

Court of Justice EU, 19 May 2022, Heitec v Heitech Promotion



HEITEC  
engineering solutions

v



HEITECH®

#### TRADE MARK LAW

**No interruption of the period of limitation or stop acquiescence**

- by an act, such as a warning letter, by which the proprietor of an earlier mark or other earlier right opposes the use of a later mark without taking the necessary steps to obtain a legally binding solution

56 Any interpretation of Article 9 of Directive 2008/95 and Articles 54, 110 and 111 of Regulation No 207/2009 to the effect that sending a warning letter is sufficient, in itself, to interrupt the period of limitation would allow the proprietor of the earlier mark or other earlier right to circumvent the regime for limitation in consequence of acquiescence by repeatedly sending a warning letter approximately every five years. Such a situation would undermine the objectives of the regime for limitation in consequence of acquiescence, referred to in paragraphs 46 to 48 above, and would deprive that regime of its effectiveness.

**No interruption of the period of limitation**

- by the bringing of a court action in which the proprietor of an earlier mark or other earlier right sought a declaration of invalidity of a later mark or opposed the use of that mark, where the application initiating proceedings, although filed before the date of expiry of the period of limitation, did not, owing to a lack of diligence on the part of the applicant, satisfy the requirements of the applicable national law for service and was rectified only after that date for reasons attributable to the applicant.

**Limitation in consequence of acquiescence**

- is also time-barred from bringing ancillary or related claims, such as claims for damages, the provision of information or the destruction of goods.

Source: [ECLI:EU:C:2022:400](#)

**Court of Justice EU, 31 March 2010**

(C. Lycourgos (Rapporteur), President of the Chamber, S. Rodin, J.-C. Bonichot, L.S. Rossi and O. Spineanu-Matei, Judges)

JUDGMENT OF THE COURT (Fourth Chamber)

19 May 2022 (\*)

*(Reference for a preliminary ruling – Trade marks – Directive 2008/95/EC – Article 9 – Regulation (EC) No 207/2009 – Articles 54, 110 and 111 – Limitation in consequence of acquiescence – Concept of ‘acquiescence’ – Interruption of the period of limitation in consequence of acquiescence – Sending of a warning letter – Date of interruption of the period of limitation in the event of a court action being initiated – Effects of limitation – Application for damages, the provision of information and destruction of goods)*

In Case C-466/20,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Federal Court of Justice, Germany), made by decision of 23 July 2020, received at the Court on 25 September 2020, in the proceedings

HEITEC AG

v

HEITECH Promotion GmbH,  
RW,

THE COURT (Fourth Chamber),

composed of C. Lycourgos (Rapporteur), President of the Chamber, S. Rodin, J.-C. Bonichot, L.S. Rossi and O. Spineanu-Matei, Judges,

Advocate General: G. Pitruzzella,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– HEITEC AG, by B. Ackermann, Rechtsanwältin,  
– HEITECH Promotion GmbH and RW, by C. Rohnke, T. Winter and C. Augenstein, Rechtsanwälte,

– The European Commission, initially by T. Scharf, É. Gippini Fournier and J. Samnadda, and subsequently by T. Scharf and J. Samnadda, acting as Agents,

after hearing the [Opinion of the Advocate General](#) at the sitting on 13 January 2022,

gives the following

#### Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 9 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 Articles 54 and 111 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The request has been made in proceedings between, on the one hand, HEITEC AG ('Heitec') and, on the other, HEITECH Promotion GmbH ('Heitech') and RW concerning the use, by the latter, of the trade name HEITECH Promotion GmbH and trade marks containing the word element 'heitech'.

### Legal context

#### European Union law

Directive 2008/95

3 Recital 12 of Directive 2008/95 stated:

*"It is important, for reasons of legal certainty and without inequitably prejudicing the interests of a proprietor of an earlier trade mark, to provide that the latter may no longer request a declaration of invalidity nor may he oppose the use of a trade mark subsequent to his own of which he has knowingly tolerated the use for a substantial length of time, unless the application for the subsequent trade mark was made in bad faith."*

4 Article 4 of that directive, headed 'Further grounds for refusal or invalidity concerning conflicts with earlier rights', provided:

*'1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:*

*(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;*

*(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.*

*2. "Earlier trade marks" within the meaning of paragraph 1 means:*

*(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;*

*(i) [EU] trade marks;*

*(ii) trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Office for Intellectual Property;*

*(iii) trade marks registered under international arrangements which have effect in the Member State;*

*(b) [EU] trade marks which validly claim seniority ...;*

*(c) applications for the trade marks referred to in (a) and (b), subject to their registration;*

*...*

*4. Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:*

*(a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State*

*concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;*

*(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;*

*(c) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraph 2 and point (b) of this paragraph and in particular:*

*(i) a right to a name;*

*(ii) a right of personal portrayal;*

*(iii) a copyright;*

*(iv) an industrial property right;*

*...*

5 Article 9 of that directive, entitled 'Limitation in consequence of acquiescence', provided:

*'1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 4(2) has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.*

*2. Any Member State may provide that paragraph 1 shall apply mutatis mutandis to the proprietor of an earlier trade mark referred to in Article 4(4)(a) or another earlier right referred to in Article 4(4)(b) or (c).*

*3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later registered trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trade mark.'*

6 Directive 2008/95, which repealed and replaced First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), was in turn repealed and replaced, with effect from 15 January 2019, by 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). However, having regard to the date of the facts giving rise to the dispute in the main proceedings, this reference for a preliminary ruling must be considered in the light of Directive 2008/95.

Regulation No 207/2009

7 Article 8 of Regulation No 207/2009, entitled 'Relative grounds for refusal', provides:

*'1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:*

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. For the purposes of paragraph 1, “earlier trade marks” means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the [EU] trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) [EU] trade marks;

(ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;

(iii) trade marks registered under international arrangements which have effect in a Member State;

(iv) trade marks registered under international arrangements which have effect in the [European Union];

(b) applications for the trade marks referred to in subparagraph (a), subject to their registration;

...

4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to [EU] legislation or the law of the Member State governing that sign:

(a) rights to that sign were acquired prior to the date of application for registration of the [EU] trade mark, or the date of the priority claimed for the application for registration of the [EU] trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

...

8 Article 54 of that regulation, entitled ‘Limitation in consequence of acquiescence’, provided:

‘1. Where the proprietor of a [EU] trade mark has acquiesced, for a period of five successive years, in the use of a later [EU] trade mark in the [European Union] while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later [EU] trade mark was applied for in bad faith.

2. Where the proprietor of an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced, for a period of five successive years, in the use of a later [EU] trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while

being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later [EU] trade mark was applied for in bad faith.

...

9 Article 110 of that regulation, entitled ‘Prohibition of use of [EU] trade marks’, provided in paragraph 1:

‘This Regulation shall, unless otherwise provided for, not affect the right existing under the laws of the Member States to invoke claims for infringement of earlier rights within the meaning of Article 8 ... in relation to the use of a later [EU] trade mark. Claims for infringement of earlier rights within the meaning of Article 8(2) and (4) may, however, no longer be invoked if the proprietor of the earlier right may no longer apply for a declaration that the [EU] trade mark is invalid in accordance with Article 54(2).’

10 Article 111 of Regulation No 207/2009, entitled ‘Prior rights applicable to particular localities’, provided:

‘1. The proprietor of an earlier right which only applies to a particular locality may oppose the use of the [EU] trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.

2. Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the [EU] trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the [EU] trade mark was applied for in bad faith.

3. The proprietor of the [EU] trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though that right may no longer be invoked against the [EU] trade mark.’

11 Regulation No 207/2009 was repealed and replaced with effect from 1 October 2017 by 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). However, having regard to the date of the facts giving rise to the dispute in the main proceedings, this reference for a preliminary ruling must be considered in the light of Regulation No 207/2009.

German law

12 Paragraph 21 of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (Markengesetz) (Law on the protection of trade marks and other distinctive signs) of 25 October 1994 (BGBl. 1994 I, p. 3082), in the version applicable in the main proceedings (‘the Law on trade marks’), provides:

‘1. The proprietor of a trade mark or trade name is not entitled to prohibit the use of a later registered trade mark for the goods or services for which it is registered if he has knowingly tolerated the use of that trade mark for a period of five consecutive years unless the later trade mark was applied for in bad faith.

2. *The proprietor of a trade mark or trade name is not entitled to prohibit the use ... of a later trade name if he has knowingly tolerated the use of [that trade name] for a period of five consecutive years, unless the proprietor of that right was acting in bad faith at the time of its acquisition.*

...'

13 Under Paragraph 125b(3) of the Law on trade marks:

*'If a registered [EU] trade mark is invoked against the use of a later trade mark registered under this Act, Paragraph 21(1) ... shall apply mutatis mutandis'.*

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

14 The applicant in the main proceedings, Heitec, is the proprietor of the EU word mark HEITEC, applied for on 18 March 1998, with seniority claimed as from 13 July 1991, and registered on 4 July 2005.

