



Reports of Cases

JUDGMENT OF THE COURT (Ninth Chamber)

8 September 2022 *

(Reference for a preliminary ruling – Judicial cooperation in civil matters – Jurisdiction and the recognition and enforcement of judgments in civil and commercial matters – Regulation (EU) No 1215/2012 – Article 24(4) – Exclusive jurisdiction – Jurisdiction over the registration or validity of patents – Scope – Patent application deposited and patent granted in a third State – Status of inventor – Proprietor of the right to an invention)

In Case C-399/21,

REQUEST for a preliminary ruling under Article 267 TFEU from the Svea hovrätt (Svea Court of Appeal, Stockholm, Sweden), made by decision of 17 June 2021, received at the Court on 28 June 2021, in the proceedings

IRnova AB

v

FLIR Systems AB,

THE COURT (Ninth Chamber),

composed of S. Rodin, President of the Chamber, L.S. Rossi and O. Spineanu-Matei (Rapporteur),
Judges,

Advocate General: P. Pikamäe,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- IRnova AB, by P. Kenamets and F. Lüning, jur. kand.,
- FLIR Systems AB, by J. Melander and O. Törngren, advokater,
- the European Commission, by M. Gustafsson and S. Noë, acting as Agents,

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

* Language of the case: Swedish.

gives the following

Judgment

- 1 This request for a preliminary ruling concerns the interpretation of Article 24(4) of Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1; ‘the Brussels Ia Regulation’).
- 2 The request has been made in proceedings between IRnova AB and FLIR Systems AB concerning the determination of the person who must be regarded as being the proprietor of the right to inventions covered by patent applications deposited and patents granted in third countries.

Legal context

Brussels Ia Regulation

- 3 Recital 34 of the Brussels Ia Regulation states:

‘Continuity between the Convention [of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1978 L 304, p. 36)], [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)] and this Regulation should be ensured, and transitional provisions should be laid down to that end. The same need for continuity applies as regards the interpretation by the Court of Justice of the European Union of the Convention [of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters] and of the Regulations replacing it.’

- 4 Article 1 of that regulation provides:

‘1. 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 or to the liability of the State for acts and omissions in the exercise of State authority (*acta iure imperii*).

2. This Regulation shall not apply to:

- (a) the status or legal capacity of natural persons, rights in property arising out of a matrimonial relationship or out of a relationship deemed by the law applicable to such relationship to have comparable effects to marriage;
- (b) bankruptcy, proceedings relating to the winding-up of insolvent companies or other legal persons, judicial arrangements, compositions and analogous proceedings;
- (c) social security;
- (d) arbitration;
- (e) maintenance obligations arising from a family relationship, parentage, marriage or affinity;

(f) wills and succession, including maintenance obligations arising by reason of death.’

- 5 Chapter II of the said regulation, entitled ‘Jurisdiction’, contains 10 sections. Article 4 of the same regulation, which appears in Section 1 of Chapter II, entitled ‘General provisions’, provides, in paragraph 1 thereof:

‘Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.’

- 6 Under Article 24 of the Brussels Ia Regulation, which is part of Section 6 of Chapter II, entitled ‘Exclusive jurisdiction’:

‘The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties:

...

- (4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, irrespective of whether the issue is raised by way of an action or as a defence, 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 an instrument of the Union or an international convention deemed to have taken place.

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, 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 Member State;

...’

Swedish law

Law on patents (1967:837)

- 7 Paragraph 17 of the Patentlagen (1967:837) (Law on patents (1967:837)) states:

‘If someone claims before the patent authority a better right to the invention than the applicant and if there is any doubt, the patent authority may order the claimant to bring legal proceedings within a certain period, failing which that claim might not be taken into consideration in the further examination of the patent application.

If a dispute over a better right to the invention is pending before the courts, the patent application may be suspended pending a final decision on the case.’

- 8 Paragraph 18 of that law provides:

‘If someone can establish before the patent authority that he holds a better right to the invention than the applicant, the patent authority shall transfer the application to him, if he so requests. The transferee must pay a new deposit fee.

Where a transfer of an application is requested, the application may not be closed, rejected or approved until the request has been finally decided.’

- 9 Under the first subparagraph of Paragraph 53 of the said law:

‘Where a patent has been granted to someone other than the person entitled to it pursuant to the provisions of Paragraph 1, the court shall, if that person brings an action to that effect, transfer the patent to him. The provisions of the sixth subparagraph of Paragraph 52, concerning the time limits for bringing the action, shall apply.

...’

