

Court of Justice EU, 27 September 2017, Nintendo v BigBen



#### PRIVATE INTERNATIONAL LAW

The Community design court can, in cases where the jurisdiction towards one defendant is based on Article 82(1) Community Designs Regulation (CDR) and jurisdiction towards a second defendant established in another Member State is based on Article 6(1) Brussel I Regulation and Article 79(1) of the CDR, because the second defendant makes and supplies goods to the first defendant, adopt orders concerning measures falling under Article 89(1) and Article 88(2) CDR also covering the second defendant's conduct other than that relating to the supply chain and with a scope which extends throughout the European Union

- that in circumstances such as those in the main proceedings where the international jurisdiction of a Community design court seized of an action for infringement is based, with regard to one defendant, on Article 82(1) of Regulation No 6/2002 and, with regard to a second defendant established in another Member State, on that Article 6(1) read in conjunction with Article 79(1) of Regulation No 6/2002, because the second defendant makes and supplies to the first defendant the goods that the latter sells, that court may, on the applicant's request, adopt orders in respect of the second defendant concerning measures falling under Article 89(1) and Article 88(2) of Regulation No 6/2002 also covering the second defendant's conduct other than that relating to the abovementioned supply chain and with a scope which extends throughout the European Union.

Concept "country in which the act of infringement was committed" from Article 8(2) Rome II Regulation refers to the country where the event giving rise to the damage occurred

- that the 'country in which the act of infringement was committed' within the meaning of

that provision refers to the country where the event giving rise to the damage occurred.

Where the same defendant is accused of various acts of infringement in various Member States, the correct approach for identifying the event giving rise to the damage is not to refer to each alleged act of infringement, but to make an overall assessment of that defendant's conduct in order to determine the place where the initial act of infringement at the origin of that conduct was committed or threatened by it.

- Where the same defendant is accused of various acts of infringement in various Member States, the correct approach for identifying the event giving rise to the damage is not to refer to each alleged act of infringement, but to make an overall assessment of that defendant's conduct in order to determine the place where the initial act of infringement at the origin of that conduct was committed or threatened by it.

#### DESIGN LAW

Third party that, without consent of the holder of rights of a design, uses images of goods corresponding to a Community design when lawfully offering for sale goods intended to be used as accessories to specific goods of the holder of the rights of those designs in order to explain the joint use of the goods thus offered for sale and the specific goods of the holder of those rights, carries out an authorised "reproduction for the purpose of making citations" within the meaning of Article 20(1)(c) CDR, as long as it fulfils the cumulative conditions laid down therein, which is for the national court to verify

- that a third party which, without the consent of the holder of the rights conferred by a Community design, uses, including via its website, images of goods corresponding to such designs when lawfully offering for sale goods intended to be used as accessories to the specific goods of the holder of the rights conferred by those designs, in order to explain or demonstrate the joint use of the goods thus offered for sale and the specific goods of the holder of those rights, carries out an act of reproduction for the purpose of making 'citations' within the meaning of Article 20(1)(c), such an act thus being authorised under that provision provided that it fulfils the cumulative conditions laid down therein, which is for the national court to verify.

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Court of Justice EU, 27 September 2017

(M. Ilešič (Rapporteur), K. Lenaerts, A. Prechal, C. Toader and E. Jarašiūnas)

JUDGMENT OF THE COURT (Second Chamber)

27 September 2017

\* Language of the case: German s for a preliminary ruling — Intellectual property — Regulation (EC) No 6/2002 — Article 20(1)(c), Article 79(1) and Articles 82, 83, 88 and 89 — Action for infringement — Limitation of the rights conferred by the Community design — Concept of ‘citations’ — Regulation (EC) No 44/2001 — Article 6(1) — Jurisdiction in respect of the co-defendant domiciled outside the Member State of the forum — Territorial scope of the jurisdiction of the Community design courts — Regulation (EC) No 864/2007 — Article 8(2) — Law applicable to claims seeking the adoption of orders relating to sanctions and other measures)

In Joined Cases C-24/16 and C-25/16,  
REQUESTS for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by decisions of 7 January 2016, received at the Court on 18 January 2016, in the proceedings

Nintendo Co. Ltd

v

BigBen Interactive GmbH,

BigBen Interactive SA,

THE COURT (Second Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, K. Lenaerts, President of the Court of Justice, acting as Judge of the Second Chamber, A. Prechal, C. Toader and E. Jarašiūnas, Judges,

Advocate General: Y. Bot,

Registrar: R. Schiano, Administrator,

having regard to the written procedure and further to the hearing on 7 December 2016, after considering the observations submitted on behalf of:

– Nintendo Co. Ltd, by A. von Mühlendahl and H. Hartwig, Rechtsanwälte,

– BigBen Interactive GmbH and BigBen Interactive SA, by W. Götz, C. Onken and C. Kurtz, Rechtsanwälte,

– the European Commission, by T. Scharf and M. Wilderspin, acting as Agents,  
after hearing the Opinion of the Advocate General at the sitting on 1 March 2017,

gives the following

### Judgment

1. These requests for a preliminary ruling concern the interpretation of Article 20(1)(c), Article 79(1) and Articles 82, 83, 88 and 89 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), Article 6(1) of 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) and Article 8(2) and Article 15 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).

2. The requests have been made in proceedings between, on the one hand, Nintendo Co. Ltd (‘Nintendo’), a company established in Japan, and, on the other hand, BigBen Interactive GmbH (‘BigBen

Germany’), a company established in Germany, and BigBen Interactive SA (‘BigBen France’), the parent company of BigBen Germany established in France, concerning actions for infringement on account of the alleged infringement by the defendants in the main proceedings of the rights conferred on Nintendo by the Community designs held by it.

### EU law

#### Regulation No 44/2001

3. Regulation No 44/2001 replaced, in relations between the Member States, the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, signed in Brussels on 27 September 1968 (OJ 1978 L 304, p. 36, ‘the Brussels Convention’). That regulation was in turn repealed and 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), which has been applicable from 10 January 2015. Article 66(1) of that regulation, relating to transitional provisions, provides that 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’.

4. Recital 11 of Regulation No 44/2001 reads:

*‘The rules of jurisdiction must be highly predictable and founded on the principle that jurisdiction is generally based on the defendant’s domicile and jurisdiction must always be available on this ground save in a few well-defined situations in which the subject-matter of the litigation or the autonomy of the parties warrants a different linking factor. ...’*

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

*‘[A person domiciled in a Member State] may also be sued:*

*(1) where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings’*

6. According to Article 68(2) of that regulation:

*‘In so far as this Regulation replaces the provisions of the Brussels Convention between Member States, any reference to the Convention shall be understood as a reference to this Regulation.’*

#### Regulation No 6/2002

7. Recitals 6, 7, 22, 29 and 31 of Regulation No 6/2002 state:

*‘(6) ... the objectives of the proposed action, namely, the protection of one design right for one area encompassing all the Member States, cannot be sufficiently achieved by the Member States by reason of the scale and the effects of the creation of a Community design and a Community design authority ...*

*(7) Enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of [European Union] excellence in the field, but*

also encourages innovation and development of new products and investment in their production.

...

(22) The enforcement of these rights is to be left to national laws. It is necessary therefore to provide for some basic uniform sanctions in all Member States. These should make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts.

...

(29) It is essential that the rights conferred by a Community design can be enforced in an efficient manner throughout the territory of the [European Union].

(30) The litigation system should avoid as far as possible "forum shopping". It is therefore necessary to establish clear rules of international jurisdiction.

(31) This Regulation does not preclude the application to designs protected by Community designs of the industrial property laws or other relevant laws of the Member States, such as those relating to design protection acquired by registration or those relating to unregistered designs, trade marks, patents and utility models, unfair competition or civil liability.'

8. Article 1(3) of that regulation provides:

'A Community design shall have a unitary character. It shall have equal effect throughout the [European Union]. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole [European Union]. This principle shall apply unless otherwise provided in this Regulation.'

9. According to Article 19(1) of that regulation:

'A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.'

10. Article 20 of Regulation No 6/2002, entitled 'Limitation of the rights conferred by a Community design', provides in paragraph (1):

'The rights conferred by a Community design shall not be exercised in respect of:

(a) acts done privately and for non-commercial purposes;

(b) acts done for experimental purposes;

(c) acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.'

11. Article 79(1) of that regulation provides:

'Unless otherwise specified in this Regulation, the [Brussels Convention] shall apply to proceedings relating to Community designs and applications for registered Community designs, as well as to proceedings relating to actions on the basis of

Community designs and national designs enjoying simultaneous protection.'

12. Pursuant to Article 79(3) of that regulation, Articles 2 and 4, Article 5(1) and (3) to (5), Article 16(4) and Article 24 of the Brussels Convention are not applicable to proceedings in respect of the actions and claims referred to in Article 81 of that regulation. It also follows from Article 79(3) that Articles 17 and 18 of that convention are applicable subject to the limitations in Article 82(4) of Regulation No 6/2002.

13. Article 80(1) of that regulation provides as follows: 'The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance (Community design courts) which shall perform the functions assigned to them by this Regulation.'

14. Article 81(a) of that regulation provides:

'The Community design courts shall have exclusive jurisdiction:

(a) for infringement actions and — if they are permitted under national law — actions in respect of threatened infringement of Community designs'.

15. Article 82 of Regulation No 6/2002 provides:

'1. Subject to the provisions of this Regulation as well as to any provisions of the [Brussels Convention] applicable by virtue of Article 79, proceedings in respect of the actions and claims referred to in Article 81 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 81(a) and (d) may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened.'

16. Article 83 of that regulation provides:

'1. A Community design court whose jurisdiction is based on Article 82(1), (2), (3) or (4) shall have jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States.

2. A Community design court whose jurisdiction is based on Article 82(5) shall have jurisdiction only in respect of acts of infringement committed or threatened within the territory of the Member State in which that court is situated.'

17. Article 88(2) and (3) of the regulation states:

'2. On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.

3. Unless otherwise provided in this Regulation, a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.'

18. Under Article 89 of Regulation No 6/2002:

'1. Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are

special reasons for not doing so, order the following measures:

(a) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;

(b) an order to seize the infringing products;

(c) an order to seize materials and implements ...

(d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.

2. The Community design court shall take such measures in accordance with its national law as are aimed at ensuring that the orders referred to in paragraph 1 are complied with.'

#### **Regulation No 864/2007**

19. According to recitals 6, 7, 13, 14, 16 and 19 of Regulation No 864/2007:

'(6) The proper functioning of the internal market creates a need, in order to improve the predictability of the outcome of litigation, certainty as to the law applicable and the free movement of judgments, for the conflict-of-law rules in the Member States to designate the same national law irrespective of the country of the court in which an action is brought.

(7) The substantive scope and the provisions of this Regulation should be consistent with [Regulation No 44/2001] and the instruments dealing with the law applicable to contractual obligations.

...

(13) Uniform rules applied irrespective of the law they designate may avert the risk of distortions of competition between [European Union] litigants.

(14) The requirement of legal certainty and the need to do justice in individual cases are essential elements of an area of justice. This Regulation provides for the connecting factors which are the most appropriate to achieve these objectives. Therefore, this Regulation provides for a general rule but also for specific rules and, in certain provisions, for an "escape clause" which allows a departure from these rules where it is clear from all the circumstances of the case that the tort/delict is manifestly more closely connected with another country. This set of rules thus creates a flexible framework of conflict-of-law rules. Equally, it enables the court seised to treat individual cases in an appropriate manner.

