Court of Justice EU, 23 November 2017, Benjumea Bravo de Laguna v Torras Ferrazzuolo

TRADEMARK LAW

National law applicable to ownership claim regarding an EU trade mark

- **provided that the situation concerned does not fall within those covered by Article 18 of the Community Trade Mark Regulation**

Articles 16 and 18 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark must be interpreted as not precluding the application to an EU trade mark of a national provision, such as that at issue in the main proceedings, under which a person harmed, by the trade mark registration which was applied for in fraud of his rights or in breach of a legal or contractual obligation, is entitled to claim ownership of that trade mark, provided that the situation concerned does not fall within those covered by Article 18 of that regulation.

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Court of Justice EU, 23 November 2017

(E. Levits, A. Borg Barthet (Rapporteur), M. Berger)

JUDGMENT OF THE COURT (Tenth Chamber)

23 November 2017 (*)

(Reference for a preliminary ruling — Regulation (EC) No 207/2009 — EU trade mark — Article 16 — Trade mark as an object of property — Dealing with EU trade marks as national trade marks — Article 18 — Transfer of a trade mark registered in the name of the agent or representative of the trade mark's proprietor — National provision allowing the possibility of bringing an action for recovery of ownership of a national trade mark registered in fraud of the owner's rights or in breach of a legal or contractual obligation — Whether compatible with Regulation No 207/2009)

In Case C‑381/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Tribunal Supremo (Supreme Court, Spain), made by decision of 28 June 2016, received at the Court on 11 July 2016, in the proceedings

Salvador Benjumea Bravo de Laguna

v

Esteban Torras Ferrazzuolo,

THE COURT (Tenth Chamber),

composed of E. Levits, President of the Chamber, A. Borg Barthet (Rapporteur) and M. Berger, Judges,

Advocate General: M. Szpunar,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– Mr Torras Ferrazzuolo, by S. Díaz Pardeiro, procuradora, and J.A. López Martínez, abogado,

– the Spanish Government, by M.A. Sampol Pucurull, acting as Agent,

– the European Commission, by É. Gippini Fournier and J. Samnadda, 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 Articles 16 and 18 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 has been made in proceedings between Salvador Benjumea Bravo de Laguna and Esteban Torras Ferrazzuolo, concerning the ownership of an EU figurative mark registered in the former's name.

Legal context

EU law

3. Recital 15 of Regulation No 207/2009 is worded as follows:

'*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.*'

4. Article 16 of that regulation, entitled '*Dealing with [EU] trade marks as national trade marks*', states:

'*1. Unless Articles 17 to 24 provide otherwise, [an EU] trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the [European Union], as a national trade mark registered in the Member State in which, according to the Register of [EU] trade marks:*

(a) the proprietor has his seat or his domicile on the relevant date;

(b) where point (a) does not apply, the proprietor has an establishment on the relevant date.

2. In cases which are not provided for by paragraph 1, the Member State referred to in that paragraph shall be the Member State in which the seat of the [European Union Intellectual Property Office (EUIPO)] is situated.

3. If two or more persons are mentioned in the Register of [EU] trade marks as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply.'

5. Article 18 of Regulation No 207/2009, entitled 'Transfer of a trade mark registered in the name of an agent', provides:

'*Where [an EU] trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment in his favour of the said registration, unless such agent or representative justifies his action.*'

6. Article 95(1) of that regulation provides:
'*The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as "[EU] trade mark courts", which shall perform the functions assigned to them by this Regulation*'.
7. Article 105(3) of Regulation No 207/2009 provides:
'*The national rules concerning further appeal [(cassation)] shall be applicable in respect of judgments of [EU] trade mark courts of second instance.*'

Spanish law

8. Article 2(2) of the Ley 17/2001 de Marcas (Law 17/2001 on Trade Marks) of 7 December 2001 (BOE No 294 of 8 December 2001, 'Law 17/2001 on Trade Marks') provides:
'*When a trade mark registration had been applied for in fraud of a third party's rights or in breach of a legal or contractual obligation, the person harmed may claim ownership of the trade mark before the courts, if he brings the appropriate action for the recovery of ownership before the date of registration or within five years of the publication of the registration or from when the registered trade mark had begun to be used in accordance with Article 39. Once the application for recovery of ownership has been filed, the Court shall notify the Spanish Patents and Trade Marks Office of the filing of the application in order for a notice to be placed in the Trade Marks Register and shall, where appropriate, order the proceedings for the registration of the trade mark to be stayed*'.

