

Court of Justice EU, 5 September 2019, AMS Neve v Heritage Audio



TRADE MARK LAW – PRIVATE INTERNATIONAL LAW

In the event of an alleged infringement through online advertising, the proprietor of a EU trade mark may bring an infringement action against a third party before the national trade mark court where the target audience of the infringing online advertisement is located

- the expression ‘the act of infringement’ must be understood as relating to acts, specified in Article 9, which the applicant claims to have been committed by the defendant, such as, in this case, acts specified in Article 9(2)(b) and (d) of that article, consisting of advertising and offers for sale under a sign identical to the mark at issue, and those acts must be held to have been ‘committed’ in the territory where they can be classified as advertising or as offers for sale, namely where their commercial content has in fact been made accessible to the consumers and traders to whom it was directed. Whether the result of that advertising and those offers for sale was that, thereafter, the defendant’s products were purchased is, however, irrelevant

59 If the rule of jurisdiction laid down in Article 97(5) of Regulation No 207/2009 were to be interpreted as meaning that that provision did not, unlike Article 5(3) of Regulation No 44/2001, permit the proprietors of EU marks to bring an infringement action before the courts of the Member State within which they seek a declaration of an infringement, the consequence would be that those proprietors would bring proceedings alleging infringement of an EU trade mark and proceedings alleging infringement of parallel national trade marks before courts of different Member States. Frequent application of the mechanism provided in Article 109 of Regulation No 207/2009 to resolve cases of *lis pendens* would, because of such a divergent approach in Article 97(5) of Regulation No 207/2009 (now Article 125(5) of Regulation 2017/1001) and Article 5(3) of Regulation No 44/2001 (now Article 7(2) of Regulation No 1215/2012), be likely, thereby defeating the objective, pursued by those regulations, of reducing cases of *lis pendens*.

Source: [ECLI:EU:C:2019:674](#)

Court of Justice EU, 9 September 2019

(E. Regan, C. Lycourgos, E. Juhász, M. Ilešič (Rapporteur) and I. Jarukaitis)

JUDGMENT OF THE COURT (Fifth Chamber)

5 September 2019 (\*)

(Reference for a preliminary ruling — EU trade mark — Regulation (EC) No 207/2009 — Article 97(5) — Jurisdiction — Infringement proceedings — Jurisdiction of the courts of the Member State in which ‘the act of infringement has been committed’ — Advertising and offers for sale displayed on a website and on social media platforms)

In Case C-172/18,

REQUEST for a preliminary ruling under Article 267 TFEU from the Court of Appeal (England & Wales) (Civil Division), made by decision of 12 February 2018, received at the Court on 5 March 2018, in the proceedings

AMS Neve Ltd,  
Barnett Waddingham Trustees,  
Mark Crabtree

v

Heritage Audio SL,  
Pedro Rodríguez Arribas,  
THE COURT (Fifth Chamber),

composed of E. Regan, President of the Chamber, C. Lycourgos, E. Juhász, M. Ilešič (Rapporteur) and I. Jarukaitis, Judges,

Advocate General: M. Szpunar,

Registrar: L. Carrasco Marco, Administrator,

having regard to the written procedure and further to the hearing on 17 January 2019,

after considering the observations submitted on behalf of:

– AMS Neve Ltd, Barnett Waddingham Trustees and Mr Crabtree, by M. McGuirk and E. Cronan, Solicitors, and by J. Moss, Barrister,

– Heritage Audio SL and Mr Rodríguez Arribas, by A. Stone and R. Crozier, Solicitors, and by J. Reid, Barrister,

– the German Government, initially by T. Henze, M. Hellmann and J. Techert, and subsequently by M. Hellmann and J. Techert, acting as Agents,

– the European Commission, by J. Samnadda, É. Gippini Fournier and M. Wilderspin, acting as Agents, after hearing [the Opinion of the Advocate General at the sitting on 28 March 2019](#),

gives the following

#### Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 97(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1).

2 The request has been made in proceedings where the opposing parties are AMS Neve Ltd, Barnett Waddingham Trustees (‘BW Trustees’) and Mr Mark Crabtree, on the one hand, and Heritage Audio SL and Mr Pedro Rodríguez Arribas, on the other, concerning an infringement claim arising from the alleged wrongful use of rights conferred by, inter alia, an EU trade mark.

#### Legal context

3 Regulation (EC) No 207/2009, which had repealed and replaced Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. It was subsequently repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1). However, given the date when the action claiming the infringement at issue in the main proceedings was brought, this reference for a preliminary ruling shall be examined having regard to Regulation No 207/2009, in its initial version.

4 Recital 17 of Regulation No 207/2009 states:

*‘Contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of a [European Union] trade mark and parallel national trade marks. ...’*

5 Article 9(1) and (2) of that regulation provided:

*‘1. The [European Union] trade mark shall confer on the proprietor exclusive rights therein: The proprietor shall be entitled to prevent all third parties not having his/her consent from using in the course of trade:*

*(a) any sign which is identical with the [European Union] trade mark in relation to goods or services which are identical with those for which the [European Union] trade mark is registered;*

*(b) any sign where, because of its identity with, or similarity to, the [European Union] trade mark and the identity or similarity of the goods or services covered by the [European Union] trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;*

...

*2. The following, inter alia, may be prohibited under paragraph 1:*

...

*(b) offering the goods, putting them on the market ... under that sign ...;*

...

*(d) using the sign ... in advertising.’*

6 Article 94 of Regulation No 207/2009 stated:

*‘1. Unless otherwise specified in this Regulation, [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, p. 1)] shall apply to proceedings relating to [European Union] trade marks and applications for [European Union] trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of [European Union] trade marks and national trade marks.*

*2. In the case of proceedings in respect of the actions and claims referred to in Article 96:*

*(a) Articles 2 and 4, points 1, 3, 4 and 5 of Article 5, and Article 31 of Regulation (EC) No 44/2001 shall not apply;*

...’

7 Article 95(1) of that regulation provided:

*‘The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as “[European Union] trade mark courts”, which shall perform the functions assigned to them by this Regulation.’*

8 Article 96 of that regulation provided:

*‘The [European Union] trade mark courts shall have exclusive jurisdiction:*

*(a) for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to [European Union] trade marks;*

...’

9 Article 97 of that Regulation stated:

*‘1. Subject to the provisions of this Regulation as well as to any provisions of Regulation (EC) No 44/2001 applicable by virtue of Article 94, proceedings in respect of the actions and claims referred to in Article 96 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.*

...

*5. Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of [a European Union] trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened ...’*

10 Article 98 of Regulation No 207/2009 provided:

*‘1. A [European Union] trade mark court whose jurisdiction is based on Article 97(1) to (4) shall have jurisdiction in respect of:*

*(a) acts of infringement committed or threatened within the territory of any of the Member States;*

...

*2. A [European Union] trade mark court whose jurisdiction is based on Article 97(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.’*

11 Article 109(1) of Regulation No 207/2009 provided:

*‘Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of a [European Union] trade mark and the other seized on the basis of a national trade mark:*

*(a) the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested;*

*(b) the court other than the court first seized may stay its proceedings where the trade marks concerned are*

*identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.'*

12 The wording of Articles 9, 94 to 98 and 109 of Regulation No 207/2009 was, essentially, reproduced in Articles 9, 122 to 126 and 136 of Regulation 2017/1001. Article 125(5) of Regulation 2017/1001 corresponds to Article 97(5) of Regulation No 207/2009 and to Article 93(5) of Regulation No 40/94.

13 Regulation No 44/2001, to which reference is made in Articles 94 and 97 of Regulation No 207/2009, was replaced by Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1). Under Article 66(1) of the latter regulation, it *'shall apply only to legal proceedings instituted, to authentic instruments formally drawn up or registered and to court settlements approved or concluded on or after 10 January 2015'*.

#### **The dispute in the main proceedings and the question referred for a preliminary ruling**

14 AMS Neve is a company established in the United Kingdom which manufactures and sells audio equipment. BW Trustees, also established in the United Kingdom, is the trustee of the AMS Neve executive pension scheme. Mr Crabtree is a director of AMS Neve.

15 Heritage Audio is a company established in Spain which sells and supplies audio equipment. Mr Rodríguez Arribas, who is domiciled in Spain, is the sole director of Heritage Audio.

16 On 15 October 2015 AMS Neve, BW Trustees and Mr Crabtree brought an action against Heritage Audio and Mr Rodríguez Arribas before the Intellectual Property and Enterprise Court (United Kingdom) claiming infringement of an EU trade mark of which BW Trustees and Mr Crabtree are the proprietors and for the use of which AMS Neve is exclusively licensed.

17 Their action concerns, in addition, the alleged infringement of two marks registered in the United Kingdom of which BW Trustees and Mr Crabtree are also the proprietors.

18 The EU trade mark relied on consists of the figure 1073 and was registered for goods within Class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The description of the goods covered is in part as follows: *'sound studio recording, mixing and processing equipment'*.

19 The defendants in the main proceedings are alleged to have offered for sale to consumers in the United Kingdom imitations of goods of AMS Neve bearing a sign that is identical or similar to that EU trade mark and to the national trade marks or referring to that sign, and to have advertised those products.

20 The applicants in the main proceedings have submitted documents in support of their action, including the contents of the Heritage Audio website and the latter's Facebook and Twitter accounts, an invoice issued by Heritage Audio to an individual residing in the

United Kingdom and correspondence between Heritage Audio and a person established in the United Kingdom concerning possible deliveries of audio equipment.

21 The applicants in the main proceedings have in particular submitted screenshots from that website on which they claim appeared offers to sell audio equipment bearing a sign identical or similar to that EU trade mark. They have stressed that the offers for sale are worded in English and that a section headed *'where to buy'* lists distributors established in various countries, including the United Kingdom. Further, they claim that it is apparent from the general sale conditions that Heritage Audio accepts orders from any EU Member State.

22 The defendants in the main proceedings pleaded that the court before which the action was brought had no jurisdiction.

23 While the defendants do not deny that Heritage Audio products might have been purchased, in the United Kingdom, through other companies, they assert that they have not, themselves, either advertised in the United Kingdom or made any sales in that Member State. They further assert that they have never appointed a distributor for the United Kingdom. Last, they contend that the content displayed on the Heritage Audio website and on the platforms to which the applicants in the main proceedings refer was, by the time of the period covered by the infringement action, obsolete and ought not therefore to be taken into account.

24 By judgment of 18 October 2016, the Intellectual Property and Enterprise Court held that it had no jurisdiction to hear the infringement action in so far as that action is based on the EU trade mark at issue.

