Reports of Cases

OPINION OF ADVOCATE GENERAL
CRUZ VILLALÓN
delivered on 16 April 2015 [1]

**Case C-580/13**

**Coty Germany GmbH**
**v**
**Stadtsparkasse Magdeburg**

(Request for a preliminary ruling from the Bundesgerichtshof (Germany))

(Intellectual property — Sale of counterfeit goods — Directive 2004/48/EC — Article 8(1) and (3)(e) — Right to information in the context of proceedings for infringement of an intellectual property right — Legislation of a Member State which allows banking institutions to refuse a request for information relating to a bank account (banking secrecy) — Charter of Fundamental Rights of the European Union — Articles 8, 17(2), 47 and 52(1) — Proportionality of the limitation of a fundamental right)

1. The question referred by the Bundesgerichtshof gives the Court of Justice the opportunity to develop in more detail its case-law in relation to Article 8 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [2] in an area which has not been examined until now. To date, the Court has dealt in particular with disputes between, on the one hand, holders of intellectual property rights and, on the other, internet users who download or share content protected by copyright, whose details are sought from internet service providers so that action can be taken against them once they have been identified. [3] On this occasion, however, it is a banking institution which, relying on banking secrecy, refuses to furnish the information needed to bring civil proceedings against a person using the technical possibilities offered by the internet to trade in counterfeit goods.

2. In short, the issue which arises in the present case is whether a third party who did not participate in an alleged infringement of the intellectual property right concerned but who 'was found to be providing on a commercial scale services used in infringing activities' (Article 8(1)(c) of Directive 2004/48) — in this particular case, a banking institution — may, under that directive and relying on banking secrecy, refuse to provide the information (specifically, the name and address of the holder of a bank account) requested from it by the holder of the intellectual property right or the person entitled to defend that right. [4]

1 — Original language: Spanish.

2 — OJ 2004 L 157, p. 45. According to the second sentence of Article 1 of Directive 2004/48, '[f]or the purposes of this directive, the term "intellectual property rights" includes industrial property rights', so from now on I shall use the term 'intellectual property' in that broad sense.

3 — See judgments in *Promusicae*, C-275/06, EU:C:2008:54; *Scarlet Extended*, C-70/10, EU:C:2011:771; *Bonnier Audio and Others*, C-461/10, EU:C:2012:219; *UPC Telekabel Wien*, C-314/12, EU:C:2014:192, and the order in *LSG-Gesellschaft zur Wahrnehmung von Leistungsschutzrechten*, C-577/07, EU:C:2009:107.

4 — According to Article 4 of Directive 2004/48, Member States must recognise as persons entitled to seek application of the measures, procedures and remedies referred to in Chapter II of the directive, inter alia, 'all other persons authorised to use those [intellectual property] rights, in particular licensees, in so far as permitted by and in accordance with the provisions of the applicable law'.

## I – **Legislative framework**

### A – *EU law*

3. According to recital 10 in the preamble to Directive 2004/48, the objective of the directive is to approximate the legislation of the Member States in relation to protection of intellectual property rights so as to ensure a high, equivalent and homogeneous level of protection of such rights in the internal market. Recital 8 states that '[t]he disparities between the systems of the Member States as regards the means of enforcing intellectual property rights are prejudicial to the proper functioning of the Internal Market and make it impossible to ensure that intellectual property rights enjoy an equivalent level of protection throughout the Community. This situation does not promote free movement within the Internal Market or create an environment conducive to healthy competition'. Recital 9 in the preamble to the directive observes that '… [i]ncreasing use of the internet enables pirated products to be distributed instantly around the globe'.

4. Article 2(3) of Directive 2004/48 stipulates: 'This directive shall not affect: (a) … 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]', a fact which is also referred to in recital 15 in the preamble to the directive.

5. Article 3 of Directive 2004/48 provides that:

'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 8 of Directive 2004/48, entitled 'Right of information', stipulates as follows:

'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:

…

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

…

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;

…

3. Paragraphs 1 and 2 shall apply without prejudice to other statutory provisions which:

…

(e) govern the protection of confidentiality of information sources or the processing of personal data.'

