2008

The EC Council Regulation on Evidences and the "description" of goods infringing IP rights

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The European Legal Forum
Forum iuris communis Europae

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The European Legal Forum (E) 2-2008, 80 - 90

The EC Council Regulation on evidence and the "description" of goods infringing IP rights*

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1. The case and the questions referred to the European Court of Justice in the Case C-175/06

Article 128 of the Italian Code of Intellectual Property (hereafter: CPI) is entitled "description" and stipulates that "1. The owner of an industrial property right may request to order the description of any objects infringing his right, as well as of the means used in the production of such objects and of the items of evidence concerning the reported infringement and its entity. / 2. The petition is filed with the President of the specialised section of the court competent for ruling on the merits pursuant to Article 120. / 3. The President of the specialised section issues a summons for a hearing and sets the final date for notification of the summons. / 4. After having heard the parties and admitted summary information, if necessary, the same court decides by non-appealable order and, if provided by the description, indicates the necessary measures to be adopted so as to ensure the protection of confidential information and may authorize the seizure of samples of the objects mentioned in paragraph 1. / When the summons of the counterpart might prejudice the implementation of the decision, it decides on the request by a reasoned judgment, derogating the provisions of paragraph 3. / 5. The judgment of acceptance, in cases where the request was filed before the case on the merit has been initiated, has to set a final time limit not exceeding 30 days for initiating the trial on the merits". This Article was codified as a result of the adoption of the Community Enforcement Directive to which reference will be made later on in this study. Also other Community States have adopted norms analogous to Art. 128 CPI and the "description" is currently also foreseen *ia* in Art. 297.2 of the Spanish Law on Civil Procedure *(de Enjuiciamiento civil)* 1/2000 and in Section 7 of the Civil Procedure Act of 1997 of the United Kingdom "in conjunction with the provision of Rule 25.1(1)(h)", which "codify the known legal institute as Anton Piller Order" and is suitable for allowing a "search order". At the beginning of October 2006 some States had not yet implemented the Enforcement Directive. Therefore, the European Commission decided on 12.10.2006 "to formally ask 12 Member States to implement Directive 2004/48/EC on the enforcement of intellectual and industrial property. The Commission's requests took the form of reasoned opinions to be sent to Belgium, France, Germany, Greece, Latvia, Luxembourg, Malta, the Netherlands, Poland, Portugal, Slovakia and Sweden" (*sic European Community Press Releases*, at <http://europa.eu/rapid/pressReleasesAction.do?reference=IP/06/1354&format=HTML&aged=0>, 12.10.2006).

Afterwards other Community States have therefore adopted norms analogous to Art. 128 CPI. Hence, the "description" is currently also foreseen *ia* in Art. 615.5 of the French Code of Intellectual Property [1].

In 2005 an Italian company lodged a request for ruling *ante causam* with the IP section of the Court of Genoa regarding the "description" of the goods pursuant to Art. 128 of the CPI against an English company and its Italian distributor. In particular, the plaintiff alleged to be the owner of an Italian patent application for an industrial invention; he claimed that the English company produced the goods in dispute in England and sent them from there to the Italian distributor, who resold them on the national market; he qualified the activity of the two companies as infringement of his patent; besides, he requested a "description" of goods according to Art. 128 CPI, and sought its performance in Italy *ex* Art. 128 CPI and addressed a request for judicial assistance to the competent body in the United Kingdom, with a view to the latter taking evidence in respect of evidential material situated in the United Kingdom according to said rule as well as Council Regulation (EC) No. 1206/2001 of 28 May 2001 on the cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters.[2] He demanded in par-

* Italian law provides for an effective method for preserving and obtaining evidence to prove intellectual property right infringements. On an application by the holder of the right, the competent court may order – even before proceedings in the main claim are brought and on an ex parte basis – that a 'description' (descrizione) be obtained of the object giving rise to the alleged infringement.

The opinion of the Advocate General of 18 July 2007 in – C-175/06 – *Tedesco* was published in [2008] EuLF I-42.

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1 On Art. 128 CPI, see in particular *Angelicchio*, *sub* "Art. 128 cpi", in *Ubertazzi* (Ed.), Commentario breve alle leggi su proprietà intellettuale e concorrenza, 627 (4th ed., Padua 2007) and there for the necessary references. On the description in general see also point 50 of the conclusions of Advocate General Kokott on which see footnote 7); *Ibbeken*, "Das TRIPS-Übereinkommen und die vorgerichtliche Beweishilfe im gewerblichen Rechtsschutz", 109 (Cologne 2004); *Szychowska*, "Taking of evidence in intellectual property matters under regulations 44/2001 and 1206/2001", in *I.R.D.I.* (Intellectuele rechten, Droits intellectuels), 116 (2006); *Nuyts*, "Le règlement communautaire sur l'obtention des preuves: un instrument exclusif?", in *RCDIP*, 76 (2007); *Vander*, *sub* "Art. 50 TRIPS", in *Busche* and *Stoll* (Eds.), *TRIPS.* Internationales und europäisches Recht des geistigen Eigentums, 653 (Cologne 2007); *Heinze*, Einstweiliger Rechtsschutz im europäischen Immaterialgüterrecht, 653 note 12 (Tübingen 2008); *Bodewits*, "Dutch enforcement legislation may be used in order to obtain evidence for foreign legal proceedings", in Journ. Int. Prop. L. Rev., 85 (2008).

2 On the Regulation in general, *see* "UE: regolamento n. 1206/2001 sull'assunzione delle prove all'estero in ambito comunitario", in *Consolo* and *De Cristofaro*, Il diritto processuale civile visto da Int'l Lis dal 2002 ad oggi, 3 (2006); *Gioia*, "Cooperazione fra autorità giudiziarie degli Stati CE nell'assunzione delle prove in materia civile e commerciale", NLCC, 1159 (2001); *Hess* and *Müller*, "Die Verordnung 1206/01/EG zur Beweisaufnahme im Ausland", in Zeischrift für Zivilprozess international 2001, 151; *Fumagalli*, "La nuova disciplina comunitaria dell'assunzione delle prove all'estero in materia civile e commerciale", in *Riv.* Dir. int. priv. proc., 327 (2002); *Borghesi*, "Convenzione dell'Aja (1970) e regolamento CE n. 1206/2001 sull'assunzione delle prove all'estero in materia civile e commerciale", in *Ferrari* (Ed.), Le convenzioni di diritto del commercio internazionale, 335 (2nd ed., Milan, 2002); *Trocker*, "Note sul regolamento n. 1206/2001 relativo all'assunzione delle prove in materia civile e commerciale", RD Int., 670 (2003); *Frigo* and *Fumagalli*, "L'assistenza giudiziale internazionale in materia civile", 159 (Padua 2003); *Bonatti*, "Sovranità nazionale e leggi processuali nell'armonizzazione del diritto delle prove in Europa", *RTDPC*, 211 (2004); *Müller*, Grenzüberschreitende Beweisaufnahme im Europäischen Justizraum, 109 (Tübingen 2004); *Biavati*, "Problemi aperti in materia di assunzione delle prove civili in Europa", *ibid.,* 425 (2005); *Sandrini*, "L'assunzione delle prove all'estero. Dalla convenzione dell'Aja del 1970 al regolamento CE

ticular that the description in the United Kingdom should extend to the counterfeited products and to further "items of evidence such as, for example but not exclusively, invoices for purchase and sale, delivery notes, orders, letters of commercial offers, advertising and promotional material, data recorded in the computerized archives, clearance documents".[3]

The President of the IP Section of the Court of Genoa admitted the petition, ordered the description in Italy and requested the British court to proceed with the description on its own territory. The reply from the Senior Master of the Queen's Bench Division of the Supreme Court of England and Wales, however, was negative, "a short note, without signature",[4] to the effect that "this is not a matter which we consider should fall to be dealt with by this office under the Letter of Request procedure",[5] granting that "we deal with questioning of witnesses whereas this particular matter calls for search and seizure of goods and documents, which seems to me to fall outside the usual practice".[6] Then, by Order of 14 March 2006, the President of the IP section of the Court of Genoa referred the following questions to the Court of Justice of the European Communities, requesting a preliminary ruling on the interpretation of Council Regulation (EC) No. 1206/2001:

"1. Is a request for obtaining a description of goods under Articles 128 and 130 of the Italian Code of Industrial and Intellectual Property, in accordance with the formal terms of the order made by this court in the present case, one of the forms of the taking of evidence prescribed by Council Regulation (EC) No 1206/2001 of 28 May 2001 (on cooperation between the courts of the Member States in the taking of evidence in civil and commercial matters) by which the courts of one Member State may, on the basis of that regulation, request that the competent court of another Member State should itself take that evidence?"; and

"2. If the answer to question 1 is yes and the request for obtaining a description is incomplete or fails to comply with the conditions under Article 4 of the regulation, is the court to which the request is made under an obligation to: / send an acknowledgment of receipt in accordance with the conditions laid down by Article 7 of the regulation; / indicate any respect in which the request may be incomplete so as to enable the requesting court to complete and/or amend its request?"

On 18 July 2007 Advocate General Kokott presented her own conclusions in the proceedings C-175/06 before the Court of Justice.[7] Nevertheless, the private parties to the judgment *a quo* had reached *medio tempore* a settlement of their dispute. Then, by Order of 26 March 2007 the President of the IP section declared that there was no need to adjudicate the case *a quo*, and thus, by Order of 27 September 2007, the Court of Justice considered "the questions referred for a preliminary ruling had become devoid of purpose" and ordered that the case be removed from its register.[8]

The above-mentioned national judgment and the Community judgment have nevertheless raised some questions which remain of interest even beyond the concrete case which has been closed by now. These questions are the subject of the present article.

