

# 18 International Jurisdiction to Grant an Interlocutory Injunction to Preclude Defendants from Infringing Intellectual Property Rights<sup>(\*)</sup>

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*An Interlocutory injunction is one type of provisional including protective measures. Since it is a provisional measure, the essence of the provisional disposition is considered to take prompt and effective measures. For example, by “Brussels I Regulation: Council regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters,” broader jurisdiction to grant provisional measures is provided than jurisdiction over an action on merits. Here, it is convenient for a rights holder to take provisional measures promptly. However, in international conflicts related to intellectual property rights, if broad jurisdiction to grant interlocutory injunction to preclude defendants from infringing IP rights is allowed, a question arises. Clarifying various characters of the measures by comparing interlocutory injunction to preclude defendants from infringing IP rights with a judgment on merits and other kinds of provisional measures, this study examines the appropriate rules of international jurisdiction to grant interlocutory injunction to preclude defendants from infringing IP rights.*

## I Introduction

In cases where a conflict or a problem concerning intellectual property rights arises and a rights holder attempts to obtain relief through a court, the rights holder may first consider “provisional protective measures” including provisional dispositions. The concepts opposite provisional measures are “measures for the case on merits” or “judgment on merits”; however, it generally takes more time to obtain a judgment on merits than to obtain a provisional disposition.

If there is no direct way to obtain relief in cases of infringement of intellectual property rights, even though a person has a right, it has no practical use. The reason why the TRIPS Agreement or “Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights” (hereinafter referred to as the “Enforcement Order”) in Europe provides minimum rules to be prepared as the content of provisional measures, which is an international trend, is due to the recognition of the considerable importance of obtaining prompt relief in cases of infringement of rights in order for the intellectual property right to be effective as a right.

There are various kinds of provisional measures. The theme of this study is international jurisdiction over “provisional dispositions on injunction of infringement.” I would like to clarify the characteristics of “provisional dispositions on injunction of infringement” by examining them in comparison with other types of provisional measures.

In the following sections, first, the various kinds of provisional measures that can be taken against the infringement of intellectual properties are reviewed from the perspective of comparative laws (in Chapter II) and, second, general rules concerning international jurisdictions in Japan and Europe are reviewed respectively (in Chapter III). I would then like to examine how international jurisdiction over orders of provisional disposition on injunction of infringement is regulated in Europe (in Chapter IV). After reviewing a newly proposed draft on international jurisdiction, etc. over conflicts related to intellectual property based the current situation in Europe (in Chapter V), I will consider the regulation of international jurisdiction over orders of provisional disposition on injunction of infringement in Japan (in Chapter VI).

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## **II Position of Order of Provisional Disposition on Injunction of Infringement**

The order of provisional disposition on injunction of infringement is a kind of provisional measure. What, then, are provisional protective measures? From the perspective of comparative law, there are various kinds of provisional protective measures, and it is not easy to give simple definition. For example, Article 1 of the Civil Preservation Act defines them “(hereinafter collectively referred to as “civil provisional remedies”)” as “A provisional seizure and provisional disposition concerning the subject matter in dispute to preserve the fulfillment of a right claimed as the merits of a civil suit, and a provisional disposition to determine provisional status with regard to a relationship of rights claimed as the merits of a civil suit.” The provisional disposition on injunction of infringement based on an intellectual property right can be included in the “provisional disposition to determine provisional status.”

### **1 Types of provisional measures that can be ordered in cases of infringement of intellectual property rights**

#### **(1) Provisional disposition on injunction of infringement**

The most important provisional measure for conflicts related to intellectual properties is considered to be the provisional disposition on injunction of infringement. Both Article 50 of TRIPS Agreement and Article 9, paragraph (1)(a) of the Enforcement Order stipulate preparation of a provisional disposition to order injunction of infringement as part of the legal system.

#### **(2) Preservation of evidence**

The preservation of evidence is also an essential system for conflicts related to intellectual properties; it is clearly indicated in Article 50 of TRIPS Agreement and the Enforcement Order. Even if a rights holder recognizes the fact that his/her intellectual property right appears to be infringed, in many cases, the specific facts on the infringing person and the extent to which the right is infringed are not clear from the beginning. In cases of filing an action, it is necessary to collect information before deciding against whom the action is to be filed.

