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Intellectual Property Rights and Exclusive (Subject Matter) Jurisdiction: Between Private and Public International Law

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INTELLECTUAL PROPERTY RIGHTS AND EXCLUSIVE (SUBJECT MATTER) JURISDICTION: BETWEEN PRIVATE AND PUBLIC INTERNATIONAL LAW

BENEDETTA UBERTAZZI*

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INTRODUCTION

A. Exclusive Jurisdiction Between Public and Private International Law

In the recent past, prestigious courts around the world have refused to adjudicate cases relating to foreign registered or unregistered intellectual property rights (hereinafter: IPRs), where the proceedings concerned an IPR infringement claim or where the defendant in an IPR infringement action or the claimant in a declaratory action to establish that the IPR is not infringed pleaded that the IPR is invalid or void and that there is also no infringement of that right for that reason (so called validity issues incidentally raised).¹ In these cases the refusal to adjudicate the foreign IPRs infringement and validity claims was grounded on exclusive subject-matter jurisdiction (exclusive jurisdiction) rules.² According to those rules, the State that granted or recognized the IPR has the exclusive jurisdiction to address claims related thereto, independent of its also having personal jurisdiction over the defendant. Among those decisions³ are the Supreme Court of Appeal of the South Africa Republic's *Gallo v. Sting Music*⁴ decision of

1. The decisions on the validity issues incidentally raised have usually *inter partes* effects, whereas the judgments on validity issues principally raised have *erga omnes* effects. See also *infra* in the content of the paper.

2. Of a statutory or a case law nature, see *infra*.

3. See also the judgments referred to in Toshiyuki Kono & Paulius Jurčys, *XVIIIth Int'l Congress on Comparative Law, Intellectual Property and Private Int'l Law* (provisional draft of the general report) (July 2010), in INTELLECTUAL PROPERTY AND PRIVATE INT'L LAW § II.4 (Toshiyuki Kono ed., Martinus Nijhof) (forthcoming); and the decisions quoted by the following national reports on *Jurisdiction and Applicable Law in Matters of Intellectual Property*, (forthcoming) *id.*; Marie-Christine Janssens, *The Relationship between Intellectual Property Law and Int'l Private Law viewed from a Belgian Perspective* § I.II.2.1.3; Joost Blom, *Report for Canada (including Quebec)*, subsection II.A; Ivana Kunda, *Report for Croatia*, subsection I.B; Marie-Elodie Ancel, *Report for France*, subsection I.ii; Axel Metzger, *Report for Germany*, subsection I.2.a.(1); Vandana Singh, *Report for India*, subsection I.2; Nerina Boschiero and Benedetta Ubertazzi, *Report for Italy*, subsection II. case 2, available at 16 *Cardozo Electronic Law Bulletin* 291 (2010), available at <http://www.unipa.it/scienze/politiche/files/Italian%20National%20Reports%20to%20Washington%202010.pdf>; Dai Yokomizo, *Report for Japan*, subsection 1.1.2; Alexandre Dias Pereira, *Report for Portugal*, subsection I.B.2.2; Damjan Možina for Slovenia, subsection I.II.1; Pedro De Miguel Asensio, *Report for Spain*, subsection 1.2.1-3; Amélie Charbon, *Report for Switzerland*, subsection I.1; Dick van Engelen, *Report for The Netherlands*, subsection 3.6.

4. *Gallo Africa Ltd. v. Sting Music (Pty) Ltd.* 2010 (6) SA 329 (SCA) (S. Afr.), available at <http://www.saflii.org/za/cases/ZASCA/2010/96.html>. This decision was delivered when this Paper had already been submitted for publication. Thus, this Paper can only note the conclusion of the decision, according to which "South Africa court has no jurisdiction to hear copyright infringement claims in respect of foreign copyright." *Id.* However, this conclusion is analogous, *mutatis mutandis*, to the *Lucasfilm Entm't Co. v. Ainsworth*, [2009] EWCA (Civ) 1328 judgment's conclusion that will be addressed here in detail. Therefore, the

March 9, 2010; the U.S. Court of Appeal for the Federal Circuit's January 2, 2007 decision in *Voda v. Cordis Corp.*;⁵ the U.K. Court of Appeal's December 16, 2009 decision in *Lucasfilm Entertainment Co. v. Ainsworth*;⁶ and the Court of Justice of the European Union GAT decision of July, 13 2006.⁷

remarks relating to the *Lucasfilm* decision may be extended, *mutatis mutandis*, to the South African *Gallo* judgment.

5. *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007). See Jane Ginsburg, *Jurisdiction and Recognition of Judgments under the ALI Principles*, in LITIGATING INTELLECTUAL PROPERTY RIGHTS DISPUTES CROSS-BORDER: EU REGULATIONS, ALI PRINCIPLES, CLIP PROJECT (Stefania Bariatti ed., CEDAM 2010).

6. *Lucasfilm Entm't Co. v. Ainsworth*, [2009] EWCA (Civ) 1328 (Eng.). Jacob LJ delivered the court's judgment which has not yet become *res judicata*. On this judgment, see Paul Torremans, *Lucasfilm v. Ainsworth*, 7 INT'L REV. OF INTELL. PROP. & COMPETITION L. 751 (2010); Andrew Dickinson, *The Force be with the EU? Infringements of US Copyright in the English Courts*, 2 LLOYD'S MARITIME AND COMMERCIAL L.Q. 181, 181 (2010). On the Court of First Instance decision of this same case, see Graeme Austin, *The Concept of "Justiciability" in Foreign Copyright Infringement Cases*, 40 INT'L REV. OF INTELL. PROP. & COMPETITION L. 393 (2009). See also the recent English judgment Royal Courts of Justice, Strand, London, WC2A 2LL, *Crosstown Music Company 1, LLC v. Rive Droite Music Ltd.*, [2009] EWHC Civ 1222, partly available at <http://vlex.co.uk/vid/hc07c01296-55141239> (in which an attempt by one party to argue for a wider application of the U.K. Court of Appeal *Lucasfilm* case failed).

7. The Court of Justice of the European Union is the former European Court of Justice, for simplicity reasons this court will hereafter be recalled as ECJ. With this judgment the ECJ pronounced not on its jurisdiction, but rather on the jurisdiction of the courts of the EU member States. See Case C-4/03, *GAT v. LuK*, 2006 E.C.R. I-6509. For critics of this decision, see Annette Kur, *A Farewell to Cross-Border Injunctions? The ECJ Decisions GAT v. LuK and Roche Nederland v. Primus and Goldenberg*, 7 INT'L REV. OF INTELL. PROP. & COMPETITION L. 844 (2006); Conflict of Laws in Intellectual Property, *Exclusive Jurisdiction and Cross Border IP (Patent) Infringement. Suggestions for Amendment of the Brussels I Regulation*, available at <http://www-cl-ip.eu>; Lydia Lundstedt, *In the Wake of GAT/LuK and Roche/Primus*, 2 NIR 122, 123 (2008); Paul Torremans, *The Widening Reach of Exclusive Jurisdiction: Where Can You Litigate IP Rights after GAT?*, INTERNATIONAL LITIGATION IN INTELLECTUAL PROPERTY AND INFORMATION TECHNOLOGY 61 (Arnaud Nuyts ed., 2008); Marcus Norrgård, *A Spider Without a Web? Multiple Defendants in IP Litigation*, in INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW 217 (Leible & Ohly eds., 2009); Luigi Fumagalli, *Litigating Intellectual Property Rights Disputes Cross-Border: Jurisdiction and Recognition of Judgments under the Brussels I Regulation 15* in LITIGATING INTELLECTUAL PROPERTY RIGHTS DISPUTES CROSS-BORDER: EU REGULATIONS, ALI PRINCIPLES, CLIP PROJECT (Stefania Bariatti ed., 2010); Annette Kur. & Benedetta Ubertazzi, *The ALI Principles and the CLIP Project—a Comparison*, section 1 and subsection 2.c in LITIGATING INTELLECTUAL PROPERTY RIGHTS DISPUTES CROSS-BORDER: EU REGULATIONS, ALI PRINCIPLES, CLIP PROJECT (Stefania Bariatti ed., 2010). See also the national reports recalled at footnote 3 of this paper. But Cf., Manlio Frigo, *Proprietà intellettuale, Gli standards di tutela dell'UE a confronto con gli standard internazionali*, Address at the Italian Society of International Law XV Congress in Bologna (June 10–11, 2010), available at http://streaming.cineca.it/SIDI-XV/play.php?dim_get=320&player_get=flash&flusso_get=flash (according to which the GAT decision should be positively evaluated since it grants the principle of legal certainty in

These decisions are grounded on the assumption that since IPRs relate to a State's sovereignty or domestic policies, IPRs are granted through State acts and are limited to the territory of the State that granted them. Therefore, if a State other than that which granted or recognized the IPR exercised jurisdiction, this State would create an unreasonable interference with the State who initially granted or recognized the IPR at stake. To avoid this unreasonable interference, the petitioned courts decline jurisdiction in foreign IPRs cases. This declination of jurisdiction is not the result of any general public international law obligation, but rather is a discretionary act of self-restraint based on domestic rules of international procedural law grounded on reasons of *comity to the courts* and on the *act of State doctrine*. (Hereafter, "comity to the courts" and the "act of State doctrine." These terms are interchangeable throughout this Paper.)⁸ Indeed, notwithstanding the fact that these comity rules are of a domestic nature, the same rules are rooted in the concept of territorial sovereignty within a system of equal nation-States. Thus, "even more important that the conflicts of law rules themselves are the basic contours of comity . . . namely"⁹ the goals that must be accomplished by adopting it, among which stays the need to avoid harmful effects on international stability and interaction among nations and "the practical desirability of making decisions which would 'further the development of an effectively functioning international system.'"¹⁰ Therefore, "the question of extending comity touches upon issues concerning the interaction of sovereign nations—matters typically within the scope of public international law"¹¹ and comity can be defined as a non-binding principle governing international affairs or as "a bridge between public

conformity with Article 6 of the ECHR. Indeed, as will be explained in greater detail *infra*, this last Article militates against exclusive jurisdiction provisions).

8. To consider the act of State doctrine as an extension of comity read Jake S. Tyshow, *Informal Foreign Affairs Formalism: The Act of State Doctrine and the Reinterpretation of International Comity*, 43 VA. J. INT'L L. 278, 298 (2002). This article also describes the similarities and the differences between comity and the act of State doctrine.

9. Nadine Jansen Calamita, *Rethinking Comity: Towards a Coherent Treatment of International Parallel Proceedings*, 27 U. PA. J. INT'L ECON. L. 601, 623 (2006).

10. *Id.* at 622.

11. *Id.* at 619. See also Harold G. Maier, *Extraterritorial Jurisdiction at a Crossroads: an Intersection between Public and Private International Law*, 76 AM. J. INT'L L. 280, 281 (1982) ("the doctrine of comity is not a rule of public international law, but the term characterizes many of those same functional elements that define a system of international legal order"). See also Thomas H. Hill, *Sovereign Immunity and the Act of State Doctrine. Theory and Policy in United States Law*, 46 RABELSZ 126 (1982).

and private international law.”¹²

The decisions here examined, then, seem in line with attempts to develop a general public international law theory of allocation of jurisdiction in civil matters that began in the 18th century in the Netherlands, that continued to develop in Anglo-American legal systems, that were popular in Germany around the turn of the 19th century¹³ that “have more recently been revived by [certain] public international lawyers,”¹⁴ and that are based on “comity” reasons.¹⁵ In contrast, this Paper adopts the opinion that “these attempts have been unsuccessful”;¹⁶ public international law does not limit a State’s exercise of jurisdiction inside its borders,¹⁷ and “public international law can play

12. See Calamita, *supra* note 9, at 619. See also Jörn Axel KÄMMERER J.A., *Comity*, in MAX PLANCK ENCYCLOPAEDIA OF PUBLIC INTERNATIONAL LAW 2 (2006), http://www.mpepil.com/subscriber_articles_by_author2?author=K%C3%A4mmerer,%20J%C3%B6rn%20Axel&letter=K. See also CEDRIC RYNGAERT, *JURISDICTION IN INTERNATIONAL LAW* 143 (2008).

13. See the studies of Ulrich Huber and Story, referred to by Maier, *supra* note 11, at 280, (collecting and construing resources) and respectively the studies of Zitelmann and Frankenstein, referred to by Ralf Michaels, *Public and Private International Law: German Views on Global Issues*, 4 J. PUB. INT’L L. 125 (2008).

14. See Michaels, *supra* note 13.

15. *Id.* at 130. See also Maier, *supra* note 11, at 281. On comity as a PIL rule in general see Lawrence Collins, *The United States Supreme Court and the Principles of Comity: Evidence in Transnational Litigation*, 8 Y.B. PRIVATE INT’L L. 53 (2006); Donald Earl Childress III, *Comity as Conflict: Resituating International Comity as Conflict of Laws*, 44 U.C. DAVIS L. REV. 11 (2010); Francisco Javier Zamora Cabot, *On The International Comity In The Private International Law System Of The U.S.A.*, 19 Revista Electrónica de Estudios Internacionales 1 (2010) available at http://www.reei.org/reei19/doc/Nota_ZAMORA_FranciscoJavier.pdf. On comity as a PIL rule with respect to IPRs, see JOHN BRAITHWAITE & PETER DRAHOS, *GLOBAL BUSINESS REGULATION* 58 (Cambridge University Press 2000). See also William Patry, *Choice of Law and International Copyright*, 48 AM. J. COMP. L. 383, 416 (2000), who, however, concentrates on copyright conflict of laws issues rather than on the international procedural matters examined here.

16. Michaels, *supra* note 13, at 125, 130. See also ALEX MILLS, *THE CONFLUENCE OF PUBLIC AND PRIVATE INTERNATIONAL LAW. JUSTICE, PLURALISM AND SUBSIDIARITY IN THE INTERNATIONAL CONSTITUTIONAL ORDERING OF PRIVATE LAW* 23 (Cambridge University Press 2009).

17. Save in exceptional cases, such as those concerning subjects that are immune from foreign jurisdiction. On the immunity from jurisdiction with respect to issues related to IPRs, see Virginia MORRIS, *Sovereign Immunity: The Exception for Intellectual Property*, 19 VAND. J. TRANSNAT’L L. 83, 115 (1986); Akihiro Matsui, *Intellectual Property Litigation and Foreign Sovereign Immunity: International Law Limit to the Jurisdiction over the Infringement of Intellectual Property*, INST. INTELL. PROP. BULL. 2003, available at http://www.iip.or.jp/e/summary/pdf/detail2002/e14_20.pdf; Benedetta Ubetazzi, *Intellectual Property and State Immunity from Jurisdiction in the New York Convention of 2004*, 11 Y.B. PRIVATE INT’L L. 599 (2009) (collecting and construing necessary case law references originating in different countries).

a role in private international law [only] in . . . the broader conception of human rights,”¹⁸ imposing on the States the granting of the right of access to courts and therefore the abandoning of their international jurisdiction provisions inconsistent with this right, namely the exorbitant¹⁹ and exclusive²⁰ jurisdiction rules, of which this paper examines only the latter and in relation to IPRs.

As a conclusion, this paper adopts and develops a thesis according to which exclusive jurisdiction rules in IPRs cases are not suggested by public international law; are actually illegal according to its rules on the denial of justice and on the fundamental human right of access to courts; and therefore, must be abandoned not only with respect to IPRs infringement issues, but also to IPRs validity claims raised as a defense in infringements proceedings, as the majority of the scholars maintain²¹ and the most recent academic initiatives like the ALI Principles and the CLIP Project codify.²²

B. Common Law and Civil Law Perspectives

Finally, with respect to international jurisdiction, it is necessary to highlight that the basic terminology, and legal institutions adopted in Europe diverge considerably from those of the U.S. system, since “European law does not distinguish between personal and subject matter jurisdiction, whereas American law does not employ the categories of general, special and exclusive jurisdiction.”²³ However, on

18. Michaels, *supra* note 13, at 125, 130 (collecting and construing resources).

19. See Carlo Focarelli, *The Right of Aliens not to be Subject to So-Called “Excessive” Civil Jurisdiction*, in ENFORCING HUMAN RIGHTS IN DOMESTIC COURTS 441 (Benedetto Conforti & Francesco Francioni eds., 1997); Diego P. Fernández Arroyo, *Compétence exclusive et compétence exorbitante dans les relations privées internationales*, 323 RECUEIL DES COURS 9 (2006); Giuditta Cordero Moss, *Between Private and Public International Law: Exorbitant Jurisdiction as Illustrated by the Yukos Case*, 32 REV. CENT. E. EUROPEAN L. 1 (2007); RYNGAERT, *supra* note 12, at 165; Nerina Boschiero, *Las reglas de competencia judicial de la Unión Europea en el espacio jurídico internacional*, 9 ANUARIO ESPAÑOL DE DERECHO INTERNACIONAL PRIVADO 35, 47 (2009) (collecting and construing resources). See also the doctrine quoted *infra* 176.

20. For the abandoning of any exclusive jurisdiction provision see Fernández Arroyo, *supra* note 19, *passim*.

21. See the ALI Principles, *infra* note 84. See the CLIP Principles, *infra* note 86.

22. The majority of the doctrine is against exclusive jurisdiction rules in relation to IPRs infringement proceedings and validity issues incidentally raised. See the doctrine that severely criticizes the ECJ GAT decision indicated at *supra* note 6. See also the doctrine mentioned at *supra* note 1. *Contra* see Frigo, *supra* note 7.

23. Kur & Ubertaini, *supra* note 7, at 140. See also Anna Gardella & Luca Radicati di Brozolo, *Civil Law, Common Law and Market Integration: EC Approach to Conflicts of Jurisdiction*, 51 AM. J. COMP. L. 611 (2003); Arnaud Nuyts, *Due Process and Fair Trial*:

the one hand, “American and European law provide functionally equivalent methods for resolving the same problems, [albeit] they cannot agree on, much less unify, these methods.”²⁴ On the other hand, at least with respect to IPR cases, it seems that a “good part of the impression”²⁵ that the two systems are “significantly different”²⁶ “ensues from differences in style and structure rather than from differences in substance.”²⁷ Therefore, although this Paper adopts the notion of exclusive jurisdiction, which is rooted in the European legal tradition rather than the U.S. categories of personal and subject matter jurisdictions, it aims at proposing and demonstrating a thesis applicable at least to both of these legal systems.

I. THESES PURPORTING THAT COMITY, THE ACT OF STATE DOCTRINE AND THE TERRITORIALITY PRINCIPLE ESTABLISH IMPLICIT EXCLUSIVE JURISDICTION RULES

A. *The U.S. Court of Appeals for the Federal Circuit Voda Judgment and the U.K. Court of Appeal Lucasfilm Decision*

In this framework, this Paper starts analyzing the first thesis, which purports that comity and the territoriality principle establish exclusive jurisdiction in the State courts that granted or recognized a registered or unregistered IPR, with respect to both its validity and infringement.²⁸ This thesis was recently adopted, *inter alia*, by two important sovereign court decisions, namely the *Voda v. Cordis* U.S. Court of Appeals for the Federal Circuit judgment and the *Lucasfilm Entertainment Co. v. Ainsworth* U.K. Court of Appeal decision. In the *Voda* case, the plaintiff, Voda, was a U.S. resident, while the defendant, Cordis, was a U.S.-based entity.²⁹ Voda owned several U.S., European, British, Canadian, French, and German patents related to a single invention,

Jurisdiction in the United States and in Europe Compared, in INTERNATIONAL CIVIL LITIGATION IN EUROPE AND RELATIONS WITH THIRD STATES 157 (Arnaud Nuyts & Nadine Watté eds., 2005); Ralf Michaels, *Two Paradigms of Jurisdiction*, 27 MICH. J. INT’L L. 1003, 1011 (2006).

24. Michaels, *supra* note 23, at 1011.

25. Kur & Ubertazzi, *supra* note 7, at 92.

26. Michaels, *supra* note 23, at 1011.

27. Kur & Ubertazzi, *supra* note 7, at 92.

28. Principally or incidentally raised, *see supra* Section I, *Introduction*.

29. *Voda v. Cordis Corp.*, 476 F.3d 887, 890 (Fed. Cir. 2007). For further details concerning this case, *see also infra* Section VI. *Exclusive Jurisdiction Implies a Denial of Justice and Violates the Fundamental Human Right of Access to Courts*.

which Voda claimed Cordis infringed.³⁰ Cordis did not object to Voda's claim of U.S. patent infringement, but opposed Voda's infringement claims concerning the European, British, Canadian, French and German patents, arguing that the court lacked subject matter jurisdiction over such claims.³¹ The court accepted Cordis' argument, and thus refused to examine Voda's foreign patent infringement claims.³²

In *Lucasfilm*, the U.S. plaintiffs sued in a U.S. Court two defendants domiciled in the United Kingdom, claiming that the defendants had infringed the plaintiffs' U.S. copyrights with respect to a number of works created for the film *Star Wars*.³³ According to the plaintiffs, the defendants' infringement activity was "all actually done in or from the U.K. [by virtue of] . . . sales to U.S. customers in the U.S. by dispatch of products from the U.K., advertising on the internet and the placing of advertisements in U.S. publications."³⁴ As the defendants did not appear before the court, the U.S. Court rendered default judgment in favor of the plaintiffs condemning the defendant for infringing the plaintiffs' U.S. copyrights. The U.S. plaintiffs then asked a U.K. Court to enforce its U.S. judgment against the defendants domiciled in the United Kingdom. The U.K. Court of Appeal denied this enforcement request, stating that since "the mere selling of goods from country A into country B does not amount to the presence of the seller in country B,"³⁵ the defendants were not to be considered present in the United States under U.K. international jurisdiction rules that require a defendants' physical presence in the forum State for the forum State's courts to adjudicate a case against them.³⁶ Therefore, the U.S. Court lacked personal jurisdiction to hear the case.³⁷ In response, the U.S. plaintiffs asked the U.K. Court to start a new proceeding on the merits to "enforce the U.S. copyright"³⁸ directly in the United Kingdom. The U.K. Court of Appeal denied this request as well, holding that foreign IPRs are not enforceable in the United Kingdom.³⁹ Indeed, the decision

30. *Id.* at 890.

31. *Id.* at 891.

32. *Id.* at 905.

33. *Lucasfilm Entm't Co. v. Ainsworth*, [2009] EWCA (Civ) 1328, ¶ 5 (Eng.). For further details concerning this case, see also *infra* Section VI. *Exclusive Jurisdiction Implies a Denial of Justice and Violates the Fundamental Human Right of Access to Courts*.

34. *Id.* at 100.

35. *Id.* at 192.

36. *See id.*

37. *See id.* at 187–194.

38. *Id.* at 17.

39. *Id.* at 194.

of the U.K. Court of Appeal has not yet become a *res judicata*, since Lucasfilm appealed to the House of Lords/U.K. Supreme Court.⁴⁰

In both the *Voda* and *Lucasfilm* cases, the respective U.S. and U.K. Courts of Appeals reached their conclusions based on two different arguments related to comity and the territoriality principle.⁴¹ The first argument was grounded on the “act of State doctrine . . . [which] requires that, in the process of deciding, the acts of foreign sovereigns taken within their own jurisdictions shall be deemed valid.”⁴² This argument purports that the rules that govern “relations between sovereigns”⁴³ and that establish “comity and the principle of avoiding unreasonable interference with the authority of other sovereigns”⁴⁴

40. The U.K. Supreme Court is a new body meant to replace the House of Lords’ traditional power as the high court in the United Kingdom.

41. See *supra*, Section I. *Introduction*.

42. *Voda*, 476 F.3d at 904. See the dissenting opinion of Judge Newman for a discussion on the act of State doctrine and on the reasons against its adoption in relation to IPRs; specifically quoting U.S. case law that “rejected the theory that ‘the mere issuance of patents by a foreign power constitutes either an act of state, as the term has developed under case law, or an example of governments’ compulsion.’” *Id.* See also Curtis Bradley, *Extraterritorial Application of U.S. Intellectual Property Law: Territorial Intellectual Property Rights in an Age of Globalization*, 37 VA. J. INT’L L. 505 (1997); Peter Nicolas, *The Use of Preclusion Doctrine, Antisuit Injunctions, and Forum Non Conveniens Dismissals in Transnational Intellectual Property Litigation*, 40 VA. J. INT’L L. 331, 363 (1999), quoting relevant U.S. case law according to which

in those cases in which the courts have traditionally invoked the act of state doctrine ‘the crucial acts occurred as a result of a considered policy determination by a government to give effect to its political and public interests[,] matters that would have significant impact on American foreign relations’. In contrast, . . . the grant of a patent for floor coverings is merely a ‘ministerial activity’ and thus ‘not the type of sovereign activity that would be of substantial concern to the executive branch in its conduct of international affairs.’

The same conclusion is reached in relation to copyright by Graeme Dinwoodie, *Conflicts and International Copyright Litigation: the Role of International Norms*, in *INTELLECTUAL PROPERTY IN THE CONFLICT OF LAWS 210* (Jürgen Basedow, Josef Drexl, Annette Kur & Axel Metzger eds., 2005) and in relation to IPRs in general by Pedro De Miguel, *Cross-border Adjudication of Intellectual Property Rights and Competition between Jurisdictions*, 41 ANNALI ITALIANI DEL DIRITO D’AUTORE 105, n.112 (2007). On the act of State doctrine and on the reasons against its adoption in international public law in general, and thus not only with respect to IPRs, see BENEDETTO CONFORTI, *DIRITTO INTERNAZIONALE*, 232 (7th ed. 2006).

43. *Voda*, 476 F.3d at 900.

44. *Lucasfilm*, [2009] EWCA (Civ) 1328 at 171 (recalling the *Voda* judgment). On the comity reasons with respect to IPRs, see *supra* note 12, and note 43.

(general public international law rules)⁴⁵ limit the exercise of international jurisdiction by a State on foreign matters that are the expression of another State's sovereignty or domestic policies. Registered and unregistered IPRs are among those matters, since such rights are an expression of the sovereignty of the States that grant or recognize them,⁴⁶ or are an expression of such State's local policies and interests.⁴⁷ As a consequence, both versions of this thesis—both the version of the *Voda* case and the *Lucasfilm* case respectively—advance that courts decline the exercise of their jurisdictions regarding matters related to both the validity and infringement of foreign IPRs, since “a world in which states regularly claimed jurisdiction over the property rights established by other nationals would be a world in which the principle of negative comity would have largely vanished.”⁴⁸ Thus, both versions of this thesis posit that comity reasons implicitly establish exclusive jurisdiction in the State granting or recognizing each IPR with respect to the validity and infringement thereof.

The second argument advanced in the *Voda* and *Lucasfilm* cases is grounded on the territoriality principle.⁴⁹ According to this argument,

45. See *supra*, Section I. Introduction.

46. *Voda*, 476 F.3d at 902 according to which “[i]t would be incongruent to allow the sovereign power of one to be infringed or limited by another sovereign's extension of its jurisdiction” with respect to a foreign patent infringement claim.

