

Court of Justice EU, 5 October 2017, Hanssen Beleggingen



TRADE MARK LAW – PRIVATE INTERNATIONAL LAW

Article 22(4) of Council Regulation (EC) is not applicable to disputes about whether a person is entitled to be registered as a proprietor of a trade mark

• [Article 22\(4\) of Council Regulation \(EC\) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters must be interpreted as not applying to proceedings to determine whether a person was correctly registered as the proprietor of a trade mark.](#)

33. The objective of Article 22(4) of Regulation No 44/2001 is to ensure that jurisdiction for proceedings concerned with the registration or validity of intellectual property rights rests with courts closely linked in fact and law to the register, since those courts are best placed to adjudicate on cases where the validity of the right, or even the existence of the deposit or registration, is in dispute (see, to that effect, as regards Article 16(4) of the Brussels Convention, judgment of [13 July 2006, GAT, C-4/03, EU:C:2006:457, paragraphs 21 and 22](#)).

34. Accordingly, the Court has held, in cases concerning jurisdiction in the field of patents, that, where the dispute concerns neither the validity of a patent nor the existence of its deposit or registration, the dispute is not covered by the concept of proceedings ‘concerned with the registration or validity of patents’ and therefore falls outside the exclusive jurisdiction of the courts of the Member State in which the right was registered (judgments of [15 November 1983, Duijnste, 288/82, EU:C:1983:326, paragraphs 22 to 25](#), and of [13 July 2006, GAT, C-4/03, EU:C:2006:457, paragraphs 15 and 16](#)).

35. Proceedings concerning exclusively the question of who is entitled to a patent do not therefore fall within the scope of such exclusive jurisdiction (judgment of [15 November 1983, Duijnste, 288/82, EU:C:1983:326, paragraph 26](#)).

36. As the Advocate General stated in [points 26 to 29 of his Opinion](#), that interpretation may be applied to a case relating to a trade mark, such as that in the main proceedings, which concerns neither the validity nor the registration of the trade mark but concerns exclusively the question of whether a person whose name has been registered as the proprietor is in fact the proprietor.

37. Proceedings in which there is no dispute regarding the registration of the trade mark as such or its validity are covered neither by the words ‘proceedings

concerned with the registration or validity of ... trade marks’ in Article 22(4) of Regulation No 44/2001, nor the objective underlying that provision. In that regard, the Court points out that the question of the individual estate to which an intellectual property right belongs is not, generally, closely linked in fact and law to the place where that right has been registered.

38. That appears to be the case here. As is clear from the order for reference, the proceedings concern the ownership of trade mark No 361604 following the death of Mr Knipping; it must therefore be ascertained whether that trade mark formed part of Mr Knipping’s estate at the time of his death.

39. It follows from all the foregoing considerations that a case such as that at issue in the main proceedings, which concerns exclusively the question of who must be regarded as the proprietor of the trade mark at issue, does not fall within the scope of Article 22(4) of Regulation No 44/2001.

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Court of Justice EU, 5 October 2017

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

JUDGMENT OF THE COURT (Second Chamber)

5 October 2017 (*)

(Reference for a preliminary ruling — Judicial cooperation in civil and commercial matters — Regulation (EC) No 44/2001 — Jurisdiction — Article 2(1) — Jurisdiction of the courts of the place where the defendant is domiciled — Article 22(4) — Exclusive jurisdiction in proceedings concerned with the registration or validity of intellectual property rights — Proceedings to determine whether a person was correctly registered as the proprietor of a trade mark)

In Case C-341/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by decision of 14 June 2016, received at the Court on 16 June 2016, in the proceedings

Hanssen Beleggingen BV

v

Tanja Prast-Knipping,

THE COURT (Second Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, A. Prechal, A. Rosas, C. Toader and E. Jarašiūnas, Judges,

Advocate General: H. Saugmandsgaard Øe,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– Ms Prast-Knipping, by P. Sohn, Rechtsanwalt,

– the European Commission, by M. Wilderspin and M. Heller, acting as Agents,

after hearing the [Opinion of the Advocate General](#) at the sitting on 13 July 2017,

gives the following

Judgment

1. This reference for a preliminary ruling concerns the interpretation of Article 22(4) of 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).

2. The request has been made in proceedings between Hanssen Beleggingen BV ('Hanssen'), whose registered office is in the Netherlands, and Ms Tanja Prast-Knippling, domiciled in Germany, concerning the registration of the latter as the proprietor of a Benelux trade mark.

