CJEU Rules Again on Jurisdiction over Co-Perpetrators

By Jonas Steinle

Jonas Steinle, LL.M., is a doctoral student at the chair of Prof. Dr. Matthias Weller, Mag.rer.publ., Professor for Civil Law, Civil Procedure and Private International Law at EBS Law School Wiesbaden, Germany.

On 5 June 2014, the Court of Justice of the European Union delivered another judgment on Art. 5 No. 3 Brussels I Regulation in *Coty Germany GmbH ./. First Note Perfumes NV*, C-360/12. With its decision, the Court completed a series of three pending decisions that all concerned cases where there are several supposed perpetrators and one of them is sued in a jurisdiction other than the one he acted in.

Facts

The German based claimant, the *Coty Germany GmbH,* sells and manufactures perfumes and cosmetics in Germany. Among its products there is one perfume that comes in a bottle, corresponding to a three-dimensional Community trademark whereof *Coty Germany* is the proprietor. The defendant, *First Note*, is a Belgium based perfume wholesaler. One of the perfumes of *First Note* was sold in a bottle, similar to the one that is protected by the Community trademark of *Coty Germany. First Note* sold this perfume to a German based intermediary, the *Stefan P. Warenhandel.* These sales were performed entirely outside of Germany since *Stefan P. Warenhandel* had collected the perfumes directly at the premises of *First Note* in Belgium and resold them in Germany.

Coty Germany claimed that the distribution of the perfume in Belgium by *First Note* constituted an infringement of its Community trademark and commenced proceedings against *First Note* before German (!) courts, although these sales had been performed entirely outside of Germany. *Coty Germany* argued that jurisdiction of the German courts could be established pursuant to Art. 93 para. 5 of the Trademark Regulation, which requires that the defendant allegedly acted within the territory of the seized court. The second basis for establishing jurisdiction of the German courts was Art. 5 No. 3 Brussels I Regulation, which

provides for the place where the damage occurred. *Coty Germany* claims that the acts of the German based *Stefan P. Warenhandel* can be imputed to the Belgium based defendant, *First Note,* and that therefore jurisdiction may be established before the German courts. Both heads of jurisdiction formed each a question for reference to the Court.

Ruling

In its first part of the judgment, the Court referred to Art. 93 para. 5 of the Trademark Regulation as a potential basis for jurisdiction. The Court ruled that the application of Art. 5 No. 3 Brussels I Regulation is expressly precluded under the Trademark Regulation and that Art. 93 para. 5 of the Trademark must therefore be interpreted independently from Art. 5 No. 3 Brussels I Regulation (para. 31) without making reference to the existing case law of the Brussels I Regulation (para. 32). By referring to the wording and the purpose of that rule, the Court came to the conclusion that Art. 93 para. 5 of the Trademark Regulation does only allow jurisdiction to be established before the courts where the trade mark was presumably infringed and not before the courts, where a potential accomplice had made any such infringements.

With regard to the second referred question on Art. 5 No. 3 Brussels I Regulation, the Court distinguished between the place where the causal event occurred and the place where the damage occurred.

As for the first alternative of this rule, the question at hand was whether one can impute the action of one perpetrator to his accomplice in order to establish jurisdiction under Art. 5 No. 3 Brussels I Regulation under the place where the causal event occurred. This would essentially allow the claimant to sue any perpetrator at a place of action of his accomplices and hence at a venue where he himself never acted. Here, the Court simply referred to its ruling in the case *Melzer* in 2013, where the Court clearly had denied such possibility as a basis for jurisdiction under Art. 5 No. 3 Brussels I Regulation.

Since the referring court, the German *Bundesgerichtshof,* had not limited the order for reference to the place where the causal event occurred, the CJEU this time could also address the second alternative under Art. 5 No. 3 Brussels I Regulation as a potential basis for jurisdiction, which is the place where the damage occurred. Here, the Court came to a different conclusion by referring to

the *Wintersteiger* and *Pinckney* decisions where it had held that the occurrence of damage in a particular Member State is subject to the protection in that relevant Member State (para. 55). Holding that this was also true for infringements of unfair competition, which was the case here, the Court stated:

57 "It must therefore be held that, in circumstances such as those of the main proceedings, an action relating to an infringement of that law may be brought before the German courts, to the extent that the act committed in another Member State caused or may cause damage within the jurisdiction of the court seised."

Accordingly, the Court does allow jurisdiction to be established on the basis of the place of occurrence of damage, to hear an action for damages against a person established in another Member State who acted in that State and whose actions – through the furtherance of another perpetrator – caused damage within the jurisdiction of the seised court.

Evaluation

As far as the ruling refers to the question of imputation of actions among several perpetrators to establish jurisdiction under the place where the causal event took place, this ruling is no big surprise neither for Art. 93 para. 5 of the Trademark Regulation, nor for Art. 5 No. 3 Brussels I Regulation. Here the Court has had its opportunities to make clear that the very existence of a particularly close linking factor between the dispute and the courts of the place where the harmful event occurred does not allow for such expansive interpretation of Art. 5 No. 3 Brussels I Regulation (which is probably also true for Art. 93 para. 5 of the Trademark Regulation). As far as Art. 5 No. 3 Brussels I Regulation is concerned, this could be expected after the previous rulings of the Court in *Hi Hotel* (C-387/12) (see previous comment on that decision on conflictoflaws.net) and *Melzer* (C-228/11).

The interesting part of the decision is the one on establishing jurisdiction at the place where the damage occurred under Art. 5 No. 3 Brussels I Regulation (para. 52 *et seqq.*). For this part, the Advocate General had very much struggled with the consequences stemming from the *Pinckney* ruling (para. 68 *et seqq.* of the Opinion the Advocate General on *Coty Germany*) and had pointed out that such interpretation of Art. 5 No. 3 Brussels I Regulation would lead to a very extensive application of Art. 5 No. 3 Brussels I Regulation. In fact, it is hard to see the link

between the harmful event (sales of a perfume in in Belgium) and the alleged damage stemming from that event (trademark infringement in Germany) without making reference to the furtherance of this damage by another perpetrator (in the case at hand *Stefan P. Warenhandel)*.

For the CJEU however, there does not seem to be any problem by applying the *Pinckney* ruling to the case at hand. What lies behind this must be some sort of attribution of effects with regard to the place where the damage occurred. The Court seems to be much more susceptible to such attribution on the effects-side rather than on the causation-side. Why this is the case is not answered by the Court, nor does it give any sort of criteria in which cases such attribution of effects may be permissible. One can imagine that the mosaic principle on the effects-side incites the Court to that much more relaxed attitude but since the Court does not say a word about all that there is much to be explored about this relatively new concept of attribution of effects and its potential limits.