

# IP ENFORCEMENT CASE-LAW COLLECTION ON THE BALANCE BETWEEN THE RIGHT OF INFORMATION AND FUNDAMENTAL RIGHTS IN THE EUROPEAN UNION



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## I. BACKGROUND

According to Article 8(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (IPRED)<sup>1</sup> the competent judicial authorities of an EU Member State, in the context of proceedings and in response to a justified and proportionate request of the claimant, may order that information on the origin and distribution networks of the goods or services, which infringe an intellectual property right (IPR), is to be provided by the infringer and/or any other person.

The persons who are potentially liable to such an order are the following:

- (a) the infringer and/or any other person who was found in possession of the infringing goods on a commercial scale;
- (b) the infringer and/or any other person who was found to be using the infringing services on a commercial scale;
- (c) the infringer and/or any other person who was found to be providing on a commercial scale services used in infringing activities;
- (d) the infringer and/or any other person who was indicated by the person referred to in point (a), (b) or (c) as being involved in the production, manufacture or distribution of the goods or the provision of the services.

The kind of information to be provided comprises:

- (a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods and services, as well as the intended wholesalers and retailers;
- (b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods and services in question.

The ability to obtain information, or in other words, the right of information, as provided by Article 8 IPRED, is a crucial tool for IPR holders to efficiently enforce IPRs against infringers. While the right of information is important for IPR holders, it is limited by other, potentially conflicting rights, such as, but not limited to, the protection of personal data or the freedom to conduct business, of the suspected infringer or other persons from whom information has been requested.

The case-law for this collection was selected with a view on Article 8 IPRED and how this provision has been implemented into national law of EU Member States. The purpose of the present case-law

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<sup>1</sup> [http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32004L0048R\(01\)&from=EN](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32004L0048R(01)&from=EN)

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collection is to provide relevant decisions of the Court of Justice of the European Union (CJEU) as well as national court decisions within selected EU Member States.

This document focuses on the balancing of the right of information and fundamental rights, and will, first, outline the main principles as established by the CJEU and, second, look at the principles as applied in selected national court decisions<sup>2</sup>.

This case-law collection was prepared within the framework of activities undertaken by the Knowledge Circle Enforcement (KCE) of the European Union Intellectual Property Office (EUIPO)<sup>3</sup>.

The collection of relevant case-law was assigned to members of the KCE and some of their work associates. Each individual carried out the research in jurisdictions and languages of a chosen EU Member State with which they were familiar.

After the initial identification of cases from the EUIPO databases and external, publicly available online sources, a case-law data collection sheet was compiled containing descriptions of the current situation in each of the examined Member States. These descriptions were peer-reviewed by other contributors.

Apart from the CJEU decisions, the case-law data collection looks at national court decisions in Belgium, Germany, Ireland, Greece, Spain, France, Cyprus, Lithuania, Austria, Poland, Portugal, and the United Kingdom<sup>4</sup>. It should be noted that it was not possible to identify relevant case-law for all of the national jurisdictions considered. This is either because no case-law exists on the subject, or because of existing limitations in accessing identified case-law databases.

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<sup>2</sup> The information contained in this document has been gathered using publicly available case-law databases. The study is by no means exhaustive and focuses on selected decisions only.

<sup>3</sup> The KCE is led by the European Observatory on Infringements of Intellectual Property Rights and is composed of members from different departments of the EUIPO. Its work is focused on the collection of key enforcement case-law, the analysis of trends in national enforcement case-law and enforcement issues related to IPR.

<sup>4</sup> The jurisdictions were selected on the basis of geographical spread in the EU, considering larger and smaller jurisdictions and the language capabilities of the KCE members.

## II. ABSTRACT

This document provides a collection of case-law consisting of decisions of the CJEU as well as national court decisions in the selected Member States relating to the relationship between the right of information, as provided by Article 8 IPRED, and fundamental rights.

The CJEU clarified in several of its decisions that the right of information should be interpreted at national level in such a way which allows for the full respect of the various applicable fundamental rights or other general principles of European Union law, such as the principle of proportionality.

The CJEU provided guidance on particular issues relating to the right of information as provided by Article 8 IPRED. However, it has only outlined general principles on how to balance fundamental rights and how to apply the principle of proportionality in doing so. The actual weighing and balancing of fundamental rights, however, is left to the national courts.

In the *Promusicae*<sup>5</sup> case the CJEU set out the requirement to implement the relevant EU directives (including the IPRED) in accordance with fundamental rights and the principle of proportionality. In *LSG-Gesellschaft*<sup>6</sup>, the CJEU concluded that Directive 2002/58/EC of the European Parliament and of the Council of 12 July 2002 concerning the processing of personal data and the protection of privacy in the electronic communications sector (Directive 2002/58/EC) as well as the IPRED do not preclude Member States from imposing an obligation to disclose personal data relating to internet traffic for the purposes of enforcing copyright. Following this case-law, the CJEU confirmed in the *Bonnier*<sup>7</sup> case that Directive 2006/24/EC of the European Parliament and of the Council of 15 March 2006 on the retention of data generated or processed in connection with the provision of publicly available electronic communications services or of public communications networks and amending Directive 2002/58/EC (Directive 2006/24/EC)<sup>8</sup> and the IPRED do not prevent national law from obliging an internet service provider (ISP) to provide information on its subscriber's IP address, which was allegedly used in an infringement. In the more recent *Coty Germany*<sup>9</sup> decision the CJEU further clarified that Article 8(3)(e) IPRED must be interpreted as precluding national law, which allows, in an unlimited and unconditional manner, to invoke banking secrecy rights to refuse providing information concerning the name and address of an account holder. Finally, in its *New Wave CZ*<sup>10</sup> decision, the CJEU decided that the right of information (Article 8(1) IPRED) may be enforced in separate proceedings even after the definitive termination of main proceedings concerning the infringement of an IPR.

<sup>5</sup> Judgment of 29 January 2008, Case C-275/06, *Productores de Música de España (Promusicae) v Telefónica de España SAU*, ECLI:EU:C:2008:54.

<sup>6</sup> Order of 19 February 2009, Case C-557/07, *LSG-Gesellschaft (LSG-Gesellschaft) zur Wahrnehmung von Leistungsschutzrechten GmbH v Tele2 Telecommunication GmbH*, ECLI:EU:C:2009:107.

<sup>7</sup> Judgment of 19 April 2012, Case C-461/10, *Bonnier Audio AB (Bonnier) and Others v Perfect Communication Sweden AB*, ECLI:EU:C:2012:219.

<sup>8</sup> Directive 2006/24/EC has been declared invalid in the meantime by the CJEU within the judgment in the joined cases C-293/12 and C-594/12, see: <https://curia.europa.eu/jcms/upload/docs/application/pdf/2014-04/cp140054en.pdf>

<sup>9</sup> Judgment of 16 July 2015, Case C-580/13, *Coty Germany GmbH (Coty Germany) v Stadtsparkasse*, ECLI:EU:C:2015:485.

<sup>10</sup> Judgment of 18 January 2017, Case C-427/15, *NEW WAVE CZ, a.s. (New Wave CZ) v ALLTOYS, spol. s r. o.*, ECLI:EU:C:2017:18.

The European Commission, in its Communication on the guidance on certain aspects of IPRED<sup>11</sup>, reiterated the importance of striking a fair balance between different fundamental rights (notably, the rights to protection of property, to effective judicial protection, to privacy and personal data, and the freedom to conduct a business) when applying the right of information. The Commission particularly clarifies that any court order issued under Article 8 IPRED should only concern information which is actually needed to identify the source and the scope of the infringement.<sup>12</sup>

Looking at national jurisdictions, all EU Member States have brought into force the laws, regulations and administrative provisions that are necessary to comply with the IPRED.

