Reports of Cases

OPINION OF ADVOCATE GENERAL
PITRUZZELLA
delivered on 5 May 2022 [1]

**Case C-256/21**

**KP**
**v**
**TV,**
**Gemeinde Bodman-Ludwigshafen**

(Request for a preliminary ruling from the Oberlandesgericht München (Higher Regional Court, Munich, Germany))

(Reference for a preliminary ruling – EU trade mark (APFELZÜGLE) – Dispute before the national courts – Jurisdiction of trade mark courts – Action for infringement – Counterclaim – Withdrawal of the action for infringement)

## I. Introduction

1. This request for a preliminary ruling, made by the Oberlandesgericht München (Higher Regional Court, Munich, Germany), concerns the interpretation of Article 124(a) and (d) and Article 128 of Regulation (EU) 2017/1001 on the European Union trade mark. [2]

2. This request has been submitted in the context of a dispute brought by KP against TV and the Gemeinde Bodman-Ludwigshafen (the Municipality of Bodman-Ludwigshafen, Germany), in relation to an action for infringement of an EU word mark and a counterclaim requesting a declaration of invalidity of that mark.

3. The referring court is essentially asking the Court of Justice to establish whether the jurisdiction of the EU trade mark court in respect of a counterclaim requesting a declaration of invalidity of a mark still applies in the case where the holder of that mark has withdrawn the original infringement claim.

[1] Original language: Italian.

[2] 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).

## II. Legal framework

### *A. European Union law*

4. According to recitals 31, 32 and 33 of Regulation 2017/1001:

‘(31) In order to ensure the protection of EU trade marks the Member States should designate, having regard to their own national system, as limited a number as possible of national courts of first and second instance having jurisdiction in matters of infringement and validity of EU trade marks.

(32) It is essential that decisions regarding the validity and infringement of EU trade marks must have effect and cover the entire area of the Union, as this is the only way of preventing inconsistent decisions on the part of the courts and the Office and of ensuring that the unitary character of EU trade marks is not undermined. …

(33) Contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of an EU trade mark and parallel national trade marks. For this purpose, when the actions are brought in the same Member State, the way in which this is to be achieved is a matter for national procedural rules, which are not prejudiced by this Regulation, whilst when the actions are brought in different Member States, provisions modelled on the rules on *lis pendens* and related actions of Regulation (EU) No 1215/2012 [3] appear appropriate.’

5. Article 1(2) of the regulation provides:

‘An EU trade mark shall have a unitary character. It shall have equal effect throughout the Union: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Union. This principle shall apply unless otherwise provided for in this Regulation.’

6. In accordance with Article 6 of that regulation, an EU trade mark is to be obtained by registration.

7. Article 59(1)(a) of the regulation provides:

‘An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where the EU trade mark has been registered contrary to the provisions of Article 7;

…’

[3] Regulation of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1).

8. In Section 5 of the regulation, under the heading 'Proceedings in the office in relation to revocation or invalidity', Article 63(3) provides:

'An application for revocation or for a declaration of invalidity shall be inadmissible where an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on its merits, either by the Office or by an EU trade mark court as referred to in Article 123, and the decision of the Office or that court on that application has acquired the authority of a final decision.'

9. Under Article 123(1) of Regulation 2017/1001:

'The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, which shall perform the functions assigned to them by this Regulation.'

10. Article 124(a) and (d) of Regulation 2017/1001 reads as follows:

'The EU trade mark courts shall have exclusive jurisdiction:

(a) for all infringement actions and – if they are permitted under national law – actions in respect of threatened infringement relating to EU trade marks;

…

(d) for counterclaims for revocation or for a declaration of invalidity of the EU trade mark pursuant to Article 128.'

11. Article 127(1) of that regulation provides:

'The EU trade mark courts shall treat the EU trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity.'

12. Under Article 128 of Regulation 2017/1001:

'1. A counterclaim for revocation or for a declaration of invalidity may only be based on the grounds for revocation or invalidity mentioned in this Regulation.

2. An EU trade mark court shall reject a counterclaim for revocation or for a declaration of invalidity if a decision taken by the Office relating to the same subject matter and cause of action and involving the same parties has already become final.

…

4. The EU trade mark court with which a counterclaim for revocation or for a declaration of invalidity of the EU trade mark has been filed shall not proceed with the examination of the counterclaim, until either the interested party or the court has informed the Office of the date on which the counterclaim was filed. The Office shall record that information in the Register. If an application for revocation or for a declaration of invalidity of the EU trade mark had already been filed before the Office before the counterclaim was filed, the court shall be informed thereof by the

Office and stay the proceedings in accordance with Article 132(1) until the decision on the application is final or the application is withdrawn.

…

6. Where an EU trade mark court has given a judgment which has become final on a counterclaim for revocation or for a declaration of invalidity of an EU trade mark, a copy of the judgment shall be sent to the Office without delay, either by the court or by any of the parties to the national proceedings. The Office or any other interested party may request information about such transmission. The Office shall mention the judgment in the Register and shall take the necessary measures to comply with its operative part.

7. The EU trade mark court hearing a counterclaim for revocation or for a declaration of invalidity may stay the proceedings on application by the proprietor of the EU trade mark and after hearing the other parties and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office within a time limit which it shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 132(3) shall apply.'

13. Under Article 129 of the regulation, entitled 'Applicable law':

'1. The EU trade mark courts shall apply the provisions of this Regulation.

2. On all trade mark matters not covered by this Regulation, the relevant EU trade mark court shall apply the applicable national law.

3. Unless otherwise provided for in this Regulation, an EU trade mark court shall 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.'

14. Article 132 of the regulation provides:

'1. An EU trade mark court hearing an action referred to in Article 124 other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the EU trade mark is already in issue before another EU trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office.

