

Case C-684/19

Request for a preliminary ruling

Date lodged:

17 September 2019

Referring court:

Oberlandesgericht Düsseldorf (Germany)

Date of the decision to refer:

9 September 2019

Appellant:

mk advokaten GbR

Respondent:

MBK Rechtsanwälte GbR

[...]

**OBERLANDESGERICHT DÜSSELDORF (HIGHER REGIONAL COURT,
DÜSSELDORF)**

ORDER

In the case of

mk advokaten GbR, [...] Kleve,

debtor and appellant,

[...]

v

MBK Rechtsanwälte GbR, [...] Mönchengladbach,

creditor and respondent,

[...]

The 20th Civil Chamber of the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) [...] on 9 September 2019 [**Or. 2**]

ordered as follows:

I.

The proceedings are stayed.

II.

Reference is made by the Higher Regional Court, Düsseldorf, to the Court of Justice of the European Union for a preliminary ruling on the following question concerning the interpretation of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25) ('the Directive'):

Does a third party referred to in an entry published on a website that contains a sign identical to a trade mark 'use' that trade mark, within the meaning of Article 5(1) of the Directive, if the entry was not placed there by the third party itself, but was taken by the website's operator from another entry that the third party had placed in infringement of the trade mark?

Grounds

I.

- 1 The creditor, a partnership of lawyers, operates under the name 'MBK Rechtsanwälte'; it is also the proprietor of German word mark 30 2014 035 913 'MBK Rechtsanwälte', registered, inter alia, in respect of 'advisory services in legal disputes; advisory services on points of law; services of a lawyer; services'.
- 2 The debtor, based in Kleve (Lower Rhine) and also a partnership of lawyers, temporarily operated under the name 'mbk rechtsanwälte' or 'mbk advokaten'. The creditor took the view that this amounted to an infringement of its trade name and trade mark and obtained an enforceable agreed judgment of the Landgericht Düsseldorf (Regional Court, Düsseldorf) of 17 October 2016 prohibiting [**Or. 3**] the debtor from offering legal services under the name 'mbk' in the course of trade, on pain of incurring statutory penalties.
- 3 The creditor subsequently discovered that, notwithstanding the enforceable agreed judgment, an entry of 'mbk Rechtsanwälte' in google.de still displayed several hits referring to the debtor. These concerned an entry on 'kleve-niederrhein.stadtbranchenbuch.com' and on the rating platform 'cylex.de'. In its defence, the debtor submits that it did not commission those entries. It stated that it had commissioned just one entry under the name 'mbk Rechtsanwälte' in the 'Das Örtliche' telephone directory — which also appears on the internet — from which those entries had been taken by third party websites without its knowledge

or intention. It submits that it immediately removed the entry from ‘Das Örtliche’. It was not, in its view, obliged to take any further steps.

- 4 In the contested order, the Regional Court imposed a fine on the debtor on the application of the creditor pursuant to Paragraph 890(1) of the Zivilprozessordnung (German Code of Civil Procedure). In its reasoning it stated that, as a result of the judgment, the debtor was obliged to remove not only the entry which it had itself commissioned, but also all entries in the usual internet directories which contained the contested sign, since those directories also benefited the debtor financially and were based on the entry that it had directly commissioned.
- 5 It is against that order that the debtor has brought the present appeal.

II.

- 6 The decision turns on the interpretation of Article 5(1) of the Directive — applicable *ratione temporis*.
- 7 1. The creditor has, it is true, asserted a claim not only on the basis of its trade mark, but also, first and foremost, on the basis of its trade name. Unlike registered trade marks, trade names are not regulated by EU law. In any event, as regards the issue raised in the present case, national law contains identical rules for trade marks and for the right to a trade name and those rules must be interpreted in the same way. [Or. 4]
- 8 Paragraph 14(2) of the Markengesetz (German Law on Trade Marks) is worded as follows:

Third parties shall not, without the consent of the proprietor of the trade mark, in the course of trade

1.

use a sign which is identical to the trade mark in relation to goods or services which are identical to those for which the trade mark is protected,

2.

use a sign where, because of its identity with or similarity to the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the trade mark.

Paragraph 15(2) of the Law on Trade Marks is worded as follows:

Third parties shall be prohibited from using the commercial designation or a similar sign in the course of trade without authorisation in a manner liable to cause confusion with the protected designation.

The first sentence of Paragraph 890(1) of the Zivilprozessordnung (German Code of Civil Procedure) is worded as follows:

If a debtor fails to comply with his obligation not to act ..., he shall, on application by the creditor, be sentenced by the court of first instance ... to a fine.

- 9 2. Where a debtor has infringed the trade mark or trade name of a third party by an entry (first entry) on the internet, he shall not only be obliged to remove that first entry. Rather, according to the settled case-law of the German courts, [...] the debtor must check the internet by means of the usual search engines to determine whether third party websites have taken that entry, albeit without the debtor's consent, and must thereafter make at least a serious attempt to remove it. That view is justified by the fact that those subsequent entries are attributable to the debtor's unlawful first entry and also benefit the debtor financially. It is therefore not the aggrieved party but the infringing party who must bear the risk [Or. 5] of entries being taken by other websites without permission being obtained. The infringing party must therefore also bear the expense and efforts associated with their removal. Taking into account that case-law, the present Chamber would have to dismiss the present appeal.
- 10 It is unclear whether this is compatible with the case-law of the Court of Justice concerning trade marks. In its judgment of 3 March 2016 (C-179/15 — *Daimler AG v Együd Garage Gépjárműjavító és Értékesítő Kft*; EU:C:2016:134), the Court of Justice ruled that subsequent entries do not constitute use within the meaning of Article 5(1) of the Directive. In its reasoning it stated that use requires active behaviour; the party who commissioned only the first entry on a particular website is not liable for the actions of third parties.
- 11 If that case-law is applied to the instant case, the present Chamber would have to vary the Regional Court's order and refuse the application for imposition of a fine.
- 12 In Germany there has been little discussion of the consequential effects of the Court of Justice's decision. It is not clear to the Chamber whether the findings of the Court of Justice relate only to the particular situation at the time, in which the first entry was originally lawful — due to the fact that, at the time, permission had been given by the trade mark proprietor as part of a collaboration between the parties — and became unlawful only as a result of a subsequent event (the termination of that collaboration and consequent withdrawal of the permission granted). By contrast, the first entry made by the debtor constituted, from the outset, an infringement of the creditor's rights.

[...]