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# National Courts as ‘Guardians’ and ‘Ordinary Courts’ of EU Law: Opinion 1/09 of the ECJ

Roberto BARATTA<sup>\*</sup>

*Opinion 1/09 may be considered as one of the most conspicuous contributions the European Court of Justice (ECJ) has given to the constitutional building of the European Union (EU). For the first time in its case law, it has labelled national courts as the ‘guardians’ and ‘ordinary courts’ of the EU legal order, focusing particularly on their role of referring courts in the preliminary ruling procedure. Reiterating a monistic approach, national courts have been entrusted with judicial powers Member States cannot rule out. Even though the ECJ remains the ultimate umpire of the EU legality, the Opinion makes the preliminary ruling procedure an instrument of judicial protection of individual rights stemming from EU law.*

## 1 INTRODUCTION

On 8 March 2011, the European Court of Justice (sitting in full Court, hereinafter the ‘ECJ’ or the ‘Court’) delivered Opinion 1/09 pursuant to Article 218(11) of the Treaty on the Functioning of the European Union (TFEU) on the compatibility of the Draft Agreement creating a unified patent litigation system with the Treaty on the European Union (TEU) and the TFEU. The Opinion is of paramount importance essentially for the emphasis the ECJ put on its relationship with the national judge, enhancing in an unprecedented way the role of the latter in the judicial system of the European Union (EU). The Opinion shows how fundamental the position of national courts has become in the European integration process within the framework of the preliminary ruling procedure. Their cooperation with the ECJ nowadays amounts to being an ‘essential’ character of the EU legal order.

The following commentary is divided into four parts. After explaining the Draft Agreement creating a unified patent litigation system and the general framework of the EU patent (section 2), the Opinion of the Court will be outlined (section 3). The statements and the reasoning of the ECJ will then be analysed as far as its substantive part is concerned (section 3.1), with the double aim of evaluating the main contribution to the architecture of the Union judicial system (section 3.2) and

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some possible implications in the view of the EU accession to the European Convention for the protection of Human Rights and Fundamental Freedoms (hereinafter ECHR; section 3.3). After a brief analysis of possible ways out from the deadlock following the negative Opinion of the Court on the envisaged agreement (section 4), some conclusions will be drawn (section 5).

## 2 THE DRAFT AGREEMENT CREATING A UNIFIED PATENT LITIGATION SYSTEM AND THE GENERAL FRAMEWORK OF THE EU PATENT

### 2.1 THE FIRST STEP: THE COMMISSION'S COMMUNICATION OF 2007

The creation of a European Court to handle patent litigation is part of a wider range of draft measures currently being examined by the EU institutions. After several attempts aimed at completing the single market for patents failed,<sup>1</sup> on April 2007, the Commission relaunched the discussion with the Communication 'Enhancing the Patent System in Europe'.<sup>2</sup> A fragmentation of the patent rules is an inherent drawback of the European Patent Convention (EPC).<sup>3</sup> Indeed, the so-called Munich Convention provides mainly for a centralized system of granting patents in Europe through the European Patent Office (EPO).

The European patent, as is known, is not a unitary title. It rather confers as many national protections as validations in State parties to the EPC the proprietor demands. Thus, when the patent is granted by the EPO, it must be validated in the territory of each State where the protection is sought by filing a translation into the

<sup>1</sup> The Union has not been able to establish a unitary patent protection since its foundation. One of the failed attempts was the Convention for the European Patent signed at Luxembourg on 15 Dec. 1975 (see OJ L 17 of 26 Jan. 1976, 1). Though amended by the Agreement concluded at Luxembourg on 15 Dec. 1989, aimed at adding two Protocols concerning the settlement of litigation on infringements and validity of patents (see OJ L 401 of 30 Dec. 1989, 1), that Convention never came into force. In 2000, the Commission proposed a Council Regulation on the Community patent whose objective was to establish a common intellectual property law among Member States, which would coexist with national patents (see COM (2000) 412 of 1 Aug. 2000). Due, in particular, to difficulties in achieving unanimity on the language arrangements, on 26 Nov. 2001, the Council failed to reach an agreement. In line with the new legal basis inserted into the treaties by the Nice revision (Arts 225a and 229a EC Treaty), the Commission proposed a Council Decision conferring jurisdiction on the ECJ as to disputes related to the EC patent. Another proposal of the Council Decision intended to set up a common Court, as well as to give the former Court of First Instance (now General Court) the power to rule on appeal cases. Despite the common political approach adopted in 2003 on the Community patent, particularly on the linguistic regime based on the proprietors' obligation to supply translations of the claims into all the official languages of Member States, the Council was able to finalize not one act at the Competitiveness Council of 26–27 Nov. 2003. On the long years of discussion in the history of EC/EU, cf. recently T. Jaeger, 'The EU Patent: *cui bono et quo vadit?*', CML Rev. (2010): 63 et seq.

<sup>2</sup> See Communication from the Commission to the European Parliament and the Council – Enhancing the Patent System in Europe, COM (2007) 165 final, 3 Apr. 2007.

<sup>3</sup> The EPC was signed in Munich on 5 Oct. 1973. Among the thirty-eight States being part of this treaty, there are all the Member States of the EU.

official language of that State.<sup>4</sup> Practically, though the pre-granted phase for delivering the classical European patent is unique, this title of intellectual property amounts to a bunch of national patents, each one being protected according to the relevant domestic law. The post-granted phase is, therefore, essentially left to the national sovereignties.

In addition, as regards the judiciary protection, the Munich system lacks a single jurisdiction for litigation. Disputes on infringements (proceedings seeking to enforce patent rights) and revocations (proceedings challenging the validity of patents granted by the relevant authority) remain the sole responsibility of the domestic courts. Multiple litigation in different States on the same patent issue may occur, accompanied by legal uncertainties, as well as greater litigation costs for companies and Small and Medium Sized Enterprises (SMEs). Last but not least, the fragmentation of the litigation on patents has inevitably led, *inter alia*, first to a 'forum shopping' strategy, the attacking party choosing the most convenient jurisdiction with regard to its own interests, and, second, to 'torpedo motions', a delaying strategy based on actions for declaring non-infringements lodged in jurisdictional systems known for dispensing justice slowly.<sup>5</sup>

## 2.2 THE TWO-PILLAR APPROACH ENDORSED BY THE COUNCIL

In order to tackle this long-standing legal vacuum in the internal market, the Council, under the Commission's propulsive role, envisaged a two-pillar approach: the establishment of a unique jurisdiction, on the one hand, and a uniform law aimed at protecting patent rights coherently throughout the Union, on the other hand. Moving from the above-mentioned Commission Communication, the Council decided to build on the existing Munich Convention, namely on its system of patent grants, which was considered an efficient foundation for further evolution. Thus, an EU patent system with unitary rights, claims, and limitations, governed by a common regulation, but delivered by the EPO, could then be established. Users of the patent system would be free to choose either the new form of European title or the national patent granted by national offices or the

<sup>4</sup> On 17 Oct. 2000, the so-called 'London Agreement' on the application of Art. 65 EPC set up a special linguistic regime, which is currently in force in eleven Member States of the EU, aimed at simplifying the translation requirements between the EPC Contracting Parties. It is an optional agreement essentially aimed at reducing the costs related to the translation of European patents. The London Agreement entered into force on 1 May 2008 and is currently applicable to twelve Member States of the EU, including United Kingdom, France, and Germany.

<sup>5</sup> Cf. D. Harhoff, 'Economic Cost-Benefit Analysis of a Unified and Integrated European Patent Litigation System', <[http://ec.europa.eu/internal\\_market/indprop/docs/patent/studies/litigation\\_system\\_en.pdf](http://ec.europa.eu/internal_market/indprop/docs/patent/studies/litigation_system_en.pdf)>, 26 Feb. 2009, 16 et seq.

classical European patent. The three types of patents would coexist, leaving the inventors the choice they deemed best.

After long and burdensome negotiations, on 4 December 2009, the Council adopted a general approach for a regulation on the EU patent.<sup>6</sup> Sensitive points, however, such as translation arrangements, renewal fees, and, to a certain extent, the distribution criteria of part of those fees among national patent offices, remained outside the scope of the informal agreement. It was settled that language arrangements would be decided unanimously according to Article 118 (2nd sentence) TFEU, while the new EU title and related problems would be figured out under the ordinary legislative procedure pursuant to Article 118 (1st sentence) TFEU.

