



**C-324/09 L'Oréal and others v eBay, judgment of 12 July 2011**

**The Court of Justice specifies the obligations imposed on companies running an online marketplace regarding infringement of trade mark rights committed by users.**

Referred the case in the context of a dispute between the company L'Oréal and the company eBay, the High Court (United Kingdom) referred to the Court of Justice several questions relating to the obligations incumbent upon a company operating an online marketplace to prevent its users from committing infringements of trade marks.

By way of introduction, the Court recalls that the exclusive rights conferred by a trade mark on its proprietor can be relied on only as against economic operators. This case therefore refers only to sales made on the marketplace concerned which, owing to their volume, their frequency or other characteristics, go beyond the realms of a private activity and for which the seller will therefore be acting 'in the course of trade'.

The Court then specifies firstly that the proprietor of a trade mark may prevent the offer for sale of trade-marked goods intended for sale in third States by means of an online marketplace accessible from the territory covered by the trade mark, as soon as it appears that this offer for sale targets consumers within that same territory. It therefore falls to the national courts to assess on a case-by-case basis whether there are any relevant factors to come to such a conclusion. In this context, the criterion of the accessibility of the website is not relevant. On the other hand, the fact that the offer for sale is accompanied by details of the geographic areas to which the seller is willing to dispatch the product is of particular importance.

Secondly, the Court considers that the proprietor of a trade mark may oppose the resale of trade-marked goods on an online marketplace, on the ground that the person reselling the goods has removed their packaging, where the consequence of that removal is that essential information, such as information relating to the identity of the manufacturer or the person responsible for marketing the product, is missing. If this is not the case, the trade mark proprietor may nevertheless oppose the resale of his unboxed product, if he establishes that the removal of the packaging has damaged the image of the product and, hence, the reputation of the trade mark.

Thirdly, the trade mark proprietor may prohibit the operator of the online marketplace from advertising products sold on this marketplace via a referencing site (such as Google), on the basis of a keyword which is identical to this trade mark, where that advertising does not enable reasonably well-informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether these goods originate from the proprietor of the trade mark or from an undertaking economically linked to it or, on the contrary, originate from a third party.

Fourthly, the Court considers that the operator of an online marketplace is not itself 'using', within the meaning of Union law, signs identical with or similar to trade marks, which are inevitably displayed in the offers for sale on its website. This use is made by the sellers who are customers of the operator of that marketplace.

Fifthly, concerning the liability of the operator of the online marketplace, the Court first recalls that only 'intermediary service providers' may rely on the exemption from liability provided for by Article 14 of Directive 2000/31/EC on certain legal aspects of information society services. The operator of an online marketplace is not an intermediary service provider of this kind if, instead of taking a neutral position



between the customer-seller concerned and potential buyers, confining itself to technical and automatic processing of the data relating to the offers it stores, it plays an active role of such a kind as to give it knowledge of, or control over, those data. This is the case where the operator provides the customer-seller with assistance consisting in particular of optimising the presentation of the offers or promoting them. It is for the national courts to carry out this assessment. In any case, even if the operator of the online marketplace has not played an active role of this kind, it will not be able to rely on the above-mentioned derogation from liability if it appears that it was aware of facts or circumstances on the basis of which a diligent economic operator should have realised that the offers for sale were unlawful and failed to act expeditiously to remove these offers or to disable access to them.

Finally, the Court pronounces on the question of injunctions which can be applied for against the operator of an online marketplace which does not decide, on its own initiative, to cause the infringement of intellectual property rights to stop and to prevent further infringements. Member States must ensure effective protection of intellectual property. To do so, the national courts must be allowed to order the operator of an online marketplace to take measures that contribute effectively not only to bringing to an end infringements to intellectual property rights committed through that marketplace, but also to preventing further infringements. The rules laid down for this purpose must be fair and proportionate and must not create barriers to legitimate trade. In this context, the measures required of the operator of an online marketplace must not consist in an active monitoring of all the data of each of its customers and must not have the effect of a general and permanent prohibition on the selling, on that marketplace, of goods bearing the trade mark concerned. On the other hand, the operator could be ordered to suspend the perpetrator of the infringement of intellectual property rights in order to prevent repeat infringements or to take measures to make it easier to identify that perpetrator.