Reports of Cases

OPINION OF ADVOCATE GENERAL
RANTOS
delivered on 17 November 2022 [1]

Case C-628/21

TB
other parties to the proceedings:
Castorama Polska Sp. z o.o.,
'Knor' Sp. z o.o.

(Request for a preliminary ruling from the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland))

(Reference for a preliminary ruling – Approximation of laws – Directive 2004/48/EC – Enforcement of intellectual property rights – Article 4 – Persons entitled to apply for the application of the measures, procedures and remedies – Article 8(1) – Action relating to an infringement of an intellectual property right – Sale of infringing goods – Copyright and related rights – Right of information of the applicant concerning the origin and distribution networks of the goods – Whether the applicant is required to prove that he or she is the holder of the intellectual property right)

I. Introduction

1. An undertaking is marketing reproductions of graphic representations without the consent of the person claiming to be the creator of those representations. The person in question brings an action relating to an infringement of intellectual property on the basis of Article 8(1) of Directive 2004/48/CE, [2] which establishes an instrumental right aimed at ensuring effective protection of the intellectual property. [3] Must that person prove that she is the holder of the intellectual property right at issue or merely lend credence to the fact that she is the holder of that right? That, in essence, is the question put by the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland).

2. The present case will lead the Court to examine, in the light of its case-law, the standard of proof that is required in the context of a request for information on the origin and distribution networks of goods or services on the basis of the right of information provided for in Article 8(1)

[1] Original language: French.

[2] Directive of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45, and corrigendum OJ 2004 L 195, p. 16). On that directive, see Petillion, F., and Heirwegh, A., 'Genesis, Adoption and Application of European Directive 2004/48/EC', in *Enforcement of Intellectual Property Rights in the EU Member States*, Petillion, F. (ed.), Intersentia, Antwerp, 2019, pp. 1 to 48.

[3] See Opinion of Advocate General Cruz Villalón in *Coty Germany* (C-580/13, EU:C:2015:243, point 24).

of Directive 2004/48. In order to answer the question, it will be necessary to weigh up, on the one hand, the right of information of holders of intellectual property and, on the other, the protection of the defendant against abuse of that right.

II. Legal framework

A. European Union law

3. According to recitals 10 and 17 of Directive 2004/48:

'(10) The objective of this Directive is to approximate [the] legislative systems [of the Member States] so as to ensure a high, equivalent and homogeneous level of protection in the Internal Market.

…

(17) The measures, procedures and remedies provided for in this Directive should be determined in each case in such a manner as to take due account of the specific characteristics of that case, including the specific features of each intellectual property right and, where appropriate, the intentional or unintentional character of the infringement.'

4. Article 1 of that directive, entitled 'Subject matter', states:

'This Directive concerns the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights. …'

5. Chapter II of that directive, entitled 'Measures, procedures and remedies', consists of Articles 3 to 15. Article 3 of that directive, entitled 'General obligation', provides:

'1. Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be fair and equitable and shall not be unnecessarily complicated or costly, or entail unreasonable time limits or unwarranted delays.

2. Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.'

6. Article 4 of Directive 2004/48, entitled 'Persons entitled to apply for the application of the measures, procedures and remedies', provides:

'Member States shall recognise as persons entitled to seek application of the measures, procedures and remedies referred to in this Chapter:

(a) the holders of intellectual property rights, in accordance with the provisions of the applicable law,

(b) all other persons authorised to use those rights, in particular licensees, in so far as permitted by and in accordance with the provisions of the applicable law,

(c) intellectual property collective rights management bodies which are regularly recognised as having a right to represent holders of intellectual property rights, in so far as permitted by and in accordance with the provisions of the applicable law,

(d) professional defence bodies which are regularly recognised as having a right to represent holders of intellectual property rights, in so far as permitted by and in accordance with the provisions of the applicable law.'