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

9. On 24 January 2011, Mr Benjumea Bravo de Laguna filed an application for registration of an EU trade mark with EUIPO.
10. Registration as a mark was sought for the following figurative sign:

11. On 29 August 2011, EUIPO registered that sign in Mr Benjumea Bravo de Laguna's name, as EU figurative mark No 9679093.
12. Since he considered that he was the lawful proprietor of that trade mark, Mr Torras Ferrazzuolo brought an action before the Juzgado de lo Mercantil de Alicante (Commercial Court, Alicante, Spain), inter alia, to recover ownership of that trade mark on the basis of Article 18 of Regulation No 207/2009 and Article 2(2) of Law 17/2001 on Trade Marks.
13. That court dismissed that action on the ground, first, that only the regime in Article 18 of Regulation 207/2009 is applicable to EU trade marks, to the exclusion of the general regime in Article 2(2) of Law 17/2001 on Trade Marks and, secondly, that the conditions of Article 18 of Regulation No 207/2009 were not met.
14. Hearing the case on appeal, the Audiencia Provincial de Alicante (Provincial Court, Alicante, Spain) held that since the regime for the recovery of ownership provided for in Article 18 of Regulation No 207/2009 was concerned only with the case of the disloyal agent or representative, it was appropriate to apply, in the present case, the rules relating to the action for the recovery of ownership of a trade mark laid down in Article 2 of Law 17/2001 on Trade Marks.
15. On the basis of Article 16 of Regulation No 207/2009, that court held that, notwithstanding the uniform rules laid down by that regulation, an EU trade mark as an object of property is to be dealt with in its entirety, and for the whole area of the European Union, as a national trade mark registered in the Member State in which the proprietor has his seat or domicile or, failing this, an establishment.
16. Since it took the view also that the conditions for upholding the action for recovery of ownership were met in the present case, the Audiencia Provincial de Alicante (Provincial Court, Alicante) declared that Mr Torras Ferrazzuolo was the proprietor of the trade mark at issue in the main proceedings.
17. Before the referring court, the Tribunal Supremo (Supreme Court, Spain), Mr Benjumea Bravo de Laguna argued that EU law provides for a person to claim ownership of a trade mark only when the registration was carried out in the name of an agent of that person without the person's authorisation. Failing this, no action for recovery of ownership of an EU trade mark may be brought.
18. Mr Torras Ferrazzuolo, on the contrary, contended that Regulation No 207/2009 allows national law to be applied in order to supplement the rules, so that Article 18 of that regulation may be interpreted as not precluding an action for recovery of ownership being brought in cases other than that provided for under that article, in accordance with the provisions of a Member State's national legislation.
19. Considering that the dispute before it raises questions of the interpretation of EU law, the Tribunal Supremo (Supreme Court) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:
'*Is the claim for the recovery of ownership of [an EU] trade mark on grounds other than those set out in Article 18 of [Regulation No 207/2009] and, in particular, in accordance with the cases provided for in Article 2(2) of [Law 17/2001 on Trade Marks] … compatible with EU law and in particular with [Regulation No 207/2009]?*'

Consideration of the question referred

Admissibility

20. Mr Torras Ferrazzuolo submits, first of all, that the request for a preliminary ruling is inadmissible on the ground that the Tribunal Supremo (Supreme Court) has no jurisdiction to make the request.
21. Relying in that regard on Article 95(1) of Regulation No 207/2009, which states that the Member States '*shall designate in their territories as limited a number as possible of national courts and tribunals of*

first and second instance, … referred to as "[EU] trade mark courts", which shall perform the functions assigned to them by this Regulation', he submits that the Tribunal Supremo (Supreme Court) has no jurisdiction to interpret that regulation.

22. He also claims that since the request for a preliminary ruling was not made at either first or second instance, it is a new question which may not be examined in the context of an appeal in cassation.

23. Such arguments cannot, however, be accepted.

24. First, it is apparent from recital 15 of Regulation No 207/2009 that Article 95(1) of that regulation seeks to strengthen the protection of EU trade marks by requiring the Member States to establish courts of first and second instance having jurisdiction in matters of infringement and validity of those marks.

25. Read in the light of Article 105(3) of Regulation No 207/2009, which states '*the national rules concerning further appeal [(cassation)] shall be applicable in respect of judgments of [EU] trade mark courts of second instance*', Article 95(1) of Regulation No 207/2009 cannot, however, be interpreted as meaning that the courts of cassation of the Member States would be denied the right to interpret that regulation in the context of the disputes pending before them.

