



Reports of Cases

JUDGMENT OF THE COURT (Second Chamber)

5 October 2017*

(Reference for a preliminary ruling — Judicial cooperation in civil and commercial matters — Regulation (EC) No 44/2001 — Jurisdiction — Article 2(1) — Jurisdiction of the courts of the place where the defendant is domiciled — Article 22(4) — Exclusive jurisdiction in proceedings concerned with the registration or validity of intellectual property rights — Proceedings to determine whether a person was correctly registered as the proprietor of a trade mark)

In Case C-341/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by decision of 14 June 2016, received at the Court on 16 June 2016, in the proceedings

Hanssen Beleggingen BV

v

Tanja Prast-Knippling,

THE COURT (Second Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, A. Prechal, A. Rosas, C. Toader and E. Jarašiūnas, Judges,

Advocate General: H. Saugmandsgaard Øe,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- Ms Prast-Knippling, by P. Sohn, Rechtsanwalt,
- the European Commission, by M. Wilderspin and M. Heller, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 13 July 2017,

gives the following

* Language of the case: German.

Judgment

- 1 This reference for a preliminary ruling concerns the interpretation of Article 22(4) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1).
- 2 The request has been made in proceedings between Hanssen Beleggingen BV ('Hanssen'), whose registered office is in the Netherlands, and Ms Tanja Prast-Knipping, domiciled in Germany, concerning the registration of the latter as the proprietor of a Benelux trade mark.

Legal context

EU law

- 3 Regulation No 44/2001 replaced, in relations between the Member States, the Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1978 L 304, p. 36, 'the Brussels Convention'). That regulation was replaced in turn by Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1). Article 66(1) of that regulation provides that it 'shall apply only to legal proceedings instituted, to authentic instruments formally drawn up or registered and to court settlements approved or concluded on or after 10 January 2015'.
- 4 Since the action at issue in the main proceedings was brought before 10 January 2015, the request for a preliminary ruling must be examined in the light of Regulation No 44/2001.
- 5 Article 2(1) of that regulation provided:

‘Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.’
- 6 Article 22 of Regulation No 44/2001, in Section 6 of Chapter II thereof, entitled ‘Exclusive jurisdiction’, stated:

‘The following courts shall have exclusive jurisdiction, regardless of domicile:

...

(4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.

...’
- 7 That provision corresponded to Article 16(4) of the Brussels Convention.

The Benelux Convention on Intellectual Property

8 The convention Benelux en matière de propriété intellectuelle (marques et dessins ou modèles) (Benelux Convention on Intellectual Property (Trade Marks and Designs)) of 25 February 2005, signed in The Hague (Netherlands) by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands ('the BCIP'), entered into force on 1 September 2006.

9 Paragraph 1.2 of the BCIP provides as follows:

'1. A Benelux Organisation for Intellectual Property (Trademarks and Designs) ... shall be established;

2. The executive bodies of the Organisation shall be:

...

(c) the Benelux Intellectual Property Office (Trademarks and Designs) ...'

10 Paragraph 1.5(1) and (2) of the BCIP specifies:

'1. The Organisation shall have its headquarters in The Hague.

2. The Office shall be set up in The Hague.'

11 Under Paragraph 4.6(1) of the BCIP:

'[The territorial jurisdiction of the courts] shall be determined in cases involving trade marks or designs by the address for service of the defendant or by the place where the obligation in dispute has arisen, or has been or should be enforced. The place in which the trade mark or design is filed or registered shall not under any circumstances be used as the sole basis for determining territorial jurisdiction.'

German law

12 Paragraph 812 of the Bürgerliches Gesetzbuch (German Civil Code) is in Title 26 thereof, headed '*Ungerechtfertigte Bereicherung*' (unjustified enrichment) and provides, in paragraph 1, that 'a person who obtains something as a result of the performance of another person or otherwise at his expense without legal grounds for doing so is under a duty to make restitution to him'.