...

(16) Uniform rules should enhance the foreseeability of court decisions and ensure a reasonable balance between the interests of the person claimed to be liable and the person who has sustained damage. A connection with the country where the direct damage occurred ("lex loci damni") strikes a fair balance between the interests of the person claimed to be liable and the person sustaining the damage, and also reflects the modern approach to civil liability and the development of systems of strict liability.

...

(19) Specific rules should be laid down for special torts/delicts where the general rule does not allow a reasonable balance to be struck between the interests at stake.'

20. Article 4(1) of that regulation provides:

'Unless otherwise provided for in this Regulation, the law applicable to a non-contractual obligation arising out of a tort/delict shall be the law of the country in which the damage occurs irrespective of the country in which the event giving rise to the damage occurred and irrespective of the country or countries in which the indirect consequences of that event occur.'

21. Article 8(1) and (2) of that regulation provide:

'1. The law applicable to a non-contractual obligation arising from an infringement of an intellectual property right shall be the law of the country for which protection is claimed.

2. In the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable shall, for any question that is not governed by the relevant Community instrument, be the law of the country in which the act of infringement was committed.'

22. Article 15(a), (d) and (g) of that regulation provides:

'The law applicable to non-contractual obligations under this Regulation shall govern in particular:

(a) the basis and extent of liability, including the determination of persons who may be held liable for acts performed by them;

...

(d) within the limits of powers conferred on the court by its procedural law, the measures which a court may take to prevent or terminate injury or damage or to ensure the provision of compensation;

...

(g) liability for the acts of another person'.

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

23. Nintendo is a multinational company active in the production and sale of video games and video game consoles, including the Wii video games console and its accessories. It is the holder of several registered Community designs relating to Wii accessories, such as the Wii remote control, the accessory known as the 'Nunchuck' for the Wii remote control, which enables compatible video games to be controlled differently, the connector plug known as the 'Wii Motion Plus' for the remote control, and the Balance Board, an accessory that allows the player to control the game through weight changes.

24. BigBen France makes remote controls and other accessories compatible with the Wii video games console and sells them via its website directly to consumers located inter alia in France, Belgium and Luxembourg, as well as to its subsidiary, BigBen Germany. The latter sells the goods made by BigBen France, inter alia via its website, to consumers located in Germany and Austria.

25. It is apparent from the file submitted to the Court of Justice that BigBen Germany does not have its own

stock of goods. Thus, it forwards the orders it receives from consumers to BigBen France. Supply of the allegedly infringing goods is therefore carried out from France. BigBen Germany and BigBen France also use images of goods corresponding to the protected designs held by Nintendo in the course of the lawful sale, including for the purposes of publicity, of certain other goods they sell.

26. Nintendo takes the view that BigBen Germany and BigBen France's sale of certain goods made by BigBen France infringes its rights under the registered Community designs held by it. It also submits that those two companies cannot be recognised as having the right to use the images of the goods corresponding to those designs for their commercial activity. Consequently, it brought actions before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) against BigBen Germany and BigBen France seeking a declaration that they had infringed the rights conferred upon it by those designs.

27. The Landgericht held that there had been an infringement by BigBen Germany and BigBen France of Nintendo's registered Community designs. However, it dismissed the actions in so far as they concerned the use of the images of the goods corresponding to those designs by the defendants in the main proceedings. The Landgericht therefore ordered BigBen Germany to cease using those designs throughout the European Union and also upheld, without territorial limitation, Nintendo's supplementary claims seeking that it be sent various information, accounts and documents held by the defendants in the main proceedings, that they be ordered to pay compensation and that the destruction or recall of the goods at issue, publication of the judgment and reimbursement of the lawyers' fees incurred by Nintendo be ordered ('the supplementary claims').

28. As regards BigBen France, the Landgericht Düsseldorf (Regional Court, Düsseldorf) held that it had international jurisdiction in respect of that company and ordered it to cease using the protected designs at issue throughout the European Union. Concerning the supplementary claims, it limited the scope of its judgment to BigBen France's supplies of the goods at issue to BigBen Germany, but without limiting the territorial scope of its judgment. It considered the applicable law to be that of the place of infringement and took the view that in the present case that was German, Austrian and French law.

29. Both Nintendo and the defendants in the main proceedings brought appeals against that judgment before the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf).

30. In support of its action, BigBen France contends that the German courts lack jurisdiction to adopt orders against it that are applicable throughout the European Union and takes the view that such orders can have merely national territorial scope. For its part, Nintendo disputes the limitation of such orders solely to the goods within the supply chain between the defendants in the main proceedings. Nintendo also claims that the

defendants in the main proceedings cannot be recognised as having the right to use, in the course of their economic activity and for the purposes of selling their own goods, the images of the goods corresponding to its registered Community designs, whereas the defendants in the main proceedings maintain that such use is in conformity with Regulation No 6/2002. Moreover, Nintendo takes the view that German law should be applied to its claims relating to BigBen Germany and French law to those relating to BigBen France, contrary to what the Landgericht Düsseldorf (Regional Court, Düsseldorf) held.

31. Nintendo therefore requests the referring court to order the defendants in the main proceedings to cease to make, import, export, use or stock for those purposes the goods at issue within the European Union and/or reproduce those goods or, as the case may be, use the images of those goods corresponding to Nintendo's Community designs, throughout the European Union. Nintendo's claim relating to ceasing the production of the goods that, in its view, infringe the registered Community designs held by it concerns solely BigBen France.

32. In addition, Nintendo requests that its supplementary claims be upheld.

33. In those circumstances, the referring court states, in the first place, that its international jurisdiction in respect of the claims against BigBen France stems from Article 79(1) of Regulation No 6/2002, read in conjunction with Article 6(1) of Regulation No 44/2001, on the ground that Nintendo's claims against BigBen Germany and BigBen France are connected because there is a supply chain of the allegedly infringing goods between the two defendants in the main proceedings. That court doubts, however, in the light of the arguments set out before it both by Nintendo and BigBen France, that the scope of the judgment delivered by the Landgericht Düsseldorf (Regional Court, Düsseldorf) in respect of BigBen France, as regards Nintendo's claims, is in conformity with the provisions of Regulation No 44/2001 and Regulation No 6/2002.

34. In the second place, the referring court explains that the question whether and in what circumstances a third party might lawfully use the image of a product corresponding to a Community design in order to advertise the goods which it sells and which constitute accessories to the goods corresponding to such a registered design is novel. Interpretation of the concept of 'citations' within the meaning of Article 20(1)(c) of Regulation No 6/2002 is therefore necessary.

35. In the third place, that court has doubts as to the law applicable to Nintendo's supplementary claims concerning both the first and second defendant in the main proceedings and is uncertain in that regard, in particular, about the scope of Article 8(2) of Regulation No 864/2007.

36. In those circumstances, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) decided to stay the proceedings and to refer the following questions, which are formulated in the same

terms in Cases C-24/16 and C-25/16, to the Court of Justice for a preliminary ruling:

(1) In connection with a trial to enforce claims under a Community design, can the court of a Member State whose jurisdiction with respect to a defendant is based solely on Article 79(1) of [Regulation No 6/2002] in conjunction with Article 6(1) of [Regulation No 44/2001], on the basis that this defendant, which is domiciled in another Member State, supplied the defendant domiciled in the pertinent Member State with goods that may infringe intellectual property rights, adopt measures against the first mentioned defendant that are applicable throughout the EU and extend beyond the supply relationships on which jurisdiction is based?

(2) Is [Regulation No 6/2002], particularly Article 20(1)(c), to be interpreted as meaning that a third party may depict a Community design for commercial purposes if it intends to sell accessory items for the right holder's goods corresponding to the Community design? If so, what criteria apply to this?

(3) For the purposes of Article 8(2) of [Regulation No 864/2007], how is the place "in which the act of infringement was committed" to be determined in cases in which the infringer:

(a) offers goods that infringe a Community design on a website and that website is also directed at Member States other than the one in which the person damaged by the infringement is domiciled, and/or;

(b) has goods that infringe a Community design shipped to a Member State other than the one in which it is domiciled?

Is Article 15(a) and (g) of the Rome II Regulation to be interpreted as meaning that the law determined in this manner is also applicable to participatory acts of other persons?

37. By order of the President of the Court of Justice of 1 February 2016, Cases C-24/16 and C-25/16 were joined for the purposes of the written and oral procedure and the judgment.

#### **The questions referred for a preliminary ruling**

##### **Question 1**

38. By its first question, the referring court asks, in essence, whether Regulation No 6/2002, read in conjunction with Article 6(1) of Regulation No 44/2001, must be interpreted as meaning that where the international jurisdiction of a Community design court seised of an action for infringement is based, with regard to one defendant, on Article 82(1) of Regulation No 6/2002 and, with regard to a second defendant established in another Member State, on that Article 6(1), read in conjunction with Article 79(1) of Regulation No 6/2002, because the second defendant makes and supplies to the first defendant the goods that the latter sells, that court may, on the applicant's request, adopt orders in respect of the second defendant concerning measures falling under Article 89(1) and Article 88(2) of Regulation No 6/2002 also covering the second defendant's conduct other than that relating to the abovementioned supply chain and with, as the

case may be, a scope which extends throughout the European Union.

39. In that regard, it should be noted that, under Article 82 of Regulation No 6/2002, subject to the provisions of that regulation and those of the Brussels Convention that are applicable, as a reference to that convention must be understood, by virtue of Article 68(2) of Regulation No 44/2001, as a reference to that regulation, the jurisdiction of the Community design courts provided for in Article 80(1) of Regulation No 6/2002 to decide the actions and claims referred to in Article 81 thereof results from rules directly provided for by that regulation (see, to that effect, judgment of 13 July 2017, Bayerische Motoren Werke, C-433/16, EU:C:2017:550, paragraph 39).

40. Article 82(1) provides that those actions and claims fall primarily within the international jurisdiction of 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 any Member State in which he has an establishment.

41. As regards the fifth paragraph of Article 82, it establishes *inter alia* alternative jurisdiction in favour of the Community design courts of the Member State in which the act of infringement has been committed or threatened.

42. Those rules have the character of *lex specialis* in relation to the rules provided for by Regulation No 44/2001 (judgment of 13 July 2017, Bayerische Motoren Werke, C-433/16, EU:C:2017:550, paragraph 39).

43. Article 79(1) of Regulation No 6/2002 provides that, subject to any contrary provision of that regulation, the provisions of Regulation No 44/2001 are applicable to proceedings relating to Community designs. In that respect, Article 79(3) lists the provisions of Regulation No 44/2001 that are not applicable to proceedings in respect of the actions and claims referred to in Article 81 of Regulation No 6/2002.

44. Article 6(1) of Regulation No 44/2001 is not included among the provisions listed in Article 79(3). Furthermore, the *lex specialis* constituted by the rules laid down by Regulation No 6/2002, recalled in paragraphs 40 and 41 of the present judgment, does not include any additional details regarding the conditions for the application of Article 6(1). A Community design court, such as the referring court in the cases in the main proceedings, may therefore, by virtue of that provision and subject to the conditions laid down by that provision being fulfilled, have jurisdiction to hear an action brought against a defendant not domiciled in the Member State in which that court is situated.