47. *Lucasfilm*, [2009] EWCA (Civ) 1328 [159, 176] according to which “[i]nfractionment of an IP right (especially copyright, which is largely unharmonized) is essentially a local matter involving local policies and local public interest” and “enforcement may involve a clash of the IP policies of different countries.”

48. See BRAITHWAITE & DRAHOS, *supra* note 15, at 58, explaining that this way of thinking originated in the beginning of the IPRs history, namely in the so called territorial period. For the arguments against the adoption of comity reasons in the current IPRs era, so called globalized period, see the following remarks.

49. On the territoriality principle and on the reasons against its interpretation as an international jurisdiction rule in relation to IPRs, see Josef Drexler, *Internationales Immaterialgüterrecht*, 11 MÜNCHENER KOMMENTAR ZUM BÜRGERLICHEN GESETZBUCH 819, 820 (2006); Nerina Boschiero, *Il principio di territorialità in materia di proprietà intellettuale: conflitti di leggi e giurisdizione*, 41 ANNALI ITALIANI DEL DIRITO D'AUTORE 34, 99 (2007); Graeme Dinwoodie, *Developing a Private International Intellectual Property Law: the Demise of Territoriality*, 51 WM. & MARY L. REV. 711 (2009); Alexander Peukert, *Territoriality and Extraterritoriality in Intellectual Property Law*, in BEYOND TERRITORIALITY: TRANSNATIONAL LEGAL AUTHORITY IN AN AGE OF GLOBALIZATION (GUNTHER Handl & Joachim Zekoll eds., 2011), available at http://www.jura.uni-frankfurt.de/ifrv1/peukert/forschung/Territoriality_and_Extraterritoriality_in_Intellectual_Property_Law.pdf. On a comparative analysis of the territoriality principle adopted as a conflict of law rule and on the current discussion concerning its appropriateness, see Riccardo Luzzatto, *Problemi Internazionali del Diritto di Autore*, 25 RIVISTA DI INTERNAZIONALE PRIVATO E PROCESSUALE 278, 278 (1989); Riccardo Luzzatto, *Proprietà Intellettuale e Diritto Internazionale*, in PROPRIETÀ INTELLETTUALE E CONCORRENZA 900,

the Paris Convention for the Protection of Industrial Property (CUP),⁵⁰ the Berne Convention for the Protection of Literary and Artistic Works (CUB),⁵¹ the Patent Cooperation Treaty (PCT),⁵² and the TRIPs agreement⁵³ establish the principle of the independence of each State's domestic IPR system, as well as the principle of territoriality of the enforcement of IPRs. As both the domestic independence principle and the territorial enforcement principle are grounded on the territoriality principle, they will hereinafter be referred to collectively as the territoriality principle. According to the argument advanced in the *Voda* and *Lucasfilm* cases, the territoriality principle implies the "independence of each country's sovereign . . . system[]" for adjudicating⁵⁴ its IPRs and does not allow any interference in the foreign country's IPR system. Within this framework, interference purportedly occurs whenever a domestic court adjudicates a foreign IPR

901 (2004); BRAITHWAITE & DRAHOS, *supra* note 15, at 58. See also Kono & Jurčys *supra* note 3, at n.1, subsection III.9.3.

50. Adopted in 1883, as amended on July 14, 1967, available at http://www.wto.org/english/docs_e/legal_e/legal_e.htm#agreements and <http://www.wipo.int/treaties/en/summary.jsp>.

51. Adopted in 1886, as amended on September 28, 1979, available at http://www.wto.org/english/docs_e/legal_e/legal_e.htm#agreements and <http://www.wipo.int/treaties/en/summary.jsp>.

52. Treaty of Washington adopted in 1970, as amended on October 3, 2001, available at http://www.wto.org/english/docs_e/legal_e/legal_e.htm#agreements and <http://www.wipo.int/treaties/en/summary.jsp>.

53. Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs), annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on April 15, 1994, available at http://www.wto.org/english/docs_e/legal_e/legal_e.htm#agreements and <http://www.wipo.int/treaties/en/summary.jsp> for the text of this treaty. The TRIPs agreement incorporates various IP conventional norms by reference, including the principles of territoriality and national treatment. However, the TRIPs agreement also

departs from the long tradition whereby international IP conventions confined themselves to imposing on Members only negative obligations, in particular by requiring national treatment of foreigners, and takes the unprecedented step of mandating positive obligations, including most-favoured nation treatment and greatly expanding minimum IP protection standards.

Marco Ricolfi, *The First Ten Years of the TRIPs Agreement: Is There an Antitrust Antidote Against IP Overprotection Within TRIPs?*, 10 MARQ. INTELL. PROP. L. REV. 305, 331 (2006). See also Marco Ricolfi, *The Interface between Intellectual Property and International Trade: the TRIPs Agreement*, ITALIAN INTELL. PROP. 29 (Jan. 2002); Christopher Wadlow, "Including Trade in Counterfeit Goods": *The Origins of TRIPs as a GATT Anti-counterfeiting Code*, 3 INTELL. PROP. Q. 350 (2007).

54. *Voda v. Cordis Corp.*, 476 F.3d 887, 899 (Fed. Cir. 2007).

issue. Thus, it is argued that the territoriality principle proscribes such adjudication. The absence of an “express jurisdictional-stripping statute”⁵⁵ in the CUP, CUB, PCT, and TRIPs agreements is alleged to lend further support to this position, since nothing in these treaties “contemplates or allows one jurisdiction to adjudicate [the] patents of another [country].”⁵⁶ In conclusion, this argument purports that the CUP, CUB, PCT, and TRIPs agreements establish an implicit exclusive jurisdiction rule with respect to both IPR validity and infringement disputes.

B. *The ECJ (CJEU) GAT Decision*

Like the two versions of the first thesis presented, a second thesis also maintains that implicit exclusive jurisdiction rules exist with respect to IPRs. However, this thesis differs from the previous in that, firstly, the exclusive jurisdiction rule covers only registered IPRs and does not encompass unregistered IPRs; and secondly, the exclusive jurisdiction rule covers the proceedings related to the validity of the IPR but does not encompass its infringement claims.⁵⁷ This thesis forms the basis of Article 16.4 of the Brussels Convention, now Article 22.4 of the Brussels I Regulation.⁵⁸ (Hereinafter, the Brussels Convention and the Brussels I Regulation are jointly referred to as “the Brussels System” together with the Lugano Convention).⁵⁹ Hence, according to the Jenard Report to the Brussels Convention,

[s]ince the grant of a national patent is an exercise of national sovereignty, Article 16(4) of the Judgments Convention provides for exclusive jurisdiction in proceedings concerned with the validity of patents. Other actions, including those for infringement of patents, are governed by the general rules of the Convention.⁶⁰

55. *Id.*

56. *Id.* See also *Lucasfilm*, [2009] EWCA (Civ) 1328 [179–180].

57. Principally or incidentally raised, see *supra* Section I. *Introduction*.

58. The Regulation 44/2001, in 2001 O.J. (L 12) 1, transformed into a Community legal instrument (communitarized) the Brussels convention on jurisdiction and recognition and enforcement of judgments in civil and commercial matters of Sept. 27, 1968.

59. See The Lugano Convention May 30, 2007, concluded between the EC and certain member States of EFTA: Switzerland, Norway, Iceland, and related to jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, *available at* <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:32007D0712:EN:NOT>.

60. 1979 O.J. (C 59) 36. See also Convention on jurisdiction and the recognition and

This thesis was also adopted and developed further by the European Court of Justice (ECJ) in its interpretation of the scope of Article 16.4 of the Brussels Convention (now 22.4 of the Brussels I Regulation) in two cases. In the first case, the *Duijnstee* case, Mr. Duijnstee, a liquidator in the dissolution of a company, applied to the Maastricht Arrondissementsrechtbank for an interlocutory injunction requiring Mr. Goderbauer, the former manager of the company, to transfer to Mr. Duijnstee the patents, both applied for and granted, in twenty-two countries for an invention that Mr. Goderbauer made while employed by the company.⁶¹ The proceeding came before the Hoge Raad, which in turn stayed and referred to the ECJ the preliminary question of “whether the concept of proceedings ‘concerned with the registration or validity of patents’ within the meaning of Article 16 (4) of the [Brussels] Convention . . . may cover a dispute such as that concerned in the main action”⁶² namely, a dispute having as its subject-matter a transfer of IPRs. The ECJ answered that Article 16.4 does not cover such disputes.⁶³

In the second case, the *GAT* case, the plaintiff LuK, sued GAT before the Landgericht Düsseldorf.⁶⁴ Here, both the plaintiff and defendant were companies established in Germany. LuK’s complaint alleged that GAT had infringed two of LuK’s French patents. GAT responded by bringing a declaratory action before the Düsseldorf Court, asking the court to establish that GAT was not in breach of LuK’s patents, as such patents were either void or invalid. The Oberlandesgericht Düsseldorf stayed the proceeding and asked the ECJ if the exclusive jurisdiction of Article 16.4 of the Brussels Convention

only applies if proceedings (with *erga omnes* effect) are brought to declare the patent invalid or are proceedings concerned with the validity of patents within the meaning of the aforementioned provision where the

enforcement of judgments in civil and commercial matters, signed in Lugano on 30 October 2007. Explanatory Report by Professor Fausto Pocar (*Holder of the Chair of International Law at the University of Milan*) in 2009 O.J. (C 319) 25.

61. Case 288/82, *Duijnstee v. Goderbauer*, 1983 E.C.R. 3663, ¶ 3.

62. *Id.* at ¶¶ 19–20.

63. *Id.* at ¶ 25.

64. Case C-4/03, *GAT v. LuK*, 2006 E.C.R. I-6509, ¶ 10. For further details concerning this case, see also *infra* Section VI. *Exclusive Jurisdiction Implies a Denial of Justice and Violates the Fundamental Human Right of Access to Courts.*

defendant in a patent infringement action or the claimant in a declaratory action to establish that a patent is not infringed pleads that the patent is invalid or void and that there is also no patent infringement for that reason, irrespective of whether the court sei[z]ed of the proceedings considers the plea in objection to be substantiated or unsubstantiated and of when the plea in objection is raised in the course of proceedings.⁶⁵

The ECJ answered that “the rule of exclusive jurisdiction laid down [by Article 16.4 of the Convention] . . . concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection.”⁶⁶

In both the *Duijnstee* and the *GAT* cases, the ECJ reached its conclusions on the basis of the following main arguments. First, according to the ECJ, “exclusive jurisdiction is justified by the fact that the issue of patents necessitates the involvement of the national administrative authorities.”⁶⁷ Here, the ECJ references the Jenard Report, according to which the granting of a patent is an “exercise of national sovereignty.”⁶⁸ This statement makes apparent that the Jenard Report is grounded on the act of State doctrine. Accordingly, the ECJ decisions citing it are also based on the act of State doctrine.

Furthermore, the act of State doctrine is adopted to ground the scope of the exclusive jurisdiction rule advanced by the second thesis. According to this thesis, the exclusive jurisdiction rule covers only registered IPRs and does not apply to unregistered IPRs. The reason for this distinction is that registered IPRs are granted through a public act of concession, which implies the intervention of the national administration and, therefore, the “exercise of national sovereignty,” whereas unregistered IPRs come into being without these formalities. Also, according to this thesis, exclusive jurisdiction rules cover the proceedings related to the validity of IPRs,⁶⁹ but do not encompass related infringement claims. Such divergent treatment is premised on the argument that proceedings concerning an IPR’s validity actually

65. *Id.* at ¶ 12.

66. *Id.* at ¶ 31.

67. *Id.* at ¶ 23.

68. P. Jenard, *Report on the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters*, 1979 O.J. (C 59) 36.

69. Principally or incidentally raised, *see supra* Section I. *Introduction*.

question or challenge the validity of its granting acts; whereas proceedings related to infringement concern only the activity of private subjects. Thus, since the granting act is an act of the national administration of the granting State, this act is argued to be an expression of the State's sovereignty, leading to the second thesis' conclusion that validity proceedings imply an examination of the sovereign activity of foreign States.

In contrast with the ECJ's embracing of the first argument of the first thesis, namely, the act of State doctrine, the ECJ has refused to adopt the second argument of the first thesis, which purports that the CUP, CUB, PCT, and TRIPs agreements also implicitly establish an exclusive jurisdiction rule. To understand the ECJ's position with regard to the CUP, CUB, PCT, and TRIPs agreements, it is relevant to briefly review the *Tod's* case. In that case, "[h]aving learnt that [a French company] was offering for sale and selling under [its] name designs of shoes which copied or at least imitated the principal characteristics of the [Italian companies] Tod's and Hogan, designs,"⁷⁰ Tod's brought an action for infringement of registered designs for shoes bearing the Tod's and Hogan trademarks in the French Court.⁷¹ The French company countered with a plea of inadmissibility contending that, under the Berne Convention, Tod's was not entitled to claim copyright protection in France for designs that did not qualify for such protection in Italy.⁷² The French Court stayed the proceeding and asked the ECJ to establish if

Article 12 EC, which lays down the general principle of non-discrimination on grounds of nationality, mean that the right of an author to claim in a Member State the copyright protection afforded by the law of that State may not be subject to a distinction based on the country of origin of the work[.]⁷³

The ECJ considered that "the purpose of that convention is not to determine the applicable law on the protection of literary and artistic works, but to establish, as a general rule, a system of national treatment

70. Case C-28/04, *Tod's SpA, Tod's France SARL v. Heyraud SA*, 2005 E.C.R. I-5783, ¶ 7, available at www.curia.eu.int.

71. *Id.* at ¶¶ 1-8.

72. *Id.* at ¶ 8.

73. *Id.* at ¶ 12.

of the rights appertaining to such works.”⁷⁴ Therefore, the ECJ answered that

Article 12 EC . . . must be interpreted as meaning that the right of an author to claim in a Member State the copyright protection afforded by the law of that State may not be subject to a distinguishing criterion based on the country of origin of the work.⁷⁵

The ECJ’s conclusions that the CUB does not relate to private international law and therefore, does not determine any applicable laws, but instead establishes that a national treatment principle of a substantive nature, may be applied to the CUP, CUB, PCT, and TRIPs agreements, and also to international procedural law. Interpreted in this way, the ECJ’s *Tod’s* decision determines that the territoriality principle of the CUP, PCT, and TRIPs agreements not only does not refer to applicable law, but also does not posit an implicit exclusive jurisdiction rule.

II. EXCLUSIVE JURISDICTION RULES ARE NOT ESTABLISHED EITHER
BY COMITY OR BY THE ACT OF STATE DOCTRINE AND THE
TERRITORIALITY PRINCIPLE, BUT RATHER ARE RENDERED ILLEGAL
BY THE PUBLIC INTERNATIONAL LAW RULES ON THE RIGHT OF
ACCESS TO COURTS: THE SUBJECT MATTER AND DELIMITATION OF
THIS RESEARCH

The two theses on exclusive jurisdiction just discussed, the first in the *Voda* and *Lucasfilm* cases, and the second in the ECJ judgments, are not convincing for two reasons. Each reason is related to the unacceptability of the arguments in their favor when considered in the context of public international law. The first argument advanced in support of these theses, based on the act of State doctrine and comity reasons, respectively, is not convincing for reasons that I will explain and demonstrate in detail in the second chapter of my forthcoming book on exclusive jurisdiction in IPRs cases.

For present purposes, I will simply state that IPRs are not an expression of the sovereignty or local policies of their granting or recognizing States but are “private rights,”⁷⁶ albeit where registered,

74. *Id.* at ¶ 32.

75. *Id.* at ¶ 37.

76. European Max Planck Group on Conflict of Laws in Intellectual Property,

they come into being with conditions of formalities, namely through an administrative act. Furthermore, albeit *arguendo* if these administrative acts were to be considered as acts of State,⁷⁷ characterizing them as such would not impede the exercise of jurisdiction by a foreign country over issues concerning the validity thereof,⁷⁸ provided that comity reasons and the act of State doctrine do not rest on general public international law grounds, that general public international law does not limit a State's exercise of jurisdiction inside its borders even with respect to acts of States, and especially that "there is [even] an infringement of the right of access to a court where a case is dismissed under the act of state doctrine."⁷⁹ Finally, the adoption of comity reasons in relation to the international jurisdiction aspects of IPRs was understandable at the beginning of the IPRs history. Namely, in the so-called "territorial period," where an intimate connection between sovereignty, IPRs, and territory existed; however, the adoption of comity reasons is not justified today, where the IPRs international and global periods that followed the territorial period produced the harmonization of the procedural and substantive laws regarding IPRs, with "a spectacular impact [on, and in] sharp contrast [with,]"⁸⁰ the sovereignty (personality and territoriality) logics.

The second argument advanced in support of these theses that is grounded on the territoriality principle is not convincing either, for reasons that I will address in detail in the third chapter of my forthcoming book. Accordingly, I simply state here that the territoriality principle adopted by the CUP, CUB, PCT, and TRIPs agreements does not ground any exclusive jurisdiction rules of an implicit nature,⁸¹ and that, even when the territoriality principle is at the base of explicit international jurisdiction provisions posed by legal

Principles for Conflict of Laws in Intellectual Property, Second Preliminary Draft, 7 (2009), available at http://www.ip.mpg.de/shared/data/pdf/draft-clip-principles-06-06-2009_version_2.pdf. However, the reference to the nature of "private rights" is not present in the *third Preliminary Draft of the CLIP Principles* (September 1, 2010), available at http://www.ip.mpg.de/shared/data/pdf/draft-clip-principles-01-09-2010_version_3.pdf.

77. However, on their not being characterized as acts of State *see supra* note 29.

78. Principally or incidentally raised, *see supra* Section I. *Introduction*.

79. As such Tobias Thienel, *The Act of State Doctrine: In Violation of International Law (Part 3)*, (Oct. 23, 2006) available at <http://corelaw.blogspot.com/2006/10/act-of-state-doctrine-in-violation-of.html>. *See also supra* Section I. *Introduction*, and *infra* Section VI. *Exclusive Jurisdiction Implies a Denial of Justice and Violates the Fundamental Human Right of Access to Courts*.

80. *See* BRAITHWAITE & DRAHOS, *supra* note 15, at 58.

81. On the territoriality principle and on the reasons against its interpretation as a conflict of jurisdiction provision in relation to IPRs, *see* the doctrine mentioned *supra* note 45.

instruments other than the CUP, CUB, PCT, and TRIPs agreement, the territoriality principle should be interpreted according to the “proximity principle,” which cannot be addressed in this paper other than by saying that such can never ground exclusive jurisdiction rules (as will be demonstrated in the third chapter of my forthcoming book).

The two theses of exclusive jurisdiction are also not convincing for a third reason related to public international law. That is, exclusive jurisdiction rules violate the right of access to courts. This right is granted by both general international law rules and by international conventions establishing the avoidance of a denial of justice, the doctrine (rule) of *forum necessitatis*, and the fundamental human right of access to courts. Thus, by violating the right of access to courts, exclusive jurisdiction provisions violate public international law. This, in turn, not only does not impose implicit exclusive jurisdiction rules, but rather, renders them illegal. The demonstration of this conclusion is the subject matter of this study.

However, this study does not examine private international law issues related to the contractual circulation of IPR, defined also as “secondary” IPR law.⁸² Rather, this study concentrates on the “primary” or “proprietary” issues related to IPRs, which comprise matters of the ownership, validity and existence of such rights as well as the transferability, scope, and infringement thereof. Hence, exclusive jurisdiction rules relate to the latter, not the former, matters.

This study presupposes a comparative analysis, which will be rendered in the first chapter of my forthcoming book, of explicit exclusive jurisdiction rules of case law and of a statutory nature, between domestic or conventional origin, and between hard law or soft law character.⁸³ This study will, then, refer to the specific exclusive jurisdiction rules only where necessary to demonstrate the herein proposed conclusion.

Moreover, this study is grounded on the premise, which will be demonstrated in the first chapter of the forthcoming book, that exclusive jurisdiction rules are not the expression of a rule of customary international public law. Here it is sufficient to state that the majority of States adopt statutory or case law rules concerning exclusive jurisdiction

82. On the EU jurisdiction related to the contractual circulation of IPRs, see Bendetta Ubertazzi, *Licence Agreements Related to IP Rights and the EC Regulation on Jurisdiction*, 40 INT'L REV. OF INTELL. PROP. & COMPETITION L. 912 (2009) (collecting and construing resources).

83. On a comparative analysis of the exclusive jurisdiction rules, see the general and national reports, *supra* note 1.

only with respect to validity issues of registered IPRs and only when such issues are principally raised. In contrast, these exclusive jurisdiction rules do not extend to either infringement claims or validity issues incidentally raised for registered IPRs or to claims related to the infringement or validity of unregistered IPRs, however raised. Also, the ALI Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes, adopted on May 14, 2007,⁸⁴ do not adopt the model of the U.S. Court of Appeals for the Federal Circuit's *Voda v. Cordis* decision but, in contrast, limit the scope of the exclusive jurisdiction (subject matter jurisdiction) rule to registered IPRs validity issues principally addressed; however, these principles do not also extend protection to unregistered IPRs or to registered IPRs incidentally raised validity issues, nor to infringement claims.⁸⁵

The same limited scope of exclusive jurisdiction is adopted by the CLIP, *Principles for Conflict of Laws in Intellectual Property* third

84. See AMERICAN LAW INSTITUTE, *INTELLECTUAL PROPERTY: PRINCIPLES GOVERNING JURISDICTION, CHOICE OF LAW, AND JUDGMENTS IN TRANSNATIONAL DISPUTES*, (2008). On the ALI Principles, see Kono, *Intellectual Property Rights, Conflict of Laws and International Jurisdiction: Applicability of ALI Principles in Japan*, 30 BROOK. J. INT'L L. 865 (2004–2005); Catherine Kessedjian, *Current International Development in Choice of Law: An Analysis of the ALI Draft*, in *INTELLECTUAL PROPERTY IN THE CONFLICT OF LAWS* 19 (Basedow, Drexler, Kur & Metzger eds., Tübingen 2005); Alex Metzger, *Transfer of Rights, License Agreements, and Conflict of Laws: Remarks on the Rome Convention of 1980 and the Current ALI Draft*, in *INTELLECTUAL PROPERTY IN THE CONFLICT OF LAWS* n. 61 (Basedow, Drexler, Kur & Metzger eds., Tübingen 2005); Francois Dessemontet, *Resolution Through Conflict of Laws: A European Point of View on the ALI Principles—Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes*, 30 BROOK. J. INT'L L. 849, 850 (2005); Rochelle Dreyfuss, *Resolution Through Conflict of Laws: The ALI Principles on Transnational Intellectual Property Disputes: Why Invite Conflicts?*, 30 BROOK. J. INT'L L. 819 (2005); Frank Beckstein, *The American Law Institute Project on Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes. Summary of the Presentation given by Rochelle Dreyfuss*, in *INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW* 22 (Stefan Leible and Ansgar Ohly eds., 2009); Moura Vicente, *La propriété intellectuelle en droit international privé*, 335 RECUEIL DES COURS 424 (2008); Kur & Ubertazzi, *supra* note 7, *passim* (collecting and construing resources); Axel Metzger, *Jurisdiction in Cases Concerning Intellectual Property Infringements on the Internet, Brussels-I-Regulation, ALI-Principles and Max Planck Proposals*, in *INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW* 251 (Stefan Leible and Ansgar Ohly eds., 2009). See also the doctrine quoted *supra* note 3.

85. The ALI Principles permit, then, the competent court to adjudicate claims arising under foreign laws (Article 211.1). Indeed, those principles limit the effectiveness of a court decision holding invalid the registered rights granted under the law of another State. Hence, Article 211.2 of the ALI principles states that such a decision shall be effective only between parties but does not affect the validity or registration of the IP rights in question as against third parties. The same result is reached under Arts. 213.2 and 213.3 of the ALI principles, concerning proceedings to obtain a declaration of invalidity of registered IP rights. See Kur & Ubertazzi, *supra* note 7, at subsection II. c.

preliminary draft,⁸⁶ which was published on September 1, 2010, and by other academic Principles currently being negotiated in certain Asian countries.⁸⁷ Hence, *inter alia*, the CLIP Principles do not adopt the model of the ECJ's GAT decision and establish exclusive jurisdiction criteria only for disputes related to validity issues principally raised concerning registered IP rights.⁸⁸ Moreover, except for the Brussels Convention, which extended the scope of exclusive jurisdiction implicitly, and the Lugano Convention, which extended the scope of exclusive jurisdiction explicitly,⁸⁹ to registered IPRs validity issues incidentally raised, exclusive jurisdiction rules concerning IPRs cases even with a limited scope cannot be found in any other international conventions. In contrast, the inclusion of such exclusive jurisdiction, even with a limited scope, in The Hague Draft Convention on

86. See EUROPEAN MAX PLANCK GROUP ON CONFLICT OF LAWS IN INTELLECTUAL PROPERTY, *Third Preliminary Draft* *supra* note 76. On the CLIP Principles see Kur & Ubertazzi, *supra* note 7 *passim*; METZGER, *Jurisdiction*, *supra* note 84, at 251; De Miguel Asensio, *Recognition and Enforcement of Judgments in Intellectual Property Litigation: The CLIP Principles*, in INTELLECTUAL PROPERTY IN THE GLOBAL ARENA: JURISDICTION, APPLICABLE LAW, AND THE RECOGNITION OF JUDGMENTS IN EUROPE, JAPAN AND THE US, (Jurgen Basedow, Toshiyuki Kono, and Axel Metzger eds., 2010) (forthcoming), available at <http://eprints.ucm.es/9841/1/PdeMiguelREC-ENF-CLIP.pdf>, at 251; Axel Metzger, *Applicable Law under the CLIP-Principles: A Pragmatic Revaluation of Territoriality*, in INTELLECTUAL PROPERTY IN THE GLOBAL ARENA: JURISDICTION, APPLICABLE LAW, AND THE RECOGNITION OF JUDGMENTS IN EUROPE, JAPAN AND THE US, (Jurgen Basedow, Toshiyuki Kono, & Axel Metzger eds., 2010) (forthcoming), available at http://www.iri.uni-hannover.de/tl_files/Materialien/Metzger/Publikationen/Metzger-ApplicableLawUnderCLIP2010.pdf. See also the doctrine quoted *supra* note 3.

87. See the *Transparency Proposal* from Japan, the *Waseda Proposal* from South-East Asia, the *Korean Proposal* from Korea and the *MOJ Proposal* from Japan, and for all extensively see Kono & Jurčys, *supra* note 3, at § I.1.

