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Injunctive Relief in European Patent Actions: preliminary injunctions and the effect of BSH

Thursday 3 July 2025

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CLA: BSH / Electrolux

3 July 2025, Rik Lambers

The 'Dutch' cross borders

No mountains...

...an open sea...

...a global view...

...a small land of merchants...

necessarily crossing borders.

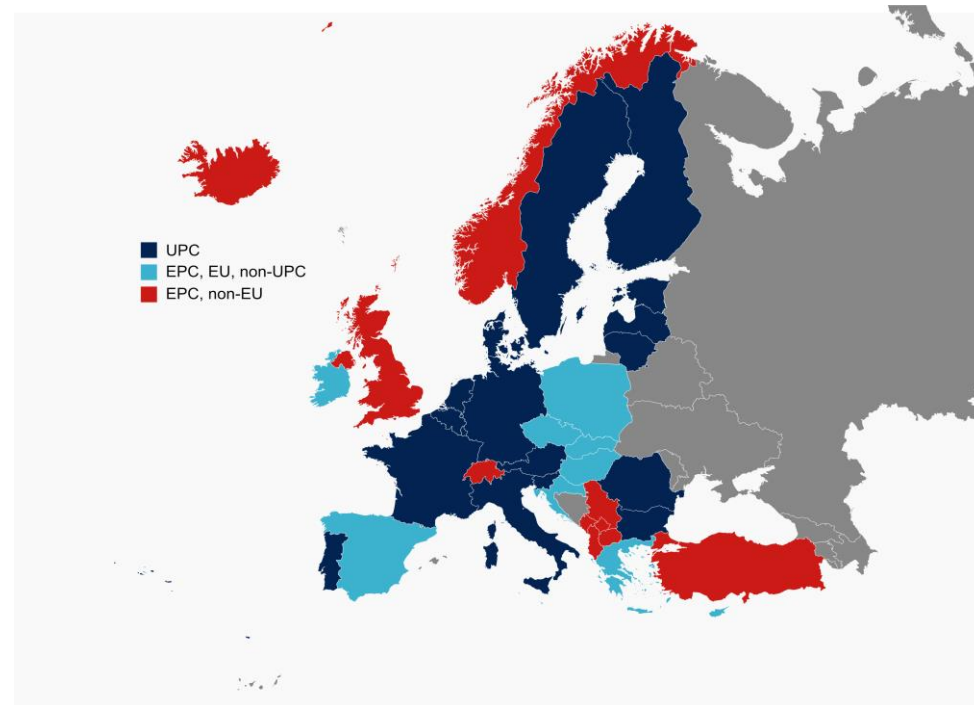


The Dutch cross-border injunction

- Patentee: European Patent (bundle national rights) in force in NL, DE, FR, Etc.
- Defendants:
 - Pharma NL: offers patent infringing product in NL, DE, FR, Etc.
 - Pharma DE, FR, Etc.: local distributors/sales entities product
- Cross-border (preliminary) injunction claim:
 - Pharma NL: (facilitating) infringement in NL, DE, FR, Etc.
 - Pharma DE, FR, Etc.: infringement in DE, FR, Etc.
- Question:
 - NL court international jurisdiction to grant cross-border relief?
 - Can NL court decide on infringement and validity not NL part EP?

European patent (litigation) landscape

- EPC: 39 contracting states
 - EU Member States
 - Other states: e.g. UK, CH, NO, TR
- EU Member States
 - UPC states
 - non-UPC states
- UPC states:
 - currently 18 EU Member States
 - e.g. not ES, PL, IRL, Greece



Brussels I-bis Regulation – Art. 4

- Art. 4 (1) BR – domicile defendant:

“... persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.”

