



Reports of Cases

OPINION OF ADVOCATE GENERAL
SAUGMANDSGAARD ØE
delivered on 26 May 2016¹

Case C-230/15

Brite Strike Technologies Inc.
v
Brite Strike Technologies SA

(Request for a preliminary ruling from the Rechtbank Den Haag (District Court, The Hague, Netherlands))

(Reference for a preliminary ruling — Judicial cooperation in civil matters — Jurisdiction and enforcement of decisions — Regulation (EC) No 44/2001 — Article 71 — Applicability of a convention relating to a specific matter — Benelux Convention on intellectual property — Convention entering into force after that regulation but restating the content of earlier treaties — Regulation No 44/2001 — Article 22(4) — Dispute relating to a Benelux trade mark — Jurisdiction of the courts of all three Benelux States or the courts of only one of the States — Criteria to be applied, if necessary, in order to identify that State))

I – Introduction

1. The request for a preliminary ruling made by the Rechtbank Den Haag (District Court, The Hague, Netherlands) relates to the interpretation of Article 22(4) and Article 71 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,² usually referred to as ‘the Brussels I Regulation’.
2. The request has been made in the course of proceedings which are pending before the Dutch court, proceedings which give rise to an issue in identifying the court which has jurisdiction *ratione loci* to rule on an action brought by a United States company in order to obtain the annulment of a Benelux trade mark held by a Luxembourg company.
3. Noting that jurisdictional rules specific to cross-border disputes between private individuals in relation to the validity of a trade mark appear in both Article 22(4) of Regulation No 44/2001 and Article 4.6 of the Benelux Convention on Intellectual Property (Trade Marks and Designs), of 25 February 2005³ (‘the BCIP’), the referring court expresses uncertainty as to how the provisions of those two instruments interact in cases where their substantive, spatial and temporal scopes overlap.

¹ — Language of the proceedings: French.

² — OJ 2001, L 12, p. 1.

³ — Convention signed at The Hague by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands.

4. Under Article 71 of Regulation No 44/2001, the entry into force of that regulation did not affect the applicability of conventions to which EU Member States were already parties and which governed jurisdiction in relation to particular matters. The Court is invited to rule on the issue of whether that article gives precedence to the BCIP, given that the BCIP entered into force after Regulation No 44/2001, but restates, particularly in Article 4.6, the substance of earlier Benelux treaties.

5. In the event of the Court holding that the provisions of Regulation No 44/2001 must take precedence over those of the BCIP, the referring court asks it to determine whether it follows from Article 22(4) of that regulation that the courts of the three Benelux states have equal international jurisdiction in respect of a dispute such as that in the main proceedings relate or, if not, to specify the criteria by which the Benelux State whose courts have sole jurisdiction can be identified, possibly by applying Article 4.6 of the BCIP at that stage.

II – Legal framework

A – Regulation No 44/2001

6. Article 2(1) of that regulation provides that, ‘subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State’.

7. The first subparagraph of Article 22(4) of Regulation No 44/2001, which appears in Section 6 of Chapter II thereof, entitled ‘Exclusive jurisdiction’, provides that ‘the following courts shall have exclusive jurisdiction, regardless of domicile: ... in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place’.

8. The second subparagraph of Article 22(4) stipulates that ‘without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973’,⁴ ‘the courts of each Member State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State’.⁵

9. Article 71 of Regulation No 44/2001, which appears in Chapter VII of that regulation, entitled ‘Relations with other instruments’, provides that:

‘1. This Regulation shall not affect any conventions to which the Member States are parties and which, in relation to particular matters, govern jurisdiction or the recognition or enforcement of judgments.

4 — The text of this convention (‘the Munich Convention’) is available at following internet address: <http://www.epo.org/law-practice/legal-texts/html/epc/2013/e/ma1.html>.

5 — The first and second subparagraphs of Article 22(4) essentially correspond, respectively, to Article 16(4) of the Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1972, L 299, p. 32), as amended by successive conventions relating to the accession of new Member States to that convention (OJ 1998, C 27, p. 1, ‘the Brussels Convention’). The interpretation and explanations provided in relation to Article 16(4) of the Brussels Convention are, in my view, applicable to Article 22(4) of Regulation No 44/2001, because of the equivalence of these provisions (see, by analogy, judgment of 10 September 2015 in *Holterman Ferho Exploitatie and Others*, C-47/14, EU:C:2015:574, paragraph 38).

2. With a view to its uniform interpretation, paragraph 1 shall be applied in the following manner:

- a) this Regulation shall not prevent a court of a Member State, which is a party to a convention on a particular matter, from assuming jurisdiction in accordance with that convention, even where the defendant is domiciled in another Member State which is not a party to that convention. The court hearing the action shall, in any event, apply Article 26 of this Regulation;

...'⁶

10. Regulation No 44/2001 was repealed by Regulation (EU) No 1215/2012,⁷ usually referred to as 'the Brussels Ia Regulation', but that regulation is not applicable to legal proceedings brought, like the main proceedings, before 10 January 2015.⁸ The jurisdictional rules set out in Article 2(1), Article 22(4) and Article 71 of Regulation No 44/2001 were restated in Article 4(1), Article 24(4) and Article 71 of Regulation No 1215/2012, with some modifications which do not affect the general tenor of those provisions.⁹ Regulation (EU) No 542/2014¹⁰ amended Regulation No 1215/2012 more substantially, adding Articles 71a to 71d in order to govern the relationship¹¹ between that regulation and both the Agreement on a Unified Patent Court¹² and the Benelux Court of Justice Treaty.¹³

B – *The BCIP*

11. Under Article 5.2 of the BCIP, that convention repealed, with effect from 1 September 2006, both the Benelux Convention Concerning Trademarks of March 19, 1962,¹⁴ to which the Uniform Benelux Law on Marks¹⁵ was annexed, and the Benelux Designs Convention of October 25, 1966,¹⁶ to which the Uniform Benelux Designs Law¹⁷ was annexed.

12. According to the preamble to the BCIP, the objectives of that convention include:

- to 'replace the conventions, uniform laws and amending protocols relating to Benelux trademarks and designs with a single Convention systematically and transparently governing both trademark law and the law on designs';

6 — Article 71 of Regulation No 44/2001 replaces Article 57 of the Brussels Convention, with only one notable difference in wording (see point 25 of this Opinion).

7 — Regulation 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 (OJ 2012, L 351, p. 1).

8 — The temporal scope of Regulation No 1215/2012 is defined in Article 66 of that regulation.

9 — In this regard, I would only point out, first that Article 24(4) of Regulation No 1215/2012 stipulates that it applies irrespective of whether the issue is raised by way of an action or as a defence (in accordance with the judgments of 13 July 2006 in *GAT*, C-4/03, EU:C:2006:457, paragraph 31, and *Roche Nederland and Others*, C-539/03, EU:C:2006:458, paragraph 40), and that, among others in the French version, Article 71 substitutes the generic term *jurisdiction* for the term *tribunal*, which appeared in Article 71 of Regulation No 44/2001.

10 — 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 (OJ 2014, L 163, p. 1), which is applicable from 10 January 2015, pursuant to Article 2 thereof.

11 — See recitals 1 to 4 in Regulation No 542/2014. In particular, the Article 71a inserted by that regulation provides that the 'court[s] common to several Member States' constituted by the Unified Patent Court and the Benelux Court of Justice are deemed to be 'courts' within the meaning of Regulation No 1215/2012.

12 — This agreement, signed on 19 February 2013 (OJ 2013, C 175, p. 1) will enter into force when 13 Member States have ratified it, under the conditions laid down in Article 89(1) thereof.

13 — Treaty on the establishment and the statute of a Benelux Court of Justice, signed at Brussels on 31 March 1965 by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands, which entered into force on 1 January 1974. On 15 October 2012 those three States signed a protocol which amended that treaty so as to transfer jurisdiction to the Benelux Court of Justice in specific areas within the scope of Regulation No 1215/2012.

