

## Case note under BSH Hausgeräte v Electrolux

Frank Eijsvogels<sup>1</sup> and Rosalie ten Wolde<sup>2</sup>

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### Introduction

1. The BSH/Electrolux case concerns the relationship between Articles 4(1) and 24(4) of Brussels I bis.<sup>3</sup> Article 4(1) contains the main rule of international jurisdiction law for cases falling within the material scope of Brussels I bis: the court of the Member State where the defendant is domiciled has international jurisdiction. It follows from the judgment of the Court of Justice of the European Union (the Court) in the Owusu case<sup>4</sup> that this court does not have the freedom not to exercise this jurisdiction on the grounds that the court of a third country would be a more appropriate forum to hear the dispute in question. In short: there is no scope for applying the forum non conveniens doctrine.
2. According to Article 24(4) of Brussels I bis, the courts of the Member State for which a European patent has been granted have exclusive jurisdiction over the registration or validity of that patent, regardless of whether the issue is raised by way of an action or a plea in objection. The fact that this exclusive jurisdiction applies under this provision, regardless of whether the issue is raised by way of an action or a plea in objection, codifies the interpretation given by the Court to Article 16(4) of the EEX Convention<sup>5</sup> in its judgment in GAT/LuK.<sup>6</sup>
3. Also important is the judgment in Solvay v Honeywell<sup>7</sup>, to which the Court refers in its answer to the first question, in which the Court ruled, inter alia, that Article 22(4) EEX-Vo 44/2001 must be interpreted as not precluding the application of Article 31 EEX-Vo 44/2001 in circumstances such as those at issue in the main proceedings.<sup>8</sup> In short: the court remains competent to give a preliminary ruling on the defences of invalidity raised by the defendant against the infringement claims based on European patents in so far as they are valid in other Member States of the EEA, in summary proceedings or in the

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<sup>1</sup> Frank Eijsvogels is a lawyer and partner at HOYNG ROKH MONEGIER in Amsterdam and member of the editorial board of IER.

<sup>2</sup> Rosalie ten Wolde is lawyer at HOYNG ROKH MONEGIER in Amsterdam.

<sup>3</sup> Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters.

<sup>4</sup> CJEU 1 March 2005, case C-281/02, ECLI:EU:C:2005:120 (Owusu).

<sup>5</sup> In GAT/LuK, the CJEU interpreted Article 16(4) of the EEX Convention. Article 16(4) has been incorporated into Article 22(4) of EEX Regulation 44/2001, with the addition of the following sentence: 'Without prejudice to the competence of the European Patent Office under the Convention on the Grant of European Patents, signed in Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction, regardless of domicile, in any proceedings concerned with the registration or validity of any European patent granted for that Member State.' Article 22(4) of Regulation (EC) No 44/2001 is the predecessor of Article 24(4) of Brussels I bis.

<sup>6</sup> ECJ 13 July 2006, ECLI:EU:C:2006:457, IER 2006/76, note by R.E.P. de Ranitz, NJ 2008/78 note by P. Vlas (GAT/LuK)

<sup>7</sup> CJEU 12 July 2012, ECLI:EU:C:2012:445, IER 2012/62, commentary by S.J. Schaafsma, BIE 2012/9, commentary by C.J.J.C van Nispen, NJ 2013/67 commentary by C. Gielen (Solvay/Honeywell)

<sup>8</sup> Art. 35 (the predecessor of Art. 35 Brussels I bis).

assessment of a claim for the imposition of a cross-border provisional measure brought in the context of proceedings on the merits. In cases where an action has been brought against a defendant domiciled in the Netherlands to impose a cross-border injunction for patent infringement by way of a provisional measure, the Dutch court has based its international jurisdiction solely on Article 4(1) of Brussels I bis (jurisdiction according to the 'first track', and not also on the basis of the 'second track' formed by Article 35 of Brussels I bis).<sup>9</sup>

4. The question is whether, in a case on the merits in which a cross-border injunction is sought for all countries where a European patent is in force, the court with international jurisdiction to rule on the infringement loses jurisdiction with regard to infringement of foreign patents if the defence is that those foreign patents are invalid. In 1997, in *Coins Control/Suzo*<sup>10</sup>, the English court ruled that the court loses that jurisdiction because infringement and invalidity are so intertwined that these issues cannot be separated for the purposes of jurisdiction. The same question was before the Supreme Court in the *Roche/Primus* case<sup>11</sup>, after the Court of Justice had handed down its judgment in *GAT/Luk*. The Supreme Court ruled differently from the English court. According to the Supreme Court, in such circumstances the court does not lose jurisdiction with regard to the infringement claim, but the court may first rule on the infringement of the foreign parts of the patent if the court that has exclusive jurisdiction under (now) Article 24(4) Brussels I-bis with respect to validity of the patent has decided. The court is therefore free to stay the infringement proceedings pending the judgment of the competent foreign court to be sought by a party, but only if the claimant so wishes. If the claimant does not wish to stay the proceedings, the court must dismiss the claim. In practice in the Netherlands following the Supreme Court's judgment in *Roche/Primus*, the patentee who brought an action in proceedings on the merits for a cross-border injunction for patent infringement also chose to seek a cross-border provisional injunction and to request a stay of the main proceedings for other countries if a defence of invalidity was raised. The District Court of The Hague has imposed cross-border provisional injunctions in a number of cases.<sup>12</sup> Such provisional injunctions can remain in force for years, particularly in situations where the defendant chooses not to bring invalidity proceedings in other Member States where the European patent on which the claims are based is in force.
5. In its long-awaited ruling in the *BSH/Electrolux* case, the Court has now answered the question previously submitted to the Supreme Court in the *Roche/Primus* case, not only with regard to EU Member States, but also with regard to third countries. This note will discuss the possible impact of this ruling on infringement proceedings before national courts and before the UPC.

