

# 18 Cross-border Injunctions to Preclude Defendants from Infringing Intellectual Property Rights<sup>(\*)</sup>

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*International injunctions can be issued in a legitimate manner in intellectual property right infringement cases. However, there are quite many unsolved problems, such as the geographical scope of an injunction and enforcement thereof, in addition to the issue of international jurisdiction that generally becomes a problem in transnational intellectual property right infringement cases. Whether a court can grant a cross-border injunction is not only related to whether the court has international jurisdiction. However, discussion has been held on the issue of to what extent international jurisdiction is recognized, in determining a demand for a cross-border injunction, particularly in Europe, due to the existence of the Brussels I Regulation and the Lugano Convention, on the premise that judgments rendered by courts whose jurisdiction was based on the provisions set in said Regulation or Convention are relatively easily recognized/enforced in other countries. The situation in the United States is different from the situation in Europe. In this study, we first overviewed the cases in which a cross-border injunction could be sought, and then considered cross-border injunctions by focusing mainly on international jurisdiction and the ways of recognizing/enforcing foreign judgments.*

## I Introduction

Article 44 of the TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights)<sup>1</sup> stipulates that “1. The judicial authorities shall have the authority to order a party to desist from an infringement,” thereby obliging its members to develop domestic law to make it possible to take an injunction through the judicial authorities as an effective measure against an infringement of an intellectual property right.<sup>2</sup> However, this provision does not specify such matters as the extent to which the judicial authorities should have the authority to grant an injunction.

Many studies have been conducted on the discipline of international intellectual property right-related cases, in particular, international jurisdiction and the issue of recognition /enforcement of judgments in general, both in Japan and abroad in recent years.<sup>3</sup> However, it seems that there have been relatively few studies focusing attention on a specific type of remedies, that is, international jurisdiction. Therefore, in this study, we tried to consider a desirable discipline of international injunction in intellectual property right infringement cases. For the discipline of international injunction, the issue of international jurisdiction, that is, which country's

court can examine/determine the existence of infringement of an intellectual property right, etc., is relevant, but beyond that, the rules of enforcement of cross-border injunctions are important. Unlike the enforcement of monetary judgments such as orders to pay damages, that of injunctions, which are non-monetary judgments, seems to involve many unsolved problems. Possible types of enforcement of cross-border injunctions are, firstly enforcement in a country to which the court that has granted the injunction belongs, and secondly enforcement of injunctions or other measures in the countries other than the country of the court that granted the injunction or measures.

## II Various Types of Transnational Intellectual Property Right Infringement Cases and Background Thereof

### 1 Cases of Transnational Intellectual Property Infringement

It is submitted that Europe and the United States, in the first place, differ in the types of situations on which courts and academics have discussed whether a court can issue a

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“cross-border injunction” in intellectual property right infringement cases, particularly, in patent infringement cases. That is, what has mainly attracted attention in Europe is an issue of whether a court in country B can issue an injunction against infringement of an intellectual property right registered in country A. On the other hand, what has mainly been discussed in the United States is about injunctions against the acts that infringe U.S. intellectual property rights outside the territory of the United States.

We can give some other sub-categories of cases of cross-border intellectual property infringement as well as those in the U.S. and in the EU. Although the classifications are not exclusive each other and might overlap in some cases, it seems that the following four or five types of transnational infringement can be assumed.

**(1) Where a person based in country B infringes a patent right registered in country A in country A (ex. the GAT case)**

The first type is the orthodox case of infringement of country A's patent right<sup>4</sup> in the territory of country A in which the base (or address) of the “infringer” is located in a country other than country A (for example, country B). In this case, if most of the infringer's property is at the place of its address, the patentee might choose to file a lawsuit to seek an injunction against the infringement, etc. in the place of the infringer's address in consideration of convenience in the subsequent enforcement stage. In that case, the court in country B can be required to examine<sup>5</sup> the existence of infringement of the patent right under the law of country A, which is another country, and to determine whether to issue an injunction against the act of infringement in country A.

On the contrary, if the patentee files a lawsuit in country A, it is only necessary for the court in country A to examine/determine infringement of the patent right registered therein. Therefore, there seems to be little difficulty in that point. However, where an injunction is issued after the infringement is found, the way of enforcing the injunction against the company in country B which does not have property in country A<sup>6</sup> can be a problem.

