



**COUNCIL OF  
THE EUROPEAN UNION**

**Brussels, 9 June 2009**

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**LIMITE**

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**NOTE**

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From: Council Legal Service  
To: Working Party on Intellectual Property (Patents)  
Subject: Request for an opinion by the European Court of Justice on the compatibility under the EC Treaty of the envisaged Agreement creating a Unified Patent Litigation System.

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Delegations will find attached the text of the Request for an Opinion of the Court of Justice prepared by the Council Legal Service in accordance with the decision adopted by the Council on 28 May 2009.

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***LEGAL SERVICE***

**ANNEX**

**DRAFT**

TO THE PRESIDENT AND MEMBERS  
OF THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES

**REQUEST FOR AN OPINION**

submitted by

**THE COUNCIL OF THE EUROPEAN UNION,**

represented by XX and XX, Legal Advisers in the Council Legal Service, acting as agents, having agreed that service may be effected on them at fax n° +00.32.2.281.56.56 and, where necessary, at the following address: Council of the European Union, Registry of the Legal Service, for the attention of XX and XX, rue de la Loi, 175, 1048 Brussels,

under Article 300(6) EC on the following question:

*"Is the envisaged Agreement creating a Unified Patent Litigation System (currently named European and Community Patents Court) compatible with the provisions of the Treaty establishing the European Community?"*

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## I. BACKGROUND

### A) The European Patent

1. The European Patent Convention of 5 October 1973 (hereinafter EPC) is a regional treaty with 35 contracting parties<sup>1</sup> intended to provide for a centralised system of granting patents in Europe. Under the EPC, patents granted by the European Patent Office (hereinafter EPO) are valid in the States parties to the Convention designated in the application for a patent. Patents thus granted constitute national patents conferring national protection, or a bundle of such national patents if the application mentions several States parties.
2. The European Community is not a Party to the EPC. A revision of this Convention to allow for the accession of the Community and to provide for the required adjustments for a future Community patent to become operational has been discussed within the Council. The progress of that envisaged revision is linked to the outcome of the discussions on a future Regulation on a Community patent.
3. At the Paris Intergovernmental Conference on 25 June 1999, the contracting parties to the EPC set up a Working Party on litigation which went to prepare a Draft Agreement on the establishment of a European patent litigation system (hereinafter the EPLA) and a Draft Statute of the European Patent Court<sup>2</sup>. These texts have not been adopted by a Diplomatic Conference.

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<sup>1</sup> All EU Member States are parties to the EPC. Croatia, the former Yugoslav Republic of Macedonia, Iceland, Liechtenstein, Monaco, Norway, San Marino, Switzerland and Turkey are also parties to the Convention

<sup>2</sup> The Draft Agreement and the Draft Statute are available at <http://www.epo.org/patents/law/legislative-initiatives/epla.html>

## B) The Community Patent

4. The first attempt to establish a Community Patent was made via the Convention for the European patent for the common market signed at Luxembourg on 15 December 1978<sup>3</sup>. That Convention was amended by the Agreement relating to Community patents done at Luxembourg on 15 December 1989, which added two Protocols on the settlement of litigation concerning the infringement and validity of Community patents and on the statute of the common appeal court relating to Community patents<sup>4</sup>. This Agreement essentially provided for national designated patent Courts to adjudicate on the infringement and validity of Community patents, including revocation, but created a Common Appeal Court with exclusive jurisdiction to determine issues raised on appeal concerning the effects of the Community patents and the validity of the Community patent. Continuing difficulties concerning the ratification of the Agreement by certain Member States caused it not to come into force.
  
