

## International jurisdiction in online EU trade mark infringement cases: where is the place of infringement located?

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### Abstract

Article 97 of the European Union Trade Mark Regulation (EUTMR) sets a number of grounds to determine international jurisdiction in cases of alleged infringement of a European Union trade mark (EUTM). Besides the possibility to bring proceedings before the courts of the Member State of domicile/establishment of the defendant/claimant and where the European Union Intellectual Property Office (formerly the Office for Harmonization in the Internal Market) has its seat, Article 97(5) EUTMR also allows for proceedings to be brought “in the courts of the Member State in which the act of infringement has been committed or threatened”. Lacking specific guidance from the Court of Justice of the European Union (CJEU), this contribution asks how Article 97(5) EUTMR is to be interpreted in relation to proceedings for alleged infringement of a EUTM over the internet. It concludes that, in light of preceding jurisprudence, the CJEU may hold that this is place where the activation of the process for the technical display of infringing content on a certain website takes place. While in the majority of instances this is likely to be the same place where the defendant is domiciled/established, this may not always be the case.

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## 1. International jurisdiction for EU trade mark infringements

Article 97 of Regulation 207/2009 on the European Union trade mark<sup>1</sup> (EUTMR), as amended by Regulation 2015/2424<sup>2</sup>, sets a number of rules regarding international jurisdiction for European Union trade mark (EUTM) infringement cases.<sup>3</sup>

Subject to the provisions of both the EUTMR and Regulation 44/2001<sup>4</sup> (Brussels I) – the latter having been recently replaced by Regulation 1215/2012<sup>5</sup> (‘Brussels I recast’) –, as well as what is stated in Article 97(4) EUTMR, proceedings in respect of the actions and claims regarding infringement and validity of a EUTM may be brought in the courts of the Member State in which the defendant is domiciled or, lacking a domicile within the territory of the European Union (EU), in which he is established (paragraph 1). If the defendant is neither domiciled nor established in the EU, then actions may be brought before the courts of the Member State in which the claimant is domiciled or, lacking a domicile in the EU, established (paragraph 2). Lacking a domicile or establishment in the EU for both claimant and defendant, then proceedings may be brought before the courts of the Member State in which the European Union Intellectual Property Office has its seat. Paragraph 5 provides that infringement proceedings (with the exception of actions for a declaration of non-infringement of a

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<sup>1</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (codified version), OJ L 78, 1-42.

<sup>2</sup> Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark 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 Harmonization in the Internal Market (Trade Marks and Designs), OJ L 341, 21-94. This Regulation shall enter into force on 23 March 2016, with a few exceptions for some provisions to enter into force on 1 October 2017.

<sup>3</sup> Following the entry into force of Regulation 2015/2424, the text of Article 97 EUTMR will remain substantially unaffected (including now outdated references to Regulation 44/2001): “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.

2. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

3. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

4. Notwithstanding the provisions of paragraphs 1, 2 and 3: (a) Article 23 of Regulation (EC) No 44/2001 shall apply if the parties agree that a different European Union trade mark court shall have jurisdiction; (b) Article 24 of Regulation (EC) No 44/2001 shall apply if the defendant enters an appearance before a different European Union trade mark court.

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, or in which an act within the meaning of Article 9(3), second sentence, has been committed.”

<sup>4</sup> 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 L 12, 1-23.

<sup>5</sup> 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 (recast), OJ L 351, 1-32.

EUTM) may also be brought “in the courts of the Member State in which the *act of infringement* has been committed or threatened” (emphasis added). In this case, however, relief is territorially limited. Overall, the structure of Article 97 EUTMR is rigid, in the sense that the rules therein are mandatory and applied in sequence.<sup>6</sup>

This contribution is concerned with international jurisdiction for infringement proceedings. More specifically, it investigates how Article 97(5) EUTMR is to be interpreted in relation to proceedings for alleged infringement of a EUTM over the internet.

In the past, courts have held the view that jurisdiction would arise any time the website at issue is intended to be accessed in the country in which the trade mark is registered and the damage done by the infringement is accordingly inflicted there.<sup>7</sup> Whether intention to target/targeting, *ie* requiring that the activity be intended to have effects within the territory of the Member State asserting jurisdiction<sup>8</sup>, is actually the criterion to employ in online EUTM infringement cases to determine jurisdiction has not yet been addressed specifically by the Court of Justice of the European Union (CJEU). As such, lacking specific guidance in the EUTMR, it is uncertain how the Court will interpret Article 97(5) EUTMR if and when given the opportunity to do so.

The following analysis focuses on relevant CJEU decisions in the area of trade marks – whether relating to ‘offline’ infringements of EUTMs or online infringements of national trade marks – and draws a parallel with recent case law on jurisdiction in online copyright infringement cases, also considering that the same allegedly infringing act may infringe both trade mark and copyright laws. CJEU jurisprudence on online copyright jurisdiction has resulted in an interpretation of relevant provisions – notably Article 5(3) Brussels I, now Article 7(2) Brussels I recast – in such a way that courts in the Member State where the allegedly infringing content is accessible are also competent to adjudicate infringement actions. This means that, unlike other areas of intellectual property, *eg* the database right, in online copyright infringement cases accessibility – rather than intention to target – is one of the criteria required to establish jurisdiction within the meaning of Article 7(2) Brussels I recast.

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<sup>6</sup> L Bently – B Sherman, *Intellectual property law*, 4<sup>th</sup> edn (OUP:2014), 1234.

<sup>7</sup> J Phillips, *Trade mark law. A practical anatomy* (OUP:2003), 475-476, referring to the decisions of the Tribunale di Roma (Court of First Instance of Rome) in *Carpaint SpA v Microsoft Corporation* [2000] ETMR 802, and Scottish Court of Session in *Bonnier Media Ltd v Greg Lloyd Smith and Kestrel Trading Corp* [2002] 1050.

<sup>8</sup> In this sense, T Schulz, ‘Carving up the internet: jurisdiction, legal orders, and the private/public international law interface’ (2008) 19(4) EJIL 799, 817.

