Reports of Cases

OPINION OF ADVOCATE GENERAL
CRUZ VILLALÓN
delivered on 16 February 2012 [1]

Case C-523/10

Wintersteiger AG
v
Products 4U Sondermaschinenbau GmbH

(Reference for a preliminary ruling from the Oberster Gerichtshof (Austria))

(Judicial cooperation in civil matters — Jurisdiction — Regulation (EC) No 44/2001– Infringement of a trade mark as a result of the registration by a competitor of a sign identical to the trade mark with an internet search services provider — Registration of an AdWord — National protection of the trade mark in a Member State other than the one in which the AdWord is registered — Determination of the place where the harmful event occurred or may occur)

1. The Oberster Gerichtshof (Austrian Supreme Court) has referred to the Court of Justice for a preliminary ruling two questions concerning the determination of the international jurisdiction of the Austrian courts in the case of an alleged infringement of an Austrian trade mark committed via the internet. In particular, the alleged infringement claimed by the applicant, which is the proprietor of an Austrian trade mark, was committed in Germany, since the defendant, a competitor established in that country, registered the applicant's name, 'Wintersteiger', as an AdWord on the search service provided by Google on its top-level domain for Germany.

2. The present case provides the Court with the opportunity to resolve a question concerning both the interpretation of Article 5(3) of Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, [2] which establishes jurisdiction for hearing claims for damages arising from non-contractual liability, and intellectual property law. In short, it is necessary to strike a balance between the difficulties raised by the national territorial nature of a trade mark and the potentially ubiquitous nature of an infringement committed in another Member State via the internet.

I – Legal framework

3. Article 5(3) of Regulation (EC) No 44/2001 provides that a person domiciled in a Member State may be sued in another Member State 'in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur'.

1 — Original language: Spanish.
2 — OJ 2001 L 12, p. 1.

II – The facts, the proceedings before the national court and the questions referred for a preliminary ruling

4. Wintersteiger AG is an undertaking which manufactures and distributes worldwide ski and snowboard servicing tools, together with replacement parts and accessories. The undertaking is established in Austria, where it has been the proprietor of the Austrian trade mark 'Wintersteiger' since 1993. Although the referring court states that the trade mark is registered only in Austria, the undertaking has indicated in its written observations that the trade mark is also protected in other States, including Germany.

5. Products 4U Sondermaschinenbau GmbH ('Products 4U') is an undertaking established in Germany, where it develops and distributes worldwide ski and snowboard servicing tools. It sells, inter alia, other products, accessories for the tools manufactured by Wintersteiger. It is clear from the case-file that Wintersteiger neither supplies its products to, nor authorises the sale of, its products by Products 4U. Nevertheless, on 1 December 2008, the German undertaking registered the AdWord 'Wintersteiger' on the search service provided by Google, although it limited the registration to searches carried out via the top-level domain for Germany ('.de').

6. According to the referring court, registration of that AdWord means that each time the word 'Wintersteiger' is entered into the Google search engine for the '.de' top-level domain, an advertising link with the heading 'Advertisement' appears on the right-hand side of the page in addition to a link to Wintersteiger's website. The text of the advertisement includes expressions such as the following: 'ski workshop accessories', 'ski and snowboard tools', and 'maintenance and repair'. Clicking on the advertising link directs the user to a section of the Products 4U website entitled 'Wintersteiger Accessories'.

7. As the referring court has pointed out, although Google operates an Austrian top-level domain ('.at'), the internet site www.google.de may be accessed in Austria.