The questions referred for preliminary ruling by the Court of Genoa concern Council Regulation (EC) No. 1206/2001, which was enacted on the basis of Art. 65 Treaty on the EU (hereafter: TEU), according to which "Measures in the field of judicial cooperation in civil matters having cross-border implications, to be taken in accordance with Article 67 and in so far as necessary for the proper functioning of the internal market, shall include: [...] / (b) promoting the compatibility of the rules applicable in the Member States concerning the conflict of laws and of jurisdiction".[9] In relation with the acts

1206/2001", in *Ambrosi* and *Scarano* (Eds.), Diritto civile comunitario e cooperazione giudiziaria civile, 215 (Milan 2005); *Perry*, "Cross Jurisdictional Requests for Evidence: United States, England, European Union", in Defense Counsel Journal, 24 (2005); *Herrera*, "La obtención internacional de pruebas. Asistencia jurisdiccional en Europa", 165 (Publicaciones del Real Colegio de España, Bologna 2005); *Esteban de la Rosa*, "La realización de pruebas en el espacio europeo de justicia: a propósito del reglamento 1206/2001 y su compatibilidad con el reglamento 44/2001", in Anuario español de Derecho internacional privado, 309 (2006); *Betetto*, "Introduction and practical cases on Council Regulation (EC) No. 1206/2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters", in [2006] EuLF I-137; *Nuyts*, *cit.,* at 53; *Franzina*, "La cooperazione fra gli Stati membri della Comunità europea nel settore della assunzione delle prove in materia civile e commerciale", ready to be Publisher in *Bonomi*, EC Regulation on Private International Law. On the relevance of the Regulation for intellectual property, *cf. Szychowska*, *cit.,* at 111.

3 *Sic* the Order on the Reference for a preliminary ruling from the Court of Genoa, which is (as yet) unpublished, but has been transmitted to me by kind courtesy of a counsel for the defence.

4 *Ibid*.

5 *Ibid*.

6 *Ibid*.

7 Opinion of Advocate General Kokott 18 July 2007 – Case C-175/06 – *Alessandro Tedesco v Tomasoni Fittings Srl and RWO Marine Equipment Ltd.* [2007] ECR I-7929.

8 *See* that order at <http://curia.europa.eu/index/htm>.

9 On Art. 65 TEU and on the Community international private law, *cf. Pocar*, "La comunitarizzazione del diritto internazionale privato: una 'European Conflict of Laws Revolution'?", in Riv. Dir. int. priv. proc., 873 (2000); *Jayme* and *Kohler*, "Europäisches Kollisionsrecht 1999 – die Abendstunde der Staatsverträge", in IPRax, 401 (1999); *Moura Ramos*, "Un diritto internazionale privato della Comunità Europea: origine, sviluppo, alcuni principi fondamentali", in Divenire sociale e adeguamento del diritto. Studi in onore di *Francesco Capotorti*, II, 273 (Milan 1999); *Basedow*, "The Communitarization of the Conflict of Laws under the Treaty of Amsterdam", in *C.M.L.Rev.* 706 (2000); *Boele–Woelki*, "Unification and Harmonization of Private International Law in Europe", in *Basedow* et al (Eds.), Private law in the international Arena: from national conflict rules towards harmonization and unification, 61, (Liber amicorum *Kurt Siehr*, The Hague 2000); *Jayme* and *Kohler*, "Europäisches Kollisionsrecht 2000: Interlokales Privatrecht oder universelles Gemeinschaftsrecht", in IPRax, 454 (2000); *Id*., "Europäisches Kollisionsrecht 2001: Anerkennungsprinzip statt IPR", in IPRax, 501 (2001); *Remien*, "European Private International Law, the European Community and its Emerging Area of Freedom, Security and Justice", in C.M.L. Rev. 76 (2001); *Jayme* and *Kohler*, "Europäisches Kollisionsrecht 2002: Zur Wiederkehr des Internationalen Privatrechts", in IPRax, 461 (2002); *Bariatti*, "Prime considerazioni sugli effetti dei principi generali e delle norme materiali del Trattato CE sul diritto internazionale privato comunitario", in Riv. Dir. int. priv. proc., 694 (2003); *Jayme* and *Kohler*, "Europäisches Kollisionsrecht 2003: Der Verfassungskonvent und das Internationale Privat – und Verfahrensrecht", in IPRax, 485 (2003); *Picone*, "Diritto internazionale privato comunitario e pluralità dei metodi di coordinamento tra ordinamenti", in *Picone* (Ed.), Diritto internazionale privato e diritto comunitario, 485 (Padua 2004); *Jayme* and *Kohler*, "Europäisches Kollisionsrecht 2004: Territoriale Erweiterung und methodische Rückgriffe", in IPRax, 481 (2004); *Rossi*, "L'incidenza dei principi del diritto comunitario sul diritto internazionale privato: dalla 'comunitarizzazione' alla 'costituzionalizzazione'," in Riv. Dir. int. priv. proc., 63 (2004); *Pataut*, "De Bruxelles à La Haye. Droit international privé communautaire et droit international privé conventionnel", in Mélanges en l'honneur de *Paul Lagarde*, Le droit international privé: esprit et méthodes, 661 (Paris 2005); *Jayme* and *Kohler*, "Europäisches Kollision-

adopted *ex* Art. 65 TEU, Art. 68 of this treaty only allows access to preliminary rulings on questions regarding an interpretation by the European Court of Justice to courts of last resort.[10] Hence the question arose as to whether the Court of Genoa could be qualified as court of last resort according to Art. 68 TEU and thus whether its request for a preliminary ruling regarding an interpretation was admissible. Advocate General Kokott has rightly answered this question in the affirmative for two reasons. The first one points out that the preliminary referral "aims at guaranteeing a uniform interpretation and application of Community law" and therefore has to be supported; the Regulation on evidence concerned "the establishment of facts", and thus an activity typically within the competence of lower courts; in order to allow a uniform interpretation and application of Regulation (EC) No. 1206/2001 "the notion of court of last resort pursuant to Art. 68(1) TEU must not be interpreted in an excessively restrictive sense".[11] The second argument states that "the qualification of a court as that of last resort" *ex* Art. 68 TEU "depends on a real rating; […] also the courts of lower level whose judgments in real proceedings are not appealable, are courts of last resort"; the "proceeding of precautionary taking items of evidence by means of description" is of "special" nature and terminates "by non-appealable order";[12] thus the Court of Genoa appears as court of last resort *ex* Art. 68 TEU.

The present study analyses only the first question referred to the ECJ for a preliminary ruling, and does not dwell upon the second question lodged by the Court of Genoa with the European Court of Justice. In fact, the first question raises a few important theoretical problems which deserve being highlighted in this article and studied in more detail. The second question, however, concerns subjects of absolutely minor importance which substantially arise in the context of minute technicalities for implementing the rules, and therefore are not worthy of any particular analysis. This however does not mean that in the case *sub iudice* before the Court of Genoa and referred to the Court of Justice the second question was substantially "theoretical"[13] and irrelevant: "on the one hand […] it is inferred from the file that the requested court has indeed acknowledged the receipt of the request within the set time limit; there are no elements to believe that the requested court would not acknowledge the receipt of a new request. Besides, the original request does not appear to have been incomplete, nor was any possible later request (…)".[14]

2. The Communitarian and autonomous character of the concept of relevant evidence according to Council Regulation (EC) No. 1206/2001

According to Art. 1 of the above mentioned Regulation, the request to take evidence has to be addressed to the court of the requested State "in accordance with the provisions of law" of the requesting State (Art. 1). At first sight this principle might suggest that the category of evidence according to Regulation (EC) No. 1206/2001 has to be reconstructed in the light of the substantial law of the forum of the requesting court.[15] In real-

srecht 2005: Hegemonialgesten auf dem Weg zu einer Gesamtvereinheitlichung", in IPRax, 481 (2005); *Pocar*, "La codification européenne du droit international privé: vers l'adoption de règles rigides ou flexibles vers les États tiers?", in Mélanges en l'honneur de *Paul Lagarde*, *cit.*, at 697; *Elvira Benayas*, "El reparto de competencias entre la Unión europea y los Estados en materia de Derecho internacional privado. Drama en tres actos", in Pacis Arte. Obra homenaje al *profesor Julio D. González Campos*, Tomo II, Derecho internacional privado, Derecho Constitucional y varia, 1453 (Madrid 2005); *Kreuzer*, "Typen Europäischer Kollisionsnormen", *ibid.*, at 1663; *Virgós Soriano* and *Garcimartín Alférez*, "Estado de origen vs. Estado de destino: las diferentes lógicas del Derecho internacional privado", *ibid.*, at 1787; *Ballarino* and *Mari*, "Uniformità e riconoscimento. Vecchi problemi e nuove tendenze della cooperazione giudiziaria nella Comunità europea", in RD Int., 7 (2006); *Munari*, "La ricostruzione dei principi internazionalprivatistici impliciti nel sistema comunitario", in Riv. Dir. int. priv. proc., 913 (2006). *See* the new text of Art. 65 TEU, as partly redrafted by the Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon on 13 December 2007, in *EC Official Journal* No. C 306 of 17 December 2007, 62.

