



Reports of Cases

JUDGMENT OF THE COURT (Fourth Chamber)

16 July 2015*

(Reference for a preliminary ruling — Intellectual and industrial property — Directive 2004/48/EC — Article 8(3)(e) — Sale of counterfeit goods — Right to information in the context of proceedings for infringement of an intellectual property right — Legislation of a Member State which allows banking institutions to refuse a request for information relating to a bank account (banking secrecy))

In Case C-580/13,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Germany), made by decision of 17 October 2013, received at the Court on 18 November 2013, in the proceedings

Coty Germany GmbH

v

Stadtsparkasse Magdeburg,

THE COURT (Fourth Chamber),

composed of L. Bay Larsen, President of the Chamber, K. Jürimäe, J. Malenovský (Rapporteur), M. Safjan and A. Prechal, Judges,

Advocate General: P. Cruz Villalón,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- Coty Germany GmbH, by M. Fiebig, Rechtsanwalt,
- the Stadtsparkasse Magdeburg, by N. Gross, Rechtsanwalt,
- the German Government, by T. Henze and J. Kemper, acting as Agents,
- the European Commission, by F. Bulst and F. Wilman, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 16 April 2015,

gives the following

* Language of the case: German.

Judgment

- 1 This request for a preliminary ruling concerns the interpretation of Article 8(3)(e) of 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).
- 2 The request has been made in proceedings between Coty Germany GmbH ('Coty Germany'), a company which owns intellectual property rights, and a banking institution, the Stadtsparkasse Magdeburg ('the Stadtsparkasse'), concerning the refusal of the Stadtsparkasse to provide Coty Germany with information relating to a bank account.

Legal context

EU law

- 3 Recitals 2, 10, 13, 15, 17 and 32 in the preamble to Directive 2004/48 are worded as follows:
 - '(2) The protection of intellectual property should allow the inventor or creator to derive a legitimate profit from his/her invention or creation. It should also allow the widest possible dissemination of works, ideas and new know-how. At the same time, it should not hamper freedom of expression, the free movement of information, or the protection of personal data, including on the Internet.
 - ...
 - (10) The objective of this Directive is to approximate legislative systems so as to ensure a high, equivalent and homogeneous level of protection in the internal market.
 - ...
 - (13) It is necessary to define the scope of this Directive as widely as possible in order to encompass all the intellectual property rights covered by Community provisions in this field and/or by the national law of the Member State concerned. ...
 - ...
 - (15) This Directive should not affect substantive law on intellectual property, Directive 95/46/EC of 24 October 1995 of the European Parliament and of the Council on the protection of individuals with regard to the processing of personal data and on the free movement of such data [(OJ 1995 L 281, p. 31)], Directive 1999/93/EC of the European Parliament and of the Council of 13 December 1999 on a Community framework for electronic signatures [(OJ 2000, L 13, p. 12)] and Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market [(OJ 2000 L 178, p. 1)].
 - ...
 - (17) The measures, procedures and remedies provided for in this Directive should be determined in each case in such a manner as to take due account of the specific characteristics of that case, including the specific features of each intellectual property right and, where appropriate, the intentional or unintentional character of the infringement.
 - ...

(32) This Directive respects the fundamental rights and observes the principles recognised in particular by the Charter of Fundamental Rights of the European Union [“the Charter”]. In particular, this Directive seeks to ensure full respect for intellectual property, in accordance with Article 17(2) of [the] Charter.’

4 Under Article 2(3)(a) of Directive 2004/48:

‘This Directive shall not affect:

(a) the Community provisions governing the substantive law on intellectual property, Directive 95/46/EC, Directive 1999/93/EC or Directive 2000/31/EC, in general, and Articles 12 to 15 of Directive 2000/31/EC in particular.’

5 Article 8 of Directive 2004/48, which is entitled ‘Right of information’, states:

‘1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person who:

- (a) was found in possession of the infringing goods on a commercial scale;
- (b) was found to be using the infringing services on a commercial scale;
- (c) was found to be providing on a commercial scale services used in infringing activities;

or

(d) was indicated by a person referred to in point (a), (b) or (c) as being involved in the production, manufacture or distribution of the goods or the provision of the services.

2. The information referred to in paragraph 1 shall, as appropriate, comprise:

- (a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers;
- (b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

3. Paragraphs 1 and 2 shall apply without prejudice to other statutory provisions which:

- (a) grant the right holder rights to receive fuller information;
- (b) govern the use in civil or criminal proceedings of the information communicated pursuant to this Article;
- (c) govern responsibility for misuse of the right of information;

or

(d) afford an opportunity for refusing to provide information which would force the person referred to in paragraph 1 to admit to his/her own participation or that of his/her close relatives in an infringement of an intellectual property right;

or

(e) govern the protection of confidentiality of information sources or the processing of personal data.’

