

**The ECJ in 2016 on**

Intellectual Property, Marketing & Media Law



# **THE ECJ IN 2016 ON**

INTELLECTUAL  
PROPERTY  
MARKETING &  
MEDIA LAW

Edited by  
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# INTRODUCTION

The aim of this book is to provide a comprehensive overview of the past year's judgments and orders of the Court of Justice of the European Union (referred to as the ECJ) for legal practitioners active in the areas of law offered by our firm. These areas have been summarised as 'Intellectual Property, Marketing and Media Law'. But, as the nature of our profession requires, there is some further explanation to be given as to what is included in this overview and what is not.

- In the intellectual property practice of our firm we focus on soft IP, most notably trademarks, copyrights, neighbouring rights, database rights and design rights. All ECJ judgments and orders on these topics are addressed in this book. We do not focus on patents or plant variety rights, so ECJ judgments on these topics are not included.
- The majority of the legal aspects of marketing have been harmonised (either entirely or in part). This includes advertising law, health claims, labelling and unfair commercial practices. All judgments on these topics are addressed in this book. We have chosen not to address marketing related case law on directives or regulations that apply to one specific sector or product category only, as such case law is relevant to only a very limited number of readers of this book.

In our media practice, we focus on freedom of speech and media related IP law. As the first is not the subject of any specific directive or regulation, there are no cases on this topic addressed in this book. We do not focus on law pertaining to media as a regulated market, so case law relating thereto (such as the judgment of 17 February 2016, in *Sanoma Media v Viestintävirasto*, C-314/14) is not included herein.

- Judgments on procedural aspects of EU law or harmonised national law and on private international law may bear relevance for our practice. However, judgments on these topics have only been included insofar as they pertain to IP related cases (including all cases relating to the Enforcement Directive).
- In appeal proceedings where the appeal is manifestly inadmissible or manifestly unfounded, the ECJ may decide not to render judgment, but to give its decision by order. By their nature, these orders generally do not provide for new insights in EU law. For this reason, we have decided not to summarise them. These orders are listed at the end of this book. Although the ECJ also renders orders in preliminary proceedings, we have decided to summarise these nonetheless.

Drafts for the summaries included in this book have been prepared by Anne Sliepenbeek and Judith de Snoo. This book has been designed by Tess Argante (Argante Argante). All has been coordinated by Wendy Bond-Mooijer. We thank them all for their excellent work. This book is easily as much theirs as it is ours.

Adonna Alkema  
Arnout Groen  
Jesse Hofhuis  
Amsterdam, December 2016

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## **Brussels I**

Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters

## **Charter**

Charter of Fundamental Rights of the European Union (2000/C 364/01)

## **Community Design Regulation**

Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs

## **Computer Programs Directive**

Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs

## **Copyright Directive**

Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society

## **Copyright Term Directive**

Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related

**E-Commerce Directive**

Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market

**Enforcement Directive**

Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights

**InfoSoc Directive**

Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society

**Nutrition and Health Claims Regulation**

Regulation No 1169/2011 of the European Parliament and of the Council of 25 October 2011 on the provision of food information to consumers

**Labelling Directive**

Directive No 2000/13/EC of the European Parliament and of the Council of 20 March 2000 on the approximation of the laws of the Member States relating to the labelling, presentation and advertising of foodstuffs

**Plant Variety Regulation**

Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights

**Rental and Lending Rights Directive**

Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property

**Resale Right Directive**

Directive 2001/84/EC of the European Parliament and of the Council of 27 September 2001 on the resale right for the benefit of the author of an original work of art

**TFEU**

Treaty on the Functioning of the European Union

**Tobacco Products Directive**

Directive 2014/40/EU of the European Parliament and of the Council of 3 April 2014 on the approximation of the laws, regulations and administrative provisions of the Member States concerning the manufacture, presentation and sale of tobacco and related products

**Trademark Directive 2008/95**

Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks

**Trademark Regulation 207/2009**

Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark

**Unfair Commercial Practices Directive**

Directive No 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market





# WINTER

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1 January  
up to 20 March  
2016

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### COMPLEMENTARITY OF THE GOODS AUTONOMOUS CRITERION

C-50/15 P

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**Kurt Hesse  
v EUIPO**

---

In an opposition filed against the registration of the word mark CARRERA for *mobile navigation apparatus* on the basis of Porsche's identical trade mark CARRERA for *cars*, both the Board of Appeal and the General Court had held that the complementary nature of the goods concerned was sufficient for a finding of similarity of the goods.

**The matter at hand**

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The applicant, Mr. Hesse, appealed this finding, arguing that the assessment of the similarity of the goods may not be based on their complementary nature alone, but must be based on an analysis of all the relevant factors relating to the goods at issue including, in this case, the origin, marketing, distribution channels and the respective points of sale of those goods. In Mr. Hesse's view, the General Court would not have found there to be similarity of the goods if it had taken these factors into account as well.

In line with steady case law, most notably the ECJ's landmark decision in *Canon/Cannon* (Case C-39/97), the ECJ first of all recalls that in assessing the similarity of goods or services, all the relevant factors relating to those goods or services should be taken into account including, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (paragraph 21).

**The judgment  
of the ECJ**

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C-50/15 P

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**Kurt Hesse  
v EUIPO**

The ECJ, however, continues that “*although the complementary nature of the goods at issue represents only one factor amongst several others (...) in the light of which the similarity of the goods can be assessed, the fact remains that it is an autonomous criterion capable of being the sole basis for the existence of such a similarity*” (paragraph 23).

Accordingly, the ECJ concludes that “*the General Court did not err in law by upholding the assessment of the Board of Appeal according to which the goods at issue were similar because of their complementarity, without carrying out, to that end, an analysis of the origin, the marketing, the distribution channels or the points of sale of those goods*” (paragraph 25).

#### **Commentary**

This decision makes clear that a finding of similarity between the goods in question may result from one of the relevant factors to be taken into account only. Although some consider this a departure from the ECJ’s landmark decision in Canon/Cannon (Case C-39/97), the decision does seem in line with steady ECJ case law regarding the other precondition of Article 8(1) (b) of Trade Mark Regulation 40/94 (the similarity of the marks) according to which a minimum degree of similarity suffices to meet this precondition (see for example Ferrero, C-552/09 P and Calvin Klein, C-254/09). The decision in the present case confirms that the same applies to the similarity of the goods. On the other hand, the fact that the similarity of the goods results from one factor only, whereas the goods are different in the other factors, does play a role in assessing whether there exists a likelihood of confusion and may still negatively impact that assessment.

### VERLADOS EVOCATION OF THE GEOGRAPHICAL INDICATION CALVADOS

C-75/15

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**Calvados  
v Verlados**

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The protection of geographical indications for spirit drinks has been laid down in EC Regulation 110/2008, which protects the geographical indications against any misuse, imitation or evocation, even if the true origin of the product is indicated or the geographical indication is used in translation or accompanied by an expression such as “like”, “type”, “style”, “made”, “flavor” or any other similar term.

**The matter at hand**

---

‘Calvados’ has been registered as a geographical indication in the category of ‘cider spirit and perry spirit’, as originating in France. A Finnish company called Viiniverla Oy, established in the Finnish village of Verla, has manufactured and marketed cider spirits named ‘Verlados’ since 2001.

The French authorities filed a complaint with the EU Commission relating to the alleged misuse of the French geographical indication ‘Calvados’, arguing that ‘Verlados’ constitutes an evocation of the geographical indication ‘Calvados’. In response, the Finnish Authority explained that ‘Verlados’ is a local product the name of which refers directly to Verla (the place of its manufacture) and took the position that there exists no evocation as the names ‘Calvados’ and ‘Verlados’ only have their last syllable in common. The EU Commission, however, considered that the ending ‘ados’ suffices to call the name ‘Calvados’ to mind and informed the Finnish Authority that the name

C-75/15

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**Calvados  
v Verlados**

'Verlados' was not authorized. Consequently, the Finnish Authority adopted a decision prohibiting Viiniverla from using the name 'Verlados'. Viiniverla subsequently brought an action before the Finnish court for annulment of the decision of the Finnish Authority.

In order to rule on the dispute at hand, the Finnish court referred several questions to the ECJ regarding the interpretation of the concept of 'evocation'. In particular, the referring court wanted to know whether account should be taken of circumstances indicating that the use of the name 'Verlados' is not likely to deceive consumers, such as the circumstance that Verlados is sold in Finland only and that it is known to Finnish consumers that 'Verlados' refers to the village 'Verla' where the product at issue is manufactured.

**The judgment  
of the ECJ**

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With reference to settled ECJ case law (*Bureau national interprofessionnel du Cognac*, C-4/10 and C-27/10, *Consorzio per la tutela del formaggio Gorgonzola*, C-87/97, and *Commission v Germany*, C-132/05) the ECJ recalls that "the concept of 'evocation' covers a situation in which the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product the image triggered in his mind is that of the product whose designation is protected" (paragraph 21). Likelihood of confusion is not required: "what matters is, in particular, that there is not created in the mind of the public an association of ideas regarding the origin of the products, and that a trader does not take undue advantage of the reputation of the protected geographical indication" (paragraph 45).

The assessment of whether such evocation exists, must be based on "the presumed expectations of the average consumer who is reasonably well informed and reasonably observant and circumspect" (paragraph 25). Considering that the Regulation protects geographical indications "against any 'evocation' throughout the territory of the European Union"

and “*in the light of the need to guarantee effective and uniform protection of those geographic indications in that territory*”, the ECJ considers that this “*covers European consumers and not merely consumers of the Member State in which the product giving rise to the evocation of the protected geographical indication is manufactured*” (paragraph 27).

C-75/15

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**Calvados  
v Verlados**

Regarding the circumstances mentioned by the referring court, the ECJ rules that none of those circumstances are relevant for the purpose of assessing the existence of an ‘evocation’ (paragraph 41 – 48). The main reason the ECJ gives for this ruling is the desired uniform protection of geographical indications throughout the entire territory of the EU. In addition, the ECJ points out that the circumstances listed by the referring court might prevent confusion or deception on the part of the Finnish consumers, but could still lead to an evocation as described above. Therefore, “*where the referring court finds that there is ‘evocation’ (...), it may not authorise the name ‘Verlados’ in the light of the circumstances mentioned in the second question*” (paragraph 50).

The ECJ further explains that in order to assess whether an evocation exists, only the visual and phonetic relationship between the names and, where appropriate, their conceptual proximity must be considered, as well as “*any evidence that may show that such a relationship is not fortuitous (...)*” (i.e. not accidental) (paragraphs 36-49).

In the light of the foregoing considerations, the ECJ concludes that “*in order to assess whether the name ‘Verlados’ constitutes an ‘evocation’ within the meaning of that provision of the protected geographical indication ‘Calvados’ with respect to similar products, the referring court must take into consideration the phonetic and visual relationship between those names and any evidence that may show that such a relationship is not fortuitous, so as to ascertain whether, when the average European consumer, reasonably well informed and*

C-75/15

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**Calvados  
v Verlados**

*reasonably observant and circumspect, is confronted with the name of a product, the image triggered in his mind is that of the product whose geographical indication is protected.” (paragraph 48).*

#### **Commentary**

This judgment is worth the read, as it helpfully summarizes the criteria for assessing whether there exists an ‘evocation’. The judgment shows that the concept of ‘evocation’ is to be interpreted broadly and covers any situation in which the name of a product ‘triggers’ the image of the product whose geographical indication is protected in the mind of the average consumer. Likelihood of confusion is not required. Besides, the judgment makes clear that the presumed expectation of the European consumer, rather than the local consumer, must be taken into account. This rule also applies in situations where mainly local consumers buy the product.



### INFRINGEMENT ACTION BY UNREGISTERED LICENSEE

C-163/15

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Hassan  
v Breiding

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This preliminary ruling concerns the interpretation of the first sentence of Article 23(1) of Trade Mark Regulation 207/2009, according to which the entry of a license, transfer or security right in the Register is required in order for the license, transfer or security right to have effect vis-à-vis third parties.

The matter at hand

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In proceedings involving an infringement action brought by the holder of a licence which had not been entered in the Register, the referring German court asked, in essence, whether Article 23(1) precludes the holder of such unregistered license from bringing proceedings alleging infringement of a EU trade mark.

With reference to its judgments in *Brain Products* (C-219/11) and *Lanigan* (C-237/15 PPU), the ECJ rules that it is necessary to consider not only the wording of the relevant provision “*but also the context in which it occurs and the objectives pursued by the rules of which it is part*” (paragraph 19).

The judgment  
of the ECJ

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Regarding the context of the provision, the ECJ observes that a literal and schematic interpretation thereof “*gives support to the idea that it, as a whole, is intended to govern the enforceability of the legal acts referred to in Articles 17, 19 and 22 of the Regulation in respect of third parties who have, or are likely to have, rights in the [EU] trade mark*” (paragraph 20).

C-163/15

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**Hassan  
v Breiding**

Considering further that the provision is included under the section entitled 'EU trade marks as objects of property' (paragraph 21) and that Article 22(3) of the Regulation provides that "*the licensee's right to bring proceedings for infringement of a EU trade mark (...) is subject only to the proprietor's consent thereto*" (paragraph 22), the ECJ takes the view that Article 23(1) intends to "*protect a person who has, or may have, rights in a [EU] trade mark as an object of property*", but does not protect third parties infringing the rights conferred by the EU trade mark (paragraph 25).

On this basis, the ECJ concludes that "*the first sentence of Article 23(1) of [Trade Mark Regulation 207/2009] must be interpreted as meaning that the licensee may bring proceedings alleging infringement of a [EU] trade mark which is the subject of the license, although that license has not been entered in the Register*" (paragraph 26).

#### **Commentary**

A few months later, the ECJ was confronted with similar questions regarding the corresponding provision in the Community Design Regulation. Reference is made to *Thomas Philipps v Grune Welle* (C-419/15) discussed in the Summer-section of this book, in which the ECJ held that an unregistered licensee is also entitled to claim damages in an infringement action brought by him.

**ADVERTISER NOT LIABLE FOR  
TRADE MARK INFRINGEMENT  
THROUGH ADVERTISEMENTS PLACED  
BY A THIRD PARTY ON HIS BEHALF  
ONCE HE EXPRESSLY REQUESTED  
THAT THIRD PARTY TO REMOVE THEM**

C-179/15

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**Daimler AG  
v Együd Garage**

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Daimler is the German manufacturer of Mercedes cars and the proprietor of the international figurative trade mark “Mercedes-Benz”. Együd Garage is a Hungarian company specialised in the sale and repair of Mercedes cars.

**The matter at hand**

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Együd Garage was a party to a contract for the supply of after-sales services concluded with (a subsidiary company of) Daimler, on the basis of which Együd Garage was entitled to use the trade mark and to describe itself as “an authorised Mercedes-Benz dealer” in its advertisements. While the contract was in force, Együd Garage ordered the publication of such advertisements from an online advertising service provider. Following the termination of that contract, Együd Garage tried to end all use of the trade mark at issue, in particular by asking the online advertising service provider to amend the advertisements in such a way that it no longer made reference to Együd Garage as an authorised Mercedes-Benz dealer. Furthermore, Együd Garage wrote to the operators of several other websites requesting the removal of its advertisements which had been published by those operators without its consent. Despite taking those steps, however, the advertisements continued to be distributed online.

In those circumstances, Daimler brought an action before the referring court in Budapest, seeking inter alia a declaration that Együd Garage infringed Daimler’s trade

C-179/15

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**Daimler AG  
v Együd Garage**

mark rights as a result of the continued online distribution of the advertisements.

In the proceedings before the ECJ, the referring court asked whether a third party who is named in an advertisement published online, which gives the impression that there is a commercial relationship between him and the proprietor of a trade mark, makes use of that trade mark in circumstances where (i) that advertisement has not been placed by that third party or at his request or (ii) where that third party has taken all reasonable steps to have it removed, but did not succeed in doing so.

**The judgment  
of the ECJ**

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The ECJ first of all holds that the publication online of an advertisement on a referencing website, referring to another person's trade mark, constitutes use of that trade mark by the advertiser if that advertisement was ordered by the advertiser and placed on the relevant website by a service provider acting on the instruction of the advertiser.

On the other hand, however, the ECJ considers that "*no one can be legally obliged to do the impossible*" (paragraph 43) and that therefore "*the advertiser cannot be held liable for the acts or omissions of such a provider who, intentionally or negligently, disregards the express instructions given by that advertiser who is seeking, specifically, to prevent that use of the mark.*" Accordingly, "*where that provider fails to comply with the advertiser's request to remove the advertisement at issue or the reference to the mark contained therein, the publication of that reference on the referencing website can no longer be regarded as a use of the mark by the advertiser*" (paragraph 34).

As to the publication of advertisements by operators of websites "*with whom the advertiser has no direct or indirect dealings and who do not act by order and on behalf of that advertiser, but on their own initiative and in their own name*", the ECJ holds that the advertiser cannot be held liable

for the independent actions of such operators in the first place (paragraph 36). Consequently, the advertiser has no obligation to request those operators to remove the relevant advertisements.

C-179/15

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**Daimler AG  
v EGYÜD GARAGE**

The ECJ, however, continues that this does not preclude the trade mark proprietor from claiming “*where appropriate*” reimbursement of the financial advantage the advertiser takes from the continued publication of such advertisements if this is permitted on the basis of national law, nor from taking action against the operators of the websites at issue.

On this basis, the ECJ concludes that “*Article 5(1)(a) and (b) of [Trade Mark Directive 2008/95] must be interpreted as meaning that a third party, who is named in an advertisement on a website, which contains a sign identical or similar to a trade mark in such a way as to give the impression that there is a commercial relationship between him and the proprietor of the trade mark, does not make use of that sign that may be prohibited by that proprietor under that provision, where that advertisement has not been placed by that third party or on his behalf or, if that advertisement has been placed by that third party or on his behalf with the consent of the proprietor, where that third party has expressly requested the operator of that website, from whom the third party ordered the advertisement, to remove the advertisement or the reference to the mark contained therein*” (paragraph 44).

