

Court of Justice EU, 19 April 2018, Peek & Cloppenburg

Peek & Cloppenburg

TRADE MARK LAW

CLAIMING PRIORITY NATIONAL MARK

No basis in EU law for the claim that the use of a national trade mark can have a curative effect in such a way as to maintain the rights attached to it after it has been surrendered

26. Although Article 14 of Directive 2008/95 does not stipulate the date which should be used in order to examine whether the conditions for invalidity or revocation have been met, it is nevertheless clear from the wording and purpose of that provision that the examination in question is intended to determine retrospectively whether those conditions had been met on the date on which the earlier national mark was surrendered or allowed to lapse.

- Accordingly, the requirement that the conditions for the invalidity or revocation of that mark must also be met on the date on which a ruling is made on the application seeking to establish a posteriori that invalidity or that revocation is not compatible with that provision.

27. Moreover, that requirement, as is clear from the order for reference and from the observations of the parties to the main proceedings, is based on the argument that the use of a national mark, after it was surrendered, may have a curative effect in such a way as to maintain the rights attached to it. That argument has no basis either in Directive 2008/95 or in Regulation No 207/2009.

EU law precludes national legislation whereby the invalidity or revocation of an earlier national trade mark, the seniority of which is claimed for an EU trade mark, may only be established a posteriori if the trade mark can be declared invalid or revoked (1), not only at the time on which this earlier national mark was surrendered or lapsed, but also (2) on the date on which the court's decision in which this determination takes place

- In addition, the interpretation of Article 14 of Directive 2008/95 in paragraph 26 above is confirmed by Article 6 of Directive 2015/2436 which entered into force after the events in the dispute in the main proceedings;

it provides, as the sole condition for establishing a posteriori the invalidity or revocation of the earlier national mark, that the invalidity or revocation of the rights could have been declared at the moment when that mark was surrendered or allowed to lapse.³¹ In addition, the interpretation of Article 14 of Directive 2008/95 in paragraph 26 above is confirmed by Article 6 of Directive 2015/2436 which entered into

force after the events in the dispute in the main proceedings; it provides, as the sole condition for establishing a posteriori the invalidity or revocation of the earlier national mark, that the invalidity or revocation of the rights could have been declared at the moment when that mark was surrendered or allowed to lapse.

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Court of Justice EU, 19 April 2018

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

JUDGMENT OF THE COURT (Ninth Chamber)

19 October 2017 (*)

(Reference for a preliminary ruling — Intellectual and industrial property — EU trade mark — Regulation (EC) No 207/2009 — Article 96(a) — Infringement proceedings — Article 99(1) — Presumption of validity — Article 100 — Counterclaim for a declaration of invalidity — Relationship between an action for infringement and a counterclaim for a declaration of invalidity — Procedural autonomy)

In Case C-425/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Federal Court of Justice, Germany), made by decision of 23 February 2017, received at the Court on 24 March 2017, in the proceedings

Peek & Cloppenburg KG, Hamburg

v

Peek & Cloppenburg KG, Düsseldorf,

THE COURT (Second Chamber),

composed of M. Ilešič, President of the Chamber, K. Lenaerts, President of the Court, acting as Judge of the Second Chamber, C. Toader, A. Prechal and E. Jarašiūnas (Rapporteur), Judges,

Advocate General: M. Szpunar,

Registrar: K. Malacek, Administrator,

having regard to the written procedure and further to the hearing on 25 January 2018,

after considering the observations submitted on behalf of:

– Peek & Cloppenburg KG, Hamburg, by

M. Petersenn and A. von Mühlendahl, Rechtsanwälte,

– Peek & Cloppenburg KG, Düsseldorf, by P. Lange,

A. Auler and M. Wenz, Rechtsanwälte,

– the European Commission, by G. Braun, 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 14 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), and Article 34(2) 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 Peek & Cloppenburg KG, Hamburg ('P & C Hamburg') and Peek & Cloppenburg KG, Düsseldorf ('P & C Düsseldorf') concerning a declaration a posteriori that the national marks owned by P & C Hamburg which it had previously surrendered are void.

Legal context

EU law

Directive 2008/95

3. Recital 5 of Directive 2008/95 states:

'This Directive should not deprive the Member States of the right to continue to protect trade marks acquired through use but should take them into account only in regard to the relationship between them and trade marks acquired by registration.'

4. Article 1 of that directive provides:

'This Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.'