2. The Office, when hearing an application for revocation or for a declaration of invalidity shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the EU trade mark is already in issue on account of a counterclaim before an EU trade mark court. However, if one of the parties to the proceedings before the EU trade mark court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

3. Where the EU trade mark court stays the proceedings it may order provisional and protective measures for the duration of the stay.'

### *B. German law*

15. Under Paragraph 33(1) of the Zivilprozessordnung (German Code of Civil Procedure; 'the ZPO'), a counterclaim may be brought in the court before which an action has been brought if there is a legal connection between the subject matter of the counterclaim and the subject matter of the original claim or the defences raised against the original claim.

16. Paragraph 261 of the ZPO, entitled 'Pendency', provides in subparagraph 3(2) that the jurisdiction of the court seised shall not be affected by any change to the circumstances giving rise to the jurisdiction.

## III. Background to the dispute, the procedure in the main proceedings and the questions referred for a preliminary ruling

17. KP is the proprietor of the EU word mark APFELZÜGLE, registered on 19 October 2017 for services in Classes 35, 41 and 43[4] of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 1957 ('the Nice Agreement').[5] It is not disputed that the term 'Apfelzügle' (apple train) denotes a train designed for apple picking, consisting of several trailers pulled by a tractor.

18. On 26 September 2018, both TV and the Municipality of Bodman-Ludwigshafen advertised an activity on their respective Facebook accounts involving the harvesting and tasting of fresh apples as part of a ride on the Apfelzügle.

19. KP therefore brought an action for infringement of the trade mark before the Landgericht München (Regional Court, Munich, Germany), seeking an order prohibiting TV and the Municipality of Bodman-Ludwigshafen from using the term 'Apfelzügle' for the services designated by that trade mark. For their part, the defendants filed counterclaims requesting a declaration of invalidity of the trade mark owned by KP before that court.

20. At the hearing before the Landgericht München (Regional Court, Munich), KP withdrew its action for infringement. Despite the withdrawal of the action, TV and the Municipality of Bodman-Ludwigshafen pursued their counterclaims.

21. By a judgment of 10 March 2020 – which held that the counterclaims were admissible – the Landgericht München (Regional Court, Munich) declared the contested mark invalid only in respect of the services in Class 41 and rejected the remainder of the defendants' claims.

22. The Municipality of Bodman-Ludwigshafen appealed against that judgment before the Oberlandesgericht München (Higher Regional Court, Munich), insisting that the counterclaim for a declaration of invalidity be upheld also with regard to the services in Classes 35 and 43 of the Nice Agreement.

[4] More specifically, the mark in question related to the following services:
Class 35: The bringing together of food and tasting products, in particular running a farm shop with sale of regional, hand-made foodstuffs and/or beverages.
Class 41: Entertainment; Cultural activities; Arranging and conducting of information events relating to rural farming.
Class 43: Services for providing food and drink, temporary accommodation; Restaurants; Catering for the provision of food and beverages.

[5] Nice Agreement adopted at the Nice Diplomatic Conference on 15 June 1957, as revised and amended (*United Nations Treaty Series*, vol. 1154, No I 18200, p. 89).

23. In the order for reference, the Oberlandesgericht München (Higher Regional Court, Munich) states that it must first assess the admissibility of the counterclaims brought by the defendants following the withdrawal of the main action, pointing out that it is not bound on that point by the decision of the court of first instance.

24. The referring court notes in that regard that, according to the predominant view in Germany, a case such as the present one is not governed by Regulation 2017/1001 but rather, by virtue of the reference in Article 129(3) of that regulation, by the rules governing German civil procedure. More particularly, Paragraph 261(3)(2) of the ZPO would apply, whereby the jurisdiction of the trade mark court over a counterclaim requesting a declaration of invalidity is independent of the outcome of the action for infringement and cannot therefore cease to exist in the event that that action is withdrawn.

25. Having some doubts about that solution, the referring court observes that:

(i) the registration of an EU trade mark is an act of a body of the European Union – the European Union Intellectual Property Office – and national courts do not have jurisdiction to annul such acts, save in the case of exceptions expressly provided for;

(ii) for that reason, Article 63(1) of Regulation 2017/1001 gives the Office jurisdiction in this area 'as a matter of priority';

(iii) on the other hand, the jurisdiction of the national court in matters of trade mark validity represents an exceptional situation, provided for in Article 124(d) of Regulation 2017/1001, solely for the case of a counterclaim, and is justified by the need to allow the defendant sued in an action for infringement to use a defence in the same proceedings;

(iv) the priority nature of the Office's jurisdiction also follows from Article 128(7) of Regulation 2017/1001, according to which the proprietor of a trade mark may arrange for the decision on an application for a declaration of invalidity not to be taken by the national court but, instead, in proceedings before the Office.

26. That said, according to the Oberlandesgericht München (Higher Regional Court, Munich), an EU trade mark court may not rule on a counterclaim for a declaration of invalidity of an EU trade mark, within the meaning of Article 128 of Regulation 2017/1001, if the action for infringement serving as the basis for the counterclaim has been withdrawn, since in such a case there is no longer any need to allow such a defence by the defendant. That conclusion can also be inferred from Regulation 2017/1001 itself, and the reference to the national legislation is not therefore relevant.

27. According to the referring court, that interpretation is supported by the judgment of 19 October 2017, *Raimund*[6] ('the *Raimund* judgment'), according to which a counterclaim for a declaration of invalidity must be examined before a ruling is made on the relevant action for infringement. Moreover, this would not place an undue and disproportionate burden on a defendant lodging a counterclaim, as that defendant would still be able to bring an action before the Office under Article 63 of Regulation 2017/1001.

[6] C-425/16, EU:C:2017:776.

