

Case C-184/21

Summary of the request for a preliminary ruling pursuant to Article 98(1) of the Rules of Procedure of the Court of Justice

Date lodged:

24 March 2021

Referring court:

Tribunal de l'entreprise francophone de Bruxelles (Belgium)

Date of the decision to refer:

22 March 2021

Applicant:

Mr Christian Louboutin

Defendants:

Amazon.com, Inc.

Amazon Services LLC

I. Subject matter and facts of the main proceedings:

- 1 Mr Christian Louboutin is the proprietor of the position mark known as the 'red sole', represented and described as follows in the registration documents for goods in Class 25 'high-heeled shoes (other than orthopaedic footwear)', namely EU trade mark registration No 8845539 and Benelux trade mark registration No 0874489:



‘The mark consists of the colour red (Pantone 18-1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)’.

- 2 The Amazon group offers online sales of various goods and services, both directly on its own behalf and indirectly for third-party sellers.
- 3 Amazon regularly displays on its websites advertisements for red-soled shoes put on the market without Mr Christian Louboutin’s consent.
- 4 On 1 March 2019, Mr Christian Louboutin brought proceedings on the basis of his Benelux trade mark before the President of the tribunal de l’entreprise francophone de Bruxelles (Brussels Companies Court (French-speaking)), Belgium, seeking injunctory relief against Amazon Europe core, Amazon eu and Amazon services Europe.
- 5 By judgment of 7 August 2019, the President of that court held that the use made of the trade mark in all the advertisements complained of was attributable to the parties against which the proceedings had been brought and prohibited its use subject to a financial penalty.
- 6 By judgment of 25 June 2020, the cour d’appel de Bruxelles (Court of Appeal, Brussels) set aside the judgment in part and decided, in particular, that only the advertisements relating to shoes sold by Amazon could be the subject of prohibitory measures, as the use of the other advertisements could be attributed only to the third-party sellers.
- 7 Mr Christian Louboutin appealed on a point of law against that judgment.
- 8 On 19 September 2019, Mr Christian Louboutin brought proceedings before the tribunal d’arrondissement de Luxembourg, (District Court, Luxembourg), on the basis of his EU trade mark, against Amazon Europe core, Amazon eu and Amazon services Europe (also ‘Amazon’), which, in various capacities, operate the websites amazon.fr, amazon.de, amazon.es, amazon.it and amazon.co.uk aimed more specifically at consumers in the European Union, seeking an injunction against their use of his trade mark and damages for the harm caused by its use.
- 9 By judgment of 5 March 2021, the tribunal d’arrondissement de Luxembourg (District Court, Luxembourg) submitted to the Court of Justice a request for a preliminary ruling, which is currently pending as Case C-148/21.
- 10 On 4 October 2019, Mr Christian Louboutin brought proceedings on the basis of his EU trade mark before the President of the tribunal de l’entreprise francophone de Bruxelles (Brussels Companies Court (French-speaking)) against the companies governed by United States law Amazon.com, Inc. and Amazon Services LLC (together also ‘Amazon’), who jointly operate the website

amazon.com, aimed at, inter alia, consumers in the European Union, seeking an injunction on the use of its trade mark, subject to financial penalties.

II. European Union law:

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

11 Article 9 provides, in the passages of interest in the present case:

‘Rights conferred by an EU trade mark

1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

...

3. The following, in particular, may be prohibited under paragraph 2:

(a) affixing the sign to the goods or to the packaging of those goods;

(b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

(d) using the sign as a trade or company name or part of a trade or company name;

(e) using the sign on business papers and in advertising;

(f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC.

...’

