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A Better Uniform Enforcement of Unitary IP Rights: Court of Justice EU, 27 September 2017, C 24/16 and C-25/16, Nintendo v. BigBen

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The Court of Justice has rendered a crucial decision on the jurisdiction of the Community design courts over European co-defendants and the national law applicable to the measures sought.

Nintendo holds various Community design rights for accessories for video game consoles, such as remote controls. It brought infringement proceedings in Germany against two companies: BigBen France, the parent company, and BigBen Germany, its subsidiary. BigBen France produces remote controls and sells them, on the one hand, on its website, directly to consumers in France and the Benelux and, on the other hand, to BigBen Germany, which in turn sells them in Germany and Austria. BigBen Germany does not hold products in stock; BigBen France is responsible for delivering all products ordered through BigBen Germany.

Nintendo sought an injunction against both co-defendants as well as other related measures (production of accounts, damages, recall and destruction, publication of the decision and reimbursement of legal fees). Nintendo asked that these measures extend, with regard to each co-defendant, to the entire territory of the EU.

The German court submitted a preliminary question to the Court of Justice regarding its jurisdiction to grant measures with pan-European effect with respect to the two co-defendants. It also wished to know which national law should be applied to the measures requested in relation to the injunction.

The Court's answer to the question of jurisdiction is crystal clear. As from the time multiple European co-defendants are validly summoned before the court of the place where one of them is domiciled (due to the fact that the claims are so closely connected that it is expedient to hear and determine them together), this court has jurisdiction over all defendants and can rule on acts of infringement that have been committed or are threatened "on the territory of any Member State"; in other words, for the entire EU.

The German court thus has jurisdiction to order all measures sanctioning the acts of infringement committed by the French and German companies.

To sanction the infringement of a Community design, the Community Design Regulation (CDR) provides, on the one hand, for measures prohibiting infringing acts and seizure but refers, on the

other hand, to “national law” for all other related measures. The question thus arises as to which national law applies to these related measures when a defendant infringes a Community design at different places in the European Union.

The Court answered that, under these circumstances, Article 8.2 of Regulation No 864/2007 (“Rome II”) should be applied and therefore that the applicable law, for any question not governed by the CDR, is that of the country in which the act of infringement was committed.

To identify the country in which the act of infringement was committed, reference should not be made to each alleged act of infringement but rather it is necessary to carry out 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” (paras. 103 and 109). The court may also use “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” (para. 104).

When an operator offers allegedly infringing products for sale online, the place where the event giving rise to the damage occurs is “the place where the process of putting the offer for sale online by that operator on its website was activated” (para. 108).

The holding of this decision in relation to Community designs can certainly be extended by analogy to European trade marks. The Court itself emphasises the “similarity of the [relevant] provisions” in the CDR and the EUTMR (para 54).

This decision further contributes to ensuring uniform protection of unitary IP rights. This holds true both for the question of jurisdiction over all co-defendants and determination of the law applicable to measures related to a pan-European injunction.

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