10 The limitation set by Art. 68 TEU has been criticised by the prevailing opinion. *Cf. Ballarino*, "La unificación de las reglas sobre la ley aplicable a las obligaciones contractuales. La transformación en regolamento del convenio de Roma", in Anuario español de derecho internacional privado, 336 (2006); *Pocar*, "Cooperazione civile, la Corte Ue cerca spazi", in *Il Sole-24 ore* of 16 May 2007, 39, according to which "it is desirable not to delay any further the assignment of competence also to jurisdictions other than courts of last resort to file a reference for a preliminary ruling with the European Court of Justice in matters relating to the field of freedom, security and justice. A step in this direction is essential for strengthening jurisdictional protection in particular sensitive sectors in terms of fundamental rights and in the context of judicial cooperation in civil matters". Finally, Art. 68 has been repealed by the Lisbon Treaty mentioned in the previous note.

11 *Sic* points 21-23 of the conclusions of Advocate General Kokott.

12 *Sic* points 21, 27 and 28 of the conclusions of Advocate General Kokott.

13 *Sic* point 34 of the conclusions of Advocate General Kokott.

14 *Ibid.*

15 Italian doctrine distinguishes between substancial norms on legal evidences, which determine the concrete admissibility of an evidence for a specific act (for instance the admissibility of the testimonial evidence in relation to contracts) and the procedural norms on evidences, which establish the abstract admissibility of an evidence for all the juridical acts in a certain historical time (for instance the admissibility of the evidence constituted by oath in general). The formers are regulated by the lex substantiae actus, while the latters are governed by the lex fori. *Vid. Morviducci*, "La legge competente a regolare l'ammissibilità dei mezzi di prova nel d.i.pr.", in RDIPP 1977, 733. This distinction is made also by the Rome Convention on the law applicable to contracts of 6.19.1980 and by the future Rome I regulation. On this point please see *Ubertazzi*, "Il regolamento Roma I", ready to be published in *Bonomi*, I regolamenti cit., passim. On the distinction between "matters of procedure" and "matters of substance" in international private law in general see also *Panagopoulos*, "Substance and Procedure in Private International Law", in JPIL 2005, 69. Su questo regolamento in particolare *cfr. Bonomi*, "Conversion of the Rome Convention on Contracts into an EC Instrument: some Remarks on the Green Paper of the EC Commission", in *YPIL* 2003, p. 53; *Max Planck Institute for Foreign Private and Private International Law*, "Comments on the European Commission's Green Paper on the conversion of the Rome Convention of 1980 on the law applicable to contractual obligations into a Community instrument and its modernization", in RabelsZ 2004, 1; *Boschiero*, "Verso il rinnovamento e la trasformazione della convenzione di Roma: problemi generali", in *Picone* (a cura di), Diritto internazionale privato cit., pp. 319–420; *Carrillo Pozo*, "Ante la revisión del art.4 del Convenio de Roma sobre la ley aplicable a las obligaciones contractuales", in Homenaje a *Julio D. González Campos cit.*, pp. 1375–1394; *Vareilles–Sommières*, "La communautarisation du droit international privé des contrats: remarques en marge de l'uniformisation européenne du droit des contrats", in Mélanges *Paul Lagarde cit.,* pp. 781–801; *Franzina* (a cura di), La legge applicabile ai contratti nella proposta di regolamento "Roma I", Padova, 2006; *Lopes Pegna*, "Il rilievo del collegamento più stretto dalla convenzione di Roma alla proposta di regolamento "Roma I"", in RDI 2006, p. 756; *Mankowski*, "Der Vorschlag für die Rom I-Verordnung", in IPRax 2006, p. 101; *Lagarde*, "Remarques sur la proposition de règlement de la Commission européenne sur la loi applicable aux obligations contractuelles (Rome I)", in RCDIP 2006, p. 331; *Max Planck Institute for Foreign Private and Private International Law*, "Comments on the European Commission's proposal for a regulation of the European Parliament and the Council on the law applicable to contractual obligations (Rome I)", in *http://www.ivir.nl/publications/eechoud/Clip_Rome_I_Comment.pdf*; *European Max Planck Group for Conflict of Laws in Intellectual Property*, "Comments on the European Com-

ity, however, the unanimous opinion holds that Art. 1 designates the *lex fori* of the requesting court as the one competent to establish conditions, methods and time limits for requesting a foreign authority to take evidence, but not for defining the concept of relevant evidence according to Regulation (EC) No. 1206/2001.[16] The latter, however, does not indicate expressly how the category of the evidence according to the Regulation should be defined.[17] At this point it is thus necessary to proceed with this qualification. For this purpose one should bear preliminarily in mind that there are two main methods for the qualification of Community categories of international private law and private procedural law.

A first method of qualification is the so called "conflictual" method, which provides that the categories of conflicting Community rules have to be qualified in the light of the substantial law of a single State, namely the one that rules the case according to the international private law of the forum. Thus for instance the concept of place of performance of the obligation in question *ex* Art. 5.1 (a) of Council Regulation (EC) No. 44/2001[18] is interpreted according to the *lex contractus* determined by the international private law of the forum.

A second method of qualifying conflicting Community rules is the "autonomous" or "comparative" one, which provides that the categories of international private law of Community acts have to be qualified not on the basis of the law of one State, but "referring, on the one hand, to the objectives and to the system of the treaty"[19] or the single act in question[20] "and, on the other hand, to the general principles deriving from the totality of legal systems of the Member States".[21] In some cases the Community rule clearly indicates that it intends to define itself the concept of category in international private law on a case by case basis, and at the same time it establishes the outlines in an accomplished way: e.g. Art. 60 of Regulation (EC) No. 44/2001 explicitly defines the concept of relevant domicile *ex* Art. 2 of said Regulation. In other cases, however, the Community rule intends to define itself the category of international private law in question; however, it does not explicitly give the necessary elements for its qualification; in such cases its outlines have to be identified by means of a comparative survey which allows, inter alia, to guarantee the useful effect of Community law by including the various institutes of substantial law which are part of it in the respective category as common denominator according to the major part of compared disciplines; the comparison has to be made among the main national systems of the Member States or, as the case may be, among the various substantial rules provided by the act containing the category to be qualified, or again among the various substantial rules established by Community or non-Community acts susceptible of systematic interpretation. Thus, for instance, the fact that Art.1of the Rome I Regulation ready to be adopted[22] establishes that it applies to contractual obligations "in civil and commercial matters", doesn't characterize expressly the category of civil and commercial matters. It nevertheless wants to characterize it autonomously and imposes therefore a confrontation with the other analogous category used by other EC legal acts, such as Regulation 44/2001 and also wants to maintain it comprehensive for instance of every contractual relationship which arose with the public administration in so much as the latter acts iure privatorum.[23]

In this framework a first opinion retains that the Community concept of evidence as in Regulation (EC) No. 1206/2001 has to be qualified according to the conflicting method, namely on the sole basis of the *lex fori* of the requesting court. This opinion quotes Art. 14.1 (b) of the Community Regulation on evidence, according to which "a request for the hearing of a person shall not be executed when the person concerned claims the right to refuse to give evidence or to be prohibited from giving evidence, [...] under the law of the Member State of the requesting court"; it holds that Art. 14 refers to the *lex fori* of the requesting State as *lex causae* for establishing when the requested court may not take evidence; it retains that the reference to the *lex fori* made in Art. 14 has to be extended to any other rule of Regulation (EC) No. 1206/2001; and it concludes that its category of evidence has to be quailfied by the *lex fori* of the requesting State.[24]

This first opinion, however, is not convincing. In fact Art. 14.1 (b) of Regulation (EC) No. 1206/2001 refers to the lex fori of the requesting State only in the particular case of hearing of witnesses, so as to allow the court of the requested State

mission's proposal for a regulation of the European Parliament and the Council on the law applicable to contractual obligations (Rome I)", in IIC 2006, p. 471; *Ballarino*, "La unificación de las reglas sobre la ley aplicable a las obligaciones contractuales. La transformación en regolamento del convenio de Roma", in Anuario español de derecho internacional privado 2006, p. 331; AA.VV., Nuovo diritto europeo dei contratti: dalla convenzione di Roma al regolamento, Milano, *passim*; *Pocar*, "Roma I", in corso di pubblicazione in il Sole-24 Ore ; *Clip*, "Intellectual Property and the Reform of Private International Law – Sparks from a Difficult Relationship", in IPRax 2007, p. 288. V. infine in http://www.drt.ucl.ac.be/gedip gli studi del gruppo europeo di diritto internazionale privato (GEDIP) V. tutte le fasi di elaborazione del futuro regolamenti in http://www.europarl.europa.eu/oeil/file.jsp?id=5301232.

16 *See* EU Regulation, *cit.*; and *see also* all the doctrine indicated in the present study.

17 *See for all Commission Services in consultation with the European Judicial Network in Civil and Commercial Matters*, "Practice Guide for the Application of the Regulation on the Taking of Evidence", which bears no date of issue and is available at <*http://ec.europa.eu/civiljustice/evidence/evidence_ec_guide_en.pdf*>, Article 8.

18 To be precise: Council Regulation (EC) No. 44/2001 of 22.12.2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, in *EC Official Journal* No. L 12 of 16. 1. 2001, 1.

19 *Sic for all* ECJ 14 October 1976 – 29/76 – *LTU v. Eurocontrol* [1976] ECR 1541, first headnote. As to doctrine, *see Mari*, Il diritto processuale civile della convenzione di Bruxelles I. Il sistema della competenza, 47 (Padova 1999); *Ballarino*, Manuale di diritto dell'Unione europea, 209-219 (6th ed., Padova); *Salerno*, "I criteri di giurisdizione comunitari in materia matrimoniale", in Riv. Dir. int. priv. proc., 63 (2007).