Legal context

EU law

3. Regulation No 44/2001 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, 'the Brussels Convention'). That regulation was replaced in turn by 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). Article 66(1) of that regulation provides that it '*shall apply only to legal proceedings instituted, to authentic instruments formally drawn up or registered and to court settlements approved or concluded on or after 10 January 2015*'.

4. Since the action at issue in the main proceedings was brought before 10 January 2015, the request for a preliminary ruling must be examined in the light of Regulation No 44/2001.

5. Article 2(1) of that regulation provided:

'Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.'

6. Article 22 of Regulation No 44/2001, in Section 6 of Chapter II thereof, entitled 'Exclusive jurisdiction', stated:

'The following courts shall have exclusive jurisdiction, regardless of domicile:

...

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.

...

7. That provision corresponded to Article 16(4) of the Brussels Convention.

The Benelux Convention on Intellectual Property

8. The convention Benelux en matière de propriété intellectuelle (marques et dessins ou modèles) (Benelux Convention on Intellectual Property (Trade Marks and Designs)) of 25 February 2005, signed in The Hague (Netherlands) by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands ('the BCIP'), entered into force on 1 September 2006.

9. Paragraph 1.2 of the BCIP provides as follows:

'1.. A Benelux Organisation for Intellectual Property (Trademarks and Designs) ... shall be established;

2.. The executive bodies of the Organisation shall be:

...

(c). the Benelux Intellectual Property Office (Trademarks and Designs) ...'

10. Paragraph 1.5(1) and (2) of the BCIP specifies:

'1..The Organisation shall have its headquarters in The Hague.

2. The Office shall be set up in The Hague.'

11. Under Paragraph 4.6(1) of the BCIP:

'[The territorial jurisdiction of the courts] shall be determined in cases involving trade marks or designs by the address for service of the defendant or by the place where the obligation in dispute has arisen, or has been or should be enforced. The place in which the trade mark or design is filed or registered shall not under any circumstances be used as the sole basis for determining territorial jurisdiction.'

German law

12. Paragraph 812 of the Bürgerliches Gesetzbuch (German Civil Code) is in Title 26 thereof, headed 'Ungerechtfertigte Bereicherung' (unjustified enrichment) and provides, in paragraph 1, that '*a person who obtains something as a result of the performance of another person or otherwise at his expense without legal grounds for doing so is under a duty to make restitution to him*'.

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

13. On 7 September 1979, a company incorporated under German law owned by Mr Helmut Knipping, operating in the production of building components, in particular windows, applied to the Benelux Intellectual Property Office (Trade Marks and Designs) ('BIPO') for registration as a Benelux trade mark of the following word and figurative sign:



14. BIPO registered that trade mark in black and white under No 361604 ('trade mark No 361604').

15. Hanssen is a company incorporated under Dutch law operating in the door and window trade. It is the proprietor of Benelux word and figurative trade mark No 0684759. That trade mark is comprised of the same word and figurative sign as that covered by trade mark No 361604, but is registered in blue and yellow.

16. On 9 October 1995, Mr Knipping died.

17. On 14 November 2003, Ms Prast-Knippling, on providing a certificate stating that she was the sole heiress of Mr Knipping, requested BIPO to register her as the proprietor of trade mark No 361604.

18. BIPO complied with the request for registration.

19. Hanssen contests the registration. It claims that trade mark No 361604 had, prior to the death of Mr Knipping, been assigned several times and was no longer part of his estate at the time of his death. The registration of Ms Prast-Knippling as the proprietor of that trade mark was therefore unjustified.

20. Since the dispute was unable to be resolved by amicable agreement, on 8 June 2012, Hanssen brought an action against Ms Prast-Knippling before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), the court of the place where Ms Prast-Knippling is domiciled. Hanssen founded its action on unjustified enrichment under Paragraph 812 of the German Civil Code and sought an order that Ms Prast-Knippling declare at BIPO that she is not entitled to the trade mark in question and to waive the registration of her name as proprietor.

21. In a judgment of 24 June 2015, the Landgericht Düsseldorf (Regional Court, Düsseldorf) dismissed that action on the ground that, at the time when Mr Knipping died, trade mark No 361604 formed part of his estate and had therefore been correctly transferred to Ms Prast-Knippling by universal succession.

