and not commonplace. The whole form of the design was striking and easy to remember and gave the bottle a particular appearance which, taking into account the overall aesthetic result allowing a consumer to distinguish it from bottles from a different commercial origin.

The Court therefore allowed Nestlé's appeal.

Doris Myles, London

Italy: New proposals to combat counterfeiting

The proposed text of the current Financial Bill includes a number of provisions designed to provide greater protection for intellectual property rights in Italy. The Bill has been drafted in such a way as to be compatible with the recent legislative decree⁷ which set up specialised court divisions to handle intellectual property cases in Italy (see our October issue).

The draft bill makes the following changes to existing law:

1. Indications of origin will receive increased protection. The exportation of and/or trade in products bearing false or misleading indications of origin will be treated as criminal offences under Italian criminal law.
2. The designation "MADE IN ITALY" will benefit from protection as a trade mark. This mark will be available to distinguish goods which have been entirely produced within the Italian territory or goods whose final phase of manufacturing takes place in Italy.
3. A national committee against counterfeiting will be set up. This will be in charge of monitoring IP infringement cases, outlining the measures needed for the protection of IP rights and assisting companies in protecting their interests against unfair commercial practices.

The Bill is currently being considered by the Italian Chamber of Deputies.

Francesca Rolla, Milan

ECJ gives guidance on registration of a sound mark

On 27 November 2003 the ECJ handed down a judgment⁸, which confirms that the Community trade mark harmonisation directive does allow sound marks or noises to be regarded as trade marks. The case also provides some guidance as to how sound marks should be graphically represented.

The matter began when an IP consultancy in the Netherlands, Shield Mark, brought an action for trade mark infringement and unfair competition against Mr Kist, who had used a cockcrow and the first notes of "*Für Elise*" in an advertising campaign. The advertising campaign, alleged Shield Mark, infringed several of its Benelux trade marks for sounds which had been registered either as words or figurative marks. The Supreme Court of the Netherlands asked the ECJ for its opinion on the matter.

The ECJ stated that, to be registrable a sound mark must be "represented graphically, particularly by means of images, lines or characters" and the representation had to be "clear, precise, self-contained, easily accessible, intelligible, durable and objective."

The Court evaluated various graphical means: written language, onomatopoeia, musical notes (eg E, D#, E...) and notes on a stave.

Whereas a stave would be good enough to meet the ECJ's test, it was held that it would not be satisfactory simply to provide a description in words or onomatopoeia. This seems eminently sensible, given that even within the European Union a cockcrow can be perceived so differently: **kikiriki**, in German; **kikeli-ki** in Danish; **quiquiriquí**, in Spanish; **kukkokiekuu**, in Finnish; **cocorico**, in French; **kokoriko**, in Greek; **cock-a-doodle-doo**, in English;

⁷ n. 168 dated 27 June 2003

⁸ *Shield Mark BV v Joost Kist bodn Memex* (Case C-283/01), The Times, 4 December 2003

chichirichi, in Italian; **kukeleku**, in Dutch; **cocorocóco**, in Portuguese; and **kukeliku**, in Swedish.

It would be interesting to see how the ECJ would react to a mark filed in the form of a sonogram, a sound recording or a digital recording.

Emma Alanko, London

New Indian trade marks law sneaks onto statute book

With a surprising lack of fanfare, India has brought into effect a new Trade Marks Act. These are some of the main changes in the new law, introduced in 1999 to comply with India's obligations under the World Trade Organisation:

1. It is now possible to register trade marks in respect of services, as well as goods.
2. The definition of a trade mark has been extended to include the shape of goods, elements of packaging and combinations of colours (but not sounds or smells).
3. "Well-known" marks are now specifically protected, even if the marks have not been used in India.
4. The courts may issue interim orders to preserve infringing goods, documents or other evidence; and to restrain offenders from disposing of or dealing with their assets in a way detrimental to the brand owner's rights.
5. The police are authorised to enter premises, search for and seize (without warrant) goods, dyes, blocks, machines, plates or other instruments or things involved in committing offences under the Act.
6. Penalties for trade mark offences have been increased to a maximum three years' imprisonment and fine of Rs200,000 (€3,350).
7. Registration now protects against unauthorised use of a mark for goods/services similar to those for which it is registered, not merely against use for identical goods/services.