- 10 The first subparagraph of Paragraph 65 of the same law provides:

‘The Patent- och marknadsdomstolen (Patent and Market Court, Sweden) is the court with jurisdiction in the matters covered by this Law. The same applies in the case of a better right to an invention which is the subject matter of a patent application.

...’

Law (1978:152) on the jurisdiction of the Swedish courts in respect of certain actions in the field of patent law (1978:152)

- 11 Lagen (1978:152) om svensk domstols behörighet i vissa mål på patenträttens område m.m. (Law (1978:152) on the jurisdiction of the Swedish courts in respect of certain actions in the field of patent law) is based on the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent (Protocol on Recognition) of 5 October 1973, which is annexed to the Convention on the Grant of European Patents, signed in Munich on 5 October 1973.

- 12 Paragraph 1 of that law provides:

‘So far as concerns actions brought against the applicant of a European patent seeking to enforce the right to the invention which is the subject matter of the patent application at issue in Sweden or in another Contracting State which is bound by the Protocol on Recognition annexed to the European Patent Convention of 5 October 1973, Articles 2 to 6 and Article 8 shall apply. The term “Contracting State” means in this case a State bound by the said protocol.’

- 13 Under Paragraph 2 of the said law:

‘The actions referred to in Paragraph 1 may be brought before the Swedish courts

1. if the defendant is domiciled in Sweden.
2. if the claimant is domiciled in Sweden and the defendant is not domiciled in a Contracting State.
3. if the parties have stipulated, by a written agreement or by an oral agreement confirmed in writing, that any appeal must be brought before the Swedish courts.’

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

- 14 IRnova and FLIR Systems, active in the infrared technology sector, are companies with their registered office in Sweden. They had a business relationship in the past.
- 15 On 13 December 2019, IRnova brought an action before the Patent- och marknadsdomstolen (Patent and Market Court) seeking, inter alia, a declaration that it had a better right to the inventions covered by international patent applications, subsequently supplemented by European, United States and Chinese patent applications deposited by FLIR in 2015 and 2016, and by United States patents granted to FLIR on the basis of those latter applications.
- 16 In support of that action, IRnova had stated, in essence, that those inventions had been made by one of its employees, meaning that that employee had to be regarded as their inventor or, at the very least, as their co-inventor. IRnova therefore argued that, as the inventor's employer and thus successor in title, it had to be regarded as the owner of the said inventions. However, FLIR, without having acquired those inventions or otherwise being entitled to do so, deposited the applications mentioned in the preceding paragraph in its own name.
- 17 The Patent- och marknadsdomstolen (Patent and Market Court) declared that it had jurisdiction to hear IRnova's action relating to the inventions covered by the European patent applications. On the other hand, it declared that it did not have jurisdiction to hear the action relating to its alleged right to the inventions covered by the Chinese and United States patent applications deposited by FLIR and by the United States patents granted to FLIR, on the ground, in essence, that the action concerning the determination of the inventor of those latter inventions is linked to the registration and validity of the patents. In view of that link, the dispute at issue falls within the scope of Article 24(4) of the Brussels Ia Regulation, such that the Swedish courts do not have jurisdiction to hear it.
- 18 It is against that decision as to lack of jurisdiction that IRnova brought an appeal before the referring court, the Svea hovrätt (Svea Court of Appeal, Stockholm, Sweden).
- 19 According to that court, the dispute before it falls within the scope of the Brussels Ia Regulation, since it seeks a declaration of the existence of a legitimate right to an invention and is therefore civil and commercial in nature. However, that court is uncertain as to whether the Swedish courts have jurisdiction to hear a dispute seeking to establish the existence of the right to an invention arising from the alleged status of inventor or co-inventor. In its view, Article 24(4) of that regulation provides, 'in proceedings concerned with the registration or validity of ... patents', for exclusive jurisdiction of the courts of the Member State in which the registration has been applied for or has taken place. That exclusive jurisdiction is justified by the fact, first, that those courts are best placed to hear cases in which a dispute concerns the validity of a patent or the existence of its deposit or registration and, second, that the grant of patents necessitates the involvement of the national administrative authorities, which indicates that the grant of a patent falls within the exercise of national sovereignty. However, while it is clear from the case-law of the Court that proceedings concerning exclusively the question of who is the holder of a patent right does not fall within that exclusive jurisdiction, that case-law does not provide any direct guidance as to the applicability of that Article 24(4) in this case.
- 20 In the present case, according to the referring court, the dispute before it can be considered to be linked to the registration or validity of the patent within the meaning of that provision. In order to identify the proprietor of the right to the inventions covered by the patent applications or by the

patents at issue, it is necessary, according to that court, to determine the inventor of those inventions. Such an assessment would involve an interpretation of the patent claims and an analysis of the respective contribution of the various alleged inventors to the said inventions. Thus, the determination of the proprietor of the right to an invention could give rise to an assessment, in the light of substantive patent law, aimed at establishing which contribution to the development work resulted in the novelty or inventive step, and raise questions as to the scope of the protection conferred by the patent law of the country of registration. Furthermore, the fact that the patent applicant is not entitled to file a patent application constitutes a ground for invalidity.

