

*S.J. Schaafsma**

Multiple defendants in intellectual property litigation

Abstract

One of the key provisions in international intellectual property litigation is the forum connexitatis in Article 8(1) of the Brussel I bis Regulation. This jurisdiction provision makes it possible to concentrate infringement claims against various defendants, domiciled in different EU Member States, before one court: the court of the domicile of any one of them. The criteria of Article 8(1) are, however, complicated and the case law of the Court of Justice is not always very clear. This contribution seeks to explore, evaluate and comment on the current state of affairs in respect of Article 8(1) in the context of intellectual property litigation.

1. Introduction

Intellectual property litigation used to be an introverted, national affair. Disputes on infringement of intellectual property rights were, as a rule, litigated before domestic courts applying their national intellectual property laws. Internationalisation occurred in the sphere of legislation. Domestic intellectual property laws were harmonised to a certain extent by treaties introducing minimum standards, such as the Berne Convention 1886 and the Paris Convention 1883.¹ Litigation, however, remained a predominantly domestic matter. This substantially changed in the second half of the 20th century under the influence of economic globalisation and advancing technology, such as the Internet. Today, the exploitation of intellectual property rights is more and more international. Yet, at the same time, with the exception of some unitary rights, intellectual property rights remain national rights. A manufacturer of pharmaceuticals introducing a new drug on the European market, protects this invention by a ‘European patent’, which is in fact a bundle of separate national patents. A photographer of an artistic photograph obtains a copyright in each country. A fashion group protects its trade mark for a perfume by national trade mark rights in each individual country. All these right holders are entitled to a bundle of separate national intellectual property rights covering the same invention, literary and artistic work, or trade mark. These are ‘parallel intellectual property rights’. Obviously, these intellectual property rights can be violated. The manufacturer of pharmaceuticals is confronted with a pharma-group competitor that brings, in each country via its local subsidiary, an infringing drug onto the European market. The

* Prof. Dr. Sierd J. Schaafsma is Professor of private international law at Leiden University, the Netherlands, and a Justice in the Court of Appeal (intellectual property department) in The Hague, the Netherlands. This publication has been written in a private capacity.

¹ Paris Convention on the Protection of Industrial Property of March 20, 1883, as amended on September 28, 1979; Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, as amended on September 28, 1979; both available at <http://www.wipo.int/treaties/en>, visited October 2016.

photographer discovers that art galleries in several countries are reproducing his artistic photograph in brochures. The fashion group discovers an international counterfeit network, trading look-alike perfumes.

These right holders share a common objective in that they aim to enforce their intellectual property rights against not just one infringer, but a number of infringers. For example, the pharma-manufacturer would like to act against all subsidiaries of its competitor, in order to remove the infringing drug from the entire European market. Jurisdiction comes into play here: which national court is competent to hear the infringement claim? Is the manufacturer required to instigate proceedings against each subsidiary of its competitor before the court of its domicile? Hence, should the German subsidiary be sued before the German court for infringement in Germany, the French subsidiary before the French court for infringement in France and so on? This would result in a number of parallel infringement claims concerning what is, in fact, one infringement dispute between two multinationals.² This would result in fragmented litigation. Or would it be possible to combine these infringement claims and bring them before just one competent court? Such a concentration of litigation seems to be more efficient.

In the European context, the answer requires to be found in the Brussels I *bis* Regulation that deals, *inter alia*, with jurisdiction.³ According to the main rule in Article 4, a defendant domiciled in a Member State shall be sued before the courts of that State (*forum rei*). Alternatively, that defendant may also be sued on the basis of Article 7(2) before the courts for the place of the infringement (*forum delicti*). These jurisdiction grounds, however, do not provide for a concentration of claims. Such concentration could be achieved on the basis of Article 8(1). This provision offers, under certain circumstances, the possibility for the right holder to sue several defendants, domiciled in different Member States, in the courts for the place where any one of them is domiciled. This alternative jurisdiction ground – a so-called *forum connexitatis* – plays an important role in international intellectual property litigation. The European Court of Justice has ruled on this provision in more than ten cases (including intellectual property cases), in which the limits of the provision were explored and tested. Those limits are, however, not very clear. Article 8(1) is a difficult provision with a somewhat intangible criterion, and the case law of the Court is not unambiguous.⁴

For the plaintiff, concentration on the basis of Article 8(1) may offer advantages such as cost saving and the coherent determination of the various claims in the entire dispute, resulting in one judgment that will be easily recognised and enforced throughout the European Union.⁵ In addition, once a court has established jurisdiction on the basis of Article 8(1) to hear various, connected claims against several defendants, the *lis pendens* provision of Article 29 Brussels I *bis* Regulation comes into effect and as a consequence this single action bars all of the defendants from starting declaratory proceedings, in which they can seek a declaration

² The constellation in the so-called *Roche* case, see para. 14 et seq., ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:458, NIPR 2006, 2006 (*Roche/Primus*).

³ Regulation (EU) No. 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast), OJ 2012, L 351/1 ('Brussels I *bis* Regulation'). Shortly, the (jurisdiction chapter of the) Regulation applies in civil and commercial matters, which includes intellectual property infringement claims (material scope, Art. 1), against a defendant with domicile in an EU Member State (formal scope, Arts. 4-6), instituted on or after 10 January 2015 (temporal scope, Art. 66).

⁴ See for example the critical remark of A. Dickenson and E. Lein, *The Brussels I Regulation Recast*, Oxford: OUP 2015, p. 188: '[...] its precise meaning and effect remains problematic, the contradictory jurisprudence of the CJEU having contributed to the uncertainty'.

⁵ Art. 36 et seq. Brussels I *bis* Regulation. Cost saving depends of course on the characteristics of the case. Litigating in just one court may be cost-reducing. On the other hand, such proceedings may be more complicated and therefore more expensive. For example, the application of several foreign law systems may increase costs.

of non-infringement in the various countries where they act⁶ or in the country of the domicile of the plaintiff/right holder. Such potential ‘torpedo actions’ are therefore counteracted in advance.⁷ For the co-defendants, it is more difficult to determine the (dis)advantages of Article 8(1) in general terms. Undoubtedly, facing proceedings abroad is considered to be detrimental. On the other hand, co-defendants may also have an interest in a coherent determination of the dispute and a common defence.

This contribution seeks to explore, evaluate and comment on the current state of affairs in respect of Article 8(1) in the context of intellectual property litigation and is based on an analysis of this provision, its genesis and its interpretation in the case law of the European Court of Justice. It focuses on the framework of national intellectual property rights, dealing, where necessary, with the *forum connexitatis* under the realm of unitary intellectual property rights instruments. Firstly, in a general overview, Article 8(1) and its applicability criteria are explored (section 2). Subsequently, the central ‘connection’ criterion of Article 8(1) is examined in detail (section 3), and finally, follow-up questions, such as correction in case of misuse, are considered (section 4).

2. Article 8(1) in general terms

Article 8(1) states that a person domiciled in a Member State may also be sued ‘where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings’. This provision goes back to Article 6(1) of the Brussels Convention 1968.⁸ That provided, in slightly different wording, that a person domiciled in a Contracting State may also be sued, ‘where he is one of a number of defendants, in the courts for the place where any one of them is domiciled’. No mention was made of a connection between the claims made against each of the defendants. In his explanatory report to the Convention, however, Jenard clarified that such a connection is required, quoting as an example the case of joint debtors. Jenard added that an action cannot be brought solely with the object of ousting the jurisdiction of the courts of the State in which the defendant is domiciled, explaining in addition that the provision was adopted in the Brussels Convention ‘because it makes it possible to obviate the handing down in the Contracting States of judgments which are irreconcilable with one another’.⁹ It was this concern – the concern of avoiding the risk of irreconcilable judgments – that was an important *leitmotiv* for the Court of Justice in its first decision on this provision, the 1988 *Kalfelis* decision.¹⁰ Referring to this concern, as expressed in the Jenard Report and in the Convention itself in the provision on related proceedings,¹¹ it held (i) that, in order to prevent this

⁶ Cf. ECJ 25 October 2012, C-133/11, ECLI:EU:C:2012:664, *NIPR* 2013, 48 (*Folien Fischer/Ritrama*).