88. Thus, in disputes having as their object a judgment relating to the grant, registration, validity, abandonment or revocation of a patent, a mark, an industrial design or any other IP right protected on the basis of registration, Article 2:401.1 grants exclusive jurisdiction to the courts in the State where the IP right was registered or is deemed to have been registered. In any case, Article 2:401.2, first sentence, clarifies that Article 2:401.1 does not apply where the validity or registration of the registered IP right is challenged in a context other than by principal claim or counterclaim. Indeed, Article 2:401.2, second sentence, establishes that decisions arising from such disputes do not affect the validity or registration of the IP rights questioned as against third parties. Finally, Article 2:402 on Obligation of other courts states that “where a court of a state is seized of a claim which has as its object a matter over which the courts of another state have exclusive jurisdiction by virtue of Article 2:401, it shall declare of its own motion that it has no jurisdiction.” It is relevant to remember that the first Draft of the CLIP principles of April 2009 established an exclusive jurisdiction also for unregistered IP rights. See Kur & Ubertazzi, *supra* note 7, at subsection II.c.

89. See the ECJ GAT decision, *supra* note 7; see Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters, Sept. 16, 1988, 1988 O.J. (L319) 9, reprinted in 28 I.L.M. 620 Article 22. 4 of the Lugano Convention.

international jurisdiction and recognition of foreign judgments of 1999,⁹⁰ was one of the principal reasons for the failure of that draft. Articles 12.4 and 12.5 of the draft granted exclusive jurisdiction in IP cases to the courts of the contracting State in which the deposit or registration had been applied for, had actually taken place, or was deemed to have taken place, but did not extend it either to copyright and related rights, or to infringement issues, nor to validity issues incidentally raised.⁹¹ Despite this limited scope, the issue of exclusive jurisdiction grounded in the provision in question, was extensively debated; since, during the negotiation proceedings, common law-jurisdiction countries (United States, England, and Australia) and representatives of business even questioned the overall necessity of exclusive jurisdiction rules.⁹²

In this context, it is reasonable to conclude that exclusive jurisdiction rules are not grounded in the States' *opinio juris ac necessitatis* but

90. *Preliminary Draft Convention on Jurisdiction and the Effects of Judgments in Civil and Commercial Matters (DHJC)*, June 18, 1999, with an explanatory report by Peter Nygh & Fausto Pocar, (HC) *Prel. Doc. No. 11*, available at (Fausto Pocar & Costanza Honorati eds., 2005) *The Hague Preliminary Draft Convention on Jurisdiction and Judgments: Proceedings of the Round Table held at Milan University on 15 November 2003*, Milan, Cedam, 2005 (Nygh/Pocar Report), p. 209. The text of the DHJC is available *ibidem*. For the history of the draft convention and the ensuing developments, see *Id.* See also Schulz, *The Hague Conference Project for a Global Convention on Jurisdiction, Recognition and Enforcement in Civil and Commercial Matters: An Update*, INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW: HEADING FOR THE FUTURE 5 (Josef Drexl & Annette Kur eds., 2005). With respect to IPRs see Annette Kur, *International Hague Convention on Jurisdiction and Foreign Judgments: A Way Forward for IP?* E.I.P.R. 175 (2002); Petkova Svetozara, *The Potential Impact of the Draft Hague Convention on International Jurisdiction and Foreign Judgments in Civil and Commercial Matters on Internet-related Disputes with Particular Reference to Copyright*, 2 INTELL. PROP. Q. 173 (2004).

91. See Arts.12.4 and 12.5 of the Draft Nygh/Pocar report, *supra* note 90, at 261; Kono & Jurčys, *supra* note 3, at § 4.1.

92. According to those countries, the mere fact of deposit or registration of IPRs might confer jurisdiction upon the courts of a country which has no jurisdiction over the defendant (*in personam* jurisdiction). Permanent Bureau, *Preliminary Document No.13, Report of the experts meeting in the intellectual property aspects of the future Convention on jurisdiction and foreign judgments in civil and commercial matters* (February 1, 2001), available at <http://www.hcch.net/upload/wop/jdgm13.pdf>. By contrast, for the Switzerland and Scandinavian delegations the court of the place of registration has exclusive jurisdiction over the matters related to validity while courts hearing infringement claims have to stay the proceeding until the validity issue is decided, see *Preliminary Document No.13*, at 4–5. For an overview of all the other delegations' opinions, see *Preliminary Document No.13*, at 4–6. See also Nygh/Pocar report, *supra* note 90, at 261; Kono & Jurčys, *supra* note 3, at § 4.1. According to the reporters of the Draft Convention, then, the definition of the proceedings related to IPRs was one of the most troublesome questions to address during the negotiation proceedings of the 1999 Hague draft and was also one of the main reasons why especially the U.S. delegation opposed to the 1999 leading to its partial failure. See Nygh/Pocar report *supra* note 90, at n. 261.

rather on criticizable political and opportunistic reasons. This statement is in line with the uncontroversial thesis regarding issues related to the absolute rights concerning not IP but immovable objects. According to this thesis, even though certain domestic or conventional norms of a soft law or a hard law nature allocate international jurisdiction exclusively to the courts of the State where the immovable object is located, those norms are not the expression of a rule of customary public international law.⁹³

Finally, even though, *arguendo*, exclusive jurisdiction rules are to be considered the expression of a rule of customary international public law, this rule is overridden by another rule of general international public law, being constituted by the general principle of international and EU law of *forum necessitatis*, and of the fundamental human right of access to courts, that will be examined later by this Paper.⁹⁴ Hence, the sovereign reasons found at the basis of allegedly existing exclusive jurisdiction customary rules cannot prevail over the fundamental human right of access to courts, which grounds the general legal principle of *forum necessitatis* and of the same right of access to courts.

This study does not examine the other possible arguments that are generally invoked in favor of exclusive jurisdiction rules. However, some examples of these arguments are (1) that those rules derived from “the principle of non-justiciability for claims concerning foreign land, established over a century ago in the *Moçambique* case,”⁹⁵ (2) that the same rules promote the “sound administration of justice”⁹⁶ and “judicial economy,”⁹⁷ (3) that the “best place[] to adjudicate” IP disputes is in the courts of the State that granted or recognized the IP right,⁹⁸ and (4) that

93. See G.L. TOSATO, LA GIURISDIZIONE VOLONTARIA NEL PROCESSO VOLONTARIO 19 (Milano, Giuffrè, 1971).

94. Hereafter, for the purposes of this Paper only, the general principle of international and EU law for simplicity will be referred to as general principle of law.

95. Dickinson, *supra* note 6, at 183. See also *Lucasfilm Entm’t Co. v. Ainsworth*, [2009] EWCA Civ 1328 [174–186], recalling the *Moçambique* case, and Torremans, *supra* note 6, at 753, according to whom the *Moçambique* case

is a case about immovable property, and the argument that intellectual property is similar to immovable property has really had its day. And in as far as subject matter jurisdiction is at issue there is simply no way it can find its way into the [Brussels I] Regulation; the *Moçambique* case is irrelevant on this point.

96. C-4/03, *GAT v. LuK*, 2006 E.C.R. I-6509, ¶ 22.

97. *Voda v. Cordis Corp.*, 476 F.3d 887, 889 (Fed. Cir. 2007).

98. Case 288/82, *Duijnste v. Goderbauer*, 1983 E.C.R. 3663, ¶ 22.

the difficulties of applying in the forum State court the foreign IP law of the State that granted or recognized the IPR are too great.⁹⁹ Accordingly, this study does not expose the arguments against these reasons since, first, they are not primarily related to international public law, and, second, they will be examined in the last chapter of my forthcoming book.¹⁰⁰

This study does not examine whether IPRs validity and infringement issues or the provisional injunctions related to the IPRs matters can be arbitrated, notwithstanding the fact that the submission of these issues to arbitration tribunals and courts that are different than those of the States that granted the IPR at hand derogates from the exclusive jurisdiction of the courts of the State granting or recognizing the IPR.¹⁰¹ Once again, this argument is not related to international public law and will be examined in the last chapter of the forthcoming book.

This study does not address the issue of the recognition and execution of foreign judgments in IPRs cases.¹⁰² Thus, although it is true

99. See *Mars Inc. v. Kabushiki-Kaisha Nippon Conlux*, 24 F.3d 1368 (Fed. Cir. 1994).

100. Book mentioned at p. 373.

101. On the arbitrability of IPRs validity (*inter partes*) and infringement issues see Section II, case 11.4, of each national report on *Jurisdiction and Applicable Law in Matters of Intellectual Property*, *supra* note 3. On the competence of the courts different than the courts of the States that granted the IPR at hand to render provisional injunctions also when the validity of the litigious IPR is disputed, see the recent decision of the District Court of The Hague Fort Vale/Pelican, June 18, 2008, according to which the ECJ GAT decision does not preclude this result. *But see also* the District Court of The Hague decision of September 15, 2010, that refers questions to the ECJ regarding the applicability to provisional measures of Article 22.4 of the Brussels I Regulation and of the ECJ GAT decision (NL - *Solvay S.A. v. Honeywell / Referral to Court of Justice EU, Solvay S.A. v. Honeywell Fluorine Products Europe B.V.*, District Court The Hague, The Netherlands, 15 September 2010, Case No. 09-2275, available at <http://www.eplawpatentblog.com/eplaw/2010/09/nl-solvay-sa-v-honeywell-referral-to-court-of-justice-eu.html#tp> (In Dutch).

102. On this issue see the following recent decisions: Case C-38/98, *Régie Nationales des Usines Renault SA v. Maxicar SpA*, 2000 E.C.R., available at www.curia.eu; *Louis Feraud Int'l v. Viewfinder, Inc.*, 406 F. Supp. 2d 274, 281 (S.D.N.Y. 2005); *Pro Swing Inc. v. Elta Golf Inc.*, [2006] 2 S.C.R. 612 (Can.), available at <http://scc.lexum.umontreal.ca/en/2006/2006scc52/2006scc52.html>. On those decisions see M. Trimble Landova, *Public Policy Exception to Recognition and Enforcement of Judgments in cases of Copyright Infringement*, 40 INT'L REV. OF INTELL. PROP. & COMPETITION L. 654 (2009). See also Kono & Jurčys, *supra* note 3, at part IV; and the national reports on *Jurisdiction and applicable Law in Matters of Intellectual Property*, *supra* note 3, at the following: M.C. Janssens for Belgium, Subsection I.II.4; J. Blom for Canada (including Quebec), subsection II.A.iii; I. Kunda for Croatia, subsection I.D; M.E. Ancel for France, subsection I.iv; A. Metzger for Germany, subsection I.1.d).(1)-(3); V. Singh for India Subsection 2.2.10; N. Boschiero and B. Ubetazzi for Italy, subsection I.iv and Subsection II. case10; D. Yokomizo for Japan, subsection 2.2.10; A. Dias Pereira for Portugal, subsection I.D; D. Možina for Slovenia, subsection II, case 10; P. De Miguel Asensio for Spain,

that the allocation of jurisdiction is effective only when the decision rendered by the competent court is recognized and enforced by the requested State, the exclusive jurisdiction rules also play a determinative role at the recognition and enforcement phase. Hence, on the one hand, the requested State can condition the recognition and enforcement of foreign judgments on the fact that the court that rendered the decision ascertained its jurisdiction on the basis of international jurisdiction rules similar to those existing in the requested country which establish an exclusive jurisdiction and therefore that exclude the court's competence to address foreign IPRs cases. In other words, the requested court recognizes and enforces the foreign decision at stake only if this decision concerns national IPRs of the State that enacted the decision, i.e., only if this decision was rendered on the basis of exclusive jurisdiction rules similar to the ones existing in the requested State.¹⁰³ On the other hand, the requested State can condition the recognition and enforcement of foreign judgments on the fact that such an action does not violate its public policy, which in the specific case is considered to be integrated by the principle that impedes the adjudication of foreign IPRs issues.¹⁰⁴ In other words, the requested court considers the foreign decision at stake compatible with its public policy, and consequently recognizes and enforces it only if this decision concerns national IPRs of the State that enacted the decision, i.e., only if this decision was rendered on the basis of exclusive jurisdiction rules similar to the ones existing in the requested State. Then, all the arguments against exclusive jurisdiction addressed here may be reasonably extended to the issues of recognition and enforcement themselves, allowing one to conclude that States shall generally recognize and enforce foreign decisions even when they address their national IPRs issues. This conclusion is supported not only by all the arguments against the exclusive jurisdiction rules, which will be listed below, but also by the view that the fundamental human right of access to courts is infringed also when the requested State illegally refuses to recognize and enforce a foreign judgment rendered by a competent court according to its PIL rules.¹⁰⁵

Finally, this Paper adheres to the prevailing opinion that not only physical persons but also corporations are entitled to at least certain

subsection 2.3.1-2.

103. See *Lucasfilm Entm't Co. v. Ainsworth*, [2009] EWCA (Civ) 1328 (Eng.).

104. See Landova, *supra* note 102, at 642.

105. See HELENE GAUDEMET-TALLON, *COMPÉTENCE ET EXÉCUTION DES JUGEMENTS EN EUROPE* 73 (4th ed., 2010); *see also infra*.

fundamental human rights, among which enter the right of access to courts and the right to intellectual property.¹⁰⁶

III. DENIAL OF JUSTICE AND *FORUM NECESSITATIS*

A. *Denial of Justice*

To avoid the denial of justice to aliens and to grant them the right of access to domestic courts, a general principle of public international law developed that requires a State to exercise jurisdiction even where it lacks international jurisdiction.¹⁰⁷ This same principle also constitutes a general principle of European Union law.¹⁰⁸

According to one thesis, States avoid denial of justice simply by making their judicial systems available to foreigners. This thesis is inspired by the Calvo Doctrine and has been adopted by many Latin American States. It is formulated, for instance, by the Salvadorian Rapporteur, on the topic of State responsibility for the Committee of Experts, in the Progressive Codification of International Law, which states that

denial of justice is therefore a refusal to grant foreigners free access to the Courts instituted in a State for the discharge of its judicial functions, or the failure to grant free access, in a particular case, to a foreigner who seeks to defend his right, although, in the circumstances, nationals of the State would be entitled to such access.¹⁰⁹

The same opinion was adopted by the Report of the Inter-American Juridical Committee in 1961, according to which

106. See Rainier Arnold, *Are Human Rights Universal and Binding? Limits of Universalism*, (July 2010), THE XVIIITH INTERNATIONAL CONGRESS ON COMPARATIVE LAW, (forthcoming). See also recently *Citizens United v. Fed. Election Comm'n*, 130 S. Ct. 876 (2010) recognizing that corporations have free-speech protections.

107. See PAULSSON J., DENIAL OF JUSTICE IN INTERNATIONAL LAW 10 (2005); Francesco Francioni, *The Right of Access to Justice under Customary International Law*, ACCESS TO JUSTICE AS A HUMAN RIGHT 10–11 (Francesco Francioni ed., 2007) according to whom in international law access to domestic justice starts to be perceived as a right of aliens and subsequently develops into a fundamental human right. On the fundamental human right of access to courts see Section V. *The Fundamental Human Right of Access to Courts*. On the general principles of law see Giorgio Gaja, *General Principles of Law*, in MAX PLANCK ENCYCLOPEDIA OF PUBLIC INTERNATIONAL LAW (Oxford University Press 2008).

108. See TRIDIMAS T., THE GENERAL PRINCIPLES OF EU LAW 370 (2d ed. 2006).

109. See the references in Francioni, *supra* note 107, at 11.

the obligation of the State regarding judicial protection shall be considered as having been fulfilled when it places at the disposal of foreigners the national Courts and the legal remedies for implementing their rights. The State cannot initiate diplomatic claims for the protection of its nationals nor bring an action before an international tribunal for this purpose when the means of resorting to the competent Court of the respective State have been made available.¹¹⁰

According to a second thesis, “access to justice is not simply access to the courts, but the availability of a system of fair and impartial justice, the effectiveness and legitimacy of which can be reviewed under international standards on the treatment of aliens.”¹¹¹

This second thesis is more in line with the need to grant foreigners effective judicial protection than is the first thesis. It is codified, for instance, in Article 9 of the Harvard Draft on State Responsibility for Injuries to Aliens, according to which

denial of justice exists when there is a denial, unwarranted delay or obstruction of access to Courts, gross deficiency in the administration of judicial or remedial process, failure to provide those guarantees which are generally considered indispensable to the proper administration of justice, or a manifestly unjust judgment. An error of a national court which does not produce manifest injustice is not a denial of justice.¹¹²

To avoid the denial of justice, a domestic court must exercise its jurisdiction over a claim of an alien where two conditions are met: first, where the case is linked to the forum State; and second, where no efficient alternative forum is available from which the applicant may seek redress. These requirements are also posed by the rule of jurisdiction by necessity, which constitutes the subject matter of Part B. of this section of this paper, having a scope analogous to that of the denial of justice rule, except that it not only concerns aliens but also

110. *See id.*

111. *See id.*

112. *See id.*

citizens of the forum State.¹¹³ Thus, the jurisdiction by necessity rule encompasses the denial of justice rule; therefore, the following analysis of the former may be extended to the examination of the latter.

B. *Forum necessitatis*

To avoid denial of justice, not only to aliens but also to citizens, general public international law requires States lacking international jurisdiction over a case to nonetheless exercise *jurisdiction by necessity* by adopting the doctrine or principle of *forum necessitatis*.¹¹⁴ Among the international norms recognizing *forum necessitatis* is article two of the Inter-American Convention on Jurisdiction in the International Sphere for the Extraterritorial Validity of Foreign Judgments, adopted in La Paz in 1984, which states that

[t]he requirements for jurisdiction in the international sphere shall also be deemed to be satisfied if, in the opinion of the judicial or other adjudicatory authority of the State Party in which the judgment is to be given effect, the judicial or other adjudicatory authority that rendered the judgment assumed jurisdiction in order to avoid a denial of justice because of the absence of a

113. See TOSATO, *supra* note 93, at 201–202, n.38 (collecting and construing resources).

114. In certain common law legal systems, the jurisdiction by necessity or the *forum necessitatis* is also referred to as the *forum conveniens*. “The institution of the *forum conveniens* for certain aspects follows the same logic grounding the *forum necessitatis* in the civil law countries,” as such Giulia Rossolillo, *Forum necessitatis e flessibilità dei criteri di giurisdizione nel diritto internazionale privato nazionale e dell’Unione europea*, 2 CUADERNOS DE DERECHO TRANSNACIONAL 406 (2010) available at <http://kusan.uc3m.es/CIAN/index.php/CDT/issue/view/239>. See also Michaels, *supra* note 23, at 1054. On the *forum necessitatis*, see also Simon Othenin-Girard, *Quelques observations sur le for de nécessité en droit international privé suisse (Article 3 LDIP)*, in SCWEIZERISCHE ZEITSCHRIFT FÜR INTERNATIONALES UND EUROPÄISCHES RECHT 251 (1999); Lycette Corbion, *Le déni de justice en droit international privé*, PUAM 202 (2004); Arroyo, *supra* note 19, at 74; Arnaud Nuyts, *Study on Residual Jurisdiction: Review of the Member States’ Rules concerning the “Residual Jurisdiction” of their courts in Civil and Commercial Matters pursuant to the Brussels I and II Regulations*, September 3rd, 2007, available at http://ec.europa.eu/civiljustice/news/docs/study_residual_jurisdiction_en.pdf, at 64; Valentin Rétornaz & Bart Volders, *Le fort de nécessité: tableau comparatif et évolutif*, REVUE CRITIQUE DE DROIT INTERNATIONAL PRIVÉ 227 (2008); Diego P. Fernández Arroyo, *Private International Law and Comparative Law: A Relationship Challenged by International and Supranational Law*, 11 Y.B. PRIVATE INT’L L. 42 (2009); Jeffery Talpis & Gerald Goldstein, *The influence of Swiss law on Quebec’s 1994 codification of private international law*, 11 Y.B. PRIVATE INT’L L. 30 (2009).

competent judicial or other adjudicatory authority.¹¹⁵

Among the international soft law norms of an academic origin establishing *forum necessitatis* is Article 24 of the European Group for Private International Law “Proposed Amendment of Regulation 44/2001 in Order to Apply it to External Situations” adopted in Bergen, Norway on September 21, 2008, according to which

where no court of a Member State has jurisdiction under this Regulation, a person may be sued before the courts of a Member State with which the claim has a sufficient connection, especially by reason of the presence of property in the territory of that State, if the right to a fair trial so requires, in particular: / (a) if proceedings in a non-Member State are shown to be impossible; or / (b) if it could not reasonably be required that the claim should be brought before a court of a non-Member State; or / (c) if a judgment given on the claim in a non-Member State would not be entitled to recognition in the State of the court seised under the law of that State and such recognition is necessary to ensure that the rights of the claimant are satisfied.¹¹⁶

In the European Union, the doctrine of *forum necessitatis* was adopted by a series of rules. Before examining these EU rules, it is relevant to note that the European Union Commission entrusted Professor Nuyts of Brussels University to prepare a study on “the Member States’ rules concerning residual jurisdiction of their Courts in civil and commercial matters pursuant to the Brussels I and II Regulations.”¹¹⁷ This study was delivered on September 3, 2007, and included a part (Part I.C.16) on *forum necessitatis*. So, among the EU norms on the *forum necessitatis*, Article 7 of the *Council Regulation on jurisdiction, applicable law, recognition, and enforcement of decisions and cooperation in matters relating to maintenance obligations*

115. Inter-American convention on Jurisdiction in the International Sphere for the Extraterritorial Validity of Foreign Judgments, Article 2, May 24, 1984, available at <http://www.oas.org/DIL/CIDIP-III-foreignjudgments.htm>.

116. Proposed Amendment of Regulation 44/2001 in Order to Apply it to External Situations, Article 22 bis, Sept. 21, 2008, available at www.gedip-egpil.eu/documents/gedip-documents-29EN.htm.

117. See Nuyts, *supra* note 114, at 64.

establishes that

[w]here no court of a Member State has jurisdiction pursuant to Articles 3, 4, 5 and 6, the courts of a Member State may, on an exceptional basis, hear the case if proceedings cannot reasonably be brought or conducted or would be impossible in a third State with which the dispute is closely connected. The dispute must have a sufficient connection with the Member State of the court seised.¹¹⁸

Also, the jurisdiction by necessity rule has been adopted by the proposal for a Council Regulation amending Regulation EC 2201/2003, which regulates jurisdiction and applicable law in matrimonial matters.¹¹⁹ According to Article 7 of this proposal on “residual jurisdiction,”

where none of the spouses is habitually resident in the territory of a Member State and do not have a common nationality of a Member State, or, in the case of the United Kingdom and Ireland do not have their ‘domicile’ within the territory of one of the latter Member States, the courts of a Member State are competent by virtue of the fact that: (a) the spouses had their common previous habitual residence in the territory of that Member State for at least three years; or (b) one of the spouses has the nationality of that Member State, or, in the case of United Kingdom and Ireland, has his or her ‘domicile’ in the territory of one of the latter Member States.¹²⁰

118. Council Regulation (EC) No. 4/2009 of 18 December 2008, Article 7, 2009 O.J. (L 7/8).

119. *Commission Staff Working Document, Annex to the proposal for a Council Regulation amending Regulation (EC) No 2201/2003 as regards jurisdiction and introducing rules concerning applicable law in matrimonial matters* SEC (2006) 949 available at http://ec.europa.eu/civiljustice/divorce/docs/sec_2006_949_en.pdf; *Commission Staff Working Document Executive Summary, Impact Assessment for the proposal for a Council Regulation amending Regulation (EC) no 2201/2003 as regard jurisdiction and introducing rules concerning applicable law in matrimonial matters* SEC (2006) 950 available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=SEC:2006:0950:FIN:EN:HTML>.

120. *Proposal for a COUNCIL REGULATION amending Regulation (EC) No 2201/2003 as regards jurisdiction and introducing rules concerning applicable law in matrimonial matters*, COM (2006) 399 final (July 17, 2006), available at http://ec.europa.eu/civiljustice/divorce/docs/sec_2006_949_en.pdf.

Finally, the *forum necessitatis* doctrine has also been proposed by the *Green Paper on the Review of Council Regulation (EC) No 44/2001 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters*.¹²¹ According to this proposal, it is “appropriate to create additional jurisdiction grounds for disputes involving third State defendants,”¹²² that should find “a balance [] between ensuring access to justice on the one hand and international courtesy on the other hand,”¹²³ such as the “*forum necessitatis*, which would allow proceedings to be brought when there would otherwise be no access to justice”¹²⁴ by

ensur[ing] that, where no court of a Member State has jurisdiction pursuant to the Regulation, the courts of the Member States may, on an exceptional basis, hear the case if proceedings cannot reasonably be brought or conducted or would be impossible in a third State with which the dispute is closely connected.¹²⁵

At the domestic level, *forum necessitatis* has been adopted by both EU and non-EU member States. Some EU member States have adopted *forum necessitatis* through explicit statutory provisions or case law (Austria, Belgium, Estonia, Finland, Germany, Iceland, Lithuania, Luxembourg, the Netherlands, Poland, Portugal, Romania, Spain, and the United Kingdom) whereas in the remaining EU Member States there are currently neither statutes nor case law concerning *forum necessitatis*.¹²⁶ However, according to professor Nuyts’ study on the Member States’ residual jurisdiction,

that does not mean that the principle of *forum necessitatis* would necessarily be rejected by the court should a relevant case arise. Some national reporters expressly note that while there is currently no practice in

121. *Green Paper on the Review of Council Regulation (EC) No 44/2001 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters*, COM (2009) 175 final available at www.europa.eu.

122. *Id.* at 3.

123. *Id.* at 3.

124. *Id.* at n. 4.

