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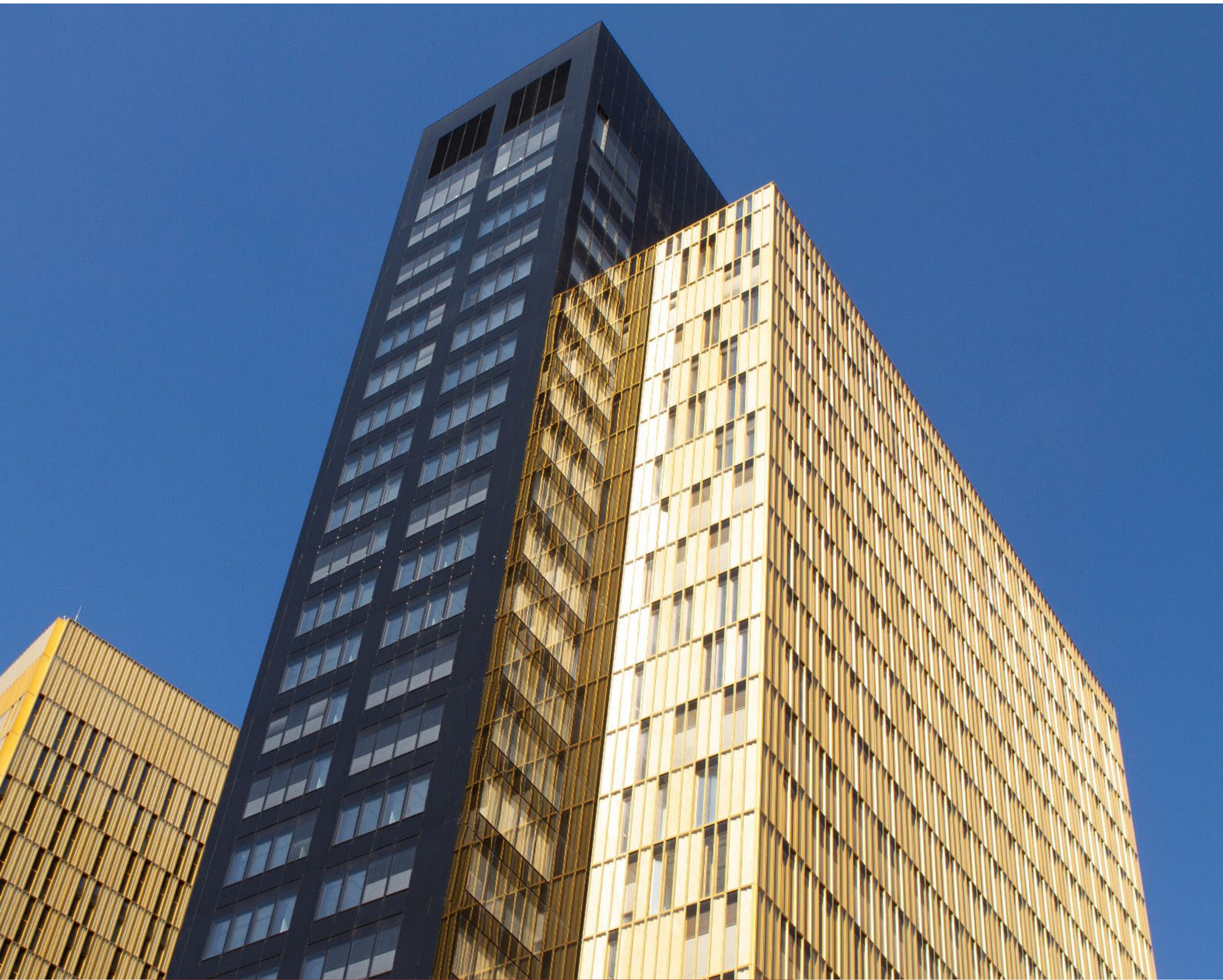

Fact sheet

Trade mark law

Research and Documentation Directorate

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Foreword

A trade mark is a sign used in trade to identify goods or services. Regulation (EC) No 40/94 [1] on the Community trade mark established a Community trade mark system enabling any interested party to acquire, by means of a single procedure, a trade mark enjoying uniform protection and having effect throughout the entire area of the European Union. Today, this regime is governed by Regulation (EU) 2017/1001 on the European Union trade mark. [2] Furthermore, the protection of trade marks at national level in the Member States of the European Union has been harmonised by Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trade marks, [3] thereby making registration and management of trade marks easier throughout the Union.

Trade mark law is currently the source of significant litigation for the Courts of the European Union and has been so for many years. Thus, it should be noted, by way of illustration, that the Court of Justice and the General Court handed down more than 360 decisions on the matter in 2024, due in particular to the fact that, first, the General Court has jurisdiction to examine actions brought against decisions handed down by the Boards of Appeal of the European Union Intellectual Property Office (EUIPO) and, second, that the Court of Justice hears appeals brought against decisions of the General Court on the matter and questions referred for a preliminary ruling on the interpretation of Directive (EU) 2015/2436. The highly significant volume of such litigation fully justifies therefore the provision of tools not only to the Court of Justice and the General Court, but also to any interested person, giving them an overview of the most relevant case-law on the matter. That is the purpose of this factsheet.

With this in mind, the factsheet includes summaries of 50 judgments of the Court of Justice and of the General Court handed down up to the end of 2025 in relation to trade mark law. The case-law was selected as part of the close collaboration established between the Court of Justice of the European Union and the World Intellectual Property Organisation (WIPO) in 2023. In this context, the Research and Documentation Directorate was asked to select the most important judgments of the Court of Justice and of the General Court in the field of intellectual property in order to populate the WIPO database and thus make the main case-law of the European Union in this field available to the public on the organisation's website. The selection made in this regard was

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1 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

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).

3 Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1).

supplemented by the most important judgments handed down in the area in 2024 and 2025.

List of acts referred to

REGULATIONS:

Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

Council Regulation (EC) No 6/2002 of 12 December 2001 on European Union designs (OJ 2002 L 3, p. 1), in the version prior to the entry into force of Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 (OJ L 2024/2822).

Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).

Regulation (EU) No 528/2012 of the European Parliament and of the Council of 22 May 2012 concerning the making available on the market and use of biocidal products (OJ 2012 L 167, p. 1).

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 Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

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).

Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 (OJ 2018 L 104, p. 1).

DIRECTIVES

Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising (OJ L 250, p.17), as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 (OJ L 290).

First 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).

Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market (OJ L 178, p. 1).

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)

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1).

INTERNATIONAL AGREEMENTS

Nice Agreement concerning the Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Paris Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883, last revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaties Series*, Vol. 828, No. 11851, p. 305).

I. Absolute grounds for refusal of registration

1. Graphic representation of a sign

Judgment of 27 November 2003, Shield Mark (C-283/01, EU:C:2003:641)

(Trade marks – Approximation of laws – Directive 89/104/EEC – Article 2 – Signs of which a trade mark may consist – Signs capable of being represented graphically – Sound signs – Musical notation – Written description – Onomatopoeia)

Shield Mark is the holder of 14 trade marks registered at the Benelux Trade Marks Office for various products, [4] eleven of which consist of the first nine notes of the musical composition 'Für Elise' by L. van Beethoven and the remaining three of the onomatopoeia of a cockcrow.

During an advertising campaign which began in 1995, Mr Kist, a communications consultant, used a melody consisting of the first nine notes of 'Für Elise' and also sold a computer program which, when starting up, emits a cockcrow. Shield Mark brought an action against Mr Kist for infringement of its trade mark and unfair competition. The application was partially upheld at first instance, in so far as it was based on the law of civil responsibility. However, it was dismissed in so far as it was based on trade mark law, on the ground that it was the intention of the governments of Benelux Member States to refuse to register sounds as trade marks.

Following an appeal by Shield Mark, the referring court made a request for a preliminary ruling on the interpretation of Article 2 of Directive 89/104 on trade marks [5] and, in particular, whether sound signs could be registered as trade marks.

The Court holds, first, that Article 2 of Directive 89/104 is to be interpreted as meaning that sound signs must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

Second, it finds that Article 2 Directive 89/104 must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

[4] The goods and services in question were in Classes 9, 16, 35, 41 and 42 of the Nice Agreement concerning the Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

[5] First 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 the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.

Judgment of 27 October 2005, Eden v OHIM (Smell of ripe strawberries) (T-305/04, EU:T:2005:380)

(Community trade mark – Olfactory mark: Smell of ripe strawberries – Absolute ground for refusal – Sign not capable of being represented graphically – Article 7(1)(a) of Regulation (EC) No 40/94)

In 1999 Laboratoires France Parfum SA filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (OHIM) in order to register an olfactory sign, not perceptible visually, described by the words 'smell of ripe strawberries' and consisting of a colour image.

