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Case No: HP-2021-000041

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)
PATENTS COURT
SHORTER TRIALS SCHEME

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL

Date: 08/11/2022

Before :

SIR ANTHONY MANN

Between :

Lisa Dräxlmaier GmbH

Claimant

- and -

BOS GmbH & Co KG

Defendant

Douglas Campbell KC (instructed by **AA Thornton IPLLP**) for the **Claimant**
Tom Alkin and Mitchell Beebe (instructed by **Powell Gilbert LLP**) for the **Defendant**

Hearing date: 19th October 2022

APPROVED JUDGMENT

This judgment was handed down remotely at 10.30 am on 8th November 2022 by circulation to the parties' representatives by email and by release to The National Archives.

Sir Anthony Mann :

The background to this application

1. This is a patent action in which the claimant (Dräxlmaier) seeks a declaration of non-infringement (“DNI”) against the patentee, the defendant (BOS) under section 71 of the Patents Act 1977. The subject matter of the EU patent (EP 3266631 B1) is part of a system of blinds installed in car windows. Dräxlmaier manufactures its own system which it supplies to Mercedes-Benz (and only to Mercedes-Benz) in Germany (on the evidence). In Germany BOS has sued Dräxlmaier for infringement in respect of those activities. It seems to be accepted by both parties that in the events which have happened these English proceedings no longer serve a useful purpose and can properly be brought to an end. The question which arose on the hearing before me is how these proceedings can properly be brought to an end, though (as in so much modern litigation) the real underlying question is one of costs.

2. As the hearing was constituted before me there were two competing contentions as to what should happen to the proceedings. BOS, in a properly formulated application, contended that the proceedings should be struck out, or alternatively that there should be defendant’s summary judgment against the claimant. Dräxlmaier expressed a wish to discontinue the proceedings, but only if it could be assured it would not have to pay the costs of the action in doing so, so it wished to have it determined that in the event of discontinuance it would not have to pay the costs, and indeed that BOS should pay the costs of the action. It did not put its stance in a formal application; rather, it raised it by inserting a paragraph in its proposals for case management directions. In two paragraphs in a draft order it proposed an order that Dräxlmaier should discontinue and have its costs of the action; this proposal (not an application) was backed by an indication that it would give an undertaking to discontinue if it got its costs. It seemed to me that there were all sorts of difficulties in this course, including (a) not least the problems posed by the wording of CPR 38.6 (which seems to require a discontinuance before the court can decide whether the usual, or some other, costs order should follow); (b) the court deciding the hypothetical question which Mr Campbell KC for Dräxlmaier sought to pose, (c) what would happen if the court determined that some lesser order than a 100% costs order were appropriate, (d) and other difficulties. When these were put to Mr Campbell and he was asked whether he wanted to discontinue and then have the debate (which would have been acceptable to BOS) he declined to do so and abandoned his application (if that is what it was) to have the hypothetical application decided.

3. What I therefore have to decide is whether BOS’s application should succeed. It seemed to have evolved as common ground that if I decided it should not, the action should nonetheless be stayed, though at one stage Dräxlmaier did seem to be arguing that if necessary the action should proceed to trial so that the question of costs could be decided in that framework. Those matters having been decided, there will then have to be a debate about costs, which will depend on the basis of my decision. Those costs are not insignificant. I was told that Dräxlmaier’s costs in this action (which has not

yet got as far as a Defence) are £156,000; BOS's costs are said to be £90,000 less than that.

4. This set of applications arises out of patent litigation in which there has been a level of procedural manoeuvring which it is impossible to admire. The history of this matter shows a patentee keen to indicate that it did not seek to enforce the patent, and indeed was content to let it lapse or even surrender it, and a potential infringer insisting on the patent being maintained and even going to the extent of paying a renewal fee and then resisting a surrender. A layman would be deeply, and justifiably, puzzled as to how this can have arisen and would wonder whether he/she had stepped through Alice's looking glass.
5. It will be useful at this stage to set out section 71 as the starting point of the procedural and technical manoeuvring in this case. It provides:

“71. Declaration or declarator as to non-infringement

(1) Without prejudice to the court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown—

(a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and

(b) that the proprietor has refused or failed to give any such acknowledgment.”

The factual background

6. The patent in suit is a UK patent which is spun off from an equivalent EU patent under the English opt-out procedure. Its publication date is 10 January 2018. It has not been asserted here by the patentee, but the equivalent German patent has been asserted by BOS against Dräxlmaier in German infringement proceedings commenced on 16

August 2021 and foreshadowed in June 2021. Until a recent discontinuance or abandonment, as appears below, it was on course for a hoped-for December trial date.

7. Not only was the English patent not asserted or relied on in this jurisdiction by BOS, BOS allowed the patent to lapse by not paying a renewal fee due on 12th June 2021. The explanation given in the evidence for that is that the patent was of no commercial significance in this jurisdiction and BOS did not particularly want the patent in this jurisdiction in the first place; it only had one because of the automatic grant under the European patent system. It therefore did not bother to renew it.
8. Thereafter the increasingly odd sequence of events was as follows.
9. The effect of non-payment was that the patent lapsed at the end of June, though it was revivable in the next 6 months if the renewal fees were paid. BOS did not seek to pay them.
10. On 17 June 2021 there was a first communication from BOS to Dräxlmaier in Germany regarding infringement of the patent. On 2 August 2021 Dräxlmaier wrote to BOS about the English patent and giving notice under section 71 of the Patents Act, requesting confirmation that Dräxlmaier's product did not infringe the English patent. There was a suggestion that this letter did not accurately identify the potentially infringing matter, but in the end that was not pursued before me and nothing turned on that for the purposes of what I have to decide. What might have been said about it is that was perhaps not entirely accurate in a statement made about infringing acts in this jurisdiction. It might also have been questioned whether or not its subsequent averment in its Particulars of Claim that it carried out or proposed to carry out an infringing act was really true, because the real weight of the evidence was that it sold its product in Germany and did not sell or import, or realistically intend to sell or import, its product into this country. However, that point was not taken by BOS and Mr Tom Alkin, who appeared for BOS, accepted that he had not challenged the material averment in the Particulars of Claim which was vouched by a statement of truth in the usual way. Since Mr Campbell had not had an opportunity to put in evidence specifically directed to a challenge on the point it was not pursued, and the significant question-mark about it was not resolved or debated further, though I return to the point below in considering the strength of that evidence and the realities of this case.
11. BOS did not respond to that letter. The evidence of Mr Wilson, BOS's solicitor, was that:

“As the Defendant intended to commence proceedings in Dusseldorf and correctly believed that it did not hold a UK patent, it did not respond specifically to the s.71 request.”