### **Commentary**

Although this decision seems to be good news for advertisers, national laws may still allow trade mark owners to claim reimbursement of the financial advantage the advertiser takes from the continued publication of infringing advertisements. This still leaves trade mark owners some leverage to get advertisers to use their best efforts to have infringing advertisements removed. Nevertheless, trade mark owners are advised to impose clear contractual obligations on licensees to

3 March 2016

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C-179/15

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**Daimler AG**  
**v Együd Garage**

take measures to get infringing advertisements removed after the termination of the contract, irrespective of whether the relevant advertisement was ordered by the licensee, including not only by expressly requesting the removal of the advertisements but also by initiating court actions aimed at obtaining an injunction against operators not complying with such request.

# CUMULATION OF HYPOTHICAL ROYALTIES AND MORAL PREJUDICE ALLOWED

**C-99/15**

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**Liffers  
v Mandarinina**

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Liffers is the director, scriptwriter and producer of the audiovisual work entitled *Dos patrias, Cuba y la noche*. Mandarinina produced an audiovisual documentary, in which certain passages of the work *Dos patrias, Cuba y la noche* were included without the consent of Liffers. That documentary was broadcast by a Spanish television channel owned by Mediaset. Liffers brought an action before the Commercial Court in Madrid requesting the court to order Mandarinina and Mediaset to cease all infringement of his intellectual property rights and to pay him € 6740 for the infringement of his exploitation rights, and an additional sum of € 10 000 as compensation for the moral prejudice which he claimed to have suffered. The amount of material damage (the first sum) had been determined by reference to the amount of royalties that would have been due to him if Mandarinina and Mediaset had requested his authorisation to use his work. Liffers was partly successful in his action.

**The matter at hand**

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However, on appeal the Provincial Court in Madrid reduced the compensation for material damage and completely set aside the compensation for the moral prejudice. According to that court, since Liffers had chosen to use the calculation method based on hypothetical royalties, as set out under the Spanish implementation of Article 13(1)(b) of the Enforcement Directive, he was not entitled to claim compensation for moral prejudice as well. Liffers

## The judgment of the ECJ

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appealed this decision before the Supreme Court, which referred to matter to the ECJ for a preliminary ruling.

First of all, the ECJ considers that Article 13(1) of the Enforcement Directive – by providing for the possibility of setting the damages as a lump sum on the basis of, ‘at least’, elements such as hypothetical royalties – allows other elements to be included in that amount as well, such as, where appropriate, compensation for any moral prejudice caused to the rightholder (paragraph 15).

Secondly, the ECJ points out that Article 13(1) sets out the general rule that the competent authorities must order the infringer to pay damages that are appropriate to the *actual prejudice* suffered by the rightholder as a result of the infringement. “*Consequently, where the rightholder in question has in fact suffered moral prejudice, (...) Article 13(1) of [the Enforcement Directive] (...) precludes the calculation of the amount of damages to be paid to that rightholder from being based exclusively on the amount of hypothetical royalties*” (paragraph 18). This is in line with the objective of the Enforcement Directive “*to attain a high level of protection of intellectual property rights that takes into account the specific aspects of each given case and is based on a method of calculating damages that addresses those specific aspects*” (paragraph 24).

The ECJ concludes that Article 13(1) of the Enforcement Directive “*must be interpreted as permitting a party injured by an intellectual property infringement, who claims compensation for his material damage on the basis of the amount of royalties or fees which would have been due to him if the infringer had requested his authorisation, to also claim compensation for the moral prejudice that he has suffered*” (paragraph 27).).



### Commentary

This judgment shows that the objective of the Enforcement Directive is to compensate the injured rightholder in full for the actual prejudice he suffered as a result of the infringement. The lump sum calculation method provided for in Article 13(1)(b) of the Enforcement Directive is therefore permitted as an alternative only 'in appropriate cases', for example where it is difficult to determine the amount of the actual prejudice suffered, and does not preclude the rightholder from claiming compensation for the moral prejudice he has suffered as well.

**C-99/15**

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**Liffers  
v Mandarinina**



## EUIPO NOT REQUIRED TO RESPOND EXPRESSLY AND EXHAUSTIVELY TO ALL THE ARGUMENTS PUT FORWARD BY AN APPLICANT

C-252/15 P

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**Naazneen Investments v EUIPO**

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Naazneen Investments is the owner of an EU trade mark for the word mark SMART WATER for beverages, namely water with dietary supplements. Energy Brands successfully filed for the revocation of that trade mark on grounds of non-use. In the appeal brought before it, the General Court confirmed the decisions of EUIPO.

**The matter at hand**

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Naazneen Investments appealed the General Court's decision before the ECJ, claiming that (i) the General Court was not entitled to regard the statement of reasons in the contested decision as sufficient because, for the most part, the Board of Appeal merely repeated the grounds set out by the Cancellation Division, without addressing the arguments submitted by the appellant and without mentioning any of the additional evidence submitted in the course of the appeal proceedings and (ii) the General Court erred in law when assessing the evidence intended to establish genuine use of the mark at issue.

The ECJ first deals with the admissibility of the first ground of appeal in response to the position taken by EUIPO and Energy Brands that that ground of appeal is inadmissible, since it merely repeats the arguments put forward at first instance. The ECJ rules that, indeed, an appeal that *"merely repeats or reproduces verbatim the pleas in law and arguments previously submitted to the General Court, including those based on facts expressly rejected by that*

**The order of the ECJ**

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C-252/15 P

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**Naazneen  
Investments  
v EUIPO**

*Court, [...] fails to satisfy the requirement to state reasons” and “amounts in reality to no more than a request for re-examination of the application submitted to the General Court, which the Court of Justice does not have jurisdiction to undertake” (paragraph 23).*

The ECJ, however, continues that this is different “*where an appellant is disputing the General Court’s interpretation or application of European Union law*” (paragraph 24). Since in this case Naazneen Investments disputed the interpretation and application of Article 75 of Trade Mark Regulation 207/2009 by the General Court, while setting out the reasons why it considered that the General Court infringed that provision, the plea is admissible (paragraph 25).

As regards the substance of the first ground of appeal, the ECJ recalls that it is settled case-law of the ECJ that the obligation to state reasons “*has the dual purpose of enabling interested parties to know the purported justification for the measure taken so as to be able to defend their rights and of enabling the Courts of the European Union to exercise their jurisdiction to review the legality of the decision*” (paragraph 29).

According to the ECJ, this dual purpose has been met in this case, partly because the Board of Appeal, by confirming the analysis made by the Cancellation Division, implicitly rejected the appellant’s arguments claiming that there was sufficient proof of genuine use (paragraph 30) and partly because “*the appellant has not disputed before the General Court, nor has it disputed in the present appeal, the sufficiency of the reasoning of the adjudicating bodies of OHIM to enable the appellant to know the purported justification for the decision at issue and to enable the General Court to exercise its jurisdiction to review the legality of that decision*” (paragraph 32).

The fact that the Board of Appeal did not refer to the arguments put forward by Naazneen Investments does not alter this conclusion, considering that *“the obligation on [EUIPO] to state reasons, under Article 75 of [Trade Mark Regulation 207/2009], may be discharged without it being necessary to respond expressly and exhaustively to all the arguments put forward by an applicant”* (paragraph 34).

Regarding the second ground of appeal, the ECJ holds that Naazneen Investments essentially asks the ECJ to substitute its own assessment of the facts and evidence for that of the General Court, which does not fall within its jurisdiction in an appeal, and that, therefore, that line of arguments is inadmissible (paragraphs 60, 64, 66, 68, 93 and 99). Besides that, the ECJ considers that Naazneen Investments relies for its arguments on a misreading of the judgment of the General Court (paragraphs 62, 65, 67 and 94).

The ECJ concludes that the appeal must be dismissed in its entirety.

C-252/15 P

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**Naazneen  
Investments  
v EUIPO**



# SPRING

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from 21 March  
up to 20 June  
2016

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## FAILURE TO PAY COMPENSATION FOR PRIVATE COPYING IS A TORT WITHIN THE MEANING OF ARTICLE 5(3) OF BRUSSELS I

C-572/14

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**Austro-Mechana  
v Amazon**

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Austro-Mechana is an Austrian copyright-collecting society whose objects include collecting the 'fair compensation' for private copying provided for in Austrian law pursuant to Article 5(2)(b) of the Copyright Directive. Under the Austrian law, this fair compensation is collected from "*persons who, acting on a commercial basis and for consideration, are first to place recording material or reproduction equipment on the market from a place located within or outside the national territory*".

**The matter at hand**

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Amazon, with headquarters in Luxembourg and Germany, sells recording materials through the internet in (inter alia) Austria. According to Austro-Mechana, Amazon is first to place recording materials on the market in Austria, and as a result is liable to pay the fair compensation. On this basis, Austro-Mechana brought proceedings before the courts in Austria seeking payment of the fair compensation from Amazon.

The dispute before the ECJ concerns the question of whether the Austrian courts have international jurisdiction in these proceedings under Article 5(3) of Brussels I, which provides that a person domiciled in a Member State may, in matters relating to tort, delict or quasi-delict, be sued in the courts of the Member State where the harmful event occurred or may occur.

**The judgment  
of the ECJ**

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The ECJ recalls that according to settled case law (including *Brogssitter*, C-548/12 and *Kolassa*, C-375/13), the concept of 'matters relating to tort' covers all actions which seek to establish the liability of a defendant and do not concern 'matters relating to a contract' within the meaning of Article 5(1)(a) of Brussels I (paragraph 32). Therefore, the ECJ starts by determining whether Austro-Mechana's claim for payment of the fair compensation concerns a 'matter relating to a contract' within the meaning of Article 5(1)(a) of Brussels I.

In that connection, the ECJ holds that, although the conclusion of a contract is not a condition for the application of that provision, it is required that there exists a "*legal obligation freely consented to by one person towards another and on which the claimant's action is based*" (paragraph 36). Considering that the obligation to pay Austro-Mechana the fair compensation for private copying was not freely consented to by Amazon, but was imposed on Amazon by law, the ECJ concludes that this obligation does not constitute a 'matter relating to a contract' within the meaning of Article 5(1)(a) of Brussels I (paragraphs 37 and 38).

The ECJ continues by assessing whether Austro-Mechana's claim constitutes an action which seeks to establish the liability of Amazon within the meaning of the case law cited above. With reference to (*inter alia*) its judgment in *DFDS Torline* (C-18/02), the ECJ holds that such is the case "*where a 'harmful event' (...) may be imputed to the defendant*" which requires "*that a causal connection can be established between the damage and the event in which that damage originates*" (paragraphs 40 and 41).

The ECJ rules that this is the case here, considering that "*the action brought by Austro-Mechana seeks to obtain compensation for the harm arising from non-payment by Amazon*" of the fair compensation provided for in the

Austrian law pursuant to Article 5(2)(b) of the Copyright Directive (paragraph 42) and that this fair compensation “*intends to compensate authors for the private copy made without their authorisation of their protected works, so that it must be regarded as compensation for the harm suffered by the authors resulting from such unauthorised copy*” (paragraph 43).

In that light, the ECJ rules that the failure by Austro-Mechana to collect the fair compensation from Amazon constitutes a harmful event within the meaning of Article 5(3) of Brussels I (paragraph 44) and that Austro-Mechana’s claim seeks to establish the liability of Amazon, since that claim is based on an infringement by Amazon of the Austrian law, which is an unlawful act causing harm to Austro-Mechana (paragraph 50).

It therefore “*follows that, if the harmful event at issue in the main proceedings occurred or may occur in Austria, which is for the national court to ascertain, the courts of that Member state have jurisdiction to entertain Austro-Mechana’s claim*” (paragraph 52).

The ECJ concludes that “*the answer to the question referred is that Article 5(3) of [Brussels I] must be interpreted as meaning that a claim seeking to obtain payment of remuneration due by virtue of a national law, such as that at issue in the main proceedings, implementing the ‘fair compensation’ system provided for in Article 5(2)(b) of [the Copyright Directive], falls within ‘matters relating to tort, delict or quasi-delict’, within the meaning of Article 5(3) of that regulation*” (paragraph 53).



## **PLAIN PACKAGING TOBACCO PRODUCTS IS LAWFUL**

C-547/14

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**Philip Morris v  
UK Secretary of  
State for Health**

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This matter concerns the legality and interpretation of the Tobacco Products Directive harmonising a number of aspects of tobacco manufacture and sale in the EU. Among other things, the Directive provides for the standardisation of the labelling and packaging of tobacco products.

**The matter at hand**

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Philip Morris and British American Tobacco brought claims before the referring High Court of Justice of England and Wales seeking judicial review of the intention of the United Kingdom to implement the Tobacco Products Directive. They argued that the Directive is invalid on the ground that a number of provisions thereof infringe Articles 114, 290 and 291 TFEU and Article 11 of the Charter. In addition, they argued that the Directive does not allow Member States to prohibit the inclusion of true and non-misleading statements about the tobacco product on the product packaging.

The referring court subsequently referred a large number of questions to the ECJ regarding the validity and interpretation of the Tobacco Products Directive.

The ECJ first goes into the admissibility of the request and of the questions referred and concludes that several questions are inadmissible, partly because they concern provisions that are not addressed to the Member States (paragraphs 42 – 46) and partly because the referring

**The judgment  
of the ECJ**

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C-547/14

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**Philip Morris v  
UK Secretary of  
State for Health**

court did not explain the reasons which led it to raise those questions (paragraphs 47-52).

The ECJ then goes into the question of whether Article 24(2) of the Tobacco Products Directive allows the Member States to adopt rules in relation to the standardisation of the packaging of tobacco products which are more stringent than those provided by the Directive, and if so, whether this means Article 24(2) is invalid because it infringes Article 114 TFEU.

Regarding the first part of this question, the ECJ rules that Article 24(2) of the Directive must be interpreted as meaning that Member States are allowed to maintain or introduce further requirements in relation to the standardisation of the packaging of tobacco products, but only in relation to aspects of the packaging which have not been harmonized by the Directive. These aspects include requirements relating to the colours of the packaging (paragraphs 73-76). So-called plain packaging legislation is therefore allowed under the Directive.

Regarding the second part of this question, the ECJ acknowledges that the Directive does not guarantee full harmonisation of the packaging requirements for tobacco products and therefore does not eliminate all obstacles to trade between the Member States. *“However, that is the inevitable consequence of the method of harmonisation chosen by the EU legislature in the present case. As has been recalled in paragraph 63 of this judgment, the EU legislature has a discretion, in particular with regard to the possibility of proceeding towards harmonisation only in stages and requiring only the gradual abolition of unilateral measures adopted by the Member States”* (paragraph 80). The judgment then goes on to explain in detail why the other provisions of the Directive referred to in the order of reference do not infringe 114 TFEU either, nor conflict with the principles of proportionality and subsidiarity. These provisions

include the prohibition of tobacco products containing a characteristic flavour, such as menthol, the rules relating to the position and size of health warnings, the option for Member States to prohibit cross-border distance sales of tobacco products to consumers and the common rules imposed on Member States which do permit that method of sale.

C-547/14

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**Philip Morris v  
UK Secretary of  
State for Health**

As to the scope of Article 13(1) of the Directive, the ECJ holds that this Article prohibits the display “*of any element or feature that is such as to promote a tobacco product or encourage its consumption*”, including promotion or encouragement that “*may result from certain information or claims, even when these are factually accurate*”. The ECJ explains that the high level of protection of human health pursued by the Directive requires that “*consumers of tobacco products, who are a particularly vulnerable class of consumers because of the addictive effects of nicotine, should not be encouraged to consume those products by means of, albeit factually accurate, information, which they may interpret as meaning that the risks associated with their habits are reduced or that the products have certain benefits*” (paragraphs 143 and 144). This includes, for example, information about the nicotine, tar or carbon monoxide content, information referring to taste, smell, flavourings and additives, words or expressions like ‘low-tar’, ‘light’, ‘ultra-light’, ‘natural’, ‘organic’, ‘without additives’, ‘without flavours’ or ‘slim’, “*and other elements or features that could mislead consumers, in particular young people, by suggesting that the products concerned are less harmful or that they have beneficial effects*” (paragraph 142).

The ECJ rules that these restrictions do not infringe the freedom of expression and information protected by Article 11 of the Charter, because they strike a fair balance between that fundamental freedom and the legitimate general interest objectives protected by the Directive (paragraph 161).

C-547/14

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**Philip Morris v  
UK Secretary of  
State for Health**

**Commentary**

This judgment is a must-read for anyone involved in matters concerning the legality of EU directives in light of the TFEU and the Charter. The ECJ goes into this in great detail with reference to its previous case law on the subject. The judgment further illustrates that the public interest in the protection of human health is considered a fundamental interest justifying far-reaching restrictions of the freedom of expression, information and advertising. Although this is not the first time that the wish to ensure a high level of consumer protection leads the ECJ to confer a wide scope on the Unfair Commercial Practices Directive, it is remarkable that the ECJ extends the reach of the Directive to isolated acts directed to one single consumer. Other than the ECJ seems to imply, the wording of the Directive certainly allows for another interpretation, considering that the term 'practice' used in the Directive gives the impression that the relevant conduct must be recurring and/or concern more than one consumer. This was also the opinion of the Advocate General in this case, who for a "manifold" of reasons did not consider it feasible to apply the Directive to conduct directed to one single consumer. The ECJ however went the other way with the result that undertakings now risk incurring fines for isolated and unintentional mistakes affecting only one consumer.



## BROADCAST OF TV PROGRAMMES IN REHABILITATION CENTRE CONSTITUTES A COMMUNICATION TO THE PUBLIC

C-117/15

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Reha Training  
v GEMA

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Reha Training operates a rehabilitation centre whose premises include two waiting rooms and a training room in which patients could watch television programmes on television sets installed there.

The matter at hand

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Reha Training, however, never requested GEMA, the company entrusted with the collective management of copyright in Germany, for permission to broadcast those programmes. GEMA subsequently brought proceedings against Reha Training before the courts in Germany, claiming that the broadcasting by Reha Training constitutes a communication to the public.