7. Article 8 of that directive, entitled 'Right of information', is worded as follows, in paragraphs 1 and 2:

'1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person who:

(a) was found in possession of the infringing goods on a commercial scale;

(b) was found to be using the infringing services on a commercial scale;

(c) was found to be providing on a commercial scale services used in infringing activities;

or

(d) 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.

2. The information referred to in paragraph 1 shall, as appropriate, comprise:

(a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or 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 or services in question.'

B. Polish law

8. Article 278 of the ustawa – Kodeks postępowania cywilnego (Law establishing the Code of Civil Procedure) of 17 November 1964, in the version applicable to the dispute in the main proceedings [4] ('the Code of Civil Procedure'), states, in paragraph 1:

'In cases requiring special knowledge, the court, after hearing the parties' requests concerning the number and choice of experts, may seek the opinion of one or more experts.'

[4] Dz. U., 2020, position 1575.

9. Article 479[89] of that code provides:

‘1. The provisions of the present section shall apply to cases relating to the protection of copyright and related rights, the protection of industrial property and the protection of other rights concerning intangible assets (intellectual property cases).

2. The following shall also be considered to be intellectual property cases for the purposes of the present section:

(1) the prevention and combating of unfair competition;

…’

10. Article 479[112] of that code provides:

‘The provisions concerning the person required to provide the information shall apply to any person, including the defendant, who has the information referred to in Article 479[113] or who has access to that information.’

11. Article 479[113] of that code is worded as follows, in paragraphs 1 and 2:

‘1. Upon application by the rightholder, where he or she plausibly demonstrates the existence of circumstances characterising an infringement of an intellectual property right, the court may, before the commencement of proceedings relating to that infringement of the intellectual property right, or while such proceedings are pending, up to the close of the hearing at first instance, request the infringer to provide information on the origin and the distribution networks of the goods or services, where that is necessary for the requirements of the holder’s action.

2. Where the court’s request for information precedes the proceedings relating to the infringement of the intellectual property right, those proceedings must be brought no later than one month from the date of enforcement of the order relating to the request for information.’

III. The dispute in the main proceedings, the questions referred for a preliminary ruling and the procedure before the Court

12. TB is a natural person who, through her online shops, markets decorative articles. In the context of her economic activity, she sells reproductions, produced mechanically by the applicant herself, with simple graphics, consisting of a limited number of colours and geometric figures and short sentences. In that regard, images A, B and C (‘the reproductions at issue’) contain, respectively, the following sentences: ‘Mój dom moje zasady’ (‘In my house, I make the rules’); ‘Nie ma ludzi idealnych a jednak jestem’ (‘Perfect persons do not exist, and yet I am one’) and ‘W naszym domu rano słychać tupot małych stopek. Zawsze pachnie pysznym ciastem. Mamy dużo obowiązków, mnóstwo zabawy i miłości’ (‘In our house, the sound of tiny feet can be heard. There is always the aroma of delicious cake. We have many obligations, much pleasure and much love’). TB claims to be the creator of the images which she reproduces, which in her contention are works for the purposes of the legislation on copyright.

13. Exact copies of images A and B, supplied by 'Knor' Sp. z o.o. ('Knor'), are sold without TB's consent in the 'bricks and mortar' shops and online shop of Castorama Polska Sp. z o.o. ('Castorama'). Neither TB's reproductions of those images nor the reproductions offered by Castorama indicate the author or the origin of those images. Castorama also sells reproductions, supplied by Knor, with identical wording to that of image C, but with certain differences in terms of their graphics and fonts. On 13 October 2020, TB gave notice to Castorama to cease and desist its infringements of the economic and moral copyright in the works created by her which that company was selling without her consent.