**(2) Where multiple infringers individually infringe any parallel patent rights in countries where the relevant patent rights have been registered (ex. the Roche Netherland case)**

The second type is the case where, for X's parallel patents in multiple countries (for example, country A, country B, and country C), Y1 individually infringes a patent right in country A, Y2 individually infringes a patent right in country B, and Y3 infringes a patent right in country C, and Y1, Y2, and Y3 are companies that belong to the same corporate group. X often wishes to bring one lawsuit against all infringers (Y1, Y2, and Y3) to seek injunctions against infringement of all the patent rights, for example, before a court in country A instead of starting multiple lawsuits in multiple countries.

If such a lawsuit is filed, firstly it is necessary to determine the existence of international jurisdiction over infringement of foreign patent rights, that is, whether the court in country A is found to have international jurisdiction over a lawsuit against multiple defendants including foreign companies.<sup>7</sup> Secondly, if the court in country A grants an injunction, the way of enforcing the injunction, in particular, against foreign companies will be an issue in the same manner as the first type of transnational intellectual property cases.

**(3) Infringement of a unified intellectual property right in multiple countries**

An example of the third type is the case where a Community trade mark is infringed in multiple Member States of the European Union (E.U.). The Council Regulation on the Community Trade Mark<sup>8</sup> for Community trade marks stipulates detailed rules. Therefore, it is possible to say there are few interpretational problems. However, there remain unclear points concerning the geographical scope of an injunction and its enforcement.

**(4) Where it is not easy to locate the “place of infringement”**

The fourth type is the case where it is not easy to locate infringement or the place of infringement in a specific country. Cases of infringement of an intellectual property right in an individual country through activities on the Internet and cases where multiple persons based in different countries are involved in the respective part of elements that constitute infringement of an intellectual property right are considered to fall under this type.

**2 Infringement on the Internet**

Some technical specificity of infringement on

the Internet obliges us to deal with that type of infringement differently from other types, for instance, as to the way of regulating it, enforcement of judgments, etc. The judgment by the French Court of Cassation in *Roederer*<sup>9</sup> case will give us enough hints.

### **3 Background of Various Cases regarding Transnational Intellectual Property Infringement**

As the background behind such difference in transnational intellectual property infringement cases, there are differences in systems of intellectual property law and differences in judicial frameworks.

First of all, the cases discussed differ significantly between in Europe and in the United States. Cross-border injunctions against infringement of foreign intellectual property rights were lively discussed, in particular, in Europe, due to the existence of the Brussels /Lugano regime for international jurisdiction and enforcement of foreign judgments.<sup>10</sup> In fact, some courts in European countries have granted cross-border injunctions mainly within European countries based on the understanding that courts can examine/determine infringement of foreign intellectual property rights to a certain extent under said rules. Secondly, even within the E.U., handling of infringement cases can differ depending on whether a right infringed is a unified intellectual property right (within the region) like a Community trade mark or a right that takes its stand on the principle of “territoriality” of intellectual property.

In the following sections, we will see an overview of different intellectual property systems and judicial frameworks for remedies regarding infringement of intellectual property rights.

## **III Legislation in the E.U.**

### **1 Community Trade Mark**

In the E.U., the situation differs between the legal system for trademarks and that for patent rights. For trademarks, there is a Community-level unified<sup>11</sup> trademark right system. It is the Community trade mark system<sup>12</sup> which is disciplined by the Council Regulation on the Community Trade Mark.<sup>13</sup>

Community trade marks are to have equal effect<sup>14</sup> throughout the Community. The construction of some provisions of the Council

Regulation on Community Trade Mark, including the article that stipulates that “a Community trade mark court shall (.....) issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark,” are getting clarified by the European Court of Justice (ex. *Nokia case*<sup>15</sup>, *Chronopost v DHL case*<sup>16</sup>).

### **2 European Patent**

A system for unified rights throughout the E.U. like Community trade marks has yet to be established in the field of patent.<sup>17</sup> Although there is a system of “European patent” that is based on the European Patent Convention of which contracting states are not limited to the Member States of the E.U.,<sup>18</sup> a patent obtained through filing an application with the European Patent Office is, in reality, nothing more than a bundle of patent rights in multiple countries which the applicant has designated at the time of filing.