In these circumstances, the referring asked the ECJ, in essence, whether the broadcasting by Reha Training constitutes an act of communication to the public within the meaning of Article 3(1) of the Copyright Directive and/or Article 8(2) of the Rental and Lending Rights Directive.

The judgment  
of the ECJ

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The ECJ first of all rules that “*in a case such as that in the main proceedings, concerning the broadcast of television programmes which allegedly affects not only copyright but also, inter alia, the rights of performers or phonogramme producers, both Article 3(1) of [the Copyright Directive] and Article 8(2) of [the Rental and Lending Rights Directive] must be applied, whilst giving the concept of ‘communication to the public’ in both those provisions the same meaning*” (paragraph 33).

C-117/15

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**Reha Training  
v GEMA**

As to the interpretation of that concept, the ECJ recalls, with reference to its judgments in *Phonographic Performance (Ireland)* (C-162/10), *ITV Broadcasting and Others* (C-607/11) and *SBS Belgium* (C-325/14), that “account has to be taken of several complementary criteria, which are not autonomous and are interdependent. Since those criteria may, in different situations, be present to widely varying degrees, they must be applied both individually and in their interaction with one another” (paragraph 35).

In that connection, the ECJ notes, again with reference to the case law cited above, that the concept of ‘communication to the public’:

Regarding the first criterion of an ‘act of communication’, the ECJ holds that this criterion refers to “any transmission of the protected works, irrespective of the technical means or process used” (paragraph 38). The ECJ notes that it has already held that “the operators of a café-restaurant, a hotel or a spa establishment carry out an act of communication where they intentionally broadcast protected works to their clientele by intentionally distributing a signal by means of television or radio sets which they have installed in their establishment” (paragraph 54). According to the ECJ “[t]hose situations are fully comparable with that at issue in the main proceedings in which, as is apparent from the order for reference, the operator of a rehabilitation centre intentionally broadcasts protected works to its patients by means of television sets installed in several places in that establishment” (paragraph 55). Consequently, the first criterion has been met.

Secondly, as regards the criterion of ‘a public’, the ECJ recalls, with reference to its judgments in *SGAE* (C-306/05) and *SCF* (C-135/10) that:

1. this criterion refers to an “indeterminate number of potential recipients”, meaning “persons in general”, that

*is, not restricted to specific individuals belonging to a private group*" (paragraph 42);

C-117/15

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**Reha Training  
v GEMA**

- II. this criterion implies, moreover, "a fairly large number of persons", indicating that "*the concept of 'public' encompasses a 'certain de minimis threshold', which excludes from the concept groups of persons which are too small, or insignificant*" (paragraph 43);
- III. in order to determine the size of that audience, "*account must be taken of the cumulative effects of making works available to potential audiences*", in which respect it is "*relevant, inter alia, to know how many persons have access to the same work at the same time and how many of them have access to it in succession*" (paragraph 44).

The ECJ rules that this criterion has been met as well, considering that "*as regards the body of patients of a rehabilitation centre (...) it must be observed, first of all, that it is apparent from the documents submitted to the Court that they are persons in general*" (paragraph 57) and that "*the circle of persons constituted by those patients is not 'too small or insignificant', it being understood, in particular, that those patients may enjoy works broadcast at the same time in several places in the establishment*" (paragraph 58).

Thirdly, as to the criterion of a 'new public', the ECJ rules that "*the patients of such a rehabilitation centre cannot, in principle, enjoy works broadcast without the targeted intervention of the operator of that centre. Furthermore, since the origin of the dispute in the main proceedings concerns the payment of royalties for copyright and related rights for the making available of protected works in that centre, it must be observed that those patients were clearly not taken into account when the original authorisation for the work to be made available was given*" (paragraph 60). Consequently, the third criterion of a 'new public' has been met as well.

C-117/15

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**Reha Training  
v GEMA**

Although the above considerations are already sufficient for the ECJ to conclude that there is a communication to the public, the ECJ notes that in this case the communication also has a profit-making nature, because the broadcasting of television programmes on television sets in the rehabilitation centre “*is intended to create a diversion for the patients*” and “*constitutes the supply of additional services which, while not having any medical benefit, does have an impact on the establishment’s standing and attractiveness, thereby giving it a competitive advantage*” (paragraph 63).

#### **Commentary**

This judgment shows that the application of the concept of ‘communication to the public’ by the ECJ is not always predictable. In SCF (C-135/10), for example, the ECJ held that the public visiting the waiting room of a dental practice does not consist of ‘persons in general’ and a ‘fairly large number of persons’, because that public is limited to patients of the dental practice only, which patients, moreover, do not give any importance to the broadcast of musical works in the waiting room, because they “visit a dental practice with the sole objective of receiving treatment” and not to listen to music. Although the same could be said for patients of a rehabilitation centre, the ECJ goes the other way in this case, considering “that it is apparent from the documents submitted to the Court” that those patients do consist of persons in general and do attach importance to the broadcast of television programmes because this creates “a diversion” for the patients.

# ENFORCEMENT DIRECTIVE DOES NOT PROVIDE BASIS FOR AWARDING PUNITIVE DAMAGES

C-481/14

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Hansson  
v Jungpflanzen

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Mr. Hansson, the holder of a Community plant variety right called 'Lemon Symphony', obtained an order from the Regional Court of Düsseldorf requiring Jungpflanzen to pay compensation for the damage resulting from an infringement of Mr. Hansson's Community plant variety right, which damage was calculated on the basis of the licence fee which Jungpflanzen should have paid him. The court, however, did not uphold Mr. Hansson's other claims, which related to payment of an 'infringer supplement' to the licence fee calculated at half of the amount of the fee claimed and reimbursement of the costs related to the proceedings.

The matter at hand

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Both parties appealed against that judgment before the Higher Regional Court in Düsseldorf, which referred a large number of questions to the ECJ regarding the interpretation of Article 94 of the Plant Variety Regulation and Article 13 of the Enforcement Directive.

With regard to the payment of an 'infringer supplement', the ECJ first of all establishes that Article 94 of the Plant Variety Regulation cannot be interpreted as providing a legal basis, to the benefit of the rightholder, which permits an infringer to be required to pay punitive damages established on a flat-rate basis (paragraph 34).

The judgment  
of the ECJ

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C-481/14

**Hansson  
v Jungpflanzen**

According to the ECJ, this interpretation is consistent with the objectives of the Enforcement Directive, which lays down a minimum standard concerning the enforcement of intellectual property rights in general (paragraph 36) and from which it follows that:

- remedies provided for in the Enforcement Directive should be determined in each case in such a manner as to take due account of the specific characteristics of that case (paragraph 37);
- *“the aim of any compensation is not to introduce an obligation to provide for punitive damages”* (paragraph 38);
- Member States are to ensure that the competent judicial authorities, on application of the injured party, order the infringer to pay *“damages appropriate to the actual damage suffered by him as a result of the infringement”* (paragraph 39).

*“In those circumstances, Article 94 of [the Plant Variety Regulation] does not permit an infringer to be ordered to pay a flat-rate ‘infringer supplement’, as described by the referring court, since such a supplement does not necessarily reflect the damage suffered by the holder of the variety infringed, although [the Enforcement Directive] does not prevent the Member States from laying down measures that are more protective”* (paragraph 40).

The ECJ continues that Article 94 of the Plant Variety Regulation does not permit the rightholder to claim restitution of the gains and profits made by an infringer either. *“In fact, both the ‘reasonable compensation’ and the amount of compensation payable under Article 94(2) of [the Plant Variety Regulation] must be set on the basis of the damage suffered by the injured party and not on the basis of the profit made by the person who committed the infringement. Although paragraph 2 of Article 94 refers to*

*the 'advantage derived ... by the person who committed the infringement', it does not provide that that advantage has to be taken into account, as such, in the amount of the financial compensation actually awarded to the holder" (paragraph 41).*

C-481/14

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**Hansson  
v Jungpflanzen**

Instead, the reasonable compensation provided for in Article 94(1) intends "to make good the loss suffered by the holder of a plant variety right who is the victim of an infringement" (paragraph 46), which loss consists of "the amount of the fee which would be payable for licensed production" (paragraph 47). It follows from that interpretation that reasonable compensation "includes loss or damage that is closely connected to failure to pay that compensation" (paragraph 52). This includes default interest (paragraph 53), but excludes "costs incurred for monitoring compliance with rights of the plant variety holder" (paragraph 51).

*"Consequently, the answer to Questions 2 and 3 is that the concept of 'reasonable compensation', provided for in Article 94(1) of [the Plant Variety Regulation], must be interpreted as meaning that it covers, in addition to the fee that would normally be payable for licensed production, all damage that is closely connected to the failure to pay that fee, which may include, inter alia, payment of default interest. It is for the referring court to determine the circumstances which require that fee to be increased, bearing in mind that each of them may be taken into account only once for the purpose of determining the amount of reasonable compensation."* (paragraph 54).

As to whether or not out-of-court expenses must be compensated and costs incurred in an unsuccessful interlocutory application preceding successful proceedings on the merits, the ECJ leaves much up to the discretion of the national courts; It is "not contrary" to the Plant Variety Regulation not to take such costs and expenses into consideration, but "a condition for not taking those expenses

C-481/14

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**Hansson  
v Jungpflanzen**

*into account is that the amount of the legal costs that are likely to be awarded to the victim of the infringement is not such, in view of the sums he has incurred in respect of out-of-court expenses and their utility in the main action for damages, as to deter him from bringing legal proceedings in order to enforce his rights” (paragraph 64).*

**Commentary**

Although this judgment mainly relates to the specific provisions in the Plant Variety Regulation, it is relevant to the calculation of damages in case of infringement of other intellectual property rights as well by making clear that the Enforcement Directive does not provide a basis for awarding punitive damages.



**SPANISH FAIR COMPENSATION  
SCHEME FUNDED THROUGH GENERAL  
STATE BUDGET INCOMPATIBLE WITH  
THE COPYRIGHT DIRECTIVE**

C-470/14

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**EGEDA  
v Spanish  
government**

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This preliminary ruling concerns the interpretation of Article 5(2)(b) of the Copyright Directive. The request has been made in connection with national Spanish legislation relating to a scheme for fair compensation for private copying financed from the General State Budget. This scheme is funded by all Spanish taxpayers regardless of whether they make private copies.

**The matter at hand**

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In proceedings between Spanish collecting societies on the one hand and the State of Spain on the other, the referring court asked the ECJ whether a scheme for fair compensation for private copying is compatible with Article 5(2)(b) of the Copyright Directive where that scheme is financed from the General State Budget.

The ECJ recalls that it follows from established case law that - although Member States are free to establish a scheme under which legal persons are, under certain conditions, liable to pay the levy intended to finance the fair compensation - the burden of that levy must ultimately be borne by the private users who make copies for private use (paragraph 34). Therefore, “*legal persons should not in any event be the persons ultimately actually liable for payment of that burden*” (paragraph 36).

**The judgment  
of the ECJ**

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In the present case, it is clear that the fair compensation is financed from all the budget resources of the General State

C-470/14

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**EGEDA  
v Spanish  
government**

Budget and therefore also from all taxpayers, including legal persons (paragraph 39). Considering, further, that there is no particular measure in Spanish law allowing legal persons to request to be exempted from contributing to the financing of that compensation or to seek reimbursement, such a scheme for financing the fair compensation cannot guarantee that the burden of that compensation is ultimately borne solely by the users of private copies (paragraphs 40 and 41).

Therefore, Article 5(2)(b) of the Copyright Directive must be interpreted as precluding a scheme for fair compensation for private copying which is financed from the General State Budget in such a way that it is not possible to ensure that the cost of that compensation is borne by the users of private copies (paragraph 42).

# SUMMER

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from 21 June  
up to 22 September  
2016

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## SUCCESSIVE RENEWAL REQUESTS OF EXPIRING EU TRADE MARK ALLOWED

C-207/15 P

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Nissan  
v EUIPO

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Nissan is the owner of an EU trade mark in respect of goods in classes 7, 9 and 12, which was going to expire in April 2011. In January 2011, during the six month period prior to the expiry of the EU trade mark, Nissan requested the renewal thereof for the goods in classes 7 and 12, but not for the goods in class 9. Consequently, EUIPO informed Nissan that the EU trade mark had been removed from the register with respect to the goods in class 9. In July and August 2011, during the six month grace period *following* the expiry of the EU trade mark, Nissan requested EUIPO to renew the EU trade mark with respect to the goods in class 9 as well.

The matter at hand

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EUIPO refused the latter request *inter alia* on grounds that, for reasons of legal certainty, Nissan could not be allowed to reverse its decision not to renew the EU trade mark in respect of the goods in class 9. In the appeal brought before it, the General Court upheld this decision, considering that successive renewal requests are prohibited on the basis of Article 47(3) of Trade Mark Regulation 207/2009. Nissan appealed this decision before the ECJ.

The ECJ considers that from the wording of Article 47(3) of Trade Mark Regulation 207/2009 it follows that the payment of an additional fee is the only condition for the submission of a request for renewal of an EU trade mark during the six month grace period following the expiry (paragraph 48).

The judgment  
of the ECJ

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C-207/15 P

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**Nissan  
v EUIPO**

Furthermore, the ECJ holds that the Regulation, by laying down two consecutive periods within which renewal may be requested, aims to facilitate the retention by the trade mark owners of their exclusive rights (paragraph 53).

As regards the issue of legal certainty, the ECJ notes that EUIPO is not *“under an obligation to register a request for partial renewal prior to the expiry of the further period”* and that it is possible for EUIPO *“to envisage, when registering such a request, information measures that would enable both the rights of proprietors of EU trade marks and the rights of third parties to be safeguarded, instead of the removal of certain classes of goods or services from the register”* (paragraph 57).

Accordingly, the ECJ concludes that the General Court erred in law in determining that Article 47(3) of Trade Mark Regulation 207/2009 and the principle of legal certainty *“preclude the submission, during the further period, of a request for renewal relating to certain classes of goods or services in respect of which an EU trade mark is registered, when a request for renewal concerning other classes of goods or services covered by the same mark has been submitted previously, within the period laid down in the first sentence of that provision”* (paragraph 58).

**REASONABLE COMPENSATION  
IN PERIOD BEFORE PUBLICATION  
OF TRADE MARK REGISTRATION  
REFERS TO THE RECOVERY OF THE  
PROFITS ACTUALLY DERIVED**

C-280/15

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**Nikolajeva  
v Multi Protect**

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Nikolajeva is the owner of an EU trade mark for the word mark HolzProf. The application for registration of that EU trade mark was filed on 24 April 2010 and then published on 31 May 2010. The registration of the EU trade mark was published on 16 September 2010. Between 3 May 2010 and 28 October 2011, the company Multi Protect used the EU trade mark as a hidden keyword. Consequently, Nikolajeva brought an action against Multi Protect before the referring court claiming *inter alia* a declaration that an infringement had occurred and compensation for the 17 months that the infringement had lasted. Nikolajeva, however, had not requested the referring court to order Multi Protect to cease the infringement.

**The matter at hand**

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The referring court decided to stay the proceedings to seek clarification from the ECJ regarding the following three questions:

- I. whether Article 102(1) of Trade Mark Regulation 207/2009 must be interpreted as requiring an EU trade mark court to issue an order prohibiting a third party from proceeding with acts of infringement even though the owner of the trade mark has not applied for such an order before that court;
- II. whether Article 9(3) of Trade Mark Regulation 207/2009 must be interpreted as precluding the owner of an EU

C-280/15

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**Nikolajeva  
v Multi Protect**

trade mark from being able to claim compensation in respect of acts of third parties occurring before publication of the trade mark *application*; and

- III. whether, in the case of acts of third parties occurring after publication of the trade mark application, but before publication of its registration, the concept of 'reasonable compensation' in Article 9(3) of Trade Mark Regulation 207/2009 means damages intended to compensate for all the harm suffered by that owner, including non-material harm.

**The judgment  
of the ECJ**

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The ECJ holds that from the application of rules of national procedural law (namely the principle that the subject matter of proceedings is determined by the parties and of the principle of *ne ultra petita*), it follows that an EU trade mark court is allowed to refrain from issuing an order which prohibits a third party from proceeding with acts of infringement (as referred to in Article 102(1) of Trade Mark Regulation 207/2009) on the ground that the trade mark owner has not applied for such an order before that court (paragraphs 29-31 and 34).

Furthermore, the ECJ considers that Article 9(3) of Trade Mark Regulation 207/2009 precludes the owner of an EU trade mark from being able to claim compensation in respect of acts of third parties occurring before the date of publication of the trade mark application (i.e. the date from which the trade mark application is deemed to be known to third parties) (paragraph 38, 39 and 59).

Regarding infringing acts of third parties committed in the period between the publication of the trade mark application and the publication of its registration, the ECJ considers that the concept of 'reasonable compensation' "*refers to recovery of the profits actually derived by third parties from use of the mark during that period*" and "*rules*



*out compensation for the wider harm which the proprietor of the mark may have suffered, including, as the case may be, moral prejudice” (paragraph 59).*

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**Nikolajeva  
v Multi Protect**

The ECJ explains that in light of the conditional nature of the rights following from a trade mark application, the ‘reasonable compensation’ must have a narrower scope than the damages which may be claimed by the proprietor of an EU trade mark for acts of infringement occurring after publication of the registration (paragraph 56).

The ECJ considers recovery of profits an appropriate redress in this regard, because this “*falls within the scope of the objective pursued by Article 9(3) of [Trade Mark Regulation 207/2009], which consists in preventing third parties from improperly benefiting from the intrinsic economic value constituted by the application for registration of a trade mark, when they are deemed to have had knowledge of that application as a result of its publication” (paragraph 58).*



**INFRINGEMENT ACTION AND  
CLAIM FOR DAMAGES BY  
UNREGISTERED LICENSEE**

C-419/15

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**Thomas Philipps  
v Grune Welle**

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The matter concerns a request for a preliminary ruling on the interpretation of Articles 32(2) and 33(2) of the Community Design Regulation.