III. Positions of the parties:

Mr Christian Louboutin

- 12 The applicant bases his action for an injunction and for damages on Article 9(2)(a) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, complaining of Amazon's use, without his consent, of an identical sign (the red sole) for identical goods in the course of trade.
- 13 As regards the concept of use in the course of trade in relation to goods, Mr Christian Louboutin emphasises that use may cover both acts carried out in public, for example in advertising, and acts concealed from the public, such as holding goods for the purpose of placing them on the market.
- 14 Mr Christian Louboutin maintains that the singularity, the vast power and the enormous success of Amazon, one of the largest companies in the world by market valuation, lie primarily in the fact that it has put in place highly efficient logistics that enable it to fulfil orders in record time. Amazon thus has 175 fulfilment centres throughout the world, a total of 14 million square metres in which approximately 250 000 persons work, who are responsible for receiving and stocking suppliers' goods, taking all orders and managing them, such management often going so far as to include shipping by Amazon of the goods ordered and dealing with any returns.

Mr Christian Louboutin observes that in its communication Amazon consistently highlights that singularity, which enhances its image as a distributor.

- 15 Mr Christian Louboutin notes that it is common ground that Amazon promotes all the goods thus offered by displaying on its website advertisements representing the goods and stating their selling price, and that all of those advertisements are essentially characterised as follows:
 - They all meet very strict presentation criteria imposed by Amazon, which confers on all the advertisements a high degree of uniformity which inevitably gives the impression that they come from the same source;
 - They all present only a single dominant distinctive sign, namely the semi-figurative Amazon sign represented below, a mark that has acquired a considerable reputation as a mark of a distributor of a vast range of goods:



- That dominant distinctive sign is found at the top of each advertising offer, Amazon alone deciding on the display of that heading, of which it retains control.

In addition, Mr Christian Louboutin further observes that those advertisements are all grouped under general or 'browse-tree' headings by category of products ('Fashion', 'Electronics', 'Home and Kitchen', 'Luggage' – 'Mode', 'Electronique', 'Maison et Cuisine', 'Bagagerie'), and under various descriptive headings such as 'Amazon best sellers', 'Amazon most wished for', 'Amazon gift ideas', 'Amazon hot new releases', etc.

He adds that the way in which those advertisements are displayed involves the systematic use by Amazon of the possessive adjective 'our', which clearly refers to Amazon in, for example, the expressions 'our most popular products based on sales', 'our best-selling new and future releases', 'our biggest gainers in sales rank over the past 24 hours', 'our most popular products offered as gifts', 'our top deals', 'our selection', 'our warehouses – 'nos produits les plus demandés', 'nos meilleures ventes actuelles et futures', 'nos plus grosses ventes ces dernières 24 heures', 'nos meilleures affaires', 'notre sélection', 'nos magasins' etc.

- 16 In this instance, Mr Christian Louboutin has established that a very large number of advertisements of that type have recently been displayed on the website amazon.com.
- 17 Mr Christian Louboutin observes that it is only by consulting, by means of a succession of clicks, all the details of those offers that it is then made clear whether the goods offered are, if they are ordered:
- sold and shipped by Amazon, which, in Mr Louboutin's submission, is perfectly consistent with Amazon's vaunted image of distributor; or
 - shipped by Amazon, although sold by a third party; or
 - sold and shipped by a third party, in which case that information is disclosed rather discretely, which is no doubt explained by the fact that those methods are scarcely consistent with Amazon's vaunted economic model.

Mr Louboutin observes that in those three cases Amazon takes care of the advertising for those products in uniform presentations, takes the orders and collects the price of the sale.

In the first two cases, Amazon also assumes responsibility for stocking the goods ordered, packaging them (possibly as a 'gift') under its Amazon mark and shipping them under that mark to the purchaser, and dealing with returns.

In the last case, the purchaser receives from Amazon, following payment and delivery, an invoice issued by that third party.

In the last two cases, Amazon deducts a commission evaluated at an average of 15% of the selling price, in addition to the costs of handling the goods (storage and shipment) in the second case.

