

Anonymised version

Translation

C-567/18-1

Case C-567/18

Request for a preliminary ruling

Date lodged:

7 September 2018

Referring court:

Bundesgerichtshof (Germany)

Date of the decision to refer:

26 July 2018

Applicant and appellant on a point of law:

Coty Germany GmbH

Defendant and respondent on a point of law:

Amazon Services Europe S.a.r.l.

Amazon FC Graben GmbH

Defendant:

Amazon Europe Core S.a.r.l.

Amazon EU S.A.R.L.

BUNDESGERICHTSHOF (Federal Court of Justice, Germany)

ORDER

[...]

In the case of

Coty Germany GmbH, [...] Mainz,

applicant and appellant on a point of law

[...]

v

1. Amazon Services Europe S.a.r.l., [...] Luxembourg,

defendant and respondent on a point of law,

2. Amazon Europe Core S.a.r.l., [...] Luxembourg,

defendant,

3. Amazon FC Graben GmbH, [...] Graben,

defendant and respondent on a point of law,

4. Amazon EU S.A.R.L., [...] Luxembourg,

defendant,

[...] **[Or. 2]**

The First Civil Chamber of the Bundesgerichtshof has [...]

made the following order:

- I. The proceedings are stayed.
- II. The following question on the interpretation of Article 9(2)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1) and Article 9(3)(b) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1) is referred to the Court of Justice of the European Union for a preliminary ruling:

Does a person who, on behalf of a third party, stores goods which infringe trade mark rights, without having knowledge of that infringement, stock those goods for the purpose of offering them or putting them on the market, if it is not that person himself but rather the third party alone which intends to offer the goods or put them on the market?

Grounds:

- 1 A. The applicant sells perfumes. The defendants are part of the Amazon group. The first defendant is domiciled in Luxembourg, the third defendant has its registered office in Graben, Germany, where it operates a warehouse. **[Or. 3]**
- 2 The applicant claims that it holds a licence for European Union trade mark No 876874 DAVIDOFF, which enjoys protection for ‘perfumes, essential oils, cosmetics’ (‘the contested mark’), and that it is entitled to enforce the trade mark rights associated therewith in its own name.
- 3 The first defendant enables third-party sellers to place offers for sale on ‘Amazon-Marketplace’. The contracts of sale for the goods marketed in that way are concluded between the third-party sellers and the purchasers. The third party sellers may avail themselves of the ‘Fulfilled by Amazon’ scheme under which goods are stored by companies in the Amazon group and dispatched by external service providers.
- 4 On 8 May 2014 one of the applicant’s test purchasers ordered the perfume ‘Davidoff Hot Water EdT 60 ml’ on the website amazon.de offered by the seller OE (‘the seller’) with the comment ‘Fulfilled by Amazon’. In the context of the ‘Fulfilled by Amazon’ scheme, the first defendant entrusted the third defendant with the storage of the goods. In response to a letter of formal notice issued by the applicant on the ground that the rights conferred on the goods in question were not exhausted, the seller submitted a prohibitory injunction coupled with a penalty clause.
- 5 By letter of 2 June 2014, the applicant requested that the first defendant return all of the seller’s ‘Davidoff Hot Water EdT 60 ml’ perfumes. The first defendant sent the applicant’s legal representatives a parcel, with shipment reference TT0034894719, containing 30 of those perfumes. After another company belonging to the group of defendants informed the applicant that 11 out of the 30 perfumes originated from another seller’s stock, the applicant requested that the first defendant disclose the name and address of that other seller, **[Or. 4]** as the rights conferred on 29 out of the 30 perfumes were not exhausted. The first defendant subsequently stated that it was no longer possible to ascertain from which stock the 11 perfumes in question originated.
- 6 The applicant considers the first and third defendants’ conduct infringed its trade mark rights and issued a letter of formal notice to the first defendant in the form of a letter from its legal representatives.
- 7 The applicant – in so far as relevant for the court hearing the appeal on a point of law – asked this Chamber to
 - I. order the first and third defendants
 1. subject to penalties, to desist, in the course of trade, from stocking or dispatching perfumes of the ‘Davidoff Hot Water’ mark in the Federal Republic of Germany for the purposes of putting them on the market

or from letting them be stocked or dispatched for the purposes of putting them on the market, if the goods have not been put on the market by the proprietor of the mark or by a third party with the proprietor's consent in Germany, another Member State of the European Union or another Contracting Party to the Agreement on the European Economic Area;

in the alternative, to make an order as described above in relation to perfumes of the 'Davidoff Hot Water EdT 60 ml' mark;

in the further alternative, to make an order as described above in relation to perfumes of the 'Davidoff Hot Water EdT 60 ml' mark, which have been consigned by the seller OE or which cannot be attributed to another seller;

2. [Claim for information on the consignor of certain perfumes] [...];
[Alternative claim for a statutory declaration] [...];
3. [Claim for information on the manufacturer's serial numbers of certain stored perfumes] [...] **[Or. 5]** [...];
[Alternative claim for a statutory declaration] [...];

II. order the first defendant to pay the applicant EUR 1 973.90 plus interest at the rate of 5% above the basic interest rate as from 24 October 2014.

