

Case C-628/21

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:

11 October 2021

Referring court:

Sąd Okręgowy w Warszawie (Poland)

Date of the decision to refer:

21 July 2021

Applicant:

TB

Other parties to the proceedings:

Castorama Polska Sp. z o.o., 'Knor' Sp. z o.o.

Subject matter of the main proceedings

Request for information about the origin and distribution networks of goods or services infringing an intellectual property right

Subject matter and legal basis of the request

Interpretation of Article 8(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights read in conjunction with Article 4(1)(a) of that directive – Legal basis: Article 267 TFEU

Questions referred for a preliminary ruling

(a) Should Article 8(1) read in conjunction with Article 4(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights be understood to refer to a measure to protect intellectual property rights only when the rightholder's intellectual property right has been confirmed in these or other proceedings?

– if Question (a) is answered in the negative

(b) Should Article 8(1) of the directive, read in conjunction with Article 4(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights be interpreted as meaning that it is sufficient to substantiate the fact that that measure refers to an existing intellectual property right, and not to prove that circumstance, especially in a case where a request for information about the origin and distribution networks of goods or services precedes the assertion of claims for compensation on account of an infringement of intellectual property rights?

Provisions of European Union law and case-law relied on

Recital 13, Article 4(1)(a), Article 8(1) and Article 9(1) and (2) of Directive 2004/48;

Judgment of 16 July 2009, *Infopaq International*, C-5/08, EU:C:2009:465;

Judgment of 18 January 2017, *NEW WAVE CZ*, C-427/15, EU:C:2017:18;

Provisions of national law relied on

Ustawa z dnia 17 listopada 1964 r. – Kodeks postępowania cywilnego (Law of 17 November 1964 – Code of Civil Procedure, ‘the CCP’) (*Dziennik Ustaw* (Journal of Laws) of 2020, item 1575, consolidated text; ‘the CPC’) – Articles 278, 479⁸⁹, 479¹¹² and 479¹¹³;

Ustawa z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych (Law of 4 February 1994 on copyright and related rights) (*Dziennik Ustaw* (Journal of Laws) of 2021, item 1062, consolidated text) – Article 1;

Ustawa z dnia 16 kwietnia 1993 r. o zwalczaniu nieuczciwej konkurencji (Law of 16 April 1993 on combating unfair competition) (*Dziennik Ustaw* (Journal of Laws) of 2020, item 1913, consolidated text) – Article 3 and Article 13(1);

Succinct presentation of the facts and procedure in the main proceedings

- 1 For the purposes of the preliminary proceedings, the referring court has accepted that the facts are as follows.
- 2 TB, the rightholder in the main proceedings, is the owner of online shops selling decorative items. As part of its business activity, the rightholder sells machine-produced reproductions of the images labelled as A, B and C. The rightholder states that it is the creator of the images that it reproduces, which it believes are works, as defined by copyright law. Each of the images contains an uncomplicated graphic consisting of several colours and geometric figures and short sentences.

- 3 Exact copies of images A and B are sold without the rightholder's consent in the online shop and in the physical shops of obligor No 1 (the company Castorama Polska), to which they are supplied by obligor No 2 (the company Knor). Neither the reproductions originating from the rightholder, nor the reproductions supplied to obligor No 1 by obligor No 2 contain details of the authorship or origin of the product. Obligor No 1 also sells images supplied by obligor No 2 that contain identical text to image C, but with variations in terms of graphics and font.
- 4 A visual comparison of the images is as follows:

Graphic A of the rightholder



Graphic A sold by the obligor (**exact copy**)



Graphic B of the rightholder



Graphic B sold by the obligor (**exact copy**)



Graphic C of the rightholder

Graphic C sold by the obligor (**identical text, differences in terms of graphic elements and font**)

W NASZYM DOMU
RANO SŁYCHAĆ
TUPOT MAŁYCH STÓPEK
ZAWSZE PACHNIE
PYSZNYM CIASTEM
 MAMY DUŻO OBOWIĄZKÓW
 MNÓSTWO ZABAWY I
MIŁOŚCI

W naszym DOMU
 rano słychać
TUPOT MAŁYCH STÓPEK
 Zawsze pachnie
PYSZNYM CIASTEM
 Mamy dużo obowiązków
 Mnóstwo zabawy i
MIŁOŚCI