This package was to be supplemented by the accession of the Union to the EPC. The institutions considered the revision of the EPC for permitting both the accession of the EU and the adjustments required for a *unitary patent at 27* to become operational in the international legal framework of the classical European patent and to be crucial indeed. However, since then, an ultimate institutional agreement on this package has never been achieved, largely due to the lack of consensus on the three linguistic translation arrangements proposed by the Commission.<sup>7</sup> In fact, Italy (pleading for an English oriented regime, being it either ‘English only’ or ‘English always’) and Spain (asking for a solution essentially involving also the Spanish language) did not accept the Commission’s approach. That explains why twelve Member States,<sup>8</sup> joined forthwith by thirteen other governments,<sup>9</sup> addressed formal requests to the Commission pointing out their desire to establish an enhanced cooperation in the area of unitary patent protection.

On 10 March 2011, the Council, after having obtained the European Parliament’s consent, adopted Decision No. 2011/167/EU authorizing enhanced cooperation both in the field of the creation of unitary patent protection and with regard to the translation arrangements.<sup>10</sup> Italian and Spanish governments disapproved, however, and later on challenged its validity before the ECJ.<sup>11</sup> Proposals

<sup>6</sup> The label ‘Community Patent’ was changed to ‘EU Patent’ due to the entry into force of the Treaty of Lisbon (hereinafter ToL) on 1 Dec. 2009; see Council Document 16113/09 Add. 1. See also Press Release of 4 Dec. 2009, IP/09/1880.

<sup>7</sup> See proposal for a Council regulation on the translation arrangements for the EU patent – COM (2010) 350 of 30 Jun. 2010. The Commission proposed that the EU patent would be granted in English, French, or German languages, while the claims would be translated into the other two EPO languages pursuant to Art. 14(6) of the EPC. No further translations and no validations in the Member States would be necessary to enforce the EU patent throughout the territories of the Member States. Finally, the patent as granted in one of the official EPO languages would be the authentic text of the EU title.

<sup>8</sup> Denmark, Estonia, Finland, France, Germany, Lithuania, Luxembourg, the Netherlands, Poland, Slovenia, Sweden, and the United Kingdom.

<sup>9</sup> Austria, Belgium, Bulgaria, the Czech Republic, Ireland, Greece, Cyprus, Latvia, Hungary, Malta, Portugal, Romania, and Slovakia.

<sup>10</sup> See OJ L 76 of 22 Mar. 2011, 53.

<sup>11</sup> See *EuroPolitics*, 31 May 2011, no. 4213, 6.

as to the two linked regulations, based, respectively, on Articles 118 (1st sentence) and 118 (2nd sentence) TFEU, were swiftly adopted by the Commission. The institutional debate is still going on at the time of this writing.<sup>12</sup>

### 2.3 THE JUDICIARY *VOLET*

As far as the judiciary *volet* is concerned, there has always been a large consensus among institutions, Member States, and stakeholders on the need to set up a unified and specialized Patent Court, holding competence for both EPO patents and a future EU patent – an indispensable objective to pursue for improving the patent system in Europe. The 2007 Commission Communication, in particular, pointed out the need for creating not only a unitary 'Community patent', as a new intellectual property right at disposal for the European industry and innovators, but also, and foremost, a common litigation body.<sup>13</sup> Even the drafting of the European Patent Litigation Agreement (EPLA) at the EPC level, though rightly opposed by the Commission because its entry into force would have affected the EU competences, reinvigorated its intention to address the litigation inefficiencies of the current patent system.<sup>14</sup> One of the most convincing arguments for creating a unique litigation system in the EU was, however, explained by an economic study undertaken for the Commission, according to which 'the private costs of duplication would range between EUR 148 and EUR 289 millions in 2013'.<sup>15</sup>

The Council Work on the establishment of the unified patent jurisdiction, led by different presidencies between 2007 and December 2009, resulted in a Draft Agreement to found the European and Community Patent Court (ECPC), afterwards informally renamed the European and EU Patent Court (EEUPC) due to the entry into force of the Treaty of Lisbon (hereinafter ToL). It was conceived as a mixed agreement to be concluded between the EU, its Member States, and an indefinite number of third-country parties to the EPC. This *international Patent Court* would have been conferred the exclusive jurisdiction for both classical European patents and EU patents regarding disputes between individuals on infringements and revocation cases, as well as for litigation on compulsory licenses, while administrative disputes concerning the issuing of patents by EPO were not included in that competence.

The international Patent Court would have been composed of a body of First Instance, articulated in a central division and local and/or regional divisions. A Court of Appeal completed the judiciary body, which included also a Registry. The Court

<sup>12</sup> Cf. COM (2011) 215 final and COM (2011) 216 final of 13 Apr. 2011.

<sup>13</sup> See 2007 Communication, *supra* n. 2, 4.

<sup>14</sup> Cf. also Jaeger, *supra*, 68 et seq. and 103 et seq.

<sup>15</sup> Cf. Harhoff, 41.

was to be connected to the ECJ through a preliminary ruling mechanism that was modelled on Article 234 TEC (now Article 267 TFEU). Actually, according to Article 48 of the Draft Agreement on the Patent Court, the Court of First Instance could, if it considered necessary, and the Court of Appeal should request the ECJ to rule on the interpretation of the EU treaties, as well as on the validity and interpretation of EU acts. The ECJ preliminary ruling would have been binding on the international Patent Court.<sup>16</sup>

### 3 A SUMMARY OF THE OPINION

#### 3.1 THE BASIC STATEMENTS OF THE COURT

The ECJ held that the agreement establishing an ECPC is inconsistent with the treaties because the exclusive jurisdiction of the Patent Court would deprive the national courts of the EU Member States of their role as EU courts.<sup>17</sup> This institutional divestment would have taken place through the conferral of the exclusive competence to make a preliminary reference to the Patent Court in accordance with a mechanism similar to the one laid down in Article 267 TFEU. Before focusing on some specific parts of the Opinion, a short summary of the admissibility issues raised before ECJ (section 3.1.1) and the substance of this decision (section 3.1.2) seems useful.

##### 3.1.1 *Admissibility of the Request for an Opinion*

As to the admissibility of the request for an opinion, the observations submitted by the European Parliament and some intervening governments raised three main issues: the imprecise content of the Draft Agreement, the insufficiently advanced stage of the decision-making process in the preparatory work, and institutional balance, which, according to the European Parliament, would have been breached since the request to the Court from the Council would have entailed the risk of letting the Council circumvent the necessary previous consent of the Parliament.

After having recalled the purpose of its advisory jurisdiction enshrined in Article 218(11) TFEU, that is, to forestall ‘complications which would result from legal

<sup>16</sup> See Council Document No. 7928/09 of 23 Mar. 2009, Draft Agreement on the EEUPC and Draft Statute. The Patent Court Agreement also provided for specific rules on the languages used in the proceedings, which was based on the official language of the State in whose territory the local or regional division of the Court of First Instance was located, although each contracting State would be able to derogate from this and appoint one of the three languages of the EPO (i.e., English, French, and German) as the language of procedure of its local or regional division. The working languages of the central division would also be limited to the three current working languages of the EPO.

<sup>17</sup> For a first comment, see D. Simon, ‘Avis négatif sur le projet de création d’une juridiction des brevets, in Europe. Actualité du droit de l’Union européenne’ (2011), n. 5, 4, comment n. 5.

disputes concerning the compatibility with the Treaties of international agreement binding upon the European Union',<sup>18</sup> the ECJ addressed the inadmissibility claims. As to the alleged lack of precision of the Draft Agreement, it replied that, in order to rule on the compatibility of the Draft Agreement with the EU treaties, it would have to know the 'actual content' of the agreement.<sup>19</sup> Since this was the case, as the Council had provided the full text of the Draft Agreement, the ECJ came to the conclusion that it had sufficient information on the content and the background of the Draft Agreement.<sup>20</sup>

Regarding the claim as to whether the decision-making process concerning the elaboration of the agreement had reached a sufficiently advanced stage, the ECJ pointed out that this would not prevent the request for an Opinion. In its reasoning, this would hold true if the subject matter of the agreement could be clearly identified prior to the beginning of the international dealings, where the information submitted would allow the Court to form a 'sufficiently certain judgment on the question raised' by the entity requesting an Opinion,<sup>21</sup> and the lack of unanimity on the decision to conclude the agreement or on the legislative side measures of the agreement would not plead against this.<sup>22</sup>

Finally, the issue on institutional balance was tackled by the ECJ, by holding that the final agreement of the concerned institutions on the international provisions was not a condition to be met. The advisory procedure could be enacted individually by each of them 'without any coordinated action and without waiting for the final outcome of any related legislative procedure'.<sup>23</sup>

### 3.1.2 *Substance*

From the outset, attention is drawn to the link between the planned international jurisdiction and EU law. The ECJ pointed out that the central question raised in the request did not concern the powers of the Patent Court in the field of the European patent. It rather relates to the administration of the future EU patent.<sup>24</sup> As the Draft Agreement aims at creating a new judicial body, the Court recalled the 'fundamental elements of the legal order and judicial system of the European Union', namely that it is a 'new legal order', possessing its 'own' institutions. Member States and their nationals are the subjects of that order, its essential

<sup>18</sup> Opinion 1/09, para. 47, and case law there mentioned.