This contribution is structured as follows. The first part recalls the *travaux préparatoires* to the EUTMR, and addresses the relationship between Article 97 EUTMR and Article 7(2) Brussels I recast, by referring in particular to the Opinion of Advocate General ('AG') Jääskinen<sup>9</sup> and the CJEU decision<sup>10</sup> in *Coty Germany v First Note Perfumes* ('Coty'). The second part reviews relevant CJEU case law on jurisdiction in trade mark infringement cases, focusing in particular on an analysis of *L'Oréal v eBay*<sup>11</sup> ('L'Oréal') and *Wintersteiger v Products 4U*<sup>12</sup> ('Wintersteiger'). The third part analyses recent CJEU decisions on jurisdiction in online copyright infringement cases, in particular devoting attention to how the Court has interpreted the concept of 'place giving rise to the damage' in Article 7(2) Brussels I recast. The final part seeks to determine to what extent the latter case law is applicable to online EUTM infringement cases in order to define the concept of 'place of infringement' in Article 97(5) EUTMR.

This article concludes that, when and if given the opportunity to address the question of where the place of infringement within Article 97(5) EUTMR is located, in light of preceding jurisprudence the CJEU may hold that this is place where the activation of the process for the technical display of infringing material on a certain website takes place. While in the majority of instances this is likely to be the same place where the defendant is domiciled/established, this may not always be the case.

## **2. The *travaux* to the EUTMR and the relationship between Articles 97(5) EUTMR and 7(2) Brussels I recast**

In order to ensure the unitary character of EUTMs, Recital 16 EUTMR provides that decisions regarding their infringement must have effect and cover the entire EU territory. To this end the same recital establishes that the provisions of what is currently Brussels I recast should apply to all actions at law relating to EUTMs, except where the EUTMR expressly derogates from them. As is apparent from Article 94(2)(a) EUTMR, the latter is the case of what is currently Article 7 Brussels I recast (formerly Article 5 Brussels I) in relation to actions concerning the infringement of a EUTM.

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<sup>9</sup> Opinion of Advocate General Jääskinen in *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, EU:C:2013:764.

<sup>10</sup> *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, EU:C:2013:764.

<sup>11</sup> *L'Oréal SA and Others v eBay International AG and Others*, C-324/09, EU:C:2011:474.

<sup>12</sup> *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, C-523/10, EU:C:2012:220.

Besides jurisdiction rules rooted within the domicile of the claimant or the defendant, Article 7(2) Brussels I recast provides that:

“A person domiciled in a Member State may be sued in another Member State ... in matters relating to tort, delict or quasi-delict, in the courts for the *place where the harmful event occurred or may occur.*” (emphasis added)

This special rule of jurisdiction has received a fairly broad<sup>13</sup> and autonomous<sup>14</sup> – yet at times oscillating<sup>15</sup> – interpretation. Relevant CJEU case law has established that the place where the harmful event occurred or may occur is to be intended as encompassing both the place where the damage occurred and the place of the event giving rise to it, so that the defendant may be sued, at the option of the applicant, in the courts for either of those places.<sup>16</sup>

As AG Jääskinen explained in his Opinion in *Coty*<sup>17</sup> (discussed further below), the Working Group on the Community Trade Mark established by the EU Commission believed that it was necessary to derogate from the rule enshrined in Article 5 of the Convention on jurisdiction and enforcement<sup>18</sup>, the content of which is mirrored in Article 7(2) Brussels I recast. The Working Group believed (without elaborating as to why that would be the case<sup>19</sup>) that the system instituted by the Convention failed to solve the special problems arising where one EUTM can be infringed in several Member States.<sup>20</sup> As such, it proposed (Article 91(2) of the 1978 draft Regulation<sup>21</sup>) that the courts of the Member State in which the act of infringement is committed would have jurisdiction only in

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<sup>13</sup> D Jerker – B Svantesson, *Private international law and the internet*, 2<sup>nd</sup> edn (Wolters Kluwer:2012), 257.

<sup>14</sup> T Kono – P Jurčys, ‘General report’ in T Kono (ed), *Intellectual property and private international law* (Hart Publishing:2012), 53.

<sup>15</sup> *Ibid*, 53-54.

<sup>16</sup> *Handelskwekerij G. J. Bier BV v Mines de potasse d'Alsace SA*, Case 21-76, EU:C:1976:166, [19]; *Fiona Shevill, Ixora Trading Inc, Chequepoint SARL and Chequepoint International Ltd v Presse Alliance SA*, C-68/93, EU:C:1995:61, [20]-[21]; *Zuid-Chemie BV v Philippo's Mineralenfabriek NV/SA*, C-189/08, EU:C:2009:475, [23]; *eDate Advertising GmbH v X and Olivier Martinez and Robert Martinez v MGN Limited*, C-509/09 and C-161/10, EU:C:2011:685, [41]; *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, C-523/10, *cit*, [19]; *Melzer v MF Global UK Ltd*, C-228/11, EU:C:2013:305, [25]; *Peter Pinckney v KDG Mediatech AG*, C-170/12, EU:C:2013:635, [26]; *Andreas Kainz v Pantherwerke AG*, C-45/13, EU:C:2014:7, [23]; *Hi Hotel HCF SARL v Uwe Spoering*, C-387/12, EU:C:2014:215, [27]; *Coty Germany GmbH v First Note Perfumes NV*, *cit*, [32]; *Pez Hejduk v EnergieAgentur.NRW GmbH*, C-441/13, EU:C:2015:28, [18].

<sup>17</sup> Opinion of Advocate General Jääskinen in *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, *cit*, [28].

<sup>18</sup> Convention of 27 September 1968 on jurisdiction and enforcement of judgments in civil and commercial matters.

<sup>19</sup> In this sense, see also C Wadlow, *Enforcement of intellectual property in European and international law* (Sweet&Maxwell:1998), 288.

<sup>20</sup> Commission of the European Communities, Commission Working Paper – Working Group on the Community Trade Mark, III/d/1294/79, October 1979, available at <http://aei.pitt.edu/5618/1/5618.pdf>, 31.

<sup>21</sup> Draft Council Regulation on the Community trade mark, III/D/753/78, July 1978

respect of acts of infringement committed within the territory of that State.<sup>22</sup> This was required because, given the unitary nature of the EUTM system, where a EUTM is infringed each Member State may be considered in practice the place where the infringement has occurred.<sup>23</sup> Such approach would have also had the objective of reducing the risk of forum shopping.<sup>24</sup> In addition, in principle Brussels I recast only applies to defendants domiciled in the EU. If the defendant is not domiciled or established within the EU, the issue of jurisdiction must be determined by reference to the conflict of laws provisions of the Member State in question. The EUTMR was aimed at avoiding such conflicts by providing a solution also in respect of defendants domiciled or established outside the EU.<sup>25</sup>

As mentioned above, Article 97(5) EUTMR provides that proceedings in respect of validity and infringement of a EUTM, with the exception of actions for a declaration of non-infringement of a EUTM (the reason for this being to avoid torpedo actions)<sup>26</sup>, “may also be brought in the courts of the Member State in which the *act of infringement* has been committed or threatened” (emphasis added). The question that arises is whether, despite the express inapplicability of Article 7(2) Brussels I recast to EUTM infringement actions, the concept of act of infringement within Article 97(5) EUTMR has the same meaning as place where the harmful event occurred or may occur within Article 7(2) Brussels I recast.