45. In order for Article 6(1) of Regulation No 44/2001 to apply, it must be ascertained whether, between various claims brought by the same applicant against various defendants, there is a connection of such a kind that it is expedient to determine those actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings. For decisions to be regarded as irreconcilable, it is not sufficient that there

be a divergence in the outcome of the disputes, but that divergence must also arise in the context of the same situation of fact and law (judgment of 21 May 2015, CDC Hydrogen Peroxide, C-352/13, EU:C:2015:335, paragraph 20 and the case-law cited).

46. In that regard, although it follows from the Court's case-law on patents that, where infringement proceedings are brought before a number of courts in various Member States in respect of a European patent granted in each of those States, against defendants domiciled in those States in respect of acts allegedly committed in their territory, any divergences between the decisions given by the courts concerned would not arise in the context of the same situation of law, since any action for infringement of a European patent must be examined in the light of the national law in force in each of the States for which it has been granted. Any diverging decisions could not, therefore, be treated as contradictory ([judgment of 13 July 2006, Roche Nederland and Others, C-539/03, EU:C:2006:458](#), paragraphs 30 to 32).

47. In the proceedings before the Court, the defendants in the main proceedings have inter alia contended, referring to that case-law, that some of the claims made by the applicant in the main proceedings seeking the provision of information, accounts and documents by the defendants, an order to pay compensation, the destruction and recall of the goods at issue, reimbursement of the lawyers' fees and publication of the judgment, depend on the application by the court with jurisdiction of provisions of national law and cannot therefore fall within the same situation of law. As the Advocate General notes in points [45 to 52 of his Opinion](#), such claims are referred to either in Article 89(1)(d) of Regulation No 6/2002 or in Article 88(2) thereof, each of those provisions referring to national law. It follows that those claims are not governed independently by Regulation No 6/2002, but are a matter of the applicable national law (see, to that effect, [judgment of 13 February 2014, H. Gautzsch Großhandel, C-479/12, EU:C:2014:75](#), paragraphs 52 to 54).

48. However, the referring court takes the view that the requirement of the same situation of law is satisfied in the cases in the main proceedings, since Nintendo's claims brought before it against the two defendants in the main proceedings arise in the same situation of law, in particular because of the unitary character of the rights conferred by a Community design, as well as in the light of the partial harmonisation of the means of enforcing intellectual property rights effected by Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45, and corrigendum OJ 2004 L 195, p. 16).

49. In that regard, it should be noted that by bringing an action for infringement, the holder seeks to protect his exclusive right to use the Community design and to prohibit any unauthorised use of it by a third party, enshrined in Article 19 of Regulation No 6/2002. Since that right has the same effect throughout the European

Union, the fact that some of the orders that may be adopted by the court having jurisdiction with a view to ensuring that that right is respected depend on provisions of national law is irrelevant to the existence of the same situation of law for the purposes of applying Article 6(1) of Regulation No 44/2001.

50. As regards the requirement of the same situation of fact, it is apparent from the orders for reference that the referring court starts from the premiss that the existence of supplies of the allegedly infringing goods effected, first, by BigBen France to BigBen Germany and, secondly, by the latter to its customers permits the inference that that requirement is met. It is, however, uncertain whether the orders sought by the applicant in the main proceedings may concern solely the supplies on which its jurisdiction is based or whether they may additionally concern other supplies, such as those made by BigBen France alone.

51. Having regard to the circumstances of the cases in the main proceedings, where one of the defendants in the main proceedings is a parent company and the other its subsidiary, which the applicant in the main proceedings accuses of similar, if not identical, acts that infringe the same protected designs and relate to identical allegedly infringing goods made by the parent company that sells them on its own account in certain Member States and also sells them to its subsidiary so that the latter may sell them in other Member States, it should be recalled that the Court has already held that the case in which defendant companies belonging to the same group have acted in an identical or similar manner in accordance with a common policy elaborated by one of them must be regarded as constituting the same situation of fact (see, inter alia, [judgment of 13 July 2006, Roche Nederland and Others, C-539/03, EU:C:2006:458](#), paragraph 34).

52. Therefore, and taking into account the objective pursued by Article 6(1) of Regulation No 44/2001, which seeks inter alia to avoid the risk of irreconcilable judgments, the existence of the same situation of fact must in such circumstances — if proven, which is for the referring court to verify, and where an application is made to that effect — cover all the activities of the various defendants, including the supplies made by the parent company on its own account, and not be limited to certain aspects or elements of them.

53. As regards the territorial scope of the orders relating to sanctions and other measures sought by the applicant in the main proceedings in respect of each defendant in the main proceedings, it should be noted that the Court has already held that the territorial scope of the prohibition against further infringement or threatened infringement of a Community trade mark, as provided for in Article 98(1) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended by Council Regulation (EC) No 3288/94 of 22 December 1994 (OJ 1994 L 349, p. 83; 'Regulation No 40/94'), is to be determined both by the territorial jurisdiction of the Community trade mark court issuing that prohibition and by the territorial extent, resulting

from Regulation No 40/94, of the Community trade mark proprietor's exclusive right which is adversely affected by the infringement or threatened infringement ([judgment of 12 April 2011, DHL Express France, C-235/09, EU:C:2011:238](#), paragraph 33).

54. That solution can be directly transposed to the analysis of the territorial scope of a prohibition against further acts of infringement or threatened infringement of Community designs, governed independently by Article 89(1)(a) of Regulation No 6/2002, bearing in mind the similarity of the provisions of Regulation No 40/94 and Regulation No 6/2002, governing, respectively, the judicial protection of the rights conferred by Community trademarks and Community designs.

55. Nor is it possible to accept a different solution for determining the territorial scope of the orders made by a Community design court in respect of claims concerning other sanctions and measures, such as those sought in the cases in the main proceedings by Nintendo, which are not governed independently by Regulation No 6/2002.

56. In that regard, it should be recalled that Regulation No 6/2002 pursues the objective, as stated in recital 29, of ensuring that the enforcement of the rights conferred by a Community design is protected effectively throughout the European Union. That objective is essential, bearing in mind, as is apparent from Article 1(3) of that regulation, the unitary character of such designs and the fact that they have equal effect throughout the European Union. That objective is achieved, in the system of protection of those rights established by Regulation No 6/2002, first, by some basic uniform sanctions provided for independently by that regulation and, secondly, by other sanctions or measures which are to be left to national laws.

57. While that regulation clearly acknowledges, in recital 22, the importance of basic uniform sanctions that are intended, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts, it also acknowledges in that recital, read together with recital 29 of that regulation, that measures falling under national law contribute equally to achieving that aim.

58. Therefore, the territorial scope of the orders relating to sanctions and other measures, such as those requested by Nintendo in the cases in the main proceedings, must be examined in the light of the criteria set out in paragraph 53 above.

59. As regards, in the first place, the territorial scope of the rights of the Community design holder, conferred under Regulation No 6/2002, they extend, as a rule, to the entire area of the European Union, on which designs enjoy uniform protection and have effect (see, by analogy, [judgment of 12 April 2011, DHL Express France, C-235/09, EU:C:2011:238](#), paragraph 39).

60. In accordance with Article 1(3) of that regulation, the Community design has a unitary character and has equal effect throughout the European Union. It may not, according to that provision, be registered,

transferred or surrendered or be the subject of a decision declaring it invalid, nor may its use be prohibited, save in respect of the whole of the European Union, that principle applying unless otherwise provided in that regulation.

61. As regards, in the second place, the territorial scope of the jurisdiction of a Community design court, such as that issue in the main proceedings, seised of an action for infringement within the meaning of Article 81(a) of Regulation No 6/2002, whose jurisdiction is based on Article 82(1) of Regulation No 6/2002 in respect of one of the defendants and before which the other defendant not domiciled in the Member State of that court has been sued validly pursuant to Article 6(1) of Regulation No 44/2001, read in conjunction with Article 79(1) of Regulation No 6/2002, it should be noted that Article 83 of Regulation No 6/2002 governs independently the scope of the jurisdiction of the Community design courts relating to infringement and states, in the first paragraph, that a court whose jurisdiction is based on Article 82(1), (2), (3) or (4) of that regulation has jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States.

62. However, the second paragraph of Article 83 provides that a Community design court whose jurisdiction is based on Article 82(5) of that regulation has jurisdiction only in respect of acts of infringement committed or threatened within the territory of the Member State in which that court is situated.

63. Regulation No 6/2002 does not specifically state what the territorial scope of a Community design court's jurisdiction should be in a situation such as that described in paragraph 61 of the present judgment. However, it is apparent neither from the wording of Article 6(1) of Regulation No 44/2001 nor the relevant case-law of the Court that courts seised validly pursuant to Article 6(1) should then see their territorial jurisdiction limited in respect of a defendant who is not domiciled in the Member State of the forum.

64. Therefore, it must be held that the territorial jurisdiction of a Community design court seised of an action for infringement within the meaning of Article 81(a) of Regulation No 6/2002, in circumstances such as those set out in paragraph 61 above, extends throughout the European Union also in respect of the defendant who is not domiciled in the Member State of the forum.

65. Such an interpretation in conformity with the general scheme and objectives of Regulation No 6/2002. First, under Article 83 of that regulation and as recalled in paragraphs 61 and 62 of the present judgment, only when the jurisdiction of a Community design court is based on Article 82(5) of that regulation does such a court have territorial jurisdiction limited to acts of infringement committed or threatened within the territory of that Member State.

66. Secondly, that interpretation is capable of ensuring the attainment of the objective pursued by Regulation No 6/2002 of providing effective protection of registered Community designs throughout the



European Union (see, to that effect, [judgment of 16 February 2012, Celaya Emparanza v Galdos International, C-488/10, EU:C:2012:88](#), paragraph 44).

67. It follows from the foregoing that the answer to the first question is that Regulation No 6/2002, read in conjunction with Article 6(1) of Regulation No 44/2001, must be interpreted as meaning that in circumstances such as those in the main proceedings where the international jurisdiction of a Community design court seised of an action for infringement is based, with regard to one defendant, on Article 82(1) of Regulation No 6/2002 and, with regard to a second defendant established in another Member State, on that Article 6(1) read in conjunction with Article 79(1) of Regulation No 6/2002, because the second defendant makes and supplies to the first defendant the goods that the latter sells, that court may, on the applicant's request, adopt orders in respect of the second defendant concerning measures falling under Article 89(1) and Article 88(2) of Regulation No 6/2002 also covering the second defendant's conduct other than that relating to the abovementioned supply chain and with a scope which extends throughout the European Union.

#### **Question 2**

68. By its second question, the referring court asks, in essence, whether Article 20(1)(c) of Regulation No 6/2002 must be interpreted as meaning that a third party which, without the consent of the holder of the rights conferred by a Community design, uses, including via its website, images of goods corresponding to such designs when lawfully offering for sale goods intended to be used as accessories to the specific goods of the holder of the rights conferred by those designs, in order to explain or demonstrate the joint use of the goods thus offered for sale and the specific goods of the holder of those rights, carries out an act of reproduction for the purpose of making 'citations' within the meaning of Article 20(1)(c) and, if so, under which circumstances such an act of reproduction may be accepted.

