Reports of Cases

JUDGMENT OF THE COURT (Fifth Chamber)

5 September 2019*

(Reference for a preliminary ruling — EU trade mark — Regulation (EC) No 207/2009 — Article 97(5) — Jurisdiction — Infringement proceedings — Jurisdiction of the courts of the Member State in which 'the act of infringement has been committed' — Advertising and offers for sale displayed on a website and on social media platforms)

In Case C-172/18,

REQUEST for a preliminary ruling under Article 267 TFEU from the Court of Appeal (England & Wales) (Civil Division), made by decision of 12 February 2018, received at the Court on 5 March 2018, in the proceedings

AMS Neve Ltd,

Barnett Waddingham Trustees,

Mark Crabtree

v

Heritage Audio SL,

Pedro Rodríguez Arribas,

THE COURT (Fifth Chamber),

composed of E. Regan, President of the Chamber, C. Lycourgos, E. Juhász, M. Ilešič (Rapporteur) and I. Jarukaitis, Judges,

Advocate General: M. Szpunar,

Registrar: L. Carrasco Marco, Administrator,

having regard to the written procedure and further to the hearing on 17 January 2019,

after considering the observations submitted on behalf of:

– AMS Neve Ltd, Barnett Waddingham Trustees and Mr Crabtree, by M. McGuirk and E. Cronan, Solicitors, and by J. Moss, Barrister,

– Heritage Audio SL and Mr Rodríguez Arribas, by A. Stone and R. Crozier, Solicitors, and by J. Reid, Barrister,

* Language of the case: English.

– the German Government, initially by T. Henze, M. Hellmann and J. Techert, and subsequently by M. Hellmann and J. Techert, acting as Agents,

– the European Commission, by J. Samnadda, É. Gippini Fournier and M. Wilderspin, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 28 March 2019,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 97(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1).

2 The request has been made in proceedings where the opposing parties are AMS Neve Ltd, Barnett Waddingham Trustees ('BW Trustees') and Mr Mark Crabtree, on the one hand, and Heritage Audio SL and Mr Pedro Rodríguez Arribas, on the other, concerning an infringement claim arising from the alleged wrongful use of rights conferred by, inter alia, an EU trade mark.

Legal context

3 Regulation (EC) No 207/2009, which had repealed and replaced Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. It was subsequently repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1). However, given the date when the action claiming the infringement at issue in the main proceedings was brought, this reference for a preliminary ruling shall be examined having regard to Regulation No 207/2009, in its initial version.

4 Recital 17 of Regulation No 207/2009 states:

'Contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of a [European Union] trade mark and parallel national trade marks. …'

5 Article 9(1) and (2) of that regulation provided:

'1. The [European Union] trade mark shall confer on the proprietor exclusive rights therein: The proprietor shall be entitled to prevent all third parties not having his/her consent from using in the course of trade:

(a) any sign which is identical with the [European Union] trade mark in relation to goods or services which are identical with those for which the [European Union] trade mark is registered;

(b) any sign where, because of its identity with, or similarity to, the [European Union] trade mark and the identity or similarity of the goods or services covered by the [European Union] trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

…

2. The following, inter alia, may be prohibited under paragraph 1:

…

(b) offering the goods, putting them on the market … under that sign …;

…

(d) using the sign … in advertising.'

6 Article 94 of Regulation No 207/2009 stated:

'1. Unless otherwise specified in this Regulation, [Council] Regulation (EC) No 44/2001 [of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1)] shall apply to proceedings relating to [European Union] trade marks and applications for [European Union] trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of [European Union] trade marks and national trade marks.

2. In the case of proceedings in respect of the actions and claims referred to in Article 96:

(a) Articles 2 and 4, points 1, 3, 4 and 5 of Article 5, and Article 31 of Regulation (EC) No 44/2001 shall not apply;

…'

7 Article 95(1) of that regulation provided:

'The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as "[European Union] trade mark courts", which shall perform the functions assigned to them by this Regulation.'

8 Article 96 of that regulation provided:

'The [European Union] trade mark courts shall have exclusive jurisdiction:

(a) for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to [European Union] trade marks;

…'.

9 Article 97 of that Regulation stated:

'1. Subject to the provisions of this Regulation as well as to any provisions of Regulation (EC) No 44/2001 applicable by virtue of Article 94, proceedings in respect of the actions and claims referred to in Article 96 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

…

5. Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of [a European Union] trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened …'

10 Article 98 of Regulation No 207/2009 provided:

'1. A [European Union] trade mark court whose jurisdiction is based on Article 97(1) to (4) shall have jurisdiction in respect of:

(a) acts of infringement committed or threatened within the territory of any of the Member States;

…

2. A [European Union] trade mark court whose jurisdiction is based on Article 97(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.'

11 Article 109(1) of Regulation No 207/2009 provided:

'Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of a [European Union] trade mark and the other seized on the basis of a national trade mark:

(a) the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested;

(b) the court other than the court first seized may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.'

12 The wording of Articles 9, 94 to 98 and 109 of Regulation No 207/2009 was, essentially, reproduced in Articles 9, 122 to 126 and 136 of Regulation 2017/1001. Article 125(5) of Regulation 2017/1001 corresponds to Article 97(5) of Regulation No 207/2009 and to Article 93(5) of Regulation No 40/94.

13 Regulation No 44/2001, to which reference is made in Articles 94 and 97 of Regulation No 207/2009, was replaced by Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1). Under Article 66(1) of the latter regulation, it 'shall apply only to legal proceedings instituted, to authentic instruments formally drawn up or registered and to court settlements approved or concluded on or after 10 January 2015'.

The dispute in the main proceedings and the question referred for a preliminary ruling

14 AMS Neve is a company established in the United Kingdom which manufactures and sells audio equipment. BW Trustees, also established in the United Kingdom, is the trustee of the AMS Neve executive pension scheme. Mr Crabtree is a director of AMS Neve.

15 Heritage Audio is a company established in Spain which sells and supplies audio equipment. Mr Rodríguez Arribas, who is domiciled in Spain, is the sole director of Heritage Audio.

16 On 15 October 2015 AMS Neve, BW Trustees and Mr Crabtree brought an action against Heritage Audio and Mr Rodríguez Arribas before the Intellectual Property and Enterprise Court (United Kingdom) claiming infringement of an EU trade mark of which BW Trustees and Mr Crabtree are the proprietors and for the use of which AMS Neve is exclusively licensed.

17 Their action concerns, in addition, the alleged infringement of two marks registered in the United Kingdom of which BW Trustees and Mr Crabtree are also the proprietors.

18 The EU trade mark relied on consists of the figure 1073 and was registered for goods within Class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The description of the goods covered is in part as follows: 'sound studio recording, mixing and processing equipment'.

19 The defendants in the main proceedings are alleged to have offered for sale to consumers in the United Kingdom imitations of goods of AMS Neve bearing a sign that is identical or similar to that EU trade mark and to the national trade marks or referring to that sign, and to have advertised those products.

20 The applicants in the main proceedings have submitted documents in support of their action, including the contents of the Heritage Audio website and the latter's Facebook and Twitter accounts, an invoice issued by Heritage Audio to an individual residing in the United Kingdom and correspondence between Heritage Audio and a person established in the United Kingdom concerning possible deliveries of audio equipment.

21 The applicants in the main proceedings have in particular submitted screenshots from that website on which they claim appeared offers to sell audio equipment bearing a sign identical or similar to that EU trade mark. They have stressed that the offers for sale are worded in English and that a section headed 'where to buy' lists distributors established in various countries, including the United Kingdom. Further, they claim that it is apparent from the general sale conditions that Heritage Audio accepts orders from any EU Member State.

22 The defendants in the main proceedings pleaded that the court before which the action was brought had no jurisdiction.

23 While the defendants do not deny that Heritage Audio products might have been purchased, in the United Kingdom, through other companies, they assert that they have not, themselves, either advertised in the United Kingdom or made any sales in that Member State. They further assert that they have never appointed a distributor for the United Kingdom. Last, they contend that the content displayed on the Heritage Audio website and on the platforms to which the applicants in the main proceedings refer was, by the time of the period covered by the infringement action, obsolete and ought not therefore to be taken into account.

24 By judgment of 18 October 2016, the Intellectual Property and Enterprise Court held that it had no jurisdiction to hear the infringement action in so far as that action is based on the EU trade mark at issue.

