Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

15 November 2012*

(Directive 2004/48/EC — Rules governing the examination of evidence in a dispute before a national court before which an application for annulment of the protection of a utility model has been brought — Powers of the national court — Paris Convention — TRIPS Agreement)

In Case C-180/11,

REFERENCE for a preliminary ruling under Article 267 TFEU from the Fővárosi Bíróság (Hungary), made by decision of 29 September 2010, received at the Court on 18 April 2011, in the proceedings

Bericap Záródástechnikai bt

v

Plastinnova 2000 kft,

intervening party:

Magyar Szabadalmi Hivatal,

THE COURT (Third Chamber),

composed of R. Silva de Lapuerta, acting as President of the Third Chamber, K. Lenaerts, E. Juhász, J. Malenovský (Rapporteur) and D. Šváby, Judges,

Advocate General: V. Trstenjak,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

— Bericap Záródástechnikai bt, by Zs. Kacsuk, ügyvéd,

— Plastinnova 2000 kft, by J. Hergár, ügyvéd,

— the Hungarian Government, by M. Fehér and K. Szíjjártó, acting as Agents,

— the European Commission, by F. Bulst and B. Béres, acting as Agents,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

* Language of the case: Hungarian

gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation 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 corrigenda in OJ 2004 L 195, p. 16 and OJ 2007 L 204, p. 27), the Agreement on Trade-Related Aspects of Intellectual Property Rights ('the TRIPS Agreement'), which constitutes Annex 1C to the Agreement establishing the World Trade Organisation (WTO) signed at Marrakesh on 15 April 1994 and approved by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1), and the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaty Series*, Vol. 828, No 11851, p. 305) ('the Paris Convention').

2 The reference has been made in proceedings between Bericap Záródástechnikai bt ('Bericap') and Plastinnova 2000 kft ('Plastinnova') concerning the alleged lack of novelty and inventive step of a utility model.

Legal context

International law

The TRIPS Agreement

3 The first recital in the preamble to the TRIPS Agreement is worded as follows:

'Desiring to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade'.

4 Article 1(1) and (2) of Part I of the TRIPS Agreement, which is headed 'General Provisions and Basic Principles', provides:

'1. Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.

2. For the purposes of this Agreement, the term "intellectual property" refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.'

5 Article 2 of the TRIPs Agreement, which is headed 'Intellectual Property Conventions', provides:

'1. In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967).

2. Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.'

6 Article 41(1) to (3) of the TRIPS Agreement, which is in Part III of that agreement, headed 'Enforcement of Intellectual Property Rights', provides:

'1. Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

2. Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

3. Decisions on the merits of a case shall preferably be in writing and reasoned. They shall be made available at least to the parties to the proceeding without undue delay. Decisions on the merits of a case shall be based only on evidence in respect of which parties were offered the opportunity to be heard.'

The Paris Convention

7 All the Member States of the European Union are parties to the Paris Convention.

8 Article 1(2) of that Convention stipulates:

'The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.'

9 Article 2(1) of that Convention provides:

'Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.'

European Union law

10 Recitals 4 to 6 in the preamble to Directive 2004/48 are worded as follows:

'(4) At international level, all Member States, as well as the Community itself as regards matters within its competence, are bound by [the TRIPS Agreement] […].

(5) The TRIPS Agreement contains, in particular, provisions on the means of enforcing intellectual property rights, which are common standards applicable at international level and implemented in all Member States. This Directive should not affect Member States' international obligations, including those under the TRIPS Agreement.

(6) There are also international conventions to which all Member States are parties and which also contain provisions on the means of enforcing intellectual property rights. These include, in particular, the Paris Convention…, the Berne Convention for the Protection of Literary and Artistic Works, and the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations.'

11 Recital 27 in the preamble to that directive provides:

'To act as a supplementary deterrent to future infringers and to contribute to the awareness of the public at large, it is useful to publicise decisions in intellectual property infringement cases.'

12 According to recital 32 in the preamble to that directive:

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

13 Article 1 of Directive 2004/48 defines its subject-matter as follows:

'This Directive concerns the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights. For the purposes of this Directive, the term "intellectual property rights" includes industrial property rights.'

14 Article 2 of Directive 2004/48, which relates to the scope of that directive, provides in paragraph 1:

'Without prejudice to the means which are or may be provided for in Community or national legislation, in so far as those means may be more favourable for rightholders, the measures, procedures and remedies provided for by this Directive shall apply, in accordance with Article 3, to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.'

