

# Case C-316/05

**Nokia Corp.**

**v**

**Joacim Wärdell**

(Reference for a preliminary ruling from the Högsta domstolen)

(Community trade mark — Article 98(1) of Regulation (EC) No 40/94 — Infringement or threatened infringement — Obligation of a Community trade mark court to issue an order prohibiting a third party from proceeding with such acts — Definition of ‘special reasons’ for not issuing such a prohibition — Obligation of a Community trade mark court to take such measures as are aimed at ensuring that such a prohibition is complied with — National legislation laying down a general prohibition of infringement or threatened infringement coupled with penalties)

Opinion of Advocate General Sharpston delivered on 13 July 2006 . . . . . I - 12086

Judgment of the Court (First Chamber), 14 December 2006 . . . . . I - 12099

## Summary of the Judgment

1. *Community trade mark — Disputes relating to infringement and validity of Community trade marks — Penalties in case of infringement or threatened infringement — Obligations of the Community trade mark courts*  
(Council Regulation No 40/94, Art. 98)

2. *Community trade mark — Disputes relating to infringement and validity of Community trade marks — Penalties in case of infringement or threatened infringement — Obligations of the Community trade mark courts*  
(Council Regulation No 40/94, Art. 98)
3. *Community trade mark — Disputes relating to infringement and validity of Community trade marks — Penalties in case of infringement or threatened infringement — Obligations of the Community trade mark courts*  
(Council Regulation No 40/94, Art. 98)

1. The term 'special reasons' relieving a Community trade mark court of the obligation to issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark, contained in the first sentence of Article 98(1) of Regulation No 40/94 on the Community trade mark, must be given a uniform interpretation within the Community legal order.

form throughout the entire area of the Community.

(see paras 27, 28)

2. As an exception to the obligation on the Community trade mark courts under the first sentence of Article 98(1) of Regulation No 40/94 on the Community trade mark to issue an order prohibiting the defendant from proceeding with infringement or threatened infringement the condition relating to 'special reasons for not doing so' must be interpreted strictly. Furthermore, the term 'special reasons' relates to factual circumstances specific to a given case.

If that term were to be interpreted differently in the various Member States, the same circumstances could give rise to prohibitions of further infringement or threatened infringement in some Member States and not in others, such that, the protection afforded to Community trade marks would not be uni-

It follows that Article 98(1) of Council Regulation (EC) No 40/94 of 20 Decem-

ber 1993 on the Community trade mark is to be interpreted as meaning that the mere fact that the risk of further infringement or threatened infringement of a Community trade mark is not obvious or is otherwise merely limited does not constitute a special reason for a Community trade mark court not to issue an order prohibiting the defendant from proceeding with those acts and the same holds true for the fact that the national law includes a general prohibition of the infringement of Community trade marks and provides for the possibility of penalising further infringement or threatened infringement, whether intentional or due to gross negligence.

(see paras 30, 36, 38, 45,  
operative part 1, 2)

3. Article 98(1) of Regulation No 40/94 on the Community trade mark is to be interpreted as meaning that a Community trade mark court which has issued an order prohibiting the defendant from proceeding with infringement or threatened infringement of a Community trade mark is required to take such measures, in accordance with its

national law, as are aimed at ensuring that that prohibition is complied with, even if the national law includes a general prohibition of infringement of Community trade marks and provides for the possibility of penalising further infringement or threatened infringement, whether intentional or due to gross negligence.

In that regard, that court is required to take, from among the measures provided for under national law, such as are aimed at ensuring that that prohibition is complied with, even if those measures could not, under that law, be taken in the case of a corresponding infringement of a national trade mark. By introducing an absolute requirement for Community trade mark courts to take such measures when they issue an order prohibiting further infringement or threatened infringement, the Community legislature has precluded the national law of a Member State from making such measures contingent on compliance with additional conditions.

(see paras 53, 58, 62,  
operative part 3, 4)