

Reconciling national measures for EU-wide CTM enforcement

This judgement by the Court of Justice of the European Union (CJEU) confirms that when a national court acting as a Community Trade Mark Court imposes measures to ensure compliance with a judgment, those measures should generally be given effect by the national courts of other Member States.

The case, C-235/09, concerns a ruling by a French court acting as a Community Trade Mark Court that a community trademark "WEBSHIPPING", held by Chronopost, had been infringed by the defendant DHL Express France (DHL). The French court prohibited DHL from continuing its infringing acts and imposed a coercive measure, namely a series or periodic penalty payments, to ensure compliance with the prohibition. However, the French court ruled that the coercive measure imposed would apply only in French territory.

Chronopost appealed, believing the coercive measure should apply throughout the EU. This was on the basis that as DHL was domiciled in France, the French court had jurisdiction in relation to all the territories of the EU Member States, under the provisions of the Trade Mark Regulation covering jurisdiction[1]. The question of the territorial effect of the coercive measure was referred to the CJEU.

The CJEU noted that the Trade Mark Regulation set out the circumstances in which a national court would have the jurisdiction to rule on the infringement of a community trademark in relation to all territories of the EU. The CJEU ruled that where a national court had such jurisdiction, a prohibition issued by that court should generally apply throughout the EU, due to the unitary character of a Community trademark. However, there may be exceptions, for example where linguistic differences affect the ability of a

mark to function as a trademark in some territories, in which case the prohibition will be given a more limited territorial scope.

In order to ensure the prohibition is complied with, the CJEU also ruled that the coercive measures should extend to the territories in which the prohibition applies, (which in most cases will be the whole of the EU). In cases where a Member State's national laws do not provide for a similar coercive measure to that imposed by the court, a provision of national law having an equivalent effect should be applied.

This decision emphasises the importance of selecting the correct jurisdiction (usually that in which the defendant is domiciled) to take advantage of European wide enforcement of Community trademarks. In particular, it will be interesting to note the extent to which national courts are required to impose coercive measures which have been ordered by the courts of a different jurisdiction, and where this does occur, how the various national courts seek to reconcile the range of measures available in the different territories of the EU.

[1] Art. 92-94 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark