



A service consisting of the mere filling of cans bearing a sign protected as a trade mark is not use of that sign which is liable to be prohibited

A service provider who merely fills under an order from and on the instructions of another person merely creates the technical conditions necessary for the other person to use the sign similar to a protected trade mark

Frisdranken Industrie Winters BV ('Winters') is a Dutch undertaking which is mainly involved in the 'filling' of cans with drinks produced by itself or by others.

Red Bull GmbH produces and markets an energy drink under the trade mark RED BULL. It has obtained international registrations for that trade mark, valid, inter alia, in the Benelux countries.

Winters filled cans with fizzy drinks on the instructions of Smart Drinks Ltd, a legal person under the law of the British Virgin Islands, which is a competitor of Red Bull. For that purpose, Smart Drinks supplied Winters with empty cans, delivered with matching lids and all bearing various signs, some of which were similar to the trade marks of Red Bull. Smart Drinks also delivered to Winters the extract contained in the fizzy drink.

Winters filled the cans with a specific quantity of the extract in accordance with Smart Drinks' directions and recipes, added water and, if necessary, carbon dioxide, and sealed the cans. Winters then placed the filled cans at the disposal of Smart Drinks, which then exported them to countries outside the Benelux. In the present case, Winters only performed the aforementioned filling services on the instructions of Smart Drinks, and did not send the filled cans to that company. Nor did Winters deliver or sell the cans to third parties.

Red Bull brought an action before the Dutch courts claiming that Winters had infringed its trade mark rights and seeking an order that Winters cease use of signs which are similar to its trade marks. In that respect, the Hoge Raad der Nederlanden (Supreme Court of the Netherlands) asks the Court of Justice whether the mere 'filling' of packaging which bears a sign similar to a protected trade mark must be regarded as 'using that sign' in the course of trade within the meaning of the Trade Mark Directive¹ even if that filling takes place as a service provided to and on the instructions of another person.

The Court notes first that, under that directive, a trade mark proprietor is entitled to prohibit a third party from using, without the proprietor's consent, a sign identical with or similar to his trade mark when that use is in the course of trade, is in relation to goods or services which are identical with, or similar to, those for which that trade mark was registered and, due to a likelihood of confusion on the part of the public, affects, or is liable to affect, the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services.

The Court then considers whether, in the present case, a service provider such as Winters itself makes 'use' of signs similar to the trade marks of Red Bull.

¹ Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1).

In that regard, the Court observes that the fact of creating the technical conditions necessary for the use of a sign and being paid for that service does not mean that the party offering the service itself uses that sign.

A service provider who merely fills, under an order from and on the instructions of another person, cans already bearing signs similar to registered trade marks does not itself 'use' those signs within the meaning of the Trade Mark Directive. Such a service provider merely executes a technical part of the production process of the final product without having any interest in the external presentation of the cans and in particular in the signs thereon and thus **only creates the technical conditions necessary for the other person to use them.**

Moreover, the Court goes on to state that a service provider in Winters' situation does not, on any view, use those signs 'for goods or services' which are identical with, or similar to, those for which the trade mark was registered, within the meaning of the Trade Mark Directive.

As the Court has already stated, that expression generally applies to goods or services of third parties who use the sign. However, in the present case, it is established that the service provided by Winters consists of the filling of cans and that **this service does not have any similarity with the product for which Red Bull's trade marks were registered.**

It is true that the Court has already held, in the context of the provision of services online, that that expression in the directive may, under certain conditions, include goods and services of another person on whose behalf the third party acts. Thus, the Court considered that a situation in which the service provider uses a sign corresponding to the trade mark of another person in order to promote goods which one of its customers is marketing with the assistance of that service is covered by that same expression when that use is carried out in such a way that it establishes a link between that sign and that service².

However, the filling of cans bearing signs similar to registered trade marks is not, by its very nature, comparable to a service aimed at promoting the marketing of goods bearing those signs and does not imply, inter alia, the creation of a **link between the signs and the filling service.** The undertaking which carries out the filling is not apparent to the consumer, which excludes any association between its services and the signs.

Therefore, the Court holds that the Trade Mark Directive must be interpreted as meaning that a service provider who, under an order from and on the instructions of another person, fills packaging – which was supplied to it by the other person who, in advance, affixed to it a sign which is identical with, or similar to, a sign protected as a trade mark – does not itself make use of the sign that is liable to be prohibited.

NOTE: A reference for a preliminary ruling allows the courts and tribunals of the Member States, in disputes which have been brought before them, to refer questions to the Court of Justice about the interpretation of European Union law or the validity of a European Union act. The Court of Justice does not decide the dispute itself. It is for the national court or tribunal to dispose of the case in accordance with the Court's decision, which is similarly binding on other national courts or tribunals before which a similar issue is raised.

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The [full text](#) of the judgment is published on the CURIA website on the day of delivery.

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² In particular, Case C-324/09 *L'Oréal and Others*, see also Press Release [69/11](#).