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<sup>9</sup> Schaafsma suggested the possibility that jurisdiction could be based on the first ground in his note under the judgment, footnote 4. See most recently Court of Appeal of The Hague, 1 March 2022, ECLI:NL:GHDHA:2022:636 (*LONGi/Hanwha*), with reference to established case law of the District Court and Court of Appeal of The Hague, including Court of Appeal of The Hague 20 May 2014, ECLI:NL:GHDHA:2014:1727, ground 20 (*Apple/Samsung*).

<sup>10</sup> High Court, *Coin Controls v Suzo International* [1997] F.S.R. 660.

<sup>11</sup> Supreme Court 30 November 2007, ECLI:NL:HR:2007:BA9608, NJ 2008/77, with commentary by P. Vlas.

<sup>12</sup> See, for example, District Court of The Hague, 7 June 2017, ECLI:NL:RBDHA:2017:6136 (*Carl Zeiss Meditec/VSYS Biotechnology et al.*), District Court of The Hague, 13 March 2024, ECLI:NL:RBDHA:2024:3939 (*Essity/MTS*) and District Court of The Hague, 16 October 2024, ECLI:NL:RBDHA:2024:17019 (*Essity/MTS*).

### BSH/Electrolux: the questions

6. The underlying case concerns a dispute between patentee BSH Hausgeräte GmbH (“BSH”), a German manufacturer of household appliances, and Aktiebolaget Electrolux (“Electrolux”), a Swedish company active in the same sector, over the alleged infringement of a European patent held by BSH. BSH has brought proceedings against Electrolux before the Swedish courts, seeking a cross-border injunction. One of Electrolux’s defences was that the foreign parts of the patent are invalid and that the court therefore no longer has international jurisdiction to rule on the infringement claim insofar as it relates to countries other than Sweden. The Swedish court referred three questions to the Court of Justice for a preliminary ruling.
- Question 1 concerns whether Article 24(4) of Brussels I bis must be interpreted as meaning that the court of the defendant’s place of domicile, where, pursuant to Article 4(1) of Brussels I-bis, a claim has been filed about infringement of a patent granted for another member state, remains competent to hear that action when the defendant challenges the validity of that patent by way of a defence in the context of that action.
  - Question 2 concerns whether the answer to the first question depends on whether national law contains provisions corresponding to a provision in the Swedish Patent Act, under which the defendant in infringement proceedings may only raise a plea of invalidity if he brings a separate action for revocation.
  - Question 3 concerns whether Article 24(4) of Brussels I bis must be interpreted as applying to a court of a third country<sup>13</sup> and, consequently, as conferring on the court of that third country exclusive jurisdiction to assess the validity of a patent granted or declared valid there.

### The Court’s ruling

#### The second question

7. The Court first answered the second question. We can be brief about the answer to this question. According to the Court, a national rule under which the defendant in infringement proceedings can only raise a plea of invalidity if he brings a separate action for annulment cannot affect the interpretation of Article 24(4) of Brussels I bis. This provision does not contain any reference to the law of the Member States, so that the terms used in it must be regarded as autonomous concepts of Union law which, regardless of any national rule or procedure in this regard, must be interpreted uniformly in all Member States. This comes as no surprise to us. The importance of this judgment lies in the answers to questions 1 and 3.

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<sup>13</sup> This refers to a country that is not a member state of the EU.

