

Court of Justice EU, 17 December 2020, Husqvarna



## TRADE MARK LAW

The date with regard to which it must be determined whether the continuous period of five years has ended is the date on which the application or counterclaim in question was filed:

- [assessment with regard to the date of the last hearing would be against the consequences of revocation as provided for in the regulation](#)

39 It follows from Article 55(1) of Regulation No 207/2009 that an interpretation of that regulation according to which, in the event of a counterclaim for revocation, the continuous five-year period of non-use laid down in Article 51(1)(a) of that regulation must be assessed with regard to the date of the last hearing would be inconsistent with the consequences of revocation provided for in that regulation.

(...)

44 Consequently, it is apparent from the consequences of the revocation, as provided for in Article 55(1) of Regulation No 207/2009, that it is with regard to the date of the counterclaim that it must be examined whether the continuous five-year period of non-use of the mark, which is one of the circumstances enabling revocation to be established, as referred to in Article 51(1) of that regulation, has come to an end. The counterclaim can succeed only if that circumstance has been established as at that date.

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## Court of Justice EU, 17 December 2020

(E. Regan, M. Ilešič, E. Juhász, C. Lycourgos and I. Jarukaitis)

JUDGMENT OF THE COURT (Fifth Chamber)

17 December 2020 (\*)

(Reference for a preliminary ruling – EU trade marks – Regulation (EC) No 207/2009 – Article 51(1)(a) – Article 55(1) – Revocation of rights in an EU mark – EU mark which has not been put to genuine use within a continuous period of five years – Expiry of the period of five years – Date of assessment)

In Case C-607/19,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Federal Court of Justice, Germany), made by decision of 6 June 2019, received at the Court on 12 August 2019, in the proceedings

Husqvarna AB

v

Lidl Digital International GmbH & Co. KG, formerly Lidl E-Commerce International GmbH & Co. KG, THE COURT (Fifth Chamber),

composed of E. Regan, President of the Chamber, M. Ilešič, E. Juhász (Rapporteur), C. Lycourgos and I. Jarukaitis, Judges,

Advocate General: E. Tanchev,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– Husqvarna AB, by A. von Mühlendahl, C. Eckhartt and P. Böhner, Rechtsanwälte,

– Lidl Digital International GmbH & Co. KG, formerly Lidl E-Commerce International GmbH & Co. KG, by M. Wolter and A. Berger, Rechtsanwälte,

– the Italian Government, by G. Palmieri, acting as Agent, and by A. Peluso, avvocato dello Stato,

– the European Commission, by É. Gippini Fournier and T. Scharf, acting as Agents,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

### Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 51(1)(a) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1) and Article 58(1)(a) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

2 The request has been made in proceedings between Husqvarna AB and Lidl Digital International GmbH & Co. KG, formerly Lidl E-Commerce International GmbH & Co. KG ('Lidl'), concerning an action for infringement of an EU mark brought by Husqvarna against Lidl.

### Legal context

#### Regulation No 207/2009

3 Recital 3 of Regulation No 207/2009 states:

*'For the purpose of pursuing the [Union's] said objectives it would appear necessary to provide for [Union] arrangements for 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 [Union]. The principle of the unitary character of the [EU] trade mark thus stated should apply unless otherwise provided for in this Regulation.'*

4 Article 1 of that regulation, entitled '[EU] trade mark', provides in paragraph 2:

*'A[n EU] trade mark shall have a unitary character. It shall have equal effect throughout the [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 [Union]. This principle shall apply unless otherwise provided in this Regulation.'*

5 Article 14 of that regulation, entitled ‘Complementary application of national law relating to infringement’, provides in paragraph 3:

*‘The rules of procedure to be applied shall be determined in accordance with the provisions of Title X.’*

6 Title VI of Regulation No 207/2009, entitled ‘Surrender, revocation and invalidity’, contains Section 2 relating to ‘grounds for revocation’, Article 51 of which, also entitled ‘Grounds for revocation’, provides in paragraph 1:

*‘The rights of the proprietor of the [EU] trade mark shall be declared to be revoked on application to the [European Union Intellectual Property] Office [(EUIPO)] or on the basis of a counterclaim in infringement proceedings:*

*(a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the [Union] in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor’s rights in a[n EU] trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;*

*(b) if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered;*

*(c) if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.’*

7 Title VI also includes Section 4, entitled ‘Consequences of revocation and invalidity’, which contains Article 55 of that regulation, also entitled ‘Consequences of revocation and invalidity’, which provides in paragraph 1:

*‘The [EU] trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.’*

8 Title X of that regulation, entitled ‘Jurisdiction and procedure in legal actions relating to [EU] trade marks’, includes Section 2 relating to ‘disputes concerning the infringement and validity of [EU] trade marks’.

