



Reports of Cases

JUDGMENT OF THE COURT (Sixth Chamber)

17 March 2016*

(Reference for a preliminary ruling — Area of freedom, security and justice — Judicial cooperation in civil matters — Regulation (EC) No 44/2001 — Contracts imposing an obligation on a Romanian undertaking to assign trade marks to an undertaking with its seat in a third country — Refusal — Clause conferring jurisdiction on a third country — Defendant entering an appearance before the Romanian courts without raising an objection — Applicable rules on jurisdiction)

In Case C-175/15,

REQUEST for a preliminary ruling under Article 267 TFEU from the Înalta Curte de Casație și Justiție (High Court of Cassation and Justice, Romania), made by decision of 5 December 2014, received at the Court on 20 April 2015, in the proceedings

Taser International Inc.

v

SC Gate 4 Business SRL,

Cristian Mircea Anastasiu,

THE COURT (Sixth Chamber),

composed of A. Arabadjiev, President of the Chamber, J.-C. Bonichot (Rapporteur) and C.G. Fernlund, Judges,

Advocate General: M. Szpunar,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- Taser International Inc., by S. Olaru, C. Radbăță, and E. Bondalici, avocats,
- the Romanian Government, by R.H. Radu and D.M. Bulancea, acting as Agents,
- the Spanish Government, by J. García-Valdecasas Dorrego, acting as Agent,
- the European Commission, by C. Gheorghiu and M. Wilderspin, acting as Agents,

* Language of the case: Romanian.

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,
gives the following

Judgment

- 1 This reference for a preliminary ruling concerns the interpretation of Articles 22(4), 23(5) and 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 (OJ 2001 L 12, p. 1).
- 2 The reference has been made in the context of a dispute between Taser International Inc. ('Taser International'), a company established in the United States, and both SC Gate 4 Business SRL ('Gate 4'), a company established in Romania, and Mr Cristian Mircea Anastasiu, administrator of Gate 4, regarding the performance of the Romanian company's contractual obligation to assign trade marks to Taser International.

Legal context

EU law

- 3 Article 1(1) of Regulation No 44/2001 is worded as follows:

'This Regulation shall apply in civil and commercial matters whatever the nature of the court or tribunal. It shall not extend, in particular, to revenue, customs or administrative matters.'

- 4 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.'

- 5 Article 22 of the regulation, entitled 'Exclusive jurisdiction', provides:

'The following courts shall have exclusive jurisdiction, regardless of domicile:

...

(4) 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.

...'

- 6 As provided in Article 23 of that regulation:

'1. If the parties, one or more of whom is domiciled in a Member State, have agreed that a court or the courts of a Member State are to have jurisdiction to settle any disputes which have arisen or which may arise in connection with a particular legal relationship, that court or those courts shall have jurisdiction. Such jurisdiction shall be exclusive unless the parties have agreed otherwise. ...

...

5. Agreements or provisions of a trust instrument conferring jurisdiction shall have no legal force if they are contrary to Articles 13, 17 or 21, or if the courts whose jurisdiction they purport to exclude have exclusive jurisdiction by virtue of Article 22.'

7 Article 24 of Regulation No 44/2001 provides:

'Apart from jurisdiction derived from other provisions of this Regulation, a court of a Member State before which a defendant enters an appearance shall have jurisdiction. This rule shall not apply where appearance was entered to contest the jurisdiction, or where another court has exclusive jurisdiction by virtue of Article 22.'

Romanian Law

8 Law No 84/1998 on trade marks and geographical indications provides, in Article 41(1) thereof:

'The rights relating to a trade mark may be transferred by assignment, independently of the transfer of the undertaking of which they form part. The assignment must be made in writing and be signed by the parties, on pain of nullity. ...'

9 Under Article 42 of that law:

'(1) The application for registration of the assignment must be accompanied by a document attesting to the change of trade mark owner.

(2) The State Office for Patents and Trade Marks (Oficiul de Stat pentru Invenții și Mărci (OSIM)) shall refuse to register the assignment when it is evident that to do so would mislead the public as to the nature, quality or geographical origin of the goods or services for which the trade mark has been registered, except in cases in which the beneficiary of the transfer agrees to limit the transfer of the trade mark to the goods or services in respect of which the trade mark is not misleading.

(3) At the request of the person concerned and following payment of the tax provided for by law, the OSIM shall enter the assignment in the Trade Mark Register and publish it in the *Buletinul Oficial de Proprietate Industrială* (Official Industrial Property Bulletin). The assignment shall be enforceable against third parties from the date on which it is published.'