As a model of measures for the preservation

of evidence under the Enforcement Order, Article 7 of the Order cites a system of “circumstantial investigation (including seizure of infringed articles if necessary)” that is similar to the French “Saisie-contrefaçon,” which is acknowledged in countries of European Union (EU).

#### **(3) Seizure of infringer’s property**

Article 9, paragraph (2) of the Enforcement Order stipulates that a judicial organization must be able to seize an infringer’s property (movables and real properties) provisionally under the conditions where the infringement is committed on a commercial scale.

## **2 Relationship with judgment on merits**

In addition to the measures listed above, there are other measures that can be categorized as “provisional measures.” What significance does it have to clarify the meaning of “provisional measures”?

First, there is a significance of distinguishing it from a judgment on merits. As assuming the regulation of jurisdiction over orders of preservation separately from the regulation of jurisdiction over an action on merits, (i) the difference between “measures for the action on merits” and “provisional protective measures” and (ii) the meaning of “provisional protective measures” must be clarified.

In this regard, given the Enforcement Order of the EU, although the systems in each country did not become completely uniform after its enforcement, because of this Order, relief for the infringement of intellectual property rights achieved a minimum level of harmonization within the EU area. As a result, in cases where relief for the infringement of intellectual property rights is sought before a court in an EU country, a minimum guarantee is supposedly provided as to the relief, etc. no matter the country in which an action is filed.

## **III International Jurisdiction**

### **1 What is international jurisdiction?**

Generally, the issue of international jurisdiction is an issue to determine which country’s courts can examine and judge a legal case. There are international jurisdictions that conduct proceedings for the case on merits and provide judgments on merits (jurisdiction to

determine the case on merits) and other international jurisdictions that conduct proceedings on the requirements for issuance of requested provisional measures and that issue an order in cases where the requirements are met (jurisdiction to grant provisional measures).

## **2 Rules of international jurisdiction**

### **(1) General rules of international jurisdiction in Japan**

According to judicial precedents, the following rules of international jurisdiction have been established as “reasons” in Japan. This means a rule that, if a forum under the Code of Civil Procedure exists in Japan with respect to the case in question, international jurisdiction is found to be in Japan unless there are special circumstances to deny the international jurisdiction.

### **(2) General rules of international jurisdiction in EU countries**

In EU countries, on the other hand, the rules of international jurisdiction, which applies in cases where a defendant (an obligor) has domicile in one of the EU countries, exist as rules common to all EU countries. This is the Brussels I Regulation: Council regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters.

### **3 Consideration of international jurisdiction over orders of preservation and an element of “effectiveness of the measures”**

Fairness between the parties (obligee and obligor), promptness of procedures, etc. are the points to be considered when examining issues of international jurisdiction over orders of preservation. However, another question to take into consideration is whether other effective provisional measures can be taken.

Under Japanese law, it is stipulated that the existence of jurisdiction should be determined regardless of its enforceability in regular civil dispute cases, from the perspective of the distinction between judgments and enforcement. Can this idea also be applied to cases of international jurisdiction over orders of preservation? As for international

jurisdiction over orders of preservation, the current consensus also considers that the effectiveness of the measures should be regulated regardless of their enforceability, like cases of international jurisdiction over the case on merits. It considers that the issue of effectiveness is a problem to be considered at proceedings on the necessity, etc. of the preservation, but not at the judgment of existence of jurisdiction. However, since multiple options can be found as grounds for jurisdiction over orders of preservation, it is not always contradictory that international jurisdiction over orders of preservation is not denied even if effective measures cannot be taken and that international jurisdiction over orders of preservation is found with a court in a place where effective measures can be taken. In the following sections, on the assumption of the abovementioned, the regulations of jurisdiction over orders of preservation under the Brussels regime in Europe (the Brussels Convention and Brussels I Regulation) will be reviewed first.

