

**Case C-607/19**

**Request for a preliminary ruling**

**Date lodged:**

12 August 2019

**Referring court:**

Bundesgerichtshof (Germany)

**Date of the decision to refer:**

6 June 2019

**Applicant:**

Husqvarna AB

**Defendant:**

Lidl E-Commerce International GmbH & Co. KG

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**BUNDESGERICHTSHOF**

**(FEDERAL COURT OF JUSTICE)**

**ORDER**

I ZR 212/17

...

6 June 2019

...

in the case of

Husqvarna AB ..., Huskvarna, Sweden,

applicant, defendant in the counterclaim and appellant on a point  
of law,

...

Lidl E-Commerce International GmbH & Co. KG [...], Neckarsulm,

defendant, applicant in the counterclaim and respondent in the appeal on a point of law,

... [Or. 2]

The First Civil Chamber of the Bundesgerichtshof ...

**has made the following order:**

- I. The proceedings are stayed.
- II. For the purposes of the interpretation of Article 51(1)(a) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ L 78 of 24 March 2009, p. 1; ‘CTMR’) and Article 58(1)(a) of Regulation (EU) 2017/1001 of 14 June 2017 on the European Union trade mark (OJ L 154 of 16 June 2017, p. 1; ‘EUTMR’), the following questions are referred to the Court of Justice of the European Union for a preliminary ruling:
  1. In the case of a counterclaim seeking a declaration that an EU trade mark has lapsed, which was filed prior to the expiry of the period of five years of non-use, is the establishment of the date which is decisive for the calculation of the period of non-use in the context of the application of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR covered by the provisions of the Community Trade Mark Regulation and the European Union Trade Mark Regulation?
  2. If Question 1 is to be answered in the affirmative: In the calculation of the period of five years of non-use pursuant to Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR in the case of a counterclaim, filed prior to expiry of the period of five years of non-use, for a declaration that [Or. 3] an EU trade mark has lapsed, is account to be taken of the date of filing of the counterclaim or of the date of the last hearing in the appeal on the merits?

Grounds:

- 1 I. The applicant manufactures apparatus for garden and landscape maintenance. In 2006 it purchased Gardena Deutschland GmbH. Since 1968, the latter has marketed the ‘Original Gardena System’, a garden-hose system the attachment set of which includes an irrigation sprinkler and a quick-action coupling for connecting the irrigation sprinkler to the garden hose.

2 The applicant is the proprietor of the three-dimensional EU trade mark No 456244 applied for on 31 January 1997 and registered on 26 January 2000 in the colours orange-red/grey/light grey in respect of the product 'irrigation sprinkler' (the trade mark at issue). The graphic representation of that trade mark in the register shows an irrigation sprinkler which consists of three parts, namely a connection piece, a grip and an end piece. The grip is grey and conical and has a finely grooved surface. The end piece is narrower and longer than the grip. It is likewise conical and tapers to the front, has slight, elliptical indentations and is dark orange in colour. [Or. 4]

3 The trade mark at issue is graphically represented in the register as follows:



4 The irrigation sprinkler with the article number 941 marketed by the applicant in any event until May 2012 corresponds to the trade mark at issue.

5 The defendant is a company of the Lidl group which is responsible for the online product offers of the discounter chain and the operation of the online shop. Since the beginning of July 2014 until at least January 2015, the defendant offered in its online shop a spiral hose set which consisted of a spiral hose, an irrigation sprinkler and a coupling sleeve for a quick-action hose coupling.

6 The applicant took the view that that offer constituted an infringement of its EU trade mark and sought, as against the defendant, an order to desist, a determination of its liability to pay compensation and reimbursement of the costs of the warning

notice. The defendant requested, by way of a counterclaim, the cancellation of the EU trade mark due to its having lapsed. The appellate court upheld the action and dismissed the counterclaim. Upon the defendant's appeal on the merits, the court dealing with the appeal on the merits dismissed the action and, in response to the counterclaim, declared EU trade mark No 456244 to be revoked as from 31 May 2017. **[Or. 5]**

7 The present Chamber allowed the appeal on a point of law, insofar as the court dealing with the appeal on the merits found against the applicant with regard to the counterclaim. By its appeal on a point of law, the applicant is seeking the restoration of the judgment of the Landgericht (Regional Court), insofar as the counterclaim was dismissed therein.