- 21 In those circumstances, the Svea hovrätt (Svea Court of Appeal, Stockholm) decided to stay the proceedings and to refer the following question to the Court for a preliminary ruling:

‘Is an action seeking a declaration of better entitlement to an invention, based on a claim of inventorship or co-inventorship according to national patent applications and patents registered in a non-Member State, covered by exclusive jurisdiction for the purposes of Article 24(4) of [the Brussels Ia Regulation]?’

Consideration of the question referred

- 22 According to settled case-law of the Court, in the procedure laid down by Article 267 TFEU providing for cooperation between national courts and the Court of Justice, it is for the latter to provide the national court with an answer which will be of use to it and enable it to decide the case before it. To that end, the Court should, where necessary, reformulate the questions referred to it (judgment of 26 April 2022, *Landespolizeidirektion Steiermark (Maximum duration of internal border control)*, C-368/20 and C-369/20, EU:C:2022:298, paragraph 50 and the case-law cited).
- 23 In the present case, although the question relates to the jurisdiction to hear a dispute regarding the existence of a better right to inventions covered by national and patent applications registered in a third country, it follows from what is set out in paragraphs 17 and 18 above that the action before the referring court concerns only the jurisdiction to hear a dispute regarding the existence of a better right to inventions covered by Chinese and United States patent applications and by United States patents.
- 24 In those circumstances, it must be held that, by its question, the referring court asks, in essence, whether Article 24(4) of the Brussels Ia Regulation must be interpreted as applying to proceedings aimed at determining, in the context of an action based on alleged inventor or co-inventor status, whether a person is the proprietor of the right to inventions covered by patent applications deposited and by patents granted in third countries.
- 25 In order to answer that question, it is appropriate, in the first place, to determine whether a legal situation with an international element which situated in the territory of a third country, such as that at issue in the main proceedings, falls within the scope of the Brussels Ia Regulation.
- 26 The dispute in the main proceedings arose between two companies having their registered office in the same Member State and seeks to determine the proprietor of a right which also arose in Sweden, namely a right to the inventions covered by the patent applications deposited and by the patents granted in the main proceedings. The only international element of that dispute lies in the

fact that it concerns, inter alia, patent applications deposited and patents granted in third countries, namely China and the United States. That international element is not, however, situated in the territory of a Member State.

- 27 In that regard, it should be recalled that the Court has already held that for the jurisdictional rules laid down by the Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters ('the Brussels Convention') to apply at all the existence of an international element is required (judgment of 1 March 2005, *Owusu*, C-281/02, EU:C:2005:120, paragraph 25).
- 28 While that element is usually based on the defendant's domicile, it may also be based on the subject matter of the proceedings. In that regard, the Court has held that the international nature of the legal relationship at issue need not necessarily derive from the involvement, either because of the subject matter of the proceedings or the respective domiciles of the parties, of a number of Contracting States. The involvement of a Contracting State and a non-Contracting State, for example because the claimant and one defendant are domiciled in the first State and the events at issue occurred in the second, would also make the legal relationship at issue international in nature, since that situation is such as to raise questions in the Contracting State relating to the determination of international jurisdiction (see, to that effect, judgment of 1 March 2005, *Owusu*, C-281/02, EU:C:2005:120, paragraph 26).
- 29 In addition, as is apparent from recital 34 of the Brussels Ia Regulation, the Court's interpretation of the provisions of that convention and those of Regulation No 44/2001 ('the Brussels I Regulation'), which replaced it, also applies to the provisions of the Brussels Ia Regulation, which itself replaced the Brussels I Regulation, whenever those provisions may be regarded as 'equivalent' (see, to that effect, judgments of 10 July 2019, *Reitbauer and Others*, C-722/17, EU:C:2019:577, paragraph 36 and the case-law cited, and of 12 May 2021, *Vereniging van Effectenbezitters*, C-709/19, EU:C:2021:377, paragraph 23). That continuity must also be ensured as regards the determination of the scope of the rules of jurisdiction established by those legal instruments.
- 30 That said, it must also be held that, in so far as the main proceedings between two private parties concern the existence of a better right to inventions, those proceedings come within the scope of 'civil and commercial matters' for the purposes of Article 1(1) of the Brussels Ia Regulation. Furthermore, the said proceedings do not come within the scope of the matters excluded from the application of that regulation, referred to in Article 1(2) thereof.
- 31 It follows from the foregoing that a legal situation such as that at issue in the main proceedings, which has an international element which is situated in the territory of a third country, falls within the scope of the Brussels Ia Regulation.
- 32 In the second place, it is appropriate to examine whether Article 24(4) of the Brussels Ia Regulation applies to proceedings, such as those in the main action, aimed at determining, in the context of an action based on alleged inventor or co-inventor status, whether a person is the proprietor of the right to inventions covered by patent applications deposited and by patents granted in third countries.
- 33 According to that provision, in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, irrespective of whether the issue is raised by way of an action or as a defence, 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 an instrument of the Union or an international convention deemed to have taken place are the courts that have exclusive jurisdiction, regardless of the domicile of the parties.