5. In 2000 the Commission presented a proposal for a Council Regulation on the Community patent<sup>5</sup>. The proposal contemplated the establishment of a Community intellectual property court. After the entry into force on 1 February 2003 of the Maastricht Treaty, inserting Article 229a and Article 225a into the EC Treaty, the Commission presented a proposal for a Council Decision conferring jurisdiction on the Court of Justice in disputes relating to the Community patent<sup>6</sup>, to be based on Article 229a EC, and a proposal for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance<sup>7</sup>. In accordance with Articles 225a and 245 of the EC Treaty, the Court of Justice<sup>8</sup> was consulted on the latter proposal<sup>9</sup>.

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<sup>3</sup> OJ L 17 of 26.1.1976, p. 1.

<sup>4</sup> OJ L 401 of 30.12.1989, p. 1.

<sup>5</sup> COM (2000) 412 final, OJ C 337 E of 22.11.2000, p. 278.

<sup>6</sup> COM (2003) 827 final.

<sup>7</sup> COM (2003) 828 final.

<sup>8</sup> In the present request the words "the Court" or "the Court of Justice" are used the reference is to the Court of Justice of the European Communities

<sup>9</sup> Document of the Council No 14349/04.

6. The combined provisions of these proposals as envisaged in the common political approach adopted by the Council on 2003 were to provide for a unitary jurisdiction for the Community patent with exclusive jurisdiction in actions and claims of invalidity or infringement proceedings and in other actions concerning Community patents. A judicial panel, called the Community Patent Court, was to be established by a Council Decision under Article 225a EC and was to be attached to the Court of First Instance of the European Communities. Final decisions by the Community Patent Court would be subject to a possible appeal before the Court of First Instance.
  
7. The Council has not been in a position to adopt the Regulation and the Decisions proposed by the Commission. The Commission has not withdrawn those proposals. Currently, progress is being made in discussions within the Council on the Regulation on the Community patent. The latest update on the state of discussions in this respect is to be found in a working document from the Presidency on the proposal for a Regulation on the Community patent, which should form the basis for further discussions and work on the outstanding issues in the coming months. It is attached as Annex 1.

C) The prospect of a Unified Litigation System

8. On April 2007 the Commission presented to the European Parliament and the Council its communication "Enhancing the patent system in Europe"<sup>10</sup> in order to re-launch the debate on the possible measures for making progress on this issue. The communication focused on the possibility of an integrated jurisdictional system for patents in the single market. The Commission outlined three possible options:
  - a) making progress on EPLA;
  - b) establishing a Community jurisdiction for European and Community patents and
  - c) what was termed "the Commission's compromise", which entailed creating a unified and specialised patent judiciary with competence for litigation on European patents and future Community patents.

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<sup>10</sup> COM (2007) 165 final.

9. On the basis of this communication, the members of the Council started discussions on a Europe-wide patent jurisdiction concerning European patents and future Community patents. The Commission fully participated in the work within the Council.
10. These discussions envisaged a new unified jurisdiction to be named "European and Community Patents Court" (hereinafter, the ECPC) with exclusive competence as regards actions for infringements and actions or counterclaims for revocation concerning both European and Community patents, as well as actions for damages relating to these patents and some related actions.
11. The ECPC would comprise a court of first instance - comprising a central division as well as local and/or regional divisions - and a court of appeal. The ECPC would comprise both legally qualified judges and technically qualified judges, to be appointed by a Mixed Committee composed of one representative of each Contracting Party.
12. When deciding on cases submitted to it, the ECPC would be obliged to respect Community law and it would base its decisions on the Agreement, Community law, the EPC and international agreements binding on all the contracting parties. The envisaged Agreement would also lay down the rules to decide on the national law applicable by the ECPC where relevant. A contracting State which is not a party to the Agreement on the European Economic Area would have to bring into force the laws, regulations and administrative provisions necessary to comply with Community law relating to substantive patent law.
13. Extensive debates have taken place on the arrangements to ensure the autonomy of the Community legal order in pursuing its own particular objectives<sup>11</sup>. It was initially envisaged that decisions by the ECPC would be subject to further appeal before the Court of Justice of the European Communities on points of law only ("cassation"). Thus, as regards Community law in general and the provisions on Community patents in particular, the Court of Justice would