15 Article 2(3)(b) of Directive 2004/48 provides that that directive is not to affect 'Member States' international obligations and notably the TRIPS Agreement, including those relating to criminal procedures and penalties'.

16 Article 3 of that directive provides:

'1. Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be fair and equitable and shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

2. Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.'

Hungarian law

The Law on the Protection of Utility Models

17 Paragraph 1(1) of Law XXXVIII of 1991 on the Protection of Utility Models (A használati minták oltalmáról szóló 1991. évi XXXVIII. törvény) provides:

'Any technical solution relating to the design, structure or arrangement of the constituents of an object (hereinafter 'the model') may receive the protection conferred on utility models (hereinafter 'the protection of models') provided that it is new, is based on an inventive step and is capable of industrial application.'

18 Paragraph 2(2) of the Law on the Protection of Utility Models provides:

'The state of the art shall be held to comprise the information which has been made available to the public by means of a written description or by use in the national territory before the date of priority.'

19 Paragraph 3(1) of that law provides:

'A utility model shall be considered to be the result of an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.'

20 Paragraph 5 of that law states:

'(1) The applicant shall be granted protection for his model if that model:

(a) satisfies the requirements of Paragraphs 1 to 4 of this law and is not excluded from the protection of models under subparagraph (2) of this Paragraph or Paragraph 1(2) of this law.'

21 Paragraph 24 of the Law on the Protection of Utility Models provides:

'(1) The protection of a model shall be invalidated if:

(a) the subject matter of the protection does not satisfy the requirements of Paragraph 5(1)(a).

…'

22 Paragraph 26 of that law provides:

'The Hungarian Patent Office shall have the competence to:

…

(c) invalidate a protection'

23 Paragraph 27 of that law states:

'…

(3) Decisions given by the Hungarian Patent Office in matters concerning the protection of models shall be reviewed by the court in accordance with the provisions of Paragraph 37 of this law.

(4) The Hungarian Patent Office may, if an application to amend a decision is submitted to it, and as long as the matter has not been referred to the court, amend or withdraw any decision terminating a procedure, which it has given on one of the following matters:

…

(c) the invalidation of a protection.'

24 Paragraph 36(3) of the Law on the Protection of Utility Models provides:

'The provisions of the legislation on patents shall apply *mutatis mutandis* to procedures … for the invalidation … of the protection of models.'

25 Paragraph 37 of that law provides:

'(1) Upon request, the court may amend the decisions adopted by the Hungarian Patent Office under:

(a) Paragraph 27(4) of this law.

…

(13) In any other matters, the provisions relating to the procedure for review by the court of the decisions taken by the Hungarian Patent Office in patent matters shall apply *mutatis mutandis* to the procedure for review by the court of decisions taken by the Hungarian Patent Office in the field of the protection of models.'

The Law on Patents

26 Paragraph 42 of Law XXXIII of 1995 on the Patentability of Inventions ('the Law on Patents') provides:

'…

(3) Where a final decision rejecting an application for invalidation has been given, a new application for invalidation based on the same facts in respect of the same patent may not be submitted by any person.'

27 Paragraph 80 of the Law on Patents states:

'(1) Subject to subparagraph 2, any person may apply, under Paragraph 42 of this law, for the invalidation of a patent by means of an application directed against the proprietor thereof.

(2) In the case referred to in Paragraph 42(1)(d), the invalidation of the patent is to be applied for by the person who is entitled to the patent according to the law.'

28 Paragraph 81 of that law states:

'…

(3) In the event that an application for invalidation is withdrawn, the procedure may be continued *ex officio*…'

29 Paragraph 86 of that law provides:

‘(1) The Budapest Municipal Court shall have exclusive jurisdiction to hear actions for amendment of the decisions adopted by the Hungarian Patent Office.

…’

30 Paragraph 88 of that law provides:

‘Subject to the derogations provided for by this law, the court shall rule on applications for amendment of the decisions of the Hungarian Patent Office in accordance with the rules on non-contentious proceedings. The general provisions of Law No III of 1952, establishing the Code of Civil Procedure (A polgári perrendtartásról szóló 1952. évi III. törvény), shall apply *mutatis mutandis* to the proceedings, unless this law or the non-contentious nature of the proceedings implies otherwise.’

The Code of Civil Procedure

31 Articles 3 and 4 of the Code of Civil Procedure are in Part I of that code, headed ‘General Provisions’, in the chapter and sub-chapter headed, respectively, ‘Fundamental Principles’ and ‘Tasks of the Courts in Civil Cases’.