However, the examiner rejected the application on the ground, first, that the olfactory sign applied for was not capable of being represented graphically and, second, that it was devoid of any distinctive character with regard to some of the goods claimed. Laboratoires France Parfum SA brought an action before the First Board of Appeal, which dismissed, finding that the sign applied for was not capable of being represented graphically within the meaning of Article 4 of Regulation No 40/94 [6] and was therefore covered by the ground for refusal provided for in Article 7(1)(a) of the regulation.

In an action brought against the decision of the Board of Appeal of OHIM, which it dismisses, the Court clarifies that Article 4 of Regulation No 40/94 must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The graphic representation of a sign must enable it to be identified accurately in order to ensure the sound operation of the trade mark registration system. Consequently, the conditions for allowing a graphic representation to be valid cannot be altered or relaxed in order to facilitate the registration of signs whose nature makes graphic representation more difficult.

[6] Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

As regards an olfactory sign, the Court considers that it cannot be ruled out that an olfactory sign might possibly be the subject of a description which satisfies all the requirements laid down by Article 4 of Regulation No 40/94.

Judgment of 25 January 2007, Dyson, Case C-321/03, EU:C:2007:51

(Trade marks – Approximation of laws – Directive 89/104/EEC – Article 2 – Concept of a sign of which a trade mark may consist – Transparent bin or collection chamber forming part of the external surface of a vacuum cleaner)

Since 1993 Dyson LTD has manufactured and marketed the Dual Cyclone vacuum cleaner, a bagless cleaner in which the dirt and dust is collected in a transparent plastic container forming part of the machine. In 1996, Notetry Ltd, a company owned by James Dyson, lodged an application with the Registrar of Trade Marks (the authority competent for trade mark registration, United Kingdom, the 'Registrar') for the registration of six trade marks in respect of 'apparatus for cleaning'. [7] The application was withdrawn for four of those marks but was maintained for the two others, which were described as follows: 'the mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'.

The Registrar nevertheless rejected the application and the Hearing Officer upheld that decision. Dyson therefore brought an appeal before the High Court of Justice of England & Wales, Chancery Division, [United Kingdom] which took the view that the two trade marks at issue were devoid of any distinctive character and that they were descriptive of characteristics of the goods covered by the application for registration. By contrast, it was uncertain whether the trade marks had acquired distinctive character through use on the date of the application. It was in those circumstances that it decided to refer a question to the Court of Justice for a preliminary ruling on the interpretation of Directive 89/104.

The Court takes the view that Article 2 of Directive 89/104 must be interpreted as meaning that the subject matter of an application for registration of trade marks, which relates to all conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, does not constitute a 'sign' within the meaning of that provision and, therefore, is not capable of constituting a trade mark within the meaning of that provision.

The subject matter of such an application which is, in actual fact, a mere property of the product concerned, is capable of taking on a multitude of different appearances and is thus not specific. Given the exclusivity inherent in trade mark law, the holder of a trade mark relating to such a non-specific subject matter would obtain an unfair competitive advantage, contrary to the purpose pursued by Article 2 of the Directive, since it would be

[7] The goods concerned were in Class 9 of the Nice Agreement.

entitled to prevent its competitors from marketing vacuum cleaners having any kind of transparent collecting bin on their external surface, irrespective of its shape.

Judgment of 24 October 2018, Pirelli Tyre v EUIPO – Yokohama Rubber (Representation of an L-shaped groove) (T-447/16, EU:T:2018:709 [8])

(EU trade mark – Invalidity proceedings – EU figurative mark representing an L-shaped groove – Absolute ground for refusal – Sign consisting exclusively of the shape of goods which is necessary to obtain a technical result – Article 7(1)(e)(ii) of Regulation (EC) No 40/94 – Article 7(1)(e)(ii) of Regulation (EC) No 207/2009 (now Article 7(1)(e)(ii) of Regulation (EU) 2017/1001) – Regulation (EU) 2015/2424 – Application of the law ratione temporis – Shape of the goods – Nature of the sign – Account taken of material relevant to identifying the essential characteristics of the sign – General interest underlying Article 7(1)(e)(ii) of Regulation No 40/94)

Since 2002, the applicant, Pirelli Tyre SpA, has been the proprietor of the EU figurative trade mark representing an L-shaped groove for tyres. [9] In 2012, the intervener, The Yokohama Rubber Co. Ltd, filed an application for a declaration of invalidity, [10] which was upheld by the Cancellation Division of the European Intellectual Property Office (EUIPO), on the ground that the contested sign consisted exclusively of the shape of the goods concerned which was necessary to obtain a technical result.

The Cancellation Division's decision was, however, annulled by the Board of Appeal of EUIPO which, upholding in part the appeal brought by the applicant, found that the Cancellation Division had erred in declaring the contested mark invalid for goods which were not covered by the application for a declaration of invalidity and that, consequently, the cancellation which it had declared went beyond the scope of that application.

On hearing the applicant's appeal against the Board of Appeal's decision, the General Court annuls in part the Board of Appeal's decision and examines whether the contested sign consists exclusively of the shape of the goods necessary to obtain a technical result. [11] To this end, it examines the nature of the contested sign and in particular its graphic representation.

In that regard, the Court points out, first, that the graphic representation of a trade mark must be self-contained, easily accessible and intelligible, in order that a sign may always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin. Second, it emphasises that the function of the graphic

[8] The two appeals against that judgment were dismissed by the judgment of 3 June 2021, Yokohama Rubber and EUIPO v Pirelli Tyre (C-818/18 P and C-6/19 P, *EU:C:2021:431*).

[9] The goods concerned were in Class 12 of the Nice Agreement.

[10] Based on Article 52(1)(a) of Regulation No 40/94, read in conjunction with Article 7(1)(b) or Article 7(1)(e)(ii) of that regulation.

[11] Within the meaning of Article 7(1)(e)(ii) of Regulation No 40/94.

representability requirement is, in particular, to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor.

2. Marks devoid of distinctive character

Judgment of 6 May 2003 (small plenary session), Libertel (C-104/01, [EU:C:2003:244](EU:C:2003:244))

(Trade marks – Approximation of laws – Directive 89/104/EEC – Signs capable of constituting a trade mark – Distinctive character – Colour per se – Orange)

Libertel is a company established in the Netherlands whose principal activity is the supply of mobile telecommunications services.

The Benelux-Merkenbureau (Benelux Trade Mark Office, 'BTMO') is the competent trade mark authority for the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands. Since 1 January 1996 the BTMO has had responsibility for examining filings of trade marks in the light of absolute grounds for refusal to register.

On 27 August 1996 Libertel filed with the BTMO an orange colour as a trade mark for certain telecommunications goods and services. In the space for reproducing the trade mark, the application form contained an orange rectangle and, in the space for describing the trade mark, the word orange without reference to any colour code.

By letter of 21 February 1997 the BTMO informed Libertel that it was provisionally refusing registration of the sign because it was devoid of any distinctive character within the meaning of Article 6bis(1)(a) of the Uniform Benelux Law on Trade Marks, as amended, (UBL)). [12] When Libertel objected to that provisional refusal, the BTMO, taking the view that there was no need to reconsider the refusal, served notice of final refusal by letter of 10 September 1997.

Pursuant to Article 6ter of the UBL, Libertel appealed against that refusal before the Gerechtshof te 's-Gravenhage (Regional Court of Appeal of The Hague, Netherlands), which was dismissed by judgment of 4 June 1998.

On 3 August 1998, Libertel appealed in cassation to the Hoge Raad der Nederlanden (Supreme Court of the Netherlands), which referred several questions to the Court of

[12] The Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands have set down their trade-mark laws in a common piece of legislation, the Uniform Benelux Law on Trade Marks (Trb. 1962, 58). That law was amended, with effect from 1 January 1996, by the Protocol of 2 December 1992 amending that law (Trb. 1993, 12) to implement the Directive in the legal order of those three Member States.

Justice for a preliminary ruling on the interpretation of, inter alia, Article 3(1)(b) of Directive 89/104.

The Court notes first of all that a colour per se is capable of constituting a trade mark within the meaning of Article 2 of Directive 89/104 provided that it is a sign which is capable of graphic representation and of distinguishing the goods or services of one undertaking from those of other undertakings. According to the Court, the large number and detailed nature of the obstacles to registration of a trade mark set out in Articles 2 and 3 of the Directive, and the wide range of remedies available in the event of refusal, indicate that the examination carried out by the competent authority at the time of the application for registration must not be a minimal one. It must be a stringent and full examination, in order to prevent trade marks from being improperly registered. For reasons of legal certainty and good administration, it is necessary to ensure that trade marks whose use could successfully be challenged before the courts are not registered.