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<sup>11</sup> Opinion 1/00, European Common Aviation Area, ECR [2002] p. I-3493, paragraphs 11, 12 and 26.

remain the final interpreter of law, in the interest of the autonomy of the Community legal order. However, as regards in particular disputes concerning European patents, the Court of Justice would thus have been given new powers to interpret and apply national law to disputes which the Treaty neither submits nor plans to submit to it. Doubts were raised as to whether in so doing the envisaged provision might be considered to change the essential character of the powers conferred on the Community institutions by the Treaty<sup>12</sup>, which would render the envisaged Agreement incompatible with the Treaty.

14. A majority of members of the Council are opposed to an appeal before the Court of Justice on points of law only ("cassation"). They are in favour of laying down, instead, an obligation for the ECPC to request a preliminary ruling from the Court of Justice when a question of interpretation of the Treaty or the validity and interpretation of acts of the institutions of the European Community is raised before the ECPC. This option has been retained in Article 48 of the envisaged Agreement, which also lays down that decisions of the Court of Justice are binding on the ECPC.
15. The envisaged Agreement provides for a specific language regime based on the official language of the State hosting the local or regional divisions, with possible derogations if that State so decides or if parties so agree. That language would also be used in the subsequent appeal, unless the parties agreed to use the language in which the patent was granted or if the Court of Appeal decided to use another official language. The language of proceedings at the central division is the language in which the patent concerned was granted<sup>13</sup>.
16. The envisaged Agreement would enter into force following its ratification by the EU Member States. States Parties to the EPC may accede to the Agreement. It is assumed that the Community may also become a Party to the Agreement.

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<sup>12</sup> Opinion 1/92, European Economic Area II, ECR [1991] p. I-2825, paragraph 32 and opinion 1/00, already quoted, paragraph 20.

<sup>13</sup> European patents must be granted in English, French or German. Thus far no rule as to the language regime to be applied for the granting of Community patents has been agreed upon.



17. The text of the envisaged Agreement, including the draft Statute of the ECPC, is submitted to the Court as Annex 2. However precisely drafted, this text is still a working document; it has not been agreed upon by the Council, nor is there yet any commitment to agree to it. It has been presented by the Council's Presidency following extensive discussions in the Council and with the Commission. It is considered as a suggestion to move forward towards a broad agreement on a Community patent and a unified jurisdiction for cases concerning Community patents or European patents. Questions such as that of the legal basis remain open.
18. On 23 March 2009, the Commission presented a recommendation to the Council in order to be authorised to open negotiations for the adoption of an Agreement creating a Unified Patent Litigation System. That recommendation is submitted to the Court as Annex 3. The Agreement whose negotiation is recommended by the Commission broadly coincides with the draft text being submitted to the Court of Justice for Opinion in these proceedings. The Council has not yet granted the Commission the authorisation referred to in that recommendation.
19. The Council is of the view that further steps towards the negotiations with third countries on this issue require legal reassurance on the compatibility of the envisaged Agreement with the Treaty pursuant to the present request for the Court's opinion. It is however of great importance for the Community and for the European companies to achieve progress as soon as possible on the protection of intellectual property in Europe. For this reason, the Council respectfully indicates to the Court that it regards the present request as urgent and that it would be grateful if the Court could deal with it in the shortest time compatible with its procedures and with its current workload.

## **II. ADMISSIBILITY OF THE REQUEST FOR AN OPINION**

20. Under Article 300(6) TEC the Council may obtain the opinion of the Court of Justice as to whether an agreement envisaged is compatible with the provisions of the Treaty.