10 Law No 105/1992 regulating international private law relationships provides in Article 154 thereof:

'If the parties have, by an appropriate contractual clause, entrusted the resolution of any dispute relating to them, or future disputes arising from the instrument that they have concluded, to the jurisdiction of a particular court, that court shall have jurisdiction, unless:

1. the court is a foreign court, and the dispute falls within the exclusive jurisdiction of a Romanian court;
2. the court is a Romanian court, and one of the parties demonstrates the exclusive jurisdiction of a foreign court.'

11 Article 157 of that law provides:

'The court seised shall, of its own motion, verify that it has jurisdiction to determine a dispute relating to international private law relationships and, if it concludes that neither it nor any other Romanian court has jurisdiction, it shall refuse the request on the ground that the dispute does not fall within the jurisdiction of the Romanian courts.'

The dispute in the main proceedings and the questions referred for a preliminary ruling

- 12 On 4 April and 12 September 2008, Taser International, whose seat is in the United States, entered into, two non-exclusive distribution agreements with Gate 4. Under those agreements, Gate 4 and its administrator, Mr Anastasiu, undertook to assign to the other contracting party the Taser International trade marks which they had registered, or for which they had applied for registration, in Romania.
- 13 Following Gate 4's and Mr Anastasiu's refusal to fulfil that contractual obligation, Taser International brought an action before the Tribunalul Bucureşti (District Court, Bucharest). Regardless of the existence in those contracts of clauses conferring jurisdiction on a court situated in the United States, Gate 4 and Mr Anastasiu entered an appearance before the Romanian court without challenging its jurisdiction. By judgment of 31 May 2011, the Tribunalul Bucureşti (District Court, Bucharest) ordered them to undertake all the formalities necessary for the registration of the assignment.
- 14 Following the Curtea de Apel Bucureşti's (Court of Appeal, Bucharest) decision to uphold that judgment, Gate 4 and Mr Anastasiu brought an appeal before the Înalta Curte de Casaţie şi Justiţie (High Court of Cassation and Justice). Although the jurisdiction of the Romanian courts to decide this case has never been challenged by the parties, the referring court considers that it must rule on that point of its own motion.
- 15 It is in this context that the referring court seeks clarification as to whether Regulation No 44/2001 is applicable to the dispute before it, since the parties elected, for the resolution of their disputes, the courts of a third country outside the European Union and not one of the courts of a Member State, as provided for in Article 23(1) of that regulation. The referring court considers that such a clause conferring jurisdiction on a third country may, for this reason alone, preclude the tacit prorogation of jurisdiction under Article 24 of that regulation.
- 16 On the assumption, however, that that latter rule is applicable, the referring court seeks to ascertain whether it should, nevertheless, decline jurisdiction on another ground.
- 17 Furthermore, it is necessary to determine whether Article 22 of Regulation No 44/2001 is applicable, in order to establish whether a dispute concerning an obligation to assign a trade mark, likely to result in a registration under national law, falls within paragraph 4 of that article.
- 18 In those circumstances, the Înalta Curte de Casaţie şi Justiţie (High Court of Cassation and Justice) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:
- (1) Must Article 24 of Regulation No 44/2001 be interpreted as meaning that the expression "jurisdiction derived from other provisions of this Regulation" also covers the situation in which the parties to a contract for the assignment of rights to a trade mark registered in a Member State of the European Union have decided, unequivocally and undisputedly, to confer jurisdiction to settle any dispute regarding fulfilment of contractual obligations on the courts of a State which is not a Member State of the European Union and in which the applicant is domiciled (has its seat), while the applicant has seised a court of a Member State of the European Union in whose territory the defendant is domiciled (has its seat)?
- (2) If the answer is in the affirmative:
- (a) Must Article 23(5) of Regulation No 44/2001 be interpreted as not referring to a clause conferring jurisdiction on a State that is not a Member State of the European Union, so that the court seised pursuant to Article 2 of the regulation will determine jurisdiction according to the rules of private international law in its own national legislation?