- Jurisdiction of defendant’s domicile/home court in principle *universal/cross-border* (CJEU 1 March 2005, C-281/02, *Owusu*)
- Art. 36 BR – domicile: statutory seat, central administration, principal place of business
- Pharma NL: NL court has cross-border home court jurisdiction in principle

Brussels I-bis – Art. 4 exceptions

- Art. 8 (1) BR – co-defendants:

*“A person domiciled in a Member State may also be sued
(1) ...where he is **one of a number of defendants**, in the courts for the place where any one of them is domiciled, provided the **claims are so closely connected** that it is expedient to hear and determine them together **to avoid the risk of irreconcilable judgments** resulting from separate proceedings;”*

- Pharma DE, FR, Etc. sued as co-defendants before NL court of *anchor* defendant Pharma NL
 - NL court can assume jurisdiction if closely connected claims
 - If same situation in fact and law

Brussels I-bis – Art. 4 exceptions

- Art. 7 (2) BR:
 - EU MS domiciled person may also be sued in courts for place where harmful event occurred or may occur.
 - no basis for cross-border jurisdiction
- Art. 6 BR: not EU MS domiciled person → jurisdiction determined by national law

Brussels I-bis: exclusive jurisdiction validity

- Art. 24 (4) BR – *exclusive jurisdiction validity* patent (e.g. FR court as to FR part EP):

*“The following courts of a Member State shall have **exclusive** jurisdiction, regardless of the domicile of the parties:*

...

*(4) in proceedings concerned with the registration or **validity of patents**, trademarks, designs, or other similar rights required to be deposited or registered, **irrespective of whether the issue is raised by way of an action or as a defence**, 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 an instrument of the Union or an international convention deemed to have taken place.”*

Pre-BSH/Electrolux

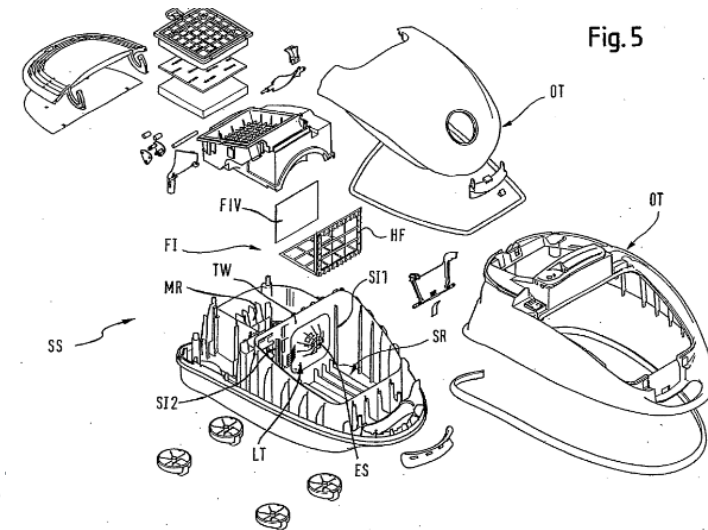
- NL court – *spider in the web* doctrine (e.g. CoA 1998, *Expandable Grafts/BSC*)
 - Group of entities, same product on different European markets
 - Jurisdiction for court of controlling entity: the (Dutch) spider in the web
- CJEU case law:
 - 2006: *GAT/LUK*, C-4/03
 - Basis for Art. 24 (4) BR – exclusive jurisdiction validity patent
 - 2006: *Roche/Primus*, C-539/03
 - Art. 8 BR – what are closely connected claims?
 - same situation in facts and law
 - Art. 8 does **not** apply to infringement by different defendants of **different** national parts of EP's
 - E.g. Pharma NL on NL part EP, Pharma FR on FR part EP

Pre-BSH/Electrolux

- 2012: *Solvay/Honeywell*, C-616/10
 - Art. 8 - **does** apply to infringement by different defendants of the **same** national parts of EP's with same product
 - E.g. Pharma NL and Pharma FR both on FR part EP
 - Invalidation defence does not preclude **provisional** cross-border jurisdiction
 - Provisional decision does not prejudice merits decision
- Dutch practice:
 - **Merits action**: cross-border infringement claim is **stayed** in case of invalidity defence until decision foreign merits court (e.g. DE court on DE part)
 - **Provisional injunction** pending foreign merits decision on validity
 - Both only if patentee requests

BSH/Electrolux (C-339/22, February 2025)

- BSH (patentee)
- BSH sued Electrolux in Sweden
 - Art. 4 BR – home court
- For infringement in eight different EU MS and two non-EU MS: UK and Turkey
- Electrolux raised invalidity defence
- Can Swedish court continue with infringement cases