21. Article 107(2) of the Court's Rules of Procedure provides that the opinion may deal not only with the question of whether the envisaged agreement is compatible with the provisions of the EC Treaty but also with the question of whether the Community or any Community institution has the power to enter into that agreement.
22. The present request for an opinion fulfils the requirement laid down in Article 300(6) TEC to the effect that the agreement must be "envisaged". The text of the envisaged Agreement is not yet final, as the Council has explained<sup>14</sup>. However, although the drafting of certain clauses is still under discussion, a broad agreement seems to emerge in the Council on the basic structure of the system envisaged in the Agreement. According to Court case law on the admissibility of a request for an opinion on the question of Community competence, it is sufficient that the purpose of the envisaged agreement is known<sup>15</sup>. The Council considers that the draft text of the envisaged Agreement provides a sufficiently clear picture of its purpose.
23. Furthermore, the Court has already stated that the admissibility of the request for an opinion cannot be challenged on the grounds that the Council has not yet adopted a decision to open negotiations<sup>16</sup>. The Court also noted in its opinion 2/94 that "*the fact that the Council has set the Article 228(6) [now Article 300(6)] procedure in motion presupposes that it envisaged the possibility of negotiating and concluding such an agreement.*"<sup>17</sup>
24. In the present procedure, the Council considers that it is in the interest of all interested Parties, including non-member States, for the question of the compatibility of the envisaged Agreement with the Treaty to be clarified as soon as possible.

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<sup>14</sup> See paragraph 17 above.

<sup>15</sup> Opinion 2/94, Accession to the European Convention for the Protection of Human Rights, ECR [1996] p. I-1759, paragraph 11.

<sup>16</sup> Idem, paragraph 13.

<sup>17</sup> Idem, paragraph 14.

### III. AIM OF THE ENVISAGED AGREEMENT

25. The EPC lays down common rules on the grant of European patents. It also lays down an appeals procedure whereby decisions of the EPO granting or refusing a patent may be challenged before a Board of Appeal. However, other disputes concerning the validity or the infringement of a European patent may be brought before the courts in the different Contracting States in respect of which the relevant European patent was granted<sup>18</sup>. It follows that there is a risk of diverging decisions, whose actual existence was pointed out by the Commission and certain members of the Council.
26. The need to submit disputes to different courts results in higher costs and lower legal certainty for companies operating in the Community. The effect of this is to hinder innovation and competitiveness within the internal market, with the risk of possible obstacles to the fundamental freedoms provided for in the Treaty.
27. A single European-wide jurisdiction for actions relating to European patents would reduce the costs for companies which currently have to bring multiple infringement actions in all relevant EU Member States and would also reduce the risk of diverging decisions (where they are caused by different approaches by national courts as regards the protection afforded by European patents).
28. The envisaged Agreement would provide for such a unified jurisdiction for European patents for the Community's territory and that of other European States parties to the EPC.
29. The envisaged Agreement would use that same jurisdiction for Community patents, thus reducing the costs that two parallel unified jurisdictions (one for European patents and one for Community patents) would entail.

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<sup>18</sup> See judgment of the Court of 13 July 2006, C-539/03, Roche Nederland, ECR [2006] p. I-6535, paragraphs 29 to 31.

#### IV. COMMUNITY COMPETENCE

30. It is acknowledged by most delegations that certain provisions of the envisaged Agreement fall within the competence of the Community, which should therefore participate in the negotiations and in the conclusion of the Agreement.
31. The analysis of Community competence is necessarily different as regards European patents and as regards Community patents, since prima facie the extent of Community competence to define the organisation and powers of the jurisdiction to be established is not the same where the question submitted to that jurisdiction concerns a Community industrial property right as where the question concerns an industrial property right created and governed by international and national law.
32. As regards European patents, the aim and content of the measure consisting in the establishment and organisation of a specialised jurisdiction of an international nature for cases concerning patents, are essentially a matter that falls within Member States' competence. However, some of the provisions of the envisaged Agreement relate to matters for which the Community has already exercised its internal competence by laying down common rules. In the light of the case law of the Court of Justice, Member States no longer have the right, acting individually or collectively, to enter into obligations with third countries which may affect these rules or alter their scope<sup>19</sup>.
33. Rules in Regulation (EC) No 44/2001 on jurisdiction in civil and commercial matters may be considered to be affected by the provisions in Article 15 and 15a of the envisaged Agreement which provide that certain actions are to be referred to the new jurisdiction pursuant to the rules in the Agreement, necessarily disregarding the common rules on jurisdiction in that Regulation..