25 That court states that the applicants in the main proceedings submitted evidence capable of proving that the Heritage Audio website was directed to, *inter alia*, the United Kingdom. That court considers, further, that the facts of the dispute before it enable it to find that Mr Rodríguez Arribas is jointly liable for the acts of Heritage Audio and that the courts of the United Kingdom have jurisdiction to hear the case in so far as that dispute concerns the protection of national intellectual property rights.

26 The Intellectual Property and Enterprise Court considers, on the other hand, that that dispute, in so far as it concerns infringement of the EU trade mark, is subject, in accordance with Article 97(1) of Regulation No 207/2009, to the jurisdiction of the courts of the Member State in whose territory the defendant is domiciled, in this case the Kingdom of Spain. The Intellectual Property and Enterprise Court adds that the jurisdiction of the Spanish courts also stems from Article 97(5) of that regulation, under which infringement actions may also be brought before the courts of the Member State in whose territory the act of infringement has been committed.

27 As regards the latter provision, the Intellectual Property and Enterprise Court considers that the court which has territorial jurisdiction to hear an action brought by the proprietor of a mark against a third party that has used signs identical or similar to that mark in

advertising and offers for sale on a website or on social media platforms is the court with jurisdiction over the place where the third party decided to place that advertising or to offer for sale products on that site or on those platforms and took steps to give effect to that decision.

28 The applicants in the main proceedings brought an appeal against that judgment before the Court of Appeal (England & Wales) (Civil Division).

29 The referring court considers that the court of first instance, while referring in its judgment to certain [judgments of the Court, such as those of 19 April 2012, Wintersteiger \(C-523/10, EU:C:2012:220\)](#), and of [5 June 2014, Coty Germany \(C-360/12, EU:C:2014:1318\)](#), misinterpreted those judgments and the case-law of the Court in general.

30 The referring court is of the opinion that such an interpretation would lead, in essence, to a finding that *'the Member State in which the act of infringement has been committed'*, within the meaning of Article 97(5) of Regulation No 207/2009, is the Member State in which the defendant set up its website and its social media accounts. According to the referring court, it follows, however, from the wording, purpose and context of that provision that the territory of the Member State subject to that provision is that in which the consumers or traders to whom the advertising and offers for sale are directed are resident.

31 The referring court adds that the Bundesgerichtshof (Federal Court of Justice, Germany), in its *'Parfummarken'* judgment of 9 November 2017 (I ZR 164/16), held that the interpretation of the wording *'law of the country in which the act of infringement was committed'*, in Article 8(2) of 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) (OJ 2007 L 199, p. 40), adopted in the [judgment of 27 September 2017, Nintendo \(C-24/16 and C-25/16, EU:C:2017:724\)](#), can be transposed to Article 97(5) of Regulation No 207/2009. However, the referring court has some doubts with regard to that finding of the Bundesgerichtshof.

32 In those circumstances, the Court of Appeal (England & Wales) (Civil Division) decided to stay proceedings and to refer to the Court the following question for a preliminary ruling, adding in its decision that that question concerns the interpretation of Article 97(5) of Regulation No 207/2009:

*'In circumstances where an undertaking is established and domiciled in Member State A and has taken steps in that territory to advertise and offer for sale goods under a sign identical to an EU trade mark on a website targeted at traders and consumers in Member State B:*

*(i) does an EU trade mark court in Member State B have jurisdiction to hear a claim for infringement of the EU trade mark in respect of the advertisement and offer for sale of the goods in that territory?*

*(ii) if not, which other criteria are to be taken into account by that EU trade mark court in determining whether it has jurisdiction to hear that claim?*

*(iii) in so far as the answer to (ii) requires that EU trade mark court to identify whether the undertaking has taken active steps in Member State B, which criteria are to be taken into account in determining whether the undertaking has taken such active steps?'*

#### **Consideration of the question referred**

33 By its question, the referring court seeks, in essence, to ascertain whether Article 97(5) of Regulation No 207/2009 must be interpreted as meaning that the proprietor of an EU trade mark who considers that his rights are infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before an EU trade mark court of the Member State in which consumers and traders targeted by that advertising and by those offers for sale are located, notwithstanding the fact that the third party made decisions and took steps in another Member State to bring about that electronic display.

34 It must, first, be recalled that, notwithstanding the principle that Regulation No 44/2001 — and, as from 10 January 2015, Regulation No 1215/2012 — applies to court proceedings relating to an EU trade mark, Article 94(2) of Regulation No 207/2009 precludes, with respect, in particular to actions concerning the infringement of such a mark, the application of certain provisions of Regulation No 44/2001, such as the application of the rules contained in Articles 2 and 4 and Article 5(3) of the latter regulation. In the light of that exclusion, the jurisdiction of the EU trade mark courts referred to in Article 95(1) of Regulation No 207/2009 to hear actions claiming an infringement of an EU trade mark follows from rules directly provided for by Regulation No 207/2009, which have the character of *lex specialis* in relation to the rules provided for by Regulation No 44/2001 ([judgments of 5 June 2014, Coty Germany, C-360/12, EU:C:2014:1318](#), paragraphs 26 and 27, and of [18 May 2017, Hummel Holding, C-617/15, EU:C:2017:390](#), paragraph 26).

35 On the other hand, with respect to national trade marks, Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), did not establish specific rules in relation to jurisdiction. The same is true of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1), which repealed and replaced, with effect from 15 January 2019, Directive 2008/95.

36 Consequently, an infringement action such as that brought by the applicants in the main proceedings on 15 October 2015 falls, in so far as it concerns national trade marks, within the scope of the rules on jurisdiction set out by Regulation No 1215/2012 and, in so far as it concerns an EU trade mark, within the scope of the rules on jurisdiction set out by Regulation No 207/2009.

37 Under Article 97(1) of Regulation No 207/2009, where the defendant is domiciled in a Member State, the

applicant is to bring its action before the courts of that Member State.

38 However, Article 97(5) of that regulation states that the applicant may 'also' bring its action before the courts of the Member State 'in which the act of infringement has been committed or threatened'.

39 Article 98(1) of that regulation states that where an action is brought before an EU trade mark court on the basis of Article 97(1) of that regulation, it has jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States, and Article 98(2) of that regulation states that, where an action is brought before such a court on the basis of Article 97(5) of that regulation, it has jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

40 It follows from that distinction that the applicant, according to whether he chooses to bring infringement proceedings before the EU trade mark court where the defendant is domiciled or before the EU trade mark court of the place where the act of infringement has been committed or threatened, determines the extent of the territorial jurisdiction of the court before which the action is brought. When the infringement action is based on Article 97(1), it potentially covers acts of infringement committed throughout the European Union, whereas, when the action is based on Article 97(5), the action is restricted to acts of infringement committed or threatened within a single Member State, namely the Member State where the court before which the action is brought is situated.

41 The right conferred on the applicant to choose one or other basis, arising from the use of the word 'also' in Article 97(5) of Regulation No 207/2009, cannot be understood as meaning that the applicant may, with reference to the same acts of infringement, simultaneously bring actions based on paragraphs (1) and (5) of Article 97, but merely reflects, as stated by the Advocate General in point 31 of his Opinion, the fact that the forum indicated in Article 97(5) is an alternative to the fora indicated in the other paragraphs of that article.

42 The EU legislature, in providing for such an alternative forum and restricting, in Article 98(2) of Regulation No 207/2009, the territorial jurisdiction attached to that forum, enables the proprietor of the EU trade mark to bring, if he wishes, targeted actions each of which relates to acts of infringement committed within a single Member State. As the Court has stated previously, where a number of infringement actions involving the same parties concern the use of the same sign but do not relate to the same territory, they do not have the same subject matter and are therefore not subject to the rules on *lis pendens* (see, to that effect, [judgment of 19 October 2017, Merck, C-231/16, EU:C:2017:771](#), paragraph 42). Accordingly, the courts of the various Member States before which actions are brought in such circumstances cannot deliver 'contradictory judgments', within the meaning of recital

17 of Regulation No 207/2009, since the actions that the applicant has brought relate to distinct territories.

43 The foregoing considerations must guide the Court in responding to the concerns of the referring court in relation to the meaning of the wording 'Member State in which the act of infringement has been committed', in Article 97(5) of Regulation No 207/2009.

44 The Court has stated, when called on to provide an interpretation of Article 93(5) of Regulation No 40/94, that the criterion for jurisdiction expressed in that wording relates to active conduct on the part of the person causing the alleged infringement ([judgment of 5 June 2014, Coty Germany, C-360/12, EU:C:2014:1318](#), paragraph 34).

45 The Court concluded that, in the event of a sale and delivery of a counterfeit product in one Member State, followed by a resale by the purchaser in another Member State in which the original seller has not himself acted, that criterion is not sufficient to establish the jurisdiction of the EU trade mark court of the latter Member State to hear an infringement action brought against the initial seller. Such jurisdiction would be based on an effect of the infringement committed by the original seller and not on the alleged unlawful act committed by the original seller, which would be contrary to the sense of the wording 'Member State in which the act of infringement has been committed' (see, to that effect, [judgment of 5 June 2014, Coty Germany, C-360/12, EU:C:2014:1318](#), paragraphs 34, 37 and 38).

46 In accordance with that case-law and the considerations set out in paragraphs 40 to 42 of the present judgment, an EU trade mark court before which an infringement action on the basis of Article 97(5) of Regulation No 207/2009 is brought must, when it is called upon to review its jurisdiction to give a ruling on whether there is an infringement in the territory of the Member State where that court is situated, be satisfied that the acts allegedly committed by the defendant were committed in that territory.

47 Where the acts allegedly committed by the defendant consist of advertising and offers for sale displayed electronically with respect to products bearing a sign identical or similar to an EU trade mark without the consent of the proprietor of that mark, it is necessary, as follows from paragraph 63 of the [judgment of 12 July 2011, L'Oréal and Others \(C-324/09, EU:C:2011:474\)](#), to hold that those acts, which fall within the scope of Article 9(2)(b) and (d) of Regulation No 207/2009, were committed in the territory where the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding the fact that the defendant is established elsewhere, that the server of the electronic network that he uses is located elsewhere, or even that the products that are the subject of such advertising and offers for sale are located elsewhere.

48 As is apparent from the same paragraph of [that judgment](#), it must be ensured that a third party who directs advertising and offers for sale to EU consumers using a sign identical or similar to an EU trade mark in

relation to products that are identical or similar to the goods for which that mark is registered cannot evade the application of Article 9 of Regulation No 207/2009 and thereby undermine the effectiveness of that provision by relying on the fact that that advertising and those offers for sale were placed online outside the European Union. 49 Similarly, it must be ensured that a third party who has used a sign identical or similar to an EU trade mark without the consent of the proprietor of that mark in relation to products that are identical or similar to the goods for which that mark is registered cannot contest the application of Article 97(5) of Regulation No 207/2009 and thereby undermine the effectiveness of that provision by relying on the place where his advertising and those offers for sale were placed online in order to exclude the jurisdiction of any court other than the court of that place and the court with jurisdiction over where he is established.