28. In those circumstances, the Oberlandesgericht München (Higher Regional Court, Munich) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

'Must Article 124(d) and Article 128 of Regulation (EU) 2017/1001 be interpreted as meaning that the EU trade mark court has jurisdiction to rule on the invalidity of an EU trade mark asserted by a counterclaim within the meaning of Article 128 of Regulation (EU) 2017/1001 even after the action for infringement based on that EU trade mark for the purposes of Article 124(a) has been validly withdrawn?'

## IV. Procedure before the Court of Justice and summary of the arguments of the parties

29. In accordance with Article 23 of the Statute of the Court of Justice of the European Union, the Municipality of Bodman-Ludwigshafen and the European Commission have submitted written observations in these proceedings.

30. The Municipality of Bodman-Ludwigshafen takes the view that the counterclaim should be regarded as an action independent of the action for infringement and that, in the absence of specific provisions in the regulation governing the case at issue, the ZPO should be applied. According to that code, the jurisdiction of the court seised shall not be affected by any change to the circumstances giving rise to the jurisdiction. It therefore proposes that the question referred for a preliminary ruling should be answered in the affirmative.

31. Conversely, the Commission contends that the national court does not retain jurisdiction to rule on a counterclaim for invalidity of an EU trade mark after the main action for infringement has been validly withdrawn. To justify that conclusion, it focuses in particular on the ancillary nature of a counterclaim for a declaration of invalidity of a trade mark: it is a means of defence for the defendant that can be exercised only in the context of an action for infringement, which necessarily depends on the existence of that action and cannot therefore be considered in isolation.

## V. Legal analysis

32. By its question referred, the Oberlandesgericht München (Higher Regional Court, Munich) is asking the Court of Justice to determine whether, under Regulation 2017/1001, an EU trade mark court retains jurisdiction to rule on the invalidity of an EU trade mark, relied on in a counterclaim by the defendant in an action for infringement, even after that action for infringement has been validly withdrawn.

### *A. The counterclaim for a declaration of invalidity within the system introduced by Regulation 2017/1001*

33. Before examining the question of jurisdiction raised by the referring court, we must review the interpretation of the concept of a counterclaim and the assessment of whether it is independent or ancillary to the original claim.

34. Indeed, if – as the Commission contends – that claim were to be considered ancillary to the original claim it would, by its very nature, suffer the same fate as the original claim. The principle of *simul stabunt simul cadent* would therefore apply to this case. Conversely, if the counterclaim is characterised as an independent claim, it will not be affected by any events that might extinguish the original claim.

35. Although the term 'counterclaim' appears in a number of provisions of Regulation 2017/1001, those provisions neither provide any definition of the term nor contain any express reference to the law of the Member States as to the meaning and scope to be given to the concept. I therefore believe, in line with the Court's settled case-law, that the concept of 'counterclaim' within the meaning, specifically, of Article 128 of Regulation 2017/1001 should be regarded as an autonomous concept of EU law and interpreted uniformly throughout the European Union, taking into account the wording of that provision, its context, and the purpose of the rules of which it forms part. [7]

36. In my view, recourse to the classifications used in national procedural law should be excluded, notwithstanding the fact that such law is applicable, under Article 129(3) of Regulation 2017/1001, unless that regulation provides otherwise. Indeed, as we will discuss more fully below, the interpretation of the scope of the concept of counterclaim under Regulation 2017/1001 affects the definition of the respective areas of jurisdiction of the Office and of the trade mark courts. In those circumstances, it is appropriate, in the context of that regulation, for that concept to be objectively enforced, independently of national legislation.

37. As correctly observed by Advocate General Campos Sánchez-Bordona in his Opinion in *Raimund*, 'counterclaim' means, in general, a cross-action lodged by the defendant in proceedings brought against him or her by the applicant before the same court, in order to obtain an advantage other than the mere rejection of the opponent's claim. Procedural economy and prevention of the risk of contradictory judgments are usually cited as the aims of a counterclaim. [8]

38. That said, it should be noted that Regulation 2017/1001 – which aims, according to its recital 4, to establish an EU trade mark system 'whereby undertakings can by means of one procedural system obtain EU trade marks to which uniform protection is given and which produce their effects throughout the entire area of the Union' [9] – establishes a complex system for reviewing the validity of EU trade marks, with a role for both the Office and the trade mark courts. [10]

39. For an action for invalidity of an EU trade mark, the legislature has created a direct and centralised administrative appeal procedure before the Office, under the control of the EU courts. Indeed, in accordance with Article 63 of Regulation 2017/1001, jurisdiction to deal

[7] See, to that effect, judgments of 29 January 2020, *Sky and Others* (C-371/18, EU:C:2020:45, paragraph 74); of 16 September 2021, *The Software Incubator* (C-410/19, EU:C:2021:742, paragraph 30); and of 20 January 2022, *Landeshauptmann von Wien (Loss of the status of long-term resident)* (C-432/20, EU:C:2022:39, paragraph 28).

[8] See the Opinion of Advocate General Campos Sánchez-Bordona in *Raimund* (C-425/16, EU:C:2017:479, footnote 17). See also, by analogy, order of 27 May 2004, *Commission* v *IAMA Consulting* (C-517/03, not published, EU:C:2004:326, paragraph 17); judgments of 16 September 2013, *GL2006 Europe* v *Commission* (T-435/09, EU:T:2013:439, paragraph 42); and of 31 May 2018, *Nothartová* (C-306/17, EU:C:2018:360, paragraphs 21 and 22).

[9] The unitary character of the EU trade mark is described in Article 1(2) of Regulation 2017/1001, see point 5 of this Opinion.

