

THE AGREEMENT ESTABLISHING A UNIFIED PATENT COURT
AND ITS IMPACT ON THE BRUSSELS I RECAST REGULA-
TION. THE NEW RULES INTRODUCED UNDER REGULATION
(EU) NO 542/2014 IN RESPECT OF THE UNIFIED PATENT
COURT AND THE BENELUX COURT OF JUSTICE*

L'ACCORDO ISTITUTIVO DEL TRIBUNALE UNIFICATO DEI
BREVETTI E LA SUA INCIDENZA SUL REGOLAMENTO BRU-
XELLES I-BIS. LE NUOVE DISPOSIZIONI INTRODOTTE DAL
REGOLAMENTO N. 542/2014 RELATIVAMENTE AL TRIBUNA-
LE UNIFICATO DEI BREVETTI E ALLA CORTE DI GIUSTIZIA
DEL BENELUX

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Abstract: The present study deals with the agreement establishing a Unified Patent Court (UPC), signed by 25 EU Member States on 19 February 2013 and its impact on the rules on jurisdiction in civil and commercial matters as contained in Regulation (EU) No. 1215/2012 (s.c. “Brussels I Recast Regulation”), which replaces the pre-existing Brussels I Regulation. The study analyses the new rules introduced in the Brussels I Recast Regulation through Regulation (EU) No 542/2014, making provision for the application of the rules on jurisdiction as contained in the Regulation to the UPC as well as to the Benelux Court of Justice, as judicial bodies common to several Member States. As concerns the UPC, the new rules introduced by Regulation No 542/2014 appear welcome, insofar as they provide for the enlargement of the territorial scope of the competence of the UPC itself, a competence that the agreement itself considers as exclusive. Nonetheless, the new rules fall short of addressing effectively the problems of coordination of the exclusive jurisdiction provided for under Article 24.4 of the Brussels I Recast Regulation in respect of actions concerning registration or validity of intellectual property rights, including European patents, with other heads of jurisdiction such as that provided for under Art. 7.2 of the same Regulation in respect of actions in matters of tort or delict, such as those concerning the infringement of the same rights.

Keywords: Unified Patent Court, courts common to several Member States, Brussels I Recast Regulation, jurisdiction in civil and commercial matters, conflicts of jurisdiction.

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Riassunto: Lo scritto esamina l'accordo istitutivo del Tribunale unificato dei brevetti, firmato da 25 Stati Membri dell'UE il 19 febbraio 2013 e la sua incidenza sulla disciplina della competenza giurisdizionale in materia civile e commerciale contenuta nel regolamento n. 1215/2012 (c. d. "Bruxelles I-bis"), che sostituisce il precedente regolamento Bruxelles I. Lo scritto si sofferma sulle nuove disposizioni inserite nel regolamento Bruxelles I-bis mediante il regolamento n. 542/2014, relativo all'applicazione delle regole contenute nel regolamento n. 1215/2012 al Tribunale unificato dei brevetti e alla Corte di giustizia del Benelux, quali organi giurisdizionali comuni a più Stati membri. Per quanto riguarda il Tribunale unificato dei brevetti, le nuove disposizioni appaiono opportune nella misura in cui comportano un'estensione *ratione loci* della competenza del Tribunale, competenza la quale presenta carattere esclusivo. Nondimeno, le nuove disposizioni presentano il limite di non affrontare adeguatamente i problemi di coordinamento della giurisdizione esclusiva prevista dall'art. 24, n. 4, del regolamento Bruxelles I-bis rispetto alle azioni concernenti la registrazione o la validità dei diritti di proprietà intellettuale, inclusi i brevetti europei, con altri criteri di giurisdizione come quello previsto dall'art. 7, n. 2, del regolamento per le azioni in materia di illeciti civili, come quelle concernenti la violazione dei diritti in questione.

Parole chiave: Tribunale unificato dei brevetti, Organi giurisdizionali comuni a più Stati Membri, Regolamento Bruxelles I-bis, Giurisdizione in materia civile e commerciale, Conflitti di giurisdizione.

Summary: I. The agreement establishing a Unified Patent Court (UPC) and the EU regulations creating an enhanced cooperation in the field of unitary patent protection. II. The competence *ratione materiae* of the UPC and the residual role of the courts belonging to Member States that are Contracting Parties to the agreement establishing the UPC. III. Coordination with the rules on jurisdiction in civil and commercial matters under the Brussels I Recast Regulation. IV. The new rules under Articles 71(a) to 71(d) of the Brussels I Recast as introduced through Regulation (EU) No 542/2014: in particular: the extension of the jurisdiction of the UPC as a court common to several Member States to third-country related disputes. V. The relationships with the courts of Member States that are not Contracting Parties to the agreement establishing the UPC. VI. Concluding remarks.

I. The agreement establishing a Unified Patent Court (UPC) and the EU regulations creating an enhanced cooperation in the field of unitary patent protection

1. The representatives of 25 EU Member States signed in Brussels on 19 February 2013 an international agreement establishing a Unified Patent Court (UPC)¹. The agreement is to be intended as closely intertwined with the substantive rules introduced by means of two EU regulations implementing an enhanced cooperation as among, currently, 26 Member States, of which, as it is worth noting, 25 signed the agreement establishing the UPC². Those EU regulations establish an optional unitary protection regime in respect of European patents³, which remain subject as far as their registration is concerned to the European Patent Convention⁴, as well as uniform rules concerning the relevant translation arrangements⁵.

¹ Agreement on a Unified Patent Court (2013/C 175/01), *O.J.E.U.*, C 175 of 20 June 2013, p. 1 ff.

² In fact, whereas all at that time existing EU Member States except Poland and Spain were signatories to the agreement establishing the UPC, all at that time existing EU Member States except Spain have decided to participate to the enhanced cooperation in the field of unitary patent protection. Actually, Italy notified its intention to participate at a later stage, and its participation has been confirmed by the European Commission, pursuant to Article 331, para. 2, TFEU, on 30 September 2015. So far, Croatia, that joined the EU after the creation of the enhanced cooperation and the adoption of the agreement establishing the UPC, does not participate to either initiative. It may nonetheless decide to join, as concerns the enhanced cooperation pursuant to the procedure under Article 331 TFEU, and in respect of the agreement pursuant to its Article 84, para. 4.

³ Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection, *O.J.E.U.* L 361 of 31 December 2012, p. 1 ff.

⁴ European Patent Convention adopted at Munich on 5 October 1973, as amended on 17 December 1991 and on 29 November 2000 (EPC), 15th edition of September 2013, available on the European Patent Office website at www.epo.org.

⁵ Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, *O.J.E.U.* L 361 of 31 December 2012, p. 89 ff.

2. On the one hand, the grounds which brought the participating Member States to opt for an enhanced cooperation in order to introduce such a unitary patent protection regime are to be found in the difficulty to reach an agreement among all the Member States, particularly as concerns the applicable translation regime. The latter raised opposition most notably by Italy and Spain, who did not accept the solution embodied in Regulation No 1260/2012, which considers as acceptable, as a general rule, a translation of the patent in one of the official languages of the European Patent Office, namely English, French and German⁶. On the other hand, the decision to conclude an international agreement among the Member States concerned for the purposes of establishing a unified patent court is due to the difficulty to place such an initiative within the scope of the competences of the EU.

In fact, the enhanced cooperation which implied the adoption of both Regulations No 1257/2012 and No 1260/2012 finds its legal basis under Article 118 TFEU. Respectively, the former Regulation found the relevant legal basis under paragraph 1 of the rule, which provides for EU acts to be adopted pursuant to the ordinary legislative procedure for the purposes of creating European intellectual property rights possessing a unified protection regime or centralized authorization, coordination and supervision arrangements. The latter Regulation found instead its legal basis under paragraph 2 of the same rule, which provides, differently, for acts to be adopted pursuant to a special legislative procedure, requiring adoption by unanimity in the Council, for the purposes of the establishment of language arrangements in respect of such rights. Neither of the two legal bases could justify the establishment of a common judicial body competent in respect of disputes concerning those rights, such as the UPC. In fact, the possibility of establishing such a judicial body is not contemplated under either paragraph of the rule, even though, as highlighted in the preamble to the agreement establishing the UPC, the latter pursues the aim of making the system of unitary patent protection established through Regulations No 1257/2012 and No 1260/2012 more effective. Actually, the establishment of the UPC strives to complete on the jurisdictional side the effort of creating a unified system of patent protection that the two Regulations just mentioned have undertaken on the substantive side⁷.