Still in his Opinion in *Coty*, AG Jääskinen responded in the negative on this point. He advised that “the place where the act of infringement was committed is a narrower concept than the place where the harmful event occurred.”<sup>27</sup> More specifically, the place referred to in Article 97(5) EUTMR could not be such as to “create jurisdiction by reason of the place where the damage occurred”<sup>28</sup>, as is instead the case of Article 7(2) Brussels I recast.

He presented four main arguments as to why Article 97(5) EUTMR could not be interpreted in light of relevant case law on Article 7(2) Brussels I recast<sup>29</sup>:

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<sup>22</sup> Commission of the European Communities, Commission Working Paper, *cit*, 31.

<sup>23</sup> Opinion of Advocate General Jääskinen in *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, *cit*, [40].

<sup>24</sup> *Ibid*, [42].

<sup>25</sup> T Cohen Jehoram – C van Nispen – T Huydecoper, *European trademark law. Community trademark law and harmonized national trademark law* (Wolters Kluwer:2010), 526.

<sup>26</sup> A Kur, ‘Enforcement of unitary intellectual property rights: international jurisdiction and applicable law’ (2015) 10(6) *JIPLP* 468, 469

<sup>27</sup> Opinion of Advocate General Jääskinen in *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, *cit*, [31]

<sup>28</sup> *Ibid*, [32].

<sup>29</sup> *Ibid*, [25].

- a. The first reason would be one of literal interpretation of the EUTMR, which expressly excludes the applicability of Article 7 Brussels I recast to EUTM infringement proceedings.<sup>30</sup>
- b. The second reason would be linked to the *travaux préparatoires* to the EUTMR (recalled above).<sup>31</sup>
- c. The third argument would follow from a comparison with EU legal instruments adopted in other areas of intellectual property, notably Regulation 2100/94 on plant variety rights.<sup>32</sup> Such comparison would suggest that – unlike the case of plant variety rights<sup>33</sup> – with regard to EUTMs EU legislature deliberately chose to reject the ground of jurisdiction contained in the Convention/Article 7(2) Brussels I recast.
- d. Finally, the AG held the view that the series of grounds that, in relation to Article 7(2) Brussels I recast, lead courts to make the distinction between the place of the event giving rise to the damage and the place the damage occurred could not be transposed onto Article 97(5) EUTMR in view of the numerous disparities that exist in terms of the content of each of those provisions.<sup>34</sup>

Nonetheless the AG acknowledged that the rationale underlying Article 7(2) Brussels I recast is the same as that of Article 97(5) EUTMR: jurisdiction in both cases is justified in light of “the existence of a particularly close connection between the dispute and the courts of the place where the harmful event occurred, a factor which justifies the attribution of jurisdiction to those courts for reasons relating to the sound administration of justice and the efficacious conduct of proceedings.”<sup>35</sup> It follows that, although the AG doubted that an analogous interpretation could be possible at all, the guiding principles applying to the interpretation of Article 7(2) Brussels I recast could be extended to the interpretation of Article 97(5) EUTMR. This would be because “[t]hose principles include the requirements relating to the close link between the dispute and the court seised, the sound

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<sup>30</sup> *Ibid*, [26].

<sup>31</sup> *Ibid*, [28].

<sup>32</sup> Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights, OJ L 227, 1-30.

<sup>33</sup> As regards jurisdiction and procedure in legal actions relating to civil law claims, Article 101(3) of Regulation 2100/94 provides that: “Proceedings relating to actions in respect of claims for infringement may also be brought in the courts for the place where the harmful event occurred. In such cases, the court shall have jurisdiction only in respect of infringements alleged to have been committed in the territory of the Member State to which it belongs.”

<sup>34</sup> Opinion of Advocate General Jääskinen in *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, *cit*, [30]

<sup>35</sup> *Ibid*, [33].

administration of justice and the efficacious conduct of proceedings, but also ... the predictability of the rules of jurisdiction and legal certainty.”<sup>36</sup>

The CJEU confirmed the analysis of AG Jääskinen in its subsequent decision in *Coty*.

### 3. The CJEU decision in *Coty*: how would its principles apply in an online context?

*Coty* was a reference for a preliminary ruling from the Bundesgerichtshof (BGH, the German Federal Court of Justice), seeking clarification as to whether what is currently Article 97(5) EUTMR means that an act of infringement is committed in one Member State in the case where, as a result of an act in another Member State, there is participation in the infringement in the first-named Member State.

This reference arose in the context of the EUTM infringement proceedings that *Coty* Germany, an undertaking established in Germany that produced and distributed perfumes and cosmetic products, had brought against First Note. The latter was a perfume wholesaler established in Belgium. In 2007 First Note sold a perfume called *Blue Safe for Women* to an individual, Stefan P, whose place of business was in Germany. Stefan P took delivery of those products at the premises of First Note in Belgium and subsequently resold them in Germany.

*Coty* Germany owned a three-dimensional EUTM registered for perfumes and representing a bottle. It marketed a women’s perfume called *Davidoff Cool Water Woman* in a bottle reproducing its EUTM. It brought an action against First Note, claiming that the distribution by First Note of *Blue Safe for Women* in a bottle similar to that of *Davidoff Cool Water Woman* amounted to an infringement of its EUTM.

*Coty* Germany was unsuccessful at both first instance and on appeal. In particular it was held on appeal that German courts did not have jurisdiction to hear such action. The BGH subsequently decided to stay the proceedings and make a reference for a preliminary ruling to the CJEU.