5. Article 12 of that directive, entitled 'Grounds for revocation' states in paragraph 1:

'A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State 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 trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, 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 for revocation which began at the earliest on expiry of the continuous period of five years of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.'

6. Article 14 of that directive, entitled 'Establishment a posteriori of invalidity or revocation of a trade mark', provides:

'Where the seniority of an earlier trade mark which has been surrendered or allowed to lapse is claimed for [an EU] trade mark, the invalidity or revocation of the earlier trade mark may be established a posteriori.'

Regulation No 207/2009

7. Article 34 of Regulation No 207/2009, entitled 'Claiming the seniority of a national trade mark', provides:

'1. The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, who applies for an identical trade mark for registration as an EU trade mark for goods or services

which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the EU trade mark the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.'

2. Seniority shall have the sole effect under this Regulation that, where the proprietor of the EU trade mark surrenders the earlier trade mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered. [...]

8. Article 35 of that regulation, entitled 'Claiming seniority after registration of the [EU] trade mark', provides in paragraph 1:

'The proprietor of an EU trade mark who is the proprietor of an earlier identical trade mark registered in a Member State, including a trade mark registered in the Benelux countries or of an earlier identical trade mark, with an international registration effective in a Member State, for goods or services which are identical to those for which the earlier trade mark has been registered, or contained within them, may claim the seniority of the earlier trade mark in respect of the Member State in or for which it was registered.'

Directive (EU) 2015/2436

9. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015, L 336, p. 1), which recast Directive 2008/95, entered into force on 12 January 2016, after the events in the dispute in the main proceedings. Article 6 of that directive is worded as follows:

'Where the seniority of a national trade mark or of a trade mark registered under international arrangements having effect in the Member State, which has been surrendered or allowed to lapse, is claimed for an EU trade mark, the invalidity or revocation of the trade mark providing the basis for the seniority claim may be established a posteriori, provided that the invalidity or revocation could have been declared at the time the mark was surrendered or allowed to lapse. In such a case, the seniority shall cease to produce its effects.'

German law

10. Paragraph 49 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 Markengesetz'), entitled 'Revocation of the rights of the proprietor', provides in paragraph 1:

'On an application, the mark shall be removed from the register, on the ground that it has been revoked, if it has not been used, within the meaning of Paragraph 26, for an uninterrupted period of five years after the date of its registration. The revocation of the rights of the proprietor of a mark may not, however, be invoked if, after that period and before the application for cancellation has been filed, use of the mark, within the meaning of Paragraph 26, has been started or resumed. The commencement or resumption of use

within a period of three months preceding the filing of the application for cancellation which began after a continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor of the mark becomes aware that the application for cancellation may be filed. Where the application for cancellation under Paragraph 53(1) is filed with the Patent Office, the application to the Patent Office shall be the determining date for calculating the three-month period referred to in the third sentence, if the cancellation action under Paragraph 55(1) has been made within three months of notification of the communication referred to in Paragraph 53(4).'

11. Paragraph 125c of the Markengesetz, entitled 'Establishment a posteriori that the mark is void', provides:

'1. If, for [an EU] mark which has been applied for or registered, the priority of a mark registered in the register of the Patent Office under Article 34 or 35 of the Regulation [No 207/2009] has been claimed, and if the mark registered in the register of the Patent Office has been cancelled because the period of protection has not been renewed ... or because the mark has been surrendered ... on an application, it may be established a posteriori that that mark is void due to revocation or invalidity.

2. A declaration that the mark is void is subject to the same conditions as those for cancellation due to revocation or invalidity. Under Paragraph 49(1) a mark may, however, be declared void due to revocation only if the conditions for cancellation laid down in that provision were also already present on the date on which the trade mark was cancelled due to the failure to renew the period of protection or due to surrender.

3. The procedure for establishing that the mark is void is based on the provisions which apply to the procedure for cancelling a registered mark, it being understood that the declaration that the mark is void shall replace its cancellation.'

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

12. P & C Düsseldorf is the proprietor of the German word and figurative marks PuC, which are registered under Nos 648526 and 648528, have priority from 1953 and claim protection for clothing.

13. P & C Hamburg is the proprietor of an EU word mark PUC which was registered on 6 April 2001 under number 242446 for goods in Classes 18 and 25 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 correspond in particular to clothes and fashion accessories. In Germany, that mark enjoys the seniority of two German word marks, PUC, filed and registered in 1978 and 1982 for clothes, under Nos 966148 and 1027854.