20 *Cf.* point 42 of the conclusions of Advocate General Kokott.

21 *Sic* ECJ, *LTU v. Eurocontrol* (*supra* note 19), *cit.*, first headnote.

22 See the Rome I regulation already quoted.

23 See ECJ 16 December 1980 – 814/79 – *Rüffer* [1980] ECR 3807, point 14.

24 According to this thesis, "one of the main contrasts between common law and civil law jurisdictions is that the latter normally do not permit oral witness evidence at trial. This raises the interesting issue of whether, under the EC Regulation, parties can obtain oral evidence from common law jurisdictions, such as the United Kingdom, for use in civil jurisdiction proceedings. The Regulation does not deal specifically with this point. However, Article 14.1 (b) gives the deponent the right to refuse to give, or to claim to be prohibited from giving, evidence 'under the law of the member state of the requesting court' that is, the court where proceedings are taking place. Hence a witness in England can refuse to give evidence for proceedings in a jurisdiction where, if the witness were in that jurisdiction, the witness could not be compelled to give that evidence". *Sic Perry*, *cit.*, at 28-29.

to refuse the taking of evidence. Nevertheless, Art. 14 is of an exceptional nature, as it appears ia from Recital 11 of Regulation (EC) No. 1206/2001, according to which "to secure the effectiveness of this Regulation, the possibility of refusing to execute the request for the performance of taking evidence should be confined to strictly limited exceptional situations"; exceptional standards cannot be applied analogously; by corollary, Art. 14.1 (b) concerns only the hearing of witnesses and cannot be extended to the whole category of relevant evidence according to Regulation (EC) No.1206/2001.

The absolutely prevailing thesis therefore retains that this category has to be reconstructed autonomously. This opinion is supported by various arguments. Above all, "the objective pursued by the Treaty of Amsterdam of creating an area of freedom, security and justice, thereby giving the Community a new dimension, and the transfer from the EU Treaty to the EC Treaty of the body of rules enabling measures in the field of judicial cooperation in civil matters having cross-border implications to be adopted testify to the will of the Member States to establish such measures firmly in the Community legal order and thus to lay down the principle that they are to be interpreted autonomously."[25] Secondly, Community law cannot entrust the definition of its scope to a *lex causae* identified by the conflicting rules of a country, and thus refer them to individual Member States.[26] Thirdly, the Regulation is part of the system of Community international private law; the rules that constitute one and the same legal system "complement" each other and can be interpreted in a systematic way; the qualification by comparison allows then to qualify in a systematic and unitary way the meaning of the provisions of the Regulation and of those of the other acts of Community international private law.[27]

3. The autonomous concept of evidence and its extension to the description pursuant to Art. 128 of the Italian Industrial Property Code

At this point the question arises whether the autonomous concept of evidence of Regulation (EC) No. 1206/2001 comprises the description pursuant to Italian law as well. A first thesis[28] gives a negative reply: because the description (i) implies measures of requisition which are not included in the Regulation; (ii) can constitute a provision of pre-trial investigation[29] and according to the declaration adopted by the Council at the moment of passing the Regulation (EC) No. 1206/2001 "the pre-trial discovery, comprising exploratory investigations (so called 'fishing expeditions'), are excluded from the area of application of the present Regulation";[30] (iii) is subject to a different Community act, namely to Regulation (EC) No. 44/2001, and has to be requested by the court identified under Art. 31 of the latter Regulation. This first thesis, however, is not convincing.

Above all, the three arguments it has invoked are not convincing. (i) Not the first one because Advocate General Kokott has correctly observed that the autonomous concept of evidence introduced by Regulation (EC) No. 1206/2001 comprises any means of pre-trial investigation which guarantees its acquisition;[31] the description implies some measures of requisition which allow access to the evidence; and these are "linked inseparably with the taking of evidence".[32] (ii) Nor is the second argument convincing because a systematic interpretation has to be given to the declaration adopted by the Council and at the same time to Art. 1.2 of Regulation (EC) No. 1206/2001,[33] according to which "a request shall not be made to obtain evidence which is not intended for use in judicial proceedings"; this systematic interpretation suggests that the description is covered by Regulation (EC) No. 1206/2001 when it is not directed to "tracing out usable supporting material, which however on its own would not be suitable for evidence purposes inherent to the process (so called 'train of enquiry' – unlawful search of irrelevant supporting material)", but rather to obtaining "items of evidence […] determined at least with such a degree of precision as to show clearly their connection with the commenced or contemplated proceedings".[34] (iii) Finally, the third argument produced by the opinion criticized here is not convincing either because by its Judgment *St. Paul Dairy Industries* of 28 April 2005[35] the European Court of Justice has declared that Art. 24 of the Brussels Convention does not apply to measures of precau-

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25 *Sic* ECJ 8 November 2005 –C-443/03 – *Leffler* [2005] ECR I-9611 = [2005] EuLF I-212, first headnote, at <http://curia.europa.eu/index/htm>, at point 45. As to doctrine, *see Trocker*, *cit.*, at 676-678; *Bonatti*, *cit.*, at 216, note 17; *Biavati*, *cit.*, at 449; *Franzina*, La giurisdizione in materia contrattuale, 69 (Padova 2006); *Salerno*, I criteri, *cit.*, at 63.

26 *See for all* point 31 of the Judgment of the ECJ 7 December 2006 – C-306/05 – *SGAE v. Rafael Hoteles SA* [2006] ECR I-11519, at <http://curia.europa.eu/index/htm>, according to which "the need for uniform application of Community law and the principle of equality require that where provisions of Community law make no express reference to the law of the Member States for the purpose of determining their meaning and scope [...] they must normally be given an autonomous and uniform interpretation throughout the Community".

27 *See for all Baratta*, "The process of characterization of private international law in the European system", in YPIL, 155 (2004); *Bariatti*, "Qualificazione e interpretazione nel diritto internazionale privato comunitario: prime riflessioni", in Riv. Dir. int. priv. proc., 361 (2006).

28 *See* the opinions of the Hellenic, Irish and British Governments referred to in point 53 of the conclusions of Advocate General Kokott.

29 *See Macklin* and *Beach*, "Pre-trial discovery in Canadian intellectual property litigation", in Canadian Intellectual Property Review, 27 (2007).

30 *Sic* point 6 of the Declaration of the Council of 4 July 2001, 54/01, 10571, p. 16, PV/CONS 26 JAI 42.

31 *Sic* point 56 of the conclusions of Advocate General Kokott.

32 *Sic* point 56 of the conclusions of Advocate General Kokott.

33 In fact "according to established case law, a declaration inserted in the minutes of the Council may be taken into consideration for interpreting a normative act if its contents is confirmed by the text of said act and it is useful for specifying a general concept". *Sic* point 69 of the conclusions of Advocate General Kokott. *See* the judgments of the ECJ cited in note 31 of these conclusions.

34 *Sic* points 72 and 73 of the conclusions of Advocate General Kokott.

35 *See* ECJ 28 April 2005 – C-104/03 – *St Paul Dairy v Unibel* [2005] ECR I-3481 = [2005] EuLF I-71, II-65. On this judgment, *see* the note, untitled, by *Pataut*, in RCDIP 2005, 746 and *see also Esteban de la Rosa*, *cit.*, at 316; *Szychowska*, *cit.*, at 123; *Nuyts*, *cit.*, at 61; *Besso*, "L'assunzione preventiva Della prova sganciata dal periculum in mora non è – secondo la Corte europea di giustizia- un procedimento provvisorio o cautelare", in Int'l lis 2006; 80; *Di Fazzio*, "Istanza di istruzione preventiva ("esplorativa") olandese e foro competente europeo", in Riv. Dir. Proc. 2006, 785. Contra the ECJ decision see also the one of the District Court of Arnhem, The Netherlands, *Synthon B.V. v Astellas Pharma Inc*, 156096/kg ZA 07-304, 1 June 2007 according to which Art.31 of the EC regulation n. 44/2001 allows the granting of provisional measures to preserve evidence that are located even outside the country. On this decision see *Bodewits*, *cit.*, 84.

tionary taking of evidence and that the latter rather falls within the scope of Regulation (EC) No. 1206/2001; the description constitutes obviously a provision for precautionary taking of evidence; and therefore it is included in the concept of evidence of Regulation (EC) No. 1206/2001.[36]

