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Applicants of EU trademarks should in future consider additionally filing a German trademark application, following a recent decision of the German Federal Supreme Court

On November 9, 2017, the German Federal Supreme Court (*Bundesgerichtshof* - BGH) delivered a decision[1] which will limit the possibilities of plaintiffs of choosing a German court in certain cases of trans-border infringement of EU trademarks. At the same time, however, the BGH confirmed that German courts remain competent in cases where the infringed trademark is not an EU mark but a German mark. Therefore it makes good sense for applicants in future to consider filing their important trademarks not only as an EU mark but also as a German trademark, in order to still be able to claim its infringement by parties located in the EU, but outside Germany, before German courts.

Facts

The plaintiff manufactured and distributed perfume, being the owner or licensee of various EU trademarks and International Registrations with protection in Germany. The defendant, a company located in Italy, had undertaken not to import perfumes under certain brands into Germany or to distribute them in Germany without the plaintiff's permission. The defendant's website was (also) available in German. A German company placed an order with the defendant for 150 flasks of perfume and had them picked up in Italy and taken to Germany. The plaintiff considered this as being an infringement of his trademark rights by the defendant, and sued the defendant before a German court, which is in principle possible according to the EU Trademark Regulation.

Decision

The BGH interpreted the applicable provision, taking into account a recent decision of the European Court of Justice[2], and denied the international jurisdiction of German courts. According to the BGH, the provision assumes that the infringer committed a positive act, and is aimed at the EU Member State where the potential act of infringement had been committed or threatened, and not at the Member State where the infringement "unfolded its effect". The place where the event giving rise to the damage occurred was the place where the process of putting the offer for sales online by the economic operator on its website was activated (here: Italy), and not the place where the website could be accessed (here: Germany). Consequently, the international jurisdiction in the EU trademark infringement case was not in Germany but in Italy. Since more and more products (including products which infringe trademarks) are ordered via the internet, situations like the one described above are becoming more frequent.

In the same decision, however, the BGH confirmed the international jurisdiction of German courts in cases of a potential infringement of a German trademark (or an International Trademark Registration with protection in Germany), on the basis of the "Brussels I" Regulation, which was applicable at the time[3]. Applicants of EU trademarks should thus consider additionally filing their important trademarks in Germany, in order to secure the international competence of German courts in future, too.

1 Case I ZR 164/16, published online in BeckRS 2017, 132438

2 Preliminary Ruling in joined Cases C-24/16 and C-25/16 of September 27, 2017 (Nintendo v BigBen), issued in a Community Design matter

3 Now: "Brussels Ia" of 2012

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Any questions regarding this decision or trademarks in general?

Please do not hesitate to contact us:

Vossius & Partner Patentanwälte Rechtsanwälte mbB
Tel.: +49 89 413 04-0 Fax: -400
trademarks@vossiusandpartner.com
www.vossiusandpartner.com