The point that a European patent is not a unified right throughout the E.U. has a significant meaning in terms of the trend of European patent infringement lawsuits. It could be that, as long as a European patent is not a unified right, even if multiple parallel patent rights that are based on the European Patent Convention are concurrently infringed, there is no need for the results of court proceedings for infringements of those parallel patent rights to be unified. In fact, for the case where multiple parallel patent rights obtained through the European Patent Convention were infringed respectively by multiple companies, the aforementioned preliminary ruling of the European Court of Justice on the *Roche Nederland case* presented an interpretation that the patentee cannot file a lawsuit for all infringements with the court in the Netherlands on the basis of the provision of *subjective* joinder of actions in Article 6(1) of the Brussels Convention.

## **IV Legislation in Each Country**

### **1 Member State of the E.U.—France**

France is one of the Member States of the E.U. As overviewed in the previous Chapter, the situation differs between the field of patent right and the field of trademark right. Therefore, cases are overviewed below while dividing them into patent right infringement cases and trademark

right infringement cases.

## **2 Switzerland**

Although Switzerland is not a Member State of the E.U., it is a contracting state of the European Patent Convention and is also a contracting state of the Lugano Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters<sup>19</sup> (hereinafter merely called the “Lugano Convention”).

## **3 The United States**

The United States is neither a contracting state of the European Patent Convention like Switzerland nor a contracting state of a convention that mutually facilitates the recognition/enforcement of foreign court judgments in relation to many European countries like the Lugano Convention. Consequently, there are problematic situations that are different from those in France and Switzerland in terms of judgments issuing international injunctions in intellectual property right infringement cases and enforcement of international injunction. The *Voda v. Cordis* case<sup>20</sup> and court precedents thereafter attract attention.

## **V Matters to Be Considered Regarding International Injunctions**

As seen above, where jurisdiction is based on the existence of the defendant’s address within the country of forum, the scope of jurisdiction is extensively recognized beyond the territory of the country of forum unless taking a stance like that in the aforementioned U.S. court precedent. Then, is the court having jurisdiction that is not limited in terms of territory able to examine an infringement overseas and issue an injunction internationally as long as the fact of infringement of an intellectual property right is recognized? In addition, even if the court is legally granted the authority, has it actually issued international injunctions?

### **1 Injunctions against Infringements on the Internet and Injunctions against Infringements in Real World**

#### **(1) Parties**

Quite a number of lawsuits to seek an injunction against infringement on the Internet are filed against Internet service providers.<sup>21</sup>

Although whether to file such a lawsuit while naming only an Internet service provider as the defendant depends on the situation, according to Professor Muir Watt, etc., people tend to file lawsuits mainly targeting Internet service providers that have property in the country of forum or have made profits in the country of forum rather than targeting the possessors or creators of marks or wordings that fall under infringement. That is because it looks more effective to stop infringement.<sup>22</sup>

#### **(2) Effectiveness of injunctions**

Even understanding infringements on the Internet as those that can be disciplined basically in the same manner as infringements in real world without considering them to be completely different,<sup>23</sup> they also have differences. One of the differences is a technical difference concerning infringement. Due to the structural and/or technical mechanism of the Internet, infringement on the Internet can occur easily internationally. On the other hand, there is a view that, where the court of a country issues an injunction against infringement on the Internet, it is also technically easy to secure the enforcement of the injunction by addressing the injunction to an intermediary, etc. that maintains the site.<sup>24</sup>

## **2 Recognition/Enforcement of Injunctions Issued by Foreign Courts**

### **(1) Difference from recognition/enforcement of monetary judgments**

It seems that there are generally differences between monetary judgments, such as orders of compensation of damages, and non-monetary judgments such as injunctions. Firstly, it can be said that the content of injunction is more wide-ranging than monetary judgments. Secondly, they differ in the ways of enforcing in the cases where an addressee of an order does not voluntarily obey to the order a judgment. Thirdly, special treatment has been traditionally admitted for an injunction that is a remedy classified as that in the field of “equity” measure, in particular, in common law countries.<sup>25</sup>

### **(2) Tendency of recognition/enforcement of foreign non-monetary judgments**

It needs to be studied whether the ways of recognition/enforcement of foreign monetary judgments and those of foreign non-monetary judgments are generally distinguished or not.