However, for some of the jurisdictions (Ireland, Cyprus and Lithuania) no relevant court decisions on the subject matter analysed in this document could be identified.

As regards the relevant national decisions that were collected, all of them dealt with the right of information as outlined in Article 8 IPRED. The level of detail provided concerning the balancing of fundamental rights on the one hand and right of information on the other hand, however, differs significantly depending on the jurisdiction and national laws.

While some national decisions expressly establish the parameters considered for the balancing of fundamental rights, others just conclude that one right prevails over the other without providing any further explanation or simply grant the right of information without an explicit balancing of rights.

The courts in Austria acknowledged the need to balance conflicting fundamental rights when assessing the right of information. According to the Oberster Gerichtshof (Austrian Supreme Court)<sup>13</sup> the assessment of proportionality requires an overall assessment of the interests of both, the IPR owner, as well as the infringer. While in general the right of information prevails over the fundamental rights of the infringer, this is not the case where the IPR holder does not need to rely on the information requested in order to enforce its rights or the information requested leads to a market foreclosure (Marktabstottung) preventing the supplier from delivering genuine products to third parties.

A similar approach has been applied in Germany, where the Bundesgerichtshof (Federal Court of Justice)<sup>14</sup> concluded that the assessment of proportionality requires an overall assessment of the interests of all parties involved. Provided a violation of rights of the IPR owner is obvious, it seems unlikely that the other parties involved would suffer unjustified damage in providing the data requested. The Federal Court of Justice relied on the fact that the uploading of protected copyright content to an online-server for free downloading, should be presumed as an obvious copyright infringement.

In another Federal Court of Justice<sup>15</sup> case, the court concluded that national bank secrecy rights cannot be used without limitations to refuse the right of information. Even if the requested information could be

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<sup>11</sup> Communication from the Commission to the European Parliament, the Council and the European Economic and Social Committee, *Guidance on certain aspects of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights*, COM(2017)708.

<sup>12</sup> See COM(2017)708, p. 11.

<sup>13</sup> Oberster Gerichtshof, Judgment of 17 November 2015, 4 Ob 170/15a.

<sup>14</sup> Bundesgerichtshof, Order of 25 October 2012, I ZB 13/12.

<sup>15</sup> Bundesgerichtshof, Judgment of 21 October 2015, I ZR 51/12.



obtained by other means (criminal proceedings), this does not preclude the granting of the right of information.

In France the Tribunal de Grande Instance de Paris<sup>16</sup> has acknowledged the need to balance the different rights at stake and would only grant the right of information provided such request would not disproportionately violate the trade secrets of the defendant.

In course of a preliminary ruling, the First Instance Court of Athens<sup>17</sup> in Greece applied the principle of proportionality as well and concluded that the right of information needs to be assessed in the light of proportionality, providing a safeguard against intellectual property violation without creating a barrier to legitimate trade.

Like in other Member States, Polish courts have followed the principles of proportionality outlined by the CJEU and applied a balancing of fundamental rights in several cases. The courts have even granted the right of information before an infringement claim has been put forward.<sup>18</sup>

While the courts in Spain, Portugal and the United Kingdom have not explicitly referred to the balancing of the rights, they have acknowledged the right of information and either granted the right of information without a detailed explanation or refused it for reasons not necessarily being a conflicting right.

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<sup>16</sup> Tribunal de grande instance de Paris, Judgment of 6 January 2014, 14-09412.

<sup>17</sup> First Instance Court of Athens, 1563/2013.

<sup>18</sup> Provincial Court Krakow, IX GCo 41/14.

## III. CASE-LAW OF THE CJEU

The CJEU has dealt with the right of information as provided by Article 8 IPRED in a number of cases. Not all of these cases, however, provide guidance as to how to strike a balance between the right of information and conflicting fundamental rights.

This study will focus only on the Court's decisions where it has clearly addressed the issue of conflicting rights in IPR infringement cases and established principles assisting in balancing these rights. In total five relevant CJEU decisions could be identified, which are summarised below in a chronological order.

### A. C-275/06 PROMUSICAE

Promusicae is a Spanish organisation of producers and publishers of musical and audiovisual recordings. The organisation sought a preliminary order against Telefónica, a telecommunication company providing, inter alia, internet access services, to disclose the identities and physical addresses of certain persons whom it provided with internet access services, whose IP address and date and time of connection were known. According to Promusicae, those persons used a peer-to-peer file exchanging program and provided access in shared files of personal computers to phonograms in which the members of Promusicae held the exploitation rights. By order of 21 December 2005, the Commercial Court No 5 of Madrid ordered the preliminary measure requested by Promusicae. Telefónica appealed, arguing that the data sought was authorised only in criminal investigation or for the purpose of safeguarding public security and national defence, but not in civil proceedings.

The Commercial Court No 5 of Madrid decided to stay the proceedings and, in its reference for a preliminary ruling, asked the CJEU whether Community law, in particular 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 (Directive 2000/31/EC), 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 (Directive 2001/29/EC) and the IPRED, read also in the light of Articles 17 and 47 of the Charter of Fundamental rights of the European Union, must be interpreted as requiring Member States to lay down, in order to ensure effective protection of copyright, an obligation to communicate personal data in the context of civil proceedings.

The CJEU considered Directive 2002/58/EC, which provides that Member States must ensure the confidentiality of communications by means of a public communications network and publicly available electronic communications services, and of the related traffic data, and must, inter alia, prohibit, in principle, the storage of that data by persons other than users, without the consent of the users concerned, save in the case of exceptions laid down in the Directive.

The CJEU pointed out that these exceptions do not relate to the bringing of civil proceedings, and it further observed that the directive in question also allows the confidentially obligation to be limited where

this is necessary to protect the rights and freedom of others, including property rights in situations where authors are seeking to obtain protection of such rights before the competent courts. The CJEU therefore concluded that Directive 2002/58/EC does not preclude the possibility for the Member States of laying down an obligation to disclose personal data in the context of civil proceedings. The CJEU noted that it is necessary to reconcile the requirements of the protection of different fundamental rights in the case, namely the right to respect for one's private life on the one hand and the right to the protection of property and an effective remedy on the other hand. The CJEU gave the referring court the task of weighing up the rights in this specific case and reconciling those conflicting rights, on the basis of the provisions contained in Directive 2002/58/EC, as well as in Directive 2000/31/EC, Directive 2001/29/EC and the IPRED, which concern information society services, the harmonisation of copyright and the enforcement of IPR respectively.

The abovementioned directives do not require the Member States to lay down, in a situation such as that in the main proceedings, an obligation to communicate personal data in order to ensure effective protection of copyright in the context of civil proceedings. However, Community law requires that, when transposing those directives, the Member States take care to rely on an interpretation of them that allows a fair balance to be struck between the various fundamental rights protected by the Community legal order. Furthermore, when implementing the measures transposing those directives, the authorities and courts of the Member States must not only interpret their national law in a manner consistent with those directives but also make sure that they do not rely on an interpretation of them that would be in conflict with those fundamental rights or with the other general principles of Community law, such as the principle of proportionality.

## B. C-557/07 LSG-GESELLSCHAFT

LSG is an Austrian collecting society, which enforces the rights of performers and phonogram producers. LSG applied for an order requiring Tele2, an Austrian internet access provider, to communicate to it the names and addresses of persons engaged in alleged illegal file-sharing activities, to whom it provides internet access and whose IP addresses, day and time of connection are known. Tele2 denied the obligation on the basis that it was not an intermediary and is not authorised to save access data. The Commercial Court Vienna granted LSG's application, which was furthermore confirmed on appeal by the Higher Regional Court Vienna.