## **IV Rules for International Jurisdiction over Orders of Provisional Disposition on Injunction of Infringement in Europe**

### **1 General jurisdiction to grant provisional measures**

Article 31 of the Brussels I Regulation (Article 24 of the Brussels Convention) stipulates, “Application may be made to the courts of a Member States for such provisional , including protective, measures as may be available under the law of the State, even if, under this Regulation, the courts of another Mamber State have jurisdiction as to the substance of the matter.” The content of this provision is very abstract, therefore, with regard to Article 24 of the Brussels Convention (which is almost the same content as Article 31 of the Brussels I Regulation), prior judgment has been requested of the Court of Justice of the European Community in order to clarify the interpretation several times. The Van Uden case<sup>(\*)</sup> is considered to be a leading case that contributed to the clarification of the rules of jurisdiction over orders of preservation set forth in Article 24 of the Brussels Convention, among those prior judgments.

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(\*) Van Uden Maritime BV v Firma Deco-Line and Another, ECJ C-391/95 (Judgment of November 17, 1998), ECR I-7091.

**(1) Interpretation of Article 24 of the Brussels Convention in the prior judgment of the Van Uden case**

The following two points should be cited particularly here as the content of the prior judgment in the Van Uden case. First, it declared that jurisdiction over orders of preservation is found both with “the court of a country that has jurisdiction over an action on merits” and “the court of a country that has no jurisdiction over an action on merits” under the Brussels Convention. Second, it clarified that a certain restriction is imposed with regard to jurisdiction over orders of preservation with “the court of a country that has no jurisdiction over an action on merits.”

**(2) Jurisdiction to grant provisional measures of “the court of a country that has jurisdiction over the action on merits”**

First, according to the Court of Justice of the European Community, “jurisdiction over the action on merits” means jurisdiction over the action on merits as defined by the Brussels Convention. In cases where the jurisdiction is based on the grounds for jurisdiction that are specified as “exorbitant jurisdiction” by Article 3, paragraph (2) of the Brussels Convention (such as, the jurisdiction of the location of property, the jurisdiction of the plaintiff’s domicile, etc.), it does not fall under “jurisdiction over an action on merits” as used here, even if the law of the host country justly provides a basis for jurisdiction over an action on merits.

**(3) Jurisdiction to grant provisional measures of “the court of a country that has no jurisdiction over an action on merits”**

What, then, does the case of “having no jurisdiction over an action on merits” mean?

**(i) Cases of “having no jurisdiction over an action on merits”**

As courts that “have no jurisdiction over an action on merits,” there are courts that can conduct proceedings on merits if there is no agreement on an exclusive jurisdiction or arbitration agreement between parties, and other courts in cases where an action on merits is pending with one court out of the multiple courts that have jurisdiction over an action on merits.

**(ii) Meaning of “real connecting link”**

According to the prior judgment in the Van Uden case, whether the court of a country “that has no jurisdiction over an action on merits” can grant a provisional measure or not depends on the existence of “true relativeness” between “the subject-matter of the measures sought and the territorial jurisdictional of the Contracting State of the court before which these measures are sought.”

There may be arguments over the judgment of the existence of “real connecting link” in individual cases. When examining how the requirements for “real connecting link” are applied in relation to various provisional measures, it is necessary to review the purpose of Article 24 of the Brussels Convention (Article 31 of the Brussels I Regulation) that stipulates that jurisdiction over orders of preservation is found to sit with the court of a country that has no jurisdiction over an action on merits only in certain cases.

**(a) Promptness and effectiveness**

First, it is considered that Article 24 finds jurisdiction over orders of preservation broadly based on the “necessity” to take provisional measures promptly and effectively.

**(b) Capability of appropriate judgment on setting conditions for provisional measures, etc.**

The court that receives a petition is required to disseminate the actual conditions under which requested measures will have effect, and it must be capable of granting of provisional measures under suitable conditions in order to ensure the tentativeness of the measures. Therefore, it is possible to understand the requirement of “real connecting link” as meaning that the jurisdiction to grant provisional measures is provided with the court that can set conditions appropriately.

**(iii) Interpretation of “real connecting link”**

For example, in cases of asset-freeze orders in England as a kind of provisional measure, if an obligor is in England, it is possible to say that that fact alone becomes a reason for a court in England to have “true relativeness” from perspective of effectiveness. However, there are arguments over whether it is necessary and sufficient, whether the “true relativeness” cannot be found in other cases, etc.