B – *National law*

7. Paragraph 19 of the German Law on trade marks of 25 October 1994, as subsequently amended (Markengesetz; 'Law on trade marks'), is entitled 'Right to information' and transposes into German law the right laid down in Article 8 of Directive 2004/48. Paragraph 19(2) is worded as follows:

'In the case of an obvious infringement or in cases where the proprietor of a trade mark or a trade name has brought an action against the infringer, the right also stands (notwithstanding subparagraph 1) against a person who, on a commercial scale,

1. was in possession of the infringing goods;

2. used the infringing services;

3. provided services used in the infringing activities, or

4. was indicated by a person referred to in points 1, 2 or 3 as being involved in the production, manufacture or distribution of those goods or in the provision of those services,

unless that person is permitted to refuse to give evidence in proceedings against the infringer under Paragraphs 383 to 385 of the Civil Procedure Code …'

8. Paragraph 383(1)(6) of the German Civil Procedure Code (Zivilprozessordnung, in the version of 5 December 2005, as subsequently amended; 'ZPO') grants persons who, as a result of their office, position or trade, have been entrusted with facts which, owing to their nature or in accordance with a legal provision, must be kept secret, the right to refuse to give evidence concerning facts to which the obligation of secrecy relates.

## II – **The dispute in the main proceedings and the question referred for a preliminary ruling**

9. The request for a preliminary ruling has arisen in the context of a dispute between the German company Coty Germany GmbH ('Coty Germany'), exclusive licensee of the Community trade mark 'Davidoff Hot Water', and Stadtsparkasse Magdeburg ('the Sparkasse').

10. In January 2011, Coty Germany purchased a bottle of perfume bearing the trade mark 'Davidoff Hot Water' on an online auction platform. It paid the price of the product into the Sparkasse bank account supplied by the seller. After Coty Germany discovered that it had purchased a counterfeit product, it asked the auction platform to provide it with the real name of the holder of the user account from which the perfume was sold to it (the sale had been made under an alias). The person named admitted to being the holder of the user account on the online auction platform but denied being the seller of the product and, relying on her right not to give evidence, refused to provide further information. Coty Germany then contacted the Sparkasse under Paragraph 19(2) of the Law on trade marks, asking it for the name and address of the holder of the bank account into which it had been required to pay the price of the counterfeit goods purchased. The Sparkasse invoked banking secrecy and refused to provide Coty Germany with that information. Coty Germany then brought an action

before the Landgericht Magdeburg (Magdeburg Regional Court), which ordered the Sparkasse to provide the information requested. The Sparkasse lodged an appeal with the Oberlandesgericht Naumburg (Naumburg Higher Regional Court), relying on Paragraph 383(1)(6) of the ZPO (to which Paragraph 19(2) of the Law on trade marks refers), which protects, inter alia, the right of banking institutions not to give evidence in civil proceedings by invoking banking secrecy. The appeal court found in favour of the Sparkasse. Coty Germany then appealed in cassation to the Bundesgerichtshof (Federal Court of Justice), claiming again that the banking institution should be ordered to provide it with the information requested.

11. In those circumstances, the Bundesgerichtshof decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

'Must Article 8(3)(e) of Directive 2004/48/EC be interpreted as precluding a national provision which, in a case such as that in the main proceedings, allows a banking institution to refuse, by invoking banking secrecy, to provide information pursuant to Article 8(1)(c) of that directive concerning the name and address of an account holder?'

12. Written observations were lodged in the present proceedings by Coty Germany, the Sparkasse, the European Commission and the German Government.

## III – **Summary of the parties' positions**

13. In its observations, Coty Germany argues that Article 8(3) of Directive 2004/48 precludes a national provision which allows a banking institution to invoke banking secrecy in order to refuse to supply the name and address of a bank account holder to a person requesting that information under Article 8(1)(c) of the directive. Coty Germany submits that anyone who infringes a trade mark right will never give permission for someone who provides a service to him within the meaning of Article 8(1)(c) of Directive 2004/48 to transmit data relating to his identity (which are personal data for the purposes of Directive 95/46) to the proprietor of an infringed right. Coty Germany claims that the conflicting interests should be weighed up in the light of the facts of the particular case, bearing in mind that anyone who sells clearly counterfeit goods does not deserve to have his identity protected.

14. The Sparkasse, which focuses in its observations on the inadmissibility of the question referred for a preliminary ruling, a point with which I shall deal shortly, submits, as regards the substance, that there is another simple remedy available to Coty Germany for the purpose of revealing the identity of the alleged infringer of the trade mark right, namely criminal proceedings, which would enable it to have access to the information gathered by the prosecutor's office, against which banking secrecy cannot be invoked. In addition, the Sparkasse states that its right not to give evidence cannot be contingent on a weighing-up of the conflicting interests in the particular case. Moreover, the Sparkasse points out that, when it comes to deciding whether or not to supply the information requested, a banking institution is not in a position to evaluate whether or not an infringement of a trade mark is obvious for the purposes of Paragraph 19(2)(1) of the Law on trade marks.