8. The period of registration has been extended from seven years to 10 years.
9. An appellate board has been established to hear appeals from the decision of the Trade Marks Registrar - currently the High Court is responsible for this.
10. The division between Part A and Part B of the register has been removed. The less strict test for Part B registration (capable of distinguishing) has become the criteria for registrability of a mark.
11. A new regime for registration of collective marks (for example for clubs) has been introduced.

Caroline Clarke-Jervoise, London

Patents

Purdue misled USPTO over OxyContin patents

A district court judge in New York has found a pharmaceutical manufacturer guilty of inequitable conduct in its attempt to obtain three patents.

Judge Sidney Stein ruled that Purdue Pharma had deliberately misled the US Patent and Trade Mark Office in order to obtain patents for its best-selling OxyContin painkiller.

In its patent applications, Purdue had asserted that it had "surprisingly discovered" that a four-fold range of dosages of OxyContin would treat "about 90%" of patients in pain. Judge Stein found that Purdue's use of the word "discovered" was designed to suggest that this assertion was based on the results of experiments, when in fact the "discovery" had been based on insights by the drug's inventor, with no empirical basis.

The issue arose when Purdue sued generic manufacturer, Endo Pharmaceuticals for infringing its OxyContin patents. Endo counterclaimed by alleging that Purdue has misled examiners at the Office.

Caroline Clarke-Jervoise, London

New Patents Bill

Earlier this month, the new Patents Bill was published. This will amend UK patent law in three respects.

First, the Bill will update the existing law so that it conforms with recent revisions to the European Patent Convention ("EPC"). Secondly, it will

introduce new procedures to enable a patent proprietor to take better advantage of its patent rights and to aid in the earlier settlement of patent disputes. Finally, the Bill will update the Patents Act 1977 (the "Act") to bring it into line with changes to the Patent Cooperation Treaty ("PCT") and the Patent Law Treaty.

The Act was enacted to bring into effect the original EPC, a treaty between 27 European states, which ensures that the national patent laws of its contracting states are harmonised. In accordance with the revised EPC, the main features of the Bill will:

- clarify the exceptions to patentability and novelty, particularly those which relate to methods of treatment and diagnosis so that "Swiss claims" will no longer have to be used in order to claim a second medical use;
- require the Comptroller and the Court, in exercising their discretion to allow or refuse a post-grant amendment, to have regard to any relevant principles that are applicable in amendment or limitation proceedings under the EPC so that a consistent approach is taken in post-grant amendment proceedings before the EPO and in the national courts;
- penalise a patent proprietor who sues for a pre-amendment infringement in bad faith;
- extend the requirement that a patent proprietor amends its partially valid patent before relief is granted for infringement to European Patents as well as UK national patents;
- allow the court or the Comptroller to order revocation of a partially invalid patent unless the proprietor limits its patent at the European Patent Office.

Finally, the Bill introduces amendments to existing Patent Office procedures in a bid to make them easier to use and more efficient. This will allow the Patent Office to issue non-binding opinions as to validity or infringement at the request of a party in an effort to foster a settlement of a dispute.

The Bill has had its second reading and has now gone to Committee stage. At this stage it is not possible to predict when it will receive Royal Assent.

Sahira Khwaja, London

USA: Microsoft loses appeal over Eolas browser plug-in patent

A Chicago federal judge has upheld a decision that Microsoft's Internet Explorer web-browsing software infringes a patent owned by Eolas Technologies and the University of California. Judge James Zagel ordered the software giant to pay \$521 million in damages, as well as over \$45m in "prejudgment interest" for the infringement. He also issued an injunction preventing Microsoft from distributing versions of its Internet Explorer web software which incorporate the patented technology. However, he immediately suspended the injunction pending the resolution of any appeals. Microsoft has indicated that it will appeal.

Given the enormous implications of this case for web programmers generally, the US Patent Office has taken the unusual step of launching a re-investigation into the validity of the patent, which covers technology used to call up separate applications, such as a media player or document viewer, within a Web page. Judge Zagel refused Microsoft's application to stay the case pending the result of this examination.

In the meantime, Microsoft has already released versions of Internet Explorer designed to fall outside the patent's claims, and has advised other web developers to follow suit.

Caroline Clarke-Jervoise, London

New EU president stresses importance of Community Patent

Ireland has promised to do everything possible to bring about the adoption of the Community Patent during its presidency of the European Union. In a paper setting out the priorities for the EU's Competitiveness Council over the next six months, Ireland's minister for enterprise, trade and employment, Mary Harney, pointed to the increasing growth gap between Europe and the US and the importance of keeping the momentum going towards the introduction of a single EU patent.

