

Anonymised version

Translation

C-76/24 – 1

Case C-76/24

Request for a preliminary ruling

Date lodged:

1 February 2024

Referring court:

Bundesgerichtshof (Germany)

Date of the decision to refer:

23 January 2024

Defendant and appellant on a point of law:

Tradeinn Retail Services S.L.

Applicant and respondent on a point of law:

PH

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BUNDESGERICHTSHOF
(FEDERAL COURT OF JUSTICE)

ORDER

[...]

Made on:
23 January 2024
[...]

in the case

Tradeinn Retail Services S.L., [...] Celra (Girona), Spain,

Defendant and appellant on a point of law,

[...]

v

PH, [...] Schierling,

Applicant and respondent on a point of law,

[...]

At the hearing on 31 August 2023, [...] the First Civil Chamber of the Federal Court of Justice

made the following order:

- I. The proceedings are stayed.
- II. The following questions are referred to the Court of Justice of the European Union for a preliminary ruling on the interpretation of Article 10(3)(b) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1):
 1. Is a proprietor of a national trade mark, under Article 10(3)(b) of Directive (EU) 2015/2436 allowed to prohibit a person in another country from stocking goods that infringe his or her trade mark for the purpose of offering those goods or putting them on the market in the country in which the trade mark is protected?
 2. Does the concept of stocking within the meaning of Article 10(3)(b) of Directive (EU) 2015/2436 depend on the possibility of actually accessing goods in infringement of trade mark or is the possibility of being able to influence the person with actual access to those goods sufficient?

Grounds:

- 1 A. The applicant is the proprietor of the following word and figurative trade marks registered with the German Patent and Trade Mark Office for, inter alia, ‘diving equipment, diving suits, diving gloves, diving masks and breathing apparatus for diving’:

No 30426551



and No 30426550



- 2 The defendant, which is established in Spain, used the applicant's trade marks to advertise or offer diving accessories via its website www.scubastore and via the trading platform www.amazon.de. In so doing, it sometimes used product photos that showed goods bearing the applicant's trade marks.
- 3 Among other things, the defendant advertised under the applicant's trade marks, via the trading platform www.amazon.de, a trim pocket which the applicant had acquired as part of a test purchase on 8 June 2019. The applicant's trade marks were not printed either on the packaging or on the trim pocket supplied.
- 4 Following an unsuccessful cease-and-desist letter of 15 September 2020, the applicant sought an injunction requiring the defendant, on pain administrative penalties specified in more detail, to refrain from

using the signs in question (the applicant's German word and figurative trade marks No 30426551 and/or No 30426550) in connection with diving accessories in the course of trade in the Federal Republic of Germany without the consent of the trade mark proprietor, in particular by affixing the signs to diving accessories or to the presentation or packaging thereof, offering, manufacturing and distributing diving accessories under those signs or otherwise putting them on the market, and advertising or stocking them for those purposes.
- 5 The applicant also sought a declaration as to the defendant's liability for damages, and an order requiring it to disclose information and reimburse the costs of the cease-and-desist letter, plus interest.
- 6 The defendant acknowledged the existence of the claim, in so far as the applicant had sought an injunction requiring it to refrain from offering or advertising diving accessories, and in so far as the applicant had requested – in relation to those acts – an order for the disclosure of information and a declaration of liability for damages.
- 7 The Regional Court, partially acknowledging the existence of the applicant's claim, gave final judgment against the defendant in accordance with the latter's acknowledgement of the existence of that claim and, in addition, awarded to the

applicant the costs of the cease-and-desist letter in the amount of EUR 1,398.25 plus interest. It dismissed the further heads of claim.