15. The German Government contends that Article 8(1)(c) of Directive 2004/48 should be interpreted as meaning that the reply to a request for information submitted under that provision must take into account the circumstances of the specific case and satisfy the requirements of the principle of proportionality when weighing up the conflicting fundamental rights. According to the German Government, EU data protection law (in particular, Directive 95/46) does not preclude *a priori*, in the circumstances of the present case, the disclosure of the information requested. The German Government further submits that what it describes as the 'exception' in Article 8(3)(e) of Directive 2004/48 is not applicable to the present case. The national provision under which it is possible to refuse to supply the information requested by invoking banking secrecy is not a provision governing the processing of personal data within the meaning of Article 8(3)(e). In the German Government's

opinion, it is instead a provision protecting the confidentiality of information sources within the meaning of Article 8(3)(e), a concept which, according to the German Government, also includes the confidentiality of the information itself. The German Government maintains that that provision of the directive must, in any event, be interpreted as allowing the national court to weigh up the conflicting fundamental rights and assess the circumstances of each individual case.

16. Lastly, the Commission states in its observations that Article 8(3)(e) of Directive 2004/48 does not preclude a national provision which allows a banking institution to invoke banking secrecy in order to refuse to provide the information requested, provided that that provision meets certain conditions; in particular, it must satisfy the requirements of the principle of legal certainty, must govern the processing of personal data and must enable the national court in each individual case to weigh up the conflicting fundamental rights.

## IV – **Analysis**

### A – *Admissibility*

17. Before addressing the substantive issue raised in the question referred by the Bundesgerichtshof, it is necessary to deal with the question of admissibility raised by the Sparkasse, the defendant in the main proceedings. The Sparkasse argues that the dispute before the referring court is not governed by Directive 2004/48 but by national law alone, in view of the fact that the request for information was not submitted in the context of proceedings concerning an infringement of an intellectual property right (Article 8(1) of Directive 2004/48, in conjunction with Paragraph 19(2)(2) of the Law on trade marks) but rather in a case of 'obvious infringement' of a trade mark (Paragraph 19(2)(1) of the Law on trade marks) — which, according to the defendant, is not provided for in the directive — in the following manner.

18. According to the Sparkasse, Article 8(1) of Directive 2004/48 does not provide for an autonomous substantive right to request information from a third party but instead grants that right only in the context of proceedings concerning an infringement of an intellectual property right — in the present case, a Community trade mark — and in response to a justified and proportionate request from the applicant. The Sparkasse maintains that, in the present case, no proceedings for infringement have been brought by the proprietor of the trade mark (or by the licensee in this case) against the infringer of its right, in the context of which the applicant requests certain information from a third party, and that instead the applicant is exercising an autonomous substantive right which is governed not by the directive but by national law alone.

19. I believe that that objection to admissibility should be rejected. It seems to me significant that the case of 'obvious infringement' was inserted into the Law on trade marks in 2008, with account specifically being taken also of those situations where, as a result of the inherent features of German procedural law, which does not allow civil proceedings to be brought against an unidentified person, there may still be no proceedings for infringement of an intellectual property right because the person against whom the action will be brought has not yet been identified. [5]

5 — BT-Drs. 16/5048, pp. 38 and 39, in conjunction with the draft German law transposing Directive 2004/48.

20. In my opinion, the expression used, inter alia, in the Spanish version of Article 8(1) of Directive 2004/48, '*en el contexto* de los *procedimientos relativos a* una infracción de un derecho de propiedad intelectual' ('*in the context* of *proceedings concerning* an infringement of an intellectual property right'),[6] is sufficiently broad to include situations such as the present one where, since there is sufficient evidence of infringement of an intellectual property right ('obvious infringement'), the request for information is clearly targeted at the objective of bringing proceedings for infringement of a trade mark. In that respect, it must be said that the request for information at issue arose 'in the context' of proceedings 'concerning' infringement of a trade mark.[7]

21. Accordingly, I believe that it must be concluded that the present case also falls within the scope of Directive 2004/48 and that the question referred for a preliminary ruling by the Bundesgerichtshof is admissible.

B – *Substance*

22. Turning now to the substance of the question, it should first of all be observed that the fundamental basis for the question referred by the Bundesgerichtshof, which the wording of the question does not state explicitly, is the provision made by Paragraph 19(2) of the Law on trade marks. As stated above, that provision expressly affords a third party from whom information is requested the possibility of refusing to provide that information if, in accordance with Paragraphs 383 to 385 of the ZPO, that party would have the right to refuse to give evidence in civil proceedings brought against the infringer. In the present case, the Sparkasse availed itself of that possibility, by invoking banking secrecy.[8]

23. It is necessary to determine whether that possibility, laid down in German law, of refusing to provide information by relying on banking secrecy respects the right to information granted to the holder or licensee of a trade mark in Article 8 of Directive 2004/48.

