

# Level up for cross-border IP litigation: the CJEU in Nintendo/BigBen

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Case note on ECLI:EU:C:2017:724

*Michiel Poesen\**

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## **ABSTRACT**

The CJEU's judgment in *Nintendo* relates to a multi-party cross-border intellectual property litigation regarding the infringement of a Community design. Within that context, the referring court submits three questions to the CJEU, two of which concern respectively jurisdiction and applicable law. This case note discusses these two questions, seeing as its scope is limited to private international law.

The first question concerns the territorial scope of orders regarding infringements that a court adopts vis-à-vis a defendant who is not based in the jurisdiction of that court, but that is brought before that court because of the close connection with a claim against another defendant who is domiciled in the courts' jurisdiction (Article 8(1) Brussels I Recast Regulation). The CJEU holds that orders can have an EU-wide scope, as long as the court that grants them has jurisdiction. The second question concerns the determination the law governing the infringement action. How should the connecting factor of the 'place of the infringement' (Article 8(2) Rome II Regulation) be localised when there are multiple infringing acts in different member states? It is held that the localisation should be done through an overall assessment. The CJEU then operationalises the localisation of infringements that are committed by selling infringing goods over the internet. This kind of infringements should be located in the place where the process of putting the offer for sale online by that operator on its website was activated.

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\* PhD candidate; Institute of Private International Law, Research Unit International and European Law, KU Leuven; [michiel.poesen@kuleuven.be](mailto:michiel.poesen@kuleuven.be).

## 1. A MULTI-PARTY, CROSS-BORDER IP LITIGATION

1. Intellectual property law ('IPL') and private international law ('PIL') are undeniably intersecting areas of the law. Infringements of intellectual property rights ('IPR') are often characterised by a cross-border element that triggers questions of PIL such as determining which court has jurisdiction and which law applies to the infringement claim. It suffices to have a look at the considerable body of case law of the Court of Justice of the European Union ('CJEU'), and legal scholarship covering cross-border IP litigation.<sup>1</sup> With the judgment in *Nintendo Co. Ltd v BigBen Interactive GmbH and BigBen Interactive SA* ('*Nintendo*'), the CJEU recapitulates and fleshes out that body of case law.<sup>2</sup>

2. Nintendo is the proprietor of a number of Community designs covering accessories for its Wii game console. Other companies produce accessories that are compatible with that console. One of these companies is Big Ben France. Big Ben France sells its accessories to consumers situated in France, Belgium and Luxembourg. It also supplies its subsidiary Big Ben Germany, which sells the accessories to consumers situated in Germany and Austria.

Nintendo alleges that Big Ben France and Big Ben Germany commit infringements of its Community design. In order to establish these infringements, Nintendo commences proceedings against Big Ben Germany and Big Ben France in the Regional Court of Düsseldorf, Germany.<sup>3</sup> Jurisdiction over the claim against Big Ben Germany is based on its presence in Germany (Article 82(1) of Regulation 6/2002,<sup>4</sup> which essentially copies Article 2 of the Brussels I Regulation 44/2001 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, now Article 4 of the Brussels I Recast Regulation 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters).<sup>5</sup> Jurisdiction over the claim against Big Ben France is based on the close connection of said claim with the claim against

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<sup>1</sup> For a comprehensive overview, see: P. TORREMANS, "Litigating Cross-border Intellectual Property Disputes in the EU Private International Law Framework" in P. BEAUMONT, M. DANOV, K. TRIMMINGS and B. YÜKSEL (eds.), *Cross-Border Litigation in Europe*, Oxford, Hart Publishing, 655-670; M.-C. JANSSENS, "International Disputes Involving Intellectual Property Rights: How to Take the Hurdles of Jurisdiction and Applicable Law" in E. DIRIX and Y. LELEU (eds.), *The Belgian reports at the Congress of Washington of the International Academy of Comparative Law*, Brussels, Bruylant, 2011, 611-652; M.-C. JANSSENS, "Belgium" in T. KONO, *Intellectual Property and Private International Law*, Oxford, Hart Publishing, 2012, 347-424; S. J. SCHAAF SMA, "Editorial. Private international law and intellectual property", *NIPR (Nederlands Internationaal Privaatrecht)* 2016, 685.