6 Directive 95/46/EC provides in Article 2, entitled ‘Definitions’:

‘For the purpose of this Directive:

(a) “personal data” shall mean any information relating to an identified or identifiable natural person (“data subject”); an identifiable person is one who can be identified, directly or indirectly, in particular by reference to an identification number or to one or more factors specific to his physical, physiological, mental, economic, cultural or social identity;

(b) “processing of personal data” (“processing”) shall mean any operation or set of operations which is performed upon personal data, whether or not by automatic means, such as collection, recording, organisation, storage, adaptation or alteration, retrieval, consultation, use, disclosure by transmission, dissemination or otherwise making available, alignment or combination, blocking, erasure or destruction;

...’

German law

7 The Law on Trade Marks (Markengesetz) of 25 October 1994 (BGBl. 1994 I, p. 3082), as amended by the Law of 19 October 2013 (BGBl. 2013 I, p. 3830, ‘the Markengesetz’), provides in Paragraph 19, entitled ‘Right to information’:

‘1. The proprietor of a trade mark or a trade name may, in the cases referred to in Paragraphs 14, 15 and 17, require the infringer to provide immediately information on the origin and distribution networks of the goods or services identified as being illicit.

2. In the case of an obvious infringement or in cases where the proprietor of a trade mark or a trade name has brought an action against the infringer, the right shall also stand (notwithstanding subparagraph 1) against a person who, on a commercial scale,

(1) was in possession of the infringing goods;

(2) used the infringing services;

(3) provided services used in the infringing activities, or

(4) was indicated by the person referred to in points 1, 2 or 3 as being involved in the production, manufacture or distribution of those goods or in the provision of those services,

unless that person is permitted to refuse to give evidence in proceedings against the infringer under Paragraphs 383 to 385 of the Civil Procedure Code (Zivilprozessordnung). In the event that the right to information under the first sentence is asserted, the court may, on request, stay proceedings against the infringer until resolution of the dispute for the right to information. The person required to provide information may demand, from the person harmed, compensation for the necessary costs incurred in providing that information.’

- 8 Paragraph 383 of the Civil Procedure Code, in the version published on 5 December 2005 (BGBl. 2005 I, p. 3202), entitled ‘Refusal to give evidence on personal grounds’, provides, in subparagraph 1:

‘The following persons are entitled to refuse to give evidence:

...

6. persons who, as a result of their office, position or trade, have been entrusted with facts which, owing to their nature or in accordance with a legal provision, must be kept secret, the right to refuse to give evidence concerning facts to which the obligation of secrecy relates.’

The dispute in the main proceedings and the question referred

- 9 Coty Germany produces and distributes perfumes and holds an exclusive licence for the Community trade mark Davidoff Hot Water, registered under number 968661, for perfumery.
- 10 In January 2011, Coty Germany purchased a bottle of perfume bearing the trade mark Davidoff Hot Water on an Internet auction platform. It paid the sum corresponding to the price of that product into the bank account opened with the Stadtparkasse which had been supplied to it by the seller.
- 11 After finding that it had purchased a counterfeit product, Coty Germany asked that auction platform to provide it with the real name of the holder of the account of that platform from which the perfume had been sold to it (the sale having been made under an alias). The person named admitted to being the holder of that account, but denied being the seller of the product concerned and, relying on her right not to give evidence, refused to provide further information.
- 12 Coty Germany contacted the Stadtparkasse to ask it, on the basis of Paragraph 19(2) of the Markengesetz, for the name and address of the holder of the bank account into which it had paid the amount corresponding to the price of the counterfeit goods purchased. The Stadtparkasse, invoking banking secrecy, refused to provide Coty Germany with that information.
- 13 Coty Germany brought an action before the Landgericht Magdeburg (Regional Court, Magdeburg), which ordered the Stadtparkasse to provide the information requested.
- 14 The Oberlandesgericht Naumburg (Higher Regional Court, Naumburg), the appeal court seised by the Stadtparkasse, quashed the judgment at first instance, holding that the request to be provided with the information concerned was not justified under point 3 of the first sentence of Paragraph 19(2) of the Markengesetz.
- 15 The Oberlandesgericht Naumburg took the view that although the services provided by the Stadtparkasse — in the case before the referring court, the holding of a current account — had been used to carry out the infringing activity, the Stadtparkasse, as a banking institution, was entitled, under the first sentence of Paragraph 19(2) of the Markengesetz, in conjunction with Paragraph 383(1) of the Civil Procedure Code, to refuse to give evidence in civil proceedings.
- 16 That court held that that conclusion was not invalidated by the interpretation which must be made of those provisions in the light of Directive 2004/48.