22. Hanssen brought an appeal against that judgment before the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany).

23. That court harbours doubts as to the jurisdiction of the German courts to hear the case. It considers that whilst jurisdiction could derive from Article 2(1) of Regulation No 44/2001, it is also possible that the courts of the Member State in which registration of the trade mark at issue in the main proceedings has taken place — namely the Netherlands, since the seat of BIPO is located at The Hague — have exclusive jurisdiction under Article 22(4) of that regulation.

24. Since jurisdiction must be assessed of the court's own motion, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) wishes the matter to be clarified.

25. According to the referring court, it is necessary, in particular, to determine whether an action such as that brought by Hanssen amounts to proceedings '*concerned with the registration or validity of ... trade marks*' within the meaning of Article 22(4) of the regulation. [The judgment of 15 November 1983, Duijnstee \(288/82, EU:C:1983:326\)](#), provides indicia suggesting that that question be answered in the negative, but, in the light of the development of trade mark law since that judgment, it is not certain that that judgment must still be taken into account.

26. As regards the development of trade mark law, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) cites, inter alia, Article 18 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21) ('Regulation No 207/2009').

27. The referring court also mentions the fact that, as regards jurisdiction, Benelux trade marks are characterised by certain specific features.

28. In those circumstances, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

'Does the notion of proceedings which are "concerned with the registration or validity of ... trade marks", within the meaning of Article 22(4) of Regulation [No 44/2001], also cover a claim, brought against the formal proprietor of a Benelux trade mark registered in the Benelux trade mark register, which seeks an order requiring that defendant to make a declaration to [BIPO] that she has no entitlement to the contested mark and that she waives registration as the proprietor of that mark?'

Consideration of the question referred

29. By its question, the referring court asks, in essence, whether Article 22(4) of Regulation No 44/2001 must be interpreted as applying to proceedings to determine whether a person was correctly registered as the proprietor of a trade mark.

30. For the purposes of answering that question, it must be borne in mind, first, that the Court has already held that Article 22(4) of Regulation No 44/2001 reflects the same system as Article 16(4) of the Brussels Convention and is, moreover, drafted in almost identical terms so that it is necessary to ensure continuity in the interpretation of those provisions (judgment of [12 July 2012, Solvay, C-616/10, EU:C:2012:445, paragraph 43](#)).

31. The Court points out, next, that the concept of proceedings '*concerned with the registration or validity of [intellectual property rights]*', referred to in those provisions, is an 'independent concept' intended to have uniform application in all contracting States (judgments of [15 November 1983, Duijnstee, 288/82, EU:C:1983:326, paragraph 19](#), and of [13 July 2006, GAT, C-4/03, EU:C:2006:457, paragraph 14](#)).

32. The Court has, lastly, held that provisions which confer exclusive jurisdiction, such as Article 16 of the Brussels Convention and Article 22 of Regulation No 44/2001, must not be given a wider interpretation than is required by their objective, since they deprive the parties of the choice of forum which would otherwise be theirs and may, in certain cases, result in a situation whereby the parties are brought before a court which is not that of any of them (judgments of 10 January 1990, Reichert and Kockler, C-115/88, EU:C:1990:3, paragraph 9, and of 12 May 2011, BVG, C-144/10, EU:C:2011:300, paragraph 30).

33. The objective of Article 22(4) of Regulation No 44/2001 is to ensure that jurisdiction for proceedings concerned with the registration or validity of intellectual property rights rests with courts closely linked in fact and law to the register, since those courts are best placed to adjudicate on cases where the validity of the right, or even the existence of the deposit or registration, is in dispute (see, to that effect, as regards Article 16(4) of the Brussels Convention, judgment of [13 July 2006, GAT, C-4/03, EU:C:2006:457, paragraphs 21 and 22](#)).

34. Accordingly, the Court has held, in cases concerning jurisdiction in the field of patents, that, where the dispute concerns neither the validity of a patent nor the existence of its deposit or registration,

the dispute is not covered by the concept of proceedings ‘concerned with the registration or validity of patents’ and therefore falls outside the exclusive jurisdiction of the courts of the Member State in which the right was registered (judgments of [15 November 1983, Duijstee, 288/82, EU:C:1983:326, paragraphs 22 to 25](#), and of [13 July 2006, GAT, C-4/03, EU:C:2006:457, paragraphs 15 and 16](#)).