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<sup>19</sup> Judgment of the Court of 31 March 1971, case 22-70, AETR, ECR [1971] p. 263.

34. It might be argued on the contrary that, by creating an international jurisdiction, the rules on jurisdiction of Regulation No 44/2001 cannot apply and thus are not affected<sup>20</sup>.
35. However, it should be pointed out that it cannot be necessarily inferred from the wording in that Regulation that such rules should be applied only when Member States confer jurisdiction on "national" Courts, whatever "national" means in that context.
36. Additionally, provisions in Regulation (EC) No 44/2001 might be considered to be affected by Article 56 of the envisaged Agreement insofar as decisions by a Court in a Member State (such as the ECPC) are to be deemed to come within the scope of application of provisions on enforcement of judgments in that Regulation, in particular Articles 38 or 71 thereof.
37. Furthermore, the Lugano Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, concluded by Council Decision of 15 October 2007<sup>21</sup>, would probably be affected. This Convention applies "*in civil and commercial matters whatever the nature of the court or tribunal*".
38. Article 14a of the envisaged Agreement, which deals with the law to be applied by the ECPC, may also be considered to affect provisions in Regulation (EC) No 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I)<sup>22</sup> and provisions in Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II)<sup>23</sup>.

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<sup>20</sup> In its Recommendation to the Council (see paragraph 18 above) the Commission notes that "*the existing *acquis* relates to national courts procedures and may thus not be directly relevant. The proposed unified jurisdictional system would diverge from existing rules concerning national court structures to the extent required for its operation*".

<sup>21</sup> OJ L 339 of 21.12.2007, p. 1.

<sup>22</sup> OJ L 177 of 04.07.2008, p. 6.

<sup>23</sup> OJ L 199 of 31.07.2007, p. 40.

Even though Article 14a of the Agreement implicitly refers to these two Regulations in order to determine the applicable law, the Court has explained that the question of Community competence must be settled before the agreement is concluded and that a Community provision may be affected although the international commitment does not conflict with that provision<sup>24</sup>.

39. Furthermore, provisions in the envisaged Treaty on persons entitled to apply (Article 27), on provisional and protective measures (Article 37), on permanent injunctions (Article 37a), on the corrective measures in infringement procedures (Article 38), on the power to order the communication of information (Article 39), on award of damages (Article 41), on legal costs (Article 42) and on publication of decisions (Article 54) deal with matters which are regulated in Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights<sup>25</sup>, in particular in Articles 4, 9, 11 and 12, 10, 8, 13 and 14 thereof. It may therefore be concluded that, since the envisaged Agreement affects these Community provisions, the Community has competence to conclude an agreement covering those matters.

40. As regards the Community patent, it seems that determining the jurisdictional system entrusted with adjudicating on disputes on the application and validity of Community patents falls within Community competence. In its Opinion 1/03<sup>26</sup>, the Court noted that the Community has already adopted internal rules relating to jurisdiction on the basis of the specific provisions which appear in sectoral regulations, such as Title X of Regulation 40/94<sup>27</sup> or Article 6 of Directive 96/71<sup>28</sup>.

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<sup>24</sup> See judgment of the Court of 5 November 2002, *Commission v. Denmark*, C-467/98, ECR [2002] p. I-9519, paragraph 101 and Opinion 1/03 of the Court of 7 February 2006, *Lugano Convention*, ECR [2006] p. I-1145, paragraphs 130 and 154.

<sup>25</sup> OJ L 157 of 30.04.2004, p. 45.

<sup>26</sup> Already quoted, paragraph 134.