Tele2 appealed to the Austrian Supreme Court, which stayed the proceedings and referred two questions to the CJEU, asking, **first**, whether the term 'intermediary' in Article 5 (1)(a) and Article 8(3) of Directive 2001/29/EC could be interpreted to include an access provider who merely provides the user with access to a network without any services (email and FRTP) or file-sharing services, and has no control over the services, and if so, **second**, whether Article 8(3) IPRED in conjunction with Article 6 and 15 of Directive 2002/58/EC prohibits the disclosure of personal traffic data to private third parties for the purposes of civil proceedings regarding alleged infringements of copyright.

In relation to the second question, the CJEU repeated its findings from the *Promusicae* case, in which it concluded that Directive 2002/58/EC does not preclude Member States from providing in their national laws an obligation for disclosure of personal traffic data to private parties for the purpose of civil proceedings. In addition, the Court repeated that Member States must not rely on an interpretation of the

relevant directives that would conflict with fundamental rights or with other general principles of Community law, such as the principle of proportionality.

As regards the first question, the CJEU found that access providers [such as Tele2] which merely provide users with internet access, without offering other services such as email, FTP or file-sharing services or exercising any control over the services which users make use of, must be regarded as intermediaries within the meaning of Article 8(3) Directive 2001/29/EC. According to the CJEU, Member States are to ensure that rights holders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe a copyright or related right. The protection sought by Directive 2001/29/EC would be substantially diminished, if intermediaries, within the meaning of Article 8(3) of that directive, were to be construed as not covering access providers, which alone are in possession of the data making it possible to identify the users who have infringed those rights.

### C. C-461/10 BONNIER

Bonnier and the other applicants were all publishing companies holding, inter alia, exclusive rights to the reproduction, publishing and distribution to the public of a number of audio books. Bonnier and the other applicants were of the opinion that their exclusive rights had been infringed by the unauthorised public distribution of these audio books, by means of illegal file exchanging via the ISP ePhone. They applied to the Solna District Court (Sweden) for an order for the disclosure of data for the purpose of communicating the name and address of the person using the IP address from which it was assumed that the files in question had been sent. ePhone challenged this application arguing that the injunction sought was contrary to the Directive 2006/24/EC. The Solna District Court granted to Bonnier and the other applicants the application for an disclosure order of data.

ePhone brought an appeal before Svea hovrätten (Stockholm Court of Appeal), seeking dismissal of the application for the order for the disclosure. The Stockholm Court of Appeal upheld the appeal filed by ePhone, finding, inter alia that no clear evidence of an IPR infringement had been adduced.

Bonnier and the other applicants appealed to the Högsta domstolen (Supreme Court of Sweden). The Supreme Court of Sweden stayed the proceedings and made a reference to the CJEU asking in essence, first, whether Directive 2006/24/EC precludes the application of a national provision based on Article 8 IPRED which permits an ISP in civil proceedings to be ordered to give a copyright holder information on the subscriber to whom the ISP provided an IP address, which was allegedly used in the infringement, and, second, whether the answer to the first question is affected by the fact that the Member State has not implemented Directive 2006/24/EC, despite the fact that the period prescribed for implementation has expired.

According to the CJEU, the communication sought by the applicants in the course of civil proceedings for the benefit of a copyright holder constitutes the processing of personal data within the meaning of Article 2 of Directive 2002/58/EC, read in conjunction with Article 2(b) of Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995 on the protection of individuals with regard to the processing of personal data and on the free movement of such data (Directive 95/46/EC). In that regard, the CJEU noted that an application for communication of personal data for ensuring effective protection of copyrights falls, by its very object, within the scope of the IPRED. The CJEU already held

that Article 8(3) IPRED in conjunction with Article 15(1) of Directive 2002/58/EC do not preclude Member States, inter alia, from imposing an obligation to disclose to private persons personal data in order to enable them to bring civil proceedings for copyright infringements<sup>19</sup>. In the present case, the Member State concerned (Sweden), did make use of such possibility and provided for such obligation in its national law.

In this regard, the CJEU noted that the national legislation requires for an order for the disclosure of personal data that there must be, inter alia, clear evidence of an infringement of an IPR, that the information can be regarded as facilitating the investigation into an infringement and that the reasons for the measure outweigh the nuisance or other harm that the measure may entail for the person affected by it. The CJEU went on to conclude that national legislation must enable national courts to weigh the conflicting interests involved and to take due account of the requirements of the principle of proportionality. Such legislation must ensure a fair balance between the protection of IPRs enjoyed by the copyright holders and the protection of personal data enjoyed by internet subscribers or users.

The CJEU therefore ruled, **first**, that Directive 2006/24/EC must be interpreted as not precluding the application of national legislation based on Article 8 IPRED, which permits an ISP in civil proceedings to provide information on the subscriber, **second**, that it is irrelevant that the Member State has not yet transposed Directive 2006/24/EC, and, third, that Directive 2002/58/EC and the IPRED must be interpreted as not precluding national legislation from ordering disclosure of personal data, provided such legislation allows to weigh the conflicting interests involved and takes into account the requirements of the principle of proportionality.

#### D. C-580/13 COTY GERMANY

Coty Germany was the exclusive licensee for the European Union trade mark 'DAVIDOFF HOT WATER' for perfumery. In 2011, Coty Germany purchased a counterfeited bottle of perfume bearing the DAVIDOFF HOT WATER trade mark on an internet auction-platform by paying the amount corresponding to the price of the perfume into a bank account opened with the Stadtparkasse bank. After finding that it had purchased a counterfeit product, Coty Germany asked that auction platform to provide it with the real name of the holder of the account of that platform from which the perfume had been sold to it. The person whose name was provided by the auction platform only admitted to be the bank account holder but claimed not to be the seller and refused to provide further information. Coty Germany contacted the Stadtparkasse to ask, on the basis of Paragraph 19(2) MarkenG (German Trade Mark Act)<sup>20</sup>, for the name and address of the holder of the bank account into which it had paid the amount corresponding to the price of the counterfeit goods purchased. The Stadtparkasse, invoking banking secrecy, refused the request of Coty Germany to provide the name and address of the bank account holder. Coty Germany brought an action before the Regional Court Magdeburg (Germany), which ordered the Stadtparkasse to provide the requested information. The Higher Regional Court Nauenburg (Germany) upheld the appeal of the Stadtparkasse holding that the Stadtparkasse was entitled to refuse providing the requested information.

<sup>19</sup> See *Promusicae* and *LSG-Gesellschaft zur Wahrnehmung von Leistungsschutzrechten*.

<sup>20</sup> Gesetz über den Schutz von Marken und sonstigen Kennzeichen (German Trade Mark Act) from 1994.

Coty Germany filed an appeal to the Federal Court of Justice (Germany), which made a reference to the CJEU asking in essence whether Article 8(3)(e) IPRED must be interpreted as precluding a national provision, which, in a case such as that in the main proceedings, allows a banking institution to invoke banking secrecy in order to refuse to provide, pursuant to Article 8(1)(c) IPRED, information concerning the name and address of an account holder.

According to the CJEU the national provision at issue, which allows a banking institution an unlimited and unconditional authorisation to invoke banking secrecy, is liable to frustrate the right to information recognised in Article 8(1) IPRED and is therefore such as to seriously infringe the fundamental right to an effective remedy and, ultimately, the fundamental right to intellectual property, enjoyed by the holders of those rights, and that it does not, therefore, comply with the requirements to ensure a fair balance between the various fundamental rights weighed up in Article 8 IPRED. The CJEU went on to conclude that it is, however, for the referring court to determine whether there were, under German law, any other means of remedies, which would allow the competent judicial authorities to order that the necessary information be provided. The CJEU therefore ruled that Article 8(3)(e) IPRED must be interpreted as precluding a national provision, such as that at issue in the main proceedings, which allows, in an unlimited and unconditional manner, a banking institution to invoke banking secrecy in order to refuse to provide, pursuant to Article 8(1)(c) IPRED, information concerning the name and address of an account holder.