On the contrary, the description *ex* Art. 128 CPI is covered by the autonomous Community concept of relevant evidence according to Regulation (EC) No. 1206/2001. (i) This conclusion has already been suggested by the Judgment of the British Queen's Bench Division pronounced on 5 April 2004 in *Sayers and others v. SmithKline Beecham plc and others.*[37] This judgment did not regard a description *ex* Art. 128 CPI and not even an infringement of a patent, but concerned a procedure of taking evidence which caused problems similar to those arising in the matter of description. In the case *Sayers and others* the plaintiffs were some children who had been vaccinated and had suffered "a variety of adverse consequences as a result of those vaccinations".[38] The defendants were the pharmaceutical companies which had produced those vaccines. The plaintiffs had collected through an Irish firm, E Ltd, "a significant number of tests [...] carried out on samples provided"[39] by themselves. Then the defendants wanted to "attend E Ltd's premises to inspect, *inter alia,* the data, the equipment on which the tests had been conducted and surrounding materials".[40] The Irish company had denied them the access to its premises and said materials. Thus, the defendants had requested the British court to ask in turn the Irish court to take said evidence on the premises of the company E Ltd according to the Community Regulation on evidence. The British court had interpreted the concept of piece of evidence pursuant to Regulation (EC) No. 1206/2001 autonomously, had held that "there is no reason why the concept of taking of evidence in the Regulation should not include [...] the inspection of premises and equipment",[41] and had concluded that the Regulation applied also to "measures which would enable the defendants' experts to visit E Ltd's premises, and measures which were ancillary to the inspection, such as the production of copies of the laboratory records".[42] Of course, the case cited here concerns neither intellectual property nor the description *ex* Art. 128 CPI. The means of evidence invoked at that time had, however, a few elements of analogy with the description *ex* Art. 128 CPI: because they consented *ia* to access the defendant's domicile in order to obtain the supporting documents that were kept there.[43] The Judgment of the British Queen's Bench Division can thus constitute a useful precedent for interpretation and application of Regulation (EC) No. 1206/2001 also in the case of description of goods considered here. (ii) Besides, the thesis proposed here is further suggested by the Commission of the European Community: because Art. 8 of its "Practice Guide for the Application of the Regulation on the Taking of Evidence"[44] provides that the concept of evidence comprises also "verifications and establishment of facts".[45] Now these latter means of pre-trial investigation do neither concern specifically and exclusively intellectual property nor the description *ex* Art. 128 CPI. However, they do have some elements of analogy with the description *ex* Art. 128 CPI: they allow *ia* to access the defendant's domicile in order to obtain from there supporting material.[46] (iii) The thesis proposed here is further suggested by the conclusions of Advocate General Kokott in the case of the above-mentioned Court of Genoa, which however concerned specifically a question relating to the description *ex* Art. 128 CPI and concluded that "means of precautionary taking of items of evidence, such as the description under Art. 128" CPI "constitute taking of evidence which falls within the scope of Art. 1 of the Regulation (EC) 1206/2001".[47] (iv) Finally, the thesis proposed here is in particular suggested at least by the following arguments.

(i) It is suggested above all by the criterion of systematic interpretation *stricto sensu, ie* the interpretation of the Regulation in the context of the entire system of Community law, and thus of the systematic reading of the Regulation and the other Community regulations. From this point of view it is necessary to refer to Directive No. 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, *ie* the so called "Enforcement Directive" concerning the civil protection of intellectual property rights.[48] In particular, according to Art. 7 of the Directive, "Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent courts may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information. Such measures may include the detailed description". Recital 20 of the Directive establishes further that "Given that evidence is an element of paramount importance for establishing the infringement of intellectual property rights, it is appropriate to ensure that effective means of presenting, obtaining and preserving evidence are available. […] For infringements committed on a commercial scale it is also important that the courts may order access, where appropriate, to banking, financial or commercial documents under the control of the alleged infringer." Art. 7 and Recital 20 of the Enforcement Directive introduce an autonomous concept of

36 *Sic* point 93 of the conclusions of Advocate General Kokott.

37 *See* Re MMR and MR vaccine Litigation (No) 10; "Sayers and others v SmithKline Beecham plc and others", in *All ER* (D) 67 Apr 2004.

38 *Sic* Re MMR and MR vaccine Litigation (No) 10; "Sayers and others v SmithKline Beecham plc and others", *cit.*

39 *Ibid*.

40 *Ibid*.

41 *Ibid*.

42 *Ibid*.

43 *See for all Nuyts*, *cit.,* at 76.

44 *Sic* Commission Services in consultation with the European Judicial Network in Civil and Commercial Matters, "Practice Guide", *cit.*

45 ID., point 8.

46 *See for all Nuyts*, *cit.,* at 76.

47 *Sic* point 113 of the conclusions of Advocate General Kokott.

48 In EC Official Journal No. L 157 of 30.4.2004. On this directive, *see for all Huniar*, "The enforcement Directive: its Effects on UK Law", in EIPR, 92 (2006); *Eisenkolb*, "Die enforcement-Richtlinie mit Ablauf der Umsetzungsfrist unmittelbar wirksam?" in GRUR, 387 (2007).

evidence which comprises explicitly the description as well.[49] The Directive constitutes a Community act the same as the Regulation on evidence. According to the systematic interpretation *stricto sensu* it may then contribute to interpreting the provisions of the latter.[50] A systematic interpretation of Regulation (EC) No. 1206/2001 on evidence in the light of Directive No. 2004/48/EC confirms that the category of relevant evidence in accordance with the Regulation comprises the description as well.[51]

(ii) The thesis proposed here is further supported by the criterion of systematic interpretation *lato sensu* of the Regulation, namely of interpreting the Regulation in the context of the complex system established by Community law and at the same time that of international law. From this point of view Art. 50.1 (b) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) comes into consideration, according to which "the judicial authorities shall have the authority to order prompt and effective provisional measures: […] (b) to preserve relevant evidence in regard to the alleged infringement". The Community as well has signed and concluded TRIPS,[52] and has implemented it (in particular and also as far as it is of interest) by the Enforcement Directive.[53] The systematic interpretation *lato sensu* then points at least in two directions for reconstruction of the concept of evidence according to Regulation (EC) No. 1206/2001 and its extension to the description *ex* Art. 128 CPI as well. Above all Art. 50.1 (b) TRIPS does not mention explicitly provisions like the description *ex* Art. 128 CPI, but it is usually interpreted as relating also to the above-mentioned means of pre-trial investigation.[54] The criterion of systematic interpretation of Regulation (EC) No. 1206/2001 and TRIPS suggest giving the concept of evidence of the first one the same content as the latter, and to include also in the first one the description that can be subsumed under Art. 50.1 (b) TRIPS. Secondly, according to Art. 300.7 TEU, "agreements concluded" by the Community "shall be binding on the institutions of the Community and on Member States." As a consequence, they prevail over the deriving Community law;[55] the latter has to be interpreted in compliance with them and in case of doubt, Regulation (EC) No. 1206/2001 and its Communitarian concept of evidence have to be reconstructed in compliance with TRIPS, namely (and as far as of interest here) as being extended in a way as to comprise also the description *ex* Art. 128 CPI.

(iii) The opinion proposed is finally suggested by the criterion of teleological interpretation of Regulation (EC) No. 1206/2001 in the light of human rights relating to judicial defence of interests and (thus also) the right to evidence. According to Art. 6.2 TEU "the Union shall respect fundamental rights, as guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms signed in Rome on 4 November 1950 and as they result from the constitutional traditions common to the Member States, as general principles of Community law." This principle imposes interpretation of all Community acts in the most suited way so as to guarantee the fundamental human rights, codified by the ECHR, the constitutions of the Member States and the Charter of Nice.[56] And among the human rights there is the

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[49] *See for all Hye-Knudsen*, Marken-, Patent- und Uhreberrechtsverletzungen im europäischen Internationalen Zivilprozessrecht, Tübingen, 2005, 225; *Szychowska*, cit., p. 113; *Heinze*, Einstweiliger Rechtsschutz im europäischen Immaterialgüterrecht, Tübingen, 2008, 68.

[50] *See De Miguel*, "Cross-Border Adjudication of Intellectual Property Rights and Competition between Jurisdictions", to be published in AIDA, 150 (2007), according to which "the rationale behind Directive 2004/48/EC should be very much taken into account by courts within the EU while interpreting the applicable rules on international jurisdiction".

[51] And here, among many others, see *Esteban de la Rosa*, cit., at 318, according to which "se aprecia una tendencia en la evolución de los distintos sistemas jurídicos, que ha encontrado también acojida en el Derecho comunitario, de conformidad con la cual se amplían las posibilidades para obtener pruebas, no solo de forma inmediata sino también previa al inicio del procedimiento en el que van a ser utilizadas, en particular en ámbitos que en el momento actual están especialmente afectados por tales riesgos, como es el caso de la protección de los derechos de propiedad intelectual e industrial". See also *Judicial cooperation in matters of intellectual property and information technology*, "Taking evidence in IP/IT in matters", at <www.ulb.ac.be/droit/ipit/docs/takingevidence. pdf>, 11, according to which the Directive 2004/48/EC "diminishes considerable differences between legislations of the Member States as to the methods of obtaining and preserving evidence in IP matters. As the use of preliminary proceedings is one of the characteristic features of the IP litigation an emphasis should be laid on the issue of the relation between this method of gathering information and the gathering of evidence through the channel of judicial cooperation".

[52] The Community has concluded TRIPS with the Council Decision 94/800/CE of 22 December 1994 "concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the Agreements reached in the Uruguay Round multilateral negotiations (1986-1994)", in *EC Official Journal* No. L 336 of 23.12.1994, 1.

[53] *See e.g.* point 35 of the Judgment of the ECJ 7 December 2006 *SGAE v. Rafael Hotels SA* (*supra* note 26) , *cit.,* according to which "Community legislation must, so far as possible, be interpreted in a manner that is consistent with international law, in particular where its provisions are intended specifically to give effect to an international agreement concluded by the Community".

[54] See for all *Tavassi*, "Tutela dei diritti in sede civile. Sequestro e descrizione – aspetti processuali", in *Frassi* and *Giudici* (Eds.), Adeguamento della legislazione nazionale agli accordi TRIPS e procedimenti cautelari in materia di proprietà industriale, 4 (Milan 1996); *Norrgård*, "Provisional Measures and Multiple Defendants in the MPI Proposal", in *Drexl* and *Kur*, Intellectual Property and Private International Law – Heading for the Future, 35 (Oregon 2005); *Bergomi*, sub "Art. 50 TRIPS", in *Ubertazzi* (Ed.), cit., at 76; *Ibbeken*,cit., at 313; *Vander*, cit., at 76.