The Court then points out that in assessing the potential distinctiveness, within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104 of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for other traders offering for sale goods or services of the same type as those in respect of which registration is sought. In the case of a colour per se, distinctiveness without any prior use, within the meaning of Article 3(1)(b) of Directive 89/104, is inconceivable save in exceptional circumstances. However, even if a colour per se does not initially have any such distinctive character, it may acquire such character in relation to the goods or services claimed following the use made of it, pursuant to paragraph 3 of that article. That distinctive character may be acquired, inter alia, after the normal process of familiarising the relevant public has taken place. The Court considers that a colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.

The Court further clarifies that a colour per se may be found to possess distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service for which registration is sought as originating from a particular undertaking and distinguishing that product or service from those of other undertakings. According to the Court, the fact that registration as a trade mark of a colour per se is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of the particular case, to assessing both the distinctive character, within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, of the colour in respect of which registration is sought, and whether its registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought. Finally, the Court states that in assessing whether a trade mark has distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, the competent authority for registering trade marks must carry out an examination by reference to the actual situation, taking account of all the circumstances of the case and in particular any use which has been made of the mark.

Judgment of 3 July 2003, Best Buy Concepts v OHIM (BEST BUY) (T-122/01, EU:T:2003:183)

(Community trade mark – Registration of a figurative mark containing the word sign BEST BUY – Absolute ground for refusal – Distinctive character – Article 7(1)(b) of Regulation (EC) No 40/94)

On 7 May 1999, the applicant filed an application under Council Regulation (EC) No 40/94 for registration of a Community figurative trade mark at OHIM. The trade mark in respect of which registration was sought consisted of the shape of a price tag in yellow (background) and black (letters, contour, circle), containing the word mark BEST BUY and the element '®'. The services for which registration of the trade mark was sought were in Classes 35, 37 and 42 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of Registration of Marks.

By decision of 19 November 1999, the examiner refused the application under Article 38 of Regulation No 40/94 on the ground that the mark applied for fell within the scope of Article 7(1)(b), (c) and (d) of Regulation No 40/94.

On 22 December 1999, the applicant filed a notice of appeal at OHIM against the examiner's decision, pursuant to Article 59 of Regulation No 40/94.

By decision of 21 March 2001, the Board of Appeal dismissed the appeal. It found, essentially, that the sign was devoid of any distinctive character, that it was descriptive and, therefore, came within the scope of Article 7(1)(b) and (c) of Regulation No 40/94.

On appeal against the Board of Appeal decision, which it dismisses, the General Court holds that the figurative mark, consisting of the shape of a coloured price tag containing the word sign BEST BUY and the element '®', in respect of which registration was sought for business management consultancy services (Class 35 of the Nice Agreement), installation and maintenance of equipment (Class 37) and technical advice and assistance for the establishment of specialised stores (Class 42), is devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94. That word mark, composed of ordinary English words which clearly indicate an advantageous relation between the price of the services covered by the application and their market value, is immediately perceived by the relevant public as a mere promotional formula or slogan rather than an indication of the commercial origin of the services. Similarly, coloured price tags are commonly used in trade for all kinds of goods and services, and the presence of elements such as ® alongside other elements, is not sufficient to confer distinctive character on a mark viewed in its entirety. Therefore, the mark applied for, as a whole, consists only of elements which, viewed separately, are devoid of any distinctive character for the marketing of the services concerned, without there being any interaction between those various elements capable of conferring distinctive character on the whole.

Judgment of 21 January 2010, Audi v OHIM (C-398/08 P, EU:C:2010:29)

(Appeal – Community trade mark – Regulation (EC) No 40/94 – Articles 7(1)(b) and 63 – Word mark Vorsprung durch Technik – Marks consisting of advertising slogans – Distinctive character – Application for a trade mark in respect of a large number of goods and services – Relevant public – Global assessment and reasoning – New documents)

On 30 January 2003, Audi applied to OHIM under Regulation No 40/94 for registration of the word mark Vorsprung durch Technik as a Community trade mark. The goods and services in respect of which registration of the mark was sought are in Classes 9, 12, 14, 16, 18, 25, 28, 35 to 43 and 45 of the Nice Agreement.

In his notice of grounds for refusal of 7 January 2004, the examiner found that the expression 'Vorsprung durch Technik' (meaning, inter alia, advance or advantage through technology) constituted, for a number of the goods and services in Classes 9, 12, 14, 25, 28, 37 to 40 and 42 relating to technology, an objective message which is perceived as descriptive advertising by the relevant consumer. Accordingly, the mark applied for is devoid of any distinctive character in respect of those goods and services. However, as regards the goods in Class 12, the examiner stated that registration of the mark could be accepted on account of the distinctive character which the mark had acquired in respect of motor vehicles and their components. In that regard, he referred to the Community word mark Vorsprung durch Technik, which had been registered on 27 April 2001 under No 621086 for those goods in Class 12.

By letter of 24 February 2004, Audi challenged the grounds set out by the examiner in that notice claiming, inter alia, that Community trade mark No 621086 had been registered not on account of distinctive character acquired through use, but on account of its inherently distinctive character. In a second notice of grounds for refusal, dated 30 June 2004, the examiner explained that, because of an oversight, Audi had not been informed, at the time of the examination of the application for registration of that mark, that the mark had been registered solely on account of its acquired distinctive character. However, as that application dated from year 1997, Audi would from now on be required to provide proof of the distinctive character acquired by the mark applied for in respect of all the goods and services covered, including those in Class 12.

By decision of 12 January 2005, the examiner refused, in part, the application for registration of the mark – in respect of some of the goods and services in Classes 9, 12, 14, 25, 28, 37 to 40 and 42 – on the same grounds as those set out in the notice of grounds for refusal of 7 January 2004. In that new refusal decision, he also stated that no evidence had been provided, in respect of the goods in Class 12, that distinctive character had been acquired.

By the contested decision, the Second Board of Appeal upheld Audi's appeal in respect of the goods in Class 12, on the ground that the earlier decision concerning registration of trade mark No 621086 was proof that the mark applied for had acquired distinctive character for vehicles and apparatus for locomotion by land. As to the remainder, in particular in relation to those other goods and services to which the examiner had raised objections, the appeal was rejected.

In that regard, the Board of Appeal held that the distinction drawn by the examiner between goods and services relating to technology was dubious. It explained that 'nearly all the goods and services relate, even if only remotely, to technology. Technology also plays an important role in the clothing sector. A manufacturer of such goods whose technology is advanced has a great advantage as compared with competing businesses. The slogan "Vorsprung durch Technik" conveys an objective message to the effect that technological superiority enables better goods and services to be manufactured and supplied. A combination of words which does no more than convey that banal objective message is, in principle, devoid of distinctive character. Given that, apart from the goods in Class 12, the applicant has provided no evidence that the slogan "Vorsprung durch Technik" has become a trade mark in the minds of the public, the application must be refused in so far as it relates to goods and services in other classes'.

By the judgment under appeal, the General Court dismissed the action brought by Audi against the contested decision.

Following an appeal by Audi, the Court of Justice upheld the appeal against the contested judgment.

In that regard, it holds, in the first place, that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 on the Community trade mark. The laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.

In the second place, the Court considers that an advertising slogan cannot be required to display 'imaginativeness' or even 'conceptual tension which would create surprise and so make a striking impression' in order for such a slogan to have the minimum degree of distinctiveness required under Article 7(1)(b) of Regulation No 40/94.

As regards a mark which can have a number of meanings, or can constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, can be easily remembered, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.

In the third place, the Court notes that marks composed of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message. Such marks are not, by virtue of that fact alone, devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

Thus, in so far as those marks are not descriptive for the purposes of Article 7(1)(c) of the regulation, they can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public.

Finally, in the fourth place, the Court points out that the slogan 'Vorsprung durch Technik', for which registration is sought for 'Vehicles'; apparatus for locomotion by land, air or water' in Class 12 of the Nice Agreement and for goods and services in Classes 9, 14, 16, 18, 25, 28, 35 to 43 and 45, is not devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 on the Community trade mark.

Even if it were to be supposed that the slogan 'Vorsprung durch Technik' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.

That message does not follow obviously from the slogan in question. The combination of words 'Vorsprung durch Technik' (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a causal link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, inasmuch as it is a widely known slogan which has been used by the applicant for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by the applicant also makes it easier for that public to identify the commercial origin of the goods or services covered.

Judgment of 25 November 2020, Brasserie St Avold v EUIPO (Shape of a dark bottle) (T-862/19, EU:T:2020:561)

(EU trade mark – International registration designating the European Union – Three-dimensional sign – Shape of a dark bottle – Absolute ground for refusal – No distinctive character – Article 7(1)(b) of Regulation (EU) 2017/1001)

Brasserie St Avold designated the European Union in the international registration of a three-dimensional sign. The sign consists of the three-dimensional representation of a dark bottle with a cap seal. A white label is wrapped in an irregular manner around the lower part of the bottle, with the exception of a peak that points upwards and does not follow the shape of the body of the bottle in that part. Protection of the trade mark was sought for beverages. EUIPO refused protection of the international registration on the ground that the sign was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation 2017/1001. [13]

The General Court dismisses the action for annulment of EUIPO's decision. It clarifies the definition of the norm and customs of the sector for assessing whether three-dimensional marks depicting the shape of the product have distinctive character.