The CJEU began its analysis explaining that, by referring this question, the BGH had asked in essence whether German courts could have jurisdiction to hear an infringement action against a subject (the original seller) established in Belgium and that had not itself acted in Germany. In other words, could German courts be considered competent because Germany was the place where the harmful event occurred? The Court reiterated the view of AG Jääskinen, and ruled out that Article 97(5) EUTMR could be interpreted analogously to Article 7(2) Brussels I recast. This would be both

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<sup>36</sup> *Ibid*, [34].



because the EUTMR expressly excludes applicability of Article 7 Brussels I recast to infringement proceedings<sup>37</sup> and provides already for several grounds of international jurisdiction.<sup>38</sup> Furthermore,

“the concept of ‘the Member State in which the act of infringement has been committed or threatened’, referred to in that provision, must be interpreted independently of the concept of ‘the place where the harmful event occurred or may occur’ referred to in [Article 7(2) Brussels I recast]. Consequently, the duality of linking factors, namely the place of the event giving rise to the damage and that where the damage occurred, accepted by the Court’s case-law relating to [Article 7(2) Brussels I Recast], cannot automatically apply to the interpretation of the concept of ‘the Member State in which the act of infringement has been committed or threatened’ in Article [97(5) EUTMR].”<sup>39</sup>

In line with the AG Opinion<sup>40</sup>, the Court held that the concept of ‘the Member State in which the act of infringement has been committed’ within Article 97(5) EUTMR implies that “that linking factor relates to active conduct on the part of the person causing that infringement. Therefore, the linking factor provided for by that provision refers to the Member State where the act giving rise to the alleged infringement occurred or may occur, not the Member State where that infringement produces its effects.”<sup>41</sup>

As such, the grounds for jurisdiction pursuant to Article 97(5) EUTMR would be narrower than those within Article 7(2) Brussels I recast, since they would only grant jurisdiction to the courts in the Member State where the event giving rising to the damage occurred, not also those located in the Member State where such damage produces its effects.

While this conclusion may appear straightforward to apply (albeit possibly not uncontroversially, as is explained more in detail further below) in the case of ‘offline’ infringements like the one at issue in the background proceedings to *Coty*, determining where the relevant act of infringement takes place in the context of online activities in order to determine jurisdiction within Article 97(5) EUTMR may prove more challenging. What would happen in a case similar to *Coty* but with the difference that First Note made the bottles of perfume available for sale over the internet? Where would the place of infringement be located in this instance?

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<sup>37</sup> *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, *cit*, [26]-[28].

<sup>38</sup> *Ibid*, [29].

<sup>39</sup> *Ibid*, [31]-[32].

<sup>40</sup> Opinion of Advocate General Jääskinen in *Coty Germany GmbH v First Note Perfumes NV*, C-360/12, *cit*, [31].

<sup>41</sup> *Coty Germany GmbH v First Note Perfumes NV*, [34].

The CJEU has yet to address specifically this point. Although it may be argued that some guidance may be inferred from its earlier decision in *L'Oréal*<sup>42</sup> and *Wintersteiger*<sup>43</sup>, neither appears to provide *per se* an unequivocal response in this respect.

#### 4. *L'Oréal and Wintersteiger*

The reference for a preliminary ruling in *L'Oréal* was made in the context of litigation before the High Court of England and Wales between *L'Oréal* (a well-known manufacturer and supplier of perfumes, cosmetics and hair-care products) and electronic marketplace operator eBay. *L'Oréal* sued the latter in a number of Member States, including the UK, claiming trade mark infringement in certain counterfeit items that third-parties had sold through eBay. The High Court made a reference to the CJEU asking whether the proprietor of a registered trade mark (whether national or EU) could prevent, under Article 5 of Directive 89/104<sup>44</sup> (codified as Directive 2008/95<sup>45</sup>, currently Article 10 of Directive 2015/2436<sup>46</sup>, the 'Trade Mark Directive') and Article 9 EUTMR, the offer for sale, on an online marketplace, of goods bearing that trade mark which have not previously been put on the market in the EEA or, in the case of a EUTM, in the EU, it is sufficient that the offer for sale is targeted at consumers located in the territory covered by the trade mark.<sup>47</sup>

The CJEU found that "the rules of Directive 89/104 and Regulation No 40/94 apply as soon as it is clear that the offer for sale of a trade-marked product located in a third State is targeted at consumers in the territory covered by the trade mark."<sup>48</sup> To hold otherwise would be to affect negatively the *effet utile* of those rules.<sup>49</sup> In its earlier decision in *Pammer and Hotel Alpenhof*<sup>50</sup>, the CJEU had noted that the mere fact that a website is accessible from the territory covered by the trade mark is not a

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<sup>42</sup> *L'Oréal SA and Others v eBay International AG and Others, cit.*

<sup>43</sup> *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH, C-523/10, cit.*

<sup>44</sup> First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, OJ L 40, 1-7.

<sup>45</sup> Directive 2008/95 of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (codified version), L 299, 25-33.

<sup>46</sup> 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 L 336, 1-26, for which implementation at the national level is due by 14 January 2019.

<sup>47</sup> *L'Oréal SA and Others v eBay International AG and Others, C-324/09, cit.*, [58].

<sup>48</sup> *Ibid.*, [61]-[62].

<sup>49</sup> *Ibid.*, [62].

<sup>50</sup> *Peter Pammer v Reederei Karl Schlüter GmbH & Co KG and Hotel Alpenhof GesmbH v Oliver Heller, C-585/08 and C-144/09, EU:C:2010:740.*

sufficient basis for concluding that the offers for sale displayed there are targeted at consumers in that territory. The references in these cases, eventually joined, had arisen in the context of litigation between traders that had concluded a contract with consumers domiciled in a Member State different from that of establishment of the former. In both cases the Oberster Gerichtshof (OGH, the Austrian Supreme Court) had to determine whether the trader had directed its activity to the Member State of the consumer's domicile, within the meaning of Article 15(1)(c) Brussels I (currently Article 17(1)(c) Brussels I Recast), so that Austrian courts would have jurisdiction to give judgment on the disputes. The OGH sought guidance from the CJEU as to the correct interpretation of this provision in the Brussels I Regulation. The CJEU held – among other things – that the words 'directs such activities to' in that provision must not be interpreted as relating to a website's merely being accessible in Member States other than that in which the trader concerned is established.<sup>51</sup> If it was sufficient for an online marketplace to be accessible from an EU Member State for the advertisements displayed there to be within the scope of Directive 89/104 and the EUTMR, this would result in an undue extension of the application of EU law.<sup>52</sup>

In *L'Oréal* the CJEU appeared to suggest that intention to target, rather than accessibility, is required to trigger applicability of the Trade Mark Directive and the EUTMR. While this response was framed within a specific question regarding an online marketplace located outside the EEA/EU and concerned the issue of when EU law applies<sup>53</sup>, the Court did not touch upon the issue of the place of infringement for the sake of establishing jurisdiction in case of alleged infringement of a EUTM over the internet. As such, despite suggestions to the contrary<sup>54</sup>, *L'Oréal* cannot be regarded as having established that targeting is required to determine jurisdiction within the EU. In this respect greater assistance may be instead found in *Wintersteiger*, although this case concerned a national trade mark.