69. In that regard, it must first of all be noted that the limitation of the rights conferred by Community designs laid down in Article 20(1)(c) of Regulation No 6/2002 applies when the use by a third party of such protected designs for the purposes of making citations constitutes an 'act of reproduction' of them. A two-dimensional representation of a product corresponding to a Community design may constitute such an act.

70. Next, it must be examined whether such an act of reproduction was carried out for the purposes of making 'citations'. In that regard, Article 20(1)(c) of Regulation No 6/2002 makes no reference to the law of the Member States on the concept of 'citations'. However, the need for a uniform application of EU law and the principle of equality require 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 normally to be given an independent and uniform interpretation throughout the EU; that interpretation must take into

account not only the wording of the provision but also its context and the objectives pursued by the rules of which it is part (see, inter alia, [judgments of 3 September 2014, Deckmyn and Vrijheidsfonds, C-201/13, EU:C:2014:2132](#), paragraph 14, and of 10 December 2015, Lazar, C-350/14, EU:C:2015:802, paragraph 21).

71. As regards the terms used in Article 20(1)(c) of Regulation No 6/2002, it is apparent from a comparative examination of the various language versions of that provision that they exhibit differences in so far as some of those versions, inter alia those in French and Dutch, use the expression 'illustration', whereas other versions refer to the concept of 'citation', as also noted by the Advocate General in [point 74 of his Opinion](#).

72. According to settled case-law, a purely literal interpretation of one or more language versions of a text of EU law, to the exclusion of the others, cannot prevail since the uniform application of EU rules requires that they be interpreted, inter alia, in the light of the versions drawn up in all the languages. Where there is a divergence between the language versions of an EU text, the provision in question must be interpreted by reference to the general scheme and purpose of the rules of which it forms part (see, inter alia, judgments of 4 September 2014, Vnuk, C-162/13, EU:C:2014:2146, paragraph 46 and the case-law cited, and of 26 April 2017, Popescu, C-632/15, EU:C:2017:303, paragraph 35).

73. As regards the objective of Regulation No 6/2002, it should be recalled that, according to recitals 6 and 7 thereof, it establishes the protection of design rights for one area encompassing all the Member States, an enhanced protection for industrial design encouraging innovation and development of new products and investment in their production. The Court has also already stated that the objective of that regulation is to ensure effective protection of registered Community designs (see, to that effect, [judgment of 16 February 2012, Celaya Emparanza v Galdos International, C-488/10, EU:C:2012:88](#), paragraph 44).

74. Therefore, provisions limiting the rights granted to the holder of such designs by virtue of that regulation, such as Article 20(1)(c) thereof, must be interpreted strictly, without, however, such an interpretation undermining the effectiveness of the limitation thereby established and disregarding its purpose (see, by analogy, [judgment of 1 December 2011, Painer, C-145/10, EU:C:2011:798](#), paragraphs 109 and 133).

75. In that regard, it should be noted that Article 20(1)(a) of Regulation No 6/2002 provides for a limitation of the rights conferred by Community designs in respect of acts done privately and for non-commercial purposes. As the limitation of the rights conferred by the Community design provided for in Article 20(1)(c) is distinct from that provided for in Article 20(1)(a), it must be held that the acts of reproduction referred to therein must be carried out in the course of a commercial activity.

76. As regards the scope of the concept of ‘citations’ within the meaning of Article 20(1)(c) of Regulation No 6/2002, it should be noted, on the one hand, that that provision aims to limit the rights conferred by the Community design so far as it concerns acts of reproduction that serve as a basis for the explanations or commentary of the person intending to rely on that limitation. On the other hand, in view of the objective of Regulation No 6/2002, referred to in paragraph 73 above, the prevention of an undertaking creating new products intended to be compatible with existing products which correspond to Community designs held by another undertaking from using images of those existing products upon the lawful sale of its own products, in order to explain or demonstrate the joint use of the two categories of products, could discourage innovation, a situation which that regulation seeks to avoid, as the Advocate General also noted in [point 75 of his Opinion](#).

77. Therefore, a third party that lawfully sells goods intended to be used with specific goods corresponding to Community designs and reproduces the latter in order to explain or demonstrate the joint use of the goods it sells and a product corresponding to a protected design carries out an act of reproduction for the purpose of making ‘citations’ within the meaning of Article 20(1)(c) of Regulation No 6/2002.

78. As regards the referring court’s questions relating to the conditions restricting the possibility of relying on that limitation, it is apparent from Article 20(1)(c) of Regulation No 6/2002 that the limitation is subject to the fulfilment of three cumulative conditions, namely the compatibility of the acts of reproduction with fair trade practice, the absence of undue prejudice to the normal exploitation of the design on account of such acts and mention of the source.

79. As regards, first, the condition that the acts of reproduction for the purpose of making citations must be compatible with fair trade practice, the Court has already interpreted the concept of ‘honest practices in industrial or commercial matters’, *inter alia* within the meaning of Article 6(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), as constituting the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner ([judgment of 17 March 2005, Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraph 41 and the case-law cited). It is appropriate to apply that case-law *mutatis mutandis* for the purpose of interpreting the concept of ‘fair trade practice’ within the meaning of Article 20(1)(c) of Regulation No 6/2002.

80. Therefore, an act of reproduction of a protected design for the purpose of making citations or of teaching is not compatible with fair trade practice within the meaning of that provision where it is done in such a manner that it gives the impression that there is a commercial connection between the third party and the holder of the rights conferred by those designs, or where the third party, who wishes to rely on that

limitation in the course of selling goods that are used jointly with goods corresponding to the protected designs, infringes the rights conferred on the holder of the design protected by Article 19 of Regulation No 6/2002, or where that third party takes unfair advantage of the holder’s commercial repute (see, by analogy, [judgment of 17 March 2005, Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraphs 42, 43, 45, 47 and 48).

81. It is for the national courts to verify fulfilment of the condition that the acts of reproduction for the purpose of making citations must be compatible with fair trade practice, by taking into account, in that regard, all the relevant facts of the case, in particular the overall presentation of the product sold by the third party.

82. As regards, secondly, the condition requiring acts of reproduction for the purpose of making citations not to unduly prejudice the normal exploitation of the design, it should be noted that that condition aims *inter alia* to prevent the act of reproduction for the purpose of making citations from negatively affecting the economic interests that the holder of the rights conferred by the Community designs may derive from a normal exploitation of those designs. The referring court has already indicated that it considers that second condition to be fulfilled in the cases in the main proceedings.

83. As regards, thirdly, the requirement to mention the source, it should be noted that Article 20 (1)(c) of Regulation No 6/2002 does not specify how it is to be mentioned. As stated in paragraph 75 of the present judgment, that provision is intended to authorise the use of Community designs for the purpose of making citations or of teaching during a commercial activity, such as that issue in the main proceedings.

84. In those circumstances, in order to fulfil the condition that the source be mentioned, it is necessary, *inter alia*, that the type of mention chosen for that purpose enables a reasonably well-informed and reasonably observant and circumspect consumer easily to identify the commercial origin of the product corresponding to the Community design.

85. However, as mention of the source is, in the cases in the main proceedings, achieved by affixing an EU trademark belonging to the holder of the rights conferred by the protected Community designs, the referring court will also have to determine whether such a mention is in compliance with the legislation on trademarks.

86. In the light of the foregoing considerations, the answer to the second question is that Article 20(1)(c) of Regulation No 6/2002 must be interpreted as meaning that a third party which, without the consent of the holder of the rights conferred by a Community design, uses, including via its website, images of goods corresponding to such designs when lawfully offering for sale goods intended to be used as accessories to the specific goods of the holder of the rights conferred by those designs, in order to explain or demonstrate the joint use of the goods thus offered for sale and the

specific goods of the holder of those rights, carries out an act of reproduction for the purpose of making 'citations' within the meaning of Article 20(1)(c), such an act thus being authorised under that provision provided that it fulfils the cumulative conditions laid down therein, which is for the national court to verify.

### Question 3

87. As a preliminary point, it must first be observed that the referring court states that it asks the third question only if it were to find that BigBen Germany and BigBen France have infringed the rights conferred on Nintendo by the Community designs as a result, on the one hand, of the making, offering, putting on the market, importing, exporting and stocking for those purposes of the goods they sell or, on the other hand, of the use of images of goods corresponding to those designs in the course of selling the goods they offer for sale.

88. While it is true that the referring court has not yet made any findings as to the existence of an infringement of the rights of the applicant in the main proceedings conferred by the Community designs, it cannot be considered, contrary to what the European Commission suggests, that the third question is consequently inadmissible. It is for the national courts alone to determine, having regard to the particular features of each case, both the need for a preliminary ruling in order to enable them to give their judgment and the relevance of the questions which they refer to the Court. Furthermore, the finding of such an infringement in the disputes in the main proceedings is not purely hypothetical (see, to that effect, judgment of 4 May 2017, *HanseYachts*, C-29/16, EU:C:2017:343, paragraph 24).

89. Secondly, it should be noted that the third question refers only to the sanctions and other measures sought by the applicant in the main proceedings that are set out in paragraph 47 of the present judgment and are not governed independently by Article 89(1)(a) to (c) of Regulation No 6/2002.

90. Thirdly, the question is based on the premiss that Article 8(2) of Regulation No 864/2007 is applicable to a situation such as that at issue in the main proceedings. The referring court also raises the issue of the interpretation of the concept of 'country in which the act of infringement was committed' within the meaning of Article 8(2), in circumstances such as those at issue in the main proceedings, where each defendant in the main proceedings is accused of several infringing acts committed in various EU Member States. It also asks whether the law designated by virtue of that provision applies, in accordance with Article 15 of Regulation No 864/2007, to participatory acts.

91. In that regard, it must first of all be noted that, according to its wording, Article 8(2) determines, in the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable to any question that is not governed by the relevant Community instrument by referring to the law of the country in which the act of infringement was committed.

92. Admittedly, the sanctions and measures sought in the cases in the main proceedings against the defendants in the main proceedings and which are the subject of the third question fall within the sanctions and measures referred to in Article 88(2) and Article 89(1)(d) of Regulation No 6/2002 (see, to that effect, [judgment of 13 February 2014, H. Gautzsch Großhandel, C-479/12, EU:C:2014:75](#), paragraphs 52 to 54).

93. Nevertheless, those provisions do not govern those sanctions and measures independently, but refer, as stated in paragraphs 47 and 89 of the present judgment, to the law of the Member States they designate, including their private international law. Accordingly, in so far as the private international law of the Member States, excluding the Kingdom of Denmark, concerning the conflict-of-law rules applicable in civil and commercial matters to non-contractual obligations, including such obligations arising from infringements of unitary Community intellectual property rights, has been harmonised through the adoption of Regulation No 864/2007 (see, to that effect, judgment of 21 January 2016, *ERGO Insurance and Gjensidige Baltic*, C-359/14 and C-475/14, EU:C:2016:40, paragraph 37), that reference must, provided that it relates to private international law, be understood as covering the provisions of that regulation.