Meanwhile, the European Commission has adopted two proposals relating to the jurisdiction of the European Court of Justice over Community Patent disputes. Both proposals are now awaiting a decision by the European Council of Ministers.

Caroline Clarke-Jervoise, London

Dutch "spider in the web" doctrine under review again?

On 19 December 2003, in *Roche v Primus*⁹, the Dutch Supreme Court submitted two questions to the European Court of Justice on the interpretation of Art 6 (1) Brussels/Lugano Conventions¹⁰ in relation to cross border-jurisdiction in patent litigation. This may put the Dutch "spider in the web" doctrine under review again.

Article 6(1) provides that a person domiciled in one Convention state may also be sued in the court of another state if he is one of a number of defendants and if one of the other defendants is domiciled in that contracting state. There has to be a connection between the claims made against each of the defendants. In *Roche v Primus*, Primus alleged that

⁹ Supreme Court, 19 December 2003, LJN No. AF9714 (unreported).

¹⁰ which deal with jurisdiction and the recognition and enforcement of judgments in civil and commercial matters. The Brussels Regulation was not yet in force when this case started.

nine affiliates of the Roche Group, based in different jurisdictions, were infringing its European biotech patent. The District Court at first instance, as well as the Court of Appeals, ruled that it had extraterritorial jurisdiction against all the Roche defendants. In the appeal before the Supreme Court, Roche contested the Dutch courts' cross border-jurisdiction.

Since the Dutch Supreme Court decision in *Lincoln v Interlas*¹¹, the Dutch patent courts have developed a very liberal practice towards cross border-jurisdiction in cases of (simultaneous) international infringement of a European patent. The courts held that, once they had assumed jurisdiction over all the defendants, the requested extraterritorial injunction could be granted as a matter of course. If not, the holder of a European patent would be forced to initiate proceedings in each separate designated country, which, in the courts' opinion, was an undesirable situation. This Dutch practice of granting cross border-injunctions is based on Art 3:296 (1) of the Dutch Civil Code and a broad interpretation of, in particular, Article 6 (1) Brussels/Lugano Convention.

Lincoln v Interlas made the Netherlands a very popular forum for international patent litigation. At the same time, this generous cross border-practice was criticised nationally and internationally. The critics felt that, by rashly imposing injunctions with extraterritorial effect, the Dutch patent court 'interfered' with the jurisdiction of other European countries.

In 1998, in *EGP v Boston Scientific*¹², the Court of Appeals showed that it was susceptible to its critics, and restricted its cross border-practice by introducing what would later be referred to as the 'spider in the web'-doctrine. The Court held that a European Patent was not "one" patent, but a bundle of national patents, so that the mere fact that various defendants were involved in simultaneous international infringement of these separate national parts of the "bundle" of patents did not imply that the connection requirement of Article 6 (1) was met. The connection requirement was only met when the various defendants were affiliates of the same group of companies and the Dutch defendant company was

the European head office (ie 'the spider in the web') of the group. Although *EGP v Boston Scientific* restricted the *Lincoln/Interlas*-doctrine to a certain extent, it does not affect the current doctrine that jurisdiction against a defendant based on Article 2 Brussels/Lugano Convention establishes cross border-jurisdiction against that defendant as a matter of course, nor the situation where the European 'spider' is not domiciled in the Netherlands.

In *Roche v Primus*, confusingly, the District Court and the Court of Appeals both assumed cross border-jurisdiction against all the defendants, but without taking the place of domicile of the European 'spider' of the Roche group into consideration. By doing so, it seemed that the courts had reconsidered the 'spider in the web'-doctrine and had returned to the broader *Lincoln v Interlas*-doctrine. It is now up to the Supreme Court to bring final clarity on the issue of cross border-jurisdiction and to this end it has referred two questions to the ECJ on the interpretation of Article 6 (1). Hopefully the court's ruling will provide us with a clear judgment about the cross border-practice developed by the Dutch courts since *Lincoln v Interlas*.

Berber Brouwer, Amsterdam

11 Supreme Court, 24 November 1989, BIE 1991/23, *Lincoln v Interlas*

12 23 April 1998, Court of Appeals The Hague