This reference for a preliminary ruling arose in the context of litigation between an undertaking (*Wintersteiger*) established in Austria and one (*Products 4U*) established in Germany. Both manufactured and sold ski and snowboard servicing tools, together with replacement parts and accessories. With regard to the latter, *Products 4U* also sold accessories for tools made by other manufacturers, including *Wintersteiger*, although in the specific case of this Austrian-based undertaking it did so without its authorisation. To advertise its services under the Google's German top-level domain (*google.de*), *Product 4U* had reserved as Google Adword 'Wintersteiger', which

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<sup>51</sup> *Ibid*, [69].

<sup>52</sup> *L'Oréal SA and Others v eBay International AG and Others*, C-324/09, *cit*, [64].

<sup>53</sup> In this sense, see C Morcom, 'Trade marks and the Internet: where are now?' (2012) 34(1) EIPR 40, 49.

<sup>54</sup> See eg A Blythe, 'Searching questions: issues surrounding trade mark use on the internet' (2013) 35(9) EIPR 507, 512-513.

corresponded to the Austrian registered trade mark owned by Wintersteiger. The latter sought an injunction in the Austrian courts claiming that, by placing the advertisement on google.de, Products 4U infringed its Austrian trade mark.

In respect of the jurisdiction of those courts to hear its application, Wintersteiger relied on what is currently Article 7(2) Brussels I recast. It argued that google.de could be also accessed in Austria and that the referencing service was configured in German. Products 4U objected to the jurisdiction of Austrian courts, in that google.de would be directed exclusively at German users, not also Austrian ones.

While the court of first instance rejected Wintersteiger's application on consideration that it lacked competence to hear such action, the court of appeal found that it did have international jurisdiction but nonetheless rejected Wintersteiger's application on the merits. The OGH stayed the proceedings and sought guidance from the CJEU as to under what conditions the advertising by use of the Austrian trade mark Wintersteiger on a website operating under a country-specific top-level domain .de may confer jurisdiction on the Austrian courts under Article 7(2) Brussels I recast to hear an action for an injunction against use of an Austrian trade mark.

The CJEU considered separately the concepts of place where the damage occurred and place where the event giving rise to the damage occurred. With particular regard to the latter (which is the one relevant to the present discussion), the Court first noted that the event giving rise to a possible infringement of trade mark law would consist of the actions of the advertiser using the referencing service for its own commercial communications, not in the actions of the provider (Google) of such referencing service.<sup>55</sup> It then dismissed the idea that such place could be considered the place of establishment of the server, by reason of its uncertain location.<sup>56</sup> The Court concluded that:

“since it is a definite and identifiable place, both for the applicant and for the defendant, and is therefore likely to facilitate the taking of evidence and the conduct of the proceedings, it must be held that the place of establishment of the advertiser is the place where the activation of the display process is decided.”<sup>57</sup>

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<sup>55</sup> *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, C-523/10, *cit.*, [35], recalling *Google France SARL and Google Inc v Louis Vuitton Malletier SA*, *Google France SARL v Viaticum SA and Luteciel SARL* and *Google France SARL v Centre national de recherche en relations humaines (CNRRH) SARL and Others*, C-236/08 to C-238/08, EU:C:2010:159, [52] and [58].

<sup>56</sup> *Ibid.*, [36].

<sup>57</sup> *Ibid.*, [37].

As such, the Court appeared to suggest – although it failed to elaborate further on this point (including with regard to the issue of damages)<sup>58</sup> – that the place where the event giving rise to the damage occurred within Article 7(2) Brussels I Recast would be the place where the alleged infringer is established. This is because such place would *likely* be the place where the relevant act of infringement took place. This conclusion is in line with the Opinion of AG Cruz Villalón in the same case, in which he held the view that this is “where the means necessary to produce an actual infringement of a mark were used.”<sup>59</sup> While in most instances such place is likely to be where the defendant is established, “situations may arise in which the defendant’s domicile and the place of the event giving rise to the damage are not in the same State.”<sup>60</sup> Determining where the act of uploading has taken place depends in fact on where the defendant was located at the time when he/she made the allegedly infringing goods/services available online.<sup>61</sup>

If it is true, as both AG Jääskinen and the CJEU indicated in *Coty*, that the place of infringement within Article 97(5) EUTMR corresponds to the place where the event giving rise to the damage occurred within Article 7(2) Brussels I recast, then for alleged online EUTM infringements such place would be where the alleged infringer is established, in that this is the place in which the activation process is decided.

This conclusion suggests that, in regard of alleged online EUTM infringements, the criterion to adopt when interpreting Article 97(5) EUTMR would be the one suggested by the Court in *Wintersteiger* and – to some extent and albeit in a different context (copyright) – AG Cruz Villalón in his Opinion in *Hejduk*. The latter is the latest instalment in the recent string of CJEU references regarding international jurisdiction in online copyright infringement cases.

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<sup>58</sup> See the discussion in P Savola, ‘The ultimate copyright shopping opportunity – jurisdiction and choice of law in website blocking injunctions’ (2014) 45(3) IIC 287, 292-298.

<sup>59</sup> Opinion of Advocate General Cruz Villalón in *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, C-523/10, EU:C:2012:90, [26].

<sup>60</sup> *Ibid.*

<sup>61</sup> S Depreeuw – JB Hubin, ‘Of availability, targeting and accessibility: online copyright infringements and jurisdiction in the EU’ (2014) 9(9) JIPLP 750, 763.

## 5. CJEU case law on online copyright infringement: from *Pinckney* to *Hejduk* via *Hi Hotel*

The 2013 decision in *Pinckney v Mediatech*<sup>62</sup> (*Pinckney*) allowed the CJEU to address for the first time how Article 7(2) Brussels I recast should be interpreted in the specific context of online copyright infringement cases.

This reference for a preliminary ruling was made in the context of proceedings between a French resident (*Pinckney*) and a company (*Mediatech*) established in Austria, concerning a claim for damages resulting from the infringement of copyright of the former in a number of musical works. *Pinckney* discovered that those works had been reproduced without his consent on CDs pressed in Austria by *Mediatech*, and then marketed by two UK companies through various internet websites accessible from his residence in Toulouse. He sued *Mediatech* before the Toulouse Regional Court seeking compensation for the damages sustained on account of the infringement of his copyrights. The defendant unsuccessfully challenged the jurisdiction of the French courts. *Mediatech* appealed against the decision at first instance, arguing that the only courts having jurisdiction were the courts of the place of the defendant's domicile (Austria), or the courts of the place where the damage was caused (UK). The Toulouse Court of Appeal agreed with *Mediatech*, so *Pinckney* appealed the decision before the French Court of Cassation, which decided to stay the proceedings and seek guidance from the CJEU.