50 If the wording '*Member State in which the act of infringement has been committed*', in Article 97(5) of Regulation No 207/2009, were to be interpreted as meaning that it refers to the Member State in the territory of which the person carrying out those commercial acts set up his website and activated the display of his advertising and offers for sale, parties established within the European Union committing an infringement, operating electronically and seeking to prevent the proprietors of infringed EU marks from resorting to an alternative forum, would have to do no more than ensure that the territory where the advertising and offers for sale were placed online was the same territory as that where those parties are established. In that way, Article 97(5) of that regulation, would, in the event that the advertising and the offers for sale are directed to consumers of other Member States, be deprived of any scope constituting an alternative to that of the rule on jurisdiction laid down in Article 97(1).

51 An interpretation of the wording '*Member State in which the act of infringement has been committed*' as meaning that it refers to the place where the defendant took decisions and technical measures to activate a display on a website is all the more inappropriate given that it may, in many cases, prove excessively difficult, or even impossible, for the applicant to identify that place. As opposed to situations in which proceedings are already pending, a factor in the situation in which the proprietor of the EU trade mark finds himself before the bringing of court proceedings is that it is impossible to compel the defendant to disclose that place, when no action has been brought before any court at that stage.

52 In order to maintain the effectiveness of the EU legislature's provision of an alternative forum, it is necessary, in accordance with the case-law to the effect that the terms of a provision of EU law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must be interpreted having regard to the context of the provision and the objectives pursued by the legislation of which it forms part (see, inter alia, [judgments of 3 September 2014, Deckmyn and Vrijheidsfonds, C-201/13, EU:C:2014:2132](#), paragraph 14, and of [18 May 2017,](#)

[Hummel Holding, C-617/15, EU:C:2017:390](#), paragraph 22), to give to the wording '*Member State in which the act of infringement has been committed*' an interpretation which is consistent with the other provisions of Regulation No 207/2009 with respect to infringement.

53 One of those provisions is, in particular, Article 9 of that regulation, which lists the acts of infringement which the proprietor of an EU trade mark can contest.

54 Accordingly, the expression '*the act of infringement*' must be understood as relating to acts, specified in Article 9, which the applicant claims to have been committed by the defendant, such as, in this case, acts specified in Article 9(2)(b) and (d) of that article, consisting of advertising and offers for sale under a sign identical to the mark at issue, and those acts must be held to have been '*committed*' in the territory where they can be classified as advertising or as offers for sale, namely where their commercial content has in fact been made accessible to the consumers and traders to whom it was directed. Whether the result of that advertising and those offers for sale was that, thereafter, the defendant's products were purchased is, however, irrelevant.

55 Subject to the findings of the referring court, the documents available to the Court and the question referred indicate that the object of the applicants in the main proceedings, by means of the infringement proceedings brought before that court, is the advertising and offers for sale displayed by the defendants on a website and on social media platforms solely to the extent that that advertising and those offers for sale were directed to consumers and/or traders in the United Kingdom.

56 Accordingly, in circumstances such as those at issue in the main proceedings, if it is apparent from the content of the website and the platforms at issue submitted by the applicants in the main proceedings that the advertising and offers for sale which they contained were targeted at consumers or traders situated in the United Kingdom and were entirely accessible by them, which is a finding that it is for the referring court to make on the basis of, inter alia, the details contained on that website and those platforms with respect to the geographical areas where the products at issue were to be delivered ([judgment of 12 July 2011, L'Oréal and Others, C-324/09, EU:C:2011:474](#), paragraphs 64 and 65), those applicants have the right to bring, on the basis of Article 97(5) of Regulation No 207/2009, their infringement action before a court of the United Kingdom, seeking a declaration of an infringement of the EU trade mark in that Member State.

57 That interpretation is supported by the fact that the EU trade mark courts of the Member State where the consumers or traders, to whom such advertising and offers for sale are directed are resident, are particularly suited to assessing whether the alleged infringement exists. In paragraphs 28 and 29 of the [judgment of 19 April 2012, Wintersteiger \(C-523/10, EU:C:2012:220\)](#), the Court took account of that factor of proximity, interpreting the wording '*the place where the harmful event occurred*', in Article 5(3) of

Regulation No 44/2001, as meaning that the proprietor of a national mark may bring an infringement action before the courts of the Member State in which the national mark is registered, since those courts are, having regard to the criteria for assessing infringement established in the [judgments of 23 March 2010, Google France and Google \(C-236/08 to C-238/08, EU:C:2010:159\)](#), and of [12 July 2011, L'Oréal and Others \(C-324/09, EU:C:2011:474\)](#), best able to assess whether the mark has been infringed. The courts of the place where the harmful event occurred are particularly suited to giving a ruling by reason of proximity and ease of taking evidence ([judgment of 17 October 2017, Bolagsupplysningen and Ilsjan, C-194/16, EU:C:2017:766](#), paragraph 27 and the case-law cited).

58 The interpretation of Article 97(5) of Regulation No 207/2009, as *lex specialis* with respect to actions alleging infringement of EU marks, must, it is true, be independent of the interpretation of Article 5(3) of Regulation No 44/2001 adopted by the Court with respect to actions alleging infringement of national marks ([judgment of 5 June 2014, Coty Germany, C-360/12, EU:C:2014:1318](#), paragraph 31). Nonetheless, the interpretations of the concepts of *'Member State in which the act of infringement has been committed'* and *'the place where the harmful event occurred'*, in those provisions, must have a degree of consistency in order, in accordance with the objective laid down in recital 17 of Regulation No 207/2009, to reduce as far as possible cases of *lis pendens* as a result of the bringing of actions, in different Member States, involving the same parties and the same territory, one brought on the basis of an EU trade mark and another on the basis of parallel national trade marks (see, to that effect, [judgment of 19 October 2017, Merck, C-231/16, EU:C:2017:771](#), paragraphs 30 to 32).

59 If the rule of jurisdiction laid down in Article 97(5) of Regulation No 207/2009 were to be interpreted as meaning that that provision did not, unlike Article 5(3) of Regulation No 44/2001, permit the proprietors of EU marks to bring an infringement action before the courts of the Member State within which they seek a declaration of an infringement, the consequence would be that those proprietors would bring proceedings alleging infringement of an EU trade mark and proceedings alleging infringement of parallel national trade marks before courts of different Member States. Frequent application of the mechanism provided in Article 109 of Regulation No 207/2009 to resolve cases of *lis pendens* would, because of such a divergent approach in Article 97(5) of Regulation No 207/2009 (now Article 125(5) of Regulation 2017/1001) and Article 5(3) of Regulation No 44/2001 (now Article 7(2) of Regulation No 1215/2012), be likely, thereby defeating the objective, pursued by those regulations, of reducing cases of *lis pendens*.

60 It must, last, be observed that the interpretation adopted in the present judgment is not invalidated by the interpretation deriving from the [judgment of 27 September 2017, Nintendo \(C-24/16 and C-25/16,](#)

[EU:C:2017:724\)](#), to which the referring court made reference against the background summarised in paragraph 31 of the present judgment.

61 In paragraphs 108 and 111 of the [judgment of 27 September 2017, Nintendo \(C-24/16 and C-25/16, EU:C:2017:724\)](#), the Court interpreted the wording *'country in which the act of infringement [of the intellectual property right at issue] was committed'*, in Regulation No 864/2007, as referring to the law of the country where the initial act of infringement, at the origin of the allegedly wrongful conduct, was committed or may have been committed, that initial act, in the context of electronic commerce, being the act of activating the process of placing online the offer for sale. 62 However, the purpose and object of the wording of Article 8(2) of Regulation No 864/2007 are fundamentally different from that of Article 97(5) of Regulation No 207/2009 and Article 5(3) of Regulation No 44/2001.

63 Article 97(5) of Regulation No 207/2009 provides an alternative forum of jurisdiction and is intended, as stated in paragraph 42 of the present judgment, to enable the proprietor of an EU trade mark to bring one or more actions, each relating specifically to the acts of infringement committed within a single Member State.

In contrast, Article 8(2) of Regulation No 864/2007 does not concern the determination of which court has jurisdiction, but relates to the question of how, in the case of a non-contractual obligation arising from an infringement of a unitary intellectual property right, the law applicable to any question that is not governed by the relevant EU instrument is to be determined (see, to that effect, [judgment of 27 September 2017, Nintendo, C-24/16 and C-25/16, EU:C:2017:724](#), paragraph 91).

64 That determination of the applicable law may become necessary when an infringement action, brought before a court that has jurisdiction to give rulings on acts of infringement committed within any Member State, relates to various acts of infringement, committed in different Member States. In such circumstances, in order to ensure that a court does not have to apply more than one law, one alone of those acts of infringement, namely the initial act of infringement, must be identified as determinative of the law applicable to the proceedings ([judgment of 27 September 2017, Nintendo, C-24/16 and C-25/16, EU:C:2017:724](#), paragraphs 103 and 104). The need to ensure that only one law is applicable does not exist in the context of rules concerning which court has jurisdiction, such as those contained in Regulation No 44/2001 and in Regulation No 207/2009, which provide for more than one forum.

65 In the light of all the foregoing, the answer to the question referred is that Article 97(5) of Regulation No 207/2009 must be interpreted as meaning that the proprietor of an EU trade mark, who considers that his rights have been infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products that are identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before an EU

trade mark court of the Member State within which the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding that that third party took decisions and steps in another Member State to bring about that electronic display.

#### Costs

66 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Fifth Chamber) hereby rules:

Article 97(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark must be interpreted as meaning that the proprietor of a European Union trade mark who considers that his rights have been infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products that are identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before a European Union trade mark court of the Member State within which the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding that that third party took decisions and steps in another Member State to bring about that electronic display.

Regan

Lycourgos

Juhász

Ilešič

Jarukaitis

Delivered in open court in Luxembourg on 5 September 2019.

A. Calot Escobar

E. Regan

Registrar

President of the Fifth Chamber

\* Language of the case: English.