<sup>19</sup> Opinion 1/09, para. 49.

<sup>20</sup> *Ibid.*, paras 50–52.

<sup>21</sup> *Ibid.*, para. 53.

<sup>22</sup> *Ibid.*, para. 54.

<sup>23</sup> *Ibid.*, para. 55.

<sup>24</sup> *Ibid.*, para. 59.

features being primacy and direct effect of EU law.<sup>25</sup> Quite surprisingly, having in mind the provision of Article 19(1) TEU,<sup>26</sup> the Court highlighted also that the ‘guardians’ of that legal order and its system of judicial protection are the Court of Justice ‘and the courts and tribunals of the Member States’.<sup>27</sup> However, it is for the Court (alone) to ensure respect for the autonomy of the EU legal order created by the treaties.<sup>28</sup> Subsequently, the focus is back on Member States and their judges. The ECJ recalled that, pursuant to the principle of sincere cooperation (Article 4(3) TEU), Member States ensure the effective application of EU law. In this context, national courts – along with the ECJ – play a decisive role on the judicial protection of individuals’ rights arising from that law,<sup>29</sup> stressing again that the EU legal order has established a ‘complete’ system of legal procedures and remedies in order to guarantee the judicial review of the acts of the institutions.<sup>30</sup>

The Court then turned to the main features of the planned Patent Court. First, by underlining that it is an organization with a distinct legal personality under international law, it noted that the envisaged litigation body is detached from the system provided for in Article 19(1) TEU. Second, it listed the fields of its exclusive jurisdiction, remarking that, according to Article 15 of the Draft Agreement, national courts would enjoy no more power to adjudicate in that regard.<sup>31</sup> The ECJ also stressed that, pursuant to Article 14a of the Draft Agreement, the Patent Court would interpret and apply EU law. The consequential effect would be to confer upon it the competences normally held by national courts to hear disputes in the field of EU patent and to ensure, in this field, the full effectiveness of EU law and the judicial protection of individual rights stemming from it.<sup>32</sup>

Then, the ECJ looked back at its advisory case law concerning, in particular, the creation of judicial bodies by virtue of international agreements to be concluded by

<sup>25</sup> *Ibid.*, paras 64–65.

<sup>26</sup> ‘The Court of Justice of the European Union shall include the Court of Justice, the General Court and specialised courts. It shall ensure that in the interpretation and application of the Treaties the law is observed. Member States shall provide remedies sufficient to ensure effective legal protection in the fields covered by Union law.’

<sup>27</sup> *Ibid.*, para. 66.

<sup>28</sup> *Ibid.*, para. 67.

<sup>29</sup> In fact, the national court, in collaboration with the ECJ, fulfils the duty to secure that the law is observed in the interpretation and application of the treaties (*ibid.*, paras 68–69).

<sup>30</sup> As the Court held in the case law quoted in this point (see judgment in Case C-50/00P, *Unión de Pequeños Agricultores* [2002] ECR I-6677, para. 40), the judicial review is both direct, through action for annulment and action for failure to act, and indirect, through the preliminary ruling on validity.

<sup>31</sup> Opinion 1/09, paras 71 and 72, that is, actions for actual or threatened infringements of patents, counterclaims concerning licenses, actions for declarations of non-infringement, actions for provisional and protective measures, actions or counterclaims for revocation of patents, actions for damages or compensation derived from the provisional protection conferred by a published patent application, actions relating to the use of the invention before the granting of the patent or to the right based on prior use of the patent, actions for the grant or revocation of compulsory licenses in respect of Community patents, and actions for compensation for licenses.

<sup>32</sup> *Ibid.*, para. 73.

the EU. The Court clearly recognized that the EU treaty making power also implies the opening of the supranational order to the decisions of these courts. Additionally, those agreements may even confer new judicial powers on the ECJ, provided that in so doing both the essential characters of its functioning, as conceived in the treaties, are not altered and that they do not affect the autonomy of the EU legal order.<sup>33</sup> In any event, the ECJ stressed that the judicial systems envisaged in the previous case law had to adjudicate disputes essentially on the interpretation and application of the agreements concerned. Moreover, where the agreements at issue provided for a power to make a preliminary reference to the ECJ, the same agreements affected neither the powers of national courts of EU Member States to interpret and apply EU law nor the power to request a preliminary ruling from the ECJ and its own power to reply.<sup>34</sup> However, the case of the Patent Court is different. It would be called upon to interpret not only the EU law provisions related to the field of the Community Patent Regulation but also other rules on intellectual property, rules of the internal market and competition law, as well as general principles of EU law and its fundamental rights.<sup>35</sup> Furthermore, this new litigation body would take the place of national courts according to Articles 15 and 48 of the Draft Agreement, preventing them from requesting preliminary rulings to the ECJ. Hence, in this field, the Patent Court would become the sole competent Court to communicate with the ECJ by means of a reference for a preliminary ruling on the interpretation and application of EU law.<sup>36</sup>

At this point, the Court laid down its first decisive objection. Despite that the ECJ cannot adjudicate on direct actions of individuals in the field of patents, as it is up to the national courts to do that, Member States cannot deprive their courts of their tasks as *ordinary courts of EU law*. For this, activity involves the power of referring questions for a preliminary ruling.<sup>37</sup> This would amount – the Court insisted – to removal of the competences of national courts. It was not the case for the Benelux Court of Justice, due to its common nature to some Member States, which is able to use mechanisms to ensure the effectiveness of EU law.<sup>38</sup>

The Court then linked this reasoning with Article 267 TFEU, which is 'essential for the preservation of the Community character of the law established by the Treaties'. That provision guarantees the uniformity in the interpretation of EU law and the elimination of difficulties national courts may encounter when applying such law in their domestic systems. In addition, Article 267 entails for national courts 'the

<sup>33</sup> *Ibid.*, paras 74–76.

<sup>34</sup> *Ibid.*, para. 77.

<sup>35</sup> *Ibid.*, para. 78.

<sup>36</sup> *Ibid.*, para. 79.

<sup>37</sup> *Ibid.*, para. 80.

<sup>38</sup> *Ibid.*, paras 81–82.

most extensive power, or even the obligation', to make a reference to the Court. The system established by this provision establishes then a form of 'direct cooperation' between the ECJ and the national courts, which are indeed 'closely involved' in ensuring the uniform application of EU law and the judicial protection of the rights conferred by EU law.<sup>39</sup> It follows that the tasks attributed to national courts and the ECJ, 'respectively', are (both) 'indispensable to the preservation of the very nature of the law established by the Treaties'.<sup>40</sup>

It is worth noting that the ECJ did not follow the path suggested by the statement of position by the Advocates General delivered on 2 July 2010, where they considered that the envisaged preliminary ruling mechanism was incompatible with the treaties,<sup>41</sup> though for very different reasons, leaving open the possibility of pursuing the route indicated in the Draft, with some adjustments. Furthermore, the Court recalled that the effective accomplishment of this mission by national courts is guaranteed by specific means of enforcement, namely the principle of non-contractual liability of Member States for breach of EU law, to be applied under 'specific conditions' when the breach is attributable to judicial bodies and, on the other hand, the infringement procedure, which can be triggered against a Member State when the infringement has been committed by a judicial authority.<sup>42</sup> Needless to say, neither of these guarantees can be applied as against the Patent Court.<sup>43</sup> The Court then concluded with a paragraph that is worthwhile reporting in full:

Consequently, the envisaged agreement, by conferring on an international court which is outside the institutional and judicial framework of the European Union an exclusive jurisdiction to hear a significant number of actions brought by individuals in the field of the Community patent and to interpret and apply European Union law in that field, would deprive courts of Member States of their powers in relation to the interpretation and application of European Union law and the Court of its powers to reply, by preliminary ruling, to questions referred by those courts and, consequently, would alter the essential character of the powers which the Treaties confer on the institutions of the European Union and on the Member States and which are indispensable to the preservation of the very nature of European Union law.<sup>44</sup>

<sup>39</sup> *Ibid.*, paras 83–84.