### **(3) Facts after granting an injunction**

After a court granted an injunction to preclude a defendant from infringing an intellectual property right, the defendant sometimes changes his conduct or products only a little bit and insists that he obeyed the injunction. How a foreign court can react to such new facts when the enforcement of the injunction is demanded? That can also be an issue.

### **3 Measures to Secure Effectiveness**

The issue of measures to secure effectiveness can be understood as a matter that belongs to compulsory enforcement in a sense. It has also been considered that, as long as enforcement competence belongs exclusively to the country to which the place of enforcement belongs under public international law,<sup>26</sup> enforcement by the organ of a country is limited, in principle, within the territory of the country. On the other hand, on the premise of the interpretation that the issue of enforcement competence under public international law is limited to the execution of physical binding power, the following point of view has also been prevailing recently: As long as a measure to secure effectiveness is a sort of normative thing at the stage of its being ordered by the court, it cannot be said that an order concerning a measure to secure effectiveness is limited within the territory of the country that has issued the order.<sup>27</sup>

#### **(1) Types/characters of measures to secure compliance**

“Measures to secure compliance” provided for in the second sentence of Article 102(1) of the Council Regulation on the Community Trade Mark are based on the domestic law of a Member State of the E.U. in which the Community trade mark court that issues an injunction is located. Therefore, measures that are taken as “measures to secure compliance” differ depending on the country.

#### **(2) Recognition/enforcement of measures to secure compliance**

According to Ms Marketa Trimble, who has analyzed cross-border injunctions issued by U.S. courts in patent infringement cases, where the defendant is neither based in the United States nor has any property in the United States, there are two possible ways of making effective a cross-border injunction. One is to request the court of a foreign country for the recognition/enforcement of the cross-border injunction itself, and the other is to obtain a contempt order from the U.S. court

and request the recognition/enforcement of the contempt order in a foreign country.<sup>28</sup>

Can measures which a court has taken to secure compliance with its injunction be recognized/enforced in other countries, in addition to the recognition/enforcement of the injunction? As mentioned above, there are various kinds of measures to secure compliance with court orders. Therefore, handling seems to be not identical.

#### **(i) Legislation in the E.U.**

Article 49 of the Brussels I Regulation provides that *astreinte* (periodic payment) ordered by a foreign court shall be enforceable in certain cases (where the amount of the payment has been “finally determined” by the court of a Member State of the E.U. that had ordered the *astreinte*)<sup>29</sup>.<sup>30</sup>

#### **(ii) Recognition/enforcement of a contempt order in the United States**

In the case in which recognition/enforcement of both a judgment on the merits based on the infringement of a trademark right and a judgment of a contempt order, both of which were rendered by the U.S. court, was requested in Canada in 2006,<sup>31</sup> the Supreme Court of Canada determined that enforcement of the contempt order issued by the U.S. court is not permissible. One of the reasons thereof was that judgments of contempt orders are always considered to have a criminal nature in Canada and that judgments of contempt orders are not enforceable as long as foreign criminal judgments are not recognizable/enforceable in Canada.<sup>32</sup> Even if civil and criminal contempt orders are distinguished in the United States, the definition of nature in the United States is irrelevant to the determination on whether enforcement in Canada is permitted.

#### **(iii) Enforcement of monetary sanctions imposed by the United States in France**

On the other hand, even where the Brussels I Regulation is not applicable, the Court of Cassation of France authorized the enforcement in France of monetary sanctions (periodic payments) imposed by the U.S. court (after the amount of the payment was finally determined) by understanding the U.S. payment order as a kind of *astreinte*.<sup>33</sup>

## **VI Suggestions to Japanese Law**

### **1 Cases in Japan**

In the following sections, how Japanese courts should deal with demands for injunctions

or recognize foreign injunctions in transnational intellectual property infringement cases will be considered in the light of what we examined so far in this study. In particular, we will see a well-known judgment of the Japanese Supreme Court in the “card reader case” and a judgment of the Tokyo district court in the “coral sands case,” both of which dealt with an issue of cross-border injunctions to preclude acts of infringement of a foreign patent.