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#### OPINION OF ADVOCATE GENERAL

SZPUNAR

delivered on 28 March 2019 [1]

Case C-172/18

AMS Neve Ltd,

Barnett Waddingham Trustees,

Mark Crabtree

v

Heritage Audio SL,

Pedro Rodríguez Arribas

(Request for a preliminary ruling from the Court of Appeal (England & Wales) (Civil Division) (United Kingdom))

(Reference for a preliminary ruling — EU trade mark — Jurisdiction — Action for infringement — Territory where the act of infringement has been committed or threatened — Advertisements and offers for sale on a website)

#### I. Introduction

1. This reference for a preliminary ruling asks the Court, in essence, to give a ruling on whether and, if so, under what circumstances, pursuant to Article 97(5) of Regulation (EC) No 207/2009, [2] the person responsible for an alleged infringement, consisting in the advertising and offer for sale of goods bearing a sign which is identical to an EU trade mark on a website, may be sued in the courts of the Member State on whose territory the traders and consumers targeted by that website are situated.

2. In essence, I shall propose a midway solution to the Court which addresses the challenges posed by the characteristics of the EU trade marks system, established by Regulation No 207/2009, and is adapted to the specific nature of online trading. More specifically, my analysis will lead me to consider that it is the fact that consumers and traders of a Member State are specifically targeted by a website which allows the jurisdiction of EU trade mark courts to be established on the basis of Article 97(5) of that regulation.

#### II. Legal framework

3. In the request for a preliminary ruling, the referring court refers, first, to provisions of Regulation No 207/2009, as amended by Regulation (EU) 2015/2424, [3] and, secondly, on provisions of Regulation (EU) No 1215/2012, [4] which replaced Regulation (EC) No 44/2001. [5]

4. The claimants in the main proceedings brought their actions for infringement on 15 October 2015. Although the provisions of Regulation No 1215/2012 applied from 10 January 2015, those of Regulation 2015/2424 did not apply, in principle, until 1 October 2017. Therefore, in this Opinion, I shall refer to the provisions of Regulations No 207/2009 and No 1215/2012. Moreover, it is clear from Article 80 of the latter regulation that all references in Regulation No 207/2009 to Regulation No 44/2001 are to be construed as references to Regulation No 1215/2012.

5. Article 94(1) and (2)(a) of Regulation No 207/2009 provides:

*'1. Unless otherwise specified in this Regulation, Regulation [No 1215/2012] shall apply to proceedings relating to [EU] trade marks and applications for [EU] trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of [EU] trade marks and national trade marks.'*

*2. In the case of proceedings in respect of the actions and claims referred to in Article 96:*

*(a) Articles [4 and 6, points 1 to 3, and 5 of Article 7 and Article 31 of Regulation No 1215/2012] shall not apply.'*

6. Under Article 95(1) of that regulation:

*'The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as "[EU] trade mark courts", which shall perform the functions assigned to them by this Regulation.'*

7. Article 96 of that regulation provides:

*'The [EU] trade mark courts shall have exclusive jurisdiction:*



(a) for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to [EU] trade marks; ...'

8. Article 97(1) and (5) of that regulation states:

*'1 Subject to the provisions of this Regulation as well as to any provisions of Regulation [No 1215/2012] applicable by virtue of Article 94, proceedings in respect of the actions and claims referred to in Article 96 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.*

...

*5. Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of [an EU] trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened ...'*

9. Under Article 98 of Regulation No 207/2009:

*'1 [An EU] trade mark court whose jurisdiction is based on Article 97(1) to (4) shall have jurisdiction in respect of:*

*(a) acts of infringement committed or threatened within the territory of any of the Member States;*

...

*2 [An EU] trade mark court whose jurisdiction is based on Article 97(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.'*

### **III. The facts of the dispute in the main proceedings**

10. AMS Neve Ltd is a company established in the United Kingdom which manufactures and sells audio equipment. Mr Mark Crabtree is a director of AMS Neve. Mr Crabtree, together with Barnett Waddingham Trustees (*'BW Trustees'*), a company also established in the United Kingdom, is the proprietor of an EU trade mark and two national trade marks registered in the United Kingdom. AMS Neve is the exclusive licensee of those three trade marks.

11. Heritage Audio SL is a company established in Spain which sells audio equipment. Mr Pedro Rodríguez Arribas, who is domiciled in Spain, is the sole director of Heritage Audio.

12. On 15 October 2015, AMS Neve, BW Trustees and Mr Crabtree (*'the claimants in the main proceedings'*) brought infringement proceedings against Heritage Audio and Mr Rodríguez Arribas (*'the defendants in the main proceedings'*) before the Intellectual Property and Enterprise Court (United Kingdom) (*'the IPEC'*) in respect of the EU trade mark and the two national trade marks registered in the United Kingdom.

13. In those proceedings, the claimants in the main proceedings complained that the defendants in the main proceedings had offered for sale to consumers in the United Kingdom imitations of AMS Neve products bearing, or referring to, signs which are identical or similar to the EU trade mark and the national trade marks in question. The claimants in the main proceedings relied, in that regard, on the contents of the Heritage

Audio website and of its Facebook and Twitter accounts; an invoice issued by Heritage Audio to an individual residing in the United Kingdom; an exchange of emails between Heritage Audio and a shop in the United Kingdom concerning the potential supply of audio equipment, and the content of a conversation between a solicitor acting for the claimants in the main proceedings and a representative of SX Pro, the United Kingdom distributor of the goods of the defendants in the main proceedings.

14. As regards the Heritage Audio website, the claimants in the main proceedings filed screen shots showing offers for sale of audio equipment bearing signs that were identical or similar to the EU trade mark in question. They also drew attention to the fact that the content of that website is written in English and a section of the website, entitled *'Where to buy'*, lists distributors in various countries, including SX Pro in the United Kingdom. Moreover, terms of sale published on that website state that Heritage Audio, will accept orders from any EU Member State.

15. The defendants in the main proceedings disputed the claim that they have advertised, offered for sale, sold or supplied any goods in the United Kingdom and submitted that the parts of the website on which the claimants in the main proceedings relied were *'obsolete'*.

16. Subsequently, the IPEC held that it had jurisdiction to decide on the claims relating to the national trade marks registered in the United Kingdom. That court held that, although the defendants in the main proceedings are established in Spain, they may be sued, under Article 7(2) of Regulation No 1215/2012, in the courts for the place where the damage resulting from their tortious acts had occurred and, in the case of the national intellectual property rights in issue, the place where the damage had occurred was the place where the rights subsisted.

17. The IPEC held that, on the other hand, it did not have jurisdiction to hear the infringement proceedings in respect of the EU trade mark. Focusing its attention on the Heritage Audio website and Article 97(5) of Regulation No 207/2009, the provision on which the claimants in the main proceedings relied, the IPEC held that only the courts of the Member State on whose territory the defendants in the main proceedings had taken steps to put the signs in question on the website, or had taken decisions to that effect, had jurisdiction to examine the claim alleging infringement proceedings in respect of the EU trade mark.

18. The claimants in the main proceedings appealed against the judgment of the IPEC before the Court of Appeal (England & Wales) (Civil Division) (United Kingdom).

### **IV. The questions referred for a preliminary ruling and the procedure before the Court**

19. In those circumstances, the Court of Appeal (England & Wales) (Civil Division) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

*'In circumstances where an undertaking is established and domiciled in Member State A and has taken steps in*

*that territory to advertise and offer for sale goods under a sign identical to an EU trade mark on a website targeted at traders and consumers in Member State B:*

*(i) does an EU trade mark court in Member State B have jurisdiction to hear a claim for infringement of the EU trade mark in respect of the advertisement and offer for sale of the goods in that territory?*

*(ii) if not, which other criteria are to be taken into account by that EU trade mark court in determining whether it has jurisdiction to hear that claim?*

*(iii) in so far as the answer to (ii) requires that EU trade mark court to identify whether the undertaking has taken active steps in Member State B, which criteria are to be taken into account in determining whether the undertaking has taken such active steps?'*

20. Written observations were submitted by the parties to the main proceedings, the German Government and the European Commission. The parties to the main proceedings and the Commission participated at the hearing on 17 January 2019.

#### **V. Analysis**

21. By its first question, the referring court seeks to establish whether the fact that a defendant, established and domiciled in Member State A, has taken steps in the territory of that Member State to advertise and offer for sale goods under a sign which is identical to an EU trade mark on a website targeted at traders and consumers in Member State B is sufficient to establish the jurisdiction of the courts of Member State B to hear the infringement proceedings on the basis of Article 97(5) of Regulation No 207/2009. By its second and third questions, which are referred in the event that the answer to the first question is in the negative, the referring court asks which criteria enable the jurisdiction of the courts of Member State B to be established in the situation described above. I shall analyse those three questions together. My analysis of the first question will reveal that, without further qualification, the criteria mentioned by the referring court in that question are not sufficient to establish jurisdiction on the basis of Article 97(5) of Regulation No 207/2009.

22. It is clear from the request for a preliminary ruling that the referring court's main doubts concern whether certain conditions set out in the judgments in *Coty Germany* [6] and *Wintersteiger* [7] have been transposed correctly by the IPEC in its decision to the situation in the present case.

23. The referring court acknowledges that it is clear from the case-law of the Court that the place referred to in Article 97(5) of Regulation No 207/2009 is the place where active steps were taken by the person responsible for the infringement. Thus, the referring court does not call into question the Court's findings in the judgment in *Coty Germany* [8] or the fact that they can be transposed to circumstances such as those of the present case. However, the referring court states that, as is clear from, inter alia, the judgments in *Pammer and Hotel Alpenhof* [9] and *L'Oréal and Others*, [10] in an online environment, the offer for sale of goods bearing a sign that is identical or similar to an EU trade mark on a website targeted at consumers in a Member State

constitutes use of that sign in that Member State for the purpose of Article 9 of Regulation No 207/2009 and active conduct in that territory for the purpose of Article 97(5) of that regulation.

24. Moreover, the referring court states that the Bundesgerichtshof (Federal Court of Justice, Germany) held in a recent judgment [11] that the interpretation of Regulation (EC) No 864/2007 [12] provided by the Court in its judgment in *Nintendo* [13] can be transposed to Article 97(5) of Regulation No 207/2009. However, the referring court also has doubts as to whether the considerations set out in that judgment can be transposed to the facts in the main proceedings.

25. The dispute between the parties focuses on the application of the considerations set out in the judgments cited above to the facts of the present case. The claimants in the main proceedings and the German Government take the view that the first question must be answered in the affirmative, whereas the defendants in the main proceedings and the Commission, which favour the interpretation of Article 97(5) of Regulation No 207/2009 in the light of the judgments in *Nintendo* [14] and *Wintersteiger*, [15] consider that the fact that traders and consumers in a Member State are targeted by advertisements and offers for sale on a website does not justify, in itself, the jurisdiction of the courts of that Member State on the basis of Article 97(5) of Regulation No 207/2009.