24. The right to information laid down in Article 8 of Directive 2004/48 is an instrumental right aimed at ensuring effective protection of intellectual property, as is apparent from recital 21 in the preamble to the directive. Its immediate objective is to level out, to a certain extent, the different amounts of information held by the alleged infringer of an intellectual property right and the holder of that right,[9] with the related impact on the effectiveness of judicial protection which the fact that the rightholder lacks the minimum information needed to bring an action against the alleged infringer may have.

6 — My emphasis. The Spanish version, like the Italian ('nel contesto dei procedimenti riguardanti la violazione di un diritto di proprietà inelletuale') and the Portuguese ('no contexto dos procedimentos relativos à violação de um direito de propriedade intelectual'), is a literal translation of the English-language version ('in the context of proceedings concerning an infringement of an intellectual property right'). The wording of the German version is '*im Zusammenhang mit* einem Verfahren wegen Verletzung eines Rechts des geistigen Eigentums' (my emphasis), while the French version uses the expression 'dans le cadre'.

7 — This view is also taken by Walter and Goebel in their analysis of Article 8 of Directive 2004/48 in Walter, M.M., and von Lewinski, S. (eds.), *European Copyright Law: a commentary*, Oxford, Oxford University Press, 2010, pp. 1263 and 1264: 'Paragraph 1 does not read "in the course of proceedings concerning an infringement of intellectual property rights", but refers to such proceedings in using the formula "in the context of" such proceedings, thus emphasising that the information must be provided *with respect to* infringement proceedings but not necessarily *in the course* of an infringement proceeding' (my emphasis).

8 — In Germany, banking secrecy is generally agreed to be a specific duty of confidentiality derived from the general duty of banking institutions to protect and not to harm their customers' financial interests, which is usually included in the general contractual conditions of the agreements which customers enter into with banking institutions and which require the latter to give a negative response to requests for information about their customers if the account holder has not consented. The general contractual conditions of Stadtsparkasse Magdeburg can be viewed on the internet at https://www.sparkasse-magdeburg.de/pdf/vertragsbedingungen/AGB.pdf. Those conditions include an express reference to banking secrecy (point 1, paragraph 1) and to the circumstances in which the banking institution may provide information concerning the customer (point 3, paragraph 2). With regard to banking secrecy, inter alia its relationship with data protection, see in particular Kahler, T., 'Datenschutz und Bankgeheimnis', in Kahler, T., and Werner, S., *Electronic Banking und Datenschutz — Rechtsfragen und Praxis*, Berlin/Heidelberg, Springer, 2008, p. 143 et seq. and the bibliography cited therein.

9 — McGuire, M.R., 'Beweismittelvorlage und Auskunftsanspruch nach der Richtlinie 2004/48/EG zur Durchsetzung der Rechte des Geistigen Eigentums', *Gewerblicher Rechtsschutz und Urheberrecht — Internationaler Teil*, 2005, p. 15, and Haedicke, M., 'Informationsbefugnisse des Schutzrechtsinhabers im Spiegel der EG-Richtlinie zur Durchsetzung der Rechte des geistigen Eigentums', in A. Ohly and others (eds.), *Perspektiven des Geistigen Eigentums und Wettbewerbsrechts — Festschrift für Gerhard Schricker zum 70. Geburtstag*, Munich, C.H. Beck, 2005, pp. 19 and 20.

Naturally, the right to information is not an absolute right and, in fact, Article 8 provides that Member States may establish certain restrictions on the exercise of that right. In that connection, although banking secrecy is not expressly included among those restrictions, paragraph 3 stipulates as follows: 'Paragraphs 1 and 2 shall apply without prejudice to other statutory provisions which … (e) govern the protection of confidentiality of information sources or the processing of personal data.' In addition, Article 2(3)(a) of Directive 2004/48 limits the right to information laid down in Article 8 by providing that that directive 'shall not affect', inter alia, Directive 95/46.