8 The Landgericht (Regional Court) dismissed the action. The applicant's appeal was unsuccessful [...]. By its appeal on a point of law for which this Chamber has granted leave, and which the first and third defendants contend should be dismissed, the applicant continues to pursue its claim.

9 B. The outcome of the appeal on a point of law depends on the interpretation of Article 9(2)(b) of Regulation (EC) No 207/2009 and Article 9(3)(b) of Regulation (EU) 2017/1001. For that reason, prior to a decision on the appeal, the proceedings must be stayed and a preliminary ruling must be obtained from the Court of Justice of the European Union pursuant to point (b) of the first paragraph of Article 267 TFEU and to the third paragraph of that article.

10 I. The Court of Appeal declared the action admissible, but considered it unfounded and stated the following in that regard:

11 A prohibitory injunction could not be imposed on the third defendant as a perpetrator in respect of the perfumes which it stored for the seller and other consignors. The third defendant did not make use of the contested mark itself. Furthermore, the third defendant did not stock the perfumes for the purpose of offering them or putting them on the market, but merely acted on behalf of the seller. There could be no liability as accomplice or co-perpetrator in the trade

mark infringement, since it is unclear whether the third defendant was aware that the trade mark rights were not exhausted. The third defendant could also not be liable indirectly as a ‘*Störer*’ since the applicant [Or. 6] did not submit that the third defendant was made aware of the trade mark infringement. The third defendant was also not obliged to provide the requested information as a third party.

- 12 Equally, a prohibitory injunction and an obligation to provide information could not be imposed on the first defendant. It neither owned nor dispatched the goods at issue. The first defendant could not be liable as a ‘*Störer*’ since it did not infringe any of the verification duties indicated by the applicant.
- 13 II. The action is admissible (see B II 1). The outcome of the applicant’s appeal on a point of law depends on the interpretation of Article 9(2)(b) of Regulation No 207/2009 and of Article 9(3)(b) of Regulation 2017/1001 (see B II 2).
- 14 1. The action is admissible. [comments] [...]
- 15 2. Whether the appeal on a point of law is successful, in so far as it is directed against the court of appeal’s judgment that the third defendant is not liable as a perpetrator of an infringement of trade mark rights, depends on the interpretation to be given to Article 9(2)(b) of Regulation No 207/2009 and Article 9(3)(b) of Regulation 2017/1001.
- 16 (a) Since the applicant bases its claim for a prohibitory injunction on the risk of a repeat offence, the action is well founded only if the third defendant’s contested behaviour was unlawful at the time when it was undertaken [Or. 7] and is unlawful at the time of the decision on the appeal on a point of law [...]. At the time of the unlawful practices, Article 9(3)(b) of Regulation 2017/1001 replaced the provision contained in Article 9(2)(b) of Regulation No 207/2009 with effect from 1 October 2017. Therefore, there are no legislative changes which are relevant to the dispute. In accordance with both provisions the proprietor of the EU trade mark is entitled to prevent all third parties not having his consent in the course of trade from offering the goods, putting them on the market or stocking them for such purposes under that sign.
- 17 (b) The outcome of the appeal on a point of law depends on whether Article 9(2)(b) of Regulation No 207/2009 and Article 9(3)(b) of Regulation 2017/1001 are to be interpreted as meaning that a person who, without knowledge of the infringement of trade mark rights, stores goods which infringe trade mark rights for a third party, stocks the goods for the purposes of offering or putting them on the market, if it is not that person himself, but the third party alone which intends to offer or put the goods on the market.
- 18 (aa) The appeal on a point of law cannot be upheld in so far as it challenges the assessment of the court of appeal that the third defendant admittedly stocked goods which infringe trade mark rights but, in doing so, did not pursue the

purpose of offering or putting the goods on the market required under Article 9(2)(b) of Regulation No 207/2009 and Article 9(3)(b) of Regulation 2017/1001. [comments]

19 [...] **[Or. 8]** [...]

20 [...]

21 (bb) The resolution of the dispute thus depends on whether a person who, on behalf of a third party, stores goods which infringe trade mark rights, without having knowledge of the infringement of those rights, stocks those goods for the purpose of offering them or putting them on the market, if it is not that person himself, but rather the third party alone which intends to offer the goods or put them on the market. That question needs to be clarified by the Court of Justice of the European Union.

22 In the view of this Chamber, the question referred for a preliminary ruling should be answered in the negative. As regards patent law, the Bundesgerichtshof (Federal Court of Justice) has held that the mere storage or transport of goods which infringe patents, – by a warehouse keeper, carrier or haulier – does not routinely occur for the purposes of offering or **[Or. 9]** putting on the market, within the meaning of paragraph 9, second sentence, No 1 of the German Law on Patents, as it would be unjustified to undermine the proprietor's limits of responsibility in accordance with paragraph 9 of the German Law on Patents by attributing the indirect proprietor's intention to the detriment of the direct proprietor [...]. In the view of this Chamber, those considerations are transferable to trade mark law. To hold liable the warehouse keeper who has no knowledge of the infringement on the basis of the indirect proprietor's intention to market the goods would overstretch the limits of the proprietor's liability for the goods under Article 9(2)(b) of Regulation No 207/2009 and Article 9(3)(b) of Regulation 2017/1001 [...].

[...]