8 II. The decision in the present case depends on the clarification of the scope of Regulation (EC) No 207/2009 on the Community trade mark ('the Community Trade Mark Regulation', CTMR) and of Regulation (EU) ... 2017/1001 on the European Union trade mark ('the European Union Trade Mark Regulation', EUTMR) and on the interpretation of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR. For that reason, prior to a decision on the appeal, the proceedings are to be stayed and a preliminary ruling is to be obtained from the Court of Justice of the European Union pursuant to the first paragraph, under (b), and the third paragraph of Article 267 TFEU.

9 1. The court dealing with the appeal on the merits considered the counterclaim to be well founded, and stated the following in this regard:

10 The trade mark at issue had to be declared to be revoked with effect from 31 May 2017. It was not the filing of the counterclaim in September 2015, but the date of the conclusion of the last hearing on 24 October 2017 that was decisive for the calculation of the continuous period of non-use. Up to that date, the applicant had not made genuine use of the trade mark within a continuous period of five years, because the irrigation sprinkler with the article number 941 had been sold only up to May 2012.

11 2. In the case in dispute, the first question that arises is whether the establishment of the date that is decisive for the calculation of the five-year period within the meaning of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR is covered by the Community Trade Mark Regulation and the European Union Trade Mark Regulation (first question referred). If that is the case, the question then arises as to the decisive date (second question referred). **[Or. 6]**

12 (a) Clarification is first required as to whether, in the event of a counterclaim for a declaration that an EU trade mark has lapsed, which was filed prior to the expiry of the period of five years of non-use, the date which is decisive for the calculation of the period of non-use in the context of the application of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR is covered by the provisions of the Community Trade Mark Regulation and the European Union Trade Mark

Regulation. This question is to be asked in respect of both regulations, because the Community Trade Mark Regulation firstly applied on the date, considered as decisive, of the filing of the counterclaim in September 2015, but this had been replaced by the European Union Trade Mark Regulation on the date of the conclusion of the hearing before the court dealing with the appeal on the merits on 24 October 2017. In the opinion of the present Chamber, the regulations mentioned do not regulate that date.

- 13 (aa) Pursuant to the first sentence of Article 14(1) CTMR and the first sentence of Article 17(1) EUTMR, the effects of EU trade marks are to be governed solely by the provisions of those regulations. Pursuant to the second sentence of Article 14(1) CTMR and the second sentence of Article 17(1) EUTMR, in other respects, infringement of an EU trade mark is to be governed by the provisions of Chapter X of those regulations. According thereto, the EU trade mark courts must apply the provisions of those regulations (Article 101(1) CTMR, Article 129(1) EUTMR). According to Article 101(2) CTMR, in the version in force on the date of filing of the counterclaim in September 2015, on all matters not covered by the Community Trade Mark Regulation, a Community trade mark court is to apply its national law, including its private international law. According to Article 129(2) EUTMR, on all trade mark matters not covered by that regulation, the relevant EU trade mark court is to apply the applicable national law. Both of the last-mentioned provisions relate to substantive trade mark law not governed by the regulations [...]. **[Or. 7]**
- 14 With regard to procedural law, Article 14(3), in conjunction with Article 101(3), CTMR and Article 17(3), in conjunction with Article 129(3), EUTMR provide that, unless otherwise provided for in those regulations, an EU trade mark court is to apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located (see Court of Justice, judgment of 22 June 2016 — C-280/15, ... paragraphs 28 and 29 — *Nikolajeva v Multi Protect*).
- 15 (bb) Those regulations do not contain an express stipulation of the date that is decisive in the case of a counterclaim for a declaration of revocation for the calculation of the period of non-use within the meaning of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR. According to the aforementioned provisions, the trade mark is to be declared to be revoked on the basis of a counterclaim in infringement proceedings if, within a continuous period of five years, it has not been put to genuine use in the European Union in connection with the goods or services in respect of which it is registered, and there are no reasons for non-use.
- 16 (1) The calculation of the ‘continuous period of five years’ of non-use that is decisive for the purpose of revocation is not regulated in the respective first clauses of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR. According to the respective second clauses of those provisions, revocation may not be claimed in the case where, during the interval between expiry of the five-year period mentioned in the first clause of the provisions and filing of the application or