25. In the question referred for a preliminary ruling, the referring court expressly refers only to Article 8(3)(e) of Directive 2004/48 as the provision which might cover banking secrecy as a limitation of, or even an exception to, the right to information laid down in Article 8(1)(c) of the directive. The question is, therefore, whether, in the circumstances of the present case, Article 8(3)(e) of the directive allows a banking institution, relying on a national statutory provision which provides for a right to refuse to give evidence in certain circumstances, to invoke banking secrecy in order to refuse to supply the information requested in the exercise of the right laid down in Article 8(1).

26. I must point out first that, in the present case, it is necessary to focus on the second situation referred to in Article 8(3)(e), which refers to the processing of personal data, and to disregard the first, relating to the protection of confidentiality of information sources. It seems clear to me that, in the present case, that situation does not arise since it does not involve the protection of the identity of an 'information source'.

27. As regards the second situation referred to in Article 8(3)(e) of Directive 2004/48, I must begin my analysis by stating that, in my view, the national legislation at issue, as presented to the Court by the referring court, has two different consequences: first, a *direct* consequence, consisting in 'frustration' of the right to information granted in Article 8(1) of Directive 2004/48; and, second, an *indirect* consequence, consisting in an 'effect' on the fundamental right to an effective remedy and, as a possible ultimate consequence, on the fundamental right to intellectual property.

28. It must be observed at the outset that the frustration of the right to information referred to above (and, indirectly, the limitation of the fundamental rights concerned) is in turn the result of the requirements of 'banking secrecy', as the latter is set out in Paragraph 383(1)(6) of the ZPO. The referring court asks whether the objective of maintaining banking secrecy could fall within the scope of the qualification which Article 8(3)(e) of Directive 2004/48 lays down in relation to the exercise of the right to information provided for in Article 8(1), inasmuch as that right is granted 'without prejudice', in particular, 'to other statutory provisions which … govern … the processing of personal data'.

29. Accordingly, it is debatable whether the qualification in question is applicable to the present case, in view of the fact that there may be some doubt as to whether 'banking secrecy' itself, as provided for in German law, is a 'statutory provision' for the purposes of Article 8(3)(e) of Directive 2004/48, and whether the provision in Paragraph 383(1)(6) of the ZPO — to which Paragraph 19(2) of the Law on trade marks refers — is intended to govern the 'processing of personal data', as the German Government, in particular, has pointed out in its observations. [10]

10 — See point 59 et seq. of those observations.

30. However, it must be borne in mind that in many situations, as occurs in the present case, what underlies the application of that provision is whether or not certain personal data relating to particular individuals should be disclosed to the court.[11] Furthermore, it must also be borne in mind that, in any event, Article 2(3)(a) of Directive 2004/48 includes a general clause on respect for the provisions of Directive 95/46 relating to the protection of personal data. Accordingly, an interpretation of Article 8(3)(e) of Directive 2004/48 in accordance with the fundamental right to protection of personal data enshrined in Article 8 of the Charter of Fundamental Rights of the European Union ('Charter') leads me to believe that the national legislation at issue is covered by Article 8(3)(e) of Directive 2004/48.

31. With the meaning of the national legislation thus defined, I believe that, in order to examine whether that legislation is compatible with Directive 2004/48, it is first necessary to make an assessment of it from the perspective of the guarantee of the fundamental rights involved. In that regard, it must be concluded at the outset that the effect of the national legislation concerned is to impose a 'limitation on the exercise' of the fundamental rights to an effective remedy and to intellectual property, within the meaning of Article 52(1) of the Charter. The legitimate interest of the banking institution in maintaining banking secrecy, a manifestation of the duty of confidentiality which governs the relationship with its customer, has the effect of limiting two fundamental rights of the proprietor or licensee of the trade mark (the latter in so far as it is the holder of certain financial rights relating to the trade mark) within the meaning of Article 52(1) of the Charter, specifically its right to intellectual property (Article 17(2) of the Charter) and its right to an effective remedy laid down in Article 47 of the Charter,[12] which is a necessary instrument for the purpose of protecting the former right.

32. Article 52(1) of the Charter allows a limitation on the exercise of fundamental rights based on two alternative objectives: the limitation must meet an objective of general interest recognised by the Union (first alternative) or the need to protect the rights and freedoms of others (second alternative). While I am aware that it falls to the national court to identify definitively the legitimate aim pursued by the legislation at issue, it is to my mind clear that the present case comes within the scope of the second alternative (although I am not ruling out the possibility that there may also be 'objectives of general interest' within the meaning of the first, related to the fact that banking institutions carry out an activity essential to the functioning of the economic system as a whole). In that respect, I believe that the limitation of the licensee's right to an effective remedy and his right to intellectual property, arising from the effect of banking secrecy — as a result of which the banking institution is obliged not to disclose data relating to its customer's identity and banking activities without that person's consent — essentially meets the need of safeguarding the customer's right (also recognised as a fundamental right in Article 8 of the Charter) to protection of personal data held by the banking institution.