**The matter at hand**

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By its first question, the referring German court asked whether Article 33(2) must be interpreted as meaning that the holder of a license which has not been entered in the Register cannot bring proceedings alleging infringement of a Community design.

By its second question, the referring court asked whether Article 32(3) must be interpreted as meaning that the licensee can claim damages for its own loss in infringement proceedings initiated by the licensee himself. The referring court had doubts about this, because Article 32(4) of the Community Design Regulation provides that a licensee is entitled to intervene in an infringement action brought by the rightholder in order to obtain compensation for damage suffered by the licensee, but does not provide that the licensee can claim such compensation in an infringement action brought by the licensee.

The first question was already answered in the affirmative in *Hassan v Breiding* (C-163/15), discussed in the Winter section of this book.

**The judgment  
of the ECJ**

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C-419/15

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**Thomas Philipps  
v Grune Welle**

Regarding the second question, the ECJ rules that the licensee can indeed claim damages for its own loss in infringement proceedings brought by the licensee (paragraph 32). According to the ECJ, the system would lack coherence if the licensee could claim its own damages only by joining an action brought by the rightholder of the Community design, while he may act alone in an infringement action (paragraph 30).

# CONTRACTUAL OBLIGATION TO PAY ROYALTIES FOR USE OF REVOKED PATENT IS NOT A RESTRICTION OF COMPETITION

C-567/14

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**Genentech  
v Hoechst**

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This preliminary ruling concerns the question of whether a licensee is required to pay royalties pursuant to a license agreement relating to the use of a patent that was revoked (with retroactive effect) at some point during the term of the licence agreement.

**The matter at hand**

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More specifically, the referring court was unsure whether this is compatible with the provisions of Article 101 TFEU (which prohibits cartels and other agreements that could disrupt free competition within the internal market), in so far as it requires the licensee to pay royalties for the use of a revoked patent and thereby places the licensee at a 'competitive disadvantage' compared to competitors.

The referring court therefore asked the ECJ whether Article 101(1) TFEU must be interpreted as precluding the imposition on the licensee of an obligation to pay a royalty for the use of a patented technology for the entire period during which that agreement was in effect in the event of the revocation or non-infringement of patents protecting that technology.

The ECJ recalls that it has already ruled in *Ottung* (C-320/87), in the context of an exclusive licence agreement, "*that the obligation to pay a royalty, even after the expiry of the period of validity of the licensed patent may reflect a commercial assessment of the value to be attributed to the possibilities of*

**The judgment  
of the ECJ**

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C-567/14

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**Genentech  
v Hoechst**

*exploitation granted by the licence agreement, especially when that obligation to pay was embodied in a licence agreement entered into before the patent was granted (...). In such circumstances, where the licensee may freely terminate the agreement by giving reasonable notice, an obligation to pay a royalty throughout the validity of the agreement cannot come within the scope of the prohibition set out in Article 101(1) TFEU” (paragraph 39).*

*“That assessment is based on the finding that that royalty is the price to be paid for commercial exploitation of the licensed technology with the guarantee that the licensor will not exercise its industrial-property rights. As long as the licence agreement at issue is still valid and can be freely terminated by the licensee, the royalty payment is due (...).” (paragraph 40).*

The ECJ reasons that the solution stemming from the Ottung judgment applies a fortiori in the situation at issue in the main proceedings: *“If, during the period in which a licence agreement is in effect, the payment of the royalty is still due even after the expiration of industrial property rights, the same applies, a fortiori, before the validity of those rights has expired.” (paragraph 41).*

On this basis, the ECJ rules that *“Article 101(1) TFEU must be interpreted as not precluding the imposition on the licensee, under a licence agreement such as that at issue in the main proceedings, of a requirement to pay a royalty for the use of a patented technology for the entire period in which that agreement was in effect, in the event of the revocation or non-infringement of a licenced patent, provided that the licensee was able freely to terminate that agreement by giving reasonable notice.”*

### **Commentary**

Although the solution reached by the ECJ appears unreasonable, it is true that the licensee did enjoy a competitive advantage compared to unlicensed competitors before the moment of revocation of the patent, namely that of being able to use the technology with the guarantee that the licensor would not exercise its patent rights. Therefore, as long as the licensee can freely terminate the license as soon as the patent is revoked, it cannot be said that he suffered a competitive disadvantage. The judgment also fits nicely with a well-known principle stemming from ancient Rome: *pacta sunt servanda*.

C-567/14

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**Genentech  
v Hoechst**





## TENANT OF A PHYSICAL MARKETPLACE IS INTERMEDIARY

C-494/15

Tommy Hilfiger  
v Delta Center

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Delta Center is the tenant of a marketplace named “Pražská tržnice” (Prague Market Halls), which sublets the various sales areas situated in that marketplace to market-traders. Having established that counterfeit goods were sold in those market halls, various trademark owners (including Tommy Hilfiger) jointly took action against Delta Center before the Czech courts, asking an order against Delta Center to take measures preventing the sale of such counterfeit goods, by refraining from subletting sales areas to market-traders who have previously been convicted for IP-infringement.

The matter at hand

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In these circumstances, the question arose whether Article 11 of the Enforcement Directive should be interpreted as meaning that it is possible to order a tenant of a *physical* marketplace – just like an operator of an *online marketplace* (see the *L’Oréal*-judgment of 12 July 2011, C-324/09) – to take measures preventing the sale of counterfeit goods.

In those circumstances, the Czech Supreme Court decided to stay the proceedings and to refer the following questions to the ECJ:

- I. Is a tenant of a physical marketplace an intermediary whose services are used by a third party to infringe an intellectual property right within the meaning of Article 11 of the Enforcement Directive?

C-494/15

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**Tommy Hilfiger  
v Delta Center**

**The judgment  
of the ECJ**

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- II. Is it possible to impose on a tenant of a physical marketplace, measures, as provided for in Article 11 Enforcement Directive, under the same conditions as those formulated by the ECJ in the *L'Oréal*-judgment of 12 July 2011, C-324/09?

Regarding the first question, the ECJ establishes that the scope of the Enforcement Directive is not limited to electronic commerce (paragraph 29). Article 11 of the Enforcement Directive is therefore not limited to online intermediaries, but also applies to “*an operator which provides to third parties a service relating to the letting or subletting of pitches in a marketplace, thanks to which they have access to that marketplace and offer for sale in that marketplace counterfeit branded products*” (paragraph 28).

Likewise, as to the second question, there is no reason to treat physical market places differently than online market places. Therefore, “*the conditions for an injunction (...) against an intermediary who provides a service relating to the letting of sales points in market halls are identical to those for injunctions which may be addressed to intermediaries in an online marketplace, set out by the Court in the judgment of 12 July 2011 in L'Oréal and Others (C324/09).*”

With reference to its aforementioned judgment in *L'Oréal*, the ECJ repeats that such injunctions must be effective and dissuasive (paragraph 33), equitable and proportionate (paragraph 34) and must ensure a fair balance between the protection of intellectual property and the absence of obstacles to legitimate trade (paragraph 35).

The ECJ furthermore confirms that the intermediary cannot be required to exercise general and permanent oversight over its customers. “*By contrast the intermediary may be forced to take measures which contribute to avoiding new infringements of the same nature by the same market-trader*” (paragraph 34).

**Commentary**

It should be noted that there is one important difference between physical and online market places that was not addressed by the ECJ, namely that physical market places cannot benefit from the limitations of liability applicable to hosting providers pursuant to Article 14 of the E-Commerce Directive. It seems, however, unlikely that national courts will hold operators of physical market places liable for infringements by their tenants in circumstances where they do not have actual knowledge of the infringements and act expeditiously to stop them once made aware of them.

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**Tommy Hilfiger  
v Delta Center**



## BRUSSELS I DOES NOT PRECLUDE APPLICATION JURISDICTION RULE IN ARTICLE 4.6 BCIP

C-230/15

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Brite Strike

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Brite Strike Technologies SA, established in Luxembourg, is the owner of the Benelux trade mark BRITE STRIKE. Brite Strike Technologies Inc. brought an action before the referring court in The Hague seeking a declaration of invalidity in respect of that mark on grounds of bad faith. Brite Strike Technologies Inc. based the jurisdiction of the court on Article 22(4) Brussels I, The Hague being the place where the Benelux trade mark register is kept.

The matter at hand

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Brite Strike Technologies SA raised an objection of lack of jurisdiction, arguing that the jurisdiction rules laid down in the Benelux Convention on Intellectual Property (“BCIP”) should be applied, according to which the action should have been brought in Luxembourg.

Bearing in mind that Article 71 Brussels I provides that it does not affect any conventions to which Member States are parties and which, in relation to particular matters, govern jurisdiction, the referring court asked the ECJ whether Article 71 Brussels I allows the member states of the BCIP to apply jurisdiction laid down therein.

With reference to its judgment in *TNT Express Nederland* (C533/08), the ECJ considers that Article 71 Brussels I applies to conventions concluded between Member States *before* the entry into force of Brussels I only. This limitation of the scope of Article 71 Brussels I “*reflects the settled*

The judgment of the ECJ

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C-230/15

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**Brite Strike**

*case-law stating that, as and when common rules come into being, the Member States no longer have the right to conclude international agreements affecting those rules” (paragraph 53).*

Although the BCIP was concluded *after* the entry into force of Brussels I, this does not decide the matter yet, as the ECJ states that it must also be determined “*whether the BCIP and that limitation are incompatible, which would have as a consequence that Article 71 [Brussels I] does not authorise the application of Article 4.6 of the BCIP instead of Article 22(4) [Brussels I]*” (paragraph 55).

In that examination, according to the ECJ, account must be taken of the fact that the BCIP is an agreement concluded in the framework of a regional union, the Benelux, and that Article 71 Brussels I must therefore be interpreted in the light of Article 350 TFEU, which provides that EU law does not preclude the existence or completion of that regional union, in so far as the objectives it pursues are not attained by the application of EU law (paragraph 56).

The ECJ explains that this enables the Benelux to leave in force, by way of derogation from the EU rules, the rules which apply within their regional union, if that regional union is further advanced than the internal market and if that derogation is indispensable for the proper functioning of the Benelux regime (paragraph 57).

The ECJ considers that the first requirement is met as the “*Benelux trade marks and designs are subject to completely uniform rules and common institutional and procedural rules*” (paragraph 59).

With regard to the second requirement, the ECJ holds that: “*having regard to the fact that Benelux trade marks and designs fall within a regime in the three Member States concerned which is in advance of the jurisdictional structure established by Benelux [...] the codified rule in Article 4.6 of the*

*BCIP [...] may [...] be treated as indispensable for the proper functioning of the Benelux regime of trade marks and designs” (paragraph 63).*

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**Brite Strike**

Consequently, as both requirements are met, the ECJ concludes that Article 71 Brussels I, read in the light of Article 350 TFEU, does not preclude the application to those disputes of the rule of jurisdiction for disputes relating to Benelux trade marks and designs, laid down in Article 4.6 of the BCIP (paragraphs 66 and 71).

#### **Commentary**

This outcome is not in line with an earlier decision of the Regional Court of Appeal of The Hague, which had held that the jurisdiction rules of Brussels I prevail over those of the BCIP. As the ECJ correctly points out, however, the result of such an outcome would have been that all disputes regarding Benelux trade mark are concentrated before the Dutch courts, which would have disrupted the proper functioning of the Benelux system of trade marks and designs.





## HEALTH CLAIMS IN ADVERTISING INTENDED FOR PROFESSIONALS FALL WITHIN SCOPE OF NUTRITION AND HEALTH CLAIMS REGULATION

C-230/15

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Verband Sozialer  
Wettbewerb  
v Innova Vital

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Innova Vital marketed a nutritional supplement and sent, exclusively to doctors, a document with laudatory claims about this supplement. The Verband Sozialer Wettbewerb (an association against unfair competition) claimed before the referring court in Munich that the document contains health claims that are prohibited by Article 10(1) of the Nutrition and Health Claims Regulation.

The matter at hand

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The referring court had doubts as to whether the provisions of the Nutrition and Health Claims Regulation apply to advertising intended for professionals and asked the ECJ, in essence, whether Article 1(2) of the Nutrition and Health Claims Regulation must be interpreted as meaning that nutrition or health claims made in a commercial communication on a food which is intended to be delivered as such to the final consumer, if that communication is addressed not to the final consumer, but exclusively to health professionals, fall within the scope of that regulation.

The ECJ first of all considers that “*the concept of a ‘commercial communication’ within the meaning of Article 1(2) of [the Nutrition and Health Claims Regulation], must be understood as covering, inter alia, a communication made in the form of advertising foods, designed to promote, directly or indirectly, those foods*” (paragraph 29).

The judgment  
of the ECJ

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C-230/15

**Verband Sozialer  
Wettbewerb  
v Innova Vital**

The ECJ continues by clarifying that *“such a communication may also take the form of an advertising document which food business operators address to health professionals, containing nutritional or health claims within the meaning of that regulation, in order that those professionals recommend, if appropriate, that their patients purchase and/or consume that food”* (paragraph 30).

Since, according to the ECJ, it cannot be ruled out that the health professionals themselves may be misled by false, deceptive, or even mendacious nutrition or health claims, there is a risk that those health professionals forward, in all good faith, incorrect information on foods which are the subject of a commercial communication to final consumers with whom they have a relationship (paragraphs 44 and 45).

Furthermore, the ECJ holds that if the communication to professionals were not within the scope of the Regulation, *“there would be a risk that the food business operators would circumvent the obligations laid down by that regulation, addressing the final consumer through health professionals, in order that those professionals recommend their foods to that consumer”* (paragraph 46).

Consequently, the ECJ concludes that *“Article 1(2) of [the Nutrition and Health Claims Regulation] must be interpreted as meaning that nutrition or health claims made in a commercial communication on a food which is intended to be delivered as such to the final consumer, if that communication is addressed not to the final consumer, but exclusively to health professionals, falls within the scope of that regulation”* (paragraph 54).

## EUIPO NOT BOUND TO JUDGMENT OF NATIONAL COURT WITH REGARD TO IDENTICAL NATIONAL TRADE MARK

C-226/15 P

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Apple and Pear  
v EUIPO

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Carolus C. filed an application for registration of an EU trade mark and a Benelux trade mark, both for the word mark ENGLISH PINK. Apple and Pear Australia and Star Fruits Diffusion filed an opposition against the EU trade mark application on the basis of its earlier EU trade mark for the word mark PINK LADY. Both the Opposition Division and the Board of Appeal rejected the opposition, the latter without taking account of the judgment of the EU trade mark court in Brussels which had meanwhile been rendered in proceedings between the same parties, in which the Benelux trade mark was annulled and Carolus C. was ordered to refrain from using that mark in the EU.

The matter at hand

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In the appeal brought before it, the General Court annulled the contested decision on the ground that the Board of Appeal had failed to state its reasons for not taking the judgment of the court in Brussels into account, but rejected the remainder of the appeal, considering that the res judicata attached to the judgment of the court in Brussels is not binding on EUIPO.

The ECJ rules that, “*in order that decisions of a court of a Member State or EUIPO which have become final are res judicata and can therefore be binding on such a court or EUIPO, it is required that parallel proceedings before them have the same parties, the same subject matter and the same cause of action*” (paragraph 52).

The judgment  
of the ECJ

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C-226/15 P

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**Apple and Pear  
v EUIPO**

According to the ECJ, the respective subject matter of the cases examined by the court in Brussels and by EUIPO are not identical since “*the action for infringement before the Belgian court sought annulment of the Benelux mark ENGLISH PINK and an order to refrain from using that sign throughout the territory of the Union, whereas the subject matter of the proceedings before EUIPO was opposition to the registration of the EU trade mark ENGLISH PINK*” (paragraph 54).

Moreover, the ECJ holds that “in the light of the exclusive competence of EUIPO’s adjudicating bodies to authorise or refuse the registration of an EU trade mark (...) the subject matter of any proceedings before EUIPO relating to registration of an EU trade mark or opposition to that registration necessarily is different to any proceedings before a national court, even where that court acts as an EU trade marks court” (paragraph 62).

The ECJ concludes that the General Court correctly found that the principle of *res judicata* did not mean that the Board of Appeal was bound by the judgment of the court in Brussels (paragraph 64).

**Commentary**

Although the decision is understandable from the perspective of the exclusive jurisdiction of EUIPO in opposition proceedings, the outcome is peculiar; On the one hand, Carolus C. is ordered by an EU trade mark court to refrain from using the contested mark in the EU, while on the other hand he does obtain a valid EU trade mark registration for that mark. However, unless the judgment of the court in Brussels constitutes a ‘proper reason’ for non-use within the meaning of Article 15 of Trade Mark Regulation 2008/95, Apple and Pear Australia and Star Fruits Diffusion will be able to get the mark revoked after all in five years time.

## DISCRETION BOARDS OF APPEAL DOES NOT EXTEND TO NEW EVIDENCE

C-597/14 P

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EUIPO  
v Grau Ferrer

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Ferrer filed an opposition against an EU trade mark application on the basis of its earlier Spanish trade mark. The Board of Appeal rejected the opposition on the ground that the existence and validity of the earlier Spanish trade mark had not been sufficiently substantiated within the period prescribed.

The matter at hand

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In the appeal brought before it, the General Court annulled this decision considering that the Board of Appeal had failed to exercise its discretion to take account of evidence on the validity of the earlier Spanish trade mark which had been produced before the Board of Appeal for the first time. EUIPO appealed this decision before the ECJ.

The ECJ holds that Rule 50 of the Implementing Regulation extends the discretion of the Boards of Appeal to additional or supplementary evidence produced before the Boards of Appeal for the first time, but not to new evidence (paragraph 27).

The judgment  
of the ECJ

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Accordingly, the ECJ rules that “*the General Court erred in law (...) by holding that the Board of Appeal had failed to exercise the discretion conferred on it to decide whether or not it was appropriate to take additional evidence into consideration*” (paragraph 28).