94. Concerning the concept of 'country in which the act of infringement was committed' within the meaning of Article 8(2) of Regulation No 864/2007, as that concept makes no reference to the law of the Member States to determine its meaning and scope, the terms of such a provision of EU law must, in accordance with the case-law recalled in paragraph 70 of the present judgment, normally be given an independent and uniform interpretation throughout the European Union that must take into account the context of the provision and the objective pursued by the rules of which it is part.

95. In that regard, it should be noted that the wording of Article 8(2) of Regulation No 864/2007 refers, in its French version, to the law of the country in which 'that right had been infringed'. It is not clear from such wording whether that concept involves active conduct on the part of the infringing party in the country thus designated, excluding the place where that infringement has effect. In contrast, other language versions of that provision, such as the versions in Spanish, German, Italian, Lithuanian, Dutch, Portuguese, Slovenian and Swedish, are more explicit in that regard, since they refer to the law of the country where 'the infringement was committed'. The same holds for the English language version, which refers to the law of the country 'in which the act of infringement was committed'.

96. As regards the general scheme and the context of Article 8(2) of Regulation No 864/2007, it is apparent from recital 16 of the regulation that uniform rules should enhance the foreseeability of court decisions and ensure a reasonable balance between the interests of the person claimed to be liable and the person who has sustained damage. To that effect, the regulation

establishes as a general principle the rule of *lex loci damni*, enshrined in Article 4 (1) thereof, by virtue of which the law applicable to a non-contractual obligation is the law of the country in which the damage occurs.

97. As is apparent from recital 19 of Regulation No 864/2007, the EU legislature has however acknowledged that specific rules should be laid down for special torts/delicts where the general rule does not allow a reasonable balance to be struck between the interests at stake; Article 8(2) of that regulation constitutes such a rule in matters of non-contractual obligations arising from infringements of unitary Community intellectual property rights.

98. It follows that, in so far as Article 8(2) of Regulation No 864/2007 lays down a specific connecting factor diverging from the general principle of *lex loci damni* laid down in Article 4(1) of that regulation, the criterion of law of the ‘country in which the act of infringement was committed’ must be understood as distinct from the criterion of the country ‘in which the damage occurs’ referred to in Article 4(1) of that regulation. Consequently, the ‘country in which the act of infringement was committed’ within the meaning of Article 8(2) of that regulation must be interpreted as meaning that it refers to the country where the event giving rise to the damage occurred, namely the country on whose territory the act of infringement was committed.

99. It must however be stated that proceedings relating to intellectual property rights infringements are particularly complex, as the Advocate General stated, in essence, in [point 64 of his Opinion](#). It is not uncommon for the same defendant to be accused of several infringing acts, with the result that several places could constitute, as the place where the event giving rise to the damage occurred, the relevant connecting factor for determining the applicable law.

100. First, by virtue of Article 19(1) and (2) of Regulation No 6/2002 and as has been stated in paragraph 49 of the present judgment, the right granted by the Community design confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. ‘Use’ within the meaning of that provision covers, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking for those purposes.

101. Secondly, unitary intellectual property rights are protected throughout the European Union and infringing acts may be carried out in several Member States, which therefore makes the determination of the substantive law applicable to questions not governed independently by the relevant Community instrument rather unpredictable.

102. The Court has already held that Regulation No 864/2007 aims, in accordance with recitals 6, 13, 14 and 16 thereof, to ensure the predictability of the outcome of litigation, legal certainty as to the law applicable and the uniform application of that

regulation in all the Member States (judgment of 17 November 2011, *Homawoo*, C-412/10, EU:C:2011:747, paragraph 34). Furthermore, the EU legislature wished, as is apparent from recitals 16 and 19 of Regulation No 864/2007, by establishing the connecting factors laid down in that regulation, to strike a reasonable balance between the interests of the person claimed to be liable and the person who has sustained damage. The connecting factor laid down in Article 8(2) of that regulation must therefore be interpreted by bearing in mind the objectives recalled above and the characteristics of the area in which it is supposed to apply.

103. In the light of those objectives, where the same defendant is accused of various acts of infringement falling under the concept of ‘use’ within the meaning of Article 19(1) of Regulation No 6/2002 in various Member States, the correct approach for identifying the event giving rise to the damage is not to refer to each alleged act of infringement, but to make an overall assessment of that defendant’s conduct in order to determine the place where the initial act of infringement at the origin of that conduct was committed or threatened.

104. Such an interpretation enables the court seised easily to identify the law applicable by using a single connecting factor linked to the place where the act of infringement at the origin of several acts alleged against a defendant was committed or threatened, in accordance with the objectives recalled in paragraph 102 of the present judgment. It also ensures the predictability of the law thus designated for all the parties to disputes concerning infringements of EU intellectual property rights.

105. The referring court additionally formulates certain questions seeking to determine the law applicable pursuant to Article 8(2) of Regulation No 864/2007 in circumstances such as those at issue in the main proceedings.

106. The first set of circumstances mentioned by the referring court concerns the situation in which an economic operator is accused of offering for sale, without the consent of the holder of the rights conferred by the Community designs, via its website goods allegedly infringing those rights, that site being accessible to consumers situated in Member States other than that in which the infringer is established.

107. In that regard, it should be noted that the 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 the Community designs, which it is possible to view on the screen and to order via that site, constitutes an offer for sale of those goods. Such an operator is thereby offering within the meaning of Article 19(1) of Regulation No 6/2002 and putting on the market allegedly infringing goods on its website, such conduct falling within the concept of ‘use’ within the meaning of that provision.

108. In such circumstances, it must be held that the event giving rise to the damage is the conduct by which

an operator offers for sale allegedly infringing goods, inter alia by placing an offer for sale on its website. Accordingly, 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.

109. As regards the second set of circumstances mentioned by the referring court, by which it inquires about the law applicable when an operator has goods that allegedly infringe the rights protected by a Community design shipped by a third-party undertaking to a Member State other than the one in which it is domiciled, it should be noted, as stated in paragraph 103 of the present judgment, that the correct approach for identifying the event giving rise to the damage within the meaning of Article 8(2) of Regulation No 864/2007 is not to refer to each of a defendant's alleged acts of infringement, but to make an overall assessment of that defendant's conduct in order to determine the place where the initial act of infringement at the origin of that conduct was committed or threatened by it.

110. As regards, finally, the referring court's question as to the law applicable to participatory acts, it should be noted that the referring court has not set out the reasons which prompted it to inquire about the interpretation of Article 15 of Regulation No 864/2007 and which would enable the Court of Justice to provide a helpful answer to that question, with the result that it must, pursuant to Article 94 of the Rules of Procedure of the Court of Justice, be regarded as inadmissible.

111. In the light of all the foregoing considerations, the answer to the third question is 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' within the meaning of that provision refers to the country where the event giving rise to the damage occurred. Where the same defendant is accused of various acts of infringement committed in various Member States, the correct approach for identifying the event giving rise to the damage is not to refer to each alleged act of infringement, but to make an overall assessment of that defendant's conduct in order to determine the place where the initial act of infringement at the origin of that conduct was committed or threatened by it.

#### Costs

112. 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 (Second Chamber) hereby rules:

1. Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, read in conjunction with Article 6(1) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, must be interpreted as meaning that in

circumstances such as those in the main proceedings where the international jurisdiction of a Community design court seised of an action for infringement is based, with regard to one defendant, on Article 82(1) of Regulation No 6/2002 and, with regard to a second defendant established in another Member State, on that Article 6(1) read in conjunction with Article 79(1) of Regulation No 6/2002, because the second defendant makes and supplies to the first defendant the goods that the latter sells, that court may, on the applicant's request, adopt orders in respect of the second defendant concerning measures falling under Article 89(1) and Article 88(2) of Regulation No 6/2002 also covering the second defendant's conduct other than that relating to the abovementioned supply chain and with a scope which extends throughout the European Union.

2. Article 20(1)(c) of Regulation No 6/2002 must be interpreted as meaning that a third party which, without the consent of the holder of the rights conferred by a Community design, uses, including via its website, images of goods corresponding to such designs when lawfully offering for sale goods intended to be used as accessories to the specific goods of the holder of the rights conferred by those designs, in order to explain or demonstrate the joint use of the goods thus offered for sale and the specific goods of the holder of those rights, carries out an act of reproduction for the purpose of making 'citations' within the meaning of Article 20(1)(c), such an act thus being authorised under that provision provided that it fulfils the cumulative conditions laid down therein, which is for the national court to verify.

3. 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') must be interpreted as meaning that the 'country in which the act of infringement was committed' within the meaning of that provision refers to the country where the event giving rise to the damage occurred. Where the same defendant is accused of various acts of infringement in various Member States, the correct approach for identifying the event giving rise to the damage is not to refer to each alleged act of infringement, but to make an overall assessment of that defendant's conduct in order to determine the place where the initial act of infringement at the origin of that conduct was committed or threatened by it.

[Signatures]

#### OPINION OF A-G BOT

delivered on 1 March 2017 (1)

Joined Cases C-24/16 and C-25/16

Nintendo Co. Ltd v BigBen Interactive GmbH, BigBen Interactive SA

(Request for a preliminary ruling from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany))

(Reference for a preliminary ruling — Regulation (EC) No 44/2001 — Jurisdiction and enforcement of

judgments — Regulation (EC) No 6/2002 — Protection of Community designs — Regulation (EC) No 864/2007 — Applicable law — Territorial scope of decisions concerning claims supplementary to an action for infringement — Concepts of ‘other sanctions’ and ‘acts of reproduction for the purpose of making citations’)

1. The present case referred to the Court gives it an opportunity to determine the territorial scope of a decision adopted by a court of a Member State in respect of two co-defendants domiciled in two different Member States concerning claims supplementary to an action for infringement brought before that court.

2. The Court is also asked whether the concept of ‘*other sanctions*’ within the meaning of Article 89(1)(d) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (2) covers claims supplementary to an action for infringement, such as the provision of accounting documents, the award of financial compensation, reimbursement of lawyers’ fees, the destruction of the infringing goods, the recall of those goods and publication of the judgment. In addition, the referring court wishes to know, in order to determine the law applicable to such claims, what criteria are to be taken into consideration.

3. Lastly, the Court will be required to clarify whether the concept of ‘*acts of reproduction for the purpose of making citations*’ within the meaning of Article 20(1)(c) of that regulation includes use by a third party of the image of goods incorporating protected Community designs for purposes of selling its own goods.

4. In this Opinion, I will explain why I consider that Article 79(1) of Regulation No 6/2002 in conjunction with Article 6(1) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (3) is to be interpreted to the effect that decisions adopted by a national court in response to claims supplementary to an action for infringement in respect of two co-defendants domiciled in two different Member States, such as compensation for damage, the destruction or recall of the infringing goods, reimbursement of lawyers’ fees or publication of the judgment, have legal effect throughout the entire territory of the Union.

5. I will then explain why, in my view, Article 89(1)(d) of Regulation No 6/2002 is to be interpreted to the effect that the concept of ‘*other sanctions*’ refers to claims such as the destruction of the infringing goods, the recall of those goods and publication of the judgment. On the other hand, that concept does not cover claims relating to compensation for damage, disclosure of company accounting information or reimbursement of lawyers’ fees.