⁷ See also R. Fentiman in: U. Magnus and P. Mankowski, *Brussels I bis Regulation*, Munich: Sellier 2016, p. 719 et seq.; M. Franzosi, ‘Worldwide Patent Litigation and the Italian Torpedo’, *European Intellectual Property Review* 1997, p. 382-385.

⁸ Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, Brussels, 27 September 1968, *OJ* 1998, C 27/1 (‘Brussels Convention’, consolidated version).

⁹ *OJ* 1979, C 59/27. The provision was not novel at that time. In his report, Jenard mentioned a number of examples in bilateral treaties, for example Art. 2(1) of the Convention of 17 April 1959 between Italy and the Netherlands (a *traité simple*), referring to the court of the domicile of the defendant, or, in case of several defendants in the same dispute, of the domicile of any one of them.

¹⁰ ECJ 27 September 1988, 189/87, ECLI:EU:C:1988:459, *NIPR* 1990, 483 (*Kalfelis/Schröder*). For a general discussion on the Court’s reasoning, see J.A. Pontier and H.J.M. Burg, *EU Principles on Jurisdiction and Recognition and Enforcement of Judgments in Civil and Commercial Matters: According to the Case Law of the European Court of Justice*, The Hague: T.M.C. Asser Press 2004.

¹¹ Art. 22 Brussels Convention (Art. 28 Brussel I Regulation; Art. 30 Brussels I bis Regulation).

provision from being used solely for the purpose of ousting the jurisdiction of the courts of the domicile of one of the defendants, a connection between the claims made against each of the defendants is required, (ii) that the nature of the connection must be determined independently from national conceptions, and (iii) that this connection must be ‘of such a kind that it is expedient to determine the actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings’. It is for the national court to verify in each individual case whether that condition is satisfied. This ‘*Kalfelis* criterion’ was adopted almost literally in the successor to this provision, Article 6(1) of the Brussels I Regulation,¹² and subsequently in Article 8(1) of the Brussels I *bis* Regulation. Since these three provisions are equivalent, this publication, for reasons of simplicity, only refers to Article 8(1).¹³

Taking the above into account, it is generally accepted that the main *ratio legis* of the provision is the avoidance of the risk of irreconcilable judgments.¹⁴ This is, however, not the only rationale. Concentrating closely related claims before one court provides for a coherent determination thereof, which is more efficient (‘expedient’) for the parties (especially the plaintiff) and for the community (judicial costs) as well as being more acceptable from the point of view of justice in the sense that there are no differing results *vis-à-vis* the various defendants.¹⁵ Such concentration facilitates the sound administration of justice, which is one of the aims of this instrument.¹⁶ In its recent *Profit Investments* decision, the Court of Justice summarised that the purpose of this provision is, in accordance with recitals 12 and 15 of the Brussels I Regulation, to meet the wish to facilitate the sound administration of justice, to minimise the possibility of concurrent proceedings and thus to avoid irreconcilable outcomes if cases are decided separately.¹⁷ Thus, the Court implicitly rejected the suggestion that Article 8(1) is dictated by a criterion of pure expediency, based on the interest that lies in having a single hearing and a single decision. This would be contrary to the condition in Article 8(1) that there be a risk of irreconcilable judgments and to the general principle that jurisdiction lies with the courts of the Member State in which the defendant is domiciled (*forum rei*).¹⁸ This also explains the interpretation method that must be applied to Article 8(1): when interpreting this provision, one must bear in mind, not only that the rules of jurisdiction must be highly predictable, but also that this *forum connexitatis*, being a derogation from the main rule of *forum rei*, should be interpreted restrictively.¹⁹

Apart from a connection between the claims at the moment when the proceedings are instituted, Article 8(1) requires that the claims be brought before the court of the *domicile* of one of the defendants (the ‘anchor defendant’) in a Member State. Domicile is a prerequisite.²⁰ This may result in a situation in which a court is competent to hear the claims

¹² Regulation (EC) No. 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, *OJ* 2001, L 012/1 (‘Brussels I Regulation’).

¹³ Recital 19 in the preamble to the Brussels I Regulation, and recital 34 in the preamble to the Brussels I *bis* Regulation; on equivalence, see also, *inter alia*, ECJ 18 October 2011, C-406/09, ECLI:EU:C:2011:668, *NIPR* 2011, 473 (*Realchemie/Bayer*).

¹⁴ Advocate General Darmon, para. 12. ECJ 27 October 1998, C-511/97, ECLI:EU:C:1998:509, *NIPR* 1999, 76 (*Réunion Européenne/Spliethoffs*), para. 48.

¹⁵ H. Muir Watt, in: U. Magnus and P. Mankowski, *Brussels I bis Regulation*, Munich: Sellier 2016, p. 373.

¹⁶ Cf. recital 16 of the Brussels I *bis* Regulation.

¹⁷ ECJ 20 April 2016, C-366/13, ECLI:EU:C:2016:282, *NIPR* 2016, 189 (*Profit Investments SIM*).

¹⁸ Opinion Advocate General Bot, ECLI:EU:C:2015:274, paras. 89, 95.

¹⁹ ECJ 20 April 2016, C-366/13, ECLI:EU:C:2016:282 (*Profit Investments SIM*).

²⁰ Cf. ECJ 27 October 1998, C-511/97, ECLI:EU:C:1998:509 (*Réunion Européenne/Spliethoffs*). Relevant moment is when the proceedings are instituted. Domicile is defined in Arts. 62 and 63 Brussels I *bis* Regulation. Critical: A. Briggs, *The Conflict of Laws*, Oxford: Clarendon 2013, p. 92, who fails to see why a co-defendant cannot be sued in proceedings in a court only having jurisdiction under Art. 7, 25 or 26. In contrast to Art. 8(1) Brussels I *bis* Regulation, for the *forum connexitatis* in Art. 7(1) of the Dutch Code of Civil Procedure it is

against several defendants for infringement in several countries, although in the country of the court where the proceedings are held, no infringement has taken place. An example: suppose an Irish company produces infringing products in its factory in Romania while local subsidiaries distribute and sell these products in various countries in continental Europe. Assuming that the infringement claims are sufficiently connected, these companies may be sued together before the Irish courts, even though there is no (infringement of an) intellectual property right in Ireland. The Irish courts are competent because the anchor defendant is domiciled in that country. In addition, under Article 8, the prerequisite of domicile in a Member State not only applies to the anchor defendant but also applies to the co-defendants that are summoned to the court of the domicile of the anchor defendant. That does not necessarily mean that co-defendants with domicile in non-member States cannot be summoned to that court: possibly, they may be sued there on the basis of a national *forum connexitatis* provision.²¹ However, as far as Article 8 is concerned, the Court of Justice ruled that it does not apply to defendants that are not domiciled in a Member State, in the case where they are sued in proceedings brought against several defendants, before the court of the domicile of one of them.²²

Hence, for Article 8(1) to be applied, three requirements have to be fulfilled.²³ First, the anchor defendant must have his domicile in the Member State of the court where proceedings are raised.²⁴ Second, the co-defendants must have their domiciles in Member States. Lastly, the claims made against each of the defendants must be so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings. This central criterion is dealt with in section 3 below. What is *not* a requirement is the separate establishment that the claims were not brought with the sole object of ousting the jurisdiction of the courts of the Member State where one of the defendants is domiciled. This was decided in the *Freeport* case.²⁵ However, once a connection between the claims is established, a ‘misuse test’ may serve as a correction, switching off Article 8(1) in case of misuse (section 4).