32 Article 3(2) of that code provides:

‘(2) Unless otherwise provided for by law, the Court shall be bound by the claims and other statements with legal effect made by the parties. …’

33 Article 4(1) of that code states:

‘(1) In its assessment, the court is not bound by the decisions taken by other authorities or given in disciplinary matters or by the findings of fact made in those decisions.’

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

34 On 17 May 1991, Plastinnova filed an application for registration of an industrial design with the Hungarian Patent Office under the number 2252-320/91, and subsequently, on 1 September 1992, an application for protection by means of a utility model was filed. Plastinnova, relying on a transformation of the protection sought, claimed, in respect of the second application, the right of priority attached to the first application. The Hungarian Patent Office granted that application for transformation and, following the filing of the application for registration of the utility model, authorised its protection with the right of priority linked to the filing of the application for registration of the industrial design.

35 On 6 May 1998, Bericap, in an administrative procedure, sought the invalidation of the protection of the utility model concerned on the ground of lack of novelty and underlying inventive step.

36 By decision No U9200215/35, of 1 June 2004, the Hungarian Patent Office confirmed the validity of that protection by utility model, but restricted its scope.

37 Plastinnova, as proprietor of the utility model, submitted an application to the Fővárosi Bíróság (Budapest Municipal Court) for amendment of that decision of the Hungarian Patent Office. That court, ruling at first instance, dismissed the application and, amending decision No U9200215/35, declared the protection of the disputed model invalid.

38 On appeal by Plastinnova, the Fővárosi ítélőtábla (Court of Appeal, Budapest), by means of an order, amended the decision given at first instance and, reversing that decision as regards the invalidation of the protection of the utility model, confirmed it as to the remainder.

39 The Legfelsőbb Bíróság (Supreme Court), before which Bericap appealed, confirmed the order made on appeal.

40 The case in the main proceedings (administrative procedure) commenced on 31 January 2007, when Bericap filed a further application for invalidation of the disputed utility model with the Hungarian Patent Office. That company put forward, as grounds for invalidation, a lack of novelty and underlying inventive step. Attached to its application were, among other documents, patent specifications, in the form of annexes, bearing the numbers K4 to K10, K19 to K25, K29 and K30.

41 Plastinnova, relying on the earlier invalidation procedure, requested that the subsequent application for invalidation be rejected without any examination as to its merits.

42 By decision No U9200215/58, the Hungarian Patent Office rejected that application for invalidation, referring to Paragraph 42(3) of the Law on Patents. It applied that provision in such a way that, of the abovementioned documents, it took no account of patent specifications K4 to K8, K10, K19, K21 and K22 in the new invalidation procedure. According to the Hungarian Patent Office, those documents '[had] constituted the basis of the decision in the previous invalidation procedure.' It added that 'each of those documents [had] been subject to examination, regardless of which of them contained information relevant to the model concerned' and that, 'since the decision in the previous procedure [was] based on all of the documents examined, they [had to] be disregarded in the present procedure'. The Hungarian Patent Office also stated that 'each of the features covered by the main claims concerning the protection by utility model [was] identifiable from the photographs and [that], therefore, the protection of that model [could] claim priority'. It added that 'a decision [had] also [been] made concerning priority in the previous procedure, and that decision was also based on the conclusion that the protection by utility model should be accorded the priority which had been conferred on it on the basis of the transformation of the protection of the industrial design'. In that respect, the Hungarian Patent Office declared that patent specifications K20 and K23 were not part of the state of the art.

43 Ultimately, the Hungarian Patent Office examined the issue of the lack of novelty and underlying inventive step only in the light of patent specifications K9, K24, K25, K29 and K30 and found that the existence of the grounds for invalidation put forward had not been proved.

44 Bericap brought, before the referring court, an action for amendment of decision No U9200215/58 and requested the invalidation of the utility model. It requested that account be taken of all the documents produced and stated that protection by utility model secured for its proprietor exclusive rights comparable to those conferred by a patent. That is why it is in the public interest that exclusive rights are based only on a protection by utility model which satisfies the legal requirements. The legislature ensured the protection of the public interest by introducing as a matter of law the action for invalidation. The public interest nature of an invalidation procedure is borne out by Paragraph 80(1) of the Law on Patents, which provides that, subject to subparagraph 2, any person may apply, under Paragraph 42 of that law, for the invalidation of a patent by means of an application directed against the proprietor thereof. The public interest is likewise apparent from Paragraph 81(3) of that law, according to which the procedure may be continued *ex officio* in the event that an application for invalidation is withdrawn.