What, then, will happen with international jurisdiction in cases of orders of provisional disposition on injunction of infringement?

## **2 International jurisdiction over orders of provisional disposition on injunction of infringement**

### **(1) Characteristics of orders of provisional disposition on injunction of infringement**

When considering the characteristics of orders of provisional disposition on injunction of infringement, it is necessary to review the proceedings and requirements for their issuance, and the method of enforcement.

#### **(i) Proceedings for granting provisional measures**

Provisional dispositions on injunctions of infringement as provisional measures are measures taken by an easier procedure than action on merits generally. The Enforcement Order provides that *ex parte* provisional dispositions on injunctions of infringement are also permitted (Article 9, paragraph (4)).

#### **(ii) Effects of measures**

Unlike orders of injunction of infringement as judgment on merits, a provisional disposition on an injunction of infringement is a temporary measure until the final settlement is given by an action on merits. However, a general trend can also be seen in some countries to facilitate final settlement by means of a provisional disposition without starting an action on merits. In this regard, the Enforcement Order stipulates that, in cases where an action on merits is not filed within a reasonable period, the provisional disposition on injunction of infringement must be canceled or it loses its effectiveness following a petition by the obligor (Article 9, paragraph (5)).

#### **(iii) Method of enforcement**

With regard to provisional dispositions on injunctions of infringement, an “infringer” is ordered into a certain inaction by a court. The effectiveness of this type of provisional measure is generally secured by a method of “indirect compulsory execution” from the perspective of comparative law. However, some countries do not have a system of “indirect compulsory execution” and there are differences between the kind of “indirect compulsory execution” of different countries.

## **(2) International jurisdiction over orders of provisional disposition on injunction of infringement and the scope of the order**

According to abovementioned characteristics of provisional dispositions on injunction of infringement, in what cases can international jurisdiction be found and what is the scope of the order issued?

#### **(i) Scope of an order by a court in a country that has jurisdiction over an action on merits**

##### **(a) Jurisdiction over the domicile**

In principle, various kinds of actions can be filed against a defendant in the country that contains said defendant’s domicile (Article 2, paragraph (1) of the Brussels I Regulation, and Article 2, paragraph (1) of the Brussels Convention). With regard to cases of infringement of intellectual property rights, the court of the country housing the domicile of an “infringer,” who becomes a defendant, has jurisdiction over an action on merits. The court of the country with the domicile of an infringer has international jurisdiction broadly with respect to cases of preservation when said infringer is an obligor, and may take measures in relation to persons and properties outside the territory.

##### **(b) Jurisdiction over the place of torts**

Article 5, paragraph (3) of the Brussels I Regulation (Article 5, paragraph (3) of the Brussels Convention) stipulates jurisdiction over the place of torts. The infringement of intellectual property rights is also construed to be a kind of tort, and it is therefore possible to file an action against infringement of intellectual property rights with the court of the country that has jurisdiction based on Article 5, paragraph (3) of the Brussels I Regulation. However, unlike cases of jurisdiction over the domicile, with regard to the scope of where the court with jurisdiction over the place of torts can conduct proceedings or render a judgment with respect to infringement of intellectual property rights, there is a certain restriction imposed based on the interpretation of a prior judgment in the case of *Shevill*<sup>(\*2)</sup> by the Court of Justice of the European Communities or from perspective of the territoriality of intellectual property rights.

##### **(c) Subjective joinder**

In many cases where infringements of intellectual property rights in multiple countries (jointly) come into question, multiple “infringers”

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(\*2) *Fiona Shevill, Ixora Trading Inc., Chequepoint SARL and Chequepoint International Ltd v Presse Alliance SA.*, ECJ Case C-68/93 (Judgment of the Court of 7 March 1995), ECR I-415.

are involved. Therefore, Article 6, paragraph (1) of the Brussels Convention was a very convenient provision for rights holders by providing a means to settle the infringement of intellectual property rights in multiple countries jointly. In this regard, courts in Holland were spotlighted by issuing an order of injunction of infringement of parallel patent rights jointly in multiple countries in Europe (cross border injunction) through prompt procedures, called kort geding procedures. Generally, they found jurisdiction with themselves based on Article 2 and Article 6, paragraph (1) of the Brussels Convention.