15 It was entered in the commercial register in 1984 under the name Heitec Industriepanung GmbH. Its name was changed in 1988 to Heitec GmbH. Since the year 2000, it has been operating under the name of Heitec AG.

16 Heitech, of which RW is the managing director, was entered in the commercial register on 16 April 2003.

17 Heitech is the proprietor of a German figurative mark containing the word element 'heitech promotion', applied for on 17 September 2002 and registered on 4 February 2003, which it has used since 29 September 2004 at the latest, and of an EU figurative mark containing the word element 'heitech', applied for on 6 February 2008 and registered on 20 November 2008, which it has used since 6 May 2009 at the latest.

18 By letter of 29 November 2004, Heitech contacted the representatives of Heitec to ask whether the latter would agree to conclude a coexistence agreement.

19 On 7 July 2008 Heitec became aware of Heitech's application for registration of the EU figurative mark containing the word element 'heitech'.

20 By letter of 22 April 2009, Heitec sent Heitech a warning letter regarding the latter's use of its trade name and the EU trade mark containing the word element 'heitech'. In its reply of 6 May 2009, Heitech again proposed the conclusion of a coexistence agreement.

21 On 31 December 2012, the Landgericht Nürnberg-Fürth (Regional Court, Nuremberg-Fürth, Germany) received, by fax, the application initiating proceedings, submitted by Heitec against Heitech and RW. That application was dated 15 December 2012. By decision of 4 January 2013, Heitec was asked to pay an advance on the costs of the proceedings.

22 On 12 March 2013, that court pointed out to Heitec's representative that that advance payment had not been made and that the originals of the application initiating proceedings had not been lodged.

23 By letter of 23 September 2013, Heitec informed Heitech that it refused to conclude a coexistence agreement and proposed to conclude a licence agreement while stating that it had initiated legal proceedings.

24 By letter of 29 December 2013, Heitec informed Heitech that it was relying on its trade name and that it was the proprietor of the EU trade mark HEITEC. It stated that the legal proceedings were pending.

25 On 30 December 2013, the Landgericht Nürnberg-Fürth (Regional Court, Nuremberg-Fürth) received written submissions from Heitec dated 12 December 2013, together with a cheque for court fees and a new application initiating proceedings bearing the date 4 October 2013.

26 On 14 January 2014, that court drew Heitec's attention to the fact that it was also necessary to serve the application initiating proceedings of 15 December 2012 and Heitec was therefore asked to lodge the original documents. Those originals were received by the court on 22 February 2014.

27 On 24 February 2014, that court alerted Heitec to the fact that the heads of claim in the originals of the application initiating proceedings received on 22 February 2014 were not consistent with the heads of claim in the initiating application submitted on 31 December 2012.

28 On 16 May 2014, the Landgericht Nürnberg-Fürth (Regional Court, Nuremberg-Fürth) opened the preliminary written procedure and ordered that copies, drawn up by that court, of the initiating application of 15 December 2012 be served on the defendants in the main proceedings. Notice was finally served on 23 May 2014.

29 By that action, Heitec brought claims based, primarily, on the infringement of the rights conferred by its trade name HEITEC and, in the alternative, on the infringement of its EU trade mark HEITEC. It claimed that Heitech should be ordered to refrain from identifying its company by the trade name HEITECH Promotion GmbH, to refrain from affixing the word elements 'heitech promotion' and 'heitech' on goods and from marketing or advertising goods or services under those signs, to refrain from using or transferring, for commercial purposes, the website heitech-promotion.de and to agree to the removal of its company name from the commercial register. Heitec also brought claims for information, for a finding of an obligation to pay compensation, for the destruction of goods and for the payment of the costs of sending the warning letter.

30 The Landgericht Nürnberg-Fürth (Regional Court, Nuremberg-Fürth) ordered Heitech to pay Heitec EUR 1 353.80, plus interest, for the costs of sending the warning letter and rejected the other claims brought by Heitec.

31 Heitec appealed against the decision of the Landgericht Nürnberg-Fürth (Regional Court, Nuremberg-Fürth) before the Oberlandesgericht Nürnberg (Higher Regional Court, Nuremberg, Germany).

32 The Oberlandesgericht Nürnberg (Higher Regional Court, Nuremberg) held that Heitec's action was unfounded on the ground that Heitec was time-barred. In that regard, it noted that Heitech had used its later signs for an uninterrupted period of at least five years and that Heitec had acquiesced in such use, since,

although it was aware of that use, it had not taken sufficient measures to stop that use.

33 According to that court, that court action had not interrupted the period of limitation, since it had been served on Heitech and RW only after five years had elapsed since the warning letter which preceded that action.

34 Heitec brought an appeal before the referring court.

35 That court notes that the outcome of the appeal depends on whether Heitec is, pursuant to Paragraph 21(1) and (2) of the Law on trade marks and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009, time-barred from bringing its claim for an injunction and its ancillary claims.

36 That court notes that the time-barring of Heitec's claims relating, in essence, to the use by Heitech of the German trade mark of which the latter is the proprietor, is governed by Paragraph 21(1) of the Law on trade marks, read in conjunction with Paragraph 125b(3) of that law, in so far as those claims are based on the EU trade mark of which Heitec is the proprietor.

37 It states that Paragraph 21(1) of the Law on trade marks transposes into German law the limitation provided for in Article 9 of Directive 2008/95, on the right conferred by trade marks (Article 9(1) of Directive 2008/95) and by other signs – including trade names – used in the course of business (Article 9(2) of Directive 2008/95), to oppose the use of a registered trade mark.

38 In so far as Heitec opposes the use of the trade name Heitech, the limitation is, according to the findings of the referring court, governed by Paragraph 21(2) of the Law on trade marks. In this regard, that court states that, notwithstanding the fact that the scope of that provision goes beyond that of Directive 2008/95 and is not reflected in Article 54 of Regulation No 207/2009, it must be interpreted on the basis of the interpretation of Paragraph 21(1) of the Law on trade marks which is consistent with that directive.

39 As regards Heitec's claims concerning the use by Heitech of the EU trade mark of which it is the proprietor, the referring court finds that Articles 54 and 110 and Article 111(2) of Regulation No 207/2009 are relevant.

40 That court notes that the Oberlandesgericht Nürnberg (Higher Regional Court, Nuremberg) did not err in law in finding that there was 'use', within the meaning of Paragraph 21(1) and (2) of the Law on trade marks and Articles 54 and 111 of Regulation No 207/2009, in the present case from 6 May 2009 at the latest and that Heitec had become aware of that by the letter of 6 May 2009 which Heitech had sent it. It is, moreover, common ground that Heitech is not accused of having acted in bad faith.

41 In the light of those circumstances, it is necessary to determine exactly what constitutes 'acquiescence' within the meaning of Article 9 of Directive 2008/95 and Articles 54 and 111 of Regulation No 207/2009.

42 In that regard, first, it is necessary to clarify whether it is possible to exclude acquiescence not only where an appeal is brought before an administrative

authority or a court, but also in the event of the sending of a warning letter. Secondly, it is necessary to determine whether, in the event of a court action it is necessary to take as a basis, in order to determine whether that action was initiated before the expiry of the period of limitation, the date on which the document instituting the proceedings was lodged or the date on which that document was received by the defendant. It is necessary, in that context, to clarify whether the fact that the service of that document is delayed through the fault of the proprietor of the earlier mark is relevant in that regard.

43 It is also necessary to determine whether the time limit applies only to an application for an injunction or also to claims that are ancillary or related to such an application, such as claims for damages, the provision of information and the destruction of goods.

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

'(1) Can acquiescence within the meaning of Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009 be excluded not only by means of an administrative or court action, but also through conduct not involving a court or administrative authority?

(2) If Question 1 is answered in the affirmative: does the sending of a warning letter, in which the proprietor of the earlier sign, before initiating legal proceedings, requires the proprietor of the later sign to agree to refrain from using the sign, and to enter into an obligation to pay a contractual penalty in the event of an infringement, constitute conduct precluding acquiescence within the meaning of Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of [Regulation No 207/2009]?

(3) When seeking judicial redress, is the bringing of the action before the court or the receipt of the action by the defendant decisive for calculating the five-year acquiescence period for the purposes of Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of [Regulation No 207/2009]? Is it significant in this regard that receipt of the action by the defendant is delayed beyond the expiry of the five-year period through the fault of the proprietor of the earlier trade mark?

(4) Does the limitation of rights in accordance with Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of [Regulation No 207/2009] encompass consequential claims under trade mark law, for example, claims for compensation, provision of information or destruction, as well as prohibitory injunctions?'

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

##### **The first and second questions**

45 By its first and second questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 9 of Directive 2008/95 and Articles 54 and 111 of Regulation No 207/2009 must be interpreted as meaning that an act, such as a warning

letter, whereby the proprietor of an earlier mark or other earlier right opposes the use of a later mark without bringing an administrative or judicial appeal, is capable of ending acquiescence within the meaning of those provisions.