14. On 15 December 2020, TB brought an action before the Sąd Okręgowy w Warszawie (Regional Court, Warsaw), the referring court, under Article 479^{113} of the Code of Civil Procedure. In the course of those proceedings, she requested Castorama and Knor to provide her with information, concerning the reproductions at issue, on the distribution networks and the quantity of goods received and ordered, a complete list of suppliers, the date on which the goods were placed on sale in Castorama's 'bricks and mortar' shops and online shop, the quantity involved and the price derived from the sale of the goods, broken down into physical sales and online sales. TB relied on her economic and moral copyright in the reproductions at issue and stated that the information requested was necessary for the purpose of bringing an action for infringement of her copyright and, in the alternative, an action for damages for unfair competition.

15. Castorama contended that that request for information should be refused and, in the alternative, that the scope of the judicial decision should be as narrow as possible, strictly limited to works classified as such for the purposes of the legislation on copyright, and disputed the very possibility that the reproductions at issue might be classified as 'works'. It also relied on the protection of business secrets and claimed that TB had not proved that she held the economic copyright in those reproductions. In Castorama's contention, the intellectual works to which TB's request refers are not original and TB has not proved that the 'novelty' condition was satisfied. Granting her request would amount to affording copyright protection to ideas and concepts, because the reproductions at issue belong to the current fashion for 'simplified motivational artworks' with trite sentences. Castorama maintained, moreover, that all the graphic elements of the reproductions at issue are trite and repetitive and are not distinguished in any original manner, as far as concerns composition, colours or the fonts used, from the other images available on the market.

16. In answer to those arguments, TB did not adduce any evidence to prove the existence of an intellectual property right in the reproductions at issue and calling for special knowledge (with a view to an expert report) in the field of graphics and design. The evidence which she produced in her application of 15 December 2020 consisted of printouts of pages of articles on sale in her online shops and of sales invoices from 2014, and also of printouts of pages from Castorama's websites and sales invoices of images in the latter's online shops.

17. When examining TB's request, the referring court was uncertain about the interpretation to be given to Article 8(1) of Directive 2004/48, in particular as regards the question whether it is necessary to adduce proof of the legal nature of the asset to which the request for information relates, or merely to lend credence to it, in view of the fact that Articles 6 and 7 of that directive use different formulations and that Article 4 of that directive refers to the 'holders of intellectual property rights'. The referring court's doubts also related to the possibility that a different standard of proof might be applied as regards the status of the reproductions at issue, namely whether or not they are works, and consequently on TB's standing to bring proceedings.

18. The referring court observes that Article 479[113] of the Code of Civil Procedure constitutes the transposition of Article 8 of Directive 2004/48 and that Article 479[89] of that code, which defines the scope of intellectual property cases, refers, in paragraph 2(1), to cases relating to 'the prevention and combating of unfair competition'. Referring to recital 13 of that directive,[5] the referring court emphasises that, for the purposes of the present case, although the Polish case-law has not yet given an unequivocal answer to that question, that court accepts the interpretation according to which national law extended, for domestic purposes, the application of that directive to acts involving unfair competition which consist in producing exact copies of goods, even if those goods are not the subject of exclusive rights such a those of the copyright holder. In the light of those factors, as regards the part of the request relating to images A and B, no problem of interpretation of EU law arises, since TB has proved that Castorama has sold reproductions consisting of exact copies of those images.

19. On the other hand, in order to adjudicate on the request relating to image C, it is necessary to interpret EU law, since the reproduction sold by Castorama is not an exact copy of that image, in that the text has been reproduced and its position on the page has been retained, but with the use of other graphic elements and other fonts. According to the Polish case-law, which coincides with the Court's,[6] it is for the court dealing with the matter to examine the creative characteristics of a work. In that regard, according to the referring court, where the facts of the case are complex and the judge's experience is insufficient, it is necessary to have recourse to an expert's opinion, while the burden of proof and responsibility for requesting an expert report are generally borne by the applicant.

20. Polish legal commentators have expressed two contradictory viewpoints on the interpretation of Article 479[113] of the Code of Civil Procedure and have considered either that the applicant must adduce proof that she is the holder of the intellectual property right in question or that she is not required to prove the infringement of the protected right, but is required merely to lend credence to such an infringement, since the request for information may also be addressed to a third party.