3. It is worth mentioning that a special provision in this respect is nonetheless to be found in the Treaties, namely under Article 262 TFEU, formerly introduced into the EC Treaty by the Treaty of Nice as Article 229 A. The said rule, actually, does not contemplate the establishment of a specialized judicial body, but, conversely, makes provision for the attribution to the ECJ of further competences in respect of intellectual property rights forming the subject of unitary protection under EU acts. This solution, which would prove more straightforward from an institutional perspective, presents nonetheless the inherent difficulty of requiring unanimity in the Council for the adoption of a decision by the latter providing for the attribution of the said additional competences to the ECJ. Such a decision, implying an extension of the competences of the ECJ as defined in the Treaties, would have then required to be approved by the Member States pursuant to their respective constitutional requirements⁸. The inevitable difficulty in reaching unanimity in this respect and the impossibility to have recourse to an enhanced cooperation for

⁶ Cf. Article 3(1), Regulation No 1260/2012 and Article 14(6), EPC; among others, M. LAMPING, "Enhanced Cooperation – A Proper Approach to Market Integration in the Field of Unitary Patent Protection?", *IIC – International Review of Industrial Property and Copyright Law*, 2011, p. 879 ff, at 899 ff; F. POCAR, "Brevi note sulle cooperazioni rafforzate e il diritto internazionale privato europeo", *Rivista di diritto internazionale privato e processuale*, 2011, p. 297 ff, at 302 ff. Italy and Spain eventually brought the case before the ECJ seeking at first unsuccessfully the annulment of the Council decision authorizing the enhanced cooperation: cf. ECJ, 16 April 2013, Cases C-274/11 and C-295/11, *Kingdom of Spain and Italian Republic v Council of the European Union*, EU:C:2013:240, with then Spain only seeking, again without success, the annulment of the two regulations: cf. ECJ, 5 May 2015, case C-146/13, *Kingdom of Spain v European Parliament and Council of the European Union*, EU:C:2015:298, concerning Regulation No 1257/2012; ECJ, 5 May 2015, case C-147/13, *Kingdom of Spain v Council of the European Union*, EU:C:2015:299, concerning Regulation No 1260/2012.

⁷ Cf. the Preamble to the Agreement on a Unified Patent Court, Recitals 4 and 5.

⁸ Cf., on the rule as formerly contained under Article 229 A, EC Treaty, J. P. TERHECHTE, *sub Art. 229a EGV*, in E. GRABITZ, M. HILF, M. NETTESHEIM (eds), *Das Recht der Europäischen Union*, vol. III, München, Beck, 2009, p. 1 ff; on the current Article 262 TFEU, R. MASTROIANNI, *sub Art. 262*, in A. TIZZANO (ed.), *Trattati dell'Unione europea*, Milano, Dott. A. Giuffrè Editore, S.p.A., 2014, p. 2045 ff, both pointing to the fact that the rule had been expressly conceived in the Treaty of Nice in order to provide for an autonomous EU jurisdictional system in patent matters.

the purposes of adopting an act extending the competences of the ECJ as defined in the Treaties⁹ featured among the driving factors of the alternative solution embodied in the agreement establishing the UPC, which the ECJ had accepted as compatible with the rule under consideration¹⁰.

II. The competence *ratione materiae* of the UPC and the residual role of the courts belonging to Member States that are Contracting Parties to the agreement establishing the UPC.

4. An essential feature of the UPC lies in its nature as a common judicial body to the Member States having established it by participating to the agreement concluded for that purpose. This is not a novelty within the EU legal order, since an earlier example of such an institution is to be found in the Benelux Court of Justice, established by an international agreement concluded by Belgium, Luxembourg and the Netherlands on 31 March 1965 and amended in 2012 with an extension of the powers of that court. In comparison to the latter court, it must be noted, nonetheless, that the UPC appears as quite different a model of common judicial body. In fact, on the one side, the subjective scope of the UPC is much broader than that of the Benelux Court, which operates in the narrow regional domain of the three neighboring countries having established it, whereas, on the other side, the substantive scope of competence of the UPC is sensibly more specialized than that of the Benelux Court, and, as noted already, it is strictly conceived in relation to the unitary protection regime established through the enhanced cooperation implemented by Regulations No 1257/2012 and No 1260/2012. Notwithstanding this, the differences existing between the two courts, albeit significant, do not reach the point of making it impossible to encompass the two within the same category of judicial bodies common to the Member States having established them¹¹.

5. As specifically concerns the UPC, even though the implementation of the enhanced cooperation aimed at creating a substantive unitary patent protection regime has certainly offered the clue for the establishment of such a court, it is worth noting that its competence is not limited to questions related to European patents with unitary effect pursuant to the mentioned Regulations Nos 1257/2012 and 1260/2012. Besides these, the competence *ratione materiae* of the UPC extends to supplementary protection certificates issued for products protected by a patent, as well as to European patents not having unitary effect that have not yet lapsed at the date when the agreement establishing the UPC enters into force or that have been granted after that date, as well as to European patent applications that are pending at the date of entry into force of the agreement or have been filed after that date¹². The extension of the competence of the UPC to patents not having unitary effect granted after the entry into force of the establishing agreement as well as to patent applications pending at that date or filed subsequently is made

⁹ As provided under Article 20, para. 1, TEU, an enhanced cooperation may be implemented only within the domain of the Union's non-exclusive competences. Cf. M. LAMPING (fn 6), at 896. Actually, the procedure contemplated under Article 262 TFEU would amount to a special procedure for amendment of the Treaties, as it appears clearly from the requirement for a subsequent approval by the Member States pursuant to their respective constitutional requirements: cf. J. P. TERHECHTE (fn 8), at 2; R. MASTROIANNI, (fn 8), at 2047.

¹⁰ ECJ, 8 March 2011, Opinion No 1/09, ECLI:EU:C:2011:123, at 61 ff, considering the procedure under Article 262 TFEU as not the only avenue for establishing a unified patent jurisdiction. To be noted that the Preamble to the agreement establishing the UPC, while avoiding any reference to the rule just mentioned, stresses the need for the Member States contracting parties to the agreement to ensure respect, through the UPC, for the obligation of sincere cooperation, and, in particular, for the duty to cooperate with the ECJ in its role as guardian of EU law. This is reflected in Articles 20 and 21 of the Agreement, respectively posing on the UPC the duty to apply EU law in its entirety and ensure its primacy, and vesting the UPC with the entitlement to request preliminary rulings from the ECJ under Article 267 TFEU, in the same terms as would apply in respect of Member States' courts. In this sense, the text of the Agreement as adopted has catered for the concerns expressed by the ECJ in its above-mentioned Opinion No 1/09, at 83 ff.

¹¹ Accordingly, the European legislator has considered it appropriate to address the two institutions together in introducing the necessary amendments to Regulation (EU) No 1215/2012 (the "Brussels I Recast Regulation") in order to ensure the applicability of its provisions in respect of those judicial bodies: cf. Regulation (EU) No 542/2014 of the European Parliament and of the Council of 15 May 2014 amending Regulation (EU) No 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice, *O.J.E.U.* L 163 of 29 May 2014, p. 1 ff.

¹² Cf. Article 3 of the Agreement establishing the UPC, which defines its scope of application.

subject to a transitional regime, whereby, for a period of seven years from the entry into force of the agreement, actions for infringement or for revocation of a European patent, or for infringement or for a declaration of invalidity of supplementary protection certificates issued for products protected by a patent, may continue to be brought as an alternative before the courts or other authorities of the Member States contracting parties to the agreement which would otherwise be competent in respect of those actions¹³.

