



Reports of Cases

OPINION OF ADVOCATE GENERAL
BOT
delivered on 1 March 2017¹

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 designs² 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 matters³ is to be interpreted to the effect that decisions adopted by a national court in response to claims

¹ Original language: French.

² OJ 2002 L 3, p. 1.

³ OJ 2001 L 12, p. 1.

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 obligations⁴ 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.

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

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 OJ 1978 L 304, p. 36.

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?

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

- (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

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).

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

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.

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.

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>

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 identical²⁵ 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.

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'.

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.

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.

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.

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.

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 citations³⁵ 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.

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).

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,

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).

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.