



Press and Information

Court of Justice of the European Union

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Advocate General's Opinion in Case C-235/09
DHL Express (France) SAS v Chronopost SA

Advocate General Cruz Villalón considers that an order of a competent national court prohibiting an infringer from continuing to use a registered Community trade mark has, in principle, effect throughout the entire area of the European Union

The domestic courts of the other Member States must recognise coercive measures which ensure compliance with the prohibition and enforce them in accordance with their national law

The Community trade mark regulation¹ provides for a uniform intellectual property right effective throughout the entire area of the European Union and, for the purposes of protecting that right, establishes a two-tier system of specialised jurisdiction. On the one hand, the Office for Harmonisation in the Internal Market (OHIM), from whose decisions an appeal may lie to the General Court and, ultimately, the Court of Justice, decides disputes between private parties and the administration responsible for registering Community trade marks. On the other hand, the 'Community trade mark courts', a limited number of national courts of first and second instance designated by each Member State, decide disputes between private parties. In the context of that system, the national courts act as special courts of the European Union.

In accordance with the Regulation, where Community trade mark courts find infringement or threatened infringement of a Community trade mark, they are to issue an order prohibiting the infringer from proceeding with the acts which infringed or would infringe the Community trade mark. They may also take such measures in accordance with their national law as are aimed at ensuring that that prohibition is complied with.

Chronopost SA is the proprietor of the French and Community trade marks 'WEBSHIPPING' relating, in particular, to services for the collection and delivery of mail. After those marks had been registered, DHL Express (France) SAS used the same word to designate an express mail management service accessible principally via the internet. In 2007, the Tribunal de Grande Instance de Paris (Regional Court, Paris), acting as a Community trade mark court, declared that there had been trade-mark infringement, prohibited DHL from proceeding with the acts constituting the infringement, and imposed a periodic penalty payment on it, that is to say, a financial penalty should it fail to comply with the prohibition.

At last instance, DHL brought an appeal in cassation before the Cour de Cassation (Court of Cassation, France). Chronopost, for its part, lodged a cross-appeal contesting the fact that the effects of the prohibition and the periodic penalty payment had been limited to French territory. In that context, the Cour de Cassation made a reference to the Court of Justice for a preliminary ruling in order to ascertain, in essence, the territorial scope of the prohibition issued by a Community trade mark court and of the coercive measures adopted in order to ensure that that prohibition is complied with.

In his Opinion delivered today, Advocate General Cruz Villalón considers, first, that, in principle, **a prohibition issued by a national court acting as a Community trade mark court has effect as a matter of law throughout the entire area of the European Union.**

¹ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

In that connection, the Advocate General recalls that the Regulation confers jurisdiction on the competent national court to declare that a trade mark has been infringed in one or more Member States, so that its proprietor may apply to a single court in order to bring the acts of infringement to an end in several Member States. The declaration of infringement relates to a trade mark granted by the European Union, whose judicial protection is entrusted to special national courts of the EU and therefore, in principle, the declaration has effect throughout the entire area of the EU.

However, where the infringement or action for infringement is limited to a specific geographical or linguistic area, the court's order is limited territorially. It follows that, since the prohibition is the natural consequence of the declaration of infringement, the territorial scope of the prohibition corresponds, in principle, to the scope of the infringement.

Second, the Advocate General considers that **coercive measures have effect within the territory in which the declaration of infringement was made and the prohibition issued.**

In fact, the quantification and enforcement of those measures take place at a later stage, when, if the prohibition has been infringed, the penalty is applied. The court which has imposed the periodic penalty payment will have jurisdiction as regards its quantification and enforcement only where the prohibition is infringed in the Member State of that court. By contrast, where the prohibition is infringed in another Member State, quantification and enforcement will be a matter for the court of that Member State.

However, in order to ensure that the prohibition is complied with, **the court of the Member State in which the prohibition has been infringed is obliged to recognise the effects of the periodic penalty payment imposed by the Community trade mark court** of the other Member State, in accordance with the rules on recognition laid down by the Brussels I Regulation².

At the same time, such measures must be adjusted to the specific features of each legal system. Thus, the court of the Member State in which the prohibition has been infringed, **if its national law so permits, is simply to recognise the order and apply the periodic penalty payment to the specific case.** By contrast, **if its national law does not provide for such a measure, it must achieve enforcement in accordance with its own national provisions.**

NOTE: The Advocate General's Opinion is not binding on the Court of Justice. It is the role of the Advocates General to propose to the Court, in complete independence, a legal solution to the cases for which they are responsible. The Judges of the Court are now beginning their deliberations in this case. Judgment will be given at a later date.

NOTE: A reference for a preliminary ruling allows the courts and tribunals of the Member States, in disputes which have been brought before them, to refer questions to the Court of Justice about the interpretation of European Union law or the validity of a European Union act. The Court of Justice does not decide the dispute itself. It is for the national court or tribunal to dispose of the case in accordance with the Court's decision, which is similarly binding on other national courts or tribunals before which a similar issue is raised.

Unofficial document for media use, not binding on the Court of Justice.

The [full text](#) of the Opinion is published on the CURIA website on the day of delivery.

Press contact: Christopher Fretwell ☎ (+352) 4303 3355

² 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).