125. COM(2009) 175 final, [2].

126. *Id.*

their country, it could theoretically not be accepted, under general principle of law, that a party be deprived of the right of access to a court if this is necessary to vindicate his rights.¹²⁷

Non EU member States adopting *forum necessitatis* include: Argentina, Canada (including Quebec), Costa Rica, Japan, Mexico, Russia, South Africa, Switzerland, and Turkey.¹²⁸ Furthermore, even in the U.S. *forum necessitatis* has “occasionally been used to rationalize courts’ decisions,” having been taken into account by the Supreme Court who “has suggested such a basis might be possible.”¹²⁹ Finally, these EU and non-EU countries already exercise jurisdiction by necessity, particularly in custody, divorce, succession, and asylum cases, but also in commercial matters.¹³⁰

In general, the exercise of jurisdiction by necessity is conditioned upon two requirements: (1) the case must have some connection to the forum State, and (2) it must be unreasonable to bring proceedings abroad. The first requirement, that the case present “some kind of connection with the forum,”¹³¹ poses a proximity condition¹³² to avoid encumbering a particular jurisdiction with the task of correcting all denials of justice happening around the entire world.¹³³ However, this requirement does not exist in the systems of the Netherlands or the United Kingdom, neither of which impose proximity conditions.¹³⁴ Where a proximity condition is required,

there is a general consensus that the required connection exists at least when the plaintiff is domiciled or habitually resident in the forum State, or even when he is a citizen of that State. But any other contacts with the forum State may be relevant, depending on the circumstances, such as for instance the presence of assets within the jurisdiction.¹³⁵

127. Nuyts, *supra* note 114, at 64.

128. See *forum necessitatis* at *supra* note 114 (collecting and construing resources).

129. See Michaels, *supra* note 23, at 1054.

130. See *forum necessitatis* at *supra* note 114.

131. Nuyts, *supra* note 114, at 65.

132. See Othenin-Girard, *supra* note 114, at 275.

133. See Rétornaz & Volders, *supra* note 114, at 235.

134. See Rossolillo, *supra* note 114, at n.19 (collecting and construing resources).

135. See Nuyts, *Study*, *supra* note 114, at 66. See also Rétornaz and Volders, *supra*

The second requirement is that “it is ‘unreasonable,’ ‘unacceptable . . . there is an ‘unreasonable difficulty’ to bring proceedings abroad, or . . . the plaintiff ‘cannot be expected’ to do so.”¹³⁶ This second requirement is slightly different than that under EU norms, which refer only to the unreasonableness of bringing proceedings before the courts of third States, but not to the unreasonableness of bringing proceedings before the courts of EU member States.¹³⁷ However, as will be demonstrated in Part *D* of this Section, this limiting of EU norms to proceedings before non-EU member States shall be overridden by way of interpretation of those norms, affecting as a result also proceedings before EU member States. The second requirement is met when there is a legal obstacle preventing access to the ordinary, competent foreign court. For instance, if that court will not guarantee a fair trial to the parties or its decision will not be enforceable in the forum State. Hence, in this latter situation,

if a decision enacted by a EU member State is not [recognized] and executed in the requested country, by virtue of impeding reasons unrelated to its merits (such as a violation of the right of defen[s]e), the party to whom the exequatur [sic] has been refused has the right, in the absence of another competent Court, to raise his action before a Court of the requested State, albeit this last Court does not have jurisdiction according to the Convention or the Regulations: this last Court can ascertain its jurisdiction recalling the denial of justice according to its domestic laws.¹³⁸

note 114, at 235–240.

136. See Nuyts, *Study*, *supra* note 114, at 65.

137. See *infra*.

138. See GAUDEMET-TALLON, *supra* note 105, at 73, according to whom

si une décision venant d'un État communautaire s'est heurté à un refus de reconnaissance et d'exécution dans l'État requis, refus fondé sur des motifs étrangers au fond du droit (par exemple, une violation des droits de la défense), la partie à qui l'exequatur a été refusé aurait le droit, en l'absence d'autre tribunal compétent, de porter son action au fond devant un tribunal de l'État requis, pourtant non doté de compétence selon la convention ou le règlement: ce dernier pourrait se reconnaître compétent sur la base du déni de justice selon le droit commun du for.

This thesis addresses cases either already decided or currently pending before the courts of EU member States, and thus, entering into the framework of the Brussels system. However, this thesis' conclusions may be easily extended, *mutatis mutandis*, to other cases where, from the perspective of the forum State, ordinary jurisdiction does not lie with it but with a court of another non-EU member State that has already rendered a decision; a decision the forum State either does not recognize or will not enforce.¹³⁹ This second requirement of *forum necessitatis* is also met when there is a practical obstacle to effectively accessing foreign courts. For instance, where "the cost of bringing proceedings abroad would be 'out of proportion' with the financial interests involved in the case."¹⁴⁰

In establishing whether the two requirements of *forum necessitatis* have been met, it is necessary to proceed on a case-by-case basis, and to adopt an extensive interpretation of *forum necessitatis* itself. Thus, *forum necessitatis* grants the fundamental human right of access to courts;¹⁴¹ and therefore, an extensive interpretation of *forum necessitatis* favors this fundamental human right. Second, with particular regard to the first requirement of a connection between the case and the forum State, "*forum necessitatis* supposes the absence of another forum in [the forum State, and thus the] connections with [the forum State] will very rarely have a strict nature."¹⁴²

The first requirement of *forum necessitatis*, the existence of a link between the case and the forum State, raises the question of whether such a link can be considered present if the relevant international procedural norms do not support the forum State's ordinary jurisdiction. In other words, since international procedural norms generally allocate ordinary jurisdiction to the courts of the forum State only where a link exists, could this link be considered as lacking where international

139. This is precisely what happened in *Lucasfilm Entm't Co. v. Ainsworth*, [2009] EWCA (Civ) 1328 (Eng.).

140. See Nuyts, *supra* note 114, at 65.

141. See Rétornaz & Volders, *supra* note 114, at 261. On the fundamental human right of access to courts see *infra* Section V. *The Fundamental Human Right of Access to Courts*.

142. As such Othenin-Girard, *supra* note 114, at 276 (collecting and construing resources). See also Rétornaz & Volders, *supra* note 114, at 234, according to whom "il s'agit en effet d'évaluer le coût *global*, et donc pas uniquement monétaire, d'un procès à l'étranger par rapport à ce qu'on peut exiger du demandeur", translation: "it is then necessary to evaluate the global costs, and therefore not only the economic ones, of a foreign proceeding in relation to what is possible to require from a plaintiff."

jurisdiction rules do not underlie the jurisdiction of the forum State's courts? For the following reasons the answer to this question must be no. First, jurisdiction by necessity presupposes the absence of ordinary international jurisdiction in the forum State; thus, the absence of the latter does not preclude its adoption. Second, "international practice" is vast and "shows that . . . the technical argument of lack of jurisdiction has not prevented the finding of a denial of justice."¹⁴³ Third, this conclusion is supported by the argument that the requirements of the *forum necessitatis* should always be interpreted in an extensive way.

With respect to the second requirement of *forum necessitatis*, the unreasonableness of bringing proceedings abroad, the question arises as to whether a *duplication of proceedings* can be considered unreasonable. This question is particularly, but not only, relevant with respect to European patent litigation, since Article Vd of the Protocol annexed to the Brussels Convention states that

[w]ithout prejudice to the jurisdiction of the European Patent Office under the Convention on the grant of European Patents, signed at Munich on October 5, 1973, the courts of each Contracting State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State¹⁴⁴

and since the ECJ rendered the *Roche* decision and maintained that

Article 6[1] of the Brussels Convention [now Article 6.1 of the Brussels I Regulation according to which a] defendant domiciled in a Contracting State may be sued: (1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled . . . must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy

143. Francioni, *supra* note 107, at 12.

144. Protocol annexed to the Brussels Convention, Article 5d, 27 Sept. 1968.

elaborated by one of them.¹⁴⁵

Since neither the patent infringements of which the various defendants are accused nor the national law in relation to which those acts are assessed are the same, there is no risk of irreconcilable decisions being given in European patent infringement proceedings brought in different contracting States because possible divergences between decisions given by the courts concerned would not arise in the context of the same factual and legal situation. Under this framework, the ECJ will have an opportunity to limit the interpretation of the *Roche* decision. Hence, on September 15, 2010, the District Court of The Hague referred to the ECJ questions concerning the correct interpretation of *irreconcilable decisions* in the context of Article 6.1 of the Brussels I Regulation. Thus, according to the District Court of The Hague, the ECJ *Roche* decision was not applicable in the case at hand, as it

concerned a case where the various defendants were accused only of infringing a patent in the respective countries where they were situated (so defendant A in country A; defendant B in country B; etc.), whereas in the current case, the various defendants were each accused of infringing a patent in all of the respective countries that are mentioned in Solvay's claim for a cross-border injunction (so defendant A both in country A and in country B; defendant B both in country A and in country B; etc.).¹⁴⁶

According to the District Court of The Hague, "in such an event Article 6(1) [Brussels I Regulation] would be applicable as there would be a risk of 'irreconcilable decisions.'"¹⁴⁷

Furthermore, the *Green Paper on the Review of Council Regulation (EC) No. 44/2001* recognizes the need to amend the Regulation in the sense of allowing a consolidation of proceedings with respect to the European patents infringements perpetrated by companies belonging to

145. Case C-539/03, *Roche Nederland BV v. Primus*, 2006 E.C.R. I-6535, ¶¶ 5, 41. On this decision see the doctrine *supra* note 7.

146. *NL-Solvay S.A. v. Honeywell Fluorine Products Europe B.V.*, District Court of The Hague, The Netherlands, 15 September 2010, Case No. 09-2275.

147. *Id.*

the same group.¹⁴⁸ The eventual future restrictive interpretation of the *Roche* decision, and the eventual future amendment of the Brussels Regulation on that point, would not change the need to answer the question posed here as to whether the duplication of proceedings in relation to IPRs cases can be considered unreasonable. Hence, the notion of duplication of proceedings adopted here does not concern European patents alone, but extends to all other IPRs, it being, *mutatis mutandis*, the same as the notion referred to by a recent study undertaken by Prof. Diemar Harhoff of the University of Munich for the European Union Commission, delivered on February 26, 2009, and entitled *Economic-Cost Benefit Analysis of a Unified and Integrated European Patent Litigation System*.¹⁴⁹ According to this study,

duplication as referred to in this report does not require that exactly the same legal matter be brought by identical parties into different national courts. For the purpose of the [study,] we can speak of duplicated cases if the introduction of a unified Court would render one or several of the cases unnecessary, *i.e.* if the different national cases are substitutes in a legal and economic sense.¹⁵⁰

With this clarification in mind, the answer to the current question as to whether a duplication of proceedings can be considered unreasonable should be yes, for the following reasons. First, the conclusion that duplication of proceedings can be considered unreasonable is supported by the argument that the requirements of *forum necessitatis* should always be interpreted in an extensive way. Second, this conclusion is also supported by the fact that duplication increases litigation costs (and also may lead to divergent outcomes), rendering them out of proportion

148. *Green Paper on the Review of Council Regulation (EC) No 44/2001 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters*, at 6, COM (2009) 175 final, available at www.europa.eu.

149. Dietmar Harhoff, *Economic Cost-Benefit Analysis of a Unified and Integrated European Patent Litigation System*, Institute for Innovation Research, Technology Management and Entrepreneurship, Feb. 29, 2009, available at http://ec.europa.eu/internal_market/indprop/docs/patent/studies/litigation_system_en.pdf. On this study see Thomas Jaeger, Reto Hilty, Josef Drexler & H. Ullrich, *Comments of the Max Planck Institute for Intellectual Property, Competition and Tax Law on the 2009 Commission Proposal for the Establishment of a Unified Patent Judiciary*, 40 INT'L REV. OF INTEL. PROP. & COMPETITION L. 818 (2009).

150. Harhoff, *supra* note 149, at n. 19.

with the financial interests involved in the case. As already seen, this circumstance constitutes a practical obstacle to bringing proceedings abroad, which renders it unreasonable to do so. Third, this conclusion is confirmed by a recent series of Swiss decisions concerning the administration of immovable estates located in more than one State, including the forum State.

In a 1990 decision, the Zurich Obergericht exercised jurisdiction by necessity over the succession of a U.K. citizen last domiciled in Italy, in relation to various estates located in different States, including Switzerland and Luxembourg.¹⁵¹ In that case, the plaintiff asked the Zurich Court of First Instance to adjudicate the succession of the Swiss and Luxembourg estates. The requested court declined its competence on the grounds that Swiss international procedural law conferred only international jurisdiction to the Swiss Courts in succession matters where the *de cuius* was last domiciled in Switzerland, whereas in the case before the court the *de cuius* was last domiciled in Italy. However, the Zurich Court of Second Instance reversed the decision, on the grounds that the courts that would have ordinarily been competent to hear the case could not have addressed it in its entirety. That is, the courts of the State where the *de cuius* was last domiciled, Italy, were not competent to address the succession issues related to the estates located abroad, while, analogously, the courts of the State of the *de cuius*' nationality, the U.K. Courts, were not competent to adjudicate the matters related to the "foreign" estates, and the courts of the State where the estates were located, i.e., Luxembourg, were competent to address only the issues related to their local estates. Thus, the Zurich Court of Second Instance concluded that requiring the plaintiff to raise proceedings in the United Kingdom, Italian, Luxembourg, and Swiss Courts would have been unreasonable, and established its jurisdiction by necessity over the succession of both the Swiss and Luxembourg estates.

This same result was reached in a subsequent case also rendered by the Zurich Obergericht in 1992.¹⁵² The plaintiffs in that case asked the Swiss Court of First Instance to adjudicate the succession of an Iraqi citizen last domiciled in London, with regard to various estates located in Switzerland and Liechtenstein. The requested court declined its

151. See Obergericht ZH, Feb. 2, 1990, ZR 89 (1990), n. 4, p.7 (Swi.). On this decision see Othenin-Girard, *supra* note 114, at 283.

152. See Obergericht ZH, Feb. 26, 1992, ZR 90 (1991), n. 89, p.289 (Swi.). On this decision see Othenin-Girard, *supra* note 114, at 284.

competence on the grounds that the *de cuius* was last domiciled in London not in Switzerland. However, the Zurich Court of Second Instance reversed the decision, finding that, firstly, it was unnecessary to establish the international jurisdiction of the Iraqi Courts since the *de cuius* was a refugee in the United Kingdom, and, according to the Swiss international jurisdiction rules (Article 24.3), where these rules refer to citizenship, in cases of refugees they shall be interpreted as designating the domicile. Secondly, the U.K. Courts ordinarily competent to hear the case could not have addressed it in its entirety, since they could not have adjudicated the issues related to the estates in Switzerland and Liechtenstein. Thus, the Zurich Court of Second Instance concluded that requiring the plaintiff to raise proceedings before both the U.K. and Swiss Courts would have been unreasonable, and thereby established its jurisdiction by necessity over the succession of both the Swiss estates and those located abroad.

In sum, both of the preceding disputes were such that the courts of no single State had the ordinary jurisdiction to address them in their entirety, thereby requiring the plaintiff to otherwise start several “local” proceedings before the courts of each State where the estates were located. In such a context, the courts of the forum State considered the bringing of so many proceedings before so many different courts to be unreasonable, and thereby determined that the duplication of proceedings met the second requirement of *forum necessitatis*.¹⁵³ It should also be noted that these adjudications also met the first requirement of the doctrine of *forum necessitatis*, in that the cases were linked to the forum State at least by the presence of estates in Switzerland.

C. Sources of Law Hierarchy

Another question that arises is whether the international, EU, and domestic rules on *forum necessitatis* are expressions of or constitute a general principle of law.¹⁵⁴ This question should be answered in the affirmative for at least the following reasons. First, since the avoidance of the denial of justice is a general principle of law, and *forum necessitatis* aims at avoiding the denial of justice, the former should have the same legal nature as the latter. Moreover, although *forum necessitatis* extends the scope of the rule of avoidance of the denial of justice, in that it concerns not only aliens but citizens alike, this

153. See Othenin-Girard, *supra* note 114, at 283–284.

154. See Gaja, *supra* note 107.

difference does not change the conclusion just reached. *Forum necessitatis* avoids not only the denial of justice, but also discrimination between citizens and aliens in the exercise of the right of access to courts, and the avoidance of discrimination and the right of access to courts are fundamental human rights and, as such, constitute general principles of law. It thereby follows that *forum necessitatis* should have the same juridical nature as these general principles of law.

Second, the conclusion that *forum necessitatis* constitutes a general principle of law is supported by the fact that the international, EU, and municipal rules establishing it generally take the same approach to this notion, creating a genuine common denominator, namely the two requirements of proximity to the forum State and the unreasonableness of litigating before the ordinary competent court. Since the existence of a genuine common denominator among rules is one possible criterion for the construction of a general principle of law,¹⁵⁵ it is reasonable to conclude that *forum necessitatis* constitutes a general principle of law.

Third, this conclusion is not deniable just because two of the municipal rules concerning *forum necessitatis* permit its adoption without imposing a proximity requirement, or because EU norms limit its adoption to cases where the ordinary competent court is in a non-EU member State. The two municipal rules that do not establish a proximity requirement do increase the scope of the *forum necessitatis*, but do so without compromising the genuine common denominator between all the other rules, which are more rigorous in that they impose the proximity condition. The same can be said with regard to the EU norms that limit the adoption of *forum necessitatis* to cases where the ordinary competent court is in a non-EU member State. While it is true that the EU rules limit rather than increase the scope of *forum necessitates*, this limitation does not compromise the genuine common denominator between all the other rules, which are more liberal in that they do not distinguish between the EU external or internal location of the ordinary competent court. Moreover, as will be demonstrated later in this section, although the EU norms explicitly refer to cases where the ordinary competent court is of a non-EU member State, they should be interpreted as also allowing the exercise of jurisdiction by necessity when the ordinary competent court is in an EU member country.

Fourth, this conclusion is supported by the Nuyts' study commissioned by the EU, according to which *forum necessitatis* is a

155. *Id.* at 30.

“general principle of public international law.”¹⁵⁶

The characterization of *forum necessitatis* as a general principle of law leads to the following conclusions. From a primary law¹⁵⁷ coordination of norms and hierarchical perspective,¹⁵⁸ *forum necessitatis* has direct effect in the EU and in the internal legal systems, and prevails over domestic rules, EU secondary norms, and international conventions. This is because

[o]ne cannot assume that treaty rules always prevail over general principles of law. This would normally be the case when the treaty and the general principle cover the same ground. However, a general principle could also affect the way in which a certain treaty rule is to be applied. It could impinge on the application of the treaty rule under limited aspects. In that case it would be more appropriate to say that the principle prevails.¹⁵⁹

Therefore, the municipal norms that do not contemplate *forum necessitatis* should be interpreted by the domestic courts as not impeding its adoption.¹⁶⁰ Accordingly, the European Union provisions that do not contemplate or that exclude *forum necessitatis* should either be interpreted by the domestic courts of the EU member States as not impeding the adoption thereof, or simply should not be applied by those domestic courts, or should be declared partially invalid by the ECJ on

156. See Nuyts, *supra* note 114, at 64. See also Rétornaz & Volders, *supra* note 114, at 229, according to whom “le for de nécessité découle d’un principe général interdisant les dénis de justice.” Translation: “the jurisdiction by necessity forum arises out of a general principle that imposes to avoid the denial of justice.”

157. With the term primary law, this Section refers to Part I of the *Draft Articles on Responsibility of States for Internationally Wrongful Acts*, 2001 Y.B. Int’l L. Comm’n 26. U.N. Doc. A/CN.4/SER/A/2001 [hereinafter *Draft Articles*], available at http://untreaty.un.org/ilc/texts/instruments/english/commentaries/9_6_2001.pdf, on “[t]he internationally wrongful act of a State [that] deals with the requirements for the international responsibility of a State to arise.” *Id.* at 32.

158. For a comparative perspective on the “hierarchy” of the sources of international law in the different national legal systems involved: Argentina, Austria, Australia, Bulgaria, Canada, Czech Republic, France, Germany, Greece, Hungary, Israel, Italy, Japan, Luxembourg, Netherlands, New Zealand, Poland, Portugal, Russian Federation, Serbia, Slovakia, United Kingdom, United States, Uruguay, and Venezuela, see Dinah Shelton, *International Law in Domestic Systems* (July 2010) in THE XVIIITH INTERNATIONAL CONGRESS ON COMPARATIVE LAW, § 10 (forthcoming).

159. See generally Gaja, *supra* note 107, at 22.

160. *Id.*

grounds of "infringement of the [EU] Treaties or of any rule of law relating to their application[.]"¹⁶¹ as they are general principles of law or, depending on the circumstances of the case, through a proceeding to review the legality of the norms under Article 263 of the Lisbon Treaty or through a preliminary ruling under Article 267.¹⁶²

Finally, the international treaties that do not contemplate or exclude *forum necessitatis* should either be interpreted by the domestic courts of the party States as indeed allowing the doctrine's adoption or should not be applied where they exclude *forum necessitatis*. It is true that inconsistency with a general principle of law does not generally invalidate a treaty;¹⁶³ however, since *forum necessitatis* is a general principle of law, it can be considered by a domestic court as prevailing over the implied treaty rule, and thus impinging on the application of the treaty rule, thereby allowing access to the court.

D. EU Brussels System

Another question that arises is whether *forum necessitatis* also applies to cases falling within the scope of international conventions or EU norms that establish international jurisdiction rules, but do so without explicitly including a jurisdiction by necessity provision. The Brussels System, in particular, will be examined below. In answering this question, it is relevant to examine the ECJ's *Owusu* decision.¹⁶⁴ While this decision addresses *forum non conveniens*,¹⁶⁵ rather than *forum necessitatis*, according to one thesis,¹⁶⁶ it applies also with respect to the latter. In the *Owusu* case, the plaintiff, a British national domiciled in the United Kingdom, suffered an accident while on vacation in Jamaica and subsequently brought in the United Kingdom both an action for breach of contract against the person, as the individual that rented him the villa in Jamaica where the accident occurred was also domiciled in the United Kingdom, and an action in tort against several Jamaican companies responsible for the villa's

161. Consolidated Version of the Treaty on the Functioning of the European Union (Lisbon Treaty), art. 263 (ex art. 230 TEC), Mar. 25, 1957.

162. *Id.* at Article 267 (ex Article 234 TEC).

163. Save where the general principle of law expresses a *jus cogens* rule, see Treaties conflicting with a peremptory norm of general international law ("*jus cogens*"), of the Vienna Convention on the Law of treaties, art. 53, done at Vienna May 23, 1969, entered into force on Jan. 27, 1980, 1155 United Nations, *Treaty Series*, 331.

164. Case C-281/02, *Owusu v. N.B. Jackson*, 2005 E.C.R. I-1383.

165. On the *forum non conveniens* notion see Section 4, Part D, *EU Brussels System*.

166. See Rossolillo, *supra* note 114, at 412.

management, upkeep and control.¹⁶⁷ The defendants argued that the courts best positioned to hear the case were the Jamaican Courts, as opposed to the U.K. Courts.¹⁶⁸ Accordingly, the defendants asked the U.K. Court to decline its jurisdiction in the name of *forum non conveniens*.¹⁶⁹ In the United Kingdom, this doctrine establishes that

a national Court may decline to exercise jurisdiction on the ground that a court in another State, which also has jurisdiction, would objectively be a more appropriate forum for the trial of the action, that is to say, a forum in which the case may be tried more suitably for the interests of all the parties and the ends of justice.¹⁷⁰

In response to the motion and prayer request, the U.K. Court referred an interlocutory question to the ECJ asking it to establish whether the doctrine of *forum non conveniens* (hereinafter the *forum non conveniens*) could be applied within the framework of the Brussels Convention, since the convention did not explicitly make reference to it.¹⁷¹ The ECJ answered that the doctrine could not apply, citing the following arguments.¹⁷² First, based on a literal interpretation of the Brussels Convention, the convention does not allow any derogation from the principles it lays down.¹⁷³ Second, the ECJ argument relied on a historical interpretation of the Brussels Convention, according to which

[i]t is common ground that no exception on the basis of the *forum non conveniens* doctrine was provided for by the authors of the Convention, although the question was

167. Case C-281/02, *Owusu v. N.B. Jackson*, 2005 E.C.R. I-1383, ¶¶ 10–12.

168. *Id.* at ¶ 15.

169. *Id.* at ¶ 15.

170. *Id.* at ¶ 8 (citing *Spiliada Mar. Corp. v. Cansulex Ltd.*, [1986] A.C. 460 (H.L.) 476.) On the relationship between the *forum non conveniens* and the Brussels Convention before the ECJ *Owusu* decision see Gardella & Brozolo, *supra* note 23, at 620; and after the *Owusu* decision see Barry J. Rodger, *Forum non conveniens post-Owusu*, 2 J. PRIVATE INT'L L. 71 (2006). See also the resolution of the Institut de Droit International, *The principles for determining when the use of the doctrine of forum non conveniens and anti-suit injunctions is appropriate*, Rapporteur Sir Lawrence Collins, Session de Bruges (Feb. 9, 2003), available at http://www.idi-iil.org/idiE/resolutionsE/2003_bru_01_en.PDF.

171. See *id.*

172. See *id.*

173. *Id.* at ¶ 37.

discussed when the Convention of 9 October 1978 on the Accession of Denmark, Ireland and the United Kingdom was drawn up, as is apparent from the report on that Convention by Professor Schlosser.¹⁷⁴

Third, the ECJ argument was based on a teleological interpretation of the Brussels Convention, which stated that while

[r]espect for the principle of legal certainty, which is one of the objectives of the Brussels Convention (see *inter alia*, Case C-440/97 *GIE Groupe Concorde and Others* [1999] ECR I-6307, paragraph 23, and Case C-256/00 *Besix* [2002] ECR I-1699, paragraph 24), would not be fully guaranteed if the court having jurisdiction under the Convention had to be allowed to apply the *forum non conveniens* doctrine¹⁷⁵

allowing *forum non conveniens* in the context of the Brussels Convention would be likely to affect the uniform application of the rules of jurisdiction contained therein in so far as that doctrine is recogni[z]ed only in a limited number of Contracting States, whereas the objective of the Brussels Convention is precisely to lay down common rules to the exclusion of derogating national rules.¹⁷⁶

Fourth, the ECJ argument based on an *ab inconvenienti* interpretation of the Convention was that *forum non conveniens* would undermine the “legal protection of persons established in the Community”¹⁷⁷ Hence, the ECJ concluded that

174. Case C-281/02, *Owusu v. N.B. Jackson*, 2005 E.C.R. I-1383 ¶ 37 (referencing Peter 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*, 1979 O.J. C 59, 71 ¶¶ 77–78).

175. *Id.* at ¶ 38.

176. *Id.* at ¶ 43.

177. *Id.* at ¶ 42.

[f]irst, a defendant, who is generally better placed to conduct his defen[s]e before the courts of his domicile, would not be able . . . reasonably to foresee before which other court he may be sued. Second, where a plea is raised on the basis that a foreign court is a more appropriate forum to try the action, it is for the claimant to establish that he will not be able to obtain justice before that foreign court or, if the court sei[z]ed decides to allow the plea, that the foreign court has in fact no jurisdiction to try the action or that the claimant does not, in practice, have access to effective justice before that court, irrespective of the cost entailed by the bringing of a fresh action before a court of another State and the prolongation of the procedural time-limits.¹⁷⁸

It is therefore important to establish whether the arguments grounding the *Owusu* decision may be extended from the context of *forum non conveniens* to that of *forum necessitatis*. To this end, a first thesis has determined that there are four possible groups of cases, of which the *Owusu* decision does not apply to three of them such that *forum necessitatis* can thus be adopted in those three groups of cases.¹⁷⁹ In the first group of cases established by this thesis, international jurisdiction is allocated under the Brussels System to the courts of a non-member State. In those cases, this thesis determines that the *Owusu* decision does not preclude the member States' courts from applying *forum necessitatis*. On one hand, this conclusion is based on the "unilateral perspective" of the Brussels System, which privileges the exercise of jurisdiction by the courts of member States over the courts of non-member States. On the other hand, the conclusion is based on the differences between *forum non conveniens* and *forum necessitatis*. The latter provides the forum court with jurisdiction that would otherwise not exist, whereas the former deprives the forum court of jurisdiction that otherwise does exist. Thus, *forum non conveniens* can lead to the denial of justice, whereas *forum necessitatis*, by its nature, avoids such a denial. In addition, the *Owusu* decision was aimed at safeguarding the "legal protection of the persons established in the [territory]" covered by the Brussels System.¹⁸⁰ Therefore, transferring proceedings, by virtue

178. *Id.* at ¶ 42.