<sup>2</sup> CJEU 27 September 2017, joined cases C-24/16 and C-25/16, ECLI:EU:C:2017:724, *Nintendo Co. Ltd v BigBen Interactive GmbH and BigBen Interactive SA*.

<sup>3</sup> Which is one of the designated Community design courts in Germany, see Article 80 of Regulation 6/2002. See regarding the Community design court: G. N. HASSELBLATT (ed.), *Community Design Regulation (EC) No 6/2002*, Munich, C.H. Beck, 2015, 474-479.

<sup>4</sup> [2002] OJ L3/1.

<sup>5</sup> [2012] OJ L351/1; [2001] OJ L12/1; G. N. HASSELBLATT (ed.), footnote 3 above, 487, para. 7.

Big Ben Germany (Article 6(1) of the Brussels I Regulation, now Article 8(1) of the Brussels I Recast Regulation).<sup>6</sup>

**3.** Of crucial importance for this case is the Regional Court's first instance judgment regarding Nintendo's claims against Big Ben France.<sup>7</sup>

First, the Regional Court asserts jurisdiction over those claims. What follows is at the heart of the first of two issues that are under consideration in *Nintendo*. The Regional Court adopts two orders (together referred to as 'the orders'). First, it orders Big Ben France to cease using the protected designs throughout the territory of the EU ('the prohibition'). Secondly, it grants a set of secondary claims, i.a. the destruction or recall of the infringing goods and the payments of damages ('the secondary order'). Importantly, the secondary order – although limited as to its scope to the supplies Big Ben France delivered to Big Ben Germany – extends throughout the EU.

Secondly, the Regional Court assesses the merits of the claims against both Big Ben Germany and Big Ben France in the light of German, Austrian and French law, pursuant to Article 8 of the Rome II Regulation *864/2007 on the law applicable to non-contractual obligations*.<sup>8</sup> According to that provision, the law of the place 'in which the act of infringement was committed' governs IP infringement claims. The interpretation of that phrase is the second of two issues that are studied in this case note.

**4.** Not satisfied with the Regional Court's judgment, Nintendo, Big Ben France, and Big Ben Germany appeal before the Higher Regional Court of Düsseldorf, Germany. Relevant for this case note are the griefs formulated by Big Ben France and Nintendo with regard to the aforementioned order and the applicable law.<sup>9</sup>

First, Big Ben France submits that the Regional Court did not have jurisdiction to grant orders that extend to the entire EU. It alleges that the territorial scope of any order must be limited to the German territory, for jurisdiction over the claim against Big Ben France is based on the close connection with the claim against Big Ben Germany, the company to which Big Ben France supplies the infringing goods in Germany. Essentially, this would entail that the referring German court cannot prohibit Big Ben France to infringe the Community designs outside of Germany. Nintendo, however, submits that the territorial scope of the orders is not problematic. Going forward, it argues that the secondary order should not be limited to the infringing goods that were delivered within the context of the supply relationship between Big Ben France and Big Ben Germany. It should extend to all the infringing goods Big Ben France produces, even those that are not delivered to Big Ben Germany but sold by Big Ben France to consumers in France, Belgium and Luxembourg.

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<sup>6</sup> *Juncto* Article 79(1) of Regulation 6/2002, which refers to the provisions of the Brussels I Recast Regulation. See G. N. HASSELBLATT (ed.), footnote 3 above, 468, para. 1.

<sup>7</sup> CJEU, footnote 2 above, para. 28.

<sup>8</sup> [2007] OJ L199/40.

<sup>9</sup> CJEU, footnote 2 above, para. 30.

Secondly, Nintendo states that the Regional Court applied the wrong law. It should have applied French law to Nintendo's claims against Big Ben France, and German law to its claims against Big Ben Germany, because the respective infringements are to be located in France and Germany.