35. Proceedings concerning exclusively the question of who is entitled to a patent do not therefore fall within the scope of such exclusive jurisdiction (judgment of [15 November 1983, Duijstee, 288/82, EU:C:1983:326, paragraph 26](#)).

36. As the Advocate General stated in [points 26 to 29 of his Opinion](#), that interpretation may be applied to a case relating to a trade mark, such as that in the main proceedings, which concerns neither the validity nor the registration of the trade mark but concerns exclusively the question of whether a person whose name has been registered as the proprietor is in fact the proprietor.

37. Proceedings in which there is no dispute regarding the registration of the trade mark as such or its validity are covered neither by the words ‘proceedings concerned with the registration or validity of ... trade marks’ in Article 22(4) of Regulation No 44/2001, nor the objective underlying that provision. In that regard, the Court points out that the question of the individual estate to which an intellectual property right belongs is not, generally, closely linked in fact and law to the place where that right has been registered.

38. That appears to be the case here. As is clear from the order for reference, the proceedings concern the ownership of trade mark No 361604 following the death of Mr Knipping; it must therefore be ascertained whether that trade mark formed part of Mr Knipping’s estate at the time of his death.

39. It follows from all the foregoing considerations that a case such as that at issue in the main proceedings, which concerns exclusively the question of who must be regarded as the proprietor of the trade mark at issue, does not fall within the scope of Article 22(4) of Regulation No 44/2001.

40. That interpretation is not affected by the fact that EU legislation contains certain provisions allowing the proprietor of an intellectual property right to demand the assignment to him of a registration initially made in the name of another.

41. In that regard, the referring court refers, in particular, to EU trade mark legislation and states that Article 18 of Regulation No 207/2009 confers, inter alia, jurisdiction on EU trade mark courts to rule on a claim by the proprietor of a trade mark to have the registration of the trade mark made by an agent or representative assigned to him. However, while that provision concerns specifically the relationship existing between an agent or representative and the proprietor of an EU trade mark, it does not appear that the case in the main proceedings, which concerns a Benelux trade mark, concerns such a relationship.

42. Furthermore, as regards the fact, also mentioned in the order for reference, that, as regards jurisdiction, Benelux trade marks are characterised by certain specific features, it is important to note that, contrary to the facts of the case which gave rise to the judgment of [14 July 2016, Brite Strike Technologies \(C-230/15, EU:C:2016:560\)](#), in which the Court clarified the relationship between the rule of jurisdiction set out in Paragraph 4.6 of the BCIP and that laid down in Article 22(4) of Regulation No 44/2001, the case in the main proceedings does not concern the registration or the validity of the Benelux trade mark in question or any potential infringement of that trade mark; indeed, according to the information supplied to the Court, Hanssen’s action is not founded on any substantive provision of the BCIP. In those circumstances, the specific features of the BCIP as regards jurisdiction are irrelevant to the case in the main proceedings.

43. In the light of the foregoing, the answer to the question referred is that Article 22(4) of Regulation No 44/2001 must be interpreted as not applying to proceedings to determine whether a person was correctly registered as the proprietor of a trade mark.

Costs

44. 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:

Article 22(4) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters must be interpreted as not applying to proceedings to determine whether a person was correctly registered as the proprietor of a trade mark.

OPINION OF ADVOCATE GENERAL SAUGMANDSGAARD ØE

delivered on 13 July 2017 (1)

Case C-341/16

Hanssen Beleggingen BV

v

Tanja Prast-Knipping

(Request for a preliminary ruling from the Oberlandesgericht Düsseldorf (Higher Regional Court of Düsseldorf, Germany))

(Reference for a preliminary ruling — Judicial cooperation in civil matters — Jurisdiction and enforcement of judgments — Regulation (EC) No 44/2001 — Article (2)(1) — Jurisdiction of the place where the defendant is domiciled — Article 22(4) — Exclusive jurisdiction in proceedings concerned with the registration or validity of trade marks — Proceedings concerned with the identity of the proprietor of a Benelux mark — Action against the formal proprietor of a Benelux mark seeking waiver of the rights to the mark as proprietor)

I. Introduction

1. By decision of 14 June 2016, received at the Court on 16 June 2016, the Oberlandesgericht Düsseldorf (Higher Regional Court of Düsseldorf) submitted a request to the Court for a preliminary ruling on the interpretation of Article 22(4) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters ('Brussels I'). (2)

2. The request has been made in proceedings between Hanssen Beleggingen BV and Tanja Prast-Knipping concerning a Benelux mark of which the latter is the formal proprietor.