6. I will also propose that the Court rule that that provision and 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 (4) are to be interpreted to the effect that the law applicable to claims that are

supplementary to an infringement action, relating to the destruction of the infringing goods, the recall of those goods, publication of the judgment, compensation for damage, disclosure of company accounting information and reimbursement of lawyers’ fees is the law of the Member State where the act giving rise to the alleged infringement occurred or may occur. In the present case, the act giving rise to the alleged infringement is the manufacture of the infringing goods.

7. Lastly, I will explain why I consider that Article 20(1)(c) of Regulation No 6/2002 is to be interpreted to the effect that the concept of ‘acts of reproduction for the purpose of making citations’ includes use by a third party of the image of goods incorporating protected Community designs for purposes of selling its own goods. It is for the national court to ascertain that this act of reproduction is compatible with fair trade practice, that it does not unduly prejudice the normal exploitation of those designs and that mention is made of the source.

#### **I – Legal context**

##### **A – Regulation No 44/2001**

8. The purpose of Regulation No 44/2001 is to unify the rules of conflict of jurisdiction in civil and commercial matters and to simplify the formalities with a view to rapid recognition and enforcement of judgments from Member States.

9. Article 2(1) of that regulation provides that ‘*[s]ubject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State*’.

10. Under Article 6(1) of the regulation, ‘*[a] person domiciled in a Member State may also be sued ... where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings*’.

##### **B – Regulation No 6/2002**

11. The purpose of Regulation No 6/2002 is to provide uniform protection to Community designs in the territory of the Union and to ensure that the rights conferred by Community designs can be enforced.

12. According to recital 22 of that regulation, ‘*[t]he enforcement of these rights is to be left to national laws. It is necessary therefore to provide for some basic uniform sanctions in all Member States. These should make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts*’.

13. Article 1(3) of that regulation provides that ‘*[a] Community design shall have a unitary character. It shall have equal effect throughout the Community. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle and its implications shall apply unless otherwise provided in this Regulation*’.

14. Under Article 19(1) of Regulation No 6/2002:

*'A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.'*

15. Article 20(1) of that regulation introduces certain limitations on the rights conferred by the Community design and provides:

*'The rights conferred by a Community design shall not be exercised in respect of:*

*(a) acts done privately and for non-commercial purposes;*

*(b) acts done for experimental purposes;*

*(c) acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.'*

16. Under Article 79(1) of the regulation:

*'Unless otherwise specified in this Regulation, the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, signed in Brussels on 27 September 1968, (5) ... shall apply to proceedings relating to Community designs and applications for registered Community designs, as well as to proceedings relating to actions on the basis of Community designs and national designs enjoying simultaneous protection.'*

17. Under Article 82(1) and (5) of Regulation No 6/2002:

*'1. Subject to the provisions of this Regulation and to any provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 79, proceedings in respect of the actions and claims referred to in Article 81 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 any Member State in which he has an establishment.*

...

*5. Proceedings in respect of the actions and claims referred to in Article 81(a) and (d) may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened.'*

18. Article 83 of that regulation states:

*'1. A Community design court whose jurisdiction is based on Article 82(1), (2) (3) or (4) shall have jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States.*

*2. A Community design court whose jurisdiction is based on Article 82(5) shall have jurisdiction only in respect of acts of infringement committed or threatened within the territory of the Member State in which that court is situated.'*

19. Article 88(2) of that regulation reads as follows:

*'On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.'*

20. Under Article 89(1) of Regulation No 6/2002:

*'1. Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures:*

*(a) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;*

*(b) an order to seize the infringing products;*

*(c) an order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew the effect for which such use was intended or if such effect would have been obvious in the circumstances;*

*(d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.'*

#### **C – The Rome II Regulation**

21. The aim of Rome II Regulation is to promote the compatibility of the rules applicable in the Member States concerning the conflict of laws and of jurisdiction with regard to non-contractual obligations in civil and commercial matters, following an infringement of a right. The regulation applies specifically in cases of infringement of an intellectual property right.

22. Article 8(1) and (2) of that regulation provides:

*'1. The law applicable to a non-contractual obligation arising from an infringement of an intellectual property right shall be the law of the country for which protection is claimed.*

*2. In the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable shall, for any question that is not governed by the relevant Community instrument, be the law of the country in which the act of infringement was committed.'*

#### **II – Facts**

23. Nintendo Co. Ltd, a Japanese undertaking which sells the Wii video game console, (6) holds several Community designs which relate to accessories such as 'Nunchuks', 'Balance Boards' and remote controls.

24. BigBen Interactive SA ('BigBen France'), which is now a European market leader in the design and distribution of video game accessories for smartphones and tablets, has various European subsidiaries in different Member States. The undertaking manufactures the same accessories as those mentioned above, which are compatible with the Wii video game console and which it sells to various customers in Belgium, France and Luxembourg and to its German subsidiary, BigBen Interactive GmbH ('BigBen Germany'), which operates on the German and Austrian markets.

25. Nintendo asserts that these goods thus placed on the European market infringe its registered Community designs. For that reason, it is claiming that the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) should order that the defendants cease the manufacture, import and export of the goods considered to be in dispute and prohibit the depiction and use of the image of the goods incorporating the protected Community designs. By its supplementary claims, Nintendo is requesting the provision of accounting documents from BigBen France and BigBen Germany, financial compensation, reimbursement of lawyers' fees, publication of the judgment and the destruction and recall of all the disputed goods.

26. In the orders made by it at first instance, the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) recognised an infringement of Nintendo's Community designs by BigBen France and BigBen Germany and therefore ordered them to cease using those designs. However, the use of images of the goods corresponding to those designs on websites was not declared unlawful by that court.

### III – The questions referred for a preliminary ruling

27. The Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf), which has doubts as to the interpretation to be given to EU law, decided to stay its proceedings and to refer the following questions to the Court for a preliminary ruling:

*'(1) In connection with a trial to enforce claims under a Community design, can the court of a Member State whose jurisdiction with respect to a defendant is based solely on Article 79(1) of Regulation No 6/2002 in conjunction with Article 6(1) of Regulation No 44/2001, on the basis that this defendant, which is domiciled in another Member State, supplied the defendant domiciled in the pertinent Member State with goods that may infringe intellectual property rights, adopt measures against the first mentioned defendant that are applicable throughout the EU and extend beyond the supply relationships on which jurisdiction is based?*

*(2) Is Regulation No 6/2002, particularly Article 20(1)(c), to be interpreted as meaning that a third party may depict a Community design for commercial purposes if it intends to sell accessory items for the right holder's goods corresponding to the Community design? If so, what criteria apply to this?*

*(3) For the purposes of Article 8(2) of the Rome II Regulation, how is the place "in which the act of infringement was committed" to be determined in cases in which the infringer:*

*(a) offers goods that infringe a Community design on a website and that website is also directed at Member States other than the one in which the person damaged by the infringement is domiciled, and/or;*

*(b) has goods that infringe a Community design shipped to a Member State other than the one in which it is domiciled?*

*Is Article 15(a) and (g) of the Rome II Regulation to be interpreted as meaning that the law determined in this manner is also applicable to participatory acts of other persons?'*

### IV – My analysis

#### A – The first question referred for a preliminary ruling

28. By its first question, the referring court is seeking, in essence, to ascertain whether Article 79(1) of Regulation No 6/2002 in conjunction with Article 6(1) of Regulation No 44/2001 is to be interpreted to the effect that decisions adopted by a national court in response to identical claims that are supplementary to an infringement action, such as compensation for damage, the destruction or recall of the infringing goods, reimbursement of lawyers' fees or publication of the judgment, in respect of two co-defendants domiciled in two different Member States have legal effect throughout the entire territory of the Union.

29. It should be stated as a preliminary point that the jurisdiction of the German court in the case in the main proceedings has not been challenged by any of the parties to the dispute. Moreover, the referring court expressly requests in this regard that the Court does not rule on its jurisdiction to adopt orders in response to the supplementary claims in respect of the co-defendants. (7) I do not therefore think it helpful to take a view either on the jurisdiction of the referring court or on the existence of a connection between the supplementary claims made by the applicant vis-à-vis the co-defendants. In any event it is for the referring court to assess the risk of irreconcilable judgments resulting from separate applications in accordance with Article 6(1) of Regulation No 44/2001. (8)

30. The referring court is thus seeking to determine the scope of the orders to be adopted by it and, more precisely, whether the measures taken pursuant to the prohibition of infringements, that is to say, the claims supplementary to the main claims, have an effect throughout the entire territory of the Union.

31. It must be observed that the territorial scope of a prohibition against further infringement or threatened infringement of a European Union trade mark, as provided for in Article 98(1) of Regulation No 40/94, (9) is to be determined both by the territorial jurisdiction of the Community trade mark court issuing that prohibition and by the territorial extent of the European Union trade mark proprietor's exclusive right which is adversely affected by the infringement or threatened infringement, as that extent results from that regulation. (10) The Court has thus ruled in connection with the European Union trade mark that a prohibition against further infringement or threatened infringement must extend to the entire area of the European Union. (11)

32. Furthermore, as the Court has held — again in a case relating to the European Union trade mark — the prohibition against further infringement and the ensuing supplementary obligations must be regarded as a single entity such that, without the existence of coercive measures which must be taken by the courts to



ensure that the decision prohibiting infringement taken by the court before which an action is brought is complied with, a prohibition of that kind would have no dissuasive effect. (12) Consequently, there would be no justification to treat the main claims and supplementary claims differently.

33. In these circumstances, I cannot see any reason why the abovementioned case-law should not be applied to the protection of Community designs. It should be borne in mind that, like the European Union trade mark, the Community design has a unitary character, that it is given uniform protection, just like the exclusive rights conferred on it, and that it has the same effects throughout the entire territory of the Union, thereby furthering the objectives pursued by the Treaties. (13)

34. In addition, the uniform protection throughout the entire area of the Union of Community designs against acts of infringement would be compromised if the measures taken to give specific effect to that protection had no effect throughout that entire area and were limited to the area in which the court which adopted them is located. (14) Right holders of Community designs would be forced to bring legal proceedings before the court having jurisdiction in each Member State, which would not only create a risk of inconsistent decisions being given, but would also represent a significant cost for the litigant.

35. This approach is, moreover, fully consistent with one of the objectives of creating an area of freedom, security and justice, namely facilitating access to justice through the principle of mutual recognition of judicial decisions. (15)

36. I wish to point out in this regard that, with regard to recognition and enforcement of court judgments, in accordance with the provisions of Chapter III of Regulation No 44/2001 and so that the prohibition decision has effect in the territory of all the EU Member States, each Member State must recognise and seek enforcement of those decisions in accordance with the rules and procedures under its domestic law. (16)

37. Although certain measures, whether coercive or not, adopted by a domestic court of a Member State are sometimes not provided for in the national law of another Member State, the latter Member State must, with a view to the enforcement of the judgment of the court of the first Member State, have recourse to the relevant provisions of its national law which are appropriate for guaranteeing equivalent compliance with that prohibition. The enforcement of the rights conferred by Community designs is to be left to national laws. (17)

38. Therefore, in view of these factors, I consider that Article 79(1) of Regulation No 6/2002 in conjunction with Article 6(1) of Regulation No 44/2001 is to be interpreted to the effect that decisions adopted by a national court in response to claims supplementary to an action for infringement in respect of two co-defendants domiciled in two different Member States, such as compensation for damage, the destruction or recall of the infringing goods, reimbursement of

lawyers' fees or publication of the judgment, have legal effect throughout the entire territory of the Union.