21. The referring court states that in its view Article 8(1) of Directive 2004/48, read in conjunction with Article 4 of that directive, must be interpreted as meaning that it refers to a measure to protect intellectual property rights only when the ownership of the intellectual property right is proved and that credence being lent to the fact that that measure relates to an existing intellectual property right is not sufficient, since it is necessary to adduce proof of that circumstance, in particular where the request for information on the origin and the distribution networks of goods or services precedes the assertion of claims for compensation on account of an infringement of intellectual property rights.

[5] That recital states that 'it is necessary to define the scope of this Directive as widely as possible in order to encompass all the intellectual property rights covered by Community provisions in this field and/or by the national law of the Member State concerned. Nevertheless, that requirement does not affect the possibility, on the part of those Member States which so wish, to extend, for internal purposes, the provisions of this Directive to include acts involving unfair competition, including parasitic copies, or similar activities'.

[6] Judgment of 16 July 2009, *Infopaq International* (C-5/08, EU:C:2009:465).

22. In those circumstances, the Sąd Okręgowy w Warszawie (Regional Court, Warsaw) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Should Article 8(1) read in conjunction with Article 4(1) of [Directive 2004/48] be understood to refer to a measure to protect intellectual property rights only when the rightholder's intellectual property right has been confirmed in these or other proceedings?

– if Question (1) is answered in the negative:

(2) Should Article 8(1) …, read in conjunction with Article 4(1) of Directive [2004/48] be interpreted as meaning that it is sufficient to lend credence to the fact that that measure refers to an existing intellectual property right, and not to prove that circumstance, especially in a case where a request for information about the origin and distribution networks of goods or services precedes the assertion of claims for compensation on account of an infringement of intellectual property rights?'

23. Written observations were lodged by Castorama, the Polish and Austrian Governments and the European Commission.

IV. Analysis

A. The admissibility of the request for a preliminary ruling

24. In its written observations, the Austrian Government expressed doubts as to the admissibility of the request for a preliminary ruling. It claimed that the classification of the reproductions at issue as 'works' should be examined as a point of law in the context of the dispute in the main proceedings. In that regard, the referring court has those reproductions before it and their specific presentation and conception are clear and undisputed. The answer to the question of the standard of proof to be applied in the context of Article 8 of Directive 2004/48 is therefore not necessary for the purpose of settling that dispute.

25. According to the Court's settled case-law, it is solely for the national court before which the dispute has been brought, and which must assume responsibility for the subsequent judicial decision, to determine in the light of the particular circumstances of the case both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the questions which it submits to the Court. It follows that questions relating to EU law enjoy a presumption of relevance. The Court may refuse to rule on a question referred by a national court for a preliminary ruling only where it is quite obvious that the interpretation of EU law that is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it.[7]

26. In this instance, the referring court has made clear that image C was not the subject of an exact copy. In that respect, it must examine the creative characteristics of a work. According to that court, when the facts of the case are complex and the judge's experience is not sufficient, it is necessary to have recourse to an expert's opinion. Furthermore, TB has not adduced evidence to

[7] See judgment of 6 October 2022, *HV (Suspension of the right to drive)* (C-266/21, EU:C:2022:754, paragraph 21 and the case-law cited).

prove the existence of an intellectual property right calling for special knowledge requiring an expert report. The referring court therefore seeks to ascertain whether Article 8(1) of Directive 2004/48 must be interpreted as meaning that it relates to a measure for the protection of intellectual property rights which is available only if the infringement of the holder's property right is proved in a situation in which the national court concerned is not in a position, in the absence of special circumstances, to carry out an autonomous assessment without the help of an expert. If that is the case, TB's request for information should be refused if no probative procedure, in which the applicant must play an active role in establishing proof, is carried out.

27. Having regard to the legal and factual context, in which the referring court states that a preliminary ruling is necessary in order for it to be in a position to deliver judgment, it is not obvious that the interpretation sought bears no relation to the main action or that the problem raised is hypothetical. In those circumstances, I am of the view that the present request for a preliminary ruling is admissible.