25 That court states that the applicants in the main proceedings submitted evidence capable of proving that the Heritage Audio website was directed to, inter alia, the United Kingdom. That court considers, further, that the facts of the dispute before it enable it to find that Mr Rodríguez Arribas is jointly liable for the acts of Heritage Audio and that the courts of the United Kingdom have jurisdiction to hear the case in so far as that dispute concerns the protection of national intellectual property rights.

26 The Intellectual Property and Enterprise Court considers, on the other hand, that that dispute, in so far as it concerns infringement of the EU trade mark, is subject, in accordance with Article 97(1) of Regulation No 207/2009, to the jurisdiction of the courts of the Member State in whose territory the

defendant is domiciled, in this case the Kingdom of Spain. The Intellectual Property and Enterprise Court adds that the jurisdiction of the Spanish courts also stems from Article 97(5) of that regulation, under which infringement actions may also be brought before the courts of the Member State in whose territory the act of infringement has been committed.

27 As regards the latter provision, the Intellectual Property and Enterprise Court considers that the court which has territorial jurisdiction to hear an action brought by the proprietor of a mark against a third party that has used signs identical or similar to that mark in advertising and offers for sale on a website or on social media platforms is the court with jurisdiction over the place where the third party decided to place that advertising or to offer for sale products on that site or on those platforms and took steps to give effect to that decision.

28 The applicants in the main proceedings brought an appeal against that judgment before the Court of Appeal (England & Wales) (Civil Division).

29 The referring court considers that the court of first instance, while referring in its judgment to certain judgments of the Court, such as those of 19 April 2012, *Wintersteiger* (C-523/10, EU:C:2012:220), and of 5 June 2014, *Coty Germany* (C-360/12, EU:C:2014:1318), misinterpreted those judgments and the case-law of the Court in general.

30 The referring court is of the opinion that such an interpretation would lead, in essence, to a finding that 'the Member State in which the act of infringement has been committed', within the meaning of Article 97(5) of Regulation No 207/2009, is the Member State in which the defendant set up its website and its social media accounts. According to the referring court, it follows, however, from the wording, purpose and context of that provision that the territory of the Member State subject to that provision is that in which the consumers or traders to whom the advertising and offers for sale are directed are resident.

31 The referring court adds that the Bundesgerichtshof (Federal Court of Justice, Germany), in its 'Parfummarken' judgment of 9 November 2017 (I ZR 164/16), held that the interpretation of the wording 'law of the country in which the act of infringement was committed', in Article 8(2) of Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II) (OJ 2007 L 199, p. 40), adopted in the judgment of 27 September 2017, *Nintendo* (C-24/16 and C-25/16, EU:C:2017:724), can be transposed to Article 97(5) of Regulation No 207/2009. However, the referring court has some doubts with regard to that finding of the Bundesgerichtshof.

32 In those circumstances, the Court of Appeal (England & Wales) (Civil Division) decided to stay proceedings and to refer to the Court the following question for a preliminary ruling, adding in its decision that that question concerns the interpretation of Article 97(5) of Regulation No 207/2009:

'In circumstances where an undertaking is established and domiciled in Member State A and has taken steps in that territory to advertise and offer for sale goods under a sign identical to an EU trade mark on a website targeted at traders and consumers in Member State B:

(i) does an EU trade mark court in Member State B have jurisdiction to hear a claim for infringement of the EU trade mark in respect of the advertisement and offer for sale of the goods in that territory?

(ii) if not, which other criteria are to be taken into account by that EU trade mark court in determining whether it has jurisdiction to hear that claim?

(iii) in so far as the answer to (ii) requires that EU trade mark court to identify whether the undertaking has taken active steps in Member State B, which criteria are to be taken into account in determining whether the undertaking has taken such active steps?'

Consideration of the question referred

33 By its question, the referring court seeks, in essence, to ascertain whether Article 97(5) of Regulation No 207/2009 must be interpreted as meaning that the proprietor of an EU trade mark who considers that his rights are infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before an EU trade mark court of the Member State in which consumers and traders targeted by that advertising and by those offers for sale are located, notwithstanding the fact that the third party made decisions and took steps in another Member State to bring about that electronic display.