First of all, the Court recalls that, because the packaging of a liquid product represents a necessity for its commercialisation, the average consumer assigns, first of all, only that function. Only a trade mark which departs significantly from the norm or customs of the sector is not devoid of any distinctive character. Thus, where a three-dimensional trade mark consists of the shape of the product in respect of which registration is sought or of the shape of its packaging, the mere fact that that shape is a variant of a common shape of that type of product or of its packaging is not sufficient to establish that the mark is not devoid of any distinctive character.

Next, the Court finds that EUIPO had established that the norm and customs in the beverages sector were characterised by variety of shapes of labels and of methods of positioning them on bottles. The Court then clarifies that even if most labels of the goods in question are rectangular in shape, affixed in their entirety to part of the cylindrical body of the bottle, the norm and customs of the sector cannot be reduced to the single shape that is statistically the most widespread, but include all of the shapes which the consumer is used to seeing on the market.

[13] 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).

Lastly, the Court points out that the label at issue is only a possible variant of shapes which already exist. It does not diverge significantly from the norm or customs of the sector. The Court therefore holds that the sign at issue is not capable of designating the origin of the goods in question. It therefore does not have the required minimum degree of distinctive character.

Judgment of 7 July 2021, Ardagh Metal Beverage Holdings v EUIPO, (Combination of sounds on opening a can of soft drink) (T-668/19, EU:T:2021:420)

(EU trade mark – Application for EU trade mark consisting of a combination of sounds on opening a can of soft drink – Absolute ground for refusal – No distinctive character – Article 7(1)(b) of Regulation (EU) 2017/1001 – Article 95(1) of Regulation 2017/1001)

Ardagh Metal Beverage Holdings GmbH & Co. KG filed an application for registration of a sound sign as an EU trade mark with EUIPO. That sign, submitted as an audio file, recalls the sound made by a drinks can being opened, followed by a silence of approximately one second and a fizzing sound lasting approximately nine seconds. Registration was sought in respect of various drinks and metal containers for storage or transport.

EUIPO rejected the application for registration on the ground that the mark applied for was not distinctive.

In its judgment, the Court dismisses the action brought by Ardagh Metal Beverage Holdings and rules for the first time on the registration of a sound mark submitted in audio format. It clarifies the criteria for assessing the distinctive character of sound marks and the perception of those marks in general by consumers.

First of all, the Court recalls that the criteria for assessing the distinctive character [14] of sound marks are not different from those applicable to the other categories of marks and that a sound mark must have a certain resonance which enables the target consumer to perceive it as a trade mark and not as a functional element or as an indicator without any inherent characteristics. [15] Thus, the consumer of the goods or services in question must, by the perception alone of the mark, without its being combined with other elements such as, inter alia, word or figurative elements, or even another mark, be able to associate it with their commercial origin.

Next, in so far as EUIPO applied by analogy the case-law [16] according to which only a mark which departs significantly from the norm or customs of the sector is not devoid of distinctive character, the Court emphasises that that case-law was developed in respect of

[14] Within the meaning of Article 7(1)(b) of Regulation 2017/1001.

[15] Judgment of 13 September 2016, Globo Comunicação e Participações v EUIPO (Sound mark) (T-408/15, *EU:T:2016:468*, paragraphs 41 and 45).

[16] See, in particular, judgment of 7 October 2004, Mag Instrument v OHIM (C-136/02 P, *EU:C:2004:592*, paragraph 31).

three-dimensional marks consisting in the shape of the product itself or of its packaging, when there are norms or customs of the sector relating to that shape. In such circumstances, the consumer concerned, who is accustomed to seeing one or several shapes corresponding to the norm or customs of the sector will not perceive the three-dimensional mark as an indication of the commercial origin of the goods if its shape is identical or similar to the usual shape or shapes. The Court adds that that case-law does not establish any new criteria for assessing the distinctive character of a mark, but merely specifies that, in the context of the application of those criteria, the perception of the average consumer is not necessarily the same in the case of a three-dimensional mark as in the case of a word, figurative or sound mark, which consists of a sign independent of the exterior appearance or shape of the goods. Consequently, the Court holds that that case-law relating to three-dimensional marks cannot, in principle, be applied to sound marks. However, even though EUIPO incorrectly applied that case-law, the Court states that that error is not such as to vitiate the reasoning set out in the contested decision, which is also based on another ground.

Regarding that other ground, based on the perception of the mark applied for by the relevant public as being a functional element of the goods in question, the Court observes, first, that the sound produced by the opening of a can will indeed be considered, having regard to the type of goods, to be a purely technical and functional element. The opening of a can or bottle is inherent to a technical solution connected to the handling of drinks in order to consume them, and such a sound will therefore not be perceived as an indication of the commercial origin of those goods. Secondly, the relevant public immediately associates the sound of fizzing bubbles with drinks. In addition, the Court observes that the sound elements and the silence of approximately one second, taken as a whole, do not have any inherent characteristic which would make it possible for them to be perceived by that public as being an indication of the commercial origin of the goods. Those elements are not resonant enough to distinguish themselves from comparable sounds in the field of drinks. Therefore, the Court confirms EUIPO's findings relating to the lack of distinctive character of the mark applied for.

Last, the Court refutes EUIPO's finding that it is unusual on the market for drinks and their packaging to indicate the commercial origin of a product using sounds alone on the ground that those goods are silent until they are consumed. The Court points out that most goods are silent in themselves and produce a sound only when they are consumed. Thus, the mere fact that a sound is made only on consumption does not mean that the use of sounds to indicate the commercial origin of a product on a specific market is still unusual. The Court explains nonetheless that any error on EUIPO's part in that regard does not lead to the annulment of the contested decision, because it did not have a decisive influence on the operative part of that decision.

Judgment of 13 November 2024, Administration of the State Border Guard Service of Ukraine v EUIPO (RUSSIAN WARSHIP, GO FK YOURSELF) (T-82/24, EU:T:2024:821)**

*(EU trade mark – Application for EU figurative mark RUSSIAN WARSHIP, GO F**K YOURSELF – Absolute ground for refusal – No distinctive character – Article 7(1)(b) of Regulation (EU) 2017/1001 – Political slogan – Equal treatment – Principle of sound administration – Article 71(1) of Regulation 2017/1001)*

By its judgment, the General Court addresses, for the first time, the question of the possibility of registering a 'political slogan' as a trade mark.

A Ukrainian border guard, the predecessor-in-title to the applicant, Administration of the State Border Guard Service of Ukraine, filed an application with EUIPO for registration of the figurative sign 'RUSSIAN WARSHIP, GO F**K YOURSELF' as an EU trade mark for various goods and services. [17] The examiner rejected that application for registration in its entirety on the basis of Article 7(1)(f) of Regulation 2017/1001, according to which trade marks which are contrary to public policy or to accepted principles of morality must not be registered. The applicant filed a notice of appeal with EUIPO against the examiner's decision. By the contested decision, [18] the Board of Appeal dismissed the appeal on the ground that the mark applied for was devoid of any distinctive character in respect of the goods and services at issue and therefore had to be refused registration pursuant to Article 7(1)(b) of Regulation 2017/1001.

The Court notes that the applicant submits unsuccessfully that the Board of Appeal erred in classifying the mark applied for as a 'political slogan'.

The phrase in the mark applied for had been widely used, immediately after its first use, in order to rally support for Ukraine and had thus become, very quickly, a symbol of Ukraine's fight against the aggression of the Russian Federation. Accordingly, that phrase was used in a political context, repetitively and with the aim of expressing and promoting support to Ukraine. That situation corresponds perfectly to the definition of the expression 'political slogan' put forward by the applicant itself in its application, namely, an expression, used in a political or social context, repetitive of an idea or purpose, with the goal of persuading the public or a target group within it.

The phrase used in the mark applied for has been used very intensively in a non-commercial context and will necessarily be associated very closely with that context by the relevant public. The phrase used in the mark applied for very quickly became one of the symbols of Ukraine's fight against Russian aggression, associated with a soldier of the Ukrainian army and, thus, with Ukraine. Given the extent of the media coverage of that

[17] More specifically, the mark applied for covered goods and services in Classes 9, 14, 16, 18, 25, 28 and 41 of the Nice Agreement.

[18] Decision of the First Board of Appeal of EUIPO of 1 December 2023 (Case R 438/2023-1).

event, that phrase will be associated with that recent historical moment, well known to the average EU consumer.