- 5 After previously filing a pre-litigation request to obligor No 1 to desist from its copyright infringement, the rightholder filed the request sent to the referring court dated 15 December 2020 for the obligors to provide information about the distribution network, a full list of suppliers, information about the quantities of goods received and ordered, the date of first marketing the goods in physical shops and in the online shop, the quantity of goods sold in physical shops and in the online shop and the price received from the sale of the goods, broken down into physical sales and online sales.
- 6 The legal basis for the request was given as Article 479¹¹³ of the CPC, as the provision implementing Article 8 of Directive 2004/48. In its request, the rightholder referred to images (graphics), reproductions of which are sold by obligor No 1 and supplied to them by obligor No 2, pointing out that it holds the financial and personal copyright to these images. It indicated that the information requested was required for further assertion of the copyright infringement claims and possible compensation claims for unfair competition. The request for information was therefore submitted prior to the start of the proceedings that would result in the possible determination of an intellectual property right infringement, which means that the request is not accompanied at this point by claims seeking to protect intellectual property rights.
- 7 Obligor No 1 requested that the application be dismissed and applied for the possible issue of as narrow a judgment as possible, limited only to works as defined by copyright law (questioning, however, the status of the images in question as works). It also referred to the protection of business secrets and to the fact that the rightholder did not indicate that it held the financial copyright to the products sold, since the intellectual creations to which the application refers are not original. Accepting the rightholder's request would therefore signify the granting of copyright protection to the concepts and ideas since the reproductions to which the request refers fit with the current trend of so-called simplified motivational graphics containing trivial sentences such as 'be positive' and 'don't forget to smile'. Obligor No 1 believes that all of the graphic elements of the

disputed reproductions are trivial, reproducible and in no way original (in terms of their composition, colours, use of fonts, etc.) compared with other graphics available on the market.

- 8 After examining the response of obligor No 1, the rightholder did not submit any evidence to demonstrate the existence of intellectual property rights through an expert opinion on the graphics and design.
- 9 The referring court learned of this *ex officio* and presented the parties with its doubts concerning the interpretation of European Union law (Article 8(1) of Directive 2004/48), especially in reference to the response to the question of the need to **prove** or merely **substantiate** the nature of the legal interest to which the proceedings refer, taking into account the fact that Articles 6 and 7 of Directive 2004/48 use different wording and Article 4 of Directive 2004/48, which recognises persons entitled to seek application of the measures, procedures and remedies as the holders of intellectual property rights. The court also had concerns about the possibility of a variable standard of evidence – and therefore the existence or absence of active procedural legitimisation – depending on whether this interest is a work or a product that does not have the characteristics of a work and is not protected by exclusive rights.

The essential arguments of the parties in the main proceedings

- 10 The rightholder and obligor No 2 did not take a position regarding the concerns of the referring court, while obligor No 1 stated that pursuant to Article 8 of Directive 2004/48, implemented by Article 479¹¹³, paragraph 1, of the CPC, the violation of an intellectual property right must be proven, not merely substantiated.

Succinct presentation of the reasoning in the request for a preliminary ruling

- 11 The referring court must issue a decision on the validity of the request for information about the origin and distribution networks of the goods or services which infringe an intellectual property right. A prerequisite for this decision is a determination as to whether the rightholder holds the intellectual property right. This is, however, conditional upon the answer to the question of whether the right to which the rightholder refers is linked to interests protected under Directive 2004/48 and whether this circumstance should be confirmed in the proceedings to provide information, or merely substantiated.
- 12 The referring court notes that in accordance with recital 13 of Directive 2004/48, it covers all the intellectual property rights covered by Community provisions in this field or by the national law of the Member State concerned, including copyright. Its provisions may also be extended, for internal purposes, to include ‘acts involving unfair competition, including parasitic copies, or similar activities’.