26. In the light of the referring court's doubts and the arguments of the parties, I shall start my analysis with some general considerations regarding Article 97(5) of Regulation No 207/2009 and an interpretation of the wording as well as schematic and teleological interpretations of that provision. Then, in the light of those general considerations, I shall answer the question whether the judgment in *Nintendo* [16] must be followed when interpreting that provision. Subsequently, I shall answer the same question in respect of the judgment in *Wintersteiger*. [17] Lastly, since both of those questions must be answered in the negative, I shall propose an interpretation of the linking factor provided for in Article 97(5) of the Regulation No 207/2009 which is specific to that regulation.

#### **A. General considerations**

##### **1. The role of Article 97(5) of Regulation No 207/2009 in the system of rules on jurisdiction laid down in that regulation**

27. There are several types of proceedings in the field of EU trade marks, as is illustrated, inter alia, by Article 96 of Regulation No 207/2009. However, the present request for a preliminary ruling is concerned solely with infringement actions by which the proprietor of a trade mark requests that a third party be censured by the court for having used in the course of trade, without his consent, a sign which is identical or similar to his trade mark in relation to goods or services which are identical or similar to those for which that trade mark is registered.

28. As regards actions for infringement, it is clear from the rules on jurisdiction in Regulation No 207/2009 that the EU legislature decided to derogate in part from the

rules on jurisdiction in Regulation No 1215/2012, which, however, are fully applicable in the case of actions relating to national trade marks.

29. In so doing, in Article 97(1) to (3) of Regulation No 207/2009, the EU legislature laid down a series of linking factors, the first being that the defendant is domiciled in the European Union and the second that the defendant has an establishment in the European Union. If the defendant is neither domiciled nor has an establishment in the territory of the European Union, Regulation No 207/2009 provides for the jurisdiction of the forum actoris, and therefore the third and fourth linking factors are, respectively, that the applicant is domiciled in the territory of the European Union and has an establishment in that territory. Finally, as a measure of last resort, infringement actions must be brought in the courts where the European Union Intellectual Property Office (EUIPO) has its seat. [18]

30. Accordingly, even if neither the proprietor of the trade mark nor the alleged infringer is established in the territory of the European Union, the alleged infringer may be sued in the courts of a Member State under Article 97(1) to (3) of Regulation No 207/2009, provided, of course, that that regulation is applicable and the alleged offences constitute an infringement under that regulation.

31. Furthermore, under Article 97(5) of Regulation No 207/2009, actions for infringement can also be brought in the courts of the Member State in which the act of infringement has been committed or threatened. Thus, using the linking factor of the place where the act of infringement occurred, that provision establishes an alternative forum in respect of actions for infringement. Actions for a declaration of non-infringement, however, do not fall within the scope of that provision.

32. Moreover, unlike the rules on jurisdiction provided for in Article 97(1) to (4) of Regulation No 207/2009, the rule in Article 97(5) of the regulation establishes jurisdiction, as is clear from Article 98(2) of that regulation, only in respect of acts committed or threatened within the territory of the Member State in which the court seised is situated.

## **2. Interpretation of the wording of Article 97(5) of Regulation No 207/2009**

33. As the dispute between the parties shows, the only conclusion to be drawn from an interpretation of the wording of Article 97(5) of Regulation No 207/2009 is that the linking factor established in that provision, namely the place where the act of infringement occurred, relates to active conduct on the part of the person responsible for the infringement. It is clear from reading that provision, therefore, that it confers jurisdiction on the EU trade mark courts in the Member State in which the defendant committed the alleged unlawful act.

34. This was the conclusion reached by the Court in the judgment in *Coty Germany*. [19] As a reminder, the Court held in that judgment that, by Article 97(5) of Regulation No 207/2009, the intention of the EU legislature was to derogate from the rule on jurisdiction provided for in Article 7(2) of Regulation No 1215/2012, which, in the light of the judgment in *Bier*,

[20] conferred jurisdiction on the courts of the place where the event giving rise to the damage occurred (*'Handlungsort'* according to German academic lawyers) and those of the place where the damage occurred (*'Erfolgsort'* according to German academic lawyers). Consequently, the Court concluded that the linking factor of the place where the act of infringement occurred provided for in Article 97(5) of Regulation No 207/2009 relates not to the Member State where the alleged infringement produces its effects but to the Member State where the act giving rise to that infringement occurred or may occur. [21]

35. Beyond that, interpretation of the wording of Article 97(5) of Regulation No 207/2009 does not enable a decision to be made as to the place where the act of infringement occurred if that act was committed on a website. Therefore, the questions referred for a preliminary ruling must be analysed by means of other interpretative methods. [22]

## **3. Schematic and teleological interpretations**

36. It should be noted at the outset that, in so far as it concerns the territory where the act of infringement has been committed or threatened, the wording of Article 97(5) of Regulation No 207/2009 corresponds to that of Article 98(2) of that regulation, which relates to acts of infringement committed or threatened within the territory of any Member State. Those provisions, read together, confer on the courts of the Member State in which the act of infringement has been committed or threatened jurisdiction which is limited to the territory of the Member State in which those courts are located. [23]

37. On account of the interconnection between Article 97(5) and Article 98(2) of Regulation No 207/2009, it is clear that those provisions must be interpreted consistently, at the very least in so far as they concern acts of infringement committed or threatened.

38. Admittedly, Article 98(2) of Regulation No 207/2009 does not concern the issue of designating the courts with jurisdiction to decide on infringement actions. That provision determines the territorial scope of the jurisdiction of the EU trade mark courts referred to in Article 97(5) of that regulation. [24] However, Article 98(2) and Article 97(5) of Regulation No 207/2009 refer to the same acts committed (or threatened) in the same place.

39. Next, it should be observed that Article 98(1)(a) of Regulation No 207/2009, which refers to Article 97(1) to (4) of that regulation, also concerns acts of infringement committed or threatened. It is clear from a combined reading of those provisions that where a court seised is acting in its capacity as an EU trade mark court to decide on an action brought under Article 97(1) to (4) of Regulation No 207/2009, that court, in accordance with Article 98(1) of the regulation, has jurisdiction to consider whether acts of infringement have been committed or threatened within the territory of any of the Member States. [25]

40. There is nothing to indicate that the reference to acts of infringement committed or threatened contained in Article 98(2) of Regulation No 207/2009 should be understood to have a different meaning from the

reference in Article 98(1)(a) of that regulation, read in conjunction with Article 97(5) thereof.

41. The only difference between the use of those references in the provisions cited above lies in the fact that Article 98(1)(a) of Regulation No 207/2009 relates to acts committed (or threatened) within the territory of any of the Member States, that is to say the European Union, whereas Article 98(2) of that regulation relates to acts committed (or threatened) within the territory of one Member State in which the court is seised on the basis of Article 97(5) of the regulation. This follows not from the differences relating to the identification of the place where the act of infringement was committed but those relating to the extent of the jurisdiction of the courts concerned. They are still the same kind of act and the place where those acts occurred must be assessed in the same way.

#### 4. Preliminary conclusions

42. It follows from the foregoing considerations, first, that the place where those acts are committed must be identified in the same way whether by reference to Article 98(2) of Regulation No 207/2009, read in conjunction with Article 97(5) thereof, or to Article 98(1)(a) of that regulation.

43. Secondly, Article 97(1) to (4) of Regulation No 207/2009 confers on courts a general jurisdiction, which extends to infringements committed or threatened within the territory of the European Union. Therefore, where an infringement is committed outside the European Union, the EU trade mark courts may not, in the light of the limits on the extent of their general jurisdiction, give a ruling on that infringement. That limitation stems from Article 98(1) of Regulation No 207/2009. [26]

44. Thirdly, the existence of limits on the extent of the general jurisdiction of EU trade mark courts must be taken into account when interpreting Article 97(5) of Regulation No 207/2009. Under Article 98(1)(a) of that regulation, the extent of the general jurisdiction of those courts is determined by locating where the acts of infringement occurred. The courts with jurisdiction on the basis of Article 97(5) of Regulation No 207/2009 are determined using a similar criterion, namely the linking factor of the place where the act of infringement occurred. The places where the acts referred to in Article 98(1)(a) and Article 97(5) of Regulation No 207/2009 occurred are identified in the same way. Consequently, the interpretation given to the linking factor of the place where the act of infringement occurred within the meaning of Article 97(5) of Regulation No 207/2009 is liable to affect the extent of the general jurisdiction of EU trade mark courts.

#### B. Judgments in Nintendo and Wintersteiger

45. With regard to identifying the place where the act of infringement occurred within the meaning of Article 97(5) of Regulation No 207/2009 in circumstances such as those in the present case, the defendants in the main proceedings and the Commission propose that the conclusion reached by the Court in the judgment in Nintendo [27] with regard to Article 8(2) of Regulation No 864/2007 should be followed.

46. Moreover, those parties consider that, when interpreting Article 97(5) of Regulation No 207/2009, the Court's conclusion in the judgment in Wintersteiger [28] with regard to Article 7(2) of Regulation No 1215/2012 and jurisdiction on the basis of the place where the event giving rise to the damage occurred (*'Handlungsort'*) should also be followed.

47. To my mind, those views are debatable in three respects at the very least: first, in terms of their implications for the extent of the general jurisdiction of EU trade mark courts, secondly, with regard to the alternative nature of the linking factor in Article 97(5) of Regulation No 207/2009 and, thirdly, as regards the fact that that linking factor, which is specific to that regulation, is independent of those in Regulations No 864/2007 and No 1215/2012.

#### 1. Implications for the extent of general jurisdiction

48. As a reminder, in the judgment in Nintendo, [29] the Court held that Article 8(2) of Regulation No 864/2007 must be interpreted as meaning that the *'country in which the act of infringement was committed'* refers to the country where the event giving rise to the damage occurred. The Court went on to hold that, in respect of an act by which an operator uses electronic commerce by offering for sale, on its website targeted at consumers in several Member States, goods infringing the rights conferred by Community designs, the place where the event giving rise to the damage occurred within the meaning of Article 8(2) of Regulation No 864/2007 is the place where the process of putting the offer for sale online by that operator on its website was activated. [30]

49. Moreover, in the judgment in Wintersteiger, [31] the Court held that an action relating to an infringement of a national trade mark registered in a Member State resulting from the use, by an advertiser, of a keyword identical to that trade mark on the website of a search engine operating under a country-specific top-level domain of another Member State, may be brought, under Article 7(2) of Regulation No 1215/2012, before either the courts of the Member State in which the trade mark is registered (jurisdiction in respect of the place where the damage occurred, *'Erfolgsort'*) or the courts of the Member State where the decision to activate the process of displaying the advertisement was made, provided that it is a definite and identifiable place (jurisdiction in respect of the place where the event giving rise to the damage occurred, *'Handlungsort'*).