9 That section contains, inter alia, Article 101, entitled ‘Applicable law’, pursuant to which:

*‘1. The [EU] trade mark courts shall apply the provisions of this Regulation.*

*2. On all matters not covered by this Regulation a[n EU] trade mark court shall apply its national law, including its private international law.*

*3. Unless otherwise provided in this Regulation, a[n EU] trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located.’*

#### **Regulation 2017/1001**

10 Recital 24 of Regulation 2017/1001 states:

*‘There is no justification for protecting EU trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used.’*

11 Article 17 of that regulation, entitled ‘Complementary application of national law relating to infringement’, provides in paragraph 3:

*‘The rules of procedure to be applied shall be determined in accordance with the provisions of Chapter X.’*

12 Chapter VI of that regulation, entitled ‘Surrender, revocation and invalidity’, contains Section 2 relating to ‘grounds for revocation’, Article 58 of which, also entitled ‘Grounds for revocation’, provides in paragraph 1:

*‘The rights of the proprietor of the EU trade mark shall be declared to be revoked on application to [EUIPO] or on the basis of a counterclaim in infringement proceedings:*

*(a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor’s rights in an EU trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;*

*(b) if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered;*

*(c) if, in consequence of the use made of the trade mark by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.’*

13 Chapter X of that regulation, entitled ‘Jurisdiction and procedure in legal actions relating to EU trade marks’, includes Section 2 relating to ‘disputes

concerning the infringement and validity of EU trade marks’.

14 That section contains, inter alia, Article 129 of Regulation 2017/1001, entitled ‘Applicable law’, pursuant to which:

‘1. The EU trade mark courts shall apply the provisions of this Regulation.

2. On all trade mark matters not covered by this Regulation, the relevant EU trade mark court shall apply the applicable national law.

3. Unless otherwise provided for in this Regulation, an EU trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located.’

15 Articles 211 and 212 of that regulation, entitled, respectively, ‘Repeal’ and ‘Entry into force’, provide that Regulation No 207/2009 is repealed and that Regulation 2017/1001 is to enter into force on the 20th day following that of its publication in the Official Journal of the European Union, namely 6 July 2017, and is to apply from 1 October 2017.

#### **German law**

16 The first sentence of Paragraph 25(2) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (Law on the protection of trade marks and other distinctive signs) of 25 October 1994 (BGBl. 1994 I, p. 3082; ‘the MarkenG’) provides that, where an objection relating to revocation is raised in the course of proceedings, the five-year period within which use must be demonstrated is to be calculated with regard to the date on which the action is brought. However, where the period of non-use comes to an end only after the action has been brought, the relevant date, pursuant to the second sentence of Paragraph 25(2) of the MarkenG, is the date on which the hearing ends.

17 The second sentence of Paragraph 55(3) of the MarkenG provides that, in respect of an action brought by the proprietor of an earlier registered mark, it is the period of five years calculated with regard to the end of the hearing which, where the defendant has raised an objection, is to be taken into account for the purposes of assessing non-use.

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

18 Husqvarna manufactures appliances and tools for gardening and landscaping. It is the proprietor of a three-dimensional EU mark, registered on 26 January 2000 under number 456244 for the goods ‘*sprinklers for irrigation*’.

19 From July 2014 until January 2015, Lidl offered for sale a spiral hose set consisting of a spiral hose, a sprinkler nozzle and a coupling sleeve.

20 Taking the view that the product marketed by Lidl constituted an infringement of its trade mark, Husqvarna brought an action for infringement against Lidl before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), for the purposes of, inter alia, bringing the infringement to an end and obtaining damages.

21 Lidl, by way of counterclaim, requested the revocation of Husqvarna’s rights in the mark at issue in the main proceedings, alleging non-use of that mark.

22 The Landgericht Düsseldorf (Regional Court, Düsseldorf) upheld Husqvarna’s claims referred to in paragraph 20 of the present judgment and dismissed Lidl’s counterclaim.

23 Lidl brought an appeal against the judgment of that court before the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), which, following the last hearing held before it on 24 October 2017, set aside that judgment and declared that Husqvarna’s rights in the mark at issue in the main proceedings were revoked as from 31 May 2017.

24 In that respect, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) considered that the relevant date, for the purposes of calculating the continuous period of non-use, was not the date on which Lidl had filed its counterclaim, namely in September 2015, but that of the last hearing before that court, which had taken place on 24 October 2017. That court found that the goods protected by the mark at issue in the main proceedings had no longer been marketed as from May 2012 and therefore concluded that, at the date on which the counterclaim for revocation had been filed, the continuous period of five years referred to in Article 51(1)(a) of Regulation No 207/2009 had not yet expired, whereas that period had expired as at the date of the last hearing.