3. Connection between the claims

The central criterion of Article 8(1) is that the claims against the defendants are ‘so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings’. What does this mean exactly?

3.1 ‘Irreconcilable judgments’ in the Brussels I bis Regulation

sufficient in this respect that the Dutch court has jurisdiction with respect to one of the defendants (whether or not on the basis of domicile). On this provision, see Court of Appeal of The Hague 18 December 2015, ECLI:NL:GHDHA:2015:3586, *NIPR* 2016, 80 (*Shell Nigeria* case), with an English translation.

²¹ See Art. 6 and note 20 on the *forum connexitatis* in Art. 7(1) of the Dutch Code of Civil Procedure. See also Dickenson and Lein 2015, p. 186, para. 4.162 (*supra* note 4).

²² ECJ 11 April 2013, C-645/11, ECLI:EU:C:2013:228, *NIPR* 2013, 158 (*Land Berlin*), and Art. 8(1) Brussels I bis Regulation. An exception applies within the framework of the Unified Patent Court (UPC) (Art. 71b(2) Brussels I bis Regulation), see M.C.A. Kant, ‘The Unified Patent Court and the Brussels I bis Regulation’, *NIPR* 2016, p. 706-715.

²³ Cf. R. Fentiman, *International Commercial Litigation*, Oxford: OUP 2015, p. 349. In addition, it should be noted, for the sake of completeness, that Art. 8(1) does not apply in the context of section 3 (insurance) and section 4 (consumer contracts). As to section 5 (employment contracts), see Art. 20(1).

²⁴ More precisely: domicile in the area of the jurisdiction of that court.

²⁵ ECJ 11 October 2007, C-98/06, ECLI:EU:C:2007:595, *NIPR* 2007, 295 (*Freeport/Arnoldsson*).

More specifically, the question arises in respect of what is meant by ‘irreconcilable judgments’. Here, two other provisions come into the picture. The Brussels I *bis* Regulation and its predecessors use this notion in two other provisions, Article 30 on related actions²⁶ and Article 45(1) on the refusal of recognition.²⁷ Should (one of) these notions perhaps be extrapolated to Article 8(1)?

Article 30 offers the possibility, in the case of related actions pending in the courts of different Member States, for any court other than the court first seised to stay its proceedings. Within the framework of this provision, actions are deemed to be related where they are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings, says Article 30(3). In its *Tatry* decision, the Court of Justice ruled that the interpretation of (the predecessor of) this provision must be broad and cover all cases where there is a risk of conflicting decisions, even if the judgments can be separately enforced and their legal consequences are not mutually exclusive.²⁸

Article 45 is on the refusal of the recognition of a judgment from another Member State. The Court clarified in its *Hoffmann* decision that, in this context, the notion ‘irreconcilable judgments’ must be construed restrictively, meaning that the judgments entail legal consequences that are mutually exclusive.²⁹

Should Article 8(1) attune to the broad or to the restrictive notion of ‘irreconcilable judgments’? The case law of the Court of Justice has not been very clear on this point.³⁰ As Advocate General Darmon already pointed out in the *Kalfelis* case,³¹ it is less obvious to follow the restrictive notion of (what is now) Article 45(1) since, as a rule, the legal consequences of different judgments as referred to in Article 8(1) will not be mutually exclusive; although they are contradictory, they can be separately enforced. In addition, it should be noted that Article 45(1) concerns judgments given between the *same* parties, hence a different situation is envisaged. It therefore seems more obvious to follow the interpretation of Article 30, which has the same formula as Article 8(1) and which was, as mentioned above, a source of inspiration for the Court of Justice in its *Kalfelis* decision.³²

It is submitted, however, that for Article 8(1) a third, independent interpretation seems to crystallise in the Court’s case law, which is very close to the broad interpretation in respect of Article 30, but is slightly more restrictive.³³ As Advocate General Trstenjak explained in her informative opinion in the *Painer* case,³⁴ the decision to apply Article 30 will be taken by the court having regard to the need for the harmonious administration of justice, whereas the decision to summon several defendants before one court in terms of Article 8(1) is taken by the plaintiff who is guided by his own interest to litigate in a jurisdiction which is more

²⁶ Art. 22 Brussels Convention, Art. 28 Brussels I Regulation.

²⁷ Art. 27 Brussels Convention, Art. 34 Brussels I Regulation. The German versions use the word ‘*unvereinbar*’ here.

²⁸ ECJ 6 December 1994, C-406/92, ECLI:EU:C:1994:400, *NIPR* 1995, 403 (*Tatry*).

²⁹ ECJ 4 February 1988, 145/86, ECLI:EU:C:1988:61, *NIPR* 1988, 316 (*Hoffmann/Krieg*).

³⁰ The Court was explicitly confronted with the problem in the *Roche* case, but it avoided the problem, ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:458 (*Roche/Primus*).

³¹ Opinion Advocate General Darmon, ECLI:EU:C:1988:312, paras. 13-15.

³² J. Vlek, *Parallelle procedures en misbruik van procesrecht onder de EEX-Verordening II*, Deventer: Kluwer 2015, p. 120.

³³ See annotation S.J. Schaafsma of ECJ 1 December 2011, C-145/10, ECLI:EU:C:2011:798, *NIPR* 2012, 75 (*Painer/Standard Verlags*) in *IER* 2012/16; L. Strikwerda, *Inleiding tot het Nederlandse Internationaal Privaatrecht*, Deventer: Kluwer 2015, p. 266. See also ECJ 7 March 2013, C-145/10 REC, ECLI:EU:C:2013:138.

³⁴ Opinion Advocate General Trstenjak, ECLI:EU:C:2011:239, paras. 69-71.

favourable to him. Therefore, sufficient account must be taken of the defendant's interests in order to check the risk of possible misuse. This justifies higher requirements to be applied to the notion of connection in Article 8(1). Although the Court of Justice has not explicitly confirmed this independent interpretation of Article 8(1), it has shown in its subsequent decisions on Article 8(1) to have considered the particularities of this provision and it has concentrated its deliberations thereon without making any further reference to Article 30. It seems to be justified to assume, therefore, that the notion of 'irreconcilable judgments' and, as a consequence, the notion of connection of claims, in Article 8(1) require to be construed independently, albeit that its interpretation is very close to the interpretation of Article 30.³⁵ That means that the same formula 'irreconcilable judgments' has three different meanings within the Brussels I *bis* Regulation. This is, however, not so strange when one realises that three different contexts are involved – jurisdiction (Article 8(1)), coordination of proceedings (Article 30) and recognition (Article 45), each having their own aims and characteristics.³⁶

3.2 Criterion in Article 8(1)

Having established that Article 8(1) has its own definition of connection, the question arises as to what exactly this criterion is. In its *Roche* decision, the Court of Justice cautiously laid the foundation stone. It ruled that assuming that the concept of 'irreconcilable' judgments must be understood in this context in the broad sense of 'contradictory' decisions, in order that decisions may be regarded as contradictory, 'it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact'.³⁷ Perhaps the Court was inspired by the opinion of Advocate General Darmon in the *Kalfelis* case, who referred to conferring jurisdiction by virtue of this provision, whenever the claims are similar in fact and in law, as a possible solution.³⁸ Anyway, the *Roche* approach was substantiated in the subsequent *Freeport* decision,³⁹ in which the Court silently shifted from 'irreconcilable' to 'contradictory' to 'a divergence in the context of the same situation of law and fact'. This approach was finally solidified in the *Painer* decision, where the Court stated that, in order for judgments to be regarded as *irreconcilable* within the meaning of (the now) Article 8(1), it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the same situation of fact and law.⁴⁰ Therefore, the claims against the various defendants are sufficiently connected for the purpose of Article 8(1) if, in the same situation of fact and law, there is a divergence in the outcome of the dispute if those claims were determined separately. Hence, divergence, the same situation of fact and the same situation of law are the key elements of this concept. How should they be assessed?⁴¹

³⁵ Another question is whether the (criteria developed in the) Court's case law on Art. 8(1) may be extrapolated to the (less advanced) interpretation of Art. 30. So far, the Court has not had an opportunity to rule on this question. Confirmative: Vlek 2015, p. 120-121 (*supra* note 32).