50. In that regard, account must be taken of the fact that, regardless of the particular circumstances of the case, the interpretation of Article 97(5) of Regulation No 207/2009 adopted in the present case will undoubtedly have a significant impact on the practice of EU trade mark courts when applying that regulation in other situations. Since the rules on jurisdiction in that regulation also apply in cases where neither the proprietor nor the alleged infringer is established in the territory of the Member States, account must also be taken, when interpreting that provision, of situations where infringements of EU trade marks originate from third States.

51. Should the Court decide that the conclusion reached in the two judgments cited above also applies in the context of Article 97(5) of Regulation No 207/2009, this would mean that, in the hypothetical situation where the third party responsible for the use, in an offer for sale or advertisement on a website targeted at consumers within the European Union, of a sign which is identical or similar to a trade mark registered in the European Union, is established in a third State and the server of the website used by the third party is located in such a State, for the purposes of applying the rules on jurisdiction in Regulation No 207/2009, the act of infringement is committed outside the territory of the European Union.

52. Not only would the courts referred to in Article 97(5) of Regulation No 207/2009 not have jurisdiction to decide on the infringement action, but those referred to in Article 97(1) to (4) of that regulation would not be able to give a ruling on that action. To recap, the general jurisdiction of EU trade mark courts, referred to in Article 97(1) to (4) of Regulation No 207/2009, extends to acts of infringement committed or threatened within the territory of the Member States. Therefore, in the situation described in the point above, even the courts of the Member State where EUIPO has its seat would not have jurisdiction to decide on such an action for infringement.

53. However, it may be inferred from the judgment in *L'Oréal and Others* [32] that, in such a situation, Regulation No 207/2009 applies and the proprietor of the EU trade mark may oppose the offer for sale or an internet advertisement targeted at consumers within EU territory. It would be paradoxical if Regulation No 207/2009 were to confer such a right on the proprietor of the EU trade mark to oppose its use but, in some cases, the rules on jurisdiction laid down in that regulation did not apply. That outcome would be particularly inconsistent as, unlike the rules on jurisdiction in Regulation No 1215/2012, those in Regulation No 207/2009 are designed so that they can also be applied in cases where neither the applicant nor the defendant is domiciled in the territory of the European Union. It is clear from the judgment in *Hummel Holding* [33] that Article 97 of Regulation No 207/2009 ensures that a court within the European Union always has jurisdiction to hear and determine cases concerning infringement.

54. Accordingly, I take the view that an interpretation of Article 97(5) of Regulation No 207/2009 in line with the judgments in *Nintendo* [34] and *Wintersteiger* [35] would undermine the effectiveness of all of the rules on jurisdiction laid down in Article 97 of that regulation.

## **2. Alternative court in the forum where the act of infringement occurred**

55. I am sympathetic to the argument put forward by the claimants in the main proceedings and the German Government, which consider that, as a general rule, the place where the initial act which gave rise to an infringement occurred in accordance with the judgments in *Nintendo* [36] and *Wintersteiger* [37] is the same as the place where the person responsible for that infringement is domiciled. Consequently, the interpretation that the place where the act of

infringement occurred in accordance with Article 97(5) of Regulation No 207/2009 should be perceived solely as the place where the initial act which gave rise to an infringement occurred cannot, in most cases, offer an alternative forum for an applicant.

56. In the judgment in *Bier*, [38] the Court has previously explained that, in order to preserve the effectiveness of the rule of alternative jurisdiction in matters of tort, delict or quasi-delict in the context of the Brussels regime, [39] that rule must be interpreted as giving an applicant an actual choice.

57. Admittedly, it could be argued that, unlike the rules on jurisdiction under that regime, the EU legislature's intention, with the rules in Regulation No 207/2009, was to limit the number of fora available to proprietors bringing infringement actions. [40] The EU legislature's reticent approach with regard to the multiplication of fora is illustrated, inter alia, by the wording of Article 94(1) of Regulation No 207/2009, which, in respect of infringement, precludes the application, inter alia, of Article 7(1) to (3) and (5) of Regulation No 1215/2012, the objective of all of which is to offer the applicant an alternative forum. The approach taken by the EU legislature can also be seen in Article 97(1) to (4) of Regulation No 207/2009. However, Article 97(5) of that regulation expressly provides for an alternative forum for an applicant and, for that reason, cannot be regarded as mirroring that approach.

58. Moreover, to follow the interpretation of Article 97(5) of Regulation No 207/2009 put forward by the defendants in the main proceedings and the Commission would restrict to a large extent the practical importance of that provision. [41] It seems to me that one of the rare practical applications of that provision would be if a defendant who is domiciled in the territory of the European Union was sued in the courts of the Member State on whose territory he has an establishment. Regulation No 207/2009 does not contain a rule on jurisdiction which is analogous with that in Article 7(5) of Regulation No 1215/2012 [42] and, in accordance with the series of linking factors set out in Article 97(1) to (3) of Regulation No 207/2009, where a defendant is domiciled in the territory of a Member State, he must be sued in the courts of that Member State.

## **3. The linking factor of the place where the act of infringement occurred is sui generis**

59. Finally, I consider that the linking factor of the place where the act of infringement occurred in Article 97(5) of Regulation No 207/2009 is independent of the linking factors in Article 8(2) of Regulation No 864/2007 and Article 7(2) of Regulation No 1215/2012.

60. With regard to whether the interpretation of Article 8(2) of Regulation No 864/2007 in the judgment in *Nintendo* [43] is transposable, the fact should not be overlooked that, on the one hand, conflict-of-law rules and, on the other, rules on jurisdiction, have different functions.

61. Moreover, it is true that the conflict-of-law rule set out in Article 8(2) of Regulation No 864/2007 is, as may be inferred from the judgment in *Vapenik* [44] and in the words of that judgment, supplementary to the rule on

jurisdiction laid down in Article 97(5) of Regulation No 207/2009. However, it is clear from the judgment in Kainz [45] that consistent interpretation of the concepts contained in EU international private law instruments cannot lead to the provisions of those instruments being interpreted in a manner which is unconnected to the scheme of those instruments and objectives they pursue. [46] As can be seen from my observations above, interpreting Article 97(5) of Regulation No 207/2009 in the light of the judgment in Nintendo [47] would undermine the effectiveness of that provision.

62. Those considerations also apply in respect of whether the conclusion reached in the judgment in Wintersteiger, [48] in so far as it concerns determining the place where the event giving rise to the damage occurred for the purposes of the application of Article 7(2) of Regulation No 1215/2012, can be transposed to Article 97(5) of Regulation No 207/2009.

63. Furthermore, it is clear from the case-law that, by the rules on jurisdiction in Regulation No 207/2009, the EU legislature's intention was to derogate from the rules on jurisdiction in Regulation No 1215/2012, [49] in particular because the rules on jurisdiction laid down in those regulations do not pursue the same objectives. [50] 64. Lastly, it may be inferred from the judgment in Leno Merken [51] that, when applying by analogy to EU trade marks the case-law relating to national trade marks, account must be taken of the differences which are apparent from the wording of the provisions relating to those two types of trade marks.

65. In that regard, I note that, when drafting Article 97(5) of Regulation No 207/2009 and its predecessor, Article 93(5) of Regulation No 40/94, the EU legislature did not use the concept of the '*place of the event giving rise to the damage*', which, since the judgment in Bier, [52] has had a well-established meaning in European international law. For that reason, the interpretation of Article 97(5) of Regulation No 207/2009 cannot be confined to the view that that provision confers jurisdiction on courts which, under Article 7(2) of Regulation No 1215/2012, have jurisdiction on the basis of the place of the event giving rise to the damage.

#### 4. Interim conclusions

66. To summarise this part of my analysis, in the light of the considerations regarding the extent of the jurisdiction of EU trade mark courts, I take the view that the interpretation of Article 97(5) of Regulation No 207/2009 to the effect that, in respect of an act by which the defendant uses electronic commerce, offering for sale, on its website targeted at consumers in one Member State, goods in breach of the rights of the proprietor of an EU trade mark, the place where the act of infringement occurred, within the meaning of that provision, can only be the place where the process of putting the offer for sale online by that defendant on its website was activated, must be disregarded. That is supported by the conclusions arising from the alternative and independent nature of the linking factor referred to in Article 97(5) of Regulation No 207/2009.

67. Therefore, it is now necessary to determine the criteria that may be necessary specifically for the

purposes of establishing the jurisdiction of the courts of a Member State on the basis of Article 97(5) of Regulation No 207/2009.

#### C. A tailor-made solution for Regulation No 207/2009 1. The risk of a multiplication of fora

68. After disregarding the interpretation of Article 97(5) of Regulation No 207/2009 that, in circumstances such as those in the present case, the place where the act of infringement occurred can only be the place where the process of putting the offer for sale online was activated, should the fact that a website is accessible from the territory of a Member State be regarded as sufficient to establish the jurisdiction of the courts of that Member State?

69. The case-law concerning the determination of courts with jurisdiction in relation to infringements of intellectual and industrial property rights, including national trade marks, may, a priori, support an answer in the affirmative. It follows from that case-law that, in respect of jurisdiction on the basis of the place where the damage occurred, Article 7(2) of Regulation No 1215/2012 does not require that the website concerned in connection with those infringements is '*directed to*' the Member State in which the court seised is situated. [53]

70. However, the internet is, by nature, worldwide and found everywhere. [54] If the fact that a website is accessible from the territory of a Member State is regarded as sufficient to confer jurisdiction on the courts of that Member State, this would lead to a considerable increase in the number of fora with jurisdiction as regards infringement of EU trade marks. [55]

71. As Advocate General Jääskinen noted in his Opinion in Coty Germany, [56] one of the objectives of Regulation No 207/2009 is to prevent forum shopping, a practice which may be used by the proprietors of EU trade marks where the rules on jurisdiction so permit.

72. In the light of that objective, account must be taken of the fact that some market participants resort to trade mark bullying. This practice involves using a trade mark for purposes beyond what could reasonably be interpreted as a use deriving from the scope of protection of the trade mark in order to harass or intimidate other economic operators. Increasing the number of fora with jurisdiction could facilitate such practice and increase its adverse effects with respect to potential defendants. That is particularly so because Article 97(5) of Regulation No 207/2009 does not follow the principle of actor sequitur forum rei and, in principle, it is more difficult for a defendant to defend himself before the courts of a country other than his own.