- 17 Coty Germany brought an appeal on a point of law before the Bundesgerichtshof (Federal Court of Justice) maintaining its claims. Entertaining doubts as the interpretation to be made of Directive 2004/48, in particular of Article 8 thereof, the Bundesgerichtshof decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

‘Must Article 8(3)(e) of Directive 2004/48 be interpreted as precluding a national provision which, in a case such as that in the main proceedings, allows a banking institution to refuse, by invoking banking secrecy, to provide information pursuant to Article 8(1)(c) of that directive concerning the name and address of an account holder?’

Admissibility

- 18 The Stadtparkasse argues that the request for a preliminary ruling is inadmissible, maintaining that the dispute before the referring court is governed not by Directive 2004/48, but by national law alone, since the request for information at issue in the main proceedings does not relate to proceedings concerning an infringement of an intellectual property right but rather to a case of obvious infringement of rights attached to a Community trade mark. In its view, such a case does not fall within Directive 2004/48.
- 19 In that regard, as stated by the Advocate General in point 20 of his Opinion, a request for information made in the context of proceedings relating to an obvious infringement of rights attached to a trade mark falls within the scope of Article 8(1) of Directive 2004/48.
- 20 That conclusion is borne out by recital 13 in the preamble to Directive 2004/48, which states that it is necessary to define the scope of the directive as widely as possible in order to encompass all the intellectual property rights covered by Community provisions in this field and/or by the national law of the Member State concerned. Therefore it is appropriate to consider that that directive also applies to proceedings concerning an infringement of rights attached to a Community trade mark.
- 21 The request for a preliminary ruling must therefore be regarded as admissible.

Consideration of the question referred

- 22 By its question, the referring court asks, in essence, whether Article 8(3)(e) of Directive 2004/48 must be interpreted as precluding a provision which, in a situation such as that at issue in the main proceedings, allows a banking institution to invoke banking secrecy in order to refuse to provide, pursuant to Article 8(1)(c) of that directive, information concerning the name and address of an account holder.
- 23 In the first place, it can be seen from the wording of Article 8(1)(c) of Directive 2004/48 that the Member States are to ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by any person who was found to be providing on a commercial scale services used in the infringing activities.
- 24 That provision must be read in the light of recital 17 in the preamble to Directive 2004/48, which states that the measures, procedures and remedies provided for in that directive should be determined in each case in such a manner as to take due account of the specific features of each intellectual property right and, where appropriate, the intentional or unintentional character of the infringement.

- 25 In the second place, it follows from Article 8(3)(e) of Directive 2004/48 that Article 8(1) thereof applies without prejudice to other statutory provisions which govern the protection of confidentiality of information sources or the processing of personal data.
- 26 It is common ground that a banking institution, such as that at issue in the main proceedings, is capable of falling within the scope of Article 8(1)(c) of Directive 2004/48. It is also common ground that the communication, by such a banking institution, of the name and address of one of its customers constitutes processing of personal data, as defined in Article 2(a) and (b) of Directive 95/46.
- 27 A national provision, such as that at issue in the main proceedings, which allows a banking institution to withhold the information requested in the context of civil proceedings by invoking banking secrecy, is therefore capable of falling within the scope of Article 8(3)(e) of Directive 2004/48.
- 28 Article 8(1)(c) of Directive 2004/48 and Article 8(3)(e) thereof, read together, require that various rights be complied with. First, the right to information and, second, the right to protection of personal data must be complied with.
- 29 The right to information which is intended to benefit the applicant in the context of proceedings concerning an infringement of his right to property thus seeks, in the field concerned, to apply and implement the fundamental right to an effective remedy guaranteed in Article 47 of the Charter, and thereby to ensure the effective exercise of the fundamental right to property, which includes the intellectual property right protected in Article 17(2) of the Charter. As noted by the Advocate General in point 31 of his Opinion, the first of those fundamental rights is a necessary instrument for the purpose of protecting the second.
- 30 The right to protection of personal data, granted to the persons referred to in Article 8(1) of Directive 2004/48, is part of the fundamental right of every person to the protection of personal data concerning him, as guaranteed by Article 8 of the Charter and by Directive 95/46.
- 31 As regards those rights, it is clear from recital 32 in the preamble to Directive 2004/48 that the directive respects the fundamental rights and observes the principles recognised by the Charter. In particular, that directive seeks to ensure full respect for intellectual property, in accordance with Article 17(2) of the Charter.
- 32 At the same time, as is clear from Article 2(3)(a) of Directive 2004/48 and from recitals 2 and 15 in the preamble thereto, the protection of intellectual property is not to hamper, inter alia, the protection of personal data, so that Directive 2004/48 cannot, in particular, affect Directive 95/46.
- 33 The present request for a preliminary ruling thus raises the question of the need to reconcile the requirements of the protection of different fundamental rights, namely the right to an effective remedy and the right to intellectual property, on the one hand, and the right to protection of personal data, on the other (see, to that effect, judgment in *Promusicae*, C-275/06, EU:C:2008:54, paragraph 65).
- 34 In that regard, it must be borne in mind, in the first place, that, according to the case-law of the Court, EU law requires that, when transposing directives, the Member States take care to rely on an interpretation of them which allows a fair balance to be struck between the various fundamental rights protected by the EU legal order. Subsequently, when implementing the measures transposing those directives, the authorities and courts of the Member States must not only interpret their national law in a manner consistent with those directives but also make sure that they do not rely on an interpretation of them which would be in conflict with those fundamental rights or with the other general principles of EU law (see judgment in *Promusicae*, C-275/06, EU:C:2008:54, paragraph 70).