34 It must, first, be recalled that, notwithstanding the principle that Regulation No 44/2001 — and, as from 10 January 2015, Regulation No 1215/2012 — applies to court proceedings relating to an EU trade mark, Article 94(2) of Regulation No 207/2009 precludes, with respect, in particular to actions concerning the infringement of such a mark, the application of certain provisions of Regulation No 44/2001, such as the application of the rules contained in Articles 2 and 4 and Article 5(3) of the latter regulation. In the light of that exclusion, the jurisdiction of the EU trade mark courts referred to in Article 95(1) of Regulation No 207/2009 to hear actions claiming an infringement of an EU trade mark follows from rules directly provided for by Regulation No 207/2009, which have the character of *lex specialis* in relation to the rules provided for by Regulation No 44/2001 (judgments of 5 June 2014, *Coty Germany*, C-360/12, EU:C:2014:1318, paragraphs 26 and 27, and of 18 May 2017, *Hummel Holding*, C-617/15, EU:C:2017:390, paragraph 26).

35 On the other hand, with respect to national trade marks, Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), did not establish specific rules in relation to jurisdiction. The same is true of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1), which repealed and replaced, with effect from 15 January 2019, Directive 2008/95.

36 Consequently, an infringement action such as that brought by the applicants in the main proceedings on 15 October 2015 falls, in so far as it concerns national trade marks, within the scope of the rules on jurisdiction set out by Regulation No 1215/2012 and, in so far as it concerns an EU trade mark, within the scope of the rules on jurisdiction set out by Regulation No 207/2009.

37 Under Article 97(1) of Regulation No 207/2009, where the defendant is domiciled in a Member State, the applicant is to bring its action before the courts of that Member State.

38 However, Article 97(5) of that regulation states that the applicant may 'also' bring its action before the courts of the Member State 'in which the act of infringement has been committed or threatened'.

39 Article 98(1) of that regulation states that where an action is brought before an EU trade mark court on the basis of Article 97(1) of that regulation, it has jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States, and Article 98(2) of that regulation states that, where an action is brought before such a court on the basis of Article 97(5) of that regulation, it has jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

40 It follows from that distinction that the applicant, according to whether he chooses to bring infringement proceedings before the EU trade mark court where the defendant is domiciled or before the EU trade mark court of the place where the act of infringement has been committed or threatened, determines the extent of the territorial jurisdiction of the court before which the action is brought. When the infringement action is based on Article 97(1), it potentially covers acts of infringement committed throughout the European Union, whereas, when the action is based on Article 97(5), the action is restricted to acts of infringement committed or threatened within a single Member State, namely the Member State where the court before which the action is brought is situated.

41 The right conferred on the applicant to choose one or other basis, arising from the use of the word 'also' in Article 97(5) of Regulation No 207/2009, cannot be understood as meaning that the applicant may, with reference to the same acts of infringement, simultaneously bring actions based on paragraphs (1) and (5) of Article 97, but merely reflects, as stated by the Advocate General in point 31 of his Opinion, the fact that the forum indicated in Article 97(5) is an alternative to the fora indicated in the other paragraphs of that article.

42 The EU legislature, in providing for such an alternative forum and restricting, in Article 98(2) of Regulation No 207/2009, the territorial jurisdiction attached to that forum, enables the proprietor of the EU trade mark to bring, if he wishes, targeted actions each of which relates to acts of infringement committed within a single Member State. As the Court has stated previously, where a number of infringement actions involving the same parties concern the use of the same sign but do not relate to the same territory, they do not have the same subject matter and are therefore not subject to the rules on *lis pendens* (see, to that effect, judgment of 19 October 2017, *Merck*, C-231/16, EU:C:2017:771, paragraph 42). Accordingly, the courts of the various Member States before which actions are brought in such circumstances cannot deliver 'contradictory judgments', within the meaning of recital 17 of Regulation No 207/2009, since the actions that the applicant has brought relate to distinct territories.

43 The foregoing considerations must guide the Court in responding to the concerns of the referring court in relation to the meaning of the wording 'Member State in which the act of infringement has been committed', in Article 97(5) of Regulation No 207/2009.

44 The Court has stated, when called on to provide an interpretation of Article 93(5) of Regulation No 40/94, that the criterion for jurisdiction expressed in that wording relates to active conduct on the part of the person causing the alleged infringement (judgment of 5 June 2014, *Coty Germany*, C-360/12, EU:C:2014:1318, paragraph 34).