### Question 1: defence of invalidity in relation to other EU Member States

8. Advocate General Emiliou has delivered two opinions in this case.<sup>14</sup> In his first opinion, he criticised the judgment in *GAT/Luk*<sup>15</sup>, noting that the interpretation given by the Court of Justice in that judgment to Article 16(4) of the EEX Convention has been codified in Article 24(4) of Brussels I bis and that the Court of Justice is therefore 'locked in' to the solution it initially chose. The Court therefore had no choice but to rule that the courts of the Member States where the patent was granted have exclusive jurisdiction under Article 24(4) Brussels I bis, have exclusive jurisdiction to hear a challenge to the validity of that patent, regardless of whether that challenge is raised by way of an action or as a plea in objection in the context of an infringement action before the court of another Member State (paragraph 35). According to the Court, this exclusive jurisdiction is justified by the fact that the granting of patents involves the intervention of national public authorities, and by the fact that the courts of the country in which a patent is in force are best placed to hear cases in which the dispute itself concerns the validity of the patent or the existence of the deposit or registration. The courts of the Member State in whose territory the registers are kept may, under their national law, rule on the validity of patents granted in that Member State. According to the Court, this concern for the proper administration of justice is all the more important in the field of patents, given that, in view of the specific nature of the subject matter, several Member States have established a special system of judicial protection whereby such disputes are reserved for specialised courts.<sup>16</sup>
9. The Court then assesses how much discretion Article 24(4) leaves to the court which, pursuant to Article 4(1), has jurisdiction to rule on the infringement claim in relation to another Member State. According to the Court, that court does not lose that jurisdiction on the sole ground that the defendant contests the validity of the patent in that other Member State by way of defence.<sup>17</sup> The Court bases this interpretation on the structure and objectives of Brussels I bis. First, Article 24(4) must be interpreted strictly because it confers exclusive jurisdiction that constitutes an exception to the main rule laid down in Article 4(1). Secondly, the principle of legal certainty underlying the Regulation requires that the rules on jurisdiction be highly predictable. An interpretation that would make the jurisdiction of the court dependent on whether or not a defence is raised is therefore contrary to that principle. Moreover, such an interpretation would mean that the defendant could bring the infringement proceedings to an end by raising the

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<sup>14</sup> The first opinion is dated 22 February 2024 (ECLI:EU:C:2024:1590) and the second opinion is dated 5 September 2024 (ECLI:EU:C:2024:687).

<sup>15</sup> The AG argues that the Court should have qualified the subject matter of the main proceedings (infringement of patent rights). In his view, the defence against the infringement claim that the patent is invalid is an exception that could have been decided *inter partes*. The AG notes that the Court's interpretation that the rule of exclusive jurisdiction for the validity of patents even applies to proceedings in which that issue is raised purely by way of exception is, to his knowledge, unique in the system of the EEX Convention and that the Court has not substantiated this interpretation in a convincing manner. See paragraphs 41-62 of the Opinion of 22 February 2024.

<sup>16</sup> CJEU 25 February 2025, ECLI:EU:C:2025:108 (*BSH/Electrolux*), para. 36.

<sup>17</sup> CJEU 25 February 2025, ECLI:EU:C:2025:108 (*BSH/Electrolux*), para. 41.

objection. Thirdly, according to the Court, the strict interpretation of Article 24(4) is in line with the objective of that provision, namely to reserve disputes concerning the registration or validity of the patent to the courts of the Member State in which the patent was granted. Fourthly, this interpretation enables the holder of a European patent to combine all his claims for patent infringement and to obtain comprehensive redress from a single court. This avoids the risk of divergent decisions, according to the Court. Finally, the Court emphasises that the fact that the application of this interpretation may lead to a division of proceedings does not affect this interpretation. Such a division does not mean that the court of the Member State of the defendant's domicile where the patent infringement claim has been brought must disregard the fact that the defendant has duly brought an action for revocation of the patent in force in another Member State. If the court considers it justified, in particular where it considers that there is a reasonable and not negligible chance that the patent will be declared invalid by the competent court of that other Member State (the Court referring by analogy to the Solvay/Honeywell judgment), the court hearing the patent infringement action may, where appropriate, stay the proceedings so that it can take account of the decision of the court hearing the action for revocation when ruling on that action.

#### Possible role for the national court

10. The question is how the national court, which has international jurisdiction under Article 4(1) of Brussels I bis to hear an action for a cross-border injunction for infringement of a European patent, will deal with a defence that the patent is invalid in other EU Member States where it is in force. The courts of the EU Member States may deal with this differently. The following comments can be made.
  - i. The question is whether the court must or may disregard a defence of invalidity relating to parallel versions of the European patent that are in force in other Member States, or whether the court may rule on this. If the court must disregard such a defence, this means that the court cannot rule on the infringement claims insofar as they relate to other Member States. After all, there is no infringement of a foreign patent that has been declared invalid. We therefore believe that the court should not be allowed to disregard such a defence. It is clear that the court should not rule on the merits of such a defence: that power lies exclusively with the court of the Member State in which the patent in question is in force. In paragraph 51 of the judgment, the Court considered that the division of the proceedings between infringement and validity proceedings does not mean that the court of the Member State of the defendant's domicile before which the patent infringement action is brought should disregard the fact that the defendant has duly brought an action for revocation of the patent granted in another Member State in that other Member State. According to the Court, the court may stay the proceedings if there is a reasonable and non-negligible possibility that the patent will be declared invalid by the competent court of the other Member State, so that the court can take into account a decision of the court where the action for invalidity has been brought when ruling on that action. We conclude from this consideration that the court can assess whether there is a reasonable chance that the court in another

Member State in which the patent is effective will declare the patent invalid and can therefore give a purely provisional ruling on the defence of invalidity for that other Member State.