33. Article 52(1) of the Charter contains detailed rules on the conditions in which it is lawful to provide for a 'limitation' of a fundamental right. In that regard, for the limitation of fundamental rights at issue in this case to be lawful, it must satisfy all the conditions laid down in that provision; that is, it must be provided for by law, it must respect the essence of the rights and freedoms concerned, and, finally, it must be appropriate and necessary in order to attain the objective pursued and it must respect the principle of proportionality.

11 — Disclosure of the name and address of the holder of the account (alleged infringer) with the Sparkasse, requested by Coty Germany, would, if it occurred, constitute disclosure of personal data, that is information relating to an identified or identifiable natural person (in accordance with the definition in Article 2(a) of Directive 95/46) and also 'processing of personal data' (in accordance with the definition in Article 2(b) of Directive 95/46).

12 — The right to an effective remedy enshrined in Article 47 of the Charter is a reaffirmation of the principle of effective judicial protection, a general principle of EU law stemming from the constitutional traditions common to the Member States (see judgments in *Unibet*, C-432/05, EU:C:2007:163, paragraph 37; *Kadi and Al Barakaat International Foundation* v *Council and Commission*, C-402/05 P and C-415/05 P, EU:C:2008:461, paragraph 335; and *AJD Tuna*, C-221/09, EU:C:2011:153, paragraph 54).

34. The task of examining whether the German legislation at issue satisfies the requirements of Article 52(1) of the Charter falls to the national court. Because of its better knowledge of the specific features of 'a case such as that in the main proceedings', of which the referring court makes mention, it falls to that court to determine, definitively, whether or not the circumstances are present which would render lawful a limitation of the fundamental rights arising from the effect of banking secrecy.

35. I shall now outline below, drawing attention to the Court's case-law on the subject, the elements necessary to enable the national court to examine, in the light of Article 52(1) of the Charter, the extent to which the legitimate interest of the banking institution in maintaining banking secrecy (i) may validly limit the right to an effective remedy of a person who, as a preliminary step for defending before the courts the rights derived from a Community trade mark, seeks to assert the right to information granted to him under Article 8(1) of Directive 2004/48, and (ii) may also limit, as a possible final consequence, that person's fundamental right to intellectual property.

1. Legality and essence

36. Article 52(1) of the Charter provides that the limitation 'must be provided for by law'; in other words, it must respect the principle of legality so that a limitation will be acceptable only if it is founded on a legal basis in national law, which must be accessible, clear and foreseeable.[13] As the referring court states at point 22 of its order for reference, the situation in the present case is that '[b]anking secrecy in Germany is not … directly established by statutory provision but is derived in German law from the general duty of a bank to safeguard the financial interests of its contractual partner and not to damage those interests'. The Bundesgerichtshof goes on to state that, in Germany, 'the protection of banking secrecy results indirectly from Paragraph 383(1)(6) of the ZPO, which establishes a right to refuse to give evidence in respect of facts which are covered by banking secrecy … [which] normally also include the name and address of the account holder'.

37. As I observed in my opinion in *Scarlet Extended*,[14] for the purposes of Article 52(1) of the Charter, the term 'law' should be understood in its 'substantive' sense, and not only its 'formal' one, as meaning that it may include both 'written law' and 'unwritten law' or even 'judge-made law', so that 'consistent decisions' which are published and therefore accessible and are followed by the lower courts are able, in some circumstances, to supplement a legislative provision and clarify it to the point of rendering it foreseeable.

38. It is for the referring court to confirm the extent to which the case-law on Paragraph 383(1)(6) of the ZPO makes it possible to establish that although banking secrecy is not expressly enshrined in German law in any legislative provision, it satisfies the requirements of the principle of legality in the terms set out above (in particular, the requirements of accessibility, clarity and foreseeability) and may, in principle, render lawful the limitation of the fundamental rights referred to above, provided that the other requirements of Article 52(1) of the Charter are met.

39. Article 52(1) of the Charter also provides that the limitation must respect the 'essence' of the fundamental right or rights concerned. In that connection, the most serious doubts which arise concern, in particular, Coty Germany's right to an effective remedy. In Germany, the effectiveness of the remedy sought by the licensee of an infringed trade mark appears to be contingent, in circumstances such as those in the present case, solely and exclusively on whether the banking institution from whom the information is requested, which has a contractual duty of confidentiality to its customer, waives, for whatever reason, the right not to give evidence conferred on it under

13 — See, in that connection, point 53 of the Opinion of Advocate General Kokott in *Promusicae*, C-275/06, EU:C:2007:454, which refers to the judgment in *Österreichischer Rundfunk*, C-465/00, C-138/01 and C-139/01, EU:C:2003:294, paragraphs 76 and 77.