- 18 Mr Christian Louboutin maintains that there is every indication, moreover, that most of the prices displayed are fixed by Amazon, even for the goods allegedly sold by third parties. Those third parties have a strong incentive to agree – in order for their goods to be displayed in a favourable position! – that their prices be fixed by a set of algorithms employed by Amazon, and the price may thus change at any time according to a series of constantly updated parameters.

He also observes that, unlike the way in which offers posted on the Amazon website are presented, all the similar offers posted on the online marketplaces operated by eBay, Facebook, Google, Marktplaats and Alibaba clearly show that they are posted by third parties, which a reasonably well informed and reasonably observant internet user knows to be the case because those websites are known to be marketplaces.

- 19 As for the attributability of the act of use of the trade mark, Mr Christian Louboutin claims, first of all, that it follows from the judgment of 3 March 2016, *Daimler* (C-179/15, EU:C:2016:134) that the use referred to is attributable to any person who has played an active role in carrying out the act constituting that use and has direct or indirect control of it. Ruling on the analogous provision of Directive 2008/95 on trade marks, the Court of Justice observed:

‘39 With regard, first, to the wording of Article 5(1), it must be noted, by way of example that, according to its ordinary meaning, the expression “zu benutzen”, “using”, “faire usage”, “usare”, “het gebruik”, “használ”, used respectively in the German, English, French, Italian, Dutch and Hungarian versions of that provision, involves active behaviour and direct or indirect control of the act constituting the use. However, that is not the case if that act is carried out by an independent operator without the consent of the advertiser, or even against his express will.

40 Secondly, as regards the scheme of Article 5 of Directive 2008/95, it should be noted that Article 5(3), which lists in a non-exhaustive manner the types of use which the trade mark proprietor may prohibit (see judgment in *Google France and Google*, C-236/08 to C-238/08, EU:C:2010:159, paragraph 65 and the case-law cited), refers exclusively to active behaviour on the part of the third party, such as that of “affixing” the sign on the goods and their packaging or “using” it in business papers and advertising, “offering” the goods, “putting them on the market” or “stocking” them for those purposes, “importing” or “exporting” them or “offering” or “supplying” services under that sign.

41 Finally, with regard to the purpose of Article 5(1) of Directive 2008/95, it is clear from that provision that it is intended to provide the proprietor with a legal instrument allowing him to prohibit, and to prevent, any use of his trade mark by a third party without his consent. However, only a third party who has direct or indirect control of the act constituting the use is effectively able to stop that use and therefore comply with that prohibition.’

- 20 Mr Christian Louboutin adds that it is indeed therefore in situations where carrying out the act constituting use has involved no active behaviour that the Court of Justice, in its earlier case-law, held that use could not be attributed to third parties who merely created ‘the technical conditions necessary’ for others to commit the act constituting use:
- Thus, a mere internet referencing service supplier (judgment of 23 March 2010, *Google France and Google* (C-236/08 to C-238/08, EU:C:2010:159, paragraphs 57 and 58);
 - By analogy, a mere host (in the information society) of an advertisement reproducing the sign, since such a host merely carries out, as a matter of law, an act of a ‘mere technical, automatic and passive nature, which implies that the supplier has neither knowledge of nor control over the information which is transmitted or stored’ (judgment of 12 July 2011, *L’Oréal and Others*, C-324/09, EU:C:2011:474, paragraphs 3, 101 and 102);
 - Or the third party who, on the instructions of a third party, ‘merely’ performs the production stage consisting in filling cans already bearing the sign (judgment of 15 December 2011, *Frisdranken Industrie Winters*, C-119/10, EU:C:2011:837, paragraphs 29 and 30);
 - Or, a third party who merely provides a warehouse service (judgment of 16 July 2015, *TOP Logistics and Others*, C-379/14, EU:C:2015:497, paragraph 45).
- 21 Mr Christian Louboutin further submits that it follows from the order of 19 February 2009, *UDV North America* (C-62/08, EU:C:2009:11), that the fact that the third party is acting as an intermediary, or that that third party has no title to the goods covered by the use, or even that that third party is not an interested party in relation to the sale of the goods covered by that use, is irrelevant.
- 22 He adds that although it is thus clear from the case-law of the Court of Justice that the ultimate criterion in assessing the attributability of the use is whether or not the third party played an active role in the commission of the act constituting use, the Court of Justice sometimes uses the complementary or alternative test of ‘own commercial communication’, in order to determine the attributability of a use in a (commercial) communication (judgments of 23 March 2010, *Google France and Google*, C-236/08 to C-238/08, EU:C:2010:159, paragraph 57; of 12 July 2011, *L’Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 102; and of 16 July 2015, *TOP Logistics and Others*, C-379/14, EU:C:2015:497, paragraphs 41 and 42).
- 23 Mr Christian Louboutin further claims that, with more specific regard to the use of an identical sign in advertising, the Court of Justice stated in its judgment of 5 September 2019, *AMS Neve and Others* (C-172/18, EU:C:2019:674):