- ii. In our view, the patentee no longer needs to request a stay of the main proceedings for the foreign country (as happened in practice after the Supreme Court handed down its judgment in *Roche/Primus*) in order to prevent the court from dismissing the claims for the foreign country. This approach has been superseded by the judgment in *BSH/Electrolux*.
- iii. The question is whether there are still reasons for the patentee to also file a claim in the main proceedings for a cross-border provisional injunction. There could be reasons for this because it is still uncertain how the court will deal with *BSH/Electrolux* in cases where the defence is that foreign parts of a European patent are invalid. There is a possibility that, in practice, the court will often no longer be able to assess such claims, e.g. in the following situations:
  - (i) the main action is not stayed, e.g. because there is no parallel invalidity action pending. In that case, the court in the main action may, in principle, impose a cross-border injunction if the patent in force in the Netherlands is considered valid, and an injunction claim for those other countries will, in principle, be rejected if this patent is considered invalid (if the court finds that there is no or a serious, non-negligible chance that the European patent will be declared invalid in the other Member States);
  - (ii) that the main proceedings are stayed, but it appears that, according to paragraph 51 of the judgment, this is only possible in practice if the court considers that there is a serious and non-negligible risk that the foreign parts in question will be declared invalid. In that case, it is difficult to imagine that there would nevertheless be scope for imposing a cross-border provisional injunction.
- iv. It appears that the Court's ruling does not impose an obligation on the defendant to initiate nullity proceedings in one or more other countries in order to obtain a court decision to suspend or stay the proceedings for the countries concerned. The court will often also have to rule on the validity of the patent in its own country, and that decision may be decisive in determining whether or not to suspend or stay the proceedings.<sup>18</sup> National courts may deal with this differently, depending on whether the court ruling on the infringement is the same court that decides on the invalidity defences (as in the Netherlands) or whether another authority decides on this, as in countries where bifurcation is applied (e.g. Germany). There is a chance that a judge based in a country where bifurcation is applied will deal with a nullity defence relating to a patent that is valid outside their own country in the same way as a nullity defence relating to a patent that is valid in their own country. For example, German courts are reluctant to stay infringement proceedings on the basis of invalidity defences raised in invalidity proceedings.<sup>19</sup>

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<sup>18</sup> As also argued by Willem Hoyng in his commentary on the judgment as published on the EPLAW blog.

<sup>19</sup> For an explanation of German practice, see Léon Dijkman, *Does the Injunction Gap Violate Implementers' Fair Trial Rights Under the ECHR?*, *GRUR International*, 70(3), 2021, 215–227, para. 16.

- v. In Bettacare/H3<sup>20</sup>, the District Court of The Hague did not grant a request to apply the Swiss method (whereby the alleged infringer is given the opportunity to file a nullity claim before the foreign court within a certain period of time) because the Supreme Court's ruling in Roche/Primus did not allow for this. The court ruled that Bettacare's request to apply the Swiss solution could not be regarded as a request for a stay of proceedings. According to the Supreme Court, the court would indeed have jurisdiction in that case, but it must reject the cross-border prohibition of infringement. As indicated, we believe that the Supreme Court's decision that the patent holder must choose whether or not to stay the case abroad no longer needs to be applied. The question is whether the court will set a time limit for the defendant to initiate invalidity proceedings in other countries if the defendant so requests. On the one hand, it can be noted that, if proceedings on the merits have been initiated, the defendant has ample time to initiate invalidity proceedings in other countries. If the patent holder had chosen to initiate national infringement proceedings, the defendant would have had to mount a thorough defence in each country where such proceedings were initiated. On the other hand, the defendant would face considerable costs if invalidity proceedings had to be initiated in every country to which the claim for a cross-border injunction extends. In addition, even if invalidity proceedings are initiated in certain countries, this does not necessarily mean that the court for those countries must suspend or stay the infringement proceedings; this may and will depend (among other things) on the court's assessment of whether there is a reasonable and not negligible chance that the patent will be declared invalid by the court in the countries concerned. In our view, it is the defendant's responsibility to assess whether invalidity proceedings should be initiated in other countries and there is therefore no reason to set a time limit for the defendant to do so.
- vi. If the court finds that the patent in force in the country of the court (its own country) is valid and has been infringed, the court may then assess whether there is a serious, non-negligible chance that the patent will be declared invalid in other EU Member States where it is in force. If the defendant has not brought any invalidity actions in other Member States, the court will have less reason to conclude that courts in other Member States will rule differently. If, in such a situation, the court finds that there is no serious and non-negligible risk that the patent will be revoked there, the court may impose a cross-border injunction on the merits. If the defendant has brought one or more invalidity proceedings in other Member States, the court may stay or suspend the main proceedings for those countries (assuming that the court has jurisdiction to do so; see point viii for more details). The court may be reluctant to pre-empt the decision of the exclusively competent foreign court. This may depend in part on the strength of the arguments for invalidity, whether the same arguments for invalidity have been put forward in those other countries and whether the same or other prior art has been invoked, and whether other evidence is available (e.g. experts and witnesses who are yet to be questioned during a hearing) and whether the defendant has substantiated that the law in the country concerned is different

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<sup>20</sup> District Court of The Hague, 27 February and 16 July 2008, ECLI:NL:RBSGR:2008:BJ9102, BIE 2009/48, with commentary by Steinhauser (Bettacare Ltd./H3 et al.).

from that in the Netherlands and therefore the outcome of the assessment for that country will be different from that for the Netherlands.