46 It should be recalled that the regime for limitation in consequence of acquiescence provided for in the EU trade mark legislation pursues the objective of striking a balance between the interest which the proprietor of a trade mark has in safeguarding its essential function, on the one hand, and the interests of other economic operators in having signs capable of denoting their goods and services, on the other (see, to that effect, judgments of [27 April 2006, \*Levi Strauss\*, C-145/05, EU:C:2006:264, paragraph 29](#), and of [22 September 2011, \*Budějovický Budvar\*, C-482/09, EU:C:2011:605, paragraph 34](#)).

47 In particular, by setting a period of limitation in consequence of acquiescence of five consecutive years with knowledge of the use of the later trade mark, the EU legislature sought to ensure that the protection conferred by an earlier trade mark on its proprietor remains limited to cases where the proprietor shows itself to be sufficiently vigilant by opposing the use of signs by other operators likely to infringe its mark (see, to that effect, judgment of [27 April 2006, \*Levi Strauss\*, C-145/05, EU:C:2006:264, paragraph 30](#)).

48 More specifically, as noted in recital 12 of Directive 2008/95, the rule on limitation in consequence of acquiescence is intended to safeguard legal certainty. Where the proprietor of an earlier mark or other earlier right, within the meaning of Directive 2008/95 or Regulation No 207/2009, has knowingly ‘acquiesced’ in the use of a later mark applied for in good faith for a continuous period of five years, the proprietor of the latter mark must be certain in law that such use can no longer be challenged by the proprietor of that earlier mark or other earlier right.

49 For the purposes of applying that rule, the concept of ‘acquiescence’, which has the same meaning in Directive 2008/95 and in Regulation No 207/2009, means that the proprietor of that earlier mark or other earlier right remains inactive even though it is aware of the use of a later mark which it would be in a position to oppose. It ‘acquiesced’ by failing to take measures open to it to remedy that situation (see, to that effect, [judgment of 22 September 2011, \*Budějovický Budvar\*, C-482/09, EU:C:2011:605](#), paragraphs 35 and 44).

50 It follows from the foregoing that the proprietor of an earlier mark or other earlier right is time-barred from seeking a declaration of invalidity or opposing the use of a later mark applied for in good faith, where, for a period of five consecutive years, while being aware of such use, it failed to carry out an act that clearly expressed its wish to oppose that use and to remedy the alleged infringement of its rights.

51 Such an interpretation of Article 9 of Directive 2008/95 and Articles 54 and 111 of Regulation No 207/2009 also applies to Article 110 of that regulation which may be relevant in a situation such as

that at issue in the main proceedings, even though it was not mentioned in the questions referred. It must be observed, in that regard, that the rule regarding limitation in consequence of acquiescence as from the date of expiry of a period of five consecutive years with knowledge of the use of the later mark, laid down in Article 9 of Directive 2008/95, is referenced, as regards the EU trade mark, in Articles 54, 110 and 111 of Regulation No 207/2009.

52 As regards the conditions under which the proprietor of the earlier mark or other earlier right may be regarded as having carried out an act that produces the effects referred to in paragraph 50 above and therefore interrupts the period of limitation, the Court has held that, in any event, the bringing of an administrative or court action before the expiry of that period ends acquiescence and consequently prevents limitation (see, to that effect, [judgment of 22 September 2011, \*Budějovický Budvar\*, C-482/09, EU:C:2011:605](#), paragraph 49).

53 By bringing such an action, the proprietor of the earlier mark or other earlier right unequivocally expresses its wish to oppose the use of the later mark and to remedy the alleged infringement of its rights.

54 Where, as in the present case, the bringing of that action was preceded by the sending of a warning letter, with which the proprietor of the later mark did not comply, that warning letter may interrupt the period of limitation in consequence of acquiescence provided that, following the unsatisfactory response to that warning letter, the proprietor of the earlier mark or other earlier right continues to express its opposition to the use of the later mark and takes the measures available to it to enforce its rights.

55 In contrast, if the proprietor of the earlier mark or other earlier right, having expressed its opposition to the use of the later mark by a warning letter, did not, after noting the refusal of the addressee of that letter to comply with it or to enter into negotiations, pursue its efforts within a reasonable period in order to remedy that situation, where appropriate by bringing an administrative or court action, it must be inferred that that proprietor failed to take the measures available to it to put an end to the alleged infringement of its rights.

56 Any interpretation of Article 9 of Directive 2008/95 and Articles 54, 110 and 111 of Regulation No 207/2009 to the effect that sending a warning letter is sufficient, in itself, to interrupt the period of limitation would allow the proprietor of the earlier mark or other earlier right to circumvent the regime for limitation in consequence of acquiescence by repeatedly sending a warning letter approximately every five years. Such a situation would undermine the objectives of the regime for limitation in consequence of acquiescence, referred to in paragraphs 46 to 48 above, and would deprive that regime of its effectiveness.

57 In the light of all the foregoing considerations, the answer to the first and second questions is that Article 9 of Directive 2008/95 and Articles 54, 110 and 111 of Regulation No 207/2009 must be interpreted as meaning that an act, such as a warning letter, by which the

proprietor of an earlier mark or other earlier right opposes the use of a later mark without taking the necessary steps to obtain a legally binding solution, does not stop acquiescence and, consequently, does not interrupt the period of limitation.

#### The third question

58 By its third question, the referring court asks, in essence, whether Article 9 of Directive 2008/95 and Articles 54 and 111 of Regulation No 207/2009 must be interpreted to mean that the limitation in consequence of acquiescence referred to in those provisions may be prevented by the bringing of a court action in which the proprietor of an earlier mark or other earlier right seeks a declaration of invalidity of a later mark or opposes the use of that mark, where the application initiating proceedings, although filed before the date of expiry of the period of limitation, was not, owing to a lack of diligence on the part of the applicant, served on the defendant until after that date.

59 As noted in paragraph 52 above, the bringing of an administrative or court action before the expiry of that period ends acquiescence and consequently prevents limitation.

60 As regards the date on which a court action must be deemed to have been brought, the Court has held, in the context of its interpretation of rules adopted in the field of judicial cooperation in civil matters, that that date may be the date on which the application initiating proceedings was lodged, although the court concerned can be deemed to be seised at that time only if the applicant has not subsequently failed to take the steps it was required to take to have service effected on the defendant (see, *inter alia*, judgments of [6 October 2015, A, C-489/14, EU:C:2015:654](#), paragraph 32, and of [4 May 2017, \*Hanse Yachts\*, C-29/16, EU:C:2017:343](#), paragraph 29).

61 Although those rules, adopted in the field of judicial cooperation in civil matters, are not formally applicable in the present case, they are nevertheless relevant for the purposes of answering the third question. The time limit directly and immediately affects the possibility for the proprietor of the earlier mark or other earlier right to rely on that mark or right in court against the proprietor of the later mark. The applicant is therefore not time-barred as long as the action is brought within that five-year period.

62 In that regard, it must be held that, as the Advocate General observed in point 53 of his Opinion, the lodging of the application initiating proceedings normally reflects the genuine and unambiguous wish of the applicant to assert its rights, which is sufficient, in principle, to end acquiescence and, consequently, to interrupt the period of limitation.

63 The conduct of that party may nevertheless, in certain cases, raise doubts as to that wish and the serious nature of the action brought before the court seised. That is the case, in particular, where, owing to a lack of diligence on the part of the applicant, the application initiating proceedings is not rectified in good time when it fails to meet the formal requirements of national law for service on the defendant.

64 In such circumstances, which are attributable to the applicant, the latter cannot claim to have put an end to the acquiescence of the use of the later mark by lodging the application initiating proceedings. It is only by rectifying that application, in accordance with the requirements of the applicable national law, that the applicant is to be regarded as having unequivocally expressed a clear and serious intention to assert its rights and that, consequently, the action may be deemed to have been effectively initiated.

65 In the present case, it is apparent from the information set out in the order for reference and summarised in paragraphs 22 to 28 above that the court with which Heitec had lodged, on 31 December 2012, an application initiating proceedings, repeatedly contacted Heitec's representative in order to draw its attention to irregularities that prevented service, on Heitech and RW, of both that application and the new application initiating proceedings subsequently lodged by Heitec. The application initiating proceedings appears to have been rectified between 24 February 2014, the date of the last reminder sent to Heitec by the court seised, and 16 May of that year, the date on which that court opened the preliminary written procedure.

66 It is also apparent from that order that, according to the findings of the trial court, of which the referring court takes note, there was knowledge of the use of the later mark on 6 May 2009.

67 In those circumstances, it is for the referring court to ascertain the date on which the application initiating proceedings was rectified in such a way as to enable the court seised to commence the proceedings and to serve that document on the defendants in the main proceedings. If the rectification did not take place until after the expiry of the period of limitation in consequence of acquiescence, it is for the referring court to assess whether that fact is mainly due to conduct on the part of the applicant in the main proceedings which may be characterised as a lack of diligence. If that court were to take the view that that was the case, it would have to conclude that, due to Heitec's lack of diligence, its action must be regarded as time-barred.