45 The Court concluded that, in the event of a sale and delivery of a counterfeit product in one Member State, followed by a resale by the purchaser in another Member State in which the original seller has not himself acted, that criterion is not sufficient to establish the jurisdiction of the EU trade mark court of the latter Member State to hear an infringement action brought against the initial seller. Such jurisdiction would be based on an effect of the infringement committed by the original seller and not on the alleged unlawful act committed by the original seller, which would be contrary to the sense of the wording 'Member State in which the act of infringement has been committed' (see, to that effect, judgment of 5 June 2014, *Coty Germany*, C-360/12, EU:C:2014:1318, paragraphs 34, 37 and 38).

46 In accordance with that case-law and the considerations set out in paragraphs 40 to 42 of the present judgment, an EU trade mark court before which an infringement action on the basis of Article 97(5) of Regulation No 207/2009 is brought must, when it is called upon to review its jurisdiction to give a ruling on whether there is an infringement in the territory of the Member State where that court is situated, be satisfied that the acts allegedly committed by the defendant were committed in that territory.

47 Where the acts allegedly committed by the defendant consist of advertising and offers for sale displayed electronically with respect to products bearing a sign identical or similar to an EU trade mark without the consent of the proprietor of that mark, it is necessary, as follows from paragraph 63 of the judgment of 12 July 2011, *L'Oréal and Others* (C-324/09, EU:C:2011:474), to hold that those acts, which fall within the scope of Article 9(2)(b) and (d) of Regulation No 207/2009, were committed in the territory where the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding the fact that the defendant is established elsewhere, that the server of the electronic network that he uses is located elsewhere, or even that the products that are the subject of such advertising and offers for sale are located elsewhere.

48 As is apparent from the same paragraph of that judgment, it must be ensured that a third party who directs advertising and offers for sale to EU consumers using a sign identical or similar to an EU trade mark in relation to products that are identical or similar to the goods for which that mark is registered cannot evade the application of Article 9 of Regulation No 207/2009 and thereby undermine the effectiveness of that provision by relying on the fact that that advertising and those offers for sale were placed online outside the European Union.

49 Similarly, it must be ensured that a third party who has used a sign identical or similar to an EU trade mark without the consent of the proprietor of that mark in relation to products that are identical or similar to the goods for which that mark is registered cannot contest the application of Article 97(5) of Regulation No 207/2009 and thereby undermine the effectiveness of that provision by relying on the place where his advertising and those offers for sale were placed online in order to exclude the jurisdiction of any court other than the court of that place and the court with jurisdiction over where he is established.

50 If the wording 'Member State in which the act of infringement has been committed', in Article 97(5) of Regulation No 207/2009, were to be interpreted as meaning that it refers to the Member State in the territory of which the person carrying out those commercial acts set up his website and activated the display of his advertising and offers for sale, parties established within the European Union committing an infringement, operating electronically and seeking to prevent the proprietors of infringed EU marks from resorting to an alternative forum, would have to do no more than ensure that the territory where the advertising and offers for sale were placed online was the same territory as that where those parties are established. In that way, Article 97(5) of that regulation, would, in the event that the advertising and the offers for sale are directed to consumers of other Member States, be deprived of any scope constituting an alternative to that of the rule on jurisdiction laid down in Article 97(1).

51 An interpretation of the wording 'Member State in which the act of infringement has been committed' as meaning that it refers to the place where the defendant took decisions and technical measures to activate a display on a website is all the more inappropriate given that it may, in many cases, prove excessively difficult, or even impossible, for the applicant to identify that place. As opposed to situations in which proceedings are already pending, a factor in the situation in which the proprietor of the EU trade mark finds himself before the bringing of court proceedings is that it is impossible to compel the defendant to disclose that place, when no action has been brought before any court at that stage.

52 In order to maintain the effectiveness of the EU legislature's provision of an alternative forum, it is necessary, in accordance with the case-law to the effect that the terms of a provision of EU law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must be interpreted having regard to the context of the provision and the objectives pursued by the legislation of which it forms part (see, inter alia, judgments of 3 September 2014, *Deckmyn and Vrijheidsfonds*, C-201/13, EU:C:2014:2132, paragraph 14, and of 18 May 2017,

Hummel Holding, C-617/15, EU:C:2017:390, paragraph 22), to give to the wording 'Member State in which the act of infringement has been committed' an interpretation which is consistent with the other provisions of Regulation No 207/2009 with respect to infringement.