14 — 'The BCT', which entered into force on 1 July 1969.

15 — 'The BLM', which entered into force on 1 January 1971.

16 — 'The BDC', which entered into force on 1 January 1974.

17 — 'The BDL', which entered into force on 1 January 1975.

- to ‘provide quick and effective procedures which will allow Benelux regulations to be brought into line with Community regulations and international treaties already ratified by the three High Contracting Parties’, and
- to ‘replace the Benelux Trademark Office and the Benelux Designs Office with the Benelux Organisation for Intellectual Property (trademarks and designs) carrying out its duties through decision-making and executive bodies provided with their own and additional powers’.¹⁸

13. Essentially restating Article 37 of the BLM¹⁹ and Article 29 of the BDL,²⁰ Article 4.6 of the BCIP, entitled ‘Territorial jurisdiction’, provides, in relation to disputes between natural or legal persons:²¹

‘1. Unless the territorial jurisdiction of the courts is expressly stated in a contract, this shall be determined in cases involving trademarks or designs by the address for service of the defendant or by the place where the obligation in dispute has arisen, or has been or should be performed. The place in which the trademark or design is filed or registered shall not under any circumstances be used as the sole basis for determining territorial jurisdiction.

2. Where the criteria mentioned above are insufficient to determine territorial jurisdiction, the petitioner may bring the case before the court of his address for service or residential address, or, if he has no address for service or residential address in Benelux territory, before the court of his choice, in either Brussels, The Hague or Luxembourg.

3. The courts shall apply *ex officio* the rules specified in paragraphs 1 and 2 and shall expressly confirm their jurisdiction.

...’

III – The main proceedings, the questions referred and the procedure before the Court of Justice

14. On 4 February 2010, Brite Strike Technologies SA, which has its headquarters in Luxembourg (Luxembourg), applied for the word sign ‘Brite Strike’ to be registered by the BOIP, which is established in The Hague, as a Benelux mark.

18 — Under Articles 1.2, 1.3 and 1.5 of the BCIP, that organisation has its headquarters in The Hague and is made up of various bodies enabling it to fulfil the duties assigned to it under the terms of that convention, including the Benelux Office for Intellectual Property (‘BOIP’).

19 — A commentary on the BCT and the BLM drafted jointly by the Belgian, Luxembourg and Netherlands Governments has been published in Dutch in the *Tractatenblad van het Koninkrijk der Nederlanden*, 1962, No 58 (see p. 75 et seq. in relation to Article 37 of the BLM). A French version of this explanatory statement appears on the BOIP’s website (https://www.boip.int/wps/portal/site/juridical/regulations/oldregulations/!ut/p/a0/04_Sj9CPykssy0xPLMnMz0vMAfGjzOKdg5w8HZ0MHQ0s_IKNDDxdfX1DHL1CDYO9DfSD04r0C7IdFQHd_Xc9/).

20 — The explanatory note relating to Article 29 of the BDL, which is in essentially the same terms as that relating to Article 37 of the BLM, also appears on the website referred to in footnote 19 to this Opinion.

21 — Cases of this kind, such as the main proceedings, must be distinguished from actions brought directly against a decision of the BOIP relating to the registration of a Benelux trade mark, in respect of which specific rules are laid down by the BCIP (see Articles 2.12, 2.17 and 4.2).

15. On 21 September 2012, Brite Strike Technologies Inc., an American company whose products have been distributed by, amongst others, Brite Strike Technologies SA, brought an action against Brite Strike Technologies SA before the Rechtbank Den Haag (District Court, The Hague) seeking annulment of that trade mark on the basis of Article 2.4²² and Article 2.28²³ of the BCIP, alleging that the defendant had caused it to be registered in bad faith and in breach of its rights as first known user of the sign in question in Benelux territory.

16. Brite Strike Technologies SA raised an objection of lack of territorial jurisdiction, maintaining that the action ought to have been brought in Luxembourg, its place of establishment, because it is the defendant, and not in The Hague, where the mark at issue was registered.

17. According to the referring court, in order to rule on this procedural issue, it is necessary to determine whether the jurisdictional rule set out in Article 4.6 of the BCIP, under which it does not consider that it would have jurisdiction to take cognisance of this dispute,²⁴ prevail over the jurisdictional rule set out in Article 22(4) of Regulation No 44/2001, under which, by contrast, it considers that it could assume jurisdiction.

18. In this regard, the Rechtbank Den Haag (District Court, The Hague) cites a judgment of the Gerechtshof Den Haag (Court of Appeal, The Hague) of 26 November 2013,²⁵ in which the latter court held that the jurisdictional rules laid down by Regulation No 44/2001 had to take precedence over those appearing in the BCIP, on the grounds that ‘even if that convention is substantially a continuation of the earlier Benelux arrangements and even if the rules of jurisdiction concerned are identical’, the BCIP ‘postdates the entry into force of Regulation No 44/2001’, ‘with the result that Article 4.6 of the BCIP cannot be considered to be a special rule for the purposes of Article 71 of Regulation No 44/2001’.²⁶

19. The referring court considers that there is nevertheless uncertainty as to the meaning to be given to Article 71 and as to how Article 22(4) of Regulation No 44/2001 is to be applied, if at all, in the context of a dispute such as that in the main proceedings, relating to the validity of a Benelux mark.

20. Against that background, by decision of 13 May 2015 which reached the Court on 20 May 2015, the Rechtbank Den Haag (District Court, The Hague) decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

‘(1) Must the Benelux Convention on Intellectual Property (Trademarks and Designs) (BCIP) (whether or not on the grounds set out in paragraphs 28 to 34 of the judgment of the Gerechtshof Den Haag [Court of Appeal, The Hague] of 26 November 2013) be considered to be a subsequent convention, with the result that Article 4.6 of the BCIP cannot be considered to be a special rule for the purposes of Article 71 of Regulation No 44/2001?

22 — Under the opening words of Article 2.4 of the BCIP and Article 2.4(f) thereof, ‘no right in a trademark shall be acquired by the following: ... (f) the registration of a [Benelux] trademark which was filed in bad faith, in particular: 1. filing in the knowledge of or in inexcusable ignorance of normal use in good faith of a similar trademark for similar goods or services by a non-consenting third party on Benelux territory during the last three years ...’.

23 — Under the opening words of Article 2.28(3) of the BCIP and Article 2.28(3)(b) thereof, ‘provided that the ... third party referred to in Article 2.4 ... (f), is a party to the action, any interested party may invoke the nullity of: ... (b) filing under which no trademark right is acquired in accordance with Article 2.4 ... (f) ... within a period of five years following the date of registration’.

24 — The referring court observes that the defendant in the main proceedings is not domiciled in the Netherlands and that there is no obligation which has been or must be performed the Netherlands.

25 — Judgment in *H&M AB and Others v G-Star* (ECLI:NL:GHDHA:2013:4466), accessible at the following internet address: <http://deeplink.rechtspraak.nl/uitspraak?id=ECLI:NL:GHDHA:2013:4466>.

26 — The referring court states that the position thus adopted by the Gerechtshof Den Haag (Court of Appeal, The Hague) in 2013 ‘is in line with an earlier article on that subject’, namely S. J. Schaafsma, *Samenloop van EEX en BVIE*, in *Intellectuele eigendom & reclamerecht (IER)*, 2012, p. 593 et seq., especially paragraph 8. It appears to me that the author of that article was one of the members of the formation of the court which delivered the judgment in question.

If that question is answered in the affirmative:

- (2) Does it follow from Article 22(4) of Regulation No 44/2001 that the Belgian, Netherlands and Luxembourg courts all have international jurisdiction to take cognisance of the dispute?
 - (3) If not, how should it be determined, in a case such as the present, whether the Belgian, Netherlands or Luxembourg courts have international jurisdiction? Can Article 4.6 of the BCIP (nonetheless) be applied with a view to (further) determining international jurisdiction?
21. Written observations were submitted by the European Commission only. No hearing took place.