6. Once having determined the scope of the competence *ratione materiae* of the UPC, which corresponds with the substantive scope of application of the establishing agreement itself, the agreement identifies the actions falling within the said substantive scope which may be brought before the UPC, vesting the latter with an exclusive competence in respect of such actions. For the said purpose, the agreement adopts the technique of listing exhaustively the actions in question, with the ensuing consequence that, as expressly stated under Article 32, paragraph 2 of the agreement, any action concerning patents or supplementary protection certificates other than those listed under paragraph 1 of the rule will fall residually under the competence of the domestic courts of the Member States contracting parties of the agreement. Actually, the subsidiary competence of such courts appears rather narrow, since the agreement provides quite an extensive listing of the actions falling under the exclusive competence of the UPC. The latter include both actions for infringement of intellectual property rights falling under the scope of application of the agreement and actions for declarations of non-infringement, as well as applications for provisional and protective measures, and for injunctions.

Furthermore, the exclusive competence of the UPC extends to actions and counterclaims for revocation of patents or for declarations of invalidity of supplementary protection certificates, as well as to actions for damages or compensation deriving from the provisional protection afforded to a published European patent application and to actions deriving from the use of the invention prior to the granting of a patent or anyway concerning the right to prior use. Finally, actions concerning licenses for use of a European patent with unitary effect granted pursuant to Article 8, Regulation No 1257/2012¹⁴ and those deriving from decisions taken by the European Patent Office in the exercise of the administrative functions conferred upon it by Article 9 of that Regulation¹⁵ also fall within the exclusive competence of the UPC¹⁶.

III. Coordination with the rules on jurisdiction in civil and commercial matters under the Brussels I Recast Regulation

7. The exclusive competence conferred upon the UPC in respect of the actions listed under Article 32, paragraph 1 of the establishing agreement brings with itself as a consequence that the UPC will substitute itself for the courts of the Member States contracting parties to the agreement which would otherwise have been competent in respect of those actions. This poses inevitably the need to make sure that the rules governing the jurisdiction of the courts of the participating Member States as concerns actions falling under the substantive scope of application of the agreement establishing the UPC are applicable to the latter as they would be in respect of domestic courts. Since the jurisdiction of the participating Member States' courts in respect of the actions falling within the scope of application of the agreement would be governed by the rules currently contained under Regulation (EU) No 1215/2012 (the

¹³ Cf. Article 83 of the Agreement establishing the UPC. See also below, section V, para. 21, concerning the effects of the transitional regime established under the agreement on the application of the rules concerning the coordination between parallel proceedings pending before the UPC and the courts of Member State contracting parties to its establishing agreement.

¹⁴ Article 8 of Regulation No 1257/2012 provides for the entitlement of the proprietor of a European patent with unitary effect to file a declaration with the European Patent Office to the effect of accepting to issue licenses for the use of the patent against a consideration. Such licenses are qualified under para. 2 of the rule as being contractual in nature.

¹⁵ Article 9 of Regulation No 1257/2012 determines the administrative tasks that the Member States participating in the enhanced cooperation confer to the European Patent Office in respect of European patents with unitary effect established pursuant to the Regulation. The rule implements Article 143 of the European Patent Convention, which provides for the power for contracting States establishing among themselves a unified patent protection regime to confer to the EPO supplementary tasks as inherent in the functioning of such a regime.

¹⁶ Cf. the list of the actions coming within the substantive scope of the exclusive competence of the UPC under Article 32, para. 1 of the establishing agreement.

“Brussels I Recast Regulation”), which, as of 10 January 2015, has replaced the pre-existing Regulation No 44/2001 (the “Brussels I Regulation”) in respect of proceedings commenced on or after that date¹⁷, the same rules are, as a matter of principle, deemed to apply in respect of the UPC¹⁸.

8. In this respect, it is worth recalling that under the Brussels I Recast Regulation, like under the pre-existing Brussels I Regulation, some actions in intellectual property matters fall under an exclusive head of jurisdiction, which is currently contemplated under Article 24(4) of the Brussels I Recast Regulation. The said rule provides that the courts of the Member State of filing or registration of a patent, trademark or other similar right subject to registration shall have exclusive jurisdiction in respect of any action concerning the registration or the validity of such rights. The rule specifies, codifying the interpretation adopted by the ECJ in respect of the pre-existing provision contained in Article 22(4) of the Brussels I Regulation, that the exclusive jurisdiction contemplated by the rule extends also to cases where an issue of registration or validity of such a right is raised as a defence¹⁹.

Article 24(4) of the Brussels I Recast Regulation further provides in its second sentence that in cases concerning registration or validity of a European patent, without prejudice for the jurisdiction of the European Patent Office under the European Patent Convention, the courts of each Member State shall have exclusive jurisdiction in respect of the European patent granted for that Member State. The rule reflects the peculiar structure of European patents under the Munich Convention of 1973, whereby such rights are articulated in a bundle of parallel intellectual property rights, each producing effect in respect of the Member State for which it has been granted. In terms of jurisdiction, this brings with itself as a consequence that in case a European patent is granted for more Member States, the courts of each of them shall have exclusive jurisdiction in respect of actions concerning the registration or validity of the patent as concerns the individual Member State, with unwelcome effects, in case such actions are brought simultaneously in different Member States, from the perspective of judicial harmony as concerns the assessment of the validity of such a patent²⁰.

¹⁷ Cf. Articles 66 and 81 Brussels I Recast Regulation. For an overview of the innovations introduced by the Brussels I Recast Regulation, among others, J.-P. BERAUDO, “Regards sur le nouveau règlement Bruxelles I sur la compétence judiciaire, la reconnaissance et l’exécution des décisions en matière civile et commerciale”, *Journal du droit international – Clunet*, 2013, p. 741 ff; H. GAUDEMET-TALLON, C. KESSEDIAN, “La refonte du règlement Bruxelles I”, *Revue trimestrielle de droit européen*, 2013, p. 435 ff; A. LEANDRO, “Prime osservazioni sul regolamento (UE) n. 1215/2012 («Bruxelles I bis»)”, *Il giusto processo civile*, 2013, p. 583 ff; P. A. NIELSEN, “The New Brussels I Regulation”, *Common Market Law Review*, 2013, p. 503 ff; A. NUYTS, “La refonte du règlement Bruxelles I”, *Revue critique de droit international privé*, 2013, p. 1 ff; F. SALERNO, *Giurisdizione ed efficacia delle decisioni straniere nel regolamento (UE) n. 1215/2012 (rifusione)*, Padova, Wolters Kluwer – CEDAM, 2015, p. 1 ff.

¹⁸ Cf. Article 31 of the Agreement, expressly providing that the jurisdiction of the UPC – which the agreement unusually defines as “international jurisdiction”, probably with the intent of marking more clearly the distinction from the competence *ratione materiae* of the UPC itself as regulated under the subsequent Article 32 – is to be established in accordance with the Brussels I Recast Regulation. Alongside the Brussels I Recast Regulation, the rule refers also, where applicable, to the Lugano Convention of 30 October 2007, probably with the intent of extending the subjective scope of the jurisdiction of the UPC, an effort made superfluous by the amendments introduced through Regulation (EU) No 542/2014, which will be examined in due course.

¹⁹ ECJ, 13 July 2006, case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG (GAT) v Lamellen und Kupplungsbau Beteiligungs KG (LuK)* ECLI:EU:C:2006:457, para. 24 ff. Cf., among others, P. FRANZINA, “Considerazioni intorno alla cognizione delle questioni pregiudiziali nella disciplina comunitaria della competenza”, *Int’l Lis*, 2006, p. 119 ff; M. WILDERSPIN, “La compétence juridictionnelle en matière de litiges concernant la violation des droits de propriété intellectuelle. Les arrêts de la Cour de justice dans les affaires C-4/03, GAT c. LUK et C-539/03, Roche Nederland c. Primus et Goldberg”, *Revue critique de droit international privé*, 2006, p. 777 ff; P. SCHLOSSER, “Report on the Application of the Judgment Regulation in the Member States, VII. Intellectual Property Rights”, in B. HESS, T. PFEIFFER, P. SCHLOSSER (eds.), *The Brussels I-Regulation (EC) No 44/2001, The Heidelberg Report on the Application of Regulation Brussels I in 25 Member States (Study JLS/C4/2005/03)*, München, Beck, 2008, p. 190 ff.