**5.** Confronted with these fundamental issues of jurisdiction and applicable law, the Düsseldorf Higher Regional Court refers the following questions to the CJEU for a preliminary ruling:

i. Can a court adopt orders against Big Ben France that are applicable throughout the EU and extend beyond the supply relationship with Big Ben Germany, while jurisdiction over the claims against Big Ben France is based on that supply relationship? **Section 2** of the case note sets out and discusses the CJEU's decision with regard to this issue.

ii. With regard to applicable law, how should the connecting factor of the place 'in which the act of infringement was committed' be understood? **Section 3** of the case note studies the CJEU's decision on this issue.

iii. A third question relates to the right of a third party to depict a Community design. This case note does not discuss this issue, for its focus is exclusively on private international law.<sup>10</sup>

In conclusion, this case note ponders the effectiveness of European PIL to administer multi-party litigation and the issues caused by the internet in localising connecting factors.

## 2. TERRITORIAL SCOPE OF IP ORDERS

**6.** The first issue: Does the Düsseldorf Regional Court's jurisdiction to adopt orders against Big Ben France extend to the entire territory of the EU and relate to infringing goods other than those concerned in the supply relationship between Big Ben France and Big Ben Germany, or is it limited to Germany and to the goods implied in the supply relationship? If orders can have an EU-wide scope, Big Ben France can be ordered to cease using the Community design throughout the EU and call back the infringing products it has sold for its own account to French, Belgian, and Luxembourgish customers. If not, an order can only have effect in Germany and should exclusively relate to the infringing goods Big Ben France has delivered to Big Ben Germany. In order to answer this seemingly straight-forward question, the CJEU is forced to follow a comprehensive analysis.

**7.** The CJEU takes a two-pronged approach in its analysis.<sup>11</sup> First, the CJEU spells out the conditions under which a court can assert jurisdiction over connected infringement claims in accordance with Article 8(1) of the Brussels I Recast Regulation (see para. 8 to 11 below).

Secondly, the CJEU clarifies to what extent a court has jurisdiction to grant orders with an EU-wide scope when that court asserts jurisdiction based on

<sup>10</sup> For an analysis, see L. RAJANAYAGAM, "Did wii win? EU-Wide Community design orders and the 'citations' defence", *Entertainment Law Review* 2018, 25-26.

<sup>11</sup> CJEU, footnote 2 above, para. 40-52.

Regulation 6/2002 *juncto* Article 8(1) of the Brussels I Recast Regulation (see para. 12 below).

## 2.1. CONNECTED CLAIMS, A LITIGANT'S 'ENFANT TERRIBLE'

**8.** Article 8(1) of the Brussels I Recast relates to jurisdiction over claims against multiple defendants. This provision allows the courts of the domicile of one of the defendants, the so-called 'anchor defendant', to assert jurisdiction over the claims against the others who are domiciled in another member state.<sup>12</sup> Jurisdiction, however, is conditional, because there must be a close connection between the claims against the anchor defendant and the other defendants.

Nintendo argues that the Regional Court has jurisdiction over its claims against Big Ben France under Article 8(1) of the Brussels I Recast Regulation. In order for the Regional Court to be able to assert jurisdiction over Nintendo's claim against Big Ben France under that article, there thus needs to be a close connection between the claim against Big Ben France and the claim against Big Ben Germany.

**9.** A close connection is generally defined as a connection implying that it is imperative that the claims are treated by the same court in order to avoid irreconcilable judgments from different courts. In that respect, long standing case law requires that the risk of irreconcilable judgments arises in 'the same situation of fact and law'.<sup>13</sup> In *Nintendo* the CJEU further sharpens the criteria to determine whether there is 'the same situation of fact and law'.

**10.** The CJEU first clarifies the requirement of the same situation 'of law'. The orders that are sought by Nintendo are governed by national law, which is the law of the place where the infringement is committed.<sup>14</sup> Hence in the case of Big Ben France and Big Ben Germany, Nintendo's infringement will not necessarily be governed by the same law, because the infringing acts took place in different countries. One could be inclined to conclude that when two judges apply different laws to claims based on the same infringement, it is evident that they can reach different conclusion because they apply a different set of legal provisions.<sup>15</sup>

<sup>12</sup> G. VAN CALSTER, *European Private International Law*, Oxford, Hart Publishing, 2016, 165.