[10] This system is the same as that used to determine the invalidity or revocation of a trade mark. In view of the subject matter of the main proceedings, I will refer in the remainder of this document only to the rules governing claims for invalidity, in both main proceedings and counterclaims.

principally with an application for a declaration of invalidity of an EU trade mark lies with the Office, and measures imposed by that body may be appealed to the Boards of Appeal of the Office, against which an action may be brought before the General Court. [11]

40. Under Article 124(d) of Regulation 2017/1001, the trade mark courts have 'exclusive' jurisdiction if a counterclaim for invalidity of a trade mark is filed in an action for infringement before those courts. [12]

41. The decision to assign such jurisdiction to the trade mark courts – which is consistent with the decision made by the EU legislature to bring the examination of disputes concerning the infringement of EU trade marks before specialised national courts – was made for two reasons. First, it allows the defendant to raise a defence on the merits of the case that extends to contesting the validity of the trade mark, despite the Office's jurisdiction in principle in that area. Second, it reflects a concern for the sound administration of justice, enabling the parties to obtain a ruling in the same proceedings and before the same court on their mutual claims. It is therefore also based on the need – which can be inferred from recitals 32 and 33 of Regulation 2017/1001 – to ensure the protection of EU trade marks, preventing inconsistent decisions and ensuring that the unitary character of EU trade marks is not undermined.

42. It should also be noted that Article 127(1) of Regulation 2017/1001 lays down a rule for proceedings before trade mark courts whereby an EU trade mark is presumed to be valid, and that presumption can only be overcome if the defendant brings a counterclaim for a declaration of invalidity. [13] In other words, the invalidity of the EU trade mark cannot be invoked by the defendant as a mere plea in defence for the sole purpose of contesting the validity of the applicant's claim, [14] and may only be invoked if, at the same time, the EU trade mark court is expressly petitioned to declare that trade mark invalid. [15]

43. As noted by Advocate General Campos Sánchez-Bordona in his Opinion in *Raimund*, [16] that decision is consistent with the unitary character of the EU trade mark, expressing support for a ruling on validity that explains its effectiveness throughout the entire EU. Indeed, judgments

[11] See Articles 66 to 72. The same procedure is provided for in Article 63 in the event that the revocation of an EU trade mark is contested.

[12] It should be noted that, in order to avoid circumventing the Office's exclusive jurisdiction to hear principal applications for a declaration of invalidity of an EU trade mark, Article 127(2) of Regulation 2017/1001 provides that the validity of such a trade mark may not be challenged in an action for a declaration of non-infringement. The grounds for invalidity that may be relied upon in the context of a counterclaim are solely those of absolute invalidity, provided for in Article 59(1) of Regulation 2017/1001, and those of relative invalidity, as listed in Article 60(1) and (2) of that regulation.

[13] This presumption can also be overcome by a counterclaim for revocation, although in that case it is the enforceability of the private rights attached to the trade mark that is contested rather than its legal validity.

[14] The scope of the prohibition on challenging the invalidity of a trade mark by means of a plea in defence was extended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21), which amended Article 99(3) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which allowed such a plea to be raised if the invalidity was invoked on the basis of an earlier right of the defendant.

[15] In the main proceedings giving rise to the *Raimund* judgment, the defendant in the action for infringement had raised both a plea of invalidity and – in separate proceedings before the same court, as permitted by Austrian procedural law – a counterclaim for invalidity, invoking in both cases bad faith in the registration of the trade mark. In the judgment, the Court of Justice essentially held that a trade mark court cannot dismiss an action for infringement on the basis of an absolute ground for invalidity of the EU trade mark without having first upheld the counterclaim for a declaration of invalidity brought by the defendant in that action for infringement based on the same ground for invalidity (see paragraph 35 and point 1 of the operative part of the judgment).

[16] C-425/16, EU:C:2017:479, points 62 and 63.

declaring a counterclaim invalid have effect *erga omnes* and, under Article 128(6) of Regulation 2017/1001, the Office must enter them in the Register and take the necessary measures to comply with the operative part. [17]

44. It is clear from the above that there is a connection between the initial action for infringement and the counterclaim for a declaration of invalidity of the trade mark. Indeed, the latter is exercised 'as an incidental matter' in the context of a case brought to establish infringement and has – at least in part – a defensive purpose, being capable, if upheld, of obtaining the dismissal of the action in the main proceedings.

45. However, the purpose of a counterclaim is not limited to this: it may lead to a revocation of the industrial property right that produces effects *erga omnes* and, therefore, extends beyond the proceedings and the merely defensive needs of the defendant, who – as the case under consideration clearly shows – retains an interest in its being upheld even if the action for infringement is withdrawn.

46. In the light of the foregoing, I take the view – contrary to the Commission's position – that the counterclaim for a trade mark to be declared invalid under Article 128 of Regulation 2017/1001 is not merely ancillary to the main action for infringement, but has a nature that is, if not completely autonomous, at least hybrid, giving it the ability to withstand events that might extinguish the action for infringement.

47. The arguments put forward by the Commission in its written observations do not, in my view, put this conclusion in doubt. On the one hand, the ancillary nature of the counterclaim under Article 127(1) of Regulation 2017/1001 – which forms part of a proceeding that has already begun [18] – and the fact that it can only be brought by the defendant in an action for infringement are merely procedural prerequisites for its introduction and do not admit of any conclusions as to its nature. On the other hand, as I have already explained, the provisions of Articles 127 and 128 of Regulation 2017/1001 not only allow the defendant in an action for infringement to defend itself on the merits by overcoming the presumption of validity of an EU trade mark, but also recognise that defendant's right to request and obtain, on an incidental basis, a judgment declaring the invalidity of that trade mark which is valid *erga omnes* and which, once *res judicata*, constitutes the basis for obtaining the removal of its registration from the Register of EU trade marks. [19]

48. Lastly, contrary to what has been suggested not only by the Commission but also by the referring court, I do not consider that it is possible to draw arguments from the *Raimund* judgment in favour of an interpretation whereby the counterclaim is subject to the same extinguishing events as the trial of which it forms part. That judgment merely states that the decision to uphold a counterclaim for invalidity must be made before the action for infringement is dismissed, where the same grounds for invalidity have also been raised as a plea in defence. That judgment, however, says nothing about the effects of a withdrawal of an action for infringement on the proceedings in which the counterclaim is lodged.

