

Individual online purchases and mail delivery constitute trademark infringement Slovenia - Item doo

Internet issues

January 14 2016

In *Rolex SA v Dragica Poric* (Case 582/2015, November 16, 2015), the Ljubljana Circuit Court established that Ms Dragica Poric had infringed the registered ROLEX and crown design Community trademarks by making online purchases of wristwatches bearing these trademarks from outside the European Union, which were then mailed to Slovenia.

On March 31 2015, during an inspection of postal parcels entering Slovenia, Customs discovered a package addressed to Poric containing a wristwatch bearing the ROLEX trademark. Suspicious that the watch was counterfeit, Customs suspended the package and informed Rolex SA, which confirmed that the watch was counterfeit and requested its destruction. Poric did not object to the destruction, so the watch was destroyed within the ambit of the customs procedure.

On June 16 2015 Customs once again discovered a package addressed to Poric containing a counterfeit Rolex wristwatch; this was once again destroyed within the ambit of the customs procedure at Rolex's request.

When Customs discovered a third counterfeit wristwatch addressed to Poric on July 8 2015, Rolex not only requested its destruction within the ambit of the customs procedure, but also sued Poric for trademark infringement before the Ljubljana Circuit Court. In the infringement action Rolex requested that:

- the court establish that Poric had infringed the ROLEX and crown design Community trademarks by purchasing counterfeit wristwatches bearing these trademarks online and having them mailed to Slovenia;
- Poric be prohibited from infringing these trademarks in the future; and
- the judgment be published in four major Slovenian newspapers at Poric's expense.

Rolex was careful to explain that even though each package addressed to Poric had contained only one counterfeit item, such activities nonetheless constituted trademark infringement because the import of infringing products is expressly mentioned in the Industrial Property Act as an act of trademark infringement without any exceptions, such as import for personal or private use. Rolex also cited the European Court of Justice (ECJ) decision in Case C-98/13, in which the ECJ held:

"Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights must be interpreted as meaning that the holder of an intellectual property right over goods sold to a person residing in the territory of a Member State through an online sales website in a nonmember country enjoys the protection afforded to that holder by that regulation at the time when those goods enter the territory of that Member State merely by virtue of the acquisition of those goods. It is not necessary, in addition, for the goods at issue to have been the subject, prior to the sale, of an offer for sale or advertising targeting consumers of that State."

In her defence, Poric explained that she had bought the watches on online store www.Aliexpress.com, but at that time had been unaware that the watches were marked with ROLEX trademarks. However, Poric acknowledged all action claims.

The court issued a judgment based on Poric's acknowledgment and granted all action claims. Although Poric had acknowledged the action claims, the court, in order to grant them, had to examine whether they were legally justified. For example, if the court believed that the import of infringing products for personal use does not constitute infringement, it would have refused the claims despite the defendant's acknowledgment.

The judgment is significant because it marks the first time that a Slovenian court has ruled that online purchases on a foreign website which are imported into Slovenia constitute infringement, even where a single product is purchased each time and the purchase is effected by someone who might be a consumer.

Gregor Maček, ITEM doo, Ljubljana

World Trademark Review™

Daily

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.