- 8 On appeal by the applicant against that judgment, the appeal court added to the injunction issued against the defendant the words ‘and distributing [diving accessories] or stocking [them] for that purpose’, extended the related heads of claim repeated on appeal to those unlawful acts and, in addition, ordered the defendant to reimburse the costs of the case-and-desist letter in the amount of EUR 1,822.96 plus interest. It dismissed the further grounds of appeal (OLG Nürnberg (Higher Regional Court, Nuremberg), GRUR 2023, 260).
- 9 By its appeal on a point of law which the appeal court allowed it to bring, and which the applicant claims should be dismissed, the defendant seeks to have the judgment of the Regional Court reinstated.
- 10 B. The success of the appeal on a point of law depends on the interpretation of Article 10(3)(b) of Directive (EU) 2015/2436. Before a decision is given on the appeal on a point of law, the proceedings must therefore be stayed and a preliminary ruling obtained from the Court of Justice of the European Union under subparagraph (b) of the first paragraph and the third paragraph of Article 267 TFEU.
- 11 I. The appeal court considered the applicant’s appeal to be admissible and in part well-founded. By way of grounds for that view, it held – in so far as its findings are relevant to the appeal on a point of law – as follows:
- 12 German courts have international jurisdiction under Article 7(2) and Article 26(1) of Regulation (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Brussels Ia Regulation).
- 13 The claim for injunctive relief for breach of trade mark extends beyond the infringing acts of ‘advertising’ and ‘offering’ to the essentially identical acts of ‘distributing’ and ‘stocking’. In this regard, it is necessary to start from the principle that all forms of conduct provided for in Paragraph 14(3) of the MarkenG (Markengesetz; Law on Trade Marks) are essentially identical and, if only one of those forms of conduct materialises, the presumption as to the existence of a risk of repetition extends to the others too. In the light of the circumstances of this case, it does not seem entirely out of the question that the defendant has not only advertised and offered products in breach of trade mark but has also distributed and stocked the products advertised and offered. The acts of use consisting in ‘distributing’ and ‘stocking’ are the subject also of the ancillary claims for a declaration of liability for damages and the disclosure of information.
- 14 If the cease-and desist letter is fully justified, the applicant is entitled to claim reimbursement of the costs thereof in the amount of EUR 1,822.96 plus interest. Contrary to the view taken by the Regional Court, there is no question of reducing that claim on the ground that the cease-and-desist letter is only partially justified.

- 15 II. The action is admissible (see in this regard section B II 1). The success of the appeal on a point of law depends on the interpretation of Article 10(3)(b) of Directive (EU) 2015/2436 (see in this regard section B II 2).
- 16 1. The action is admissible. So far as the defendant, which is established in Spain, is concerned, the international jurisdiction of the German courts [...] arises in any event from its having entered an appearance not in order to contest the jurisdiction, as provided for in the first sentence of Article 26(1) of the Brussels 1a Regulation. [...].
- 17 2. In so far as the appeal on a point of law is directed against the appeal court's assessment that judgment must be given against the defendant because of its stocking of diving accessories in breach of the applicant's trade marks, the success of the appeal depends on questions concerning the interpretation of Article 10(3)(b) of Directive (EU) 2015/2436 that require clarification. Also dependent on those questions is the issue as to whether it was right for the defendant to be ordered to disclose information and to be found liable for damages in this regard.
- 18 a) The claims pursued by the applicant are to be assessed under German law. In accordance with Article 8(1) of Regulation (EC) No 864/2007 (Rome II Regulation), the law applicable to a non-contractual obligation arising from an infringement of an intellectual property right is to be the law of the country for which protection is claimed. That law calls for an assessment in particular of the existence of the right in question, the proprietorship of that right by the injured party, the substance and scope of the protection and the defining elements and legal consequences of an infringement of that right (settled case-law; see BGH (Federal Court of Justice), GRUR 2022, 1675 (paragraph 31) – *Google-Drittauskunft*, with further references). Since the subject matter of this action is made up of claims arising from an infringement of German trade marks, the law applicable in the present dispute is German trade mark law.
- 19 b) The use of signs that is complained of by the applicant exhibits the necessary economically relevant connection with national territory.
- 20 aa) Because of the principle of territoriality applicable in intellectual property law, the scope of the protection commanded by a domestic trade mark is limited to the territory of the Federal Republic of Germany. A claim to injunctive relief under Paragraph 14(2) and (5) of the MarkenG and claims to damages and the disclosure of information under Paragraph 14(6) and Paragraph 19(1) of the MarkenG are therefore conditional upon an act of use in breach of trade mark law performed in national territory (see BGH, judgment of 13 October 2004 – I ZR 163/02, GRUR 2005, 431 [juris, paragraph 21] = WRP 2005, 493 – *HOTEL MARITIME*; judgment of 7 November 2019 – I ZR 222/17, GRUR 2020, 647 [juris, paragraph 25] = WRP 2020, 730 – *Club Hotel Robinson*). An act of use is normally present where goods or services are offered under the sign in question in national territory (BGH, GRUR 2005, 431 (paragraph 21) – *HOTEL MARITIME*;

