Hunting with Artemis

9th Session: EU Case-Law Update

Multinational trade mark infringement dispute

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Abstract

The Court of Justice of the European Union (CJEU) handed down a landmark decision on multinational infringement disputes on September 27, 2017 in Joined Cases C-24/16 and 25/16, Nintendo v Bigben, answering questions referred to it in a preliminary ruling. While the decision concerns Community designs, it is obviously also applicable for the European Union trade mark and the corresponding provisions of the European Union Trade Mark Regulation.

Question 1 asks, in essence, whether a co-defendant (established in another Member State than the Court deciding the case) can be sued together with a defendant (established in the Member State of this Court) and whether this Court has jurisdiction to adopt orders with EU-wide effect also against the co-defendant. *Question 3* relates to the applicable national law for such measures and sanctions not provided for by the Regulation, e.g. damages for infringements, where various acts of infringement were committed in various Member States.

Both questions are core issues of the enforcement of the EU trade mark as unitary EU intellectual property right in cases of multinational infringements before those national courts of the Member States sitting as EU trade mark courts. The EU legal framework governing these questions is rather complicated, in particular, because several EU legal instruments have to be applied in combination.

The CJEU answered both questions in favour of EU trade mark owners seeking effective enforcement of their rights against multinational trade mark infringements. According to the ruling of the CJEU, an EU trade mark court is now entitled to adopt orders against a co-defendant, who is not established in the Member State of this court, with an EU-wide scope. In addition, as regards the applicable national law, an EU trade mark court does not have to apply the national law of each Member State regarding each act of infringement, but rather has to determine the Member State where the *event giving rise to the damage* occurred and to apply the law of that Member State.

Just a few weeks after this CJEU ruling, the German Federal Court of Justice applied the above findings regarding the *event giving rise to the damage* made in the context of applicable national law also for the international jurisdiction based on an act of infringement that has been committed or threatened in the Member State (Judgment of November 11, 2017, file no. I ZR 164/16 – Parfummarken [perfume trademarks]). As a result, this decision denied international jurisdiction of the German EU trade mark courts in favour of the Italian EUTM Courts, because the publication of the offer of the infringing products also towards customers in Germany on the website was initiated in Italy.

The England and Wales Court of Appeal (Judgement of February 1, 2018, AMS Neve Ltd & Ors v Heritage Audio S.L. & Anor, [2018] EWCA Civ 86) recognized that the Nintendo decision supports the conclusion that the placing by an undertaking in Member State A of an advertisement on a website targeted at consumers in Member State B is not sufficient to confer jurisdiction on an EU trade mark court in Member State B. However, this court found substantial arguments against this conclusion and referred the case for clarification to the CJEU (new case C-172/18, AMS Neve and Others, lodged on March 5, 2018).