- 13 Although the referring court believes that Polish case-law does not provide an unequivocal answer in this respect, for the purposes of this case this court accepts the interpretation by which national law, for internal purposes, has extended the application of the provisions of Directive 2004/48 to acts of unfair competition consisting of the exact copying of products (even if they are not subject to copyright, rights to a registered trademark or other exclusive rights). Therefore, in terms of images A and B, there is no issue with the interpretation of European Union law. The rightholder has certainly not only substantiated but also proved that obligor No 1 sold products that were an exact copy of its images A and B.
- 14 A decision on the request in terms of image C, however, requires the interpretation of European Union law. In the case of this image, we are not dealing with a copy of the external form of the product. What has been used is the text, maintaining its layout on the page, but using other graphic elements and other fonts. The referring court therefore needs to determine whether we are dealing with a work.
- 15 According to Polish case-law, the examination of the features of a work, in terms of its creativity, is a task for the relevant court, which in principle does not have to seek the opinion of an expert in this respect, unless a particular case is complicated by the factual matters of the case and the judge's experience is insufficient. It is also accepted that the burden of proof and the submission of a request for an expert opinion lies with the party, so the court should notify the party if it has doubts in this respect.
- 16 Polish legal commentators have adopted two contradictory viewpoints on the interpretation of Article 479¹¹³ of the CPC, which implements Article 8 of Directive 2004/48. According to one viewpoint, the circumstances indicating an infringement of a right must be reliably demonstrated, which results in an obligation to prove this, rather than just substantiate it. According to the other viewpoint, there is no need to prove the infringement, but merely substantiate it since a claim for information under Article 8(1) of the directive may be sent not only to the infringer but also to a third party.
- 17 Concerns regarding the interpretation of Article 8(1) of Directive 2004/48 influence the interpretation of Article 479¹¹³ of the CPC. Their settlement affects the way in which the request for information is settled. So, if Article 8(1) of Directive 2004/48 is to be understood to refer to a measure to protect intellectual property rights only when an infringement is proven in relation to the interest of the copyright holder, then in a situation where the court is unable to carry out an independent assessment without the support of an expert on account of a lack of specialist knowledge, the request in this respect should be dismissed (if such evidentiary proceedings with the participation of an expert are not carried out). However, if substantiation is sufficient and it is not necessary to confirm (or assume) the existence of an intellectual property right in these proceedings, but only substantiate this, the request for information should be accepted in full.

- 18 The concerns regarding the interpretation of Article 8(1) of Directive 2004/48 also come from the fact that Article 4(1)(a) of Directive 2004/48 states that ‘Member States shall recognise as persons entitled to seek application of the measures, procedures and remedies referred to in this Chapter: ... the holders of intellectual property rights, in accordance with the provisions of the applicable law’. It is the court’s view that this provision shows that the issue of entitlement to an intellectual property right should be proven and not merely substantiated. Protective measures are for the rightholder, not the person who is the alleged subject of the intellectual property rights.
- 19 In turn, Article 9(1) of Directive 2004/48 refers to the concept of the alleged infringer – which indicates that the matter of the infringement itself does not have to be prejudged unequivocally in reference to the measures set out in Articles 6, 7 and 8 of Directive 2004/48 – but this concept is not applicable to the applicant rightholder. In turn, in accordance with Article 4(1)(a) of Directive 2004/48, this may only be the holder of the intellectual property rights.
- 20 In the referring court’s opinion, the judgment of the Court of Justice of the European Union of 18 January 2017, *NEW WAVE CZ*, C-427/15, EU:C:2017:18, shows that a request for information (pursuant to Article 8(1) of Directive 2004/48) may be submitted in the context of court proceedings concerning an infringement of an intellectual property right, with it not being necessary in the proceedings relating to the right to information to confirm the infringement of an intellectual property right, which means that the applicant has only to substantiate the circumstances of the infringement. It seems clear, therefore, that Article 8(1) of Directive 2004/48 recognises the right to information in order to determine the scope, extent and fact of an intellectual property right infringement in the event of the uncertainty of the rightholder in terms of these facts.
- 21 This reasoning, however, cannot be applied to the issue determining the submission of a request for information (Article 8(1) of Directive 2004/48), in other words the matter of whether a given person holds the intellectual property right at all. If we acknowledge that this issue may only be substantiated, we would be dealing with an imbalance between basic rights – to the detriment of the commercial secrets, business secrets and business interests to which the request for information refers. In the proceedings to request information, the information required should be provided to determine the scope and source of the infringement. It does not seem reasonable to simultaneously adopt this same standard in relation to the fact of whether a given person is the intellectual property right holder. This matter should be confirmed, rather than merely substantiated
- 22 Taking the above comments into account, the referring court proposes that Question (a) be answered in the affirmative. If that question is answered in the negative, the court proposes answering Question (b) in the negative, in other words that it is not sufficient to substantiate that the protective measure in

question concerns an existing intellectual property right, **since that circumstance would need to be proven.**

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