[55] And here, among many others, *see Ballarino*, Manuale breve di diritto dell'Unione europea, 92 (Padova 2007).

[56] Besides, the latter is recalled expressly by Art. 6.1 TEU in its Lisbon version of 13.12.2007 according to which "the Union recognises 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." On the relationship between Art. 6 ECHR and private international law see FAWCETT, "The Impact of Article 6 (1) of the ECHR on the Private International Law", in ICLQ 2007, 1-48. On the legal value of the Charter of Nice before the Lisbon Treaty, *see Weber*, "The European Charter of Fundamental Rights", in German Yearbook Int. L., 101 (2000); *Vitorino*, "La Charte des droits fondamentaux de l'Union européenne", in Rev. dr. Un. eur., 502 (2000); *Levi*, "Carta dei diritti e Costituzione europea", in *Ferrari* (Ed.), I diritti fondamentali dopo la Charter of Nice. Il costituzionalismo dei diritti, 184 (Milan 2001); *Panebianco*, "Verso una 'Costituzione' comune dei diritti fondamentali dell'Unione Europea", in Riv. int. dir. uomo, 730-744 (2001); *Pocar*, "Carta dei diritti fondamentali dell'Unione europea", in *Pocar* (Ed.), Commentario breve ai Trattati della Comunità e dell'Unione europea, 1178–1181 (Padova 2001); *Viarengo*, "La Carta dei diritti fondamentali dell'Unione europea", in *Nascimbene*, La convenzione europea dei diritti dell'uomo. Profili ed effetti nell'ordinamento italiano, 197 et seq. (Milan 2002); *Weber*, "Il futuro della Carta dei diritti fondamentali dell'Unione europea", in Riv. it. dir. pub. com., 42 (2002); *Chiti*, "La Carta europea dei diritti fondamentali: una carta di carattere funzionale?", in Riv. trim. dir. pub., 1-26 (2002); *Rossi*, "Carta dei diritti fondamentali e Costituzione dell'Unione europea", *passim* (Milan 2002); *Carlier* and *De Schutter*, "La Charte des droits fondamentaux de l'Union européenne: son apport à la protection des droits de l'homme en Europe, Hommage à *Silvio Marcus Helmons*", *passim* (Brussels 2002); *Sacerdoti*, "La Carta europea dei diritti fondamentali: dall'Europa degli Stati all'Europa dei cittadini", in Comunicazioni e studi, 277–298 (2002); *Radicati di Brozolo*, "L'Unione e i

right to a fair trial, codified in Art. 6 ECHR, according to which "1. [...] everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law. [...] / 3. Everyone charged with a criminal offence has the following minimum rights: […] (d) to examine or have examined witnesses against him and to obtain the attendance and examination of witnesses on his behalf under the same conditions as witnesses against him". The right to a fair trial is then also guaranteed by the constitutions of the Member States: *sic* by Art. 24 of the Italian constitution, by Art. 103.1 of the German, by Art. 24 of the Spanish and by Art. 20 of the Portuguese one. The right to a fair trial is finally also provided by Art. 47 of the Charter of Nice.

The right to a fair trial naturally also comprises the right to evidence. This is recognized by the constitutions of the major Community States.[57] The right to evidence is further guaranteed by Art. 6.3 (d) ECHR referring expressly only to testimonial evidence, which is however obviously interpreted as relating to any other type of evidence as well.[58]

The ECHR provides expressly the right to evidence only in favour of those "charged with a criminal offence" and thus certainly in criminal matters.[59] (i) The European Court of Justice however has established that the category of those "charged with a criminal offence" according to Art. 6.3 ECHR has to be qualified in an autonomous way and in the light of the criterion of seriousness of the penalty related to the offence *sub iudice*; a penalty is serious when it violates fundamental human rights; therefore judicial proceedings are of criminal nature according to Art. 6.3 ECHR where the penalty following the offence violates fundamental human rights, independent of whether the penalty is of civil or criminal nature according to the internal law of the State concerned.[60] (ii) The interpretation of the European Court of Justice appears shareable at least for two reasons. The first one follows from the *sedes materiae*: because the right to evidence is sanctioned by a paragraph (para. 3) of an article (Art. 6) concerning both fair trial and also civil matter. The second reason derives then from the criterion of teleological interpretation: because the right to evidence ensures equality of arms and thus the right to judicial defence,[61] and equality of arms and judicial defence of course also have to be guaranteed in civil matters. (iii) Now proceedings relating to intellectual property rights may vary in criminal or civil proceedings according to the national systems of the Member States; nevertheless, both can involve sanctions which affect intellectual property rights; the latter are qualified as fundamental human rights *ia* by Art. 1 Protocol 1 ECHR, Art. 17 of the Charter of Nice, Art. 6 TEU and some other provisions in national[62] or international constitutions[63] apart from their interpretation by the European Court of Justice[64] and some other constitutional

diritti fondamentali: un passo avanti e due indietro (sui diritti economici)", in Dir.Un. eur., 551–554 (2002); *Acierno*, "La sentenza Carpenter: diritti fondamentali e limiti dell'ordinamento comunitario", *ibid.,* at 653–670; *Di Turi*, "La prassi giudiziaria relativa all'applicazione della Charter of Nice", *ibid.,* at 671–686; *Conetti*, "Sulla natura giuridica della Carta dei diritti fondamentali dell'Unione europea", in Studi di diritto internazionale in onore di Gaetano Arangio–Ruiz, III, 1899–1905 (Naples 2004).

57 The fundamental right to evidence is provided expressly by Art. 24.2 of the Spanish Constitution, according to which "*todos tienen derecho [...] a utilizar los medios de prueba pertinientes para su defensa*": and on this article, *see Herrera*, *cit.,* at 107 *et seq*., 281 note 751 and there for the necessary references to case law. The right to evidence is, however, provided only implicitly by Art. 24 of the Italian Constitution, as interpreted by unanimous opinion: on which *see for all Denti*, "Armonizzazione e diritto alla prova", in RTDPC 1994, 673; *Leo*, "Il diritto alla prova nella giurisprudenza della Corte Costituzionale", in AAVV, La prova nel processo civile, I, Quaderni del Consiglio Superiore della Magistratura, 72 (Rome 1999), and there for references to case law; *Comoglio*, "Istruzione e discovery nei giudizi in materia di proprietà industriale", in AIDA, 272 (2000); *Consolo*, Spiegazioni di diritto processuale civile. Le tutele, I, 37 (Padova 2003) and there for necessary references to case law; *Vignera*, "Garanzie costituzionali del diritto alla tutela giurisdizionale e durata del processo", at <www.ambientediritto.it>, 2 (2004). The right to evidence is provided also implicitly by Art. 103.1 of the German Constitution, on which *see Heinz* and *Putzo*, Zivilprozeßordnung, 4 (Munich 2003).

58 Cf. ECHR 6 May 1985 *Bönisch v. Austria*, at <www.hudoc.echr.coe.int>. As to doctrine, see for all *Liakopoulos*, Equo processo nella convenzione europea dei diritti dell'uomo e nel diritto comunitario, 61 (Padova 2007).

59 *See for all* finally the judgments of the ECHR of 10 May 2007 *A.H. v. Finland*, at <www.hudoc.echr.coe.int> (point 30); of 8 February 2007, "*Kollcaku v. Italy*", *ibid,* point 67.

60 *See* in this sense *Focarelli*, Equo processo e convenzione europea dei diritti dell'uomo, 320-339 and 373-393 (Padova 2007) and there for further necessary references. Besides, the conclusion adopted here is in line with Community guidelines: in fact Art. 47 of the Charter of Nice provides analogous rights to those guaranteed by Art. 6 ECHR and does not make any distinction as to civil or criminal nature of the judicial proceedings.

61 *See for all* the judgments cited at note 64.

62 *See eg* Art. I, Section 8, clause 8 of the Constitution of the U.S.A. which "grants Congress authority 'to promote the progress of science and the useful arts' by securing to inventors for a limited time the exclusive right to their work", *sic Burk*, "Patents in Cyberspace: Territoriality and Infringement on Global Computer Networks", in *Tulane Law Rev.* 26 (1993). *See* also the three following notes.

63 *See* the references in *Geiger*, "'Constitutionalising' Intellectual Property Law? The Future of Fundamental Rights on Intellectual Property in the European Union", in IIC, 371 (2006).