53 One of those provisions is, in particular, Article 9 of that regulation, which lists the acts of infringement which the proprietor of an EU trade mark can contest.

54 Accordingly, the expression 'the act of infringement' must be understood as relating to acts, specified in Article 9, which the applicant claims to have been committed by the defendant, such as, in this case, acts specified in Article 9(2)(b) and (d) of that article, consisting of advertising and offers for sale under a sign identical to the mark at issue, and those acts must be held to have been 'committed' in the territory where they can be classified as advertising or as offers for sale, namely where their commercial content has in fact been made accessible to the consumers and traders to whom it was directed. Whether the result of that advertising and those offers for sale was that, thereafter, the defendant's products were purchased is, however, irrelevant.

55 Subject to the findings of the referring court, the documents available to the Court and the question referred indicate that the object of the applicants in the main proceedings, by means of the infringement proceedings brought before that court, is the advertising and offers for sale displayed by the defendants on a website and on social media platforms solely to the extent that that advertising and those offers for sale were directed to consumers and/or traders in the United Kingdom.

56 Accordingly, in circumstances such as those at issue in the main proceedings, if it is apparent from the content of the website and the platforms at issue submitted by the applicants in the main proceedings that the advertising and offers for sale which they contained were targeted at consumers or traders situated in the United Kingdom and were entirely accessible by them, which is a finding that it is for the referring court to make on the basis of, inter alia, the details contained on that website and those platforms with respect to the geographical areas where the products at issue were to be delivered (judgment of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraphs 64 and 65), those applicants have the right to bring, on the basis of Article 97(5) of Regulation No 207/2009, their infringement action before a court of the United Kingdom, seeking a declaration of an infringement of the EU trade mark in that Member State.

57 That interpretation is supported by the fact that the EU trade mark courts of the Member State where the consumers or traders, to whom such advertising and offers for sale are directed are resident, are particularly suited to assessing whether the alleged infringement exists. In paragraphs 28 and 29 of the judgment of 19 April 2012, *Wintersteiger* (C-523/10, EU:C:2012:220), the Court took account of that factor of proximity, interpreting the wording 'the place where the harmful event occurred', in Article 5(3) of Regulation No 44/2001, as meaning that the proprietor of a national mark may bring an infringement action before the courts of the Member State in which the national mark is registered, since those courts are, having regard to the criteria for assessing infringement established in the judgments of 23 March 2010, *Google France and Google* (C-236/08 to C-238/08, EU:C:2010:159), and of 12 July 2011, *L'Oréal and Others* (C-324/09, EU:C:2011:474), best able to assess whether the mark has been infringed. The courts of the place where the harmful event occurred are particularly suited to giving a ruling by reason of proximity and ease of taking evidence (judgment of 17 October 2017, *Bolagsupplysningen and Ilsjan*, C-194/16, EU:C:2017:766, paragraph 27 and the case-law cited).

58 The interpretation of Article 97(5) of Regulation No 207/2009, as *lex specialis* with respect to actions alleging infringement of EU marks, must, it is true, be independent of the interpretation of Article 5(3) of Regulation No 44/2001 adopted by the Court with respect to actions alleging infringement of national marks (judgment of 5 June 2014, *Coty Germany*, C-360/12, EU:C:2014:1318, paragraph 31). Nonetheless, the interpretations of the concepts of 'Member State in which the act of infringement has been committed' and 'the place where the harmful event occurred', in those

provisions, must have a degree of consistency in order, in accordance with the objective laid down in recital 17 of Regulation No 207/2009, to reduce as far as possible cases of *lis pendens* as a result of the bringing of actions, in different Member States, involving the same parties and the same territory, one brought on the basis of an EU trade mark and another on the basis of parallel national trade marks (see, to that effect, judgment of 19 October 2017, *Merck*, C-231/16, EU:C:2017:771, paragraphs 30 to 32).