²⁰ Cf. ECJ, 13 July 2006, case C-539/03, *Roche Nederland v Primus* ECLI:EU:C:2006:458, para. 25 ff., excluding the application of the rule on related actions under Article 6(1) Brussels I Regulation (*i.e.*, current Article 8(1) Brussels I Recast Regulation) in respect of actions for infringement of the same European patent brought before the courts of different Member States, on the assumption that each of these actions concerns the respective national parts of the patent: see P. SCHLOSSER (fn 19), at 195 f.; ECJ, 12 July 2012, case C-616/10, *Solvay SA v Honeywell Flourine Products Europe BV et al.* EU:C:2012:445, with comment by E. TREPOZ, *Revue critique de droit international privé*, 2013, p. 479 ff, allowing the application of the said rule when the actions are brought before the same court of a Member State against defendants domiciled in different Member States, insofar as they concern the infringement of the same national part of a European patent. See also F. MARONGIU BUONAIUTI, *Le obbligazioni non contrattuali nel diritto internazionale privato*, Milano, Dott. A. Giuffrè Editore, S.p.A., 2013, p. 64 ff.

9. In respect of the rules concerning jurisdiction in intellectual property disputes as contained under the Brussels I Recast Regulation it must be noted that the Agreement establishing the UPC provides for a broader scope of the exclusive jurisdiction of the UPC itself as compared to that which would be granted to the domestic courts of the individual Member States under the Brussels I Recast Regulation. In fact, even though, pursuant to the general rule under Article 31 of the Agreement, the jurisdiction of the UPC is to be established pursuant to the Brussels I Recast Regulation, Article 32 of the Agreement itself ends up with conferring to the UPC an exclusive competence in respect of actions for which Member States' courts would be vested, pursuant to the Regulation, with a purely concurrent jurisdiction. Actually, whereas under the Brussels I Recast Regulation the exclusive jurisdiction provided for under Article 24(4) is limited to disputes addressing questions of registration or validity of intellectual property rights subject to registration, including European patents, even if raised as mere defences, under Article 32 of the Agreement establishing the UPC the exclusive competence of the latter extends also to actions of a different nature, including those for infringement of a European patent or a supplementary protection certificate, that under the Brussels I Recast Regulation would be subject to the normal interplay of the general and of the special rules of jurisdiction contemplated by the Regulation. In fact, within the scheme of the Recast Regulation, as already under the pre-existing Brussels I system, in respect of those actions the plaintiff enjoys the benefit of an alternative between the general *forum* of the defendant's domicile pursuant to the current Article 4 Brussels I Recast Regulation and the special *forum* for actions in matters of tort or delict under Article 7(2) of the same Regulation²¹.

10. The need to achieve a satisfactory coordination between the system of allocation of jurisdiction in civil and commercial matters among Member States' courts as embodied in the Brussels I Recast Regulation and the competences of the UPC as devised in its establishing agreement has been expressly acknowledged in the agreement itself, which under its Article 89 expressly subjects its entry into force to the adoption of those amendments to the Regulation as are necessary to ensure the smooth application of its rules to the UPC. As a matter of fact, the said amendments have been rather swiftly adopted through Regulation (EU) No 542/2014, well ahead of the date fixed for the commencement of the application of the Brussels I Recast Regulation²², while the Agreement establishing the UPC is still waiting to reach the minimum number of ratifications required for its entry into force²³.

IV. The new rules under Articles 71(a) to 71(d) of the Brussels I Recast as introduced through Regulation (EU) No 542/2014: in particular: the extension of the jurisdiction of the UPC as a court common to several Member States to third-country related disputes.

11. In fact, following a proposal by the European Commission dating of 26 July 2013²⁴, on 15 May 2014 the European Parliament and the Council have adopted, in accordance with the ordinary legislative procedure, Regulation (EU) No 542/2014, providing for the amendment of Regulation (EU)

²¹ Concerning the problems inherent in the application of the said ground of jurisdiction, previously contemplated under Article 5(3), Brussels I Regulation, among others S. M. CARBONE, *Lo spazio giudiziario europeo*, 6th ed., Torino, G. Giappichelli Editore, 2009, p. 88 ff; H. GAUDEMET-TALLON, *Compétence et exécution des jugements en Europe*, Paris, L.G.D.J., 2010, p. 215 ff; B. HESS, *Europäisches Zivilprozessrecht*, Heidelberg, C. F. Müller, 2010, p. 280 ff; F. SALERNO (fn 17), at 157 ff; F. MARONGIU BUONAIUTI (fn 20), at 15 ff.

²² Fixed on 10 January 2015, pursuant to Article 81 Brussels I Recast Regulation. See, above, fn 17 and corresponding text, with reference also to the transitional regime provided for under Article 66 of the Regulation.

²³ Pursuant to Article 89 of the Agreement establishing the UPC, its entry into force is fixed on the first day of the fourth month after the deposit of the thirteenth instrument of ratification or accession, including those of the three Member States where the highest number of European patents had effect the year before the signature of the agreement itself. For the event that such a requirement would have been met earlier, the rule provided that the entry into force of the agreement would have been postponed to the first day of the fourth month after the date of the entry into force of the amendments to the Brussels I Recast Regulation concerning its relationships with the agreement itself.

²⁴ Proposal for a regulation of the European Parliament and of the Council amending Regulation (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, Brussels, 26 July 2013, doc. COM(2013) 554 final, 2013/0268 (COD).

No 1215/2012 as concerns the rules to be applied in respect of the UPC as well as of the Benelux Court of Justice²⁵. The amendments introduced through Regulation (EU) No 542/2014 aim, as concerns the first of these courts, at ensuring the necessary coordination of the rules of jurisdiction as contained in the Brussels I Recast Regulation with the provisions contained in the Agreement establishing the UPC in respect of its competences. Those amendments pursue the same aim, despite the already noted differences existing between the two courts, as concerns the Benelux Court of Justice, whose competences have been extended through a protocol dating of 15 October 2012, in consideration of the common features that the two institutions present as judicial bodies common to the Member States having established them²⁶.

12. Actually, the technique adopted under Regulation (EU) No 542/2014 consists of supplementing rather than, strictly speaking, amending the text of the Brussels I Recast Regulation, by introducing a series of new provisions in Chapter VII of that Regulation, devoted to the relationships with other instruments²⁷. The first of these provisions, numbered as Article 71(a), places the courts common to several Member States, as are expressly identified under paragraph 2 of the rule with the UPC and with the Benelux Court of Justice, in the same position in which the courts of the Member States having participated in their establishment would have been pursuant to the Regulation. This reflects the already underlined assumption that, as a matter of principle, each of the two courts should substitute itself for the otherwise competent domestic courts whenever the dispute falls within the scope of application of the relevant establishing agreement and the agreement itself provides for the competence of the common court in respect of the dispute. As far as the UPC is specifically concerned, the latter will be vested with jurisdiction under the rule both in those cases where a court of a Member State having participated to the agreement establishing it would have exclusive jurisdiction pursuant to the Brussels I Recast Regulation and in those cases where such a court under the same Regulation would have a jurisdiction that would be merely concurrent with that of the courts of another Member State. This is not likely to cause difficulties insofar as both Member States are contracting parties to the agreement establishing the UPC, since both will be bound by the rule contained in Article 32 of the agreement conferring an exclusive nature to the competence of the UPC in respect of the actions contemplated thereby, with the ensuing consequence of excluding the coexistence of its competence with that of the domestic courts of the Member States having participated in the agreement establishing the UPC. Some difficulties are instead likely to arise in those cases where, pursuant to the Brussels I Recast Regulation, the courts of a Member State contracting party to the agreement establishing the UPC would have jurisdiction concurrently with the courts of a Member State which is not a contracting party to the said agreement, since those courts would not be bound to recognize the exclusive competence of the UPC in respect of the dispute²⁸.

13. The second modification introduced by Regulation No 542/2014 consists of an extension of the subjective scope of the jurisdiction conferred on the UPC or the Benelux Court under the Brussels I Recast Regulation in *lieu* of the ordinarily competent courts of the Member States participating in the relevant establishing agreements, so as to encompass also cases where the defendant to an action is not domiciled in an EU Member State and the Brussels I Recast Regulation would not otherwise confer jurisdiction upon him²⁹. The latter amendment produces the effect, as specifically concerns the UPC, of extending the *erga omnes* perspective inspiring the exclusive grounds of jurisdiction under the

²⁵ Above, fn 11.