## **2 The Way of Thinking of Japanese Courts toward Injunctions and the Enforcement**

### **(1) Where Japanese courts issues a cross-border injunction**

Even in the card reader case, the Supreme Court did not deny the international jurisdiction of the Japanese court over “foreign” patent infringement cases. The point that became a problem in terms of a demand for injunction in the card reader case is that the U.S. patent law, which can serve as a basis for a demand for injunction, had cross-border effects. Therefore, when it comes to infringements within the territory of the United States like that in the coral sands case, it is considered that a demand for injunction against the act of infringement within the territory of the United States may be accepted as long as the relevant act is found, as a substantive determination, to constitute infringement of a patent right under the U.S. patent law. That is, it has not been denied in a theoretical sense that the Japanese court issues a sort of cross-border injunctions.

Moreover, according to the holding of the Tokyo District Court in the coral sands case, a judgment rendered by the Japanese court “shall be recognized/enforced in other countries” where the Japanese court is recognized as having international jurisdiction. Although only negative confirmation of the right to seek an injunction was disputed in the coral sands case, the holding of the Tokyo District Court is understood as being based on the premise that, even if the place of infringement of an intellectual property right is outside Japan, the Japanese court can issue a cross-border injunction if the defendant at the Japanese court has general venue within the territory of Japan.

However, in order to expect recognition /enforcement in other countries, it is extremely important, in particular, in relation to common law countries, that the content of the injunction is clearly specified. Furthermore, it is not always certain that injunctions by Japanese courts can be

recognized/enforced in other States as it is the case in the E.U. Therefore, if it were necessary for Japanese courts to expect their injunctions to be recognized by foreign courts in order to grant cross-border injunctions, there might be quite limited situations where Japanese courts can grant such injunctions.

### **(2) Measures to Secure the Effectiveness of Injunctions**

While it is not certain that injunctions by Japanese courts can be recognized/enforced by foreign courts, it does not always mean that Japanese courts turn out not be unable to grant cross-border injunctions. Firstly, it will be disputable whether or not the effectiveness of court orders is a condition for Japanese courts to grant a cross-border injunction. Secondly, even if such a condition shall be fulfilled, it would be possible to secure effectiveness by resorting to a measure such as a kind of “astreinte” as far as a defendant has assets in Japan.

### **(3) Recognition/enforcement of foreign injunctions by Japanese courts**

Then, could the Japanese court authorize the enforcement of a foreign injunction?

In the coral sands case, the Tokyo District Court stated, “A declaratory judgment on non-existence of the right to seek an injunction that has been rendered by the court of a country having international jurisdiction should be recognized in other countries, including the country of registration, in the same manner as a judgment dismissing a demand for injunction that has been rendered by the court of a country having international jurisdiction, even if the country is not the country of registration.”

It seems, however, doubtful that the court really thought about enforcing foreign injunctions in Japan as well as recognizing a foreign decision which declared non-infringement or dismissed a demand for an injunction.

## **VII Conclusion**

International injunctions can be issued in a legitimate manner in intellectual property infringement cases. However, there are quite many unsolved problems, such as the geographical scope of an injunction and enforcement thereof, in addition to the issue of international jurisdiction that generally becomes a problem in transnational intellectual property infringement cases. Whether a court can grant a

cross-border injunction is not only related to whether the court has international jurisdiction. However, discussion has been held on the issue of to what extent international jurisdiction is recognized, in determining a demand for a cross-border injunction, particularly in Europe, due to the existence of the Brussels I Regulation and the Lugano Convention, on the premise that judgments rendered by courts whose jurisdiction was based on the provisions set in said Regulation or Convention are relatively easily recognized/enforced in other countries.

In fact, however, it is difficult to say that international injunctions have been frequently issued in intellectual property infringement cases in Europe, though cross-border injunctions through the Dutch kort geding proceedings at courts in the Netherlands attracted public attention for a period of time. In particular, only a few cases of recognition/enforcement of cross-border injunctions in other countries have been known.

Nevertheless, it seems that one reason why cross-border injunctions against IP infringement are not often granted nor enforced abroad is a lack of clarification of the procedural rules as to cross-border injunctions. If the rules can be clearer, cross-border injunctions might be more often sought and might be granted in transnational intellectual property infringement cases.