In that regard, the Court considers that the Board of Appeal did not err in law in finding that the general principle that the relevant public is not very attentive with regard to a sign which does not immediately indicate the origin of the goods and services concerned, given that they would not perceive it or mentally register it as a trade mark, also applied to signs whose main message was of a political nature.

In view of the essential function of a trade mark, namely that of identifying the origin of the goods or services covered by it, a sign is incapable of fulfilling that function if the average consumer does not perceive, in its presence, the indication of the origin of the goods or services, but only a political message.

As regards the obligation to state reasons, the Court points out that, where the same ground for refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all of the goods or services concerned. The case-law has indeed made clear that such a power extends only to goods and services which are interlinked in a sufficiently direct and specific way, to the point where they form a sufficiently homogeneous category or group of goods or services. Nevertheless, it has stated that it is necessary to take into account, in order to determine whether the goods and services are interlinked in a sufficiently direct and specific way and can be placed in sufficiently homogenous categories and groups, the fact that the objective of that exercise is to enable and facilitate the assessment in concreto of the question whether or not the mark concerned by the application for registration comes under one of the absolute grounds for refusal. In addition, the placement of the goods and services at issue in one or more groups or categories must be carried out in particular on the basis of the characteristics which are common to them and which are relevant for the analysis of whether or not a specific absolute ground for refusal may apply to the mark applied for in respect of those goods and services. It follows that such an assessment must be carried out in concreto for the examination of each application for registration and, as the case may be, for each of the different absolute grounds for refusal which may apply.

In the present case, the Board of Appeal found, in the contested decision, that the mark applied for would not be perceived by the relevant public as indicating a commercial origin. Furthermore, it stated that the phrase in the mark applied for would first and foremost be interpreted as a political message and that that perception would be identical for all the goods or services covered by that mark. It follows that the Board of Appeal found that the goods and services covered by the mark applied for form a sufficiently homogeneous group, having regard to the absolute ground for refusal which, in its view, has caught registration of that mark.

Given that the Board of Appeal was right in finding that the mark applied for would not be perceived by the relevant public as indicating a commercial origin, but as a political message promoting support for Ukraine’s fight against the military aggression of the

Russian Federation, it could validly group all the goods and services covered by the mark applied for in a single category, despite having different inherent characteristics.

Therefore, in view of the specific nature of the mark applied for and its identical perception by the relevant public with regard to all the goods and services covered by the application for registration, the Court held that it was without committing an error of assessment that the Board of Appeal found that those goods and services form part of a single group to which the ground for refusal, which it upheld, applies in the same way and that it was right to find that the mark applied for is devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation 2017/1001.

Judgment of 10 September 2025, BVG v EUIPO (Sound of a melody) (T-288/24, EU:T:2025:847)

(EU trade mark – Application for an EU trade mark consisting of a sound of a melody – Absolute ground for refusal – Distinctive character – Article 7(1)(b) of Regulation (EU) 2017/1001)

In its judgment, the Court annuls the decision of the Board of Appeal of EUIPO [19] on the ground that the board did not correctly assess the distinctive character of an EU trade mark for which registration was sought in respect of a sound sign consisting of a sound of a melody in the light of Article 7(1)(b) of Regulation 2017/1001.

The applicant, Berliner Verkehrsbetriebe (BVB), applied for registration of a trade mark consisting of a sound of a melody in relation to certain transport services. [20] Following the examiner's rejection of that request, the applicant filed a notice of appeal with EUIPO.

The Board of Appeal found that the mark applied for lacked distinctive character. Given that it was a two-second sound sign consisting of a simple sequence of four different perceptible sounds, that mark was so short and banal that it had no resonance or recognisability and was incapable of being recognised by consumers as an indication of the commercial origin of the services concerned. It would simply be perceived as a functional sound element intended to attract the listener's attention.

The applicant brought an action against that decision before the General Court.

The Court finds that several factors permit the inference that the characteristics of the mark applied for in terms of duration and resonance make it possible to establish the existence rather than the lack of distinctive character within the meaning of Article 7(1)(b) of Regulation 2017/1001 and the related case-law.

[19] Decision of the Fifth Board of Appeal of EUIPO of 2 April 2024 (Case R 2220/2023-5).

[20] Those services are in Class 39 of the Nice Agreement and correspond to the following description: 'Transport; passenger transport; wrapping and packaging services; storage; arranging of transportation for travel tours'.

First, as regards the customs of the economic sector at issue, it is well known that operators in the transport sector increasingly use 'jingles', that is to say, short sound patterns, in order to create a sound identity recognisable by the public – an audio equivalent of the visual identity of a mark – for the goods and services associated with it. Those jingles allow the listeners' attention to be captured in environments which can sometimes be noisy, such as in airport terminals or on the platforms of train stations, and to introduce or accompany messages addressed to the target public for advertising purposes or in connection with associated services.

Second, the sound of the melody of which the mark applied for consists does not have a direct link with the services covered and does not appear to be dictated by technical or functional considerations. In addition, it has not been established that that sound is already known to the public, which gives rise to the presumption that it is an original work. In that context, it may be considered that its purpose is rather to serve as a jingle, that is to say, as a short, striking sound sequence likely to be remembered. Moreover, that assessment is confirmed by EUIPO's decision-making practice and the EUIPO examination guidelines in relation to sound marks, which may constitute a reference source.

In view of the characteristics of the mark applied for in terms of duration, melody used and perceptible sounds, and the various indications provided by EUIPO in the past regarding the role played by those characteristics in the assessment of the distinctive character of a sound mark for which registration is sought, the Board of Appeal's assessment is incorrect in the light of both the customs of the sector concerned and the elements which characterise the mark applied for. Neither the duration of the mark applied for nor its alleged simplicity or banality, which does not in itself prevent the corresponding melody from being recognised, are obstacles which are sufficient, in themselves, to justify the lack of any distinctive character.

Thirdly, the Board of Appeal erred in finding that the mark applied for had merely a functional role and that it was customary to play a short sequence of sounds before loudspeaker announcements providing information on means of transport in order to attract passengers' attention. Even if it were necessary to envisage one of the potential uses of the mark applied for, that is to say, to refer to its use in a station to announce the associated transport service, such use, even if it has a functional role, would not in any way prevent the mark applied for from performing its function of indicating the commercial origin of that service.

Fourthly, as regards the other services covered by the mark applied for, which did not directly concern transport, but aspects associated with it, the Court held that it was difficult to understand from the Board of Appeal's findings, firstly, to which aspects of those services the sound of the melody constituting that mark may be linked and, secondly, how the fact that the sound sign applied for may be used in advertising those services militated against its registration as a trade mark.

In the light of those considerations, the Court concludes that the Board of Appeal did not correctly assess the distinctive character of the mark applied for.

3. Descriptive trade marks

Judgment of 23 October 2003 (full court), OHIM v Wrigley (C-191/01 P, EU:C:2003:579)

(Appeal – Community trade mark – Regulation (EC) No 40/94 – Absolute ground for refusal to register – Distinctive character – Marks consisting exclusively of descriptive signs or indications – the word DOUBLEMINT)

In 1996, Wm Wrigley Jr. Company ('Wrigley') applied to OHIM for registration of the term 'Doublemint' as a Community trade mark for chewing gum.

The examiner at OHIM rejected that application, following which Wrigley brought an appeal before OHIM. However, the Board of Appeal dismissed the appeal on the ground that the word Doublemint, a combination of two English words with no additional fanciful or imaginative elements, was descriptive of certain characteristics of chewing gum, namely their mint-based composition and their mint flavour, and that it could therefore not be registered as a Community trade mark by virtue of Article 7(1)(c) of Regulation No 40/94.

Wrigley's appeal against that decision to the Court of First Instance was upheld. The Court concluded that the word Doublemint, when applied to chewing gum, had an ambiguous and suggestive meaning open to various interpretations and did not enable the public concerned immediately and without further reflection to detect the description of the characteristic of those goods. Since it was not exclusively descriptive, the term could not, according to the Court of First Instance, be refused registration.

By that judgment, the Court of Justice upholds the appeal brought by OHIM against the judgment of the General Court and sets aside the judgment of the Court of First Instance.

First of all, the Court recalls that Article 7(1)(c) of Regulation No 40/94 on the Community trade mark provides that trade marks which 'consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service' are not to be registered.

Next, the Court holds that, in order for OHIM to refuse to register a trade mark under that article, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.

Lastly, the Court clarifies that, interpreting Article 7(1)(c) as precluding the registration of trade marks which are 'exclusively descriptive' of the goods or services in respect of which registration is sought, or of their characteristics, implies applying a test which is not the test laid down by that provision and is beyond its scope.