179. See Rossolillo, *supra* note 114, at 417.

180. Case C-281/02, *Owusu v. N.B. Jackson*, 2005 E.C.R. I-1383 ¶ 2.

of *forum non conveniens*, to the courts of a non-member State would deprive the persons established in the territory, and thereby covered by the Brussels System, of its procedural and substantive standard of protection and of its regime of free circulation of decisions. In contrast, however, *forum necessitatis* implies the exercise of jurisdiction by the forum court of a member State, and is therefore in line with the system and standards established by the Brussels System to safeguard those aforementioned procedural and substantive rights.

In the second group of cases delineated by this thesis, under the Brussels System, international jurisdiction is allocated to the courts of an EU member State other than that of the forum, but the courts of the forum State are permitted to exercise jurisdiction by necessity either because the other member State's decision will be unenforceable in the forum State's courts for reasons of public policy, or because fortuitous or *force majeure* circumstances, such as a war or an earthquake, impede the plaintiff from bringing the proceedings before the ordinarily competent court. According to this thesis, in such cases the exercise of jurisdiction by necessity does not imply an evaluation of the legal system of the State with ordinary jurisdiction. Thus, the *Owusu* decision does not preclude the exercise of jurisdiction by necessity. This conclusion is based, *mutatis mutandis*, on the reasons set forth with respect to the first group of cases examined.

In the third group of cases established by this thesis, international jurisdiction is allocated under the Brussels System to the courts of a member State, but the forum State is permitted to exercise its jurisdiction by necessity due to the need to grant the plaintiff certain rights not recognized by the legal system of the State with ordinary competence, such as the right to contract a same-sex marriage. Here, the exercise of jurisdiction by necessity implies an evaluation of the legal system of another member State. Yet, in these cases, this thesis holds that the *Owusu* decision does not preclude such jurisdiction. On the one hand, this conclusion is based on the need to safeguard the rights in question, such as the right to contract a same-sex marriage. On the other hand, this conclusion is based, *mutatis mutandis*, on the reasons set forth with respect to the first group of cases examined.

Finally, in the fourth group of cases established by this thesis, international jurisdiction is allocated under the Brussels System to the courts of a member State, but the exercise of jurisdiction by necessity is not permitted since it is grounded on reasons such as excessive time or cost of proceeding before the "ordinary" competent court. In those cases, this thesis holds that such an exercise of jurisdiction implies an

evaluation of the legal system of the State with ordinary jurisdiction. The thesis thereby holds that in those cases the *Owusu* decision precludes the exercise of jurisdiction by necessity. This conclusion is grounded not on the differences but rather on the similarities between the *forum non conveniens* and the *forum necessitatis*, namely, that they both provide domestic courts with great discretionary power to establish on a case-by-case basis whether it is appropriate to exercise jurisdiction, and that excluding the adoption of *forum non conveniens* and *forum necessitatis* only when the ordinary competent court is located in a EU member State implies an obligation of mutual trust between member States, which is the concept that lay at the base of the Brussels System.¹⁸¹

The conclusions of this first thesis are convincing in relation to the first three groups of cases proposed by it, specifically the groups of cases that exclude the application of the ECJ *Owusu* decision to *forum necessitatis*. However, it seems to me that the arguments on which this thesis grounds its conclusions are not convincing. Also, other reasons exist on the basis of which one may conclude that *forum necessitatis* is always applicable no matter the peculiarities of the case involved, such that the distinction among the different groups of cases is unnecessary.

The arguments raised by this thesis are unconvincing for the following three reasons. First, on the one hand, this thesis does not permit the adoption of *forum necessitatis* when, as in the fourth group of cases, ordinary jurisdiction belongs to another member State and the forum's exercise of jurisdiction would imply an evaluation of the other State's system. Yet, on the other hand, when as with the third group of cases, institutions are involved that are unknown to the State with ordinary jurisdiction, such as same-sex marriage, this thesis allows the forum State to exercise jurisdiction by necessity notwithstanding the fact that ordinary jurisdiction belongs to another member State, and that such an exercise of jurisdiction implies an evaluation of the other State's legal system. Furthermore, this thesis justifies disparate treatment on the grounds that only the latter cases implicate rights deserving special protection. Here, the weakness of this thesis' logic lies in its failure to recognize that both the former and the latter cases relate to the right of access to courts, which as a fundamental human right also deserves special protection.

181. See Case C-7/98, *Krombach v. Bamberski*, 2000 E.C.R. I-1935; Case C-116/02, *Gasser v. MISAT*, 2003 E.C.R. I-14693, on both of which in relation to the obligation of mutual trust, see Rossolillo, *supra* note 114, at 417; Luca G. Radicati di Brozolo, *Choice of Court and Arbitration Agreements and the Review of the Brussels I Regulation*, 30 PRAXIS DES INTERNATIONALEN PRIVAT- UND VERFAHRENS-RECHTS [IPRAX] 121 (2010).

Second, this thesis contradicts itself. It allows the exercise of jurisdiction by necessity when, as in the second group of cases, the decision of the court of ordinary competence would be contrary to the public policy of, and thus unenforceable in, the forum State, while at the same time, it proscribes such jurisdiction when, as in the fourth group of cases, bringing a proceeding before the court of ordinary competence would entail excessive time or cost. However, since the excessive time or cost of a proceeding renders a judgment contrary to Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms, opened for signature by the member States of the Council of Europe in Rome on November 4, 1950 (ECHR) and thus, contrary to the public policy of the forum member State, it is therefore also unenforceable in the forum State.

Third, this thesis first emphasizes the differences between *forum necessitatis* and *forum non conveniens*, then suggests an application to the former of the *Owusu* decision related to the latter, then subsequently highlights the similarities between *forum non conveniens* and *forum necessitatis*, and then finally suggests an application to the latter of the *Owusu* decision related to the former. Thus, this thesis is not linear, as well as being excessively complicated.

In contrast, the thesis proposed here maintains that *forum necessitatis* can always be adopted, even within the framework of international conventions that do not explicitly mention it, for the following eight reasons. First, a coordination of the norms and hierarchical interpretation of the Brussels System and *forum necessitatis* highlights that the latter constitutes a general principle of law and as such prevails over the Brussels System. Second, a literal interpretation of the Brussels System indicates that it does not explicitly impede application of *forum necessitatis*. Third, a teleological and systematic interpretation of the Brussels System and the norms concerning fundamental human rights indicates that, since the fundamental human right of access to courts is at the basis of the *forum necessitatis*, the Brussels System must be interpreted as operating in a sense favorable to, and as ultimately adopting, *forum necessitatis*. Fourth, a teleological and systematic interpretation of the Brussels System and the norms of fundamental human rights also highlights that the obligation of mutual trust and the need for legal certainty cannot prevail over the fundamental human right of access to courts. This conclusion is in line with the jurisprudence of the European Court of Human Rights (ECtHR), according to which member States of the ECHR violate its Article 6 provision even when they limit the applicant's right of access

to courts to give effect to the rules of an international agreement,¹⁸² such as the Brussels and Lugano Conventions. Furthermore, as will be demonstrated by the following remarks, the same conclusions apply with respect to EU norms such as the Brussels I Regulation, despite the peculiarities of the relation between the ECHR and the European Union. Fifth, a teleological interpretation of the Brussels System emphasizes that even in the presence of such a system

the risk of a negative conflict of competence is never totally inexistent; it is never possible to exclude that the sei[z]ing of the Courts of a member State which is exclusively competent with respect to the [Brussels System] happens to be impossible for the plaintiff, and therefore that he suffers a denial of justice.¹⁸³

Indeed, the Brussels System “aims at improving the condition of the persons involved and not at depriving them of an accessible Court when they suffer a denial of justice by reason of a malfunction of a mechanism instituted by an international instrument.”¹⁸⁴ Thus, the existence of the Brussels System cannot preclude the exercise of jurisdiction by necessity. Sixth, a historical interpretation of the Brussels System demonstrates that, during its adoption, no discussion with respect to *forum necessitatis* occurred. Thus, no argument precluding the exercise of jurisdiction by necessity can be derived from its legislative history. Seventh, the thesis proposed here is supported by current States’ practice, which already applied *forum necessitatis* to cases falling within the scope of the Brussels System, even when ordinary jurisdiction belonged to the courts of another member State. Eighth, the thesis proffered here is not contradicted by the ECJ *Owusu* decision. Hence, this decision does not explicitly concern the *forum necessitatis*. Additionally, as already mentioned, *forum non conveniens* deprives a forum court of jurisdiction that otherwise exists, as such bringing

182. *See infra*.

183. *See* Othenin-Girard, *supra* note 114, at 266, “le risque d’un conflit négatif de compétence n’est jamais totalement inexistant; on ne peut jamais exclure que la saisine des juridictions d’un Etat contractant exclusivement compétent au regard de la convention se révèle impossible pour le demandeur, et que celui-ci subisse un déni de justice.” *See also* GAUDEMET-TALLON, *supra* note 105, at 73.

184. *See* Othenin-Girard, *supra* note 114, at 267, “pour fonction d’améliorer le sort des justiciables et non de les priver d’un for lorsqu’elles subissent un déni de justice en raison du mauvais fonctionnement des mécanismes instaurés par l’instrument international.”

jurisdiction outside the European Union, whereas *forum necessitatis* provides the EU Courts with jurisdiction that would otherwise not exist and, therefore, is in line with the need to safeguard the “legal protection of the persons established in the [territory]”¹⁸⁵ covered by the Brussels System. Then, unlike *forum non conveniens*, the legislative history of the Brussels Convention does not preclude the exercise of jurisdiction by necessity. Finally, *mutatis mutandis*, the aforementioned reasons lead to the conclusion that while the aforementioned EU norms explicitly contemplate *forum necessitatis* only with respect to cases belonging to the ordinary jurisdiction of non-EU member States, jurisdiction by necessity can still be exercised in relation to cases pertaining to the ordinary jurisdiction of EU member countries.

E. Exclusive Jurisdiction in the Brussels System

Another question arises as to whether *forum necessitatis* also applies to cases falling within the Brussels System’s exclusive jurisdiction provisions. The answer to this question should be in the affirmative, for the following reasons.

The first recalls all the reasons in favor of the adoption of *forum necessitatis* within the framework of the Brussels System, which reasons, *mutatis mutandis*, apply even when ordinary jurisdiction belongs exclusively to a court outside of the forum State.

The second argument recognizes that exclusive jurisdiction provisions can easily lead to the denial of justice, and consequently emphasizes that their presence further obliges the adoption of *forum necessitatis*. For example, bringing a case before the courts of a member State that, according to the Brussels System are *exclusively* competent with respect to this case, may be impossible for the plaintiff, with the consequence that if no other forum has jurisdiction to examine the case, the plaintiff suffers a denial of justice.¹⁸⁶

The third argument emphasizes that, save the just cited thesis, which maintains that exclusive jurisdiction provisions render the adoption of *forum necessitatis* all the more necessary, none of the other studies that I examined address differently the exclusive jurisdiction provisions from all other international jurisdiction norms as far as *forum necessitatis* is concerned. Thus, the conclusions reached with respect to the latter, to the effect that *forum necessitatis* must be adopted even within the framework of the Brussels System, should also apply with respect to the

185. Case C-281/02, *Owusu v. N.B. Jackson*, 2005 E.C.R. I-1383 ¶ 2.

186. See Othenin-Girard, *supra* note 114, at 266.

former, thereby establishing that jurisdiction by necessity must be exercised within the framework of the Brussels System even in cases falling within their exclusive jurisdiction provisions.

The fourth argument is based on the thesis proposed here, which asserts that exclusive jurisdiction provisions are contrary to public international law; as such, they are thereby illegal and should be overruled from a *de lege ferenda* perspective, whereas from a *de lege lata* perspective these rules cannot derogate from or prevail over the rule of *forum necessitatis*.

IV. THE FUNDAMENTAL HUMAN RIGHT OF ACCESS TO COURTS

A. Right of Access to Courts

Public international law grants, to both aliens and citizens alike, the fundamental human right of access to courts.¹⁸⁷ Among the universal international norms regarding the right of access to court are: Article 8 of the Universal Declaration of Human Rights, adopted on December 10, 1948, by the General Assembly of the United Nations and Article 2.3 of the International Covenant of Civil and Political Rights, adopted by the same General Assembly on December 16, 1966.¹⁸⁸ Among the regional international norms regarding the right of access to courts are: Article 6.1 of the ECHR and Article 8 of the American Convention on Human Rights, adopted at San José, Costa Rica on November 22, 1969.¹⁸⁹

With respect to the European Union, the right of access to courts is granted by Article 47 of the Charter of Fundamental Rights of the European Union, adopted at Nice on December 7, 2000 (Charter of Nice), which is referenced by Article 6.1 of the Treaty of Lisbon

187. On the impact of the fundamental human right of access to a court (due process) on the issue of international jurisdiction, see MATSCHER F., *IPR und IZVR vor den Organen der EMRK – Eine Skizze*, in BARFUSS W., DUTOIT B., FORKEL H., IMMENGA U. and MAJOROS F. (eds.), *Festschrift für Karl H. Neumayer zum 65. Geburtstag* 459 (Nomos, Baden-Baden, 1985); PETER SCHLOSSER, *Jurisdiction in International Litigation—The Issue of Human Rights in Relation to National Law and to the Brussels Convention*, LXXIV RIVISTA DI DIRITTO INTERNAZIONALE 5 (1991); Guinchard E., *Procès équitable (article 6 CESDH) et droit international privé*, in INTERNATIONAL CIVIL LITIGATION IN EUROPE AND RELATIONS WITH THIRD STATES 199, n. 22 (NUYTS A. & WATTÉ N. eds., 2005); James Fawcett, *The Impact of Article 6(1) of the ECHR on Private International Law*, 56 INT'L COMP. L.Q. 1, nn. 6, 36 (2007); FABIEN MARCHADIER, LES OBJECTIFS GÉNÉRAUX DU DROIT INTERNATIONAL PRIVÉ À L'ÉPREUVE DE LA CONVENTION DES DROITS DE L'HOMME 37 (Bruylant ed. 2007). See also the doctrine referred to at note 18.

188. See for all Francioni, note 107, at 24.

189. *Id.*

amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon, 13 December 2007.¹⁹⁰ According to that treaty, “[t]he Union recognizes the rights, freedoms and principles set out in the Charter of Fundamental Rights of the European Union of 7 December 2000, as adapted at Strasbourg, on 12 December 2007, which shall have the same legal value as the Treaties.”¹⁹¹ Furthermore, Article 6.3 of the same Treaty states that “[f]undamental rights, as guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms and as they result from the constitutional traditions common to the Member States shall constitute general principles of the Union’s law.”¹⁹² Finally, according to Article 6.2 of the Lisbon Treaty on the European Union “the Union shall accede to the European Convention for the Protection of the Human Rights and Fundamental Freedoms.”¹⁹³

The fundamental right of access to courts is domestically established by several EU member States, namely, Austria, Finland, Germany, Italy, Spain, and The Netherlands.¹⁹⁴ This right is also domestically established by several non-EU member States, namely, Australia, Brazil, Canada, Colombia, Japan, Mexico, Russia, South Africa, Switzerland, and Turkey.¹⁹⁵ Furthermore, although “U.S. law does not endorse an explicit general right of access to court[s],”¹⁹⁶ such a right constitutes the “European equivalent of the American constitutional guarantee of due process,”¹⁹⁷ and can be found “indirectly in two other doctrines,”¹⁹⁸ namely, jurisdiction by necessity and the duty of courts to exercise the jurisdiction they have been given by the legislature.

The proceeding remarks relate, in particular, to the fundamental human right of access to courts as established by Article 6 of the ECHR and as interpreted by the ECtHR *inter alia* because of its place within

190. Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon, 13 December 2007, 2007 O.J. C 306/01.

191. *Id.*

192. *Id.*

193. *Id.* See Protocol relating to Article 6(2) on the Treaty on the European Union on the accession of the Union to the European Convention for the Protection of the Human Rights and Fundamental Freedoms, 2007 O.J. C 306/01, at 155.

194. See <http://confinder.richmond.edu/>.

195. *Id.*

196. Michaels, *supra* note 23, at 1053.

197. As such Guinchard E., *supra* note 187, at 199. See also Nuyts, *supra* note 23, at 157; Michaels, *supra* note 23, at 1054.

198. Michaels, *supra* note 23, at 1053.

the European Convention of Human Rights, which is considered to be the most advanced international system for the protection of fundamental human rights. According to Article 6 of the ECHR, “in the determination of his civil rights and obligations . . . everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law.”¹⁹⁹ Thus, Article 6 does not expressly guarantee the right of access to courts. However, decisions of the ECtHR have established that the denial of access to domestic courts can amount to a breach of Article 6.²⁰⁰

From a primary law coordination of norms and hierarchical perspective, the question arises as to whether Article 6 of the ECHR gives rise to a general principle of international or European law (hereinafter: general principle of law). The answer to this question is yes, for the following reasons. First, the characterization as a general principle of EU law of the fundamental human rights established by the ECHR and emanating from the shared constitutional traditions of the Member States, such as the right of access to courts, is explicitly rendered by Article 6.3 TEU and by relevant ECJ case law. Second, the right of access to courts can be characterized as a general principle of international public law, *mutatis mutandis*, for the same reasons, according to which *forum necessitatis* is also a general principle of law. Third as a general principle of public international law and of EU law, the right of access to courts has a direct effect and prevails over domestic rules, EU secondary norms, and international conventions.²⁰¹

From a content perspective, Article 6 of the ECHR imposes on its member States a non-horizontal, positive, and procedural obligation of result.²⁰² This obligation is non-horizontal because it does not aim at

199. European Convention for the Protection of Human Rights and Fundamental Freedoms, art. 6, 213 U.N.T.S. 222, *entered into force* Sept. 3, 1953, *as amended by* Protocols Nos. 3, 5, 8, and 11 *which entered into force* on Sept. 21, 1970, Dec. 20 1971, Jan. 1 1990, and Nov. 1 1998 *respectively*.

200. The first decision was taken by the ECtHR in *Golder v. United Kingdom*, Eur. Ct. H.R. Application No. 4451/70, ¶¶ 28, 31 (1975), *available at* www.hudoc.echr.coe.int. See David Harris, Michael O’Boyle, Edward Bates & Carla Buckley, HARRIS, O’BOYLE & WARBRICK: LAW OF THE EUROPEAN CONVENTION ON HUMAN RIGHTS 235 (2nd ed. 2009) according to whom this decision was “one of the most creative steps taken by the European Court in its interpretation of any article of the Convention.”

201. See *supra*, the remarks rendered with regard to the *forum necessitatis* as a general principle of law.

202. See Cordula Dröge, *Positive Verpflichtungen der Staaten in der Europäischen Menschenrechtskonvention*, in BEITRÄGE ZUM AUSLÄNDISCHEN ÖFFENTLICHEN RECHT UND VÖLKERRECHT 159, 380 (2003), *available at* <http://www.mpil.de/shared/data/pdf/beitr159.pdf>.

protecting the rights-holder against interference by another private party, but rather from interference by the State itself.²⁰³ This obligation is positive because it does not require that States “refrain from acting,”²⁰⁴ but rather requires that they take positive actions to facilitate the fundamental human right of access to courts. The obligation is procedural because it operates at the procedural level, rather than at the substantive level, of adjudication.²⁰⁵ This obligation is an obligation of result because it imposes on member States the duty to immediately facilitate the right of access to courts, as opposed to simply requiring that they help avoid a violation of the right (i.e., due diligence obligation), or set up an internal system capable of realizing the right within a prescribed amount of time (i.e., programmatic obligation).²⁰⁶

Also, the fundamental human right of access to courts goes to the core of fundamental human rights, which have a universal nature rather than a purely regional character.²⁰⁷ Finally, Article 6 applies with respect to proceedings related to “civil rights and obligations,”²⁰⁸ but, according to the jurisprudence of the ECtHR, “the concept of ‘civil rights and obligations’ cannot be interpreted solely by reference to the domestic law of the respondent State, but must be given an autonomous interpretation in the light of the object and purpose of the Convention.”²⁰⁹ Certain questions then arise relating to the characterization of the category *civil right* under Article 6 of the ECHR.

B. Applicable Law

The first question that arises is whether the characterization of the notion of civil rights under Art. 6 ECHR should be made only with respect to the forum’s substantive law, or if it should also be made according to foreign laws made applicable by virtue of relevant private international law provisions. According to one thesis, reference should only be made to the domestic law of the forum State.²¹⁰ This thesis finds

203. *See id.* at 381.

204. *Id.* at 380.

205. *See id.* at 383.

206. *See id.* at 388.

207. *See* Arnold, *supra* note 106.

208. European Convention for the Protection of Human Rights and Fundamental Freedoms, art. 6, 213 U.N.T.S. 222, entered into force Sept. 3, 1953, as amended by Protocols Nos. 3, 5, 8, and 11 which entered into force on Sept. 21, 1970, Dec. 20 1971, Jan. 1 1990, and Nov. 1 1998 respectively.

209. COUNCIL OF EUROPE, YEARBOOK OF THE EUROPEAN CONVENTION ON HUMAN RIGHTS 48 (1991).

210. *See* the references in Jean Claude Soyer and Michel De Salvia, *Sub art. 6 ECHR*,

its basis in the jurisprudence of the ECtHR, according to which “[w]hether or not a right is to be regarded as civil within the meaning of this expression in the Convention must be determined by reference to the substantive content and effects of the right—and not its legal classification—under the domestic law of the State concerned.”²¹¹ This thesis, however, is unpersuasive for the following reasons. First, the ECtHR jurisprudence just recalled was proffered in a purely domestic case that did not pose the question of whether a right could be considered as *civil* by reference to a foreign law. Second, a literal interpretation of the relevant jurisprudence highlights that it not only refers to the “substantive” law of the State concerned, but to its “domestic” law in general, which includes the State’s private international law rules, which may themselves reference foreign law. Third, according to recent ECtHR jurisprudence, the terms “domestic law” and “internal legal order” are synonymous with the notion of “the juridical order of the contracting States.”²¹² Therefore:

[I]t is possible to interpret this reference as referring to the ‘juridical system at stake,’ as much as, to say it differently, the legal system applicable to the claim, being it relevant or not in light of the ECHR. The *lex causae* can pertain to a juridical system internal or external to the ECHR. Thus, the source of the claimed right is not relevant; the important thing is that it is granted by an internal system of whatever nature.²¹³

Fourth, Article 6 has already been applied by the ECtHR in international cases where a right was regarded as “civil” by reference to laws distinct from those of the forum State.²¹⁴ Fifth, the alternative thesis advanced here extends the scope of Article 6, and is thus in line with the obligation of member States to interpret ECHR norms in an

in *La Convention européenne des droits de l'homme. Commentaire article par article* 250 (L.E. Pettiti, E. Decaux & P. H. Imbert eds., Paris: Economica 1995).

211. *König v. Germany*, Eur. Ct. H.R. Application No. 6232/73, ¶¶ 89 (1978), available at <http://cmiskp.echr.coe.int>.

212. See MARCHADIER, *supra* note 187, at 51–52.

213. “Il est alors possible d’interpréter cette référence comme visant ‘le système juridique en cause,’ soit, en d’autres termes, l’ordre juridique applicable à la cause, qu’il relève ou non de la CEDH. La *lex causae* peut émaner d’un ordre juridique tant interne qu’externe à la Convention. Ainsi, peu importe la source du droit revendiqué, l’essentiel est qu’il trouve un fondement dans un ordre juridique interne quelconque.” *Id.* at 52–53.

214. See *id.* at 62.

extensive way.

C. Nature of the Proceeding

A second question that arises is whether the administrative proceedings related to the granting of registered IPRs fall within the category of proceedings related to *civil rights*. Note that this question does not relate to unregistered IPRs, since those rights come into being without condition of formalities and therefore without administrative proceedings. According to the Human Rights Commission, while “[t]here is no doubt that patent rights, once granted, must be considered as civil rights within the meaning of Article 6(1)[.]”²¹⁵ this Article does not encompass proceedings between private persons and administrative organs related to “the registration of patents.”²¹⁶ Hence, those proceedings:

do[] not concern . . . the legal relationship between private persons, but the objective right of an inventor vis-à-vis the Administration to be granted a patent if he has fulfilled the necessary material and formal conditions. It is true that the law provides that other private persons may file objections against the registration of a patent in a given case But it is also true that these objections are limited to arguments that the objective conditions of registration are not fulfilled.”²¹⁷

Thus, “under these circumstances the registration of patents must be considered as an essentially administrative matter which is outside the scope of Article 6 of the Convention.”²¹⁸

As a matter of fact, however, this jurisprudence has been overruled by subsequent case law related to patents and designs. As for patents, the ECtHR has established that “the patent application proceedings . . . concern[] ‘the determination of civil rights and obligations’” and therefore fall within the scope of Article 6 of the ECHR.²¹⁹ As for

215. *X v. Austria*, Eur. Ct. H.R. Application No. 7830/70, at 201 (1978), available at www.hudoc.echr.coe.int.

216. *Id.* at 202.

217. *Id.* at 201.

218. *Id.* at 201. See also *X v. Switzerland*, Eur. Ct. H.R. Application No. 8000/77 (1978).