64 Strasbourg case law has interpreted the concept of property *ex* Art. 1 of Protocol 1 to ECHR as comprising also immaterial property and, as consequence, has applied to the latter the principle cited *ia* in the cases *SmithKline* in 1990 (Commission (decision) 12633/87, "*SmithKline and French Laboratories Ltd v. The Netherlands*", 4 October 1990, at <www.hudoc.echr.coe.int>), *Melnychuk* in 2005 (ECHR 5 July 2005, "*Melnychuk v. Ukraine*", (dec.), at <www.hudoc.echr.coe.int>) and *Anheuser-Busch* in 2007 (ECHR 11 January 2007, *Anheuser-Busch Inc. v. Portugal*, at <www.hudoc.echr.coe.int>): the first of these concerned the ownership of a patent relating to an invention "of a new chemical substance and of its use in medical dosage forms", the second case concerned copyright and the third one a trademark. In the sense that Art. 1 Protocol 1 ECHR protects intellectual property rights, as to doctrine *see Velu* and *Ergec*, La Convention européenne des droits de l'homme, 676 (Brussels 1990); *Schermers*, "The international protection of the right of property", in Mélanges en l'honneur de *Gérard Wiarda,* Protection des droits de l'homme: la dimension européenne, 571 (Cologne 1988); *Gerin*, Il diritto di proprietà nel quadro della convenzione europea dei diritti dell'uomo, 2 (Padova 1989); *Harris*, *O'Boyle* and *Warbrick*, Law of the European Convention on Human Rights, 517 (London 1995); *Condorelli*, "Article 1", in *Pettiti*, *Decaux* and *Imbert*, La Convention européenne des droits de l'homme. Commentaire article par article, 976 (Paris 1999); *Peukert*, "Artikel 1 des 1.ZP", in *Frowein* and *Peukert*, Europäische MenschenRechtsKonvention. EMRK-Kommentar, 768 (2nd ed., Strasburg 1996); *Charrier*, Code de la convention européenne des droits de l'homme, 317 (Paris 2000); *Padelletti*, La tutela della proprietà nella convenzione europea dei diritti dell'uomo, 61 (Milan 2003); *Mastroianni*, "Proprietà intellettuale e costituzioni europee", in AIDA, 12 (2005); *Schneider*, Menschenrechtlicher Schutz geistigen Eigentums (Stuttgart 2006); *Geiger*, *cit.,* at 395. *See* also my own comment to the Case "*Beyeler*" of the European Court of Human Rights in AIDA, 271–277 (2001). Besides, the European Court of Human Rights holds that IP rights are suitable for limiting the fundamental human right to freedom of expression under Art. 10 ECHR: this confirms further the nature of human rights to those relating to intellectual property. *Cf.* finally the ECHR 7 December 2006, *Österreichischer Rundfunk v. Austria*, at <www.hudoc.echr.coe.int> and ECHR 14 December 2006, *Verlagsgruppe News GMBH v. Austria, ibid.* It remains to be said that the European Court of Justice qualifies as fundamental human rights *ex* Art. 10 ECHR also those to make and receive advertising: and it is recalled that advertising falls into

courts of a few important States;[65] the sanctions resulting from proceedings relating to intellectual property rights can therefore be considered "serious" according to Art. 6.3 ECHR; by corollary these proceedings fall within the category of "criminal matter" *ex* Art. 6.3 ECHR and have to guarantee the right to evidence.

At this point however one still has to wonder whether the right to evidence also comprises the means of pre-trial investigation allowing the early acquisition of evidence, as e.g. the description. Neither the European Court of Human Rights nor the European Court of Justice have yet pronounced a decision in this respect. Instead the Italian Constitutional Court has done so in relation to Art. 24 of the Italian Constitution: according to the latter it is rightly held that "in civil proceedings and for configuration of the evidence provided there, the guarantee of the action and the judgment, in order to avoid its being suppressed if not even made futile, implies that whenever there is a risk of dispersion of elements necessary to form evidence, a possibility should be provided to recognize and take such elements, by means of urgent proceedings and provisions intended to avoid that a change in situations and events likely to occur before the judgment prevents their timely acquisition. Otherwise the assertions and evaluations necessary for the proceedings on the merit might definitely be compromised and the request would thus be devoid of its supporting material."[66] These reasons and conclusions by the Italian Constitutional Court can be reasonably applied also to the provisions of Arts. 6 ECHR, 6 TEU and 47 of the Charter of Nice considered here.[67]

This order in the regulation of the human rights has of course corollaries on the interpretation of Regulation (EC) No. 1206/2001 and on the question examined here, namely if the description *ex* Art. 128 CPI falls within the concept of relevant evidence according to this Regulation. In fact, the criterion of teleological interpretation of Regulation (EC) No. 1206/2001 imposes its interpretation in the most appropriate way so as to guarantee the human right to evidence *ex* Arts. 6 ECHR, 6 TEU, 47 Charter of Nice and 24 of the Italian Constitution. Hence, the category of relevant evidence pursuant to Regulation (EC) No. 1206/2001 has to be qualified as comprising also the means of early acquisition of evidence, and thus even that of the description *ex* Art. 128 CPI.[68]

4. The refusal to execute a request as provided by Council Regulation (EC) No. 1206/2001 in case it "does not fall within the functions" of the requested court or involves "major practical difficulties". The question of its refusal by reason of public policy of the State of the requested court

A. In short, it may be concluded that the category of relevant evidence pursuant to Regulation (EC) No. 1206/2001 is Communitarian and autonomous with respect to that of national systems, and comprises also the description *ex* Art. 128 CPI. Nevertheless, Regulation (EC) No. 1206/2001 provides for some cases where the requested court may refuse to execute the request, and thus creates a few interesting problems. The case of the Court of Genoa points out in particular three of them, which will be referred to below.

A first problem concerns the provision of Art. 14.2 according to which "the execution of a request may be refused [...] if: [...] (b) the execution of the request under the law of the Member State of the requested court does not fall within the functions of the judiciary". This rule was possibly the basis for the refusal by the English court to execute the request of the Court of Genoa. From this point of view it is significant that the judgment of the Queen's Bench Division had declared that the request "seems to me to fall outside the usual practice":[69] on the other hand, the conclusions of Advocate General Kokott states the United Kingdom's point of view according to which the description is not performed directly by the court, but by a supervising solicitor who is "charged by the court" to execute the description; the supervising solicitor is "an independent organ of the court (officer of the court)", however he is not "a agent in the service of the court";[70] and, by corollary, the court might appear at the first sight not "competent" according to Art. 14.2(b) of Regulation (EC) No. 1206/2001.

The present study of course dispenses with verifying whether the features of the English system were concretely such as to allow the British court *ex* Art. 14.2 of Regulation (EC) No. 1206/2001 to refuse the Italian request for description *ex* Art. 128 CPI. It takes note that according to the conclusions of Advocate General Kokott the English court could not have refused it.[71] Instead, it will dwell on the grounds (which it shares) of Kokott's conclusions, according to which the description *ex* Art. 128 CPI does fall within the functions of the English judiciary. Under this point of view, it has to be

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the category of unfair competition, which in turn can be subsumed in that of intellectual property according to a broad definition expressed *eg* in Art. 2.7 of the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on 14 July 1967. *See* the text of the treaty at <www.wipo.int>, according to which "'intellectual property' shall include the rights relating to: / literary, artistic and scientific works, / performances of performing artists, phonograms, and broadcasts, / inventions in all fields of human endeavor, / scientific discoveries, / industrial designs, / trademarks, service marks, and commercial names and designations, / protection against unfair competition, / and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields". *See* finally the judgments of the ECHR of 6 November 2003, "*Krone v. Austria*", and of 10 July 2003, "Murphy v. Ireland", both at <www.hudoc.echr.coe.int>. For further reference on case law relating to Art. 10 ECHR, *see Testa*, "Libertà di espressione e pubblicità nella giurisprudenza della Corte europea dei diritti dell'uomo", in Studi in onore di *Gerhard Schricker*, 529 (Milan 2005); *Ubertazzi* and *Ubertazzi*, "Il diritto della pubblicità", at <www.ubertazzi.it>, paragraph 57 (2006).

65 *See* the references in *Mastroianni*, *cit.,* at 9.

66 *Sic* point 3 of the Judgment of the Italian Constitutional Court of 20.2.1997, No. 46, in Giust.civ. 1997, I, 880. *See also* point 2.2 of the Judgment of the Italian Constitutional Court of 22.10.1999, No. 388, in Foro it. 2000, I, 1072 commented by *Pagni*, "I limiti dell'accertamento tecnico preventivo ancora al vaglio della Corte costituzionale", *ibid.* The Italian Constitutional Court is in line *ia* with the opinion of Advocate General Kokott referred to here above in this paragraph, according to which the description is "linked up inseparably with the taking of evidence" and thus falls into the latter category.

67 *Cf. Heinze*, *cit.,* at 41 and there for references.

68 *See Biavati*, *cit.,* at 449; *Herrera*, *cit.,* at 179; *Nuyts*, *cit.,* at 76. In a doubting way, *see however Szychowska*, *cit.,* at 117.

69 *Sic* l'ordinanza genovese di rinvio pregiudiziale.

70 *Sic* points 101, 103 and 105 of the conclusions of Advocate General Kokott.

71 *Sic* point 111 of the conclusions of Advocate General Kokott.

said that the category of the functions of the court *ex* Art. 14.2 (b) of Regulation (EC) No. 1206/2001 has to be qualified in an autonomous way, so as to secure the effectiveness of Regulation (EC) No. 1206/2001 and thus "rightfully in favour of judicial assistance";[72] "if only the acts of pre-trial investigation of evidence performed directly by the court were considered to fall within the functions of the court, the practical effectiveness of the Regulation would appear excessively limited";[73] by corollary, all the provisions fall within the competence of the requested court even those only ordered by it (but not executed), among which the peculiar description the United Kingdom was requested to perform.