## E. C-427/15 NEW WAVE CZ

New Wave initially sued Alltoys for using the ‘MegaBabe’ mark without New Wave’s consent. The national court granted an injunction against further infringement, but did not allow New Wave to amend its application for the purpose of requesting Alltoys to provide all information relating to the goods concerned. New Wave brought a new action before the City Court, Prague (Czech Republic) seeking an order for Alltoys to communicate to it all information on the origin and distribution network of the infringing goods. The City Court, Prague dismissed the claim based on the findings that the right of information could not be submitted independently from an infringement claim. New Wave filed an appeal, which was upheld by the Court of Appeal, Prague.

Finally, Alltoys filed an appeal to the Supreme Court, Czech Republic, which decided to stay the proceedings and to make a reference to the CJEU asking whether Article 8(1) IPRED must be interpreted as applying to a situation in which, after the definitive termination of proceedings in which it was held that an IPR was infringed, the applicant in separate proceedings seeks information on the origin and distribution networks of the goods or services by which that IPR is infringed?

The CJEU noted, **first**, that for the purpose of interpreting a provision of EU law, it is necessary to consider not only its wording but also the context in which it occurs and the objectives pursued by the rules of which it is part. According to the CJEU, the wording of Article 8(1) IPRED does not exclude coverage of separate proceedings, such as proceedings initiated after the definitive termination of proceedings in which it was held that an IPR was infringed. **Secondly**, the CJEU concluded that it is apparent from the wording of Article 8(1) IPRED that the obligation to provide information is directed not only at the infringer of the IPRs in question but also at third parties who are not necessarily parties to the proceedings. **Thirdly**, the CJEU recalled that the right of information provided for in Article 8(1) IPRED is



a specific expression of the fundamental right to an effective remedy guaranteed in Article 47 of the Charter of Fundamental Rights of the European Union and thereby ensures the effective exercise of the fundamental right to property. Without full knowledge of the extent of the infringement, the rights holder would not be in a position to determine or calculate the damages he or she was entitled to by reason of the infringement.

The CJEU ruled that Article 8(1) IPRED must be interpreted as applying to a situation, in which, after the definitive termination of proceedings in which it was held that an IPR was infringed, the applicant in separate proceedings seeks information on the origin and distribution networks of the goods or services by which that IPR is infringed.

## IV. NATIONAL CASE-LAW

### A. AUSTRIA

#### 1. OBERSTER GERICHTSHOF 4 OB 170/15A

The claimant is the owner of several European trade marks registered, among other goods, for 'perfumes'. The claimant runs a selective distribution system, in which it obliges its distribution partners to only sell its products within that distribution system. The defendant, who does not belong to the selective distribution system of the claimant, operates a network of shops in Austria. The defendant sells perfumes from the claimant, which it purchases from an unknown source based within the EU. The claimant brought an action to the court of first instance requesting the defendant to stop the illegal activity, remove the infringing goods and to provide information. The action was partially upheld by the court, but dismissed, *inter alia*, as far as the claimant requested the disclosure of specific information. The appellat court dismissed the appeal filed by the claimant and confirmed the decision of the lower instance court.

The claimant went on and filed an appeal to the Supreme Court requesting the court to order the defendant to disclose its suppliers. The Supreme Court dismissed the action.

The Supreme Court found that the claim of information exists, in general, also for cases of prohibited parallel imports. According to Section 55a MSchG (Austrian Trade Mark Act)<sup>21</sup> and Article 8(1) IPRED, the right of information exists subject to the existence of a trade mark infringement and subject to proportionality. While the Supreme Court acknowledged the existence of a trade mark infringement in the present case, it considered the right of information of the claimant to be outbalanced by the interest of the defendant to keep its source (supplier) confidential.

In balancing the right of information of the claimant and the interest of the defendant to keep its source confidential, the court concluded that the assessment of proportionality requires an overall assessment of the interests of both, the trade mark owner, as well as the infringer. While the Supreme Court went on to find that in cases of a trade mark infringement the interest of the trade mark owner would mostly prevail, it concluded that, in the present case, the interest of the defendant not to disclose its source prevails. The Supreme Court was of the opinion that the disclosure of the source (supplier) would enable the claimant to prevent the supplier from delivering genuine products to third parties, thus causing the risk of a market foreclosure. In such a scenario the claimant would have to prove that the products in question were not intended for the EU market. Apart from the risk of market foreclosure, the Supreme Court took into account the fact that the claimant could have obliged (contractually) its distributors outside the EU not to sell the products back into the EU and to provide information as to whom they sell. Thus, the claimant does not have to rely solely on its right of information. Furthermore, the defendant could not know, due to the labelling of the products, where the products have been put on the market the first time (e.g. in- or

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<sup>21</sup> Markenschutzgesetz (Austrian Trade Mark Act) from 1970.



outside the EU). Considering all the circumstances of the case, the Supreme Court found the right of information to be disproportionate compared to the seriousness of the infringement.

## 2. OBERSTER GERICHTSHOF 4 OB 41/09X

The claimant is a collecting society. It enforces (as a trustee) the rights of music producers and music artists in Austria. The defendant is an internet access provider, which assigns IP addresses to its clients. In order to be able to bring civil proceedings against users of unauthorised file-sharing systems, the claimant brought an action before the Commercial Court requesting the defendant to provide the names and addresses of its clients to whom it had provided an internet access service and whose IP addresses were known to be involved in unauthorised file-sharing activities. The Commercial Court upheld the claims of the claimant. This decision was affirmed by the Higher Regional Court.

The defendant filed an appeal to the Supreme Court. The Supreme Court decided to stay the proceedings and to request a preliminary ruling from the Court of Justice. The Supreme Court asked, *inter alia*, whether Article 8(3) IPRED, regard being had to Article 6 and Article 15 of Directive 2002/58/EC, had to be interpreted (restrictively) as not permitting the disclosure of personal traffic data to private third parties for the purposes of civil proceedings for alleged infringements of exclusive rights protected by copyright.

The Court of Justice found (C-557/07) that Article 8(3) IPRED, read in conjunction with Article 15(1) of Directive 2002/58/EC — does not preclude Member States from imposing an obligation to disclose to private third parties personal data relating to internet traffic in order to enable them to bring civil proceedings for copyright infringements. European Union law nevertheless requires Member States to ensure that, when transposing Directives 2000/31/EC, 2001/29/EC, 2002/58/EC and the IPRED into national law, they rely on an interpretation of those directives, which allows a fair balance to be struck between the various fundamental rights involved. Moreover, when applying the measures transposing those directives, the authorities and courts of Member States must not only interpret their national law in a manner consistent with those directives, but must also make sure that they do not rely on an interpretation of those directives, which would conflict with those fundamental rights or with the other general principles of European Union law, such as the principle of proportionality.

The Supreme Court upheld the appeal, dismissing the claims to provide the names and addresses of the defendant's clients.

The Supreme Court found that the current national legislation prevents the defendant from legally storing traffic data. Such traffic data, however, would have to be processed in order to identify the names and addresses of the persons in question. Thus, the requested information could be only obtained by means of an illegal processing of traffic data, which cannot be requested from the defendant. The Supreme Court, therefore, came to the conclusion that the claims based on Section 87(b)(3) UrhG (Austrian Copyright Act)<sup>22</sup> had to fail as the requested information could be obtained only by means of an illegal processing of traffic data.

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<sup>22</sup> Urheberrechtsgesetz (Austrian Copyright Act) from 1936.