- vii. If the patent is found to be invalid in the home country and the court grants a counterclaim for revocation for the home country, the question is how the court will rule for other Member States if the defendant has not filed a nullity claim in other Member States. It seems to us that the court can reject the claims in their entirety on the basis of a preliminary assessment of the likelihood of how the court in other Member States will rule on the invalidity (just as the court that rules that there is an infringement based on a preliminary assessment that the foreign court will rule that the patent is valid can impose a cross-border prohibition).
- viii. The question is whether the court can stay the proceedings in the main action for other Member States where the patent is in force. In his first opinion, AG Emiliou discusses the situation in which invalidity proceedings have been initiated abroad before or after the infringement proceedings have been initiated. In the first situation, the court may stay the proceedings on the basis of Article 30(1) of Brussels I-bis or (if the invalidity proceedings have been brought in a third country) on the basis of Article 34(1) of Brussels I-bis. In the second situation, these articles offer no relief. According to AG Emiliou, in that situation, the court has the option of applying the solutions provided for in its procedural law (*lex fori*) until the EU legislator has adopted provisions to that effect, and that court must sometimes even make use of them.<sup>21</sup> The question is whether Brussels I-bis precludes this. The Court does not provide any clarity in this regard, merely considering in paragraph 51 that the court may suspend the proceedings 'where appropriate'. It is not clear from this whether the Court agrees with AG Emiliou that there is scope for this in the second situation. The wording chosen by the Court seems to indicate that the Court considers that such scope exists. If it is assumed that there is scope for this, Article 20(1) of the Code of Civil Procedure is relevant. According to Article 20(1) of the Code of Civil Procedure, the court must guard against unreasonable delays in the proceedings and, if necessary, take measures at the request of a party or on its own initiative. Article 20 of the Code of Civil Procedure does not appear to provide a basis for staying proceedings insofar as the claims relate to countries in which no nullity proceedings have yet been instituted, because in that case a stay could be of indefinite duration. In order to limit unreasonable delay, the court may set a time limit for the defendant to initiate invalidity proceedings in other member states. We believe that, for the reasons mentioned under iv., there is no reason to set such a time limit for the defendant.
- ix. If the court rules that there is no infringement in its own country and the defendant has brought a counterclaim for invalidity and has argued that the patent is invalid in other Member States where it is in force, the question is whether the court still has to assess the invalidity. For the Netherlands, the court will have to rule on the invalidity if the defendant has not made the counterclaim for invalidity conditional (depending on the condition that the court finds that there is an infringement). It is possible that if the court finds that there is no infringement under Dutch law, it will also find that there is no infringement under

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<sup>21</sup> See point 86 of the opinion of 22 February 2024.



the law of the other Member States where the patent is valid and to which the claim extends, on the basis of Article 69 EPC, which is in force in all Member States, and for that reason reject the cross-border claims. In this situation, it will be up to the patentee to substantiate that the assessment of the infringement of a foreign patent under the law of the country concerned leads to a different result. Only if the court considers such an argument to be well-founded and finds that the patent has been infringed in the Member State concerned can the court proceed to assess whether there is a reasonable and non-negligible chance that the court in that Member State will declare the patent in question invalid for that Member State.

- x. The final decision of the court that a product directly or indirectly infringes a patent that is valid in other Member States will become final if no legal remedy is or can be lodged against it. This does not apply to the court's assessment of whether there is a serious and non-negligible possibility that the court in other Member States will declare the patent invalid: such an assessment is, by its nature, provisional and not an inter partes decision between the parties on validity. The defendant can therefore still bring an action for invalidity in other Member States.
- xi. In cases where the court imposes a cross-border prohibition in the main proceedings and the European patent is declared invalid in another country to which the cross-border prohibition extends, it can be argued that a circumstance relevant to the imposition of that prohibition for that country (namely that the patent is in force in that country) has ceased to exist and, with it, the prohibition has lapsed. Van Nispen notes that the question may still arise as to whether the judgment must have become final before the prohibition of infringement lapses.<sup>22</sup> The court may consider imposing the prohibition on the condition that the prohibition will no longer apply in a particular Member State in which the patent is in force from the date on which the EPO or the competent court of that country revokes or invalidates the patent in whole or in part.<sup>23</sup> This can lead to problems if, for example, the validity of the patent is confirmed on appeal in the country concerned and the judgment at first instance is set aside. The defendant has the alternative of initiating an enforcement dispute and bringing an action for suspension of enforcement.
- xii. The BSH/Electrolux doctrine will also apply in situations where defendants from other Member States are involved in the proceedings and the court has international jurisdiction over those defendants on the basis of Article 8(1) of Brussels I-bis. The question is whether the Court will continue to adhere to the condition for international jurisdiction based on Article 8(1) that the Court set in Roche/Primus, namely that the same factual and legal situation must apply to all defendants.<sup>24</sup>

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<sup>22</sup> C.J.J.C. van Nispen, *Het rechterlijk verbod en bevel*, 2nd completely revised edition, 2025, p. 373, footnote 105.