[17] The same system applies in the case of a successful counterclaim for revocation.

[18] In other words, it builds on such a process, see the circumstances of the main proceedings in the case giving rise to the *Raimund* judgment.

[19] See Article 128(6) of Regulation 2017/1001.

49. The conclusion reached in point 46 of this Opinion as to the nature of the counterclaim under Article 128 of Regulation 2017/1001 is in line with the Court's interpretation of that procedural law precept in the context of the system created by the Brussels Convention, [20] reproduced first in Regulation (EC) No 44/2001, [21] and then in Regulation No 1215/2012 currently in force.

50. On this point, it should be noted that the rules on jurisdiction and the recognition and enforcement of judgments have constantly been expressly referred to in the various regulations on the Community trade mark and the EU trade mark that have succeeded one another over time, and each time they have been applied within the framework of the legal systems created by those regulations. Thus, Council Regulation (EC) No 40/94 on the Community trade mark and Council Regulation (EC) No 207/2009 on the Community trade mark – the predecessors of Regulation 2017/1001 – referred, respectively, to the Brussels Convention and to Regulation No 44/2001 and extended their application in the context of the regulation of EU trade marks, in order to allocate jurisdiction among the various Member States in relation to actions concerning Community trade marks. [22] Currently, Article 122 of Regulation 2017/1001 establishes the applicability of the rules in question 'to proceedings relating to EU trade marks and applications for EU trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of EU trade marks and national trade marks', except as otherwise provided for in that regulation, referring expressly, in paragraph 2, to the most recent rules on the subject, namely those contained in Regulation No 1215/2012.

51. It seems to me, therefore, that the notion of counterclaim must be interpreted in a manner consistent with the abovementioned regulations on jurisdiction and the case-law that has dealt with them. [23]

52. That said, I note that already in the judgment of 13 July 1995, *Danværn Production*, [24] in which the Court had to determine whether an application for set-off made by the defendant should be regarded as a 'counterclaim' within the meaning of Article 6(3) of the Brussels Convention, [25] a clear distinction emerges between a counterclaim, which is based on a claim that is distinguishable from the applicant's claim and is intended to obtain a judgment against the latter, and a mere plea in defence, which is an instrument of defence, with no independent value in

[20] The Brussels Convention of 27 September 1968 on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1972 L 299, p. 32; 'the Brussels Convention').

[21] 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).

[22] See in particular: (i) the recitals in Regulation No 40/94, which state that 'whereas the rules contained in the Brussels Convention of Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters will apply to all actions at law relating to Community trade marks …'; (ii) Article 94 of Regulation No 207/2009, which lays down rules for the application of Regulation No 44/2001 to proceedings relating to EU trade marks.

[23] It should also be noted that the terminology used in Article 6(3) of the Brussels Convention, in Article 6(3) of Regulation No 44/2001 and, now, in Article 8(3) of Regulation No 1215/2012 coincides exactly with that used in Regulation 2017/1001 (for example, the terms 'Widerklage' in German, 'counterclaim' in English, 'demande reconventionnelle' in French, 'domanda riconvenzionale' in Italian).

[24] C-341/93, EU:C:1995:239.

[25] Article 6(3) of that convention enabled the defendant to enter a counterclaim against the plaintiff in the court seised of the original claim, irrespective as to the basis of that court's jurisdiction, in order to avoid a proliferation of courts having jurisdiction, provided that there is a contractual or factual connection with the plaintiff's claim (see, on this point, the Opinion of Advocate General Léger in *Danværn Production* (C-341/93, EU:C:1995:139, point 7).

relation to the main proceedings, intended solely to paralyse the main proceedings. [26] This subject was also examined in depth by Advocate General Léger in the case giving rise to the abovementioned judgment. In his Opinion, he pointed out in particular that a counterclaim is 'a new claim, put forward during the proceedings by the defendant, who becomes in turn a plaintiff …', 'seeks a separate decision against the opponent and is not confined to seeking the dismissal of the original plaintiff's claims' and has a course and an outcome that are 'independent of the main claim', and thus 'if the principal plaintiff withdraws, this does not terminate the counterclaim'. [27]

53. More recently, the Court dealt with the concept of counterclaim in the judgment of 12 October 2016, *Kostanjevec*, [28] concerning, inter alia, the interpretation of Article 6(3) of Regulation No 44/2001. On that occasion, the Court held that a counterclaim concerned 'in substance, a separate claim seeking a judgment against the claimant, which may be made for an amount exceeding that claimed by the claimant, and can be proceeded with even if the claimant's claim is dismissed'. [29]

54. In short, therefore, the case-law cited above confirms the argument whereby a counterclaim is a legal remedy of a defendant who takes advantage of the plaintiff's claim made against him in the same proceedings and extends the *thema decidendum* by bringing an incidental, independent action, which goes beyond a simple request for dismissal of the plaintiff's claim and which can be continued regardless of the events that might extinguish that claim.

### *B. Applicability of the principle of perpetuatio fori*

55. Having thus demonstrated the non-ancillary nature of a counterclaim, I do not consider that the question posed by the referring court can be said to have been resolved. The question we need to resolve at this stage is whether, once the action for infringement has ceased to exist, jurisdiction to hear the counterclaim should be determined on the basis of the rules governing the principal application for a declaration of invalidity under Article 63 of Regulation 2017/1001, with consequent transfer to the Office, or whether, on the basis of other principles, the matter should remain within the jurisdiction of the trade mark court hearing the action.

