

Court of Justice EU, 10 March 2022, Maxxus v Globus



## TRADE MARK LAW

**Burden of proof for genuine use within the meaning of Article 19 Directive (EU) 2015/2436 Trade Marks Directive 2015 rests on the trade mark proprietor**

- [Burden of proof does not constitute a procedural rule within the competence of the Member States procedural requirement - the same legal protection in all member states is fundamental](#)

In this connection, it should be pointed out that the question of the burden of proof in respect of genuine use, within the meaning of Article 19(1) of Directive 2015/2436, in the context of proceedings relating to revocation of a trade mark for non-use does not constitute a procedural provision falling within the competence of the Member States ([see, by analogy, judgment of 22 October 2020, Ferrari, C-720/18 and C-721/18, EU:C:2020:854, paragraph 76 and the case-law cited](#)).

34. If that question were a matter for the national law of the Member States, the consequence for proprietors of trade marks could be that protection would vary according to the legal system concerned, with the result that the objective of ‘*the same protection under the legal systems of all the Member States*’ set out in recital 10 of Directive 2015/2436, where it is described as ‘*fundamental*’, would not be attained ([see, by analogy, judgment of 22 October 2020, Ferrari, C-720/18 and C-721/18, EU:C:2020:854, paragraph 77 and the case-law cited](#)).

### Article 19 Trade Marks Directive 2015

- [precludes a procedural rule of a Member State according to which, in revocation proceedings for non-use of a trade mark, the applicant is required to carry out a market research on the possible use of that trade mark by the proprietor and to substantiated submissions in support of its application](#)

Source: [ECLI:EU:C:2022:174](#)

Court of Justice EU, 10 March 2022

(Jarukaitis, Gratsias, Csehi)

JUDGMENT OF THE COURT (Tenth Chamber)

10 March 2022<sup>1</sup>

(Reference for a preliminary ruling – Approximation of laws – Trade marks – Directive (EU) 2015/2436 – Article 19 – Genuine use of a trade mark – Burden of

proof – Application to revoke for non-use – National procedural rule obliging the applicant to carry out market research concerning use of the mark)

In Case C-183/21,

REQUEST for a preliminary ruling under Article 267 TFEU from the Landgericht Saarbrücken (Regional Court, Saarbrücken, Germany), made by decision of 4 March 2021, received at the Court on 23 March 2021, in the proceedings

Maxxus Group GmbH & Co. KG

v

Globus Holding GmbH & Co. KG,

THE COURT (Tenth Chamber),

composed of I. Jarukaitis, President of the Chamber, D. Gratsias (Rapporteur) and Z. Csehi, Judges, Advocate General: N. Emiliou,

Registrar: A. Calot Escobar,

having regard to the written procedure, after considering the observations submitted on behalf of:

– Maxxus Group GmbH & Co. KG, by E. Stolz, Rechtsanwalt,

– the European Commission, by G. Braun, G. Wilms and É. Gippini Fournier, acting as Agents, having decided, after hearing the Advocate General, to proceed to judgment without an Opinion, gives the following

### Judgment

1. This request for a preliminary ruling concerns the interpretation of Article 12(1) 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 of Articles 16, 17 and 19 of 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, and corrigendum OJ 2016 L 110, p. 5).

2. The request has been made in proceedings between Maxxus Group GmbH & Co. KG (‘Maxxus’) and Globus Holding GmbH & Co. KG (‘Globus’) concerning revocation of the latter’s rights in two trade marks registered in Germany.

### Legal context

#### European Union law

Directive 2008/95

3. Article 10 of Directive 2008/95, headed ‘*Use of trade marks*’, stated:

‘1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Directive, unless there are proper reasons for non-use. The following shall also constitute use within the meaning of the first subparagraph:

<sup>1</sup> Language of the case: German.

(a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;  
 (b) affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.

2. Use of the trade mark with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor. ...'

4. Article 12 of Directive 2008/95, headed 'Grounds for revocation', provided in paragraph 1: 'A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use. However, no person may claim that the proprietor's rights in a trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed. The commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.'

Directive 2015/2436

5. Recital 10 of Directive 2015/2436 states:

'It is essential to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States. ...'