IV – Assessment

A – *The interpretation of Article 71 of Regulation No 44/2001*

1. The subject-matter of the first question referred

22. By its first question, the referring court invites the Court of Justice, essentially, to determine how the jurisdictional rules laid down in Article 4.6 of the BCIP interact with those laid down in Regulation No 44/2001, in the light of Article 71 thereof, in cases where the scopes of those two instruments, which do not overlap completely, coincide in territorial, temporal and material terms.

23. Bearing in mind that the dispute main proceedings relates to the validity of a Benelux trade mark, Article 22(4) of Regulation No 44/2001 is the provision which the referring court more specifically envisages invoking in order to establish its jurisdiction, it being noted that the courts of a different Member State could have jurisdiction if Article 4.6 of the BCIP was instead applied. Nevertheless, it has formulated its first question in such a way as to embrace all the provisions of Regulation No 44/2001. I also consider that the issue of the interaction between these two international instruments does not arise solely from the perspective of Article 22(4) of that regulation. It is possible that, in other situations, other jurisdictional rules laid down by that regulation would compete with those in Article 4.6 of the BCIP in relation to legal proceedings concerning the protection of trade marks and designs.²⁷ This possibility should not therefore be overlooked in the course of examining the first question referred in this matter, and answering it in a way that will be generally applicable.

24. The purpose of Article 71 of Regulation No 44/2001 is to reserve the applicability of jurisdictional rules contained in conventions concluded by Member States, between themselves or with third States, which relate to ‘particular matters’.²⁸ The material scope of the BCIP is specialised by comparison to that of that regulation. In this regard, I note that, contrary to the impression that might be given by its shortened title, the scope of the BCIP does not extend to all intellectual property rights, but is limited to ‘trademarks and designs’.²⁹ As for Regulation No 44/2001, and in particular Article 22(4)

27 — The general rules in Regulation No 44/2001 are applicable to actions other than those ‘concerned with the registration or validity’ of intellectual property rights as referred to in Article 22(4) thereof (see, in relation to Article 16(4) of the Brussels convention (the equivalent of Article 22(4) of Regulation No 44/2001), judgment of 15 November 1983 in *Duijnste*, 288/82, EU:C:1983:326, paragraphs 23 et seq.). Thus, infringement proceedings relating to a Benelux mark could fall within both Article 4.6 of the BCIP and Article 5(3) of Regulation No 44/2001, which is applicable to tortious matters — as was the case in the matter which gave rise to the judgment of the Gerechtshof Den Haag (Court of Appeal, The Hague) referred to in the order for reference — see point 18 of this Opinion) or indeed Article 31 of that regulation, which relates to provisional measures (see judgment of 12 July 2012, *Solvay*, C-616/10, EU:C:2012:445, paragraph 31 et seq.).

28 — I note that in contrast to Article 71, which *preserves the effect of* ‘conventions to which the Member States are parties and which *in relation to particular matters*, govern jurisdiction or the recognition or enforcement of judgments’ (my emphasis), Article 69 of Regulation No 44/2001 provides that that regulation *supersedes* those conventions concluded between Member States which govern the same issues but are *general in scope*. Furthermore, even where a specialised convention exists, the rules laid down by the regulation must be applied to all jurisdictional issues not covered by that convention (see, in relation to Article 57 of the Brussels convention (the equivalent of Article 71 of the regulation), judgment of 6 December 1994 in *Tatry*, C-406/92, EU:C:1994:400, paragraphs 25 and 27).

29 — See point 3 and point 11 et seq. of this Opinion.

thereof, this covers a broader range of intellectual property rights.³⁰ Accordingly, one might expect the reservation in Article 71 of that regulation to result in the jurisdictional rules laid down in Article 4.6 of the BCIP being applicable to the dispute in the main proceedings, and not the rule laid down in Article 22(4) of the regulation.

25. However, the Court has interpreted the wording of Article 71 as meaning that ‘the rules governing jurisdiction ... laid down in the specialised conventions to which the Member States *were already party at the time of entry into force of that regulation* had, in principle, the effect of precluding the application of provisions of that regulation relating to the same question’, where the dispute falls within the scope of such a convention.³¹ It based this restrictive interpretation on the observation that, unlike Article 71, which uses the words ‘are parties’, Article 57 of the Brussels convention, from which Article 71 derives, used the wording ‘are or will be parties’ and thus made it clear that that convention, unlike Regulation No 44/2001, did not preclude the application of different jurisdictional rules to which the Contracting States might agree, *even in the future*, by concluding specialised conventions.³²

26. The Rechtbank Den Haag (District Court, The Hague) asks the Court how these principles of interaction are to be applied in the present case, given that the BCIP was undoubtedly concluded after the date on which Regulation No 44/2001³³ entered into force, but that its purpose was essentially to consolidate two Benelux conventions which had been concluded before that date.³⁴ In other words, it asks whether the BCIP should be classified as a subsequent convention to that regulation, which in its view would result, as the Gerechtshof Den Haag (Court of Appeal, The Hague) has held in another matter,³⁵ in the provisions of the latter instrument, and not those of the convention, being applicable in the main proceedings.

27. The Commission suggests that the answer to the first question referred should be that, because of the date of its entry into force, the BCIP does not fall within the scope of *ratione temporis* of the reservation provided for in Article 71 of Regulation No 44/2001 and that, accordingly, the jurisdictional rules laid down in Article 4.6 of that convention cannot prevail over those of the regulation. My view is that although the BCIP is formally subsequent to regulation No 44/2001, the specialised jurisdictional rules it contains are substantively prior to those laid down by that regulation and must therefore prevail over those rules, on the grounds which follow.

30 — Article 22(4) refers to ‘patents, trade marks, designs and to other similar rights required to be deposited or registered’. The latter formulation includes, amongst other things, the protection of plant varieties (see P. Jenard, Report on the Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters, OJ 1979, C 59, p. 36, ‘the Jenard report’).

31 — My emphasis. See judgments of 4 May 2010 in *TNT Express Nederland* (C-533/08, EU:C:2010:243, paragraphs 45 to 48), and of 4 September 2014 in *Nickel & Goeldner Spedition* (C-157/13, EU:C:2014:2145, paragraph 37).

32 — My emphasis. Judgment of 4 May 2010 in *TNT Express Nederland* (C-533/08, EU:C:2010:243, paragraphs 37 and 38).

33 — I observe that the BCIP entered into force on 1 September 2006, and thus after the entry into force of Regulation No 44/2001 which, pursuant to Article 76 thereof, entered into force on 1 March 2002 in respect of the three Member States which make up Benelux.

34 — See point 11 of this Opinion.

35 — See point 18 of this Opinion.

2. Applicability of Article 71 of Regulation No 44/2001 with regard to the jurisdictional rules laid down by the BCIP

a) Scope of the principle of precedence of prior specialised conventions laid down in Article 71 of Regulation No 44/2001

28. Recital 25 of Regulation No 44/2001 states that the precedence granted, by Article 71 of that regulation, to specialised conventions is justified by ‘respect for international commitments entered into by the Member States’. As the Commission states, the concern expressed in that recital relates mainly to agreements concluded with third States.³⁶ Nevertheless, it is not disputed that the reservation contained in Article 71 also covers conventions concluded exclusively between Member States, such as the Benelux conventions.

29. In this regard, I emphasise that, unlike several other regulations also relating to judicial cooperation in civil matters, Regulation No 44/2001 does not contain any provision under which, ‘as between Member States, [it is to] take precedence over conventions concluded exclusively between two or more of them in so far as such conventions concern matters governed by [that] regulation’,³⁷ a form of words which ousts agreements between Member States — unlike agreements concluded with third States — even if they are both specialised and prior in relation to the regulation concerned.