²⁶ See above, section II, para. 4, fn 11 and corresponding text.

²⁷ Cf. P. MANKOWSKI, "Die neuen Regeln über gemeinsame Gerichte in Artt. 71a-71d Brüssel Ia-VO", *GPR – Zeitschrift für Gemeinschaftsprivatrecht*, 2014, p. 330 ff, at 331, questioning the correct location of the new provisions within Chapter VII of the Brussels I Recast Regulation and proposing that they could have been more consistently placed after Articles 69-70, devoted to the relationships with agreements concluded among Member States only, rather than after Article 71, concerning instead agreements concluded by Member States with third countries.

²⁸ As it will be noted below, section V, para. 20, Regulation (EU) No 542/2014 has catered for this difficulty by having resort to the traditional mechanisms of *lis pendens* and related actions.

²⁹ Cf. Article 71(b), paragraph 2, as introduced under Article 1, Regulation (EU) No 542/2014; S. M. CARBONE, C. E. TUO, "Non-EU States and Brussels I: New Rules and some Solutions for Old Problems", *Rivista di diritto internazionale privato e processuale*, 2015, p. 5 ff, at 26 ff; P. MANKOWSKI (fn 27), at 334 ff; F. SALERNO (fn 17), at 99 ff.

Brussels I system, including the rule concerning registration and validity of intellectual property rights, which apply irrespective of the defendant's domicile, also to other rules of jurisdiction likely to come for consideration in respect of disputes falling within the domain of the competence of the UPC, with particular regard, as concerns actions for infringement of intellectual property rights, to Article 7(2), Brussels I Recast Regulation, which would normally apply only as against EU-domiciled defendants.

The modification introduced by the rule under Article 71(b), paragraph 2, presents the undeniable advantage of overcoming, albeit for the sole purposes of the application of the agreements establishing courts common to several Member States, the traditional dichotomy between cases where the defendant is EU-domiciled and cases where he is not. As it is well known, the Brussels I Recast Regulation has in fact unsatisfactorily maintained such a distinction, refusing to follow, but for some limited exceptions³⁰, the strong suggestions for its overcoming provided by the European Commission in its proposal for a recast of the pre-existing Brussels I Regulation³¹.

14. The extension in respect of non-EU domiciled defendants of the jurisdiction rules contemplated under the Brussels I Recast Regulation for the purposes of establishing the jurisdiction of the UPC or of the Benelux Court pursuant to the relevant establishing agreements is pursued further also under Article 71(b), paragraph 3, which provides for an extension of the jurisdiction of a common court – essentially, the UPC – as against a non-EU domiciled defendant in respect of disputes related to an infringement of a European patent giving rise to damage within the EU, that is, under the rule contained in Article 7(2) Brussels I Recast Regulation, also as concerns damage arising outside the EU from the same infringement. The said extension is nonetheless subject to a twofold requirement posed by the second sentence of the rule, aimed to secure the existence of a sufficiently close connection between the dispute and the Member State whose courts are seized and to ensure the enforceability of the judgment to be delivered as against a non-EU domiciled defendant on assets located in any Member State party to the agreement establishing the common court³².

In fact, on the one side the extension of the jurisdiction of the common court also in respect of damage caused by an infringement of a European patent in third countries appears reasonable, since it promotes a concentration of the litigation arising from the infringement of the same European patent before a common court, that is, the UPC, avoiding parallel proceedings before the courts of third countries in respect of damage arising there. Such situations, at first sight, could not be dealt with by the subsequent provisions addressing problems of coordination among jurisdictions, since these, at least in the express terms in which they have been conceived, apply only as concerns a common court on the one side and the courts of Member States which are not parties to the agreement establishing such a court on the other side³³. At the same time, inevitably, the said extension has to cater for the risk of third countries refusing to recognize or enforce a judgment given by a common court in the said circumstances, a risk which could exist also as concerns judgments delivered by a domestic court of a Member State in comparable circumstances³⁴.

³⁰ Cf. Article 18(1), in matters of consumer contracts; Article 21(2)(lit. b), in matters of employment contracts; Article 25(1), as concerns choice of court agreements; among others, S. M. CARBONE, C. E. TUO (fn 29), at 6 ff; H. GAUDEMET-TALLON, C. KESSEDIAN (fn 17), at 439 ff; A. LEANDRO (fn 17), at 585 ff; P. A. NIELSEN, (fn 17), at 512 ff; A. NUYTS (fn 17), at 4 ff; F. SALERNO (fn 17), at 81 ff.

³¹ Cf. the Commission's Proposal of 14 December 2010, esp. Article 4, para. 2; R. LUZZATTO, "On the Proposed Application of Jurisdictional Criteria of Brussels I Regulation to Non-Domiciled Defendants", in F. POCAR, I. VIARENGO, F. C. VILLATA (eds.), *Recasting Brussels I*, Padova, Wolters Kluwer – CEDAM, 2012, p. 111 ff; F. POCAR, "Révision de Bruxelles I et ordre juridique international: quelle approche uniforme?", *Rivista di diritto internazionale privato e processuale*, 2011, p. 591 ff, at 595 ff; J. WEBER, "Universal Jurisdiction and Third States in the Reform of the Brussels I Regulation", *Rechtszeitschrift für ausländisches und internationales Privatrecht*, 2011, p. 619 ff., at 623 ff; see also F. MARONGIU BUONAIUTI, "La tutela del diritto di accesso alla giustizia e della parità delle armi tra i litiganti nella proposta di revisione del regolamento n. 44/2001", in A. DI STEFANO, R. SAPIENZA (eds), *La tutela dei diritti umani e il diritto internazionale*, XVI Convegno SIDI, Catania, 23-24 giugno 2011, Napoli, Editoriale Scientifica, 2012, p. 345 ff., at 353 ff.

³² Cf. Article 71(b), para. 3, as contemplated under Article 1, Regulation (EU) No 542/2012; P. MANKOWSKI (fn 27), at 337 ff.

³³ Cf. Article 71(c), to be dealt with below, section V, para. 20 ff.

³⁴ Such a risk is dealt with, e.g., under Article 12, Regulation (EU) No 650/2012 in matters of succession, which allows Member State courts seized of an action in matters of succession involving also assets located in a third country to refrain from

15. The rule under Article 71(b), paragraph 3, second sentence tries, at first, to reduce that risk, by requiring that the dispute as a whole presents a close connection with a Member State party to the agreement establishing the common court, such as would make it appear reasonable from the perspective of the third country concerned for a court sitting in any such Member State, and, accordingly, for a common court acting in its place, to exercise jurisdiction in respect of the dispute, thereby tending to meet the requirement based on the reflexive application of domestic jurisdiction rules frequently present within domestic rules concerning the recognition of foreign judgments. Secondly, in case, notwithstanding the existence of such a connection of the dispute with a Member State contracting party to the agreement establishing the common court, the judgment delivered by that court is still refused recognition by the third country concerned, *e.g.* due to a different appreciation of the close connection requirement or for want of other requirements for recognition provided for under the third country's law, the other requirement posed by Article 71(b), paragraph 3, second sentence tends to ensure that the judgment may be capable of enforcement in a Member State party to the agreement establishing the common court, by requiring that assets belonging to the defendant are located in any such Member State.

In this respect, it is worth noting that, on the one side, the rule does not require such assets to be proportionate to the value of the claim, as would have been reasonable if the purpose of the rule is actually to be identified as that which we have proposed, even though the Preamble to Regulation (EU) No 542/2012 in its Recital 7 suggests that the value of the assets concerned should be taken into account by the common court for that purpose in deciding on whether to exercise its jurisdiction³⁵. On the other side, the rule seems to neglect that also assets belonging to the defendant which are located in a Member State that is not a party to the agreement establishing the common court might come for consideration for the purposes of ensuring enforcement of the judgment to be delivered by the common court, since under Article 71(d) judgments given by a common court are to be recognized and enforced in Member States not parties to the agreement establishing the common court under the ordinary rules contained in the Brussels I Recast Regulation, which, as it is well known, provide for the abolition of *exequatur* as among Member States³⁶.

