

Court of Justice EU, 19 October 2017, Merck v Merck



TRADEMARK LAW – PRIVATE INTERNATIONAL LAW

The condition laid down in Article 109(1)(a) of the EU Trade Mark Regulation as to the existence of the ‘same cause of action’ is only present in so far as those actions relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

- **Any other interpretation would lead to the result that the possibilities for a proprietor of an EU trade mark — who has initially brought an action for infringement against an alleged infringer on the basis of an identical national trade mark before a court of a Member State having jurisdiction, in infringement matters, limited solely to the territory of that Member State — to assert the rights which he derives from an EU trade mark in the territory of other Member States would be unduly restricted.**

Such an interpretation would be contrary to the objective, referred to in recital 15 of Regulation No 207/2009, of strengthening the protection of EU trade marks.

44. In view of the foregoing considerations, the answer to the first and second questions is that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘same cause of action’ is satisfied where actions for infringement between the same parties, on the basis of a national trade mark and an EU trade mark respectively, are brought before the courts of different Member States, only in so far as those actions relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

Where actions for infringement, the first on the basis of a national trade mark concerning an alleged infringement within the territory of a Member State and the second on the basis of an EU trade mark concerning an alleged infringement in the entire territory of the European Union, are brought before the courts of different Member States between the same parties, the court other than the court first seised must decline jurisdiction in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seised.

- **territorial scope of the prohibition restricted under these circumstances**

The court other than the court first seised is not required to decline jurisdiction in favour of the court first seised:

- **if the actions in question no longer relate to the territory of the same Member States**

In the light of the foregoing considerations, the answer to the fifth and sixth questions is that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘same cause of action’ is no longer satisfied where, following a partial withdrawal by an applicant, provided that it was properly declared, of an action for infringement on the basis of an EU trade mark seeking initially to prohibit the use of that trade mark in the territory of the European Union, such a withdrawal concerning the Member State referred to in the action brought before the court first seised, on the basis of a national trade mark seeking to prohibit the use of that trade mark within the territory of that Member State, the actions in question no longer relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

- **if the trade marks concerned are not identical and valid for identical goods or services**

In that regard, it is clear from the wording of Article 109(1)(a) of Regulation No 207/2009 that that provision applies ‘*where the trade marks concerned are identical and valid for identical goods or services*’.

61. It follows that the court other than the court first seised must, where the EU trade mark and the national trade mark are identical, decline jurisdiction in favour of the court first seised only in so far as those trade marks are valid for identical goods or services.

62. In the light of the foregoing considerations, the answer to the seventh question is that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, where the trade marks are identical, the court other than the court first seised must decline jurisdiction in favour of the court first seised only in so far as those trade marks are valid for identical goods or services.

Source: curia.europa.eu

Court of Justice EU, 19 October 2017

(M. Ilešič (Rapporteur), A. Rosas, C. Toader, A. Prechal, E. Jarašiūnas)

JUDGMENT OF THE COURT (Second Chamber)

19 October 2017 (*)

(Reference for a preliminary ruling — Regulation (EC) No 207/2009 — EU trade mark — Article 109(1) — Civil actions on the basis of EU trade marks and national trade marks — Lis pendens — Meaning of ‘same cause of action’ — Use of the name ‘Merck’ on the internet in domain names and on social media platforms — One action based on a national trade mark followed by another based on an EU trade mark — Disclaimer of jurisdiction — Scope)

In Case C-231/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Landgericht Hamburg (Regional Court, Hamburg, Germany), made by decision of 14 April

2016, received at the Court on 25 April 2016, in the proceedings
Merck KGaA

v

Merck & Co. Inc.,
Merck Sharp & Dohme Corp.,
MSD Sharp & Dohme GmbH,
THE COURT (Second Chamber),
composed of M. Ilešič (Rapporteur), President of the
Chamber, A. Rosas, C. Toader, A. Prechal and E.
Jarašiūnas, Judges,
Advocate General: M. Szpunar,
Registrar: K. Malacek, Administrator,
having regard to the written procedure and further to
the hearing on 15 February 2017,
after considering the observations submitted on behalf
of:

– Merck KGaA, by S. Völker and M. Pemsler,
Rechtsanwälte,
– Merck & Co. Inc., Merck Sharp & Dohme Corp. and
MSD Sharp & Dohme GmbH, by A. Bothe, Y.
Draheim and P. Fromlowitz, Rechtsanwälte,
– the European Commission, by T. Scharf and M.
Wilderspin, acting as Agents,
after hearing [the Opinion of the Advocate General](#)
at the sitting on 3 May 2017,
gives the following

Judgment

1. This request for a preliminary ruling concerns the
interpretation of Article 109(1) of Council Regulation
(EC) No 207/2009 of 26 February 2009 on the
European Union trade mark (OJ 2009 L 78, p. 1).
2. The request been made in proceedings between
Merck KGaA and Merck & Co. Inc., Merck Sharp &
Dohme Corp. and MSD Sharp & Dohme GmbH,
concerning the former's applications for an injunction
prohibiting the latter companies from using the name
'MERCK' on the internet in domain names and social
media platforms, as well as in business names, both in
Germany and elsewhere in the European Union.

Legal context

Regulation (EC) No 44/2001

3. Council Regulation (EC) No 44/2001 of 22
December 2000 on jurisdiction and the recognition and
enforcement of judgments in civil and commercial
matters (OJ 2001 L 12, p. 1) replaced, in relations
between the Member States, the Convention of 27
September 1968 on jurisdiction and the enforcement of
judgments in civil and commercial matters (OJ 1978 L
304, p. 36),

4. Recital 15 of Regulation No 44/2001 stated:

*'In the interests of the harmonious administration of
justice it is necessary to minimise the possibility of
concurrent proceedings and to ensure that
irreconcilable judgments will not be given in two
Member States. There must be a clear and effective
mechanism for resolving cases of lis pendens ...'*

5. Article 27 of that regulation, which was in Section 9
of Chapter II, entitled 'Lis pendens — related actions',
provided:

*'1. Where proceedings involving the same cause of
action and between the same parties are brought in the
courts of different Member States, any court other than
the court first seised shall of its own motion stay its
proceedings until such time as the jurisdiction of the
court first seised is established.'*

*2. Where the jurisdiction of the court first seised is
established, any court other than the court first seised
shall decline jurisdiction in favour of that court.'*

Regulation No 207/2009

6. Recitals 3 and 15 to 17 Regulation No 207/2009
state:

*'(3) For the purpose of pursuing the [European
Union's] ... objectives it would appear necessary to
provide for ... arrangements for [EU] trade marks
whereby undertakings can by means of one procedural
system obtain [EU] trade marks to which uniform
protection is given and which produce their effects
throughout the entire area of the [European Union].
The principle of the unitary character of the [EU] trade
mark thus stated should apply unless otherwise
provided for in this Regulation.'*

...

*(15) In order to strengthen the protection of [EU] trade
marks the Member States should designate, having
regard to their own national system, as limited a
number as possible of national courts of first and
second instance having jurisdiction in matters of
infringement and validity of [EU] trade marks.'*

*(16) Decisions regarding the validity and infringement
of [EU] trade marks must have effect and cover the
entire area of the [European Union], as this is the only
way of preventing inconsistent decisions on the part of
the courts and the [European Union Intellectual
Property Office (EUIPO)] and of ensuring that the
unitary character of [EU] trade marks is not
undermined. The provisions of [Regulation No
44/2001] should apply to all actions at law relating to
[EU] trade marks, save where this Regulation
derogates from those rules.'*

*(17) Contradictory judgments should be avoided in
actions which involve the same acts and the same
parties and which are brought on the basis of [an EU]
trade mark and parallel national trade marks. For this
purpose, when the actions are brought in the same
Member State, the way in which this is to be achieved is
a matter for national procedural rules, which are not
prejudiced by this Regulation, whilst when the actions
are brought in different Member States, provisions
modelled on the rules on lis pendens and related
actions of [Regulation No 44/2001] appear
appropriate.'*

7. Article 1(2) of Regulation No 207/2009 states:

*'An EU trade mark shall have a unitary character. It
shall have equal effect throughout the [European
Union]: it shall not be registered, transferred or
surrendered or be the subject of a decision revoking the
rights of the proprietor or declaring it invalid, nor shall
its use be prohibited, save in respect of the whole
[European Union]. This principle shall apply unless
otherwise provided in this Regulation.'*

8. Article 109 of that regulation, entitled ‘Simultaneous and successive civil actions on the basis of [EU] trade marks and national trade marks’, in Section 1 of Title XI of that regulation, which is entitled ‘Civil actions on the basis of more than one trade mark’, states, in paragraph 1(a):

‘Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seised on the basis of an EU trade mark and the other seised on the basis of a national trade mark:

(a) the court other than the court first seised shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested’.

The dispute in the main proceedings and the questions referred for a preliminary ruling

9. The applicant in the main proceedings, Merck, is a chemical and pharmaceutical undertaking which, according to the order for reference, employs approximately 40 000 employees and operates in 67 countries worldwide.

10. The first defendant in the main proceedings, Merck & Co., is the publicly listed parent company of the second defendant in the main proceedings, Merck Sharp & Dohme, which primarily sells medicines and vaccines, as well as cosmetic and healthcare products. According to the order for reference, Merck Sharp & Dohme is responsible for the operational activities of the group and, in particular, its internet visibility, particularly through the publication of information of interest to its shareholders. The third defendant in the main proceedings, MSD Sharp & Dohme, is a German subsidiary of Merck & Co.