The *Pinckney* reference concerned interpretation of the concept of place where the damage occurred, rather than place of the event giving rise to the damage.<sup>63</sup> Following the decision in *Coty*, it may be of limited relevance to the present analysis, though it is worth stressing that the Court rejected the approach indicated as preferable by AG Jääskinen in his Opinion in the same case, *ie* that to establish jurisdiction within Article 7(2) Brussels I recast it is required that the allegedly infringing act of the defendant is targeted at the Member State in which the court seised is located.<sup>64</sup> This would not be the case, according to the Court, because *nothing* in Article 7(2) Brussels I recast appears to require so.<sup>65</sup> The CJEU concluded that jurisdiction within Article 7(2) Brussels I recast subsists also in relation to the courts located in the Member State in which the allegedly infringing

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<sup>62</sup> *Peter Pinckney v KDG Mediatech AG*, C-170/12, *cit.*

<sup>63</sup> *Ibid.*, [29].

<sup>64</sup> Opinion of Advocate General Jääskinen in *Peter Pinckney v KDG Mediatech AG*, C-170/12, EU:C:2013:400, [61]-[65].

<sup>65</sup> *Peter Pinckney v KDG Mediatech AG*, C-170/12, *cit.*, [42]. On targeting and Article 5(3) Brussels I in the pre-*Pinckney* era, see G Smith, 'Here, there or everywhere? Cross-border liability on the internet' (2007) 13(2) *CTLR* 41, 44, noting how, while on the one hand this provision does not appear to require targeting, on the other hand the approach of UK courts (*Tesam Distribution Ltd v Schuh Mode Team GmbH* [1990] *ILPR* 149, CA; *Müllycke AB v Procter & Gamble Ltd* [1992] 1 *WLR* 1112, CA; *ABKCO Music & Records Inc v Music Collection International Ltd* [1995] *RPC* 657, CA), unlike courts in other Member States (*eg* Germany and Denmark), has been in the sense of requiring targeting of UK jurisdiction.

content can be accessed, although in this case the court seized would be only competent to adjudicate on the damages occurred on that specific territory.<sup>66</sup>

In his Opinion AG Jääskinen had highlighted the potential risks associated with the adoption of an accessibility criterion to establish jurisdiction, in lieu of a targeting approach, particularly with regard to forum shopping and ultimately “a multiplication of courts”.<sup>67</sup> Besides issues arising from limitations in damages<sup>68</sup>, adopting accessibility as a criterion to establish jurisdiction might also facilitate a deep-pocketed claimant to sue – if not harasses altogether (this might be for instance the case of so called copyright “trolls”) – the defendant before a multiplicity of courts, possibly with the objective of pushing him/her into a settlement.<sup>69</sup> Above all this approach might have the effect of conferring jurisdiction over non-existent torts. This is because the issue of jurisdiction would not really depend on the merits of the underlying cause of action. The result might be that a national court is compelled to accept jurisdiction on the basis that the allegedly infringing content can be accessed in that territory, to conclude eventually that there is no infringement of relevant rights because the website at issue is not targeted at that territory.

Nonetheless, the CJEU confirmed accessibility as a valid criterion to establish jurisdiction pursuant to Article 7(2) Brussels I recast in *Hi Hotel v Uwe Spoering*<sup>70</sup> (*Hi Hotel*). This reference for a preliminary ruling from the BGH arose in the context of litigation between a photographer and a hotel chain. The former had been commissioned to take a number of photographs of Hi Hotel rooms in Nice, and granted Hi Hotel the right to use them in advertising brochures and on its website. He subsequently noticed in a bookshop in Cologne an illustrated book on interior architecture published by a German publisher, containing reproductions of some of his photographs. He successfully sued Hi Hotel (established in France) for copyright infringement before a German court. The subsequent appeal brought by Hi Hotel was dismissed. The BGH decided to stay the proceedings and seek guidance from the CJEU as to whether German courts could be competent to hear such action.

The CJEU also confirmed that the place giving rise to the damage within that provision cannot be considered as conferring jurisdiction to courts located in a Member State in which the alleged

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<sup>66</sup> *Peter Pinckney v KDG Mediatech AG*, C-170/12, *cit.*, [44]-[47].

<sup>67</sup> Opinion of Advocate General Jääskinen in *Peter Pinckney v KDG Mediatech AG*, C-170/12, *cit.*, [68].

<sup>68</sup> Depreeuw –Hubin, ‘Of availability, targeting and accessibility’, *cit.*, 764.

<sup>69</sup> In this sense, see P Torremans, ‘Jurisdiction in intellectual property cases’ in P Torremans (ed), *Research handbook on cross-border enforcement of intellectual property* (Edward Elgar:2014), 386, and K Bercimuelle-Chamot, ‘Accessibility is the relevant criterion to determine jurisdiction in online copyright infringement cases’ (2015) 10(6) *JIPLP* 406, 407.

<sup>70</sup> *Hi Hotel HCF SARL v Uwe Spoering*, C-387/12, *cit.*

infringer has not acted.<sup>71</sup> Despite this, in his subsequent Opinion in *Hejduk v EnergieAgentur*<sup>72</sup>(*Hejduk*), AG Cruz Villalón also highlighted the potential shortcomings of the accessibility criterion, and advised (unsuccessfully) the CJEU to employ the causal event criterion that the Court itself had rejected in *Hi Hotel*.

The reference in *Hejduk* was made in the context of proceedings for copyright infringement that an Austrian resident and professional photographer had brought before the Handelsgericht Wien (Vienna Court of First Instance) against a company established in Germany. The litigation concerned unauthorised publication of protected works of the claimant on the defendant's website for viewing and downloading. The defendant objected to the jurisdiction of Austrian courts: since it was established in Germany and its webpage used a .de top level domain, the competence to hear this case would have been of German courts. The Handelsgericht Wien decided to stay the proceedings and ask the CJEU whether Article 7(2) Brussels I recast provides that jurisdiction subsists for courts situated alternatively in the Member State in which the alleged perpetrator of the infringement is established or that to which the website, according to its content, is directed.