8. Wintersteiger brought an action for an injunction in the Austrian courts, together with an application for protective measures, requiring Products 4U to desist from using the trade mark 'Wintersteiger' as an AdWord on the google.de search engine. At first instance, the applicant's application was ruled inadmissible on the grounds of lack of international jurisdiction because the court took the view that, since the AdWord concerned was limited to google.de, there was not a sufficient connection with Austrian territory. The Oberlandesgericht Linz rejected that finding on appeal and held that the Austrian courts did have jurisdiction, although it dismissed the action as to the substance. An appeal was brought against the judgment of the appellate court before the Oberster Gerichtshof which, in the light of the facts, harbours doubts as to whether it has jurisdiction and has therefore referred the following questions to the Court of Justice for a preliminary ruling:

'(1) In the case of an alleged infringement by a person established in another Member State of a trade mark granted in the State of the court seised through the use of a keyword (AdWord) identical to that trade mark in an internet search engine which offers its services under various country-specific top-level domains, is the phrase "place where the harmful event occurred or may occur" in Article 5(3) of Regulation (EC) No 44/2001 ("the Brussels I Regulation") to be interpreted as meaning that:

(1.1) jurisdiction is established only if the keyword is used on the search engine website the top-level domain of which is that of the State of the court seised;

(1.2) jurisdiction is established only if the search engine website on which the keyword is used can be accessed in the State of the court seised;

(1.3) jurisdiction is dependent on the satisfaction of other requirements additional to the accessibility of the website?

(2) If Question 1.3 is answered in the affirmative:

Which criteria are to be used to determine whether jurisdiction under Article 5(3) of the Brussels I Regulation is established where a trade mark granted in the State of the court seised is used as an AdWord on a search engine website with a country-specific top-level domain different from that of the State of the court seised?'

9. Written observations were lodged by the applicant and the defendant in the main proceedings, the Austrian, Spanish, United Kingdom and Italian Governments and the Commission.

III – Analysis of the questions referred for a preliminary ruling

A – *Preliminary remarks*

10. First of all, it is necessary to address a number of points which will have a bearing on the analysis of the substance of the reference for a preliminary ruling.

11. As I have already stated, the Oberster Gerichtshof harbours doubts concerning the interpretation of Article 5(3) of Regulation No 44/2001 in connection with proceedings for an injunction to prohibit conduct on the internet which allegedly infringes a national trade mark. In that regard, the referring court has submitted two questions to the Court of Justice, the first of which is in turn framed as three sub-questions, each reflecting the different possible interpretations of the provision concerned. However, instead of analysing and proposing a reply to each of those questions, it is my view that the Court would provide a perfectly helpful response by merely setting out the criteria which, as appropriate, may justify the international jurisdiction of a national court in a case of this kind. Accordingly, I shall deal with the case at issue by reformulating the questions as a single question.

12. Next, it is also appropriate to note that the applicant in the main proceedings, Wintersteiger, sought at first instance a ruling on the substance in addition to the adoption of a protective measure. The referring court makes reference to that fact on a number of occasions, although its questions relate exclusively to the interpretation of Article 5(3) of Regulation No 44/2001.

13. It is common knowledge that the adoption of protective measures in a transnational European Union context requires the application of Article 31 of the regulation and gives rise to specific problems. However, despite the fact that that matter appears to have been addressed by the different courts seised of the main proceedings, the question referred in these preliminary-ruling proceedings is confined exclusively to the proceedings for an injunction and, consequently, to the interpretation of Article 5(3). Accordingly, in this Opinion, I shall confine myself strictly to the subject of the question, leaving aside the difficulty of the protective measure which appears to underlie the main proceedings. [3]

14. Finally, it is also appropriate to clarify a point which is liable to alter the approach required for the purposes of disposing of the case. The referring court states that the applicant is the proprietor of an Austrian trade mark and it is apparent from the order for reference that that is the only intellectual property right currently protecting the 'Wintersteiger' mark. The applicant's written observations openly dispute that description of the facts and state that the applicant is the proprietor of 'a number of international trade marks including the word element "Wintersteiger"'. In that connection, the applicant refers to 'international trade marks 615.770 WINTERSTEIGER (WB) and 992.008 WINTERSTEIGER (WB), which are protected in a number of countries, including Germany.'