<sup>23</sup> See also Willem Hoyng in his commentary on the judgment as published on the EPLAW blog, in which he draws an analogy with R.118.2(a) RoP.

<sup>24</sup> ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:457, IER 2006n6, note by R.E.P. de Ranitz, NJ 2008/6, note by P. Vlas (Roche/Primus).

### Question 3: invalidity defence with regard to third countries

11. The number of cases in which Dutch courts have had to rule on infringement of a patent that is valid in a third country is limited.<sup>25</sup> The best-known case concerns the dispute between Stork and CFS Bakel. Stork sought a declaration of non-infringement of an American patent owned by CFS Bakel on two grounds: firstly, that the patent was invalid and, secondly, that its product did not fall within the scope of protection of this patent. The District Court of The Hague declared that it had no jurisdiction to hear the first ground. By analogy with Article 16(4) of the EEX Convention, the court considered that only the American court had jurisdiction to hear questions concerning the validity of the American patent. With regard to the second ground, it was ruled that the Dutch court had international jurisdiction. The case was referred to the District Court of Den Bosch because, according to Article 80 of the ROW 1995, the District Court of The Hague only has jurisdiction to hear the patent disputes referred to therein, namely disputes concerning Dutch and European patents that are in force in the Netherlands.<sup>26</sup>
12. The Court considers that the Brussels I bis system constitutes an internal jurisdiction regime within the European Union that pursues its own objectives, such as the proper functioning of the internal market and the creation of an area of freedom, security and justice. Article 24(4) of Brussels I bis cannot therefore be considered applicable to a situation in which the patents in question have not been granted or validated in a Member State but in a third country. Thus, it cannot confer on a court of a third country – whether exclusive or not – jurisdiction to assess the validity of a patent granted or validated in that country. The Court then assesses whether general international law precludes the court which, on the basis of Article 4(1) Brussels I bis, has international jurisdiction to rule on the infringement in third countries from also having jurisdiction to rule on the invalidity defences raised in respect of the foreign patents in question. According to the Court, only the competent courts of the state in which the patent in question is valid can declare that patent invalid. The court with jurisdiction on the basis of Article 4(1) does have jurisdiction to rule on the arguments for invalidity put forward, on the understanding that the court's decision on those arguments will only apply between the parties concerned.
13. This interpretation is limited only by three special rules, namely Article 73(1) of Brussels I bis (exclusive jurisdiction of the courts of the States party to the Lugano Convention), Article 73(3) of Brussels I bis (exclusive jurisdiction on the basis of a bilateral agreement) and Articles 33 and 34 of Brussels I bis (jurisdiction of the courts of third countries under certain circumstances).<sup>27</sup>
14. In his second opinion on the third question, Advocate General Emiliou concluded that Article 24(4) of Brussels I bis does not apply to the validity of a patent registered in a third country, but that the courts of Member States which have jurisdiction under another rule of that regulation may refrain from ruling on that issue. The judgment does

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<sup>25</sup> See, for example, District Court of The Hague, 8 November 2023, ECLI:NL:RBDHA:2023:16624 (Itrec and Huisman v IHC Holland). In these joined cases, the court declared itself incompetent to rule on patents in force in Brazil, Norway, the UK and the US, but did consider itself competent to rule on the injunction sought as a provisional measure in the infringement case.

<sup>26</sup> District Court of The Hague, 26 May 2004, ECLI:NL:RBSGR:2004:AQ6728, IER 2004/60 with commentary by Ch. Gielen (Stork Titan/CFS Bakel). For the interim judgment in the main action, see District Court of Den Bosch, 13 July 2005, ECLI:NL:RBSHE:2005:AV3615, BIE 2006/9, with commentary by J.H.J. den Hartog.

<sup>27</sup> CJEU 25 February 2025, ECLI:EU:C:2025:108 (*BSH/Electrolux*), paragraphs 63–65.

not indicate that the Court considers that a court which has jurisdiction, for example, on the basis of Article 4(1), may refrain from ruling on the infringement claim based on a patent in force in a third country and on the defences of invalidity raised against it.