30. This feature of Regulation No 44/2001 is all the more remarkable for the fact that that regulation was entirely recast in 2012 and that, despite the practical difficulties which had been encountered in assessing the scope of Article 71,³⁸ the EU legislature did not amend the content of that article.³⁹ Article 71 of Regulation No 1215/2012, which replaced Regulation No 44/2001, has undoubtedly been supplemented to a significant extent by Regulation No 542/2014,⁴⁰ but this has been done without restricting the principle under which rules of jurisdiction laid down by specialised conventions, even if concluded exclusively between Member States, make it possible to derogate from those laid down, currently, by Regulation No 1215/2012.

36 — The Jenard Report (op. cit., p. 60) indicates, in relation to Article 57 of the Brussels Convention (the equivalent of Article 71 of Regulation No 44/2001) that, ‘the Member States of the Community, when they entered into these agreements, had for the most part contracted obligations towards non-Member States which should not be modified without the consent of those States’.

37 — See, in particular, Article 28(2) of Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II) (OJ 2007, L 199, p. 40); Article 25(2) of Regulation (EC) No 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I) (OJ 2008, L 177, p. 6), as well as recital 73 (towards the end) and Article 75(2) of Regulation (EU) No 650/2012 of the European Parliament and of the Council of 4 July 2012 on jurisdiction, applicable law, recognition and enforcement of decisions and acceptance and enforcement of authentic instruments in matters of succession and on the creation of a European Certificate of Succession (OJ 2012, L 201, p. 107). See, previously, the similar wording of Article 49(1) of Council Regulation (EC) No 1346/2000 of 29 May 2000 on insolvency proceedings (OJ 2000, L 160, p. 1) and of Article 59(1) of Council Regulation (EC) No 2201/2003 of 27 November 2003 concerning jurisdiction and the recognition and enforcement of judgments in matrimonial matters and the matters of parental responsibility, repealing Regulation (EC) No 1347/2000 (OJ 2003, L 338, p. 1).

38 — See B. Hess, T. Pfeiffer and P. Schlosser, *Study JLS/C4/2005/03 — Report on the Application of Regulation Brussels I in the Member States*, Ruprecht Karls University, Heidelberg, 2007, p. 67 et seq., especially paragraph 145, as well as the subsequent Report from the Commission to the European Parliament, the Council and the European Economic and Social Committee on the application of Council Regulation (EC) No 44/2001, of 21 April 2009 (COM(2009) 174 final, paragraph 3.8.1).

39 — Except for one minor correction (see footnote 9 to this Opinion).

40 — See point 10 of this Opinion.

31. The second objective pursued by Article 71 of Regulation No 44/2001, which in my view has an important role to play in this matter, is to ensure that due consideration is given to the fact that jurisdictional rules laid down by specialised conventions have been drafted with regard to the specific features of the areas concerned, and that those rules therefore have a utility which should be preserved.⁴¹ This relates more specifically to jurisdictional rules designed for intellectual property and appearing in international conventions, which those who drafted that regulation did not intend to override.⁴²

32. In my view it follows from the foregoing that Article 71 of Regulation No 44/2001 was conceived as seeking to preserve the applicability of jurisdictional rules laid down in specialised conventions concluded by Member States before its entry into force, to the extent that the content of those rules is more specifically designed for the area concerned and, in accordance with the Court's case-law, in so far as they conform to the principles governing judicial cooperation in civil and commercial matters within the European Union.⁴³ I consider that this positive approach should be followed, in particular, in relation to Article 4.6 of the BCIP, having regard to its substantive content.

b) The fact that the BCIP restates jurisdictional rules which were contained in specialised conventions pre-dating the entry into force of Regulation No 44/2001

33. Both the referring court and the Commission observe that the BCIP replaced conventions which had been in force in the three Member States which constitute Benelux, since 1971 in relation to trade marks, and since 1975 in relation to designs, without making any substantial amendments to their content. In particular, Article 4.6 of the BCIP, the only provision which is relevant in this matter,⁴⁴ restates in identical terms the jurisdictional rules which appeared in those former instruments, save for terminological changes necessitated by the fact that the new text concerns both trade marks and designs.⁴⁵

34. The Commission maintains that it is nevertheless irrelevant, in answering the first question referred, that the provisions of the BCIP are thus analogous to those of the Benelux conventions which it replaced. In my opinion it is, on the contrary, essential to take account of the fact that in adopting that Article 4.6, the three States which are parties to the BCIP simply preserved the content of specialised provisions which were already applicable before the entry into force of Regulation No 44/2001, without amending their substantive content in any way.

41 — See judgment of 4 May 2010 in *TNT Express Nederland* (C-533/08, EU:C:2010:243, paragraph 48 and the case-law cited therein), as well as the Jenard report (op. cit., p. 60), which emphasises that 'the rules of jurisdiction laid down in these agreements have been dictated by particular considerations relating to the matters of which they treat'. Furthermore, during the preparatory work for Regulation No 44/2001, in a joint statement 'on Articles 71 and 72 and on the negotiations within the framework of the Hague Conference on Private International Law', the Council of the European Union and the Commission stated that 'since it may sometimes be useful to draw up specific rules on particular matters, the Council and the Commission will pay particular attention to the possibility of engaging in negotiations with a view to the conclusion of international agreements in some of these areas' (see note from the General Secretariat of the Council of 14 December 2000, document No 14139/00, JUSTCIV 137, annex I, p. 3, paragraph 2).

42 — The Commission proposal for a Council Regulation (EC) on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters of 14 July 1999 — which led to the adoption of Regulation No 44/2001 — made express reference, among the specialised conventions which were to remain applicable, which it initially listed in Article 63, to the Munich Convention on the grant of European patents, which was also referred to in Article 22(4) of the proposal (COM(1999) 348 final, pp. 38 and 51).

43 — In this last regard, see the case-law referred to in point 37 of this Opinion.

44 — Since the request for a preliminary ruling relates, essentially, to the interaction between the rules of jurisdiction contained in Article 4.6 of the BCIP and those laid down by Regulation No 44/2001, it is appropriate in my view to focus the analysis on rules of that type, and thus not to examine the rules of substantive law laid down in other provisions of that convention. See, by analogy, P. Schlosser, Report on the Convention on the Association of the Kingdom of Denmark, Ireland and the United Kingdom of Great Britain and Northern Ireland to the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters and to the Protocol on its interpretation by the Court of Justice (OJ 1979, C 59, p. 139, 'the Schlosser Report', towards the end of paragraph 238).

45 — See point 11 et seq. of this Opinion.

35. On the basis that one of the objectives of Article 71 of Regulation No 44/2001 is to permit the application of rules designed more specifically for the particularities of the area in question,⁴⁶ it seems to me that this consideration justifies precedence being given to the jurisdictional rules reproduced in Article 4.6 of the BCIP over those laid down by that regulation. As the Commission acknowledges, the BCIP aims, amongst other things, to lay down specific rules which take account of the particularities of the Benelux trade mark, namely that it is a single trade mark which is neither divided between the Member States concerned nor attached to any particular one of those States. In my view the jurisdictional rules reproduced in Article 4.6 of the BCIP are better suited to a dispute relating to a Benelux trade mark than the jurisdictional rules laid down by Regulation No 44/2001.

36. That is true, in particular, in relation to the rule set out in Article 22(4) of that regulation, which, unlike Article 4.6 of the BCIP, was not designed for disputes such as that in the main proceedings. I will return below to the limits within which Article 22(4) could be applied to the present dispute, but will state the main reasons for this negative conclusion immediately. In this regard, I emphasise, first, that the wording of this provision does not make it possible to identify, directly, the court with jurisdiction to determine a dispute of this kind,⁴⁷ whereas Article 4.6 of the BCIP sets out a more precise series of jurisdictional criteria.⁴⁸ Secondly, the latter article — unlike Article 22(4) of Regulation No 44/2001 — prevents jurisdiction being determined solely on the basis of the place of deposit or registration of a mark, so as to avoid jurisdiction being concentrated in one of the Benelux States.⁴⁹ Finally, I note that the EU legislature itself saw fit to adopt jurisdictional rules derogating from Regulation No 44/2001 where intellectual property rights of this kind, having unitary effect in several Member States, were created at EU level.⁵⁰

37. Furthermore, I consider that to apply the jurisdictional rules laid down in Article 4.6 of the BCIP in the present case would not in any way infringe — far from it — the essential principles on which judicial cooperation between the Member States in civil and commercial matters is based, which the Court ensures are observed in cases where rules contained in specialised international conventions are applied in this area.⁵¹ Having regard to their specific features, in particular the fact that they designate

46 — See also point 31 of this Opinion.