14. On 11 February 2005, P & C Düsseldorf brought an action for cancellation, due to revocation, of the German word marks PUC. Since P & C Hamburg

voluntarily applied, on 7 July 2005, to the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) for those marks to be cancelled, both parties declared that they were putting an end to the dispute, and the marks in question were cancelled on 9 and 31 August 2005.

15. On 12 March 2010, P & C Düsseldorf brought an action before the Landgericht Hamburg (Regional Court, Hamburg, Germany) for an order that P & C Hamburg may no longer claim the seniority of the German word marks PUC, arguing, primarily, that on the date on which they were cancelled, due to their having been surrendered by that company, they could also have been cancelled due to revocation. In the alternative, P & C Düsseldorf claimed that, at that time, the trade marks could also have been cancelled due to earlier rights which it held.

16. The Landgericht Hamburg (Regional Court, Hamburg) granted the action, and the appeal before the Oberlandesgericht Hamburg (Higher Regional Court, Hamburg, Germany) brought by P & C Hamburg, was dismissed. In its decision, the appeal court considered that P & C Düsseldorf's application was well founded under Paragraph 125c(1) and (2) and Paragraph 49(1) of the Markengesetz, in that the cancelled German word marks, the seniority of which was claimed for the EU mark PUC, could have been cancelled due to revocation, both on the date on which they were cancelled due to surrender and on the date of the last hearing which took place before that court.

17. P & C Hamburg then lodged an appeal on a point of law against that decision before the Bundesgerichtshof (Federal Court of Justice, Germany).

18. In the first place, the referring court states that the appeal court correctly interpreted Paragraph 125c(2) of the Markengesetz when it held that the conditions for cancelling a mark due to revocation had to be met, not only at the time that mark was surrendered, but also on the date of the last hearing before the court dealing with an application for a declaration that that mark was void. However, it is unsure whether that interpretation is compatible with Article 14 of Directive 2008/95.

19. Finding that Article 14 does not specify the requirements which may be imposed in order to establish a posteriori the invalidity of the earlier national mark which was surrendered or which lapsed, the referring court observes that it follows from Article 6 of Directive 2015/2436 that there cannot be a requirement under that directive that the conditions for revocation must also be met on the date of the decision ruling on the action for a declaration a posteriori of revocation. It is unsure whether that directive redefined the requirements to which such a finding is subject or whether it merely clarified the requirements already applicable under Article 14 of Directive 2008/95.

20. In the second place, the referring court states that, if the interpretation of Paragraph 125c of the Markengesetz, set out in paragraph 18 above, is compatible with Article 14 of Directive 2008/95, the question then arises as to whether P & C Hamburg, after surrendering its German word marks on 7 July

2005, could have used those marks in such a way as to maintain the rights attached to them. Since the appeal court considered that the use of the trade marks could not be taken into account after they had been surrendered, as that use had no ‘curative effect’, the referring court is unsure whether that analysis is accurate in the light of Article 34(2) of Regulation No 207/2009 and, in that respect, it is uncertain about the effect of claiming for an EU trade mark the seniority of an earlier national mark.

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

(1) Is the fact that the invalidity or revocation of a national trade mark which forms the basis of a claim for the seniority of an EU trade mark and which has been surrendered or allowed to lapse may be established a posteriori only where the conditions of invalidity or revocation are present, not only at the time when the trade mark was surrendered or allowed to lapse but also at the time of the judicial decision establishing its invalidity or revocation, compatible with Article 14 of [Directive 2008/95]?

(2) If the first question is to be answered in the affirmative: Does claiming seniority under Article 34(2) of [Regulation No 207/2009] have the effect that the right under the national trade mark lapses and can no longer be used in such a way as to maintain rights attached to it, or is the national trade mark preserved by virtue of EU law, even though it no longer exists in the register of the Member State concerned, with the result that it can and must continue to be used in such a way as to maintain the rights attached to it?’

Consideration of the questions referred for a preliminary ruling

22. By its two questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 14 of Directive 2008/95, read in conjunction with Article 34(2) of Regulation No 207/2009, must be interpreted as precluding an interpretation of national legislation according to which the invalidity or revocation of an earlier national mark, the seniority of which is claimed for an EU mark, may be established a posteriori only if the conditions for that invalidity or that revocation were met, not only on the date on which that earlier national mark was surrendered or the date on which it lapsed, but also on the date on which the judicial decision making that finding is taken.