3 — Shortly before delivering this Opinion I considered the interpretation of Article 31 of Regulation No 44/2001 in *Solvay* (C-616/10), a case concerning intellectual property rights.

15. Although, if it is confirmed, that fact would alter the scope of the main proceedings, it cannot be ignored that the referring court has asked exclusively about the interpretation of Article 5(3) of Regulation No 44/2001 in a context in which there is only one trade mark, which is registered in Austria. The examination of other situations would entail consideration of a subject on which none of the parties, with the exception of the applicant, have expressed a view. Therefore, I shall confine myself below to providing a reply to the question which has actually been submitted by the referring court.

B – *The interpretation of Article 5(3) of Regulation No 44/2001*

1. The place where the harmful event occurred within the meaning of Article 5(3), applied to conduct liable to infringe a national trade mark via the internet

16. In this case, the problematic point of interpretation is the determination of *the place or places where the damage occurred or may have occurred* for the purposes of Article 5(3) in a situation in which the activity allegedly infringing a national trade mark was carried out via the medium of the internet.

17. First of all, it should be recalled that, since the judgment in *Mines de potasse*, where there is one event but the place of origin of the damage and the place of its outcome are different, the Court has interpreted Article 5(3) of Regulation No 44/2001 as establishing the jurisdiction of two separate courts: the courts for the place where the damage actually occurred and the courts for the place of the event giving rise to that damage, and it is for the claimant to choose the court which best suits his interests.[4] That approach guarantees the practical effect of the rule laid down in Article 5(3) while at the same time allowing the victim of the damage a certain amount of decision-making discretion which, in addition, ensures the proximity of the court seised to the relevant facts of the dispute. The fundamental question to examine in this case is, in short, whether that case-law applies when the event giving rise to the alleged damage occurs via the internet. However, in that connection, a number of additional points must also be taken into account.

18. There are a number of exceptions to the rule laid down in *Mines de potasse*, in particular where the same victim suffers damage in more than one State. That occurs when there is an infringement of personality rights. For those cases, in its judgment in *Shevill* the Court restricted the scope of the jurisdiction of the competent court.[5] In that judgment, the Court laid down the so-called 'mosaic rule', according to which a claimant may bring a claim either in the courts of the State where the damage originated, in respect of the whole of the damage suffered, or in the courts of the States where the damage actually occurred, but only in respect of the damage suffered on the territory of the States concerned.

19. The approach taken in *Shevill* was recently adapted to the specific features of the internet. In *eDate Advertising*,[6] the Court held that where personality rights are infringed on the internet the infringement has a number of particularly serious features resulting from the geographical impact of the harmful information. Accordingly, the connecting criteria laid down in *Shevill* were extended, although that extension was limited to cases involving an infringement of personality rights. In addition to the criteria set out in the previous point, according to the *eDate Advertising* case-law, an alleged victim may bring a claim in respect of the whole of the damage suffered before the courts of the State where he has his 'centre of interests'.

4 — Case 21/76 *Bier* [1976] ECR 1735, paragraphs 24 and 25; Case C-167/00 *Henkel* [2002] ECR I-8111, paragraph 44; Case C-18/02 *DFDS Torline* [2004] ECR I-1417, paragraph 40; and Case C-189/08 *Zuid-Chemie* [2009] ECR I-6917, paragraph 24.

5 — Case C-68/93 *Shevill* [1995] ECR I-415.

6 — Joined Cases C-509/09 and C-161/10 *eDate Advertising* [2011] ECR I-10269.

20. The approach in *Shevill* and *eDate Advertising* is not applicable to the case at issue. Both those judgments concern infringements of personality rights, which differ significantly from intellectual property rights which are protected on a territorial basis and are concerned with the commercial exploitation of a product.[7] Therefore, the connecting criteria laid down in Article 5(3) cannot be applied without distinction to situations of the kind in the aforementioned cases and the one in this case and instead the interpretation of the article must be adapted to the particular characteristics of intellectual property law.