47 — See point 56 of this Opinion.

48 — Under Article 4.6, jurisdiction may be assigned by a choice of forum clause; in default of such an express agreement, jurisdiction attaches either to the place where the defendant has its address for service, or to the place where the obligation to which the dispute relates has arisen, or has been or should be performed (Article 4.6(1)); otherwise the claimant may bring the case before the court of his address for service or residential address, provided that it is in Benelux territory, or, if not, before the court of his choice, in either Brussels, The Hague or Luxembourg (Article 4.6(2)).

49 — See the last sentence of Article 4.6(1) of the BCIP. It is apparent from the explanatory statement to Article 37 of the BLM (op. cit.) that those who drafted the jurisdictional rules set out in that article, which are restated in Article 4.6 of the BCIP, intended, amongst other things, not to 'give preference to a court of a one of the contracting countries alone' and 'to prevent too great an expansion of the jurisdiction of the court for the place of establishment of the Benelux Trademarks Office', which was replaced by the Benelux Organisation for Intellectual Property in accordance with Article 5.1 of the BCIP. This rejection of centralisation of jurisdiction in any one State seems to me to address the laudable concerns of ensuring that the burden of contentious matters is divided fairly between the national courts, and ensuring that court users are treated fairly with regard to language, given that within a regional union where both Dutch and French are used, it is useful in my view to avoid causing one of those official languages to predominate over the other.

50 — In this regard, see point 58 et seq. of this Opinion.

51 — See judgment of 4 September 2014 in *Nickel & Goeldner Spedition* (C-157/13, EU:C:2014:2145, paragraph 38 and the case-law cited therein). In that judgment, relating to a convention concluded with third States — namely the Convention on the Contract for the International Carriage of Goods by Road (known as the CMR), signed in Geneva on 19 May 1956 — the Court referred, in particular, to 'the principles, recalled in recitals 6, 11, 12 and 15 to 17 in the preamble to Regulation No 44/2001, of the free movement of judgments in civil and commercial matters, predictability as to the courts having jurisdiction and therefore legal certainty for litigants, the sound administration of justice, minimisation of the risk of concurrent proceedings, and mutual trust in the administration of justice in the EU'.

the court which is best placed to rule on an action relating to the validity of a Benelux mark, and do so in a more precise and more balanced manner than is possible under Article 22(4) of Regulation No 44/2001,⁵² the rules set out in Article 4.6 of the BCIP satisfy, in my view, those of the principles mentioned above which are relevant to jurisdictional rules.⁵³

38. Furthermore, I do not share the Commission's view that if the Court were to decide that Article 4.6 of the BCIP should take precedence over the competing provisions of Regulation No 44/2001, this would infringe the rule, set out in Article 3(2) TFEU and explained in more detail in the case-law of the Court, that Member States are no longer free to conclude conventions between themselves which 'may affect common rules', such as those laid down by Regulation No 44/2001, 'or alter their scope', as the Union has exclusive competence in this area.⁵⁴ It is true that the Court has also held, in relation to a convention concluded with third States, but without restricting itself expressly to that situation, that Article 71(1) of that regulation 'does not enable the Member States to introduce, by concluding new specialised conventions or amending conventions already in force, rules which would prevail over those of Regulation No 44/2001'.⁵⁵

39. Nevertheless, I consider that, since the jurisdictional rules set out in Article 4.6 of the BCIP go no further than to restate the provisions of the BCT and BDC which were in existence before the entry into force of Regulation No 44/2001, by consolidating those two instruments, it cannot be held either that the adoption of the BCIP may have affected the provisions of that regulation or altered their scope, or that the BCIP constitutes a 'new specialised convention' or a convention 'amending conventions already in force', within the meaning of the case-law referred to above.

40. In this specific context in which two Benelux conventions pre-dating Regulation No 44/2001 were simply recast in another Benelux convention signed and ratified after that regulation, the principle of precedence of specialised conventions which is set out in Article 71 of that regulation must, in my opinion, prevail over considerations tending to attach more importance to form than to substance. The position defended by the Commission would have the questionable result of preventing Member States from making changes relating simply to drafting or purely to form, which should in my view be distinguished from the substantive amendments which are prohibited by the case-law referred to above.

41. The interpretation of Article 71 of Regulation No 44/2001 which I advocate, a non-formalist interpretation, is supported in my view by more general considerations based on primary EU law. It is apparent from Article 350 TFEU⁵⁶ that specific regional agreements concluded in relation to Benelux are to be preserved in so far as they enable the objectives of Benelux to be attained better than would EU law, and in so far as they are necessary to ensure the proper functioning of the Benelux

52 — See also points 36, 56 and 60 of this Opinion.

53 — In that the jurisdictional rules laid down by Article 4.6 exhibit a high level of predictability, facilitate the sound administration of justice and enable the risk of concurrent proceedings to be reduced, bearing in mind that of the principles stated in footnote 51 to this Opinion, those regarding the free movement of judgments and mutual trust on the part of Member States relate to the recognition and enforcement of judgments (see judgment of 4 May 2010 in *TNT Express Nederland*, C-533/08, EU:C:2010:243, paragraphs 53 and 54).

54 — In this regard, the Commission refers to Opinion 1/03 of 7 February 2006 (EU:C:2006:81) and to the judgment of 27 November 2012 in *Pringle* (C-370/12, EU:C:2012:756, paragraphs 100 and 101). See also Opinion 1/13 of 14 October 2014 (EU:C:2014:2303, point 71 et seq.), where the contours of this exclusive competence of the Union are identified.

55 — Judgment of 4 May 2010 in *TNT Express Nederland* (C-533/08, EU:C:2010:243, paragraph 38), stating that 'this finding is confirmed by the case-law stating that, as and when common rules come into being, the Member States no longer have the right to conclude international agreements affecting those rules (see, inter alia, Case 22/70 *Commission v Council (ERTA)* [1971] ECR 263, [EU:C:1971:32], paragraphs 17 to 19, and Case C-467/98 *Commission v Denmark (Open Skies)* [2002] ECR I-9519, [EU:C:2002:625], paragraph 77)'.

56 — Article 350 TFEU provides that 'the provisions of the Treaties shall not preclude the existence or completion of regional unions between Belgium and Luxembourg, or between Belgium, Luxembourg and the Netherlands, to the extent that the objectives of these regional unions are not attained by application of the Treaties'.

system.⁵⁷ I am of the opinion that in the circumstances, it was appropriate, even indispensable, for the three Benelux States to retain, in Article 4.6 of the BCIP, specialised jurisdictional rules which they had previously adopted in order to ensure that the uniform trade mark system which existed between them operated in a harmonised and balanced manner.⁵⁸ This opinion is based on the fact that that system, which entirely replaced the legislation of those States in this area,⁵⁹ does not so far have any equivalent in EU law⁶⁰ and also on the fact that the application of Regulation No 44/2001 would not produce as satisfactory a result as that of Article 4.6, in this specific context.

42. Therefore, in my opinion the BCIP should be classified as a convention relating to particular matters to which Member States are parties, within the meaning of Article 71 of Regulation No 44/2001 and, accordingly, the jurisdictional rules appearing in Article 4.6 of that convention must prevail over those set out in that regulation in cases within the scope of both. I therefore suggest that the answer to the first question referred should be that Article 71 must be interpreted as meaning that where a cross-border dispute falls within the scope of both Regulation No 44/2001 and the BCIP, a Member State may, in accordance with Article 71(1), apply the jurisdictional rules laid down in Article 4.6 of the BCIP.