68 In the light of all the foregoing considerations, the answer to the third question is that Article 9 of Directive 2008/95 and Articles 54, 110 and 111 of Regulation No 207/2009 must be interpreted to mean that the limitation in consequence of acquiescence referred to in those provisions may not be prevented by the bringing of a court action in which the proprietor of an earlier mark or other earlier right sought a declaration of invalidity of a later mark or opposed the use of that mark, where the application initiating proceedings, although filed before the date of expiry of the period of limitation, did not, owing to a lack of diligence on the part of the applicant, satisfy the requirements of the applicable national law for service and was rectified only after that date for reasons attributable to the applicant.

#### The fourth question

69 By its fourth question, the referring court asks, in essence, whether Article 9 of Directive 2008/95 and Articles 54 and 111 of Regulation No 207/2009 must be

interpreted as meaning that, where the proprietor of an earlier mark or other earlier right, within the meaning of those provisions, is time-barred from seeking a declaration of invalidity of a later mark and from opposing the use of that mark, that proprietor is also time-barred from bringing ancillary or related claims, such as claims for damages, the provision of information or the destruction of goods.

70 As explained in the context of the examination of the first and second questions, the proprietor of an earlier mark or other earlier right that, while being aware of the use of a later mark applied for in good faith, fails, for a continuous period of five years, to act in a manner that unequivocally expresses its wish to oppose that use and to remedy the alleged infringement of its rights is time-barred from challenging the use of that later mark.

71 As the Advocate General observed in point 64 of his Opinion, it would be contrary to the objectives of the regime for limitation in consequence of acquiescence, most notably the safeguarding of legal certainty, to allow, in such a situation, that proprietor to bring an action against the proprietor of that later mark after the end of that period of five consecutive years seeking that the latter be ordered to pay damages or seeking injunctions against the latter.

72 If such an action or such claims were to succeed after the expiry of the period of limitation, it would amount to leaving intact, beyond that date, the possibility of a finding that the use of the later mark infringes the earlier mark or the earlier right and of attributing, on that basis, non-contractual liability to the proprietor of the later mark. Such an interpretation of the regime of limitation in consequence of acquiescence would undermine the objective pursued by that regime, which is to give the proprietor of the later trade mark the certainty, at the end of that period, that the use of that mark can no longer be challenged, by whatever legal means, by the person that has knowingly acquiesced in its use for an uninterrupted period of five years.

73 In the light of all the foregoing considerations, the answer to the fourth question is that Article 9 of Directive 2008/95 and Articles 54, 110 and 111 of Regulation No 207/2009 must be interpreted as meaning that, where the proprietor of an earlier mark or other earlier right, within the meaning of those provisions, is time-barred from seeking a declaration of invalidity of a later mark and from opposing the use of that mark, that proprietor is also time-barred from bringing ancillary or related claims, such as claims for damages, the provision of information or the destruction of goods.

#### Costs

74 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 (Fourth Chamber) hereby rules:

1. Article 9 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 and Articles 54, 110 and 111 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that an act, such as a warning letter, by which the proprietor of an earlier mark or other earlier right opposes the use of a later mark without taking the necessary steps to obtain a legally binding solution does not stop acquiescence and, consequently, does not interrupt the period of limitation.

2. Article 9 of Directive 2008/95 and Articles 54, 110 and 111 of Regulation No 207/2009 must be interpreted to mean that the limitation in consequence of acquiescence referred to in those provisions may not be prevented by the bringing of a court action in which the proprietor of an earlier mark or other earlier right sought a declaration of invalidity of a later mark or opposed the use of that mark, where the application initiating proceedings, although filed before the date of expiry of the period of limitation, did not, owing to a lack of diligence on the part of the applicant, satisfy the requirements of the applicable national law for service and was rectified only after that date for reasons attributable to the applicant.

3. Article 9 of Directive 2008/95 and Articles 54, 110 and 111 of Regulation No 207/2009 must be interpreted as meaning that, where the proprietor of an earlier mark or other earlier right, within the meaning of those provisions, is time-barred from seeking a declaration of invalidity of a later mark and from opposing the use of that mark, that proprietor is also time-barred from bringing ancillary or related claims, such as claims for damages, the provision of information or the destruction of goods.

#### OPINION OF ADVOCATE GENERAL

PITRUZZELLA

delivered on 13 January 2022 (1)

**Case C-466/20**

**HEITEC AG**

v

**HEITECH Promotion GmbH,**

**RW**

(Request for a preliminary ruling by the Bundesgerichtshof (Federal Court of Justice, Germany))  
(*Reference for a preliminary ruling – European Union trade marks – Limitation in consequence of acquiescence – Calculation of the five-year period – Interruption of the period of limitation in consequence of acquiescence – Sending of a warning letter – Effects of limitation – Associated rights concerning compensation, provision of information and handing over of products for destruction*)

1. In 2006, the International Association for the Protection of Intellectual Property (AIPPI) found that most of the European groups, which were then participating in the summary project undertaken by that association on the issue of acquiescence to acts of infringement of intellectual property rights in general and the interruption of acquiescence by the proprietor of the earlier right, in particular, ‘acknowledge that no



regulation [had] targeted this question and that it [merited] additional specificity, as [did] the entire issue of limitation in consequence of acquiescence'. (2) Nearly 16 years later, and after the Court of Justice had laid the foundations of the Community regime for the limitation in consequence of acquiescence in its judgment in *Budějovický Budvar*, (3) the present reference for a preliminary ruling provides a new opportunity for the Court to define the scope of that legal regime.

## I. Legal background

### A. European Union law

#### 1. Directive 2008/95

2. It is clear from recital 12 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 (4) that 'it is important, for reasons of legal certainty and without inequitably prejudicing the interests of a proprietor of an earlier trade mark, to provide that the latter may no longer request a declaration of invalidity nor may he oppose the use of a trade mark subsequent to his own of which he has knowingly tolerated the use for a substantial length of time, unless the application for the subsequent trade mark was made in bad faith'.

3. Article 4 of Directive 2008/95, entitled 'Further grounds for refusal or invalidity concerning conflicts with earlier rights', provides:

'1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

- (a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;
- (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. "Earlier trade marks" within the meaning of paragraph 1 means:

- (a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;

- (i) Community trade marks;
- (ii) trade marks registered in the Member State ...;
- (iii) trade marks registered under international arrangements which have effect in the Member State;
- (b) Community trade marks which validly claim seniority ...;
- (c) applications for the trade marks referred to in points (a) and (b), subject to their registration;

...  
4. Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

...

(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;

(c) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraph 2 and point (b) of this paragraph and in particular:

- (i) a right to a name;
  - (ii) a right of personal portrayal;
  - (iii) a copyright;
  - (iv) an industrial property right;
- ...'

4. Article 9 of Directive 2008/95 reads as follows:

'1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 4(2) has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.

2. Any Member State may provide that paragraph 1 shall apply *mutatis mutandis* to the proprietor of an earlier trade mark referred to in Article 4(4)(a) or an other earlier right referred to in Article 4(4)(b) or (c).

3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later registered trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trade mark.'

#### 2. Regulation No 207/2009

5. Article 8 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (5) provides:

'1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

- (a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
- (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. For the purposes of paragraph 1, "earlier trade marks" means:

- (a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the European

Union trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

- (i) European Union trade marks;
- (ii) trade marks registered in a Member State ...;
- iii) trade marks registered under international arrangements which have effect in a Member State;
- iv) trade marks registered under international arrangements which have effect in the European Union;
- (b) applications for the trade marks referred to in subparagraph (a), subject to their registration;

...

4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to EU legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the European Union trade mark, or the date of the priority claimed for the application for registration of the European Union trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

...

6. Article 54 of Regulation No 207/2009 on limitation in consequence of acquiescence states as follows:

'1. Where the proprietor of a European Union trade mark has acquiesced, for a period of five successive years, in the use of a later European Union trade mark in the European Union while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later European Union trade mark was applied for in bad faith.

2. Where the proprietor of an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced, for a period of five successive years, in the use of a later European Union trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later European Union trade mark was applied for in bad faith.

3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later European Union trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later European Union trade mark.'

7. Article 110 of Regulation No 207/2009 is entitled 'Prohibition of use of European Union trade marks'. The first paragraph thereof provides that 'this

Regulation shall, unless otherwise provided for, not affect the right existing under the laws of the Member States to invoke claims for infringement of earlier rights within the meaning of Article 8 or Article 53(2) in relation to the use of a later European Union trade mark. Claims for infringement of earlier rights within the meaning of Article 8(2) and (4) may, however, no longer be invoked if the proprietor of the earlier right may no longer apply for a declaration that the European Union trade mark is invalid in accordance with Article 54(2)'.

8. Article 111 of Regulation No 207/2009 reads as follows:

'1. The proprietor of an earlier right which only applies to a particular locality may oppose the use of the European Union trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.

2. Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the European Union trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the European Union trade mark was applied for in bad faith.

3. The proprietor of the European Union trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though that right may no longer be invoked against the European Union trade mark.'

B. German law

9. Paragraph 21 of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (Markengesetz) (Law on the protection of trademarks and other distinctive signs) of 25 October 1994 (the 'Law on trade marks')(6) provides:

'1. The proprietor of a trade mark or trade name is not entitled to prohibit the use of a later registered trade mark for the goods or services for which it is registered if he has knowingly tolerated the use of that trade mark for a period of five consecutive years unless the later trade mark was applied for in bad faith.

2. The proprietor of a trade mark or trade name is not entitled to prohibit the use ... of a later trade name if he has knowingly tolerated the use of [that trade name] for a period of five consecutive years, unless the proprietor of that right was acting in bad faith at the time of its acquisition.

...'

10. Paragraph 125b(3) of the Law on trade marks provides that 'if a registered European Union trade mark is invoked against the use of a later trade mark registered under this Act, paragraph 21(1) [of the Law on trade marks] shall apply mutatis mutandis'.

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

11. The applicant in the main proceedings was entered in the commercial register as Heitec Industrieplanung GmbH in 1984. Its name was changed in 1988 to HEITEC GmbH. Since changing its legal status in 2000, it has been operating under the name of HEITEC AG. It is the proprietor of the word mark HEITEC, European Union trade mark No 774 331,

applied for on 18 March 1998, with seniority claimed as from 13 July 1991, and registered on 4 July 2005. (7)

12. One of the two defendants in the main proceedings (8) was entered in the commercial register on 16 April 2003 under the name HEITECH Promotion GmbH, the name under which it carries on business ('Heitech'). It is the proprietor of a German figurative mark applied for on 17 September 2002, registered on 4 February 2003 and used since 29 September 2004 at the latest. It is also the proprietor of EU figurative mark No 6 647 432 containing the word element HEITECH, applied for on 6 February 2008, registered on 20 November 2008 and used since 6 May 2009 at the latest.

13. On 29 November 2004, Heitech wrote to the representatives of Heitec proposing the conclusion of a coexistence agreement. On 7 July 2008, EUIPO informed Heitec of the lodging of the application for registration of the European Union trade mark HEITECH. On 22 April 2009, Heitec sent a warning letter to Heitech regarding the use of the trade name and the mark containing the word element HEITECH. In its reply of 6 May 2009, Heitech again proposed the conclusion of a coexistence agreement.

14. On 31 December 2012, the Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth, Germany) received by fax the application initiating proceedings, submitted by the applicant in the main proceedings, bearing the date 15 December 2012. On 4 January 2013, that court requested the applicant in the main proceedings to pay an advance on the costs of the proceedings. That advance payment had still not been made by 12 March 2013, when the Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) reminded the applicant in the main proceedings that the advance payment had not been made and that the originals of the document initiating proceedings had not been lodged.

15. On 23 September 2013, Heitec informed Heitech by letter that it was not willing to enter into a coexistence agreement with it. It offered to enter into a licence agreement and at the same time indicated that it had initiated legal proceedings. In a further letter sent to Heitech on 29 December 2013, Heitec informed the defendant in the main proceedings that it was relying on its trade name and that it was the proprietor of the European Union trade mark HEITEC. It also stated that legal proceedings were pending.

16. On 30 December 2013, the Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) received written submissions from Heitec dated 12 December 2013, together with a cheque for court fees and a new application initiating proceedings bearing the date 4 October 2013. On 14 January 2014, that court drew Heitec's attention to the need to serve the application initiating proceedings of 15 December 2012 since it had still not lodged the originals intended for the court and the defendant in the main proceedings. After having been requested to lodge those documents, Heitec sent those originals to the Landgericht Nürnberg-Fürth

(Regional Court of Nuremberg-Fürth) on 22 February 2014.

17. On 24 February 2014, the Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) alerted Heitec to the fact that the heads of claim in the originals of the application initiating proceedings received on 22 February 2014 were not consistent with the heads of claim in the initiating application submitted on 31 December 2012. On 16 May 2014, the Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) finally opened the proceedings and ordered that copies of the initiating application of 15 December 2012 be served on the defendants in the main proceedings.

18. On 23 May 2014, the initiating application of 15 December 2012 was finally served on the defendants in the main proceedings (9) after the original documents were sent to the Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) on 21 May 2014.

19. Heitec brought claims based, primarily, on the infringement of the rights conferred by its trade name HEITEC and, in the alternative, on the infringement of its European Union trade mark HEITEC. It seeks a finding whereby Heitech is ordered to refrain from identifying its company with the name HEITECH Promotion GmbH (Claim I), to refrain from affixing the signs HEITECH PROMOTION and HEITECH on its goods, to refrain from offering goods or services with those signs, to refrain from using those signs in commercial documents, on websites or in advertisements (Claim II), to refrain from using or transferring, for commercial purposes, the website 'heitech-promotion.de' (Claim III) and to agree to the removal of its company name from the commercial register (Claim VII). Heitec has, moreover, brought claims against both defendants for information, for a finding of an obligation to pay compensation, for destruction and for payment of the costs of sending the warning letter (Claims IV, V, VI and VIII).

20. The Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) ordered Heitech to pay Heitec EUR 1 353.80, plus interest, for the costs of sending the warning letter and rejected the other claims.

21. Heitec appealed to the Oberlandesgericht Nürnberg (Higher Regional Court of Nuremberg, Germany). That court, in turn, held that the action was unfounded on the grounds that Heitec was time-barred. In this respect, it argued that Heitech had used its later signs for an uninterrupted period of at least five years and that Heitec had acquiesced to that since, although it was aware of this use, it had not taken sufficient measures to stop it within a period of five years. According to that court, the court action brought before the Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) had not interrupted the limitation period, since it was served on the defendants in the main proceedings only after five years had elapsed since sending the warning letter which preceded that action. The appellate court also held that it was not possible to consider that the acquiescence had ended on the date of sending the warning letter in so far as the service of the

application initiating the proceedings did not take place shortly after sending the warning letter.

22. Heitec lodged an application for judicial review with the referring court. According to that court, the outcome of that action depends on whether Heitec is time-barred from bringing its claims for an injunction and its ancillary claims, pursuant to Article 21(1) and (2) of the Law on trade marks and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009.

23. The referring court notes that the time-barring of Heitec's claims relating to the use by Heitech of the German trade mark of which it is the proprietor (Claim II in so far as it concerns the sign HEITECH PROMOTION) is governed by Paragraph 21(1) of the Law on trade marks, read in conjunction with Paragraph 125b(3) of that law, in so far as those claims are based on the European Union trade mark of which Heitec is the proprietor.

24. It states that Paragraph 21(1) of the Law on trade marks transposes into German law the limitation provided for in Article 9 of Directive 2008/95, on the right conferred by trade marks (Article 9(1) of Directive 2008/95) and by other signs – including trade names – used in the course of business (Article 9(2) of Directive 2008/95), to oppose the use of a registered trade mark.

25. In so far as Heitec is taking action in respect of Heitech's trade name (Claims I, II, III and VII), the limitation is, according to the findings of the referring court, governed by Paragraph 21(2) of the Law on trade marks. In this regard, that court states that, notwithstanding the fact that the scope of that provision goes beyond that of Directive 2008/95 and is not, moreover, reflected in Article 54 of Regulation No 207/2009, it must be interpreted in harmony with the interpretation of Paragraph 21(1) of the Law on trade marks which is consistent with that directive. Furthermore, in so far as Heitec relies on its European Union trade mark, Paragraph 21(2) of the Law on trade marks would apply by virtue of the reference to national law made by Article 101(2) of Regulation No 207/2009. (10)

26. With regard to Heitec's claims concerning the use by Heitech of the European Union trade mark of which it is the proprietor (Claim II in so far as it concerns the sign HEITECH), the referring court finds that Articles 54, 110 and 111(2) of Regulation No 207/2009 are relevant.

27. The referring court then recalls the following findings made by the appellate court. First, Heitech actually used its trade name to identify its business activity and trade marks for the goods and services and in the territory for which they were protected respectively in a manner corresponding to what is claimed in the heads of claim. There was therefore use, at the latest on 6 May 2009, when Heitech sent a letter to Heitec proposing the conclusion of a coexistence agreement. Second, it must be assumed that it was on that date, at the latest, that Heitec also became aware of the use of the signs in question. Finally, Heitech's good faith was not called into question either before the

Landgericht Nürnberg-Fürth (Regional Court of Nuremberg-Fürth) or before the appellate court.