In his Opinion AG Cruz Villalón noted at the outset how the factual background made this case different from *Pinckney*, notably because the works at issue in the former were not offered for sale.<sup>73</sup> As such, localising the damage could prove challenging. Although the Austrian court only referred to two possible linking factors (these being the defendant's domicile and the Member State to which the website's content is directed), in his analysis the AG also explored other possibilities. After reviewing the centre of interest criterion (which the CJEU adopted in *Shevill*<sup>74</sup> and *eDate*<sup>75</sup> but rejected in relation to intellectual property rights in *Wintersteiger*)<sup>76</sup>, the AG addressed the targeting criterion (referred to in the Opinion as focalisation criterion). He noted how the CJEU adopted it in *L'Oréal* but subsequently rejected in *Pinckney* on grounds that Article 7(2) Brussels I recast does not require that the activity concerned be targeted at the Member State in which the court seised is situated. According to the AG, the CJEU stance in *Pinckney* should be read as "rul[ing] out in principle

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<sup>71</sup> Judgment in *Hi Hotel HCF SARL v Uwe Spoering*, C-387/12, *cit.*, [31], recalling the earlier judgment in *Melzer v MF Global UK Ltd*, C-228/11, *cit.*, [40].

<sup>72</sup> Opinion of Advocate General Cruz Villalón in *Pez Hejduk v EnergieAgentur.NRW GmbH*, C-441/13, EU:C:2014:2212.

<sup>73</sup> *Ibid.*, [2]-[3].

<sup>74</sup> *Fiona Shevill, Ixora Trading Inc., Chequepoint SARL and Chequepoint International Ltd v Presse Alliance SA*, C-68/93, *cit.*

<sup>75</sup> *eDate Advertising GmbH v X and Olivier Martinez and Robert Martinez v MGN Limited*, C-509/09 and C-161/10, *cit.*

<sup>76</sup> Opinion of Advocate General Cruz Villalón in *Pez Hejduk v EnergieAgentur.NRW GmbH*, C-441/13, *cit.*, [23]-[27].



the possibility of extending the focalisation criterion to cases of non-contractual damages based on infringements of intellectual property rights.”<sup>77</sup>

The AG also dismissed the accessibility criterion (referred to in the Opinion as the territoriality criterion) adopted in *Pinckney*. He agreed with the Commission that had noted how limitations on damages (only those suffered in the territory of the Member State in which the court seised is situated) might prove ineffective in a case like that at hand. Not only would it be difficult for the defendant having potentially to face actions in multiple Member States, but also the claimant would have limited benefits from seeking limited damages in more jurisdictions.<sup>78</sup> The AG concluded that to comply with the objectives of Article 7(2) Brussels I recast (these being the same underlying the special provision in Article 97(5) EUTMR), notably the sound administration of justice<sup>79</sup>, in cases where delocalised damage occurs on the internet the best option is to exclude the possibility of suing in the courts of the State where the damage occurred and to limit jurisdiction, at least that based on Article 7(2) Brussels I recast, to the courts of the State where the event giving rise to the damage occurred.<sup>80</sup> In any case, this option would not exclude the jurisdiction of the courts of the Member State where the defendant is domiciled. Although in the majority of cases both criteria would lead to the same court, this might not always be so.<sup>81</sup>

The CJEU did not follow the approach suggested by AG Cruz Villalón, and confirmed instead the possibility for one to sue *also* before the courts of the Member State in which the damage occurred. As regards the causal event criterion, the Court also stated that this, which is defined as the event which gives rise to the alleged damage, would not attribute jurisdiction to the court seised.<sup>82</sup> Where the alleged tort consisted in the online infringement of an intellectual property right (copyright), “the activation of the process for the technical display of the photographs on that website must be regarded as the causal event. The event giving rise to a possible infringement of copyright therefore lies in the actions of the owner of that site”.<sup>83</sup> The Court found that in a case like the one at hand, the acts or omissions liable to constitute such an infringement could be only localised only at the place

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<sup>77</sup> *Ibid*, [31].

<sup>78</sup> *Ibid*, [40]

<sup>79</sup> *Ibid*, [42].

<sup>80</sup> *Ibid*, [45].

<sup>81</sup> *Ibid*.

<sup>82</sup> *Pez Hejduk v EnergieAgentur.NRW GmbH*, C-441/13, *cit*, [23]-[26].

<sup>83</sup> *Ibid*, [24], referring to *Wintersteiger AG v Products 4U Sondermaschinenbau GmbH*, C-523/10, *cit*, [34]-[35].

where the defendant had its seat, since that is where the company took and carried out the decision to place the allegedly infringing reproductions online on a particular website.<sup>84</sup>

## 6. Conclusion: the place of infringement as the place of the activation process – an unhelpful criterion

Recent CJEU case law – notably *Coty* – has drawn a distinction between the notions of ‘harmful event’ in Article 7(2) Brussels I recast and ‘act of infringement’ in Article 97(5) EUTMR. The result is that jurisprudence relating to interpretation of the former provision would not be really applicable in the context of EUTM infringements. This conclusion may be regarded as incorrect in the sense that the *forum loci delicti* in Article 97(5) EUTMR would be derived from Article 7(2) Brussels I recast and should be given the same meaning.<sup>85</sup> There would be no determinative reason as to why an exception to the criteria for jurisdiction pursuant to Article 7(2) Brussels I recast should be made.<sup>86</sup> It has also been argued that locating the act and effect of an infringement would not make sense in relation to intellectual property rights.<sup>87</sup> Overall – unlike general tort law – it would be inappropriate to distinguish between physical actions taken in one country, *eg* manufacturing of infringing goods, and their effects, *eg* distribution of those goods to the public in a foreign market. This would arise from the consideration of how:

“[T]he territorial structure of intellectual property requires that each element in a sequence of (domestic) acts and (foreign) effects be evaluated separately as to whether it constitutes, in itself, an infringement of a domestic right. It follows already from the characteristic feature of intellectual property that jurisdiction is regularly vested in the courts where the alleged infringer has substantially acted as well as in those where the effect accrues. Other than in general tort law, the theoretical possibility of restricting jurisdiction to the courts in the country where either the defendant has acted or where the direct injury is felt is not a viable option.”<sup>88</sup>

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<sup>84</sup> *Pez Hejduk v EnergieAgentur.NRW GmbH*, C-441/13, *cit.*, [25].

<sup>85</sup> In this sense, *see* V Scordamaglia, ‘Jurisdiction and procedure in legal actions’ in M Franzosi (ed), *European Community trade mark. Commentary to the European Community regulations* (Kluwer Law International:1997), 387; Torremans, ‘Jurisdiction’, *cit.*, 383; 117; Cohen Jehoram – van Nispen – Huydecoper, *European trademark law*, *cit.*, 527.