12. A footnote to his witness statement explains that the reason for the belief was the lapse of the patent which had already taken place. I find that averment inherently incredible. Mr Alkin invited me to accept that it was a reasonable and plausible view, and that Dräxlmaier would have assumed that that was the position, given that BOS would have received a reminder letter from the IPO, that BOS had patent attorneys looking after its portfolio of patents, and that Dräxlmaier knew those facts.
13. I find that to be highly unlikely. If BOS was looking after its portfolio in an organised way without the background of the threatened German proceedings, and protecting it where appropriate, it is far more likely that it would have responded to the section 71 notice in some way (if only to point out that the patent had lapsed or was about to lapse). I think that the real reason was that, for tactical reasons, BOS did not want to acknowledge non-infringement (because that would have affected its German proceedings) and probably thought that the best thing to do was to keep quiet about the patent. The correspondence in this case demonstrates that BOS does not shrink from writing letters to advance its position. This silence is more likely to be part of the tactical battle between these parties rather than the more casual “it does not matter, so we won’t bother to respond at all” attitude suggested by Mr Wilson.
14. On 16 August 2021 BOS commenced infringement proceedings in Germany. As is normal in Germany, these proceedings did not include validity questions; they were about infringement only.
15. On 12 November 2021 Dräxlmaier (not BOS) paid the renewal fee for the English patent, thereby reviving it. It is plain enough from the evidence which I have received that that was done in order to improve the target at which the declaratory proceedings, which were about to be commenced, was aimed. There can have been no other motivation for that extremely odd step. It was not done with the knowledge or consent of BOS; BOS did not know about it until April 2022.
16. 4 days later, on 16 November 2021 Dräxlmaier issued these proceedings in this jurisdiction seeking a declaration under section 71 that its product did not infringe. It did so without any warning to BOS after the section 71 notice and it sought to have those proceedings dealt with under the Shorter Trial Scheme which operates in this court. It did not engage in the pre-action protocol requirements which apply to such trials. The section 71 notice had invited BOS to nominate solicitors to accept service, but of course there was no response to that. Accordingly, and because the proceedings

had to be served in Germany, the normal service-out hoops had to be gone through. Because of the delays inherent in that process the proceedings were not served until 31 March 2022. Until then BOS knew nothing of them at all other than the threat in the DNI notice.

17. On 19 April 2022, before it acknowledged service of the proceedings, BOS wrote to Dräxlmaier indicating that it intended to apply to the UK patent Office to surrender the patent and it invited Dräxlmaier to discontinue the proceedings in the light of that surrender. The next day, on 20 April 2022, BOS wrote to UK IPO offering to surrender the patent under section 29 of the 1977 Act, thereby triggering that Office's procedures for surrender. The following day (21 April) BOS filed its acknowledgement of service. When it was told of the proposed surrender Dräxlmaier, through its solicitors invited BOS to withdraw its surrender offer. It obviously wanted to procure the survival of the patent it had originally paid for the renewal of; its "looking glass" conduct continued.
18. On 4 May 2022 BOS's solicitors invited Dräxlmaier to agree to stay of the UK proceedings pending completion of the surrender proceedings and a 28 day extension of time for filing the Defence to allow BOS sufficient time to prepare an application to stay the UK proceedings. It confirmed very firmly that it did not intend to enforce the UK patent. The letter of that date averred that these proceedings had no point.
19. On 5 May 2022 Dräxlmaier (through solicitors) agreed to only a 14 day extension of time for the Defence, on the footing that that was the maximum amount of time that could be agreed between the parties in an action under the Shorter Trial Scheme, provided that BOS set out its reasons to the court. BOS did not take advantage of that offer, and instead made an application to extend time for the filing of a Defence for the shorter of a period of 56 days or seven days after the court decided an application to be made by BOS for a stay of the UK proceedings pending the surrender proceedings in UK IPO.
20. On 9 May 2022 UKIPO indicated it intended to advertise the offer to surrender in the Patents Journal to be published on 1 June 2022. That triggered a four-week period for opposition to the surrender.
21. On 27th of May 2022 BOS filed the strike-out/summary judgment application which now comes before me. The annexed order (reinforced by a statement in its supporting evidence) demonstrated that it proffered an undertaking to the court not to seek to enforce the patent:

"The Defendant undertakes irrevocably not to enforce EP (UK)
3 266 631 B1 against any person, whether for an injunction,
damages, and account of profits or any relief howsoever, for acts

in the United Kingdom under s.60 of the Patents Act 1977, whether such acts occurred before or after the date of this undertaking.”

22. On 9th June 2022 it was listed for hearing in the window commencing 17 October 2022 and on the next day (10th June) Marcus Smith J directed that the extension of time application be heard on the same occasion.
23. On 17th June Dräxlmaier filed a Notice of Opposition and Statement of Grounds in UKIPO opposing Dräxlmaier’s surrender application. One of the grounds of opposition was that the surrender was part of the tactic in which BOS was trying to avoid the determination of the non-infringement issue raised in the current proceedings. The result of dealings thereafter was that the UKIPO stayed the surrender proceedings on 30th September pending a decision in the strike-out application now before me.
24. On 14th June Dräxlmaier made an application to expedite the trial in these proceedings so that it be listed to be heard within 12 months of the date of issue. It also issued an application for a combined hearing of the three extant applications (the extension of time application, the strike-out application and the expedited trial application) and seeking expedition of the combined hearing so that it be heard before the end of July. In that context Dräxlmaier indicated openly for the first time that the reason, or perhaps the main reason, for the English proceedings was to be able to have an English decision on the infringement point for deployment in the German proceedings, though in its statement of grounds of opposition to the surrender it had averred a mirror image of that point in that it complained that the tactical goal of BOS was to avoid having an English decision which might reflect adversely on the strength of its infringement claim in Germany (see paragraph 24). This motivation plays a significant part in what I have to decide.
25. On 8th July BOS filed an application for a CMC in this action and sought to list it alongside the strikeout application. Technically that matter comes before me as well as all the other matters, though in the events which have happened I will not have to consider it.
26. The application to expedite the application to expedite (which is a somewhat unusual application, though in line with the other unusual aspects of this matter) came before Mellor J. He refused it on 21st June, giving reasons on 27th June ([2022] EWHC 1642 (Pat)).

27. On 29 September 2022 BOS withdrew the German infringement proceedings. It is said that that was done because a licensing deal had been done with Mercedes-Benz which rendered the infringement claim otiose. That materially changes the complexion of the present proceedings and has led to Dräxlmaier itself now accepting that, as a result of that, these proceedings have no real point. That was the basis on which it indicated that it would discontinue the proceedings if that course did not have adverse costs consequences (see above).

28. Thus the matter arrived before me. I no longer have to consider the application to extend time for the Defence, the trial expedition application or the directions to trial. I have to consider just the strike-out/summary judgment application, and in due course, and dependent on the outcome of that and the reasons for my decision, the question of the costs of the action (which is what the current dispute is really all about). The strike-out/summary judgment applications turned on the same points, and it was not suggested that the summary judgment application might succeed if the strike-out application fails, so I can consider just the strike-out application.