#### **B – The third question referred for a preliminary ruling**

39. By its third question, the referring court is seeking clarifications on the law applicable to the supplementary claims made by the applicant. Whilst that court starts from the premiss that the Rome II Regulation is applicable to those claims, I, however, think that it is first necessary to examine the nature of those claims so as then to be able to determine the law applicable to them. Furthermore, this point was raised at the hearing, in particular in the questions asked by the Judge-Rapporteur. In the answers they gave at that hearing, the parties to the dispute in the main proceedings seem to take the view that Article 89(1)(d) of Regulation No 6/2002 applies in respect of those claims and refers to the Rome II Regulation.

40. I therefore propose that the question asked by the referring court be reformulated as follows. By its third question, the referring court is asking, in essence, whether Article 89(1)(d) of Regulation No 6/2002 is to be interpreted to the effect that the concept of '*other sanctions*' refers to claims such as the provision of accounting documents, the award of financial compensation, reimbursement of lawyers' fees, the destruction of the infringing goods, the recall of those goods and publication of the judgment, such that the law applicable to those claims is the law of the Member State in which the acts of infringement or threatened infringement are committed. If that question is answered in the affirmative, the referring court asks what criteria should be taken into consideration in determining the place in which the act of infringement or threatened infringement is committed.

41. The question whether such measures can be classified as '*other sanctions*' within the meaning of that provision is essential in so far as, if that is not the case, other rules on the applicable law will govern the supplementary claims made by the applicant. Whilst Article 89(1)(d) of Regulation No 6/2002 states that it is the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law, that applies to the other sanctions, Article 88(2) of that regulation provides that '*[o]n all matters not covered by [that regulation], a Community design court shall apply its national law, including its private international law*'.

42. It is therefore necessary to clarify the concept of '*other sanctions*' within the meaning of Article 89(1)(d) of that regulation, so as then to be able to determine the law applicable to the supplementary claims made by the applicant.

#### **1. The concept of 'other sanctions'**

43. Regulation No 6/2002 does not provide any definition or clarification of the concept of '*other sanctions*'. Article 89(1) of that regulation simply provides for sanctions which could be described as harmonised in so far as Member States are required to make provision for them in their domestic legal order. The same holds for a measure consisting in an order

prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design or an order to seize the infringing products or to seize materials and implements predominantly used in order to manufacture the infringing goods. It is clear from recital 22 of that regulation that these measures are intended to make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts. (18)

44. It would therefore seem that ‘other sanctions’ must be construed more broadly and not cover only sanctions which make it possible to stop the infringing acts. In my view, the sanction is not intended solely to stop the infringing act but also seeks to ensure effective compliance with and enforcement of a right, in this case the right of the right holder for the Community design. Measures to ensure such effective compliance and enforcement can, for example, take the form of a penalty payment or confiscation of all or part of the revenue from the infringement.

45. With regard to the supplementary claims made by the applicant, I note that the nature of some of them has already been established by the Court. Thus, the claim for the destruction of the infringing goods falls within the ‘other sanctions’ under Article 89(1)(d) of Regulation No 6/2002. (19)

46. As regards the claim for compensation for damage, the Court, departing from the view taken in this regard by Advocate General Wathelet, held that it did not constitute a sanction within the meaning of that provision. The Court concluded that, accordingly, pursuant to Article 88(2) of Regulation No 6/2002, the law applicable to that claim was the national law of the Community design court hearing the proceedings, including its private international law. (20)

47. With regard to the claim for disclosure of accounting information, whilst the Court has not been required specifically to determine whether such a claim falls within the ‘other sanctions’ within the meaning of Article 89(1)(d) of that regulation, I note that it has ruled, in *H. Gautzsch Großhandel*, that disclosure of information relating to an undertaking’s activities did not constitute an ‘other sanction’ within the meaning of that provision. (21) In my view, information on the undertaking’s activities, which has an economic use, moreover, also encompasses information on that undertaking’s accounting documents. It would therefore seem consistent to take the view that the law applicable to a claim for disclosure of an undertaking’s accounting information is, in accordance with the abovementioned case-law and Article 88(2) of Regulation No 6/2002, the national law of the Community design court hearing the proceedings, including its private international law.

48. With regard to the claim for the recall of the goods, it seems to be similar to a claim for seizure of the products, which is expressly referred to in Article 89(1)(b) of that regulation. Recall of the goods can be defined as a measure seeking to prevent, after distribution, the consumption or use of a product by consumers and/or to warn them of the danger to which

they might be exposed if they have already consumed the product, (22) whereas seizure of products is a measure preventing the sale of goods. Although the two measures are not therefore at the same level of the economic circuit, they nevertheless have binding force and both seek to guarantee effective compliance with and enforcement of the intellectual property right claimed, by ensuring that none or few of the infringing goods will continue in circulation on the economic market. Therefore, I think that a claim for the recall of goods must be considered to fall within the ‘other sanctions’ under Article 89(1)(d) of that regulation.

49. As far as the claim for publication of the judgment is concerned — a claim which is, moreover, regularly made in proceedings of this kind — in my view it also constitutes a sanction within the meaning of that provision. It is a coercive measure requiring the infringer, at its own expense, to publish the judgment on the internet or in newspapers so as to put an end to the infringing exploitation.

50. Lastly, with regard to the claim for reimbursement of lawyers’ fees, it relates to fees incurred in legal proceedings and cannot be considered to fall within the ‘other sanctions’ within the meaning of that provision.

51. Consequently, I consider that Article 89(1)(d) of Regulation No 6/2002 is to be interpreted to the effect that the concept of ‘other sanctions’ refers to claims such as the destruction of the infringing goods, the recall of those goods and publication of the judgment. On the other hand, that concept does not cover claims relating to compensation for damage, disclosure of company accounting information or reimbursement of lawyers’ fees.

52. Having clarified the concept of ‘other sanctions’ within the meaning of Article 89(1)(d) of Regulation No 6/2002, it is now necessary to determine the law applicable to the various supplementary claims made by Nintendo in the dispute in the main proceedings.

## **2. The law applicable to the supplementary claims**

53. The Rome II Regulation on the law applicable provides in Article 8(2) that ‘*[i]n the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable shall, for any question that is not governed by the relevant Community instrument, be the law of the country in which the act of infringement was committed*’. An a contrario interpretation of that provision clearly shows that, where the ‘question’ is governed by a specific Community instrument, it is that instrument which, where appropriate, determines the law applicable. Thus, in the present case, reference should be made, first, to Regulation No 6/2002 in order to determine the law applicable to the supplementary claims made by Nintendo.

54. In this regard, Article 88 of Regulation No 6/2002, entitled ‘*Applicable law*’, itself refers to specific provisions of that regulation, as it states, in Article 88(1), that ‘*[t]he Community design courts shall apply the provisions of this Regulation*’. However, with regard to the supplementary claims made by Nintendo,

I have stated that some must be classified as *'other sanctions'* within the meaning of Article 89(1)(d) of that regulation, while others fall under Article 88(2) thereof.

55. As regards the claims falling under Article 89(1)(d) of Regulation No 6/2002, the concept of *'Member State in which the acts of infringement or threatened infringements are committed'* has never, to my knowledge, been interpreted by the Court in a dispute concerning Community designs. However, the Court has had the opportunity to clarify this concept in disputes concerning the European Union trade mark and relating to the jurisdiction. (23)

56. I concur with the Commission that this case-law should be applied to the present case. In *Coty Germany*, the Court ruled that the concept of *'the Member State in which the act of infringement has been committed or threatened'* within the meaning of Article 93(5) of Regulation No 40/94 is an independent concept of EU law. (24) However, the use of almost identical (25) wording in Article 89(1)(d) of Regulation No 6/2002, the fact that the latter regulation governs the scope of the protection of an intellectual property right and the fact that, as for the European Union trade mark, that protection has a unitary character and has effects throughout the entire territory of the Union suggest that the concept in Regulation No 6/2002 should be given the same interpretation as the concept in Regulation No 40/94.

57. In this respect, in *Coty Germany* the Court ruled that *'the concept of "the Member State in which the act of infringement has been committed" 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'*. (26)

58. Thus, regard must be had to the place of the active conduct on the part of the person causing the infringement in determining the law applicable to the supplementary claims made by Nintendo which fall within the scope of Regulation No 6/2002. A difficulty could arise in determining that active conduct in the present case in so far as several Member States are affected by the acts of infringement. However, I consider that there is a single act giving rise to that infringement, which is located in a single Member State, namely in France. It should be borne in mind that the goods at issue in this case were manufactured in France. Without that manufacture, it is clear that the act of infringement would quite simply not have existed and the goods would never have been sold on the markets of the different Member States.

59. I therefore take the view that, for the supplementary claims made by Nintendo which fall within the scope of Article 89(1)(d) of Regulation No 6/2002, the law applicable is French law.

60. As far as the other supplementary claims falling under Article 88(2) of that regulation are concerned, it

should be noted that that provision refers to the national law of the Community design court hearing the proceedings, including its private international law. However, as is pointed out by the parties to the dispute in the main proceedings, in matters of non-contractual obligations arising from an infringement of a unitary Community intellectual property right, private international law is unified by Article 8(2) of the Rome II Regulation. In my view, it is therefore that provision which applies to those claims.

61. Under that provision, the law applicable is the law *'of the country in which the act of infringement was committed'*. This concept has not yet been interpreted by the Court. In my view, it should not be given a different definition to the concept used in Article 89(1)(d) of Regulation No 6/2002.

62. Whilst it is true that the application of different laws to the same dispute was envisaged by the Union legislature, through Article 88(2) and Article 89(1)(d) of Regulation No 6/2002, I think that the adoption, subsequent to that regulation, of the Rome II Regulation, unifying private international law in this regard, strengthens a little further legal certainty in proceedings of this kind, and thus the predictability of the applicable law. This is, moreover, one of the stated objectives of the latter regulation. (27)

63. Furthermore, for obvious reasons connected with the foreseeability of the law, the Rome II Regulation itself establishes the single linking factor in the country where the direct damage occurred, regardless of the country or countries in which the indirect consequences could occur. (28)

64. Therefore, to give the concept of *'country in which the act of infringement was committed'* in Article 8(2) of the Rome II Regulation a different interpretation to that for the concept of *'Member State in which the acts of infringement or threatened infringement are committed'* in Article 89(1)(d) of Regulation No 6/2002 would run counter to the principle of legal certainty in proceedings precisely where greater legal certainty is required by reason of the frequency of complexity and of the multiplicity of places in which the effects of damage arising from the act of infringement can arise.

65. Consequently, I think that the concept contained in Article 8(2) of the Rome II Regulation must be given the same meaning as the concept contained in Article 89(1)(d) of Regulation No 6/2002.

66. Thus, in the light of all the above factors, I consider that Article 89(1)(d) of Regulation No 6/2002 and Article 8(2) of the Rome II Regulation are to be interpreted to the effect that the law applicable to the supplementary claims relating to the destruction of the infringing goods, the recall of those goods, publication of the judgment, compensation for damage, disclosure of company accounting information and reimbursement of lawyers' fees is the law of the Member State where the act giving rise to the alleged infringement occurred or may occur.