BSH/Electrolux

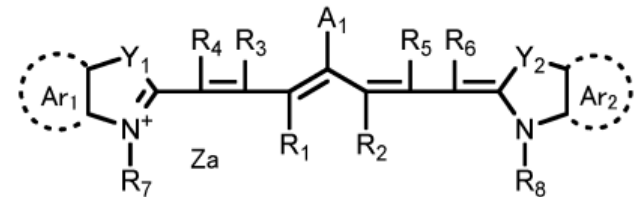
- CJEU answer **EU MS**:
 - Art. 4 BR (domicile) court has cross-border infringement jurisdiction
 - And still has this jurisdiction if validity foreign part patent is challenged
 - Infringement court **may** stay proceedings if considers justified
 - In particular: if it takes view reasonable, non-negligible possibility court other MS will declare patent invalid
- CJEU answer **third states** (i.c. Turkey):
 - Art. 24 (4) BR (exclusive validity jurisdiction) does **not** apply
 - Art. 4 BR (domicile) has cross-border infringement jurisdiction
 - Infringement cannot invalidate, but decide **inter partes** on validity

BSH/Electrolux – old wind of change?

- Merits infringement action:
 - NL: if invalidity defence raised as to foreign part: court *stay* or *reject* cross-border injunction claim
 - *Now* EU states: court may *stay* or *grant* cross-border injunction claim EU states
 - make validity assessment foreign part
 - *Now* third states: inter partes assessment invalidity defence
 - Possibly less provisional measures pending merits action
 - Cross-border *damages* relief ?
 - Not possible as provisional measure
- Will non-Dutch national courts get inspired? Different validity assessment(s)?

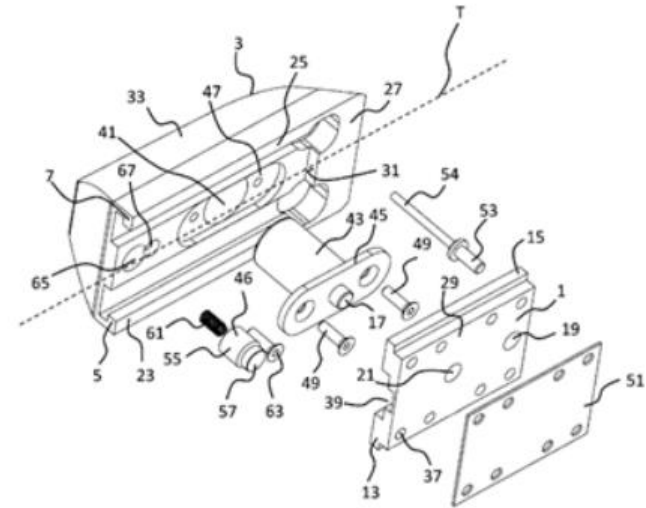
UPC: Fujifilm/Kodak (Düsseldorf, January 2025)

- Germany domiciled defendant
 - Infringement claim UPC (Germany) and UK part
 - Revocation counterclaim German part;
 - UK validity challenged (no counterclaim)
-
- UPC has jurisdiction if national court EU MS has jurisdiction (Art. 71b (1) BR)
 - UPC has universal home court jurisdiction (Art. 4 BR) over Germany based defendant
 - Jurisdiction extends to infringement UK part
 - No jurisdiction to rule on validity UK part (NB. pre-BSH/Electrolux)
 - Still: infringement UK part denied, as German part found invalid



UPC: applies BSH/Electrolux

- Mul-T Lock/IMC (Paris, March 2025)
 - Art. 4 defendant (domiciled France)
 - Cross-border infringement jurisdiction
 - ES (BR) and CH (Lugano): stay possible
 - UK: possibility inter partes validity decision
- Alpinestar/Dainese (Milan, April 2025)
 - Art. 4 defendant (domiciled Italy)
 - Universal infringement jurisdiction
- Supponsor/AIM (CoA, April 2025)
 - Addition of ES allowed in view of BSH/Electrolux



UPC: Genevant/Moderna (The Hague, May 2025)