<sup>40</sup> *Ibid.*, para. 85.

<sup>41</sup> In particular, concerning the preliminary ruling procedure provided for in the Draft Agreement, they had considered that the judgments of the Court would have been compelling for the Patent Court. However, the Advocates General had not given importance to the divestment of national courts of their competence as referring courts: see points 94–103 of the collective Opinion, <[www.ipeg.eu/blog/wp-content/uploads/Advocates-General-Opinion-1-09.pdf](http://www.ipeg.eu/blog/wp-content/uploads/Advocates-General-Opinion-1-09.pdf)>.

<sup>42</sup> *Ibid.*, paras 86–87.

<sup>43</sup> *Ibid.*, para. 88.

<sup>44</sup> *Ibid.*, para. 89.

### 3.2 THE CONTRIBUTION OF OPINION 1/09 TO THE ARCHITECTURE OF THE UNION JUDICIAL SYSTEM

Opinion 1/09, it may be argued, is deemed to acquire an authoritative status, given its contribution to the architecture of the Union judicial system. Indeed, some passages of its *ratio decidendi* seem to add new bricks to the 'constitutional building' of the EU. While assessing whether the creation of a new court structure, such as the *international* Patent Court, was compatible with the treaties, the ECJ focused, as is tentatively demonstrated below, on the functional link of preliminary ruling proceedings, involving both ECJ and national courts, with the protection of individual rights. Certainly, in its long-standing case law, the ECJ already enhanced the preliminary reference procedure when it stressed its function of pursuing the full and uniform application of EU law through national judges,<sup>45</sup> being the same judges instrumental in achieving the legal integration objective.<sup>46</sup> However, the conception held in Opinion 1/09 according to which national courts seem to have received a sort of *necessary* delegation of power for protecting individual rights, being them *irreplaceable* enforcers of EU law, appears quite unprecedented.

If, as it is here suggested, Article 267 TFEU is a means to ensure individual rights as guaranteed by EU law, which the ECJ, indirectly, and national judges, directly, have to secure within domestic legal orders, this approach focuses on the horizontal (or cooperative) side of the binomial ECJ/national judges relationship.<sup>47</sup> Yet, this relationship was and still remains multifaceted since, arguing from Article 19 TEU and long-standing jurisprudence on the effect of Article 267 rulings on the national courts, it is not a relation among equals. As a result, one may reasonably assume that, in the underlying reasoning of the Opinion, the preliminary ruling judgments and the related domestic court decisions are a unitary and constituent part of the legal system protecting individual rights, amounting to an essential part of the basic features of the EU legal order as a whole.

<sup>45</sup> See also judgment of 22 Oct. 1987, Case 314/85, *Foto-Frost* [1987] ECR 4199, where the ECJ held that the national courts have no power to declare a Union act invalid on the basis of policy considerations, that is to say by stating the necessity of safeguarding the uniform application of Union law. More in general, it is well known that the preliminary ruling procedure has been an exceptional means for ensuring effectiveness and supremacy of EU law, as well as an instrument for integrating very different legal traditions: see among others A. Barav, 'Transmutations préjudicielles', in *Une Communauté de droit. Festschrift für G. C. Rodríguez Iglesias*, eds N. Colneric et al. (Berlin, 2003), 621; T. Tridimas, 'Knocking on Heaven's Door: Fragmentation, Efficiency and Defiance in the Preliminary Reference Procedure', *CML Rev.* 40 (2003): 9; F.G. Jacobs, 'Effective Judicial Protection of Individuals in the European Union: Now and in the Future', *Il diritto dell'Unione europea* (2002): 203.

<sup>46</sup> As regards to the possible reasons behind the success of preliminary ruling procedure, see C.J. Carrubba & L. Murrach, 'Legal Integration and Use of the Preliminary Ruling Process in the European Union', *International Organization* 59 (2005): 399–418.

<sup>47</sup> Cf. T.C. Hartley, *The Foundations of European Union Law*, 7th edn (Oxford: Oxford University Press, 2010), 287; Wyatt & Dashwood, *European Union Law*, 5th edn (London: Sweet & Maxwell, 2006), 510.

The ECJ does recognize that the jurisdiction to rule on actions between individuals in the field of patents belongs to national courts. However, unlike the AG opinion that concluded that the establishment of an international body situated outside the institutional scope of the EU was not per se incompatible with the EU treaties, the ECJ held that Member States cannot outsource such a competence to an international court – that is, ‘outside the institutional and judicial framework of the European Union’.<sup>48</sup> This result would deprive national judges of their inherent task, as ordinary courts within the EU legal order, to ensure uniform implementation of EU law and, thereby, of their related power or the obligation provided for in Article 267 TFEU to refer questions for a preliminary ruling. In this preservation attitude of the national judges’ tasks according to the founding treaty rules, the authority to refer preliminary questions to the ECJ, even provided for by Article 48 of the rejected Draft Agreement, has no doubt a minor, if any, importance. In the ECJ thinking, that authority does not countervail the basic shortcoming of an *international* body holding no link with national courts.

The Luxembourg Court’s cooperation with national judges seems vital in the intimate motive of Opinion 1/09. It focuses on the role of national judges (along obviously with its own) as the ‘guardians’ both of the EU legal order and its judicial system.<sup>49</sup> Such a conclusion seems quite persuasive and could also be advocated on the basis of the rule that provides for the jurisdiction of Member States’ courts unless a specific competence has been given to the ECJ (Article 274 TFEU). In any event, the fact that national judges, in their respective territories, and the ECJ are the custodians of the application and respect of EU law is in itself ‘evident from Article 19(1) TEU’.<sup>50</sup> It does not mean that there is no difference between the ECJ and the domestic courts. By recalling *incidenter tantum* that it is for the ECJ *alone* to ensure respect for ‘the autonomy of the EU legal order thus created by the Treaties’,<sup>51</sup> it seems clear that the ECJ stresses its leading role in the judicial system of the EU. In the previous Opinions, the issue of consistency was based on the competencies of the Court and on the possible encroachment upon its jurisdiction coming from ‘external’ courts.<sup>52</sup> In Opinion 1/09, the decentralized competence and the referring role of the national courts are under attack, and not the central supreme role of the ECJ itself. This explains why, in the ECJ thinking, national courts became part of the supranational legal order. It appears as if their competence, as EU provisions enforcers, is as important as that of the ECJ even though it is only

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<sup>48</sup> At para. 71.

<sup>49</sup> See, in particular, paras 68 and 69.

<sup>50</sup> At para. 66.

<sup>51</sup> Opinion 1/09, para. 67.