Judgment of 12 January 2005, Deutsche Post EURO EXPRESS v OHIM (EUROPREMIUM) (T-334/03, EU:T:2005:4 [21])

(Community trade mark – EUROPREMIUM – Absolute ground for refusal – Descriptive nature – Article 7(1)(c) of Regulation (EC) No 40/94)

Deutsche Post EURO EXPRESS GmbH filed an application with OHIM for registration of the word sign EUROPREMIUM as a Community trade mark. That application having been rejected, Deutsche Post EURO EXPRESS filed notice of appeal against the examiner's decision.

The Board of Appeal of OHIM dismissed the appeal on the ground that the mark EUROPREMIUM was likely to be perceived by consumers as an indication of the notable quality and European origin of the goods and services covered by the trade mark application.

Following an appeal by Deutsche Post EURO EXPRESS against that latter decision, which it annulled, the Court of First Instance was called upon to assess the descriptive character of the sign applied for. [22]

In the first place, the Court holds that the registration of a Community trade mark consisting of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded, as such, by reason of such use on the sole condition that the mark in question may be perceived immediately as an indication of the commercial origin of the goods or services covered, in order to enable the relevant public, without any possibility of confusion, to distinguish the goods or services of the proprietor of the mark from those of a different commercial origin.

[21] The appeal against that judgment was struck out by order of the President of the Court on 14 December 2005, OHIM v Deutsche Post EURO EXPRESS (C-121/05 P, *EU:C:2005:767*).

[22] Within the meaning of Article 7(1)(c) of Regulation No 40/94.

That ability of such a sign to be perceived as an indication of the commercial origin of the goods and services must be assessed in the context of Article 7(1)(b) of Regulation No 40/94.

By contrast, to come within the scope of Article 7(1)(c) of Regulation No 40/94, a trade mark must serve to designate in a specific, precise and objective manner the essential characteristics of the goods and services at issue.

In the second place, the Court notes that it has not been shown that the word sign EUROPREMIUM, for which registration as a Community trade mark is sought, inter alia, for goods intended for packaging, storage or transport, advertising, management or business assistance services or transport and storage services in Classes 16, 20, 35 and 39 of the Nice Agreement and which could be understood by the average English-speaking consumer as a reference to high-quality European goods and services, may serve directly to designate, within the meaning of Article 7(1)(c) of Regulation No 40/94, those goods and services.

Firstly, the sign at issue is not composed of elements descriptive of the goods and services referred to since the prefix 'euro' does not designate them either directly or by reference to one of their essential characteristics and the term 'premium' is merely a laudatory term evoking a characteristic that the applicant was seeking to attribute to its own goods, yet without informing consumers of the specific and objective characteristics of the goods or services offered.

Secondly, it had not been established that that the term 'EUROPREMIUM', taken as a whole, was or could be a generic or usual name to identify or distinguish the goods or services concerned.

Judgment of 10 March 2011 (C-51/10, Agencja Wydawnicza Technopol v OHIM, ECLI:EU:C:2011:139)

(Appeal – Community trade mark – Sign composed exclusively of numerals – Application for registration of the sign '1000' as a mark in respect of brochures, periodicals and newspapers – Allegedly descriptive character of that sign – Criteria for the application of Article 7(1)(c) of Regulation (EC) No 40/94 – Obligation on OHIM to take into account its previous decision-making practice)

Agencja Wydawnicza Technopol sp. z o.o. ('Technopol') filed an application with OHIM for registration of the sign '1000' as a Community trade mark for brochures, periodicals and newspapers. That application was, however, rejected on the ground that the sign '1000' had no distinctive character and constituted a descriptive indication of the content or other characteristics of the goods concerned.

The appeal lodged by Technopol against the examiner's decision was dismissed by the Board of Appeal of OHIM, which found that the sign '1000' could be used to designate Technopol's publications and that, in any event, the sign was not distinctive since it would be perceived by consumers as praising the publications and not as indicating their provenance.

Technopol subsequently brought an appeal before the General Court, which was also dismissed. On appeal against the judgment of the General Court, which it dismissed, the Court had the opportunity to examine the criteria relating to the application of the absolute ground for refusal of registration relating to the descriptive character of a sign.

In the first place, the Court held that each of the grounds for refusal listed in Article 7(1) of Regulation No 40/94 must be interpreted in the light of the public interest underlying it. The general interest underlying Article 7(1)(c) of that regulation is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.

With a view to ensuring that the objective of free use is fully met, in order for OHIM to refuse to register a sign on the basis of Article 7(l)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It was sufficient that the sign could be used for such purposes. By the same token, the application of that ground for refusal did not depend on there being a real, current or serious need to leave a sign or indication free, and it was therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question. It was, furthermore, irrelevant whether there were other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration. It follows from the foregoing that the application of Article 7(1)(c) of the regulation does not require the sign at issue to be the usual means of designation.

Secondly, the Court held that the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 were also devoid of any distinctive character within the meaning of Article 7(1) (b) of the regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation, Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of the regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

In the third place, the Court points out that situations specifically covered by the ground for refusal set out in Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of which registration as a trade mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of the regulation, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, firstly, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in that provision are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. Consequently, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics.

Those specific points are of particular relevance as regards signs which are composed exclusively of numerals. Given that such signs are generally equated with numbers, one of the things that they can do, in trade, is to designate a quantity. Nevertheless, in order for a sign which is composed exclusively of numerals to be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 on the ground that it designates a quantity, it must be reasonable to believe that, in the mind of the relevant class of persons, the quantity indicated by those numerals characterises the goods or services in respect of which registration is sought.

In the fourth and final place, the Court observes that the rule laid down in Article 12(b) of Regulation No 40/94 does not have a decisive influence on the interpretation of the rule laid down in Article 7(1)(c) of the regulation. Article 12 of that regulation concerns the limits on the effects of a Community trade mark, whereas Article 7 of that regulation relates to the grounds for refusal to register signs as marks.

The fact that Article 12(b) of Regulation No 40/94 ensures that every trader may freely use indications relating to the characteristics of goods and services in no way limits the scope of Article 7(1)(c) of that regulation. On the contrary, that fact clearly discloses the need for the ground of refusal set out in Article 7(1)(c) of Regulation No 40/94 to be actually applied to any sign which may designate a characteristic of the goods or the services in respect of which its registration as a mark is sought.

Judgment of 25 October 2018, Devin v EUIPO – Haskovo (DEVIN) (T-122/17, EU:T:2018:719 [23])

(EU trade mark – Cancellation proceeding – European Union word mark DEVIN – Absolute ground for refusal – Descriptive character – Geographical name – Article 7(1)(c) of Regulation (EC) No 207/2009 (now Article 7(1)(c) of Regulation (EU) 2017/1001))

On 11 July 2014, the Haskovo Chamber of Commerce and Industry (HCCI, Haskovo Chamber of Commerce and Industry, Bulgaria) filed a request for a declaration of invalidity of the EU word mark DEVIN, belonging to Devin AD and registered by EUIPO in 2011 for goods in Class 32 of the Nice Agreement, and corresponding to non-beverages, including mineral water.

The Cancellation Division of EUIPO accepted the request for a declaration of invalidity based on Article 7(1)(c) of Regulation No 207/2009 [24] and declared the mark invalid in its entirety, taking the view that the mark consisted of a sign that could be used to designate the geographical origin of the goods. [25] The EUIPO Board of Appeal dismissed the appeal against that decision brought by DEVIN on the ground that the Bulgarian town of Devin was known to the general public in Bulgaria and a significant part of consumers in neighbouring countries such as Greece and Romania, especially as a spa town, and that the name of that town was linked by the relevant public with the designated goods in Class 32, especially mineral waters.

In its judgment, the Court annuls the decision of the EUIPO Board of Appeal and provides clarification on assessing the descriptive character of a sign consisting of a geographical name within the meaning of Article 7(1)(c) of Regulation No 207/2009.

As regards, more particularly, signs or indications that may serve to designate the geographical origin or destination of the categories of goods, or the place of performance of the categories of services, in respect of which a European Union trade mark has been applied for, the Court points out it is in the public interest that geographical names remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods or services concerned, and may also, in various ways, influence consumer preferences by, for instance, associating the goods or services with a place that may evoke positive feelings.

In this respect, firstly, the registration of geographical names as trade marks where they designate specified geographical locations which are already famous, or are known for the category of goods or services concerned, and which are therefore associated with that category in the mind of the relevant class of persons, is excluded as, secondly, is the

[23] The appeal against that judgment was dismissed by order of 11 July 2019, Haskovo v Devin (C-800/18 P, *EU:C:2019:606*).

[24] Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

[25] Within the meaning of Article 7(1)(c) of Regulation No 207/2009.

registration of geographical names which are liable to be used by undertakings and must remain available to such undertakings as indications of the geographical origin of the category of goods or services concerned.