- 35 In the second place, it should be noted that Article 52(1) of the Charter states, *inter alia*, that any limitation on the exercise of the rights and freedoms recognised must respect the essence of those rights and freedoms and that it is apparent from the case-law of the Court that a measure which results in serious infringement of a right protected by the Charter is to be regarded as not respecting the requirement that such a fair balance be struck between the fundamental rights which must be reconciled (see, as regards an injunction, judgments in *Scarlet Extended*, C-70/10, EU:C:2011:771, paragraphs 48 and 49, and *Sabam*, C-360/10, EU:C:2012:85, paragraphs 46 and 47).
- 36 In the present case, the national provision at issue in the main proceedings allows a banking institution to invoke banking secrecy in order to refuse to provide, pursuant to Article 8(1)(c) of Directive 2004/48, information concerning the name and address of an account holder. However, although it is true that Article 8(1) of that directive does not recognise an autonomous right to information which individuals may exercise directly against the infringer or the persons covered by Article 8(1)(a) to (d) of that directive, it nevertheless imposes on the Member States an obligation to ensure that that information can be obtained by means of measures of enquiry ordered by a court.
- 37 It appears that the provision of national law at issue in the main proceedings, taken in isolation, allows such an unlimited refusal, since its wording does not contain any condition or qualification, a matter which is, however, for the referring court to determine.
- 38 Accordingly, such a provision of national law, taken in isolation, is liable to frustrate the right to information recognised in Article 8(1) of Directive 2004/48 and is therefore, as follows from paragraph 29 of the present judgment, such as to infringe the fundamental right to an effective remedy and the fundamental right to intellectual property.
- 39 In that regard, that unlimited and unconditional authorisation to invoke banking secrecy is such as to prevent the procedures laid down by Directive 2004/48 and the measures taken by the competent national authorities, in particular when they seek to order the disclosure of necessary information under Article 8(1) of that directive, from taking due account of the specific characteristics of each intellectual property right and, where appropriate, the intentional or unintentional character of the infringement.
- 40 It follows that an authorisation of that kind is capable of seriously impairing, in the context of Article 8 of Directive 2004/48, the effective exercise of the fundamental right to intellectual property — to the benefit of the right of persons covered by Article 8(1) of Directive 2004/48 to the protection of personal data concerning them — as a result of the obligation, for a banking institution, to respect banking secrecy.
- 41 It follows from the foregoing that a national provision, such as that at issue in the main proceedings, taken in isolation, is such as to seriously infringe the fundamental right to an effective remedy and, ultimately, the fundamental right to intellectual property, enjoyed by the holders of those rights, and that it does not, therefore, comply with the requirement to ensure a fair balance between the various fundamental rights weighed up in Article 8 of Directive 2004/48.
- 42 It is, however, for the referring court to determine whether there are, in the national law concerned, any other means or other remedies which would allow the competent judicial authorities to order that the necessary information concerning the identity of persons who are covered by Article 8(1) of Directive 2004/48 be provided, in view of the specific circumstances of each case, in accordance with recital 17 in the preamble to that directive.

- 43 It follows from all the foregoing that the answer to the question referred is that Article 8(3)(e) of Directive 2004/48 must be interpreted as precluding a national provision, such as that at issue in the main proceedings, which allows, in an unlimited and unconditional manner, a banking institution to invoke banking secrecy in order to refuse to provide, pursuant to Article 8(1)(c) of that directive, information concerning the name and address of an account holder.

Costs

- 44 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 (Fourth Chamber) hereby rules:

Article 8(3)(e) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights must be interpreted as precluding a national provision, such as that at issue in the main proceedings, which allows, in an unlimited and unconditional manner, a banking institution to invoke banking secrecy in order to refuse to provide, pursuant to Article 8(1)(c) of that directive, information concerning the name and address of an account holder.

[Signatures]