- Infringement action: 15 Moderna defendants
- Patentee:
 - Moderna NL: anchor defendant / spider in web
 - Art. 4 BR
 - Other 14 defendants: co-defendants
 - Art. 8 BR: same infringement/same state
- LD: jurisdiction infringement non-UPC states ES, PL, NO by local co-defendants
- LD: jurisdiction infringement TR, MO by non-UPC domiciled co-defendants is dealt with in main proceedings



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UPC approach to preliminary injunctions



UPC approach to preliminary injunctions

- 01 Visible and hidden requirements
- 02 Illustrative case law

PIs at the UPC

Basic regime

- Article 62 UPCA
- Rules 205 ff. RoP

Visible requirements

Article 62.4 UPCA (Provisional and protective measures):

“The Court may, in respect of the measures referred to in paragraphs 1 and 3, require the applicant to provide any reasonable evidence in order to satisfy itself with a sufficient degree of certainty that the applicant is the right holder and that the applicant’s right is being infringed, or that such infringement is imminent”

Rule 211.2 RoP (Order on the Application for provisional measures):

“In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent”.

Visible requirements

Article 62.4 UPCA (Provisional and protective measures):

*“The Court may, in respect of the measures referred to in paragraphs 1 and 3, require the applicant to provide any reasonable evidence in order to satisfy itself with a sufficient degree of certainty that the applicant **is the right holder** and that **the applicant’s right is being infringed, or that such infringement is imminent**”*

Rule 211.2 RoP (Order on the Application for provisional measures):

*“In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that **the applicant is entitled to commence proceedings** pursuant to Article 47, that **the patent in question is valid** and that **his right is being infringed, or that such infringement is imminent**”.*

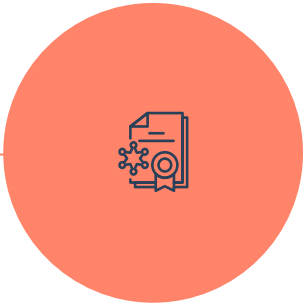
Visible requirements



Entitlement



Infringement
(threatened or taking place)



Validity

Hidden requirements

Article 62.2 UPCA (Provisional and protective measures):

“The Court shall have the discretion to weigh up the interests of the parties and in particular to take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.”

Rule 211.3 RoP (Order on the Application for provisional measures):

“3. In taking its decision the Court shall in the exercise of its discretion weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction”.

Hidden requirements

Article 62.2 UPCA (Provisional and protective measures):

“The Court shall have the discretion to weigh up the interests of the parties and in particular to take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.”

Rule 211.3 RoP (Order on the Application for provisional measures):

“3. In taking its decision the Court shall in the exercise of its discretion weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction”.

Hidden requirements

Rule 206.2(d) RoP (Application for provisional measures):

"An Application for provisional measures shall contain:

(d) the facts and evidence relied on in support of the Application, including evidence to support the claim that provisional measures are necessary including the matters referred to in Rule 211.2 and .3"

Rule 211.4 RoP (Order on the Application for provisional measures):

"4. The Court shall have regard to any unreasonable delay in seeking provisional measures".

Hidden requirements

Rule 206.2(d) RoP (Application for provisional measures):

"An Application for provisional measures shall contain:

*(d) the facts and evidence relied on in support of the Application, including evidence to support the **claim that provisional measures are necessary** including the matters referred to in Rule 211.2 and .3"*

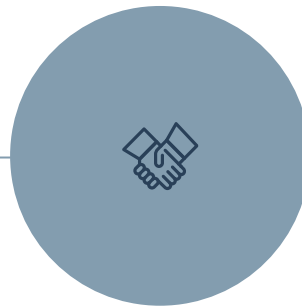
Rule 211.4 RoP (Order on the Application for provisional measures):

*"4. The Court shall have regard to **any unreasonable delay in seeking provisional measures**".*

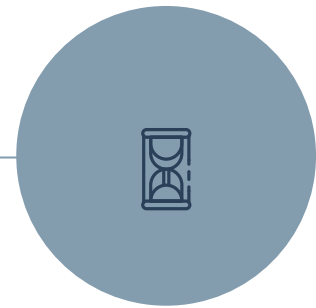
Hidden requirements



**Weighing of
interests**



Necessity



**No unreasonable
delay**

A solid blue circle located at the top right edge of the dark blue circular overlay.

