

Anonymised version

Translation

C-832/21 – 1

Case C-832/21

Request for a preliminary ruling

Date lodged:

27 December 2021

Referring court:

Oberlandesgericht Düsseldorf (Germany)

Date of the decision to refer:

16 December 2021

Defendants and appellants:

Beverage City & Lifestyle GmbH

MJ

Beverage City Polska Sp.z.o.o.

FE

Applicant and respondent:

Advance Magazine Publishers, Inc.

[...]

OBERLANDESGERICHT DÜSSELDORF (HIGHER REGIONAL COURT,
DÜSSELDORF)

ORDER

In the case of

1. Beverage City & Lifestyle GmbH, [...] Schorfheide,
2. Mr MJ, [...],

EN

first and second defendants and appellants,

[...]

3. Beverage City Polska Sp.z.o.o., [...] Kraków, Poland,
4. Mr FE, [...],

third and fourth defendants and appellants,

[...]

v

Advance Magazine Publishers Inc., [...] New York, United States of America,
applicant and respondent,

[...]

the 20th Civil Chamber of the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) [...]

ordered as follows:

I.

The proceedings are stayed.

II.

The Higher Regional Court, Düsseldorf, refers the following question to the Court of Justice of the European Union for a preliminary ruling concerning the interpretation of Article 122 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark ('EUTMR') in conjunction with Article 8(1) of Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the enforcement of judgments in civil and commercial matters ('the Brussels Ia Regulation'):

Are claims 'so closely connected' that it is expedient to hear and determine them together to prevent irreconcilable judgments, within the meaning of Article 8(1) of the Brussels Ia Regulation, where, in infringement proceedings for infringement of an EU trade mark, the connection consists in the fact that the defendant domiciled in a Member State (here, Poland) supplied the goods which infringe an EU trade mark to a defendant domiciled in another Member State (here, Germany) whose legal representative, against whom infringement proceedings have also been brought, is the anchor defendant, if the parties are connected to each other

only through the mere supply relationship beyond which there is no legal or factual connection?

Grounds

A)

- 1 The applicant is the proprietor of a number of EU trade marks containing the word element 'Vogue', including
 - EU trade mark 00183756 VOGUE with priority from 1.4.1996 registered inter alia in Class 16 for 'printed matter';
 - EU trade mark 004023041 VOGUE with priority from 2.9.2004 registered inter alia in Class 16 for 'printed matter';
 - EU trade mark 014273296 VOGUE with priority from 2.9.2004 registered on 19.6.2015 inter alia in Class 43 for 'temporary accommodation services; hotel, bar, café, restaurant and nightclub services; provision of food and drink; catering';in respect of which it claims that the trade marks have a reputation.
- 2 The first defendant is a company under German law with its registered office in Schorfheide in Brandenburg, whose business is managed by the second defendant, its managing director, who is domiciled in Niederkassel in North Rhine-Westphalia. The third defendant is a company under Polish law with its registered office in Kraków in Poland, whose managing director is the fourth defendant, also resident in Kraków.
- 3 The third defendant manufactures, advertises and markets an energy drink under the name 'DIAMANT VOGUE'. The first defendant was connected with the third defendant through an exclusive distribution agreement for Germany and sourced the energy drink bearing that name in Poland from the third defendant. No further legal connections exist between the first and third defendants, in particular they are not affiliated companies, despite the similarity in name.
- 4 The applicant takes the view that this is an infringement of its EU trade marks and brought an action against all defendants before the Landgericht Düsseldorf (Regional Court, Düsseldorf), as the EU trade mark court with jurisdiction for North Rhine-Westphalia, for injunctive relief throughout the European Union and – later limited to acts in Germany – for information, the disclosure of accounts and a declaration of liability for damages. The third and fourth defendants argued, inter alia, that there is a lack of international jurisdiction over the action brought against them.
- 5 The Regional Court, Düsseldorf, ruled against the defendants in accordance with the form of order sought and based its international jurisdiction with regard to the

third and fourth defendants on Article 8(1) of the Brussels Ia Regulation. It considered that the principles established by the Court of Justice in its judgment of 27 September 2017, C-24/16 and C-25/16, *Nintendo Co. Ltd v BigBen Interactive GmbH and Other* (ECLI:EU:C:2017:724), apply to the facts of the present case.

- 6 That judgment is challenged, following the withdrawal by the first and second defendants of the appeal they had initially brought, by the third and fourth defendants, who continue to maintain in their appeal, *inter alia*, that the German courts lack international jurisdiction. According to the third and fourth defendants, they had operated exclusively in Poland and had also delivered the goods to their customers there. The decision in *Nintendo v BigBen* is not, it is argued, transposable to the present case because the first and second defendants, on the one hand, and the third and fourth defendants, on the other, are not connected to each other in any relevant way.

B)

- 7 The resolution of the dispute depends on the answer to the question referred for a preliminary ruling.
- 8 International jurisdiction of the German EU trade mark courts over the action against the third and fourth defendants can arise only from Article 8(1) of the Brussels Ia Regulation. The Regional Court, Düsseldorf (and, on appeal, this chamber) has international jurisdiction under Article 125(1) EUTMR only in respect of the second defendant, who is domiciled in North Rhine-Westphalia. Jurisdiction in respect of the third and fourth defendants thus presupposes that the claims against them and the claim against the second defendant ‘are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings’.
- 9 The facts of the present case differ from those which formed the basis of the judgment in *Nintendo v BigBen*, firstly, in that the supply relationship was not between the anchor defendant, namely the second defendant, and the third and fourth defendants, but between the first and third defendants, while the second and fourth defendants are each sued as representatives acting on behalf of the legal persons.
- 10 Secondly, the Court of Justice in *Nintendo v BigBen* took into account, *inter alia*, the fact that the defendants in that case were affiliated companies (paragraph 51 of the judgment). Such a connection is lacking in the present case. The respective parties in Germany and Poland operate autonomously and independently of each other. Ultimately a factual connection exists only in the form of a supply chain. It seems questionable, however, whether that alone is sufficient.
- 11 Admittedly, the applicant is correct that the trade marks are the same, as are the potentially infringing goods, so that there is a risk of irreconcilable judgments if one court finds that the marketing constitutes an infringement and another court does not. Then again, however, that argument would also apply if there were no

relationship at all between the parties, but they were marketing the same goods – sourced from a third party – within the European Union. In that respect, it should be noted that the applicability of Article 8(1) of the Brussels Ia Regulation must not undermine the rule of jurisdiction in Article 125 EUTMR. However, in the case-law of the national courts (Österreichischer Oberster Gerichtshof (Austrian Supreme Court), GRUR Int. 2013, 569 – *Red Bull v Pitt Bull*, 4 Ob 221/12x of 15.1.2013) that provision is also applied in the case of a mere supply relationship.

[...]

WORKING DOCUMENT