28. According to the referring court, it is nevertheless necessary to specify the conditions for 'acquiescence' within the meaning of Article 9(1) and (2) of Directive 2008/95 and Article 111(2) of Regulation No 207/2009 by determining, in particular, whether, as might be understood from the judgment in *Budějovický Budvar*, (11) only administrative or court action shall be liable to interrupt the five-year limitation period or whether conduct such as sending a warning letter not necessarily or not immediately followed by the institution of proceedings before the aforementioned bodies could suffice for that purpose. More specifically, the referring court has doubts as to whether conduct such as that adopted by Heitec in the context of the main proceedings can be regarded as conduct which has put an end to the acquiescence within the meaning of the abovementioned provisions. Finally, in the event that legal proceedings are finally brought, the referring court wonders at what point the limitation period is to be regarded as interrupted where the defendant's receipt of the document instituting the proceedings is delayed, through the fault of the proprietor of the earlier mark, until after the expiry of the five-year period.

29. In those circumstances, the Bundesgerichtshof (Federal Court of Justice, Germany) decided to stay the proceedings and, by decision received at the Court Registry on 25 September 2020, to refer the following questions to the Court of Justice for a preliminary ruling:

*“(1) Can acquiescence within the meaning of Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009 be excluded not only by means of an administrative or court action, but also through conduct not involving a court or administrative authority?*

*(2) If Question 1 is answered in the affirmative: does the sending of a warning letter, in which the proprietor of the earlier sign, before initiating legal proceedings, requires the proprietor of the later sign to agree to refrain from using the sign, and to enter into an obligation to pay a contractual penalty in the event of an infringement, constitute conduct precluding acquiescence within the meaning of Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of [Regulation No 207/2009]?*

*(3) When seeking judicial redress, is the bringing of the action before the court or the receipt of the action by the defendant decisive for calculating the five-year acquiescence period for the purposes of Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of [Regulation No 207/2009]? Is it significant in this regard that receipt of the action by the defendant is delayed beyond the expiry of the five-year period through the fault of the proprietor of the earlier trade mark?*

*(4) Does the limitation of rights in accordance with Article 9(1) and (2) of [Directive 2008/95] and Article 54(1) and (2) and Article 111(2) of [Regulation No 207/2009] encompass consequential claims under trade mark law, for example, claims for compensation,*

*provision of information or destruction, as well as prohibitory injunctions?”*

### III. Procedure before the Court of Justice

30. Heitec, Heitech and the European Commission submitted their observations to the Court of Justice. The Court also sent questions for written answer to all the participants in the written stage of the present preliminary ruling procedure, all of whom submitted their answers to those questions to the Court.

### IV. Analysis

#### A. Introductory remarks

31. As regards the applicable law, the questions referred to the Court for a preliminary ruling concern the interpretation of provisions of Directive 2008/95 and Regulation No 207/2009. Although these two acts have now been repealed and replaced, (12) they contain, as the referring court noted, the provisions applicable *ratione temporis* to the dispute in the main proceedings, since the essence of the case is to determine what type of conduct shall be liable to have put an end to the tolerance of known infringements of earlier rights in a context in which a case was finally brought before a court by the proprietor of those rights – the applicant in the main proceedings – and where the action was served on the defendant in the main proceedings no later than 23 May 2014, under the two abovementioned acts.

32. As regards those acts, it will be recalled that Regulation No 207/2009 defines the legal regime applicable to European Union trade marks, understood as trade marks for goods or services registered in accordance with the conditions contained in that regulation. (13) In that regard, it should be noted that Heitec is the proprietor of the EU word mark HEITEC registered on 4 July 2005 and that the defendant in the main proceedings is, for its part, the proprietor of an EU figurative mark containing the word element HEITECH registered on 20 November 2008. For its part, Directive 2008/95 applies 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. (14) The defendant in the main proceedings is the proprietor of a German figurative mark containing the word element HEITECH PROMOTION registered on 4 February 2003.

33. The various claims made in the main action seek to challenge both the use of the German trade mark of which Heitech is proprietor and its use of the European Union trade mark of which it is proprietor. (15)

#### B. The first and second questions referred for a preliminary ruling

34. By the first and second questions referred to the Court for a preliminary ruling – which, in my view, should be considered together – the referring court seeks clarification from the Court of Justice as to the legal regime for limitation in consequence of acquiescence provided for both by Directive 2008/95 and by Regulation No 207/2009.

35. It should be noted at the outset that the wording of Article 9(1) of Directive 2008/95 (16) is almost identical to that of Article 54(1) of Regulation

No 207/2009. Both provisions provide for a similar scheme: the proprietor of an earlier trade mark (national or European Union) which has acquiesced, in another Member State or more generally in the European Union, to the use of a later trade mark for a period of five consecutive years and with knowledge of such use, may no longer apply for a declaration of invalidity or oppose the use of the later trade mark on the basis of the earlier trade mark in respect of the goods or services for which the later trade mark has been used. The limitation can be overcome in at least two cases: if the application for the later mark was made in bad faith or if it is no longer possible to establish acquiescence on the part of the proprietor of the earlier mark. Article 111(2) of Regulation No 207/2009 provides for a similar scheme.

#### 1. What is known about acquiescence

36. The first two questions referred ask the Court to clarify what type of event or conduct is capable of ending acquiescence within the meaning of Article 9(1) of Directive 2008/95 and Articles 54(1) and (2) and 111(2) of Regulation No 207/2009.

37. Before answering these questions, it is necessary, first of all, to define this concept of ‘acquiescence’. In this respect, the judgment in *Budějovický Budvar* (17) contains a number of useful insights. The Court was asked, inter alia, about the interpretation of Article 9(1) of Directive 89/104/EEC, (18) a provision which is reproduced identically in Article 9(1) of Directive 2008/95, with the result that the statements contained in the aforementioned judgment which concern Directive 89/104 apply, *mutatis mutandis*, to the interpretation of Article 9(1) of Directive 2008/95.

38. It may therefore be inferred from that judgment that the equivalence referred to in Article 9(1) of Directive 2008/95, in so far as it is neither defined by that provision that does not contain an express reference to national law for that purpose, nor by any other provision of that directive, is an autonomous concept of EU law. (19)

39. Furthermore, the Court held, with particular reference to recitals 3, 7, 9 and 11 of Directive 89/104 (20), that Article 9 of that directive effects ‘a complete harmonisation of the conditions under which the proprietor of a later registered trade mark may, through the limitation in consequence of acquiescence, maintain his rights to that mark where the proprietor of an identical earlier trade mark seeks a declaration that the later trade mark is invalid or opposes its use’. (21) Since those recitals were reproduced in recitals 4, 8, 10 and 12 of Directive 2008/95, this is also true of the latter.

40. Finally, the Court ruled that the same concept of acquiescence was used in Article 54(1) of Regulation No 207/2009 ‘with the same meaning as in Article 9(1) of Directive 89/104’ (22) and therefore with the same meaning as in Article 9(1) of Directive 2008/95. ‘Acquiescence’, within the meaning of Article 9(1) of Directive 2008/95 and Article 54(1) of Regulation No 207/2009, is therefore a concept of EU law, the meaning and scope of which must be identical in all Member States and which must be given an autonomous and uniform interpretation in the EU legal order. (23)

41. Asked to clarify the interpretation of an autonomous concept of EU law for which EU law did not provide a definition, the Court carried out a traditional analysis consisting of determining the meaning and scope of that concept by reference to the usual meaning in everyday language of the term ‘acquiescence’, while also taking into account the context in which that concept was used and the purposes of the rules of which it formed part. (24) It emerged from this analysis that ‘the characteristic of a person who acquiesces is that he is passive and declines to *take measures open to him* to remedy a situation of which he is aware and which is not necessarily as he wishes. ... the concept of “acquiescence” implies that the person who acquiesces remains inactive when faced with a situation which he would be *in a position to oppose*’. (25)

42. First, the proprietor of the earlier trade mark must therefore have ‘knowingly tolerated’ the use of a trade mark subsequent to its own for a substantial length of time and therefore “‘intentionally”, “in full knowledge of the facts””. (26)

43. Second, the objective of Directive 89/104, as of Directive 2008/95, is to ‘strike a balance between the interest of the proprietor of a trade mark to safeguard its essential function and the interests of other economic operators in having signs capable of denoting their goods and services’, (27) that objective ‘[implying] that, in order to safeguard that essential function, the proprietor of an earlier trade mark must be capable ... of opposing the use of a later trade mark identical to [its] own’. (28) Thus, the Court held in paragraph 49 of the judgment in *Budějovický Budvar* (29) that ‘the effect of any administrative action or court action initiated by the proprietor of the earlier trade mark within the period prescribed in Article 9(1) of Directive 89/104 [and thus of Article 9(1) of Directive 2008/95] is to interrupt the period of limitation in consequence of acquiescence’.

## 2. The need to formalise the end of the acquiescence to the infringement of rights

44. The introduction of such an action is clearly the most advanced, most formalised degree of the ‘position to oppose’, to use the language of the Court. However, it is not clear from the text of paragraph 49 alone of the judgment in *Budějovický Budvar* (30) that the Court ruled that only the introduction of such an action can have the effect of interrupting the limitation period in consequence of acquiescence. Nor does this seem to me to be an explicit requirement of the EU legislature, having regard to the actual wording of Article 9(1) and (2) of Directive 2008/95 and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009.