3. The referring court enquires whether the dispute before it falls within the scope of the exclusive jurisdiction rule laid down in Article 22(4) of Brussels I in respect of proceedings '*concerned with the registration or validity of ... trade marks*', meaning that the German courts — including the referring court — would not have jurisdiction to entertain the dispute. If, on the other hand, the dispute does not fall within the scope of the exclusive jurisdiction rule, the German courts would have jurisdiction under the general jurisdiction rule laid down in Article 2(1) of Brussels I.

4. In what follows, I will set out the reasons why, in my view, proceedings such as those brought before the referring court, seeking an order requiring the person formally registered as proprietor of a mark to make a declaration to the competent authority that she has no entitlement to the mark and that she waives registration as the proprietor of that mark, does not fall within the scope of the exclusive jurisdiction rule laid down in Article 22(4) of Brussels I.

II. Legal context

5. Under the general jurisdiction rule laid down in Article 2(1) of Brussels I, '*subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State*'.

6. The first subparagraph of Article 22(4) of Brussels I, which appears in Section 6 of Chapter II entitled 'Exclusive jurisdiction', provides that the following courts shall have exclusive jurisdiction, regardless of domicile: '*in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered*', the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.

III. Main proceedings, question referred for a preliminary ruling and procedure before the Court

7. The main proceedings concern rights relating to a Benelux mark. Ms Prast-Knipping, who is the defendant in the main proceedings, resides in Hamminkeln (Germany). She is registered as proprietor of the figurative mark No 361604, reproduced below, at the Office Benelux de la propriété intellectuelle (Benelux Office for Intellectual Property, 'OBPI').



8. An application for registration of that mark was made on 7 September 1979 in favour of the undertaking Helmut Knipping. After submitting a certificate of inheritance to the OBPI identifying her as sole heiress of Mr Knipping, Ms Prast-Knipping secured the transfer of the contested mark into her name on 14 November 2003.

9. Hanssen Beleggingen BV ('Hanssen Beleggingen'), the applicant in the main proceedings, is a company with seat in the Netherlands.

10. By its application, Hanssen Beleggingen seeks an order requiring Ms Prast-Knipping to make a declaration to the OBPI stating that she is not entitled to the contested mark and that she waives registration as the trade mark proprietor. In support of its application, Hanssen Beleggingen submits that, as a result of a chain of transfers of the contested mark, it has become the actual proprietor of the rights to the contested mark. It submits that it therefore has a statutory claim against Ms Prast-Knipping for the corresponding declarations to be made to the OBPI.

11. The Landgericht Düsseldorf (Regional Court of Düsseldorf) dismissed the application by judgment of 24 June 2015 on the ground that Hanssen Beleggingen was not entitled to claim against Ms Prast-Knipping by reason of unjust enrichment, because Ms Prast-Knipping was not incorrectly registered as being formally entitled to the contested mark in the Benelux trade mark register. The court found that the contested mark was, at the time of Mr Knipping's death, among his assets and was therefore transferred by universal succession to Ms Prast-Knipping as sole heiress. It did not address the issue of the international jurisdiction of the German courts, which has not been challenged by Ms Prast-Knipping.

12. Hanssen Beleggingen brought an appeal against the above judgment before the Oberlandesgericht Düsseldorf (Higher Regional Court of Düsseldorf). That court has doubts concerning the international jurisdiction of the German courts. It states that such jurisdiction could be founded on Article 2(1) of Brussels I, given that Ms Prast-Knipping is domiciled in Germany. However, the assumption of the international jurisdiction of the German courts might, however, be precluded by the exclusive international jurisdiction of the Netherlands courts in accordance with Article 22(4) of Brussels I.

13. The referring court has also stated that, under Article 66(1) of Regulation No 1215/2012, Brussels I applies *ratione temporis* to the main proceedings since they were instituted before 10 January 2015.