B. Substance

28. By its two questions, which should be examined together, the referring court asks, in essence, whether Article 8(1) of Directive 2004/48 must be interpreted as meaning that, in the context of an action relating to infringement of an intellectual property right, the applicant must prove that he or she is the holder of the intellectual property right at issue or whether it is sufficient that he or she lends credence to the fact that he or she is the holder of that right, in particular where the request for information precedes the assertion of claims for compensation on account of an infringement of the intellectual property right.

29. Castorama and the Polish and Austrian Governments suggest that the answer to those questions should be that the applicant must prove that he or she is the holder of the intellectual property right in question. The Commission, on the other hand, maintains that it is sufficient for the applicant to lend credence to the fact that his or her request for information relates to an existing intellectual property right.

30. In the words of Article 8(1)(a) of Directive 2004/48, Member States are to ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer or any other person who was found in possession of the infringing goods on a commercial scale.

31. In this instance, the referring court seeks to ascertain whether, when a claimant brings an action concerning an infringement of an intellectual property right on the basis of Article 8(1) of Directive 2004/48, he or she must prove that he or she is the holder of the intellectual property right in question.

32. Given its wording, that provision does not in itself provide for such an obligation for the claimant. However, as the request for information must be 'justified', it follows that the request must contain reasoning setting out sufficient facts and evidence relating to the intellectual property right relied on.

33. As the referring court observes, Article 8(1) of Directive 2004/48 must be read in conjunction with Article 4 of that directive, according to which the person applying for the application of the measures, procedures and remedies provided for in Chapter II of that directive must come within one of the four categories of persons or bodies listed in Article 4(a) to (d) of that directive. Those categories include, first, holders of intellectual property rights; second, all the other persons authorised to use those rights, in particular licensee;, third, intellectual property collective rights management bodies which are regularly recognised as having a right to represent holders of intellectual property rights; and, fourth, professional defence bodies which are regularly recognised as having a right to represent holders of intellectual property rights. However, unlike the holders of intellectual property rights referred to in Article 4(a), in accordance with recital 18[8] of that directive, the three categories of persons referred to in Article 4(b) to (d) of that directive must also have a direct interest in the defence of those rights and the right to be a party to legal proceedings in so far as permitted by, and in accordance with, the applicable legislation.[9]

34. As Article 4(a) of Directive 2004/48 refers to the 'holders of intellectual property rights', that provision might be understood as meaning that, in the context of the application of Article 8 of that directive, the applicant must actually show that he or she is the holder of the intellectual property right.

35. However, according to the Court's settled case-law, it follows from the need for uniform application of EU law and from the principle of equality that the terms of a provision of EU law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must normally be given an autonomous and uniform interpretation throughout the European Union. That interpretation must take into account not only its wording but also its context and the objective pursued by the legislation in question.[10]

36. As regards the context of Article 8 of Directive 2004/48, it should be noted that Article 6 of that directive, entitled 'Evidence', provides in paragraph 1 that Member States are to ensure that on application by *a party which has presented reasonably available evidence sufficient* to support its claims, and *has, in substantiating those claims, specified evidence* which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information. Article 7 of that directive, entitled 'Measures for preserving evidence', provides in paragraph 1 that Member States are to ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by *a party who has presented reasonably available evidence to support his or her claims* that his or her intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence, subject to the protection of confidential information. As for Article 9 of that directive, entitled 'Provisional and precautionary measures', it provides, in paragraph 3, that the judicial authorities are, in respect of the measures referred to in paragraphs 1 and 2 of that article, to require *the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the rightholder* and that the applicant's right is being infringed, or that such infringement is imminent.

8 In the words of that recital, 'the persons entitled to request application of those measures, procedures and remedies should be not only the rightholders but also persons who have a direct interest and legal standing in so far as permitted by and in accordance with the applicable law, which may include professional organisations in charge of the management of those rights or for the defence of the collective and individual interests for which they are responsible'.