<sup>13</sup> CJEU 1 December 2011, C-145/10, ECLI:EU:C:2011:798, *Painer*, para. 79; CJEU 11 October 2007, C-98/06, ECLI:EU:C:2007:595, *Freeport*, para. 40; CJEU 13 July 2006, C-539/03, ECLI:EU:C:2006:458, *Roche Nederland BV*, para. 26-31; P. TORREMANS (ed.), *Cheshire, North & Fawcett: Private International Law*, Oxford, OUP, 2017, 285; H. MUIR WATT, "Article 8" in U. MAGNUS and P. MANKOWSKI, *Brussels Ibis Regulation*, Munich, Otto Schmidt, 2016, 383-384, para. 25; A. DICKINSON and E. LEIN, *Brussels I Regulation Recast*, OUP, Oxford, 2015, 187-188, para. 4.167

<sup>14</sup> See section 3 below regarding the determination of the law governing IP infringement claims.

<sup>15</sup> CJEU 13 July 2006, C-539/03, ECLI:EU:C:2006:458, *Roche Nederland BV*, para. 26-31; C. SEVILLE, *EU Intellectual Property Law and Policy*, Cheltenham, Edward Elgar, 2016, 517; A. BRIGGS and P. REES, *Civil Jurisdiction and Judgments*, London, Informa, 2009, 122-123, para. 2.71, 295, para. 2.204.

However, the CJEU holds that the fact that national law governs Nintendo's claims does not imply that the orders sought against Big Ben France and Big Ben Germany do not result from the same situation of law. Indeed, Regulation 6/2002 partially harmonises national law, and confers rights under the Community design that have a unitary character and aim to protect the Community design throughout the EU.<sup>16</sup> This is in line with the CJEU's case law pursuant to which the existence of the same situation of law is more easily accepted if there is some extent of European harmonisation of national law.<sup>17</sup>

**11.** Then, the CJEU elaborates on the requirement of the same situation 'of fact'. The central question is the following: For there to be the same situation of fact, should the referring court only have regard to (infringements committed within) the supply chain within which Big Ben France supplied infringing goods to Big Ben Germany?<sup>18</sup> The CJEU responds negatively. The requirement of the existence of the same situation of fact covers all the activities of the co-defendants, including activities that are unrelated to the supply chain.<sup>19</sup>

Scholarship observes that this means the CJEU restricts the potential for the use of anchor defendants: the more facts one needs to take into account, the less likely these will coincide with the alleged infringing acts of the anchor defendant.<sup>20</sup> Somewhat limiting that restriction, scholarship anterior to *Nintendo* has suggested that different types of infringements (manufacturing versus selling) may qualify as one and the same situation of fact.<sup>21</sup>

## 2.2. TERRITORIAL SCOPE OF ORDERS

**12.** Having clarified jurisdiction under Article 8(1) of the Brussels I Recast Regulation, the CJEU proceeds by analysing the extent of the referring courts' jurisdiction under Regulation 6/2002 *juncto* Article 8(1) of the Brussels I Recast Regulation.

**13.** The CJEU refers to its case law on the territorial scope of prohibitions against infringements of Community trademarks.<sup>22</sup> Their territorial scope is determined by two demarcators: (i) territorial jurisdiction of the court that is sought to grant the order, and (ii) the territorial extent of the IPR.<sup>23</sup> The CJEU holds that these demarcators should also apply to prohibitions against infringements of Community designs, as well as secondary orders such as

<sup>16</sup> CJEU, footnote 2 above, para. 48-49.

<sup>17</sup> CJEU 1 December 2011, C-145/10, ECLI:EU:C:2011:798, *Painer*, para. 82; P. TORREMANS, "Jurisdiction for cross-border intellectual property cases in Europe", *Common Market Law Review* 2016, 1641; P. TORREMANS, "Intellectual property puts art.6(1) Brussels I Regulation to the test", *IPO (Intellectual Property Quarterly)* 2014, 6.

<sup>18</sup> CJEU, footnote 2 above, para. 50.

<sup>19</sup> CJEU, footnote 2 above, para. 52.