However, the Court of Justice of the European Communities indicated an interpretation in the prior judgment in the case of Roche Nederland<sup>(\*3)</sup> in 2006 that denied the application of Article 6, paragraph (1) of the Brussels Convention to a case of infringement of patent rights in multiple countries in Europe.

(ii) **Scope of orders by the court of a country that has no jurisdiction over an action on merits**

Even if it is a court of a country that has no jurisdiction over an action on merits, if there is “true relativeness” to the subject of the provisional measures and the court that accepts the petition of the measures, the court is found to have jurisdiction over the order of preservation (prior judgment of the Court of Justice of the European Communities in the case of Van Uden). As an interpretation of the requirements for this “true relativeness,” the standpoint that construes that the provisional measures by a court of a country that has no jurisdiction over an action on merits shall be limited to the territory of the country issuing the order is also dominant. However, as mentioned above, it can be construed that if the requirements for “true relativeness” are established for the purpose for making the court take effective measures in the issuing country and to make the court impose appropriate conditions for judgment, it is impossible to prevent the effect of the order of preservation from exerting influence outside the territory, even if the execution of the preservation is limited to the territory. This is because, with regard to the category of measures that secure the effectiveness of measures by the method of indirect compulsory execution, the place to execute the preservation

and the scope of the effect of the provisional measures do not match. However, it is another question altogether whether the effect outside the territory is approved by countries other than the country issuing the order.

### **3 Provisional dispositions on injunctions of infringement and allegations of invalidity of the right**

In 2006, in the prior judgment in the case of GAT<sup>(\*4)</sup>, the Court of Justice of the European Communities indicated an interpretation that the exclusive jurisdiction prescribed in Article 16, paragraph (4) of the Brussels Convention (Article 22, paragraph (4) of the Brussels I Regulation) must be construed to be applied to any procedures concerning patent registration and its effectiveness.

If this judgment is understood literally, “any procedures concerning patent registration and its effectiveness” include procedures for orders of preservation. If a person who is considered to be an “infringer” brings a suit against the effectiveness of a foreign patent, it will be interpreted that a court other than the court in the state of registry of said patent right cannot continue the procedures for an order of preservation. If so, it is possible to restrict drastically the cross border injunctions taken as provisional measures to order the injunction of infringement of foreign intellectual property rights.

Jurisdiction over orders of preservation does not come into question itself in the case of GAT. Consequently, with regard to the relationship between provisions of exclusive jurisdiction under the Brussels Regime and jurisdiction over orders of preservation, it is necessary to wait for future judgments of the Court of Justice of the European Communities.

## **V Rules of Jurisdiction to grant provisional measures, etc. under the CLIP Principle**

### **1 Jurisdiction to grant provisional measures under the CLIP principle**

Both the Brussels Convention and the Brussels I Regulation, which is a European Community Regulation established on the basis of

(\*3) Roche Nederland BV and others v Frederick Primus, Milton Goldenberg, ECJ Case C-539/03 (Judgment of 13 July 2006), ECR I-6535.

(\*4) Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG, ECJ Case C-4/03,

the former, target general civil and commercial cases, and, in particular, they do not always establish the best rules for jurisdiction over cases related to intellectual property rights. Therefore, because the regulations of jurisdiction over cases related to intellectual property rights is unclear or is the cause of problems even in the EU, rules for jurisdiction, governing law, approval, and execution focused on cases related to intellectual property rights (CLIP principle) have been newly proposed<sup>(\*5)</sup>.

Basically, the provisions on jurisdiction over orders of preservation under the CLIP principle (Article 2:501) follow the directions indicated by the prior judgment in the case of Van Uden by the Court of Justice of the European Communities. Paragraph (1) finds jurisdiction over orders of preservation with “the court of a country that has jurisdiction over an action on merits” and paragraph (2) finds jurisdiction over orders of preservation also with “the court of a country that has no jurisdiction over an action on merits” in certain cases. It is interesting that items (a) and (b) that are listed as cases where even the court of a country that has no jurisdiction over an action on merits as set forth in paragraph (2) has jurisdiction over orders of preservation. These are considered to have shaped the requirements for “true relativeness” that are indicated by the prior judgment of the Court of Justice of the European Community in the Van Uden case.