³⁶ See annotation S.J. Schaafsma of ECJ 1 December 2011, C-145/10, ECLI:EU:C:2011:798 (*Painer/Standard Verlags*) in *IER* 2012/16; J.A. Pontier, *Onrechtmatige daad en andere niet-contractuele verbintenissen*, Praktijkreeks IPR, Apeldoorn/Antwerp: Maklu 2015, p. 57-58; Dickenson and Lein 2015, p. 188 (*supra* note 4). Contra: Fentiman 2015, p. 350 (*supra* note 23) (same meaning as in Art. 30).

³⁷ ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:458 (*Roche/Primus*).

³⁸ Opinion Advocate General Darmon, ECLI:EU:C:1988:312, para. 4. Cf. also the opinion of Advocate General Tesauro, paras. 28-29, in the *Tatry* case, ECLI:EU:C:1994:289.

³⁹ ECJ 11 October 2007, C-98/06, ECLI:EU:C:2007:595 (*Freeport/Arnoldsson*), paras. 39-40.

⁴⁰ ECJ 1 December 2011, C-145/10, ECLI:EU:C:2011:798 (*Painer/Standard Verlags*), para. 79. In the Dutch language version, the word '*tegenstrijdig*' (contradictory) is used, in the German version '*widersprechend*'.

⁴¹ See also M.C.A. Kant, *Cross-Border Patent Litigation within the European Union*, Groningen: Huber Institute 2015, p. 152 et seq. presenting six constellations.

3.3 Divergence

The first element in the criterion is a *divergence* in the outcome of the dispute. In this respect, the Court ruled in its recent *Profit Investment* decision that the mere fact that the result of one of the procedures may have an effect on the result of the other does not suffice to characterise the judgments to be delivered in the two procedures as ‘irreconcilable’ for the purpose of Article 8(1). In the *Profit Investment* case, there was, on the one hand, a procedure for damages on the ground of mismanagement and, on the other, a procedure for a declaration of nullity of one of the contracts and restitution of sums paid but not due, the results of which are independent, whereas – according to the referring court – the two procedures had different subject-matters and bases and were not connected by a link of subordination or incompatibility.

An example in the context of intellectual property could be a plaintiff suing before a French court, firstly, a defendant in France (the anchor defendant) in a contractual dispute to determine who is the proprietor of a certain trade mark in Spain, and, secondly, another defendant (the co-defendant), domiciled in the Netherlands, for an infringement of that trade mark in Spain. It goes without saying that the result of the former procedure, regarding whether or not the plaintiff is indeed the right holder, may have an effect on the outcome of the latter case where the issue of whether the plaintiff can act against the alleged infringer arises. However, it seems that this in itself will not be sufficient to characterise the judgments to be delivered in the two procedures as ‘irreconcilable’. In the words of Advocate General Bot, they must have ‘the potential to be inconsistent and contradictory, even if it is not necessary to establish that they will have radically irreconcilable legal consequences’, within the context of the same situation of fact and law.

3.4 Same situation of fact

Let us first focus on the notion of the ‘same situation of fact’, a notion that is difficult to define in general terms. In addition, the case law of the Court of Justice is not always very clear in this regard.

First of all, in the *Roche* case, the Court was confronted with the constellation of a plaintiff, a proprietor of a European patent (hence, a bundle of national patents), who brought an action for patent infringement before the Dutch courts against several companies belonging to the Roche group, most of whom were domiciled in other Member States. The alleged infringements consisted of placing a competing Roche product on the market in countries where these companies were established. Hence, the German Roche company sold this product in Germany, the French Roche company in France and so forth.

To understand the *Roche* decision, it is important to bear in mind that the Court of Justice was responding to the questions of the court that referred the case. Its ruling reflects two different situations described by the referring court. As far as the first situation is concerned, the Court held that the same situation of fact was not established ‘if the defendants are different and the infringements they are accused of, committed in different countries, are not the same’.⁴² At first sight, this seems somewhat surprising. The fact that the defendants are ‘different’ cannot be an obstacle, as this is the very *raison d’être* of Article 8(1). Perhaps the Court meant that the defendants are not affiliated. Anyway, the Court was examining a hypothetical situation here since, in the *Roche* case, all of the defendants belonged to one group of companies. The other element considered by the Court, namely the infringements,

⁴² ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:458 (*Roche/Primus*), paras. 27-28. Confirmed in ECJ 12 July 2012, C-616/10, ECLI:EU:C:2012:445, *NIPR* 2012, 353 (*Solvay/Honeywell*), para. 25.

allegedly committed in different countries, not being the same, must also be hypothetical since, in the particular case, the alleged infringements were (almost) the same. It may therefore be assumed that the Court was describing a hypothetical situation – a situation that, in its view, could not constitute a same situation of fact. As to the second situation, the Court examined the constellation ‘where defendant companies, which belong to the same group, have acted in an identical or similar manner in accordance with a common policy elaborated by one of them’, which is, in fact, the constellation of the *Roche* case.⁴³ Here, not surprisingly, the Court found that the factual situation is the same (‘[...], so that the factual situation would be the same’).

Taking this as a whole, it is therefore submitted, that in the *Roche* ruling, the Court explored two extremes of the spectrum, thereby taking into account several elements, such as the relationship between the defendants, the question whether or not there was a concerted practice, the identity of the infringements and the geography thereof.

Having explored these extremes of the spectrum in *Roche*, in its *Freeport* decision (which was not an intellectual property case) the Court subsequently introduced a margin of appreciation for the national court. The Court ruled in this case that the national court, when assessing whether there is a connection between the different claims, must take account of all the necessary factors in the case file.⁴⁴

This margin of appreciation was repeated in the *Painer* decision, a case in which a copyright proprietor sued several defendants before the Austrian courts. One of the defendants was domiciled in Austria and the others in Germany. The plaintiff contended there had been copyright infringement in these countries in respect of a photograph. The defendants had been acting in their own countries, apparently independently of each other. The Court stated that it is for the national court to judge, in the light of all the elements of the case, whether there is a connection between the different claims, and added: ‘For that purpose, the fact that defendants against whom a copyright holder alleges substantially identical infringements of his copyright did or did not act independently may be relevant.’⁴⁵ Hence, two elements arise. Firstly, the Court used the words ‘substantially identical infringements’. It is not entirely clear what the Court means by this. Is it a prerequisite for the same situation of fact, repeating *Roche*,⁴⁶ and if so, what exactly is meant by this formula? Or, is it perhaps – more prosaic and simply – just an echo of the wording of the question raised by the referring court? Secondly, whether or not the defendants acted independently, is presented as a factor that *may be* relevant (‘*kann erheblich sein*’). This is remarkable. One would expect that at least some degree of concerted parallel conduct is required, as Advocate General Trstenjak pointed out.⁴⁷ Nevertheless, apparently, the Court’s view was that it could not be ruled out completely that defendants, who act independently, may be sued before the court of the domicile of one of them on the basis of Article 8(1). This may seem surprising; however, as is explained below, this is acceptable because the Court introduced the requirement that it had to be foreseeable for the co-defendants that they might be sued in the Member State where at least one of them is domiciled.⁴⁸

⁴³ ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:458 (*Roche/Primus*), para. 34.