219. *British-American Tobacco Co. v. Netherlands*, Eur. Ct. H.R. Application No. 19589/92, ¶ 67 (1995), available at www.hudoc.echr.coe.int. However, as regarding the right

designs, the European Commission has established that an administrative proceeding “decisive for the registration of the applicant’s design [is]... comparable to that of a patent [and]... therefore... involve[s] a determination of ‘civil rights’ within the meaning of Article 6....”²²⁰

This new ECtHR case law is convincing and may be extended to all other registered IPRs, for the following reasons. First, in the *Budweiser* decision of 2007, the ECtHR recognized that “an applicant for the registration of a trade mark... owned a set of proprietary rights... even though they can be revoked under certain conditions.”²²¹ This decision supports the thesis that is related to patents but that is also reasonably extendable to any IPRs and according to which “there should be no doubt that the applicant for a patent, as well as the patentee who seeks to have his revoked patent reinstated are both protected under Article 6 (1) ECHR.”²²² Second, in regard to patents within the various patent systems “the applicant is already presumed to be the owner of the invention, regardless of its patentability.”²²³ Third, in regards to any IPRs, ECtHR jurisprudence generally incorporates within the notion of civil rights and obligations all disputes between private persons and the State that do not concern the execution of sovereign powers, and since as already mentioned, IPRs are not an expression of the sovereignty of their granting States, proceedings in

to be heard, which is also based on Article 6 ECHR, the more recent Strasbourg jurisprudence does not analyze whether the EPO proceeding at stake infringes this right but limits itself to state that “the European Patent Convention provides for equivalent protection as regards the Convention.” *Rambus Inc. v. Germany*, Eur. Ct. H.R. Application No. 40382/04, at 2 (2009), available at www.hudoc.echr.coe.int (citing *Lenzing AG v. Germany*, Eur. Ct. H.R. Application. No. 39025/97 (1999)). On these decisions and the *Lenzing* case also before the European Strasbourg Court and the German Constitutional Court, see Jochen Pagenberg, *The ECJ on the Draft Agreement for a European Community Patent Court – Hearing of May 18, 2010*, INT’L REV. OF INTELL. PROP. & COMPETITION L. 695 (2010). This jurisprudence is therefore grounded on the principle of equivalence and is criticizable for all the reasons that will be analyzed at the last paragraph of this paper. See also *id.* for critical terms.

220. *Denev v. Sweden*, Eur. Ct. H.R. Application No. 25419/94 (1997), available at www.hudoc.echr.coe.int.

221. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01 Eur. Ct. H.R. ¶ 78 (2007), available at www.hudoc.echr.coe.int. See also *Smith Kline and French Labs. Ltd. v. Netherlands*, App. No. 12633/87 Eur. Ct. H.R. (1990), available at www.hudoc.echr.coe.int; *Melnichuk v. Ukraine*, Eur. Ct. H.R. Application No. 28743/03 (2005), available at www.hudoc.echr.coe.int; *Balan v. Moldova*, App. No. 19247/03 Eur. Ct. H.R. (2008), available at www.hudoc.echr.coe.int.

222. See CATARINA HOLTZ, DUE PROCESS FOR INDUSTRIAL PROPERTY: EUROPEAN PATENTING UNDER HUMAN RIGHTS CONTROL 132 (2003).

223. See *id.* at 131.

respect thereto do not involve sovereign powers.

D. Possible Restrictions of the Right

The right of access to courts is not an absolute right. Hence, certain restrictions on this right “are permitted by implication since the right of access by its very nature calls for regulation by the State.”²²⁴ Consequently, States may establish such regulations in accordance with a certain “margin of appreciation”²²⁵ of the “needs and resources of the community and of individuals.”²²⁶ However, these limitations fall within the purview of the ECtHR’s oversight and control. Thus, in verifying the legal character of such regulations, the jurisprudence of the ECtHR is authoritative, and a review thereof reveals that restrictions on the right of access to courts must be established by law, must have a legitimate aim, and must respond to the principle of proportionality.

As for the establishment by law requirement, restrictions must “have some basis in domestic law,”²²⁷ be it of a statutory or a case law nature,²²⁸ and have some internal or international origin.²²⁹ Furthermore, the laws establishing the restrictions must have a certain “quality,”²³⁰ that is, they must be “accessible to the person concerned,”²³¹ “compatible with the rule of law,”²³² “consistent, clear and precise [and] . . . foreseeable.”²³³

As for the requirement of a legitimate aim, among the aims the ECtHR has considered legitimate are “advantages for the individual concerned,”²³⁴ advantages “for the administration of justice,”²³⁵

224. *Fogarty v. United Kingdom*, App. No. 37112/97, Eur. Ct. H.R. ¶ 33 (2001), available at www.hudoc.echr.coe.int.

225. *Id.* at ¶ 33.

226. *Golder v. United Kingdom*, App. No. 4451/70, Eur. Ct. H.R. ¶ 38 (1975).

227. *Kruslin v. France*, App. No. 11801/85, Eur. Ct. H.R. ¶ 27 (1990), available at www.hudoc.echr.coe.int.

228. *Ass’n Ekin v. France*, App. No. 39288/98, Eur. Ct. H.R. ¶ 46 (2001), available at www.hudoc.echr.coe.int, according to which “the concept of ‘law’ must be understood in its ‘substantive’ sense, not its ‘formal’ one. It therefore includes everything that goes to make up the written law, including enactments of lower rank than statutes.” *Id.*

229. See MARCHADIER, *supra* note 187, at 62, 133.

230. *Kruslin*, App. No. 11801/85 at ¶ 27.

231. *Id.*

232. *Id.*

233. *Ekin*, App. No. 39288/98 at ¶ 46. See also *De Geouffre de la Pradelle v. France*, App. No. 12964/87, at 35 (Eur. Ct. H.R. Dec. 12, 1992), available at www.hudoc.echr.coe.int (according to which the rule of law should be “sufficiently coherent and clear”).

234. *Deweert v. Belgium*, App. No. 6903/75, Eur. Ct. H.R. ¶ 49 (1980), available at www.hudoc.echr.coe.int; *Acquaviva v. France*, App. No. 19248/91, Eur. Ct. H.R. ¶ 66 (1995), available at www.hudoc.echr.coe.int (“secure the interests of the defend[er]”).

compliance with public international law, and cooperation between legal systems.²³⁶

With regard to the proportionality requirement, the jurisprudence of the ECtHR maintains that restrictions on the right of access are proportionate where they realize a fair balance between the limits to the right of access to courts and the aim sought to be achieved by the restrictions.²³⁷ In establishing whether this balance exists, member States possess a margin of appreciation. However, this margin of appreciation is subject to the control of the ECtHR in several respects. First, in determining whether the State has exceeded its margin of appreciation, the ECtHR examines the limitation applied to see if it impairs the very essence of the right of access to courts. Furthermore, the ECtHR adopts a restrictive method of interpretation that favors the right of access. Hence, according to the ECtHR, the “right of access to the courts [holds] . . . prominent place . . . in a democratic society.”²³⁸ This conclusion is in line with the need to extensively interpret the right of access to courts, especially when the right to be adjudicated by the petitioned court is also a fundamental human right, as is the case with IPRs.

E. International Jurisdiction Rules

Within this framework, one question that arises is whether a member State of the ECHR is in breach of Article 6 when such State’s courts refuse to try a case on the grounds that they do not have international jurisdiction according to the relevant applicable international jurisdiction rules.²³⁹ The ECtHR has answered this question on several occasions, maintaining that these rules can in principle violate Article 6 of the ECHR. However, the ECtHR has also invoked certain “peculiarities” or circumstances in denying that a breach of Article 6 ECHR occurred. These conclusions seem grounded on criticizable reasons of a political nature. Indeed, the following pages

235. *Deweert*, App. No. 6903/73 at ¶ 49. On the sound administration of justice see MARCHADIER, *supra* note 187, at 145; Luigi Mari, *Equo Processo e Competenza in Materia Contrattuale*, NEW INSTRUMENTS OF PRIVATE INTERNATIONAL LAW 673, 679 (2009).

236. See MARCHADIER, *supra* note 187, at 145.

237. On the proportionality requirement as a general principle of international public law see ENZO CANNIZZARO, IL PRINCIPIO DELLA PROPORZIONALITÀ NELL'ORDINAMENTO INTERNAZIONALE (2d. ed. 2000); RYNGAERT, *supra* note 12, at 158 n.11.

238. *Airey v. Ireland*, App. No. 6289/73, Eur. Ct. H.R. ¶ 24 (1979), available at www.hudoc.echr.coe.int.

239. See Fawcett, *supra* note 187, at 3.

do not expose the numerous arguments that can be raised in opposition to the solutions adopted by the ECtHR in such cases, but rather present a systematic reconstruction of the principles that have been emphasized by the ECtHR and that are relevant to demonstrate that the exclusive jurisdiction rules go against the right of access to courts.²⁴⁰

In the first case, the applicant, a dual Turkish and German citizen, petitioned before a German Court an Iraqi Bank for breach of contract.²⁴¹ The German Court proceeded to ascertain whether the case was sufficiently linked to Germany by reason of the plaintiff's nationality, to confer jurisdiction to hear the case. However, according to Germany's domestic rules on international civil procedure, such a link was not sufficient to find German jurisdiction. Thus, the German Court determined that it lacked competence to hear the case. The applicant, then, asked the ECtHR to assess whether the German Court's failure to find jurisdiction infringed his fundamental human right of access to courts. The ECtHR responded that the right of access to courts "does not imply an unlimited right to choose the competent tribunal. The international private law rules that limit the party autonomy relevance are not incompatible as such to Article 6 § 1 of the Convention."²⁴²

However, these rules on international jurisdiction must not be arbitrary, but rather must be established by law. The court found that these conditions were met, since

in the concrete case, having deeply examined the case the German Courts concluded that they did not have jurisdiction over it. They have deeply grounded their decision. The reasons indicated by the German Courts and criticized by the applicant exclude that these Courts have come up with arbitrary conclusions attempting to the equitableness of the proceeding at stake.²⁴³

240. With respect to the exclusive jurisdiction rules it seems that a systematic reconstruction of the ECtHR jurisprudence is currently still absent in the legal writings. However, on the general incompatibility of the exclusive jurisdiction rules and the right of access to courts *see* Arroyo, *supra* note 19, at 74.

241. Bayrak v. Germany, App. No. 27937/95 Eur. Ct. H.R. (2000), *available at* www.hudoc.echr.coe.int (text available only in French).

242. "[N]’implique pas un droit illimité de choisir le tribunal compétent. Les règles du droit international privé limitant le libre jeu de l’autonomie de la volonté ne sont pas incompatibles avec l’article 6 § 1 de la Convention," *Id.* at ¶ 2.

243. "En l’espèce, les tribunaux allemands ont conclu, après un examen approfondi, à l’absence de leur compétence. Ils ont amplement motivé leurs décisions. Les motifs fournis

Thus, the court concluded that the German Court's declining of jurisdiction had not improperly restricted the applicant's fundamental human right of access to courts.

In the second case, the applicant, Prince Hans-Adam II of Liechtenstein, having learned that the municipality of Cologne obtained a certain painting as a temporary loan from the Czech Republic, brought a proceeding before the Cologne Regional Court against the municipality of Cologne, maintaining that his late father was the true owner of the loaned painting, which had been illegally confiscated from his father by the government of the former Czechoslovakia in 1946.²⁴⁴ The applicant requested that the municipality of Cologne deliver the painting to him, as his father's heir.²⁴⁵ The German Court considered whether the case was sufficiently linked to Germany, given that the painting was in German territory and that the defendant was a German municipality, for it to hear the case.²⁴⁶ Here however, Chapter 6, Article 3, of the Convention on the Settlement of Matters Arising Out of the War and Occupation, "excluded any review, by German Courts, of measures carried out with regard to German external assets or other property, seized for the purpose of reparation or restitution, or as a result of the State of war."²⁴⁷ In the case in question, the former government of Czechoslovakia had confiscated the painting in 1946 as a measure against a German citizen as reparation for war damages.²⁴⁸ Thus, the German Court declined its jurisdiction.²⁴⁹

The applicant then asked the ECtHR to assess whether this declining of jurisdiction infringed his fundamental human right of access to courts.²⁵⁰ The ECtHR emphasized that member States are responsible for violating Article 6 of the ECHR even where they "limit the applicant's right of access to a Court in order to give effect to the rules of an international agreement excluding [their] jurisdiction"²⁵¹

dans les décisions judiciaires critiquées par le requérant permettent d'exclure que les juges aient tiré des conclusions de caractère arbitraire de nature à porter atteinte à l'équité de la procédure." *Id.* at ¶ 2.

244. Hans-Adam II v. Germany, App. No. 42527/98 Eur. Ct. H.R. ¶¶ 10–16 (2001), available at www.hudoc.echr.coe.int.

245. *Id.* at ¶ 15.

246. *Id.* at ¶ 16.

247. *Id.* at ¶ 61.

248. *Id.* at ¶ 11.

249. *Id.* at ¶ 51.

250. *Id.* at ¶ 52.

251. *Id.* at ¶ 52.

In the case before it, the court determined that the restriction on the applicant's right of access to the German Court had a legitimate aim, since it was "a consequence of the particular status of Germany under public international law after the Second World War,"²⁵² and that it aimed at realizing "the vital public interest in regaining sovereignty and unifying Germany."²⁵³

Moreover, the restriction on the applicant's right of access to the German Court was proportionate to the aim thereby pursued. Hence, notwithstanding that the ECtHR's previous jurisprudence had established that the proportionality requirement was met only where "reasonable alternative means . . . to protect effectively the rights under the Convention" existed,²⁵⁴ the court found that the case before it presented peculiarities, such as "the particular status of the Federal Republic of Germany under public international law after the Second World War,"²⁵⁵ that excluded the application of such jurisprudence.²⁵⁶ Thus, the restriction on the applicant's right of access to courts, as imposed by the Convention on the Settlement of Matters Arising Out of the War and Occupation, met the proportionality requirement, even in the absence of other reasonable means of effective recourse. The court concluded, then, that the declining of jurisdiction by the German Court had not improperly restricted the applicant's right of access to courts.²⁵⁷

In a third series of cases, the ECtHR dealt with rules regarding immunity from jurisdiction of States and International Organization. With regard to the immunity from jurisdiction of States, most of the cases addressed by the ECtHR concern tort claims related either to employment in a foreign diplomatic mission²⁵⁸ or to personal injuries sustained from "State " acts amounting to torture."²⁵⁹ In both of these categories of cases, the court pays particular attention as to whether the State immunity rules involved not only had a legitimate aim but were also proportional to that aim. As for the requisite for legitimate aim, the court has established that "the grant of sovereign immunity to a

252. *Id.* at ¶ 59.

253. *Id.* at ¶ 69.

254. *Id.* at ¶ 48.

255. *Id.* at ¶ 68.

256. *See id.* at ¶ 37.

257. *Id.* at ¶ 69.

258. *See Fogarty v. United Kingdom*, App. No. 37112/97 Eur. Ct. H.R. (2001), available at www.hudoc.echr.coe.int.

259. *Al-Adsani v. United Kingdom*, App. No. 35763/97 Eur. Ct. H.R. (2001), available at www.hudoc.echr.coe.int; *McElhinney v. Ireland*, App. No. 31253/96 Eur. Ct. H.R. (2001), available at www.hudoc.echr.coe.int.

State in civil proceedings pursues the legitimate aim of complying with international law to promote comity and good relations between States through the respect of another State's sovereignty."²⁶⁰ As for the requisite for degree of proportionality, the court has maintained that "measures taken by a High Contracting Party which reflect generally recogni[z]ed rules of public international law on State immunity cannot in principle be regarded as imposing a disproportionate restriction on the right of access to Court as embodied in Article 6 § 1."²⁶¹

With regard to immunity from jurisdiction of International Organization the most relevant case is *Waite v. Germany*.²⁶² In this case, the plaintiffs were two British citizens residing in Germany, who were employed by a British Company and placed at the disposal of the European Space Agency (ESA) to perform services at the European Space Operations Center in Germany.²⁶³ The applicants, after having been informed that their employment with the British Company would soon terminate, instituted proceedings before a German Labor Court against the ESA, "arguing that, pursuant to the German Provision of Labor (Temporary Staff) Act (*Arbeitnehmerüberlassungsgesetz*), they had acquired the status of employees of the ESA."²⁶⁴ The ESA replied that its immunity impeded the exercise of jurisdiction by the German Courts.²⁶⁵ The German Courts agreed, determining that the ESA had validly relied on its immunity, and consequently declined to take jurisdiction over the applicants' claims.²⁶⁶

The applicants then asked the ECtHR to assess whether this declining of jurisdiction infringed their fundamental human right of access to courts.²⁶⁷ The ECtHR, in turn, verified whether the restriction placed on the applicants' right of access to the German Court pursued a legitimate aim and was proportionate, stating, with regard to the requirement for legitimate aim:

260. Al-Adsani, App. No. 35763/97 at ¶ 54. This conclusion is highly criticized. See HARRIS, O'BOYLE, & WARBRICK, *supra* note 200, at 243 n.170.

261. McElhinney, App. No. 31253/96 at 37; Al-Adsani, App. No. 35763/97 at ¶ 54.

262. *Waite v. Germany*, App. No. 26083/94, Eur. Ct. H.R. (1999), *available at* www.hudoc.echr.coe.int. See also *Beer and Regan v. Germany*, App. No. 28934/95, Eur. Ct. H.R. (1999), *available at* www.hudoc.echr.coe.int.

263. *Waite*, App. No. 26083/942 at ¶¶ 11–13.

264. *Id.* at ¶ 15.

265. *Id.* at ¶ 17.

266. *Id.* at ¶ 17–26.

267. *Id.* at ¶ 43.

[T]he attribution of privileges and immunities to international organi[z]ation is an essential means of ensuring the proper functioning of such organi[z]ation free from unilateral interference by individual governments. The immunity from jurisdiction commonly accorded by States to international organi[z]ation under the organi[z]ation constituent instruments or supplementary agreements is a long-standing practice established in the interest of the good working of these organi[z]ation. The importance of this practice is enhanced by a trend towards extending and strengthening international cooperation in all domains of modern society.²⁶⁸

Thus, “the rule of immunity from jurisdiction, which the German Courts applied to ESA in the present case, has a legitimate objective.”²⁶⁹ Likewise with regard to proportionality, the court stated that, on the one hand, this requirement had to be verified both “in light of the concrete circumstances of the case”²⁷⁰ and “in view of the prominent place held in a democratic society by the right to a fair trial,”²⁷¹ and on the other hand, that the following two factors were relevant to determine the proportionality of the restrictions at issue. First, “the applicants [must have] . . . had available to them reasonable alternative means to protect . . . their rights under the Convention.”²⁷² Second, these means must have been “effective.”²⁷³ In the case before it, the court verified that

the ESA Convention, together with its Annex I, expressly provides for various modes of settlement of private-law disputes, in staff matters as well as in other litigation Since the applicants argued an employment relationship with ESA, they could and should have had recourse to the ESA Appeals Board.²⁷⁴

268. *Id.* at ¶ 63.

269. *Id.* at ¶ 63.

270. *Id.* at ¶ 64.

271. *Id.* at ¶ 67.

272. *Id.* at ¶ 68.

273. *Id.* at ¶ 68.

274. *Id.* at ¶ 69.

However, since the applicants invoked rights that were established by German substantive labor law and not by the ESA, its dispute settlement bodies probably would have dismissed their recourse, thus providing them with an ineffective adjudication alternative. Nonetheless, according to the court, it was possible to presume that recourse to another effective tribunal existed in the case at hand since all legal systems, and thus also the German one, are “in principle open to temporary workers to seek redress from the firms that have employed them and hired them out. Relying on general labour [sic] regulations or, more particularly, on the German Provision of Labour [sic] (Temporary Staff) Act, temporary workers can file claims in damages against such firms.”²⁷⁵ Thus, the court concluded that the German Court’s declining of jurisdiction by reason of the ESA’s immunity did not improperly restrict the applicants’ right of access to courts.²⁷⁶

To synthesize, a domestic court must adjudicate a case, even where it would not generally do so according to its international procedure norms, when its declining of jurisdiction would violate the right of access to courts. Also, Article 6 of the ECHR obliges member States, in principle, to grant access to their courts whenever a case is sufficiently and not fortuitously linked to the forum State.²⁷⁷

In contrast, member States can restrict the right of access to their courts where all of the following four requirements are met. First, the restrictions are established by law (whether of a domestic or an international origin, and whether of a case law or a statutory nature), and the law is sufficiently clear. Second, the restrictions pursue a legitimate aim, which, according to the ECtHR, is the case only when they comply with public international law.²⁷⁸ Third, the restrictions are proportionate to the aim pursued; according to the ECtHR, restrictions are proportionate when they pertain to cases involving the immunity of

275. *Id.* at ¶ 70.

276. *Id.* at ¶ 73.

277. See *Mari*, *supra* note 235, at 678. See also *supra* note 176 (explaining doctrine); *Bayrak v. Germany*, App. No. 27937/95 Eur. Ct. H.R. (2000), available at www.hudoc.echr.coe.int; and; *Hans-Adam II v. Germany*, App. No. 42527/98 Eur. Ct. H.R. (2001), available at www.hudoc.echr.coe.int. See also the dissenting opinion judge Rozakis in *McElhinney v. Ireland*, App. No. 31253/96, Eur. Ct. H.R. (2001), available at www.hudoc.echr.coe.int. On this dissenting opinion see *infra*.

278. Hence, examination of the European case law manifests that the aim of the sound administration of justice is relevant only with respect to internal rules of competence in pure internal cases. See also *MARI*, *supra* note 235, at 678.

subjects, or present peculiarities such as “the particular status of the Federal Republic of Germany under public international law after the Second World War.”²⁷⁹ In contrast, restrictions are not proportionate when they impair in its essence the right of access to courts. Fourth, the applicant can protect his or her rights through the use of other reasonable and effective alternative means of recourse.

F. Alternative Means of Recourse

Particularly with respect to the last requirement, i.e., the existence of (reasonable) alternative means of recourse, another question arises: whether this requirement should be read as an alternative means in a third State or in an international organization (hereinafter: third States and international organization will be jointly referred to as third States), or whether it should be interpreted as requiring alternative means within the forum/defendant (hereafter defendant) State before the ECtHR that declines jurisdiction.

According to the part of the ECtHR’s *Waite and Kennedy* decision that established that the existence of (reasonable) alternative means of recourse should be read as an alternative means of recourse in either a third State or third legal system, rather than in the defendant State, this requirement is met when alternative means exist in a third State, rather than within the defendant State. So a first thesis maintains that this conclusion takes into account the plurality of legal systems, is a consequence of the coordination purpose proper of private international law and, therefore, “appears particularly welcomed since this coordination purpose allows to take into account that the lack of competence influences the right of access to a court only temporarily, being the interested parties invited to put themselves in a better situation.”²⁸⁰ Indeed, this European case law and the thesis proffered in support thereof (hereinafter: the thesis here criticized) are not persuasive for the following arguments.

The first argument arises from the inconsistency of the thesis here criticized. On the one hand, it acknowledges that in international cases the interests of individuals in having access to courts are even stronger than in purely domestic cases, since “the consequences arising out of a

279. *Hans-Adam II v. Germany*, App. No. 42527/98 Eur. Ct. H.R. ¶ 59 (2001), available at www.hudoc.echr.coe.int.

280. Translated to English from MARCHADIER, *supra* note 187, at 165. “Apparaît particulièrement opportune puisqu’elle permet de prendre en compte le fait que l’incompétence affecte le droit d’accès au tribunal seulement de manière temporaire, les individus étant invités à mieux se pourvoir.”

lacking of international jurisdiction according to private international law can reveal themselves to be much more annoying for the interested party that the absence of internal competence in the internal legal order,”²⁸¹ and thus “the international element contributes to diminish the freedom of States to refuse to adjudicate cases.”²⁸² Yet, on the other hand, the thesis here criticized maintains that the same international character of the cases at issue allows the courts of the forum State to decline jurisdiction whenever another foreign court is competent to hear the same case. Thus, the thesis here criticized supports a conclusion that is the exact opposite of the previous conclusion just recalled that it purported to maintain.

The second argument derives from a systematic *stricto sensu* interpretation of Article 6.1 of the ECHR and the ECHR system itself. Hence, under the thesis here criticized, when a complaint is made for a breach of the ECHR, the ECtHR is obliged to examine the complaint by reference not only to the legal system of the respondent State, but also to the systems of third-party States, which could eventually include ECHR non-member States. However:

[W]hen a complaint is made for a breach of the Convention, the complaint should be examined by the [European Court with] reference only to the legal system of the respondent State. Any defects or other problems relating to such a system cannot be remedied by reference to the legal system of any other High Contracting Party, whether neighbo[r]ing to the respondent State or not. Therefore, the fact that the applicant . . . had the possibility of a judicial remedy in [another legal system] in respect of his grievance should be irrelevant to the issue before the Court, which was solely and exclusively whether the applicant had access to the Courts in [the defendant State] in respect of the same complaint.²⁸³

281. Translated to English from MARCHADIER, *supra* note 187, at 157. “Les conséquences liées au refus d’une compétence en matière de droit international privé peuvent se révéler beaucoup plus ennuyeuses pour les individus que la négation d’une compétence territoriale dans l’ordre interne.”

282. Translated to English from MARCHADIER, *supra* note 187, at 156. “L’élément international contribue à réduire la liberté des Etats de refuser leur compétence.”

283. See the Dissenting Opinion of Judge Loukis Loucaides in *McElhinney v. Ireland*, App. No. 31253/96, Eur. Ct. H.R. (2001), according to whom “I think it is unfair as well as

This conclusion ought to be embraced even more fervently in cases where the third-party State in question is not an ECHR member.

The third argument again relies on a systematic *stricto sensu* interpretation of Article 6.1 of the ECHR and Article 14 of the ECHR. Hence, the thesis here criticized allows domestic courts to decline their jurisdiction whenever other means of recourse exist abroad. As aliens are more often involved in transnational cases than citizens, and transnational cases are more likely to be heard by foreign courts than are pure internal cases, the right of access to the forum State's courts can be derogated more often in cases involving aliens than in cases involving citizens. Therefore, the jurisprudence of the ECtHR indirectly and de facto discriminates by reason of nationality, and thereby contradicts Article 14 of the ECHR.²⁸⁴

The fourth argument relies on a teleological interpretation of Article 6.1 of the ECHR. The opinion here criticized allows domestic courts to decline their jurisdiction whenever other means of recourse exist abroad. Thus, this opinion restrictively interprets Article 6 by limiting its scope to cases that cannot be heard abroad. However, such an interpretation is contrary to the need to read the provisions posed by the ECHR in an extensive way.

The fifth argument relies on a systematic *lato sensu* interpretation of Article 6.1 of the ECHR and of international jurisdiction rules in general. Here, it is necessary to distinguish international jurisdiction rules of an internal or domestic nature from those imposed by international conventions. The former types of rules allocate international jurisdiction to the courts of the forum State without considering whether other foreign courts are competent to hear the same case, and, as such, have a unilateral, rather than a bilateral, character. The opinion here criticized, however, imposes on the petitioned courts seized the duty to also take into account the international jurisdiction of foreign courts, and as such is contrary to the nature of these rules.

With respect to the international jurisdiction norms of a conventional origin, the result is at least partially the same. These rules

odd to expect the applicant to have recourse to another State as a solution to his problem of lack of access to a court in his own country, against which his complaint was directed."

284. On the violation of Article 14 ECHR realized by way of indirect discriminations see ODDNÝ MJÖLL ARNARDÓTTIR, EQUALITY AND NON-DISCRIMINATION UNDER THE EUROPEAN CONVENTION ON HUMAN RIGHTS 73 (2003).

allocate international jurisdiction to the courts of a member State, this time while taking into account whether or not other foreign courts are competent to hear the same case, and as such have a bilateral nature. However, these rules do not consider the international jurisdiction provisions of non-member States; and therefore, have a unilateral nature when examined not with respect to the sole systems of their member States, but in relation to the entire international framework. Thus, this thesis is also contrary to the nature and scope of the internationally derived international jurisdiction rules, at least with respect to third States.