## **2 Type of provisional measures under the CLIP principle**

A more interesting point with the CLIP principle is that examples of specific provisional measures (items (a) through (e)) are listed after the definition of “provisional protective measures” in Article 2:401, paragraph (3).

## **3 Recognition of of foreign orders of preservation under the CLIP principle**

As mentioned above, the CLIP principle finds jurisdiction over orders of preservation not only with “the court of a country that has jurisdiction over an action on merits,” but also with “the court of a country that has no jurisdiction over an action on merits.” Unlike orders of preservation by the former court, orders of preservation issued by the latter court cannot be approved in other countries (Article 4:301 (1)).

# **VI Rules of International Jurisdiction over Orders of Provisional Disposition on Injunction of Infringement in Japan**

## **1 Article 12 of the Civil Preservation Act**

Legal conditions in European countries have been reviewed. Now, regulations of international jurisdiction over provisional dispositions on injunctions of infringement under Japanese laws will be reviewed. After considering the trends in Europe, I would like to examine the rules in Japan as a legislative discussion.

According to the rules established by the judicial precedents in Japan with respect to international jurisdiction over regular civil actions, in cases where jurisdiction under the Code of Civil Procedure exists in Japan over said case, international jurisdiction is found with courts in Japan over the case in principle. If there are special circumstances, the jurisdiction is, by exception, denied. There is a judicial precedent with lower instance courts to judge the existence of international jurisdiction based on the same idea as cases of petitions for orders of preservation.

As rules for jurisdiction over orders of preservation in domestic cases in Japan, the following provision is established in Article 12, paragraph (1) of the Civil Preservation Act:

“A case of order of preservation shall be under the jurisdiction of the court with jurisdiction over the case on the merits or the district court having jurisdiction over the location of the property to be provisionally seized or the subject matter in dispute.”

## **2 International jurisdiction over a case of application for provisional disposition**

### **(1) In cases where jurisdiction over the case on merits is found with a court in Japan**

If the general forum of a defendant (obligor) is in Japan, international jurisdiction with a court in Japan will be found without any problem for an action on merits or for a case of application for provisional disposition.

With regard to the jurisdiction over the place of torts, if plausible reasons are provided for the objective facts of infringement of intellectual

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(\*5) CLIP European Max-Planck Group for Conflict of Laws in Intellectual Property, “Exclusive Jurisdiction and Cross-Border IP (Patent) Infringement”, (2007) EIPR 195. The second draft of this proposal is available from the

property rights and the place of infringement of the intellectual property rights or the place where the results of the infringement are generated is in Japan, it is considered that international jurisdiction is found with a court in Japan over either a case on merits or a case of provisional disposition.

**(2) In cases where jurisdiction over the case on merits is not found with a court in Japan**

With regard to a case of petition for provisional disposition to determine a provisional status, there was a ruling of the Tokyo District Court on August 28, 2007<sup>(\*6)</sup> (unrelated to intellectual property) on a case where jurisdiction over an order of provisional disposition was not found with a court in Japan since it was not a “court with jurisdiction over the case on merits.” This ruling judged that, with regard to cases where there is an arbitration agreement, “it is reasonable to interpret that” a “court with jurisdiction over the case on merits” “does not include a court that could have jurisdiction over an action on merits if there was no arbitration agreement.” Based on this judgment, in cases where there is an agreement to grant exclusive jurisdiction to a foreign court, a court that could have jurisdiction over an action on merits if there was no agreement on jurisdiction is not included in the “court with jurisdiction over the case on merits” set forth in Article 12, paragraph (1) of the Civil Provisional Remedies Act.

Theoretically, it is common that jurisdiction over orders of provisional disposition is found for the location of the subject matter in disputes prescribed in Article 12, paragraph (1) of the Civil Provisional Remedies Act and also with respect to the provisional disposition to determine provisional status. The ruling of the Tokyo District Court on August 28, 2007 stated that “The petition in question does not seek to order a provisional seizure or provisional disposition concerning property. Therefore, “the district court having jurisdiction over the location of the property to be provisionally seized or the subject matter in dispute” prescribed in said paragraph does not become a court with jurisdiction over the case.” And the judgment construed that jurisdiction over orders of preservation is found with the court of the country containing “the place of the subject matter in dispute” only in cases of provisional disposition on the subject

matter in dispute.