- 34 In that regard, it should be noted, first, that it is apparent from the wording of the said provision that exclusive jurisdiction in proceedings concerned with the registration or validity of patents is conferred only on the courts of the Member State in which the deposit or registration of a patent has been applied for, taken place or deemed to have taken place.
- 35 In the present case, as has already been pointed out in paragraph 26 of the present judgment, the patent applications at issue in the main proceedings were deposited and the patents concerned were granted not in a Member State, but in third countries, namely the United States and China. As Article 24(4) of the Brussels Ia Regulation does not envisage that situation, however, that provision cannot be regarded as applicable to the main proceedings.
- 36 Second, and in any event, proceedings such as those in the main action do not constitute proceedings ‘concerned with the registration or validity of patents’ within the meaning of Article 24(4) of the Brussels Ia Regulation, such that it is not necessary to ensure that jurisdiction for them, in accordance with the objective pursued by that provision, rests with courts closely linked in fact and law to the register, since those courts are best placed to adjudicate on cases where the validity of the right concerned, or even the existence of the deposit or registration, is in dispute (see, to that effect, judgment of 5 October 2017, *Hanssen Beleggingen*, C-341/16, EU:C:2017:738, paragraph 33 and the case-law cited).
- 37 Since that Article 24(4) essentially reproduces the content of Article 22(4) of the Brussels I Regulation, which itself reflects the system of Article 16(4) of the Brussels Convention, it is appropriate, as has already been noted in paragraph 29 above, to ensure continuity in the interpretation of those provisions (see, to that effect, judgment of 5 October 2017, *Hanssen Beleggingen*, C-341/16, EU:C:2017:738, paragraph 30).
- 38 It follows from settled case-law that the concept of proceedings ‘concerned with the registration or validity of patents’, referred to in those provisions, is an autonomous concept intended to have uniform application in all Member States (judgments of 15 November 1983, *Duijnste*, 288/82, EU:C:1983:326, paragraph 19; of 13 July 2006, *GAT*, C-4/03, EU:C:2006:457, paragraph 14, and of 5 October 2017, *Hanssen Beleggingen*, C-341/16, EU:C:2017:738, paragraph 31).
- 39 That concept must not be given a wider interpretation than is required by its objective, since Article 24(4) of the Brussels Ia Regulation results in depriving the parties of the choice of forum which would otherwise be theirs and, in certain cases, in their being brought before a court which is not that of the domicile of any of them (see, to that effect, as regards Article 16(4) of the Brussels Convention and Article 22(4) of the Brussels I Regulation, judgments of 26 March 1992, *Reichert and Kockler*, C-261/90, EU:C:1992:149, paragraph 25, and of 5 October 2017, *Hanssen Beleggingen*, C-341/16, EU:C:2017:738, paragraph 32 and the case-law cited). Consequently, the specific rule of jurisdiction at issue must be interpreted strictly (judgment of 10 July 2019, *Reitbauer and Others*, C-722/17, EU:C:2019:577, paragraph 38).
- 40 Thus, the Court has specified that proceedings ‘concerned with the registration or validity of patents’, within the meaning of Article 24(4) of the Brussels Ia Regulation, must be regarded as proceedings in which the conferral of exclusive jurisdiction on the courts of the Member State in which the patent was granted is justified by the fact that those courts are best placed to adjudicate

on cases relating to the validity or lapse of a patent, the existence of its deposit or registration, or indeed an alleged right of priority by reason of an earlier deposit. If, on the other hand, proceedings do not concern the validity of a patent or the existence of its deposit or registration, those proceedings are not covered by that provision (judgments of 15 November 1983, *Duijnstee*, 288/82, EU:C:1983:326, paragraphs 24 and 25; of 13 July 2006, *GAT*, C-4/03, EU:C:2006:457, paragraphs 15 and 16, and of 5 October 2017, *Hanssen Beleggingen*, C-341/16, EU:C:2017:738, paragraph 33 and the case-law cited).