‘54 Accordingly, the expression “the act of infringement” must be understood as relating to acts, specified in Article 9, which the applicant claims to have been committed by the defendant, such as, in this case, acts specified in Article 9(2)(b) and (d) of that article, consisting of advertising and offers for sale under a sign identical to the mark at issue, and those acts must be held to have been “committed” in the territory where they can be classified as advertising or as offers for sale, namely where their commercial content has in fact been made accessible to the consumers and traders to whom it was directed. Whether the result of that advertising and those offers for sale was that, thereafter, the defendant’s products were purchased is, however, irrelevant.’

24 Mr Christian Louboutin infers that it therefore follows from the case-law of the Court of Justice that:

- A use (for goods in the course of trade) may be attributed to any person who has played an active role in carrying out the act constituting use and has been able to control it, directly or indirectly;
- Consequently, the fact of acting as an intermediary does not preclude the status of third-party user, unless, as in the case of a mere host or a mere warehousekeeper, the intermediary only offers a neutral service by reference to the act constituting use;
- Consequently, again, the use of a sign in an advertisement is attributable to any person who has incorporated it in his commercial communication, irrespective of whether that advertisement leads to purchases from which that third party profits.

25 Mr Christian Louboutin also refers to the judgment of 30 April 2020, *A (Infringement by importing ball bearings)* (C-772/18, EU:C:2020:341, paragraph 27) according to which: ‘As regards whether the person concerned can be considered to have himself used a sign identical to a trade mark, although that person was acting in the economic interests of a third party, it must be observed that, in order to identify use in the course of trade, ownership of the goods on which the trade mark is affixed is of no relevance. The Court has held that the fact that an economic operator uses a sign corresponding to a trade mark in relation to goods which are not his own goods – in the sense that he does not have title to them – does not in itself prevent that use from falling within the scope of Article 5(1) of Directive 2008/95 (see, to that effect, judgment of 12 July 2011, *L’Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 91).’

26 Mr Christian Louboutin therefore submits that the advertisements at issue form an integral part of Amazon’s commercial communication, since they show, at the top of each advertisement, Amazon’s semi-figurative trade mark, which is a trade mark of a well-known distributor, and also since in their composition they resemble the normal advertisements of large distributors, namely advertisements

bearing the distributor's trade mark, a reproduction of the goods being offered and their price.