6. Article 16 of Directive 2015/2436, headed 'Use of trade marks', provides:

'1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during a continuous five-year period, the trade mark shall be subject to the limits and sanctions provided for in Article 17, Article 19(1), Article 44(1) and (2), and Article 46(3) and (4), unless there are proper reasons for non-use. ...'

5. The following shall also constitute use within the meaning of paragraph 1:

(a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor;

(b) affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.

6. Use of the trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.'

7. Article 17 of Directive 2015/2436, headed 'Non-use as defence in infringement proceedings', provides:

'The proprietor of a trade mark shall be entitled to prohibit the use of a sign only to the extent that the proprietor's rights are not liable to be revoked pursuant to Article 19 at the time the infringement action is brought. If the defendant so requests, the proprietor of the trade mark shall furnish proof that, during the five-year period preceding the date of bringing the action, the trade mark has been put to genuine use as provided in Article 16 in connection with the goods or services in respect of which it is registered and which are cited as justification for the action, or that there are proper reasons for non-use, provided that the registration procedure of the trade mark has at the date of bringing the action been completed for not less than five years.'

8. Article 19 of Directive 2015/2436, headed 'Absence of genuine use as ground for revocation', states:

'1. A trade mark shall be liable to revocation if, within a continuous five-year period, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

2. No person may claim that the proprietor's rights in a trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed.

3. The commencement or resumption of use within the three-month period preceding the filing of the application for revocation which began at the earliest on expiry of the continuous five-year period of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.'

9. Article 54 of Directive 2015/2436, headed 'Transposition', provides:

'1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with Articles 3 to 6, Articles 8 to 14, Articles 16, 17 and 18, Articles 22 to 39, Article 41, Articles 43 and 44 and Articles 46 to 50 by 14 January 2019. Member States shall bring into force the laws, regulations and administrative provisions to comply with Article 45 by 14 January 2023. They shall immediately communicate the text of those measures to the Commission. ...'

10. Article 55 of Directive 2015/2436, headed 'Repeal', provides:

'Directive [2008/95] is repealed with effect from 15 January 2019, without prejudice to the obligations of the Member States relating to the time limit for the transposition into national law of [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)] set out in Part B of Annex I to Directive [2008/95].

References to the repealed Directive shall be construed as references to this Directive and shall be read in accordance with the correlation table in the Annex.'

German law

11. Under Paragraph 49(1) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (Markengesetz) (Law on the protection of trade marks and other signs) of 25 October 1994 (BGBl. 1994 I, p. 3082), the registration of a trade mark is, upon application, to be cancelled on the ground of revocation if the trade mark has not been used within a continuous period of five years.

12. Under Paragraph 55(2)(1) of that law, any person may bring an action pursuant to Paragraph 49 thereof for a declaration of revocation of a trade mark in so far as he or she pleads non-use of that mark.

**The facts giving rise to the dispute in the main proceedings and the question referred for a preliminary ruling**

13. Globus is the proprietor of the word mark MAXUS. That mark was registered in July 1996 at the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office, Germany) for a number of goods in Classes 1 to 9 and 11 to 34 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

14. In addition, Globus is the proprietor of the following figurative mark, registered at the German Patent and Trade Mark Office in May 1996 for goods in Classes 1 to 9 and 11 to 34:



15. On 28 November 2019, Maxxus brought before the Landgericht Saarbrücken (Regional Court, Saarbrücken, Germany), which is the referring court, an action seeking, in essence, a declaration revoking Globus's trade marks referred to in paragraphs 13 and 14 of the present judgment on the ground of non-use.

16. In support of its application, Maxxus submits that over the past five years Globus did not make a use of those trade marks that is such as to preserve its rights over them. Maxxus states that it has searched online, including on Globus's website, and that those searches have provided no indication of such use. If the term 'MAXUS' is entered in the internal search tool on Globus's website, two results are displayed, which refer to a beverage store in Freilassing (Germany) operated by a company connected to Globus. However, it is apparent from research on the internet that the beverages sold by that company bear not the trade mark MAXUS, but other marks of third party manufacturers. That was confirmed by investigations carried out in the store in question by a detective agency instructed by Maxxus.

17. Globus disputes those contentions and maintains that it has made a use of the two trade marks at issue that is such as to preserve its rights over them.