The Supreme Court acknowledged that Section 87(b)(3) UrhG provides for a civil right of information in general. It underlined that the conflicting fundamental rights at stake, namely that the right of the creator to enforce its exclusive rights and the right of persons to have their personal data protected, have to be balanced. However, due to the lack of national legislation to allow the processing of traffic data, the claims for information were dismissed, without the need to enter into a balancing of fundamental rights.

## B. BELGIUM

### 1. TRIBUNAL DE COMMERCE DE BRUXELLES 12-05787

The claimant, a car manufacturer, brought an action against the companies X, Y and Z for infringement of its designs, trade marks and copyright relating to several types of wheel rims.

The tribunal held that the defendants must destroy all the counterfeited rims and logos in their possession and provide proof of this to the claimant. It also ordered the communication of the exact number of rims commercialised, offered to sell, put on the market, sold, imported, exported, stocked or used in the EU, as well as the complete contact details of each provider, distribution channels and any other information such as the purchase and resale price of each wheel rim. While the right of information was apparently granted, the tribunal did not enter into an explanation of the balancing of the different rights at stake.

## C. FRANCE

### 1. COUR DE CASSATION 10-28088

The trade mark owner Y sued X and Z, a sports goods manufacturer and its retail organisation, for infringement of trade mark rights and unfair competition. The claimant requested the 'juge de la mise en état' (Pre-Trial Judge) to order the defendants to produce various accounting records on the basis of Article L.716-7-1 CPI (French Intellectual Property Code)<sup>23</sup>. The judge granted this request.

The defendants filed a 'nullity appeal' against the order. The appeal was declared inadmissible by the court of appeal. The defendants therefore appealed to the court of cassation on the ground that the judge exceeded its powers because the production of the accounting documents did not make it possible to determine the origin and the distribution networks of the products under investigation. In order to pronounce such a measure the judge must first establish the counterfeiting. Furthermore, the defendants claimed that by ordering the production of the accounting documents before deciding on the counterfeiting the judge disregarded the principle of proportionality. According to the defendants, the order is a disproportionate breach of confidentiality, an essential component of the right to privacy; it is an infringement of the right to the peaceful enjoyment of its possessions and disproportionate in nature, and

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<sup>23</sup> Code la Propriété Intellectuelle (French Intellectual Property Code) from 1992.

finally it is an infringement of the right to a fair trial. Furthermore, the defendant claims the existence of a legitimate impediment.

The court found that Article L.716-7-1 CPI allows the ‘juge de la mise en état’ to order the measures it foresees before any decision on the materiality of the infringement is taken. The judge did not commit any excess of power and the appeal is therefore not admissible. The court did not provide additional information as regards its considerations while striking the balance between the rights at stake.

## 2. TRIBUNAL DE GRANDE INSTANCE DE PARIS 14-09412

The claimant is the owner of the French trade mark ‘SWEET PANTS’ for ‘clothing, footwear and headgear’ in Class 25. In 2012 it launched a collection of jogging pants under the trade mark ‘SWEET PANTS’. The defendant sent an advertisement to retailers by email in July 2013 entitled ‘ONLY PROMOS SPECIALES SOLDES + SWEATS PANTS EXCLU’ promoting models of jogging pants referred to as ‘SWEATS PANTS’.

The claimant brought an action against the defendant for trade mark infringement in order to obtain, inter alia, the list and number of recipients of the email, and the quantity produced, commercialised, delivered, received or ordered as well as the price of the jogging pants.

The defendant requested that the applications be rejected because they are premature and disproportionate in that they seek to remedy the claimant’s failure to prove damage. Second, it argues that the communication of the recipients of the emails would cause the defendant considerable harm as it would imply disclosing the contact details of some of its distributors, which is confidential information covered by trade secret.

The court found that the request for information is neither premature nor disproportionate as the claimant presents serious means of evidence in support of its claims. However, the communication of the recipients of the disputed emails, which would reveal to the plaintiff important information regarding the clientele of the defendant, constitutes a breach of trade secret, which would be disproportionate. Accordingly, the tribunal ordered the communication of the information requested, with the exception of the list of recipients of the disputed emails.

The court balanced the different rights at stake by limiting the right of information of the plaintiff in order to ensure that there is no disproportionate violation of the trade secrets of the defendant. In order to achieve a balance between the right of information and the right of protection of trade secrets, the judge determines whether the request for some type of information is ‘disproportionate’.



## D. GERMANY

### 1. BUNDESGERICHTSHOF I ZB 13/12

The claimant, a software company, holds the exclusive copyright to the computer game ‘Two Worlds II’ in Germany, Austria and Switzerland. The claimant was informed by a German company it had contracted, that several users had offered its software online — in exchange forums to other users for downloading. The respective IP addresses had been attributed to these users by X, also a party to the proceedings, in its capacity as internet service provider. The claimant requested, according to Section 101, para. 9 UhrG (Copyright Act)<sup>24</sup>, in combination with Section 101, para. 2, 1st sentence No 3 UhrG, to allow X, using the data gathered according to Section 3 No 30 TKG (Telecommunications Act)<sup>25</sup>, to provide information about the names and the addresses of those users who had been in possession of the respective IP addresses at the time of the infringement. The claimant brought an action to the court of first instance requesting an order to allow the divulgence of this information, but its action was dismissed. The appellant court dismissed the appeal filed by the claimant and confirmed the decision of the lower instance.

The claimant filed an appeal to the Supreme Court requesting an order to X to disclose the relevant data. The Supreme Court upheld the action. It ruled that Section 101 UhrG grants the claimant a right to request information not only concerning the infringers but also concerning third parties. In cases of obvious infringements, or in cases where the holder of the infringed rights is suing the infringer, such a right to request information exists also concerning third parties, who rendered the business services used to commit the infringements, unless the third party is entitled to refuse to give evidence according to Sections 383-385 ZPO (Code of Civil Procedure)<sup>26</sup>. If the requested information can be supplied only by using data according to Section 3 No 30 TKG, a judicial order according to Section 101, para. 9 UhrG act is required. Section 101, para. 2.1, sentence No 3 UhrG does not require infringements occurring on a commercial basis.

The Supreme Court acknowledged the request to allow the third party (X) to transmit the information according to Section 3 No 30 TKG and to inform the claimant about the names and the addresses of the users having used the relevant IP addresses at the relevant point in time.

In balancing the right of information of the claimant and the interest to keep third party data confidential, the court concluded that the assessment of proportionality requires an overall assessment of the interests of all parties involved. The violation of the rights of the claimant is obvious to such an extent that it seems unlikely that the parties involved would suffer unjustified damage. The right to be informed also is a proportionate measure, and in the case in question nobody submitted that the claimant requesting the information would not have any or only little interest in knowing the authors of the infringements. The request of the claimant seems, taking into consideration the rights of the concerned owner obliged to provide the information and the rights of the concerned infringers and also taking into account the principle of proportionality, to be justified without any further considerations.

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<sup>24</sup> Urheberrechtsgesetz (German Copyright Act) from 1965.

<sup>25</sup> Telekommunikationsgesetz (German Telecommunication Act) from 2004.

<sup>26</sup> Zivilprozessordnung (German Code of Civil Procedure) from 1950.

## 2. BUNDESGERICHTSHOF I ZR 51/12

In January 2011, a seller offered on an internet auction platform the perfume 'Davidoff Hot Water'. Payments had to be made into a bank account managed by the defendant, a bank. The plaintiff holds the exclusive licence rights of the registered European Union trade mark 'Davidoff Hot Water'. The plaintiff bought the perfume that was obviously fake. The owner of the auction platform identified the seller as S.F. in M town. According to an analysis made, from December 2010 to January 2011 the turnover on this platform reached about EUR 11 000. According to the plaintiff, S.F. claimed not to be the seller and invoked its right to refuse to give evidence. The plaintiff then requested information of the defendant concerning the name and the address of the owner of the bank account managed by it. The plaintiff won at first instance and after losing at second instance brought the case before the Federal Court of Justice.