However, in principle, Article 7(1)(c) of Regulation No 207/2009 does not preclude the registration of geographical names which are unknown to the relevant class of persons – or at least unknown as the designation of a geographical location – or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of goods or services concerned originates there.

Furthermore, as regards the assessment of the descriptive character of such a sign, the Court finds that EUIPO is required to establish that the geographical name is known to the relevant class of persons as the designation of a place. Furthermore, the name in question must suggest a current association, in the mind of the relevant class of persons, with the category of goods or services concerned, or else it must be reasonable to assume that such a name may, in the view of those persons, designate the geographical origin of that category of goods or services. In making that assessment, particular consideration should be given to the relevant class of persons' degree of familiarity with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods or services concerned.

In the present case, the Court holds that the word mark DEVIN is not descriptive of a geographical origin as regards the average consumer in the neighbouring countries of Bulgaria, namely Greece and Romania, or that of the other Member States of the European Union, with the sole exception of Bulgaria.

While the geographical name Devin is known to the relevant class of persons in Bulgaria, as regards the relevant class of persons in the other Member States of the European Union, the geographical name Devin is largely unknown to them or, at the very least, unknown as a designation of a geographical place.

The mere fact that the town of Devin has a detectable presence on the internet cannot suffice to establish that it would be known by a significant part of the relevant public of Greece and Romania. The existence of a 'tourist profile on the internet', in itself, does not suffice to establish the knowledge of a small town by the relevant public abroad. The average consumer of mineral water and beverages in the European Union does not have a high degree of specialisation in geography or tourism. The Board of Appeal, by wrongly focusing on foreign tourists, in particular Greeks or Romanians, who visit Bulgaria and Devin, did not take into consideration the entire relevant public, consisting of the average consumer of the European Union, in particular from Greece and Romania, but wrongly limited itself to a very small or minimal fraction of the relevant public, namely foreign tourists visiting Bulgaria or Devin, which in any case is negligible and cannot be held to be sufficiently representative given by the relevant public in the light of case-law. Accordingly, the Board of Appeal applied a wrong test, which led it to an incorrect factual assessment of the perception of the word 'devin' by the relevant public.

Concerning the availability of the geographical name Devin, it should be considered that a descriptive use of the name 'Devin' is permitted in order to promote the town as a tourist destination. Regulation No 207/2009 on the European Union trade mark provides, in the very definition of the exclusive right conferred by such a mark, safeguards to protect the interests of third parties. The name of the town of Devin remains available to third parties not only for descriptive use, such as the promotion of tourism in that town, but also as a distinctive sign in cases of 'due cause' and where there is no likelihood of confusion excluding the application of Articles 8 and 9 of Regulation No 207/2009. The general interest in preserving the availability of a geographical name such as that of the spa town of Devin can thus be protected by allowing descriptive uses of such names and by means of safeguards limiting the exclusive right of the proprietor of the contested mark, without requiring cancellation of that mark.

Judgment of 7 May 2019, Fissler v EUIPO (vita) T-423/18, EU:T:2019:291

(EU trade mark – Cancellation proceeding – European Union word mark DEVIN – Absolute ground for refusal – Descriptive character – Geographical name – Article 7(1)(b) and (c) of Regulation (EU) 2017/1001)

In the judgment in Fissler v EUIPO (vita) (T-423/18), delivered on 7 May 2019, the General Court annulled EUIPO's decision refusing registration of the word mark vita as an EU trade mark in respect of goods such as food processors, electric pressure cookers and household utensils. In the present case, EUIPO had refused registration of the mark in respect of goods in Classes 7, 11 and 21 (inter alia, electric food processors, electric pressure cookers and household utensils), on the grounds that that mark was descriptive and devoid of any distinctive character [Article 7(1)(c) and (b) of Regulation 2017/1001]. It had found, in particular, that, as the mark applied for was a Swedish term (vita is the determinate form and plural form of the word 'vit', which means 'white' in Swedish), the relevant public was the Swedish-speaking public in the European Union. EUIPO had essentially based its finding that the mark applied for is descriptive on two grounds. In the first place, it stated that the goods concerned are fairly usually available in white, although they are not most commonly available in that colour. In the second place, it stated that those goods are often referred to as 'vitvaror' ('white goods') in Swedish.

Regarding the more or less common use of the colour white in manufacturing the goods concerned, the Court found it necessary to ascertain whether such use may be categorised as a 'characteristic' of those goods for the purposes of the case-law. The Court pointed out that a sign can be refused registration on account of its descriptiveness (on the basis of Article 7(1)(c) of Regulation 2017/1001) only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics. Furthermore, although it is irrelevant whether such a characteristic is commercially essential or ancillary, a characteristic, within the meaning of that article, must nevertheless be 'objective' and 'inherent to the nature of that product' or service and 'intrinsic and permanent' with regard to that product or service.

In the present case, the Court stated that the colour white does not constitute an 'intrinsic' characteristic which is 'inherent to the nature' of the goods concerned (such as food processors, electric pressure cookers and household utensils), but a purely random and incidental aspect which only some of them may have and which does not, in any event, have any direct and immediate link with their nature. Such goods are available in a multitude of colours, among them the colour white, which is not more prevalent than the others. The mere fact that the goods concerned are more or less usually available in white, among other colours, is not disputed, but is irrelevant, since it is not 'reasonable', within the meaning of the case-law, to believe that for that reason alone the colour white will actually be recognised by the relevant public as a description of an intrinsic characteristic which is inherent to the nature of those goods. The term 'vita' is thus not descriptive of a characteristic of the goods in question and is not therefore covered by the ground for refusal set out in Article 7(1)(c) of Regulation 2017/1001.

Furthermore, the Court pointed out that the public interest underlying Article 7(1)(b) of Regulation 2017/1001, which precludes registration of a mark which is devoid of any distinctive character, concerns consumer protection by enabling the consumer, without any possibility of confusion, to distinguish the origin of the goods or services covered by the mark, in accordance with its essential function as an indication of origin, whereas the public interest underlying the rule set out in Article 7(1)(c) of Regulation 2017/1001, which precludes registration of a descriptive mark, is focused on the protection of competitors against a risk of monopolisation by a single trader of indications which are descriptive of characteristics of such goods or services. Accordingly, a mark which is not descriptive, as in the present case, is not, for that reason, distinctive.

Taking the view that the relevant public will not understand the mark applied for as a simple statement of fact according to which those goods are available in white, but rather as an indication of their origin, the Court held, in essence, that that mark was distinctive.

In view of all of the foregoing, the Court upheld the two pleas in law and annulled the decision of EUIPO.

Judgment of 16 July 2025, Iceland Foods v EUIPO – Íslandsstofa (Promote Iceland) and Others (ICELAND) (T-105/23, EU:T:2025:729)

(EU trade mark – Invalidity proceedings – EU word mark ICELAND – Absolute grounds for invalidity – Descriptive character – Article 7(1)(c) of Regulation (EC) No 40/94 (now Article 7(1)(c) of Regulation (EU) 2017/1001))

In its judgments, the General Court rules on the descriptive character of two signs incorporating the name of a European country (ICELAND) and dismisses the actions brought against the decisions of the Grand Board of Appeal of EUIPO on the ground that those signs are descriptive of the geographical origin of the goods and services to which they relate or of their characteristics.

Iceland Foods Ltd, the applicant, submitted to EUIPO applications for registration of the word sign ICELAND and the figurative sign Iceland in respect of various goods and services, on 19 April 2002 and 12 February 2013 respectively. Subsequently, two applications for a declaration of invalidity of the marks at issue were filed with the Cancellation Division of EUIPO in respect of a number of the goods and services covered by those marks. [26] The Cancellation Division upheld those applications for a declaration of invalidity in respect of all the goods and services concerned.

The applicant accordingly filed a notice of appeal against each of the Cancellation Division's decisions. By decisions of 15 December 2022, the Grand Board of Appeal dismissed those actions ('the contested decisions'). The Grand Board of Appeal found that the marks at issue were perceived by the relevant public, namely the English-speaking general public of the European Union, as an indication that the goods and services covered by them came from Iceland and that they had to be regarded as descriptive. [27] After noting that it was sufficient that one of the absolute grounds for refusal applied in order for the signs at issue not to be registrable as EU trade marks, the Grand Board of Appeal found that, in any event, if the marks at issue were also to be examined in the light of their distinctive character, [28] it would inevitably be found that they had none. [29]

The applicant accordingly brought an action before the Court against each of the contested decisions. [30]

The Court recalls, at the outset, that there are two situations in which it is not permissible to register geographical names. The first concerns the registration of geographical names as trade marks where they designate specific geographical locations which are already famous or known for the category of goods or services concerned and which are therefore associated with that category of goods or services by the relevant class of persons. The second concerns the registration of geographical names which are liable to

[26] The goods and services are in Classes 7, 11, 16, 29 to 32 and 35 and Classes 29, 30 and 35 of the Nice Agreement.