The main issue in the present applications

29. BOS makes its application on the footing that the proceedings always were, or alternatively have become, an abuse of process because they always were, or have become, pointless and wasteful litigation – *Jameel v Dow Jones & Co Inc [2005] EWCA Civ 75* (“*Jameel*”). The proceedings were also an abuse because they are being pursued for a collateral purpose, namely so that an English decision could be obtained for the purpose of the German proceedings. In that context the proceedings are oppressive or vexatious and there was no reasonable ground for bringing them. The claim for a DNI declaration is a waste of time and in circumstances in which the patent had lapsed and was only restored because of the restoration by the potential infringer, and in the face of a clear indication that the patent was to be surrendered (which would have the effect that no historic infringement could be sued for - see section 29(3) of the 1977 Act). If Dräxlmaier had only waited another 6 weeks they could have seen that the patent had lapsed beyond possibility of restoration. If it be said (and it was said) that there was a further risk of restoration for another 13 months under section 28 of the Act, that was fanciful because Dräxlmaier cannot have thought that the lapse was unintentional (a requirement of the section) because it knew that BOS had patent attorneys and lawyers here and they would not have allowed an accidental lapse. The lack of any residual risk to any potential infringer which might exist was removed by the undertaking which was proffered. In the circumstances there could be no justification for the commencement and/or continuation of the present proceedings. Using them to get a DNI declaration so that it could be used in the German proceedings was not a legitimate purpose. Dräxlmaier is not, and never was, at risk of being sued for infringement here. Furthermore, the package presented by BOS’s acts (lapse, surrender, statements in correspondence and undertaking) gave more extensive protection than the DNI action, because it prevented any claim for infringement in the future in relation to any product, and by any person, whereas the action just covered the specific Dräxlmaier product which was the subject of the DNI notice. That reinforced the submission that the DNI application served no useful legitimate purpose. The abuse

principles applied to DNI actions as much as to any other type of action. Accordingly these proceedings ought to be struck out.

30. Mr Campbell, for Dräxlmaier, said that he was entitled to seek a DNI declaration with no requirement that the proceedings should seek to achieve some useful purpose. The genesis of the section and authority showed that. That being the case, he was entitled to maintain his proceedings if he wished to do so. He was entitled to bring his proceedings despite the lapse because the patent could have been revived by BOS paying the fees within 6 months after the end of the month of lapse, and possibly a further 13 months after that if an application for restoration was made on the footing that the original failure to pay was unintentional. As a result his clients were at risk of a restoration, and then being sued, for a total of 19 months. That justified their seeking the DNI declaration. He accepted that he could have brought his action without his clients themselves paying the fee to restore the patent on which they did not wish to be sued, but they paid the fee to remove a “barrier”. The undertaking that was offered was not a proper undertaking; the relevant witness statement contained no more than a willingness to offer it. It was not until a confirmation was obtained from Mercedes-Benz on 29th September that Dräxlmaier considered itself properly secure from infringement proceedings “in any jurisdiction”. That is because Mercedes-Benz confirmed that under the licence that company could licence third parties, so that would cover Dräxlmaier’s products to the extent that “they are used on behalf of Mercedes-Benz AG and its affiliated companies”.

31. One or two points need to be made in relation to the parties’ points before moving on:
 - (a) Mr Campbell is technically correct to say that when it was proposed the undertaking offered was not an undertaking, but merely an expression of a willingness to give an undertaking. But that is merely because no vehicle for giving the undertaking (an order) was actually in existence. It would have been very easy to bring such an order into existence, and there can be no doubt that BOS would have achieved that if required. This application should be determined on the footing that the undertaking would be given as part of the protection offered to Dräxlmaier.
 - (b) The suggestion of Mr Alkin that Dräxlmaier ought to have inferred and assumed that the non-renewal by BOS was deliberate does not hold water. Dräxlmaier may have wondered, but the idea that it should have assumed that it was deliberate because it had sound advisers is completely misplaced. They could not safely have inferred that, and in any event if BOS wished them to know then they could have responded to the DNI notice by telling them (even though that would not have been a response of the kind that the notice was seeking).

The motivations of the parties

32. The main factual matter underlying the current dispute is what the purpose of these proceedings is and what the motivation of Dräxlmaier was for bringing and maintaining them. I consider that there is no doubt that the predominant motive (by a long way) in their bringing their present proceedings was to obtain the DNI declaration for the purposes of being able to place it before the German infringement court to show the views of the English court on infringement issues. Although they were technically able to say that they proposed to do something in this jurisdiction which would amount to an infringement (without specifying it), because that particular point was not challenged in these proceedings and Mr Alkin accepted as much, everything points to Dräxlmaier's requiring the declaration rather than needing to be assured that they could not and would not sue here. Getting a patent restored cannot be viewed as the act of someone who wanted reassurance against being sued here. Such a person would hardly restore the cause of action which could be asserted against them. The motivation for that was clearly a need to make sure that Dräxlmaier had a target for the DNI declaration, and the need for that was in reality so that it could be used in the German proceedings. As Mr Campbell accepted, paying the fee to restore the patent was not strictly necessary to enable the DNI claim to survive, but it does demonstrate the desire to have a target for that action as an action, rather than a desire to clarify whether an infringement claim would be brought here. Nor is Dräxlmaier's opposition to the surrender the act of a person who wishes to avoid being sued in this jurisdiction. It is the act of a person who wishes to maintain the patent as a target of the DNI application for reasons other than being sure about not being sued. In the first witness statement of Mr Hussey, solicitor to Dräxlmaier, he points out that:

“If the Defendant had intended to relinquish its rights over [the patent] in the United Kingdom, the proper way to do that would have been to surrender the patent in the first instance.” (Para 36)

33. He gave that evidence in the context of meeting a suggestion that BOS was demonstrating an intention to abandon the patent by not applying for renewal. Mr Hussey is right in what he says, which makes it even more remarkable that his client then went on to *oppose* such a surrender. The only real explanation for that is, once again, that Dräxlmaier wanted to maintain a target for this action, and the only real explanation for that is so that a judgment on infringement (which it no doubt hoped would go its way) could be produced to the German court. That was also the motivation behind the expedition application which it made, in the hope that time could be made up and a judgment obtained before the German hearing at the beginning of December 2022.

34. The real desire to put an English judgment before the German court is also apparent from the second witness statement of Mr Hussey though that evidence does not say that it is the predominant desire. However, that that was what Dräxlmaier really wanted is demonstrated by the circumstances in which it finally expressed the view that these

proceedings were no longer required. By 29 September 2022 (the date on which the German proceedings went) Dräxлмаier really had all it needed in terms of protection in this jurisdiction. It had clear expressions from BOS’s solicitors that BOS did not intend to assert its patent, and that therefore explained why BOS did not renew it. Then it had the surrender application made by BOS (which would have dealt with any historical breaches), and during the course of these proceedings it had the benefit of the undertaking identified above. However, despite all that, it sought to press on with (and even expedite) this action. It only abandoned that stance when the German proceedings were finally abandoned and, as a result, it became apparent that Dräxлмаier could not be sued in Germany because the Mercedes-Benz licence prevented that. That really reinforces what one would otherwise have inferred. True it is that Mr Hussey says that these final arrangements protected Dräxлмаier from being sued in any jurisdiction, but there never was any apparent prospect of its being sued anywhere else. I therefore find that the vastly predominant motive in bringing and maintaining the DNI claim was to produce a judgment on infringement for deployment in the German court. Any technical residual expressed intention to do an infringing act in this jurisdiction (the nature of which was never indicated) is almost de minimis in this context.

35. The motivation of BOS in all of this is not quite so important though it still plays its part. It is right to record that in some respects it was very cagey and, at least in the initial stages, it might be said that it brought the action on itself. Its failure to respond to the DNI notice was a tactical one in order to avoid conceding non-infringement, but it could have responded by indicating that it no longer supported the patent. If it had done that then the course of events which resulted when the proceedings were served could well have occurred earlier and a lot of costs avoided. Its subsequent actions indicate that it was keen to be seen to avoid asserting the patent at all without conceding non-infringement for its own tactical reasons.