14. In those circumstances, the Oberlandesgericht Düsseldorf (Higher Regional Court of Düsseldorf) decided to stay the proceedings and to refer the following question to the Court for a preliminary ruling:

'Does the notion of proceedings which are "concerned with the registration or validity of ... trade marks",

within the meaning of Article 22(4) of [Brussels I], also cover a claim, brought against the formal proprietor of a Benelux trade mark registered in the Benelux trade mark register, which seeks an order requiring that defendant to make a declaration to the [OBPI] that she has no entitlement to the contested mark and that she waives registration as the proprietor of that mark?’

15. Written observations were submitted by Ms Prast-Knippling and the European Commission. No hearing took place.

IV. Analysis

16. By the question it submits for a preliminary ruling, the referring court asks the Court whether an action such as that brought in the main proceedings, seeking an order requiring the person formally registered as proprietor of a Benelux mark to make a declaration to the OBPI that she has no entitlement to the mark and that she waives registration as the proprietor of that mark, falls within the scope of Article 22(4) of Brussels I.

17. Both Ms Prast-Knippling and the Commission take the view that this question should be answered in the negative. I share that view for the following reasons.

18. The Court has already had occasion to adjudicate on the scope of the exclusive jurisdiction rule laid down in Article 22(4) of Brussels I, particularly in *Duijnstee*. (3) One of the questions the Court addressed in that judgment was the interpretation of the concept of ‘*proceedings concerned with the registration or validity of patents*’ within the meaning of Article 16(4) of the Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters. (4) I consider that that judgment, which involves proceedings similar to the main proceedings in this case, is of critical relevance here. I note that the Court essentially confirmed the principles deriving from that judgment in *GAT*. (5)

19. In *Duijnstee*, Mr *Duijnstee*, the liquidator in the winding-up of *Schroefboutenfabriek BV*, brought an action against Mr *Goderbauer*, the former manager of that undertaking, seeking an order requiring him to transfer to the company the patents applied for and the patents granted in 22 countries in respect of an invention which Mr *Goderbauer* had made while employed by the company. (6)

20. The Court considered that concept to be an independent concept intended to have uniform application in all contracting States. (7)

21. In order to interpret that concept, the Court stated that the exclusive jurisdiction in proceedings concerned with the registration or validity of patents conferred upon the courts of the contracting State in which the deposit or registration has been applied for or taken place is justified by the fact that those courts are best placed to adjudicate on cases in which the dispute itself concerns the validity of the patent or the existence of the deposit or registration. (8)

22. Consequently, the Court held that the scope of the exclusive jurisdiction rule, interpreted narrowly in the light of the aim of proximity mentioned above, is restricted to proceedings relating to the validity,

existence or lapse of a patent or an alleged right of priority by reason of an earlier deposit. (9)

23. At the conclusion of its reasoning, the Court found that the action pending before the national court did not fall within the scope of Article 16(4) of the Brussels Convention thus defined, since it concerned neither the validity nor registration of the disputed patents and was confined to the question whether Mr *Goderbauer* or the insolvent company *Schroefboutenfabriek* was entitled to the patent, which had to be determined on the basis of the legal relationship existing between the parties concerned. (10)

24. That line of reasoning seems to me to be fully capable of being applied to this case for the following reasons.

25. In the first place, the Court has already had occasion to find that, in the light of the high degree of similarity between Article 22(4) of Brussels I and Article 16(4) of the Brussels Convention, it is necessary to ensure continuity in the interpretation of those two provisions, in accordance with recital 19 of Brussels I. (11) Indeed, Article 22(4) of Brussels I reflects the same system as Article 16(4) of the Brussels Convention and is, moreover, drafted in almost identical terms. (12) According to settled case-law, the interpretation provided by the Court in respect of the provisions of the Brussels Convention is also valid for those of Brussels I whenever the provisions of those instruments may be regarded as equivalent. (13)

26. In the second place, I see no reason not to extend the test established by the Court concerning patents in *Duijnstee* (14) to proceedings concerning trade marks. The wording of Article 22(4) of Brussels I does not draw any distinction between proceedings concerned with patents and those concerned with trade marks. Furthermore, the concepts of validity, existence, lapse or an alleged right of priority by reason of an earlier deposit are also relevant to trade marks.

27. In the third place, and pursuant to the test established by the Court in *Duijnstee*, (15) I note that the main proceedings in this case do not relate to the validity, existence or lapse of the trade mark or an alleged right of priority by reason of an earlier deposit. They are solely concerned with whether the proprietor of the contested mark is Ms *Prast-Knippling* or *Hanssen Beleggingen*, which must be determined on the basis of the legal relationship existing between the parties concerned, just as in the main proceedings in *Duijnstee*. In other words, as the Commission rightly pointed out, the instant case does not relate to the trade mark as such but to the identification of its proprietor, which is not concerned with the registration or validity of the trade mark within the meaning of Article 22(4) of Brussels I.