The sixth argument also relies on a systematic *lato sensu* interpretation of Article 6.1 of the ECHR, and international jurisdiction rules. The thesis here criticized cites the aim of coordinating the proceedings that are proper to international jurisdiction rules. Yet the right of access to courts, as set forth in Article 6 of the ECHR, is a fundamental human right. Thus, the aim of coordinating proceedings cannot prevail over the fundamental human right of access to courts. This conclusion can be reached even when the international jurisdiction rules are established by international conventions. In this respect, this conclusion is in line with the jurisprudence of the ECtHR, according to which ECHR member States are responsible for violating ECHR Article 6 even when they limit the applicant's right of access to courts in order to give effect to the rules of an international agreement.

The seventh argument is based on opportunity reasons. The thesis here criticized imposes on the forum State's court a duty to establish, before they decline jurisdiction, whether the case at hand can be adjudicated effectively by foreign State courts. However, forum State courts apply their own domestic rules of international civil procedure, which do not establish the international jurisdiction of foreign State courts. Thus, to verify that other foreign courts have the requisite international jurisdiction to hear a case, the forum State's court must verify the domestic rules on international jurisdiction for every legal system in the world. Opportunity reasons, then, suggest exempting domestic courts from performing such a difficult or impossible task, and instead requiring only that those courts verify if other reasonable means of recourse are available within their forum State, according to their own international jurisdiction rules.

The eighth argument is based on the dissenting opinion of Judge Rozakis in the *McElhinney* case.²⁸⁵ The dissent referenced the part of

285. *McElhinney*, App. No. 31253/96 at n.209 (Judge Rozakis' dissenting opinion).

the ECtHR's *Waite and Kennedy* decision that established that the existence of reasonable alternative means of recourse should be read as an alternative means of recourse in either a third State or third legal system, rather than in the defendant State.²⁸⁶ The dissenting Judge maintained that the decision "referred to specific circumstances concerning persons working within an international organi[z]ation and labour [sic] disputes for which internal proceedings existed and were known to the applicants when they decided to become employees of the organi[z]ation[.]"²⁸⁷ and emphasized, in contrast, that in cases where the defendant is a foreign State, rather than an international organization, "the applicant did not have any [such] link with the [foreign State's] jurisdiction . . . or any kind of allegiance and loyalty to [it]."²⁸⁸ The Judge thus stated that the part of the *Waite and Kennedy* decision concerning alternative means of recourse did not apply, and the requirement of the existence of reasonable alternative means of recourse should, accordingly, be read as alternative means within the defendant State, rather than in third States.²⁸⁹ This opinion deserves to be approved.

In synthesis, the requirement of the existence of reasonable alternative means of recourse cannot be read as alternative means in a third State, but must be interpreted as alternative means that allow access to the courts of the defendant State.²⁹⁰

286. *Id.* at Rozakis' Dissent ¶ 4.

287. *Id.* at Rozakis' Dissent ¶ 4.

288. *Id.* at Rozakis' Dissent ¶ 4.

289. *Id.* at Rozakis' Dissent ¶ 4. According to whom "[i]n any event, I seriously dispute an unqualified transposition of a principle that the Court applied in a specific category of case (e.g. *Waite and Kennedy v. Germany*)—namely the circumscribed scope of Article 6 in circumstances where a State party to the Convention has relinquished parts of its jurisdiction to an international organi[z]ation—to all cases involving a jurisdictional plurality." *Id.*

290. See *McElhinney*, App. No. 31253/96 (Judge Loucaides' dissenting opinion), according to whom:

it is correct that Article 6 may be subject to inherent limitations, but these limitations should not affect the core of the right. Procedural conditions such as time-limits, the need for leave to appeal etc. do not affect the substance of the right. But completely preventing somebody from having his case determined by a Court, without any fault on his part and regardless of the nature of the case, contravenes, in my opinion, Article 6 § 1 of the Convention.

G. Exclusive Jurisdiction

Finally, the last question that arises in this context is whether the right of access to courts can be improperly restricted by international jurisdiction norms that establish exclusive jurisdiction in certain fora. The ECtHR has not yet provided an answer to this specific question. However, it is apparent that the conclusions reached in parts *E* and *F* of this Section with respect to all other general international jurisdiction rules apply, *mutatis mutandis*, to exclusive jurisdiction provisions. Furthermore, no reasons can be invoked to proscribe this application. Thus, the rules on exclusive jurisdiction violate the right of access to courts because, by their proper nature, they restrict this access when the case at hand does not enter into the exclusive jurisdiction of the forum State, although it meets all the requirements necessary to consider improper the restriction in question.

V. EXCLUSIVE JURISDICTION IMPLIES A DENIAL OF JUSTICE AND VIOLATES THE FUNDAMENTAL HUMAN RIGHT OF ACCESS TO COURTS

A. Denial of Justice

The public international law rules on denial of justice, *forum necessitatis*, and on the right of access to courts will now be applied to exclusive jurisdiction rules in IPR cases. To this end the *Voda*, *Lucasfilm*, and *GAT* cases will be adopted as examples, because they constitute the most recent jurisprudence involving the application of exclusive jurisdiction within the context of IPR cross-border litigation. Furthermore, with particular reference to Article 6 of the ECHR, while it is true that this Article does not apply to the United States, and thus, to the *Voda* case, a systematic interpretation of Article 6 can influence the application of the already-examined corresponding rules on right of access to courts that are in force in the United States. Therefore, the arguments based on Article 6 can also be adopted, *mutatis mutandis*, with respect to the U.S. *Voda* case.

As for denial of justice and *forum necessitatis*, in the *Voda* case, both parties were U.S.-domiciled companies and the controversy concerned several European, British, Canadian, French, and German patents, in addition to U.S. patents.²⁹¹ Accordingly, the case was sufficiently linked to the United States, and met the first connection requirement of the denial of justice/*forum necessitatis* rule. However, the U.S. Court of

291. *Voda v. Cordis Corp.*, 476 F.3d 887, 890 (Fed. Cir. 2007).

Appeals for the Federal Circuit held that Voda was required to bring its British, Canadian, French, German, and European patent infringement claims before the respective courts of the United Kingdom, Canada, France, Germany, and each single State for which a European patent was granted, since each State was held to have exclusive jurisdiction over its patent infringement claims.²⁹² In so holding, the U.S. Court of Appeals required that Voda should duplicate its proceedings.²⁹³

The duplication of proceedings in IPR cases has been shown to increase their costs. According to the already-mentioned study *Economic-Cost Benefit Analysis of a Unified and Integrated European Patent Litigation System*,

between 146 and 311 patent infringement cases are being duplicated annually in EU Member States. By 2013, this number is likely to increase to between 202 and 431 duplicated cases. Total private savings from having access to a unified patent proceeding would span the interval between EUR 148 and 289 million.²⁹⁴

Moreover, the costs of the duplication of proceedings are even higher where the systems involved are such as the United Kingdom one. Hence, “the average cost of pursuing through to first instance trial a patent infringement action in the U.K. is approximately 500,000, and this is about three times the cost of an infringement action in most other European jurisdictions.”²⁹⁵

Furthermore, the duplication of proceedings in IPR cases can lead to divergent outcomes, as occurred in a recent series of cases.

In the *Epilady case* (EP0101656), infringement suits of the patent-holder were successful in Belgium, Germany, Italy and the Netherlands, but not successful in Austria, France and the United Kingdom. In *Securities System Inc. vs. ECB* (EP0455750), the German and Dutch

292. *Id.* at 898–904.

293. *Id.* at 898–904.

294. See Harhoff, *supra* note 149, at 5. This study refers explicitly to the Unified Patent Court (ECPC), *see infra*. However, its results are extensible to any other unitary enforcement system of national and foreign patents.

295. See David Knight, *The Reducing Cost of European and U.K. Patent Litigation?*, PATENT WORLD (May 28, 2008), <http://www.ffw.com/publications/all/articles/reducing-cost-patent.aspx>.

Courts upheld the patent, while it was revoked in France and the UK. In the *Senseo* case (EP0404717), initial divergent rulings have been issued by Belgian and Dutch Courts, but several other national cases are still pending. In the *Monsanto* case (EP0546090), the District Court of The Hague gave an interim judgment on March 19, 2008 and referred the case to the European Court of Justice for an interpretation of Directive 98/44/EC of 6.7.1998 on the legal protection of biotechnological inventions; several parallel cases are pending in different Member States.²⁹⁶

Moreover, another case that exemplifies the risk of divergent outcomes due to the duplication of proceedings is the *European Central Bank (ECB) v. Document Security Systems Inc. (DSS)* case.²⁹⁷ To properly describe this case, it is relevant to refer to the wording of the decision rendered by the U.K. Court of Appeal on March 19, 2008. The controversy according to the court was that a U.S. company

contend[ed] that [its] patent . . . and its sister patents are infringed by euro banknotes. Imaginatively but overoptimistically it tried to bring central proceedings before the Court of First Instance of the EU. On 5th September 2007, that Court held, not surprisingly, it had no jurisdiction to hear patent infringement proceedings even against an EU institution, case T-295/05. Meanwhile the ECB had started revocation proceedings in France, Germany, the Netherlands, Spain, Italy, Belgium, Luxembourg and Austria. These are ongoing.²⁹⁸

Prior to the U.K. Court of Appeals decision, there were several conflicting judgments coming from different jurisdictions concerning the validity of the patent:²⁹⁹

296. See Harhoff, *supra* note 149, at 15 n.20.

297. See *European Central Bank v. Document Security Systems Inc.*, [2008] EWCA (Civ). 192 (Eng.), available at <http://www.bailii.org/ew/cases/EWCA/Civ/2008/192.html>.

298. *Id.* at ¶¶ 3–4.

299. *Id.* at ¶ 4.

The German Federal Patent Court (Bundespatentgericht) did not agree with [the U.K. Court of First Instance decision in the case *ECB v. DSS* invalidating the patent and] . . . held the patent valid. Then, on 9 January 2008, the French Court (le Tribunal de Grande Instance de Paris) agreed with [the U.K. first instance decision] and disagreed with the German Court. On 12th March 2008 the Dutch Court agreed with the German Court. In sporting terms, the score is currently 2-2 to the ECB at first instance level. All this is deeply regrettable. It illustrates yet again the need for a one-stop patent shop (with a ground floor department for first instance and a first floor department for second instance) for those who have Europe-wide businesses.³⁰⁰

Finally, the U.K. Court of Appeal dismissed the plaintiff's appeal and confirmed the first instance decision holding the patent void.³⁰¹

In light of the above, requiring the plaintiff in the *Voda* case to address its claims to the courts of each of the foreign States where the patents had been granted was unreasonable and ineffective, and thereby met the second requirement of the denial of justice/*forum necessitatis* rule.

In the *Lucasfilm* case, the denial of justice was even more apparent. First, the case involved defendants who were not only domiciled in the United Kingdom but had also perpetrated their infringing acts from the United Kingdom.³⁰² Thus, the U.K. Court's declining of jurisdiction was contrary to the Brussels Regulation. According to its Article 2 provision, "persons domiciled in a Member State shall . . . be sued in the courts of that Member State."³⁰³ The defendants were domiciled in the United Kingdom; therefore, the U.K. Court had jurisdiction to hear the case. However, this conclusion was not reached by the U.K. Court of Appeal for two different reasons. First, Article 2 of the Brussels Regulation did not ground the U.K. Court's jurisdiction, since it conditions its application upon the existence of not only the "personal jurisdiction,"³⁰⁴ but also the "subject-matter jurisdiction of the court,"³⁰⁵

300. *Id.* at ¶¶ 3–5.

301. *Id.* at ¶ 52.

302. *Lucasfilm Entm't Co. v. Ainsworth*, [2009] EWCA (Civ) 1328, ¶¶ 100, 103 (Eng.).

303. *Id.* at ¶ 123.

304. *Id.* at ¶ 127.

which does not exist where “the wrongs [are] done outside the EU by persons who happen to be domiciled within the EU.”³⁰⁶ Second, Article 2 of the Brussels I Regulation did not ground the U.K. Court’s jurisdiction since the subject matter of the case at hand entered into the exclusive jurisdiction of the U.S. Courts, which exclusive jurisdiction was purportedly established implicitly by the CUP, CUB, PCT and TRIPs agreement.³⁰⁷

However, neither of the arguments adopted by the U.K. Court is convincing. With respect to the first argument, on the one hand, the notions of personal jurisdiction and subject-matter jurisdiction are common law concepts extraneous to the Brussels I Regulation, which conditions its general application upon the sole presence of the defendants’ domicile inside the European Union, without posing any further proximity requirements to the EU territory.³⁰⁸ On the other hand, the *Lucasfilm* case presented additional connections to the EU territory, since the defendants perpetrated the infringing acts from the United Kingdom. With respect to the second argument, as we have already noted, the purported implicit exclusive jurisdiction provision in the CUP, CUB, PCT and TRIPs agreement not only does not exist, but nevertheless it would be contrary to public international law if it did.

Furthermore, even where the Brussels I Regulation was not to be applied, the U.K. Court’s declining of jurisdiction was contrary to *forum necessitatis*, since the *Lucasfilm* case presented a sufficient link with the United Kingdom to meet the first requirement of the denial of justice/*forum necessitatis* rule. Also, according to the U.K. Court of

305. *Id.* at ¶ 127.

306. *Id.* at ¶ 129.

307. *See id.* at ¶ 107–108.

308. *See Competence of the Community to Conclude the New Lugano Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters*, ECJ 145 (Feb. 7, 2006); Case C-281/02, *Owusu v. N.B. Jackson*, 2005 E.C.R. I-1383 ¶¶ 25–26. *See also* Torremans, *supra* note 6, at 752 according to whom in the *Lucasfilm* case:

the dangerous consequence of the analysis put forward by the Court of Appeal is that this jurisdiction is declined and that a substantial risk is created that not a single court will be available and willing to hear the case and to do justice between the parties. The Court itself indicates that Ainsworth does no longer travel to the US and will in this way be able to escape the jurisdiction of the US courts, and in the next phase the Court of Appeal refuse to recognise and enforce the Californian judgment in the U.K. This kind of denial of justice is undesirable and dangerous, but it will be the inevitable consequence of the approach taken by the court.

Appeal, the United States had exclusive jurisdiction to address the infringement of U.S. copyrights. However, the U.K. Court of Appeal did not enforce the judgment rendered by the U.S. Court in the infringement action already brought by the plaintiffs in the United States. Thus, the United Kingdom's non-enforcement of the decision of the U.S. Court, which was the ordinary competent court according to the United Kingdom, rendered access to that U.S. tribunal ineffective with respect to the United Kingdom. Therefore, the non-enforcement of the U.S. judgment constituted a legal obstacle to effectively exercise the right of access to U.S. Courts. As such, in the United Kingdom it met the second requirement of the denial of justice/*forum necessitatis* rule.

In the *GAT* case, both the plaintiff and defendant were companies established in Germany.³⁰⁹ The case, therefore, was sufficiently linked with Germany to meet the first requirement of the denial of justice/*forum necessitatis* rule. Moreover, in the *GAT* case, the patents at issue were granted by a single State, France. Thus, the declining of jurisdiction by the German Court imposed by the ECJ's *GAT* decision obligated the plaintiff to bring the proceeding before a French Court, which had ordinary exclusive jurisdiction to hear the validity issues of the French patents. Yet the exclusive jurisdiction of the French Court concerned the sole issue of whether the French patents were valid; it did not address their infringement. Rather, the German Court had ordinary jurisdiction to examine the infringement claims, by reason of the general jurisdiction criterion of the Brussels System, which granted jurisdiction to the country of the defendant's domicile, here, Germany. As a result, the German Court had to stay its proceeding while it referred to the French Court the issue of the French patents' validity, and after the French Court's decision on the validity of the patents, the German Court had to resume the case and examine the infringement claims.³¹⁰ Indeed, proceeding in this manner would have produced a duplication of disputes. Thus, even the *GAT* case met the second requirement of the denial of justice/*forum necessitatis* rule.

309. Case C-4/03, *GAT v. LuK*, 2006 E.C.R. I-6509, ¶ 8.

310. The ECJ *GAT* decision did not establish explicitly the necessity to proceed in this manner. However, this necessity can be gleaned from the interpretation thereof. See Explanatory Report by Professor Fausto Pocar, at 27. See also *supra* note 7 (collecting and construing jurisprudence that proceeds in this manner, as well as the contrary jurisprudence that declines its jurisdiction not only on the validity issues but also on the infringement claims).

B. Violation of the Fundamental Human Right of Access to Courts

As for the fundamental right of access to courts, in the *Voda* case, by virtue of the exclusive jurisdiction rules purported to exist, the U.S. Court declined to exercise jurisdiction over Voda's infringement claims related to foreign patents. Thus, in that case, the exclusive jurisdiction rules not only impeded Voda's access to the U.S. Court with respect to its foreign patent infringement claims, but also restricted Voda's fundamental human right of access to the U.S. Courts.

Furthermore, this restriction was improper for the following reasons. First, a sufficient and non-fortuitous link existed between the case and the forum State. Second, the restriction on the right of access to courts was not established by a sufficiently clear law. Rather, it was grounded on implicit rules of public international law alleged to exist. Third, the restriction did not pursue a legitimate aim. Here, the purported aim was to comply with public international law, but public international law not only does not impose implicit exclusive jurisdiction rules, but considers such rules illegal. Fourth, the restriction was not proportionate to the aim pursued. Here, the restriction concerned neither matters regarding immunity from jurisdiction nor cases presenting certain recognized peculiarities. The restriction also impaired in its essence the right of access to courts, since on the one hand Voda did not have other means of recourse available in the United States, and on the other hand, the means of recourse available to Voda outside the United States implied a duplication of proceedings and, therefore, were ineffective.

In the *Lucasfilm* case, the violation of the right of access to courts was even more apparent. There, by virtue of the purported exclusive jurisdiction of U.S. Courts, the U.K. Court of Appeal declined to exercise jurisdiction over infringement claims of U.S. copyrights. Exclusive jurisdiction rules impeded access to the U.K. Court, and restricted the plaintiff's right of access to courts, as set forth in Article 6 of the ECHR.

Furthermore, this restriction was illegal for the following reasons. First, a sufficient and non-fortuitous link existed between the case and the forum State. Second, for the same reasons explained with respect to the *Voda* case, the restriction on the right of access to courts was not established by a sufficiently clear law. Third, and again for the same reasons explicated with respect to the *Voda* case, the restriction in issue did not pursue a legitimate aim. Fourth, the restriction on the right of access to courts was not proportionate to the aim it pursued. The plaintiff did not have other means of recourse available in the United

Kingdom, but had other means of recourse available outside the United Kingdom. Thus, the plaintiff supposedly could have brought the infringement of his U.S. copyright before a U.S. Court. Yet the plaintiff had already availed himself of this means of recourse, obtaining a judgment from the U.S. Courts that the U.K. Court refused to enforce. This action thus demonstrated that while, *in arguendo*, in conformity with the ECtHR *Waite and Kennedy* decision, an “alternative means of recourse” existed in a country (the United States) different than the forum State (the United Kingdom), this (allegedly) existing available alternative means of recourse was in fact ineffective.

Likewise, in the *GAT* case, by virtue of an extensive interpretation of the exclusive jurisdiction rules posed by Article 16.4 of the Brussels Convention, the German Court had to decline its jurisdiction with respect to the validity claims of the plaintiff’s French patents. Thus, here again, the application of exclusive jurisdiction rules would have impeded access to the German Court and restricted LuK’s right of access to courts, as established in Article 6 of the ECHR.

Furthermore, this restriction was illegal for the following reasons. First, a sufficient and non-fortuitous link existed between the case and Germany. Second, the restriction on the right of access to courts was not established by a sufficiently clear law. Rather, the restriction in issue was grounded in an extensive interpretation by the ECJ of Article 16.4 of the Brussels Convention that does not explicitly extend the scope of the exclusive jurisdiction rule to IPR validity issues not raised in a principal way but rather as a plea in objection. Moreover, before the *GAT* decision, the ECJ had highlighted the “restrictive nature of the provision contained in Article 16 (4)”³¹¹ and thus had interpreted it in a restrictive way. That interpretative treatment thus gave rise to a legitimate expectation that a restrictive interpretation was to also be adopted with respect to IPR validity issues raised as a plea in an objection, excluding them from the scope of Article 16.4. Third, for the same reasons explicated with respect to the *Voda* case, the restriction at issue did not pursue a legitimate aim. Fourth, the restriction was not proportionate to the aim pursued. LuK did not have other means of recourse available in Germany, and while other means of recourse were available to LuK outside Germany, the utilization of those means produced a duplication of proceedings that thereby made them ineffective.³¹²

311. See Case 288/82, *Duijnste v. Goderbauer*, 1983 E.C.R. 3663, ¶ 23.

312. This duplication of proceedings is different from that of certain legal systems,

C. PIL and Human Rights Solutions

In the *Voda*, *Lucasfilm*, and *GAT* cases, then, the rules on exclusive jurisdiction resulted in denial of justice to the respective IPR owners, violating *forum necessitatis* and the fundamental human right of access to courts. Since the *Voda*, *Lucasfilm*, and *GAT* cases are the most recent expression of the application of exclusive jurisdiction in IPR cross-border litigation, *mutatis mutandis*, their conclusions may be easily extended to all other international IPR disputes.

To avoid denial of justice and to safeguard the right of access to courts, States should follow three different, concurrent approaches, each of which leads to the same results. First, from a *de lege ferenda* perspective States must declare as unconstitutional or overrule their explicit exclusive jurisdiction provisions, and also revisit their case law according to which exclusive jurisdiction rules are implicitly imposed by public international law. Second, also from a *de lege lata* perspective States must adopt “the private international law solution”³¹³ (hereafter the PIL solution). According to the PIL solution, States must search for other rules of private international law that are different and prevailing over the rules that would otherwise lead to the declining of jurisdiction. Then, States must find these rules in *forum necessitatis*, which is a PIL rule and a general principle of law, and which therefore has a direct effect and prevails over exclusive jurisdiction rules (domestic or of the Brussels system). Finally, States must adopt this forum and thus exercise jurisdiction by necessity despite exclusive jurisdiction provisions. Third, always from a *de lege lata* perspective, States must adopt “the human rights solution.”³¹⁴ According to this solution, States must recognize the right of access to courts as a general principle of law, and in any case the ECHR primacy over the other international, European, and domestic rules on exclusive jurisdiction, such as those of the Brussels System. Then, the States must recognize that to decline jurisdiction by reason of the exclusive jurisdiction rules would constitute a breach of the ECHR by a court. Furthermore, States must refer to

such as the German one, according to which the German Court competent to address the IPR validity issue incidentally raised is not the same court that is competent to examine its infringement issue. Hence, it is apparent that the former kind of duplication of proceedings requires much more “entry thresholds (such as language, distance, costs, mentality) for parties to the litigation system” than the latter one. Jaeger *et al.*, *supra* note 149, at 826, referring to the ECPC on which *see infra*.

313. See James Fawcett, *supra* note 187, at 37.

314. *Id.*

this violation “as the ground for not so acting,”³¹⁵ and therefore of not declining jurisdiction. Finally, States must exercise jurisdiction despite exclusive jurisdiction provisions.

As for the PIL solution, in the *Voda* case, the U.S. Court of Appeals should have exercised its jurisdiction by necessity over all of Voda’s infringement claims, regardless of whether the patents involved were national or foreign. Likewise, in the *Lucasfilm* case, the U.K. Court of Appeal should have exercised its jurisdiction by necessity to enforce the U.S. copyrights at stake. Finally, in the *GAT* case, the German Court should have exercised its jurisdiction by necessity over both LuK’s French patents’ validity and infringement claims. Particularly with respect to the *GAT* case, the exercise of jurisdiction by necessity by the German Court over the validity of LuK’s French patents is contrary to the ECJ’s *GAT* decision.

However, a literal interpretation of this decision highlights that it does not address the compatibility of *forum necessitatis* with the exclusive jurisdiction rules of the Brussels Convention and, thus, cannot be interpreted as maintaining that the latter prevails with respect to the former. Second, a teleological interpretation of the ECJ’s *GAT* decision highlights that the court did not intend to speak on the compatibility of *forum necessitatis* and the exclusive jurisdiction rules of the Brussels Convention; thus, its decision cannot be construed in that sense. Third, allowing the German Court to exercise its jurisdiction by necessity is in line with the already-demonstrated finding that *forum necessitatis* is adoptable within the framework of the Brussels System, even in derogation of its exclusive jurisdiction provisions. Finally, even assuming, *in arguendo*, that the *GAT* decision was interpreted as implying the prevalence of the exclusive jurisdiction provisions of the Brussels System over *forum necessitatis*, EU member States would nonetheless be compelled to derogate from the precedent set by that ECJ case to realize the general principle of law of *forum necessitatis*.

As for the human rights solution, the U.S. Court of Appeals in the *Voda* case should have exercised jurisdiction over all of Voda’s patent infringements claims, regardless of whether the patents involved were national or foreign; the U.K. Court of Appeal in the *Lucasfilm* case should have exercised its jurisdiction to enforce the U.S. copyrights at issue; and the German Court in the *GAT* case should have exercised its jurisdiction over both LuK’s validity and infringement claims. Particularly with regard to the *GAT* case, the infringement of Article

315. *Id.*

16.4 of the Brussels Convention (now Article 22.4 of the Brussels I Regulation) that would have, according to the ECJ, followed from the German Court's exercise of jurisdiction over the validity issues of the French patents, would have been necessary for the German State to avoid liability for violating Article 6 of the ECHR.