73. Finally, it is true, as noted by the claimants in the main proceedings and the German Government, that rejecting the interpretation of Article 97(5) of Regulation No 207/2009 to the effect that the fact that a website is accessible from the territory of a Member State is sufficient to establish the jurisdiction of the courts of that Member State leads to a situation where actions for infringement relating to national trade marks and EU trade marks cannot be brought in a uniform

manner before the courts of the Member State in which consumers have access to that website.

74. However, the considerations set out in points 63 to 65 of this Opinion militate against the case-law in relation to infringements of intellectual and industrial property rights being transposable to Article 97(5) of Regulation No 207/2009.

75. Moreover, unlike its implications for Regulation No 207/2009, adopting the criterion of accessibility under Regulation No 1215/2012 does not lead to the risk of a multiplication of fora. With regard more specifically to actions for infringement relating to national trade marks, the Court held in the judgment in *Wintersteiger* [57] that the objectives of Regulation No 1215/2012 militate in favour of conferring jurisdiction, in respect of the damage occurred, on the courts of the Member State in which the right at issue is protected. Thus, the number of fora available under Regulation No 1215/2012 is limited by the fact that the trade mark concerned is a national trade mark. [58] However, EU trade marks are given uniform protection and produce their effects throughout the entire area of the European Union.

76. In the light of the foregoing considerations, I consider that the place from which a website may be accessed is not a sufficient criterion to establish the jurisdiction of the courts of that Member State under Article 97(5) of Regulation No 207/2009.

77. Thus, because all the interpretations taken from the case-law on infringements of intellectual and industrial property rights, relating to other EU international private law instruments, are unsatisfactory, I propose that an interpretation be developed of the linking factor of the place where the act of infringement occurred for the purpose of Article 97(5) of Regulation No 207/2009 which is specific to that regulation.

## **2. The interpretation to be adopted**

78. When interpreting Article 97(5) of Regulation No 207/2009 in the light of the circumstances of the case, it must be borne in mind that the result achieved in the context of that interpretation must be sufficient to ensure that that provision is effective, irrespective of the specific circumstances of the dispute concerned.

79. Moreover, on account of the overlap between Article 97(5) of Regulation No 207/2009, read in conjunction with Article 98(2) thereof, and Article 98(1)(a) of that regulation, as those provisions relate to the place where the act of infringement occurred, the interpretation of that first provision must also ensure that the other rules on jurisdiction laid down in Article 97 of that regulation are effective.

80. In order for Article 97 of Regulation No 207/2009 to be able to maintain its effectiveness and ensure that there is a forum within the European Union with jurisdiction to hear and determine all cases concerning infringement, the interpretation of the linking factor of the place where the act of infringement occurred must ensure that the EU trade mark courts have jurisdiction in respect of actions for infringement where, as regards substantive law, Regulation No 207/2009 confers on a proprietor the right to oppose conduct which infringes his EU trade mark.

81. Therefore, the territorial scope of the general jurisdiction of EU trade mark courts, which is determined by locating the place where the acts of infringement occurred, cannot be narrower than the territorial scope of the protection enjoyed by those trade marks and the scope of Regulation No 207/2009.

82. In that regard, I note that the judgment in *L'Oréal and Others* [59] concerned the determination of the territorial scope of the regulations relating to EU trade marks. [60]

83. Drawing inspiration from that judgment once more, in my view, where the defendant is accused of acts consisting in an advertisement and an offer for sale on a website, the EU trade mark courts of a Member State must be regarded as having jurisdiction on the basis of the place where the act of infringement occurred, provided that that advertisement or that offer is targeted at consumers located in the territory of that Member State. [61]

84. It is important to note that that interpretation of Article 97 of Regulation No 207/2009 reflects settled case-law to the effect that jurisdiction must be conferred in accordance with the objective of foreseeability and that of the sound administration of justice.

85. As regards, first, whether the conferral of jurisdiction is foreseeable, account must be taken of the fact that an applicant must be able to determine a priori the courts before which he can assert his substantive rights. On the basis of the content of a website, the proprietor of a trade mark is able to identify the public targeted by that site. Similarly, a potential defendant is able to foresee the fora in which he may possibly be sued on account of the fact that he has control over his marketing and the sales made via his website.

86. As regards, secondly, the objective of the sound administration of justice, it is clear from the case-law on infringements of intellectual and industrial property rights that the courts of the Member State from whose territory a website is accessible is, objectively, best placed to determine whether the national trade mark protected in that Member State has actually been infringed. [62] In my view, such a court does not lose that status as regards infringements of EU trade marks.

## **3. Targeting criteria and how they apply in the case in the main proceedings**

87. It follows from all the foregoing considerations that, where the defendant is accused of acts consisting in an advertisement and an offer for sale on a website, the criterion which enables the jurisdiction of EU trade mark courts to be established on the basis of Article 97(5) of Regulation No 207/2009 is the public targeted by that advertising and that offer for sale, namely the public of the Member State concerned.

88. In determining jurisdiction on the basis of Article 97(5) of Regulation No 207/2009 in circumstances such as those in the main proceedings, the fact that an advertisement and an offer for sale are organised in such a way that it is possible to identify the public of a Member State (or the public of several Member States, provided that it is not the public of the European Union in general) specifically targeted by that advertisement

and that offer is decisive for the purpose of establishing the jurisdiction of the courts of that or those Member States. Moreover, the fact that a website is aimed at the consumers and traders of a Member State must be apparent, straight away, from the content of that website. On the other hand, where such acts occur offline that may make it possible to establish the jurisdiction of the courts of the Member State concerned for reasons other than the public of that Member State being targeted by the website. That might be the case in respect of measures taken in that Member State in order to establish a distributor there.

89. In determining such jurisdiction on the basis of the place where the act of infringement occurred, a number of factors are of particular importance: the fact that an offer and an advertisement refer expressly to the public of a Member State, that they are available on a website with a country-specific top-level domain of that Member State, that the prices are given in the national currency or that telephone numbers on such a website contain the national prefix of the State concerned. This list of factors is neither exhaustive nor exclusive.

90. Furthermore, the fact that an offer for sale provides details regarding the geographic areas to which the seller is willing to dispatch the goods may also play a significant role in determining jurisdiction on the basis of Article 97(5) of Regulation No 207/2009, provided that it is not a general indication which covers the whole of the European Union. A general indication of that kind does not enable the audience or audiences specifically targeted to be identified. In addition, if a general indication of that kind was given any weight, the person responsible for the alleged infringement could be sued in the courts of all of the Member States. This might encourage traders to limit sales areas within the European Union in order to limit the risk of being sued in the courts of Member States in which sales volumes are not very high. This is contrary to the objectives of the internal market.

91. However, in view of the difference between the rules on general jurisdiction laid down in Regulation No 207/2009 and those in Article 97(5) of that regulation, as set out in point 41 of this Opinion, the fact that a seller is willing to dispatch the goods to all Member States may make it possible to establish the jurisdiction of the EU trade mark courts on the basis of Article 97(1) to (4) of Regulation No 207/2009. To illustrate this, as another example, I shall refer to specific provisions relating to EU customs duties. Although those provisions indicate that an offer is targeted at consumers in the European Union, they do not, however, enable the public specifically targeted by that offer to be identified.

92. For the same reason, I also doubt that the fact that a website is written in a language that is widely understood in the territory of a Member State might, in itself and in all cases, be of particular importance. Account must be taken of the fact that, on the one hand, some languages are frequently used in a number of Member States and, on the other, some of the languages spoken in Europe are also widely understood in third States. Moreover, a website may be targeted at the public

of a Member State even though its content is not written in a language that is widely understood on the territory of that State. This is the case, *inter alia*, where a website targets a community of foreign nationals residing in that Member State.

93. Furthermore, the determination of jurisdiction must not be confused with an examination of the substance of the case at issue. [63] The determination of jurisdiction on the basis of Regulation No 207/2009 should neither take the place of the examination as to whether an EU trade mark has actually been infringed, nor prejudice the outcome of that examination.

94. In that context, the defendants in the main proceedings submit that it may be inferred from certain components of the advertisements and offers for sale on their website that those advertisements and offers were no longer valid during the period concerned by the dispute in the main proceedings.

95. The assessment as to whether actions which are liable to constitute an alleged unlawful act are obsolete falls within the scope of the examination of the substance in an action for infringement. Similarly, the fact that an event giving rise to damage dates back over a considerable period of time may, depending on the applicable law, mean that an action relating to that event is time-barred and, for that reason, also falls within the scope of the examination of whether that action is well founded. Consequently, in view of the considerations set out in point 93 of this Opinion, neither the fact that the advertisements and offers for sale on a website are obsolete nor the fact that an event giving rise to damage dates back over a considerable period of time may be taken into account when determining jurisdiction on the basis of the place where the act of infringement occurred, for the purposes of Article 97(5) of Regulation No 207/2009.

96. Following the analysis set out in this Opinion, I consider that Article 97(5) of Regulation No 207/2009 must be interpreted as meaning that, in circumstances where an undertaking which is established and domiciled in Member State A has taken steps in that territory to advertise and offer for sale goods under a sign identical to an EU trade mark on a website targeted at traders and consumers in Member State B, an EU trade mark court in Member State B has jurisdiction to hear an action for infringement of the EU trade mark in respect of the advertisement and offer for sale of the goods in that territory, provided that that advertisement and that offer target specifically the public in one or more Member States.

97. As regards the case in the main proceedings, with the exception of a list of distributors in various countries, including the United Kingdom, these being economic operators which are independent of the defendants in the main proceedings, together with their mailing addresses and website addresses, there is nothing to indicate that the website of the defendants in the main proceedings is specifically targeted at consumers in the United Kingdom. Moreover, such information regarding a distributor is not sufficient in itself, in my view, to establish the jurisdiction of the United Kingdom courts



on the basis of Article 97(5) of Regulation No 207/2009. The case in the main proceedings does not concern an act of infringement committed by that distributor, but an infringement committed by the defendants in the main proceedings on a website.

98. However, it is for the referring court to adjudicate on that matter when determining the jurisdiction of the courts of the Member State concerned on the basis of Article 97(5) of Regulation No 207/2009, taking into account all the criteria set out in points 88 to 95 of this Opinion.

#### VI. Conclusion

99. In the light of the foregoing considerations, I propose that the Court should answer the questions referred for a preliminary ruling by the Court of Appeal (England & Wales) (Civil Division) (United Kingdom) as follows: Article 97(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark must be interpreted as meaning that, in circumstances where an undertaking which is established and domiciled in Member State A has taken steps in that territory to advertise and offer for sale goods under a sign identical to an EU trade mark on a website targeted at traders and consumers in Member State B, an EU trade mark court in Member State B has jurisdiction to hear an action for infringement of the EU trade mark in respect of the advertisement and offer for sale of goods in that territory.