The ECJ, however, continues that it follows from settled case-law that where the grounds of a judgment of the

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**EUIPO**  
**v Grau Ferrer**

General Court disclose an infringement of EU law whereas the operative part of the judgment is shown to be well founded for other legal reasons, the appeal must be dismissed after all (paragraph 29).

Considering that the General Court also relied on the fact that the Board of Appeal had rejected the evidence at issue without examining whether it could be regarded as being 'supplementary' instead of 'new', the ECJ concludes that the appeal must be dismissed (paragraphs 30 and 31).

**THE SUCCESSFUL PARTY SHOULD  
HAVE THE RIGHT TO REIMBURSEMENT  
OF A SIGNIFICANT AND APPROPRIATE  
PART OF THE REASONABLE COSTS  
ACTUALLY INCURRED**

C-57/15

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**United Video  
Properties  
v Telenet**

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This matter concerns the interpretation of Article 14 of the Enforcement Directive, which provides that Member States shall ensure that reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity does not allow this.

**The matter at hand**

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The request has been made in proceedings in Belgium between United Video Properties and Telenet, in which the claims instituted by United Video Properties on the basis of an alleged patent infringement were denied and in which United Video Properties was ordered to pay Telenet a procedural cost indemnity relating to the proceedings at first instance of € 11 000, the maximum amount provided for in the Belgium Judicial Code. United Video Properties lodged an appeal against that judgment before the Antwerp Court of Appeal, but subsequently decided to discontinue its appeal. After that discontinuance, Telenet requested that United Video Properties be ordered to reimburse it € 185 462 in respect of lawyers' fees and € 44 400 in respect of the assistance provided by an agent specialised in the field of patents.

At issue was first of all whether a provision of the Belgium Judicial Code which provides for a flat-rate scheme setting out an absolute reimbursement ceiling in respect of costs for the assistance of a lawyer is compatible with the Enforcement Directive.

C-57/15

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**United Video  
Properties  
v Telenet**

**The judgment  
of the ECJ**

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Secondly, the referring court asked whether national rules providing that reimbursement of the costs of a technical adviser is provided for only in the case of fault on the part of the unsuccessful party is compatible with the Enforcement Directive.

Regarding the first question, the ECJ holds that national legislation that lays down an absolute limit in respect of legal costs *“must ensure, on the one hand, that that limit reflects the reality of the rates charged for the services of a lawyer in the field of intellectual property, and, on the other, that, at the very least, a significant and appropriate part of the reasonable costs actually incurred by the successful party are borne by the unsuccessful party”* (paragraph 30).

This precludes national legislation providing maximum amounts that are too low, *“so that the reimbursement which the successful party may claim becomes disproportionate or even, where applicable, insignificant, thus depriving Article 14 of [the Enforcement Directive] of its practical effect”* (paragraph 30).

In that light, the ECJ holds that *“Article 14 of [the Enforcement Directive] must be interpreted as not precluding national legislation (...) which provides that the unsuccessful party is to be ordered to pay the legal costs incurred by the successful party, offers the courts responsible for making that order the possibility of taking into account features specific to the case before it, and provides for a flat-rate scheme for the reimbursement of costs for the assistance of a lawyer, subject to the condition that those rates ensure that the costs to be borne by the unsuccessful party are reasonable, which it is for the referring court to determine. However, Article 14 of that directive precludes national legislation providing flat-rates which, owing to the maximum amounts that it contains being too low, do not ensure that, at the very least, that a significant and appropriate part of the reasonable costs incurred by the successful party are borne by the unsuccessful party”* (paragraph 32).



As to whether a national rule may subject the reimbursement of the costs of a technical adviser to the condition that the unsuccessful party has committed a fault, this depends on the link between those costs and the judicial procedure concerned (paragraph 38). If such a link is direct and close, those costs fall within the scope of Article 14 of the Enforcement Directive as ‘other expenses’ and cannot be conditioned on fault (paragraph 36). The costs of a technical adviser incurred in the context of a general observation of the market and the detection of possible infringements of intellectual property law do not appear to show such a close direct link between the costs and the judicial procedure (paragraph 39). However, to the extent that the services of a technical adviser are essential in order for a legal action to be usefully brought seeking, in a specific case, to have such a right upheld, the costs thereof do fall within the scope of Article 14 of the Enforcement Directive (paragraph 39).

In those circumstances, Article 14 of the Enforcement Directive “*precludes national rules providing that reimbursement of the costs of a technical adviser are provided for only in the event of fault on the part of the unsuccessful party, given that those costs are directly and closely linked to a judicial action seeking to have such an intellectual property right upheld*” (paragraph 40).

### **Commentary**

The application of Article 14 of the Enforcement Directive in the various Member States is far from uniform and case law shows that courts often have difficulty determining what constitutes ‘reasonable and proportionate’ legal costs. In several countries, courts or Member States have therefore chosen for flat-rate schemes that give the courts some guidance. For the courts, it will have come as good news that the ECJ in principle allows such schemes, as long as the rates are ‘reasonable’, ‘not too low’ and ensure

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**United Video  
Properties  
v Telenet**

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**United Video  
Properties  
v Telenet**

that a 'significant' and 'appropriate' part of the 'reasonable' costs actually incurred by the successful party are borne by the unsuccessful party. Although this does set some kind of standard, this still leaves courts and Member States some discretion when dealing with cost claims in IP proceedings.

**COMPUTERS SOLD EXCLUSIVELY  
WITH PRE-INSTALLED SOFTWARE  
NOT UNFAIR**

C-310/15

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**Vincent Deroo  
v Sony**

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A French consumer purchased a Sony laptop including pre-installed Windows software. Upon the first use of the computer, the consumer refused to accept the end-user licence agreement. Instead, the consumer requested Sony to reimburse him for part of the purchase price of the laptop that would correspond to the cost of the pre-installed software, that he would never use. Sony refused this, submitting that the computer and the pre-installed software form part of a single and non-separable offer. Sony offered to cancel the sale and to reimburse the entirety of the sale price. Since there was no option for the consumer to purchase the same model not equipped with pre-installed software, the consumer declined this offer and issued proceedings against Sony (for payment of € 450 for the pre-installed software and of € 2,500 for the damage suffered as a result of unfair commercial practices). The claims were dismissed by the District Court and the Court of Appeals in France, but the Court of Cassation decided to refer questions to the ECJ.

**The matter at hand**

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The referring court asked whether the sale of a computer equipped with pre-installed software without any option for the consumer to purchase the same model of computer not equipped with that software constitutes an unfair commercial practice within the meaning of Article 5(2) of the Unfair Commercial Practices Directive, which provides that a commercial practice is unfair if it is contrary to the

C-310/15

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**Vincent Deroo  
v Sony**

requirements of professional diligence and it materially distorts or is likely to materially distort the economic behaviour with regard to the product of the average consumer.

Secondly, the court asked whether the failure to indicate the price of the pre-installed software constitutes a misleading commercial practice within the meaning of Article 5(4)(a) and Article 7 of the Directive.

Regarding the first question, the ECJ considers that it must be ascertained “*whether the behaviour of the trader entails a possible violation of honest market practices or of the principle of good faith in the trader’s field of activity*” (paragraph 34).

**The judgment  
of the ECJ**

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The ECJ considers that this does not appear to be the case here, considering “*that the consumer was correctly informed, that the combined offer met the expectations of a significant proportion of consumers and that it was possible for the consumer to accept all the elements of that offer or to cancel the sale*” (paragraph 37). As to whether the combined offer impairs the ability of consumers to make an informed transactional decision, the ECJ seems to consider that unlikely in the given circumstances as well, but leaves this for the referring court to determine (paragraph 41).

Regarding the failure to indicate the price of the pre-installed software, the ECJ considers that it is clear from the wording of the Directive that the overall price of the product offered for sale, and not the price of each individual component, is considered to be material information which the consumer needs to make an informed transactional decision (paragraph 46). Therefore, the failure to indicate the price of the pre-installed software is “*not such as to prevent the consumer from taking an informed transactional decision or likely to cause the average consumer to make a transactional decision that he would not have taken otherwise*”.

## **HYPERLINKING TO AN ILLEGAL SOURCE CONSTITUTES COMMUNICATION TO THE PUBLIC**

C-160/15

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**GS Media  
v Sanoma**

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GS Media operates the news and entertainment website GeenStijl, which provides, according to that website, “news, scandalous revelations and investigative journalism with light-hearted items and wacky nonsense”. GeenStijl is one of the 10 most visited news websites in the Netherlands.

**The matter at hand**

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On 26 October 2011, the editors of GeenStijl received a message from a person using a pseudonym, with a hyperlink to an electronic file hosted on the website Filefactory.com containing as yet unpublished nude photographs of Dutch reality star Britt Dekker which had been made for Playboy, a magazine published by Sanoma. The next day, an article entitled “...! Nude photos of Britt Dekker” was published on GeenStijl, together with a hyperlink to the electronic file containing the photos.

Sanoma subsequently brought proceedings against GS Media, claiming that by publishing the hyperlink, GS Media had infringed the photographer’s copyright and acted unlawfully towards Sanoma. The District Court in Amsterdam upheld Sanoma’s claims, but that decision was set aside in appeal, after which Sanoma appealed to the Dutch Supreme Court.

Bearing in mind that the ECJ had already held in *Svensson* (C-466/12) that the posting of a hyperlink to a protected work published on another website with the consent of the

C-160/15

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**GS Media  
v Sanoma**

rightholder, does not constitute a communication to the public within the meaning of the Copyright Directive, the Supreme Court asked the ECJ, in essence, whether this rule also applies to hyperlinks to protected works which have been made available to the general internet public without the consent of the rightholder.

**The judgment  
of the ECJ**

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First of all, the ECJ recalls that hyperlinking to a so-called legal source does not constitute a communication to the public, because such hyperlink does not reach a 'new' public, that is to say a public that was not already taken into account by the copyright holder when he authorized the initial communication to the public of his work. Where a copyright holder has made his work freely available on a website, he must, after all, be considered to have taken all internet users into account. Consequently, a hyperlink to that work does not reach a public not already taken into account by the copyright holder (paragraph 42).

Where it concerns a hyperlink to an illegal source, however, it cannot be said that the copyright holder has already consented to the public availability of his work on the internet. In such a case, therefore, the hyperlink does reach a new public (paragraph 43).

Secondly, the ECJ assesses whether the posting of a hyperlink to an illegal source constitutes an 'act of communication', which requires that a person "*intervenes, in full knowledge of the consequences of [his] action, to give access to a protected work*" (paragraph 35).

In this regard, and considering that "*the internet is (...) of particular importance to freedom of expression and of information (...) and that hyperlinks contribute to its sound operation as well as to the exchange of opinions and information in that network*", the ECJ notes that "*it may be difficult, in particular for individuals who wish to post such links, to ascertain whether [the] website to which those links*

*are expected to lead, provides access to works which are protected and, if necessary, whether the copyright holders of those works have consented to their posting on the internet” (paragraphs 45 and 46).*

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**GS Media  
v Sanoma**

Therefore, it is necessary, “when the posting of a hyperlink to a work freely available on *another website is carried out by a person who, in so doing, does not pursue a profit, to take account of the fact that that person does not know and cannot reasonably know, that that work had been published on the internet without the consent of the copyright holder” (paragraph 47). In other words, account must be taken of the fact that such a person “does not, as a general rule, intervene in full knowledge of the consequences of his conduct in order to give customers access to a work illegally posted on the internet” (paragraph 48).*

Obviously, this is different “*where it is established that such a person knew or ought to have known that the hyperlink he posted provides access to a work illegally placed on the internet, for example owing to the fact that he was notified thereof by the copyright holders” (paragraph 49).*

As to the posting of a hyperlink by a person who does pursue a profit, the ECJ holds that “*it can be expected that the person who posted such a link carries out the necessary checks to ensure that the work concerned is not illegally published on the website to which those hyperlinks lead, so that it must be presumed that that posting has occurred with the full knowledge of the protected nature of that work and the possible lack of consent to publication on the internet by the copyright holder. In such circumstances, and in so far as that rebuttable presumption is not rebutted, the act of posting a hyperlink to a work which was illegally placed on the internet constitutes a ‘communication to the public’” (paragraph 51).*

C-160/15

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**GS Media  
v Sanoma**

**Commentary**

This judgment means that news media and all other websites pursuing a profit are expected to verify whether a link leads to a legal source before publishing it and are liable for copyright infringement if it turns out the link leads to an illegal source (unless they manage to rebut somehow that they had knowledge of the “possible” lack of consent to publication on the internet by the copyright holder). The judgment has been criticized out of fear that this may hinder the free flow of information on the internet as well as the freedom of expression. It seems, however, that there is still room to weigh the interests protected by copyright against those protected by other fundamental rights, which may tip the balance in favour of the latter in exceptional circumstances.



# PROVIDER OF FREE WI-FI NETWORK IS NOT LIABLE FOR THIRD-PARTY COPYRIGHT INFRINGEMENTS BUT MAY BE REQUIRED TO TAKE MEASURES TO PROTECT ITS NETWORK

C-484/14

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Mc Fadden  
v Sony Music

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Mc Fadden runs a store selling and leasing lighting and sound systems. In order to draw the attention of customers of near-by shops, passers-by and neighbours, he offered anonymous access to a free Wi-Fi network which could be accessed in the vicinity of the store. This Wi-Fi network was subsequently used by a third party to make a musical work available on the internet free of charge to the general public without the consent of the rightholders, including Sony Music.

The matter at hand

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In these circumstances, the referring court asked the ECJ whether Article 12(1) of the E-Commerce Directive should be interpreted as meaning that a professional who, in the course of business, operates a Wi-Fi network can be held liable for copyright infringements committed by users of that network.

First of all, the ECJ holds that the making available of a Wi-Fi network to the general public free of charge constitutes an 'information society service' within the meaning of Article 12(1) of the E-Commerce Directive where the activity is performed by the service provider for the purposes of advertising the goods sold or services supplied by that service provider (paragraph 43).

The judgment  
of the ECJ

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Furthermore, the ECJ confirms that, where the three conditions in Article 12(1) of the E-Commerce Directive

C-484/14

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**Mc Fadden  
v Sony Music**

are satisfied – namely that the provider 1) does not initiate the transmission, 2) does not select the receiver of the transmission and 3) does not select or modify the information contained in the transmission – a service provider such as Mc Fadden, who provides access to a communication network, may not be held liable for copyright infringements committed by users of that network (paragraphs 54 and 65). Consequently, the copyright holder is not entitled to claim compensation from the provider of that network or to claim reimbursement of the legal costs in relation to that claim (paragraph 79).

The ECJ, however, continues that Article 12(1) of the E-Commerce Directive does not preclude a copyright holder “*from claiming injunctive relief against the continuation of that infringement and the payment of the costs of giving formal notice and court costs from a communication network access provider whose services were used in that infringement where such claims are made for the purposes of obtaining, or follow the grant of injunctive relief by a national authority or court to prevent that service provider from allowing the infringement to continue*” (paragraph 79).

Regarding the measures that such a provider can be required to take in order to prevent the recurrence of an infringement, the ECJ recalls, with reference to *Promusicae* (C-275/06) and *UPC Telekabel Wien* (C-314/12), that these measures must strike a fair balance between the freedom to conduct a business protected under Article 16 of the Charter and the fundamental right to the protection of intellectual property laid down in Article 17(2) of the Charter.

According to the ECJ, a measure consisting in securing a Wi-Fi network by means of password-protection, must be considered to strike such a fair balance, provided that users are required to reveal their identity in order to obtain the password (paragraph 96). Measures consisting of monitoring the information transmitted over the network

or in terminating the internet connection completely, however, cannot be regarded as complying with the requirements of ensuring a fair balance between the fundamental rights which must be reconciled (paragraphs 87 and 89).

C-484/14

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**Mc Fadden  
v Sony Music**

### **Commentary**

This judgment makes it difficult for stores to offer free Wi-Fi-access to their customers. After all, the requirement to have customers reveal their identity in order to obtain the password, creates a barrier for customers to use the network. The judgment has been widely criticized as causing disproportionate damage to society as a whole, because it may lead to less publicly available Wi-Fi access points and may impact Commission President Juncker's goal to provide free Wi-Fi in public spaces across Europe.



## ITALIAN LEGISLATION ON FAIR COMPENSATION IN BREACH WITH EU LAW

C-110/15

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**Nokia  
v SIAE**

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The applicants in the main proceedings, including Nokia, Hewlett-Packard, Dell and Sony, produce and sell personal computers, recorders, storage media, mobile telephones and cameras. In the context of several disputes concerning the 'fair compensation' to be paid by the applicants to the Italian collecting society SIAE for private copies made by virtue of the Italian implementation of Article 5(2)(b) of the Copyright Directive, the referring court in Italy referred the following questions to ECJ:

**The matter at hand**

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- I. Does Article 5(2)(b) of the Copyright Directive preclude national legislation according to which an exemption from the levy for private copying with respect to reproduction media and devices acquired for professional use, can be obtained only through the conclusion of agreements with the national collecting society, in this case SIAE?
  
- II. Does Article 5(2)(b) of the Copyright Directive preclude national legislation that provides that, when reproduction media and devices are acquired for professional use only, reimbursement of the levy paid may be requested only by the final user and not by the manufacturers and importers of the media and devices?

## The judgment of the ECJ

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The ECJ holds that the questions of the referring court must be examined in light of the two principles set by the ECJ in *Copydan* (C-463/12) and *Amazon* (C-521/11), namely that (i) the private copying levy “*must not be applied to the supply of reproduction equipment, devices and media to persons other than natural persons for purposes clearly unrelated to private copying*” (paragraph 36) and that (ii) the levy system used “*must provide for a right to reimbursement of the private copying levy which is effective and does not make it excessively difficult to obtain repayment of the levy paid*” (paragraph 37).