Abuse of process or no reasonable ground for bringing the claim

36. CPR 3.4(2) provides:

“(2) The court may strike out a statement of case if it appears to the court –

(a) that the statement of case discloses no reasonable grounds for bringing or defending the claim;

(b) that the statement of case is an abuse of the court’s process or is otherwise likely to obstruct just disposal of the proceedings;...”

37. BOS claims that the current proceedings are an abuse of process, or that there is no reasonable ground for bringing the claim, on various bases. First, it is said that the proceedings always were, or alternatively from April became, pointless and a waste of

time and resources because they were totally unnecessary and served no useful commercial purpose. Second, they were an abuse because they were being pursued for an illegitimate collateral purpose, namely to produce a judgment which Dräxlmaier hoped could be used in the German proceedings. Third, they are oppressive because they involve parallel proceedings where there are other equivalent proceedings in another jurisdiction. Fourth, there are no reasonable grounds for bringing the claim (which turns out to be the same point as the first one).

38. The general principles applicable to abuse were not in dispute. Mr Alkin said that his main basis was the principal that the court will not allow pointless and wasteful litigation as set out in *Jameel*.

“54 ... An abuse of process is of concern not merely to the parties but to the court. It is no longer the role of the court simply to provide a level playing field and to referee whatever gain the parties choose to play upon it. The court is concerned to ensure that judicial and court resources are appropriately and proportionately used in accordance with the requirements of justice.

...

69 ...The game will not merely have not have been worth the candle, it will not have been worth the wick.”

...

70. It would be an abuse of process to continue to commit the resources of the English court, including substantial judge and possibly jury time, to an action where so little is now seen to be at stake ...” (all per Lord Phillips MR)

39. The principle of not allowing wasted resources was applied in patent proceedings in *Edwards Lifesciences Crop v Meril GMBH* [2021] EWHC 761, though an actual abuse was not relied on by the judge (Meade J) – see para 39. I develop this case more fully below.

40. So far as collateral purposes are concerned, in *Lonrho v Fayed (No 5)* [1993] 1 WLR 1489 at p 1502 Stuart-Smith LJ said:

“If an action is not brought bona fide for the purpose of obtaining relief but for some ulterior or collateral purpose, it may be struck out as an abuse of the process of the court. The time of the court

should not be wasted on such matters, and other litigants should not have to wait till they are disposed of.”

41. As for the question of oppression in bringing parallel proceedings, Mr Alkin pointed to *Australian Commercial Research v ANZ McGaughan* [1989] 3 All ER 75 and *Marriage of Henry* [1995] 185 CLR 571 at 591. I do not think that this point adds anything to Mr Alkin’s case, and I will not trouble to set out those citations.

The interaction of the abuse jurisdiction and section 71

42. Mr Campbell did not go so far as to suggest that section 71 DNI proceedings could not be an abuse, but he did submit that there was no requirement in the statute for the section to serve a “useful purpose”, and no such requirement should be introduced via the abuse jurisdiction. He accepted that a declaration under the inherent jurisdiction would usually have to be for a “useful purpose”, but seemed to suggest that there was no such constraint under section 71. He also submitted that one did not need locus to apply under section 71, and that any “busybody”, might apply, which was again different from an application for a declaration under the inherent jurisdiction.
43. In my view Mr Campbell’s attempt to distance section 71 applications from the application of the normal abuse jurisdiction fails. As a matter of principle there is no reason why the same considerations of abuse should not apply to such applications. The section does not suggest otherwise. It is not right to say that anyone, even a “busybody” can apply. The “person” who can serve the notice referred to in paragraph (a) of section 71(a) is the “person” referred to earlier in the section. That “person” is not just anyone (a “busybody”) who feels like serving notices and starting proceedings just for the fun of it. It is a person “doing or proposing to do” the feared infringing act. A busybody does not qualify. If the qualification is fulfilled then it will generally be the case that that alone is a useful purpose, and it cannot be said that the application is an abuse for want of a useful purpose. It is enough to be useful that the person is doing or intends (proposes) to do the act in question.
44. Mr Campbell cited Floyd J in *Omnipharm v Merial* [2011] EWHC 3393 (Pat) at para 154 in a section of his judgment headed “Standing to claim a declaration of non-infringement”:

“154. Section 71 of the Patents Act 1977 allows a person who is “doing or proposing to do” an act to apply for a declaration of non-infringement. A number of things can be noted about this requirement:

- i) The language is in contrast to that of section 72, the section which governs applications for revocation of patents. That section confers standing on “any person”: even a “straw man”

provided no abuse of process is involved: see *Cairnstores v Hassle* [2002] FSR 564.

ii) The language is also in contrast with section 64 which confers a right to continue in certain circumstances on a person who either “does in good faith an act which would constitute an infringement of the patent if it were in force” or “makes in good faith serious and effective preparations to do such an act”.

iii) In *Nokia v Interdigital* [2007] FSR 23 at [17] Jacob LJ said, obiter, “Section 71 requires no claim of right, nor even any intention by the applicant to make or do the acts the subject matter of the declaration he seeks. Normally, of course, the applicant will at least have in mind the possibility of doing those acts, but whether he does so or not is irrelevant.”

iv) In *3M's Patent* [1999] RPC 135 at 152, Pumfrey J (as he was then) described the proposed formulations as “argumentative” in the sense that they were intended to point up particular difficulties on construction. He considered that it was sufficient for the applicant to be able to say “I should like to do this if I can”.

v) The section supplements the court’s inherent power to grant a declaration where to do so would serve a useful purpose. It was enacted at a time when the court’s inherent power was thought to be subject to jurisdictional constraints, such as the need for an applicant for a declaration to show a contrary claim of right. Its object was to allow a defendant to bring a question before the court where a patentee was prevaricating, but making no claim of right. Its purpose was accordingly to remove jurisdictional constraints, not create them.”

45. None of this supports Mr Campbell. The reference in sub-paragraph (v) to a declaration which would serve a useful purpose does not suggest that section 71 can be deployed when there is no useful purpose – that is not the contrast which is being drawn. All Floyd J was doing there was describing the nature of the inherent jurisdiction by reference to useful purpose, not suggesting that other declarations can be sought where there is none. In sub-paragraph (i) Floyd J demonstrates that the abuse jurisdiction does apply to revocation actions even where there is a “straw man” (aka “busybody”). That being the case, would be odd if it did not apply to section 71 (and I do not think that Mr Campbell was suggesting otherwise), and it would be equally odd if the concept of abuse in that context did not include an absence of a useful purpose if the facts demonstrated that state of affairs. The citation in sub-paragraph (iii) is a little odd, and at odds with the wording of the statute, which does require some level of intention (or proposal). Since it was obiter and conflicts with the statute (and what Pumfrey J is recorded as saying) I take the view that it does not assist me.