18. The referring court points out that, in the context of proceedings for revocation of a trade mark for non-use, under the case-law of the Bundesgerichtshof (Federal Court of Justice, Germany) a distinction is to be drawn between the burden of setting out the facts (Darlegungslast) and the burden of proof. As regards the setting out of the facts, it is incumbent upon the applicant to set out, in a substantiated manner, the matters intended to show non-use of the trade mark. For that purpose, it should, using its own resources, conduct an investigation to ascertain whether the proprietor used the mark concerned in such a way as to preserve its rights. Since the applicant does not, generally, have knowledge of the business processes of the proprietor of the mark, the proprietor could then bear a 'secondary' burden of setting out the facts. As to the burden of proof in respect of non-use, that burden rests on the applicant.

19. The referring court observes that, following the judgment of 22 October 2020, Ferrari (C-720/18 and C-721/18, EU:C:2020:854, paragraph 82), in which the Court of Justice ruled that the burden of proof that a trade mark has been put to 'genuine use', within the meaning of Article 12(1) of Directive 2008/95, rests on the proprietor of that mark, the abovementioned case-law of the Bundesgerichtshof (Federal Court of Justice) relating to the burden of proof is no longer tenable. It considers, however, that the question whether national law may continue to place the burden of setting out the facts on the applicant remains unresolved. In its view, that question must be answered in the affirmative.

20. In that regard, the referring court provides explanation of the distinction drawn in German law between the burden of setting out the facts and the burden of proof. The burden of setting out the facts requires a party to be as concrete as possible in its submissions, at the risk of losing the case if it does not fulfil that obligation. German procedural law also imposes on the defendant a secondary burden of setting out the facts. Each of the parties is required to carry out investigations in their own sphere of activity. Those various burdens and obligations are separate from the burden of proof. The burden of setting out the facts differs from the burden of proof in that each party must present submissions concerning the facts that are known to it or can be researched with reasonable effort.

21. The referring court takes the view that EU law, and, in particular, Directive 2015/2436, do not preclude the burden of setting out the facts from being placed on the party that applies for revocation of a trade mark for non-use. That burden may be justified by a weighing up of the interests of the parties concerned. In proceedings for revocation of a trade mark for non-use, it is incumbent upon the applicant to verify, to the extent possible, whether the defendant has put its mark to genuine use. It is only after such an investigation has been conducted and its results set out that the defendant is to be required to reveal the use that it has made of its mark. Since no specific legal interest in bringing proceedings is required



in order to apply for revocation of a trade mark for non-use, any person might require the proprietor to disclose the use that it makes of its mark, entailing a serious risk of proceedings being brought that constitute an abuse. The applicant could require the proprietor of the mark concerned to give up trade secrets and to make considerable efforts in the research necessary to demonstrate genuine use of its mark.

22. Since Directive 2015/2436 does not govern the national procedure relating to an application for revocation of a trade mark for non-use, the referring court takes the view that the judgment of 22 October 2020, Ferrari ([C-720/18](#) and [C-721/18](#), [EU:C:2020:854](#)), does not preclude the applicant from bearing a burden of setting out the facts as contemplated by that court.

23. It was in those circumstances that the Landgericht Saarbrücken (Regional Court, Saarbrücken) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling: *'Is EU law, in particular with regard to [Directive 2008/95], in particular in Article 12, and Directive [2015/2436], in particular in Articles 16, 17 and 19, to be interpreted as meaning that the effet utile of those provisions prohibits an interpretation of national procedural law which:*

(a) *imposes on the applicant in civil proceedings for cancellation of a national registered trade mark on grounds of revocation for non-use a burden of setting out the facts, as distinguished from the burden of proof; and*

(b) *requires the applicant, in the context of that burden of setting out the facts,*

– *to make, in such proceedings, substantiated submissions regarding the defendant's non-use of the trade mark, to the extent that it is possible for the applicant to do so; and*

– *to carry out, for that purpose, its own research into the market, in a manner which is appropriate to the request for cancellation and to the specific nature of the trade mark concerned?'*

#### **Consideration of the question referred**

##### **Admissibility**

24. Maxxus submits, in essence, that in a judgment of 14 January 2021 the Bundesgerichtshof (Federal Court of Justice) held, following delivery of the judgment of 22 October 2020, Ferrari ([C-720/18](#) and [C-721/18](#), [EU:C:2020:854](#)), that, in proceedings for revocation of a trade mark for non-use, the applicant must only assert that the proprietor of that trade mark has not made use of it, as the burden of proof and the burden of setting out the facts fall, in German law, on the proprietor of the mark at issue. It follows, according to Maxxus, that it is not necessary to answer the question submitted by the referring court in order to resolve the dispute in the main proceedings.

