

Case C-10/89

SA CNL-SUCAL NV

v

HAG GF AG

(Reference for a preliminary ruling
from the Bundesgerichtshof)

(Free movement of goods — Trade mark)

Report for the Hearing	3712
Opinion of Mr Advocate General Jacobs delivered on 13 March 1990	3725
Judgment of the Court, 17 October 1990	3752

Summary of the Judgment

Free movement of goods — Industrial and commercial property — Trade mark — Similar products protected in different Member States by identical marks or marks liable to be confused belonging to two entirely separate undertakings — Opposition of the proprietor of the mark in one Member State to the importation of products marketed by the other undertaking under its own trade mark — Whether permissible — Common origin of the two marks prior to expropriation resulting in separate proprietors being entitled to use the trade mark — Not relevant (EEC Treaty, Arts 30 and 36)

Articles 30 and 36 of the EEC Treaty do not preclude national legislation from allowing an undertaking which is the proprietor of a trade mark in a Member State to oppose the importation from another Member State by an undertaking which is legally and economically independent of it and without its consent of similar products lawfully bearing in the

latter State an identical trade mark or one which is liable to be confused with the protected mark, even if the mark under which the goods in dispute are imported originally belonged to a subsidiary of the undertaking which opposes the importation and was acquired by a third undertaking following the expropriation of that subsidiary.

From the date of expropriation and notwithstanding their common origin, each of the marks independently fulfilled its

function, within its own territorial field of application, of guaranteeing that the marked products originated from one single source.

REPORT FOR THE HEARING in Case C-10/89 *

I — Facts and procedure

The company HAG GF AG, the plaintiff and respondent to an appeal on a point of law in the main proceedings, was founded in 1906 and since it was the first to discover a process to decaffeinate coffee its main activity for a long time has been the manufacture and sale of such coffee. It holds numerous trade marks in the Federal Republic of Germany — the oldest registered in 1907 — in which the main element is the word 'HAG', which is also part of the corporate name.

In 1908 it had two trade marks registered in Belgium, relating to the name 'Kaffee HAG'. In 1927 it set up a subsidiary company in Belgium, trading as 'Café HAG SA', which was wholly owned and controlled by it. The subsidiary company had at least two trade marks registered on its own account, one of which related to the mark 'Café HAG'. With effect from 1935, the plaintiff also transferred the trade marks registered in its own name in Belgium to the subsidiary.

In 1944 Café HAG SA was seized as enemy property. Later, the Belgian authorities sold the shares *en bloc* to the Van Oevelen family. In 1971 Café HAG SA assigned the Benelux marks held by it to Société en commandite Van Zuylen Frères, Liège.

When HAG AG began in 1972 to import its products into Luxembourg under the name 'Kaffee HAG', Van Zuylen Frères brought legal proceedings in Luxembourg to restrain it. In those proceedings the Court of Justice, to which the matter had been referred for a preliminary ruling, held that: 'To prohibit the marketing in one Member State of a product legally bearing a trade mark in another Member State for the sole reason that an identical trade mark, having the same origin, exists in the first State, is incompatible with the provisions for the free movement of goods within the common market' (judgment in Case 192/73 *Van Zuylen v HAG* [1974] ECR 731). Following that decision the Belgian company's claim was rejected.

* Language of the case: German.