46. Accordingly the position is that section 71 proceedings could be struck out as an abuse if they serve no useful purpose, bearing in mind that a proposal to do an apparently infringing act would be likely to generate a useful purpose in this context. Of course, if it could be demonstrated that the applicant did not propose to do the act at all and was fibbing, then the proceedings could be struck out for want of locus, but that is not (quite) suggested in this present case.
47. There is therefore no reason why the abuse jurisdiction should not be applied to an action brought under section 71 and that allows in considerations of a useful purpose (or its absence) and, if appropriate, an illegitimate collateral purpose.

The alleged abuses in this case.

48. The most material forms of abuse to this application are lack of a useful purpose (a version of the *Jameel* abuse) and pursuing them for a collateral purpose. On the facts of this case they effectively intertwine.
49. I shall take the *Jameel* point first. The complaint that the proceedings lack a useful purpose is centred around an averment that they were unnecessary in the first place, and became more obviously unnecessary as BOS ratcheted up its indications that Dräxlmaier would not be pursued for infringement. It is said by BOS that it would be wrong to devote court resources to the further conduct of these proceedings, and particularly a trial which would last some 4 judge-days (with pre-reading) with further time for judgment writing. By the time of the surrender offer at least, in terms of being protected from being sued, Dräxlmaier had all that it could hope to achieve by its declaration. Indeed, it obtained more than the declaration would achieve, in that the declaration would give protection only to Dräxlmaier, and only in respect of the potentially infringing product, whereas BOS's offers would provide protection to Dräxlmaier and all third parties, and in respect of all possible future (or past) products. These proceedings were, or became, otiose and could serve no useful purpose.
50. I agree that in terms of protection the offers of BOS as they now are give more legal protection than the present proceedings, and therefore to that extent these proceedings have become otiose and pointless. Indeed, in terms of protection, that point is now effectively conceded by Dräxlmaier which no longer seeks to pursue them. However, just looking at this aspect of abuse, it was not always the case. When the proceedings started it was not apparent what BOS's attitude was because it did not state it. It failed to take the opportunity to state its position when it was served with the section 71 notice, and that was, as I have found, a deliberate tactical move. So if it was intending not to sue anyone in connection with the patent, it kept that to itself. It would not have been reasonable for Dräxlmaier to infer, as suggested by Mr Alkin, that it intended to let the patent go permanently and without any enforcement.

51. The pointlessness aspect of the abuse therefore did not exist at that time. The odd act on the part of Dräxlmaier of paying for the restoration of the patent does not go to this aspect of the abuse.

52. That remained the position until April 2022 when, as a result of the proceedings, BOS started to make its position clear, first in correspondence and then when it applied for a surrender and then when it offered the undertaking. At the stage when it offered a surrender, which would have been more advantageous than the declaration in terms of enforceability of the patent, it becomes apparent that there is no real point left in the proceedings (other than the possible benefits of using the judgment in the German proceedings). That position was reinforced even more when the undertaking was given (in a witness statement 27th May 2022). At that point the proceedings were apparently pointless in terms of the value of the remedy, unless something unconventional was also operating.

53. Of course, as I have already held, it was, so it is appropriate to move from that head of abuse to the collateral purpose, because in the real world it is the existence of the German proceedings which informed the acts of the parties. It seems likely that BOS was avoiding conceding non-infringement as such because of the effect of such a concession on the German proceedings, and by the same token Dräxlmaier wanted to establish non-infringement for precisely the same reason. That being the case, it is necessary to consider whether proceedings which are commenced and/or persisted in for that reason are capable of being an abuse. This is the collateral use point.

The authorities on abuse in this context

54. Before embarking on a consideration of the authorities it is necessary to bear in mind the litigation context in which views on the topic have been expressed. First, they all seem to involve actions which, at least as started, were actions with a legitimate UK interest. None of them were actions which were started purely for the purpose of getting a UK decision so that could be deployed to influence a foreign court in an action considering the same patent. Second, they all involved a validity challenge as well as an infringement challenge. None of them were concerned with infringement challenges alone, save for *Edwards v Meril* which ended up being a case in which dealing with that point was the only issue left after concessions by the defendant. Third, validity challenges under section 72 may stand in a different category, because no particular locus is required to challenge a patent, and no particular reason either – see the *TNS* case referred to below. “Any person” may apply. That is said to be because there is a genuine public interest in being able to challenge an (allegedly) improperly granted monopoly. If that is right, and no particular motivation has to be justified, then a motivation to use a decision in a foreign court would not disqualify. Fourth, one of the potential uses of an English decision on validity which has been identified as a legitimate use is in addressing the “injunction gap” which arises in jurisdictions like

Germany which operate a bifurcated system and in which the foreign court has to address whether to grant an injunction, having found infringement, pending a second trial of validity issues. Apparently English decisions on validity have a part to play there. That does not apply to English decisions on infringement.

55. Turning now to the authorities, Mr Alkin submitted that on the authorities such a purpose made the proceedings an abuse. Mr Campbell submitted that they demonstrated that it did not; it was perfectly permissible to commence infringement (or non-infringement) proceedings in this jurisdiction in order that the decision could be shown to a foreign court which was also considering infringement of an equivalent European patent.
56. As a starting point, it would appear that in this case Mellor J was less than convinced about the utility of an English decision on infringement (as opposed to validity) in the German court. He was not considering the question of abuse, but the likely utility of the decision (or rather the lack of it) was one of the reasons for his refusing to expedite the expedited trial application. His judgment draws a distinction between decisions on validity and infringement, and at paragraph 43 he said:

“(ii) Second, it seems to me that the experienced infringement Court in Düsseldorf does not need assistance in the form of the judgment of this court on infringement of the UK designation of the patent.”

This is not the point which I have to decide, but it is some sort of starting point for BOS, and other parts of his judgment do demonstrate a difference between decisions on validity and infringement which needs to be borne in mind when considering the authorities which I am about to turn.

57. Before doing so I should deal with the evidence, such as it is, as to whether or not the German court would itself pay any attention to a decision of this court on infringement. Putting it briefly, each side has put in evidence (through English solicitors reporting what their German lawyers say) supporting its case. Dräxlmaier has put in evidence saying that the German court would pay some attention to it, and BOS has put in evidence saying it would not. I cannot resolve that difference and will leave it as a matter in dispute.
58. The first relevant authority is the decision of Arnold J in *TNS v Neilsen* [2009] EWHC 1160. This, like most other cases in this area, was one involving validity. The case was one in which there was an application to strike out a claim challenging validity on the *Jameel* basis on the footing that the patentee had offered a licence which was said

to remove any commercial need to challenge the patent. There was also an additional commercial need point based on the interaction between the expiry of the patent preceding a new contract to which it would presumably otherwise have been relevant (see paragraph 5). Arnold J accepted that a claim could be struck out where it was pointless and wasteful (paragraph 11) but that did not apply to a case such as that before him. He declined to strike out the claim, following earlier cases which refused to strike out validity challenges on the footing that section 72 of the Act permitted “any person” to challenge a patent. The underlying justification for this was said in the earlier cases to be that patents are monopolies and anyone had an interest in challenging the monopoly per se, whether or not they had a commercial interest in doing so (see the citations from *Oystertec’s Patent* [2002] EWHC 2324 (Pat) set out in paragraphs 17 and 18 of *TNS*). I observe that that reasoning does not apply to infringement claims, so they are to that extent more vulnerable to an abuse claim based on absence of legitimate commercial or other interest.