9 See judgment of 17 June 2021, *M.I.C.M.* (C-597/19, EU:C:2021:492, paragraphs 63 and 64 and the case-law cited).

10 See judgment of 2 June 2022, *T.N. and N.N. (Declaration concerning the waiver of succession)* (C-617/20, EU:C:2022:426, paragraph 35 and the case-law cited).

37. Consequently, although Directive 2004/48 refers to the 'holders of intellectual property rights' among the persons who can seek application of the measures, procedures and remedies provided for in Chapter II of that directive, the directive expressly provides that the applicant, pursuant to Articles 6, 7 and 9 of that directive, may present reasonably available evidence sufficient to support his or her claims, that is to say, without having to prove that he or she is the holder of the intellectual property right in question. Accordingly, I am of the view that the concept of 'holder of intellectual property rights', for the purposes of Article 4 of Directive 2004/48, cannot be understood as meaning that it requires the applicant to prove that he or she is the holder of the intellectual property right on which he or she relies in an action relating to an infringement of an intellectual property right brought under Article 8 of that directive.

38. As for the objective pursued by Directive 2004/48, it is clear from recitals 10 and 13, respectively, of that directive that that objective is to approximate the legislative systems of the Member States so as to ensure a high, equivalent and homogeneous level of protection in the internal market and that the scope of that directive must be defined as widely as possible in order to encompass all the intellectual property rights covered by the EU provisions in that field or by the national law of the Member State concerned. [11] Furthermore, the Court has held that the objective pursued by that directive is that the Member States should ensure, especially in the information society, effective protection of the intellectual property. [12] It is also apparent from the Court's case-law that the provisions of that directive are intended to govern the aspects of intellectual property rights related, first, to the enforcement of those rights and, second, to infringement of them, by requiring that there must be effective legal remedies designed to prevent, terminate or rectify any infringement of an existing intellectual property right. [13]

39. However, still according to the Court's case-law, in order to ensure a high level of protection of intellectual property, an interpretation recognising the right of information laid down in Article 8(1) of Directive 2004/48 solely in proceedings seeking a finding of an infringement of an intellectual property right must be rejected, since such a level of protection might not be ensured if it were not possible also to exercise that right of information in the context of *separate proceedings brought after the final termination* of an action in which a finding was made of a breach of an intellectual property right. [14] The Court has stated that it is appropriate to apply the same reasoning in relation to a *separate procedure preceding an action for damages* with a view to being able usefully to bring legal proceedings against the alleged infringers. [15]

40. In addition, the Court has held that the right of information provided for in Article 8(1) of Directive 2004/48 implements the fundamental right to an effective remedy guaranteed in Article 47 of the Charter of Fundamental Rights of the European Union ('the Charter') and thereby ensures the effective exercise of the fundamental right to property, which includes the intellectual property right protected in Article 17(2) of the Charter. That right of information thus enables the holder of an intellectual property right to identify who is infringing that right and to take the necessary steps, such as making an application for the provisional measures set out in Article 9(1) and (2) of that directive or for damages as provided for in Article 13 thereof, in order to protect that intellectual property right. Without full knowledge of the extent of the

[11] Judgment of 18 December 2019, *IT Development* (C-666/18, EU:C:2019:1099, paragraph 38).

[12] Judgment of 18 December 2019, *IT Development* (C-666/18, EU:C:2019:1099, paragraph 39 and the case-law cited).

[13] Judgment of 28 April 2022, *Phoenix Contact* (C-44/21, EU:C:2022:309, paragraph 39 and the case-law cited).

[14] Judgment of 18 January 2017, *NEW WAVE CZ* (C-427/15, EU:C:2017:18, paragraph 24).