- 27 Furthermore, Mr Christian Louboutin also claims that the answer to the question whether an advertisement forms part of a given person's own commercial communication must be assessed from the viewpoint of the reasonably well informed and reasonable observant consumer at whom that advertisement is aimed.
- 28 In Mr Christian Louboutin's view, there is every reason to think, as a matter of common sense and by analogy with the settled case-law of the Court of Justice on communications aimed at consumers, in particular on the internet, that the perception of those communications by the target audience is very relevant in the assessment of the nature and lawfulness of such communications, including by the use of trade marks, which are communication tools *par excellence*. He observes that it is thus settled case-law that it is from the viewpoint of the relevant public that infringements of a trade mark, by the use of an identical or similar sign, must be assessed.
- 29 Mr Christian Louboutin states that the Court of Justice has not yet ruled on that important question. He therefore proposes that a question for a preliminary ruling be referred to the Court of Justice.
- 30 Mr Christian Louboutin adds that not only is Amazon actively involved in the content of the advertisements at issue, but in particular that, by their uniform presentation, containing a mixture of Amazon's own goods and third parties' goods, those advertisements all seem to be Amazon's own advertisements, which is not the case of advertisements posted on large platforms such as Google, eBay, Alibaba or Rakuten. He adds that Amazon's appropriation of those advertisements is also demonstrated by the fact that Amazon offers most of the services traditionally offered by the sellers of the goods featured in those advertisements.
- 31 Mr Christian Louboutin further takes issue with Amazon for using a sign that infringes his trade mark when shipping goods bearing that sign. He observes that Amazon does not dispute that the fact of shipping to a purchaser goods bearing a sign identical with a trade mark constitutes an act of use of that sign, just like the acts, expressly set out in the regulation, of importing or exporting such goods.
- 32 As for the attributability of such an act, it cannot in Mr Christian Louboutin's submission, be covered by the exemptions from liability set out in Article 14(1) of Directive 2000/31. Mr Christian Louboutin refers in that regard to the Opinion of Advocate General Campos Sánchez-Bordona in *Coty Germany* (C-567/18, EU:C:2019:1031, points 62 and 63):

‘Those exemptions are limited to the technical process of operating and giving access to a communication network over which information made available by third parties is transmitted or temporarily stored. They cannot therefore be applied to an activity such as the physical storage and material delivery of goods.

Furthermore, the Court of Justice has held that Article 14(1) of Directive 2000/31 does not apply to an electronic market operator that plays an active role such as providing “assistance which entails, among other things, optimising the presentation of the offers for sale ... or promoting those offers”.’

- 33 Mr Christian Louboutin therefore considers that use, in the form of the shipment of goods, is definitely attributable to the shipper, in this instance Amazon, who knows or is deemed to know that the goods bear the sign.

He further maintains that Amazon cannot contend that that use could be imputed to it only if it had actual knowledge of the infringement, which it does not have, as it does not visually inspect all the goods which it ships. Mr Christian Louboutin refers on that point to the Opinion of Advocate General Campos Sánchez-Bordona in *Coty Germany* (C-567/18, EU:C:2019:1031, point 82):

‘Given the significant extent to which those undertakings are involved in the marketing of goods under that program, it is reasonable to expect them to exercise special care (diligence) when it comes to monitoring the lawfulness of the goods in which they trade. The very fact that they are aware that, without such monitoring, they might easily act as a channel for the sale of “unlawful, counterfeit, pirated or stolen goods, [and the sale of] goods in an unlawful or unethical manner, violating the proprietary rights of others”, means that they cannot simply relieve themselves of their liability by attributing it exclusively to the seller.’

- 34 Mr Christian Louboutin concludes that the shipment by Amazon of shoes bearing an infringing sign is an unlawful use that can be attributed to Amazon.
- 35 He emphasises that in the judgment of 2 April 2020, *Coty Germany* (C-567/18, EU:C:2020:267), the Court of Justice explicitly proceeds on the assumption that, first, the warehousekeeper is not aware of the infringement and, second, that it is a third party that puts the goods on the market. He claims that it is ‘audacious’ to infer from that judgment that the same answer would have to be given if the warehousekeeper or the shipper was aware of the infringement.

Mr Christian Louboutin maintains, moreover, that shipping goods to a consumer who has ordered them cannot be treated as the same as merely holding the goods, since the shipping, when it is done to fulfil an order, implies that the shipper is aware of what it is shipping.