28. In that regard, the fact that the action brought by *Hanssen Beleggingen* seeks, inter alia, to have Ms *Prast-Knippling* waive registration as the proprietor of the contested mark does not mean that the main proceedings fall within the concept of ‘*proceedings concerned with the registration or validity of ... trade marks*’ within the meaning of the abovementioned

provision. That application is merely ancillary to the main application, which seeks recognition that the contested mark does not belong to Ms Prast-Knippling due to the existence of private agreements providing for the transfer of the mark to Hanssen Beleggingen. (16) As explained in the previous point, such a dispute does not relate to the validity, existence or lapse of the mark, or to an alleged right of priority by reason of an earlier deposit.

29. In the fourth place, as Ms Prast-Knippling and the Commission pointed out, the aim of proximity pursued by Article 22(4) of Brussels I does not prevent the main proceedings falling within the scope of the exclusive jurisdiction rule laid down in that provision. (17) The arguments under consideration in the main proceedings, which concern, in particular, the existence of unjust enrichment and the scope of agreements between private parties, (18) is extraneous to the question of the validity or registration of the contested mark. Accordingly, the courts of the State in which the mark has been registered are best placed to adjudicate on such arguments.

30. In my view it follows from the foregoing that the main proceedings do not fall within the scope of the exclusive jurisdiction rule laid down in Article 22(4) of Brussels I. Consequently, the German courts — including the referring court — have, as courts of the Member State where the defendant in the main proceedings, Ms Prast-Knippling, is domiciled, international jurisdiction to entertain those proceedings, under the general jurisdiction rule provided for in Article 2(1) of Brussels I.

31. I should make clear in that regard that the fact that the proceedings at issue may possibly fall within the scope of Article 5(3) of Brussels I, because the action brought by Hanssen Beleggingen is, in particular, based on the existence of unjust enrichment, has no bearing on the German courts' jurisdiction under Article 2(1) thereof. The former provision establishes an additional — and not exclusive — ground of jurisdiction in relation to the ground set out in the latter provision.

32. In the alternative, if the Court finds that the main proceedings fall within the scope of Article 22(4) of Brussels I, the only courts with jurisdiction to entertain the proceedings would be the courts of the Member State in which the mark has been registered. That provision lays down an exclusive ground of jurisdiction the effect of which is to preclude the application of the general jurisdiction rule laid down in Article 2(1) of Brussels I.

33. According to the information provided by the referring court, the application of Article 22(4) of Brussels I would mean that the German courts would not have jurisdiction to entertain the main proceedings. (19)

34. I wish to draw attention to the implications of Brite Strike Technologies (20) in such circumstances. It is true that the Court held in that judgment that Article 71 of Brussels I, read in the light of Article 350 TFEU, does not preclude the application to those disputes of the rule of jurisdiction for disputes relating to Benelux

trademarks and designs, laid down in Article 4.6 of the Benelux Convention on Intellectual Property (Trade Marks and Designs) (21) ('the Benelux Convention').

35. However, that case-law seems to me to be irrelevant for the purpose of deciding whether the German courts have international jurisdiction, which is the subject matter of the main proceedings, since the Federal Republic of Germany is not a party to the Benelux Convention. To my mind, it is hard to imagine how a convention to which the Federal Republic of Germany is not a party could produce binding effects with respect to the German courts. I note that, unlike this case, Brite Strike Technologies (22) concerned proceedings before a court in the Netherlands.

36. That interpretation is supported, were any such support needed, by the wording of Article 71(2)(a) of Brussels I, which applies, in its own words, to '*a court of a Member State, which is a party to a convention on a particular matter*'. (23)

37. Consequently, if the Court were to find that the main proceedings fell within the scope of Article 22(4) of Brussels I, the referring court would be required to declare of its own motion that it has no jurisdiction pursuant to Article 25 thereof. Only if the main proceedings had been brought before a court of a Benelux Member State could Article 4.6 of the Benelux Convention be taken into account by that court for the purpose of examining its jurisdiction, in accordance with the judgment in Brite Strike Technologies. (24)

V. Conclusion

38. In the light of the foregoing considerations, I propose that the Court answer the question referred for a preliminary ruling by the Oberlandesgericht Düsseldorf (Higher Regional Court of Düsseldorf, Germany) as follows:

An action such as that brought in the main proceedings, seeking an order requiring the person formally registered as proprietor of a Benelux mark to make a declaration to the Office Benelux de la propriété intellectuelle (Benelux Office for Intellectual Property, OBPI) that she has no entitlement to the mark and that she waives registration as the proprietor of that mark, does not fall within the scope of Article 22(4) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters.