21. Against that background, the starting point must be that, where there is conduct liable to infringe a national trade mark, Regulation No 44/2001 provides that, as a general rule, a claimant may bring proceedings in the courts for the defendant's domicile, in accordance with the general forum provided for in Article 2, or in the courts for the place where the harmful event occurred or may occur, in accordance with Article 5(3). That rule is qualified when the damage is caused in one State but actually occurs in another, in which case the rule laid down in the *Mines de potasse* judgment applies. Thus, where an Austrian national trade mark has been infringed as a result of counterfeit goods produced in Germany and targeted at the Austrian market, in addition to the forum of the defendant's domicile there is nothing to preclude the proprietor of the trade mark from relying on Article 5(3) of Regulation No 44/2001 for the purposes of bringing proceedings in Germany (the place where the event giving rise to the damage occurred) or in Austria (the place where the damage actually occurred).[8]

22. That approach becomes problematic when the harmful conduct is carried out via the technical medium of the internet. In that case, it might be thought that the mere fact that the harmful information is accessible causes damage, thereby increasing the number of courts with jurisdiction in all the Member States. In addition, the person circulating the harmful information on the internet would be acting as the cause of the damage, thereby fragmenting the place of origin of the infringement.[9]

23. For those reasons, albeit in a context other than intellectual property law, the Court has consistently rejected the view that the mere fact that harmful information is accessible or is simply circulated on the internet is of sufficient importance to justify the application of the provisions on jurisdiction laid down in Regulation No 44/2001.[10]

24. Accordingly, it should be reiterated that, for the purposes of establishing the territory on which the damage occurred or may occur, where that damage is carried out via the internet Article 5(3) of Regulation No 44/2001 must be interpreted, in accordance with the *Mines de potasse* case-law, as meaning that it establishes the jurisdiction of the courts for the place where the event giving rise to the damage occurred, on the one hand, and the jurisdiction of the courts for the place where the damage actually occurred, on the other, in accordance with a number of specific criteria which I shall set out below.

25. As I have pointed out above, the place where the damage actually occurs will, always and in any event, be the State of registration of the trade mark, since damage can arise only in a place where there is legal protection. The presence of harmful information on the internet is not sufficient for the purposes of attributing jurisdiction to the courts of the State of registration. For that to be possible, I believe that it is necessary for the disputed information to be capable of occasioning an actual infringement of the trade mark.

7 — See, in that connection, Virgós Soriano, M., and Garcimartín Alférez, F.J., *Derecho Procesal Civil Internacional. Litigación Internacional*, 2nd ed., Thomson-Civitas, 2007, pp. 194 and 195, and Heinze, C., 'The CLIP Principles on Jurisdiction', in Basedow, J., Kono, T. and Metzger, A. (eds.), *Intellectual Property in the Global Arena. Jurisdiction, Applicable Law, and the Recognition of Judgments in Europe, Japan and the US*, MatIPR 49, Mohr Siebeck, Tubingen, 2010, pp. 68 and 69.

8 — On the question of whether extraterritorial conduct is liable to infringe a trade mark, albeit in a context other than jurisdiction, see Case C-324/09 *L'Oréal* [2011] ECR I-6011, paragraph 63.

9 — See Moura Vicente, D., *La propriété intellectuelle en droit international privé*, Martinus Nijhoff, Leiden-Boston, 2009, pp. 398 to 405.

10 — Joined Cases C-585/08 and C-144/09 *Pammer and Hotel Alpenhof* [2010] ECR I-12527. In addition, in *L'Oréal*, the Court held, in paragraph 64, that the mere fact that a website is accessible is not a relevant factor from a legal point of view, although it did so as part of the substantive analysis of the infringement of a trade mark and not as part of the determination of jurisdiction.