<sup>52</sup> See, in particular, Opinion 1/91, [1991] ECR I-6079, para. 35; Opinion 1/92, [1992] ECR I-2821, para. 32; Opinion 1/00, [2002] ECR I-3493, paras 21, 23, and 26.

for the Court, as supreme judge, to ensure the autonomy of the whole system. What is new, in comparison to the previous jurisprudence, is the reading of Article 19(1) TEU as a provision referring also to national courts. It is the wording of this provision to require Member States to ensure that the right to effective judicial protection is duly respected when Member States set up judicial remedies related to fields covered by EU law, according to a formulation that brings back to the stiff statement of the Court contained in the *Unión de Pequeños Agricultores* case.<sup>53</sup> Actually, the ECJ stated that it is 'evident' from this provision that the 'guardians' of the EU legal order and of its judicial system are the Court of Justice 'and the courts and tribunals of the Member States'.<sup>54</sup> Against this background, national judges cannot be divested, through the means of a mixed agreement, of the essential tasks Article 267 TFEU confers upon them.<sup>55</sup> This close connection between Article 19(1) TEU and Article 267 TFEU seems to lead the ECJ to bring fresh light on the preliminary ruling jurisdiction within the EU legal order. The system set up by Article 267 TFEU is not only 'essential for the preservation of the Community character of the law established by the Treaties' and for its uniform application throughout the Union<sup>56</sup> but also all the more pivotal for 'the protection of individual rights conferred by' the EU law.<sup>57</sup> As a result, 'the tasks attributed to the national courts and to the Court of Justice respectively are indispensable to the preservation of the very nature of the law established by the Treaties'.<sup>58</sup> On these grounds of reasoning, one could conclude that, in the ECJ perspective, the preliminary ruling mechanism is essential in *protecting individual rights conferred upon them by EU law*. It seems so crucial to become a fundamental feature of the EU legal order, as designed by the founding treaties and progressively developed by the 'constitutional' jurisprudence of the ECJ. That being said, what comes as a matter of course is the confirmation of the constitutional relevance of judicial control enshrined in Article 19(1) TEU. The right to a court, and in particular to a 'referring court' within the meaning of Article 267 TFEU, represents the guarantee of due observance of one of the very basic principles of EU law, which

<sup>53</sup> Judgment in C-50/00P [2002] ECR I-6077, para. 41: It is for the Member States to establish a system of legal remedies and procedures that ensure respect for the right to effective judicial protection.

<sup>54</sup> Opinion 1/09, para. 66.

<sup>55</sup> See notably para. 80: 'Member States cannot confer the jurisdiction to resolve such disputes on a court created by an international agreement which would deprive those courts of their task, as "ordinary" courts within the European Union legal order, to implement European law and, thereby, of the power provided for in Article 267 TFEU, or, as the case may be, the obligation, to refer questions for a preliminary ruling in the field concerned', and para. 81.

<sup>56</sup> At para. 83. In its case law, the ECJ focused on the aim of preliminary ruling jurisdiction to avoid divergences in the interpretation of EU law (see, in that respect, the judgment in Case 166/73, *Rheinmühlen-Düsseldorf* [1974] ECR 33, paras 2 and 3, and judgment in C-458/06, *Gourmet Classic* [2008] ECR I-4207, para. 20).

<sup>57</sup> See para. 84.

<sup>58</sup> See para. 85.

is the respect of the rule of law, now expressly mentioned in Article 2 TEU among the founding values of the EU.

### 3.3 THE IMPLICATIONS OF OPINION 1/09 IN THE PERSPECTIVE OF THE EU ACCESSION TO THE ECHR: THE PRIOR INVOLVEMENT OF THE ECJ BEFORE THE STRASBOURG COURT CARRIES OUT ITS EXTERNAL CONTROL

If the assumptions above are correct, they should be taken into account when drawing the specific characteristic of the Union, as well as of its legal order, in view of the negotiation of the accession agreement of the EU to the ECHR. To put it differently, Opinion 1/09 could turn out to be an indirect, but significant, contribution of the ECJ to outline the specificity of the EU legal order in the perspective of Article 1(a) of Protocol No. 8 relating to the accession of the Union to the ECHR.<sup>59</sup> As is known, one of the major question raised under the negotiation concerns the role of preliminary ruling jurisdiction within the judicial system of the EU in relation to the external control that will be conferred to the European Court of Human Rights (hereinafter, ECtHR) after the accession. Since Article 35(1) ECHR provides that an individual can seek judicial protection only ‘after all domestic remedies have already been exhausted according to the general recognized rules of international law’, should the prior internal control of the ECJ be possible if, in a case brought before the ECtHR *against a Member State*, the ECJ did not have the opportunity to assess the compatibility of an EU legal act with the relevant fundamental rights as guaranteed by the EU Charter?

Certainly, a negative answer could be advocated, arguing notably that in situations of indirect actions (against a Member State) brought before the Strasbourg Court concerning the compatibility of an EU act, the subsidiarity condition enshrined in Article 35 ECHR is met under certain circumstances – that is, when the applicant raised for the first time the question regarding the compatibility of a given

<sup>59</sup> Pursuant to Art. 6(2) TEU, the ‘Union shall accede to the’ ECHR. As a result, since the entry into force of the ToL, the accession of the EU to the ECHR has been put on the Council agenda. This institution approved on 4 Jun. 2010 a decision authorizing the Commission to negotiate an accession agreement. However, access of the Union is subject to specific conditions laid down in Art. 6(2) TEU (‘the Union shall accede to the European Convention for the Protection of Human Rights and Fundamental Freedoms. Such Accession shall not affect the Union’s competences as defined in the Treaties’), as well as in Protocol No. 8 annexed to the Treaties. It follows that after the entry into force of ToL the EU competence to join the ECHR is not an issue anymore. Therefore, the problem at stake is not ‘if’ (the *an*) the EU accedes to the ECHR, for this problem has been already solved by Art. 6.2 TEU but how (the *quomodo*) to preserve in the accession agreement all the conditions laid down by the treaties and notably in Protocol No. 8. Cf. C. Timmermans, ‘L’adhésion de l’Union européenne à la Convention européenne des Droits de l’homme’, <[www.europarl.europa.eu/document/activities/cont/201003/20100324ATT71235/20100324ATT71235EN.pdf](http://www.europarl.europa.eu/document/activities/cont/201003/20100324ATT71235/20100324ATT71235EN.pdf)>; P. Mengozzi, ‘Les caractéristiques spécifiques de l’Union européenne dans la perspective de son adhésion à la CEDH’, *Il Diritto dell’Unione europea* (2010): 231 et seq.

EU act with fundamental rights and forthwith requested the national court to refer a preliminary question to the ECJ on such a matter. Although the EU treaties do not envisage this procedure as providing an individual remedy, the party initiative of referral to be made would suffice per se and a failure of the national judge to ask for a preliminary ruling would be capricious and amount to a violation of the right of access to court under Article 6 ECHR.<sup>60</sup> That failure could also entail an infringement procedure under the EU legal order, given the obligation to refer to the ECJ validity issues concerning secondary law as held in *Firma Foto-Frost*.<sup>61</sup>

Though theoretically conceivable, that negative answer seems tenuous, especially in terms of judicial protection of individuals.<sup>62</sup> First, the ECtHR would not be able to assess any violation of a fundamental right whose breach has been alleged but the right of access to court contrary to Article 6. This would be the only possible solution if one considers that the exhaustion of local remedy condition, pursuant to Article 35 of the ECHR, has not been met since the ECJ was not given the opportunity to rule on the compatibility of the EU act with the fundamental rights as guaranteed in the EU legal order. Consequently, there would be no judicial remedy for evaluating the alleged violation of the fundamental substantive right at stake and no form of reparation whatsoever in that regard.

Second, even if the relevant State faced a second infringement procedure before the ECJ, likely lodged by the Commission for the very same facts, the ruling would just state the violation of Article 267 TFEU. Ultimately, on the one hand, the complainant's judicial protection would be undermined. On the other hand, a punitive attitude towards governments would prevail, bearing even in mind that ironically, due to domestic constitutional constraints on separation of powers, governments would hardly be in a position to enforce against a national judge any obligation to raise preliminary rulings to the ECJ. The negative scenario, as to the individual needs, would be circumvented only if the ECtHR could assess the compatibility of the EU act with the ECHR any time the applicant raised, before the national court, the preliminary ruling request. No matter what the national courts decides on the referral plea, the complainant has no means for compelling that court to make a reference.

However, a more sound approach, in terms both of international law and EU law, may be advocated so to ensure the prior involvement of the ECJ before the external control of the ECtHR, regardless of the complainant's requests in the

<sup>60</sup> Cf. by analogy the case law examined in P. van Dijk et al., *Theory and Practice of the European Convention on Human Rights*, 4th edn (Antwerpen/Oxford: Intersentia, 2006), 563 et seq.

<sup>61</sup> Judgment in Case 314/85, *Firma Foto-Frost*, *supra*.