11. The applicant and the defendants in the main proceedings were initially part of the same group of companies. However, they have been completely separate since 1919.

12. It is clear from the order for reference that Merck is the proprietor of the national trade mark MERCK, registered in the United Kingdom. It is also the proprietor of the EU word mark MERCK for goods in Classes 5, 9 and 16 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and for services in Class 42 of that agreement.

13. Several agreements were entered into successively between the company which was Merck’s predecessor in title and the company which was Merck Sharp & Dohme’s predecessor in title. Those agreements, the most recent of which is still in force, laid down rules governing the use of Merck’s trade marks by Merck Sharp & Dohme in Germany and in other states.

14. From the website of the defendants in the main proceedings, www.merck.com, any user in Germany or in another Member State is led, in particular by way of links, to secondary websites which also include content

reflecting the internet presence of the defendants in the main proceedings, such as www.merckengage.com, www.merckvaccines.com or www.merck-animal-health.com. On those websites, the dissemination of information is not geographically targeted, with the result that all of the content is accessible in the same form worldwide.

15. Alongside their internet domain names, Merck & Co. and Merck Sharp & Dohme have established other forms of online visibility on several social media platforms.

16. On 8 March 2013, the applicant in the main proceeding brought an action before the High Court of Justice of England and Wales, Chancery Division (United Kingdom) against, in particular, Merck & Co. and Merck Sharp & Dohme, for an alleged infringement of its national trade mark due to the use of the name ‘Merck’ in the United Kingdom.

17. On 11 March 2013, the applicant in the main proceedings also brought an action before the Landgericht Hamburg (Regional Court, Hamburg, Germany) against the same defendants, but also against MSD Sharp & Dohme, on the basis of the EU trade mark of which it is the proprietor.

18. As is apparent from the order for reference, the applicant in the main proceedings takes the view that the fact that the websites of the defendants in the main proceedings, screenshots of which it submitted, are accessible in the European Union, and therefore also in Germany, without geographical targeting of the dissemination, infringes its trade mark rights.

19. By pleadings of 11 November 2014, 12 March 2015, 10 September 2015 and 22 December 2015, the applicant in the main proceedings amended its heads of claim before the referring court and stated that it was withdrawing its action in so far as the applications related to the territory of the United Kingdom. That withdrawal was opposed by the defendants in the main proceedings

20. The defendants in the main proceedings take the view that the action pending before the referring court is inadmissible in the light of Article 109(1)(a) of Regulation No 207/2009, at least in so far as it relates to the plea in law alleging infringement of the EU trade mark owned by the applicant in the main proceedings in the entire European Union. The partial withdrawal declared by the applicant in the main proceedings is said to be irrelevant in that regard.

21. The Landgericht Hamburg (Regional Court, Hamburg) notes that Article 109(1)(a) of Regulation No 207/2009 appears to exclude any limitation of the territorial scope of a possible declining of jurisdiction on the part of the court other than the court first seised, in circumstances such as those at issue in the main proceedings. However, the referring court has doubts in that regard.

22. In those circumstances, the Landgericht Hamburg (Regional Court, Hamburg) decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

(1) Must the term “same cause of action” in Article 109(1)(a) of [Regulation No 207/2009] be interpreted as applying to the maintenance and use of a worldwide, and therefore also EU-wide, identical online internet presence under the same domain name, on account of which actions for infringement between the same parties have been brought before the courts of different Member States, one action being for infringement of an EU trade mark and the other being for infringement of a national trade mark?

(2) Must the term “same cause of action” in Article 109(1)(a) of Regulation No 207/2009 be interpreted as applying to the maintenance and use of worldwide, and therefore also EU-wide, identical online content on the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, in each case — as regards the relevant domain names “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, on account of which actions for infringement between the same parties have been brought before the courts of different Member States, one action being for infringement of an EU trade mark and the other being for infringement of a national trade mark?

(3) Must Article 109(1)(a) of Regulation No 207/2009 be interpreted as meaning that when a “court other than the court first seized” of a Member State is seized of an “action for infringement” of an EU trade mark through the maintenance of a worldwide, and therefore also EU-wide, identical online website under the same domain name, and claims have been put forward to it under Article 97(2) and Article 98(1)(a) of Regulation No 207/2009 in relation to acts of infringement committed or threatened within the territory of any of the Member States, it must decline jurisdiction under Article 109(1)(a) of Regulation No 207/2009 only for the territory of the other Member State in which a court had been “first” seized of a claim for infringement of a national trade mark (which is identical to and covers identical goods as the EU trade mark asserted before the “court other than the court first seized”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical online internet presence under the same domain name, to the extent that both the marks themselves and the goods and services covered are identical, or, in such a situation, must the “court other than the court first seized”, to the extent that both the marks themselves and the goods and services covered are identical, decline jurisdiction with regard to all claims put forward before it under Article 97(2) and Article 98(1)(a) of Regulation No 207/2009 in relation to acts of infringement committed or threatened within the territory of any of the Member States and therefore in relation to EU-wide claims?

(4) Must Article 109(1)(a) of Regulation No 207/2009 be interpreted as meaning that when a “court other than the court first seized” of a Member State is seized of an “action for infringement” of an EU trade mark on account of the maintenance of worldwide, and therefore also EU-wide, identical online content on the internet domain names “facebook.com” and/or

“youtube.com” and/or “twitter.com”, each — as regards the relevant domain names of “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, and claims have been put forward to it under Article 97(2) and Article 98(1)(a) of Regulation No 207/2009 in relation to acts of infringement committed or threatened within the territory of any of the Member States, it must decline jurisdiction under Article 109(1)(a) of Regulation No 207/2009 only for the territory of the other Member State in which a court was “first” seized of a claim for infringement of a national trade mark (which is identical to and covers identical goods as the EU trade mark asserted before the “court other than the court first seized”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical online content on the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, each — as regards the relevant domain names “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, to the extent that both the marks themselves and the goods and services covered are identical, or in such a situation must the “court other than the court first seized”, to the extent that the marks themselves and the goods and services covered are identical, decline jurisdiction with regard to all claims put before it under Article 97(2) and Article 98(1)(a) of Regulation No 207/2009 in relation to the acts of infringement committed or threatened within the territory of any of the Member States and therefore in relation to EU-wide claims?

(5) Must Article 109(1)(a) of Regulation No 207/2009 be interpreted as meaning that the withdrawal of an action — brought before the “court other than the court first seized” of a Member State, for infringement of an EU trade mark infringement through the maintenance of a worldwide, and therefore also an EU-wide, identical online internet presence under the same domain name, in which claims had initially been put forward under Article 97(2) and Article 98(1)(a) of Regulation No 207/2009 in relation to acts of infringement committed or threatened within the territory of any of the Member States — in relation to the territory of the other Member State in which a court was “first seized” of a claim for infringement of a national trade mark (that is identical to and covers identical goods as an EU trade mark asserted at the “court other than the court first seized”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical online internet presence under the same domain name, precludes a declining of jurisdiction by the “court other than the court first seized” under Article 109(1)(a) of Regulation No 207/2009 to the extent that the marks themselves and the goods and services covered by the marks are identical?

(6) Must Article 109(1)(a) of Regulation No 207/2009 be interpreted as meaning that the withdrawal of an action — brought before a “court other than the court first seized” of a Member State, on account of

infringement of an EU trade mark through the maintenance of worldwide, and therefore also EU-wide, identical online content of the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, each — as regards the relevant domain names “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, with which claims had initially been made under Article 97(2) and Article 98(1)(a) of Regulation No 207/2009 in relation to acts of infringement committed or threatened within the territory of any of the Member States — in relation to the territory of the other Member State in which a court was first seised of a claim for infringement of a national mark (that is identical to and covers identical goods as an EU trade mark asserted at the “court other than the court first seised”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical online content on the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, each — as regards the relevant domain names of “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, precludes a declining of jurisdiction by the “court other than the court first seised” under Article 109(1)(a) of Regulation No 207/2009 to the extent that the marks themselves and the goods and services covered by the marks are identical?

(7) Must Article 109(1)(a) of Regulation No 207/2009 be interpreted as meaning that it follows from the wording “where the trade marks concerned are identical and valid for identical goods or services” that, in a situation where the marks are identical, the “court other than the court first seised” is without jurisdiction only in so far as the EU trade mark and the earlier national trade mark are registered for the same goods and/or services, or is the “court other than the court first seised” entirely without jurisdiction, even when the EU trade mark asserted before that court also protects additional goods and/or services that are not protected by the other national mark, for which the contested acts may be identical or similar?’

Consideration of the questions referred

The first and second questions

23. By its first and second questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘*same cause of action*’ is satisfied where actions for infringement between the same parties, the first on the basis of a national trade mark concerning an alleged infringement within the territory of a Member State and the second on the basis of an EU trade mark concerning an alleged infringement in the entire territory of the European Union, are brought before the courts of different Member States.

24. Under Article 109(1)(a) of Regulation No 207/2009, where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one

seised on the basis of an EU trade mark and the other seised on the basis of a national trade mark, the court other than the court first seised is required, of its own motion, to decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services.

25. The wording of Article 109(1)(a) of Regulation No 207/2009 does not define what is to be understood by the phrase ‘*same cause of action*’ in that provision.