**Navigating the case
law on these
requirements**

IP 360  : One team, all sides of Intellectual Property

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UPC Preliminary Injunctions

Case law on the 'hidden requirements'

Bryce Matthewson, Powell Gilbert

Weighing of Interests

Mammut v Ortovox, UPC_CoA_1822024, 25 September 2024 (Court of Appeal)

(Decision [here](#) [DE])

- Court of Appeal found that irreparable harm is not a requirement (even for an *ex parte* PI)
- An (alleged) infringer deprives the patentee of market opportunity associated with the patent protection; thus, defendant's argument that damages were adequate remedy could not succeed
-
- Timing of hearing vis-à-vis winter ski season taken into account

Häfele SE & Co KG v Kunststoff, UPC_CFI_443/2024, 25 September 2024 (Munich Local Division)

(Decision [here](#) [DE])

- Defendant had been on the market for several years; PI filed in respect of newly granted patent
- Court did not follow patentee's argument regarding financial loss & rejected argument of "lock in effect" due to Defendant's presence on the market

Necessity

Biolitec v Light Guide Optics, UPC_CoA_540/2024, 24 February 2025 (Court of Appeal)

(Decision [here](#))

- *“If proceedings on the merits can be awaited, provisional measures are not necessary since proceedings on the merits offer more procedural safeguards”* i.e. is it necessary to jump the queue
 - E.g. Irreparable harm (although not a requirement)
 - direct competition not sufficient, although relevant
 - “single-use and substitutable product” counted against necessity
 - price spirals?
 - reputational damage?
- PI denied because product already available for number of years

No Unreasonable Delay

Ericsson v Asus, UPC_CFI_317/2024, 15 October 2024 (Lisbon Local Division)

(Decision [here](#))

- Ericsson sought PI prohibiting the offering and selling of laptops and notebooks containing specific Intel modules
- Delay occurs where *“the Applicant has acted negligently or hesitated in requesting provisional measures after gathering all the necessary elements for a promising legal action”*
- Onus on applicant to establish that, in light of the circumstances, it has not delayed proceedings unnecessarily. Defendant pointed to launch of products in 2019 & 2021 to establish delay
- Applicant must establish when it first became aware of infringement; if silent, Court will assume it became aware at date of alleged infringement

Injunctive Relief in the UK: preliminary injunctions

Tom Oliver

Powell Gilbert

Competition Law Association

3 July 2025

Preliminary Injunctions in the UK

- Many European jurisdictions take the merits into account, possibly a mini-trial. Not in the UK.

“It is no part of the court's function at this stage of the litigation to try to resolve conflicts of evidence on affidavit as to facts on which the claims of either party may ultimately depend nor to decide difficult questions of law which call for detailed argument and mature considerations. These are matters to be dealt with at the trial.”

American Cyanamid v Ethicon [1975]

- Position driven by importance given to hearing evidence / argument at trial.



The basic principle is that the court should take whichever course seems likely to cause the least irremediable prejudice to one party or the other.

National Commercial Bank of Jamaica v Olint [2009]

Preliminary Injunctions in the UK – What is the test?

The American Cyanamid Questions

- 1) Is there a serious question to be tried?
- 2) Would damages be an adequate remedy for the claimant?
- 3) Would damages be an adequate remedy for the defendant?
- 4) Where does the balance of convenience lie (least risk of injustice)?

Preliminary Injunctions in the UK – Anything else?

Q: Is there an urgency requirement?

A: As a practical matter - yes

- Existence of delay suggests harm to patentee not such as to necessitate preliminary injunction
- Delay allows defendant to establish position in market.

Q: Is there an obligation to “Clear the way”

A: Potentially in pharmaceutical cases

“Where litigation is bound to ensue if the defendant introduces his product, he can avoid all the problems of an interlocutory injunction if he clears the way first. That is what the procedures for revocation and declaration of non-infringement are for.”

