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CJEU rules on the procedural autonomy of national courts acting as EU trade mark courts

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In Case [C-654/21](#), the CJEU ruled on a reference for a preliminary ruling from the Sąd Okręgowy w Warszawie (XXII Division of the District Court in Warsaw, Poland) in a dispute between two individuals.



The dispute concerned an action for infringement of the European Union trade mark “[MULTISELECT](#)” brought before the Warsaw IP Court and a counterclaim for a declaration of invalidity of that trade mark based, in particular, on lack of distinctiveness. While the infringement action concerned only certain goods and services for which the EU trade mark was registered, the counterclaim was aimed at having the EU trade mark declared invalid in its entirety.

The Polish court asked whether the counterclaim could be directed against the entire trade mark relied on, without being limited to the subject matter of the infringement action. In other words, the Polish court wanted to know whether the defendant could, by way of counterclaim, seek invalidation of the entire EU trade mark and not only of the goods and services relied on by the EU trade mark holder. The Polish court also wanted to know whether the invalidity counterclaim was linked to the content of an infringement claim.

The CJEU confirmed that the counterclaim could be directed against the entire EU trade mark relied on. In particular, the CJEU relied on its previous judgment of 13 October 2022 in [C-256/21](#)

(Gemeinde Bodmann-Ludwigshafen) and held that under EU laws “the counterclaim” was a separate and autonomous concept and that its procedural handling was independent of the principal claim (para. 32). Although the ‘counterclaim’ is a legal remedy which remains conditional on the bringing of an action for infringement and is therefore initially linked to that action, the purpose of such a remedy is to extend the subject-matter of the dispute and to obtain recognition of a claim which is separate and independent from the infringement claim, among others, to have the EU trade mark concerned declared invalid. Moreover, the subject-matter of the counterclaim cannot be limited by the subject-matter of the infringement action in the context of which the counterclaim is brought (para. 35). This would be contrary to procedural economy and equivalence, which are the objectives of the invalidity counterclaim (para. 44). As an aside, the CJEU pointed out that the EUIPO had exclusive jurisdiction over the registration and opposition of EU trade marks. Jurisdiction to declare an EU trade mark invalid or to revoke an EU trade mark, however, is shared (para. 51).

Comment

The CJEU held that an application for a declaration of invalidity as a counterclaim in an EU trade mark infringement action is unrelated to that infringement action in terms of its scope. This is because in invalidity proceedings and in response to an infringement action, the EU trade mark, the EUIPO and the national EU trade mark courts have the same level of jurisdiction over the validity of the trade mark. The CJEU concluded that it is possible to extend the subject matter of an action for infringement of an EU trade mark and to seek recognition of a claim, which is independent and separate from the infringement claim, in order to invalidate an EU trade mark. Consequently, this separate claim can be brought even if the infringement claim has been dismissed or withdrawn (as confirmed in C-256/21) or has gone beyond the scope of the infringement action. This means that a counterclaim for invalidity before the referring court has a greater subject matter scope than a counterclaim for invalidity related to an infringement claim under the relevant provisions of Polish national procedural law, which are after all autonomous. In other words, if the case were brought based on a national trade mark rather than an EU trade mark, the defendant would not be entitled to bring a counterclaim for a declaration of invalidity of the entire earlier trade mark.

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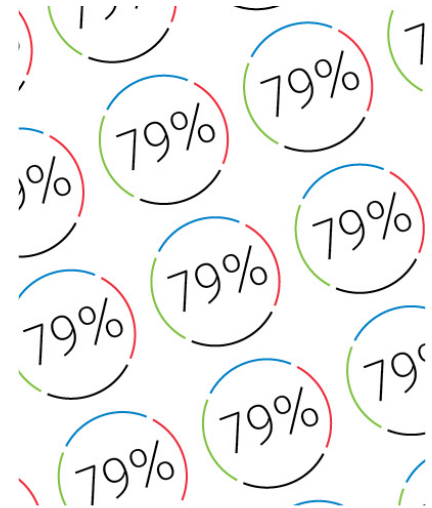
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