<sup>20</sup> G. VAN CALSTER, "The CJEU in Nintendo. Where will you sue next?", [www.gavclaw.com](http://www.gavclaw.com), 6 October 2017, last accessed 30 March 2018.

<sup>21</sup> S. J. SCHAAFSMA, "Multiple defendants in intellectual property litigation", *NIPR* 2016, 701.

<sup>22</sup> CJEU, footnote 2 above, para. 53.

<sup>23</sup> CJEU 12 April 2011, C-235/09, ECLI:EU:C:2011:238, *DHL Express France SAS v. Chronopost SA*, para. 33.

orders to recall or destroy infringing goods.<sup>24</sup> This case note focuses on demarcator (i), for the CJEU straightforwardly equates (ii) to the entire territory of the EU because the protection under a Community design extends to the entire EU.<sup>25</sup>

**14.** Then the CJEU observes that Article 83(2) of Regulation 6/2002 contains an exhaustive list of instances in which jurisdiction is limited to infringements committed in a member state.<sup>26</sup> Instances in which a court asserts jurisdiction over an infringement claim based on Article 8(1) of the Brussels I Recast Regulation are not included in that list. Hence, there is no reason to extend the exception of Article 83(2), which implies that orders can have an EU-wide scope.<sup>27</sup> Moreover, the CJEU points out the EU-wide scope of orders is justified by the goal of Regulation 6/2002 of providing effective protection of Community designs in the EU.<sup>28</sup>

### 3. LOCALISING INFRINGEMENTS

#### 3.1. AN OVERALL ASSESSMENT

**15.** The law that governs the infringements of Community designs is determined in accordance with Article 88(2) of Regulation 6/2002, whereas measures such as recall and damages following such infringements are governed by the law to which Article 89(1)(d) of said Regulation refers. These provisions do not contain a proper conflict rule. Where Article 88(2) refers to the private international law of the member states, Article 89(1)(d) refers to the private international law of the member state in which the infringements are committed.<sup>29</sup> In the EU, both provisions mostly lead to the application of the applicable law rules of the Rome II Regulation. The Rome II Regulation contains a provision that governs claims arising out of infringements of unitary Community IPR's, more particularly Article 8(2).<sup>30</sup>

Article 8(2) of the Rome II Regulation refers to 'the law of the country in which the act of infringement was committed'. In *Nintendo*, the referring court essentially inquires how the place where the infringement was committed should be understood when there are several infringing acts. This question had until now not been answered yet by the CJEU.<sup>31</sup>

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<sup>24</sup> CJEU, footnote 2 above, para. 54-55.

<sup>25</sup> CJEU, footnote 2 above, para. 59-60.

<sup>26</sup> G. N. HASSELBLATT (ed.), footnote 3 above, 492, para. 1.

<sup>27</sup> CJEU, footnote 2 above, para. 62-65.

<sup>28</sup> CJEU, footnote 2 above, para. 66. See recital 29 and 30 of Regulation 6/2002; C. SEVILLE, footnote 15 above, 257.

<sup>29</sup> R. PLENDER and M. WILDERSPIN, *The European Private International Law of Obligations*, London, Sweet and Maxwell, 2015, 688, para. 22-031; G. N. HASSELBLATT (ed.), footnote 3 above, 512, para. 8, 519, para. 27.

<sup>30</sup> M. ILLMER, "Art. 8 Rome II" in P. HUBER (ed.), *Rome II Regulation*, Munich, Sellier, 2011, 240, para. 27.

<sup>31</sup> BOT AG, 1 March 2017, joined cases C-24/16 and C-25/16, ECLI:EU:C:2017:146, *Nintendo Co. Ltd v BigBen Interactive GmbH and BigBen Interactive SA.*, para. 60; G. N. HASSELBLATT (ed.),

**16.** The reasoning starts from the Rome II Regulation's general aim of providing for a foreseeable connecting factor to determine applicable law. This means that litigants should be able to predict the law that courts will apply. The CJEU excludes that the place of the infringement can be equated to the place where the damage occurred (the '*locus damni*'), which is the connecting factor that is used in the general conflict rule of Article 4(1) of the Rome II Regulation. If they were to be equated, the EU legislature would not have provided a separate connecting factor for IPR infringements in Article 8(2). Hence, *a contrario*, the place of infringement equates to the place where the event causing the damage occurred (the '*locus delicti commissi*').<sup>32</sup>