⁴⁴ ECJ 11 October 2007, C-98/06, ECLI:EU:C:2007:595 (*Freeport/Arnoldsson*), para. 41.

⁴⁵ ECJ 1 December 2011, C-145/10, ECLI:EU:C:2011:798 (*Painer/Standard Verlags*), para. 83.

⁴⁶ ‘[...] and the infringements they are accused of, committed in different Contracting States, are not the same’ (para. 27).

⁴⁷ Opinion Advocate General Trstenjak, ECLI:EU:C:2011:239, para. 92.

⁴⁸ Advocate General Trstenjak proposed to introduce this foreseeability requirement in the context of the same situation of fact, but the Court introduced this requirement in the context of the same situation of law.

Next was the *Solvay* case, an intellectual property infringement case with a particular constellation.⁴⁹ Solvay, the proprietor of a European patent, instigated a court action for patent infringement against several companies, belonging to the Honeywell group, domiciled in different Member States. These proceedings were instigated in a Dutch court as one of them had its domicile in the Netherlands. It was contended that each company had committed an infringement separately by performing reserved actions with regard to the same product, not only in its own country, but also in other Member States, thus infringing the respective national parts of the European patent. For example, it was claimed that the Belgian Honeywell company had committed an infringement, not only in Belgium, but also in Finland, Portugal, etc. Similarly, the contention was that the Dutch Honeywell company had committed an infringement, not only in the Netherlands, but also in Finland, Portugal, etc. Here, according to the Court, potential divergences in the outcome of the proceedings were likely to arise in the same situation of fact and law and this must ultimately be assessed by the national court. Hence, without providing further instructions on the notion ‘same situation of fact’, the Court did not exclude that, in this constellation, there is the same situation of fact.⁵⁰ This seems to be in line with the characterisation of the second situation in the *Roche* decision.

Finally, in *CDC/Akzo*, the Court dealt with Article 8(1) in a competition case. These proceedings concerned a plaintiff seeking compensation before the German courts, due to the domicile of the anchor defendant, from several defendants in various Member States for loss sustained as a result of a breach of Article 81 EC (Article 101 Treaty on the Functioning of the European Union, TFEU). The Court held that the requirement that the same situation of fact and law must arise was satisfied in this case since, despite the fact that the co-defendants participated in the implementation of the cartel by concluding and performing contracts under it, in different places and at different times, the cartel agreement was qualified by the European Commission as a single and continuous infringement of Article 101 TFEU.⁵¹ The decision seems less helpful in the intellectual property context as it was tailored to the specific features of the competition situation in that particular case. Nevertheless, it may perhaps be inferred that synchronicity is not required.⁵²

Having analysed the Court’s case law on the same factual situation in intellectual property cases, let us now try to come to a synthesis thereof. The starting point is that the court is required to assess, *in the light of all the elements of the case*, whether there is a same situation of fact. Taking into account the above case law and trying to systematise it, what are the relevant factual elements in intellectual property cases? It seems that these elements may be classified in three groups: (i) the objects involved, (ii) the key players involved, and (iii) the acts involved. This provides us with a non-exhaustive list of elements that may be relevant. It will be a matter for the court to appreciate these elements. The presence of only one element will not suffice. It is all about an accumulation of elements, and an evaluation of these by the court.

⁴⁹ ECJ 12 July 2012, C-616/10, ECLI:EU:C:2012:445 (*Solvay/Honeywell*).

⁵⁰ The Court considered that the same infringing product was involved, but this seems to be an echo of the question. In the case where the co-defendants put forward the argument that they are not active in other Member States, this should be assessed, see ECJ 16 June 2016, C-12/15, ECLI:EU:C:2016:449, *NIPR* 2016, 298 (*Universal Music*).

⁵¹ ECJ 21 May 2015, C-352/13, ECLI:EU:C:2015:335, *NIPR* 2015, 292 (*CDC/Akzo*), para. 21. See also Opinion Advocate General Jääskinen, ECLI:EU:C:2014:2443, paras. 63-65.

⁵² In *CDC/Akzo*, geography is not relevant either (‘different places’). However, in view of the territoriality of intellectual property rights, it does not seem appropriate to extrapolate that element of *CDC/Akzo* to the intellectual property context.

First, there are the ‘objects’ involved. To begin with, it may be assumed that, as far as the plaintiff is concerned, the same ‘infringed object’ (a copyright-protected work, patent-protected invention, etc.) must be at stake.⁵³ By contrast, in respect of the defendants, it seems that there is no requirement that the same ‘infringing product’ is involved (cf. the *Painer* case). Having said that, where all defendants use the same infringing product, this may be a relevant indication (cf. *Roche* and *Solvay*).

The second classification is the *dramatis personae* themselves. Is there a connection between the defendants? Are they, for instance, affiliated companies or are they members of the same group of companies? It seems that such a connection is not required (cf. the *Painer* case); however, it may be a relevant factor, which can contribute to the assessment of a same situation of fact (cf. *Roche* and *Solvay*).

Finally, there are the acts of the defendants. In this regard, various aspects can be distinguished. The first and foremost aspect is whether or not the defendants acted independently (cf. *Painer*). It is submitted that concerted conduct is a strong indication of a same situation of fact (cf. *Roche*, second situation). However, as explained above, such conduct is not a prerequisite. The nature of the infringing acts is a further aspect that may be taken into account. Are the infringing acts more or less the same? Are the defendants acting in an identical or similar manner?⁵⁴ It is submitted, however, that this is not a necessity so that differing acts of infringement should not preclude the assessment of a same situation of fact.⁵⁵ Suppose, for example, in the *Roche* constellation (second situation), that a subsidiary in Member State X manufactures the infringing product there, whereas another subsidiary, domiciled in Member State Y, imports and sells these products in that State. These are different infringing acts (manufacturing and selling), but it seems that, depending on the specific circumstances of the case, such a co-ordinated chain (manufacturing, distributing, selling) may be qualified as one factual situation.⁵⁶ The geography of the acts could be a third aspect. The *fact* that the infringing acts take place in different Member States, however, does not seem to be relevant.⁵⁷

This approach whereby various elements are weighed gives a great deal of flexibility to national courts. Possibly, the Court of Justice will provide some more instructions or indications in this respect in the future, although it seems that it does not need to interfere too much since it has built in a safeguard mechanism by which possible difficulties in respect of the same factual situation may be resolved, which is, of course, the requirement of foreseeability. This will be dealt with hereafter in the context of the same situation of law.

3.5 Same situation of law

In order for judgments to be regarded as irreconcilable within the meaning of Article 8(1), there must be a divergence in the outcome of the dispute in the same situation of fact and of law. In the latter context, the Court of Justice has not held a steady course.

⁵³ Obviously, there is a link here with the situation of law, the right holder invoking parallel intellectual property rights in respect of the object of those rights.

⁵⁴ Cf. ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:458 (*Roche/Primus*), para. 34 (the second situation).

⁵⁵ See section 3.4 above on the words ‘substantially identical infringements’ in *Painer*.

⁵⁶ See Kant 2015, p. 154-155 (*supra* note 41).

⁵⁷ This aspect has a link with the same situation of law, as intellectual property rights are in principle territorial in nature. The case law of the Court was so far concerned with intra-European cases. But suppose a group of companies sells an allegedly infringing product in Europe and the US, a German subsidiary distributing that product on the US market. Is it possible to sue the German defendant before a Dutch court on the basis of Art. 8(1) (anchor defendant) for infringement in the US?

Its journey began in the *Réunion* case, where the Court ruled that two claims in one action for compensation, directed against different defendants and based in one instance on contractual liability and in the other on liability in tort or delict, cannot be regarded as being connected.⁵⁸ This ruling was interpreted as being a prerequisite for Article 8(1) that the actions brought against different defendants required to have identical legal bases.

This interpretation was perhaps reinforced by the subsequent *Roche* decision, where the Court introduced the concept of the same situation of fact and law. It stated that there was not a same situation of law in that case, since the defendants, acting in different countries, were thereby allegedly infringing different patent rights (a European patent being a bundle of national patent rights, each right governed by its national patent law):

‘[...] that, where infringement proceedings are brought before a number of courts in different Contracting States in respect of a European patent granted in each of those States, against defendants domiciled in those States in respect of acts allegedly committed in their territory, any divergences between the decisions given by the courts concerned would not arise in the context of the same legal situation.’⁵⁹

This decision has been the subject of much criticism since, by definition, it prevents multi-State parallel infringement actions.⁶⁰

After *Roche*, the Court of Justice declared in the *Freeport* case, however, that the fact that claims brought against a number of defendants have different legal bases (in the *Freeport* case: a claim based on contract and a claim based on tort or delict) does not preclude the application of Article 8(1).⁶¹ According to the Court, such a requirement is not apparent from the wording of the provision. The legal bases of the actions are just one factor, which may, if appropriate yet without it being necessary for the assessment, be taken into consideration. The *Réunion* decision had been misunderstood, the Court explained.⁶²

Freeport was not an intellectual property case; nevertheless, its line of reasoning was continued in the *Painer* case, where, as in *Roche*, parallel intellectual property rights were invoked. In contrast to *Roche*, the Court considered in *Painer* that this difference in legal basis (German copyright law, Austrian copyright law) did not preclude the application of Article 8(1), and this was particularly so, in cases where the relevant national laws were substantially identical (harmonised copyright law). The identical legal bases of the actions brought is only

⁵⁸ ECJ 27 October 1998, C-511/97, ECLI:EU:C:1998:509 (*Réunion Européenne/Splithoffs*), para. 50.

⁵⁹ ECJ 13 July 2006, C-539/03, ECLI:EU:C:2006:458 (*Roche/Primus*), para. 31.

⁶⁰ See Advocate General Trstenjak in her Opinion in the *Painer* case, ECLI:EU:C:2011:239, para. 78 et seq. (‘Legitimate objections’), referring to, *inter alia*, A. Kur, ‘A Farewell to Cross-Border Injunctions? The ECJ Decisions GAT v. Luk and Roche Nederland v. Primus and Goldenberg’, *International Review of Intellectual Property and Competition Law* 2006, p. 844 et seq.; M. Wilderspin, ‘La compétence juridictionnelle en matière de litiges concernant la violation des droits de propriété intellectuelle’, *Revue critique de droit international privé* 2006, p. 777-809; P. Schlosser, ‘Anmerkung zur EuGH, Urteil v. 13.7.2006 – Rs. C-539/03, Roche Nederland BV u.a./Primus u. Goldenberg’, *Juristenzeitung* 2007, p. 303-307. See also A. Kur and A. Metzger, ‘Exclusive Jurisdiction and Cross Border IP (patent) Infringement Suggestions for Amendment of the Brussels I Regulation’, *IER* 2007, p. 1-8; J. Adolphsen, ‘Renationalisierung von Patentstreitigkeiten in Europa’, *IPRax* 2007, p. 15-21; M. Rössler, ‘The Court of Jurisdiction for Joint Parties in International Patent Litigation’, *International Review of Intellectual Property and Competition Law* 2007, p. 380-400; Muir Watt 2016, p. 385-386 (*supra* note 15); G. Van Calster, *European Private International Law*, Oxford: Hart 2016, p. 167 et seq.

⁶¹ ECJ 11 October 2007, C-98/06, ECLI:EU:C:2007:595 (*Freeport/Arnoldsson*).

⁶² See P. Vlas, *Groene Serie Burgerlijke Rechtsvordering*, Deventer, Kluwer 2008, Commentary to Art. 6(1), para. 2; M.V. Polak, *Ars Aequi* 2007, p. 987-995.

one relevant factor among others, and is not an indispensable requirement for the application of Article 8(1).⁶³ Hence, the Court seemed to reconsider its *Roche* decision. In addition, the Court introduced a new and important element: the requirement of foreseeability. In paragraph 81, the Court ruled:

‘Thus, a difference in legal basis between the actions brought against the various defendants, does not, in itself, preclude the application of Article 6(1) of Regulation No 44/2001, provided however that it was foreseeable by the defendants that they might be sued in the Member State where at least one of them is domiciled (see, to that effect, *Freeport*, paragraph 47).’

The Court suggested that it had already introduced this foreseeability requirement in its *Freeport* decision; however, in that decision it did not mention foreseeability as a concrete requirement for the application of Article 8(1). Later, it crystallised that this requirement was conceived with a reference to recital 11 in the preamble to the Brussels I Regulation, stipulating the general principle of the predictability of jurisdiction.⁶⁴

It is fascinating that the Court introduced this foreseeability requirement in the context of the situation of law.⁶⁵ It seems more natural that foreseeability is a consequence of the factual situation. In any event, it is clear that foreseeability implies a factual situation in which the defendants have something to do with each other: there is some sort of mutual involvement or inter-relationship, to such an extent that it is foreseeable that one has to be accountable before the court of the domicile of another defendant. According to the wording of paragraph 81 of the *Painer* case, cited above, the requirement only seems to apply in the case of a difference in the legal basis. However, where this requirement apparently ensues from the general principle of the predictability of jurisdiction, it may be contended that it applies anyway.

Finally, the Court ruled that it must be foreseeable by the defendants that they might be sued in the Member State ‘where at least one of them is domiciled’. Therefore, it does not seem to be necessary that it is foreseeable that one might be sued in the Member State where this *specific* anchor defendant is domiciled.⁶⁶

After having surprised with *Painer*, the Court again surprised the intellectual property world with its *Solvay* decision. In this case, the Court explicitly cited the aforementioned, criticised *Roche* ruling and held that, in the particular *Solvay* constellation, a same situation of law seemed to be present since the defendants were accused of infringing the same national parts of the particular European patent at issue.⁶⁷ It is not entirely clear how this decision ought to be evaluated.⁶⁸ Was it an easy way to distinguish it from *Roche*? In that case, *Solvay* has no

⁶³ ECJ 1 December 2011, C-145/10, ECLI:EU:C:2011:798 (*Painer/Standard Verlags*).

⁶⁴ See Opinion Advocate General Jääskinen, ECLI:EU:C:2014:2443 (*CDC/Akzo*), para. 67. Cf. para. 36 of *Freeport*. Cf. also ECJ 13 July 2006, C-103/05, ECLI:EU:C:2006:471, *NIPR* 2006, 297 (*Reisch Montage/Kiesel*), para. 25: The principle of legal certainty ‘requires, in particular, that the special rules on jurisdiction be interpreted in such a way as to enable a normally well-informed defendant reasonably to foresee before which courts, other than those of the State in which he is domiciled, he may be sued’.

⁶⁵ By contrast, Advocate General Trstenjak proposed to introduce this foreseeability requirement in the context of the same situation of fact, see annotation S.J. Schaafsma, annotation in *IER* 2012, p. 157 (see note 33).