B – *The interpretation of Article 22(4) of Regulation No 44/2001*

1. The subject-matter of the second and third questions referred

43. The referring court submits the second and third questions on a purely subsidiary basis, solely in the event that, in answering the first question referred, the Court holds that the provisions of Regulation No 44/2001 must prevail over the jurisdictional rules appearing in Article 4.6 of the BCIP. I consider that they should not. If the Court approves my proposed interpretation of Article 71 of that regulation, it will be unnecessary to answer these two questions. Nevertheless, for the sake of completeness I make the following observations in this regard.

44. First, I note that, having regard to the interconnection between these questions, both of which, in my view, relate to the meaning and scope to be given to Article 22(4) of Regulation No 44/2001 in the context of a dispute such as that in the main proceedings, it is appropriate to consider them together, if it is necessary to answer them.

45. In the view of the referring court, if the jurisdictional rule set out in Article 22(4) is to apply in a dispute which, like that in the main proceedings, relates to the possible invalidity of a Benelux trade mark, there is doubt concerning the meaning to be given, in this particular context, to the expression ‘the courts of the Member State in which the deposit or registration has been applied for’, which is the criterion relevant to the allocation of jurisdiction, under that provision, in relation to the validity of trade marks.

57 — See in relation to Article 233 EEC (now Article 350 TFEU), in particular, judgment of 11 August 1995 in *Rodens and Others* (C-367/93 to C-377/93, EU:C:1995:261, paragraph 40), where the Court stated, on the contrary, that the Member States making up Benelux could rely on that provision in order to avoid their obligations under Community law, where this was ‘indispensable for the good functioning of the Benelux system’; as well as the Opinion of Advocate General Tesauro in *Rodens and Others* (C-367/93 to C-377/93, EU:C:1995:11, point 8 and the case-law cited therein), observing that ‘the aim of that provision is to prevent the application of Community law from causing the disintegration of the regional union established between those three Member States or from hindering its development’.

58 — See the considerations set out in footnote 49 to this Opinion.

59 — In this regard, the referring court explains that ‘there is no national trade mark law in the legislation of the Benelux countries, but only Benelux trade mark law. A right in respect of a Benelux trade mark is valid throughout the Benelux territory’.

60 — The Community trade mark, now the European Union trade mark (see footnote 80 to this Opinion), confers a protection on the proprietor which is available in all the Member States but, in contrast to the Benelux trade mark, the European Union Trade Mark system does not replace the procedures and rules of law which are applicable at national level (see recitals 4 and 6 in Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009, L 78, p. 1)). Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008, L 299, p. 25) undoubtedly harmonises these, but only partially (see recital 4 et seq. in that directive).

46. To justify its second question, the referring court states, essentially, that an application to register a Benelux trade mark is uniformly valid for the entirety of Benelux territory, such that the courts of each of the Benelux Member States — in other words the Belgian, Luxembourg and Dutch courts — could have joint jurisdiction having regard to the wording of Article 22(4).

47. In the event that that interpretation is rejected by the Court, the referring court asks it, by its third question, to clarify, first, which of the three Member States has sole international jurisdiction in this area and, secondly, whether the criteria of territorial jurisdiction laid down in Article 4.6 BCIP could be used at this stage in order to identify the State in question.

48. In its observations, the Commission suggests, rightly in my view, that the second question should be answered as follows: ‘Article 22(4) of Regulation [No 44/2001] must be interpreted as meaning that, in a dispute relating to the registration or the validity of a Benelux trade mark, the Belgian courts, the Dutch courts and the Luxembourg [courts] have international jurisdiction to take cognisance of the dispute’. The Commission does not state any view as to the third question. For my part, I would make some remarks in that regard.

2. The courts having jurisdiction to rule on a dispute relating to the validity of a Benelux trade mark in the event that Article 22(4) of Regulation No 44/2001 is applied

a) The content of the jurisdictional rule set out in Article 22(4) of Regulation No 44/2001

49. I note that, as indicated by the opening words of Article 22 of Regulation No 44/2001, all of the jurisdictional rules set out in Article 22(1) to Article 22(5) have the common feature that they apply regardless of where the parties are domiciled⁶¹ and confer a jurisdiction of an exclusive and mandatory nature, the application of which is specifically binding on both litigants and courts.⁶² Since they thus derogate not only from the general rule laid down in Article 2 of that regulation which tends to favour defendants, but also from the possibilities of consensual prorogation of jurisdiction which are, in principle, open to the parties,⁶³ these specialised provisions must be interpreted strictly.⁶⁴

50. Contrary to what is stated in the Commission’s written observations,⁶⁵ Article 22(4) of Regulation No 44/2001, which refers collectively to ‘the courts of [a] Member State’, merely designates the Member State whose courts have jurisdiction *ratione materiae* under that provision, and does not allocate jurisdiction within the Member State concerned, as the Court has already held.⁶⁶

61 — Article 4(1) of Regulation No 44/2001 ensures that Article 22 of that regulation is applicable even where the defendant is not domiciled in a Member State.

62 — See, in relation to Article 16 of the Brussels convention (the equivalent of Article 22 of Regulation No 44/2001) judgment of 13 July 2006 in *GAT* (C-4/03, EU:C:2006:457, paragraph 24).

63 — Article 23(5) and Article 24 of Regulation No 44/2001 respectively prevent the rules of exclusive jurisdiction laid down in Article 22 of that regulation from being circumvented by either an agreement conferring jurisdiction or the fact that a defendant voluntarily enters an appearance. I note that, conversely, Article 4.6 of the BCIP gives effect to choice of forum clauses.

64 — See judgment of 12 May 2011 in *BVG* (C-144/10, EU:C:2011:300, paragraph 30), emphasising the need for a ‘strict interpretation’ of all of the provisions of Article 22; as well as judgment of 17 December 2015 in *Komu and Others* (C-605/14, EU:C:2015:833, paragraph 24), observing that ‘in so far as they introduce an exception to the general rules of jurisdiction [of Regulation No 44/2001] ... the provisions of Article 22(1) of Regulation No 44/2001 must not be given an interpretation broader than is required by their objective. These provisions have the effect of depriving the parties of the choice of forum which would otherwise be theirs and, in certain cases, of resulting in their being brought before a court which is not that of the domicile of any of them’.

65 — The Commission states, wrongly in my opinion, that ‘the application of the criteria set out in Article 22(4) makes it possible, in principle, to designate a single national court having jurisdiction. Depending on the situation, this is *the court* of the Member State’ in which the deposit or registration of the intellectual property right in question has taken place (my emphasis).

66 — See judgment of 28 April 2009 in *Apostolides* (C-420/07, EU:C:2009:271, paragraph 48).

51. The first subparagraph of Article 22(4) provides that where a cross-border dispute relates to the registration or validity of an intellectual property right required to be deposited or registered, such as a trade mark, international jurisdiction is conferred exclusively on the ‘courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place’. The second subparagraph of Article 22(4) adds that, in the specific area of European patents governed by the Munich convention, ‘the courts of each Member State shall have exclusive jurisdiction ... in proceedings concerned with the registration or validity of any European patent granted for that State’.⁶⁷

52. An exclusive allocation of jurisdiction of the kind provided for by those two paragraphs, in favour of the Member State directly concerned by the issue of the right in question, has good reason to be precise. It reflects the legislature’s desire to conform to the objectives of a close link between the court and the action, and facilitation of the sound administration of justice, which are referred to, as justifications for departing from the principle that the courts of the place where the defendant is domiciled have jurisdiction, in recital 12 in the preamble to Regulation No 44/2001.