**17.** Subsequently, the CJEU explains how the place where the event giving rise to the damage should be located when there are multiple infringing acts. In the case of Big Ben France, there are already four laws that could apply: (i) France, for this is where the goods are fabricated and sold, or (ii) Belgium and (iii) Luxembourg, for these are the countries in which it sells infringing goods to consumers, and (iv) Germany, for it supplies Big Ben Germany with the infringing goods. The same goes for Big Ben Germany, which sells goods to consumers situated in Germany and Austria.

Stressing that the Rome II Regulation aims to increase legal certainty and foreseeability, the CJEU comes to the conclusion that the place where the infringement took place, refers to one place and one place only.<sup>33</sup> National courts should not refer to the place of each individual infringing act. The CJEU invites national courts to 'make an overall assessment' that should lead to 'the place where the initial act of infringement at the origin of that conduct was committed or threatened'.<sup>34</sup> This stands in contrast with the suggested solution in legal scholarship comprising to locate the place of the infringement in the place of the last act of infringement that directly causes the damage on the part of the proprietor of the IPR,<sup>35</sup> or to apply a *de minimis* rule that makes an abstraction of small ('*de minimis*') infringements.<sup>36</sup>

### 3.2. THE INTERNET ERA, AND AN INTRA-EUROPEAN SUPPLY CHAIN OF INFRINGING GOODS

**18.** Then the CJEU concretises the 'overall assessment' of the place where the infringement took place. It analyses a set of particular circumstances that the referring national court pointed out in its preliminary reference.

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footnote 3 above, 512, para. 8; A. KUR and T. DREIER, *European Intellectual Property Law*, Cheltenham, Edward Elgar, 2013, 525.

<sup>32</sup> CJEU, footnote 2 above, para. 96-98. See M. ILLMER, footnote 30 above, 256, para. 54.

<sup>33</sup> CJEU, footnote 2 above, para. 103. *Cfr.* G. N. HASSELBLATT (ed.), footnote 3 above, 512, para. 8: The author suggests that legal certainty requires that multiple infringements in different member states should be subjected separately to the law of each member state in which the respective infringement is committed.

<sup>34</sup> CJEU, footnote 2 above, para. 103.

<sup>35</sup> P. TORREMANS (ed.), footnote 13 above, 834; M. ILLMER, footnote 30 above, 247-248, para. 39.

<sup>36</sup> J. FAWCETT and P. TORREMANS, *Intellectual Property and Private International Law*, Oxford, OUP, 2011, 818-820, para. 15.46-15.49.



**19.** First, the CJEU discusses the commercialisation of products by means of a website that is accessible to consumers in member states other than that of the company owning the website (*in casu* Big Ben France’s customers situated in Belgium and Luxembourg, and Big Ben Germany’s customers situated in Austria). The CJEU opts for a seemingly simple connecting factor. When an economic operator commits infringements through a website, the place of the infringement must be located in the place ‘where the process of putting the offer for sale online by that operator on its website was activated’.<sup>37</sup>

However, the reference to the place ‘where the process of putting the offer for sale online by that operator on its website was activated’ is possibly even more troublesome. Consider the following example: a company established in France sells infringing goods on its website that is accessible all over Europe. Its website is put online and managed by a company located in Spain. Should French or Spanish law govern the infringement? One may assume that in our example, French law is applicable, for the order to put the offer for sale online is given by company A established in France. This would be in line with the ‘country of origin’ approach the CJEU has evidently taken, which favours the law of the infringing party over the law of the victim of the infringement.<sup>38</sup>

**20.** It is worth noting that the connecting factor of the place ‘where the process of putting the offer for sale online by that operator on its website was activated’ allows for applicable law shopping. By purposefully activating said process in a particular country, an infringer can opt for the IP law of a that country.<sup>39</sup> What is more, an infringer can even opt for the law of a non-EU country with lenient IPR protection, because the Rome II Regulation applies universally and can therefor point to the law of a non-EU country.<sup>40</sup>