⁶⁶ As suggested by P. Stone, *EU Private International Law*, Glos: Elgar 2014, p. 117. In addition, some technical problems may arise in this respect. For example, the relevant moment for determining whether the court has jurisdiction under Art. 8 is the time at which the proceedings are instituted (see Dickenson and Lein 2015, p. 187, para. 4.165 (*supra* note 4)); but is this moment also relevant as to the connection of the claims? As to the domicile of the anchor defendant, however, the moment of the institution of the proceedings is relevant, see Muir Watt 2016, p. 382 (*supra* note 15).

⁶⁷ ECJ 12 July 2012, C-616/10, ECLI:EU:C:2012:445 (*Solvay/Honeywell*), paras. 25-29.

⁶⁸ See annotation S.J. Schaafsma to ECJ 12 July 2012, C-616/10, ECLI:EU:C:2012:445 (*Solvay/Honeywell*) in *IER* 2012/62, p. 524 et seq.; P.L.C. Torremans, ‘Intellectual Property Puts Art. 6(1) Brussels I Regulation to the Test’, *Intellectual Property Quarterly* 2014, p. 1-12.

particular significance in this respect and does not affect *Painer*. Or conversely, did the Court intend to uphold its *Roche* decision? If so, the question then arises as to how this relates to *Painer*. Taking into account the remark in *Painer* about ‘substantially identical’ national laws and the explicit reiteration in *Solvay* that the national parts of a European patent are governed by national patent law,⁶⁹ it is submitted that the most plausible explanation seems to be that, in the Court’s view, the national patent laws in Europe are not sufficiently harmonised or, at least, there is no European Union instrument harmonising patent law which would justify an application of Article 8(1). By contrast, copyright law is harmonised to a large extent by means of a European Directive, as is trade mark law and design law. The correctness of that view may be questioned;⁷⁰ however, this does explain the co-existence of the different approaches of *Painer*, on the one hand, and of *Roche-Solvay*, on the other.⁷¹ We will simply have to wait for clarification in an intellectual property case decided by the Court in the future.

In the meantime, the Court has added some elements to its notion of the same situation of law. In *Land Berlin*, it ignored a difference in legal basis, in respect of an action based on the recovery of an amount unduly paid and an action on a tortious act, considering that both actions were directed at the same interest, namely the repayment of the erroneously transferred surplus amount.⁷² It also took into account the defence raised by the defendants. However, this decision seems to have resulted, to a considerable extent, from the specific circumstances of the case. Finally, in *CDC/Akzo*, the Court stated, in a nutshell, that given that the European Commission had established that the cartel agreement amounted to a single and continuous infringement of Article 101 TFEU, the compensation claims may, by virtue of the rules of private international law of the court seised, be governed by various national (tort) laws. Such a difference in legal basis does not, however, in itself, preclude the application of Article 8(1).⁷³

The above analysis of the Court’s case law on the same situation of law in intellectual property cases informs us, in synthesis, as follows. To begin with, the court requires to assess, again, *in the light of all the elements of the case*, whether there is such a same situation of law. Listed non-exhaustively, relevant factors that may be taken into account by the court seem to be (i) identity of the legal basis of the actions against the various defendants, (ii) the extent to which the relevant national laws are identical, and (iii) whether the actions are directed at the same interest. As regards the first factor, it is noted that a difference in legal basis, within a national law system or by virtue of the rules of private international law, does not, in itself, preclude the application of Article 8(1). Apparently, it seems that parallel patent infringement actions do not constitute a same situation of law, so that Article 8(1) cannot be applied. Such a situation may exist, however, in cases concerning other areas of intellectual property law such as copyright law, trade mark law and design law, where there is European harmonisation. Finally, in the context of the same situation of law, there is a requirement that it was foreseeable for the co-defendants that they might be sued in the Member State where at least one of them is domiciled.

⁶⁹ ECJ 12 July 2012, C-616/10, ECLI:EU:C:2012:445 (*Solvay/Honeywell*), para. 26.

⁷⁰ Cf. Torremans 2014, p. 1-12 (*supra* note 68).

⁷¹ Possibly, if this is indeed the Court’s view, it will therefore not be possible to sue a co-defendant for infringement in the United States, see the example mentioned in note 57, since there is not the same situation of law.

⁷² ECJ 11 April 2013, C-645/11, ECLI:EU:C:2013:228 (*Land Berlin*), para. 47.

⁷³ ECJ 21 May 2015, C-352/13, ECLI:EU:C:2015:335 (*CDC/Akzo*), para. 21.

It should be noted that Article 8(1) also applies in the context of two European unitary intellectual property rights: Community designs and Community trade marks, recently renamed EU trade marks. In respect of Community designs, Article 79(1) of the Community Designs Regulation stipulates that, unless otherwise specified in that Regulation, the Brussels Convention (and, as may be assumed, its successors) shall apply to proceedings relating to Community designs.⁷⁴ A series of Brussels provisions is subsequently ruled out in Article 79(3); however Article 8(1) is not. In fact, its range is extended by Article 79(3)(c), which states that the jurisdiction provisions which are applicable to persons domiciled in a Member State shall also be applicable to persons who do not have a domicile in any Member State but have an establishment therein. The same applies to EU trade marks.⁷⁵ Where Article 8(1) also applies in the context of these unitary rights, it may be assumed that, in infringement actions against different defendants, there is a same situation of law.

In addition, it is noted that in the context of the Benelux unitary rights (Benelux trade mark, Benelux design), Article 8(1) does not apply, nor another *forum connexitatis* in respect of co-defendants. The Benelux Convention on Intellectual Property 2005 has its own set of jurisdiction rules (Article 4.6) that, according to the Court of Justice, prevails over the Brussels I Regulation.⁷⁶ In this set of rather antiquated Benelux rules, a *forum connexitatis* in respect of co-defendants is absent.

4. Further questions

Once it has been established that there is a sufficiently close connection between the claims against the various defendants, that is to say, that there is a risk of irreconcilable judgments if those claims were determined separately, for which it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the same situation of fact and law, then the court may assume jurisdiction on the basis of Article 8(1).⁷⁷

4.1 A court of a particular defendant?

Which court is competent? On the basis of Article 8(1), various courts could be competent. Are any of these competent, *n'importe quelle*? Or is there a court of a particular defendant, one 'central' court, that should hear the various claims? In 1998, the Court of Appeal of The Hague presented in a parallel patent infringement case the so-called 'spider in the web' approach, which concentrates Article 8(1) jurisdiction in the court for the place of the domicile (the statutory seat) of the headquarters company that is in charge and/or from which

⁷⁴ Art. 79(1) of Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs, *OJ* 2002, L 3/1.

⁷⁵ Art. 94 of Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark, *OJ* 2009 L 78/1, amended by Regulation (EU) 2015/2424 of 16 December 2015, *OJ* 2015, L 341/21. As to (a different regulation in respect of) Community plant variety rights, see Art. 101-102 of Regulation (EC) No. 2100/94 of 27 July 1994, *OJ* 1994, L 227/1.

⁷⁶ ECJ 14 July 2016, C-230/15, ECLI:EU:C:2016:560, *NIPR* 2016, 302 (*Brite Strike Technologies*).