14 — C-70/10, EU:C:2011:771, point 99.

Paragraph 383(1)(6) of the ZPO.[15] It is for the national law of the different Member States to govern the procedure for application of EU law in accordance with the principle of procedural autonomy (so that, in principle, each Member State may decide the terms in which it governs the right of certain persons not to give evidence on facts of which they have knowledge). The degree of latitude available to the Member States when exercising that competence is limited by the requirement that the effectiveness of the protection must be guaranteed at all times, so that the exercise of the rights conferred by EU law is not rendered impossible in practice or excessively difficult.[16] In any event, it is clear that the essence of the rights would not be respected if the national legislation at issue resulted in the frustration of the right of any holders of intellectual property rights to obtain protection from the courts.

2. Proportionality in the broad sense

40. In accordance with the second sentence of Article 52(1) of the Charter, '[s]ubject to the principle of proportionality, limitations may be made only if they are necessary and genuinely meet … the need to protect the rights and freedoms of others'. In that connection, it will be necessary to assess whether, in the circumstances of the present case, preventing Coty Germany, by virtue of reliance on banking secrecy, from exercising the right to an effective remedy, thereby also leaving unprotected its right to intellectual property, is appropriate, necessary and proportionate for the purpose of achieving the legitimate objective pursued, which, in my view, as I have stated above, is to safeguard the alleged infringer's right to protection of the data held by the banking institution with which the infringer holds an account.

a) Appropriateness

41. First, as far as compliance with the first requirement is concerned, the question of appropriateness necessitates an examination of whether the limitation of the licensee's fundamental rights to an effective remedy and intellectual property is appropriate in order to achieve the objective pursued; that is, in the words of Article 52(1) of the Charter, whether 'it genuinely meets' the need, in this case, to safeguard the account holder's right to data protection.

b) Necessity

42. Second, and this appears to be particularly important in the circumstances of the present case, it must be established whether the limitation is really necessary in order to achieve that objective. The limitation of Coty Germany's fundamental rights will be necessary only if the aim pursued (protection by the bank of its customer's data) cannot be achieved by a measure which limits those rights to a lesser degree. I believe that, in this regard, it will be necessary to assess, in particular, whether the data which Coty Germany has requested from the Sparkasse could possibly be obtained by other means or from a different source, other than the banking institution.[17] In addition, it will also be necessary to examine here the feasibility of the suggestion made by the Sparkasse in its observations,

15 — In that regard, the reference made in point 19 of this Opinion to the impossibility of bringing civil proceedings in Germany against an unidentified person should be borne in mind. As Advocate General Trstenjak pointed out in her Opinion in *Hypoteční banka*, C-327/10, EU:C:2011:561, '[i]f an applicant were unable to bring an action against a defendant who cannot be traced even after all investigations required by good conscience and good faith have been undertaken, the applicant's right to effective legal protection could be rendered entirely devoid of meaning' (point 131).

16 — See, inter alia, judgments in *Safalero*, C-13/01, EU:C:2003:447, paragraph 49; *Weber's Wine World and Others*, C-147/01, EU:C:2003:533, paragraph 103; *Wells*, C-201/02, EU:C:2004:12, paragraph 67; and *Unibet*, C-432/05, EU:C:2007:163, paragraph 43; and the Opinion of Advocate General Trstenjak in *N.S. and Others*, C-411/10 and C-493/10, EU:C:2011:611, points 160 and 161. The principle of effectiveness is now enshrined not only in the right to an effective remedy as recognised in Article 47 of the Charter but also, in the specific area of interest in this case, in Article 3 of Directive 2004/48.