45 Plastinnova requested that decision No U9200215/58 be confirmed as it was well founded.

46 The referring court set aside decision No U9200215/58 and referred the case back to the Hungarian Patent Office for a new decision. The court held that the evidence produced in the subsequent invalidation procedure could not be disregarded on the sole ground that it had already been produced during the earlier invalidation procedure.

47 The Fővárosi ítélőtábla set aside the order made at first instance and referred the case back to the Fővárosi Bíróság for re-examination and a new decision, after finding that the Hungarian Patent Office had, in its examination of the subsequent application for invalidation, correctly defined the factual context to be analysed.

48 In the order for reference, the Fővárosi Bíróság states that, in view of the provisions of Directive 2004/48, in particular Articles 2(1) and 3(2) thereof, it has doubts concerning the way in which the rules of national law relating to procedures for the invalidation of the protection of utility models are applied.

49 Furthermore, the referring court states that the questions on which the Court is asked to give a preliminary ruling are based on a comparison of the provisions of the Paris Convention and the TRIPS Agreement with the way in which the relevant rules of national law are applied. It states, in that regard, that, in Hungary, the Paris Convention was promulgated by Legislative Decree No 18 of 1970 and the TRIPS Agreement was promulgated by Law No IX of 1998.

50 In those circumstances, the Fővárosi Bíróság decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

‘(1) Is it consistent with European Union law if, during proceedings to amend a decision relating to an application for invalidation of a utility model, the measures, procedures and legal remedies are applied in such a way that the national court is not bound by the claims or statements with legal effect made by the parties, and the court is entitled to order of its own motion the production of any evidence that it may deem necessary?

(2) Is it consistent with European Union law if, during proceedings to amend a decision relating to an application for invalidation of a utility model, the measures, procedures and legal remedies are applied in such a way that the national court, when making its decision, is not bound by the administrative decision made in relation to the application for invalidation, or by the findings established therein, nor, specifically, by the grounds for invalidation indicated during the administrative procedure, or by the declarations, assertions or evidence submitted during the administrative procedure?

(3) Is it consistent with European Union law if, during proceedings to amend a decision relating to a further application aimed at invalidating a utility model, the measures, procedures and legal remedies are applied in such a way that the national court excludes any evidence submitted with the further application, including evidence relating to the state of the art, to which reference was already made in connection with the previous application for invalidation of a utility model?’

Consideration of the questions referred

Admissibility

51 Plastinnova and the Hungarian Government dispute, on various grounds, the admissibility of the reference for a preliminary ruling.

52 In the first place, Plastinnova requests the Court to reject, without any examination as to its merits, that reference on the grounds, first, that the Fővárosi Bíróság did not, under the Code of Civil Procedure, have the power to make such a reference and, secondly, that, inasmuch as, in the present main proceedings, the decision at issue may be appealed on a point of law, only the Supreme Court had the jurisdiction to make a reference for a preliminary ruling.

53 In that regard, it must be borne in mind that, in accordance with settled case-law, Article 267 TFEU gives national courts the widest discretion in referring matters to the Court if they consider that a case pending before them raises questions involving the interpretation of provisions of European Union law, or consideration of their validity, which are necessary for the resolution of the case before them. National courts are, moreover, free to exercise that discretion at whatever stage of the proceedings they consider appropriate (see Case C-173/09 *Elchinov* [2010] ECR I-8889, paragraph 26 and the case-law cited).

54 The Court has thus concluded that the existence of a national procedural rule cannot call into question the discretion of national courts not ruling at final instance to make a reference to the Court for a preliminary ruling where they have doubts, as in the main proceedings, as to the interpretation of European Union law (*Elchinov*, paragraph 25, and Case C-396/09 *Interedil* [2011] ECR I-9915, paragraph 35).

55 Furthermore, the Court has held that a court which is not ruling at final instance must be free, if it considers that a higher court's legal ruling could lead it to give a judgment contrary to European Union law, to refer to the Court questions which concern it (see *Elchinov*, paragraph 27 and the case-law cited).

56 In those circumstances, the plea of inadmissibility put forward by Plastinnova in that regard must be rejected.

57 In the second place, the Hungarian Government submits that the reference for a preliminary ruling must be rejected as inadmissible inasmuch as the referring court does not explain the reasons why it considers an interpretation of Directive 2004/48 to be necessary.