26. It must be recalled that, according to the Court’s settled case-law, it follows from the need for a uniform application of EU law and from the principle of equality that the wording of a provision of EU law which, as in the present case, 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, having regard not only to its wording but also to the context of the provision and the objective pursued by the rules of which it forms part (see, *inter alia*, judgments of 26 May 2016, *Envirotec Denmark*, C-550/14, EU:C:2016:354, paragraph 27, and of [18 May 2017, *Hummel Holding*, C-617/15, EU:C:2017:390, paragraph 22 and the case-law cited](#)).

27. At the outset, it should be pointed out that the scope of Article 109(1)(a) of Regulation No 207/2009 cannot be determined on the basis of an exclusively textual interpretation due to the differences between the various language versions of that provision (see, to that effect, judgment of 15 March 2017, *Al Chodor*, C-528/15, EU:C:2017:213, paragraph 32 and the case-law cited).

28. While certain language versions, such as the Spanish, French and Slovenian language versions make reference to actions for infringement brought involving ‘*the same acts*’, other language versions, such as the English and Lithuanian language versions, refer to actions involving the ‘*same cause of action*’ or, even, such as the Danish language version, to actions with the same ‘*subject matter*’ and ‘*legal basis*’.

29. As regards the context of the provision at issue, it should be noted, first, that, as is clear from recital 17 of Regulation No 207/2009, Article 109 of that regulation is modelled on the rules on *lis pendens* contained in Regulation No 44/2001, Article 27(1) of which states that, where proceedings involving the same cause of action and between the same parties are brought in the courts of different Member States, any court other than the court first seised is required, of its own motion, to stay its proceedings until such time as the jurisdiction of the court first seised is established, and Article 27(2) of which states that, where the jurisdiction of the court first seised is established, the court other than the court seised is required to decline jurisdiction in favour of that court.

30. Second, it should be pointed out that the procedural rules laid down by Regulation No 207/2009 are *lex specialis* in relation to the procedural rules contained in Regulation No 44/2001. Thus, pursuant to Article 94(1) of Regulation No 207/2009, the provisions of

Regulation No 44/2001 are, in so far as Regulation No 207/2009 does not provide otherwise, applicable to proceedings relating to EU trade marks and to proceedings relating to simultaneous and successive actions on the basis of EU trade marks and national trade marks, which suggests a coherent interpretation of the concepts contained in those instruments.

31. As regards the objective of Article 109(1) of Regulation No 207/2009, it should be noted that, according to recital 17 of the regulation, it is intended to avoid contradictory judgments in actions which involve the same acts and the same parties and which are brought on the basis of an EU trade mark and parallel national trade marks.

32. That objective corresponds to one of the objectives of Regulation No 44/2001, which is, in particular, according to recital 15 of that regulation, to minimise the possibility of concurrent proceedings and to ensure that irreconcilable judgments will not be given in different Member States.

33. It must therefore be found that the condition relating to the existence of the ‘same cause of action’ within the meaning of Article 109(1) of Regulation No 207/2009 must be given the same interpretation as that given by the Court to the condition relating to the existence of proceedings involving the ‘same cause of action’ within the meaning of Article 27(1) of Regulation No 44/2001.

34. Furthermore, it must be observed, in that regard, that the English language versions of those provisions use the same wording as regards the condition relating to the identical nature of the subject matter of the proceedings.

35. It follows from the foregoing considerations that, in order to establish whether, in the context of the application of Article 109(1) of Regulation No 207/2009, the condition relating to the existence of the ‘same cause of action’ is satisfied, it is necessary, as the Advocate General indicated in points 49 and 50 of his [Opinion](#), to establish whether the actions for infringement under Article 109(1)(a) of Regulation No 207/2009 have the same cause of action.

36. According to the case-law on Article 21 of the Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, the Court’s interpretation of which is equally valid for Article 27 of Regulation No 44/2001, the ‘cause of action’ comprises the facts and the rule of law relied on as the basis of the action (see, by analogy, [judgments of 6 December 1994, Taty, C-406/92, EU:C:1994:400, paragraph 39](#), and of 22 October 2015, [Aannemingsbedrijf Aertssen and Aertssen Terrasements, C-523/14, EU:C:2015:722, paragraph 43](#)).

37. In the present case, first, it is necessary to find, as did the Advocate General in point 51 of his [Opinion](#), that successive civil actions on the basis of EU trade marks and national trade marks must be considered, for the purposes of the application of Article 109(1)(a) of Regulation No 207/2009, as having the same basis, given that they are based on exclusive rights arising

from identical trade marks. If the action brought before the court first seised is based on a national trade mark, while the action brought before the court other than the court first seised is based on an EU trade mark, such a circumstance is inherent in the rule of *lis pendens* laid down in Article 109(1)(a) of Regulation No 207/2009.

38. Second, as regards the cause of action, it is clear from the order for reference that the actions initiated before the High Court of Justice of England and Wales, Chancery Division and the Landgericht Hamburg (Regional Court, Hamburg) respectively concern the use of the term ‘Merck’ on the internet in domain names and on social media platforms which are accessible worldwide. Therefore, it is apparent that, subject to verification by the referring court, the condition relating to the identical nature of the facts, like that relating to the identical nature of the cause of action, is satisfied in the present case.

39. As regards the ‘*subject matter*’, the Court has stated that this means the end the action has in view ([see, by analogy, judgments of 6 December 1994, Taty, C-406/92, EU:C:1994:400, paragraph 41](#), and of 8 May 2003, [Gantner Electronic, C-111/01, EU:C:2003:257, paragraph 25](#)); the concept of ‘subject matter’ cannot be restricted so as to mean two claims which are formally identical (see, by analogy, judgment of 8 December 1987, [Gubisch Maschinenfabrik, 144/86, EU:C:1987:528, paragraph 17](#)).

40. Account must be taken in that regard of the applicants’ respective claims in each of the sets of proceedings (see, by analogy, judgment of 14 October 2004, [Mærsk Olie & Gas, C-39/02, EU:C:2004:615, paragraph 36](#)).

41. In the present case, it must be stated that actions initiated before the High Court of Justice of England and Wales, Chancery Division and the Landgericht Hamburg (Regional Court, Hamburg) respectively concern claims which only partially overlap. Even though the actions concern the use of the name ‘Merck’ on the internet in domain names and on social media platforms, the content of which are accessible in the same form worldwide, it should be observed that the action brought before the High Court of Justice of England and Wales, Chancery Division, which is based on rights resulting from a trade mark registered in the United Kingdom, seeks to prohibit the use of the name ‘Merck’ in the United Kingdom, while the action brought before the Landgericht Hamburg (Regional Court, Hamburg), which is based on rights resulting from an EU trade mark, seeks to prohibit the use of that name in the territory of the European Union.

42. In view of the objective of Article 190(1)(a) of Regulation No 207/2009, set out in paragraph 31 above, the actions initiated before the courts listed in the previous paragraph must, for the application of the provision, be found to have the same subject matter only in so far as the alleged infringements relate to the same territory.

43. Any other interpretation would lead to the result that the possibilities for a proprietor of an EU trade mark — who has initially brought an action for

infringement against an alleged infringer on the basis of an identical national trade mark before a court of a Member State having jurisdiction, in infringement matters, limited solely to the territory of that Member State — to assert the rights which he derives from an EU trade mark in the territory of other Member States would be unduly restricted. Such an interpretation would be contrary to the objective, referred to in recital 15 of Regulation No 207/2009, of strengthening the protection of EU trade marks.

44. In view of the foregoing considerations, the answer to the first and second questions is that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘same cause of action’ is satisfied where actions for infringement between the same parties, on the basis of a national trade mark and an EU trade mark respectively, are brought before the courts of different Member States, only in so far as those actions relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

The third and fourth questions

45. By its third and fourth questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, where actions for infringement, the first on the basis of a national trade mark concerning an alleged infringement in the territory of a Member State and the second on the basis of an EU trade mark concerning an alleged infringement in the entire territory of the European Union, are brought before the courts of different Member States between the same parties, the court other than the court first seised must decline jurisdiction as regards the action for infringement brought before it in its entirety, or must only decline jurisdiction in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seised.

46. It should be noted that the wording of Article 109(1)(a) of Regulation No 207/2009 does not specify, where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seised on the basis of an EU trade mark and the other seised on the basis of a national trade mark, the extent to which the court other than the court first seised must decline jurisdiction in favour of the court first seised.

47. However, it is clear from the objective of Article 109 of Regulation No 207/2009, set out in paragraph 31 above and in the answer to the first and second questions, that the declination of jurisdiction laid down in Article 109(1)(a) of the regulation may apply only to the extent that the actions brought before those courts involve the same cause of action (see, to that effect, [judgment of 6 December 1994, Tatry, C-406/92, EU:C:1994:400, paragraphs 33 and 34](#)).

48. The condition regarding the existence of the ‘same cause of action’ within the meaning of Article 109(1)(a) of Regulation No 207/2009 is satisfied where actions for infringement between the same parties, on the basis of a national trade mark and an EU trade mark respectively, are brought before the courts of different Member States only in so far as those actions relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

49. Admittedly, as the defendants in the main proceedings have pointed out, in accordance with Article 1(2) of Regulation No 207/2009, the EU trade mark has a unitary character. Having equal effect throughout the European Union, it may not, in accordance with that provision, unless otherwise provided in that regulation, be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor may its use be prohibited, save in respect of the whole of the European Union. Furthermore, it follows from recital 3 of Regulation No 207/2009 that the objective pursued by that regulation involves the creation of arrangements for EU trade marks to which uniform protection is given and which produce their effects throughout the entire area of the European Union. Lastly, according to recital 16 of that regulation, the effects of decisions regarding the validity and infringement of EU trade marks must cover the entire area of the European Union in order to prevent inconsistent decisions on the part of the courts and of EUIPO and to ensure that the unitary character of EU trade marks is not undermined.