- (b) Can a dispute relating to the enforcement, through the courts, of the obligation to assign rights to a trade mark registered in a Member State of the European Union, assumed under a contract between the parties to that dispute, be regarded as referring to a right “required to be deposited or registered” within the meaning of Article 22(4) of the regulation, having regard to the fact that, under the law of the State in which the trade mark is registered, the assignment of rights to a trade mark must be entered in the Trade Mark Register and published in the Official Industrial Property Bulletin?
- (3) If the answer [to the first question] is in the negative, does Article 24 of Regulation No 44/2001 preclude a court seised pursuant to Article 2 of the regulation, in a situation such as that described in the [first] question, from declaring that it does not have jurisdiction to determine the case, even though the defendant has entered an appearance before that court, including in the final instance, without contesting the jurisdiction?

Consideration of the questions referred for a preliminary ruling

Questions 1 and 2(a)

- 19 By its first question and part (a) of its second question, the referring court asks, in essence, whether Articles 23(5) and 24 of Regulation No 44/2001 must be interpreted as meaning that, in a dispute concerning the non-performance of a contractual obligation, in which the applicant has brought proceedings before the courts of the Member State in which the defendant has its seat, the jurisdiction of those courts may stem from Article 24 of that regulation, where the defendant does not dispute their jurisdiction, even though the contract between the two parties contains a clause conferring jurisdiction on the courts of a third country.
- 20 It should be noted that Regulation No 44/2001 is applicable in a dispute between a defendant domiciled in a Member State and an applicant from of a third country (see, by analogy, judgment in *Owusu*, C-281/02, EU:C:2005:120, paragraph 27).
- 21 Furthermore, the first sentence of Article 24 of Regulation No 44/2001 lays down a rule of jurisdiction based on the entering of an appearance by the defendant in respect of all disputes where the jurisdiction of the court seised does not derive from other provisions of that regulation. That provision applies also in cases where the court has been seised in breach of the provisions of that regulation and implies that the entering of an appearance by the defendant may be considered to be a tacit acceptance of the jurisdiction of the court seised and thus a prorogation of that court’s jurisdiction (judgment in *Cartier parfums-lunettes and Axa Corporate Solutions assurances*, C-1/13, EU:C:2014:109, paragraph 34).
- 22 The second sentence of Article 24 of Regulation No 44/2001 provides exceptions to that general rule. It determines that there is no tacit prorogation of jurisdiction of the court seised where the defendant contests the jurisdiction, thereby expressing its intention not to accept that court’s jurisdiction, or where the dispute is one in respect of which Article 22 of that regulation provides for rules on exclusive jurisdiction (judgment in *Cartier parfums-lunettes and Axa Corporate Solutions assurances*, C-1/13, EU:C:2014:109, paragraph 35).
- 23 Thus, the general rule on the tacit prorogation of jurisdiction of the court seised applies, except in the circumstances which are expressly included amongst the exceptions laid down in the second sentence of Article 24. Since the prorogation of jurisdiction by an agreement on jurisdiction for the purposes of Article 23 of Regulation No 44/2001 is not included amongst the exceptions, the Court has previously held that neither the general scheme nor the objectives of that regulation provide grounds for the view

that the parties are prevented from submitting their dispute to a court other than that stipulated in the agreement (see, to that effect, judgment in *ČPP Vienna Insurance Group*, C-111/09, EU:C:2010:290, paragraph 25).

- 24 This reasoning applies both to agreements conferring jurisdiction on the courts of a Member State and to those in favour of the courts of a third country, since the tacit prorogation of jurisdiction by virtue of the first sentence of Article 24 of Regulation No 44/2001 is based on a deliberate choice made by the parties to the dispute regarding jurisdiction (see judgment in *A*, C-112/13, EU:C:2014:2195, paragraph 54). Accordingly, as is apparent from the previous paragraph of this judgment, the question on the applicability of Article 23 of that regulation is irrelevant.
- 25 In the light of all the foregoing considerations, the answer to the first question and to part (a) of the second question is that Articles 23(5) and 24 of Regulation No 44/2001 must be interpreted as meaning that, in a dispute concerning the non-performance of a contractual obligation, in which the applicant has brought proceedings before the courts of the Member State in which the defendant has its seat, the jurisdiction of those courts may stem from Article 24 of that regulation where the defendant does not dispute their jurisdiction, even though the contract between the two parties contains a clause conferring jurisdiction on the courts of a third country.