1 – Original language: French.

2 – OJ 2001 L 12, p. 1. The referring court set out the reasons why that regulation — since repealed by 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) — applies *ratione temporis* to the facts in the main proceedings. See point 13 of this Opinion.

3 – Judgment of 15 November 1983 (288/82, EU:C:1983:326).

4 – OJ 1978 L 304, p. 36, ‘the Brussels Convention’. On the obligation to take account of the case-law relating to Article 16(4) of the Brussels Convention for the purpose of interpreting Article 22(4) of Brussels I, see point 25 of this Opinion.

5 – Judgment of 13 July 2006, GAT (C-4/03, EU:C:2006:457, paragraphs 14 to 23).

6 – Judgment of 15 November 1983, Duijnstee (288/82, EU:C:1983:326, paragraph 3).

7 – Judgments of 15 November 1983, Duijnstee (288/82, EU:C:1983:326, paragraph 19), and of 13 July 2006, GAT (C-4/03, EU:C:2006:457, paragraph 14).

8 – Judgments of 15 November 1983, Duijnstee (288/82, EU:C:1983:326, paragraph 22), and of 13 July 2006, GAT (C-4/03, EU:C:2006:457, paragraphs 21 to 23).

9 – Judgments of 15 November 1983, Duijnstee (288/82, EU:C:1983:326, paragraphs 23 to 25), and of 13 July 2006, GAT (C-4/03, EU:C:2006:457, paragraph 15).

10 – Judgment of 15 November 1983, Duijnstee (288/82, EU:C:1983:326, paragraph 26).

11 – Judgment of 12 July 2012, Solvay (C-616/10, EU:C:2012:445, paragraph 43 and the case-law cited).

12 – The only difference in wording is the expression ‘under the terms of an international convention’ in Article 16(4) of the Brussels Convention, which became ‘under the terms of a Community instrument or an international convention’ in the first subparagraph of Article 22(4) of Brussels I.

13 – See, in particular, judgments of 16 July 2009, Zuid-Chemie (C-189/08, EU:C:2009:475, paragraph 18); of 12 July 2012, Solvay (C-616/10, EU:C:2012:445, paragraph 42 and the case-law cited); of 10 September 2015, Holterman Ferho Exploitatie and Others (C-47/14, EU:C:2015:574, paragraph 38); and of 16 June 2016, Universal Music International Holding (C-12/15, EU:C:2016:449, paragraph 22).

14 – Judgment of 15 November 1983 (288/82, EU:C:1983:326, paragraphs 24 and 25).

15 – Judgment of 15 November 1983 (288/82, EU:C:1983:326, paragraphs 24 and 25).

16 – See points 10 and 11 of this Opinion.

17 – See point 21 of this Opinion.

18 – See points 10 and 11 of this Opinion.

19 – See point 12 of this Opinion.

20 – Judgment of 14 July 2016 (C-230/15, EU:C:2016:560, paragraph 66).

21 – Convention of 25 February 2005, signed in The Hague by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands. It came into force on 1 September 2006.

22 – Judgment of 14 July 2016 (C-230/15, EU:C:2016:560).

23 – Emphasis added. Article 71 of Brussels I provides as follows:

‘1. This Regulation shall not affect any conventions to which the Member States are parties and which in

relation to particular matters, govern jurisdiction or the recognition or enforcement of judgments.

2. With a view to its uniform interpretation, paragraph 1 shall be applied in the following manner:

(a) this Regulation shall not prevent a court of a Member State, which is a party to a convention on a particular matter, from assuming jurisdiction in accordance with that convention, even where the defendant is domiciled in another Member State which is not a party to that convention. The court hearing the action shall, in any event, apply Article 26 of this Regulation;

...

24 – Judgment of 14 July 2016 (C-230/15, EU:C:2016:560).