53. The courts of the State where the intellectual property right is to produce its legal effects are considered to be ‘best placed’⁶⁸ to adjudicate on the registration or validity of that right with the regard to the applicable law, which is generally the legislation of the same State in which protection of the right is claimed.⁶⁹ As the Commission emphasises, there has traditionally been a strong link between the protection of intellectual property rights and national sovereignty.⁷⁰ In this regard, the Court has also pointed out that the grant of rights such as patents necessitates the intervention of national administrative authorities and that disputes relating to them have been reserved to specialised courts in a number of Member States.⁷¹

54. It is in the light of the matters thus established both by legislation and by case-law, and taking account of the notable particularities of the intellectual property right at issue in the main proceedings, that the question of how (if at all) Article 22(4) of Regulation No 44/2001 should be applied in this matter should be considered.

b) The application, if any, of Article 22(4) of Regulation No 44/2001 in the present case

55. I state at the outset that if the Court were to hold — contrary to my proposed answer to the first question referred — that Regulation No 44/2001 must apply in a dispute such as that in the main proceedings, it seems to me to be clear, having regard to its wording, that it is indeed the jurisdictional rule set out in Article 22(4), and not those appearing in other provisions of that regulation,⁷² which must determine which court has jurisdiction to rule on the ‘validity’ of the Benelux trade mark concerned.

67 — The Schlosser Report states that the courts thus given exclusive jurisdiction are not those of the State in which the application for a European patent has been filed, but those of the State in relation to which that application is considered valid and must be challenged (op. cit., p. 123).

68 — See, in relation to Article 16(4) of the Brussels convention (the equivalent of Article 22(4) of Regulation No 44/2001), judgment of 13 July 2006 in *GAT* (C-4/03, EU:C:2006:457, paragraph 22 and the case-law cited therein).

69 — In relation to the application of the *lex loci protectionis*, see, in particular, Article 8 of Regulation No 864/2007, and Article 2 of the Paris Convention for the Protection of Industrial Property of 20 March 1883, referred to in the Opinion of Advocate General Jääskinen in *Genesis* (C-190/10, EU:C:2011:202, point 29).

70 — The Jenard Report links the fact that ‘the grant of a national patent [or equivalent right] is an exercise of national sovereignty’ and with the exclusive nature of the jurisdictional rule laid down in the area (op. cit., p. 36).

71 — See judgment of 13 July 2006 in *GAT* (C-4/03, EU:C:2006:457, paragraphs 22 and 23).

72 — As to the possible impact of other provisions of Regulation No 44/2001 in intellectual property matters, see paragraph 23 of this Opinion.

56. The decisive factor in the allocation of jurisdiction in respect of the disputes to which Article 22(4) applies is the close link which must exist between the intellectual right at issue and the territory in which that right can have the benefit of protection.⁷³ In the particular case of the unitary right that is the Benelux trade mark, which is valid in the three Benelux States and has the benefit of uniform protection in those States,⁷⁴ I consider that the territory referred to by the words ‘the Member State in which ...’ in the first paragraph of Article 22(4) of Regulation No 44/2001 must be understood in the circumstances to be the entire territory of Benelux,⁷⁵ which can be treated like the territory of a Member State, as the Court has already held in similar contexts.⁷⁶ I consider therefore that, in relation specifically to the Benelux trade mark, the territories of those three States are designated collectively and the courts of each one potentially have jurisdiction, on the basis that they can all be regarded as being ‘best placed’ to apply the uniform system adopted by those States in relation to that trade mark.

57. I point out that the rule allocating jurisdiction nationally, which is expressly laid down in relation to the European patent in the second subparagraph of Article 22(4), cannot be applied to the Benelux trade mark, since the systems in question are fundamentally distinct.⁷⁷ The European patent differs from the Benelux trade mark in that it is not a unitary right but amounts to a bundle of separate national patents.⁷⁸ As the Commission states, ‘essentially, in legal terms it remains a matter of distinct patents which continue to relate, individually, to the national territory concerned’. This justifies the fact that jurisdiction is still allocated to each State within the territory in which the protection of a European patent is claimed, as is the case for strictly national intellectual property rights.

73 — Since all of the jurisdictional rules laid down by Article 22 of Regulation No 44/2001 are based solely on the subject-matter of the proceedings and apply regardless of where the parties are domiciled, Article 22(4) could in theory be applicable even if none of the parties were established in a Member State, or in particular a Benelux State; however, that is not the case here because the defendant in the main proceedings is a Luxembourg company.

74 — See the introduction to and commentary on both Article 1 of the BCT and Article 37 of the BLM, in the explanatory statement referred to in footnote 19 to this Opinion.

75 — The Benelux territory made up of ‘the territories of the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands in Europe’, under Article 1.16 of the BCIP.

76 — See judgment of 7 September 2006 in *Bovemij Verzekeringen* (C-108/05, EU:C:2006:530, paragraph 20 and the case-law cited therein), where the court observed that, ‘as regards the trade marks registered at [the Benelux Trade Mark Office, now the Benelux Organisation for Intellectual Property], the Benelux territory must be treated like the territory of a Member State, since Article 1 of [First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1)] regards Benelux trade marks as trade marks registered in a Member State’ (my emphasis). See also, by analogy, judgment of 11 August 1995 in *Rodgers and Others* (C-367/93 to C-377/93, EU:C:1995:261, paragraph 20), where the Court held that ‘Belgium, the Netherlands and Luxembourg are to be regarded as a single territory so far as excise duties on wines are concerned ... [given that a] convention [concluded between those countries] standardised the rates of duty [in that area] and the criteria governing their application’ (my emphasis).

77 — In relation to the distinction between the European patent system and that of a unitary right, and the impact of that distinction in terms of jurisdiction, see the Schlosser Report (op. cit., p. 123).

78 — While this right is granted on the conclusion of a single procedure conducted by the European Patent Office in Munich, it confers on the proprietor, simultaneously in the various States designated by the applicant, the same rights as would a national patent granted in each of those Contracting States (see Articles 2, 3, 64 and 79 of the Munich Convention).

58. It is precisely because the jurisdictional rules introduced by the Brussels Convention and restated in Regulation No 44/2001 are not entirely suited to the particularities of unitary intellectual property rights that specific jurisdictional rules have been adopted for the rights of that kind which have been created at European Community and subsequently EU level. Such was the case in relation to ‘Community designs’,⁷⁹ the ‘Community trade mark’ which has recently become the ‘European Union trade mark’,⁸⁰ and the ‘European patent with unitary effect’.⁸¹

59. In its written observations, the Commission asserts that these ‘derogating regimes do not have the effect, however, that the courts having jurisdiction may be those of a Member State in which the intellectual property right is not valid’.⁸² For my part, I would emphasise that the provisions in question, particularly those relating to the validity of a European Union trade mark, lead to a total exclusion of the rule set out in Article 22(4) of that regulation, in that they provide for a centralised office to have jurisdiction to determine free-standing invalidity applications, and for specialised courts to have jurisdiction to determine invalidity claims brought by way of counterclaim — particularly in infringement proceedings — those courts being, in principle, courts of the Member State where the defendant is domiciled.⁸³

60. In line with the Commission’s observations, I concede that, because it would lead to the courts of three EU Member States being in an equal position to have jurisdiction to entertain invalidity proceedings relating to a Benelux trade mark, the strict interpretation of Article 22(4) which is proposed here would lead to a result which is ‘not optimal’ in the light of the objectives of Regulation No 44/2001.⁸⁴ Nevertheless, in the event that that regulation is considered to be applicable to such proceedings, that interpretation will in my view be unavoidable, having regard to both the wording and the basis of Article 22(4), and by reason of the particular characteristics of the intellectual property right with which we are concerned.⁸⁵

79 — See Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002, L 3, p. 1), Articles 79 to 94 of which lay down the rules of ‘jurisdiction and procedure in legal actions relating to community designs’, relating these to the Brussels Convention.

80 — See Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade marks and Designs) (OJ 2015, L 341, p. 21), which entered into force on 23 March 2016. In particular, Article 1(90) to 1(96) of Regulation No 2015/2424 amends Articles 94 to 108 of Regulation No 207/2009, which laid down the rules of ‘jurisdiction and procedure in legal actions relating to Community trade marks’, indicating amongst other things the extent to which Regulation No 44/2001 was applicable in the area (see recitals 16 and 17 in the preamble to Regulation No 207/2009).