<sup>27</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ L 11 of 14.1.1994, p. 1.

<sup>28</sup> Directive 96/71/EC of the European Parliament and of the Council of 16 December 1996 concerning the posting of workers in the framework of the provision of services, OJ L 18 of 21.1.1997, p. 1.

41. Doubts have been expressed on whether the prerogative of the Community to establish a system of jurisdiction concerning the Community patents could be exercised via an international commitment. This issue will be analysed below when examining the compatibility of the envisaged Agreement with Article 229a of the Treaty.

## V. LEGAL ANALYSIS

42. A number of legal concerns have been expressed by and discussed in the Council. They can be outlined and summarised, for the Court's consideration, as follows, it being underlined that the presentation of the various issues is intended to be neutral, making no reference to the degree of support received by the various approaches, and that the Council is taking side neither for one answer nor for the other.

*A) The compatibility with the Treaty of conferring jurisdiction on the ECPC in cases relating to the validity and/or to the application of Community patents.*

43. The envisaged Agreement establishes that the ECPC shall have exclusive jurisdiction in respect of actions, among others, for revocation or for infringement of Community patents. It means that the judicial implementation of a Community patent and even its validity would be entrusted neither to the Court of Justice (pursuant to Articles 225a and 229a EC) nor to the national courts, but to the new jurisdiction.

44. Pursuant to the Regulation on a community patent, currently under discussion within the Council<sup>29</sup>, Community patents would be granted by the EPO, which is not a Community institution or body, but a body set up and governed by the EPC. However, the conditions for the validity of Community patents and the powers that they confer on their holders would be governed by Community law.

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<sup>29</sup> See paragraph 4 above.

45. Doubts have been raised as to the compatibility with the Treaty of a system whereby Community law - in particular concerning the validity of Community patents - is to be applied by a jurisdiction (the ECPC) outside the judicial systems of the Community and of the Member States.
46. It must be stated from the outset that an international agreement cannot affect the exclusive jurisdiction of the Court. However, the Court has not been given exclusive jurisdiction as regards any action which requires that Community law be applied. Rather, it may be argued that where the Court has not been granted exclusive jurisdiction, the general rule - with the exception of Article 229a EC which will be discussed below - is that disputes come within the jurisdiction of the courts and tribunals of the Member States regardless of whether or not they concern the application of Community law. In this sense, it may be noted that disputes on the validity and interpretation of Community trademarks may be submitted to national courts pursuant to Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark, notably Articles 91 and 92 thereof.
47. Article 229a EC does not create an obligation to submit disputes relating to the application of acts which create Community industrial property rights to the Court of Justice, but allows the Council "*to confer jurisdiction, to the extent that it shall determine, on the Court of Justice*" in such disputes (emphasis added). The possibility for the ECPC to refer a question of interpretation of the Treaty or validity and interpretation of acts of the institutions to the Court of Justice might be considered to reflect an option to confer jurisdiction on the Court of Justice to a limited extent. It might be considered on the contrary that the envisaged Agreement is not to confer jurisdiction on the Court of Justice in so far as such a possibility to refer a question already exists pursuant to Article 234 EC, but that there is no obligation for the Council to confer jurisdiction on the Court as regards disputes on Community patents.