45. Heitech submits that those provisions should be interpreted as referring only to legal actions actually initiated to end acquiescence and, in support of its argument, invokes various provisions of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights. (31) Those provisions frequently refer to the national jurisdictional authorities competent in intellectual property matters. However, I

note that the purpose of Directive 2004/48 is to approximate national laws which, until then, offered a disparate level of protection as regards the means of enforcing intellectual property rights, so that its specific subject matter is, according to Article 1 thereof, ‘the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights’. All these measures, procedures and remedies are judicial in nature. Furthermore, it must be stated that there is no provision in Directive 2004/48 dealing with the issue of limitation in consequence of acquiescence, so that no meaningful conclusion for the present case can really be drawn from the reading of that directive.

46. Thus, if one were to rely on the lack of precision of the text of the two legal rules submitted for our examination today, it could easily be concluded that any behaviour of the proprietor of the earlier trade mark which tends to produce, in a somewhat active manner, a disagreement with the use by the proprietor of the later trade mark, of the trade mark and/or of the sign concerned, could suffice to interrupt the period of limitation in consequence of acquiescence.

47. Since the textual interpretation of the two provisions before us today is not enlightening, it is necessary to consider the purpose of the provisions. In this respect, it should be noted that the EU legislature has clearly indicated that limitation in consequence of acquiescence was introduced ‘for reasons of legal certainty and without inequitably prejudicing the interests of a proprietor of an earlier trade mark’. (32) In order to fill the gaps left by the legislature, it is therefore important to take due account of its desire to ‘strike a balance between the interest of the proprietor of a trade mark to safeguard its essential function and the interests of other economic operators in having signs capable of denoting their goods and services’. (33)

48. It follows from the foregoing that, in my view, acquiescence is terminated when the proprietor of the earlier mark *takes the measures open to it to put an end* to the infringement of its rights. And, since it is a question of balancing the interests involved while respecting the legal certainty of each party, that opposition must be formalised by recourse to the legal means available with a view to obtaining a binding solution.

49. The formalisation of the opposition is indeed necessary to ensure, as Heitech and the Commission have rightly argued, the effectiveness of Article 9(1) of Directive 2008/95 and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009. Indeed, if an informal exchange, such as the sending of a simple letter, could suffice to interrupt the time limit, the legal position of the proprietor of the later trade mark (assuming the other required conditions were met) could never be consolidated. That is clearly not the intention of the EU legislature, as I mentioned above. For example, a letter threatening legal proceedings, without the threat ever being carried out, would consist in the proprietor of the earlier mark declining, within the meaning of the judgment in *Budějovický Budvar*, (34) to take measures open to it to remedy a situation of which

it is undeniably aware, thereby prolonging the acquiescence instead of interrupting it. In that respect, sending a warning letter does not provide any more guarantees as to the seriousness of the intention to assert one's rights in a binding manner.

50. The formalisation of the opposition is necessary in so far as legal certainty requires that both the starting point of the time limit (35) and the time at which it is interrupted or expires be precisely determined. For that to be the case, only an event which unequivocally shows a clear and serious intention to assert rights, such as the bringing of a judicial or administrative action, is likely to put an end to acquiescence.

51. It follows from the above that only an unequivocal expression of a clear and serious intention to terminate the acquiescence by the proprietor of the earlier rights taking judicial or administrative action is capable, if taken within a period of five years from the date on which the proprietor became aware of the use of the later mark, of terminating the acquiescence within the meaning of Article 9(1) and (2) of Directive 2008/95 and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009.

### ***C. The third question referred for a preliminary ruling***

52. If, as I suggest, the Court were to hold that only the bringing of an action before an administrative or judicial body shall be liable to interrupt the five-year period and thus terminate the acquiescence within the meaning of Article 9(1) of Directive 2008/95 and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009, the referring court asks the Court to clarify further at what exact moment that period is deemed to have ended.

53. In this regard, I note that my analysis of the first and second questions referred for a preliminary ruling shows that what is decisive is the attitude of the proprietor of the earlier trade mark. In my opinion, in order to determine whether the time limit for limitation in consequence of acquiescence has come to an end, it is therefore necessary to look at it from the point of view of that proprietor to examine whether, from a subjective point of view, it has taken the necessary steps with a view to stopping the infringement of its rights by bringing legal action. At the time when that action was brought, the serious and unequivocal intention to assert its rights was very clear on the part of the proprietor of the earlier mark.

54. Furthermore, unlike the limitation period, which affects the enforceability of a subjective right which the person concerned can no longer effectively assert before the courts, (36) the time limit directly and immediately affects the ability to bring legal proceedings. The action is therefore not time-barred as long as it is brought within five years of knowledge of its use and it is therefore, in my view, logical that the time limit should end on the date on which the action is brought or, more precisely, on the date of the application initiating proceedings. While it harmonises, as such, the period of limitation in consequence of acquiescence as well as, in principle, the effects of such acquiescence, EU law

leaves it to Member States to organise the procedural aspects of a legal action (as well as the conditions of its admissibility or even its service), the specific aim of which is to put an end to the acquiescence. In those circumstances, taking the date of the interruption of the limitation period as the date on which the legal action is brought, seems to me, as EU law currently stands, to be the most satisfactory solution and the one most likely to iron out the national differences which might become more marked during the successive stages of the legal proceedings. At the time of bringing the action, the intention of the proprietor of the earlier mark can be established with relative certainty. (37)

55. On the other hand, using the date of service on the defendant to the action seems to me to be more risky, given the differences in national practices that I mentioned earlier. On this point I agree with the reservations expressed by the Commission.

56. Finally, I also agree with the Commission that, although, in principle, the limitation period is interrupted from the date on which the action is brought before the competent court, it will ultimately be for the courts concerned to determine whether that is the case. Thus, in so far as the interests of the proprietor of the later trade mark must also be taken into consideration, the interruption of the limitation period can only be effected under certain conditions, the first of which is the admissibility of the action brought. Since these interests must be borne in mind, the defendant must be informed of the existence of the action within a relatively short period of time following the bringing of that action. An applicant who delays in regularising an application that is irregular in form, for example, or who in some way hinders the proceedings by leaving unclear its true intention to bring proceedings (such as by failing to pay the costs of the proceedings) or, as the referring court points out, through its own fault delays informing the defendant so that the passage of time would have given rise to a legitimate expectation on the part of the defendant in being able to rely on acquiescence, should not, in those very particular circumstances, claim to have interrupted the period of limitation in consequence of acquiescence until it has put its application in order, or paid the costs of the proceedings or finally complied with the orders of the relevant court so that its action can finally be considered as having been effectively brought.

57. I note that the period of limitation in consequence of acquiescence is, according to EU law, five years and that it begins to run from the moment when the proprietor of the earlier mark becomes aware of the use by the proprietor of the later mark. This five-year period enables the proprietors of earlier rights to assert their rights in the context of a situation of which they have been aware for a long time, without waiting until the very end of the period to bring their action. If this were to be the case, it would be in their interest to bring a properly directed and validly filed action as soon as possible to avoid being accused of negligence. (38)

58. In those circumstances, where the expiry of the period of limitation in consequence of acquiescence occurs between the bringing of that action and its

notification to the defendant, it will be for the relevant court to assess whether or not there has been a delay in notifying the defendant and, if so, whether that delay can be attributed to the conduct of the defendant during the proceedings. In such a case, the relevant court must still examine whether such conduct is likely to call into question the serious nature of the action brought before it and must draw all the necessary conclusions therefrom with regard to the calculation of the period of limitation in consequence of acquiescence.

59. It follows from the foregoing that, where legal proceedings are brought by the proprietor of the earlier trade mark, the date on which those proceedings are brought must, in principle, be taken as the date of interruption of the five-year limitation period laid down in Article 9(1) and (2) of Directive 2008/95 and in Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009. Where the expiry of that time limit occurs between the lodging of the said action and its service on the defendant, it will then be for the relevant court to assess whether or not there has been a delay in informing the defendant and, if so, whether that delay can be attributed to the conduct of the defendant during the proceedings. In such a case, the relevant court must still examine whether such conduct is likely to call into question the serious nature of the action brought before it and must draw all the necessary conclusions therefrom with regard to the calculation of the period of limitation in consequence of acquiescence.

#### **D. The fourth question referred for a preliminary ruling**

60. By this question the referring court wishes to know whether a limitation of rights encompasses not only prohibitory injunctions on the use of the later trade mark but also ancillary and connected claims, such as those seeking a finding of an obligation to pay compensation, provide information and destroy counterfeit goods.

61. The objection of the applicant in the main proceedings that, in so far as there is no limitation of rights in the main proceedings, there is no need for the Court to answer that fourth question, must be addressed at the outset. I would point out that, while the Court's task is to provide the referring court with a helpful interpretation of the provisions which it intends to apply, the Court has no jurisdiction to give a ruling on the facts of the main proceedings or to apply the rules of EU law which it has interpreted to national measures or situations, since those questions are matters for the exclusive jurisdiction of the national courts. (39) Consequently, the Court cannot assume that the action brought by the applicant in the main proceedings before those courts is not time-barred in order not to answer the question referred.