counterclaim, genuine use of the trade mark has been started or resumed. Therefore, a distinction is made in both clauses between the five-year period that is decisive for the revocation and the subsequent filing of the counterclaim, which means that, between the end of the five-year period and the filing of the counterclaim, there may be a period in which the trade mark is used. It cannot be concluded therefrom that the filing of the counterclaim is (likewise) important for determining the five-year period that is decisive according to the respective first clauses of those provisions. **[Or. 8]**

- 17 (2) Insofar as Article 99(3) CTMR and Article 127(3) EUTMR declare the date of the infringement action to be decisive, this expressly applies only to a plea, filed against actions pursuant to Article 96(a) and (c) CTMR and Article 124(a) and (c) EUTMR, relating to revocation of the EU trade mark submitted otherwise than by way of a counterclaim. Article 100 CTMR and Article 128 EUTMR, which regulate counterclaims, do not contain any such rule. Accordingly, under the second sentence of Article 17 of Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trade marks, in the case of non-use as defence in infringement proceedings, account is to be taken of the date on which an action is brought for the calculation of the five-year period. That directive does not contain any statement in respect of the date that is decisive in the case of a counterclaim for cancellation.
- 18 (3) An express stipulation of the end point of the five-year period is contained in Article 47(2) CTMR and Article 47(2) EUTMR in respect of opposition proceedings, based on an earlier EU trade mark, against an application for an EU trade mark and in Article 57(2) CTMR and Article 64(2) EUTMR in respect of proceedings for a declaration of revocation or invalidity before the European Union Intellectual Property Office (EUIPO). These provisions, which apply to administrative proceedings before the Office, likewise contain no statement regarding the calculation date that is decisive in the case of a judicial counterclaim for a declaration of revocation.
- 19 (cc) In the opinion of the present Chamber, the determination of the date that is decisive in the case of a counterclaim for a declaration of revocation for the calculation of the period of non-use within the meaning of Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR does not fall under those regulations, because this is a question of procedural law that is not regulated therein. **[Or. 9]**
- 20 (1) The fact that, under trade mark law harmonised throughout the European Union, this is a question of procedural law is supported by recital 9 of Directive 2008/95/EC to approximate the laws of the Member States relating to trade marks. According to that recital, it is up to the Member States to establish the applicable rules of procedure in respect of revocation and declaration of invalidity due to earlier rights. The fact that Directive (EU) 2015/2436 no longer expressly regulates this is probably connected with the introduction, provided for in Article 45 thereof, of revocation proceedings before the trade mark offices but, in

view of judicial revocation proceedings, does not militate against the qualification under procedural law of the period calculation ...