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

13 On 7 September 1979, a company incorporated under German law owned by Mr Helmut Knipping, operating in the production of building components, in particular windows, applied to the Benelux Intellectual Property Office (Trade Marks and Designs) ('BIPO') for registration as a Benelux trade mark of the following word and figurative sign:



14 BIPO registered that trade mark in black and white under No 361604 ('trade mark No 361604').

- 15 Hanssen is a company incorporated under Dutch law operating in the door and window trade. It is the proprietor of Benelux word and figurative trade mark No 0684759. That trade mark is comprised of the same word and figurative sign as that covered by trade mark No 361604, but is registered in blue and yellow.
- 16 On 9 October 1995, Mr Knipping died.
- 17 On 14 November 2003, Ms Prast-Knipping, on providing a certificate stating that she was the sole heiress of Mr Knipping, requested BIPO to register her as the proprietor of trade mark No 361604.
- 18 BIPO complied with the request for registration.
- 19 Hanssen contests the registration. It claims that trade mark No 361604 had, prior to the death of Mr Knipping, been assigned several times and was no longer part of his estate at the time of his death. The registration of Ms Prast-Knipping as the proprietor of that trade mark was therefore unjustified.
- 20 Since the dispute was unable to be resolved by amicable agreement, on 8 June 2012, Hanssen brought an action against Ms Prast-Knipping before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), the court of the place where Ms Prast-Knipping is domiciled. Hanssen founded its action on unjustified enrichment under Paragraph 812 of the German Civil Code and sought an order that Ms Prast-Knipping declare at BIPO that she is not entitled to the trade mark in question and to waive the registration of her name as proprietor.
- 21 In a judgment of 24 June 2015, the Landgericht Düsseldorf (Regional Court, Düsseldorf) dismissed that action on the ground that, at the time when Mr Knipping died, trade mark No 361604 formed part of his estate and had therefore been correctly transferred to Ms Prast-Knipping by universal succession.
- 22 Hanssen brought an appeal against that judgment before the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany).
- 23 That court harbours doubts as to the jurisdiction of the German courts to hear the case. It considers that whilst jurisdiction could derive from Article 2(1) of Regulation No 44/2001, it is also possible that the courts of the Member State in which registration of the trade mark at issue in the main proceedings has taken place — namely the Netherlands, since the seat of BIPO is located at The Hague — have exclusive jurisdiction under Article 22(4) of that regulation.
- 24 Since jurisdiction must be assessed of the court's own motion, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) wishes the matter to be clarified.
- 25 According to the referring court, it is necessary, in particular, to determine whether an action such as that brought by Hanssen amounts to proceedings 'concerned with the registration or validity of ... trade marks' within the meaning of Article 22(4) of the regulation. The judgment of 15 November 1983, *Duijnstee* (288/82, EU:C:1983:326), provides indicia suggesting that that question be answered in the negative, but, in the light of the development of trade mark law since that judgment, it is not certain that that judgment must still be taken into account.
- 26 As regards the development of trade mark law, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) cites, inter alia, Article 18 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21) ('Regulation No 207/2009').

- 27 The referring court also mentions the fact that, as regards jurisdiction, Benelux trade marks are characterised by certain specific features.
- 28 In those circumstances, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

‘Does the notion of proceedings which are “concerned with the registration or validity of ... trade marks”, within the meaning of Article 22(4) of Regulation [No 44/2001], also cover a claim, brought against the formal proprietor of a Benelux trade mark registered in the Benelux trade mark register, which seeks an order requiring that defendant to make a declaration to [BIPO] that she has no entitlement to the contested mark and that she waives registration as the proprietor of that mark?’

Consideration of the question referred

- 29 By its question, the referring court asks, in essence, whether Article 22(4) of Regulation No 44/2001 must be interpreted as applying to proceedings to determine whether a person was correctly registered as the proprietor of a trade mark.
- 30 For the purposes of answering that question, it must be borne in mind, first, that the Court has already held that Article 22(4) of Regulation No 44/2001 reflects the same system as Article 16(4) of the Brussels Convention and is, moreover, drafted in almost identical terms so that it is necessary to ensure continuity in the interpretation of those provisions (judgment of 12 July 2012, *Solvay*, C-616/10, EU:C:2012:445, paragraph 43).
- 31 The Court points out, next, that the concept of proceedings ‘concerned with the registration or validity of [intellectual property rights]’, referred to in those provisions, is an ‘independent concept’ intended to have uniform application in all contracting States (judgments of 15 November 1983, *Duijnstee*, 288/82, EU:C:1983:326, paragraph 19, and of 13 July 2006, *GAT*, C-4/03, EU:C:2006:457, paragraph 14).
- 32 The Court has, lastly, held that provisions which confer exclusive jurisdiction, such as Article 16 of the Brussels Convention and Article 22 of Regulation No 44/2001, must not be given a wider interpretation than is required by their objective, since they deprive the parties of the choice of forum which would otherwise be theirs and may, in certain cases, result in a situation whereby the parties are brought before a court which is not that of any of them (judgments of 10 January 1990, *Reichert and Kockler*, C-115/88, EU:C:1990:3, paragraph 9, and of 12 May 2011, *BVG*, C-144/10, EU:C:2011:300, paragraph 30).
- 33 The objective of Article 22(4) of Regulation No 44/2001 is to ensure that jurisdiction for proceedings concerned with the registration or validity of intellectual property rights rests with courts closely linked in fact and law to the register, since those courts are best placed to adjudicate on cases where the validity of the right, or even the existence of the deposit or registration, is in dispute (see, to that effect, as regards Article 16(4) of the Brussels Convention, judgment of 13 July 2006, *GAT*, C-4/03, EU:C:2006:457, paragraphs 21 and 22).
- 34 Accordingly, the Court has held, in cases concerning jurisdiction in the field of patents, that, where the dispute concerns neither the validity of a patent nor the existence of its deposit or registration, the dispute is not covered by the concept of proceedings ‘concerned with the registration or validity of patents’ and therefore falls outside the exclusive jurisdiction of the courts of the Member State in which the right was registered (judgments of 15 November 1983, *Duijnstee*, 288/82, EU:C:1983:326, paragraphs 22 to 25, and of 13 July 2006, *GAT*, C-4/03, EU:C:2006:457, paragraphs 15 and 16).