Question 2(b)

- 26 By Question 2(b), the referring court asks whether Articles 22(4) and 24 of Regulation No 44/2001 must be interpreted as meaning that a dispute relating to the non-performance of a contractual obligation to assign rights to a trade mark, such as the dispute in the main proceedings, falls within the scope of Article 22(4), and, consequently, of the exceptions to the general rule on the tacit prorogation of jurisdiction of the court seised laid down in the second sentence of Article 24 of that regulation.
- 27 Under Article 22(4) of Regulation No 44/2001, which concerns the registration or validity of trade marks, the courts of the Member State in which the deposit or registration of the mark has been applied for have exclusive jurisdiction. Thus, if that provision is applicable to the main proceedings, the Romanian courts will have exclusive jurisdiction.
- 28 However, in the circumstances of the main proceedings, it is not necessary to determine whether a request for the enforcement of the contractual obligation to assign trade marks actually falls within Article 22(4) of Regulation No 44/2001, since the Romanian courts have, in any event, jurisdiction to decide this case. On the assumption that Article 22(4) is applicable to this dispute, the courts whose jurisdiction stems from that provision are the same as those whose jurisdiction is determined pursuant to the first sentence of Article 24 of that regulation, as the defendant in the main proceedings entered an appearance before the Romanian courts without challenging their jurisdiction.
- 29 In the light of the above, there is no need to answer Question 2(b).

Question 3

- 30 By its third question, the referring court asks whether Article 24 of Regulation No 44/2001 must be interpreted as precluding, in a dispute between parties to a contract which contains a clause conferring jurisdiction on the courts of a third country, the court of the Member State in which the defendant has its seat, which has been seised, from declaring of its own motion that it does not have jurisdiction to determine the case, even though the defendant does not contest the jurisdiction of that court.

- 31 As is clear from the answer given to the first and second questions, the presence of a clause conferring jurisdiction on the courts of a third country does not preclude the application of Article 24 of Regulation No 44/2001.
- 32 Furthermore, it is clear from recitals 2 and 11 in its preamble that Regulation No 44/2001 seeks to unify the rules of conflict of jurisdiction in civil and commercial matters by way of rules of jurisdiction which are highly predictable. Accordingly, Regulation No 44/2001 pursues an objective of legal certainty which consists in strengthening the legal protection of persons established in the European Union, by enabling the applicant to identify easily the court in which he may sue and the defendant reasonably to foresee before which court he may be sued (judgment in *Falco Privatstiftung and Rabitsch*, C-533/07, EU:C:2009:257, paragraphs 21 and 22).
- 33 Thus, the Court has held that, where the rules on exclusive jurisdiction within the meaning of Article 22 of Regulation No 44/2001 do not apply, the court seised must declare itself to have jurisdiction where the defendant enters an appearance and does not contest that court's jurisdiction, since entering an appearance in that way amounts to a tacit prorogation of jurisdiction for the purpose of Article 24 of the regulation (see, to that effect, judgment in *ČPP Vienna Insurance Group*, C-111/09, EU:C:2010:290, paragraphs 26 and 33).
- 34 Indeed, that would still be the case where the jurisdiction of the court seised stems from Article 22 of Regulation No 44/2001.
- 35 Having regard to the position of that provision within the scheme of that regulation and the objective pursued, the rules of jurisdiction provided for in that provision are of an exclusive and mandatory nature, the application of which is specifically binding on both litigants and courts (see, to that effect, judgment in *Solvay*, C-616/10, EU:C:2012:445, paragraph 44).
- 36 In the light of those considerations, the answer to the third question is that Article 24 of Regulation No 44/2001 must be interpreted as precluding, in a dispute between parties to a contract which contains a clause conferring jurisdiction on the courts of a third country, the court of the Member State in which the defendant has its seat, which has been seised, from declaring of its own motion that it does not have jurisdiction, even though the defendant does not contest the jurisdiction of that court.

Costs

- 37 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the referring court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Sixth Chamber) hereby rules:

- 1. Articles 23(5) and 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 as meaning that, in a dispute concerning the non-performance of a contractual obligation, in which the applicant has brought proceedings before the courts of the Member State in which the defendant has its seat, the jurisdiction of those courts may stem from Article 24 of that regulation, where the defendant does not dispute their jurisdiction, even though the contract between the two parties contains a clause conferring jurisdiction on the courts of a third country.**

2. **Article 24 of Regulation No 44/2001 must be interpreted as precluding, in a dispute between parties to a contract which contains a clause conferring jurisdiction on the courts of a third country, the court of the Member State in which the defendant has its seat, which has been seised, from declaring of its own motion that it does not have jurisdiction, even though the defendant does not contest the jurisdiction of that court.**

[Signatures]