

Case C-421/20

Request for a preliminary ruling

Date lodged:

8 September 2020

Referring court:

Oberlandesgericht Düsseldorf (Higher Regional Court Düsseldorf,
Germany)

Date of the decision to refer:

31 August 2020

Appellant:

Acacia Srl

Respondent:

Bayerische Motoren Werke Aktiengesellschaft

[...]

**OBERLANDESGERICHT DÜSSELDORF (HIGHER REGIONAL COURT,
DÜSSELDORF, GERMANY)**

ORDER

In the legal proceedings between

ACACIA S.R.L., [...]

[...], Italy,

defendant and appellant,

[...]

v

Bayerische Motoren Werke Aktiengesellschaft, [...], Munich,

claimant and respondent,

[...]

[Or. 2] on 31 August 2020 the 20th Civil Chamber of the Oberlandesgericht Düsseldorf (Higher Regional Court Düsseldorf, Germany) [...], after hearing the parties,

made the following order:

I.

The proceedings are stayed.

II.

The Oberlandesgericht Düsseldorf refers to the Court of Justice of the European Union the following questions on the interpretation of Article 82(5) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (Community Designs Regulation; ‘the CDR’)

for a preliminary ruling:

1. In proceedings for an infringement of Community designs, can the national court dealing with the infringement proceedings having international jurisdiction pursuant to Article 82(5) of the CDR apply the national law of the Member State in which the court dealing with the infringement proceedings is situated (*lex fori*) to subsequent claims in relation to the territory of its Member State?
2. If Question 1 is answered in the negative: Can the ‘initial place of infringement’ for the purposes of the CJEU judgments in Cases C-24/16, C-25/16 (*Nintendo v BigBen*) regarding the determination of the law applicable to subsequent claims under 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’) (‘the Rome II Regulation’) also lie in the Member State **[Or. 3]** where the consumers to whom internet advertising is addressed are located and where goods infringing designs are put on the market within the meaning of Article 19 of the CDR, in so far as only the offering and the putting on the market in that Member State are challenged, even if the internet offers on which the offering and the putting on the market are based were launched in another Member State?

G r o u n d s

A)

- 1 The claimant is a car manufacturer. It is, inter alia, the registered holder of Community design No 001598277-0002 ('the Registered Design'), filed and registered on 5 August 2009 and published on 14 January 2010.

The defendant, an Italian company, manufactures rims for motor vehicles in Italy and sells them throughout the European Union. In Germany, it markets rims under the name 'WSP Italy', including the 'Neptune GT' model.

- 2 The claimant considers that the distribution of the rims in Germany by the defendant constitutes an infringement of its Registered Design, whereas the defendant invokes the repair clause in Article 110 of the CDR.
- 3 The Landgericht (Regional Court) , in accordance with the form of order sought, ordered the defendant – geographically limited to the Federal Republic of Germany – to cease and desist, to provide information, to return documents and to surrender items for the purpose of destruction, and established the defendant's obligation to pay damages. It based its international jurisdiction on Article 82(5) of the CDR and assumed that the defendant had infringed the Registered Design, and applied German law to the subsequent claims asserted (damages, information, rendering of accounts, [Or. 4] return of documents and surrender of items for the purpose of destruction) in accordance with Article 8(2) of the Rome II Regulation.
- 4 The defendant brought an appeal against that judgment. It continues to rely in particular on Article 110 of the CDR. In addition, it takes the view that under Article 8(2) of the Rome II Regulation Italian law is applicable to the subsequent claims asserted by the claimant.

Consideration of the questions referred

- 5 The resolution of the dispute hinges on the questions referred for a preliminary ruling. It is a decisive factor for the dispute whether the subsequent claims put forward by the claimant are to be assessed under German or Italian law. The Chamber assumes that the court hearing the action has international jurisdiction under Article 82(5) of the CDR, that the defendant infringed the Registered Design and that it cannot rely on Article 110 of the CDR because the conditions laid down by the Court of Justice of the European Union in its judgment of 20 December 2017 (C-397/16 and C-435/16) are not been satisfied. According to German law, the asserted claims for damages, information, rendering of accounts, return of documents and surrender of items for the purpose of destruction are also well-founded. The defendant, by contrast, submitted an Italian legal opinion according to which the claimant has no right under Italian law to the rendering of accounts and return of documents (which are not covered by Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights and have therefore not been harmonised). The ruling at first instance would therefore potentially have to be amended if Italian law was to be applied to the subsequent claims.

- 6 The claimant takes the view that Article 8(2) of the Rome II Regulation is applicable only if acts of infringement are the subject of a dispute in several Member States. Only then – as in *Nintendo v Big Ben* (C-24/16 and C-25/16) – would the question arise as to which law is applicable. The claimant sees this view confirmed by the decision of the CJEU of 5 September 2019 (C-172/18, *AMS Neve*) [Or. 5]. The claimant argues that if the infringer is not accused of acts of infringement in several Member States but only in one State – here, in Germany – it is not appropriate to link the jurisdiction under Article 82(5) of the CDR to a substantive law which is not the *lex fori* of the court dealing with the infringement proceedings. In this case, in which only the offering, the putting on the market and the importing of the rims by the defendant in Germany is being challenged, the applicable law is that of the country in which the infringement was committed and not the law of the place where the initial act of infringement on which the conduct complained of is based – here: the production of the rims and offering in different Member States – occurred. According to the claimant, German law must therefore be applied to the subsequent claims asserted.
- 7 It is, however, doubtful whether the judgment of the CJEU of 5 September 2019 (C-172/18, *AMS Neve*) is to be regarded as a limitation of or departure from its judgment of 27 September 2017 (C-24/16 and C-25/16 *Nintendo v Big Ben*) and whether, in the case of an action based on a Community design and relating solely to acts of infringement in Germany, the action is governed solely by German law under Article 8(2) of the Rome II Regulation. This would run counter to the spirit of the Rome II Regulation, which is to private international law by applying the same substantive law to infringements in the whole of the European Union irrespective of the place of jurisdiction. If the claimant's legal position were to apply, this would mean that a different substantive law would apply to a legal action with an EU-wide scope than to an action limited to one Member State only, even if the actions each concern the same act and the same prejudice. Therefore, Article 8(2) of the Rome II Regulation militates in favour of applying Italian law to the subsequent claims asserted under Articles 89(1)(d) and 88(2) of the CDR in conjunction with Article 8(2) of the Rome II Regulation because the defendant is established in Italy and supplies the products at issue to Germany from there.

[...]