- 35 Proceedings concerning exclusively the question of who is entitled to a patent do not therefore fall within the scope of such exclusive jurisdiction (judgment of 15 November 1983, *Duijnstee*, 288/82, EU:C:1983:326, paragraph 26).
- 36 As the Advocate General stated in points 26 to 29 of his Opinion, that interpretation may be applied to a case relating to a trade mark, such as that in the main proceedings, which concerns neither the validity nor the registration of the trade mark but concerns exclusively the question of whether a person whose name has been registered as the proprietor is in fact the proprietor.
- 37 Proceedings in which there is no dispute regarding the registration of the trade mark as such or its validity are covered neither by the words ‘proceedings concerned with the registration or validity of ... trade marks’ in Article 22(4) of Regulation No 44/2001, nor the objective underlying that provision. In that regard, the Court points out that the question of the individual estate to which an intellectual property right belongs is not, generally, closely linked in fact and law to the place where that right has been registered.
- 38 That appears to be the case here. As is clear from the order for reference, the proceedings concern the ownership of trade mark No 361604 following the death of Mr Knipping; it must therefore be ascertained whether that trade mark formed part of Mr Knipping’s estate at the time of his death.
- 39 It follows from all the foregoing considerations that a case such as that at issue in the main proceedings, which concerns exclusively the question of who must be regarded as the proprietor of the trade mark at issue, does not fall within the scope of Article 22(4) of Regulation No 44/2001.
- 40 That interpretation is not affected by the fact that EU legislation contains certain provisions allowing the proprietor of an intellectual property right to demand the assignment to him of a registration initially made in the name of another.
- 41 In that regard, the referring court refers, in particular, to EU trade mark legislation and states that Article 18 of Regulation No 207/2009 confers, inter alia, jurisdiction on EU trade mark courts to rule on a claim by the proprietor of a trade mark to have the registration of the trade mark made by an agent or representative assigned to him. However, while that provision concerns specifically the relationship existing between an agent or representative and the proprietor of an EU trade mark, it does not appear that the case in the main proceedings, which concerns a Benelux trade mark, concerns such a relationship.
- 42 Furthermore, as regards the fact, also mentioned in the order for reference, that, as regards jurisdiction, Benelux trade marks are characterised by certain specific features, it is important to note that, contrary to the facts of the case which gave rise to the judgment of 14 July 2016, *Brite Strike Technologies* (C-230/15, EU:C:2016:560), in which the Court clarified the relationship between the rule of jurisdiction set out in Paragraph 4.6 of the BCIP and that laid down in Article 22(4) of Regulation No 44/2001, the case in the main proceedings does not concern the registration or the validity of the Benelux trade mark in question or any potential infringement of that trade mark; indeed, according to the information supplied to the Court, Hanssen’s action is not founded on any substantive provision of the BCIP. In those circumstances, the specific features of the BCIP as regards jurisdiction are irrelevant to the case in the main proceedings.
- 43 In the light of the foregoing, the answer to the question referred is that Article 22(4) of Regulation No 44/2001 must be interpreted as not applying to proceedings to determine whether a person was correctly registered as the proprietor of a trade mark.

Costs

- ⁴⁴ Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

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

Article 22(4) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters must be interpreted as not applying to proceedings to determine whether a person was correctly registered as the proprietor of a trade mark.

[Signatures]