Finally, with particular reference to the *GAT* case, the result just proposed was partially achieved by a recent Dutch decision rendered by the District Court of The Hague in the 2007 *Single Buoy Moorings v. Bluewater* case.³¹⁶ In this case, the owner of a European patent sued a Dutch company, claiming that by manufacturing and/or offering the essential parts of the plaintiff's patented invention with knowledge that such parts would be installed by a third party in two countries for which the plaintiff had been granted the European patent (U.K. and Norway), the defendant committed "a special form of indirect cross-border infringement."³¹⁷ The defendant raised the question of the invalidity of the European patent before the Dutch Court. Thus, according to the ECJ's *GAT* decision, the Dutch Court should have declined its jurisdiction (at least) on the validity issues of the English and Norway portions of the European patent at stake. However, the District Court of The Hague distinguished between the *GAT* case and the dispute before it, stating that while the former "concerned a declaration of non-infringement of a European patent in various countries (and thus with a possibility to split up in a declaration per country)," the claim before the Dutch Court concerned a declaration of infringement and "contain[ed] the judgment of the validity of a European patent in two territories" and therefore was "different from *GAT/LuK*," and unlike *GAT* could "not be split up."³¹⁸ In other words, the claim before the German Court in *GAT* concerned the judgment of the validity of a French patent in just one territory (France). However, in the case before the Dutch Court,

316. *Cross-border Jurisdiction after GAT/LuK: International "Indirect" Infringement*, NAUTADUTILH E-NEWSLETTER INTELLECTUAL PROPERTY, June 6, 2007, at 1, available at http://www.newsletter-nautadutilh.com/EN/xzine/intellectual_property/e-newsletter_patent_law/cross-border_jurisdiction_after_gat/luk_international_indirect_infringement.html?cid=4&xzine_id=3925&aid=9631. See also John Anders, et al., *Liability for Contributory Infringement of IPRs – Certain Aspects of Patent Infringement*, THE NETH. INT'L ASSOC. FOR THE PROT. OF INTELL. PROP., available at https://www.aippi.org/download/comitees/204/GR204the_netherlands.pdf. On contributory infringement see also Graeme B. Dinwoodie, Rochelle Dreyfuss, & Annette Kur, *The Law Applicable To Secondary Liability In Intellectual Property Cases*, 42 JILP 201, (2009).

317. See NautaDutilh, *supra* note 316.

318. *Id.* at 4.4.

the claim would involve determining the validity of a European patent in two territories, U.K. and Norway, creating a risk of conflicting judgments with respect to validity which in the Dutch Court's opinion would have rendered reaching a judgment on infringement impossible. The court considered this undesirable and in conflict with Article 6 of the ECHR.³¹⁹

Furthermore, the Dutch Court established that although it considered itself to be competent to adjudicate the case, the exclusive jurisdiction provision of the Brussels System as interpreted by the ECJ GAT decision obliged it to "defer a decision concerning the validity of a foreign patent, if nullity proceedings are instituted in the involved foreign country, without regard to the stage of the Dutch proceedings."³²⁰ However, since in the case in question, no nullity proceedings had been instituted before the implicated Norwegian and U.K. Courts, the Dutch Court decided to examine the European patent validity issue with respect to its Norwegian and U.K. parts as raised by the defendant.

This decision deserves to be particularly welcomed because it takes into account the inopportuneness of the GAT solution, and it tries to escape it. Thus, the first conclusion from this decision regarding the incompatibility of the exclusive jurisdiction provisions of the Brussels System with Article 6 of the ECHR, deserves to be approved for all the arguments examined in previous sections.

However, the second conclusion regarding the obligation of the Dutch Court to defer the validity issue of the foreign portions of the European patent to their respective domestic courts only if nullity proceedings were instituted before them, as well as the reasons grounding both conclusions of this decision, are not convincing. Thus, first even if nullity proceedings were instituted before the respective domestic courts of the foreign portions of the European patent, the exclusive jurisdiction rules shall still be considered illegal and therefore inapplicable for all the arguments already examined in this Section, which militate against them. Second, the alleged differences between the case pending before the Dutch Court and the GAT case, namely the number of territories involved by the validity claim or the positive or

319. *Id.* at 4.4. *Contra* Frigo, *supra* note 7, according to whom the GAT decision should be positively evaluated since it grants the principle of legal certainty, in conformity with Article 6 of the ECHR.

320. *Id.* at 4.5.

negative nature of the infringement claim at stake,³²¹ are indeed to be considered irrelevant to the Brussels System's norms of exclusive jurisdiction, as interpreted by the ECJ.

VI. COROLLARIES

A. General Corollaries

The conclusions regarding the relation between the exclusive jurisdiction rules related to IPR cases and the fundamental human right of access to courts Article 6 ECHR, *mutatis mutandis*, are analogous to the conclusions regarding the relation between the same exclusive jurisdiction rules and the denial of justice/*forum necessitatis* rules. This analogy constitutes a final argument in favor of the thesis demonstrated here, according to which exclusive jurisdiction rules in IPR cases are not imposed either for reasons of comity or by the territoriality principle codified in international public law treaties, are even illegal according to international public law, and therefore should be abandoned. Those conclusions concern IPRs infringement issues, and also IPRs validity claims raised as a defense in infringement proceedings.

B. European Union IPRs

These conclusions apply also with respect to the European Union IPRs, such as the Community trademark.³²² Hence, with regard to claims related to infringement actions, actions for declaration of non-infringement, and counterclaims for revocation or for a declaration of invalidity of the Community trademarks, Articles 92–94 of the Community Trademark Regulation pose “exclusive jurisdiction” rules.³²³ However, on the one hand, from an EU member States' perspective, those norms do not ground the international jurisdiction of a sole and exclusive competent court, but, rather, establish a plurality of possible different competent tribunals, namely of the (trademark) courts of the EU member State chosen by the parties according to the Brussels Convention (now Brussels I Regulation), or, alternatively, of the EU member State where the defendant is domiciled or has an establishment, where the plaintiff is domiciled or has an establishment,

321. *Id.* at 4.4.

322. See Council Regulation 40/94, *The Community Trade Mark*, 1993 O.J. (L 011) 1 (EC). (See the amendments to this Regulation at <http://oami.europa.eu/en/mark/aspects/reg/reg4094.htm>).

323. *Id.* at art. 92–94.

where the Office of Harmonization for the Internal Market (OHIM) has its seat, or where the infringement has been committed or threatened (with the exception of actions for a declaration of non-infringement of a Community trade mark.)³²⁴ Thus, those “exclusive jurisdiction” rules, not being at all exclusive, do not conflict with the norms of public international law on denial of justice and on the fundamental human right of access to courts.

On the other hand, from a non EU member States’ perspective, Articles 92–94 of the Community Trademark Regulation aim at impeding access to courts other than the exclusively competent EU tribunals. Thus, with respect to non-EU countries, Articles 92–94 of the Community Trademark Regulation effectively establish exclusive jurisdiction rules, even though in favor of more than one EU court. Therefore, these rules can conflict with the rules of public international law on the denial of justice and on the fundamental human right of access to courts.

The conclusions just reached with respect to the Community trademarks also apply in relation to other European and Community IP rights, such as plant variety rights³²⁵ and design.³²⁶

C. European Unified Patent Judiciary

Finally, the same conclusions of the here-purported and demonstrated thesis, apply with respect to the 2009 Council presidency *Proposal for the Establishment of a Unified Patent Judiciary* (ECPC),³²⁷

324. *Id.* at art. 92–94.

325. See Council Regulation 2100/94, *Community plant variety rights*, 1994 O.J. (L 227) 1 (EC).

326. See Council Regulation 6/2002, *Community designs*, 2002 O.J. (L 3) 1 (EC).

327. See *Proposal for a Council Regulation on the European Union patent*, COM (2000) 2000/0177 final (Nov. 28, 2000), available at <http://register.consilium.europa.eu/pdf/en/09/st16/st16113-ad01.en09.pdf>. See also *European Community Patents Court Draft Agreement*, 7928/09 PI 23 COUR 29 (Mar. 23, 2009), available at [http://documents.epo.org/projects/babylon/eponet.nsf/0/3C42A8FB1B30CA1AC125770D0030AB65/\\$File/draft_agreement_European_and_Community_Patents_Court_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/3C42A8FB1B30CA1AC125770D0030AB65/$File/draft_agreement_European_and_Community_Patents_Court_en.pdf). See Jaeger et al., *supra* note 149, at 817. For an historical perspective see Sven J.R. Bostyn, *The Unbearable Heaviness of Harmonization: SPLT and CP*, I BREVETTI PER INVEZIONE FRA DIRITTO EUROPEO E NAZIONALE, 128 (Marco Ricolfi ed., 2004); Jurgen Schade, *Is The Community (EU) Patent Beyond the Times?—Globalisation Urges Multilateral Cooperation*, INT’L REV. OF INTELL. PROP. & COMPETITION L. 806 (2010). See also Request for an opinion submitted by the Council of the European Union pursuant to Article 300(6) EC, 2009 O.J. (C 220/15); and the “statement of position by the Advocates General” presented on July 2, 2010 but published over six weeks after the date of July 2 given on the document in French (the official language of the document) on a patent lawyer’s blog. See the informal English

which “enjoys the support of the Commission, which is now seeking to receive a mandate to open negotiations with States parties to the European Patent Convention (EPC) over the Draft Agreement, and to obtain an opinion from the ECJ under Article 300.6 EC on the compatibility with the EC Treaty.”³²⁸ This proposal aims to establish a unitary and specialized patent judiciary, a new international organization with a central division and several regional and local divisions, which will be designated by member States as their national exclusively competent court to deal with European patents and respectively future Community patents validity and infringement issues. Particularly, the ECPC central division will be competent to address the actions for revocations, i.e., the validity claims principally raised, the validity issues incidentally raised, and all the claims for which are competent the local and regional divisions. In contrast, the ECPC regional or local divisions will be competent to address the infringement claims (when localized in the State where the defendant is domiciled or, alternatively, in the State where the infringement occurs), including provisional measures, damages etc., and the revocation counter claims, i.e., validity issues incidentally raised. Then, in the majority of the cases, the ECPC will grant unitary litigation with significant positive effects as compared to the status quo of fragmented litigation.

However, the distribution of jurisdiction “requires further elaboration in the Proposal or in flanking rules, e.g. insofar as currently no common jurisdiction [rules] for actions against multiple defendants”³²⁹ and consolidation of proceedings related to coordinated infringements of European patents are provided.

Finally, for the limited purposes of this Paper I would just briefly mention from a European perspective, the ECPC determines more than one competent court and also favors decentralization, lowering “entry thresholds (such as language, distance, costs, mentality) for parties to the litigation, and is therefore generally to be welcomed.”³³⁰ However, from a non-European perspective, the ECPC litigation system impedes the access to non-EU courts, raising the same concerns as the Community Trademark Regulation, particularly where the owner of the

translation of this document at <http://www.eplawpatentblog.com/eplaw/2010/08/eu-opinion-on-the-compatibility-of-the-proposed-european-patent-court-system-with-european-treaty-la.html>. See also Pagenberg, *supra* note 219, at 695.

328. See Jaeger et al., *supra* note 149, at 820. On the request for an ECJ opinion see *supra* note 327.

329. See Jaeger et al., *supra* note 149, at 826.

330. *Id.*

European patent does not have enough economic resources to litigate its European patent case before the regional or central division of the European Patent Court and especially in a language different from its own.³³¹

D. Internal Jurisdiction

Finally, the here-purported and demonstrated thesis relates to the international jurisdiction and does not concern the allocation of jurisdiction in purely domestic cases. Nevertheless, even with respect to those cases, when determining the court competent to address an IRPs issue, the States shall allow the petitioning of more than one court, thereby avoiding a denial of justice and safeguarding the fundamental human right of access to courts.

E. Forum Shopping

The exclusive jurisdiction rules determine a single forum that has international jurisdiction to hear the case, impeding forum shopping, and favoring the principle of legal certainty.³³² In contrast, one could think that the conclusions here proposed favor forum shopping, and “are so malleable as to render them non-criteria in practice.”³³³ Thus, one could think that the conclusions proposed here are in contrast to the need of legal certainty. However, it is not so. First, the conclusions here proposed allow the petitioning of a limited number of courts other than the one that would have exclusive jurisdiction over the case. Hence, the public international rules considered here do not ground the international jurisdiction of whichever court, but rather ground the international jurisdiction of the courts of the States to which the case at stake is sufficiently and not fortuitously linked, in conformity with the

331. See Statement of positions by the Advocates General, *supra* note 327, section c.

332. See FRIGO, *supra* note 7.

333. As such see RYNGAERT, *supra* note 12, at 182, who, however, criticizes these critics as adopting a “defeatist approach,” which shall not be embraced. The author purports that a general principle of public international law exists according to which states shall exercise their jurisdiction in civil and commercial transnational matters taking duly into account the interests of the international community and thus in a reasonable way. Then, the general principle of international law of the reasonable jurisdiction not only “requires that States restrain their jurisdiction, but also . . . require[s] them to actually exercise their jurisdiction when such would be in the interest of the international community” (p.5). Thus, the reasonableness principle leads to similar conclusions as the general principle of law of the access to a court, namely both principles impede the exorbitant fora (p. 165), as much as the exclusive jurisdiction ones. See RYNGAERT, *supra* note 12, *passim*, for relevant jurisprudential and normative references to the general principle of law of the reasonable jurisdiction.

general principles of law of proportionality and genuine connection.³³⁴ Also, the conclusions proposed here arise from the international public law rules related to the right of access to courts, and as mentioned, those rules prevail over the need of legal certainty.³³⁵

Moreover, the existence of more than one court with international jurisdiction over the case in question constitutes the typical situation according to the Brussels System which establishes a true right to forum shopping: this system establishes a general forum and several concurrent fora, and while the same system does impose certain exclusive fora, those are of an exceptional nature.³³⁶ Thus, the concurrent international jurisdiction here proposed does not determine a legal uncertainty different than that at the basis of the typical situation under the Brussels system.

Finally, it is true that recent decades have seen debate aimed at limiting forum shopping with regard to intellectual property cross-border litigation. However, this debate aimed at limiting forum shopping has arisen only in connection with cases where the adoption thereof was abusive. According to the debate, when “a party abusively triggers the jurisdiction of a court in order to obtain an unjust advantage, thus practi[c]ing unacceptable forum shopping, the court addressed could decline jurisdiction by adopting the ‘corrective mechanisms’³³⁷ established by its international procedural law rules “such as ‘forum non conveniens’ in English Law, or ‘exception de fraude’ in French Law,”³³⁸ or imposed by the ECHR in granting to the defendant the right to be submitted (not to exorbitant jurisdictions) but to a fair trial. Indeed, the here-proposed conclusions do not favor abusive forum shopping, but are instead strictly limited to that necessary to allow the right of access to courts; and therefore, respect the general principle of law imposing the avoidance of the abuse of rights.³³⁹

334. See RYNGAERT, *supra* note 12, at 145, 148.

335. *Id.*

336. On the right of forum shopping see MARTA PERTEGAS SENDER, CROSS-BORDER ENFORCEMENT OF PATENT RIGHTS 32 (2002); Gilles Cuniberti, *Abusive Forum Shopping?*, CONFLICTOFLAWS.NET (May 3, 2010), <http://conflictoflaws.net/2010/abusive-forum-shopping/>.

337. See FORUM SHOPPING IN THE EUROPEAN JUDICIAL AREA (Pascal de Vareilles-Sommières ed., 2007); Martin George, *Publication: Forum Shopping in the European Judicial Area*, CONFLICTOFLAWS.NET (Feb. 8, 2008), <http://conflictoflaws.net/2008/publication-forum-shopping-in-the-european-judicial-area/>.

338. See George, *supra* note 337.

339. On which see RYNGAERT, *supra* note 12, at 150.

VII. THE INTERNATIONAL RESPONSIBILITY OF THE FORUM STATE FOR ITS ILLEGAL DECLINING OF JURISDICTION

A. Remedies for Denial of Justice

The exclusive jurisdiction rules in IPRs cases are contrary to the avoidance of a denial of justice general principle of law. From a secondary law or responsibility perspective³⁴⁰ the responsibility of a State may arise out of improper judicial decisions.³⁴¹ Therefore, declining jurisdiction over a case in conflict with *forum necessitatis* and the right of access to courts triggers an international responsibility of the forum State or a non-contractual liability of the European Union.³⁴²

As to *forum necessitatis*, according also to the *Report of the Inter-American Juridical Committee* in 1961, when the forum State declines jurisdiction over a case (by virtue of exclusive jurisdiction rules established by domestic, EU, or international norms), another State may “initiate diplomatic claims for the protection of its nationals . . . bringing an action”³⁴³ against the forum State and under the conditions imposed by international public law to the exercise of diplomatic protection³⁴⁴ before an international tribunal competent to address the case, such as the International Court of Justice (ICJ), which under Article 38.1.c of its statute (and its case law interpretation) is competent

340. With the term “secondary law” this Paper refers to the “content of the international responsibility of a State” and, respectively, “the implementation of the international responsibility of a State,” as established in parts II and III of the Draft Articles already mentioned. Precisely, this Paper refers to “the legal consequences” in the international legal order “for the responsible State of its internationally wrongful act, in particular with respect to cessation and reparation,” and, respectively, to “identifying the State or States which may react to an internationally wrongful act and specifying the possible modalities by which this may be done” (see the General Commentary n.6 of the Draft Articles). By contrast, as this Paper concentrates on the international dimension of the exclusive jurisdiction rules, it does not deal with the consequences of the illegal act in the domestic legal systems involved. However, reference should be made to the circumstance that “the responsibility of a State may not be invoked if: / (a) the claim is not brought in accordance with any applicable rule relating to the nationality of claims; / (b) the claim is one to which the rule of exhaustion of local remedies applies and any available and effective local remedy has not been exhausted” (as such Article 44 of the Draft Articles on Admissibility of Claims).

341. Draft Articles, *supra* note 157, at ch. IV.E.1 on Article 4 *Conduct of organs of a State* according to which “1. The conduct of any State organ shall be considered an act of that State under international law, whether the organ exercises . . . judicial [functions].”

342. See PAULSSON, *supra* note 107, at 207.

343. See the references in Francioni, *supra* note 107, at 11.

344. On the condition imposed by international public law on the exercise of diplomatic protection, among which the expiring of the internal ways of recourse and its being a residual remedy, see CONFORTI, *supra* note 42, at 213.

to adjudicate the violations of the general principles of law. In such a case, the competent international tribunal could force the forum State that improperly declined jurisdiction, *inter alia*, the reopening of the proceedings³⁴⁵ and the exercise of jurisdiction over the case. In this sense, the Belgian State recently brought an action before the ICJ against Switzerland for having adopted private international law *lato sensu* rules to decline (not its jurisdiction but) to enforce certain Belgium decisions.³⁴⁶ However, States generally do not initiate diplomatic protection in favor of their nationals for the illegal use of private international norms by another country, even where such implies denial of justice.³⁴⁷

Furthermore, when the rule adopted to decline jurisdiction over a case is an EU norm, the plaintiff can bring an action directly against the European Union before the European Court of Justice under Article 268 of the Treaty of the Functioning of the European Union (TFEU),³⁴⁸ which states that “[t]he Court of Justice of the European Union shall have jurisdiction in disputes relating to compensation for damage provided for in the second . . . paragraph[] of Article 340,”³⁴⁹ which states that “in the case of non-contractual liability, the Union shall, in accordance with the general principles common to the laws of the Member States, make good any damage caused by its institutions . . . in the performance of their duties,”³⁵⁰ such as the legislative duty. The ECJ

345. See Case Concerning *Avena v. United States* (Mex. v. U.S.), 2004 I.C.J. 12 (Mar. 31). See also PAULSSON, *supra* note 107, at 207.

346. See Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters (Belg. v. Switz.), Application, 2009 I.C.J. 1 (Dec. 22), available at <http://www.icj-cij.org/docket/index.php?p1=3&code=besu&case=145&k=e6>. On this case see Caroline Kleiner, *Private International Law Dispute Before the ICJ (Belgium v. Switzerland on the Interpretation and Application of the Lugano Convention)*, CONFLICTOFLAWS.NET (Dec. 27, 2009), <http://conflictolaws.net/?s=Private+International+Law+Dispute+Before+the+ICJ>; Fabrizio Marongiu Buonaiuti, *Una controversia relativa alla Convenzione di Lugano giunge innanzi alla Corte internazionale di giustizia*, 2 SOCIETÀ ITALIANA DI DIRITTO INTERNAZIONALE 454 (2010), available at http://www.sidi-isil.org/wp-content/uploads/2010/02/nota-Marongiu-Buonaiuti_.pdf.

347. However, see Case of the S.S. *Lotus* (Fr. v. Turk.) 1927 P.C.I.J. (ser. A) No. 10 (Sept. 7). On this case see *supra* notes 9, 11, 15. In an action brought by the Netherlands before the ICJ against Sweden for having this last State violated the conflict of laws rules of an international convention see Application of the Convention of 1902 Governing the Guardianship of Infant (Neth. v. Swed.) 1958 I.C.J. 55 (Nov. 28).

348. Treaty on European Union and of the Treaty Establishing the European Community 2006 O.J. (C 321 E/2), Article 235 (TEC).

349. Consolidated Version of the Treaty on the Functioning of the European Union 2008 O.J. (C 115/47), Article 268; ex. Article 288 TEC.

350. *Id.* at Article 340.

has held that

Community law confers a right to reparation where three conditions are met: the rule of law infringed must be intended to confer rights on individuals; the breach must be sufficiently serious; and there must be a direct causal link between the breach of the obligation [by the EU Institution] . . . and the damage sustained by the injured parties[.]³⁵¹

and must also be a “higher-ranking rule of law.”³⁵² Thus, with reference to the first condition, the ECJ maintained that a rule of law confers rights upon individuals when it poses “the right to be heard” by a court,³⁵³ and hence “it is foreseeable”³⁵⁴ that such a rule can be characterized as a high-ranking rule of law.

B. Remedies for Violation of the Fundamental Human Right of Access to Courts

As for the fundamental human right of access to courts, and always from a secondary law or responsibility perspective, the content of the responsibility of the States, *mutatis mutandis*, is the same as that related to the violation of *forum necessitatis*, save for the following peculiarities of the ECHR system. First, when the declining of jurisdiction is grounded on the domestic rules of the forum State, the applicant can petition the forum State before the ECtHR according to ECHR mechanisms. Second, when the declining of jurisdiction is based on treaty norms, the applicant can petition the forum State before the ECtHR, since member States of the ECHR violate its Article 6, even when they limit the applicant’s right of access to courts to give effect to the rules of an international agreement. Third, when the declining of jurisdiction is based on EU norms, the applicant can still petition the forum State before the ECtHR.

In those cases, the ECtHR’s *Bosphorus* jurisprudence applies, according to which “the protection of fundamental rights by EC law can

351. Joined Cases C-46/93 & C-48/93, *Brasserie du Pêcheur SA v. Bundesrepublik Deutschland & Queen v. Secretary of State for Transport*, 1996 E.C.R. I-1029, ¶ 51.

352. See Case C-352/98, *Laboratoires Pharmaceutiques Bergaderm SA v. Comm’n*, 2000 E.C.J. 42, ¶ 17, available at <http://curia.europa.eu>.

353. Case T-193/04, *Tillack v. Comm’n*, 2006 E.C.R. II-3995, ¶ 127.

354. See MASSIMO CONDINANZI & ROBERTO MASTROIANNI, *IL CONTENZIOSO DELL’UNIONE EUROPEA* 280 (2009).

be considered to be... ‘equivalent’... to that of the Convention system.”³⁵⁵ “By ‘equivalent’ the Court means ‘comparable’... [rather than] ‘identical’.”³⁵⁶ Therefore, “presumption arises that [the forum EU member State] did not depart from the requirements of the Convention when it implemented legal obligations flowing from its membership of the EC.”³⁵⁷

[On the one hand this] presumption can be rebutted if, in the circumstances of a particular case, it is considered that the protection of Convention rights was manifestly deficient. In such cases, the interest of international cooperation would be outweighed by the Convention’s role as a ‘constitutional instrument of European public order’ in the field of human rights... [and the defendant] State would be fully responsible under the Convention [for the violation of the right of access to courts].³⁵⁸

On the other hand, the future accession of the European Union to the ECHR according to Article 6.2 TEU will reasonably override the presumption posed by the Bosphorus jurisprudence and has been correctly criticized by the opinion of several judges also comprising the Grand Chamber that enacted it. Hence, it is true that according to Article 2 of the *Protocol to the Lisbon Treaty n. 8 Relating to Article 6(2) of the Treaty on European Union on the Accession of the Union to the European Convention on the Protection of Human Rights*, “[t]he agreement relating to the accession... shall make provision for preserving the specific characteristics of the Union and Union law...”.³⁵⁹ However, as it was recently correctly noted,³⁶⁰ it is the

355. *Turizm v. Ireland*, App. No. 45036/98, ¶ 165 (2005) available at www.hudoc.echr.coe.int. See *M. & Co. v. Germany*, App. No. 13258/87 Eur. Ct. H.R. (1990), available at www.hudoc.echr.coe.int, last page.

356. *Turizm*, App. No. 45036/98, ¶ 155.

357. *Id.* at ¶ 165.

358. *Id.* at ¶156–157.

359. Relating to Article 6(2) of the Treaty on European Union on the Accession of the Union to the European Convention on the Protection of Human Rights and Fundamental Freedoms, available at <http://eur-lex.europa.eu/en/treaties/dat/12007L/htm/C2007306EN.01015501.htm>.

360. See Vladimiro Zagrebelsky, *L’adesione Dell’UE alla CEDU: Il ‘Nodo Giudiziario,’* ITALIAN SOCIETY OF INTERNATIONAL LAW XV CONGRESS IN BOLOGNA (June 10–11, 2010), available at <http://streaming.cineca.it/SIDI->

European Union that is accessing to the ECHR, and not vice versa. Furthermore, the privileged system posed by Bosphorus in favor of the European Union will not be tolerable to all other non-EU member States that are party to the ECHR, especially when accession of the European Union will place it on an equal footing with them.

At any rate, the ECtHR very recently established that the equivalence of the European Union and the ECHR systems shall be evaluated not in the abstract but on a case-by-case basis, in a realistic and not merely theoretical way.³⁶¹ The ECtHR, at the same time, “expanded the subjective and objective scope of the State responsibility” in relation to international organization, by stating in the Gasparini decision³⁶² that “member States are obliged, when they transfer a part of their sovereign powers to an international organi[z]ation to which they adhere, to scrutini[z]e that the rights granted by the Convention will receive in the frame of the international organi[z]ation an ‘equivalent protection’ to that of the Convention system.”³⁶³

Finally, in all those cases according to the ECtHR “the most appropriate form of redress would, in principle, be trial *de novo* or the reopening of the proceedings, in due course and in accordance with the requirements of Article 6 of the Convention.”³⁶⁴

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361. See *Producentenorganisatie van de Nederlands Kokkelvisserij U.A. v. Netherlands*, App. No. 13645/05 Eur. Ct. H.R. (2009) available at www.hudoc.echr.coe.int.

362. See *Gasparini v. Italia and Belgium*, App. No. 10750/03 Eur. Ct. H.R. (2009), available at www.hudoc.echr.coe.int (only available in French).

363. *Id.* “[L]es Etats membres ont l’obligation, au moment où ils transfèrent une partie de leurs pouvoirs souverains à une organisation [sic] internationale à laquelle ils adhèrent, de veiller à ce que les droits garantis par la Convention reçoivent au sein de cette organisation [sic] une ‘protection équivalente’ à celle assurée par le mécanisme de la Convention.”

364. See *Somogyi v. Italy*, App. No. 67972/01, Eur. Ct. H.R. ¶ 86 (2004), available at www.hudoc.echr.coe.int.