The Federal Court of Justice ruled that the plaintiff has according to Section 19(2) 1st sentence No 3, (3) No 1 MarkenG (Trade Mark Act)<sup>27</sup> a rightful claim against the defendant to be informed about the name and the address of the owner of the bank account where the transactions concerning the faked perfume goods were made.

Even if the defendant enjoys, according to Section 19(2) sentence 1, 2nd. part MarkenG together with Sections 383 to 385 ZPO, a right to refuse to give evidence, this does not exclude the right of the plaintiff to be informed about the name and the address of the owner of the bank account where the transactions concerning the faked perfume goods were made. In the case at hand, the fundamental right for protection of intellectual property and effective judicial proceedings of the plaintiff collide with the fundamental right of protection of personal data of clients of the defendant according to Article 8 of the Charter of Fundamental Rights and its right to freely exercise its profession according to Article 15 of the Charter of Fundamental Rights.

In a preliminary ruling requested to the CJEU by this court, the CJEU held (C-580/13, of 16 July 2015 — Coty Germany/Sparkasse Magdeburg) that Article 8 (3)(e) IPRED prevents national law from allowing the defendant bank to refuse to inform about the name and address of the owner of a bank account managed by it. The German Federal Court of Justice decided accordingly that the defendant is not entitled to always refuse this information if the account was used in connection with an obvious violation of trade mark rights.

The German Federal Court of Justice emphasised that the data requested from the defendant could possibly be obtained by other means or from a different source, other than from the banking institution, namely by means of, criminal proceedings against an unknown person. Obtaining the name of the alleged infringer by means of that route, does not preclude the right according to Section 19 (2) 1, sentence No 3 MarkenG. To require the rights holder to take recourse to criminal proceedings is not compatible with its fundamental right to effective remedy before a tribunal according to Article 47 of the Charter of Fundamental Rights. The defendant, therefore, does not enjoy an unconditional right to always refuse information according to Section 383 (1) No 6 ZPO as this would result in unlawfully impeding the fundamental right of effective judicial remedy and the protection of IPRs.

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<sup>27</sup> Gesetz über den Schutz von Marken und sonstigen Kennzeichen (German Trade Mark Act) from 1994.

## E. GREECE

### 1. COURT OF FIRST INSTANCE ATHENS 1563/2013

The claimant owns several trade marks registered at national and EU level concerning parts and components of motorcycles. The claimant uses its own representatives to distribute the products in Greece. The claimant claims infringement of its trade marks by the defendant selling original products without its consent. The Court of first instance issued a preliminary ruling, obliging the defendant to provide all the relevant information regarding the distribution networks. The court found that the claim to information prevails. It has acknowledged the existence of trademark infringement and considered that the right of information of the claimant prevails over the right to privacy.

The court applied the proportionality principle (case C-491/01 'British American Tobacco (Investments) and Imperial Tobacco'), and referred to Article 3 IPRED, which states that measures, procedures and remedies must also be effective, proportionate and dissuasive and must be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

## F. POLAND

### 1. COURT OF APPEAL BIALYSTOK I ACZ 114/13

The claim under Article 80 of the Copyright Act, which regulates the principles of preservation of evidence and providing of information in copyright infringement cases, was applied to disclose personal data for the purposes of future civil proceedings. The applicant intended to claim the author's economic rights to audiovisual works, which were shared without his permission by internet users whose IP addresses were attached to the application.

On the basis of Article 80.1.3.c of the Copyright Act, a person that owns the author's economic rights to audiovisual works can ask an internet service provider to reveal the personal data of users (name and surname and residential address) that, as part of an online peer-to-peer file sharing and distribution network, provide access to copyright protected audiovisual works to other users.

The principle of proportionality, stated in Article 8 IPRED, was incorporated in Article 80.1.3 of the Copyright Act. This means that the court decides whether to provide information and to what extent. The court considers the scale and importance of the infringement of the author's economic rights, taking into account the purpose of profit making.

The right of information, provided in Article 8 IPRED, is based on the principle of proportionality. It is indicated that: (1) the claimant's request for information must be proportionate, and (2) the information on the origin and distribution networks of the goods and services is provided only if it is appropriate. The principle of proportionality expresses the idea of taking only such actions that are necessary to achieve an objective and those that are adequate in certain circumstances. The actions taken should limit the rights of other entities to the smallest extent, which corresponds to the provision of Article 730, para. 3 of the Code of Civil Procedure. While choosing the method of the protection, the court takes into account

the interests of the parties or participants in the proceedings to the extent that entitled persons receive legal protection.

It is necessary to consider whether in certain circumstances the objective of protection of IPRs justifies the limitation of the protection of personal data of the persons allegedly infringing those rights. The guidelines for the interpretation of rules on the application of the principle of proportionality are provided in the preamble of IPRED. Recital 14 of the IPRED points out that the measures envisaged in Article 8(1) IPRED only apply to acts carried out on a commercial scale. The justification for this is the fact that commercial acts aim to gain direct or indirect economic profit on a large scale and consequently infringe the economic rights of the authors.

Recital 17 of the IPRED states that the intentional or unintentional nature of the infringement should be also taken into account when applying the measures provided by this Directive. Given the limited ability to process (disclose) personal data, it is considered that, under Articles 8(1) and (2) IPRED, providing information on the personal data of an alleged copyright infringer is proportionate when the infringement is made for commercial purposes. In other cases, the specific nature of each case and the extent of the infringement should be taken into account.

In the view of the Court of Appeal, this argumentation takes into account the purpose of the IPRED and is consistent with the principles of interpretation of the preamble of this Directive, which neither can lead to derogations from the rules contained therein nor to determine the meaning in a manner that is obviously contradictory to the rules (C-134/08, C-162/97, C-308/97, C-136/04).

The court referred to the decision of the CJEU, which stated that Community law, particularly Article 8(3) IPRED, in relation with Article 15.1 of Directive 2002/58/EC, does not preclude the Member States from obligation to provide data to private third parties to enable them to bring infringement proceedings in civil cases. The court stated that Member States are not obliged to do it, and in the event of the protection of IPRs, it should be remembered that the application of this measure is based on interpretation of directives that allow a fair balance between fundamental rights that may exist in the present case, that is, the right to protection of personal data and right to effective protection of authors' economic rights (Case C-275/06, Case C-557/07).

The information about the 'distribution networks' (Article 80.1.3 of the Copyright Act) includes, as indicated in Article 8(2)(a) IPRED, data on persons distributing goods and services. Thus, it is generally justified to require the disclosure of personal data of users distributing, in peer-to-peer systems, copyright protected works, in order to bring a proper action against them.

The concept of 'distribution networks' in business trading includes a group of entities cooperating with each other in the delivery of goods and services. It should be recognised that the distribution network is composed of entities involved in the distribution of copyright protected content. The basic information about 'distribution networks' is the information about the entities that create them. Consequently, there is no justified basis to assume that the data covered by this information does not include data on entities violating authors' economic rights. That makes it possible to effectively enforce IPRs.

## 2. PROVINCIAL COURT KRAKÓW IX GCO 41/14

The applicant claimed author's economic rights to a geometrised image used on t-shirts and brought an action based on Articles 79.1 and 80.1.2 of the Copyright Act. The applicant requested information about the production, sale and purchase of the abovementioned t-shirts and asked to provide documentation as regards the production.

The court found that Article 80 of the Copyright Act allows the application of the right of information before bringing an infringement claim, and granted injunctive relief accordingly.