The localisation of the place where the process of putting the offer for sale online was activated, and the corresponding leeway to pick that location is *mutatis mutandis* relevant for the special jurisdiction rule of Article 7(2) of the Brussels I Recast Regulation. Article 7(2) confers jurisdiction over claims in tort to i.a. the ‘*locus delicti commissi*’,<sup>41</sup> interpreted accordingly as the place where the process of putting the offer for sale online was activated.<sup>42</sup>

**21.** Lastly, the CJEU ponders the impact of an intra-European supply chain.<sup>43</sup> If a company produces infringing goods in country A and supplies a subsidiary in country B with those goods, where does the infringing act take place? This question is met with a brief response. The national courts should make an overall assessment, instead of having regard to each individual infringing act.

<sup>37</sup> CJEU, footnote 2 above, para. 106, 108.

<sup>38</sup> G. SMITH, “Here, there or everywhere? Cross-border liability on the internet”, *Computer and Telecommunications Law Review* 2007, 41.

<sup>39</sup> G. VAN CALSTER, footnote 20 above; T. LUTZI, “Internet cases in EU private international law – Developing a coherent approach”, *International and Comparative Law Quarterly* 2014, 707.

<sup>40</sup> Article 3 of the Rome II Regulation.

<sup>41</sup> P. TORREMANS, footnote 1 above, 658; G. VAN CALSTER, footnote 12 above, 147-148; A. BRIGGS, *Private International Law in English Courts*, OUP, Oxford, 2014, 279-280, para. 4.269.

<sup>42</sup> T. LUTZI, footnote 39 above, 706-707; G. VAN CALSTER, footnote 20 above.

<sup>43</sup> CJEU, footnote 2 above, para. 109.

One can only assume that the national courts should opt for the law of the state where the infringing goods were produced, as BOT AG opined.<sup>44</sup>

## CONCLUSION

**22.** *Nintendo* once more demonstrates that jurisdiction over multiple defendants in the context of IP litigation can be a source of uncertainty. In this regard, the CJEU clarifies that an order against a party infringing a Community design can have an EU-wide scope. This also applies when a national court asserts jurisdiction over a claim pursuant to Article 8(1) of the Brussels I Recast Regulation. The scope of orders is not limited by Regulation 6/2002 to infringements committed in that court's member state.

An additional yet essential precondition is that the court in which the infringement claim is brought has jurisdiction under Article 8(1) of the Brussels I Recast Regulation. The CJEU provides the referring court with additional guidelines for asserting jurisdiction under that provision. It reiterates that there must be a risk of irreconcilable judgments that arises in the same situation of law and of fact. For there to be the same situation 'of fact' in a case like *Nintendo* the CJEU imposes the requirement that the referring court should take into account all activities of the defendants, including the supplier's (i.e. Big Ben France's) activities that are independent from its supply relationship with the distributor (i.e. Big Ben Germany).

**23.** The CJEU also clarifies how to locate the place where an IP infringement was committed for the purpose of determining the applicable law under Article 8(2) of the Rome II Regulation. National courts should make an overall assessment that should lead to 'the place where the initial act of infringement at the origin of that conduct was committed or threatened'.

Furthermore, the CJEU rises to the difficult task of locating an online IPR infringement for the purpose of determining the applicable law (*in casu* the law that governs an IPR infringement claim). This is a symptom of a more general challenge to locate – traditionally territorial – connecting factors when a dispute relates to acts committed over the internet.<sup>45</sup> In *Nintendo*, the CJEU concretises the place of an online IPR infringement by referring to the place where the process of the offer for sale of the infringing goods was activated.

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<sup>44</sup> BOT AG, footnote 31 above, para. 67.

<sup>45</sup> E.g. recently in CJEU 17 October 2017, C-194/16, ECLI:EU:C:2017:766, *Bolagsupplysningen*. See also, A. KUR and T. DREIER, footnote 31 above, 527-528; D. J. B. SVANTESSON, *Private International Law and the Internet*, Alphen aan den Rijn, Kluwer Law International, 2007, 9-10, 60-61