Further, the ECJ makes clear that the exceptions provided for in Article 5 of the Copyright Directive “*must be applied in a manner consistent with the principle of equal treatment, affirmed in Article 20 of the Charter (...) which (...) requires that comparable situations must not be treated differently and that different situations must not be treated in the same way unless such treatment is objectively justified*” (paragraph 44).

The ECJ rules that the Italian system does not comply with these principles, because the national legislation does not contain any generally applicable provision exempting producers and importers who show that the devices and media were acquired for professional use, and because such an exemption can be obtained only by concluding an agreement with SIAE, the terms of which may differ in each case being subject to ‘free bargaining’ (paragraphs 46-49).

Regarding the second question, the ECJ recalls that it already held in *Copydan* (C-463/12) that EU law does not preclude a system of fair compensation which provides for a right to reimbursement of the private copying levy for the final user of the devices or media subject to the levy, provided that the persons responsible for payment (in this case the manufacturers and importers of said media and devices) are exempt from payment of that levy if they establish that they have supplied the devices and media in question to persons other than natural

persons for purposes clearly unrelated to private copying (paragraph 55).

C-110/15

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**Nokia  
v SIAE**

On this basis, the ECJ concludes that Article 5(2)(b) of the Copyright Directive “*precludes national legislation, such as that at issue in the main proceedings, that, on the one hand, subjects exemption from payment of the private copying levy for producers and importers of devices and media intended for use clearly unrelated to private copying to the conclusion of agreements between an entity which has a legal monopoly on the representation of the interests of authors of works, and those liable to pay compensation, or their trade associations, and, on the other hand, provides that the reimbursement of such a levy, where it has been unduly paid, may be requested only by the final user of those devices and media*” paragraph 56).

Furthermore, the ECJ denies SIAE’s request to limit the effects of the judgment in time (paragraphs 57-64), which means SIAE may become liable for the restitution of levies already collected from the applicants in the past with respect to devices and media acquired for professional use, even though SIAE has already distributed the collected levies to the rightholders.

### **Commentary**

This judgment is likely to have serious repercussions for levy systems across Europe. Dutch law, for example, also does not contain any generally applicable exemption for producers and importers who show that the devices and media were acquired for professional use, and also leaves it up to the national collecting society, Stichting de Thuiskopie, to grant such exemptions through agreements concluded with producers and importers.





**INJUNCTION ONLY FOR  
THE PARTS OF THE EU WHERE  
THERE EXISTS LIKELIHOOD  
OF CONFUSION**

C-223/15

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**Combit  
v Commit**

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The company Combit Software is the owner of a German trade mark and an EU trade mark for the word mark COMBIT for goods and services in the computer industry. Commit Business Solutions sells software bearing the word sign COMMIT through its website in a number of countries, including Germany. Combit Software sought, on the basis of its EU trade mark, an order that Commit Business Solutions refrain from using, in the EU, the word sign COMMIT. In the alternative, it requested, in reliance on its German trade mark, an order that Commit Business Solutions refrain from using that word sign in Germany. Only Combit Software's alternative claim was upheld.

**The matter at hand**

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In the appeal brought before it, the referring court in Düsseldorf concluded that there is indeed a likelihood of confusion in the German-speaking Member States, but that there is no such likelihood in the English-speaking Member States. As the referring court is uncertain about the way in which the principle of the unitary character of the EU trade mark should be applied in such a situation, it decided to stay the proceedings and ask the ECJ whether, in case an EU trade mark court finds that the use of a sign creates a likelihood of confusion with an EU trade mark in one part of the EU whilst not creating such a likelihood in another part thereof, that court must conclude that there is an infringement and issue an order prohibiting the use throughout the EU.

**The judgment  
of the ECJ**

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With reference to its *DHL Express France* judgment (C235/09), the ECJ considers that if an EU trade mark court finds that the use of the sign in question does not, in a given part of the EU, create any likelihood of confusion, in particular for linguistic reasons, and therefore cannot, in that part of the EU, adversely affect the trade mark's function of indicating origin, that court must limit the territorial scope of the prohibition (paragraph 31).

The ECJ continues by pointing out that "*where an EU trade mark court concludes (...) that there is no likelihood of confusion in a part of the European Union, legitimate trade arising from the use of the sign in question in that part of the European Union cannot be prohibited*" and that "*such a prohibition would go beyond the exclusive right conferred by the EU trade mark, as that right merely permits the proprietor of that mark to protect his specific interests as such, that is to say, to ensure that the mark is able to fulfil its functions*" (paragraph 32).

According to the ECJ such interpretation does not undermine the unitary character of the EU trade mark, since the right of the proprietor of the trade mark to prohibit all use which adversely affects the functions inherent in that mark is preserved (paragraph 35).

On this basis, the ECJ concludes that "*where an EU trade mark court finds that the use of a sign creates a likelihood of confusion with an EU trade mark in one part of the European Union whilst not creating such a likelihood in another part thereof, that court must conclude that there is an infringement of the exclusive right conferred by that trade mark and issue an order prohibiting the use in question for the entire area of the European Union with the exception of the part in respect of which there has been found to be no likelihood of confusion*" (paragraph 36).

**GENERAL COURT IS NOT REQUIRED TO EXAMINE PLEAS NOT INVOLVING MATTERS OF PUBLIC POLICY OF ITS OWN MOTION and ASSESSMENT OF SIMILARITIES IS NOT SUBJECT TO REVIEW BY THE ECJ ON APPEAL**

C-442/15 P

**Pensa Pharma  
v EUIPO**

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Pensa Pharma is the owner of two EU trade marks relating to the sign PENSA. The Ferring companies filed applications for declaration of invalidity of these EU trade marks on the basis of earlier trade marks for the word mark PENSATA registered in France and the Benelux countries. EUIPO upheld the applications for a declaration of invalidity of the EU trade marks on the ground of likelihood of confusion.

**The matter at hand**

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In the appeal brought before it, the General Court held that the arguments Pensa Pharma put forward during the hearing before it were inadmissible because they sought to alter the legal and factual context of the dispute as it was brought before EUIPO.

Pensa Pharma appealed this decision before the ECJ, alleging (i) an error of law committed by the General Court in so far as it rejected as inadmissible the arguments Pensa Pharma had put forward during the hearing, (ii) a distortion of the facts and evidence and an error of law, which led the General Court to confirm the contested decisions despite the failure of the Board of Appeal to verify the renewal of the earlier marks, (iii) an error of law committed by the General Court in so far as it did not annul the contested decisions for failure to state reasons and (iv) infringement of Article 8(1)(b) of Trade Mark Regulation 207/2009 by the General Court in the global assessment of the likelihood of confusion between the marks at issue.

The judgment  
of the ECJ

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The ECJ starts by examining Pensa Pharma's second ground of appeal, by which Pensa Pharma argues that the Board of Appeal should have verified whether the earlier marks of the Ferring companies were still valid. According to Pensa Pharma, the Board of Appeal should have found that, in the absence of a renewal, the validity period of those marks had expired before the contested decisions were adopted and the General Court should have identified that error both of its own motion and following the argument to that effect made by Pensa Pharma during the hearing.

The ECJ rejects this plea, considering that the General Court was not required to examine the validity of the earlier marks of its own motion and that it is not apparent that Pensa Pharma raised such a plea: "*Proceedings before the Courts of the European Union are inter partes. With the exception of pleas involving matters of public policy which the Courts are required to raise of their own motion, such as the failure to state reasons for a contested decision, it is for the applicant to raise pleas in law against that decision and to adduce evidence in support of those pleas*" (paragraph 26). "*Contrary to what Pensa Pharma argues, it is not apparent from reading its application at first instance, which is included in the file of the General Court sent to this Court, that it raised such a plea*" (paragraph 27).

The third ground of appeal raised by Pensa Pharma, alleging that the General Court should have annulled the contested decisions for erroneous allocation of the costs, is rejected for the same reasons: "*Such a plea relates not to compliance with the obligation to state reasons which is binding on the departments of EUIPO pursuant to Article 75 of [Trade Mark Regulation 207/2009], but to the merits of those reasons. It is therefore not among the pleas which the General Court must, if necessary, raise of its own motion and it was up to Pensa Pharma itself to raise it before the General Court*" (paragraph 37).

The second and third ground of appeal are therefore rejected on the basis that these grounds constitute a new

plea under the first subparagraph of Article 48(2) of the Rules of Procedure of the General Court in the version in force during the proceedings before that Court. The General Court, however, had rejected Pensa Pharma's pleas not because they had been put forward before it out of time, but because they sought to alter the legal and factual context of the dispute as it was brought before the Board of Appeal.

C-442/15 P

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**Pensa Pharma  
v EUIPO**

*"However, by the arguments put forward during the hearing before the General Court, Pensa Pharma submitted neither facts nor evidence not submitted before the departments of EUIPO, but called into question the assessment, by those departments, of the facts and evidence that were available to them" (paragraph 47). "Such arguments did not alter the legal and factual context of the dispute as it had been brought before the Fifth Board of Appeal of EUIPO and, had they been raised in time before the General Court, they would have been admissible" (paragraph 49).*

Although this leads the ECJ to the conclusion that the General Court rejected Pensa Pharma's pleas for the wrong reasons, and that the General Court therefore infringed EU law, this infringement has no impact on the operative part of the judgment under appeal as it is shown to be well founded on other legal grounds. Consequently, the General Court's infringement of EU law is not capable of bringing about the annulment of its decision and the first ground of appeal is dismissed as well (paragraph 51).

As to the fourth ground of appeal, the ECJ rules that *"the assessment of the similarities between the signs at issue is of a factual nature and, save where the evidence and facts are distorted, is not subject to review by the Court of Justice on appeal"* (paragraph 60). Considering that no such distortion was alleged or demonstrated by Pensa Pharma, the fourth ground of appeal is rejected as inadmissible as well (paragraph 61).

Accordingly, the ECJ dismisses the appeal.



# AUTUMN

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from 23 September  
up to 21 December  
2016

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**INITIAL ACQUIRER OF A COPY OF  
A COMPUTER PROGRAM MAY NOT  
PROVIDE HIS BACK-UP COPY TO  
A NEW ACQUIRER WITHOUT THE  
AUTHORISATION OF THE RighthOLDER**

C-166/15

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**Ranks  
v Microsoft**

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In the context of criminal proceedings in Latvia against two individuals charged with the unlawful sale - through an online marketplace - of used copies of computer programs stored on non-original media, the referring court asked whether the Computer Programs Directive must be interpreted as meaning that the acquirer of a used copy of a computer program, stored on a non-original material medium, may, under the rule of exhaustion of the rightholder's distribution right, resell that copy where (i) the original material medium of that program, acquired by the initial acquirer, has been damaged and (ii) that initial acquirer has erased his copy or ceased to use it.

**The matter at hand**

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With reference to *UsedSoft* (C-128/11), the ECJ recalls that the holder of the copyright in a computer program who has sold, in the European Union, a copy of that program on a material medium, such as a CD-ROM or a DVD-ROM, accompanied by an unlimited licence for the use of that program, can no longer oppose the resale of that copy by the initial acquirer or subsequent acquirers of that copy [paragraph 30].

**The judgment  
of the ECJ**

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The ECJ, however, rules that this does not apply in the case where the original material medium is copied to another non-original material medium, which non-original medium is then resold, as the reproduction of a computer program on another medium constitutes a reproduction under Article

C-166/15

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**Ranks &  
Vasiljevics**

4(a) of the Computer Programs Directive. Although Article 5(2) of that Directive does allow a person having a right to use a computer program to make a back-up copy, this exception to the reproduction right applies only in so far as this is necessary for the use of that program by that person. *“It follows that a back-up copy of a computer program may be made and used only to meet the sole needs of the person having the right to use that program and that, accordingly, that person cannot — even though he may have damaged, destroyed or lost the original material medium — use that copy in order to resell that program to a third party”* (paragraph 43).

Instead, in circumstances where the initial acquirer of an unlimited licence for the use of a computer program no longer has the original material medium on which that computer program was initially delivered to him, because he has destroyed, damaged or lost it, the subsequent acquirer of that licence must be enabled to download the program from the copyright holder’s website (paragraph 54), on condition that the initial acquirer makes any copy in his possession unusable at the time of its resale (paragraph 55).

**COPYRIGHT TERM DIRECTIVE DOES NOT APPLY TO COPYRIGHT WHICH EXPIRED PRIOR TO 1 JULY 1995**

C-169/15

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**Montis  
v Goossens**

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Under the former Uniform Benelux Law on designs and models, rightholders owning both design rights and copyrights with respect to a product had to file a 'maintenance declaration' for that product in order to maintain the copyright after the expiry or cancellation of the design right. This provision was repealed after the Dutch Supreme Court had held that the provision was not compatible with Article 5(2) of the Berne Convention, which provides that the enjoyment and the exercise of copyright may not be subject to any formality.

**The matter at hand**

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According to the Copyright Term Directive – implemented in the Dutch Copyright Act – the protection term of 70 years after the author's death applies to works which are at 1 July 1995 protected by the national legislation relating to copyright in at least one Member State.

While the Uniform Benelux Law on designs and models was still in force, and before 1 July 1995, furniture designer Montis had neglected to file the required maintenance declaration for one of its products when the term of the design rights with respect thereto had expired, with the result that the copyright had lapsed in 1993. In copyright infringement proceedings against Goossens, Montis however claimed that its copyright should be held to have been restored by virtue of the repeal of the required maintenance declaration and/or following the adoption of the Copyright Term Directive.

C-169/15

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**Montis  
v Goossens**

The Dutch Supreme Court had doubts as to the effects of the repeal of the requirement of a maintenance declaration and referred questions to the Benelux Court of Justice, which in turn referred questions to the ECJ. First of all, whether the terms of protection laid down by the Copyright Term Directive are applicable to copyright which was initially protected by the national legislation but which was extinguished prior to 1 July 1995. And secondly, whether the Directive precludes national legislation which initially granted copyright protection to a work, as in the main proceedings, but which, thereafter, caused that copyright to be definitively extinguished because of non-compliance with a formal requirement.

**The judgment  
of the ECJ**

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The ECJ rules that the terms of protection laid down by the Copyright Term Directive do not apply to copyright which was initially protected by national legislation, but which was extinguished prior to 1 July 1995 and which is not protected in the territory of any other Member State (paragraph 37).

Furthermore, the Directive does not preclude repeal provisions in national legislation that do not effect any restoration of rights and therefore leave some rights definitively extinguished, even though the repealed provision leading to the extinction of those rights is not compatible with the Berne Convention (paragraph 44).

#### **Commentary**

The EU legislature chose to apply the terms of protection provided for in the Copyright Term Directive to works protected in one of the Member States on 1 July 1995. The legislator has not determined the conditions under which that protection could be extinguished before that date, this question continuing to be governed by the applicable national legislation. The ECJ however observes that the Member State do bear the consequences of the liability they incur from any legislation regarding the expiry of copyright that infringed the Berne Convention before this date. Although this does not solve Montis' problem, this does mean he might be able to sue the Benelux legislator for damages.

## GENERAL COURT NOT REQUIRED TO TAKE ACCOUNT OF REVOCATION DECISION THAT IS SUBSEQUENT TO DECISION OF BOARD OF APPEAL

C-482/15 P

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Westermann  
v EUIPO

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Westermann applied for the registration of an EU trade mark for the stylized word mark BAMBINO LÜK. Diset filed an opposition against this EU trade mark application on the basis of its earlier trade mark for the word- / figurative mark BAMBINO. The opposition was upheld by the Board of Appeal of EUIPO in respect of certain goods. After the Board of Appeal rendered its decision, the earlier mark which formed the basis for the opposition was revoked.

The matter at hand

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The General Court dismissed the action brought before it by Westermann. Westermann appealed this decision before the ECJ on the ground that the General Court erred in law and distorted the facts by taking into account the earlier mark of Diset, even though that mark had been revoked and therefore no longer had any effect at the time Westermann brought its action before the General Court.

First of all, the ECJ indicates – with reference to its judgments in *Sunrider* (C416/04) and *Kaul* (C-29/05) – that the General Court may annul or alter a decision against which an action has been brought “*only if, at the date on which that decision was adopted, it was vitiated by one of those grounds for annulment or alteration*”, but “*not (...) on grounds which come into existence subsequent to its adoption*” (paragraph 27).

The judgment  
of the ECJ

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C-482/15 P

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**Westermann  
v EUIPO**

On this basis, the ECJ had already held in *Cadila Healthcare* (C-268/12) that “*the expiry of an earlier mark after the action had been brought before the General Court did not deprive the decision of the Board of Appeal of EUIPO of its purpose or of its effects*” and, consequently, that the “*assessment in that decision that there was a likelihood of confusion between the marks at issue (...) continued to produce its effects at the time the General Court delivered its judgment*” (paragraph 29).

Accordingly, the ECJ holds that, since the actual date of revocation of the earlier mark is subsequent to the decision of the Board of Appeal, it must be held that the General Court was not required, during its review of the lawfulness of that decision, to take into account the EUIPO decision revoking that earlier mark (paragraph 30).

## SIX MONTHLY CHARGE OMITTED OR PRESENTED IN A LESS CONSPICIOUS MANNER THAN THE MONTHLY CHARGE UNFAIR

C-611/14

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Canal Digital  
Denmark

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This preliminary ruling concerns the interpretation of the Unfair Commercial Practices Directive, which provides that commercial practices shall be unfair if they are misleading within the meaning of Article 6 (misleading actions) or Article 7 (misleading omissions).

The matter at hand

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Canal Digital provides television solutions, including television programme packages, to consumers. Proceedings against this company were brought before the Danish court for infringement of the Danish commercial practices act in connection with an advertising campaign for TV subscriptions. The campaign consisted of two advertisements shown on television and on the internet as well as three banner ads on the internet. The prices of the TV subscriptions consisted of a monthly charge of about EUR 13.30/EUR 20 and a six-monthly 'card service' charge of about EUR 52.30. The proceedings were brought against Canal Digital on the ground that Canal Digital did not provide consumers with sufficiently clear information regarding the fact that, in addition to the monthly price, there was also a six-monthly charge for a 'card service'.