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<sup>1</sup> Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization.

<sup>2</sup> See Article 41 of the TRIPS Agreement (provision set in Section 1 General Obligations in Part III Enforcement of Intellectual Property Rights).

<sup>3</sup> Outside Japan, detailed proposals have been made by the European Max-Planck-Group for Conflict of Laws in Intellectual Property (CLIP) and the American Law Institute (ALI). Also in Japan, studies and proposed rules have been introduced through the Transparency of Japanese Law Project and by the research group of the Waseda University Global COE Program.

<sup>4</sup> A patent right registered in country A is called country A's patent right.

<sup>5</sup> In this case, the existence of international jurisdiction over a defense of validity of a foreign patent right can become a problem. See the holdings of the European Court of Justice in the GAT case (ECJ Case C-4/03, Judgment of the Court (First Chamber) of 13 July 2006, *Gesellschaft für Antriebstechnik mbH & Co. KG (GAT) v Lamellen und Kupplungsbau Beteiligungs KG (LuK)*) and the holdings in the coral sands case in Japan.

<sup>6</sup> In most of the cases where infringement of the patent right in country A is found, in many cases, the company in country B or its affiliate company is supposed to be conducting some sort of activity that affects country A. The establishment of joint infringement with an affiliate

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company can be questioned in some cases.

<sup>7</sup> See the holdings of the European Court of Justice in the Roche Nederland case (Case C-539/03: Judgment of the Court (First Chamber) of 13 July 2006, *Roche Nederland BV and others v Frederick Primus, Milton Goldenberg*).

<sup>8</sup> Cited below at note 11.

<sup>9</sup> Cour de cass. civ., 9 décembre 2003, *Revue crit. DIP* 2004, 632.

<sup>10</sup> See, Marketa Trimble, "Cross-border Injunctions in U.S. Patent Cases and Their Enforcement abroad," 13 *Marq. Intell. Prop. L. Rev.* 331, esp., pp. 355-356 (2009).

<sup>11</sup> Article 8 of the Regulation (EC) No864/2007 of the European Parliament and the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II) is a provision on the law applicable to infringement of intellectual property rights. Paragraph 2 thereof particularly provides for the cases of infringement of "unitary Community intellectual property rights" separately from the cases of infringement of other intellectual property rights (paragraph 1 of said Article). Therefore, Article 8, paragraph 2 applies in deciding the law applicable to infringement of Community trade marks. On the other hand, the law applicable to infringement of European patent rights mentioned later is decided not based on Article 8, paragraph 2 of the Rome II Regulation but on paragraph 1 thereof. In this regard, see Andrew Dickinson, *The Rome II Regulation* (New York, Oxford University Press, 2008), pp.447 et s., esp., pp.452-455.

<sup>12</sup> With regard to the Regulation (EC) No40/1994, details are given in André Huet, "La marque communautaire: la compétence des juridictions des Etats membres pour connaître de sa validité et de sa contrefaçon," *JDI*, 1994, pp. 623-641. With regard to the system based on the Regulation (EC) No 207/2009, see Agnès Marcadé, "La marque communautaire devant le juge français," *Propriété industrielle*, 2010, pp.9-11.

<sup>13</sup> The latest version is the Council Regulation (EC) No 207/2009 on the Community trade mark (OJ L 78,1 of 24.3.2009). However, the following European Court of Justice's preliminary ruling is the interpretation of the provisions of the previous Regulation (EC) No40/1994 on the Community trade mark (OJ L11,1 of 14.1.1994). Those interpretations are considered to apply also as the interpretations of the relevant provisions of the current Council Regulation on the Community Trade Mark.

<sup>14</sup> Article 1(2) of the Council Regulation on the Community Trade Mark.

<sup>15</sup> *Nokia Corp. v Joacim Wärdell*, ECJ, Case C-316/05, Judgment of 14 December 2006.

<sup>16</sup> *DHL Express (France) SAS, anciennement DHL International SA c. Chronopost SA*, ECJ C-235/09. Conclusions de l'avocat général M.P. Cruz Villalón, le 7 octobre 2010.