#### Possible application by the national court

15. The following comments can be made:

- i. Here too, the patentee no longer has any reason to follow the Supreme Court's decision in *Roche/Primus* in order to prevent the claims relating to third countries from being rejected, by asking the court of the defendant's place of residence to stay the main proceedings until the court of the third country has ruled on the grounds for invalidity relating to the patent in force in that country, because the court of the defendant's place of residence has jurisdiction to rule on these grounds for invalidity in inter partes proceedings.
- ii. With regard to the possibilities for staying the proceedings, we refer to the comments we made above under point viii.
- iii. The defendant may consider initiating invalidity proceedings in the third country concerned. This can be quite costly in certain countries. However, it is not certain that the court which has jurisdiction under Article 4(1) of Brussels I bis and can rule inter partes on the grounds for invalidity relating to the patent in force in the third country will stay the proceedings until the invalidity claim has been decided in the third country concerned. The defendant may therefore not gain much by initiating invalidity proceedings in a third country.
- iv. If the court with jurisdiction under Article 4(1) of Brussels I bis rules inter partes on a defence of invalidity relating to a patent that is in force in a third country, such a decision may become res between the parties if no appeal is lodged (in time). The question is how the court in the third country will deal with such a decision if, for example, the defendant has initiated nullity proceedings in the third country and the res judicata effect of the decision on the nullity arguments is invoked against him. The answer to this question depends on whether that decision can be recognised in the third country. The defendant can prevent the authority of the res judicata from being invoked by having the nullity claim in the third country brought by another party. If the court with jurisdiction under Article 4(1) imposes an injunction in respect of a third country, it can be argued that that injunction is no longer valid if the patent has been declared invalid in that country by the competent court. The question here is also whether it is necessary for the decision of the competent court in the third country to be final and whether the judgment of the court with jurisdiction under Article 4(1) on the grounds for invalidity is binding on the claimant in the invalidity proceedings in the third country (see the previous point). The court with jurisdiction under Article 4(1) may consider imposing a prohibition in relation to the third country subject to conditions, namely on the condition that the prohibition for that third country will cease to have effect from the date on which the competent court of that country has revoked the patent in whole or in part. See point xi above.

## Application by the UPC

16. Now that the international jurisdiction of the UPC is also established in accordance with the rules of Brussels I bis<sup>28</sup>, the ruling in BSH/Electrolux also has consequences for the UPC.
17. The divisions of the UPC are recognised as courts of a Member State pursuant to Article 71b of Brussels I bis. As a result, the courts of the UPC have jurisdiction in cases where the courts of a contracting Member State would have had jurisdiction under Brussels I bis. Article 32 UPCA specifies the subjects on which the participating Member States have given the UPC exclusive jurisdiction. Non-European patents are not mentioned therein. National courts therefore remain competent to rule on infringements of such patents. In certain circumstances, the national court may therefore be a more attractive forum for the settlement of an international patent dispute than the UPC. It should be noted, however, that the UPC applies largely uniform substantive and procedural law. Insofar as the claims are based on infringement of a patent that is valid in another country, the national court will have to apply the law of that other country, which may give rise to discussion as to whether certain matters belong to procedural law (to which the *lex fori* applies) or to substantive law (to which, in the case of infringement claims with a *lex loci* connection to a third country, the law of that third country will apply). This will add to the complexity of the case.
18. Pursuant to Article 4(1) of Brussels I bis, the UPC has jurisdiction to hear infringement claims relating to a European patent that is valid in several Member States of the UPCA, if the defendant is domiciled in a country that is a party to the UPCA and has ratified the UPCA. Where an action for a cross-border injunction is brought which must also extend to, for example, Spain (an EU Member State but not a party to the UPCA), the UPC also has jurisdiction to rule on the infringement in Spain. If the defence is that the patent is invalid in Spain, the UPC does not have jurisdiction to rule on that defence under Article 24(4) of Brussels I bis.<sup>29</sup> Where a claim for a cross-border injunction is imposed that must also extend to, for example, the United Kingdom (not an EU Member State and not a party to the UPCA), the UPC has jurisdiction to rule on the infringement in the United Kingdom and has jurisdiction to rule *inter partes* on a defence that the patent is invalid in that country. See in this regard the ruling of the Mannheim Regional Court in the Fujifilm/Kodak case, in which the Mannheim Regional Court imposed a cross-border injunction for the United Kingdom.<sup>30</sup>

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<sup>28</sup> See Article 31 UPCA. The international jurisdiction of the UPC is determined on the basis of the Brussels I bis Regulation or, where applicable, in accordance with the Lugano Convention.

<sup>29</sup> See, for example, Paris District Court 21 March 2025, UPC\_CFI\_702/2024 (Mul-T-lock/IMC Créations) and Milan District Court 8 April 2025, UPC\_CFI\_792/2024 (Alpinstars/Dainese).

<sup>30</sup> Mannheim District Court 18 July 2025, UPC\_CFI\_365/2023 (Fujifilm/Kodak). Since no invalidity proceedings were pending in the United Kingdom in this case, the UPC ruled that there was no reason to stay the proceedings and, since there was an infringement and the patent was considered valid in the United Kingdom, the UPC imposed an injunction for the United Kingdom. For more information on cross-border injunctions at the UPC, see also Willem Hoyng, Cross border injunctions and the UPC in: Collection in memory of Prof. Antoon Quaadvlieg, Delex 2025, chapter 16.