B. A second problem concerns the provision of Art. 10.3 of Regulation (EC) No. 1206/2001, according to which the court requested by the Italian court could refuse the performance of a description *ex* Art. 128 CPI if that involved "major practical difficulties". In this context, however, the conclusions of Advocate General Kokott point out that Art. 10.3 has to be interpreted in teleological manner, in order to guarantee the effectiveness of the Regulation and thus "rightfully in favour of judicial assistance".[74] Thus, Art. 10.3 cannot be applied where "the measure requested in accordance with the foreign law does not coincide perfectly with the national law and practice", because otherwise the Regulation "would never find application".[75] Therefore, the requested court has to "attempt in the first place as far as possible to execute in the most satisfactory way the measure provided for by the law of the requesting State with the means at its disposal". "When it is literally not possible to execute the request under the foreign law due to conflicting national provisions or by reason of major practical difficulties, the request cannot *sic et simpliciter* be sent back again without executing it *in toto*. The requested court [...] instead has to execute the request in modified form, so as to make it compatible with the provisions of its own national law". Finally, "in case not even this can be done, there remains still the possibility to apply by analogy a procedure provided by its own national law".[76] This interpretation has been confirmed by the above-mentioned Recital 11 of Regulation (EC) No. 1206/2001, according to which "to secure the effectiveness of this Regulation, the possibility of refusing to execute the request for the performance of taking of evidence should be confined to strictly limited exceptional situations."

C. Some Member States do not provide for means of pre-trial investigation of the kind of description *ex* Art. 128 CPI.[77] On the other hand, this causes of course a problem in the relationship between the human right to evidence and the equally fundamental right to the inviolability of one's domicile.[78] A similar question of legal balance between the fundamental human right to intellectual property and another "further fundamental right, namely the right that guarantees protection of personal data and hence of private life"[79] has been recently raised in front of the European Court of Justice in the case *Productores de Música de España versus Telefónica de España* of 29.1.2008. In this case the European Court has correctly maintained that Community law requires that […] the Member States take care to rely on an interpretation" of the EC rules "which allows a fair balance to be struck between the various fundamental rights protected by the Community legal order" "which would" not "be in conflict with those fundamental rights or with the other general principles of Community law, such as the principle of proportionality".[80]

It remains to be questioned whether the requested State could add to the proportionality principle the one of compatibility with its public policy, considered that the rules relating to human rights are part of the *ordre public* of European States.[81] Now the Regulation does not mention *ordre public*. However, it seems necessary to make a distinction between the requests, depending on whether they have to be executed on the basis of the procedure provided by the *lex fori* of the requesting court *ex* Art. 10.3 of the Regulation on evidence, according to which "the requesting court may call for the request to be executed in accordance with a special procedure provided for by the law of its Member State", or pursuant to that of the requested State *ex* Art. 10.2 of the same Regulation, according to which "the requested court shall execute the request in accordance with the law of its Member State". The requests that have to be executed on the basis of the procedure under the *lex fori* of the requesting court, inter alia the description of the case *de quo*, fall within Art. 10.3 of the Regulation. With respect to these, the *ordre public* has then been recognized in the categories of "incompatibility" of the request "with the law of the Member State" of the requested court and of "major practical difficulties" according to Art. 10.3 of the Regulation:[82] Thus, for all the considerations set out in the previous paragraph, the British court could not refuse the execution of the request by reason of *ordre public*.

Art. 10.3 does not apply, however, to the requests that have to be executed according to the procedure pursuant to the lex fori of the requested court, and thus these can be refused only by the reasons indicated in Art. 14 of Regulation (EC) No. 1206/2001, among which ordre public does not appear. Therefore, a first thesis holds that the list of Art. 14 is not peremptory; it sustains that ordre public is also to be included among

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72 *Sic* point 111 of the conclusions of Advocate General Kokott.

73 *Sic* point 104 of the conclusions of Advocate General Kokott.

74 *Sic* point 111 of the conclusions of Advocate General Kokott.

75 *Sic* point 107 of the conclusions of Advocate General Kokott.

76 *Sic* point 111 of the conclusions of Advocate General Kokott.

77 See paragraph 1 of this study.

78 This right is guaranteed *ia* by Art. 8 ECHR according to which "everyone has the right to respect for […] his home" and by Art. 7 of the Charter of Nice which provides that "everyone has the right to respect for his or her […] home".

79 Sic ECJ, 29 January 2008 – C-275/06 – *Productores de Música de España contra Telefónica de España* (not yet published at the ECR), in www.curia.eu.int, at point 63.

80 Sic the conclusión of the ECJ decision, *Productores de Música de España contra Telefónica de España* (*supra* note 79), cit.

81 For Italy *cf. Viviani*, "Coordinamento fra valori fondamentali internazionali e statali: la tutela dei diritti umani e la clausola di ordine pubblico", in *Riv. Dir. int. priv. proc.*, 847–888 (1999); *Picchio Forlati*, "Critères de rattachement et règles d'applicabilité, à l'heure de la protection des droits de l'homme", in *Riv. Dir. int. priv. proc.*, 889-907 (2005). I further take the liberty to refer to *Ubertazzi*, "La capacità", *cit.,* paragraph 4, and there for reference.

82 *Sic* point 96 of the conclusions of Advocate General Kokott.

the reasons of refusal to take evidence; consequently, it concludes that the request may be refused when it is against the ordre public of the requested court.[83] In reality, this thesis does not convince compared to the prevailing opinion, which considers that the list in Art. 14 is peremptory and the request to take evidence can therefore not be refused for being against the ordre public of the requested forum:[84]

Besides, this last thesis is also in line with the teleological interpretation of the Regulation, with its Recital 11[85] and the most recent orientation according to which the courts of Member States cannot invoke ordre public in order to refuse cooperation among each other.[86]

[83] *Esteban de la Rosa*, *cit.,* at 314.

[84] *See Commission Services in consultation with the European Judicial Network in Civil and Commercial Matters*, "Practice Guide", *cit.,* point 45, according to which "Apart from the above exceptions, no public policy *("ordre public")* exception can be invoked to justify the refusal of the taking of evidence by the requested court.". *See also Müller*, *cit.,* at 109; *Sandrini*, *cit.,* at 222; *Borghesi*, *cit.,* at 350.

[85] According to which "To secure the effectiveness of this Regulation, the possibility of refusing to execute the request for the performance of taking of evidence should be confined to strictly limited exceptional situations."

[86] *Cf.* ECJ, 28 March 2000 – C-7/98 – *Krombach* [2000] ECR I-1935, at <http://curia.europa.eu/index/htm>; ECJ 23 November 1999 Joined Cases – C-369/96 and C-376/96 – *Arblade* [1999] ECR I-8453 *ibid.;* ECJ 11 May 2000 – C-38/98 – *Renault* [2000] ECR I-02973, *ibid.* As to doctrine, *see for all Mosconi*, "La difesa dell'armonia interna nell'ordinamento del foro tra legge italiana, convenzioni internazionali e regolamenti comunitari", in Riv. Dir. int. priv. proc., 25 (2007).

Civil Procedure

ECJ 22 May 2008 – C-462/06 – Glaxosmithkline, Laboratoires Glaxosmithkline v Jean-Pierre Rouard

Brussels I Regulation[1] Article 6 (1), and Section 5 of Chapter II – Jurisdiction over individual contracts of employment – Special jurisdiction – More than one defendant

The rule of special jurisdiction provided for in Article 6, point 1, of Brussels I Regulation[2] cannot be applied to a dispute falling under Section 5 of Chapter II of that regulation concerning the jurisdiction rules applicable to individual contracts of employment.

Facts: *Mr Rouard was engaged in 1977 by the company Laboratoires Beecham Sévigné, the seat of which was in France, and he was posted to various African States.*

Pursuant to a new contract of employment concluded in 1984 with Beecham Research UK, another company in the group, which was registered in the United Kingdom, Mr Rouard was engaged by that company and sent to Morocco. Under that contract of employment, his new employer undertook to maintain the contractual rights acquired by Mr Rouard under his initial contract of employment with Laboratoires Beecham Sévigné, and in particular to preserve his rights derived from length of service and his entitlement to compensation in the event of dismissal.

Mr Rouard was dismissed in 2001. In 2002 he brought an action before the Conseil de prud'hommes de Saint-Germain-en-Laye[3] against Laboratoires Glaxosmithkline, which has assumed the rights of Laboratoires Beecham Sévigné, the seat of which is in France, and Glaxosmithkline, which has assumed the rights of Beecham Research UK, the seat of which is in the United Kingdom. Mr Rouard requests that those companies be ordered jointly and severally to pay him various amounts of compensation and damages for non-compliance with the dismissal procedure, dismissal without genuine and serious cause and wrongful breach of his employment contract.

Mr Rouard submits that those two companies were his joint employers. Since the French courts have jurisdiction in respect of Laboratoires Glaxosmithkline, the seat of which is in France, those courts, he submits, also have jurisdiction, pursuant to Article 6, point 1, of the Regulation, in respect of Glaxosmithkline.

Those companies disputed the jurisdiction of the Conseil de prud'hommes de Saint-Germain-en-Laye, which upheld that objection of lack of jurisdiction. After the Cour d'appel de Versailles[4] set aside the first instance judgment, those companies appealed in cassation against the judgment of 6 April 2004 of that latter court.

It is in those circumstances that the Cour de cassation (FR) decided to stay proceedings and to refer the matter to the Court for a preliminary ruling.

Extract from the decision: "(...)

Legal Background

3. Article 2, point 1, in Section 1, entitled General provisions of Chapter II of the Regulation, provides:

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

4. Article 6 of the Regulation, in Section 2 of Chapter II thereof, entitled Special jurisdiction, states:

A person domiciled in a Member State may also 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, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings; (…)

(3) on a counter-claim arising from the same contract or facts on which the original claim was based, in the court in which the original claim is pending; (...)

5. Among the objectives of the Regulation, recital 13 states:

In relation to insurance, consumer contracts and employment, the

[1] Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001, L 12 at 1; the Regulation).

[2] *Supra* note 1.

[3] Employment Tribunal, Saint-Germain-en-Laye (FR).

[4] Court of Appeal, Versailles (FR).