

Infringement of a CTM leads to EU-wide injunction.



In its decision of 12 April 2011 (docket no. C-235/09 – “WEBSHIPPING”), the Court of Justice of the European Union (ECJ) ruled that a prohibition issued on the basis of a Community trade mark extends, as a rule, to the entire territory of the European Union.

However, a Community trade mark court must limit the territorial scope of the prohibition to a single Member State or to part of the territory of the European Union, if the defendant proves that the use of the sign at issue does not affect the functions of the trade mark in the remaining territory of the European Union. As the ECJ points out, such difference may be due to linguistic grounds. Another reason could be that the reputation of the trade mark is limited to part of the EU only, if the claim is based on the special protection of the trade mark being well-known.

For the burden of proof this means: It is not the plaintiff's burden to prove an unlimited infringement, but the defendant's burden to prove a merely limited infringement.

The plaintiff may also decide to restrict the territorial scope of the motion for an injunction, in particular if it seems to be likely that the defendant may be able to prove that the infringement is limited to part only of the EU. This would be another reason to limit the territorial scope of the prohibition accordingly.

Note: The decision leaves the principle unaffected that the prohibition is to be restricted to the Member State in which the infringement has happened, if the international competence of the Community trade mark court does not follow from a seat or business establishment of the defendant (or the plaintiff or OHIM as fall back venues), but from the place of infringement.

Furthermore, the ECJ addressed the enforcement of the prohibition: The Community trade mark court is required to select the appropriate coercive measures, for example a penalty payment, to ensure that the prohibition is complied with. As the measures are not provided for in the CTM Regulation, the court has to make the selection from the coercive measures provided for under the legislation of its own Member State. If the prohibition is later enforced in another Member State than the Member State of the court issuing the prohibition, the provided measure must be performed by the court in that Member State in the way as provided for under the legislation of that Member State. In case, the national law of that Member State does not provide for a coercive measure corresponding or similar to the one ordered by the Community trade mark court which issued the prohibition, the enforcing court must take that action which ensures that the prohibition is complied with in an equivalent manner.

If you have any questions or if you require more detailed information, please do not hesitate to contact us.

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