<sup>62</sup> The approach described above raises doubts. For instance, it cannot be reasonably expected that an individual asks the national judge to enact a preliminary ruling procedure before the ECJ in order to demonstrate that he had exhausted his domestic remedies, had the ECJ already rejected a similar complaint.

domestic proceedings and, consequently, the reaction of the national court.<sup>63</sup> So the individual would not endure any disadvantage from its omission. Furthermore, from an international law standpoint, it seems worth noting that the control mechanism set up by ECHR is founded on the *principle of subsidiarity*, which is to be considered not only as a procedural prerequisite pursuant to Article 35(1) ECHR but also more generally as a principle that provides sound support for the ‘margin of appreciation’ doctrine. In brief, it allows some space of manoeuvre, within the criteria for the application of that doctrine as set out in the case law of the ECtHR, for the adaptation of the Convention to the specificities of each of the High Contracting Parties.<sup>64</sup> Therefore, that principle, as well as that doctrine, implies an enhanced role of the Contracting Parties’ judges when applying the ECHR provisions. It is primarily their responsibility to implement those provisions at the national level, since fundamental rights, as guaranteed at the conventional degree, should be coherently applied in the domestic legal order.<sup>65</sup> After all, when the EU accession will be finalized, it seems reasonable to argue that the ECJ is best positioned to appreciate, against the background of the specificities of the EU legal order, the compliance of EU acts with the catalogue of fundamental rights enshrined both in the Convention and in the broader framework of the Charter. It need hardly be said that the prior internal control would not and should not affect at all the full judicial powers of the ECtHR. It should additionally imply some procedural adjustments for preserving the interests of the individuals concerned to have swift proceedings. The fact that the Strasbourg Court may eventually reverse the Luxembourg Court judgment does not entail in itself any negative reply to the issue of the prior control within the EU.

This approach appears sounder even from an EU law perspective. The EU accession to ECHR must be coherent with the conditions laid down in the primary law, the latter being a superior source of law with respect to the international agreements concluded by the institutions.<sup>66</sup> If the role of ensuring the protection of individual rights through the preliminary ruling proceedings is a principle of structure of the EU legal order, as argued above, it should follow that the prior

<sup>63</sup> *Contra* T. Lock, ‘EU Accession to the ECHR: Implications for Judicial Review in Strasbourg’, *E.L.Rev.* 6 (2010): 777 et seq., 792, whereby the author argues that ‘there may be instances in which the Strasbourg Court will decide upon the compatibility of Member action which is triggered by EU law without a prior decision by the ECJ on the issue.’ In addition, the author does not even recommend that the Strasbourg Court would refer the case to the ECJ for a review of compatibility with the ECHR (at 793).

<sup>64</sup> Cf. Y. Arai, *The Margin of Appreciation Doctrine and the Principle of Proportionality in the ECHR* (Antwerp: Intersentia, 2002), *passim*; M. Lugato, ‘Sulla sussidiarietà in diritto internazionale’, *Archivio Giuridico* (2011): 3 et seq.

<sup>65</sup> It is worth recalling that the High Level Conference on the Future of the European Court of Human Rights, held at Interlaken on 19 Feb. 2010, stressed the ‘subsidiary nature of the supervisory mechanism established by the Convention and notably the fundamental role which national authorities, that is, governments, courts and parliament must play in guaranteeing and protecting human rights at the national level’. Moreover, it reiterated the call ‘for a strengthening of the principle of subsidiarity’.

<sup>66</sup> Cf., *inter alia*, G. Isaac & M. Blanquet, *Droit general de l’Union européenne*, 9th edn (Paris: Dalloz, 2006), 197.

involvement of the ECJ has to be ensured, under certain conditions, by the accession agreement. In other words, assuming that the protection of individual rights belongs primarily to the ECJ, according to Article 19 TEU and the related constitutional jurisprudence, the accession agreement as a result cannot but provide for the prior involvement mechanism in order to comply with Article 1(a) of Protocol No. 8, according to which the same agreement shall make provision, *inter alia*, 'for preserving the specific characteristics of the Union and Union law'.

Finally, the prior involvement of the ECJ could come under criticism, arguing that the ECJ would be seized not by a national court, as stipulated by Article 267 TFEU, but according to a different modality. Nonetheless, even this alleged incoherence should be considered in the broader picture of the ECJ case law. Indeed, the Luxembourg Court held that an international agreement, concluded by the EU, may confer new competencies on the institutions (including the ECJ), unless that international instrument alters the essential character of the powers conferred on the institutions by primary law.<sup>67</sup> Having that in mind, it is arguable that the prior involvement mechanism is not but a means of resuming a power originally attributed to the ECJ – a power that it should have exercised at the outset but that it failed to do so by virtue of the poor treatment of the case by the national judge. It is here suggested that the prior involvement mechanism would not undermine the essential character of the treaties.

Be that as it may, it is worth noting that the issue on the prior involvement is somehow settled by the 'activism' of the two Courts. First, the ECJ published a 'Discussion document' pleading for a mechanism 'capable of ensuring that a question of validity of a Union act' as to compliance with fundamental rights 'can be brought effectively before the Court of Justice before the European Court of Human Rights rules on the compatibility of that act with the Convention'.<sup>68</sup> Second, a joint

<sup>67</sup> ECJ endorsed that solution at least twice: see in particular, Opinion 1/92, of 10 Apr. 1992 (ECR 1992, I-2821, paras 32 and 41) and Opinion 1/00, of 18 Apr. 2002 (ECR 2002, I-3493, paras 20 and 21). Cf. in the same sense Timmermans, 8.

<sup>68</sup> See Discussion Document of the Court of Justice of the European Union on certain aspects of the accession of the European Union to the European Convention for the Protection of Human Rights and Fundamental Freedoms, <[http://curia.europa.eu/jcms/upload/docs/application/pdf/2010-05/convention\\_en\\_2010-05-21\\_12-10-16\\_272.pdf](http://curia.europa.eu/jcms/upload/docs/application/pdf/2010-05/convention_en_2010-05-21_12-10-16_272.pdf)>, para. 12. Basically, the ECJ argued that the prior involvement was to be justified on two grounds: first, on the principle of subsidiarity provided for in the control mechanism of the ECHR (para. 6); second, because in the judicial system of the EU, the ECJ alone has the jurisdiction to declare that an act of the Union is invalid (para. 8). However, one may wonder whether, after the accession, the judicial control of the ECtHR on the EU acts would actually affect the latter. A. Gianelli, 'L'adesione dell'Unione europea alla CEDU secondo il Trattato di Lisbona', *Il Diritto dell'Unione europea* (2009): 683 (n. 133), stresses that the Strasbourg Court would eventually declare just the responsibility of the EU.

communication of the presidents of the two Courts expressed this at a later date in the same vein.<sup>69</sup>

#### 4 SOME POSSIBLE WAYS FORWARD FOR THE EU PATENT LITIGATION SYSTEM AFTER THE NEGATIVE OPINION

Any tentative way out to set up a unified patent litigation body – largely recognized as an essential pillar to enhance the patent system in the EU – must start from Opinion 1/09 viewed in its context and merits. Against that strict background, several options may be still envisaged, leaving aside, for obvious reasons, the hypothesis of revising the treaties.<sup>70</sup>

##### 4.1 THE TRADEMARK JUDICIARY MODEL

First, as for the EU trademark, the jurisdiction could rest on national courts. In this judiciary model, disputes concerning infringement actions and counterclaims for revocation or for a declaration of invalidity of the Community trademark are submitted to ‘Community trademark courts’ that Member States are obliged to designate in their territories pursuant to Regulation No. 207/2009, notably Article 95 and the following.<sup>71</sup> As a result, national courts would rule on infringements and validity disputes on EU patents for the whole territory of the Union (or just for the territories of the Member States participating to the enhanced cooperation). Under the traditional preliminary ruling procedure, a bridge would be provided between the national courts and the Union legal system so as to ensure the primacy and the uniform interpretation of all forms of EU law. This track would undoubtedly be consistent with primary law, mirroring it with the classical relationship between national system and the EU legal order as the treaties provide for in general. Nonetheless, that judiciary model would hardly match the need, reiterated, *inter alia*, by governments, of setting up a unified and specialized system in this domain. As a matter of fact, economic models and the US experience suggest that ensuring a uniform high quality of professional experience is essential in the patent area.<sup>72</sup>

<sup>69</sup> See Joint Communication from the Presidents of the European Court of Human Rights and the Court of Justice of the European Union, further to the meeting between the two courts in January 2011, <[http://curia.europa.eu/jcms/upload/docs/application/pdf/2011-02/cedh\\_cjue\\_english.pdf](http://curia.europa.eu/jcms/upload/docs/application/pdf/2011-02/cedh_cjue_english.pdf)>.