48. The envisaged Agreement would not deprive the Court of Justice of exclusive jurisdiction as regards disputes relating to the application of acts which create the Community patent, since those actions do not fall within its exclusive competence. In so far as the Court's powers are not affected, Member States should be able to organise the structure of the judicial system as they think fit, including by setting up a court via an international agreement, provided the powers of the Court of Justice are respected. The envisaged Agreement aims at achieving this objective by providing an obligation for the ECPC to request a preliminary ruling from the Court of Justice when a question of interpretation of the Treaty or the validity and interpretation of acts of the institutions is raised. In that way, the ECPC would be in a similar position to national courts when applying Community law.
49. Arguments against the compatibility of the envisaged Agreement with the Treaty focus on the requirement to ensure the autonomy of the Community legal order in pursuing its own particular objectives. They note that the position of the ECPC differs from that of national courts. While national courts are directly bound by the Treaty and the jurisdictional system therein established, the ECPC would only be bound by the new Agreement. Thus, the ECPC would have to apply and respect Community law in so far as prescribed by this Agreement. Although care has been taken to ensure that Community law is respected, its legal standing cannot be the same since it depends on the provisions of the envisaged Agreement.
50. Additionally, the system currently envisaged does not foresee any sort of appeal on points of law ("cassation") before any Court outside the ECPC, in particular before the Court of Justice. It follows that there are no legal remedies available in case of misapplication of Community law by the Court of Appeal of the ECPC. Doubts have been expressed as to the compatibility with the Treaty of such a system which lacks available remedies provided for in the Treaty (e.g. actions for reparation of damages caused to individuals by infringements of Community law<sup>30</sup> or infringement procedures under Articles 226 et seq of the EC Treaty).

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<sup>30</sup> See judgment of the Court of 30 September 2003, case C-224/01, Köbler, ECR [2003] p. I-10239.

51. While doubts have been expressed mainly on the application by the ECPC of Community provisions on the Community patent, it must be noted that - when adjudicating on disputes concerning European patents - the ECPC is also likely to be called upon to interpret and apply Community provisions which may affect or regulate the subject-matter of the dispute.

*B) Primacy of Community law*

52. In a similar vein to the previous sub-chapter, questions have been raised about the ability of the envisaged system to ensure effective implementation of the principle of the primacy of Community law.

53. The envisaged Agreement lays down the obligation for the ECPC to respect Community law and to base its decision, inter alia, on directly applicable Community law (Article 14a). Furthermore, when a question of interpretation of the Treaty or the validity and interpretation of acts of the institutions is raised before the ECPC, its Court of First Instance has the possibility and its Court of Appeal has the obligation to request the Court of Justice to decide on the question. The decision by the Court of Justice shall be binding on the ECPC (Article 48).

54. The obligation for the ECPC to respect Community law is intended to have a very wide scope, covering not only the Treaty and acts of the institutions but also the applicable general principles and the case-law. It may be argued that the ECPC would thus be required to apply Community law in the same way as national courts and it would be subject to a similar obligation to request a decision from the Court of Justice where necessary.

55. However, it may also be argued that the primacy of Community law over the envisaged Agreement is not absolute under Article 14a of this Agreement and that, as stated in point 50 above, a failure by the ECPC to abide by Community law as interpreted by the Court of Justice - were it to happen - could remain without remedy.

*C) Preliminary rulings submitted to the Court by a non-national court*

56. Article 48 of the envisaged Agreement lays down a procedure for the ECPC submitting a request for a preliminary ruling in analogous terms to those of Article 234 CE.

57. Doubts have been raised as to the compatibility with the Treaty of allowing for such request where this is not provided for in the Treaty.

58. The Court has stated that an international agreement concluded by the Community may confer new powers on the Court or other institutions, provided that in so doing it does not change the essential character of the powers conferred on the Community institutions by the Treaty<sup>31</sup>. In its opinion 1/00<sup>32</sup>, the Court considered that the possibility for courts of third States to refer questions to the Court of Justice for a preliminary ruling was compatible with the Treaty, provided certain conditions were fulfilled. It may be inferred that extending that possibility to a court, like the ECPC, set up by an international agreement would not change the essential character of the powers vested in the Court of Justice by the Treaty.

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<sup>31</sup> See footnote 10.

<sup>32</sup> Already quoted.