17 — In that respect, it must be borne in mind in the present case that Coty Germany had already tried, unsuccessfully, to obtain that information from the auction platform through which it purchased the counterfeit product and from the person whom that platform identified as the holder of the user account from which the sale was made.

to the effect that Coty Germany could bring criminal proceedings against an unknown person in order to obtain the name of the alleged infringer by that route. For that purpose, the national court will have to determine to what extent the holder or licensee of the mark can be required to have recourse to criminal proceedings and, as a preliminary point, whether that is even possible in practice under the relevant national law (and, if it is, whether it might constitute an unacceptable abuse of criminal proceedings for purposes unrelated to such proceedings).

c) Proportionality in the strict sense

43. Finally, the analysis of proportionality will require an examination of the extent to which the objective of protection of certain rights vis-à-vis other fundamental rights sufficiently compensates for the sacrifices involved. The national court must take into account, amongst other factors, the type and extent of the information requested by Coty Germany, which, on the basis of the case-file, appears to be limited to what is strictly necessary in order to bring legal proceedings against the alleged infringer; the degree of evidence which exists of an infringement of an intellectual property right; [18] the degree of evidence which exists that the account holder whom Coty Germany seeks to identify may have acted unlawfully; [19] the extent to which the person allegedly trading in counterfeit goods deserves to have their identity protected, in particular because, as Coty Germany argues in its observations, provision of a correct name and address is amongst the obligations of anyone acting in good faith in the course of trade; [20] the existence of substantial damage caused to the proprietor of the protected trade mark; and the guarantees regarding the use which Coty Germany will make of any data it succeeds in obtaining, so that the information disclosed is used only to commence proceedings against the alleged infringer and not for other purposes unrelated to that objective. In any event, in the context of that examination of proportionality, the national court must take into account all the fundamental rights affected and, accordingly, proceed to strike a balance between the conflicting fundamental rights. [21]

44. Having regard to the foregoing considerations, I believe that Article 8(3)(e) of Directive 2004/48 must be interpreted as precluding national legislation which has the effect of unconditionally allowing a banking institution to refuse, by relying on banking secrecy, to provide information concerning the name and address of a bank account holder which has been requested from it under Article 8(1)(c) of that directive. Such an effect will be compatible with the aforementioned provision of the directive only in so far as it results from a prior assessment, which it falls to the national court to carry out, which ensures the lawfulness of the limitation of the fundamental rights affected by the national legislation at issue, in accordance with Article 52(1) of the Charter of Fundamental Rights of the European Union.

18 — See, in that connection, *Bonnier Audio and Others*, C-461/10, EU:C:2012:219, paragraph 58, which held to be acceptable for the purposes of EU law national legislation requiring, inter alia, that, for an order for disclosure of the data in question to be made, there be *clear evidence* of an infringement of an intellectual property right, and the Opinion of Advocate General Trstenjak in *N.S. and Others*, C-411/10 and C-493/10, EU:C:2011:611, point 159. It should be recalled that, in the present case, the referring court states, at point 2 of the order for reference, that '[t]he perfume was clearly recognisable as counterfeit, even to a non-specialist'.

19 — Unlike in *Promusicae*, C-275/06, EU:C:2008:54, in which Advocate General Kokott stated, at point 115 of her Opinion, EU:C:2007:454, that 'it does not follow conclusively from the fact that copyrights were infringed under an IP address at a particular time that those acts were also carried out by the subscriber to whom that address was assigned at that time', in the present case, the starting point is — rightly, in my view — that the holder of the account into which the price of the counterfeit goods was paid was the person (or one of the persons) who benefited financially from infringement of the trade mark right.

20 — In that regard, it should be borne in mind that in *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 142, the Court held that 'although it is certainly necessary to respect the protection of personal data, the fact remains that when the infringer is operating in the course of trade and not in a private matter, *that person must be clearly identifiable*' (my emphasis). In the present case, it is clear that the person who sold the counterfeit perfume acted 'on a commercial scale' for the purposes of Directive 2004/48 since, according to the case-file, from mid-December 2010 to mid-January 2011, the turnover for the user account with the online auction platform from which the sale was made exceeded EUR 10 000.

21 — See in that connection, judgments in *Promusicae*, C-275/06, EU:C:2008:54, and *Bonnier Audio and Others*, C-461/10, EU:C:2012:219; and the order in *LSG-Gesellschaft zur Wahrnehmung von Leistungsschutzrechten*, C-557/07, EU:C:2009:107.

## V – **Conclusion**

45. In the light of the foregoing considerations, I propose that the Court of Justice should reply to the Bundesgerichtshof as follows: Article 8(3)(e) 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 precluding national legislation which has the effect of unconditionally allowing a banking institution to refuse, by relying on banking secrecy, to provide information concerning the name and address of a bank account holder which has been requested from it under Article 8(1)(c) of that directive. Such an effect will be compatible with the aforementioned provision of the directive only in so far as it results from a prior assessment, which it falls to the national court to carry out, which ensures the lawfulness of the limitation of the fundamental rights affected by the national legislation at issue, in accordance with Article 52(1) of the Charter of Fundamental Rights of the European Union.