50. Thus, in order to guarantee the uniform protection throughout the entire area of the European Union of the right conferred by the EU trade mark against the risk of infringement, the prohibition by a competent EU trade mark court on proceeding with acts which infringe or would infringe an EU trade mark must therefore, as a rule, extend to the entire area of the European Union ([judgments of 12 April 2011, DHL Express France, C-235/09, EU:C:2011:238, paragraph 44](#), and of [22 September 2016, combit Software, C-223/15, EU:C:2016:719, paragraph 30](#)).

51. However, the territorial scope of the prohibition may in certain circumstances be restricted ([judgments of 12 April 2011, DHL Express France, C-235/09, EU:C:2011:238, paragraph 46](#), and of [22 September 2016, combit Software, C-223/15, EU:C:2016:719, paragraph 31](#)).

52. As the Advocate General observed in point 82 of his [Opinion](#), this must also apply when the court other than the court first seised is required partially to decline jurisdiction pursuant to Article 109(1)(a) of Regulation No 207/2009.

53. In the light of the foregoing considerations, the answer to the third and fourth questions is that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, where actions for infringement, the first on the basis of a national trade mark concerning an alleged infringement within the territory of a Member State and the second on the basis

of an EU trade mark concerning an alleged infringement in the entire territory of the European Union, are brought before the courts of different Member States between the same parties, the court other than the court first seised must decline jurisdiction in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seised.

The fifth and sixth questions

54. By its fifth and sixth questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘same cause of action’ is satisfied where, following a partial withdrawal by an applicant, provided that it was properly declared, of an action for infringement on the basis of an EU trade mark seeking initially to prohibit the use of that trade mark in the territory of the European Union, such a withdrawal concerning the Member State referred to in the action brought before the court first seised, on the basis of a national trade mark seeking to prohibit the use of that trade mark within the territory of that Member State, the actions in question no longer relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

55. It is clear from the order for reference that the fifth and sixth questions are based on the premiss that Article 109(1)(a) of Regulation No 207/2009 does not allow the court other than the court first seised partially to decline jurisdiction in relation to the action brought before it.

56. However, as is apparent from the answer to the first to fourth questions, where actions for infringement between the same parties, on the basis of a national trade mark and an EU trade mark respectively, are brought before the courts of different Member States, relating to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States and in the entire territory of the European Union, the court other than the court first seised must decline jurisdiction only in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seised.

57. It follows that where, following a partial withdrawal, properly declared by the applicant, of an action for infringement on the basis of an EU trade mark seeking initially to prohibit the use of that trade mark in the territory of the European Union, such a withdrawal concerning the Member State referred to in the action, brought before the court first seised, on the basis of a national trade mark seeking to prohibit the use of that trade mark within the territory of that Member State, the actions for infringement no longer relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States, the court other than the court

first seised is not required to decline jurisdiction in favour of the court first seised.

58. In the light of the foregoing considerations, the answer to the fifth and sixth questions is that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘same cause of action’ is no longer satisfied where, following a partial withdrawal by an applicant, provided that it was properly declared, of an action for infringement on the basis of an EU trade mark seeking initially to prohibit the use of that trade mark in the territory of the European Union, such a withdrawal concerning the Member State referred to in the action brought before the court first seised, on the basis of a national trade mark seeking to prohibit the use of that trade mark within the territory of that Member State, the actions in question no longer relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

The seventh question

59. By its seventh question, the referring court asks, in essence, whether Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the court other than the court first seised, where the national trade mark and the EU trade mark are identical, must decline jurisdiction in favour of the court first seised only in so far as those trade marks are valid for identical goods or services, or whether the court other than the court first seised also lacks jurisdiction where the EU trade mark relied on before the court other than the court first seised is registered for additional goods and services not covered by the identical national trade mark relied on before the court first seised.

60. In that regard, it is clear from the wording of Article 109(1)(a) of Regulation No 207/2009 that that provision applies ‘*where the trade marks concerned are identical and valid for identical goods or services*’.

61. It follows that the court other than the court first seised must, where the EU trade mark and the national trade mark are identical, decline jurisdiction in favour of the court first seised only in so far as those trade marks are valid for identical goods or services.

62. In the light of the foregoing considerations, the answer to the seventh question is that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, where the trade marks are identical, the court other than the court first seised must decline jurisdiction in favour of the court first seised only in so far as those trade marks are valid for identical goods or services.

Costs

63. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Second Chamber) hereby rules:

1. Article 109(1)(a) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘same cause of action’ is satisfied where actions for infringement between the same parties, on the basis of a national trade mark and an EU trade mark respectively, are brought before the courts of different Member States, only in so far as those actions relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

2. Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, where actions for infringement, the first on the basis of a national trade mark concerning an alleged infringement within the territory of a Member State and the second on the basis of an EU trade mark concerning an alleged infringement in the entire territory of the European Union, are brought before the courts of different Member States between the same parties, the court other than the court first seised must decline jurisdiction in respect of the part of the dispute relating to the territory of the Member State referred to in the action for infringement brought before the court first seised.

3. Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition laid down in that provision as to the existence of the ‘same cause of action’ is no longer satisfied where, following a partial withdrawal by an applicant, provided that it was properly declared, of an action for infringement on the basis of an EU trade mark seeking initially to prohibit the use of that trade mark in the territory of the European Union, such a withdrawal concerning the Member State referred to in the action brought before the court first seised, on the basis of a national trade mark seeking to prohibit the use of that trade mark within the territory of that Member State, the actions in question no longer relate to an alleged infringement of a national trade mark and an identical EU trade mark in the territory of the same Member States.

4. Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, where the trade marks are identical, the court other than the court first seised must decline jurisdiction in favour of the court first seised only in so far as those trade marks are valid for identical goods or service.

OPINION OF ADVOCATE GENERAL SZPUNAR

delivered on 3 May 2017 (1)

Case C-231/16

Merck KGaA

v

Merck & Co. Inc.,

Merck Sharp & Dohme Corp.,

MSD Sharp & Dohme GmbH

(Request for a preliminary ruling from the Landgericht Hamburg (Regional Court, Hamburg, Germany))

(Reference for a preliminary ruling — EU trade mark — Regulation (EC) No 207/2009 — Lis pendens — Article 109(1) — Simultaneous actions on the basis of an EU trade mark and a national trade mark — Meaning of ‘the same parties’ — Economically linked companies using the same trade mark — Meaning of ‘same cause of action’ — Use of the name ‘Merck’ on internet sites and online platforms — One action based on a national trade mark followed by another based on an EU trade mark — Partial lack of jurisdiction of the second court seised, as regards part of the European Union)

Introduction

1. The present request for a preliminary ruling provides the Court, for the first time, with the opportunity to interpret the lis pendens rule contained in Article 109(1) of Regulation (EC) No 207/2009, (2) which is applicable where simultaneous actions are brought on the basis of EU trade marks and national trade marks.

2. The request — which is only one episode in a legal battle between two undertakings known worldwide, over the use of the name ‘Merck’ — has been made in the course of infringement proceedings brought by Merck KGaA before a German court, sitting in its capacity as an EU trade mark court.

3. The applicant company seeks to prevent the three defendants in the main proceedings — Merck & Co. Inc., Merck Sharp & Dohme Corp. and MSD Sharp & Dohme GmbH — from using the word ‘Merck’, which is protected by the EU trade mark, on internet sites accessible in the European Union and on the Facebook, Twitter and YouTube online platforms.

4. When the German court became seised, an action was already pending between those same companies, with the exception of one of the defendants, before a court of the United Kingdom. These parallel proceedings comprise, amongst other things, an action for infringement based on the use of the term ‘Merck’, to which the national trade marks relate, on the internet.

5. The crux of the issue raised by the present request lies in the interpretation of the manner in which Article 109(1)(a) of Regulation No 207/2009 applies in a situation where the court first seised is hearing proceedings, brought on the basis of national trade marks, for infringement within the territory of a Member State, while the second court seised is an EU trade mark court with jurisdiction in respect of the entire European Union.

Legal context

6. Article 109(1) of Regulation No 207/2009 provides as follows:

‘Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seised on the basis of an [EU] trade mark and the other seised on the basis of a national trade mark:

(a) the court other than the court first seised shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its

proceedings if the jurisdiction of the other court is contested;

(b) the court other than the court first seised may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.'

The main proceedings

7. The applicant in the main proceedings is the parent company of the German group Merck, which operates in the chemical and pharmaceutical sector. Its history goes back to the 17th century.

8. The defendants in the main proceedings, two American companies and the German subsidiary of one of them, belong to the Merck & Co. group (Merck Sharp & Dohme), which is one of the world's largest pharmaceutical undertakings. Historically, this group grew out of the former American subsidiary of the German group 'Merck'. Since 1919, the two groups have been entirely separate in economic terms.

9. Following this separation, several coexistence agreements were entered into between the German group and the American group regarding the use of the trade marks protecting the name Merck. Those agreements include one dated 1 January 1970, made between the applicant in the main proceedings and Merck & Co.