[15] Judgment of 17 June 2021, *M.I.C.M.* (C-597/19, EU:C:2021:492, paragraph 82). Thus, Article 479[113](2) of the Code of Civil Procedure states that 'where the court's request for information precedes the proceedings relating to the infringement of the intellectual property right, those proceedings must be brought no later than one month from the date of enforcement of the order relating to the request for information'.

infringement of his or her intellectual property right, the rightholder would not be in a position to determine or calculate precisely the damages he or she was entitled to by reason of the infringement. [16]

41. It follows clearly from that body of case-law that it is necessary to distinguish the function of a request for information pursuant to Article 8 of Directive 2004/48 from that of legal proceedings seeking a finding that there has been an infringement of an intellectual property right. In particular, in the situation referred to by the referring court in its second question, namely where the request for information precedes the assertion of claims for compensation on account of an infringement of the intellectual property right, that request is *separate and preliminary* in nature and is made in order to obtain full knowledge of the extent of the infringement of the intellectual property right and, where appropriate, to be able to bring usefully an action to remedy that infringement.

42. At that stage of the proceedings, the applicant cannot be required, in order to be able to bring proceedings, to prove that he or she is the holder of the intellectual property at issue. If that were the case, the request for information provided for in Article 8 of Directive 2004/48 would be subject to the same evidentiary requirements as the legal action seeking a finding of an infringement of an intellectual property right, whereas it fulfils a different role. Thus, as the separate procedure established in that Article 8 constitutes a specific aspect of EU law, [17] it would, in such a case, lose a large part of its practical effect.

43. In those circumstances, I am of the view that, in the context of the application of that Article 8, the applicant must lend credence, by presenting sufficient evidence, to the fact that he or she is the holder of the intellectual property right at issue, but is not required to prove that circumstance, in particular where the request for information precedes the assertion of claims for compensation on account of an infringement of the intellectual property right.

44. In this instance, the referring court states that the issue in the main proceedings is TB's copyright. In that regard, while Directive 2004/48 contains no definition of the intellectual property rights that fall within its scope, the Statement by the Commission concerning Article 2 of Directive 2004/48 [18] makes clear that, according to the Commission, copyright is among those rights. It is also apparent from the Court's case-law that copyright is covered by the concept of 'intellectual property' within the meaning of that directive. [19]

45. In the words of recital 17 of that directive, the measures, procedures and remedies provided for in that directive should be determined in each case in such a manner as to take due account of the specific characteristics of that case. In that regard, recital 19 of that directive [20] emphasises that copyright exists from the creation of a work and does not require formal registration. With

[16] See judgments of 18 January 2017, *NEW WAVE CZ* (C-427/15, EU:C:2017:18, paragraph 25), and of 17 June 2021, *M.I.C.M.* (C-597/19, EU:C:2021:492, paragraph 83).

[17] As stated in the Proposal for Directive of the European Parliament and of the Council on measures and procedures to ensure the enforcement of intellectual property rights, presented by the Commission on 30 January 2003 (COM(2003) 46 final, p. 15), such a right of information had been introduced into the legal system of only a few Member States, namely in Germany in the laws on intellectual property and in the Benelux law on trade marks.

[18] OJ 2005 L 94, p. 37.

[19] See, for example, judgment of 18 December 2019, *IT Development* (C-666/18, EU:C:2019:1099).

[20] In the words of that recital, 'since copyright exists from the creation of a work and does not require formal registration, it is appropriate to adopt the rule laid down in Article 15 of the Berne Convention, which establishes the presumption whereby the author of a literary or artistic work is regarded as such if his name appears on the work. …'

respect to copyright, it follows from the Court's case-law relating to Directive 2001/29/EC [21] that the concept of 'work' has two conditions. First, it entails an original subject matter which is the author's own intellectual creation and, second, it requires the expression of that creation. As regards the first of those conditions, if a subject matter is to be capable of being regarded as original, it is both necessary and sufficient that the subject matter reflects the personality of its author, as an expression of his or her free and creative choices. As regards the second condition, the concept of 'work' that is the subject of Directive 2001/29 necessarily entails the existence of a subject matter that is identifiable with sufficient precision and objectivity. [22] It is for the referring court to ascertain whether TB lent credence, by presenting sufficient proof, to the fact that she holds the copyright in image C from the aspect of the reproduction of that image marketed by Castorama.

