



Julia Carretero

Offering goods or services online may be decisive in determining territorial jurisdiction

 GRAU & ANGULO
 ABOGADOS

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Intellectual Property, Spain

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Facts

Grifols, SA filed a lawsuit before the Barcelona courts against Algoritmos Procesos y Siseños, SA (APD) for infringement of European Patent 2.025.601/Spanish Patent 2.372.228, which protected a blister pack handling machine (the UNIBOT machine).

Once the lawsuit was admitted, APD was summoned and filed a declinatory plea due to lack of territorial jurisdiction. APD argued that the courts with competence to handle this case were the Madrid commercial courts (and not the Barcelona courts) because:

- APD was domiciled in Madrid;
- Madrid was the only place in which the UNIBOT machine had been marketed; and
- Madrid was where potential online sales of the UNIBOT machine were considered to have taken place.

Grifols opposed APD's declinatory plea and argued that the Barcelona courts had territorial jurisdiction to hear the procedure because:

- the UNIBOT machine was offered on the Internet throughout Spain and was therefore also offered in Barcelona; and
- according to the rules of jurisdiction established under the Patent Law, plaintiffs have the right to choose the forum in which to bring their action.

Decision

On 17 April 2019 Barcelona Commercial Court Number 1 rejected APD's declinatory plea for lack of territorial competence, ruling as follows:

- Article 118.4 of the Patent Law – which concerns the rules of jurisdiction in infringement cases – grants patent owners the procedural power to choose one of the following as the forum of territorial jurisdiction:
 - the court that is territorially competent under Article 118.3 of the Patent Law (ie, the specialised commercial court corresponding to the defendant's domicile (if any)); and
 - the specialised court of the autonomous community (if any) where the infringement took place or where its effects would have occurred.
- The right to choose between two jurisdictions with territorial jurisdiction is bestowed exclusively on the plaintiff filing an infringement claim. Defendants cannot challenge said choice as it is provided for by law.
- The court rejected APD's argument that the choice of jurisdiction lay with the Madrid courts as the UNIBOT machine had been marketed only in Madrid. The court based this decision on the fact that acts of infringement are not limited to marketing and sales, but also include offering a product for subsequent marketing (Article 59.1 of the Patent Law).
- It was proven that the allegedly infringing products had been offered throughout Spain via APD's website. On this basis, the court concluded that at least one infringing act would have had an effect in Catalonia; therefore, the Barcelona courts were competent to hear the case.

Finally, the court pointed out that this was a case of forum choosing (rather than forum shopping) which illustrates the importance of patent owners' right to choose, which has been expressly granted to them by the legislature.

This decision is final.

For further information on this topic please contact Julia Carretero at Grau & Angulo by telephone (+34 93 202 34 56) or email (j.carretero@ga-ip.com). The Grau & Angulo website can be accessed at www.ga-ip.com.

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