### **3 Legislative discussion**

**(1) Jurisdiction over provisional dispositions on injunctions of infringement with a court of a country that has no jurisdiction over the case on merits**

The issue that the ruling of the Tokyo District Court on August 28, 2007 raises is whether there is a court with jurisdiction over provisional dispositions to determine provisional status other than the “court with jurisdiction over the case on merits.”

In this regard, there is also a standpoint that construes the concept of “the location of the subject matter in dispute” broadly and finds international jurisdiction over provisional dispositions to determine provisional status with “the location of the subject matter in dispute” in addition to the “court with jurisdiction over the case on merits.” It is possible to include a location where the infringement, which is subject to injunction, is performed in the “location of the subject matter in dispute”; however, it is difficult to include the domicile of an obligor in the concept of the “location of the subject matter in dispute.” Under Japanese law, for example, in cases where the prohibition of manufacturing certain products is issued as “provisional disposition to order inaction,” if the obligor does not follow the order voluntarily, an obligee may apply for indirect compulsory enforcement. Indirect compulsory enforcement under Japanese law is executed in the form of an order to the obligor to pay money so that it becomes effective if it is ordered at the main place of the obligor’s life and activity. If so, from the perspective of effectiveness, it is reasonable to find jurisdiction over orders of provisional disposition with the domicile of the obligor.

In conclusion, it is appropriate to find international jurisdiction over provisional dispositions on injunction of infringement with the court of a country that has no jurisdiction over the case on merits, with (i) the country where the infringement subject to the injunction is performed (or the country that protects the intellectual property rights being infringed) and (ii) the country of the obligor’s domicile, regardless the concept of the “location of the subject matter in dispute.”

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(\*6) Tokyo District Court ruling of August 28, 2007, H19(*yo*)No.20047, *Hanrei Jiho* No.1991, p.89, *Hanrei Times* No.1272, p.282.



## **(2) Conditions to be set with the provisional disposition on injunction of infringement**

If courts which do not have jurisdiction as to the substance of the matter can have jurisdiction to grant provisional measures and if the proceedings for provisional measures and those as to the substance of the matter are held by courts of different States, it is highly possible that inconsistent judgments will be given in these procedures. In cases where contradictory judgments are given in the procedures for provisional measures and in the action on merits, if the effects of the proceedings or orders of the provisional protective procedures are closer to the effect of the proceedings or judgment of the action on merits, the demerits, such as the impact on the obligor, can become bigger. Therefore, since jurisdiction to grant provisional measures is regulated separately from the jurisdiction over the case on merits, it is necessary to prevent provisional measures to become almost like a final solution. It is possible to prevent such results by adding the appropriate conditions in a court to give provisional protective dispositions, by keeping the provisional measures only “provisional” or “temporary.”

These ideas are not new, but have been indicated as a direction in the abovementioned Van Uden case. However, the following points should be examined separately: what is sought in the case of Van Uden is a typical type of measures, such as provisional dispositions on monetary payment; and the issue particularly focused on in this report is the provisional disposition for injunction of infringement of intellectual property rights that requires expert and technical proceedings and judgments.

## **VI Conclusion**

Including provisional dispositions on injunctions of infringement based on the intellectual property rights, it is possible to say that there is an international wave of agreement to find international jurisdiction over orders of preservation with the courts of a country that has no jurisdiction over the case on merits. And a court that has no jurisdiction over the case on merits, but has jurisdiction over orders of preservation is generally a court in a location where measures can be taken effectively, such as the place where the measures are executed, etc. In Japan, it is appropriate to find international jurisdiction over provisional dispositions on injunctions of infringement based on intellectual

property rights with a court other than “the court with jurisdiction over the case on merits” in certain cases. However, if it is regulated in this direction, it is necessary to review the methods of proceedings and effects in cases of judging the injunction of infringement in the form of a provisional disposition and to clarify role sharing between provisional measures and the judgment on merits.