

**Judgment in interim relief proceedings of 2 November 2006**

In the case of

the private company with limited liability **TOMTOM INTERNATIONAL B.V.**,  
with registered office in Amsterdam,  
plaintiff,  
attorney of record: H.J.A. Knijff  
attorneys at law: H.F.R. van Heemstra and K.Th.M. Stopertie in Amsterdam

versus

1. the company incorporated under foreign law  
**GARMIN CORPORATION**,  
with registered office in Shijr, Taipei  
County, Taiwan;
2. the company incorporated under foreign law  
**GARMIN INTERNATIONAL, INC.**,  
with registered office in Olathe, Kansas,  
United States of America;
3. the company incorporated under foreign law  
**GARMIN EUROPE LTD.**,  
with registered office in Romsey, Hampshire,  
United Kingdom;
4. the company incorporated under foreign law  
**GARMIN LTD.**,  
with registered office in George Town,  
Grand Cayman, Cayman Islands;

attorney at record: P.J.M. von Smidt auf Altenstadt

attorney at law: K.A.J. Bisschop in Amsterdam

Hereinafter the parties will be referred to as TomTom and Garmin

**1. The proceedings**

1.1 The course of proceedings so far is evident from:

- the writ of summons
- the statement of defence in interim relief proceedings and document containing exhibits,
- the hearing,
- the pleading notes of TomTom with exhibits,
- the pleading notes of Garmin with exhibits.

1.2. Finally, judgment has been determined.

**2. The facts**

2.1. At the so-called CeBit trade show, held on 18 March 2004 in Hannover, Germany, TomTom displayed in public a navigation device under the name "TomTom GO", which looks as follows:

[pictures]

2.2. Since the end of 2004 Garmin, or at least the defendant under 3, puts also a navigation device on the market in Europe, including Netherlands, with the type specifications C-320, C-330, C-340 and C510, C-530 and C-550. These designs look as follows:

[pictures]

2.3. On 15 December 2004 TomTom filed an application for a Community design, which design has been registered on 8 March 2005 under number 000267968-0001 with the description "Portable electronic navigation devices". The following drawings have been attached to the design:

[drawings]

### **3. The dispute**

3.1 TomTom claims - summarized and after an amendment of claim - an injunction relating to both its above mentioned registered Community design and its non-registered Community design in the EU, all under penalty of a forfeiture and with ancillary claims.

3.2 Garmin has brought forward a defence. The parties' contentions are dealt with further below to the extent that they are of significance.

### **4. The judgment**

#### *Jurisdiction*

4.1. Concerning the international jurisdiction it is considered as follows. It has not become plausible that the defendants under 1, 2 and 4 have a European branch office with the defendant under 3 (in the United Kingdom). With respect to these defendants, who are not domiciled in the EU, the jurisdiction of the Dutch judge covers the entire territory of the EU (82 sub 2 in conjunction with 83 sub 1 CDR). As to the defendant under 3 the jurisdiction is limited to the Netherlands, now that this defendant is domiciled in the United Kingdom (82 sub 5 in conjunction with 83 sub 2 CDR).

4.2. The exclusive jurisdiction of the interim relief judge in The Hague to hear claims in interim relief proceedings based on a Community design is founded on article 81 CDR (Regulation 6/2002, hereinafter CDR) in conjunction with article 3 of the Implementation Act (*Uitvoeringswet*).

#### *Infringement design rights*

4.3. Against the submission of TomTom that there would be an unlawful copy of its registered design, Garmin has defended itself by indicating that there is insufficient similarity between the designs. The interim relief judge accepts this defence as well-founded for which the following is considered.

4.4. In the court's preliminary opinion the Garmin design produces a different overall impression on the informed user than the registered design. The following differences turn the

scale in that respect. The front of the TomTom design is rectangular, whereas the Garmin designs are broader at the bottom than at the top, as in a truncated pyramid, and the side panels are somewhat bowed. This provides the designs, when viewing them at the front (which according to TomTom is the most important view) with a clearly different appearance. It is further notable that the corners at the front of the Garmin designs are considerably sharper (and mainly remain in a horizontal level) than the relatively rounded corners (also in the depth, see in particular the drawings 0001.3 and 0001.4 of the design) of the TomTom design. Finally, when looking at the front it attracts attention that the TomTom design at the bottom part has a slot for the memory card, two buttons and a round hole/small lamp, whilst all of this is missing in the Garmin designs. See the following comparative figure (on the left hand side drawing 0001.1 of the design, in the middle the Garmin 300 series and on the right hand side the Garmin 500 series):

[pictures]

4.5. To the foregoing very significant differences in the other views of the designs can be added. The following figures are self explanatory, in which in addition to numerous differences in the detail, in particular the significantly more angular overall shape of the Garmin designs is striking (at the top each time the relevant drawing from the registered design, in the middle the Garmin 300 series and at the bottom the Garmin 500 series):

Rear view (0001.2):

Top view: (0001.3):

[picture]

[picture]

Bottom view (0001.4):

Side view (0001.5):

[picture]

[picture]

4.6 In this respect it should be noted that in a preliminary assessment it has become sufficiently plausible that a part of the similarity in the front view is caused by the technical measure to use a touch screen, as the result of which a bank of buttons on the side, which was in use in the prior art designs, was no longer necessary. Thus it was logical to place the LCD screen in the front view symmetrically. This is insufficiently altered by the fact that there was already a design on the market with a touch screen, i.e. the Streetpilot 2610 of Garmin, which was still provided with buttons on the side of the screen. Garmin has persuasively explained that these buttons were maintained in order to be used by motor drivers wearing gloves whereas this requirement had been dropped with respect to the designs in suit. The choice for an internal antenna, which is also of a technical nature, can also not be considered as distinctive.

4.7. The fact that certain journalists and analysts have indicated in a number of publications that the designs of Garmin are a counterfeit or a copy of the TomTom GO, if relevant at all, does not alter this opinion. In the first place it is by no means certain that this would be *communis opinio*. Any additional evidence in the form of a relevant market research is missing, whereas there is no room for further investigation of this within the framework of these interim relief proceedings. In the second place these writers will not have had knowledge of the fact, which in the court's preliminary opinion is plausible, that some of the similarity in the front view is mainly based on the use of a touch screen in the TomTom GO which rendered the bank of buttons on the side which were usual until then (in a normal use in a car) superfluous.

4.8. On the basis of the same analyses there is also no infringement of the non-registered design relating to the TomTom GO.

*Conclusion*

4.9. The claims must be rejected because in the court's preliminary opinion there is no case of infringement of the design rights of TomTom or at least it is insufficiently certain that the court in the case on the merits will conclude to that effect. The further defences of Garmin do not need to be discussed. TomTom, as the party against which judgment has been given, will be ordered to pay the costs of these proceedings. The costs of Garmin have not been disputed and are assessed, by the application of article 14 of the Enforcement Directive (Directive 2004/48/EG) on:

- court fees	EUR	248.00
- other costs		0.00
- lawyers fees		37,000.00
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Total	EUR	37,248.00

## 5. The ruling

The interim relief judge:

5.1. dismisses the claims,

5.2. orders TomTom to pay the costs relating to the proceedings, estimated to the date of this ruling on Garmin's side at EUR 37,248.00.

5.3. rules that this judgment as far as the order for costs is concerned is provisionally enforceable.

This judgment has been delivered by E.F. Brinkman and pronounced in public on 2 November 2006.