The referring court *inter alia* asked whether - for the purposes of assessing whether a commercial practice must be considered as a misleading omission - consideration should be given to the context in which that practice takes place, in particular the limitations of time and space imposed

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**Canal Digital  
Denmark**

by the communications medium used, as provided for in Article 7 of the Directive, even though such a requirement is not expressly referred to in the national legislation.

Also, the referring court asked whether — in situations where a trader has stated the price for a subscription so that the consumer must pay both a monthly charge and a six-monthly charge — that practice will be considered a misleading omission (Article 7) and/or a misleading action (Article 6) if the monthly charge is particularly highlighted in the marketing, whilst the six-month charge is omitted entirely or presented only in a less conspicuous manner.

**The judgment  
of the ECJ**

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The ECJ first of all rules that the national court must, when applying the provisions of national law specifically intended to implement the Directive, interpret those provisions so far as possible in such a way that they are applied in conformity with the objectives of the Directive (paragraph 34). Therefore, for the purposes of assessing whether a commercial practice must be considered a misleading omission within the meaning of Article 7 of the Directive, “*consideration should be given to the context in which that practice takes place, in particular the limitations of the communications medium used for the purposes of that commercial practice, the limitations of time and space imposed by that communications medium and any measures taken by the trader to make the information available to consumers by other means, even though that requirement is not expressly referred to in the wording of the national legislation in question*” (paragraph 35).

However, unlike Article 7 (which deals with misleading omission), Article 6 (which deals with misleading actions) contains no reference to limitations of space or time related to the communication medium used. “*Accordingly, it must be held that the time constraints that may apply to certain communication media, such as television commercials, cannot be taken into account when assessing whether*



*a commercial practice is misleading under Article 6(1)"*  
(paragraph 42).

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**Canal Digital  
Denmark**

The referring court must therefore assess, without taking account of time constraints that may apply to a certain communication medium, whether the commercial communication *"is likely to lead to a mistaken perception of the overall offer"* (paragraph 43) and is *"likely to cause an average consumer to take a transactional decision that he would not have taken otherwise"* (paragraph 45).

The ECJ considers that this is likely to be the case where the price of a product - which is *"in principle a determining factor in the mind of the average consumer"* (paragraph 46) - is divided into several components, one being particularly emphasised in the marketing, while the other is completely omitted or is presented less prominently. According to the ECJ, this applies especially if *"the omitted or less visible component represents a significant element of the total price"* (paragraph 47).

In the light of those considerations, the ECJ concludes that Article 6(1) of the Directive *"must be interpreted as meaning that a commercial practice which consists of dividing the price of a product into several components and highlighting one of them, must be regarded as misleading, since that practice would be likely, first, to give the average consumer the false impression that he has been offered a favourable price and, secondly, cause him to make a transactional decision that he would not have made otherwise, which it is for the referring court to ascertain, taking into account all the relevant circumstances of the main proceedings. However, the time constraints that may apply to certain communication media, such as television commercials, cannot be taken into account when assessing whether a commercial practice is misleading under Article 6(1) of that directive."*

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**Canal Digital  
Denmark**

As to the assessment of whether there is a misleading omission, which does require time constraints applying to certain communication media to be taken into account, the ECJ emphasizes that the Directive aims to ensure a high level of consumer protection. Consequently, *“the limitations of time and space imposed by the communication medium used must be weighed against the nature and characteristics of the product in question, in order to determine whether the trader concerned in fact found it impossible to include the information at issue or to provide it in a clear, intelligible and unambiguous manner in the initial communication”* (paragraph 62). Only if this is, in fact, the case, the traders is allowed to mention only some of the information in the commercial communication and refer to its website for the rest, *“provided that that website contains the material information relating to the main characteristics of that product, the price and other conditions, as required under Article 7 of Directive 2005/29”* (paragraph 63).

Finally, the ECJ goes into the questions asked by the referring court regarding the material information that must be included in an invitation to purchase. To these questions, the ECJ answers that Article 7(4) of the Unfair Commercial Practices Directive contains an exhaustive list of the material information that must be included in an invitation to purchase. However, *“the fact that a trader provides, in an invitation to purchase, all the information listed in Article 7(4) of that directive does not preclude that invitation from being regarded as a misleading commercial practice within the meaning of Article 6(1) or Article 7(2) of that directive”* (paragraph 72).

#### **Commentary**

The most noteworthy part of this judgment is that time constraints that may apply to certain communication media, such as television commercials, cannot be taken into account when assessing whether a commercial practice constitutes a misleading action. This is especially relevant for commercials mentioning prices.

As the price of a product is considered a determining factor in the mind of the average consumer, the omission to mention a component thereof is likely to constitute a misleading action.

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**Canal Digital  
Denmark**



## CONTRADICTION IN REASONING GENERAL COURT AMOUNTS TO FAILURE TO STATE REASONS

C-537/14 P

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Debonair  
v EUIPO

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Groupe Léa Nature filed an application for registration of an EU trade mark for the word-/ figurative mark SO'BIO ETIC, which was opposed by Debonair on the basis of earlier trade marks for the word mark SO...?. After the Opposition Division had initially rejected the opposition, it was upheld by the Board of Appeal. The General Court, however, annulled the decision of the Board of Appeal, considering that the similarity caused by the common word element 'so' is insufficient to create confusion, because this word element, according to the General Court, has a laudatory function if followed by another word.

**The matter at hand**

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In the appeal brought before the ECJ, EUIPO argued that the General Court had contravened the requirement to provide reasons which permit the parties to comprehend the grounds on which the finding was based, given the fact that in the earlier marks the word element 'so' is not followed by another word.

The ECJ holds that the General Court is required “to disclose clearly and unequivocally the reasoning followed by it, in such a way as to enable the persons concerned to ascertain the reasons for the decision taken and the Court of Justice to exercise its power of review [...]” (paragraph 32).

**The judgment  
of the ECJ**

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According to the ECJ, the General Court did not comply with this obligation as the statement of reasons in its

C-537/14 P

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**Debonair  
v EUIPO**

judgement was contradictory, by stating on the one hand that the element 'so' has a laudatory function while on the other hand considering that that laudatory function exists when the element 'so' was accompanied by another word (paragraphs 36 and 37). "

The ECJ considers that "*such a contradiction in the reasoning amounts to a failure to state reasons*" with the result that "*the parties and the Court are unable to ascertain whether, in the General Court's analysis, the word element 'so' has a laudatory function only when it is used with another word or also when it is used on its own*" (paragraph 36).

Consequently, the ECJ concludes that the judgment under appeal must be set aside and that the case must be referred back to the General Court.

**LIKELIHOOD OF CONFUSION NOT  
PRECLUDED WHERE DISTINCTIVE  
CHARACTER IS WEAK and ASSUMPTION  
OF VALIDITY DESCRIPTIVE TRADE  
MARKS IN OPPOSITION PROCEEDINGS**

C-43/15 P

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**BSH  
v EUIPO**

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BSH filed an application for registration of an EU trade mark for the word-/ figurative mark COMPRESSOR TECHNOLOGY. LG filed an opposition against this EU trade mark application on the basis of its earlier trade marks for the word mark KOMPRESSOR. The Opposition Division of EUIPO upheld the opposition in respect of certain goods.

**The matter at hand**

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BSH filed a notice of appeal against this decision, but LG did not. Instead, in its response to the grounds of appeal, LG submitted that some of the goods that had been considered dissimilar were in fact similar and that, consequently, the application for registration at issue should also have been rejected in respect of those goods. The First Board of Appeal of EUIPO dismissed BSH's appeal, but upheld LG's claim regarding some of the goods that had been considered dissimilar, which claim it classified as an 'ancillary' appeal under Article 8(3) of Regulation 216/96 laying down the rules of procedure of the Boards of Appeal.

In the appeal brought before it, the General Court dismissed the single plea of BSH that the Board of Appeal of EUIPO had not taken sufficient account of the weak distinctive character of the earlier national trade marks of LG which would result from the fact that the sign KOMPRESSOR is descriptive in respect of goods containing a compressor, such as vacuum cleaners, air conditioners and refrigerators.

C-43/15 P

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**BSH  
v EUIPO**

BSH appealed this decision before the ECJ, arguing that the General Court should not have given its (implicit) approval to the classification by the Board of Appeal of LG's response as an 'ancillary' appeal which had led the Board of Appeal to refuse registration of the trade mark at issue to a greater extent than the Opposition Division had. According to BSH, only an appeal complying with the conditions laid down in Article 60 of Regulation 216/96 could have justified extending the rejection of the application beyond the rejection in the decision of the Opposition Division.

Secondly, BSH complained that the General Court relied on an erroneous understanding of the concept of likelihood of confusion, by in effect holding that, if two trade marks coincide as regards a purely descriptive element, that is sufficient to give rise to such a likelihood, thereby leading to the monopolisation of a purely descriptive indication.

**The judgment  
of the ECJ**

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The ECJ dismisses the first plea of BSH as inadmissible on the ground that BSH had not raised this plea before the General Court: "*In accordance with settled case-law, to allow a party to put forward for the first time before the Court of Justice a plea and arguments which it did not raise before the General Court would be to authorise it to bring before the Court of Justice, whose jurisdiction in appeals is limited, a case of wider ambit than that which came before the General Court. In an appeal, the jurisdiction of the Court of Justice is thus confined to review of the findings of law on the pleas and arguments debated before the General Court (see, in particular, judgment of 21 September 2010, Sweden and Others v API and Commission, C-514/07 P, C-528/07 P and C-532/07 P, EU:C:2010:541, paragraph 126 and the case-law cited)*" (paragraph 43).

Therefore - although it is apparent from paragraph 45 of the judgment that the ECJ is of the opinion that the Board of Appeal infringed the adversarial principle laid down in Articles 63(2) and 75 of Regulation 216/96 by upholding LG's so-called 'ancillary' appeal without having placed BSH in



the position to put forward any observations in response thereto – the ECJ has no choice but to dismiss the first plea.

C-43/15 P

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**BSH**  
**v EUIPO**

Regarding BSH's second plea, the ECJ holds that *"although it is true that the more distinctive the earlier mark the greater the likelihood of confusion will be, such a likelihood of confusion cannot, however, be precluded where the distinctive character of the earlier mark is weak"* (paragraph 62). "Consequently, even in a case involving an earlier mark of weak distinctive character, the General Court may hold that there is a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered" (paragraph 63).

As regards the argument advanced in this regard by BSH that this leads to the monopolisation of a purely descriptive indication, *"it must be stated that it is not Article 8(1)(b) of [Trade Mark Regulation 40/94] but Articles 7(1)(b) and (c) and 51 of that regulation and Article 3(1)(b) and (c) of [Trade Mark] Directive 2008/95 which are intended to avoid such monopolization"* (paragraph 65). *"In so far as it concerns earlier national marks, this means that in opposition proceedings the validity of national marks may not be called into question"* (paragraph 66).

*"Therefore, assuming that an earlier national mark is in fact descriptive in respect of some of the goods for which it has been registered and that its protection leads to improper monopolisation of the descriptive indication in question, such a consequence must be remedied not by an application of Article 8(1)(b) of [Trade Mark Regulation 40/94] excluding those goods as a matter of principle from the protection which that provision confers on the earlier marks, but by invalidity proceedings brought in the Member State concerned by virtue of Article 3(1)(b) and (c) of [Trade Mark] Directive 2008/95"* (paragraph 68).

Consequently, the second plea is dismissed as well and the contested decision is upheld.



### TRADE MARK OWNER MAY OPPOSE REPACKAGING WHERE PRODUCT CAN BE MARKETED IN SAME PACKAGING IN IMPORTING STATE AS IN EXPORTING STATE

C-297/15

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**Ferring  
v Orifarm**

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Ferring is the owner of the trade mark KLYX under which it markets a medicinal product in Denmark, Finland, Sweden and Norway. In all those States, Klyx is sold in packets containing 1 or 10 containers. In the course of its parallel import business, Orifarm purchases KLYX in Norway in packets of 10, repackages them in packets of 1 and then sells the repackaged product on the Danish market.

**The matter at hand**

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Before the referring court in Denmark, Ferring argued that it can oppose this repackaging since, in the first place, the repackaging is not necessary to sell the product in Denmark and, in the second place, the only reason for the repackaging is the importer's attempt to secure a commercial advantage.

In those circumstances, the referring court asked the ECJ whether the contested repackaging can be opposed on the basis of Article 7(2) of Trade Mark Directive 2008/95.

With reference to its judgments in *Boehringer Ingelheim* (C-348/04 and C-348/04) and *Bristol-Myers Squibb* (C-427/93, C-429/93 and C-436/93), the ECJ notes that *"the change brought about by any repackaging of a trade-marked medicinal product – creating by its very nature the risk of interference with the original condition of the product – may be prohibited by the trade mark proprietor unless the repackaging is necessary in order to enable the marketing of the products imported in parallel and the legitimate interests of the proprietor are also safeguarded"* (paragraph 19).

**The judgment  
of the ECJ**

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C-297/15

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**Ferring  
v Orifarm**

Such necessity exists when the packet size used by the trade mark proprietor in the EEA State where the importer purchased the product cannot be marketed in the importing State, *“because of, in particular, a rule authorising packaging only of a certain size or a national practice to the same effect, sickness insurance rules making the reimbursement of medical expenses depend on the size of the packaging, or well-established medical prescription practices based, inter alia, on standard sizes recommended by professional groups and sickness insurance institutions”* (paragraph 21).

However, in circumstances where the trade mark proprietor uses several different sizes of packaging in the importing State, the finding that one of those sizes is also marketed in the exporting State is not enough to justify the conclusion that repackaging is unnecessary. After all, *“partitioning of the markets would exist if the importer were able to sell the product in only part of his market”* (paragraph 22).

Considering that Ferring markets the product in identical packaging in both the importing and exporting State, and that none of the aforementioned circumstances appear to apply in the present case, the ECJ concludes that Ferring can, in principle, oppose the repackaging by Orifarm (paragraphs 24 – 26). This could be different if it would be established that the market for Klyx in packets of 10 represents only a limited part of the Danish market (paragraphs 27 and 28).

On the basis of these considerations, the ECJ rules that a trade mark proprietor may object to the continued marketing of a repackaged medicinal product by a parallel importer, where, first, the medicinal product at issue can be marketed in the importing State in the same packaging as that in which it is marketed in the exporting State and, second, the importer has not demonstrated that the imported product can only be marketed in a limited part of the importing State’s market (paragraph 29).

**THE LENDING OF AN E-BOOK MAY,  
UNDER CERTAIN CONDITIONS,  
BE TREATED IN THE SAME WAY AS  
LENDING OF A TRADITIONAL BOOK**

C-174/15

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**VOB  
v Leenrecht**

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The questions referred to the ECJ concern the lending of e-books in the Netherlands. Under Dutch law, the lending of a copy of a book - put into circulation by the rightholder or with his consent - does not constitute an infringement of the copyright in that work, provided that a fair remuneration is paid to the rightholder. For a while, it was generally assumed that the digital lending of electronic books did not fall within the scope of this exception. As a consequence, public libraries made electronic books available via the internet on the basis of licensing agreements with rightholders.

**The matter at hand**

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The library association VOB (representing the interests of all public libraries in the Netherlands) brought proceedings before the District Court in The Hague against Stichting Leenrecht (the foundation entrusted with collecting the fair lending remuneration due to authors), seeking declaration that the existing Dutch lending regime also covers digital lending. VOB's action concerned lending under the 'one copy, one user' model, namely the lending of an electronic book carried out by placing that copy on the server of a public library and allowing the user concerned to download it onto his own computer, bearing in mind that only one copy may be downloaded during the lending period and that, after that period has expired, the downloaded copy can no longer be used by that user.

C-174/15

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**VOB  
v Leenrecht**

The District Court referred a number of preliminary questions to the ECJ regarding the interpretation of the Rental and Lending Rights Directive, which provides that the exclusive right to authorize or prohibit rental and lending may be derogated from by Member States in respect of public lending (the public lending exception), provided that authors receive a remuneration. The referring court asked whether the concept of lending (defined as: making available for use, for a limited period of time and not for direct or indirect economic or commercial advantage, through establishments which are accessible to the public) covers the lending of an e-book under the 'one copy, one user' model.

**The judgment  
of the ECJ**

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The ECJ first considers that there is no decisive ground allowing for the exclusion, in all cases, of the lending of digital copies and intangible objects from the scope of the Rental and Lending Rights Directive (paragraph 44).

The ECJ then verifies whether the public lending of a digital copy of a book under the 'one copy, one user' model is capable of coming within the scope of the public lending exception (paragraph 49). The ECJ answers the question in the affirmative, "*given the importance of the public lending of digital books, and in order to safeguard both the effectiveness of the (...) the public lending exception and the contribution of that exception to cultural promotion*". The exception may therefore also apply "*where the lending operation by a library has essentially similar characteristics to the lending of printed works*" (paragraph 51). The ECJ considers this to be the case as regards the lending of a digital copy of a book under the 'one copy, one user' model (paragraph 53). Obviously, this applies on condition that the digital copy of the book was not obtained from an illegal source (paragraphs 66-72).

Furthermore, the ECJ holds that Member States are allowed to impose stricter conditions than those laid down in Article 6(1) of the Directive "*to improve the protection of*

*authors' rights beyond what is expressly laid down in that provision" (paragraph 61), such as the condition "that the digital copy of a book made available by the public library must have been put into circulation by a first sale or other transfer of ownership of that copy in the European Union by the holder of the right of distribution to the public or with his consent" (paragraph 62).*

C-174/15

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**VOB  
v Leenrecht**





**IN EXAMINING THE TECHNICAL  
FUNCTION OF A SHAPE MARK, THE  
FUNCTION OF THE ACTUAL GOODS  
REPRESENTED BY THAT MARK MUST  
BE TAKEN INTO ACCOUNT**

C-30/15 P

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**Simba Toys  
v Seven Towns**

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In the late 1990s, Seven Towns, the company that manages the IP rights relating to the famous Rubik's Cube, successfully applied for the registration of the shape of the Rubik's Cube as a three-dimensional EU trade mark for 'three-dimensional puzzles' in class 28.