56. Like the Commission, the referring court considers that it must infer a need to devolve jurisdiction to the Office from the exceptional nature of the jurisdiction of the trade mark courts, which in turn derives from the fact that they, as national courts, can only in exceptional cases set aside acts of the European Union, such as an act of registration of an EU trade mark.

[26] See judgment of 13 July 1995, *Danværn Production* (C-341/93, EU:C:1995:239, paragraph 12). The Court noted, in particular, that 'the national laws of the Contracting States generally distinguish between two situations. One is where the defendant pleads, as a defence, the existence of a claim he allegedly has against the plaintiff, which would have the effect of wholly or partially extinguishing the plaintiff's claim. The other is where the defendant, by a separate claim made in the context of the same proceedings, seeks a judgment or decree ordering the plaintiff to pay him a debt. In the latter case, the separate claim can be made for an amount exceeding that claimed by the plaintiff, and it can be proceeded with even if the plaintiff's claim is dismissed.' In paragraph 17 of that judgment, it is also pointed out that there are different expressions in national legislation for each of the two situations. In particular, with specific regard to counterclaim and set-off as a defence, French law distinguishes between 'demande reconventionelle' and 'moyens de défense au fond', English law between 'counterclaim' and 'set-off as a defence', German law between 'Widerklage' and 'Prozeßaufrechnung', and Italian law between 'domanda riconvenzionale' and 'eccezione di compensazione'.

[27] Opinion of Advocate General Léger in *Danværn Production* (C-341/93, EU:C:1995:139, points 25 and 26).

[28] C-185/15, EU:C:2016:76.

[29] Judgment of 12 October 2016, *Kostanjevec* (C-185/15, EU:C:2016:763, paragraph 32). That assertion is in line with the Opinion delivered by Advocate General Kokott in the same case (Opinion of Advocate General Kokott in *Kostanjevec*, C-185/15, EU:C:2016:397, points 39 to 41), which states that 'the counterclaim must therefore pursue a claim that is distinguishable from the plaintiff's claim, seeking a separate judgment … Such a claim does not constitute a mere defence to the opposing party's claim …'.

57. Furthermore, in support of its view, the Oberlandesgericht München (Higher Regional Court, Munich) asserts that Regulation 2017/1001 gives preference to the Office's review of validity. That preference should, in particular, be inferred from Article 128(7) of the regulation, which provides that, on application by the proprietor of the trade mark, the trade mark court may order the Office to take a decision on an application for a declaration of invalidity.

58. I do not consider the two arguments to be decisive.

59. It seems to me, first of all, that the division of powers, as regards the validity of EU trade marks, between the Office and the trade mark courts does not denote a rule/exception relationship between the jurisdiction of the former and that of the latter, but, rather, a relationship based on complementarity, intended to pursue the purpose of the legislation which, as already noted, is to ensure the protection of those marks, avoiding conflicting decisions of the courts and the Office and safeguarding the unitary character of the EU trade mark.

60. As highlighted by Advocate General Campos Sánchez-Bordona, in his Opinion in the case resulting in the *Raimund* judgment, indeed, unlike the procedure for registration of EU trade marks, 'established as being the exclusive task of EUIPO, unaffected by any decision of a national court', competence for declaring an EU trade mark invalid is 'shared' between the national EU trade mark courts and the Office. [30]

61. But even if I were to accept it, I do not think that the exceptional nature of the jurisdiction of the trade mark court over counterclaims for invalidity can affect the answer to the question raised. There is no doubt that at the time when the counterclaim was filed, the trade mark court had jurisdiction. To this I would add – from a 'dynamic' point of view – that the counterclaim's character, on which we have dwelt at length in the preceding paragraphs, is original, ontologically linked to the conditions existing at the time when it is introduced, and is independent of subsequent procedural developments. In other words, a counterclaim does not become a principal action because of the extinction of what was the original claim instituting the proceedings.

62. Thus, even if we were to admit the exceptional nature of the jurisdiction of the trade mark court, I believe that a situation such as that at issue in the main proceedings, characterised by the withdrawal of the action in the main proceedings, would also fall within that jurisdiction. This is not a question of an analogous application of the jurisdiction of the national courts, which is prohibited by the exceptional nature of that jurisdiction, but of its ordinary application to the case expressly indicated by the rule.

63. With regard to Article 128(7) of Regulation 2017/1001, it cannot be denied that this reflects the intention of the EU legislature to enhance a system of centralised assessment of the validity of trade marks and of the events leading to the extinction of corresponding rights within the Office. Moreover, Article 132(2) of the regulation takes the same line and allows proceedings

[30] See Opinion of Advocate General Campos Sánchez-Bordona in *Raimund* (C-425/16, EU:C:2017:479, point 83). See also, by analogy, in that it relates to the similar case of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), the judgment of 16 February 2012, *Celaya Emparanza y Galdos Internacional* (C-488/10, EU:C:2012:88, paragraph 48), which states that 'as regards … applications for a declaration of invalidity of registered Community designs, the Regulation opted for the centralised treatment of such actions by OHIM, although that rule is tempered by the fact that it is possible for Community design courts to hear counterclaims for a declaration of invalidity of a registered Community design raised in connection with infringement actions or actions in respect of threatened infringement'.

before it – even where the trade mark court is the body to which the matter is first referred – to be stayed at the request of a party pending the decision by the Office before which proceedings relating to the same subject matter have subsequently been instituted.

64. However, those provisions do not support the view that the jurisdiction of the trade mark court lapses as a result of the withdrawal of an action for infringement, but rather militate in favour of that view being rejected. As is clear from their very wording, those provisions grant a discretionary power to the trade mark court (the use of the verb 'may' leaves no doubt in this respect), which, in the presence of a request by the trade mark proprietor to refer the question of validity to the Office, may nevertheless decide, after hearing the parties, to rule on the counterclaim itself.

