



Reports of Cases

Case C-433/16

Bayerische Motoren Werke AG
v
Acacia Srl

(Request for a preliminary ruling from the Corte suprema di cassazione)

(Reference for a preliminary ruling — Jurisdiction in civil and commercial matters — Regulation (EC) No 44/2001 — Intellectual property — Community designs — Regulation (EC) No 6/2002 — Articles 81 and 82 — Action for a declaration of non-infringement — Jurisdiction of Community design courts of the Member State where the defendant is domiciled)

Summary — Judgment of the Court (Second Chamber), 13 July 2017

1. *Judicial cooperation in civil matters — Jurisdiction and the enforcement of judgments in civil and commercial matters — Regulation No 44/2001 — Prorogation of jurisdiction — Entering of an appearance of the defendant before the court seised — Challenge to jurisdiction in the alternative to other procedural objections raised in the same first defence — Entering of an appearance does not confer jurisdiction*

(Council Regulation No 44/2001, Art. 24)

2. *Judicial cooperation in civil matters — Jurisdiction and the enforcement of judgments in civil and commercial matters — Regulation No 44/2001 — Scope — Action for a declaration of non-infringement under Article 81(b) of Regulation No 6/2002 on Community designs — Not included — Applicability of Regulation No 6/2002 — Jurisdiction of courts of the Member State where the defendant is domiciled — Exceptions*

(Council Regulations No 44/2001 and No 6/2002, Art. 82)

3. *Judicial cooperation in civil matters — Jurisdiction and the enforcement of judgments in civil and commercial matters — Regulation No 44/2001 — Special jurisdiction — Jurisdiction in tort, delict or quasi-delict — Scope — Action for a declaration of non-infringement under Article 81(b) of Regulation No 6/2002 on Community designs — Not included*

(Council Regulations No 44/2001, Art. 5(3) and No 6/2002, Art. 79(3)(a))

4. *Judicial cooperation in civil matters — Jurisdiction and the enforcement of judgments in civil and commercial matters — Regulation No 44/2001 — Special jurisdiction — Jurisdiction in tort, delict or quasi-delict — Scope — Actions for abuse of a dominant position and unfair competition connected to actions for declaration of non-infringement — Not included — Conditions*

(Council Regulations No 44/2001, Art. 5(3) and No 6/2002, Art. 79(3)(a))

1. Article 24 of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters must be interpreted to the effect that a challenge to the jurisdiction of the court seised, raised in the defendant's first submission in the alternative to other objections of procedure raised in the same submission, cannot be considered to be acceptance of the jurisdiction of the court seised, and therefore does not lead to prorogation of jurisdiction pursuant to that article.

Referring to its case-law concerning Article 18 of the Brussels Convention, that provision being identical in essence to Article 24 of Regulation No 44/2001, the Court has already held that the challenge to the jurisdiction of the national court prevents prorogation where the applicant and the court seised are able to ascertain from the first defence that it is intended to contest the jurisdiction of the court. That is also the case where the first defence contains submissions on the substance of the dispute as well as submissions on the jurisdiction of the court (judgment of 27 February 2014, *Cartier parfums-lunettes and Axa Corporate Solutions assurances*, C-1/13, EU:C:2014:109, paragraph 37 and the case-law cited). It follows that, where the defendant unambiguously contests the jurisdiction of the court in its first defence, that challenge prevents prorogation of jurisdiction under the first sentence of Article 24 of Regulation No 44/2001, whether or not the submission contesting the jurisdiction of the court is the only subject of that first defence.

(see paras 33, 34, 36, operative part 1)

2. Article 82 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted to the effect that actions for declaration of non-infringement under Article 81(b) of that regulation must, when the defendant is domiciled in an EU Member State, be brought before the Community design courts of that Member State, except where there is prorogation of jurisdiction within the meaning of Article 23 or Article 24 of Regulation No 44/2001, and with the exception of the cases of *lis pendens* and related actions referred to in those regulations.

In that regard, it should first be noted that, notwithstanding the principle that Regulation No 44/2001 applies to court proceedings relating to a Community design, the application of certain provisions of that regulation to proceedings in respect of the actions and claims referred to in Article 81 of Regulation No 6/2002 is excluded under Article 79(3) of that regulation. In the light of that exclusion, the jurisdiction of the Community design courts laid down in Article 80(1) of Regulation No 6/2002 to hear the actions and claims referred to in Article 81 of that regulation follows from rules directly provided for by that regulation, which have the character of *lex specialis* in relation to the rules provided for by Regulation No 44/2001 (see, by analogy, judgments of 5 June 2014, *Coty Germany*, C-360/12, EU:C:2014:1318, paragraph 27, and of 18 May 2017, *Hummel Holding*, C-617/15, EU:C:2017:390, paragraph 26). It is also clear from the very wording of Article 82 of Regulation No 6/2002 that actions for declaration of non-infringement under Article 81(b) of that regulation must, when the defendant is domiciled in an EU Member State, be brought before the Community design courts of that Member State, except where there is prorogation of jurisdiction within the meaning of Article 23 or Article 24 of Regulation No 44/2001, those provisions having replaced Articles 17 and 18 of the Brussels Convention.

(see paras 38-40, 42, operative part 2)

3. The rule on jurisdiction in Article 5(3) of Regulation No 44/2001 does not apply to actions for a declaration of non-infringement under Article 81(b) of Regulation No 6/2002.

In that regard, it suffices to note that Article 5(3) of Regulation No 44/2001 replaced Article 5(3) of the Brussels Convention and that the application of that provision to proceedings in respect of actions and claims referred to in Article 81 of Regulation No 6/2002 is excluded pursuant to Article 79(3)(a) of that regulation.

(see paras 44, 46, operative part 3)

4. The rule on jurisdiction set out in Article 5(3) of Regulation No 44/2001 does not apply to actions for a declaration of abuse of a dominant position and of unfair competition that are connected to actions for declaration of non-infringement, in so far as granting those applications presupposes that the action for a declaration of non-infringement is allowed.

In that regard, it is appropriate to consider that, when actions for a declaration of abuse of a dominant position and of unfair competition are brought in the wake of an action for a declaration of non-infringement of a Community design and essentially allege that the proprietor of that design objects to the applicant for a declaration of non-infringement manufacturing replicas of that design, the determination of the court with jurisdiction must be based, for the entirety of the proceedings, on the jurisdiction regime established by Regulation No 6/2002, as interpreted in answer to the first to fourth questions.

Indeed, in such circumstances, those claims are founded in essence on the argument, submitted in the context of the action for a declaration of non-infringement, that the manufacturing of replicas does not constitute an infringement, with the result that the proprietor of the Community design must accept competition by those replicas. To determine, in those circumstances, the court with jurisdiction on the basis of the rule set out in Article 5(3) of Regulation No 44/2001 would compromise the effectiveness of Article 79(3)(a) of Regulation No 6/2002, which is specifically designed to set aside that rule with regard, in particular, to disputes between manufacturers of replicas and proprietors of Community designs that relate to the question whether the proprietor of the Community design at issue may prohibit the manufacture of the replicas at issue.

(see paras 49, 50, 52, operative part 4)