62. Returning to this fourth question, I note, first, that neither the text of Article 9(1) and (2) of Directive 2008/95 nor that of Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009 specifies in concrete terms the effects of the limitation of rights. However, on reading those provisions, we learn that, if the conditions otherwise provided for therein for

establishing limitation of rights are met, the proprietor of the earlier mark 'shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used'. (40) *A contrario*, therefore, until limitation in consequence of acquiescence occurs, the proprietor of a trade mark is authorised to request that the later mark be declared invalid or to oppose its use by means of infringement proceedings. (41)

63. As regards the European Union trade mark, the consequences of invalidity are, for their part, specified in Article 55(2) of Regulation No 207/2009 according to which 'the European Union trade mark shall be deemed not to have had, as from the outset, the effects specified' in that regulation, which are governed by Section 2 of Title II thereof. Directive 2008/95 does not contain equivalent provisions and it is clear from recital 6 of that directive that 'Member States should remain free to determine the effects of revocation or invalidity of trade marks'.

64. Like the analysis conducted in relation to the first and second questions referred for a preliminary ruling, the letter of Article 9(1) and (2) of Directive 2008/95 and of Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009 must be informed by a purposive reading of those provisions. If the limitation in consequence of acquiescence is a mechanism provided for in order to ensure the balancing of the interests involved in the preservation of the imperative of legal certainty, it would seem to me to be contrary to the latter if, after five years of acquiescence, the proprietor of the earlier trade mark could no longer request the invalidity of the later trade mark or oppose its use, but could continue to obtain compensation following a use which it did not oppose when it could have done so and which it can no longer oppose because of the limitation. The legal certainty sought would be jeopardised if the proprietor of the earlier trade mark could indefinitely continue to seek redress throughout the tolerated parallel use of the two marks. Moreover, because of this very acquiescence, it would be a legal absurdity to obtain the destruction of goods that cannot be classified as counterfeit.

65. I am therefore inclined to consider that being unable to 'oppose the use of the later trade mark', within the meaning of Article 9(1) and (2) of Directive 2008/95 and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009, must be interpreted broadly so that, from the moment when the limitation in consequence of acquiescence is established, the proprietor of the earlier trade mark loses all its privileges relating to the earlier trade mark vis-à-vis the proprietor of the later trade mark whose use it has tolerated and that the limitation in consequence of acquiescence must therefore be understood as affecting not only the action for a prohibitory injunction but also ancillary claims based on the earlier trade mark right, such as claims for compensation, information or destruction.

#### **V. Conclusion**



66. In view of all the foregoing considerations, I suggest that the Court answer the questions referred by the Bundesgerichtshof (Federal Court of Justice, Germany) as follows:

(1) Article 9(1) and (2) 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 and Article 54(1) and (2) and Article 111(2) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark must be interpreted as meaning that only the unequivocal expression of a clear and serious intention that the acquiescence be terminated, by the proprietor of the earlier rights instituting judicial or administrative proceedings shall, if expressed within a period of five years from the proprietor's knowledge of the use of the later trade mark, be liable to terminate the time limit for limitation in consequence of acquiescence.

(2) Where legal action is brought by the proprietor of the earlier trade mark, the date of the bringing of that action should, in principle, be taken as the date of interruption of the five-year limitation period as provided for in Article 9(1) and (2) of Directive 2008/95 and in Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009. Where the expiry of that time limit occurs between the bringing of the action and its service on the defendant, it will be for the relevant court to assess whether or not there has been a delay in informing the defendant and, if so, whether that delay can be attributed to the conduct of the defendant during the proceedings. In such a case, the relevant court will still have to examine whether such conduct is liable to call into question the seriousness of the action brought before it and will have to draw all the necessary conclusions with regard to the calculation of the period of limitation in consequence of acquiescence.

(3) Article 9(1) and (2) of Directive 2008/95 and Article 54(1) and (2) and Article 111(2) of Regulation No 207/2009 must be interpreted as meaning that, from the time when limitation in consequence of acquiescence is established, the proprietor of the earlier trade mark loses all its rights connected with the precedence of its trade mark vis-à-vis the proprietor of the later trade mark the use of which it has tolerated and that, consequently, the limitation in consequence of acquiescence within the meaning of those provisions must be understood as encompassing not only the prohibitory injunction but also the ancillary claims based on the right to the earlier mark.

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1 Original language: French.

2 International Association for the Protection of Intellectual Property, 'Summary Report – Question Q192 – Acquiescence (tolerance) to infringement of Intellectual Property Rights', 2006, available here: <https://www.aippi.fr/upload/Gothenburg%202006%20Q189%20190%20191%20192/sr192english.pdf>

3 [Judgment of 22 September 2011 \(C-482/09, EU:C:2011:605\)](#).

4 OJ 2008 L 299, p. 25.

5 OJ 2009 L 78, p. 1.

6 BGB1. 1994 I, p. 3082.

7 The referring court states that, by decision of 5 June 2018, the European Union Intellectual Property Office (EUIPO) declared the applicant in the main proceedings to have forfeited its trade mark rights for non-use. That applicant appealed that decision to the General Court of the European Union. At the time of writing, that appeal is still pending (T-520/19).

8 The action in the main proceedings is also directed against RW, the defendant's managing director. Unless otherwise stated, Heitech will be referred to as the defendant in the main proceedings throughout this Opinion.

9 See **point 12** of this Opinion.

10 According to which 'on all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law'.

11 Judgment of 22 September 2011 (C-482/09, EU:C:2011:605).

12 Directive 2008/95 is no longer in force since 14 January 2019 and was replaced by 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). Regulation No 207/2009 is no longer in force since 30 September 2017 and was replaced by 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). The provisions of Directive 2015/2436 and of Regulation 2017/1001 on limitation in consequence of acquiescence are entirely similar to those contained in Directive 2008/95 and in Regulation No 207/2009: see, for comparison, Article 9(1) and (2) of Directive 2015/2436 and Article 61(1) and (2) and Article 138(2) of Regulation 2017/1001.

13 See Article 1 of Regulation No 207/2009.

14 See Article 1 of Directive 2008/95.

15 For the details of these various claims, **see points 23 et seq. of this Opinion**.

16 Since Article 9(2) of Directive 2008/95 allows Member States to extend the application of Article 9(1) thereof to the cases mentioned therein, the interpretation

given to the latter provision also applies when Member States implement Article 9(2) of that directive.

17 [Judgment of 22 September 2011 \(C-482/09, EU:C:2011:605\)](#).

18 First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1).

19 See, by analogy, [judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraphs 28 and 29\)](#).

20 See [judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraphs 30 to 32\)](#).

21 [Judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 33\)](#).

22 [Judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 35\)](#).

23 See, by analogy, [judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 37\)](#).

24 See [judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 39 and the case-law cited\)](#).

25 [Judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 44\)](#). *Italics added.*

26 [Judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 47\)](#).

27 [Judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 48\)](#).

28 [Judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 48\)](#).

29 [Judgment of 22 September 2011 \(C-482/09, EU:C:2011:605\)](#).

30 [Judgment of 22 September 2011 \(C-482/09, EU:C:2011:605\)](#).

31 OJ 2004 L 157, p. 45.

32 Recital 12 of Directive 2008/95.

33 [Judgment of 22 September 2011, Budějovický Budvar \(C-482/09, EU:C:2011:605, paragraph 48\)](#). See also paragraph 34 of this judgment and the case-law cited.

34 [Judgment of 22 September 2011 \(C-482/09, EU:C:2011:605\)](#).

35 See, however, in a totally different context, judgment of 16 May 2000, Preston and Others (C-78/98, EU:C:2000:247, paragraph 68).

36 See [judgment of 8 November 2012, Evropaïki Dynamiki v Commission \(C-469/11 P, EU:C:2012:705, paragraph 52\)](#).

37 That certainty can only be relative as long as the court decision on the substance of the case has not been given and in so far as, for example, it is always possible to discontinue the action in the course of the proceedings.

38 Here again, everything will depend on the court's assessment of all the circumstances of the case submitted to it for examination. For example, in the case of an action brought at the very end of the five-year period but where the two interested parties have long been in negotiations or engaged in non-contentious dispute resolution, the lateness of the filing of the action could not, of course, be interpreted as negligence on the part of the proprietor of the earlier mark.

39 Amongst a large body of case-law, see, in particular, [judgment of 7 September 2006, Jehle, Weinhaus Kiderlen \(C-489/04, EU:C:2006:527, paragraph 36 and the case-law cited\)](#).

40 Article 9(1) of Directive 2008/95. Article 54 of Regulation No 207/2009 is drafted in similar but not strictly identical terms.

41 See order of 10 March 2015, Rosa dels Vents Assessoria (C-491/14, EU:C:2015:161, paragraph 25).