65. It would therefore be inconsistent with the scheme of the regulation – which expressly envisages a discretionary power for the court if the proprietor requests that the question of validity be referred to the Office – to allow the proprietor of the trade mark, by withdrawing the action for infringement, to cause the power of the court to cease to apply, irrespective of any assessment by that court.

66. In conclusion, I consider that the arguments put forward by the referring court are not conclusive. It seems to me, on the contrary, that the question should be resolved on the basis of the general principle of *perpetuatio fori*. And this situation applies, it should be noted, by virtue of EU law, without there being any need to have recourse, in accordance with the reference in Article 129(3) of Regulation 2017/1001, to provisions of national procedural law laying down that principle. [31]

67. By virtue of that precept, once a competent court is seised, in principle it retains jurisdiction even if the connecting factor used to establish jurisdiction changes during the proceedings. [32] The purpose of that principle is to avoid the damage that litigants would suffer if a subsequent change in the circumstances determining jurisdiction occurring during the proceedings were to result in a situation where the jurisdiction of the court before which the proceedings were brought ceases to apply.

68. There is no doubt that EU law is familiar with that principle. In this respect, reference should be made to the judgment of 11 October 2007, *Freeport*, [33] which expressly considered the time when the action was brought as a point of reference in assessing whether there was a connection between the claims, in order to determine jurisdiction under Article 6(1) of Regulation No 44/2001.

69. Reference should also be made to the Opinion delivered on 11 December 2014 by Advocate General Jääskinen [34] in *CDC Hydrogen Peroxide* and the judgment of 21 May 2015 delivered by the Court in the same case, also concerning Regulation No 44/2001. In that case, it was established, in application of the principle of *perpetuatio fori*, that the jurisdiction of the court

[31] The majority view in Germany is that Paragraph 261(3)(2) of the ZPO applies, whereby the jurisdiction of a court before which an action is brought is not affected by a change in the circumstances that gave rise to that jurisdiction.

[32] See the Opinion of Advocate General Szpunar in *A* (C-716/17, EU:C:2019:262, point 74).

[33] C-98/06, EU:C:2007:595, paragraph 54.

[34] Opinion of Advocate General Jääskinen in *CDC Hydrogen Peroxide* (C-352/13, EU:C:2014:2443, points 76 to 83).

seised, determined on the basis of the domicile of only one of the defendants in the proceedings, does not cease to apply even if the claim brought against the defendant justifying the determination of jurisdiction is withdrawn.[35]

70. The principle of *perpetuatio fori* then formed the basis of the judgment of 17 January 2006, *Staubitz-Schreiber*,[36] where the Court interpreted Regulation (EC) No 1346/2000[37] as meaning that the court of the Member State within the territory of which the centre of the debtor's main interests is situated at the time when the debtor lodges the request to open insolvency proceedings retains jurisdiction to open those proceedings if the debtor moves the centre of his main interests to the territory of another Member State after lodging the request but before the proceedings are opened.

71. The principle of *perpetuatio fori* is also referred to by Advocate General Szpunar in his Opinion delivered on 24 September 2014 in *Carl Gendreau*,[38] and in the Opinion delivered on 27 March 2019 in *A*,[39] and in the Opinion delivered on 30 April 2020 in *Novo Banco*.[40]

72. The principle in question is also addressed in the Practice guide for the application of the Brussels IIa Regulation[41] and was endorsed by the Institute of International Law at its session in Dijon in 1981.[42] Moreover, the principle of *perpetuatio fori* is provided for in many legal systems. It is known, inter alia, to the German, Italian, French and Spanish courts.

73. Lastly, it should be noted that that principle has in fact also been applied in the context of the division of jurisdiction between the Court of Justice and the General Court. In the case giving rise to the order in *IAMA Consulting*, the General Court, seised by virtue of an arbitration clause contained in a contract concluded by the European Community, referred to the Court of Justice an application made by way of counterclaim by the Commission after declaring that the applications submitted by the applicant company were inadmissible.[43] The General Court considered that jurisdiction to hear the case lay with the Court of Justice in accordance with Article 225(1) EC in conjunction with Article 51 of the Statute of the Court of Justice of the European Union in force at the time, according to which actions brought by Community institutions fell within the jurisdiction of the Court of Justice. The Court of Justice noted, first, that the Community system of jurisdiction entailed a precise delimitation of the respective jurisdictions of the Court of Justice and the General Court, based at the time on the status of the applicant, such that the jurisdiction of one of those two courts to rule on an action necessarily excluded the jurisdiction of the other.[44] It went on to state that 'in the Community system of legal remedies, jurisdiction to rule on a main action entails jurisdiction to rule on any counterclaim brought in the same proceedings arising from the same act or fact that is the subject matter of the

35 Judgment of 21 May 2015, *CDC Hydrogen Peroxide* (C-352/13, EU:C:2015:335, paragraph 28), where, although not expressly stating the principle of *perpetuatio fori*, the Court has in fact implemented that principle.

36 C-1/04, EU:C:2006:39. See also the Opinion delivered in that case by Advocate General Ruiz-Jarabo Colomer (C-1/04, EU:C:2005:500).

37 Council Regulation (EC) No 1346/2000 of 29 May 2000 on insolvency proceedings (OJ 2000 L 160, p. 1).

38 C-376/14 PPU, EU:C:2014:2275, footnote 37.

39 C-716/17, EU:C:2019:262, point 74.

40 C-253/19, EU:C:2020:328, point 23.

41 Practice guide for the application of the Brussels IIa Regulation, published on 20 June 2016 by the European Commission, available from https://op.europa.eu/en/publication-detail/-/publication/f7d39509-3f10-4ae2-b993-53ac6b9f93ed.