BGH, judgment of 8 March 2012 – I ZR 75/10, GRUR 2012, 621 (paragraph 34) = WRP 2012, 716 – *OSCAR*; judgment of 9 November 2017 – I ZR 134/16, GRUR 2018, 417 (paragraph 37) = WRP 2018, 466 – *Resistograph*). However, not every offer of services or goods from another country that is available on the internet in national territory triggers claims under trade mark law in the event of double identity or likelihood of confusion with a domestic trade mark. Rather, such a claim requires that the offer exhibit a sufficient economically relevant connection with national territory ('commercial effect'). That condition is fulfilled where the conduct complained of is centred in national territory and not in another country. If the conduct complained of is centred in another country, it must be established, on the basis of an overall assessment of the circumstances, whether a sufficient economically relevant connection with national territory exists (see BGH, GRUR 2018, 417 (paragraph 37) – *Resistograph*, with further references; GRUR 2020, 647 (paragraph 28) – *Club Hotel Robinson*).

- 21 bb) The conduct of which the defendant is accused is centred not in another country but in national territory. The appeal court found that the defendant had advertised and offered products in breach of trade mark via websites accessible in Germany and intended for the domestic market. It also found that the defendant had delivered to Germany and placed on the market in Germany goods offered and advertised under the trade marks at issue. These acts of infringement substantiate the necessary connection with national territory, even though the defendant is established in Spain, maintains a European online sales network, does not deliver to Germany alone and stocks the goods it distributes in Spain. Since the conduct of which the defendant is accused is centred in national territory and not in another country, there is no need for any special determinations, to be made by way of an overall assessment of the interests and circumstances concerned, as to whether the conduct complained of has a sufficient economically relevant connection with national territory.
- 22 c) In accordance with point 1 of the first sentence of subparagraph (2) and the first sentence of subparagraph (5) of Paragraph 14 of the MarkenG, anyone who, without the consent of the proprietor of the trade mark, uses in the course of trade, in relation to goods or services, a sign identical to the trade mark for goods or services which are identical to those for which the trade mark enjoys protection may, in the event of a risk of repetition of that infringement, be the subject of an action for an injunction brought by the proprietor of the trade mark. In accordance with the second sentence of Paragraph 14(5) of the MarkenG, a claim to injunctive relief exists even in the event of the risk of a first-time infringement. If the conditions laid down in Paragraph 14(2) of the MarkenG are met, it is prohibited, in particular, to offer the goods, put them on the market or stock them for those purposes under the sign (point 2 of Paragraph 14(3) of the MarkenG) and to use the sign on business papers and in advertising (point 6 of Paragraph 14(3) of the MarkenG). The provisions thus contained in Paragraph 14(2) and (3) of the MarkenG transpose Article 10(2)(a) and (3)(b) and (e) of Directive (EU) No 2015/2436 and must therefore be interpreted in accordance with that directive (see BGH, judgment of 28 June 2018 – I ZR 236/16, GRUR 2019, 165

(paragraph 15) = WRP 2019, 200 – *‘keine-vorwerkvertretung.de’*; judgment of 12 January 2023 – I ZR 86/22, GRUR 2023, 808 (paragraph 14) = WRP 2023, 715 – *DACHSER*).

- 23 d) The appeal court based its assessment on the fact that the defendant had committed trade mark infringements as provided for in point 1 of the first sentence of Paragraph 14(2) of the MarkenG inasmuch as it had used in the course of trade signs identical to the trade marks at issue in connection with identical goods without the applicant’s consent. According to the appeal court, it is common ground that the defendant offered and advertised products in breach of trade mark via the website operated by itself and via the trading platform *www.amazon.de*. In this regard, the appeal court was also of the view that there was a risk of repetition of the infringement. That assessment is not in dispute between the parties. The defendant has already recognised at first instance the existence of the claims, pursued by the action brought by the applicant, in relation to the acts of use consisting in ‘advertising’ and ‘offering’ diving accessories.
- 24 e) In the view of this Chamber, the challenges advanced by the appeal on a point of law against the appeal court’s assessment that, in addition to the claims in relation to the acts of infringement consisting in ‘offering’ and ‘advertising’, recognised by the defendant, the applicant is entitled to direct the claims pursued by way of the action it has brought also against the form of conduct consisting in distribution (point 1 of the first sentence of subparagraph (2), points 2 and 6 of subparagraph (3), the first sentence of subparagraph (5), and subparagraph (6) of Paragraph 14, and Paragraph 19(1), of the MarkenG), are unsuccessful.
- 25 f) In so far as the applicant seeks an injunction requiring the defendant to refrain from stocking diving accessories, this case raises questions concerning the interpretation of EU law that require clarification.
- 26 aa) The appeal court took the view that the issue of an injunction against the defendant on account of the unauthorised stocking of goods identified by the trade marks at issue with a view to offering them or putting them on the market in the Federal Republic of Germany is not precluded by the fact that the defendant has its registered office in Spain and stocks its goods there. Stocking for the purpose of offering the goods or placing them on the market, it states, is a typical act preparatory to the commission of the infringement itself in the case of which it is immaterial whether the unlawful act of stocking, which is in principle internal to the undertaking concerned, was committed in national territory or in another (European) country. The sole decisive factor is whether the purpose associated with that act, of offering the goods or putting them on the market in national territory, has either already occurred or is imminent. Since the defendant’s internet offer is intended for the German public, the goods are stocked for the direct purpose of being offered in national territory. They are also stocked for the purpose of being put on the market in Germany. The defendant is established in another EU country and in the Schengen area, maintains a European online sales

