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WEBINAR

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

Speakers: Tom Oliver, Powell Gilbert (**TO**)
Bryce Matthewson, Powell Gilbert (**BM**)
Sara Nazaré, NLP Legal (**SN**)
Rik Lambers, Brinkhof (**RL**)
Chaired by Tess Waldron (CLA Committee) (**TW**)

Date: 3 July 2025

Introductions

Tess Waldron introduced the panel and opened the session. She provided an overview of the key themes that will be explored in the discussion.

Reflecting on BSH / Electrolux

Rik Lambers provided an overview of Dutch cross-border practice and the legal framework under the Brussels I-bis Regulation. He explained that EU Member State courts, under Article 4, may assume 'home court' jurisdiction over cross-border infringement claims involving entities of that Member State. At the same time, those courts, under Article 8, may assume jurisdiction over co-defendants from different EU member states where claims are closely connected.

He highlighted the limitations posed by Article 24(4), which reserves exclusive jurisdiction over the validity of national parts of European patents to the courts of the respective member states. Historically, pre-BSH / Electrolux, the "spider in the web" doctrine had enabled Dutch courts to claim jurisdiction over related entities across Europe, although this was constrained by Court of Justice of the EU ('CJEU') case law in *GAT / LUK* and *Roche / Primus*. The CJEU's *Solvay/Honeywell* confirmed the possibility of suing co-defendants in certain circumstances, and that an invalidity defence does not preclude provisional cross-border measures.

RL discussed how the **BSH / Electrolux** ruling reaffirmed that courts in the domicile of a defendant have jurisdiction over cross-border infringement claims, even where validity is challenged regarding foreign national parts of a European patent. Courts may stay proceedings if there is a reasonable, non-negligible possibility that a foreign court will declare the patent invalid, but they are no longer required to do so automatically, i.e. they may grant the cross-border injunction. He noted that while the ruling largely confirms existing Dutch practice, it opens up possibilities for cross-border damages relief.

RL also reflected on how UPC divisions have begun applying BSH / Electrolux principles, as seen in cases like *Mul-T Lock/IMC* and *Genevant / Moderna*, where cross-border jurisdiction was assumed beyond UPC territories.

The UPC approach to Preliminary Injunctions

Sara Nazaré outlined the requirements for preliminary injunctions (PIs) under the Unified Patent Court Agreement (UPCA) and Rules of Procedure. She distinguished between:

- **"Visible" requirements:** The applicant must provide reasonable evidence of entitlement (e.g. as patent holder or licensee), validity of the patent (although the terms are also a bit unclear under the existing case law), and actual or imminent infringement (Article 62(4) UPCA, Rule 211.2 RoP).
    - SN highlighted *Novartis/Genentech v. Celltrion*, and *myStromer / Revolt* as good case law for

determining what is considered "imminent" - the former showing that promotional activity alone is insufficient without launch readiness, and the latter confirming that concrete commercial offers or displays can meet the threshold.

- She noted that the burden of demonstrating validity rests initially with the defendant (according to 10xGenomics v. Nanostring) and that a limited number of invalidity attacks should be brough by the defendant (Cardo v. Asmax), although the applicant may want to present some reasons as to why the patent is likely to be valid in the context of the obligations arising under Rule 13.1(h) RoP, such as having survived opposition proceedings.

- **"Hidden" requirements:** These include the weighing of parties' interests (Article 62(2) UPCA, Rule 211.3 RoP), necessity of the injunction, and the absence of unreasonable delay (sometimes named "urgency" by the case law). SN observed that the necessity and urgency requirements are not entirely clear in the UPC rules, particularly in what concerns the substance of what is required to have these demonstrated, so it will need further clarification through case law. While some of these requirements appear in the context of the formal application for provisional measures requirements (Rule 206 RoP), others appear in the Rule that governs the Order of the Court (Rule 211). This said, to be on the safe side, the applicant should raise the issue.

Bryce Matthewson discussed emerging UPC case law:

- In *Mammut / Ortovox*, the Court of Appeal confirmed that irreparable harm is not a requirement for granting a PI (although it may strengthen an application) – a key distinction from UK case law. Contextual commercial factors and the scheduling of the oral hearing in the main hearing were considered.

- In *Haefele / Kunststoff*, the court implied that the status quo at the time of filing is an important consideration: acting before the competitor becomes entrenched in the market could be beneficial, underlining the importance of prompt applications to support urgency and weighing of interests.

- In *Biolitec / Light Guide Optics*, the court considered necessity in detail, confirming that while irreparable harm is not a formal requirement for a PI, demonstrating it can strengthen the case. The court took into account that the defendant's product was a **single-use, substitutable item** — a commodity that purchasers would simply buy again if needed — in deciding that there was no irreparable harm. Additionally, the product had already been on the market for several years, which weighed against the need for immediate intervention. The application was denied on the basis that provisional measures were not necessary in the circumstances.

- In *Ericsson / Asus*, the court stressed the importance of prompt action, placing the burden on applicants to justify any delay in seeking relief. BM indicated that the case law indicated a period of roughly one to three months being the limit of an acceptable delay. The applicant had the burden to prove they had acted sufficiently quickly. Ericsson secured trap purchases in May and filed in June; however, they didn't disclose when they first became aware of infringement. The court therefore assumed that they became unaware when the first infringement occurred which was a few years prior.

Addressing Injunctive Relief in the UK

Tom Oliver compared the UK approach, explaining that UK courts do not conduct mini-trials at the interim stage. Instead, they apply the American Cyanamid test, considering whether there is a serious issue to be tried, whether damages would be an adequate remedy for either party, and where the balance of convenience lies.

TO noted that urgency plays a practical role, with delay undermining claims for interim relief. The controversial obligation to "clear the way" was discussed, particularly in pharmaceutical cases. He also reflected on the Novartis v Teva case, where a PI was granted in anticipation of an imminent patent grant, and on the AZ /

Glenmark litigation, where the courts sought to preserve the status quo amid uncertainty over damages adequacy and patent validity.

Closing Reflections

The session concluded with reflections on how the landscape for injunctive relief is evolving. RL highlighted strategic considerations for generic companies in structuring their operations to mitigate cross-border exposure. TO suggested that UK courts may look to assert jurisdiction creatively in response to developments in the UPC and EU states. The panel noted that while the BSH / Electrolux ruling clarifies certain aspects of cross-border jurisdiction, its wider consequences are still unfolding.