26. In addition, it is also possible under Article 5(3) of Regulation No 44/2001 to establish the jurisdiction of the courts of the State where the event giving rise to the damage occurred. In the specific context of intellectual property, I believe that that is the place where the means necessary to produce an actual infringement of a mark were used. That view does not take account of the intentions of the perpetrator or the victim's (proprietor's) centre of interests but rather of the use of those means when an actual infringement of a trade mark was caused in another Member State by means of the internet. Admittedly, in most cases that place will be the same as the defendant's domicile, but it should also be noted that situations may arise in which the defendant's domicile and the place of the event giving rise to the damage are not in the same State.

27. In order to determine both the place of the event giving rise to the damage and the place where the damage actually occurs, it is necessary to have regard to a number of criteria which will enable the place of both events to be determined accurately. As will be seen below, the criteria which I am going to set out may be used for determining both the place of the event giving rise to the damage and the place where the damage actually occurs, since they refer to factual matters applicable to both aspects of the event.

28. The fundamental factor or point is whether the information disseminated on the internet is really likely to have an effect in the territory where the trade mark is registered. [11] It is not sufficient if the content of the information leads to a risk of infringement of the trade mark and instead it must be established that there are objective elements which enable the identification of conduct which is in itself intended to have an extraterritorial dimension. For those purposes, a number of criteria may be useful, such as the language in which the information is expressed, the accessibility of the information, and whether the defendant has a commercial presence on the market on which the national mark is protected.

29. It is also necessary to establish the territorial scope of the market on which the defendant operates and from which the information was disseminated on the internet. [12] For that purpose, an assessment must be made of facts such as, inter alia, the top-level domain, the address or other location data supplied on the website, and the place where the person responsible for the information has the place of business for his internet activities.

30. As a result of that examination, the court will conclude whether the case before it involves the means necessary for producing, a priori, an actual infringement of a trade mark in another Member State via the internet. Thus, it will be possible to establish both the place of the event giving rise to the damage and the place where the damage actually occurred. That approach is consistent with the territorial nature of national trade marks, because at no point does it lose sight of the fact that the actual infringement occurred in a State where the trade mark concerned is protected. In addition, it enables the claimant to bring proceedings in States where there is a close connection between the harmful event and the court, without there being a fragmentation of jurisdiction which jeopardises the meaning of Regulation No 44/2001. In addition to the foregoing, it must be borne in mind that the solution is one which is adapted to the specific features of intellectual property while being consistent with the spirit underlying the Court's case-law to date.

31. Clearly, that analysis requires an assessment of the facts which is closely linked to the consideration of the substance of the case, but, obviously, the two spheres are different and they must not be confused. [13] The 'necessary means' criterion, which is limited to the stage in which jurisdiction is determined, does not take into account the infringement which has been committed and has taken

11 — In that regard, see, for example, *McBee* v *Delica Co.*, United States Court of Appeals, 1st Circuit, 417 F.3d 107 (2005) and the order of the Tribunal de grande instance de Paris of 16 May 2008 in *Rueducommerce* v *Carrefour Belgium*.

12 — See, for example, *Zippo Manufacturing Company* v *Zippo Dot Com, Inc.*, United States District Court, W.D. Pennsylvania, 952 F. Supp 1119, and the judgment of the French Cour de cassation of 11 January 2005 in *Société Hugo Boss* v *Société Reemstma Cigarettenfabriken GmbH*.

13 — See Case C-365/88 *Kongress Agentur Hagen* [1990] ECR I-1845, paragraph 12 et seq.

place and instead takes into account the *infringement potential* of particular conduct. That difference between the two spheres is perfectly clear in the present case: it should be recalled that the Austrian court which was seised of the first appeal in the case ruled that it had jurisdiction and then dismissed the action as to the substance.

2. The proposed criterion in the light of the facts of the present case

32. Having established the criterion for the interpretation of Article 5(3) of Regulation No 44/2001, and for the purposes of providing the referring court with a useful reply, I shall analyse the consequences of the proposal in the particular circumstances of the instant case.