It is for the referring court to adjudicate on that matter when determining the jurisdiction of the courts of the Member State concerned on the basis of Article 97(5) of Regulation No 207/2009.

[1] Original language: French.

[2] Council Regulation of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).

[3] Regulation of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

[4] Regulation of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1).

[5] Council Regulation of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1).

[6] Judgment of 5 June 2014 (C-360/12, EU:C:2014:1318).

[7] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[8] Judgment of 5 June 2014 (C-360/12, EU:C:2014:1318).

[9] Judgment of 7 December 2010 (C-585/08 and C-144/09, EU:C:2010:740).

[10] Judgment of 12 July 2011 (C-324/09, EU:C:2011:474).

[11] Judgment of 9 November 2017, known as '*Parfummarken*' (BGH IZR 164/16).

[12] Regulation of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II) (OJ 2007 L 199, p. 40).

[13] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[14] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[15] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[16] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[17] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[18] Moreover, under Article 97(4) of Regulation No 207/2009, the parties may derogate from those rules on jurisdiction by way of an agreement concluded between themselves or if the defendant enters an appearance before an EU trade mark court.

[19] Judgment of 5 June 2014 (C-360/12, EU:C:2014:1318, paragraphs 34 and 37).

[20] Judgment of 30 November 1976 (21/76, EU:C:1976:166).

[21] Judgment of 5 June 2014, *Coty Germany* (C-360/12, EU:C:2014:1318, paragraph 34).

[22] This illustrates, as I have already noted in a very different context, namely in the field of tax, and stated in my Opinion in *Geelen* (C-568/17, EU:C:2019:109, points 17 and 28), that, as regards the online environment, the interpretation of the wording of a provision concerning the place where a given event occurred is not, in some cases, capable of ensuring a satisfactory outcome.

[23] Judgment of 18 May 2017, *Hummel Holding* (C-617/15, EU:C:2017:390, paragraph 33).

[24] With regard to the concept of the territorial scope of jurisdiction in trade mark matters, see *Larsen, T.B., 'The extent of jurisdiction under the forum delicti rule in European trademark litigation'*, *Journal of Private International Law*, 2018, Vol. 14(3), p. 555. Moreover, it should be observed, in that context, that issues relating to the designation of the courts with jurisdiction, on the one hand, and the determination of the scope of their jurisdiction, on the other, must be distinguished from the issue of the territorial effects of decisions delivered by those courts. That distinction also follows from the Court's findings in the judgment of 18 May 2017, *Hummel Holding* (C-617/15, EU:C:2017:390). On the one hand, in paragraph 33 of that judgment, the Court stipulated that the extent of the jurisdiction of the court with jurisdiction under Article 97(5) of Regulation No 207/2009 is limited to the territory of the Member State in which it is located, as is apparent from Article 98 of Regulation No 207/2009. On the other hand, in paragraph 36 of that judgment, the Court held that the decisions of the courts with jurisdiction on the basis of

Article 97 of Regulation No 207/2009 have effect and cover the entire area of the European Union.

[25] Judgment of 22 September 2016, *combit Software* (C-223/15, EU:C:2016:719, paragraph 24). See, also, judgment of 12 April 2011, *DHL Express France* (C-235/09, EU:C:2011:238, paragraph 37). See, also, Stone, P., *EU Private International Law*, Edward Elgar, Cheltenham — Northampton, 2014, p. 163.

[26] See judgment of 12 April 2011, *DHL Express France* (C-235/09, EU:C:2011:238, paragraph 38), in which the Court held that a court hearing a case pursuant to the rules in Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, corresponding to those set out in Article 97(1) to (4) of Regulation No 207/2009 has jurisdiction in respect of acts of infringement committed or threatened within the territory of one or more Member States, or even all the Member States. Thus, its jurisdiction may extend to the entire area of the European Union. I infer from this that such a court, a contrario, does not have jurisdiction in respect of acts committed outside the European Union. See, to that effect, Fawcett, J.J., Torremans, P., *Intellectual Property and Private International Law*, Oxford University Press, Oxford, 2011, p. 415, point 8.31, and Ubertazzi, B., *Exclusive Jurisdiction in Intellectual Property*, Mohr Siebeck, Tübingen, 2012, p. 74.

[27] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[28] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[29] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724, paragraph 98).

[30] Judgment of 27 September 2017, *Nintendo* (C-24/16 and C-25/16, EU:C:2017:724, paragraph 108).

[31] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[32] Judgment of 12 July 2011 (C-324/09, EU:C:2011:474).

[33] Judgment of 18 May 2017 (C-617/15, EU:C:2017:390, paragraph 33).

[34] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[35] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[36] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[37] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[38] Judgment of 30 November 1976 (21/76, EU:C:1976:166, paragraph 20).

[39] That is to say Regulations No 1215/2012 and No 44/2001 and the Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1978 L 304, p. 36).

[40] See, to that effect, Nuyts, A., '*Suing At the Place of Infringement: The Application of Article 5(3) of Regulation 44/2001 to IP Matter and Internet Disputes*' in Nuyts, A. (ed.), *International Litigation in Intellectual Property and Information Technology*, Kluwer Law International, 2008, Alphen-sur-le-Rhin, p. 116.

[41] See also Rosati, E., '*International jurisdiction in online EU trade mark infringement cases: where is the place of infringement located?*' *European Intellectual Property Law*, 2016, 38(8), p. 482.

[42] Under Article 7(5) of Regulation No 1215/2012, '*[a] person domiciled in a Member State may be sued in another Member State ... as regards a dispute arising out of the operations of a branch, agency or other establishment, in the courts for the place where the branch, agency or other establishment is situated*'. Admittedly, like that provision, Article 97(1) of Regulation No 207/2009 uses the '*establishment*' as a linking factor. However, it is clear from the judgment of 18 May 2017, *Hummel Holding* (C-617/15, EU:C:2017:390, paragraphs 26, 27 and 40) that there are substantial differences between that provision of Regulation No 207/2009 and the one in Regulation No 1215/2012. See, also, Fawcett, J.J., and Torremans, P., *Intellectual Property and Private International Law*, Oxford University Press, Oxford, 2011, p. 417, point 8.43.

[43] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[44] Judgment of 5 December 2013 (C-508/12, EU:C:2013:790).

[45] Judgment of 16 January 2014 (C-45/13, EU:C:2014:7, paragraph 20).

[46] With regard to that issue, see, also, my Opinion in *Pillar Securitisation* (C-694/17, EU:C:2019:44, points 39 to 46).

[47] Judgment of 27 September 2017 (C-24/16 and C-25/16, EU:C:2017:724).

[48] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220).

[49] Judgment of 5 June 2014, *Coty Germany* (C-360/12, EU:C:2014:1318, paragraph 36).

[50] Judgment of 18 May 2017, *Hummel Holding* (C-617/15, EU:C:2017:390, paragraphs 27 and 28).

[51] See judgment of 19 December 2012, (C-149/11, EU:C:2012:816, paragraph 33).

[52] Judgment of 30 November 1976 (21/76, EU:C:1976:166, paragraph 20).

[53] See judgments of 3 October 2013, *Pinckney* (C-170/12, EU:C:2013:635, paragraph 42), and of 22 January 2015, *Hejduk* (C-441/13, EU:C:2015:28, paragraph 32). In the judgment of 19 April 2012, *Wintersteiger* (C-523/10, EU:C:2012:220), that consideration was not expressly stated. In his Opinion in *Wintersteiger* (C-523/10, EU:C:2012:90, points 25 to 31), Advocate General Cruz Villalón took the view that the jurisdiction of national courts should be assessed in the light of the necessary means criterion. Since the Court did not follow the solution advocated in that Opinion, I infer from this that the judgment in *Wintersteiger* follows the logic of the judgments cited above. See, also, Kohl, U., '*Jurisdiction in cyberspace*', in Tsagourias, N., Buchan, R., (eds), *Research Handbook on International Law and Cyberspace*, Cheltenham — Northampton, 2015, p. 46.

[54] For a different outlook on that issue in the context of the territorial scope of EU law, see my Opinion in

Google (Territorial scope of de-referencing) (C-507/17, EU:C:2019:15, points 47 to 53).

[55] See, to that effect in the context of Regulation No 1215/2012, Moura Vincente, D., *'La propriété intellectuelle en droit international privé'*, Recueil des cours de l'Académie de La Haye, Vol. 335, 2008, p. 392.

[56] C-360/12, EU:C:2013:764, point 42.

[57] Judgment of 19 April 2012 (C-523/10, EU:C:2012:220, paragraph 27).

[58] According to academic legal writing, the fact that a trade mark is a national trade mark does not limit the number of fora available with regard to interim measures. See, inter alia, van Calster, G., *European Private International Law*, Hart Publishing, Oxford — Portland, 2016, p. 153.

[59] See judgment of 12 July 2011 (C-324/09, EU:C:2011:474).

[60] See Opinion of Advocate General Jääskinen in *L'Oréal and Others* (C-324/09, EU:C:2010:757, point 125), and my recent Opinion in *Google (Territorial scope of de-referencing)* (C-507/17, EU:C:2019:15, points 51 to 53). See, also, Jääskinen, N., Ward, A., *'The External Reach of EU Private Law in the Light of L'Oréal versus eBay and Google and Google Spain'*, in Cremona, M., Micklitz, H.W., *Private Law in the External Relations of the EU*, Oxford University Press, Oxford, 2016, pp. 128 and 144.

[61] See, by analogy, judgment of 12 July 2011, *L'Oréal and Others* (C-324/09, EU:C:2011:474, paragraph 67).

[62] See judgments of 3 October 2013, *Pinckney* (C-170/12, EU:C:2013:635, paragraphs 28, 34 and 47), and of 22 January 2015, *Hejduk* (C-441/13, EU:C:2015:28, paragraphs 20 and 38).

[63] See judgment of 3 October 2013, *Pinckney* (C-170/12, EU:C:2013:635, paragraphs 40 and 41). See, also, to that effect, judgments of 19 April 2012, *Wintersteiger* (C-523/10, EU:C:2012:220, paragraph 26), and of 16 June 2016, *Universal Music International Holding* (C-12/15, EU:C:2016:449, paragraph 44); see, also, Opinion of Advocate General Cruz Villalón in *Wintersteiger* (C-523/10, EU:C:2012:90, point 31), and my Opinion in *Universal Music International Holding* (C-12/15, EU:C:2016:161, point 57).

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