58 According to settled case-law, the Court may refuse to rule on a question referred by a national court only where it is quite obvious that the interpretation of European Union law that is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it (see, inter alia, Case C-379/98 *PreussenElektra* [2001] ECR I-2099, paragraph 39; Case C-466/04 *Acereda Herrera* [2006] ECR I-5341, paragraph 48; and Joined Cases C-94/04 and C-202/04 *Cipolla and Others* [2006] ECR I-11421, paragraph 25).

59 It must be stated that it is not obvious that the interpretation of European Union law sought by the referring court bears no relation to the actual facts of the main action or its purpose or that the questions on the interpretation of that law are hypothetical. Although the questions referred refer, very generally, to European Union law, it is, however, apparent from the order for reference that the court before which the dispute in the main proceedings was brought in actual fact seeks the interpretation of Articles 2(1) and 3(2) of Directive 2004/48 and also of Article 2(1) of the Paris Convention and Article 41(1) and (2) of the TRIPS Agreement, so that it may assess whether the national rules of procedure which are applicable in the course of an application for invalidation of the protection of a utility model are compatible with those provisions.

60 In those circumstances, the presumption of relevance attaching to the questions referred has not been rebutted.

61 It follows that that second plea of inadmissibility must also be rejected.

62 In the third place, the Hungarian Government disputes the admissibility of the reference for a preliminary ruling by submitting that Directive 2004/48 is manifestly irrelevant as regards the outcome of the present dispute, because it seeks only to harmonise the civil and administrative measures applicable in cases of infringement of intellectual property rights. In the present case, the subject-matter of the pending proceedings is the validity of a utility model and not an infringement of intellectual property rights.

63 In that regard, it is sufficient to state that the question whether a procedure for the invalidation of a utility model constitutes a procedure which is intended to ensure that intellectual property rights are enforced does not relate to the admissibility of the questions referred for a preliminary ruling but concerns the substance of those questions (see, by analogy Joined Cases C-295/04 to C-298/04 *Manfredi and Others* [2006] ECR I-6619, paragraph 30, and Case C-467/08 *Padawan* [2010] ECR I-10055, paragraph 27). Consequently, such a submission cannot result in the rejection of the reference for a preliminary ruling at the stage of the assessment as to its admissibility.

64 Since the third plea of inadmissibility must also be rejected, it follows from all of the foregoing considerations that the reference for a preliminary ruling must be declared admissible.

Substance

65 By its three questions, which it is appropriate to examine together, the referring court asks, in essence, whether European Union law precludes that, in judicial proceedings relating to an application for invalidation of the protection of a utility model, the court:

— is not bound by the claims and other statements made by the parties and is entitled to order of its own motion the production of any evidence that it may deem necessary;

— is not bound by an administrative decision made in relation to an application for invalidation or by the findings of fact in that decision, and

— is not entitled to re-examine evidence which was already submitted in connection with a previous application for invalidation.

66 In particular, it is apparent from the order for reference that the referring court takes the view that Directive 2004/48 is applicable to the procedure followed in the main proceedings and raises questions concerning the interpretation of that directive, in particular that of Articles 2(1) and 3(2) thereof, in the light of the articles of the Paris Convention and the TRIPS Agreement referred to in paragraph 59 of the present judgment.

67 In that regard, it must be pointed out at the outset that the Agreement establishing the WTO, of which the TRIPs Agreement forms part, has been signed by the European Union and subsequently approved by Decision 94/800. Therefore, according to settled case-law, the provisions of the TRIPS Agreement now form an integral part of the European Union legal order and, within the framework of that legal order, the Court has jurisdiction to give preliminary rulings concerning the interpretation of that agreement (see Case C-431/05 *Merck Genéricos - Produtos Farmacêuticos* [2007] ECR I-7001, paragraph 31 and the case-law cited).

68 It is apparent in particular from the provisions of Article 41(1) and (2) of the TRIPS Agreement, read together, that the States which are parties to that agreement are to ensure that enforcement procedures with specific characteristics are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by that agreement.

69 Pursuant to those provisions, the States which are parties to that agreement, including the European Union, are thus required to legislate by introducing, into their national law, measures relating to the enforcement of intellectual property rights in accordance with what is specified in those provisions.

70 Furthermore, given that the TRIPS Agreement provides, as is apparent from Article 2(1) thereof, that, in respect of Parts II, III and IV of that agreement, the States which are parties to the agreement are to comply with Articles 1 to 12 and 19 of the Paris Convention, the legislation required by Article 41(1) and (2) of the TRIPS Agreement must comply, inter alia, with Article 2(1) of that Convention.