Amazon

- 36 In response, Amazon states, first of all, that it does not dispute that the use of a sign in an advertisement may constitute use of a trade mark. It submits, however, that ‘offers of what are alleged to be infringing shoes published by third-party sellers on its websites and the shipping of those shoes sold by those third-party sellers do not constitute use of the trade mark by Amazon’. It adds that, according

to settled case-law, it cannot be held liable, as the operator of an online marketplace, for the (unauthorised) use of a trade mark by third parties.

- 37 Amazon relies on the judgment of 25 June 2020 (referred to in paragraph 6), in which the cour d'appel de Bruxelles (Court of Appeal, Brussels) held:

‘13. Consequently, the use of the trade mark in an advertisement for the sale of infringing goods placed by a third-party seller is not attributable to the operator of the online marketplace – even if the latter’s identity is visible, because it does not form part of its own commercial communication. The fact that the sales advertisement is the act of the third party seller, and not that of the operator of the online marketplace, which is an objective fact, is sufficient to preclude use by that operator.

The [Court of Justice] does not require, moreover, that the public perceives that the sales advertisement is placed by the third-party seller and not by the operator of the online marketplace; the public perception is therefore immaterial for the purpose of determining the person who has perpetrated the unlawful use of the sign in the present context. ...

15. It does not assist Mr Christian Louboutin to highlight the judgment [of 12 July 2011, *L’Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 116] in which the [Court of Justice] defines the circumstances in which the operator must be considered to have taken a neutral position or, on the contrary, to have played an active role (its assistance having entailed, in particular, optimising the presentation of the offers for sale or promoting those offers). Those considerations relate to the liability of the operator of the online marketplace in the light of the directive on e-commerce: according to the [Court of Justice], the fact that the operator of the website played an active role in devising the advertisement may have the effect, where appropriate, of depriving it of the benefit of the limitations placed on its liability, in the light of the general rules on liability. ...

16. Nor does it assist Mr Christian Louboutin to rely on the principles stated in the judgment [of 3 March 2016, *Daimler*, C-179/15, EU:C:2016:134], as the facts of that case are clearly different from those that gave rise to the judgment [of 12 July 2011, *L’Oréal and Others*, C-324/09, EU:C:2011:474] and from those of the present dispute. In the judgment in *Daimler*, it was acknowledged that it was the seller – the person who had placed an advertisement – and not the operator of the website hosting the advertisement that was the user of the trade mark that appeared in the advertisement. The question referred to the [Court of Justice] concerned whether the seller continued to use the mark if the advertisement was displayed against its wishes and its efforts to remove it. That judgment, referring to the judgments [in *Google France and Google*, C-236/08 to C-238/08, EU:C:2010:159, paragraphs 51 and 52, and also in *Frisdranken Industrie Winters*, C-119/10, EU:C:2011:837, paragraph 36], begins by stating that the publication online of an advertisement on a website is attributable to the advertiser who ordered that advertisement and upon whose instruction the operator of that site, as

service provider, acted. Admittedly, the judgment goes on to state that the advertisement ceases to be attributable to that advertiser if the website operator continues to display it although the advertiser has expressly asked him to remove it ([judgment of 3 March 2016, *Daimler*, C-179/15, EU:C:2016:134], paragraph 34). In doing so, however, the judgment in *Daimler* does not call into question the fact that the advertisement continues to be attributable to the advertiser (and not to the operator of the website) so long as its display on the website is in accordance with the advertiser’s instructions; and, above all, it does not rule on the attributability of the use of the mark to the operator of the website. In addition, where the judgment establishes the need for active behaviour on the part of the third party referred to in Article 5 of Directive 2008/95 (affixing the sign, using it in business papers or advertising, offering the goods, holding them, putting them on the market, importing or exporting ... them), it is emphasising the need for the act of use complained of to be done by a person who has control of the use, since only a person “who has direct or indirect control of the act constituting the use is effectively able to stop that use and therefore comply with that prohibition” ([judgment of 3 March 2016, *Daimler*, C-179/15, EU:C:2016:134], paragraph 41).