59. Then Arnold J turned to the question of collateral purpose. The evidence of the patentee was that it wished to have an English revocation to show to potential customers in other jurisdictions, where there was an equivalent EU patent, that those other patents were worthless.

“Such a decision may be ‘exported’ to other national Courts, or shown to customers and potential customers to alleviate their concerns.”

He then cited other authority and concluded as follows:

“24. In *Unilever plc v. Frisa N. V.* [2000] F.S.R. 708, 713 Laddie J. said this:

"Furthermore, there is an advantage of proceedings being conducted here in accordance with the fairly tight time tables which are now imposed, namely that judgments obtained from this court, or obtained from this court and then from the Court of Appeal on issues of infringement and validity have in the past, at least on occasions, helped to inform the parties so as to enable them to resolve their disputes on a worldwide basis earlier rather than later."

25. That passage was quoted by and relied upon by Kitchin J. in *GlaxoSmithKline Biologicals SA v. Sanofi Pasteur SA* [2006] EWHC 2333 (Pat) at [32] - [35] and again at first instance by Lewison J. in *Glaxo Group Ltd v. Genentech Inc* [2007] EWHC 1416 (Pat), [2007] F.S.R. 35 at [63] - [65]. On appeal in the latter case, [2008] EWCA Civ 23, [2008] FSR 18, Mummery L.J., giving the judgment of the Court of Appeal, referred to that part of Lewison J.'s judgment with apparent approval at [33].

“26. In my judgment, those authorities demonstrate that it is perfectly legitimate for the claimant to seek to obtain a judgment of this court on the validity of the patent in suit in the hope that it will lead to a settlement of the dispute between the parties throughout Europe. Nor, in my judgment, would it be in any way illegitimate for the claimant, absent such a settlement being achieved, to seek to rely upon the judgment of the English court in proceedings before the courts of other Contracting States or the European Patent Office. It is commonplace for parties litigating on the same European patent in a number of Contracting States to put before the courts of one Contracting State decisions arrived at in one or more other Contracting States. I do not see that such conduct can possibly be stigmatised as an abuse of process. That is particularly so given that such judgments may come to the attention of courts in other Contracting States in any event. The courts of all the Contracting States are seeking to apply the same substantive law. It would be most unfortunate if anything were to be done which made it more difficult for the courts of the Contracting States to arrive at common answers to common questions.”

60. In considering this question it must be borne in mind that the cases cited all involved validity challenges. While the dictum from *Frisia* referred to infringement, infringement (or at least infringement by itself without an opposing validity challenge) does not seem to be the material context of the actual cases. The cases tend to concern a timing competition between English validity challenges and EPO validity challenges. Mr Alkin drew attention to that factor. Furthermore, the cases (some of which were considered by Mellor J in his judgment in this case) concern situations where there was an interest in the English proceedings other than an interest in being able to show an English judgment to a foreign court.

61. In *Fujifilm [etc] Ltd v Abbvie Biotechnology Ltd* [2017] EWHC 395 (Pat) Henry Carr J had to consider the grant of “Arrow” declarations (under the inherent jurisdiction). At paragraph 365 he started a section dealing with the legal principles involved in the grant of declarations. He acknowledged in paragraph 367 that a declaration which had no useful purpose was commercially pointless, but in paragraph 368 he acknowledged that the attainment of commercial certainty of itself would be, or could be, a useful purpose. At paragraph 369 he cited *IPCOM v HTC* [2013] EWCA Civ 1496:

“8. The Patents Court judge is entitled to refuse a stay of national proceedings where the evidence is that some commercial certainty would be achieved at a considerably earlier date in the case of the UK proceedings than in the EPO. It is true that it will not be possible to attain certainty everywhere until the EPO proceedings are finally resolved, but some certainty, sooner rather than later, and somewhere, such as in the UK, rather than

nowhere, is, in general, preferable to continuing uncertainty everywhere.”

That demonstrates, if it needs to be demonstrated, that attaining commercial certainty is a legitimate purpose. However, this says nothing about the use of an English decision in a foreign court considering the same patent.

62. At paragraph 372 Henry Carr J considered the value of “spin-off” judgments and he cited *TNS*. Having considered a further authority he said:

“I accept that the spin-off value of a judgment in a contracting state can be very valuable, and it is legitimate for parties to rely upon such judgments in other contracting states. However, it is important not to extend this principle too far. Statements as to the spin-off value of UK judgments have been made in the context of applications to stay pending resolution of EPO oppositions, or applications to expedite trials. Those cases are very different from the present. It is also important to guard against forum shopping, where a declaration from the UK court is sought in cases which have no connection with this jurisdiction.”

The qualifications in that paragraph are of significance in this case. The present proceedings are not really brought because there is a real connection with this jurisdiction, despite the terms of the DNI notice. They are in substance brought in order to achieve some sort of influence in the German court.

63. Henry Carr J then drew some conclusions at paragraph 377:

“377. This [viz *Jameel* and other authorities] shows that when considering whether to grant the declaration in the present case, I am concerned with whether it will serve a useful purpose in the United Kingdom. A declaration which is sought solely for the benefit of foreign courts will rarely be justified, as was emphasised by Lloyd LJ in the FKB Appeal Judgment:

‘95. We are not persuaded that declarations *in the Arrow* form will open any floodgates. The *Arrow* decision is now of some age, and has not resulted in many such cases being brought. The circumstances in which such declarations will be justified, will, we would have thought, be uncommon. Mr Hobbs’ examples of a

business problem in Romania would be unlikely to justify the grant of a declaration by the English court.”

64. In the next section of his judgment Henry Carr J considered the application of his principles to the facts. He came to the conclusion that on the facts before him the declarations would serve a useful commercial purpose in the UK and that they would also promote the dispelling of commercial uncertainty in “the UK (and European market)” (paragraph 397). He was also prepared to accept, on the evidence before him, that the declaration would or might promote settlement – paragraph 407. At the end of the section he turned again to spin-off value:

“411. I now turn to the question of spin-off value. The Claimant submits that the declarations will be influential in other European Court and tribunals, and will make it more difficult for AbbVie to obtain preliminary injunctions, particularly in jurisdictions where validity cannot be challenged well patterns are under opposition in the EPO.

412. I accept that the spin-off value of a judgment in a contracting state can be very valuable, and it is legitimate for parties to rely upon such judgments in other contracting states. However, on reflection and having regard to the legal principles which I have set out above, I have not taken this into account other than to the extent that this issue may have an impact on the UK market...”.

65. What the judge did not do was analyse the circumstances in which an English judgment would be useful in other jurisdictions, but paragraph 411 would seem to indicate that he had the “injunction gap” in mind. Mellor J accepted that relevance in his judgment in this case. That is different from the use to which Dräxlmaier would have wished to put an English judgment from this case. It would also appear that Henry Carr J was very cautious about allowing claims with no real connection to this jurisdiction. That is apparent from what he said, and with his citation from Floyd LJ to the same effect with apparent approval. I would respectfully agree.
66. It is right to point out what the same judge said in another case, *Takeda UK Ltd v F Hoffman-La Roche AG* [2018] EWHC 2155 (Ch). That, like many of the other cases, was a decision on timing. The question was whether an English trial (which would seem to have involved both infringement and validity, as usual) should and could be made to take place before a German infringement trial. In that context Henry Carr J observed:

“11. In my view, it is important to give Takeda at least the opportunity of obtaining a judgment from the UK court, which may have some influence on the Düsseldorf court hearing the infringement action. By a decision of the Bundesgerichtshof, dated 15th April 2010, Xa ZB 10/09, *Roll-Forming Machine*, the Federal Supreme Court held that:

"The German courts are required to consider decisions rendered by organs of the European Patent Office and courts in other EPC contracting states and pertaining to a largely similar issue and, where appropriate, address the reasons leading to a diverging result in the earlier decision. Insofar as points of law are concerned, this also applies, for instance, to the question of whether the subject-matter of a property right was obvious in the light of prior art."