10. The applicant in the main proceedings is the proprietor of several trade marks protecting that name, including national marks protected in the United Kingdom, and the EU word mark 'Merck', registered for goods in classes 5, 9 and 16, and services in class 42, of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

11. The defendants in the main proceedings operate several internet sites using the name 'Merck'. The functioning of those internet sites does not involve geographical targeting of information, the content thus being accessible in the same form throughout the world, and therefore throughout the European Union. The defendants in the main proceedings have also established other forms of internet presence, more specifically on the Facebook, Twitter and YouTube platforms.

12. On 8 March 2013, the applicant in the main proceedings brought an action against the first two defendants in the main proceedings, as well as three other companies belonging to the same group, before the High Court of Justice (England and Wales), Chancery Division (United Kingdom). That action alleges breach of the agreement of 1 January 1970 as well as infringement of national and international trade marks protected in the United Kingdom, by reason of the use of the name 'Merck' by the defendants in the main proceedings, on the internet.

13. On 11 March 2013, the applicant in the main proceedings also brought an action for infringement before the referring court, the Landgericht Hamburg (Regional Court, Hamburg, Germany), against the

defendants in the main proceedings, based on the EU trade mark Merck and on the use of the name 'Merck' on their internet sites and on the Facebook, Twitter and YouTube platforms.

14. By pleadings of 11 November 2014 and of 12 March, 10 September and 22 December 2015, the applicant in the main proceedings withdrew its action in so far as it related to the territory of the United Kingdom. This withdrawal has been opposed by the defendants in the main proceedings.

15. The defendants in the main proceedings maintain that the action pending before the referring court is inadmissible having regard to Article 109(1)(a) of Regulation No 207/2009, at least in so far as it concerns the plea alleging that the EU trade mark held by the applicant in the main proceedings has been infringed in the entire European Union. The partial withdrawal declared by the applicant in the main proceedings is said to be irrelevant in this regard.

16. The applicant in the main proceedings, for its part, maintains that since, in the second proceedings, it relies on the rights conferred on it by the EU trade mark, which are valid throughout the European Union, Article 109(1)(a) of Regulation No 207/2009 is not applicable, and that in any event, that provision is no longer applicable because of the partial withdrawal as regards the territory of the United Kingdom.

17. The referring court expresses doubt as to the interpretation of Article 109(1)(a) of Regulation No 207/2009 having regard to the circumstances of the present case. It is inclined to the view that the two actions at issue are the same and that the wording of that provision does not enable it to decline jurisdiction in part, as regards one Member State only. It also expresses uncertainty as to whether it is Article 109(1)(a) or (1)(b) of Regulation No 207/2009 which should be applied, pointing out that the EU trade mark relied on before it covers a more extensive list of goods and services than the national trade mark relied on before the United Kingdom court.

Questions referred and procedure before the Court

18. In those circumstances, the Landgericht Hamburg (Regional Court, Hamburg) decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

'(1) Must the term "same cause of action" in Article 109(1)(a) of [Regulation No 207/2009] be interpreted as applying to the maintenance and use of a worldwide, and therefore also EU-wide, identical online internet presence under the same domain name, on account of which actions for infringement between the same parties have been brought before the courts of different Member States, one action being for infringement of an EU trade mark and the other being for infringement of a national trade mark?

(2) Must the term "same cause of action" in Article 109(1)(a) of Regulation No 207/2009 be interpreted as applying to the maintenance and use of worldwide, and therefore also EU-wide, identical online content on the internet domain names "facebook.com" and/or "youtube.com" and/or "twitter.com", in each case —

as regards the relevant domain names “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, on account of which actions for infringement between the same parties have been brought before the courts of different Member States, one action being for infringement of an EU trade mark and the other being for infringement of a national trade mark?

(3) Must Article 109(1)(a) of Regulation No 207/2009 be interpreted as meaning that when a “court other than the court first seized” of a Member State is seized of an “action for infringement” of an EU trade mark through the maintenance of a worldwide, and therefore also EU-wide, identical online website under the same domain name, and claims have been put forward to it under Article 97(2) and Article 98(1)(a) of [Regulation No 207/2009] in relation to acts of infringement committed or threatened within the territory of any of the Member States, it must decline jurisdiction under Article 109(1)(a) of Regulation No 207/2009 only for the territory of the other Member State in which a court had been “first” seized of a claim for infringement of a national trade mark (which is identical to and covers identical goods as the EU trade mark asserted before the “court other than the court first seized”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical online internet presence under the same domain name, to the extent that both the marks themselves and the goods and services covered are identical, or, in such a situation, must the “court other than the court first seized”, to the extent that both the marks themselves and the goods and services covered are identical, decline jurisdiction with regard to all claims put forward before it under Article 97(2) and Article 98(1)(a) of Regulation No 207/2009 in relation to acts of infringement committed or threatened within the territory of any of the Member States and therefore in relation to EU-wide claims?

(4) Must Article 109(1)(a) of Regulation No 207/2009 be interpreted as meaning that when a “court other than the court first seized” of a Member State is seized of an “action for infringement” of an EU trade mark on account of the maintenance of worldwide, and therefore also EU-wide, identical online content on the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, each — as regards the relevant domain names of “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, and claims have been put forward to it under Article 97(2) and Article 98(1)(a) of [Regulation No 207/2009] in relation to acts of infringement committed or threatened within the territory of any of the Member States, it must decline jurisdiction under Article 109(1)(a) of [Regulation No 207/2009] only for the territory of the other Member State in which a court was “first” seized of a claim for infringement of a national trade mark (which is identical to and covers identical goods as the EU trade mark asserted before the “court other than the court first seized”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical

online content on the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, each — as regards the relevant domain names “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, to the extent that both the marks themselves and the goods and services covered are identical, or in such a situation must the “court other than the court first seized”, to the extent that the marks themselves and the goods and services covered are identical, decline jurisdiction with regard to all claims put before it under Article 97(2) and Article 98(1)(a) of [Regulation No 207/2009] in relation to the acts of infringement committed or threatened within the territory of any of the Member States and therefore in relation to EU-wide claims?

(5) Must Article 109(1)(a) of [Regulation No 207/2009] be interpreted as meaning that the withdrawal of an action — brought before the “court other than the court first seized” of a Member State, for infringement of an EU trade mark infringement through the maintenance of a worldwide, and therefore also an EU-wide, identical online internet presence under the same domain name, in which claims had initially been put forward under Article 97(2) and Article 98(1)(a) of [Regulation No 207/2009] in relation to acts of infringement committed or threatened within the territory of any of the Member States — in relation to the territory of the other Member State in which a court was “first seized” of a claim for infringement of a national trade mark (that is identical to and covers identical goods as an EU trade mark asserted at the “court other than the court first seized”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical online internet presence under the same domain name, precludes a declining of jurisdiction by the “court other than the court first seized” under Article 109(1)(a) of [Regulation No 207/2009] to the extent that the marks themselves and the goods and services covered by the marks are identical?

(6) Must Article 109(1)(a) of [Regulation No 207/2009] be interpreted as meaning that the withdrawal of an action — brought before a “court other than the court first seized” of a Member State, on account of infringement of an EU trade mark through the maintenance of worldwide, and therefore also EU-wide, identical online content of the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, each — as regards the relevant domain names “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, with which claims had initially been made under Article 97(2) and Article 98(1)(a) of [Regulation No 207/2009] in relation to acts of infringement committed or threatened within the territory of any of the Member States — in relation to the territory of the other Member State in which a court was first seized of a claim for infringement of a national mark (that is identical to and covers identical goods as an EU trade mark asserted at the “court other than the court first

seised”) through the maintenance and use of the same worldwide, and therefore also EU-wide, identical online content on the internet domain names “facebook.com” and/or “youtube.com” and/or “twitter.com”, each — as regards the relevant domain names of “facebook.com” and/or “youtube.com” and/or “twitter.com” — under the same username, precludes a declining of jurisdiction by the “court other than the court first seised” under Article 109(1)(a) of [Regulation No 207/2009] to the extent that the marks themselves and the goods and services covered by the marks are identical?

(7) Must Article 109(1)(a) of [Regulation No 207/2009] be interpreted as meaning that it follows from the wording “where the trade marks concerned are identical and valid for identical goods or services” that, in a situation where the marks are identical, the “court other than the court first seised” is without jurisdiction only in so far as the EU trade mark and the earlier national trade mark are registered for the same goods and/or services, or is the “court other than the court first seised” entirely without jurisdiction, even when the EU trade mark asserted before that court also protects additional goods and/or services that are not protected by the other national mark, for which the contested acts may be identical or similar?'

19. The order for reference was received at the Court Registry on 25 April 2016. Written observations were submitted by the parties in the main proceedings and by the European Commission. The parties to the main proceedings and the Commission presented oral arguments at the hearing, which took place on 15 February 2017.

Analysis

Preliminary observations

20. The request for a preliminary ruling in this matter will provide the Court with the opportunity to consider, for the first time, several aspects of the lis pendens rule applicable in EU trade mark law, contained in Article 109(1) Regulation No 207/2009.

21. First, as is apparent from the Commission’s written observations and from the inter partes argument at the hearing, the facts described in the order for reference give rise to doubt as to whether the ‘same parties’ condition is met. The action before the referring court was brought against the German subsidiary of the American group, which is not involved in the first proceedings. In my view it is appropriate to consider this issue — notwithstanding that it is not raised in the questions referred — in order to provide the referring court with clarification as to all relevant aspects of Article 109(1) of Regulation No 207/2009.