17. It follows from the foregoing that in this instance the use of a sign complained of in the advertisements that appear on the websites Amazon.fr and Amazon.de on behalf of a third-party seller – whether or not its identity is mentioned – is attributable to that third-party seller and not to Amazon itself, even though the public would have a different perception, notably that the offer for sale came from the operator of the website that used the trade mark in the context of its own business mark.

In the light of the foregoing, there is no need to refer the second question for a preliminary ruling suggested by Mr Christian Louboutin, since it is based on the false premiss that the public perception of the advertiser would be relevant’.

- 38 Amazon infers from that judgment that in this instance, too, it must be held that the reproduction, in the advertisements which Amazon considers are placed by third-party sellers for high-heeled shoes, of signs that are identical with Mr Christian Louboutin’s trade mark, does not constitute a use of the mark that can be attributed to Amazon.
- 39 Amazon further submits, with regard to whether it is appropriate to have regard to the perception of the average reasonably well informed and reasonably observant consumer, at whom an advertisement is aimed, in order to determine whether that advertisement is the result of a person’s commercial communication, that, contrary to Mr Christian Louboutin’s claim, the Court of Justice has already answered that question.
- 40 Amazon maintains in that regard that the fact that the judgment of 12 July 2011, *L’Oréal and Others* (C-324/09, EU:C:2011:474) does not at any point mention the perception of the consumer demonstrates that that aspect is not relevant for the

purpose of answering that question. In fact, in Amazon's submission, by not taking the consumer's perception into account when examining whether the use of a trade mark is attributable to a party (such as the operator of an online marketplace), the Court of Justice implicitly but indisputably ruled on that question.

- 41 The Court of Justice thereby clearly indicated that that factor is not relevant and that it is not to be taken into account in the evaluation of the attributability of the use of a trade mark. Amazon therefore maintains that, for the Court of Justice, the perception of the consumer is not relevant for the purpose of determining the attributability of a trade mark to the operator of an online marketplace.
- 42 Amazon further submits that, in the judgment of 2 April 2020, *Coty Germany* (C-567/18, EU:C:2020:267), the Court of Justice clearly indicated that, where an economic operator does not itself pursue the objective of offering the goods or putting them on the market, it cannot be concluded that the act constituting use of the mark is carried out by that person, or that the sign is used in that person's own commercial communication.
- 43 Amazon refers on that point too to the judgment of the cour d'appel de Bruxelles (Court of Appeal, Brussels) referred to above, according to which:

'28. That act does not however constitute an act of use by Amazon. ...

29. ... It follows in essence from the judgment in *Coty* that use of the trade mark is not attributable to the economic operator which does not itself pursue the purpose of offering the goods for sale under the sign complained of ([judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267], paragraphs 45 and 47) – that economic operator being the operator of an online marketplace, and also a storage service in relation to goods for the purpose of shipping them. The [Court of Justice] refers in that regard to its case-law, according to which "the fact of creating the technical conditions necessary for the use of a sign and being paid for that service does not mean that the party offering the service itself uses the sign" (*ibid.*, paragraph 43).

Although the [Court of Justice] makes an exception for two situations in which use of the mark in the sales offer is attributable to an economic operator of the 'online marketplace operator' type, those situations do not apply to Mr Christian Louboutin's claim. In the first situation, the economic operator itself offers goods for sale under the sign complained of and stocks them on its own behalf and not on behalf of third parties, and in the second situation it is unable to identify the third-party seller (*ibid.*), paragraph 48).

Although the [Court of Justice] dealt only with the question referred to it – the question for a preliminary ruling being concerned with the stocking of the infringing goods on behalf of a third party sellers – the findings of that judgment can be transposed to shipment, since that is merely an extension of the first act, constituting as it were 'holding in motion'. That finding must be made even if the

stockist – or, in this instance, the shipper – knows or is deemed to know that the goods bear an infringing sign.

