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¿IP forum shopping? Not always on sale

Carolina Pina (Garrigues) · Monday, April 10th, 2017

The Spanish Supreme Court has concluded that it is not appropriate to waive the Court jurisdiction from the defendant's domicile (in this case Italy), which had ruled against the claimant, by creating a link with another entity that it is domicile in another European country (in this case Spain), when that connection is not sufficiently direct.

The facts are as follows:

- BMW filed a complaint before the European Union Trade Mark and Design Court in Alicante against Acacia, S.R.L. ("**Acacia**") and Autohaus Motorsport, S.L. ("**Autohaus**") due to the offer, promotion, marketing and sale of rims which, according to BMW, infringe its Community models that protect specific wheel rims.
- Autohaus is a Spanish automobile repair garage and retailer which sells replacement rims.
- Acacia (which is domicile in Naples, Italy) is the company that distributes the alleged infringing products sold by Autohaus.
- BMW had already filed a claim against Acacia before the Neapolitan Courts (the competent jurisdiction) which was unsuccessful. This Court, had upheld the manufacture and distribution of replacement wheel rims on the understanding that they are a replacement of a complicated product needed to return it to its initial state.
- The claimant considered that the fact that one of the defendants was a distributor and the other a vendor of wheel rims meant that they were very closely related, and therefore it was necessary to file a jointly claim against both companies in order to ensure that there would be no irreconcilable pronouncements with regard to the case, given that the legal and factual situation was the same.
Spanish case law clearly establishes that this forum by connection is subsidiary, and that it could not be used to remove the jurisdiction corresponding to one of the defendants.
- The Court of First Instance ruled against the defendants for infringement of the Community models, despite the fact that the Italian distributor requested the dismissal of the claim, due to a lack of competence, as it should have been filed in Naples where the distributor is domiciled.
- In the Second Instance, the claim was dismissed with regard to Acacia. Finally, the claimant appealed before the Supreme Court alleging that the connection between

both companies was sufficient to be able to bring the Neapolitan distributor to the proceedings in Spain, and that this was not a case of *Forum Shopping*.

The Supreme Court concluded that the real motivation for filing the claim in Alicante, against both the Italian distributor and the Spanish automobile repair company that sold the rim wheels, was to waive the Court jurisdiction from Naples, which had been unfavourable to the claimant, to the Spanish jurisdiction, which was more favourable to its case. The Supreme Court considers that this type of “*forum shopping*” is unacceptable.

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