46. It should be added that the purpose of Directive 2004/48 is to establish a fair balance between, on the one hand, the interest of the holders of copyright in the protection of their intellectual property rights, enshrined in Article 17(2) of the Charter, and, on the other hand, the protection of the interests and fundamental rights of users of protected subject matter, as well as of the public interest. More specifically, as regards Article 8 of that directive, the Court has previously had occasion to hold that the aim of that provision is to reconcile compliance with various rights, inter alia the right of holders to information and the right of users to protection of personal data. [23]

47. In a similar vein, Article 3(1) of Directive 2004/48 provides that the measures, procedures and remedies are to be, inter alia, fair and equitable and are not to be unnecessarily costly. Furthermore, in the words of paragraph 2 of that article, those measures, procedures and remedies are to be effective, proportionate and dissuasive and are to be applied in such a manner as to provide for safeguards against their abuse. That article thus requires the Member States and, ultimately, the national courts to offer guarantees that, inter alia, the request for information referred to in Article 8 of that directive is not to be abused. [24]

48. Consequently, it is for the referring court to assess the merits of the request for information and to ascertain that the applicant has not abused that request. To that end, it must take due account of all the objective circumstances of the case, including the conduct of the parties. [25] If it concludes that there has been an abuse of right, it should refuse entitlement to the right of information provided for in Article 8 of Directive 2004/48. [26]

49. Having regard to all of the foregoing, I consider that Article 8(1) of that directive must be interpreted as meaning that, in the context of an action relating to an infringement of an intellectual property right, the applicant must lend credence, by submitting sufficient evidence, to the fact that he or she is the holder of the intellectual property right in question, in particular where the request for information precedes the assertion of claims for compensation on account of the infringement of the intellectual property right. The national court must also assess the

[21] Directive 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 (OJ 2001 L 167, p. 10).

[22] See judgment of 11 June 2020, *Brompton Bicycle* (C-833/18, EU:C:2020:461, paragraphs 22 to 25).

[23] See judgment of 9 July 2020, *Constantin Film Verleih* (C-264/19, EU:C:2020:542, paragraphs 37 and 38 and the case-law cited). See also Communication from the Commission to the European Parliament, the Council and the European Economic and Social Committee of 29 November 2017, 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 final, pp. 10 and 11), according to which 'in order to ensure the balanced use of the [intellectual property rights] enforcement system, the competent judicial authorities should generally conduct a case-by-case assessment when considering the grant of the measures, procedures and remedies' provided for by Directive 2004/48.

[24] See, to that effect, judgment of 28 April 2022, *Phoenix Contact* (C-44/21, EU:C:2022:309, paragraph 43).

[25] See, to that effect, judgment of 12 September 2019, *Bayer Pharma* (C-688/17, EU:C:2019:722, paragraph 70).

[26] See, to that effect, Opinion of Advocate General Szpunar in *M.I.C.M.* (C-597/19, EU:C:2020:1063, point 121).

merits of that request and take due account of all the objective circumstances of the case, including the conduct of the parties, in order to ascertain, in particular, that the applicant has not abused that request.

V. Conclusion

50. In the light of the foregoing considerations, I propose that the Court of Justice should answer the questions for a preliminary ruling referred by the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland) as follows:

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

must be interpreted as meaning that in the context of an action relating to an infringement of an intellectual property right, the applicant must lend credence, by submitting sufficient evidence, to the fact that he or she is the holder of the intellectual property right in question, in particular where the request for information precedes the assertion of claims for compensation on account of the infringement of the intellectual property right. The national court must also assess the merits of that request and take due account of all the objective circumstances of the case, including the conduct of the parties, in order to ascertain, in particular, that the applicant has not abused that request.