⁷⁷ Provided, of course, that the other requirements are also met, see section 2. It should be mentioned that a defendant may contest the validity of the industrial property right involved, an issue for which the *forum registrationis* is exclusively competent on the basis of Art. 24(4), see ECJ 13 July 2006, C-4/03, ECLI:EU:C:2006:457, *NIPR* 2006, 205 (*GAT/LuK*). In respect of provisional measures, see ECJ 12 July 2012, C-616/10, ECLI:EU:C:2012:445 (*Solvay/Honeywell*) and Court of Appeal of The Hague 12 July 2011, ECLI:NL:GHSGR:2011:BR1364, *NIPR* 2011, 487 partly translated into English in *IIC* 2012/2, p. 214-217 (*Yellow Pages*) and Court of Appeal of The Hague 20 May 2014, ECLI:NL:GHDHA:2014:1727, *NIPR* 2014, 275 (*Apple/Samsung*). This complication is outside the scope of this publication.

the policy originated.⁷⁸ This approach reduces forum shopping. A similar proposal was made by Advocate General Trstenjak in the *Painer* case.⁷⁹ The Court of Justice does not, however, follow such an approach. Perhaps the reasoning for this is, firstly, that the search for a spider may further complicate the dispute and, in addition, that the position of the defendants is sufficiently safeguarded by the foreseeability requirement, on the one hand, and the misuse test, which is explored below, on the other.

4.2 A misuse test?

Clearly, the *forum connexitatis* of Article 8(1) can be misused for purposes of forum shopping. It is conceivable, for instance, that a plaintiff ‘devises’ a claim against a defendant, who is used as an anchor defendant in order to sue other defendants in that jurisdiction. The risk of misuse – which has serious consequences⁸⁰ – were already recognised by Jenard in his explanatory report to the Brussels Convention. He explained that an action cannot be brought on the basis of the present provision solely with the object of ousting the jurisdiction of the courts of the state in which the defendant is domiciled.⁸¹ Notwithstanding this, a specific misuse test was not inserted, whereas it was included in the second paragraph of the provision that deals with third-party proceedings.⁸²

The Court of Justice has always been reticent to misuse tests within the context of the Brussels instruments.⁸³ Within the framework of Article 8(1), the Court ruled in *Freeport*, responding to a question on misuse, that this provision applies where claims brought against different defendants were connected when the proceedings were instituted, without there being any further need to establish separately that the claims were not brought with the sole object of ousting the jurisdiction of the courts of the Member State where one of the defendants was domiciled. This decision was interpreted as determining that, where it is established that there is a sufficient connection between the various claims, there is no misuse.⁸⁴ In *CDC/Akzo*, however, the Court made it clear that, *after* establishing that there was a connection, a misuse test may be applied:

‘It follows that where, when proceedings are instituted, claims are connected within the meaning of Article 6(1) of Regulation No 44/2001, the court seised of the case can find that the rule of jurisdiction laid down in that provision has potentially been circumvented only where there is firm evidence to support the conclusion that the applicant artificially fulfilled, or prolonged the fulfilment of, that provision’s applicability.’⁸⁵

⁷⁸ Court of Appeal of The Hague 23 April 1998, ECLI:NL:GHSGR:1998:AK3913, *IER* 1998/30, *NIPR* 1998, 317 (*Expandable Grafts/Boston Scientific*), para. 18.

⁷⁹ Opinion Advocate General Trstenjak, ECLI:EU:C:2011:239, paras. 87-90 and note 39.

⁸⁰ Stone 2014, p. 120 (*supra* note 66).

⁸¹ *OJ* 1979, C 59/26.

⁸² Art. 6(2) Brussels Convention/Regulation; Art. 8(2) Brussels I bis Regulation: ‘unless these were instituted solely with the object of removing him from the jurisdiction of the court which would be competent in his case’.

⁸³ See for example, in the context of *lis pendens*, ECJ 9 December 2003, C-116/02, ECLI:EU:C:2003:657, *NIPR* 2004, 36 (*Gasser/Missat*).

⁸⁴ See ECJ 11 October 2007, C-98/06, ECLI:EU:C:2007:595 (*Freeport/Arnoldsson*), paras. 48, 51-54 in conjunction with the Opinion of Advocate General Mengozzi, ECLI:EU:C:2007:302, paras. 58-60. See Muir Watt 2016, p. 374-375 (*supra* note 15); Vlek 2015, p. 132 et seq. (*supra* note 32).

⁸⁵ ECJ 21 May 2015, C-352/13, ECLI:EU:C:2015:335 (*CDC/Akzo*), para. 29. This approach seems to fit with ECJ 13 July 2006, C-103/05, ECLI:EU:C:2006:471 (*Reisch Montage/Kiesel*), see Opinion of Advocate General Mengozzi, ECLI:EU:C:2007:302, note 35 (*Freeport*).

It will be up to the defendants to allege that, at the time that proceedings were instituted,⁸⁶ the plaintiff artificially fulfilled, or prolonged the fulfilment of, that provision's applicability, and to support that allegation with firm evidence.⁸⁷

In the Court's case law, there are two constellations of possible misuse that were dealt with, that may also be relevant in intellectual property proceedings. In *CDC/Akzo* the plaintiff withdrew the action against the anchor defendant as a result of an out-of-court settlement with that defendant. Is that misuse? The Court made clear that simply holding negotiations with a view to concluding an out-of-court settlement does not in itself prove misuse. However, it would be otherwise if it transpired that such a settlement had, in fact, been concluded, but that it had been concealed in order to create the impression that the conditions of application of Article 8(1) had been fulfilled. In the other case, *Reisch Montage*, the Court decided that Article 8(1) applies even when the action against the anchor defendant is regarded under a national provision as inadmissible from the time it is brought. This could be different in the case of misuse; however, according to the Court that did not seem to be the case in those proceedings.⁸⁸

5. Conclusion

The *forum connexitatis* in Article 8(1) plays an important role in international intellectual property litigation, enabling a concentration of litigation against multiple defendants. The criteria are, however, rather complicated. Over the years, the Court of Justice has developed an interpretation of Article 8(1) and this has finally accumulated in a rather clear concept. The path towards this concept has not always been easy, its decisions have not always been entirely clear or have been difficult to reconcile (which makes it tempting to speak of irreconcilable judgments). In any event, its case law crystallised the requirement for a connection between the claims against the various defendants, interpreted as a divergence in the outcome of the proceedings in the same situation of fact and law, so that there is a risk that they will culminate in irreconcilable judgments resulting from separate proceedings. Having provided a number of relevant factors for determining what constitutes the same situation of fact and law, the assessment is now left to the national courts. This approach gives the national courts much flexibility, which enables them to respond to the particular features of each individual case. It is submitted that this is a sensible approach that enables tailor-made decisions. The drawback of this flexibility, however, is uncertainty. Here, the Court has introduced two counteracting mechanisms in order to impede uncertainty and unfairness. Firstly, the important requirement of foreseeability and, secondly, an exceptional correction in the case of misuse. This set of instruments taken together makes Article 8(1) an important tool in intellectual property cases, which provides a jurisdiction ground that meets the growing demands of the present economic reality of networks of infringers cooperating on an international level, whether or not in a corporate group structure. This tool is however absent in one area. It seems that the Court of Justice is reluctant to make Article 8(1) available in parallel European patent infringement cases.⁸⁹ Hopefully, it will come up with a solution for this important area of the intellectual property arena in the near future.

⁸⁶ This is the *perpetuatio fori* principle, see also ECJ 13 July 2006, C-103/05, ECLI:EU:C:2006:471 (*Reisch Montage/Kiesel*), para. 27.

⁸⁷ ECJ 21 May 2015, C-352/13, ECLI:EU:C:2015:335 (*CDC/Akzo*), para. 31.

⁸⁸ Cf. Opinion of Advocate General Mengozzi, ECLI:EU:C:2007:302, note 35 (*Freeport*). Critical: Dickenson and Lein 2015, p. 190 (*supra* note 4).

⁸⁹ As to the UPC, see Art. 71b(2) *Brussel I bis* Regulation and Kant 2016, p. 706-715 (*supra* note 22).