30. There is no need to refer a new question to the [Court of Justice], since the solution has already been clearly indicated by the it.

Mr Christian Louboutin’s appeal is unfounded on that point’.

Amazon therefore submits that, in the present case too, the question of the attributability of Amazon of the shipping of ‘identical goods’ (high-heeled shoes) ‘bearing a sign identical with the trade mark’ which are sold by third-party sellers must be answered in the same way: there is no use of the mark by Amazon that is attributable to Amazon.

IV. Findings of the [referring] court:

- 44 The referring court rejects the pleas of inadmissibility raised by Amazon, declares that it has international jurisdiction under Article 125(1) of Regulation 2017/1001 (formerly Article 97 of Regulation No 207/2009), since the two companies against which the action is brought, established in a third country, have an establishment in Belgium in the person of either the limited company Amazon Web Services Belgium [srl] or the limited company Amazon Data Services Belgium [srl]. The court recalls that ‘it is ... irrelevant whether the establishment thereby determined has participated in the alleged infringement. Such a requirement, which is not laid down in Article 97(1) of Regulation No 207/2009, would, in addition, not be reconcilable with the need for a broad interpretation of the concept of “establishment” ...’ (judgment of 18 May 2017, *Hummel Holding*, C-617/15, EU:C:2017:390, paragraph 40) and rejects Amazon’s applications for the cancellation of the EU mark relied on and the stay of the proceedings..
- 45 The referring court considers that the answer to the question of the circumstances in which the use of an infringing sign in an advertisement might be attributed to the operator of an online shop which is also a distributor is necessary for the resolution of the dispute before it.
- 46 The question whether, and in what circumstances, the perception of the public by reference to that advertisement would be relevant to the determination of the attributability of such use must also be referred to the Court of Justice.
- 47 The referring court considers that the answer to the question of the relevance of the circumstances in which goods bearing a sign that infringe a trade mark are shipped is necessary for the purpose of determining the application of Article 9(2) of Regulation 2017/1001 on the European Union trade mark in the present case.

V. The questions for a preliminary ruling:

48 The court refers to the Court of Justice the following questions for a preliminary ruling:

First question:

Must Article 9(2) of Regulation 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark be interpreted as meaning that the use of a sign identical with a trade mark in an advertisement displayed on a website is, in principle, attributable to its operator if, in the perception of a reasonably well informed and reasonably observant internet user, that operator has played an active part in the preparation of that advertisement or if that advertisement may be perceived by such an internet user as forming part of that operator's own commercial communication?

Will such perception be influenced:

- by the fact that that operator is a well-known distributor of a wide range of goods, including goods in the category of those featured in the advertisement; or
- by the fact that the advertisement thus displayed presents a heading in which the service mark of that operator is reproduced, that mark being well known as a distributor's trade mark; or
- furthermore, by the fact that, as well as displaying that advertisement, that operator offers services traditionally offered by distributors of goods in the same category as that to which the goods featured in the advertisement belong?

Second question:

Must Article 9(2) of Regulation 2017/1001 on the European Union trade mark be interpreted as meaning that the shipment, in the course of trade and without the consent of the proprietor of a trade mark, to the final consumer of goods bearing a sign identical with the mark constitutes a use attributable to the shipper only if the shipper has actual knowledge that that sign has been affixed to those goods?

Is such a shipper the user of the sign concerned if the shipper itself or an economically linked entity has informed the final consumer that it will undertake that shipment after it or an economically linked entity has stocked the goods for that purpose?

Is such a shipper the user of the sign concerned if the shipper itself or an economically linked entity has previously made an active contribution to the display, in the course of trade, of an advertisement for the goods bearing that sign or has taken the final consumer's order on the basis of that advertisement?