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RECHTSANWÄLTE UND FACHANWÄLTE
FÜR GEWERBLICHEN RECHTSSCHUTZ

***Territorial Scope of Community
Trademark Injunctions after ECJ's
Chronopost v. DHL decision***

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Enforcing a CTM

- One TM for the entire EU
- One legal regime (CTMR)
- But: different legal regimes, e.g. regarding rules of civil procedure



- Core question:
Scope of an injunction and corresponding penalties for violation of said injunction

Unitary Character of CTM

- **Art. 1 Para. 2 CTMR:** *“A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community“.*
- **Recital 16 CTMR:** *“Decisions regarding the validity and infringement of Community trade marks must have effect and cover the entire area of the Community, as this is the only way of preventing inconsistent decisions on the part of the courts and the Office and of ensuring that the unitary character of Community trade marks is not undermined.”*
(NB: Questionable if still applicable as such)

The issue

- If infringement of the CTM occurred in one country only, can injunction still be issued EU-wide?

- **Yes** (German Supreme Court; Spanish, Dutch and French courts)

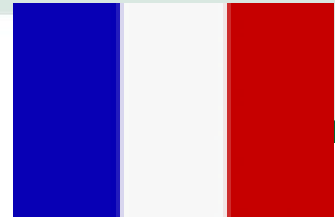


- but the plaintiff shall ask the court to do so, plaintiff may limit the scope of the mark (Supreme Court of Austria)



The DHL v. Chronopost Case

National case leading to ECJ C-235/09



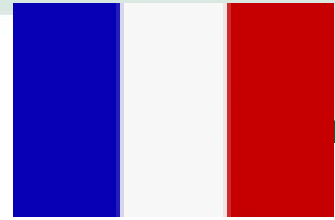
- Chronopost owns, *inter alia*, French TM and CTM „Webshipping“ for „services for collection and delivery of mail“



- Chronopost sues DHL for use of identical and similar marks in French Court sitting as CTM Court (TGI Paris)
- First instance court enjoins DHL from using the mark „Webshipping“ based on French mark and for the territory of France

The DHL v. Chronopost Case

National case leading to ECJ C-235/09



- Chronopost appeals to Cour d'Appell (Paris), sitting as second instance CTM court. Appellate court confirms injunction is also based on CTM, but still restricts the scope to France
- Appellate Court also sets penalty payments for violating the injunction
- DHL appeals to Cour de Cassation (dismissed), Chronopost cross-appeals, essentially asking for penalties to be applied throughout the EU (...)



The DHL v. Chronopost Case

ECJ C-235/09



- Cour de Cassation refers case to the ECJ pursuant to Art. 367 TFEU (ex art. 234 TEC)
- Question to consider:
 - No doubt injunction applies community-wide
 - But: What about remedies? What if remedies are ordered in country A which are not even existing under procedural laws of country B?



The ECJ decision

ECJ C-235/09

- An injunction by a national CTM Court applies throughout the EU, as long as the „function of the trademark“ is at stake, i.e.
 - CTM Court can limit injunctions if plaintiff has asked for that or if linguistic issues command a territorial limitation
 - Which means a court will need to rule on the territory unless it wants the injunction to apply EU-wide
- And penalties?



ECJ on enforcement of penalties:

“Where the national law of one of those other Member States does not contain a coercive measure similar to that ordered by the Community trade mark court, the objective pursued by that measure must be attained by the competent court of that other Member State by having recourse to the relevant provisions of its national law which are such as to ensure that the prohibition is complied with in an equivalent manner.”



Open Questions / Issues



- Criteria very vague, what is „equivalent“?
- For discussion: We need to keep two things apart:
 - Unitary right needs to be regarded EU-wide (e.g., a mark can't have acquired distinctiveness in Germany and thus be a CTM)
 - Other issues, however, do not have to be applied unilaterally:
 - Example:
 - Additional protection for marks with reputation in only part of the community, Art. 9 Para. 1 lit. c CTMR.
 - ECJ itself says in PAGO that reputation does not need to be EU-wide
 - Since ECJ can't rule on civil procedure anyway, why try?

Speaker is done. Wake up and discuss!



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