22. Secondly, I will analyse the issue which is central to the present case, which relates to the interpretation of the same actions condition in Article 109(1)(a) of Regulation No 207/2009. This analysis will also cover the question of whether the second court seised must decline jurisdiction in part, as regards part of the territory of the European Union (which relates to the first to fourth of the questions referred).

23. Thirdly, although the answers to the previous questions should enable the referring court to determine whether the lis pendens exception applies, I will nevertheless examine the two other aspects of the request for a preliminary ruling. These concern, first, whether the partial withdrawal is to be taken into account in assessing whether there is a situation of lis pendens (which relates to the fifth and sixth of the questions referred) and, secondly, the boundary between Article 109(1)(a) and (b) of Regulation No 207/2009 (the seventh question referred).

The lis pendens rule contained in Article 109(1)(a) of Regulation No 207/2009

24. Article 94(1) of Regulation No 207/2009 makes a general reference to the provisions of Regulation (EC) No 44/2001. (3)

25. That reference is subject to specific rules. Article 109(1) of Regulation No 207/2009 lays down such a specific rule as regards simultaneously pending civil actions based on EU trade marks and on national marks.

26. The justification for that rule lies in the coexistence of the EU trade mark and national trade marks, which is a characteristic feature of the trade mark protection system in the EU.

27. The objective of the rule in Article 109(1) of Regulation No 207/2009 accords, essentially, with that of the lis pendens rules contained in Article 27 of the Brussels I Regulation. (4) That objective consists in avoiding contradictory judgments being given in parallel actions between the same parties and involving the same cause of action. (5)

28. However, Article 109(1) of Regulation No 207/2009 deals with the issue of lis pendens in a very limited context, that of two parallel actions for infringement, one based on an EU trade mark and the other on an identical national mark.

29. In relation, therefore, to legislation drawing directly on the lis pendens rules contained in the Brussels Convention, (6) and subsequently restated in the Brussels I Regulation, the Court’s case-law as to the interpretation of the convention and regulation remains entirely relevant. (7)

30. That conclusion is supported by the fact that Regulation No 207/2009 does not cover all situations of lis pendens involving an EU trade mark. Parallel actions brought before the courts of different Member States on the basis of the same EU trade mark, for example, are covered by the lis pendens rules contained in the Brussels I Regulation (or, in relation to actions brought on and after 10 January 2015, the Regulation No 1215/2012). (8)

31. It follows that the concept of lis pendens underlying Article 109(1) of Regulation No 207/2009 must necessarily be the same as that underlying Article 27(1) of the Brussels I Regulation.

32. The concepts used in Articles 27 of the Brussels I Regulation to determine whether a situation of lis pendens exists are independent of the analogous concepts already existing in national law. (9)

33. The Court has interpreted the concept of *lis pendens* by laying down a three-fold test: the parties must be the same; the causes of action must be the same, and the object of the actions must be the same. In this regard, the Court has based its reasoning on the wording of Article 21 of the Brussels Convention in the French and other language versions, without reference to the fact that the German and English versions do not distinguish the concept of ‘object’ from that of ‘cause of action’. (10)

34. The interpretation of Article 109(1)(a) of Regulation No 207/2009 gives rise to a similar linguistic difficulty. The English version of Article 109(1)(a) of Regulation No 207/2009 uses the same expression as that used in Article 27(1) of the Brussels I Regulation, (11) whereas the French and German versions use different wording. (12)

35. Nevertheless, given that the rule concerned clearly draws on the *lis pendens* rules formulated in the context of the Brussels Convention, in my view this linguistic divergence should be disregarded. In interpreting Article 109(1) of Regulation No 207/2009, the starting point should be that that provision is based on the same concept of *lis pendens* as Article 27(1) of the Brussels I Regulation — incorporating the three-fold test under which the parties, the cause of action and the object of the actions must be the same. (13)

36. The difference between the *lis pendens* rules of Article 109 and those of the Brussels I Regulation relates to the fact that, in the former case, the requirement for the actions to be the same is met despite the difference in their formal legal basis — one being based on an EU trade mark and the other on a national trade mark — where the marks at issue are identical and valid for the same goods or services.

Whether the parties are the same

37. It is apparent from the order for reference that the second action commenced in this matter names a party as defendant which was not a defendant in the first action, namely the German subsidiary of the group constituted by the first two defendants in the main proceedings.

38. It is thus necessary to consider whether the two actions are between the same parties.

39. Where parallel proceedings have only some parties in common, the second court seised is required to decline jurisdiction only to the extent to which the parties to both sets of proceedings are the same, and the action before it can thus continue between the other parties. (14)

40. In principle, in order for the parties to be the same, they must be the same persons.

41. Nevertheless, in certain exceptional circumstances, the requirement may be met even if the parties to the parallel proceedings are different persons.

42. The Court has accepted that it is conceivable for the interests of the two parties, in relation to the subject matter of the proceedings, to be regarded as identical and indissociable to such an extent that they must be considered to be one and the same party for the purposes of application of the *lis pendens* rules. (15)

43. In my opinion such exceptional circumstances exist in the case of two parallel actions for infringement — such as those to which the present case relates — involving the same sign used by companies which are economically linked.

44. Within a group of companies, control of intellectual property rights, including trade mark rights, must be given to one of the legal persons, often the parent company, even though, in practice, the signs may be used in the same way by all group companies.

45. In those circumstances, the interests of the companies concerned, notwithstanding that they are distinct persons, exhibit such unity that those companies can be regarded as being one and the same party for the purposes of the objective of avoiding contradictory judgments in trade mark matters. (16)

46. I therefore consider that, in circumstances such as those of the present case, two parallel actions for infringement, one brought against the parent company and the other against that same company and its subsidiary, must be regarded as proceedings between the same parties where the actions relate to the use of the same sign by economically connected entities. It will, of course, be for the national court to apply those criteria in the main proceedings.

Whether the actions for infringement are the same

47. As I have already observed, Article 109(1) of Regulation No 207/2009 is based on the same concept of *lis pendens* as Article 27(1) of the Brussels I Regulation.

48. It is apparent from the case-law relating to the Brussels I Regulation that, in order to be caught by a *lis pendens* rule, actions must have the same ‘cause of action’, that is, the same factual and legal basis, (17) and the same ‘object’, that is, the end the action has in view. (18)

49. Thus the actions need not be ‘identical’ in the strict sense, but must coincide as regards their cause of action and object. (19)

50. In my view, Article 109(1)(a) of Regulation No 207/2009 is based on the same considerations, in that it provides that it is applicable to actions for infringement which involve the same cause of action and are based on identical national and EU trade marks.

51. In the present case, in relation to the cause of action relied on in the proceedings, it is apparent from the order for reference that the two actions have legal bases which are regarded as similar for the purposes of the *lis pendens* rule in Article 109(1)(a) of Regulation No 207/2009, namely the exclusive rights arising from national trade marks and from an identical EU trade mark.

52. Furthermore, the two actions involve matters of fact which overlap to some extent, in that they relate to the use of the sign ‘Merck’ on the same internet sites.

53. The difficult points of interpretation to which this dispute gives rise relate to the territorial aspect of the actions.

54. Although both actions seek to prohibit the use of the same sign, the scope of the allegations of

infringement made in them, as well as the territorial effect of the prohibitions, overlap only in part.

55. Thus, in the circumstances of the present case, the jurisdiction of the court seised of the first action is limited to the territory of the United Kingdom, whereas the second action has been brought before an EU trade mark court, pursuant to Article 97(1) to (4) of Regulation No 207/2009, that court having jurisdiction to determine whether acts of infringement have taken place within the territory of any Member State and to impose an EU-wide prohibition.

56. What is the impact of that difference on the assessment of whether the cause of action and the object of the two actions are the same?

57. The parties differ on this point. The applicant in the main proceedings considers that the difference in territorial scope between the two actions means that they cannot be regarded as the same. The defendants in the main proceedings, for their part, maintain that the situation at issue involves two actions which are the same for the purposes of Article 109(1)(a) of Regulation No 207/2009.

58. The Commission, for its part, states that the requirement for the 'cause of action' to be the same must refer to infringement of the same trade marks within the territory of the same Member States. It considers that the concept of 'the same cause of action' must be understood, in the context of Article 109(1)(a) of Regulation No 207/2009, as relating to two actions not only concerning infringement of the same trade marks, but also concerning the same territory.

59. I note that the question raised by the present dispute relates to an issue on which academic opinion is divided into two camps.

60. On the first view, Article 109(1)(a) of Regulation No 207/2009 precludes a second action for infringement in relation to the same trade mark, regardless of the territorial aspects of the two actions. In other words, that provision requires the second court seised on the basis of an EU trade mark to decline jurisdiction, even where the first action is based on a national trade mark and therefore concerns allegations of infringement limited to the territory of the Member State in question. (20)

61. On the second view, two infringing acts alleged in simultaneous actions, one based on a national trade mark and the other on an EU trade mark, are only the same where the facts relate to the same territory. The EU trade mark court is not required to decline jurisdiction to the extent that the territorial scope of the dispute before it is broader than that of the dispute before the national court which was first seised. (21) The same doubt concerning the two possible interpretations of Article 109(1)(a) is reflected in certain national judgments. (22)

62. Common to those two views is an acceptance that the wording of Article 109(1)(a) of Regulation No 207/2009 is problematic. Understood in a broad sense, it creates a lacuna in the judicial protection of the proprietor of an EU trade mark. This would lie in the impossibility of bringing an action seeking to protect

the proprietor's rights at European level, where a simultaneous action based on the national trade mark is pending before a court having jurisdiction, in infringement matters, limited to the territory of a single Member State. (23)

63. In my view, regard must be had to the scheme of the provision in order to resolve this doubt as to its interpretation.