<sup>86</sup> A Nuyts, ‘Suing at the place of infringement: the application of Article 5(3) of Regulation 44/2001 to IP matters and internet disputes’ in A Nuyts (ed), *International litigation in intellectual property and information technology* (Wolters Kluwer:2008), 117.

<sup>87</sup> Kur, ‘Enforcement of unitary intellectual property rights’, *cit.*, 471.

<sup>88</sup> A Kur, ‘Article 2:202: Infringement’ in European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP), *Conflict of law in intellectual property. The CLIP principles and commentary* (OUP:2013), 70. But *see* E Jooris, ‘Infringement of

It is also necessary to qualify the statement that Brussels I recast jurisprudence would be inapplicable to Article 97(5) EUTMR situations. Following the reasoning of both AG Jääskinen and the CJEU in *Coty*, jurisprudence on Article 7(2) Brussels I recast would not be applicable to Article 97(5) EUTMR cases only insofar as it concerns the place of the harmful event intended as the place where the damage has occurred. Jurisprudence on Article 7(2) Brussels I recast would be instead applicable by analogy to Article 97(5) EUTMR situations in the part in which the place of the harmful event is intended as the place giving rise to the damage.

With regard to online infringement cases, the CJEU has had the opportunity to determine the concept of place of the event giving rise to the damage in respect of national trade marks (*Wintersteiger*) and copyright (*Pinckney*, and *Hejduk*). In *Wintersteiger* the Court held that such place would be where the activation of the display process is decided. Although in that case such place was found to coincide with the Member State of establishment of the alleged infringer, in subsequent case law (and also in the Opinion of AG Cruz Villalón in *Wintersteiger*) the CJEU clarified that the place of the event giving rise to the damage is likely to coincide with the place where the defendant is established, although it held further (*Hejduk*) that what is key is indeed to determine where the activation of the process for the technical display of the infringing content on a certain website has occurred.

In relation to online EUTM infringement cases, the CJEU decision in *L'Oréal* does not appear to constitute a valid precedent to identify the competent court(s). First, that case regarded applicability of EU trade mark legal instruments to an online platform established outside the territory of the EU, rather than determination of jurisdiction in such cases. This was in light of the overarching objective not to limit trade mark protection to cases in which the goods in question are put on the market in the EU.<sup>89</sup> Secondly, similarly to Article 7(2) Brussels I recast (as interpreted by the CJEU in *Pinckney*, *Hi Hotel* and *Hejduk*) there is nothing in Article 97(5) EUTMR that appears to require targeting/intention to target to determine judicial competence.

From the preceding analysis it follows that the place of infringement in Article 97(5) EUTMR should be located where the activation process for the display of content (goods or services) that infringes a EUTM has occurred. Even prior to the CJEU decision in *Wintersteiger* it had been suggested

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foreign copyright and the jurisdiction of English courts' (1996) 18(3) EIPR 127, 139-140, arguing in the sense of inappropriateness of the duality of jurisdictions in Article 7(2) Brussels I recast.

<sup>89</sup> Opinion of Advocate General Jääskinen in *L'Oréal SA and Others v eBay International AG and Others*, C-324/09, EU:C:2010:757, [127].

that this place would be where the allegedly infringing sign is used or sent.<sup>90</sup> In most cases such place is likely to coincide with the Member State where the defendant is domiciled/established and, therefore, with the criterion of jurisdiction indicated in Article 97(1). There may be however instances in which this will not be the case.

It is arguable that such an interpretation of Article 97(5) EUTMR – if endorsed by the CJEU – would likely trigger some unwanted consequences.

On the one hand, the choices for the claimant would be reduced, in the sense that the criterion in Article 97(5) EUTMR would likely be the same (even if not always) as that of the place of domicile/establishment of the defendant. In addition, unlike Article 7(2) Brussels I recast and in light of the CJEU stance in *Coty*, the place where the damage occurred could not represent a valid criterion to determine jurisdiction. The shortcomings of limiting jurisdiction only to the courts located in the place of the causal event have been highlighted both by AGs Darmon<sup>91</sup> and Léger<sup>92</sup> and the CJEU in *Shevill*, when it considered that this place would like coincide with the place where the defendant is domiciled or established, and limiting jurisdiction only to this ground would make the special rule in Article 7(2) Brussels I recast (and consequently also Article 97(5) EUTMR) “meaningless”.<sup>93</sup> In addition, with particular regard to online infringement cases, determination of the defendant's domicile/establishment may not always be a straightforward process.<sup>94</sup>

On the other hand, in Article 97(5) EUTMR situations, jurisdiction would subsist even without the need to prove that the allegedly infringing activities of the defendant were directed at consumers located in that Member State. However, the fact that targeting would not be expressly required to establish jurisdiction might have implications with regard to the damages that the claimant would be realistically able to seek and obtain in that particular Member State. For a claimant to be able to rely effectively on Article 97(5) EUTMR – and make it worth for him/her to start proceedings in a certain Member State – it would be in fact necessary to demonstrate not only that

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<sup>90</sup> Nuyts, ‘Suing at the place of infringement’, *cit*, 120.

<sup>91</sup> Opinion of Advocate General Darmon in *Fiona Shevill, Ixora Trading Inc, Chequepoint SARL and Chequepoint International Ltd v Presse Alliance SA*, C-68/93, EU:C:1994:303, [42] ff.

<sup>92</sup> Opinion of Advocate General Léger in *Fiona Shevill, Ixora Trading Inc, Chequepoint SARL and Chequepoint International Ltd v Presse Alliance SA*, C-68/93, EU:C:1994:303, [9] ff.

<sup>93</sup> *Fiona Shevill, Ixora Trading Inc, Chequepoint SARL and Chequepoint International Ltd v Presse Alliance SA*, C-68/93, *cit*, [27]

<sup>94</sup> Y Lahlou – L Sinopoli – P Guez, ‘Chronicle of conflict of law in business matters’ (2013) 3 IBLJ 217, 220.

the defendant has acted in that territory by activating the relevant display process, but also that the activity at issue may be considered as having been directed to consumers on that specific territory.<sup>95</sup>

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<sup>95</sup> This conclusion appears in line with what the European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP) proposed in its 2011 Principles, notably in Article 2:202 (on which *see* Kur, 'Article 2:202', *cit.*, 69 ff): "In disputes concerned with infringement of an intellectual property right, a person may be sued in the courts of the State where the alleged infringement occurs or may occur, unless the alleged infringer has not acted in that State to initiate or further the infringement and her or his activity cannot reasonably be seen as having been directed to that State."