16. The rule contained in Article 71(b), paragraph 3 is conceived according to the Preamble to Regulation (EU) No 542/2014 under the same Recital 7 as a sort of subsidiary jurisdiction rule³⁷. Actually, it may appear doubtful whether this qualification of the rule is correct, since subsidiary jurisdiction rules as such should provide for a jurisdiction which is not available on other grounds, as it happens, *e.g.*, under Article 6, Regulation (EC) No 4/2009 on maintenance obligations³⁸ or Article 10, Regulation (EU) No 650/2012 in matters of succession³⁹. In the instant case, instead, the rule merely provides

ruling on such assets whenever it can be expected that the judgment to be delivered by the Member State court seized will be denied recognition in respect of those assets in the third country concerned; cf., among others, A. BONOMI, *sub* Article 12, in A. BONOMI, P. WAUTELET (eds), *Le droit européen des successions. Commentaire du règlement n° 650/2012 du 4 juillet 2012*, Bruxelles, Bruylant, 2013, p. 231 ff; A. DAVI, A. ZANOBETTI, 'Il nuovo diritto internazionale privato delle successioni nell'Unione europea', *Cuadernos de derecho transnacional*, 2013, n. 2, p. 5 ff, at 121; A. DAVI, A. ZANOBETTI, *Il nuovo diritto internazionale privato europeo delle successioni*, Torino, G. Giappichelli Editore, 2014, p. 211 ff; A. DUTTA, *sub* Art. 12 EuErbVO, in: J. VON HEIN ET AL. (eds.), *Münchener Kommentar zum BGB*, München, Beck, 2015, paras 1 ff.

³⁵ Cf. the Preamble to Regulation No 542/2014, Recital 7. The latter Regulation follows the regrettable practice, rather widespread in recent EU legislation particularly in the domain of judicial cooperation in civil matters, to supplement the actual text of the act with further specifications, which tend to complete rather than simply explain the grounds of the relevant provisions and clarify their interpretation, something which is a source of uncertainty and possible disputes, given the non-binding nature of statements contained in the preambles to EU acts. Cf., for similar remarks concerning Regulation (EU) No 650/2012 in matters of succession, A. DAVI, A. ZANOBETTI (fn 34, *Cuadernos de derecho transnacional*, 2013, n. 2), at 17, fn 55; A. DAVI, A. ZANOBETTI (fn 34, Torino, G. Giappichelli Editore, 2014), at 23 ff, fn 74.

³⁶ Cf. Article 71(d), to be dealt with below, section V, para. 23.

³⁷ See the Preamble to Regulation (EU) No 542/2014, Recital 7.

³⁸ Cf., among others, M. CASTELLANETA, A. LEANDRO, 'Il regolamento CE n. 4/2009 relativo alle obbligazioni alimentari', *Le nuove leggi civili commentate*, 2009, p. 1051 ff., at 1073 ff; B. ANCEL, H. MUIR-WATT, 'Aliments sans frontières. Le règlement n° 4/2009 du 18 décembre 2008 relatif à la compétence, la loi applicable, la reconnaissance et l'exécution des décisions et la coopération en matière d'obligations alimentaires', *Revue critique de droit international privé*, 2010, p. 457 ff, at 463 ff.

³⁹ Cf., among others, A. BONOMI, *sub* Article 10, in A. BONOMI, P. WAUTELET (eds), *Le droit européen des successions. Commentaire du règlement n° 650/2012 du 4 juillet 2012*, Bruxelles, Bruylant, 2013 (fn 34), p. 211 ff; A. DAVI, A. ZANOBETTI (fn 34, *Cuadernos de derecho transnacional*, 2013, n. 2), at 115 ff; A. DAVI, A. ZANOBETTI (fn 34, Torino, G. Giappichelli Editore,

for an extension of the scope of a jurisdiction already established pursuant to paragraph 2 of the same provision, which makes the qualification of the rule as subsidiary inappropriate, at least if compared with what is meant with that expression in other EU instruments adopted in the field concerned⁴⁰.

17. The said rules providing for an extension of the jurisdiction of the common courts as to the substance are completed under Article 71(b), para. 2, second sentence with a provision concerning the jurisdiction of those courts to grant provisional, including protective measures. The provision appears strictly modelled on that contained under Article 35 of the Brussels I Recast Regulation, since it provides that a common court will have jurisdiction to grant provisional, including protective, measures even if the courts of a third country have jurisdiction as to the substance⁴¹. Nonetheless, the coincidence between the two rules is more apparent than real, since, in order for the rule to be strictly inspired to the same logic as that underlying Article 35 of the latter Regulation, it ought to have referred to the circumstances in which the courts of Member States who are not parties to the agreement establishing the common court have jurisdiction as to the substance of the case⁴². In fact, as noted already, in the logic of Regulation (EU) No 542/2014, common courts act as a substitute for the courts of the Member States participating in the relevant establishing agreement, and their jurisdiction therefore stands in the first place against that of the courts of the other Member States, rather than against that of third countries' courts⁴³.

At the same time, had the rule referred merely to cases where the courts of Member States not parties to the relevant establishing agreement had jurisdiction as to the substance of the case, it would have been totally superfluous, since such cases already fall under the purview of Article 35 of the Brussels I Recast Regulation, thanks to the general rule under Article 71(b), paragraph 1⁴⁴. The latter rule, in fact, places common courts in the same position in which the courts of the Member States contracting parties to the relevant establishing agreement would have been in respect of the exercise of jurisdiction under the latter Regulation. Instead, the rule under consideration gives rise to the same sort of exorbitant jurisdiction against third country courts in respect of the granting of provisional, including protective measures, which Article 35 produces among Member States' courts, by allowing the granting of such measures independently of the existence of jurisdiction as to the substance of the case⁴⁵.

18. Obviously, the rule under consideration is in turn different from that under Article 35 of the Brussels I Recast Regulation in that it contains no specification as concerns the sort of measures which might be sought from a common court under the rule. In this respect, it seems fairly plain that the express reference contained in Article 35 to the law of the Member State whose courts are being seized of an application for such measures is to be intended as replaced in the rule under examination by an implied reference to the rules contained for the same purposes in the agreement establishing the common court concerned⁴⁶.

2014), at 201 ff; A. DUTTA, *sub* Article 10 EuErbVO, in: J. VON HEIN ET AL. (eds.), *Münchener Kommentar zum BGB*, München, Beck, 2015, paras 1 ff.

⁴⁰ See P. MANKOWSKI (fn 27), at 337 ff, noting that the provision in question operates technically speaking as a rule on the scope of the adjudication (*eine Regel über den Umfang der Kognitionsbefugnis*) rather than as an autonomous head of jurisdiction; F. SALERNO (fn 17), at 99, commenting that the rule in question pursues, alongside the previous one under paragraph 2, an exorbitant extension of the scope of application of EU rules of jurisdiction, consistently with the integrationist attitude of the Union; S. M. CARBONE, C. E. TUO (fn 29), at 28, adding to this the further concern that the rule might vest the UPC with an excessive degree of discretion, as would seem to be inherent in the rules in question pursuant to the Preamble to Regulation (EU) No 542/2014, Recital 6.

⁴¹ Cf. Article 71(b), para. 2, second sentence, as set out under Article 1, Regulation (EU) No 542/2012.

⁴² Cf. Article 35 Brussels I Recast Regulation.

⁴³ See above, section III, para. 7.

⁴⁴ Cf. P. MANKOWSKI (fn 27), at 337.

⁴⁵ See, among others, as concerns the latter rule, C. HONORATI, "Provisional Measures and the Recast of Brussels I Regulation: A Missed Opportunity for a Better Ruling", *Rivista di diritto internazionale privato e processuale*, 2012, p. 525 ff.; at 526 ff; A. LEANDRO (fn 17), at 624 ff; A. NUYS (fn 17), at 34 ff.; F. SALERNO (fn 17), at 293 ff.

⁴⁶ Cf. P. MANKOWSKI (fn 27), at 337. As specifically concerns the UPC, its power to grant provisional, including protective measures is governed by Chapter IV of the establishing Agreement, under which, besides provisional and protective measures properly intended (Article 62), further interim measures of a different nature are contemplated (cf. Articles 58-61).