**The matter at hand**

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In 2006, Simba Toys, a German toy manufacturer, filed an application for a declaration of invalidity of that mark pursuant to Article 51(1)(a) in conjunction with (inter alia) Article 7(1)(e)(ii) of Trade Mark Regulation 40/94, which provides that signs "*which consist exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result*" shall not be registered.

Simba Toys essentially argued that the grid structure on each surface of the cube reflects the rotating capability of the individual elements of the cube and is therefore necessary to obtain a technical result.

Both EUIPO and the General Court dismissed this argument, considering that the argument was based on the knowledge of the rotating capability of the cube, whereas that capability does not result from the grid structure as such but, at most, from an invisible mechanism internal to the cube. According to the General Court, this invisible mechanism should not be included in the analysis of the functionality of the mark, because that would not be

C-30/15 P

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**Simba Toys  
v Seven Towns**

consistent with the requirement that any inference must be drawn as objectively as possible from the shape in question, as represented graphically, and with sufficient certainty. On this basis, the General Court took the view, as did the Board of Appeal, that the grid structure on each surface of the cube at issue had the effect of dividing visually each surface of that cube into nine equal square elements, which could not constitute a technical function.

Simba Toys appealed the judgment of the General Court to the ECJ.

**The judgment  
of the ECJ**

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The ECJ first of all establishes that it has not been contested that the essential characteristics of the shape at issue are a cube and a grid structure on each surface of the cube and that it must therefore be examined whether these characteristics perform a technical function.

The ECJ then recalls, with reference to *Lego Juris v OHIM* [C-48/09], that “*in order to analyse the functionality of a sign for the purposes of Article 7(1)(e)(iii) of [Trade Mark Regulation 40/94] - which concerns only signs which consist of the shape of the actual goods - the essential characteristics of a shape must be assessed in the light of the technical function of the actual goods concerned*” (paragraph 46).

For this reason, “*the General Court should have defined the technical function of the actual goods at issue, namely a three-dimensional puzzle, and it should have taken this into account when assessing the functionality of the essential characteristics of that sign*” (paragraph 47).

The ECJ explains that the analysis of the technical function of a shape mark cannot be made solely on the basis of its graphic representation without using additional information on the actual goods concerned. In this regard, the ECJ refers to *Lego Juris v OHIM* [C-48/09], *Philips* [C-299/99] and *Pi-Design and Others v Yoshida Metal Industry* [C-337/12 P to

C-340/12 P) as examples of cases in which the competent authorities would not have been able to analyse the shapes concerned without taking account of the function of the actual goods at issue (paragraph 50).

C-30/15 P

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**Simba Toys  
v Seven Towns**

In this context, the ECJ emphasizes that the fact that Seven Towns did not append to its application for registration a description specifying that the shape at issue had a rotating capability, “*cannot preclude account from being taken of the technical function of the actual goods represented by the sign at issue for the purpose of examining the functionality of the essential characteristics of that sign, as the proprietor of that mark would otherwise be allowed to broaden the scope of the protection arising from the registration thereof to cover every type of puzzle with a similar shape, namely any three-dimensional puzzle with cube-shaped elements, regardless of the principles by which it functions*” (paragraph 52).

To conclude otherwise would run contrary to the objective pursued by Article 7(1)(e)(ii) of Trade Mark Regulation 40/94 “*to prevent an undertaking from being granted a monopoly on technical solutions or functional characteristics of a product*” (paragraph 53).

Therefore, when examining the functional characteristics of a sign, the competent authority must carry out “*a detailed examination that takes into account material relevant to identifying appropriately the essential characteristics of a sign, in addition to the graphic representation and any descriptions filed at the time of application for registration*” (paragraph 49), taking account also of “*additional circumstances which an objective observer would not have been able to ‘fathom precisely’ on the basis of the graphic representations of the contested mark, such as the rotating capability of individual elements in a three-dimensional ‘Rubik’s Cube’-type puzzle*” (paragraph 51).

On the basis of these considerations, the ECJ annuls the judgment of the General Court.



## NATIONAL LEGISLATION AUTHORISING THE DIGITAL REPRODUCTION OF OUT OF PRINT BOOKS INCOMPATIBLE WITH EU LAW

C-301/15

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Soulier & Doke

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The question referred to the ECJ concerns French legislation relating to the digital exploitation of out-of-print books (books which are no longer commercially distributed by a publisher and are currently not published in print or digital form) of the 20th Century. The legislation introduced a system of mandatory collective management, with opt-out possibilities. In short, the French law gives approved collecting societies the right to authorise the reproduction and the representation in digital form of out-of-print books of the 20th Century, while allowing the authors of those books to oppose or put an end to that practice subject to certain conditions (inter alia proving that the author is the only right holder). In the event that the author does not make use of the opt-out possibility, the right to authorise the reproduction or performance of those books in digital format is exercised by approved collecting societies, six months after their registration in a publicly accessible database.

**The matter at hand**

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Two authors of literary works requested the Council of State in France to annul certain aspects of the French legislation, claiming that the French legislation establishes an exception or a limitation to the exclusive reproduction right of the authors as laid down in Article 2(a) of the InfoSoc Directive, while this exception or limitation is not provided for in Article 5 of that Directive. The Council of State subsequently asked the ECJ whether the French system is compatible with the InfoSoc Directive.

**The judgment  
of the ECJ**

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The ECJ emphasizes that the rights guaranteed to authors by Articles 2(a) and 3(1) of the InfoSoc Directive are preventive in nature, in the sense that any reproduction or communication to the public of a work by a third party requires the prior consent of its author (paragraph 33). Those provisions also allow that consent to be expressed implicitly (paragraph 35). However, for the existence of such consent to be accepted, the ECJ considers that every author must actually be informed of the future use of his work by a third party and of the means at his disposal to prohibit it if he so wishes (paragraph 38).

Considering that the French legislation does not seem to offer a mechanism ensuring that authors are actually and individually informed, the ECJ holds that it is not inconceivable that some of the authors concerned are not aware of the envisaged use of their works and, therefore, that they are not able to adopt a position on it. In those circumstances, a mere lack of opposition on their part cannot be regarded as the expression of their implicit consent to that use (paragraph 43).

The ECJ adds that pursuing an objective such as the digital exploitation of out-of-print books in the cultural interest of consumers and of society as a whole (while compatible with the Directive as such) cannot justify a derogation not provided for by the EU legislature to the protection that authors are ensured by that Directive (paragraph 45).

Finally, the ECJ considers that the author of a work must be able to put an end to the exercise by a third party of exploitation rights in digital format that he holds on that work, and in so doing prohibit him from any future use in such a format, without having to submit beforehand, in certain circumstances, to a formality consisting of proving that other persons are not, otherwise, holders of other rights in that work (paragraph 51).

**TRANSITIONAL MEASURE OF  
NUTRITION AND HEALTH CLAIMS  
REGULATION APPLIES TO PRODUCTS  
MARKETED AS MEDICINAL PRODUCT  
BEFORE 1 JANUARY 2005**

C-177/15

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**Nelsons**

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Nelsons markets preparations made from flowers, known as 'Bach flower remedies', in pharmacies in Germany. Before 1 January 2005, Nelsons marketed the preparations in Germany as medicinal products, under the EU trade mark RESCUE, which was, at that time, registered for medicinal products. In 2007, Nelsons also obtained a registration for the EU trade mark RESCUE for foodstuffs. The Higher Regional Court in Hamburg held, by its judgment of 21 February 2008, that Bach flower remedies are not medicinal products, but foodstuffs. Following that judgment, Nelsons, which was not a party to the dispute in that case, began marketing the remedies not as medicinal products, but as foodstuffs, without making any changes to them.

**The matter at hand**

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Ayonnax Nutripharm and Bachblütentreff, which also market Bach flower remedies in Germany, have challenged some of Nelsons' advertising messages and the way in which it has presented the remedies on the German market. Those companies claim that Nelsons has advertised alcoholic beverages by relying on effects that are beneficial, or in no way detrimental, to health, which constitutes an act of unfair competition.

According to the referring court in Germany, the designations 'RESCUE TROPFEN' and 'RESCUE NIGHT SPRAY' used by Nelsons for its Bach flower remedies are

C-177/15

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**Nelsons**

health claims within the meaning of the Nutrition and Health Claims Regulation, because the word 'RESCUE' suggests to the consumers concerned that the use of the remedies is recommended so they can be 'rescued' when facing certain health problems. However, as the referring court in Germany had doubts as to the applicability of the Nutrition and Health Claims Regulation, it decided to ask the ECJ *inter alia* whether the transitional measure of Article 28(2) of the Nutrition and Health Claims Regulation applies where a product was marketed before 1 January 2005, not as a foodstuff, but as a medicinal product, so that the provisions of that Regulation are not applicable to the remedies during the transitional period laid down in that provision.

**The judgment  
of the ECJ**

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First of all, the ECJ establishes that “[A]ccording to Article 28(2) of [the Nutrition and Health Claims Regulation], products bearing trade marks or brand names existing before 1 January 2005 which do not comply with that regulation may continue to be marketed until 19 January 2022, after which time the provisions of that regulation will apply” (paragraph 29).

According to the ECJ, “[T]hat provision is thus a transitional measure derogating from Article 1(3) of [the Nutrition and Health Claims Regulation], according to which a trade mark, brand name or fancy name appearing in the labelling, presentation or advertising of a food which may be construed as a nutrition or health claim may be used without undergoing the authorisation procedures provided for in this regulation, provided that it is accompanied by a related nutrition or health claim in that labelling, presentation or advertising which complies with the provisions of the regulation” (paragraph 30).

Furthermore, the ECJ holds that Article 28(2) of the Nutrition and Health Claims Regulation “is applicable only to products bearing a trade mark or brand name ‘existing’ before 1 January 2005” (paragraph 46).



The ECJ continues by stating that the wording ‘existing’ *“must be understood as meaning that those products had, already before that date, to have the same substantive characteristics and bear the same trade mark or brand name”* and that it is clear that such is the case in the main proceedings (paragraph 47).

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**Nelsons**

Consequently, the ECJ concludes that *“Article 28(2) [of the Nutrition and Health Claims Regulation] must be interpreted as meaning that that provision applies in the situation in which a foodstuff bearing a trade mark or brand name was, before 1 January 2005, marketed as a medicinal product and then, while having the same physical characteristics and bearing the same trade mark or brand name, as a foodstuff prior to that date”* (paragraph 48).



**IN EXAMINING WHETHER THE USE OF A MARK IN A FORM THAT DIFFERS FROM THE FORM IN WHICH IT IS REGISTERED CONSTITUTES GENUINE USE, THE DISTINCTIVE CHARACTER OF THAT MARK MUST BE ASSESSED**

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C-642/15 P

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**Klement  
v EUIPO**

In 2004, Bullerjan GmbH successfully applied for the registration of the shape of an oven as a three-dimensional EU trade mark for 'ovens' in class 11.

**The matter at hand**

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In 2011, Mr. Klement filed an application for revocation of that mark due to non-use pursuant to Article 51(1) of Trade Mark Regulation 207/2009. Both the Cancellation Division and the Board of Appeal of EUIPO dismissed the application. Mr. Klement appealed the decision of the Board of Appeal to the General Court, arguing that the mark in question was used only in combination with the distinctive word element "Bullerjan" applied to the front of the ovens and that this necessarily altered the distinctive character of the mark in the form in which it was registered within the meaning of Article 15(1)(a) of Trade Mark Regulation 207/2009. The General Court dismissed the appeal, considering that the word "Bullerjan" applied to the front of the goods did not affect the distinctive character of the shape mark in the form in which it was registered.

Mr. Klement appealed the General Court's decision to the ECJ, submitting that the reasons given in the contested judgment are contradictory, considering that the General Court held, on the one hand, that the mark applied for has an unusual form, while on the other hand confirming that other manufacturers sell ovens with a very similar shape. Furthermore, the General Court held, on the one hand, that

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**The judgment  
of the ECJ**

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the shape in question has a high degree of distinctiveness despite its functionality, while on the other hand considering that the similarity between the mark in question and the ovens sold by other manufacturers is caused by the fact that said manufacturers wanted to obtain a certain technical result.

The ECJ rules that even assuming, as EUIPO maintained, that the mere fact that other manufacturers market ovens with a very similar shape does not preclude the shape of that mark from being considered unusual, “*the contested judgment does not explain why the relevant trade circles perceive the shape of the contested mark as a strong indication of origin while they perceive the shape of similar ovens marketed by other manufacturers as functional*” (paragraph 27).\*

Furthermore, the ECJ rules that it is not clear why the fact that other manufacturers market ovens with a shape very similar to that of the three-dimensional mark in question did not affect the General Court’s assessment of the distinctive character of the mark in question (paragraph 28).

With reference to its judgment in *Lotte v EUIPO* (C-586/15), the ECJ notes that “[i]n the context of the application of the first subparagraph of Article 15(1)(2)(a) of [Trade Mark Regulation 207/2009], according to which the use of an EU mark in a form that differs from the form in which it is registered without altering the distinctive character thereof constitutes genuine use, the form in which the mark is registered must (...) be assessed in light of the distinctive character of the mark in question, in order to establish whether that distinctive character is affected. In this regard, the high or low degree of distinctive capacity of the contested mark must be taken into account” (paragraph 29).\*

On this basis, the ECJ concludes that the reasons given by the General Court in its judgment are not clear and comprehensible and that the contested judgment must therefore be set aside.

\* Unofficial translation; The judgment is available in French and German only.





# OTHER ORDERS OF THE ECJ

Article 181 of the Rules of Procedure of the Court of Justice of 19 July 2016 stipulates that “*where the appeal [is] manifestly inadmissible or manifestly unfounded, the Court may [...], decide by reasoned order to dismiss that appeal [...] in whole or in part.*” The orders in appeal proceedings rendered in 2016 have not been described in this book. But for the sake of completeness, the following orders on the topics addressed in this book have been handed down in 2016:

14 January 2016, C-278/15 P

(Royal County of Berkshire Polo Club v EUIPO)

14 January 2016, C-500/15 P

(TVR Italia v TVR Automotive and EUIPO)

20 January 2016, C-382/15 P (Skype v EUIPO)

20 January 2016, C-383/15 P (Skype v EUIPO)

20 January 2016, C-384/15 P (Skype v EUIPO)

21 January 2016, C-170/15 P (Enercon v EUIPO)

28 January 2016, C-374/15 P (Harper Hygienics v EUIPO)

4 February 2016, C-251/15 P (Emsibeth v EUIPO)

17 February 2016, C-396/15 P (Shoe Branding Europe v Adidas)

25 February 2016, C-35/14 P DEP (Gamesa Eólica v Enercon)

25 February 2016, C-346/15 P (Steinbeck v EUIPO)

25 February 2016, C-487/15 P

(Deutsche Rockwool Mineralwoll v EUIPO)

3 March 2016, C-440/15 P (AgriCapital v EUIPO)

15 March 2016, C-476/15 P (Grupo Bimbo v EUIPO)

7 April 2016, C-474/15 P (Harper Hygienics v EUIPO)

7 April 2016, C-475/15 P (Harper Hygienics v EUIPO)  
7 April 2016, C-653/15 P (Bopp v EUIPO)  
14 April 2016, C-451/15 P (Best-Lock (Europe) v EUIPO)  
14 April 2016, C-452/15 P (Best-Lock (Europe) v EUIPO)  
14 April 2016, C-479/15 P (Nanu-Nana Joachim Hoepf v EUIPO)  
14 April 2016, C-480/15 P (KS Sports v EUIPO)  
14 April 2016, C-515/15 P (Roland v EUIPO)  
21 April 2016, C-232/15 P (ultra air v EUIPO)  
4 May 2016, C-602/15 P (Monster Energy v EUIPO)  
4 May 2016, C-603/15 P (Monster Energy v EUIPO)  
11 May 2016, C-636/15 P (August Storck v EUIPO)  
24 May 2016, C-63/16 P (Actega Terra v EUIPO)  
26 May 2016, C-578/15 P (Dairek Attoumi v EUIPO)  
26 May 2016, C-639/15 P (Gat Microencapsulation v EUIPO)  
26 May 2016, C-77/16 P  
(Hewlett Packard Development Company v EUIPO)  
8 June 2016, C-41/16 P (Liu v EUIPO)  
14 June 2016, C-43/16 P (Copernicus-Trademarks v EUIPO)  
15 June 2016, C-94/16 P (LTJ Diffusion v EUIPO)  
16 June 2016, C-611/15 P (L'Oréal v EUIPO)  
21 June 2016, C-619/15 P  
(P Mocek, Wenta, KAJMAN Firma v EUIPO)  
22 June 2016, C-295/15 P (Matratzen Concord v EUIPO)  
12 July 2016, C-399/15 P (Vichy Catalán v EUIPO)  
21 July 2016, C-591/12 P-DEP (Panrico v Bimbo)  
21 July 2016, C-363/15 P (Louis Vuitton Malletier v EUIPO)  
21 July 2016, C-87/16 P (Tsumimoto v Kenzo)  
6 September 2016, C-224/14 P (Lidl Stiftung v EUIPO)  
6 September 2016, C-237/14 P (Lidl Stiftung v EUIPO)  
7 September 2016, C-586/15 P  
(Lotte v Nestlé Unternehmungen Deutschland - EUIPO)  
8 September 2016, C-309/15 P (Real Express v EUIPO)  
13 October 2016, C-285/16 P (Grupo Bimbo v EUIPO)  
19 October 2016, C-313/16 P (Médis v EUIPO)  
26 October 2016, C-575/15 P (Inditex v EUIPO)  
27 October 2016, C-272/16 P (Tayto Group v EUIPO)  
8 November 2016, C-361/16 P (Franmax v EUIPO)  
10 November 2016, C-351/16 P (100 % Capri Italia v EUIPO)  
25 November 2016, C-450/16 P (U-R LAB v EUIPO)