25. In that regard, it is clear from settled case-law that the Court is empowered to rule solely on the interpretation or validity of EU law in the light, inter alia, of the legal situation as described by the referring court, in order to provide that court with such guidance as will

assist it in resolving the dispute before it ([judgment of 20 December 2017, Schwepes, C-291/16, EU:C:2017:990, paragraph 21 and the case-law cited](#)).

26. Furthermore, the Court has repeatedly held that it is solely for the national court before which the dispute has been brought, and which must assume responsibility for the subsequent judicial decision, to determine, in the light of the particular circumstances of the case, both the need for and the relevance of the questions which it submits to the Court (judgment of 6 October 2021, Consorzio Italian Management and Catania Multiservizi, C-561/19, EU:C:2021:799, paragraph 35 and the case-law cited). Consequently, where the questions submitted concern the interpretation of EU law, the Court is in principle bound to give a ruling ([judgment of 20 December 2017, Schwepes, C-291/16, EU:C:2017:990, paragraph 23 and the case-law cited](#)).

27. The Court may thus refuse to rule on a question referred for a preliminary ruling by a national court only where it is quite obvious that the interpretation of EU law that is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it ([judgment of 20 December 2017, Schwepes, C-291/16, EU:C:2017:990, paragraph 24](#)).

28. That is not the situation here. The referring court has set out and interpreted German procedural rules, under its own responsibility, and has taken them to mean that, in proceedings for revocation of a trade mark for non-use, the applicant must comply with certain requirements regarding the setting out of the facts, upon which the admissibility of its application depends. The referring court asks the Court, in essence, whether Directive 2008/95 or Directive 2015/2436 must be interpreted as precluding national rules which impose such requirements. It is clear that such a question bears a direct relation to the subject matter of the main action. 29. Therefore, the request for a preliminary ruling is admissible.

##### **Substance**

30. First of all, it should be pointed out that it is clear from the documents sent to the Court by the referring court that the application for revocation which forms the subject matter of the main proceedings was lodged on 28 November 2019. The period within which the Member States were to transpose Directive 2015/2436 into national law, laid down in Article 54(1) of that directive, expired on 14 January 2019. That directive, pursuant to Article 55 thereof, repealed and replaced Directive 2008/95. Whilst it is true that the relevant provisions of Directives 2008/95 and 2015/2436 are substantially the same, the fact remains that the present reference for a preliminary ruling must be examined in the light of Directive 2015/2436 ([see, to that effect, judgment of 2 July 2020, mk advokaten, C-684/19, EU:C:2020:519, paragraph 4](#)).

31. In addition, neither Article 16 of Directive 2015/2436, relating to the concept of genuine use of a trade mark and the period within which its proprietor must have put it to such use, nor Article 17 of that directive, relating to non-use as a defence in infringement proceedings, is of direct relevance for answering the referring court's question. Therefore, the question referred should be answered in the light solely of Article 19 of that directive.

32. In the light of those clarifications, the referring court should be considered to be asking by its question, in essence, whether Article 19 of Directive 2015/2436 must be interpreted as precluding a procedural rule of a Member State which, in proceedings concerning an application for revocation of a trade mark for non-use, requires the applicant to carry out market research concerning the possible use of that mark by its proprietor and to make in that regard, to the extent possible, substantiated submissions in support of its application.

33. In this connection, it should be pointed out that the question of the burden of proof in respect of genuine use, within the meaning of Article 19(1) of Directive 2015/2436, in the context of proceedings relating to revocation of a trade mark for non-use does not constitute a procedural provision falling within the competence of the Member States (see, by analogy, judgment of 22 October 2020, Ferrari, C-720/18 and C-721/18, EU:C:2020:854, paragraph 76 and the case-law cited).