## G. PORTUGAL

### 1. TRIBUNAL DA RELAÇÃO DE LISBOA 1287/09.9TYLSB-A.L1-1

The applicant is the owner of two European Union trade marks registered for goods in Class 18. The products 'C' were commercialised under these trade marks in Portugal and Belgium through the Belgian Society 'D1' and Portuguese Society 'E' Lda. The defendant commercialised original backpacks in Portuguese supermarkets under the applicant's trade marks 'C'. The applicant requested an interlocutory injunction before the 4th Chamber of Commerce of Lisbon '4 Juízo do Tribunal de Comércio de Lisboa'.

The 4th Chamber of Commerce of Lisbon rejected the applicant's interlocutory injunction. According to the Court, the absence of consent of the defendant using its mark on the market was not sufficiently proved.

The applicant appealed before the Lisbon Court of Appeal 'Tribunal da Relação de Lisboa'. The interlocutory injunction contained a request for, inter alia, the seizure of all the defendant's products reproducing the registered mark in the market; the definitive removal from the distribution channels in the Portuguese market; the destruction of the contested infringement products and the request for information on the origin and distribution networks of the goods that infringe the earlier trade mark, in other words Article 8 IPRED.

The Lisbon Court of Appeal rejected the appeal. According to the Court, it was not proven that the defendant acted without the trade mark owner's consent. The Appeal Court of Lisbon confirmed the first instance decision and rejected the interlocutory injunction. According to this, the applicant did not present enough evidence of the supposed infringement act pursuant to Articles 338-H, 338-C CPI<sup>28</sup> (Portuguese Industrial Property Act). Therefore, the requested information on the origin and distribution networks of the contested goods was not sufficiently justified.

The Appeal Court of Lisbon stated that the interlocutory injunction was unfounded regarding the proofs submitted by the applicant, which did not prove that the defendant acted on the distribution of the contested products without its consent. Therefore, the request for information on the distribution and

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<sup>28</sup> Código da Propriedade Industrial (Portuguese Industrial Property Act) from 1995.



origin should be disregarded. The decision does not contain an explicit balancing between the right of property, right of information and right of privacy.

## H. SPAIN

### 1. TRIBUNAL SUPREMO SALA DE LO CONTENCIOSO 6153/2011

The claimant is a trade association that represents music producers from Spain. In recent years it attempted to obtain from several telecommunication operators, personal data of users connected with P2P networks through IP addresses in order to defend the IPRs of its members.

The action was brought against the Spanish Agency for Data Protection<sup>29</sup> before the Administrative Chamber of the National High Court<sup>30</sup> with the aim of getting an exemption set out in the Article 5(5) of the Data Protection Act<sup>31</sup> that allows the claimant to obtain personal data of users (IP address), without giving the required prior information to such users, pursuing the initiation of legal proceedings against them. The Administrative Chamber of the National High Court dismissed the action.

The claimant appealed before the Administrative Chamber of the Supreme Court<sup>32</sup>, which also dismissed the action. The Supreme Court found that when applying an exemption to a legal rule, it has to be done correctly; otherwise data processing without the consent of the data subject is not compatible with data protection as a fundamental right.

The claimant argues that several legal precepts<sup>33</sup> allowing the data processing without the user's consent can be found indirectly in the Intellectual Property Act after the implementation of the IPRED in the national law of Spain. The claimant claims that data processing is an essential condition to be able to initiate successful judicial proceedings in defence of its rights holder's interest. However, the Supreme Court concluded that none of those legal provisions held by the claimant contain any express reference to the exemption of the prior information to the data subjects. The court found that any limitation of the fundamental right to data protection should be based on a legal provision with constitutional justification, meeting the requirements of proportionality, accuracy and legal certainty, with an express and accurate reference to all the possible scenarios where the exemption can be applied.

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<sup>29</sup> Asociación Española de Protección de Datos, AEPD (Spanish Agency for Data Protection).

<sup>30</sup> Sala de lo Contencioso Administrativo de la Audiencia Nacional (Administrative Chamber of the National High Court).

<sup>31</sup> Ley orgánica de protección de datos (Spanish Data Protection Law) from 1999.

<sup>32</sup> Sala de lo Contencioso del Tribunal Supremo de Justicia (Administrative Chamber of the Supreme Court).

<sup>33</sup> Articles 138.3, 139.1.h) and 141.6 of Intellectual Property Act. Those Articles were referred to the content of Article 8 IPRED when the directive was implemented into national law.

## I. UNITED KINGDOM

### 1. INTELLECTUAL PROPERTY ENTERPRISE COURT CC13P03341

The claimant X sued the defendant Y for passing off and trade mark infringement. The infringement was admitted. The key issue before the court was whether to grant an injunction to the claimant forcing the defendant to disclose the names and addresses of its suppliers of the infringing goods.

The judge decided not to grant the injunction because the defendant could suffer irreparable harm. Y's company secretary gave written evidence that the retail industry is a small and close knit community and if Y were ordered to make disclosure of its suppliers there would be a complete lack of trust in Y. Its reputation would be severely undermined in the eyes of its suppliers who would be concerned about future disclosures by Y. Y's business might well suffer irreparable harm if disclosure is ordered. Resentful suppliers could find themselves subject to investigations on behalf of X to see if they had any involvement with the infringing products and may risk litigation, justified or otherwise.

The decision did not seek to strike a balance between the fundamental rights and the right of information. The decision was made on the basis of the risk of irreparable harm, which is one of the factors that must be taken into account when issuing what is known in the UK (and Ireland) as a *Norwich Pharmaceutical* order.

## V. ANNEXES

### ANNEX I: SUMMARY

#### 1. CASE-LAW SUMMARY ON THE BALANCE BETWEEN THE RIGHT OF INFORMATION AND FUNDAMENTAL RIGHTS IN THE EU

The following table provides a brief summary of each case analysed by outlining the following points: 1) main conclusion(s)/outcome, e.g. are courts obliged to grant access to information in the event of IP infringements?; 2) exceptions and reasoning (when applicable); 3) application of the principle of proportionality (when applicable), which is essential in balancing the divergent interests of the parties involved.

| CASE-LAW OF THE CJEU         |   |  |  |
|------------------------------|---|--|--|
| CASE                         | MAIN CONCLUSION(S)/OUTCOME  | EXCEPTION(S)   | PROPORTIONALITY  |
| C-275/06<br>Promusicae       | Directives do not require the MS to lay down an obligation to communicate personal data in order to ensure effective protection of copyright in the context of civil proceedings. However, Community law requires that, when transposing those Directives, the MS take care to rely on an interpretation of them which allows a fair balance to be struck between the various fundamental rights.   | Exceptions do not relate to the bringing of civil proceedings.                                     | Interpretation of national law should not be in conflict with general principles of Community law, such as the principle of proportionality.                                 |
| C-557/07<br>LSG-Gesellschaft | Community law neither requires nor prohibits an order requiring an internet access provider to disclose – in the context of civil proceedings – the personal data of its users for the purpose of effective enforcement of copyright. It leaves the MS with the necessary discretion in reconciling various fundamental rights.   | No exceptions are provided for internet access providers. They must be regarded as intermediaries. | The principle of proportionality must be respected when interpreting Directives.   |
| C-461/10<br>Bonnier          | Communication of personal data, in civil proceedings, in order to obtain a declaration that there was an infringement of intellectual property rights falls outside of the scope of the Data Retention Directive (Directive 2006/24), which deals exclusively with the handling and retention of data for the purpose of the investigation, detection and prosecution of serious crime and their communication to the competent national authorities. National legislation is free to lay down an obligation to communicate personal data to private persons in civil proceedings as long as it is furnished with sufficient safeguards to weigh the conflicting interests involved (namely, the protection of intellectual property rights and the protection of personal data of internet subscribers). |  | When dealing with an application for an order for disclosure of personal data national courts must take due account of the requirements of the principle of proportionality. |
| C-580/13<br>Coty Germany     | IPRED prohibits unlimited and unconditional authorisation to invoke banking secrecy as a ground for refusal to provide information concerning the name and address of account holders allegedly involved in trade mark infringement. Such authorisation would not allow   |  | National provisions, which allow for an unlimited and unconditional authorisation to invoke banking secrecy, do not comply with the  |