network consisting of 17 individual stores and can fulfil orders directly and at a cost comparable with that incurred by a German trader.

- 27 bb) This Chamber interprets the operative part and the grounds of the judgment on appeal as meaning that the appeal court prohibited the defendant from stocking diving accessories in breach of trade mark for the purpose of offering and distributing them. It is true that, on the basis of the sentence structure and wording of the operative part of the judgment on appeal, the prohibition of stocking goods in breach of trade mark relates only to ‘that purpose’ consisting in distribution. From the grounds of that judgment, however, it is apparent beyond any doubt that stocking for the purpose of offering goods in breach of trade mark is also intended to be prohibited. This Chamber will, if necessary, clarify the operative part of the judgment on appeal in its judgment on the appeal on a point of law.
- 28 The operative part of that judgment must also be interpreted as meaning that the appeal court prohibited the defendant from stocking the goods for the aforementioned purposes in the Federal Republic of Germany and in the Kingdom of Spain. In so doing, the appeal court correctly interpreted the form of order sought by reference to the grounds of the application.
- 29 cc) In order for the form of conduct consisting in the unauthorised stocking of goods provided for in point 2 of Paragraph 14(3) of the MarkenG to be realised, the objective element, in the form of stocking goods infringing the rights in the trade mark, and the subjective element, in the form of stocking deliberately for the purpose of bringing the goods to market by means of any legal transaction, including by offering them, must be present (see the Opinion of Advocate General Campos Sánchez-Bordona of 28 November 2019 in *Coty Germany*, C-567/18, EU:C:2019:1031, point 48). Since the scope of the protection commanded by a domestic trade mark is confined to the territory of the Federal Republic of Germany, the offering or putting on the market of goods in breach of trade mark must be aimed at national territory.
- 30 dd) According to the findings of the appeal court, the subjective element is present on the part of the defendant. It stocks the diving accessories in breach of the trade marks at issue for the purpose of putting those goods on the market in the Federal Republic of Germany by any legal transaction, including by offering them.
- 31 ee) The question, however, is whether Article 10(3)(b) of Directive (EU) 2015/2436 allows the proprietor of a national trade mark to have a person in another country prohibited from stocking goods that infringe his or her trade mark for the purpose of offering them or putting them on the market in the country where the trade mark is protected (first question referred for a preliminary ruling).
- 32 (1) This could be precluded by the principle of territoriality. According to the concurring case-law of the Court of Justice of the European Union and the German Federal Court of Justice, the principle of territoriality applicable in intellectual property law states, first, that the conditions for the protection of a

national protective right are governed by the law of the State in which that protection is sought, and, secondly, that the protection enjoyed by national intellectual property rights is confined to national territory and only acts committed in national territory are punishable (on trade mark law, see judgment of 22 June 1994, *IHT Internationale Heiztechnik and Danzinger*, C-9/93, EU:C:1994:261 = GRUR Int. 1994, 614 (paragraph 22) ; judgment of 19 April 2012, *Wintersteiger*, C-523/10, EU:C:2012:220, GRUR 2012, 654 (paragraph 25); BGH, judgment of 25 April 2012 – I ZR 235/10, GRUR 2012, 1263 (paragraph 17, 23 et seq.) = WRP 2012, 1530 – *Clinique happy*; BGH, GRUR 2020, 647 (paragraph 25) – *Club Hotel Robinson*, with further references; on copyright law, see judgment of 14 July 2005, *Lagardère Active Broadcast*, C-192/04, EU:C:2005:475 = GRUR 2006, 50 (paragraph 46). This would indicate that anyone stocking goods abroad, even for the purpose of offering them and putting them on the market under the sign in question in national territory, does not infringe a domestic trade mark.