34. If that question were a matter for the national law of the Member States, the consequence for proprietors of trade marks could be that protection would vary according to the legal system concerned, with the result that the objective of 'the same protection under the legal systems of all the Member States' set out in recital 10 of Directive 2015/2436, where it is described as 'fundamental', would not be attained (see, by analogy, judgment of 22 October 2020, Ferrari, C-720/18 and C-721/18, EU:C:2020:854, paragraph 77 and the case-law cited).

35. Furthermore, the principle under which it is for the proprietor of the mark to prove genuine use of that mark is in reality merely an application of common sense and of a basic requirement of procedural efficacy. It is the proprietor of the mark at issue which is best placed to adduce evidence in support of the assertion that its mark has been put to genuine use (judgment of 22 October 2020, Ferrari, C-720/18 and C-721/18, EU:C:2020:854, paragraphs 78 and 81 and the case-law cited).

36. It follows that Article 19 of Directive 2015/2436 must be interpreted as meaning that the burden of proof that a trade mark has been put to 'genuine use', within the meaning of that provision, rests on the proprietor of that mark (see, by analogy, judgment of 22 October 2020, Ferrari, C-720/18 and C-721/18, EU:C:2020:854, paragraph 82).

37. It is true that the fact that the applicant, in a given procedure, does not have to bear the burden of proof does not necessarily release that party from the

obligation to provide, in its application, a full statement of the facts upon which it bases its claims.

38. However, it is clear from Article 19 of Directive 2015/2436 that an application for revocation of a trade mark on the basis of that provision is founded on the claim that the mark has not been put to genuine use by its proprietor. Such a claim, by its nature, does not lend itself to a more detailed statement.

39. In that regard, it must be stated that the national procedural rule contemplated by the referring court goes beyond a mere obligation on the applicant to set out the facts upon which its application is founded. That rule requires the applicant to state and, in the event of challenge, to prove that, before its application was lodged, it carried out market research and that it was unable to establish that the trade mark at issue was put to genuine use.

40. Such a rule thus places the burden of proof of use, or non-use, of the trade mark at issue at least partially on the applicant, although, according to the case-law cited in paragraph 36 of the present judgment, that burden rests exclusively on the proprietor of that mark.

41. The risk, mentioned by the referring court, of a proliferation of applications for revocation on the ground of non-use that constitute an abuse cannot result in a different interpretation.

42. For the purpose of guarding against such a risk, which, moreover, concerns not only proceedings for revocation of a trade mark for non-use but all judicial proceedings, there are, as the Commission has observed, various appropriate procedural means of deterring abuse of process.

43. Those procedural means include the possibility of laying down provisions enabling an application for revocation on the ground of non-use to be dismissed summarily as manifestly inadmissible or manifestly unfounded, or the applicant to be ordered, if its claims are rejected, to pay the costs incurred by the proprietor of the trade mark at issue. It is also possible to require the applicant to pay a fee when it brings its action. It is clear from the documents before the Court that, in this instance, Maxxus had to pay such a fee.

44. As regards the risk, mentioned by the referring court, of revocation proceedings for non-use of a trade mark being brought solely in order to secure the disclosure of the trade secrets of that mark's proprietor, it is clear from the Court's case-law that 'genuine use' of the trade mark, within the meaning of Article 19(1) of Directive 2015/2436, entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned (judgment of 11 March 2003, Ansul, C-40/01, EU:C:2003:145, paragraph 37).

45. It follows that the evidence of genuine use of a trade mark must relate to use of that mark on the market, which, as such, is not covered by commercial confidentiality.

46. In the light of all the foregoing considerations, the answer to the question referred is that Article 19 of Directive 2015/2436 must be interpreted as precluding a procedural rule of a Member State which, in proceedings

concerning an application for revocation of a trade mark for non-use, requires the applicant to carry out market research concerning the possible use of that mark by its proprietor and to make in that regard, to the extent possible, substantiated submissions in support of its application.

**Costs**

47. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Tenth Chamber) hereby rules:

**Article 19 of 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 must be interpreted as precluding a procedural rule of a Member State which, in proceedings concerning an application for revocation of a trade mark for non-use, requires the applicant to carry out market research concerning the possible use of that mark by its proprietor and to make in that regard, to the extent possible, substantiated submissions in support of its application.**

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