<sup>70</sup> According to Art. 218(11) TFEU in case of negative opinion from the Court, the envisaged agreement cannot enter into force unless it is modified or the treaties are revised. This possibility is rather unlikely.

<sup>71</sup> See Council Regulation (EC) No. 207/2009 of 26 Feb. 2009 on the Community trademark (codified version), OJ L 78 of 24 Mar. 2009, 1.

<sup>72</sup> Cf. Jaeger, *supra*, 95 et seq.

#### 4.2 THE ARCHETYPE OF THE BENELUX COURT: HOW FAR CAN THE INSTITUTIONS BUILD ON IT?

A second way forward could be derived from the archetype of the Benelux Court for trademarks established by a treaty signed in Brussels on 31 March 1965 between the Kingdom of Belgium, the Grand Duchy of Luxembourg, and the Kingdom of the Netherlands. This Court is composed of judges of the Supreme Courts of the same States. According to another Convention on Trademarks that was concluded between them, that common court does not have the jurisdiction to rule on individual litigation. It rather acts, so to say, as a 'federal' judge on the interpretation on the Uniform Benelux Law on a preliminary basis. Its rulings are noticeably binding on national courts.

It is worth recalling that the consistency with the treaties of that archetype was accepted by the ECJ in *Parfums Christian Dior*, whereby the ECJ held that there was 'no good reason' why a court common to a number of Member States, such as the Benelux Court, should not be able to refer preliminary rulings, in the same way as other national judges.<sup>73</sup> However, in Opinion 1/09, the ECJ remarked the difference between the Benelux Court and the Patent Court as described in the Council Draft Agreement. Unlike the Patent Court, the former 'is a court common to a number of Member States, situated, consequently, within the judicial system of the European Union'; as a result, 'its decisions are subject to mechanism capable of ensuring the full effectiveness of the rules of the European Union'.<sup>74</sup> Indeed, the Benelux Court relies necessarily on national judges, as the ECJ acknowledged in *Parfums Christian Dior* by stating that the procedure before that Court 'is a step in the proceedings before national courts leading to definitive interpretations of common Benelux legal rules'<sup>75</sup> in the field of trademark law.

Since the Benelux model rests upon the key position of national judges, one may wonder whether the international judiciary body envisaged by the Council in the Draft Agreement submitted to the ECJ, and rejected in Opinion 1/09, could replace national judges in the Benelux model. In other words, may the Member States elaborate on that model so to conclude, exclusively among them, an international agreement aimed at setting up a common litigation body composed by a Court of First Instance, articulated in a central division and local and/or regional divisions, and by a Court of Appeal and a Registry?

The answer should be given in the light of the jurisprudence of the ECJ. First, it is to be noted that the Benelux archetype and the Patent Court structure are quite different. The former is situated within the judicial system of the EU and rests upon

<sup>73</sup> See Case C-337/95, *Parfums Christian Dior* of 4 Nov. 1997 [1997] I-6013, para. 21; Hartley, *supra*, 304.

<sup>74</sup> Opinion 1/09, *supra*, para. 82.

<sup>75</sup> See C-337/95, *supra*, para. 22.

the national judges' activity, with all the inherent consequences, particularly in terms of Member States' liability for incorrect judgments where the breach is sufficiently serious and regarding their responsibility to face infringement procedures before the ECJ for acts imputed to their national courts. On the contrary, the Patent Court, with its innate international character, would again be located outside the institutional and judicial framework of the EU, and once more, it would not be 'part of the judicial system provided for in Article 19(1)'.<sup>76</sup>

Admittedly, some appropriate provisions could be inserted in the *new* Draft Agreement in order to fulfil the gaps pointed out in Opinion 1/09, while preserving the very substance of the Patent Court structure as defined in the old Draft Agreement, the one rejected by the ECJ. Accordingly, for instance, new rules could provide that the Court of Appeal's erroneous application of EU law could expose Member States, jointly considered, to infringement procedures and to financial liability. In short, some appropriate provisions can be embedded in the Patent Court model so to ensure conformity with primary law as laid down in paragraphs 86 and 87 of Opinion 1/09. In the end, the new international agreement could also reiterate the obligation for the Patent Court to request preliminary rulings to the ECJ, as it was provided for in Article 48 of the Draft Agreement rejected by ECJ.

Nonetheless, it remains debatable whether the role of national judges may be replaced by an international body because an 'international' judge is hardly in a position comparable to that of national courts when the application of EU law, including general principles and fundamental rights, is at stake. Would it be, for instance, in the same condition as a national court, should a question arise concerning the primacy of EU fundamental rights and principles over some EPC rules? All in all, Opinion 1/09 seems negative-oriented as to preventing national courts from exercising their key role in the EU judicial constitutional system. Certainly, its paragraph 82 seems to open a door for the establishment of a common court among Member States if a role is left to national judges. However, the reference to the Benelux Court model must be considered in its context, bearing in mind particularly the repeated (seven times, at least) emphasis the ECJ put on the role of national judges in the EU judiciary system;<sup>77</sup> for they are the custodians of the EU legal order;<sup>78</sup> for an international agreement cannot deprive national courts of their intrinsic task as ordinary courts within that order,<sup>79</sup> without altering 'the essential character of the powers which the Treaties confer on the institutions of the EU and on the Member States and which are indispensable to the preservation of the very nature of the EU

<sup>76</sup> See Opinion 1/09, *supra*, para. 71.

<sup>77</sup> See Opinion 1/09, in particular paras 66, 68, 69, 80, 81, 84, and 85.

<sup>78</sup> *Ibid.*, para. 66.

<sup>79</sup> *Ibid.*, para. 80.

law';<sup>80</sup> for the responsibility attributed to the domestic courts are indispensable to the preservation of the very nature of the law established by the treaties.<sup>81</sup>

Furthermore, in the very recent ruling of *Miles and Others v. European Schools*, the ECJ confirmed a negative approach vis-à-vis judicial bodies of international organizations created by an agreement concluded between Member States and the EU.<sup>82</sup> In fact, a reference from the Complaints Board of European Schools to interpret some principles of EU law was refused by the Great Chamber despite the fact that the Board was a 'tribunal' according to Article 267 TFEU and the well-established case law in that respect.<sup>83</sup> The Complaints Board does not fulfil the requirement of being a tribunal 'of a Member State'.<sup>84</sup> In the ECJ thinking, it is instead an international litigation body, located outside both the EU and domestic systems.<sup>85</sup> Unlike the Benelux Court, the Complaints Board is not a jurisdiction common to Member States and does not have any link with their judicial systems. The lack of this feature was largely emphasized in Opinion 1/09. National courts are conceived as the only instrument capable of ensuring that the EU law is applied uniformly throughout the Union. In the ECJ rationale, the fact that a judicial body holds an international status, being it distinct both from the EU and Member States' legal orders, seems a decisive negative trait, at least in the *European Schools* case.

Certainly, a final obiter dictum leaves the Contracting Parties of the European Schools Convention the chance to reform its system of judicial protection. On that basis, it could be argued that they could, if they would, ensure the possibility or indeed the obligation for the Complaints Board to make preliminary rulings in a given dispute, so that ultimately the EU law principles would be 'applied uniformly' and that the rights that seconded teachers derive from them would be 'effectively protected'.<sup>86</sup> However, that dictum should not be overestimated if compared to the ECJ negative approach with regard to the internationalization of national courts' responsibility. After all, Opinion 1/09 did not pay consideration for the preliminary ruling system provided for in Article 48 of the Council Draft Agreement. That being noted, it remains highly controversial whether an 'international' litigation body on patents would be consistent with primary law, given its huge impact on EU law, surely

<sup>80</sup> *Ibid.*, para. 89.

<sup>81</sup> *Ibid.*, para. 85.

<sup>82</sup> See judgment in C-196/09 of 14 Jun. 2011, not yet reported in the ECR.

<sup>83</sup> *Ibid.*, paras 37 and 38.

<sup>84</sup> *Ibid.*, para. 38; see, *inter alia*, judgment in C-54/96 of 17 Sep. 1997, *Dorsch* [1997] ECR I-4961, where the Court took an opportunity to spell out the criteria according to which the referring body is considered as having judicial character.

<sup>85</sup> That Board falls within the remit not of a Member State but of the European School Convention that is 'a *sui generis* system which achieves, by means of an international agreement, a form of cooperation between the Member States and between those States and the European Union, for the education together of the children of the staff of the European Communities in order to ensure the proper functioning of the European institutions' (para. 39).