81 — The amendments made to Regulation No 1215/2012 by Regulation No 542/2014 (see point 10 of this Opinion) are summarised in recitals 1 to 12 in that regulation. See also the commentary on Article 71a et seq. of Regulation No 1215/2012 by P. Mankowski, in *European Commentaries on Private International Law*, vol. I, *Brussels Ibis Regulation*, U. Magnus and P. Mankowski (Eds), Otto Schmidt, Cologne, 2016, p. 1075 et seq.

82 — In this regard, the Commission refers, in particular, to Article 97 of Regulation No 207/2009 and to Article 71a and 71b of Regulation No 1215/2012, inserted by Regulation No 542/2014.

83 — On the entirety of these specific jurisdictional rules, which are complex, see, in particular, J.-P. Beraudo and M.-J. Beraudo, *Convention de Bruxelles, conventions de Lugano et règlement (CE) No 44/2001* (The Brussels Convention, the Lugano Conventions and Regulation (EC) No 44/2001), *JurisClasseur Europe*, volume 3010, 2015, paragraph 66 et seq.; H. Gaudemet-Tallon, *Compétence et exécution des jugements en Europe* (Jurisdiction and Enforcement of Judgments in Europe), LGDJ-Lextenso, Issy-les-Moulineaux, 5th ed., 2015, paragraph 118 et seq.

84 — The Commission accepts that Regulation No 44/2001 would give the claimant a choice which would not be perfectly in line with the objectives of that instrument and would lead to less predictability than if Article 4.6 of the BCIP had been followed, since that article would, in most cases, have led to a single court having exclusive jurisdiction. I reiterate that, according to recitals 11 and 15 in that regulation, it is intended in principle to ensure that ‘the rules of jurisdiction [are] highly predictable’ and to ‘minimise the possibility of concurrent proceedings’.

85 — J.-P. Beraudo and M.-J. Beraudo, op. cit., also consider that where, under an international instrument, a claim filed in a State or with an international office leads to the grant of a right in several States, the courts of each of the States in respect of which the right has been granted have exclusive jurisdiction to take cognisance of disputes concerning its registration or its validity in that State (see the end of paragraph 51).

61. In any event, I consider that this unfavourable observation should be nuanced, as it is probable that in practice, it would often be the *Rechtbank Den Haag* (District Court, The Hague) before which — as in the main proceedings — the action was brought, by reference to the place where the Benelux trade mark in question had been deposited or registered.⁸⁶ It seems to me that the fact that the claimant could choose to bring the matter before any of the three States could undoubtedly oblige the defendant to plead in a language of which he did not have a perfect command and could lead to a risk of forum shopping. Nevertheless, the practical consequences of the claimant having that choice are less severe in the particular context of the Benelux trade mark than they would generally be, because the legal regime applicable to such trade marks has been fully harmonised by those Member States and is interpreted in a uniform manner.⁸⁷

c) The impossibility of having supplementary reference to Article 4.6 of the BCIP

62. To avoid the difficulties that would arise if Article 22(4) of Regulation No 44/2001 were applied to a dispute concerning an intellectual property right with unitary effect such as the Benelux trade mark,⁸⁸ the referring court envisages the possibility of having reference, apparently on a supplementary basis, to the series of rules of ‘territorial jurisdiction’ appearing in Article 4.6 of the BCIP, in order to determine exactly which of the three Benelux States has jurisdiction in the area.⁸⁹

63. As a preliminary remark, I note that Article 4.6 of the BCIP sets out jurisdictional rules in a cascading form,⁹⁰ those rules being fundamentally different in content from the rule of exclusive jurisdiction appearing in Article 22(4) of Regulation No 44/2001. I add that it is settled case-law that the provisions of Regulation No 44/2001, such as Article 22(4), must be interpreted in an independent manner, and not by reference to the law of Member States.⁹¹

64. Moreover, I do not consider that there can be any reference, even a merely supplementary reference, to this provision of the BCIP in the event of the Court holding that the BCIP is excluded by Regulation No 44/2001, by virtue of Article 71 of that regulation. Only the provisions of Regulation No 44/2001 would then be applicable in order to determine the conflicts of jurisdiction or indeed the procedural conflicts which could be generated by a dispute such as that in the main proceedings.

65. The fact that, as I see it, the claimant would be able to bring proceedings indiscriminately before the courts of any of the Benelux States, in the event that Article 22(4) of Regulation No 44/2001 must be applied to such a dispute, gives rise to difficulties, but these are not insurmountable, as the regulation itself provides solutions to them. Thus, in the event of concurrent proceedings,

86 — The reason this is probable is that The Hague is the place of establishment of the BOIP, with which applications for registration of a Benelux mark can be filed either directly or through the agency of a national authority which is obliged, in such circumstances, to forward the filing it receives to the BOIP (Article 2.5(1) to 2.5(4) of the BCIP). It was, moreover, in order to avoid concentrating jurisdiction in this way that the Benelux States adopted the series of rules reproduced in Article 4.6 of the BCIP (see footnote 49 to this Opinion).

87 — Pursuant to Article 6 of the treaty on the establishment and the statute of a Benelux Court of Justice (see footnote 13 to this Opinion) and Article 1.15 of the BCIP, it is to that court that questions relating to the interpretation of the provisions of that instrument may, indeed must, be referred by the courts of the three Benelux States for a preliminary ruling.

88 — As to those difficulties, see, in particular, footnote 84 to this Opinion.

89 — In relation to the potential application of Article 4.6 of the BCIP so as to supplement the provisions of Regulation No 44/2001, see S.J. Schaafsma, *op. cit.*, paragraph 9.

90 — The content of which is summarised in footnote 48 to this Opinion.

91 — See, in relation to Article 16(4) of the Brussels Convention (the equivalent of Article 22(4) of Regulation No 44/2001), judgments of 15 November 1983 in *Duijnste* (288/82, EU:C:1983:326, paragraphs 16 to 19) and of 13 July 2006 in *GAT* (C-4/03, EU:C:2006:457, paragraph 14), as well as, by analogy, in relation to Article 22(1) of that regulation, judgment of 17 December 2015 in *Komu and Others* (C-605/14, EU:C:2015:833, paragraph 23).

international jurisdiction would be allocated among those three States in accordance with the rule giving priority to ‘the court first seised’, as set out in Articles 27 to 30 of that regulation, which govern situations of *lis pendens* and related actions capable of arising between the courts of Member States,⁹² this being done in the light of the Court’s case-law on those articles.⁹³

66. Accordingly, in the event that the Court considers it necessary to rule on the second and third questions referred, it would be appropriate in my view to hold that Article 22(4) of Regulation No 44/2001 must be interpreted as meaning that jurisdiction to entertain a cross-border dispute relating to the registration or validity of a Benelux trade mark lies with the courts of each of the three Member States in which that intellectual property right produces its effects and is required to be given uniform protection, namely the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands.

V – Conclusion

67. In the light of the foregoing considerations, I suggest that the Court should answer the questions referred by the Rechtbank Den Haag (District Court, The Hague, Netherlands) as follows:

Article 71 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 as meaning that, in a situation where a cross-border dispute falls within the scope of both that regulation and the Benelux Convention on Intellectual Property (Trademarks and Designs), signed at The Hague on 25 February 2005, a Member State may, in accordance with Article 71(1) of that regulation, apply the jurisdictional rules laid down in Article 4(6) of that convention.

92 — See also recital 15 in the preamble to Regulation No 44/2001. In particular, Article 29 of that regulation provides that ‘where actions come within the exclusive jurisdiction of several courts’, as might be the case if Article 22(4) were applied to a dispute relating to a Benelux trade mark, ‘any court other than the court first seised shall decline jurisdiction in favour of that court’.

93 — See in particular, in relation to the interaction between an exclusive jurisdiction rule appearing in Article 22 of that regulation and the rule relating to *lis pendens* laid down in Article 27 thereof, judgment of 3 April 2014 in *Weber* (C-438/12, EU:C:2014:212, paragraph 48 et seq.).