19. Lastly, the rule is silent as concerns the effects of provisional, including protective measures granted by a common court. In this respect, it seems that the effects of such measures in the Member States which are not parties to the agreement establishing the common court concerned fall to be governed by the general rule contained in respect of judgments given by a common court under Article 71(d). This presupposes, first of all, that such measures are entitled to qualify as “judgments” for the purposes of the rule, in which respect the definition contained under Article 2(a) of the Brussels I Recast Regulation, with the inherent limitations as concerns the said measures, applies in the same terms as it would with regard to measures granted pursuant to Article 35 of the Regulation⁴⁷. As concerns, instead, the effects of these measures in third countries, this is inevitably left for the law of the third countries concerned to regulate. These would be at liberty to refuse to give effect to such measures, particularly if their courts would have jurisdiction as to the substance of the case, and even more so if their jurisdiction would be exclusive in nature⁴⁸.

V. The relationships with the courts of Member States that are not Contracting Parties to the agreement establishing the UPC

20. As noted already, the relationships between the UPC, as well as the Benelux Court, on the one side and the domestic courts of the Member States parties to the relevant establishing agreement on the other side are based on the priority of the common courts, so that the domestic courts of those Member States will exercise their jurisdiction under the Brussels I Recast Regulation only in respect of actions not falling within the competence of the common courts as determined pursuant to the relevant establishing agreement. The situation is instead quite different as concerns the relationships with the domestic courts of Member States that are not parties to such agreements, which cannot be considered as obliged to grant any priority to the common courts in the handling of disputes falling under their competence. This state of affairs is reflected in the solution embodied in Article 71(c), paragraph 1, whereby the ordinary rules concerning *lis pendens* and related actions as among different Member States’ courts shall apply in respect of parallel proceedings pending before a common court on the one side and before the courts of Member States not parties to the relevant establishing agreements on the other side⁴⁹.

Such a situation appears particularly likely to arise, as concerns the UPC, in respect of proceedings related to the infringement of a European patent or other intellectual property right falling under the scope of the establishing agreement, since in respect of such proceedings the agreement provides for the exclusive competence of the UPC, whereas under the ordinary rules as embodied in the Brussels I Recast Regulation the courts of the Member State where the defendant is domiciled would have concurrent jurisdiction with the courts of the Member State where the infringement occurred, with the inherent problems of localization which the application of such a rule entails⁵⁰.

21. Analogously, Article 71(c) provides in its second paragraph for the application of the same rules in respect of concurrent proceedings pending before the UPC on the one side and before the domestic courts of the Member States parties to the establishing agreement on the other side during the transitional period provided for under Article 83 of the agreement⁵¹.

⁴⁷ Cf. in this respect O. LOPES PEGNA, “Il regime di circolazione delle decisioni nel regolamento (UE) n. 1215/2012 («Bruxelles I-bis»)”, *Rivista di diritto internazionale*, 2013, p. 1206 ff., at 1207 ff.

⁴⁸ Cf. S. M. CARBONE, C. E. TUO (fn 29), at 28, noting an essential shortcoming inherent in the approach underlying the rules under examination, consisting in their attempting to address from a purely unilateral perspective situations connected with third countries. See below, section VI, para. 28, for further remarks in this respect.

⁴⁹ Cf., concerning the rules in question and the amendments introduced in their respect under the Brussels I Recast Regulation, among others, L. FUMAGALLI, “*Lis alibi pendens*: the Rules on Parallel Proceedings in the Reform of the Brussels I Regulation”, in F. POCAR, I. VIARENGO, F. C. VILLATA (eds), *Recasting Brussels I*, Padova, Wolters Kluwer – CEDAM, 2012, 237 ff; F. MARONGIU BUONAIUTI, “Per una prima lettura del regolamento «Bruxelles I-bis»: il nuovo regime della litispendenza e della connessione privativa”, published on-line at <http://aldricus.com>, 19 December 2012.

⁵⁰ See above, section III, para. 7, fn 18 and corresponding text.

⁵¹ See above, section II, para. 5, fn 13 and corresponding text. Consistently with a general principle of *perpetuatio*

22. The rule under Article 71(c) does not address, instead, situations where concurrent proceedings are pending before a common court on the one side and the courts of a third country on the other side⁵², even though it must be conceded that, at least as far as the UPC is concerned, territorial considerations would make it rather unlikely for third country courts to be seized of actions concerning a European patent or other intellectual property rights granted on a EU level⁵³. For unlikely that the said circumstances might appear, the rules embodied in Articles 33 and 34 of the Brussels I Recast Regulation are in any event to be considered as applicable without need for a specific reference, based on the underlying assumption that, as expressly stated under Article 71(b), paragraph 1, common courts are to be considered as exercising jurisdiction under the Brussels I Recast Regulation *in lieu* of the domestic courts of the Member States parties to the relevant establishing agreement.

Therefore, common courts are subject, as a matter of principle, to the same rules concerning coordination with the courts belonging to countries which are not contracting parties to the agreement as the domestic courts of those Member States would have been. This sufficiently obvious consideration would probably make the entire rule under Article 71(c) redundant of itself, or, rather, would lead to consider it as having a merely pedagogical nature. If the latter assumption is correct, then it would have been more coherent to complete the rule with a reference to Articles 33 and 34 of the Regulation for the event that the circumstances contemplated in those rules might arise⁵⁴.

23. Probably a similar pedagogical intent inspires the rule as contained in Article 71(d), which provides for the application of the ordinary rules contained in the Brussels I Recast Regulation in respect of the recognition and enforcement of judgments delivered by other Member States' courts as concerns, on the one side, the recognition and enforcement of judgments given by a common court in the Member States that are not parties to the relevant establishing agreement and, on the other side, of judgments delivered by a court of a Member State not party to the agreement establishing the relevant common court in the Member States parties to such an agreement.

While the second part of the rule contains probably a statement of the obvious, since it is self-evident that judgments delivered by Member States subject to the Brussels I Recast Regulation that are not contracting parties to the agreement establishing either of the common courts still are judgments delivered by a Member State court pursuant to the Regulation, the first part of the rule concerning judgments delivered by the common courts themselves can easily be considered in turn as a corollary of the general rule under Article 71(b), paragraph 1, whereby common courts are placed as a matter of principle in the same position in which the domestic courts of the Member States participating in the relevant establishing agreement would have been as concerns the exercise of jurisdiction under the Regulation⁵⁵.

24. Lastly, not only tautological, but out of place altogether within a set of rules addressing issues of coordination between the common courts on the one side and the domestic courts of the Member States not participating in the relevant establishing agreements appears the final part of the rule, which would seem to contain, at first sight, a rather obvious specification of the *lex specialis* principle, by stating that the recognition and enforcement of judgments delivered by a common court in the Member States parties to the relevant establishing agreement shall be governed by the pertinent rules contained in

*iurisdictio*nis, Article 83, para. 2 of the Agreement on a Unified Patent Court provides that actions pending before domestic courts under the transitional regime will not be affected by the subsequent expiry of the period established by the rule.

⁵² Which are dealt with under Articles 33 and 34 of the Brussels I Recast Regulation: cf. F. MARONGIU BUONAIUTI, "Lis alibi pendens and Related Actions in the Relationships with the Courts of Third Countries in the Recast of the Brussels I Regulation", *Yearbook of Private International Law*, vol. XV, 2013/2014, p. 87 ff; P. FRANZINA, "Lis alibi pendens Involving a Third Country Under the «Brussels I-bis» Regulation: An Overview", *Rivista di diritto internazionale privato e processuale*, 2014, p. 23 ff.

⁵³ Cf. P. MANKOWSKI (fn 27), at 340.

⁵⁴ Cf. P. MANKOWSKI (fn 27), at 340, also suggesting that for sake of comprehensiveness the rule could have referred to Articles 33 and 34 as well, noting at the same time that the absence of such a reference cannot be interpreted in the sense of excluding the application of those rules altogether.