26. Secondly, it must be pointed out that, according to settled case-law, it is not for the Court of Justice to determine whether the decision whereby a matter is brought before it was taken in accordance with the rules of national law governing the organisation of the courts and their procedure (judgment of 7 July 2016, Genentech, C‑567/14, EU:C:2016:526, paragraph 22 and the case-law cited).

27. Moreover, it must be borne in mind that the procedure provided for in Article 267 TFEU is an instrument of cooperation between the Court of Justice and national courts and tribunals, by means of which the former provides the latter with interpretation of such EU law as is necessary for them to give judgment in cases upon which they are called to adjudicate (judgment of 5 July 2016, Ognyanov, C‑614/14, EU:C:2016:514, paragraph 16 and the case-law cited).

28. In accordance with equally settled case-law, Article 267 TFEU gives national courts the widest discretion in referring matters to the Court if they consider that a case pending before them raises questions involving the interpretation of provisions of EU law, or consideration of their validity, which are necessary for the resolution of the case before them. National courts are, moreover, free to exercise that discretion at whatever stage of the proceedings they consider appropriate (judgment of 5 July 2016, Ognyanov, C‑614/14, EU:C:2016:514, paragraph 17 and the case-law cited).

29. Lastly, it must be borne in mind that, under the third paragraph of Article 267 TFEU, when there is no judicial remedy under national law against the decision of a court or tribunal of a Member State, that court or tribunal is, in principle, obliged to bring the matter before the Court of Justice, where a question relating to the interpretation of EU law is raised before it (see, in particular, judgment of 9 September 2015, Ferreira da Silva e Brito and Others, C‑160/14, EU:C:2015:565, paragraph 37 and the case-law cited).

30. The request for a preliminary ruling is, therefore, admissible.

Substance

31. By its question the national court asks, in essence, whether Regulation No 207/2009 must be interpreted as precluding the application to an EU trade mark of a national provision under which a person harmed, by the trade mark registration which was applied for in fraud of his rights or in breach of a legal or contractual obligation, is entitled to claim ownership of that trade mark.

32. First of all, it must be borne in mind that Article 16(1) of Regulation No 207/2009 provides that, '*Unless Articles 17 to 24 provide otherwise, [an EU] trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the [European Union], as a national trade mark registered in the Member State in which, according to the Register of [EU] trade marks … the proprietor has his seat or his domicile [or failing this] an establishment*'.

33. In that regard, it is important to note that Article 18 of that regulation entitles the proprietor of an EU trade mark to demand the assignment in his favour of the registration of that mark if it is registered without his authorisation in the name of his agent or representative.

34. It follows that actions for recovery of ownership of an EU trade mark registered in the name of an agent or representative of the proprietor of that trade mark without that proprietor's authorisation are governed exclusively by Regulation No 207/2009.

35. On the other hand, Article 18 of that regulation does not govern actions for recovery of ownership of an EU trade mark in cases other than that of a trade mark registered in the name of an agent or representative of the proprietor of that trade mark without that proprietor's authorisation.

36. Consequently, as provided for in Article 16 of Regulation No 207/2009, an EU trade mark as an object of property must, in cases falling outside that envisaged in Article 18 of that regulation, be dealt with as a national trade mark registered in the Member State determined in accordance with the criteria set out in Article 16.

37. Accordingly, provided that a situation does not fall within the scope of Article 18 of Regulation No 207/2009, it is the national legislation of the Member State which will apply to actions for the recovery of ownership of an EU trade mark.

38. In the light of all the foregoing considerations, the answer to the question raised is that Articles 16 and 18 of Regulation No 207/2009 must be interpreted as not precluding the application to an EU trade mark of a national provision, such as that at issue in the main proceedings, under which a person harmed, by the trade mark registration which was applied for in fraud of his rights or in breach of a legal or contractual obligation, is entitled to claim ownership of that trade mark, provided that the situation concerned does not fall within those covered by Article 18 of that regulation.

Costs

39. 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 (Tenth Chamber) hereby rules:

Articles 16 and 18 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark must be interpreted as not precluding the application to an EU trade mark of a national provision, such as that at issue in the main proceedings, under which a person harmed, by the trade mark registration which was applied for in fraud of his rights or in breach of a legal or contractual obligation, is entitled to claim ownership of that trade mark, provided that the situation concerned does not fall within those covered by Article 18 of that regulation.

[Signatures]

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* Language of the case: Spanish.