25 Husqvarna brought an appeal on a point of law (Revision) before the referring court, the Bundesgerichtshof (Federal Court of Justice, Germany).

26 That court takes the view that the outcome of the dispute before it depends, first, on the question whether the determination of the relevant date for the purposes of calculating the five-year period referred to in Article 51(1)(a) of Regulation No 207/2009 and Article 58(1)(a) of Regulation 2017/1001 is governed by those regulations and, second, should that be the case, on how that date is to be determined.

27 According to that court, neither Article 51(1)(a) of Regulation No 207/2009 nor Article 58(1)(a) of Regulation 2017/1001 indicates the relevant date for the purposes of calculating the five-year period of non-use referred to in those provisions, where the request for the revocation of rights in the EU mark concerned is made by way of counterclaim.

28 In that regard, the Bundesgerichtshof (Federal Court of Justice) is of the view that that question is a procedural matter and that, in the absence of any clarification in Regulation No 207/2009 and Regulation 2017/1001, it falls within the scope of national law. That court states that that assessment follows from a combined reading of Article 14(3) and Article 101(3) of Regulation No 207/2009 and of Article 17(3) and Article 129(3) of Regulation 2017/1001, as is apparent from the judgment of 22 June 2016, Nikolajeva (C-280/15, EU:C:2016:467, paragraph 28).

29 The referring court notes that, according to German civil procedure law, the court must base its decision on all arguments and facts relied on before the date on



which the last hearing ends. Where an objection relating to revocation is raised in the course of legal proceedings by way of counterclaim, German trade mark law provides, in the first sentence of Paragraph 25(2) of the MarkenG, that the five-year period within which use must be demonstrated is to be calculated with regard to the date on which the action is brought. However, where the period of non-use comes to an end only after the action has been brought, the relevant date, pursuant to the second sentence of Paragraph 25(2) of the MarkenG, is the date on which the hearing ends. Furthermore, the second sentence of Paragraph 55(3) of the MarkenG provides that, in respect of an application for declaration of invalidity of a trade mark on the ground of the existence of an earlier mark, the proprietor of that earlier mark must, where the defendant has raised an objection, prove that it has been used during the last five years prior to the end of the hearing.

30 If the answer should be that both Regulation No 207/2009 and Regulation 2017/1001 determine the date with regard to which it must be ascertained whether the five-year period has come to an end, the referring court takes the view that the relevant date should be that of the last hearing before the court hearing the appeal on the merits.

31 In that regard, the referring court states that that solution is confirmed by recital 24 of Regulation 2017/1001, according to which there is no justification for protecting EU trade marks unless they are actually used. That court adds that taking the date of the last hearing as the relevant date for the purposes of calculating the five-year period of non-use of the EU mark meets the requirement of procedural economy, in that, should that period expire in the course of the proceedings, the party making the counterclaim would not be required to file a new application or counterclaim.

32 In those circumstances, the Bundesgerichtshof (Federal Court of Justice) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

*'(1) In the case of a counterclaim for the revocation of rights in an EU trade mark which was filed prior to the expiry of the five-year period of non-use, is the determination of the date which is relevant for the purposes of calculating the period of non-use in the context of Article 51(1)(a) of Regulation No 207/2009 and Article 58(1)(a) of Regulation 2017/1001 governed by those regulations?'*

*'(2) If Question 1 is to be answered in the affirmative: In the case of a counterclaim for the revocation of rights in an EU trade mark which was filed prior to the expiry of the five-year period of non-use referred to in Article 51(1)(a) of Regulation No 207/2009 and Article 58(1)(a) of Regulation 2017/1001, must that period be calculated by taking into account the date on which the counterclaim was filed or the date of the last hearing in the appeal on the merits?'*

#### **Consideration of the questions referred**

33 By its two questions, which it is appropriate to examine together, the referring court asks, in essence, whether, in the case of a counterclaim for revocation, as

provided for in Article 51(1)(a) of Regulation No 207/2009 and Article 58(1)(a) of Regulation 2017/1001, the relevant date for the purposes of determining whether the continuous period of five years referred to in those provisions has ended is laid down by those regulations and, if so, what that date is. 34 At the outset, it must be noted that Article 101 of Regulation No 207/2009, entitled '*Applicable law*', provides, first of all, in paragraph 1, that the EU trade mark courts are to apply the provisions of that regulation. Next, paragraph 2 of that article states that, on all matters not covered by that regulation, an EU trade mark court is to apply its national law, including its private international law. Finally, that article, in paragraph 3, specifies that, unless otherwise provided in that regulation, an EU trade mark court is to apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located.