<sup>86</sup> Judgment in C-196/09, para. 45.

wider than the one implied by the *European Schools* agreement. In a general perspective, the deletion by the ToL of Article 293 ECT does not necessarily entail that EU treaties do not allow anymore for the conclusions of *inter se* agreements provided that they are compatible with the treaties.<sup>87</sup> Naturally, the same compatibility test applies as far as *inter se* obligations stemming from mixed multilateral agreements are concerned.<sup>88</sup> Opinion 1/09 confirms this approach. However, it implies additionally that no risk of undermining or fragmenting the judicial system of the EU can be acceptable when concluding obligations among Member States.

In any case, it must be stressed that, as long as an international agreement, concluded only between Member States, includes rules on jurisdiction, recognition of judgments, and remedies, it would no doubt affect some portions of EU law currently in force, notably, for example, the Brussels I Regulation, the Lugano Convention, and other secondary law acts.<sup>89</sup> Member States no longer have the right of acting or intervening collectively or to enter into international obligations that may affect or alter the common provisions laid down by the EU.<sup>90</sup> As a result, a prior ‘de-harmonization process’ – that is, the ruling out or revision of the *acquis* – would be needed for avoiding clashes by the international agreement with the relevant *acquis*. In addition, that agreement could not be subject to a preliminary opinion to the ECJ pursuant to Article 218(11) TFEU in order to clear at the outset its compatibility with the EU treaties. That entails a considerable legal risk – *quid iuris* if the ECJ sooner or later will be referred as preliminary ruling proceedings, would it refuse the referral (as in the *European Schools* case) or even incidentally declare its incompatibility with the treaties?

#### 4.3 THE EU JUDGE WAY OUT

Finally, a third way out is, in principle, envisageable. An EU law-based judiciary, by making use of Article 262 TFEU, is certainly an option available for establishing a unified patent litigation system. As the ECJ stated in Opinion 1/09, that provision can be used to confer ‘on the Court some of the powers which it is proposed to grant to the Patent Court’. Yet, as the ECJ asserted, it ‘is not the only conceivable

<sup>87</sup> R. Baratta, ‘Sulle fonti delegate ed esecutive dell’Unione europea’, *Il Diritto dell’Unione europea* (2011): 295.

<sup>88</sup> As for multilateral mixed agreements, the ECJ acknowledged that they can set up *inter se* obligations, without, however, affecting Union law: see judgment in C-459/03, *Commission v. Ireland (Max Plant)* [2006] ECR I-4635, paras 84–86.

<sup>89</sup> For instance, some rules of Directive 2004/48/EC of the EP and of the Council of 24 Apr. 2004 on the enforcement of intellectual property rights (OJ L 157 of 30 Apr. 2004, 45) could be affected.

<sup>90</sup> See Art. 3(2) TFEU and judgment of 31 Mar. 1971, Case 22/70, *AETR*, ECR 263.

way of creating a unified patent court'.<sup>91</sup> In its thinking, Article 262 TFEU is just an 'option' for it 'does not establish a monopoly for the Court' as regards to individual disputes in the field of intellectual property rights.<sup>92</sup> Nevertheless, this facultative legal basis would undoubtedly be safer in terms of compatibility with the treaties, when envisaging a litigation body for patents. It could be even used in an innovative way, for instance, by creating a partly decentralized system of regional/local divisions located throughout the territories of Member States. Admittedly, its decision-making process would require unanimity in the Council, as well as the approval by Member States in accordance with their respective constitutional requirements, with all the related implications.

## 5 CONCLUSIONS

Opinion 1/09 is likely one of the most interesting contributions the Court has given to the constitutional building of the EU – an atypical construction equipped of an undeniable degree of special characteristics, constantly built by virtue of its jurisprudence. This holds true in particular as to the understanding of the relationship between the ECJ and the national judges. The Opinion represents a revealing precedent for appreciating how tight the links between these two layers of the EU system of judicial protection have become. Certainly, in its long-standing jurisprudence, the ECJ had already held that the preliminary ruling procedure is crucial for the preservation of the common character of the law established by the treaties, its object being to ensure uniformity throughout the Union.<sup>93</sup> Yet, in Opinion 1/09, the Court makes a step forward. The preliminary ruling mechanism becomes essential for the *protection of individual rights conferred upon them by EU law*. The complementary roles of the two judicial 'actors', the ECJ and domestic judges, must be preserved by institutions and Member States. For the ECJ ensures the autonomy of the common legal order and the uniformity of its rules, while the national judges, along with their daily activities, contribute to the same objectives in a way that cannot be replaced by international organs located outside the EU legal order. Domestic judges seem then to hold a basic function, which cannot be escaped from or avoided surreptitiously. A fundamental feature of the supranational order, as designed by the founding treaties, would be irremediably altered instead. It seems even reasonable to assume that by linking that procedure with its own jurisdiction pursuant to Article 19(1) TEU, the ECJ makes it clear that that form of synergy, which entails a division of duties with national

<sup>91</sup> Opinion 1/09, *supra*, para. 61.

<sup>92</sup> *Ibid.*, para. 62.

<sup>93</sup> See, in particular, judgment in Case 166/73, *Rheinmülen* [1974] ECR 33, para. 2.

courts in the interest of the proper and uniform application of the EU law, could hardly be waived by virtue of a treaty revision.

As regards the judicial relationship with domestic courts, it looks as if the ECJ continues to maintain a non-dualistic attitude. Notwithstanding, dualism provides a convenient methodology, and perhaps an even more fascinating conceptual framework than monism, for addressing the relations between national and EU judges. It seems as if by choosing implicitly a monistic approach, the ECJ derives the most suitable conceptual perspective for explaining the ‘common’ engagement they must use to protect the individual rights stemming from the EU legal order. The ECJ gives the sensation that national courts may be viewed as playing a key role. At that conceptual level of analysis, there is no clear dichotomy between national courts and the EU judges. Indeed, the monistic approach seems more pertinent, in the ECJ thinking, to promote an in-depth and irreplaceable coordination between domestic and preliminary ruling proceedings. That theoretical framework can even imply a hierarchical configuration towards national judges, a sort of vertical control on them, though the legitimacy of their activity stems from internal law. By adopting an autonomous definition of the ‘national tribunal’ notion,<sup>94</sup> so that the triggering of preliminary ruling proceedings does not depend on the national law,<sup>95</sup> the ECJ has often used an approach whereby EU and Member States’ legal orders are integrated in a unique system of law. Consequently, there is no external filter when its relationship with the national judges is at stake. The complementary element, built in Opinion 1/09, to protect their role of ‘ordinary courts of EU law’<sup>96</sup> from being divested of their preliminary ruling competences shows that they are, in the judicial system, an irreplaceable element of the constitutional building of the Union.

<sup>94</sup> See judgment in Case 61/65, *Vaassen, née Goebbels* [1966] ECR 408, as well as the case law that followed in its wake: judgment in C-516/99, *Walter Schmid* [2002] ECR I-4573, para. 34 ff. See also judgment in Case 14/86, *Pretore di Salò v. X* [1987], ECR 2545; judgment in C-178/99, *Salzmann* [2001] ECR I-4421; judgment in C-17/00, *De Coster* [2001], ECR I-9945, para. 9 ff. and the Opinion of AG Jarabo Colomer, who had hinted at a different reading of the definition of ‘national jurisdiction’ mentioned in former Art. 234 EC (para. 58 ff.); judgment in C-205/08, *Umweltanwalt von Kärnten and Alpe Dria Energia Spa* [2009] ECR I-11525, paras 34–39; Order in C-210/06, *Cartesio* [2008] ECR I-9641, para. 5 ff.

<sup>95</sup> As observed (K. Lenaerts, ‘The Unity of European Law and the Overload of the ECJ – The System of Preliminary Rulings Revisited’, in *The Future of the European Judicial System in a Comparative Perspective*, eds I. Pernice, J. Kokott & C. Saunders (Baden-Baden: Nomos, 2006), 211 et seq., 229), the Court has also used in a rather extensive way this case law, with the effect of considering ‘national courts’ even bodies that were not considered as such in national law (see, for instance, judgment in C-54/95, *Dorsch Consult* [1997] ECR I-4961) and with the final deliberate consequence of widening the scope of the preliminary ruling procedure.

<sup>96</sup> Opinion 1/09, para. 80.

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