64. The objective pursued by Article 109(1) of Regulation No 207/2009 is a product of the interaction between two principles, namely, on the one hand, the unitary nature of the EU trade mark, and, on the other, the coexistence of that trade mark with national trade marks, leading to the need to avoid contradictory judgments.

65. The link between those principles is apparent from the objectives described in recitals 16 and 17 of Regulation No 207/2009. According to those recitals, decisions regarding the validity and infringement of EU trade marks must have effect and cover the entire European Union. Furthermore, contradictory judgments should be avoided in actions which involve the same acts and which are brought on the basis of an EU trade mark and parallel national trade marks. (24)

66. The interaction of those two objectives would be undermined if Article 109(1)(a) of Regulation No 207/2009 were interpreted broadly, as preventing the proprietor of an EU trade mark from relying on the EU-wide effect of such a trade mark where a simultaneous action is pending, based on a national trade mark and relating to infringement in a more limited territory. Such an interpretation would undoubtedly contribute to achieving the objective of avoiding contradictory judgments, but it would endanger the objective of ensuring that decisions on infringement of an EU trade mark have effect across the entire European Union.

67. By contrast, a balance between those two objectives can be fully ensured by interpreting Article 109(1)(a) of Regulation No 207/2009 as being applicable only to parallel actions which relate to the same territory. Such an interpretation ensures, firstly, that the proprietor of an EU trade mark is able to protect its rights at European level, even where there is a simultaneous action based on a national trade mark. Secondly, it enables contradictory judgments to be avoided, inasmuch as the territorial jurisdiction of courts simultaneously seised on the basis of national and EU marks can be clearly delimited.

68. I therefore consider that, in circumstances where the first action is brought on the basis of a national trade mark, in relation to infringement within the territory of the Member State concerned, and the second is brought on the basis of an EU trade mark, in relation to infringement within the territory of that Member State but also in other parts of the European Union, those actions coincide only partly, to the extent of the infringement within the territory in which the national trade mark is protected.

69. That conclusion seems to be supported by the more general approach underlying the application of Article 27 of the Brussels I Regulation.

70. In the context of Article 27 of that regulation, the question whether those proceedings have the same cause of action and the same subject matter must be considered in particular in the light of the potential effects of the judgment to be given by the court first seised. Thus, it is appropriate to ask whether a party to the first proceedings would still have something to gain, in the second proceedings, having been successful or unsuccessful in the first proceedings. (25)

71. Accordingly, it is only appropriate to decline jurisdiction on the ground of *lis pendens* to the extent that the potential effects of the judgments in the two actions overlap. If that principle applies to Article 27 of the Brussels I Regulation, it must also apply to Article 109(1)(a) of Regulation No 207/2009. (26)

72. In circumstances where — as in the present case — the court first seised is ruling on infringement of a national trade mark, success in the first proceedings would not give the proprietor of the EU trade mark such extensive protection as is sought, on the basis of the EU trade mark, in the second proceedings.

73. It is true that Article 109(1)(a) of Regulation No 207/2009 is also intended to avoid a situation where the proprietor of parallel trade marks — an EU trade mark and an identical national trade mark — could bring proceedings before two courts in different Member States in relation to the same infringement.

74. Nevertheless, I observe that such an abuse of process cannot be presumed. In particular, the possibility cannot be ruled out that the proprietor of parallel marks may, in certain situations, have objective reasons for asserting its rights in two parallel actions. That appears to be the position in the present case, given that the infringement relating to the territory of the United Kingdom must be considered in conjunction with the contractual dispute arising out of the coexistence agreement of 1 January 1970.

75. Lastly, the interpretation which I propose seems to me to be supported by still more fundamental considerations, drawing on the principle of effective judicial protection enshrined in Article 47 of the Charter of Fundamental Rights of the European Union.

76. In this regard, I am conscious of the fact that the scope of the *lis pendens* rules, or of the rules for identifying the competent court generally, cannot, in principle, be altered by reference to the Charter of Fundamental Rights (27). Nevertheless, in my view, where a provision which is at issue is open to two possible readings, it is appropriate to adopt the reading on which it can be ensured that the approach taken is in line with the principle of effective judicial protection. If Article 109(1)(a) of Regulation No 207/2009 were to be interpreted as requiring the EU trade mark court to decline jurisdiction where there is a simultaneous action before a court with a more limited territorial jurisdiction, the judicial protection of the rights of the proprietor of an EU trade mark could be undermined.

77. For all of those reasons, I consider that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the cause of action and object of two actions for infringement, the first based

on a national trade mark and concerning infringement within the territory of a Member State, and the second brought on the basis of an EU trade mark and concerning infringement in the European Union as a whole, coincide only partly, to the extent that they relate to the territory of the Member State in which that national mark is protected.

Declining jurisdiction partially, in respect of only one part of the EU territory

78. What obligation is incumbent, under Article 109(1)(a) of Regulation No 207/2009, on the second court seised, where the actions for infringement coincide only partly?

79. In principle, where there is a partial overlap between the two actions, the second court seised is only required to decline jurisdiction to the extent necessary to avoid that overlap. (28)

80. That, of course, assumes that it is possible to decline jurisdiction in part in that way, having regard to the nature of the second action.

81. I note in this regard that the Court has already laid down the principles under which the EU trade mark court may, exceptionally, restrict the territorial effect of a judgment in an action for infringement, in two situations. The first is where the applicant has limited the territorial scope of its action, in the exercise of its power freely to determine the scope of the action, and the second is where the EU trade mark tribunal concludes, on the basis of the material which the defendant should, in principle, put before it, that the use of the relevant sign does not create a likelihood of confusion with the EU trade mark in one precisely defined part of the European Union. (29)

82. It seems to me to be appropriate to add a third situation in which the territorial scope of a judgment delivered in an action for infringement of an EU trade mark should be limited. This relates to cases where the EU trade mark court, being the second court seised, must decline jurisdiction in part in order to delimit the scope of simultaneous actions based on national and EU trade marks.

83. Furthermore, I consider that the responsibility for delimiting its territorial jurisdiction, in order to avoid a situation of *lis pendens*, is not that of the parties to the actions, but of the second court seised.

84. That conclusion is based both on the role of a court in determining its territorial jurisdiction and on the mechanism of the *lis pendens* rules, which provide for the court to stay the action and subsequently to decline jurisdiction as a consequence of a situation of *lis pendens*. It is also reflected in the wording of Article 109(1)(a) of Regulation No 207/2009, which requires the second court seised to decline jurisdiction of its own motion.

85. In the light of the foregoing, I consider that Article 109(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, where simultaneous actions brought on the basis of a national and an EU trade mark overlap in part, as regards the territory in which the national trade mark is protected, the EU trade mark court, where it is the second court seised, must of

its own motion decline jurisdiction as regards the part of the action which concerns the territory common to both actions.

Alternative reasoning: the consequences of partial withdrawal

86. In the light of the above analysis, it is not necessary to answer the fifth to seventh of the questions referred. I will consider them briefly, in the alternative, in case the Court thinks fit to answer them.

87. By its fifth and sixth questions, which should be considered together, the referring court asks, essentially, whether a partial withdrawal by the applicant in the main proceedings, as regards infringement within the United Kingdom, can be taken into consideration for the purposes of applying Article 109(1)(b) of Regulation No 207/2009.

88. I observe, as a preliminary matter, that the defendants in the main proceedings state that the withdrawal at issue is not effective under the national procedural rules, pursuant to which, in order to take effect unilaterally, a withdrawal must be declared before the hearing. That is a question of national law which is outside the jurisdiction of the Court. I will therefore limit myself to examining the effects of withdrawal from the point of view of Article 109(1)(b) of Regulation No 207/2009.

89. In this regard, the applicant in the main proceedings maintains that the withdrawal in the present case eliminates the overlap between the two actions, such that there is no longer a situation of *lis pendens*. The defendants in the main proceedings maintain, for their part, that whether there is a situation of *lis pendens* must be assessed as at the commencement of the proceedings, such that a withdrawal while they are ongoing cannot be taken into account.

90. As far as I am aware, the Court has not previously had the opportunity to rule on the consequences of withdrawal for the application of the *lis pendens* rules. (30)

91. It is undoubtedly true, given that the *lis pendens* rules relate to the jurisdiction of the court seised, that the decision in that regard should, in principle, be taken by reference to the situation at the time when the action is brought.

92. Nonetheless, that consideration must be reconciled with the objective of the rules in question, which are intended to avoid contradictory judgments. In my view, where, as a result of a procedural event which occurs during the course of the proceedings, there is no longer any risk of contradiction, that should be taken into account in applying the *lis pendens* rules. (31)

93. I therefore consider that where, having regard to a partial withdrawal which has taken place during the course of the second proceedings, the simultaneous actions for infringement can no longer be considered to be the same, that must be taken into account in applying Article 109(1)(a) of Regulation No 207/2009.

Alternative reasoning: whether the goods and services are identical

94. By its seventh question, the referring court seeks to establish the distinction between the situations referred

to in Article 109(1)(a) and (b) of Regulation No 207/2009.