- 41 In that context, the Court has held that proceedings concerning exclusively the question of who is entitled to a patent or proceedings to determine whether a person had been correctly registered as the proprietor of a trade mark do not fall within the scope of the rule of exclusive jurisdiction laid down in that provision (judgments of 15 November 1983, *Duijnstee*, 288/82, EU:C:1983:326, paragraph 26, and of 5 October 2017, *Hanssen Beleggingen*, C-341/16, EU:C:2017:738, paragraphs 35 to 37 and 43). In that regard, the Court has found that the question of the individual estate to which an intellectual property right belongs is not, generally, closely linked in fact and law to the place where that right has been registered (judgment of 5 October 2017, *Hanssen Beleggingen*, C-341/16, EU:C:2017:738, paragraph 37).
- 42 In this case, the main proceedings relate not to the existence of the deposit of a patent application or the grant of a patent, the validity or lapse of a patent, or indeed an alleged right of priority by reason of an earlier deposit, but to whether FLIR must be regarded as being the proprietor of the right to the inventions concerned or to a portion of them.
- 43 It must be pointed out, first, that the question of who owns the inventions concerned, which encompasses the question of who is their inventor, relates not to an application for an intellectual property right or that right as such, but to their subject matter. Although the Court has found, as has been recalled in paragraph 41 of the present judgment, that the question of the individual estate to which an intellectual property right belongs is not, generally, closely linked in fact and law to the place where that right has been registered, which would justify the application of the rule of exclusive jurisdiction laid down in Article 24(4) of the Brussels Ia Regulation, that consideration also applies, at the very least, where that question relates solely to the subject matter of that right, namely the invention.
- 44 Second, it should be borne in mind that the identification of the inventor, which is the sole subject matter of the main proceedings, is a preliminary matter and, therefore, separate from that relating to the existence of the deposit of a patent application or to the grant of that patent.
- 45 Nor does it concern the validity of such a deposit, since it seeks only to determine the right to the inventions at issue themselves. The fact that, as the referring court notes, the absence of a right to an invention may constitute a ground for invalidity of that application is therefore irrelevant as regards the jurisdiction to hear disputes concerning the status of inventor.
- 46 Third, the preliminary matter relating to the identification of the inventor is also separate from that of the validity of the granted patent at issue, the latter not being the subject matter of the main proceedings. Even if that identification involved, as the referring court states, an examination of the claims of the patent application or patent at issue for the purposes of determining the contribution of each employee to the making of the invention concerned, that examination would not relate to the patentability of that invention.

- 47 Furthermore, it must be pointed out that the fact that an examination of the claims of the patent or patent application at issue may have to be carried out in the light of the substantive patent law of the country in which that application was deposited or that patent was granted does not require the application of the rule of exclusive jurisdiction laid down in Article 24(4) of the Brussels Ia Regulation, either.
- 48 In that regard, suffice it to note that proceedings concerning a patent infringement also involve a thorough analysis of the scope of the protection conferred by that patent in the light of the patent law of the country in which that patent was granted. The Court has already held that, in the absence of the requisite close link in fact and law to the place where the intellectual property right at issue has been registered, such proceedings fall not within the exclusive jurisdiction of the courts of that Member State, but, pursuant to Article 4(1) of the Brussels Ia Regulation, within the general jurisdiction of the courts of the Member State in which the defendant is domiciled (see, to that effect, judgments of 15 November 1983, *Duijnste*, 288/82, EU:C:1983:326, paragraph 23, and of 13 July 2006, *GAT*, C-4/03, EU:C:2006:457, paragraph 16).
- 49 Having regard to all the foregoing considerations, the answer to the question referred for a preliminary ruling is that Article 24(4) of the Brussels Ia Regulation must be interpreted as not applying to proceedings aimed at determining, in the context of an action based on alleged inventor or co-inventor status, whether a person is the proprietor of the right to inventions covered by patent applications deposited and by patents granted in third countries.

Costs

- 50 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national 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 (Ninth Chamber) hereby rules:

Article 24(4) of Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters,

must be interpreted as:

not applying to proceedings aimed at determining, in the context of an action based on alleged inventor or co-inventor status, whether a person is the proprietor of the right to inventions covered by patent applications deposited and by patents granted in third countries.

[Signatures]