D) Article 229a EC

59. As explained above, the envisaged Agreement confers limited jurisdiction - via preliminary rulings - on the Court of Justice in disputes relating to the application of acts adopted on the basis of the Treaty which create the Community patent.
60. Doubts have been expressed as to the possibility of exercising that competence by entering into an international agreement. Indeed, the case law of the Court of Justice has laid down the conditions regarding and the limits to the doctrine of the implied powers of the Community in external relations. The Court *"has held that the Community's competence to enter into international commitments may arise not only from express conferment by the Treaty but also by implication from provisions of the Treaty. Such implied external competence exists not only whenever the internal competence has already been used in order to adopt measures for implementing common policies, but also if the internal Community measures are adopted only on the occasion of the conclusion and implementation of the international agreement. Thus, the competence to bind the Community in relation to non-member countries may arise by implication from the Treaty provisions establishing internal competence, provided that participation of the Community in the international agreement is necessary for attaining one of the Community's objectives (see Opinion 1/76, paragraphs 3 and 4)."*<sup>33</sup>
61. It is difficult to ascertain how an international agreement may be necessary for attaining the objective of conferring jurisdiction on the Court of Justice as regards Community acts, insofar as the participation of third countries seems clearly superfluous as regards Community patents. It might be argued that implied external powers of the Community cannot be inferred from Article 229a of the EC Treaty .

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<sup>33</sup> Judgment of the Court of 5 November 2002, Commission v. Denmark, case C-467/98, ECR [2002] p. I-9519, paragraph 56.

62. However, it might also be argued that the international agreement is necessary to provide for a unified jurisdiction for both Community and European patents, which is the aim of the envisaged Agreement in order to attain the objective of an internal market without obstacles. As explained above<sup>34</sup>, it might also be argued that the envisaged Agreement does not confer jurisdiction on the Court. The powers granted to the Court in Article 48 of the envisaged Agreement would be merely aimed at excluding the possibility of a request for a preliminary ruling by the Court of Justice disappearing as a consequence of granting jurisdiction in disputes between private parties to a non-national court.

## VI. PROCEDURAL SUGGESTION

63. Article 107(1) of the Court's Rules of Procedure lays down that, if the request for a prior opinion pursuant to Article 300 of the EC Treaty is submitted by the Council, it is to be served on the Commission and on the European Parliament. Contrary to cases in which a request for an opinion is submitted by the Commission or by a Member State, a request submitted by the Council is not therefore automatically served on the Member States so that they may submit their written observations.

64. However, there is nothing to stop the Court from serving such a request for an opinion also on the Member States and inviting them to comment on this request for an opinion. The Court did precisely that in the context of the procedure concerning Opinions 2/94<sup>35</sup> and 1/03<sup>36</sup>.

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<sup>34</sup> See paragraph 48 above.

<sup>35</sup> Already quoted.

<sup>36</sup> Already quoted.

65. The Council considers that it would be necessary in the present case to allow the Member States to comment on the question posed by the Council. Discussions within the Council have established that members of the Council have different views on the importance of legal doubts expressed as regards the compatibility of the envisaged Agreement with the Treaty.

66. In consequence, the Council suggests that the Court serve the request for an opinion also on the Member States and that it invite those Member States which so desire to submit their written observations.

## VII. CONCLUSIONS

67. In conclusion, the Council

- requests the opinion of the Court of Justice, under Article 300(6) EC, on the following question:

*"Is the envisaged Agreement creating a Unified Patent Litigation System (currently named European and Community Patents Court) compatible with the provisions of the Treaty establishing the European Community?"*

- suggests that the Court serve this request for an opinion also on the Member States and that it invite those Member States which so desire to submit their written observations.

## TABLE OF ANNEXES

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Annex 2	23 March 2009	Working Document on a Revised Presidency text on a Draft Agreement on the European and Community Patents Court and Draft Statute Council document 7928/09	76	Page 8, point 17, of the Request for an opinion
Annex 3	23 March 2009	Recommendation from the Commission to the Council to authorise the Commission to open negotiations for the adoption of an Agreement creating a Unified Patent Litigation System. Council document 7927/09	9	Page 8, point 18, of the Request for an opinion