12. The UK courts are always very interested to see decisions of our German colleagues and judges of other EPC Contracting States pertaining in particular to equivalent patents. If I were hearing an infringement case in the UK, I would be very interested to see what decision the German courts had reached.”

67. As in all the other authorities which bear on this point, that case involved a substantive action in this jurisdiction which would have been run even if the question of use of the judgment in foreign proceedings had not arisen. That seems to me to be material consideration, and ultimately a distinction from the present case.

68. In *Fresenius v Carefusion* [2011] EWHC 2959 (Pat) Vos J had to consider whether to order a trial to consider the basis on which a patent failed in circumstances in which the patentee agreed the patent should be revoked (which was apparently the subject of the action) but did not agree the grounds for revocation. The challenger to the patent sought a trial to establish those grounds, and it seems to have relied on being able to use such matters in foreign jurisdiction (see eg paragraph 34). Vos J considered *TNS* (supra) and said:

“32. All Arnold J was saying there was that if the underlying reason for litigation which is contested is that the claimants wish to establish something which can be used in a foreign jurisdiction in the patent context, that is not a good reason for saying that the proceedings are an abuse of process. I respectfully agree.”

69. Yet Vos J refused to allow the case to go on. He said that the successful party had got what it wanted – the patent was revoked and there was no point in disputing the details of the claim. He went on:

“42. I reach this conclusion without any regret. It seems to me that it is not appropriate for the court to try academic questions which may be of interest in other jurisdictions. This applies as much in a patent case as in any other case. The court is here to comply with the legitimate demands and requirements of the parties to resolve live disputes. It is not, in a normal case, here to resolve disputes that may or may not arise, or may already have arisen, in other jurisdictions. The overriding objective makes it perfectly clear that it is to deal with the case justly including, so far as practical “(b) saving expense; and (c) dealing with the case in ways which are proportionate; and (e) allotting to it an appropriate share of the courts resources while taking into account the need to allot resources to other cases.”

“43. If I were to accede to Mr Tappin’s submission and now go in detail into the question of the whys and wherefores of the invalidity of the patent, I would be using court time that could otherwise be used by court users who are unfortunately queueing up to find time to bring their cases before this court.”

70. That is therefore a case in which a patentee wished to maintain a case so that it had the benefit of a finding of this court for foreign litigation purposes and it was not allowed court time to do so. This was not on the basis that do so was an abuse, but it was nonetheless something which the court should not countenance.

71. The case which is closest to the present facts is the decision of Meade J in *Edwards Lifesciences v Meril* (supra). That case has some similarities to the present. A defendant alleged infringer wished to give up its defence and submit to relief, including injunctive and ancillary relief, but it did not wish to submit to a declaration of infringement or make an equivalent express acknowledgment. It appears from the report that there were proceedings elsewhere and paragraphs 17 and 18 make it clear that the parties were concerned about the presentation of the matter abroad, including to a foreign court. At paragraph 28 the judge determined:

“21. In my view, therefore, that case [viz *Fresenius*] supports the submission that I am not constrained to have to consider the question of whether there should be a declaration if I do not think that that is an appropriate use of the court’s resources.

72. Meade J turned to use of a judgment in foreign jurisdictions in paragraph 36:

“36. The fourth reason why a declaration is important for Edwards is for its possible utility in other jurisdictions. There is no concrete evidence about that before me, other than the fact that proceedings in other jurisdictions are going on. That would not stop me taking account of it and, in a number of cases concerning *Arrow* declarations and the like, the court has simply taken judicial notice of the fact that decisions of the Patents Court are given weight abroad. But the current situation is rather different from that, because whatever step is taken by me here, the court in another jurisdiction will be aware that Meril’s attitude is that they gave up for pragmatic reasons, and any trial that were undertaken as Edwards seeks would have been opposed by Meril.

37. I am not persuaded that either a judgment made because Meril under (it would say) coercion, gives an admission, or a judgment made after consideration of the merits when Meril is not present will have material weight in any foreign jurisdictions. It is established on the authorities that it is entirely proper for a patentee bringing proceedings in the UK to want to get a decision which can be considered in other jurisdiction. But that is not the same thing as saying that the court should go ahead and give an inappropriate amount of resources to litigation here, simply so that can happen.”

73. In the remainder of his judgment he considers that the amount of court resources that would be required to go forward to a trial for a declaration would not be merited. At paragraph 43 he concluded

“43. I ought to say that in reaching this conclusion, I have had in mind that the amount of court time sought by Edwards is really very substantial. I accept the submission made on Edwards’ behalf that it is a lot less than if all the trials had gone ahead, but nonetheless, one day’s reading, two days in court and judgment-writing time is a lot of time to ask for the making of declaration without the attendance of the other side and which would probably not be of practical (as opposed to presentational) importance. That has been an important part of my thinking.”

74. It is right to observe that it was an important part of Meade J’s reasoning that the declaration sought would be of less weight because the grant would have been unopposed, which suggests that it might have affected his decision if he thought a decision would have had more weight abroad, but nonetheless he still applied a consideration of a waste of court resources.

75. Reviewing those authorities, it is apparent that none of them quite raise the question which arises in these proceedings. In the light of my finding as to motivation, and looking at the matter realistically, the main reason, and the only real reason, for the DNI proceedings was to obtain an English decision in advance of the German proceedings so that it could be deployed there. There is no substantial evidence that it would promote market certainty to any significant extent, and no evidence that it would promote a settlement of other proceedings. Although I cannot ignore Dräxlmaier's evidence on the point, such as it is, I give it little weight. The reality, as I find it to be, is that the real motivation was the use in foreign proceedings. That distinguishes this case from all the reported cases were cases in which there was a genuine domestic interest in the issues raised, whether infringement or revocation, at least at the outset of those proceedings. The remarks of Arnold J and Henry Carr J have to be read in that context.
76. From the authorities I draw the following points:
- (a) There is no abuse authority directly in point in terms of an action which raises only infringement, and not validity, claims.
 - (b) An intention to use an English decision in foreign proceedings is not of itself an intention amounting to an abuse of process.
 - (c) This is plainer in relation to validity issues as opposed to infringement issues. This may be partly because section 72 of the Act would seem to allow anyone to apply for revocation without reference to standing or commercial need, and perhaps because of the "injunction gap" point.
 - (d) All the authorities are cases in which it would seem there was a real legitimate UK-based reason for the proceedings as they were originally constituted. The desire to deploy an English decision in a foreign court was an additional, and not the sole or predominant, reason for the English proceedings.
 - (e) I accept that *TNS* became a case in which use in foreign proceedings became a justification for continuing proceedings which had apparently lost their original justifications. It was, however, a validity case in which Arnold J came to the view that the claimant's desire to have commercial certainty on validity justified the continuance of the proceedings and there was no abuse.
 - (f) It does not follow that in all cases, and in infringement only cases, a desire to have an English decision to present to a foreign court addressing the same issues, is necessarily non-abusive.
 - (g) Henry Carr J (*Abbvie* at paragraph 372) and Vos J (*Fresenius* at paragraph 42) and Floyd LJ (*Omnifarm* at paragraph 154(v)) all expressed views which were contrary to allowing proceedings to be brought, or continued, in this jurisdiction where they were academic here and (in the case of Henry Carr J) smacked of forum shopping.
77. In the light of those views I consider that I am not bound by Arnold J's broad statements to hold that an infringement claim, or its counterpart DNI claim, can be brought in this jurisdiction solely or essentially for the purpose of the decision being used to influence a foreign court. I prefer the views summarised at paragraph 76(g) of this judgment, and that such proceedings could and should be struck out as an abuse, or at the very least