71 Under the provisions of Article 2(1) of the Paris Convention, nationals of any country to which that Convention applies are, as regards the protection of industrial property, to enjoy, in all the other countries to which that Convention also applies, the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by that Convention. Consequently, they are to have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

72 Thus, the main element common to all the abovementioned provisions of the TRIPS Agreement and the Paris Convention is the obligation of the parties to them to ensure, by means of their domestic law, that intellectual property rights are enforced by providing for effective legal remedies against any act of infringement of those rights.

73 The European Union fulfilled that obligation to legislate by adopting Directive 2004/48 which seeks specifically, as is apparent from Article 1 thereof, to ensure the enforcement of intellectual property rights by means of the introduction, for that purpose, of various measures, procedures and remedies within the Member States.

74 More particularly, as is apparent from Article 2(1) of Directive 2004/48, the measures, procedures and remedies provided for by that directive are to apply, in accordance with Article 3 thereof, to any infringement of intellectual property rights as provided for by European Union law and/or by the national law of the Member State concerned.

75 Thus, all the abovementioned provisions of the TRIPS Agreement, the Paris Convention and Directive 2004/48 ('the relevant provisions') are intended to govern only the aspects of intellectual property rights related to, first, the enforcement of those rights and, secondly, to infringement of them, by requiring that there must be effective legal remedies designed to prevent, terminate or rectify any infringement of an existing intellectual property right.

76 In that regard, as is apparent from Article 17 of the Charter of Fundamental Rights of the European Union, a procedure which is intended to ensure the enforcement of an intellectual property right presupposes that that right has been lawfully acquired (see, to that effect, Joined Cases C-154/04 and C-155/04 *Alliance for Natural Health and Others* [2005] ECR I-6451, paragraph 128).

77 If follows, as is moreover also apparent from Article 2(1) of Directive 2004/48, that the relevant provisions simply ensure the enforcement of the various rights enjoyed by persons who have acquired intellectual property rights, namely the proprietors of such rights, and cannot be interpreted as being intended to govern the various measures and procedures available to persons who, like the applicant in the main proceedings, without themselves being the proprietors of such rights, dispute the intellectual property rights acquired by others.

78 An invalidation procedure such as that at issue in the main proceedings is specifically available to a person who, without being the proprietor of an intellectual property right, disputes the protection of a utility model granted to the proprietor of the corresponding rights.

79 Consequently, such a procedure is not intended to ensure, for the purposes of the relevant provisions, that proprietors of intellectual property rights are protected.

80 Indeed, that procedure does not involve infringement of an intellectual property right, whether (i) as regards the person who initiates that procedure, since, not being the proprietor of such a right, he cannot, by definition, be subject to any infringement of that right, or (ii) as regards the proprietor of a right to which that procedure relates, since an action which is brought against him and disputes, in law, the existence of his intellectual property right cannot, by definition, be categorised as an infringement.

81 It follows from the foregoing that the relevant provisions are not intended to govern the various aspects of an invalidation procedure such as that at issue in the main proceedings.

82 Consequently, the answer to the questions referred is that, inasmuch as the provisions of Articles 2(1) and 3(2) of Directive 2004/48, interpreted in the light of Article 2(1) of the Paris Convention and of Article 41(1) and (2) of the TRIPS Agreement, are not applicable to an invalidation procedure such as that at issue in the main proceedings, those provisions do not preclude that, in such judicial proceedings, the court:

— is not bound by the claims and other statements made by the parties and is entitled to order of its own motion the production of any evidence that it may deem necessary;

— is not bound by an administrative decision made in relation to an application for invalidation or by the findings of fact in that decision, and

— is not entitled to re-examine evidence which was already submitted in connection with a previous application for invalidation.

Costs

83 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 (Third Chamber) hereby rules:

Inasmuch as the provisions of Articles 2(1) and 3(2) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, interpreted in the light of Article 2(1) of the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979, and of Article 41(1) and (2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights, which constitutes Annex 1C to the Agreement establishing the World Trade Organisation (WTO) signed at Marrakesh on 15 April 1994 and approved by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994), are not applicable to an invalidation procedure such as that at issue in the main proceedings, those provisions do not preclude that, in such judicial proceedings, the court:

— is not bound by the claims and other statements made by the parties and is entitled to order of its own motion the production of any evidence that it may deem necessary;

— **is not bound by an administrative decision made in relation to an application for invalidation or by the findings of fact in that decision, and**

— **is not entitled to re-examine evidence which was already submitted in connection with a previous application for invalidation.**

[Signatures]