95. While the relevance of this issue is not expressly set out in the order for reference, the arguments of parties to the main proceedings show that there is a dispute as to whether Article 109(1)(a) of Regulation No 207/2009 applies where the EU trade mark relied on before the second court seised has also been registered for additional goods and services, in comparison to the national trade mark relied on in the first proceedings.

96. In this regard, as the Commission rightly observed, it seems relevant to establish, for the purposes of applying Article 109(1)(a) of Regulation No 207/2009, whether the actions before the two courts involve allegations of infringement of a national trade mark and an EU trade mark, respectively, in relation to the same goods or services. If infringement in relation to the additional goods or services is only alleged before the second court seised, the cause of action of the two actions coincides only partly, so as to lead the court to decline jurisdiction in part.

97. However, as I have pointed out above, this issue is not relevant if the Court follows my proposed answers to the first four questions referred.

Conclusion

98. In the light of the foregoing considerations, I propose that the Court should answer the questions referred for a preliminary ruling by the Landgericht Hamburg (Regional Court, Hamburg, Germany) as follows:

Article 109(1)(a) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the EU trade mark must be interpreted as meaning that, where two actions for infringement are brought before courts of different Member States, the first on the basis of a national trade mark, concerning infringement within the territory of a Member State, and the second on the basis of an EU trade mark, concerning infringement in relation to the entire territory of the European Union, those actions coincide only partly, to the extent that they concern the territory of that Member State.

The EU trade mark court, where it is the second court seised, must of its own motion decline jurisdiction as regards the part of the action which concerns the territory common to both actions.

1 — Original language: French.

2 — Council Regulation of 26 February 2009 on the EU trade mark (OJ 2009 L 78, p. 1). Apart from the insertion of references to the ‘European Union trade mark’, Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade

Marks and Designs) (OJ 2015 L 341 p. 21) has not amended the provisions concerned.

3 — Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1) ('the Brussels I Regulation').

4 — Replaced, as from 10 January 2015, by Article 29 of Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1). Under the transitional rule contained in Article 66(1) of that regulation, the present proceedings, which were instituted before 10 January 2015, continue to be governed by the Brussels I Regulation. I note in any event that the situation of *lis pendens* referred to in the first paragraph of both articles is described in identical terms.

5 — Recital 17 of Regulation No 207/2009.

6 — Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1978 L 304, p. 36), as amended by successive conventions on the accession of further Member States to that convention ('the Brussels Convention').

7 — See the Opinion of Advocate General Tanchev in *Hummel Holding* (C-617/15, EU:C:2017:13, point 33).

8 — See Schennen, D., in Eisenführ, G., and Schennen, D., *Gemeinschaftsmarkenverordnung*, 4th edition, Carl Heymanns Verlag, Cologne 2014, article 109, point 4.

9 — See, in relation to Article 21 of the Brussels Convention, judgments of 8 December 1987, *Gubisch Maschinenfabrik* (144/86, EU:C:1987:528, paragraph 11), and of 6 December 1994, *Tatry* (C-406/92, EU:C:1994:400, paragraph 30). I do not subscribe to the view expressed by D. Schennen, who comments that whether the actions involve the same facts and the same cause of action is to be judged according to national procedural law. See Schennen, D., in Eisenführ, G., and Schennen, D., *Gemeinschaftsmarkenverordnung*, 4th edition, Carl Heymanns Verlag, Cologne 2014, article 109, point 8.

10 — See judgments of 8 December 1987, *Gubisch Maschinenfabrik* (144/86, EU:C:1987:528, paragraph 14), and of 6 December 1994, *Tatry* (C-406/92, EU:C:1994:400, paragraph 38).

11 — '[Actions/proceedings] involving the same cause of action'.

12 — In French, 'demandes ayant le même objet et la même cause' (Article 27 of the Brussels I Regulation) and 'actions en contrefaçon... formées pour les mêmes faits' (Article 109(1) of Regulation No 207/2009). In German, respectively, 'Klagen wegen desselben Anspruchs' and 'Verletzungsklagen... wegen derselben Handlungen'.

13 — See, on the connection between Regulation No 207/2009 and Article 27 of the Brussels I Regulation, the Opinion of Advocate General Bobek in *Apple and Pear Australia and Star Fruits Diffusion v EUIPO* (C-226/15 P, EU:C:2016:250, points 35 to 37). The courts

of England and Wales have come to the same conclusion as to the relationship between the two provisions — see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 1553 (Ch) (19 May 2014) para. 18.

14 — Judgment of 6 December 1994, *Tatry* (C-406/92, EU:C:1994:400, paragraph 34).

15 — See, to this effect, in relation to parallel proceedings involving insurer and insured, judgment of 19 May 1998, *Drouot assurances* (C-351/96, EU:C:1998:242, paragraphs 19 and 23).

16 — See also, for a similar view, Hartmann, M., *Die Gemeinschaftsmarke im Verletzungsverfahren*, Peter Lang, Frankfurt am Main, 2009, p. 164.

17 — Judgments of 6 December 1994, *Tatry* (C-406/92, EU:C:1994:400, paragraph 39); of 14 October 2004, *Mærsk Olie & Gas*, C-39/02, EU:C:2004:615, paragraph 38; and of 22 October 2015, *Aannemingsbedrijf Aertssen and Aertssen Terrassements* (C-523/14, EU:C:2015:722, paragraph 43).

18 — Judgments of 6 December 1994, *Tatry* (C-406/92, EU:C:1994:400, paragraph 41); of 8 May 2003, *Gantner Electronic* (C-111/01, EU:C:2003:257, paragraph 25), and of 22 October 2015, *Aannemingsbedrijf Aertssen and Aertssen Terrassements* (C-523/14, EU:C:2015:722, paragraph 45).

19 — See, in particular, Mankowski, P., and Magnus, U. (Eds), *European Commentaries on Private International Law (ECPII)*, Brussels Ibis Regulation, vol. I, Otto Schmidt, Cologne, 2016, article 29, p. 726.

20 — See Schack, H., 'Die grenzüberschreitende Durchsetzung gemeinschaftsweiter Schutzrechte', in *Festschrift für Rolf Stürner*, Mohr Siebeck, Tübingen, 2013, p. 1352.

21 — See Halbsguth, D., *Territorialität im Verletzungsverfahren aus der Europäischen Gemeinschaftsmarke*, Hamburg, 2010, pp. 117 and 118, and Janal, R., *Europäisches Zivilverfahrensrecht und Gewerblicher Rechtsschutz*, Mohr Siebeck, Tübingen 2015, §13 Rn 61.

22 — See the German case-law (OLG Düsseldorf, 08.11.2005 – I-20 U 110/04 — *RODEO/RODEO DRIVE*) as well as the United Kingdom case-law (*Prudential Assurance v Prudential Insurance* [2003] EWCA Civ 327 and *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 1553). For an analysis of those judgments, see Hartmann, M., *Die Gemeinschaftsmarke im Verletzungsverfahren*, Peter Lang, Frankfurt am Main, 2009, pp. 105 to 108.

23 — See Halbsguth, D., *op. cit.*, p. 118; Janal, R., *op. cit.*, p. 61; Schack, *op. cit.*, p. 1352. H. Schack observes that this result is 'harsh but apparently intentional' ('hart aber anscheinend gewollt').

24 — See, in relation to the link between those two recitals, judgment of 12 April 2011, *DHL Express France* (C-235/09, EU:C:2011:238, paragraph 42).

25 — See the Opinion of Advocate General Jääskinen in *Weber* (C-438/12, EU:C:2014:43, point 67).

26 — See Janal, R., *op. cit.*, §13 Rn 61.

27 — See the Opinion of Advocate General Jääskinen in Weber (C-438/12, EU:C:2014:43, points 87 and 88).

28 — See to this effect, concerning the situation where some but not all of the parties are the same, judgment of 6 December 1994, Tatry (C-406/92, EU:C:1994:400, paragraph 33).

29 — See judgments of 12 April 2011, DHL Express France (C-235/09, EU:C:2011:238, paragraphs 46 to 48), and of 22 September 2016, combit Software (C-223/15, EU:C:2016:719, paragraph 36).

30 — The Court's case-law does not provide a clear answer on this point. In the judgment of 14 October 2004, Mærsk Olie & Gas (C-39/02, EU:C:2004:615, paragraph 41), the Court had regard, for the purposes of applying Article 22 of the Brussels I Regulation, of the fact that the first proceedings had been definitively terminated, such that there were no longer any 'related actions'. By contrast, in the judgment of 8 May 2003, Gantner Electronic (C-111/01, EU:C:2003:257, paragraph 30), the Court observed that the purpose of Article 21 of the Convention would be frustrated if the content and nature of the claims could be modified by arguments necessarily submitted at a later date by the defendant, as such a solution could have the result that a court initially designated as having jurisdiction under that article would subsequently have to decline to hear the case.

31 — See, in the context of United Kingdom case-law, Briggs, A., *Civil Jurisdiction and Judgments*, Routledge, New York, 2015, p. 324. It has been observed, in this regard, that Articles 21 and 22 of the Brussels Convention relate to parallel proceedings and do not therefore apply where a party has properly brought the first proceedings to an end (*Internationale Nederlanden Aviation Lease BV v Civil Aviation Authority* [1997] 1 Lloyd's Reports 80). The Italian Corte suprema di cassazione (Court of cassation, Italy) came to a similar conclusion, in relation to Article 21 of that convention, in its judgment of 28 April 1993 (No 4992).