|                         |  |  |  |
|-------------------------|--|--|--|
|                         | the specific characteristics of each intellectual property right to be taken into account or, where appropriate, the intentional or unintentional character of the infringement.   |  | requirement to ensure a fair balance between various fundamental rights weighed up in Article 8 IPRED. |
| C-427/15<br>New Wave CZ | IPRED applies to a situation in which information about the origin and distribution networks of infringing goods or services is sought in separate proceedings, initiated after the definitive termination of proceedings in which the infringement was found. |  |  |

| NATIONAL CASE-LAW   |  |   |   |
|---|--|---|---|
| CASE  | MAIN CONCLUSION(S) / OUTCOME   | EXCEPTION(S)  | PROPORTIONALITY   |
| Oberster Gerichtshof<br>4 Ob 170/15a (Austria)                  | The interest of the defendant not to disclose its source (supplier) prevailed over the interest of the trade mark owner to obtain further information.                                     | The interest not to disclose the source (supplier) prevails when: i) the disclosure would enable the claimant to prevent the supplier from delivering genuine products to third parties, thus causing market foreclosure; ii) the claimant could oblige (contractually) its distributors outside of the EU not to sell the products back to the EU and to provide information about who they sell to. | The assessment of proportionality requires an overall assessment of the interests of both the trade mark owner and the infringer. As the claimant did not have to rely on its right to information, the interest of the defendant prevails. |
| Oberster Gerichtshof<br>4 Ob 41/09x<br>(Austria)                | The claim for personal information was dismissed due to the lack of national legislation to allow the processing of traffic data.  |   | No need for balancing exercise.   |
| Tribunal de commerce de<br>Bruxelles<br>12-05787<br>(Belgium)   | The defendants were ordered to reveal information on the origin and distribution networks of infringing goods.   |   |   |
| Cour de Cassation 10-<br>28088<br>(France)                      | The defendants were ordered to produce various accounting records during the infringement proceedings.   |   |   |
| Tribunal de Grande<br>Instance de Paris<br>14-09412<br>(France) | The defendant in the infringement proceedings was ordered to reveal various information on infringing goods, but not the list of its customers, which was considered to be a trade secret. | Information regarding the clientele may be exempt from communication.   | In order to achieve a balance between the right of information and the right of protection of trade secrets, the judge determines whether the request for some type of information is 'disproportionate'.                                   |
| Bundesgerichtshof I ZB<br>13/12<br>(Germany)                    | The claimant was granted a right to request personal information concerning direct infringers and third parties involved in the infringement.  |   | The assessment of proportionality requires an overall assessment of the interests of all parties involved. Obviousness of the infringement and the degree of the rights holder's interest in the relevant information matters.              |

|   |  |   |   |
|---|--|---|---|
| <p>Bundesgerichtshof I ZR 51/12<br/>(Germany)</p>                             | <p>The plaintiff was granted a right to be informed about the name and the address of the owner of the bank account where the transactions concerning infringing goods were made.</p>  | <p>The defendant is not entitled to refuse information on the bank account if it was used in connection with an obvious violation of trade mark rights.</p> | <p>To require the rights holder to take recourse to criminal proceedings in order to obtain necessary personal data is not compatible with its fundamental right to effective judicial remedy and the protection of IPRs. Furthermore, an unconditional right (banking secrecy) to always refuse information is unlawfully impeding the fundamental right of effective judicial remedy.</p> |
| <p>Court of First Instance Athens 1563/2013<br/>(Greece)</p>                  | <p>The claim to information concerning distribution networks prevailed over the right to privacy.</p>  |   | <p>Measures, procedures and remedies must also be effective, proportionate and dissuasive and must be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.</p>  |
| <p>Court of Appeal Białystok I ACz 114/13<br/>(Poland)</p>                    | <p>An internet service provider was ordered to reveal names and residential addresses of its users, allegedly involved in online peer-to-peer file sharing and distribution networks, which provided access to copyright protected audio-visual works.</p> |   | <p>The court applied the principle of proportionality by ordering the disclosure of information to the extent that was necessary and adequate to achieve an objective protection of IPRs.</p>   |
| <p>Provincial Court Kraków IX GCo 41/14<br/>(Poland)</p>                      | <p>An injunctive relief was granted based on the provision of the Copyright Act, which allowed the application of the right of information before bringing an infringement claim.</p>  |   |   |
| <p>Tribunal da Relação de Lisboa 1287/09.9TYLSB A.L1 1<br/>(Portugal)</p>     | <p>The request for information on the origin and distribution networks of the contested goods was rejected as not being sufficiently justified.</p>  |   |   |
| <p>Tribunal Supremo Sala de lo Contencioso 6153/2011<br/>(Spain)</p>          | <p>The claim to obtain users' personal data, without providing the required prior information to such users, was rejected.</p>   |   | <p>The court found that any limitation of the fundamental right to data protection should be based on a legal provision with constitutional justification, meeting the requirements of proportionality, accuracy and legal certainty, with an express and accurate reference to all the possible scenarios where the exemption can be applied.</p>  |
| <p>Intellectual Property Enterprise Court CC13P03341<br/>(United Kingdom)</p> | <p>Injunction for disclosure of the names and addresses of the suppliers of the infringing goods was rejected.</p>   |   | <p>The decision was made on the basis of the risk of irreparable harm for the defendant (i.e. its reputation would be severely undermined in the eyes of its suppliers).</p>  |

## ANNEX II: CJEU

- [C-275/06 Promusicae \(29 January 2008\)](#)
- [C-557/07 LSG-Gesellschaft zur Wahrnehmung von Leistungsschutzrechten \(19 February 2009\)](#)
- [C-461/10 Bonnier Audio and Others \(19 April 2012\)](#)
- [C-580/13 Coty Germany \(16 July 2015\)](#)
- [C-427/15 NEW WAVE CZ \(18 January 2017\)](#)

## ANNEX III: AUSTRIA

- [4 Ob 41/09x \(14 July 2009\)](#)
- [4 Ob 170/15a \(17 November 2015\)](#)

## ANNEX IV: BELGIUM

- Tribunal de commerce de Bruxelles 12-05787 (16 February 2015)  
(not available via free online resources)

## ANNEX V: FRANCE

- [Cour de Cassation 10-28088 \(13 December 2011\)](#)
- Tribunal de grande instance de Paris 14-09412 (6 January 2017)  
(not available via free online resources)

## ANNEX VI: GERMANY

- [Bundesgerichtshof I ZB 13/12 \(25 October 2012\)](#)
- [Bundesgerichtshof I ZR 51/12 \(21 October 2015\)](#)

## ANNEX VII: GREECE

- Court of First Instance Athens 1563/2013 (28 March 2013)  
(not available via free online resources)

## ANNEX VIII: POLAND

- [Court of Appeal Bialystock I ACz 114/13 \(7 February 2013\)](#)
- [Provincial Court Krakow IX GCo 41/14 \(15 April 2014\)](#)

## ANNEX IX: PORTUGAL

- [Tribunal da Relação de Lisboa 1287/09.9TYLSB-A.L1-1 \(22 July 2010\)](#)

## ANNEX X: SPAIN

- [Tribunal Supremo Sala de lo Contencioso 6153/2011 \(3 October 2014\)](#)

## ANNEX XI: UNITED KINGDOM

- [Intellectual Property Enterprise Court CC13P03341 \(2 July 2014\)](#)

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