- 21 (2) According to German civil procedural law, the court has to base its decision on the arguments submitted up to the conclusion of the final hearing .... If revocation is pleaded in the legal proceedings, German trade mark law stipulates in the first sentence of Paragraph 25(2) of the Markengesetz (Trade Mark Law; MarkenG) that account is to be taken of the lodging of the action when calculating the five-year period of use. However, according to the second sentence of Paragraph 25(2) MarkenG, if the period of five years of non-use ends subsequent to the lodging of the action, account is to be taken of the conclusion of the hearing ... If the action is lodged by the proprietor of a registered trade mark with earlier priority, the provision of the second sentence of Paragraph 55(3) MarkenG provides that, in response to a plea by the defendant in respect of the issue of non-use, account is to be taken of the period of five years starting from the conclusion of the hearing.
- 22 As an evidentiary hearing regarding right-maintaining use before the court dealing with the appeal on a point of law is excluded, it is, with regard to the revocation of a trade mark, according to established case-law of the present Chamber, the last hearing before the [Or. 10] court dealing with the appeal on the merits that matters ...
- 23 According to this principle of the 'shifting period of use', there may be — as in the present case — the revocation of a trade mark which has still been used in a right-maintaining manner in the last five years before the action was lodged, but has no longer been used in such a manner five years before the date of the last hearing before the court dealing with the appeal on the merits.
- 24 (b) If the first question referred is to be answered in the affirmative, this raises, in the context of interpreting Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR, the further question in need of clarification as to whether, when calculating the period of five years of non-use pursuant to Article 51(1)(a) CTMR and Article 58(1)(a) EUTMR in the case of a counterclaim, filed prior to the expiry of the period of five years of non-use, for a declaration of revocation of an EU trade mark, account is to be taken of the date of filing of the counterclaim or the date of the last hearing in the appeal on the merits. In the opinion of the present Chamber, the date of the last hearing in the appeal on the merits should be decisive.
- 25 (aa) The question referred is material to the decision. The appeal on a point of law will be successful if account is to be taken of the filing of the counterclaim in September 2015 for the calculation of the period of non-use. In this case, with regard to the use of the trade mark at issue through the sale of the irrigation sprinkler with the article number 941 up to May 2012, there would be an absence of non-use for a continuous period of five years, which would mean that the counterclaim would be unfounded. By contrast, the [Or. 11] appeal on a point of

law will be unsuccessful if account is to be taken of the date of the last hearing in the instance examining the facts for the calculation of the period of five years of continuous non-use. The assumption made by the court dealing with the appeal on the merits that right-maintaining use of the trade mark at issue had been proven only up to May 2012 stood up to the examination for the purposes of appeal on a point of law. The court dealing with the appeal on the merits would then, in consideration of a most recent right-maintaining use in May 2012, have been right to declare the trade mark at issue to be revoked as from 31 May 2017, as the last hearing took place on 24 October 2017.

- 26 (bb) The date that is decisive for a revocation due to five years of suspension of use under Article 58(1)(a) EUTMR and Article 51(1)(a) CTMR is neither clear nor already clarified by the case-law of the Court of Justice of the European Union. It is in particular not possible to derive clarification of the question referred from the judgment of the Court of Justice of the European Union of 19 April 2018 (C-148/17, ... *P&C Hamburg v P&C Düsseldorf*). According to that judgment, Article 14 of Directive 2008/95/EC, read in conjunction with Article 34(2) CTMR, must be interpreted as precluding an interpretation of national legislation according to which the invalidity or revocation of an earlier national mark, the seniority of which is claimed for an EU mark, may be established *a posteriori* only if the conditions for that invalidity or that revocation were met, not only on the date on which that earlier national mark was surrendered or the date on which it lapsed, but also on the date on which the judicial decision making that finding is taken (Court of Justice, ... paragraph 32 — *P&C Hamburg v P&C Düsseldorf*). No findings for answering the question referred in the case in dispute can be derived from that judgment. The present case does not involve the examination of whether the conditions for the invalidity or revocation of a national mark had been met on the date on which it was surrendered or allowed to lapse (see Court of Justice, ... paragraph 26 — *P&C Hamburg v P&C Düsseldorf*). It is instead to be examined whether a trade mark that is still in the register has lapsed. **[Or. 12]**
- 27 (cc) Taking account of the date of the conclusion of the hearing in the appeal on the merits fulfils the objective mentioned in recital 24 of the European Union Trade Mark Regulation, that the granting of trade mark protection is justified only in the case of actual use, to a greater extent than taking account of the date of filing of the counterclaim. The latter may lead to an infringement action being successful and a counterclaim for a declaration of revocation having to be dismissed, even though the trade mark at issue merited cancellation at the time of the decision. Taking account of the date of the last hearing in the appeal on the merits also complies with procedural economy, because the applicant in the counterclaim is not directed to a new counterclaim or a cancellation application, but a period of five years of non-use has been completed during the dispute. The uniformity of the protection of the EU trade mark is not affected in a relevant manner by account being taken of the date of the last hearing.

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