33. Since the applicant in the main proceedings is the proprietor of the 'Wintersteiger' trade mark in Austria, the criteria set out above mean that Article 5(3) of Regulation No 44/2001 may be relied on to establish the jurisdiction of the Austrian courts. If it is found that the means necessary to produce an actual infringement of the trade mark were used, then competence will rest with both the courts for the place in which the event giving rise to the damage took place and also with the courts for the place where the damage actually occurred; in other words, the courts of the territory where the mark is protected, which in this case are the Austrian courts.

34. According to the case-file, Products 4U is an undertaking established in Germany which carries out its activities on a worldwide basis. However, its place of business is established in Germany and certain advertising activities are confined to that State, such as the registration of certain AdWords on Google. Registration of the AdWord 'Wintersteiger', applied for by the defendant, was limited to the search services offered by Google via a top-level, country-specific domain for Germany (.de).

35. It is clear that there is a potential for infringement of the Austrian trade mark.

36. As the Court observed in *Google France*, a reference for a preliminary ruling which, it should be recalled, concerned the substantive infringement of a trade mark rather than the question of jurisdiction, the function of a trade mark may be adversely affected 'when internet users are shown, on the basis of a keyword identical with a mark, a third party's ad, such as that of a competitor of the proprietor of that mark'.[14] The Court went on to state in *Google France* that whether there is an infringement will depend, nevertheless, on the manner in which the advertisement is presented. However, in any event, the function of indicating the origin of the mark is adversely affected 'if the ad 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, on the contrary, originate from a third party'.[15]

37. It should be pointed out that the case-law cited above concerns infringements which effectively occurred as a result of the registration of AdWords. However, in the case before the Court, which is concerned solely with the determination of jurisdiction, it is necessary to consider only the potential for infringement, as I have observed in point 31 of this Opinion. From that perspective, it is clear that the registration of an AdWord limited to the top-level domain '.de', which uses the German language and is accessible in Austria, a country bordering Germany, is liable to occasion, a priori, an actual infringement of the Austrian trade mark.

38. As the applicant observed in its written observations, the fact that the registration of the AdWord is intended to cover a geographical area limited to Germany does not preclude — or come close to precluding — customers of the Wintersteiger mark who are located in Austria from using the google.de. search engine either in Austria or in Germany. The fact that the applicant's market is

14 — Joined Cases C-236/08 to C-238/08 *Google France and Google* [2010] ECR I-2417, paragraph 83.

15 — *Google France and Google*, paragraphs 84 and 99, and point 1 of the operative part.

international and that its German competitor operates from a neighbouring country via a medium, like Google.de, which is freely accessible in Austria and which is in the same language, is a factor that is clearly indicative of the effect which, objectively, the defendant's conduct has on the 'Wintersteiger' mark in Austria.

39. In addition, the fact that the AdWord 'Wintersteiger' includes a link which takes the user directly to the defendant's website, without any reference to the fact that it is a national trade mark linked to an Austrian undertaking, is another factor which, objectively, is likely to contribute to the user, who may be accessing Google.de in Austria without any restriction, confusing the two companies which are competitors on the European Union internal market.

40. Accordingly, I believe that in the circumstances of the present case, the defendant used the necessary means which, objectively, were likely to occasion an actual infringement of the trade mark registered in Austria. Accordingly, it is appropriate to conclude that, for the purposes of Article 5(3) of Regulation No 44/2001, the place where the damage occurred is not only Germany, the place of the event giving rise to the damage, but also Austria, in so far as the defendant engaged in conduct liable, a priori, to infringe the Austrian trade mark.

IV – Conclusion

41. In view of the above, I propose that the Court state in answer to the questions referred by the Oberstersgerichtshof (Austria):

Where conduct occurs via the internet which is liable to infringe a national trade mark registered in a Member State, Article 5(3) of Regulation No 44/2001 must be interpreted as meaning that it attributes jurisdiction:

— to the courts of the Member State in which the trade mark is registered,

— and to the courts of the Member State where the means necessary to produce an actual infringement of a trade mark registered in another Member State are used.