23. In that regard, it must be recalled that Article 34 of Regulation No 207/2009 makes it possible for the proprietor of an earlier national mark, who applies for an identical mark for registration as an EU mark for goods or services which are identical with those for which the earlier national mark has been registered, to claim, in the application for registration of the EU mark, the seniority of the earlier national mark in respect of the Member State in or for which it is registered. Article 35 of that regulation provides for the

same possibility to claim seniority following the registration of a mark as an EU mark.

24. The only effect of the claim for the seniority of an earlier national mark, according to Article 34(2) of that regulation, is that, where the proprietor of that mark surrenders it or allows it to lapse, he is to be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.

25. For the purposes of opposing such a claim, Article 14 of Directive 2008/95 makes it possible to establish a posteriori the invalidity or revocation of the earlier national mark which was surrendered or allowed to lapse.

26. Although Article 14 of Directive 2008/95 does not stipulate the date which should be used in order to examine whether the conditions for invalidity or revocation have been met, it is nevertheless clear from the wording and purpose of that provision that the examination in question is intended to determine retrospectively whether those conditions had been met on the date on which the earlier national mark was surrendered or allowed to lapse. Accordingly, the requirement that the conditions for the invalidity or revocation of that mark must also be met on the date on which a ruling is made on the application seeking to establish a posteriori that invalidity or that revocation is not compatible with that provision.

27. Moreover, that requirement, as is clear from the order for reference and from the observations of the parties to the main proceedings, is based on the argument that the use of a national mark, after it was surrendered, may have a curative effect in such a way as to maintain the rights attached to it. That argument has no basis either in Directive 2008/95 or in Regulation No 207/2009.

28. It should be pointed out, first of all, that the possibility of making use of a national mark which has been surrendered was in no way intended by Directive 2008/95. In addition, it is clear from recital 5 and Article 1 that that directive applies only to those marks which were the subject of a registration or of an application for registration, so that a cancelled mark is no longer in existence in the light of that directive.

29. Next, it follows from the second subparagraph of Article 12(1) of Directive 2008/95 that the use of the mark is taken into consideration only on the date of the filing of the application for revocation, possibly brought forward by three months in the circumstances referred to in the third subparagraph of that provision. It would therefore not be consistent with that provision to take into consideration, in proceedings seeking to establish a posteriori the revocation of a mark, the use made after the date on which the proprietor himself declared his surrender of that mark or allowed it to lapse.

30. Finally, it is clear from Article 34(2) of Regulation No 207/2009 that the only effect of the seniority of an earlier national mark claimed for an EU mark is that the proprietor of that earlier national mark, who surrendered it or allowed it to lapse, is to be deemed to continue to have, in the Member State in or for which it

was registered, the same rights as he would have had if that mark had continued to be registered. That provision thus creates a fiction intended to enable the proprietor of the EU mark to continue to enjoy, in that Member State, the protection enjoyed by the earlier national mark which was cancelled and not to enable that mark to continue to exist in the same form. It follows, in particular, that any use of the sign at issue after that cancellation must be regarded, in such a case, as use of the EU mark and not of the cancelled earlier national mark.

31. In addition, the interpretation of Article 14 of Directive 2008/95 in paragraph 26 above is confirmed by Article 6 of Directive 2015/2436 which entered into force after the events in the dispute in the main proceedings; it provides, as the sole condition for establishing a posteriori the invalidity or revocation of the earlier national mark, that the invalidity or revocation of the rights could have been declared at the moment when that mark was surrendered or allowed to lapse.

32. In the light of the foregoing considerations, the answer to the questions referred is that Article 14 of Directive 2008/95, read in conjunction with Article 34(2) of Regulation No 207/2009, must be interpreted as precluding an interpretation of national legislation according to which the invalidity or revocation of an earlier national mark, the seniority of which is claimed for an EU mark, may be established a posteriori only if the conditions for that invalidity or that revocation were met, not only on the date on which that earlier national mark was surrendered or the date on which it lapsed, but also on the date on which the judicial decision making that finding is taken.

Costs

33. 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 14 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, read in conjunction with Article 34(2) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark, must be interpreted as precluding an interpretation of national legislation according to which the invalidity or revocation of an earlier national mark, the seniority of which is claimed for an EU mark, may be established a posteriori only if the conditions for that invalidity or that revocation were met, not only on the date on which that earlier national mark was surrendered or the date on which it lapsed, but also on the date on which the judicial decision making that finding is taken.

[Signatures]