59 If the rule of jurisdiction laid down in Article 97(5) of Regulation No 207/2009 were to be interpreted as meaning that that provision did not, unlike Article 5(3) of Regulation No 44/2001, permit the proprietors of EU marks to bring an infringement action before the courts of the Member State within which they seek a declaration of an infringement, the consequence would be that those proprietors would bring proceedings alleging infringement of an EU trade mark and proceedings alleging infringement of parallel national trade marks before courts of different Member States. Frequent application of the mechanism provided in Article 109 of Regulation No 207/2009 to resolve cases of *lis pendens* would, because of such a divergent approach in Article 97(5) of Regulation No 207/2009 (now Article 125(5) of Regulation 2017/1001) and Article 5(3) of Regulation No 44/2001 (now Article 7(2) of Regulation No 1215/2012), be likely, thereby defeating the objective, pursued by those regulations, of reducing cases of *lis pendens*.

60 It must, last, be observed that the interpretation adopted in the present judgment is not invalidated by the interpretation deriving from the judgment of 27 September 2017, *Nintendo* (C-24/16 and C-25/16, EU:C:2017:724), to which the referring court made reference against the background summarised in paragraph 31 of the present judgment.

61 In paragraphs 108 and 111 of the judgment of 27 September 2017, *Nintendo* (C-24/16 and C-25/16, EU:C:2017:724), the Court interpreted the wording 'country in which the act of infringement [of the intellectual property right at issue] was committed', in Regulation No 864/2007, as referring to the law of the country where the initial act of infringement, at the origin of the allegedly wrongful conduct, was committed or may have been committed, that initial act, in the context of electronic commerce, being the act of activating the process of placing online the offer for sale.

62 However, the purpose and object of the wording of Article 8(2) of Regulation No 864/2007 are fundamentally different from that of Article 97(5) of Regulation No 207/2009 and Article 5(3) of Regulation No 44/2001.

63 Article 97(5) of Regulation No 207/2009 provides an alternative forum of jurisdiction and is intended, as stated in paragraph 42 of the present judgment, to enable the proprietor of an EU trade mark to bring one or more actions, each relating specifically to the acts of infringement committed within a single Member State. In contrast, Article 8(2) of Regulation No 864/2007 does not concern the determination of which court has jurisdiction, but relates to the question of how, in the case of a non-contractual obligation arising from an infringement of a unitary intellectual property right, the law applicable to any question that is not governed by the relevant EU instrument is to be determined (see, to that effect, judgment of 27 September 2017, *Nintendo*, C-24/16 and C-25/16, EU:C:2017:724, paragraph 91).

64 That determination of the applicable law may become necessary when an infringement action, brought before a court that has jurisdiction to give rulings on acts of infringement committed within any Member State, relates to various acts of infringement, committed in different Member States. In such circumstances, in order to ensure that a court does not have to apply more than one law, one alone of those acts of infringement, namely the initial act of infringement, must be identified as determinative of the law applicable to the proceedings (judgment of 27 September 2017, *Nintendo*, C-24/16 and C-25/16, EU:C:2017:724, paragraphs 103 and 104). The need to ensure that only one law

is applicable does not exist in the context of rules concerning which court has jurisdiction, such as those contained in Regulation No 44/2001 and in Regulation No 207/2009, which provide for more than one forum.

65 In the light of all the foregoing, the answer to the question referred is that Article 97(5) of Regulation No 207/2009 must be interpreted as meaning that the proprietor of an EU trade mark, who considers that his rights have been infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products that are identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before an EU trade mark court of the Member State within which the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding that that third party took decisions and steps in another Member State to bring about that electronic display.

Costs

66 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 (Fifth Chamber) hereby rules:

Article 97(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark must be interpreted as meaning that the proprietor of a European Union trade mark who considers that his rights have been infringed by the use without his consent, by a third party, of a sign identical to that mark in advertising and offers for sale displayed electronically in relation to products that are identical or similar to the goods for which that mark is registered, may bring an infringement action against that third party before a European Union trade mark court of the Member State within which the consumers or traders to whom that advertising and those offers for sale are directed are located, notwithstanding that that third party took decisions and steps in another Member State to bring about that electronic display.

Regan Lycourgos Juhász

Ilešič Jarukaitis

Delivered in open court in Luxembourg on 5 September 2019.

A. Calot Escobar
Registrar

E. Regan
President of the Fifth Chamber