stayed on case management grounds. I express no views as to whether that applies to validity claims, to which different considerations may apply.

78. It is likely that this will seldom apply in a DNI case. A claimant in such a case has to allege and substantiate that it is doing or proposes to do something in the jurisdiction which might be an infringement. That averment would be sufficient to bring about a connection with the jurisdiction which makes the question non-academic even if it is also intended to get a decision for the benefit of a foreign court. If it is an inaccurate averment and can be demonstrated to be such then the proceedings could be struck out for lack of standing, and one does not get to the question of collateral use. However, the question can still be made to arise in the odd circumstances of the present case.
79. The abuse analysis, or the desirability of a stay, can also be made to arise in a situation similar to that before Meade J in *Meril*, where the original local justifications for a claim have gone and all that is left is a desire to have an English judgment for the foreign court. Whether or not one characterises the situation as an abuse of process at that point (and Meade J preferred not to) the action should not be allowed to proceed.

The application of those conclusions to this case

80. The strict context in which this arises in the present case is an application which seeks to establish that the present proceedings always have been, or have become, an abuse of process. However, in the light of the case law it will also be useful to consider whether the proceedings should also be stayed on a case management basis, as Meade J did in *Edwards v Meril*. I also bear in mind that this case is now just about costs, since both sides consider there is no need for it any more (for their own separate reasons) and need to have costs dealt with as a result. I shall therefore make some findings about the conduct of the parties for that purpose.
81. Looking at the proceedings as they were commenced, they did not, of themselves, look like an abuse. Dräxlmaier was prepared to say, in Particulars of Claim verified by a statement of truth, that it had carried out or proposed to carry out potentially infringing acts in this jurisdiction. Furthermore, Mr Hussey, solicitor to Dräxlmaier, said in a witness statement that his client “took steps to clarify its commercial position in the United Kingdom” by sending the section 71 notice. They could certainly not be characterised as an abuse at that stage on the footing that BOS had given, or would give, all or more than could be obtained in the proceedings, because BOS had not at the time engaged with Dräxlmaier after the DNI notice. It was, in my view, keeping a low (or non-existent) profile in the hope that it could get away without having to confront the issue of infringement. By not responding it was asking for trouble.

82. The position changed, and reality intervened, after service of the proceedings. BOS embarked on its steps to remove the patent from the fray without admitting non-infringement. The true nature of the claim then became apparent. Dräxlmaier was determined to keep its proceedings going against a defendant which did not wish to assert its patent. That is obvious. The tactical step of opposing the surrender of the patent made clear what was pretty clear from the paying of the renewal fee, that it was more important for Dräxlmaier to have a target for these proceedings than to resolve the commercial aspects of theoretical (but unlikely) potentially infringing activities in this jurisdiction. If Dräxlmaier had been interested in resolving its infringement position in this jurisdiction, then once the surrender was offered it would have gone along with it and sought to safeguard any residual concerns (if any) by other agreements. As Mr Hussey himself acknowledged, that was a relinquishment of rights. It is not easy to see what legitimate residual concerns would have existed, because a surrender (unlike a lapse) would have prevented any actions for historical infringements (contrary to a suggestion made by Mr Campbell in his skeleton argument) – see section 29(3) of the 1977 Act. If Dräxlmaier had engaged properly on the issue then BOS is likely to have proffered what was necessary, short of an admission of non-infringement. That is demonstrated by the undertaking that was subsequently offered. All that would have removed the commercial significance of the action in this jurisdiction and rendered it academic (if it was not already). As Mr Alkin submitted, Dräxlmaier was offered, and obtained, far more, in commercial terms, than it could have obtained in these proceedings, which were confined to possible infringement by one product. The prolongation of this action beyond the surrender offer has been motivated by a desire to keep the proceedings alive in reality not for the purposes of getting a useful judgment here but for the purposes of getting a judgment which it was thought would be useful in German proceedings. For the reasons given above that is not a legitimate purpose for these proceedings.
83. From that point, therefore, and at the latest, it was apparent that these proceedings were not such as to justify the devotion of court resources to it, and they ought to have been brought to an end then. It would just about be possible to characterise this as an abuse if it is necessary to do so, but I doubt if that characterisation matters now that the parties have agreed the proceedings should not proceed further because they have no point. Since this application is now all about costs, it is right that I should record that, whether or not one applies the “abuse” label, the proceedings were unjustifiably maintained by the claimant from that time.
84. That leaves the question of whether the same applies to the preceding period, when the action was commenced and delayed for reasons of service. Logically it does. I consider that on the facts the real motive for these proceedings was the same all along, and the proper approach to this matter requires that that be acknowledged even though Dräxlmaier technically had a claim that it proposed to do something relevant in this jurisdiction. In truth this action was not about any such thing. Accordingly, the action should never have been brought, whether an abuse or not.

85. Again, however, with an eye to costs arguments, I should record that BOS is far from blameless in this matter. The action got under way because of its failure to engage at all after service of the DNI notice. Even if it did not want to respond directly to the notice, if its attitude was that it did not seek to press the patent and make any claims (as it has been revealed to be) then it should have said so at that time. If it had said so at the time then events might have taken a different course, and the litigation might have been avoided if the parties could have reached the present situation earlier when the issues were flushed out. Of course, my findings on the real motivation of Dräxlmaier mean that that they might have started proceedings anyway even if the surrender was offered much earlier as long as the German proceedings were extant, but, as I have already said, in not responding to the DNI notice at all BOS was at the very least asking for trouble. The significance of this on costs will have to be worked out.

The order to be made

86. In my view the better order to make would be to stay these proceedings generally, rather than the temperature-raising and probably unnecessary order of a striking-out. However, that should not disguise or minimise the significance of the finding that these proceedings have been pursued when they should not have been.
87. That conclusion leaves the costs to be decided. My findings above are intended to operate in that context and I would hope (with less than the usual level of sanguinity) that the parties can agree the costs consequences. If and to the extent that they do not then I will, of course, decide the point. I will decide costs either on paper or at a hearing, depending on the level of disagreement. The parties will be invited to indicate the levels of disagreement and agreement and I will then decide how the dispute should be disposed of.