42 The document entitled 'The Problem of Choice of Time in Private International Law' (available from https://www.idi-iil.org/app/uploads/2017/06/1981_dijon_01_en.pdf) states that 'changes during the course of the proceedings in the facts that constitute the basis for assuming jurisdiction shall not deprive a court of its existing jurisdiction or normally affect the recognition or enforcement of its judgments in other States'.

43 See order of 25 November 2003, *IAMA Consulting* v *Commission* (T-85/01, EU:T:2003:309).

44 See order of 27 May 2004, *Commission* v *IAMA Consulting* (C-517/03, not published, EU:C:2004:326, paragraph 15).

action' and that that jurisdiction is based in particular on the interest of procedural economy.[45] Lastly, the Court of Justice observed that the fact that the action had been dismissed and that the counterclaim had therefore ceased to be incidental in nature did not mean that the General Court did not have jurisdiction to rule on that claim.[46]

74. Having said that, I consider that the principle of *perpetuatio fori* should also apply in the present case. On this point, I consider relevant the reference in Article 122 of Regulation 2017/1001 to the rules on jurisdiction and the recognition and enforcement of judgments, in relation to which the case-law referred to above has considered the principle of *perpetuatio fori* to be applicable. If the applicability of that principle for the purposes of allocating jurisdiction among the various Member States in relation to actions concerning EU trade marks cannot be disputed, I do not see why a different conclusion should be reached in the present case in which, in fact, we are still dealing with rules for the attribution of a judicial or quasi-judicial power.

75. The principle of *perpetuatio fori*, moreover, by anchoring jurisdiction to the time when the counterclaim is introduced, guarantees legal certainty and avoids the prejudicial consequences – which in my opinion are significant – to the detriment of procedural economy and the defendant's right of defence that would result from attributing any importance to the withdrawal of the main action.

76. By way of example, we should consider the case in which, close to the end of proceedings characterised by a complex and costly preliminary investigation, or even at the appeal stage, the applicant withdraws from the action for infringement because he or she becomes aware that it is likely to be dismissed. The court's lack of jurisdiction to hear the counterclaim would require the defendant to start proceedings before the Office right from the beginning.

77. I do not think it is a matter for debate that the principle of procedural economy, which should characterise not only the judicial activity but also the administrative activity of the Office, would be undermined by a nullification of the work carried out and the time spent in the proceedings at first instance, given that this would involve a duplication of overlapping activities leading to comparable results under Regulation 2017/1001. The defendant would also have to bear additional costs for instituting proceedings before the Office. It should be noted that these negative consequences would automatically result from a decision – to withdraw the main action – taken by the person against whom the counterclaim has been filed.

78. The interpretation provided does not conflict with the specific purpose of the framework contained in Regulation 2017/1001.

[45] See order of 27 May 2004, *Commission* v *IAMA Consulting* (C-517/03, not published, EU:C:2004:326, paragraph 17 and the case-law cited).

[46] See order of 27 May 2004, *Commission* v *IAMA Consulting* (C-517/03, not published, EU:C:2004:326, paragraph 20). In the same vein, see also the judgment of 16 September 2013, *GL2006 Europe* v *Commission* (T-435/09, EU:T:2013:439, paragraphs 45 to 47), given in the context of a case assigned to that court on the basis of an arbitration clause within the meaning of Article 272 TFEU. On that occasion, the General Court – after emphasising the distinct nature of the counterclaim brought by the Commission in relation to the undertaking's main action – held that it was necessary to rule on that application notwithstanding the fact that it had declared that there was no need to adjudicate on the main action, which had become devoid of purpose because the applicant was no longer represented by a lawyer. See also the judgment of 9 July 2013, *Lito Maieftiko Gynaikologiko kai Cheirourgiko Kentro* v *Commission*, T-552/11, not published, EU:T:2013:349, paragraph 41 and the case-law cited), the resolution of which was not called into question by the Court in its judgment on appeal (see judgment of 9 September 2015, *Lito Maieftiko Gynaikologiko kai Cheirourgiko Kentro* v *Commission*, C-506/13 P, EU:C:2015:562).

79. As already mentioned, it is clear from recital 32 of Regulation 2017/1001 that the essential requirement underlying the rules in question is that 'decisions regarding the validity and infringement of EU trade marks have effect and cover the entire area of the Union, as this is the only way of preventing inconsistent decisions on the part of the courts and the Office and of ensuring that the unitary character of EU trade marks is not undermined'.

80. The purposes underlying the legislation in question and the origin of the jurisdiction of the trade mark court over counterclaims for a declaration of invalidity are not affected by the extinction of the main action for infringement. That extinction does not give rise to multiple proceedings, since the case is heard by a single body, nor does it affect the effect *erga omnes* of the decision of the national court on the validity of the trade mark. This preserves the requirements both for procedural economy and for uniformity of the mark throughout the EU. Moreover, there is no risk of contradictory decisions, given that the matter has been referred to only one body.

81. In conclusion, for all the reasons set out above, I consider that the trade mark court retains jurisdiction to rule on the invalidity of an EU trade mark invoked through a counterclaim under Article 128 of Regulation 2017/1001 even after the main action for infringement has been validly withdrawn.

## VI. Conclusion

82. On the basis of all the foregoing considerations, I suggest that the Court reply as follows to the question referred for a preliminary ruling by the Oberlandesgericht München (Higher Regional Court, Munich, Germany):

Article 124(d) and Article 128 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark should be interpreted as meaning that the EU trade mark court retains jurisdiction to rule on the invalidity of an EU trade mark asserted by a counterclaim within the meaning of Article 128 of Regulation 2017/1001 even after the action for infringement based on that EU trade mark for the purposes of Article 124(a) has been validly withdrawn.