- 33 (2) However, it is also conceivable to regard it as sufficient – as the appeal court does – for a national trade mark to be infringed that the goods be stocked in another country for the purpose of being offered and put on the market under the sign in question in the country in which that sign is protected. Thus, the Court of Justice of the European Union has already held that a protective right which is protected only in national territory may also be infringed by acts which take place in another country. Thus, a trader established in another country who customises his advertising for the country in which the protective right is protected and creates or makes available for interested parties in that country a specific delivery system and specific methods of payment, or allows a third party to do so, enabling those interested parties to have goods in breach of the protective right delivered to them, commits an act in breach of the protective right in the country in which that right is protected (on copyright, see judgment of 21 January 2012, *Donner*, C-5/11, EU:C:2012:370, GRUR 2012, 817 (paragraph 30) = WRP 2012, 927).
- 34 (3) The first question referred for a preliminary ruling cannot be answered unequivocally by reference to the case-law of the Court of Justice of the European Union. It is true that the Court of Justice has held that the court seized in the country in which the intellectual property right enjoys protection may grant protection in respect of that right even if the damage arises from acts committed in another country that may cause damage in national territory. In those circumstances, the domestic court seized has jurisdiction to rule only on the damage caused in the territory of the Member State in which it is located (see judgment of 3 October 2013, *Pinckney v KDG Mediatech*, C-170/12, EU:C:2013:635, GRUR 2014, 100 (paragraphs 39 and 47) = WRP 2013, 1456). However, that judgment of the Court of Justice of the European Union considered not the question of whether an infringement of the domestic intellectual property right in question was committed by an act performed in another country but directed at national territory, but the scope of the international jurisdiction of the court seized in the country in which that right was protected. The judgment of 21 June 2012, *Donner* (C-5/11, EU:C:2012:370) does not answer the first question

referred for a preliminary ruling either. It was concerned not with trade mark law but with copyright law. It had to do with the question as to whether the marketing of copies [of works] from another country infringes the author's right of distribution in the country in which the copyright on those works is protected. In the present dispute, the first question referred for a preliminary ruling is concerned not with whether the defendant must be prohibited from offering or distributing goods from another country to national territory, but with whether it is possible, on the basis of a national trade mark, to prohibit even the stocking of goods in breach of trade mark in another country for the purpose of offering and distributing them [in national territory]. The judgment of the Court of Justice of the European Union in *Donner* is silent in this regard.

- 35 ff) The present case raises the further question as to whether the concept of stocking within the meaning of Article 10(3)(b) of Directive (EU) 2015/2436 is dependent on the possibility of actually accessing goods in breach of trade mark or whether the possibility of being able to influence the person with actual access to those goods is sufficient (second question referred for a preliminary ruling).
- 36 (1) In accordance with the case-law of the Court of Justice of the European Union, the terms of a provision of EU law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must normally be given an autonomous and uniform interpretation throughout the European Union (see judgments of 3 September 2014, *Deckmyn and Vrijheidsfonds*, C-201/13, EU:C:2014:2132, GRUR 2014, 972 (paragraph 14) = WRP 2014, 1181; and of 13 October 2022, *Gemeinde Bodman-Ludwigshafen*, C-256/21, EU:C:2022:786, GRUR 2022, 1669 (paragraph 33) = WRP 2023, 40). Since Directive (EU) 2015/2436 makes no express reference to the law of the Member States in connection with the concept of stocking, this Chamber takes the view that that concept must be interpreted autonomously and uniformly throughout the European Union.
- 37 (2) Under German law, the concept of possession is broad (see BeckOGK.BGB/Götz, as at 1 October 2023, Paragraph 854, points 25 to 30). In accordance with Paragraph 854(1) of the Bürgerliches Gesetzbuch (German Civil Code) (BGB), possession of a thing is acquired by obtaining actual control of the thing; possession is brought to an end by the possessor giving up actual control of the thing or losing control of it in another way (Paragraph 856(1) of the BGB). Under German law, the generic concept of possession includes not only direct possession characterised by actual control over a thing, as provided for in the aforementioned provisions, but also indirect possession. In accordance with Paragraph 868 of the BGB, if a person possesses a thing on the basis of a relationship by virtue of which he is, in relation to another person, entitled or obliged to possess it for a certain period of time, the other person is also a(n) (indirect) possessor. In the case of a mail order purchase (such as that concluded over the internet in the present case), the logistics service provider who transports the goods from the seller to the buyer becomes the direct possessor under German law. After the goods have been handed over to the forwarding agent or carrier, the