SmithKline Beecham v Apotex Europe Ltd [2003]

Preliminary Injunctions in the UK – Anything else?

Q: Can you get a preliminary injunction on a patent application?

A: Possibly

- *Novartis v Teva* (Fingolimod)
- Examination appealed to TBA.
- TBA said patent should be granted
- PPI application brought in March. Grant expected in June.

*“Novartis and the generic Defendants **all know that a patent will be granted** and the scope of that patent, where the reason that it was not granted immediately following the decision of the TBA in February 2022 is **only because of the administrative procedures which apply in the EPO**, and where once it has been granted Novartis will then be entitled to claim damages for loss suffered over the period between present introduction of generic product and the date of grant, in my judgment **it cannot be regarded as an abuse of process for Novartis to seek interim relief** to restrain the acts which would otherwise give rise to that loss.”*

Preliminary Injunctions in the UK – Anything else?

Q: Is the patentee obliged to compensate the defendant for a PI which turns out to be wrongly granted?

A: Yes

- Patentee must give a “cross undertaking in damages”
- a promise, to the Court, to pay the defendant the amount that the Court orders.
- Identified parties other than the defendant can have the benefit of a cross undertaking
- E.g. suppliers (lost profit) or customers (e.g. National Health Service - if pays more for pharmaceuticals).

“Rules of Thumb”

Non-Pharmaceutical Cases

- Preliminary injunctions rarely sought or granted.
- Requires special commercial circumstances.

Pharmaceutical Cases

- Preliminary injunctions often sought and granted.
- Generic expected to give advance notice of launch to allow PI hearing to take place
- Commercial circumstances still important.
- Failure to clear the way may be decisive.
- Price spiral / ability to put up prices if Generic removed from market.
- Route to market might be important – hospital tendering or sale to wholesalers?

Recent developments in the UK - Dapagliflozin

First Instance Decision – 28 March 2025

- Post trial / pre-judgment - the trial judge declined to grant a PI
- On the evidence:
 - Damages adequate remedy for AZ and balance of convenience in Glenmark's favour
 - AZ unlikely to reduce its price of dapagliflozin following generic entry – no price spiral
 - the ability to assess Glenmark's damages more difficult than AZ's.
 - What Gx price / volume available?
 - What Gx competition in market?
 - What would AZ do?
 - What lasting value to Glenmark of being first mover advantage?

Recent developments in the UK - Dapagliflozin

PI Appeal hearing – 9 April 2025

- AZ's appeal was allowed and PI granted to “hold the ring”.
 - CA anticipated AZ likely to reduce price and price spiral on generic entry
 - *status quo* should be maintained
 - The fact that Glenmark was “jumping the gun” had not “cleared the way” should be taken into account

86. ... It seems to me that the correct conclusion is that there is real doubt as to the adequacy of damages for both parties (and for the NHS), and it is not possible to form a reliable view as to which side is more at risk of receiving an inadequate remedy in damages.

...

87. Given that it is not possible to form a reliable view as to which side is more at risk of receiving an inadequate remedy in damages, and given the shortness of the period in question, it is prudent to preserve the status quo...

AZ v Glenmark [2025] EWCA Civ 480 Arnold LJ,

Recent developments in the UK - Dapagliflozin

PI can continue after validity decision finding patent invalid

AZ's dapagliflozin patent held invalid by Tappin – arbitrary selection and not plausible.

AZ appealed and sought to continue PI pending expedited appeal.

HHJ Hacon granted injunction to preserve status quo – less than a month away.

130. Each side is likely to suffer irreparable harm on the alternative hypotheses of an injunction being granted or not. The harm on either side is different, so there is no question of comparing like with like in assessing the comparative risk with any measure of accuracy. Uncertainties exist on both sides.

131. In those circumstances, following a principle of law emphasised by the Court of Appeal in *Neurim Pharmaceuticals* and endorsed in the [the Court of Appeal's decision in *AZ v Glenmark*] I am persuaded that it is appropriate for me to maintain the status quo. ... The status quo requires the grant of an injunction as sought.

AZ v Glenmark [2025] EHW 1339 (Pat), [130]-[131] (Judge Hacon)

Our awards