35 As regards revocation, Article 51(1)(a) of Regulation No 207/2009 provides that the rights of the proprietor of the EU trade mark are to be declared to be revoked, *inter alia*, on the basis of a counterclaim in infringement proceedings if, within a continuous period of five years, the trade mark has not been put to genuine use in the European Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

36 That being said, it must be noted, as the referring court stated, that Regulation No 207/2009 does not expressly indicate the relevant date for the purposes of calculating that continuous period of five years.

37 Nevertheless, it follows from the provisions of Regulation No 207/2009 laying down the framework of the applicable regime that the date with regard to which it must be determined whether the continuous period of five years has ended is the date on which the application or counterclaim in question was filed.

38 In that regard, it must be noted that, pursuant to the first sentence of Article 55(1) of Regulation No 207/2009, the EU trade mark is to be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in Regulation No 207/2009, to the extent that the rights of the proprietor have been revoked; the second sentence of that provision states that an earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

39 It follows from Article 55(1) of Regulation No 207/2009 that an interpretation of that regulation according to which, in the event of a counterclaim for revocation, the continuous five-year period of non-use laid down in Article 51(1)(a) of that regulation must be assessed with regard to the date of the last hearing would be inconsistent with the consequences of revocation provided for in that regulation.

40 First, an assessment with regard to the date of the last hearing would lead, as the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) held in the main proceedings, to the revocation taking effect as from the date, in the course of the proceedings, on which the

conditions referred to in Article 51(1)(a) are fulfilled, even though those conditions were not met at the time the counterclaim was filed.

41 In that regard, it must be noted that, while Article 55(1) of Regulation No 207/2009 provides that, exceptionally, the consequences of the revocation may be fixed at a date earlier than that of the counterclaim, it does not provide for such a possibility in respect of a date later than that on which that counterclaim was filed.

42 Second, it could be considered that recognising the merits of a counterclaim as from a date later than the date on which it was filed does not affect the fact that the EU mark is deemed not to have had, as from the date of filing, the effects specified in the regulations on the EU trade mark.

43 Nevertheless, an interpretation of Regulation No 207/2009 according to which, where the counterclaim is filed prior to the expiry of the five-year period of non-use, the revocation could have consequences for a period during which the conditions for the establishment of the ground for that revocation, referred to in Article 51(1)(a) of that regulation, were not yet met, cannot be accepted.

44 Consequently, it is apparent from the consequences of the revocation, as provided for in Article 55(1) of Regulation No 207/2009, that it is with regard to the date of the counterclaim that it must be examined whether the continuous five-year period of non-use of the mark, which is one of the circumstances enabling revocation to be established, as referred to in Article 51(1) of that regulation, has come to an end. The counterclaim can succeed only if that circumstance has been established as at that date.

45 Furthermore, the argument that the relevant date, for the purposes of assessing whether the continuous five-year period of non-use referred to in Article 51(1)(a) of Regulation No 207/2009 has ended, should be the date of the last hearing before the court hearing the appeal on the merits, on the ground that that interpretation would fulfil the objective of protecting marks only if they are actually used and the objective of procedural economy, cannot be accepted.

46 That line of reasoning adopts a criterion which is inconsistent with the one deriving from the relevant provisions of that regulation and is therefore liable to undermine the EU legislature's objective – referred to in recital 3 and Article 1 of Regulation No 207/2009 – of ensuring the unitary character of the EU mark.

47 That unitary character could thus be called into question if the scope of the protection of the mark that its proprietor enjoys under EU law could vary, in the context of counterclaims for revocation, according to the procedural rules of the Member States where those counterclaims are filed.

48 In particular, as the Italian Government and the European Commission submitted in their observations, the merits of a counterclaim for revocation alleging a five-year period of non-use of an EU mark cannot be dependent on the length of the national proceedings.

49 To the extent that the questions referred also concern the interpretation of Regulation 2017/1001, it must be borne in mind that, as noted in paragraph 44 of the

present judgment, it is with regard to the date on which the counterclaim is filed that it must be determined whether the continuous five-year period of non-use of the EU mark has ended. Since, in the main proceedings, Regulation No 207/2009 was still applicable when the counterclaim was filed, the questions referred must be answered in the light of that regulation only.

50 In the light of the foregoing, the answer to the questions referred is that Article 51(1)(a) of Regulation No 207/2009 must be interpreted as meaning that, in the case of a counterclaim for the revocation of rights in an EU mark, the relevant date for the purposes of determining whether the continuous five-year period referred to in that provision has ended is the date on which that counterclaim was filed.

#### Costs

51 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 (Fifth Chamber) hereby rules:

Article 51(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, in the case of a counterclaim for the revocation of rights in an EU mark, the relevant date for the purposes of determining whether the continuous five-year period referred to in that provision has ended is the date on which that counterclaim was filed.

[Signatures]

\* Language of the case: German.