consignor too is the possessor, but only the indirect possessor (see BGH, judgment of 28 June 2001 – I ZR 13/99, TranspR 2001, 471 (paragraph 19); BeckOK.BGB/Fritzsche, 68th edition [as at 1 August 2023], Paragraph 854, point 7; MünchKomm.BGB/ F. Schäfer, 9th edition, Paragraph 854, point 1). Under German law, therefore, when the defendant commissions the dispatch of goods in breach of trade mark, it exercises (indirect) possession of those goods in Germany as soon as they arrive there. The defendant could – as the applicant claims it should – be prohibited from doing so in relation to the territory of the Federal Republic of Germany, if indirect possession, as it is known in German law, were to be regarded as unlawful possession (stocking) within the meaning of point 2 of Paragraph 14(3) of the MarkenG and Article 10(3)(b) of Directive (EU) 2015/2436.

- 38 (3) It is doubtful whether such an assignment of possession to third parties is permissible under Article 10(3)(b) of Directive (EU) 2015/2436.
- 39 In *Coty*, the Advocate General noted that the term ‘possession’ does not appear in all the language versions of Article 9(3)(b) of Regulation 2017/1001 on the European Union trade mark. Only the French (‘détenir’) and the German (‘besitzen’) versions use vocabulary that is directly related to the legal concept of possession (‘possessio’). Other versions, such as, for example, the Spanish, the Italian, the Portuguese, the English and the Swedish (‘almacenarlos’, ‘stoccaggio’, ‘armazená-los’, ‘stocking’ and ‘lagra’), prefer verbs or nouns denoting the action of storing goods. In that case, the Advocate General was convinced that all of the languages convey the idea of possessing for commercial purposes, since storage or possession comes with the requirement that this take place ‘for those purposes’, that is to say for the purposes of offering the goods or putting them on the market, there being no linguistic discrepancies in evidence in the second part of the phrase (Opinion of Advocate General Campos Sánchez-Bordona in *Coty Germany*, C-567/18, EU:C:2019:1031, points 46 and 47).
- 40 The fact that other language versions of Directive (EU) 2015/2436 often use the term ‘stocking’ instead of ‘possession’ indicates rather that the presence of possession within the meaning of Article 10(3)(b) of Directive (EU) 2015/2436 is conditional upon the direct possibility of accessing the goods, and the person who hands over the goods to the forwarding agent or carrier loses possession on handing them over because the ‘stocking’ ends at that point.
- 41 On the other hand, EU law allows the actions of a logistics service provider or carrier engaged by a trader to be attributed to that trader in the case where those actions lead to an infringement of a national protective right. The Court of Justice has thus regarded a trader as being liable not only for every act which the trader himself has carried out but also for acts carried out on his behalf, in the case where it was the objective of the trader concerned to offer and distribute goods in breach of the protective right in question in the country where that right was protected and he could not have been unaware of the conduct of that third party

(on copyright law, see judgment of 21 June 2012, *Donner*, C-5/11, EU:C:2012:370, paragraph 27).

- 42 (4) The answer to the second question referred for a preliminary ruling cannot be found in the case-law of the Court of Justice of the European Union on trade mark law. The judgment in *Donner* concerned copyright law and did not address the question of the attribution of possession. Neither is there any case-law of the Court of Justice of the European Union on the interpretation of the concept of possession in breach of protective rights in EU provisions concerning other industrial property rights in which that concept is used (much as it is in trade mark law) (second sentence of Article 12(1) of Directive 98/71/EC on the legal protection of designs and the second sentence of Article 19(1) of Regulation [EC] No 6/2002 on Community designs).

[...]

Lower courts:

LG Nürnberg-Fürth (Regional Court, Nuremberg- Fürth), decision of 3 February 2022 [...]

OLG Nürnberg (Higher Regional Court, Nuremberg), decision of 29 November 2022 [...] – issued:

Certified

[...]