## Possible consequences of BSH/Electrolux: anti-suit injunctions

19. A legal entity that is sued in proceedings seeking a cross-border injunction, or a group company of that legal entity (e.g. the parent company), could bring an action against the patentee before a court in a third country to obtain a so-called anti-suit injunction ("ASI").
20. In the Boston Scientific/Cook case, Boston Scientific brought summary proceedings seeking a cross-border injunction against various companies belonging to the Cook group, including Cook UK Medical Ltd (in Ireland, 'Cook UK'). Cook UK had brought proceedings against Boston Scientific before the UK High Court and requested, among other things, that an ex parte ASI be imposed on Boston Scientific for the English part of the patent, including a prohibition on continuing the relevant summary proceedings with regard to the United Kingdom. Boston Scientific chose not to defend itself against the ASI and ultimately withdrew its infringement claim for the UK.<sup>31</sup>
21. If an application for an ASI is brought before a court of an EU Member State, the claimant will have to take into account, among other things, the Court's judgment in the case *Turner/Grovit*<sup>32</sup>, from which it follows that Brussels I bis precludes a court of a Member State from prohibiting a party to proceedings before it from bringing or continuing proceedings before a court of another Member State, even if that party is acting in bad faith in order to obstruct the proceedings already pending.
22. The ruling issued by a panel of three WTO arbitrators in a WTO arbitration between the European Union and China is of great importance for the possibility of imposing ASIs.<sup>33</sup> The question in these proceedings was whether ASIs are contrary to TRIPs, which the panel found to be the case. The arbitration concerned a policy of the Standing Committee of the National People's Congress that Chinese courts were expected to follow. According to the panel, this policy meant that ASIs could be issued to prohibit foreign enforcement proceedings based on standard essential patents, on pain of substantial fines, in order to promote certain objectives of Chinese interest. Since the policy was found to be inconsistent with the TRIPs Agreement, this will mean that ASIs granted by courts in accordance with that policy are also inconsistent with the TRIPs Agreement.
23. The panel ruled that the obligation of WTO members under Article 1(1) of the TRIPs Agreement to implement the provisions of the Agreement not only requires WTO members to enact patent legislation, but also "necessarily entails an active and ongoing obligation to ensure that the provisions of the TRIPs Agreement are applied on a permanent basis".
24. The panel was then able to assess whether the policy is contrary to Article 28 of the TRIPs Agreement. Since Article 28(1) stipulates that the purpose of a patent is to prevent third parties from exploiting the patented invention without the consent of the patentee, it prohibits measures that frustrate the enforcement of patents, such as ASIs. Furthermore, ASIs also affect the bargaining position of patentees to conclude licence agreements under Article 28(2). They distort the obligations of holders of standard essential patents and of those who apply such patents to negotiate a licence in good faith; they remove the main incentive for those who apply such patents to negotiate

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<sup>31</sup> Known from *Vzr. Rb. Amsterdam* 3 May 2022, ECLI:NL:RBAMS:2022:2418 (Boston Scientific/Cook).

<sup>32</sup> ECJ 27 April 2004, ECLI:EU:C:2004:228, NJ 2007/152, with commentary by P. Vlas

<sup>33</sup> See the ruling of the WTO arbitration panel of 21 July 2025, case WT/DS611/ARB25.

licences. Therefore, according to the panel, the ASI policy is contrary to both Article 28(1) and Article 28(2) of the TRIPs Agreement. This ruling is not only important for Chinese policy, but also for the possibility of imposing ASIs in general.

Possible consequences of BSH/Electrolux: third-country courts may follow suit

25. Before BSH/Electrolux was handed down, cross-border injunctions in patent cases were imposed almost exclusively by Dutch courts, by way of provisional measures. In our opinion, the BSH/Electrolux ruling should lead judges in other Member States to also impose cross-border injunctions in patent cases where appropriate. Third-country courts could also do so, and the likelihood of this happening may increase if the courts of the EU Member States become less reluctant to impose injunctions in relation to the third country concerned.
26. If judges from EU Member States start to make use of the broad powers offered by Article 4(1) of Brussels I bis to impose a cross-border injunction in relation to a third country and start to impose such injunctions, the interests of that third country may be harmed. It remains to be seen whether a third country will ask the WTO whether imposing a ban on that country on the basis of that broad international power is in line with the TRIPs Agreement.<sup>34</sup>
27. We are curious to see what impact BSH/Electrolux will have on the international enforcement of patent rights.
28. The judgment has also been annotated by Pot<sup>35</sup> and by co-editor Speyart<sup>36</sup>.

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<sup>34</sup> Miquel Montañá, The WTO arbitration decision against China: anti-suit injunctions are dead, long live the long-arm jurisdiction? Kluwer Patent Blog 23 July 2025.

<sup>35</sup> Berichten IE 2025/2, pp. 72-82.

<sup>36</sup> EPLP 2025/3 p. 107 The Practical Consequences of BSH v. Electrolux and Fujifilm v. Kodak