67. In the present case, the act giving rise to the alleged infringement is the manufacture of the infringing goods.

**C – The second question referred for a preliminary ruling**

68. By its second question, the referring court is seeking to ascertain, in essence, whether Article 20(1)(c) of Regulation No 6/2002 is to be interpreted to the effect that the concept of ‘acts of reproduction for the purpose of making citations’ includes use by a third party of the image of goods incorporating protected Community designs for purposes of selling its own goods.

69. As a preliminary point, I would point out that the exclusive rights conferred on a Community design permit the right holder to prevent any third party from using that design, such as the making or putting on the market of a product in which the design is incorporated. (29) Nevertheless, by way of exception, those rights may be limited. Thus, Article 20(1)(c) of that regulation provides inter alia that the rights conferred by a Community design are not to be exercised in respect of acts of reproduction for the purpose of making citations.

70. In the case at issue, one of the two co-defendants, BigBen France, uses the image of goods incorporating the Community design registered by Nintendo for the purposes of advertising in connection with the sale of its own goods, which are accessories that can be used with the Nintendo goods in question.

71. Article 20(1)(c) of Regulation No 6/2002 makes acts which might be considered as acts of reproduction for the purpose of making citations subject to the fulfilment of a number of conditions, namely the compatibility of the acts in question with fair trade practice, mention of the source and no undue prejudice to the normal exploitation of the design.

72. It must therefore be determined, first, whether use by a third party of the image of goods incorporating protected Community designs for purposes of selling its own goods can be, by nature, an act of reproduction and whether it is for the purpose of making citations.

73. As Dominique Kaesmacher and Théodora Stamos have stated, *[this] concept must be interpreted as broadly as possible. It covers primarily any form of reproduction, by any method and in any form, direct or indirect (remotely), full or partial, temporary or permanent, on a medium of the same kind or of a different kind*. (30) There is no doubt that the act in question in the dispute in the main proceedings is an act of reproduction, as it consists in publishing images of goods incorporating Community designs registered by Nintendo on packages and on the website of BigBen France.

74. As far as the purpose of that act is concerned, the term ‘illustration’ used in the French version of Regulation No 6/2002 is not the same as is used in the English version, which employs the term ‘citation’. Where there is divergence between the language versions of a European Union text, the provision in question must be interpreted by reference to the general scheme and purpose of the rules of which it forms part. (31)

75. In my view, in the light of the general scheme of that regulation, the concept of ‘citation’ should not be interpreted too strictly, since the regulation seeks, through the protection it confers on Community designs, to encourage innovation and thereby to make the Union more competitive. (32) Preventing an undertaking creating new products which are intended to be compatible with existing products — the Community design for which is owned by another undertaking — could undoubtedly discourage innovation.

76. As in trade mark law, the objective of effective protection of Community designs must therefore be balanced with the interests of third parties selling accessories for goods incorporating protected Community designs, in particular from the point of view of the needs of the internal market, (33) such as free movement of goods, (34) free competition and promotion of innovation.

77. Furthermore, it would seem that the aim pursued in reproducing a registered Community design for the purpose of making citations (35) is simply to explain the way in which the other product, which is intended as an accessory for the first product, is to be used.

78. Consequently, use by a third party of the image of goods incorporating protected Community designs for purposes of selling its own goods is an act for the purpose of making citations.

79. Second, with regard to the conditions to be met in order for a third party to be permitted to carry out such an act, it would seem that mention of the source is uncontroversial. The mention must determine the commercial origin of the registered Community design, that is to say, an informed public must know at a glance with which trade mark or undertaking the product sold by the third party is associated.

80. Similarly, I think that attention must be paid to the indication of origin of the Community design. In the context of sale through a website, the Court has held, with regard to the European Union trade mark, that the function of indicating the origin of the mark is adversely affected if the ad which appears after typing the keyword does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or originate from a third party. (36)

81. In the light of the context and the purpose of Regulation No 6/2002, it seems appropriate to apply this analysis to the mention of the source for the reproduction of Community designs. In the present case, it is for the national court to determine whether the inclusion of the indication ‘for Wii’ on packages and website advertisements for the goods of BigBen France meets this condition.

82. In addition, with regard to the condition of the compatibility of the act of reproduction with fair trade practice, according to Article 5 of Directive 2005/29/EC, (37) a commercial practice is unfair if it is

contrary to the requirements of professional diligence and if it materially distorts or is likely to materially distort the economic behaviour with regard to the product of the average consumer whom it reaches or to whom it is addressed. In this regard, the Court has ruled that the indication of a photocopier manufacturer's product numbers and of spare parts in catalogues of a competing supplier did not enable him to take unfair advantage of the reputation of the competitor's trade mark as, in that case, the public did not associate the reputation of the trade mark with the competitor's goods. (38) The national court will therefore, in my view, be required to determine whether reproduction of the image of a Nintendo product, such as a video game console remote control, for purposes of selling an accessory for that remote control, does not either confuse or mislead the consumer.

83. Lastly, as regards the condition of no undue prejudice to the normal exploitation of the design, I think that it is for the right holder for that Community design to provide evidence of such prejudice, if necessary, and for the national court to assess that evidence.

84. In the light of all these factors, I consider that Article 20(1)(c) of Regulation No 6/2002 is to be interpreted to the effect that the concept of '*acts of reproduction for the purpose of making citations*' includes use by a third party of the image of goods incorporating protected Community designs for purposes of selling its own goods. It is for the national court to ascertain that this act of reproduction is compatible with fair trade practice, that it does not unduly prejudice the normal exploitation of those designs and that mention is made of the source.

#### IV – Conclusion

85. In view of all the foregoing considerations, I propose that the questions referred for a preliminary ruling by the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) be answered as follows:

(1) Article 79(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs in conjunction with Article 6(1) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters is to be interpreted to the effect that decisions adopted by a national court in response to claims that are supplementary to an action for infringement in respect of two co-defendants domiciled in two different Member States, such as compensation for damage, the destruction or recall of the infringing goods, reimbursement of lawyers' fees or publication of the judgment, have legal effect throughout the entire territory of the Union.

(2) Article 89(1)(d) of Regulation No 6/2002 is to be interpreted to the effect that the concept of '*other sanctions*' refers to claims such as the destruction of the infringing goods, the recall of those goods and publication of the judgment. On the other hand, that concept does not cover claims relating to compensation

for damage, disclosure of company accounting information or reimbursement of lawyers' fees.

(3) Article 89(1)(d) of Regulation No 6/2002 and 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 is to be interpreted to the effect that the law applicable to the claims that are supplementary to an action for infringement relating to the destruction of the infringing goods, the recall of those goods, publication of the judgment, compensation for damage, disclosure of company accounting information and reimbursement of lawyers' fees is the law of the Member State where the act giving rise to the alleged infringement occurred or may occur. In the present case, the act giving rise to the alleged infringement is the manufacture of the infringing goods.

(4) Article 20(1)(c) of Regulation No 6/2002 is to be interpreted to the effect that the concept of '*acts of reproduction for the purpose of making citations*' includes use by a third party of the image of goods incorporating protected Community designs for purposes of selling its own goods. It is for the national court to ascertain that this act of reproduction is compatible with fair trade practice, that it does not unduly prejudice the normal exploitation of those designs and that mention is made of the source.

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1 Original language: French.

2 OJ 2002 L 3, p. 1.

3 OJ 2001 L 12, p. 1.

4 OJ 2007 L 199, p. 40, 'the Rome II Regulation'.

5 OJ 1978 L 304, p. 36.

6 'Wii' is a European Union trade mark registered by Nintendo.

7 See paragraph 8 of the request for a preliminary ruling in Case C-24/16 in the language of the case.

8 See judgments of 1 December 2011, Painer (C-145/10, EU:C:2011:798, paragraph 83), and of 12 July 2012, Solvay (C-616/10, EU:C:2012:445, paragraph 23).

9 Council Regulation of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

10 See judgment of 12 April 2011, DHL Express France (C-235/09 'DHL Express France', EU:C:2011:238, paragraph 33).

11 See DHL Express France (paragraph 44).

12 See judgment of 14 December 2006, Nokia (C-316/05, EU:C:2006:789, paragraph 60) and DHL Express France (paragraph 57).

13 See recital 1 of Regulation No 6/2002.

14 See, to that effect, DHL Express France (paragraph 54).

15 See Article 67(4) TFEU.

16 See judgment of 16 July 2015, Diageo Brands (C-681/13, EU:C:2015:471, paragraph 40).

17 See recital 22 of Regulation No 6/2002.

18 See, in this regard, Opinion of Advocate General Wathelet in *H. Gautzsch Großhandel* (C-479/12, EU:C:2013:537), with whom I fully concur.

19 See judgment of 13 February 2014, *H. Gautzsch Großhandel* (C-479/12 ‘*H. Gautzsch Großhandel*’, EU:C:2014:75, paragraph 52).

20 See *H. Gautzsch Großhandel* (paragraph 53).

21 See *H. Gautzsch Großhandel* (paragraph 53).

22 See the website of the Directorate-General for Competition, Consumer Affairs and Fraud Prevention (France) at <http://www.economie.gouv.fr/dgccrf/securite/rappels-produits>

23 See judgment of 5 June 2014, *Coty Germany* (C-360/12 ‘*Coty Germany*’, EU:C:2014:1318).

24 See paragraph 31 of *Coty Germany*.

25 Article 93(5) of the French version of Regulation No 40/94 uses the words ‘État membre sur le territoire duquel’ while Article 89(1)(d) of Regulation No 6/2002 uses the terms ‘État membre dans lequel’. In the German version of those regulations, the wording of those passages is even identical, since those provisions refer to the ‘Mitgliedstaats ..., in dem’.

26 Paragraph 34 of *Coty Germany*.

27 See recital 6 of that regulation.

28 See recitals 16 and 17 and Article 4(1) of that regulation.

29 See Article 19(1) of that regulation.

30 See Kaesmacher, D., and Stamos, T., *Brevets, marques, droits d’auteurs ...: mode d’emploi, Librairie générale de droit et de jurisprudence*, Paris, 2009, p. 265.

31 See judgment of 4 September 2014, *Vnuk* (C-162/13, EU:C:2014:2146, paragraph 46).

32 See recital 7 of that regulation.

33 See recital 8 of Regulation No 6/2002.

34 See judgment of 17 March 2005, *Gillette Company and Gillette Group Finland* (C-228/03, EU:C:2005:177, paragraph 29).

35 The term ‘illustration’ is defined by Larousse as follows: ‘[a]ction d’éclairer par exemples un développement abstrait, ce qui a valeur d’application, de vérification, de démonstration’ (‘act of clarifying, by means of examples, an abstract idea for purposes of application, verification and demonstration’).

36 See judgment of 23 March 2010, *Google France and Google* (C-236/08 to C-238/08, EU:C:2010:159, paragraph 84).

37 Directive of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market and amending Council Directive 84/450/EEC, Directives 97/7/EC, 98/27/EC and 2002/65/EC of the European Parliament and of the Council and Regulation (EC) No 2006/2004 of the European Parliament and of the Council (OJ 2005 L 149, p. 22).

38 See judgment of 25 October 2001, *Toshiba Europe* (C-112/99, EU:C:2001:566, paragraph 58).