<sup>17</sup> As obstacles to the establishment of the system of Community patent (currently called E.U. patent), there has been difficulty in agreeing on the language used and constitutional problems concerning a unified court system, in addition to the risk of translation costs becoming expensive. With regard to such problems pointed out from France's standpoint, see, "Entretiens avec Marc Guillaume et Jean-Claude Magendie," *Gazette du Palais*, 21 décembre 2006, pp. 3828-3830.

<sup>18</sup> For example, Switzerland is also a contracting state of

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the Convention.

<sup>19</sup> Convention du 16 septembre 1988 concernant la compétence judiciaire et l'exécution des décisions en matière civile et commerciale. The revised Lugano Convention is effective from January 1, 2011. See, Walter A. Stoffel & Isabelle Chabloz, *Voies d'exécution* (2e éd., Stämpfli Editions SA Berne, 2010), esp., pp. 15-16.

<sup>20</sup> 476 F.3d 887 (Fed. Cir., 2007).

<sup>21</sup> Article 11 of the Enforcement Directive (Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights) also provides that Member States shall develop law to ensure that rightholders are in a position to apply for an injunction against intermediaries.

<sup>22</sup> Dominique BUREAU & Horatia MUIR WATT, *Droit international privé*, Tome II, 2e éd. mise à jour, PUF, 2010, p. 439.

<sup>23</sup> Horatia MUIR WATT, "Yahoo! Cyber-Collision of Cultures: Who Regulates?," 24 *Michigan Journal of International Law* 673, particularly in p. 679 (Professor Muir Watt does not support the idea that the discipline in the real world does not apply to infringements, etc. on the Internet).

<sup>24</sup> MUIR WATT, supra note 20, pp. 689-692. Needless to say, whether regulating things in cyberspace can be technically easily effective is not completely unrelated to the degree of technological development (elaboration of filtering technology and zoning technology).

<sup>25</sup> In that sense, in common law countries, there is a stronger tendency to handle injunctions separately from general monetary judgments than in civil law countries.

<sup>26</sup> Although there are many past studies concerning national jurisdiction under international law, in this study, we mainly referred to Frank GERHARD, *L'exécution force transfrontière des injonctions extraterritoriales non pécuniaires en droit privé*, Schulthess Juristische Medien SA, Zurich, 2000, which analyzes national jurisdiction in relation to cross-border non-monetary judgments (orders).

<sup>27</sup> With regard to the situation of discussion, see, Gilles Cuniberti & Clotilde Normand & Fanny Cornette, *infra* note 27, pp. 259-260.

<sup>28</sup> Marketa Trimble, supra note 9, p. 346.

<sup>29</sup> With regard to the wording in Article 49 of the Brussels I Regulation, "définitivement fixé," Professor Hélène Gaudemet-Tallon states, "The wording merely means that astreinte shall be cleared and means of appeal for a clearance decision being exhausted is not considered to be necessary." In this regard, see, Hélène Gaudemet-Tallon, *Compétence et execution des jugements en Europe*, 4e édition, L.G.D.J, 2010, p. 487.

<sup>30</sup> Shinobu Ohama, "Buryusseru I kisoku ni okeru kansetsukyousei no kiritsu" (Discipline of indirect enforcement in the Brussels I Regulation), Akira Ishikawa, Makoto Nagata, and Takehiko Mikami, ed., *Bodaresushakai to hou* (Borderless society and law) (Shinzansha Publisher, 2009), p. 125 and, in particular, p. 128; Gilles Cuniberti & Clotilde Normand & Fanny Cornette, *Droit International de l'exécution*, L.G.D.J, 2011, p. 273.

<sup>31</sup> *Pro Swing Inc. v. Elta Golf Inc.*, Supreme Court of Canada, judgment of November 17, 2006, [2006] 2 S.C.R. 612; 2006 SCC 52.

<sup>32</sup> Judgment on the *Pro Swing* case, paragraphs 34-39.

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See also, Marketa Trimble, supra note 9, p. 352.

<sup>33</sup> *L'affaire Blech*, Cass Ire civ., 28 janvier 2009; Cuniberti, *Gazette d'Yu Palais*, 28 novembre 2009 n°332, p. 2; Gilles Cuniberti & Clotilde Normand & Fanny Cornette, supra note 27, pp. 273-274. This point is also mentioned in Ohama, cited above in note 27, at note 67 in p. 154.