⁵⁵ See above, section III, para. 7. Cf. also P. MANKOWSKI (fn 27), at 341, noting the merely declaratory nature of the rule under examination.

such agreement rather than by the rules contained in the Regulation⁵⁶. Actually, according to the general rule under Article 71(a), as further specified under the subsequent Article 71(b), paragraph 1, common courts are courts of the Member States contracting parties to the relevant establishing agreement insofar as they exercise jurisdiction under the Regulation, so that their judicial activity is to be considered as collectively attributable to the Member States having established them.

Therefore, it might be questioned whether the rules concerning recognition and enforcement of judgments delivered in other Member States as contained in the Brussels I Recast Regulation could apply at all in respect of judgments which, as far as the Member States contracting parties to the agreement establishing the relevant common court are concerned, are not judgments delivered in *another* Member State. This is confirmed by the fact that, at least as far as the UPC is concerned, pursuant to its establishing agreement judgments delivered by the latter are entirely to be treated in each of the Member States contracting parties to the agreement itself in the same terms as domestic judgments delivered in the Member State concerned⁵⁷.

VI. Concluding remarks

25. Attempting to draw some conclusions from the foregoing analysis, even though it must be borne in mind that at the moment of writing the agreement establishing the UPC is still awaiting its entry into force⁵⁸, its establishment is to be viewed as a useful complement on the jurisdictional level to the creation of a unitary regime concerning the effects of European patents as established through the enhanced cooperation implemented by the two regulations No 1257/2012 and No 1260/2012, since it aims to concentrate before a specialized court common to several Member States most actions concerning the said patents.

In this respect, the choice made in the Agreement establishing the UPC to extend its competence also to actions concerning European patents not having unitary effect, as well as to actions concerning supplementary protection certificates granted on the basis of national patents, appears appropriate. In fact, also in respect of those actions it appears desirable to have access to a centralized system of judicial protection offering a high level of specialization as necessary in respect of intellectual property litigation.

26. Equally appropriate appears, from the same perspective, the solution adopted in the agreement to define in sensibly broad, even though not all-encompassing terms, the competence of the UPC, since this appears likely to contribute to a broader and more effective achievement of the said objectives and to reduce, if not eliminate altogether, the risk of fragmentation of litigation, with the ensuing likelihood of parallel proceedings before different courts and the inherent risk of contradictory judgments being handed down. In this sense, particularly welcome appears the solution of granting to the competence of the UPC

⁵⁶ Cf. P. MANKOWSKI (fn 27), at 341, alleging that the supposed prevalence in terms of *lex specialis* of the rules concerning the effects of UPC judgments as contained in the relevant establishing agreement may find a limit in the *s. c. Günstigkeitsprinzip*, whereby the prevalence of such rules would be subject to their affording a more favourable treatment to those judgments than would have been available under the Regulation, had the latter been applicable as concerns the effects of those judgments in the Member States having established the UPC; F. SALERNO (fn 17), at 100, who appears to construe instead the relationships between the two sets of rules in terms of complementarity.

⁵⁷ In fact, Article 82 of the Agreement on a Unified Patent Court provides that decisions and orders of the UPC shall be directly enforceable in any Member State contracting party to the establishing agreement, subject to an order for the enforcement being delivered by the UPC itself. Paragraph 3 of the rule clarifies that any decision of the UPC is to be enforced in the same conditions as a decision given in the Contracting Member State where enforcement is sought. Consistently with the general rule under Article 71(a), judgments delivered by a common court are, in the Member States parties to the relevant establishing agreement, equivalent to a domestic judgment and not to a judgment delivered in another Member State, as they are, instead, in the Member States that are not parties to such an agreement.

⁵⁸ At the moment of writing, the Agreement on a Unified Patent Court appears to have been ratified only by nine Member States (Austria, Belgium, Denmark, Finland, France, Luxembourg, Malta, Portugal and Sweden, from data published on the Council's website at <<http://www.consilium.europa.eu/en/documents-publications/agreements-conventions/agreement/?aid=2013001>>, consulted on 2 March 2016). See above, section III, para. 10, fn 23, concerning the requirements posed under Article 89 of the agreement for its entry into force.

an exclusive nature, even though this is subject to a long transitional regime within which the competence of the latter will co-exist with that of the otherwise competent national courts⁵⁹. In the same vein goes the decision taken in the agreement to extend such an exclusive competence not only to actions concerning issues of validity and registration but also to actions for infringement of the contemplated rights⁶⁰.

It is particularly in respect of the latter feature of the agreement establishing the UPC that problems of coordination have arisen with the system of allocation of jurisdiction in civil and commercial matters among the Member States of the EU, as embodied under the Brussels I Recast Regulation. As it has been noted, within the latter Regulation exclusive jurisdiction is contemplated only in respect of actions concerning validity or registration of patents or other intellectual property rights subject to registration, and not of actions concerning their infringement, which are instead subject to the concurrent jurisdiction of alternative *fora*⁶¹.

27. The new provisions introduced into the text of the Brussels I Recast Regulation by Regulation (EU) No 542/2014, while on the one side they appear courageous in their effort to overcome the traditional limitations of the scope of application *ratione personarum* of the jurisdiction rules embodied in the Brussels I Regulation's jurisdiction rules which the Recast Regulation itself has left largely untouched, on the other side they are probably too reluctant in their attempt to achieve an effective coordination between the two systems. This would have implied overcoming the said disparity concerning the scope of exclusive jurisdiction in respect of patent litigation, by directly amending the relevant rules of the Brussels I Recast Regulation instead of merely supplementing them with special rules applicable only for the purposes of establishing the jurisdiction of a common court⁶². Such a solution would have been desirable in order to reduce to a larger extent the risk of concurrent proceedings before the UPC and the courts of Member States not parties to its establishing agreement, even though the rules contained in the Brussels I Recast Regulation as concerns *lis pendens* and related actions may be of avail in this respect⁶³.

28. As concerns the problems inherent in third-country related disputes, it must be considered that the already noted technique of unilaterally addressing such situations by means of merely extending the subjective scope of application of EU jurisdiction rules is not entirely satisfactory. In fact, if from the one side this solution presents the advantage of simplicity and of filling a gap which would have been left open due to the impossibility to refer residually to the domestic rules of jurisdiction of an individual Member State for the purposes of establishing the jurisdiction of the UPC, as a court common to several Member States, in respect of a non-EU domiciled defendant⁶⁴, on the other side it risks revealing an intent of creating an exorbitant jurisdiction, with the inherent risk of giving rise to limping situations⁶⁵. As it has been noted, the said technique cannot ensure an effective cooperation by the third countries concerned, which would be at liberty to deny recognition and enforcement to judgments delivered by Member States' courts in respect of disputes which those countries could consider from their own perspective as subject to their potentially exclusive jurisdiction⁶⁶.

⁵⁹ As provided for under Article 83 of the Agreement (see above, section II, para. 5, fn 13 and corresponding text).

⁶⁰ See above, section II, para. 6, concerning Article 32 of the Agreement establishing the UPC.

⁶¹ Above, section III, para. 8 f, with regard to Articles 24(4) and 7(2) of the Brussels I Recast Regulation.

⁶² Above, section IV, para. 13 ff, in respect of the provisions contained in Article 71(b) as introduced into the Brussels I Recast Regulation pursuant to Article 1, Regulation (EU) No 542/2014, concerning the determination of the jurisdiction of a common court.

⁶³ Above, section V, para. 20 ff., with regard to Article 71(c) as introduced into the Brussels I Recast Regulation pursuant to Article 1, Regulation ((EU) No 542/2014.

⁶⁴ Cf. Recital 6 in the Preamble to Regulation (EU) No 542/2014.

⁶⁵ Cf. particularly the critiques by F. SALERNO (fn 17), at 99, and by S. M. CARBONE, C. E. TUO (fn 29), at 28.

⁶⁶ See above, section IV, para. 15 f., commenting on the rule contained under Article 71(b), para. 3, second sentence, requiring the presence of property belonging to the defendant in any Member State party to the agreement establishing the common court in order for that court to exercise jurisdiction as against a non-EU domiciled defendant also in respect of damage arising outside the Union from the infringement of a European patent giving rise to damage within the Union, as well as on the rule contained under Article 71(b), para. 2, second sentence, providing for the power of a common court to grant provisional, including protective, measures even if the courts of a third country have jurisdiction as to the substance of the case.