[27] Within the meaning of Article 7(1)(c) of Regulation No 40/94, now Article 7(1)(c) of Regulation No 207/2009, itself replaced by Article 7(1)(c) of Regulation 2017/1001.

[28] Within the meaning of Article 7(1)(b) of Regulation No 40/94, cited above, subsequently Article 7(1)(b) of Regulation No 207/2009, cited above, which was itself replaced by Article 7(1)(b) of Regulation 2017/1001, cited above.

[29] The claim of the applicants for a declaration of invalidity that the marks at issue were contrary to public policy (within the meaning of Article 51(1)(a) of Regulation No 40/94 (subsequently Article 52(1)(a) of Regulation No 207/2009, now Article 59(1)(a) of Regulation 2017/1001) in conjunction with Article 7(1)(f) Regulation No 40/94 (subsequently, Article 7(1)(f) of Regulation No 207/2009, now Article 7(1)(f) of Regulation 2017/1001)), was rejected by the Grand Board of Appeal as inadmissible on account of its late submission. Accordingly, that issue was not examined by either the Board of Appeal or, subsequently, the Court.

[30] Cases Iceland Foods v EUIPO – Íslandsstofa (Promote Iceland) and Others (ICELAND) (T-105/23) concerning the word mark ICELAND and Iceland Foods v EUIPO – Icelandic trade mark (Iceland) (T-106/23) concerning the figurative mark Iceland.

be used by undertakings and must remain available to such undertakings as indications of geographical origin of the category of goods or services concerned.

In addition, the Court finds that the assessment of the descriptive character of the marks at issue requires taking into account a set of relevant factors such as the knowledge of Iceland and of its characteristics and the link between the categories of goods and services and the marks at issue.

In that regard, it observes that the marks at issue refer to the name of a country which is located in Europe, is composed of a territory which is, admittedly, relatively sparsely populated, but which has a surface area larger than that of some Member States of the European Union and of the European Economic Area (EEA).

The Court accordingly notes that the word 'Iceland' was recognised by a significant part of the relevant public, which consists of the English-speaking general public of the European Union.

Furthermore, the Court confirms that the evidence on which the Grand Board of Appeal relied establishes, first, that Iceland was an environmentally friendly country, on account of, in particular, multiple geothermal and hydroelectric power stations, secondly, that Iceland was a popular tourist destination and, thirdly, that Iceland offered a wide range of goods and services, while maintaining, in respect of those goods and services, significant commercial relationships with the EEA countries.

The Court also notes that it is appropriate to take into account a set of circumstances, existing on the date of the application for registration of each mark at issue, and to do so with a prospective outlook and without being limited to only the question of the 'reputation' which Iceland enjoyed among the relevant public, or which it was liable to enjoy in the future, in relation to the goods and services covered by the marks at issue. In addition, the various characteristics of Iceland are significant for the purpose of ascertaining the extent to which the geographical origin of the goods or services in question is likely to be relevant, in the mind of the relevant class of persons, for the assessment of the quality or other characteristics of the goods or services concerned. For those reasons, the Court finds that the Grand Board of Appeal was correct to take into account the economic prosperity, including the assessment of gross domestic product (GDP), skilled workforce and even the presence of various industries, since those factors could make it possible to ascertain whether Iceland was likely to become famous or known as a place of geographical origin in relation to the goods and services in question.

Next, as regards the goods including foodstuffs of plant and animal origin and liquids intended for human consumption, the Court finds that the marks at issue have a descriptive character in respect of those goods. Accordingly, on the date of registration of each of the marks at issue, Iceland produced and exported such goods and was capable of producing others, with the result that where one of those products is marketed under one of the marks at issue, it may be perceived as originating from that country. Furthermore, assuming that the present export of foodstuffs by Iceland is not a relatively significant part of its exports in general, the Court finds that that claim does not make it possible to call into question the descriptive link between the marks and the goods concerned in so far as that claim does not take into account, from a prospective viewpoint, the link which may reasonably be established between the mark at issue and the goods concerned.

Lastly, the Court notes that the Grand Board of Appeal carried out a detailed analysis of the descriptive character of the marks at issue in respect of all of the goods and services in question. In addition, as regards the figurative mark Iceland, [31] it adds that neither the typography nor the colour of the mark at issue give it an unusual or striking effect. The word element of that mark is represented in a font of standard white letters, without any typographical specificity. While, admittedly, it is positioned on a red, orange and yellow rectangular background, of which the yellow and orange effect gives it the impression of having a slightly faded look, the coloured background, in particular in orange and yellow colours, is, in essence, common in the advertising and on packaging, with the result that the consumer may regard it as a decorative element. In those circumstances, the figurative elements of the mark at issue served only to highlight the word element of that mark and did not alter in any way the descriptive content conveyed by the latter element.

As regards Article 12(b) of Regulation No 40/94, [32] concerning the limitation of the effects of the mark, which would allow Icelandic entities to use the name 'Iceland', the Court recalls that that provision is intended, inter alia, to resolve the problems posed by registration of a mark which consists wholly or partly of a geographical name and does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters. In addition, the fact that Article 12(b) of Regulation No 40/94 ensures that every trader may freely use indications concerning the characteristics of goods and services does not guarantee the protection of the public interest underlying Article 7(1)(c) of that regulation. On the contrary, that fact clearly discloses the need for the ground of refusal set out in Article 51(1)(a), read in conjunction with Article 7(1)(c), of Regulation No 40/94 – which, moreover, is an absolute ground for refusal – to be actually applied to any sign which may designate a characteristic of the goods or the services in respect of which the mark is registered.

[31] Judgment of 16 July 2025, Iceland Foods v EUIPO – Icelandic trade mark (Iceland) (T-106/23, *EU:T:2025:730*).

[32] Now Article 12(b) of Regulation No 207/2009, now Article 14(b) of Regulation 2017/1001.

4. Marks composed exclusively of signs or indications which have become customary

Judgment of 16 March 2006, Telefon & Buch/OHMI v Herold Business Data (WEISSE SEITEN) (T-322/03, EU:T:2006:87)

(Community trade mark – Admissibility of the action – Unforeseeable circumstances – Application for a declaration of invalidity – Article 51(1)(a) of Regulation (EC) No 40/94 – Word mark WEISSE SEITEN – Absolute grounds for refusal – Article 7(1)(b) to (d) of Regulation No 40/94)

Telefon & Buch Verlagsgesellschaft mbH filed an application with OHIM for registration of the term WEISSE SEITEN for various products. [33] Herold Business Data GmbH & Co. KG, applied for a declaration of invalidity of that registration on the basis of Article 7(1)(b) to (d), and (g) of Regulation No 40/94. That application was partially granted by the Cancellation Division. The Board of Appeal, for its part, declared the mark invalid on the ground that, as regards goods in Classes 9 and 16, it consisted exclusively of signs or indications which had become customary in the current language or in the bona fide and established practices of the trade. In addition, it took the view that Article 7(1)(b) and (c) of Regulation No 40/94 also applied to all the goods and services covered.

Hearing an action against the latter decision, which it dismisses, the Court points out, firstly, that the question whether a mark is customary can be assessed only, first, by reference to those goods or services in respect of which registration is sought, even though the provision in question does explicitly refer to those goods and services, and, secondly, on the basis of the target public's perception of the mark. Next, with regard to the target public, it states that account must be taken of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question Lastly, it points out that signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and therefore do not fulfil the essential function of a trade mark.

In the light of those considerations, the Court considers that, in the present case, the term WEISSE SEITEN should not have been registered as a Community trade mark for goods in Classes 9 and 16 of the Nice Agreement, on account of the existence of the absolute ground for refusal referred to in Article 7(1)(d) of Regulation No 40/94, in so far as it has been shown that, for the average German-speaking consumer, the term 'weiße Seiten' had become customary, on the date on which the application for registration of the mark

[33] The goods concerned were in Classes 9, 16, 41 and 42 of the Nice Agreement.

was filed, as a generic name for the telephone directory of private individuals not only in hard copy but also in electronic form.

Judgment of 18 May 2018, Mendes v EUIPO – Actial Farmaceutica (VSL#3) (T-419/17, EU:T:2018:282)

(EU trade mark – Revocation proceedings – EU word mark VSL#3 – Trade mark having become a common name in the trade for a product or service for which it is registered – Mark liable to mislead the public – Article 51(1)(b) and (c) of Regulation (EC) No 207/2009 (now Article 58(1)(b) and (c) of Regulation (EU) 2017/1001))

Actial Farmaceutica Srl was the proprietor of the EU word mark 'VSL#3' for pharmaceutical preparations. Mendes s.u.r.l. filed an application for revocation of that mark, claiming, first, that, as a result of acts or inactivity of the intervener, it had become the common name in the trade for the goods in question and, second, that it misled the public because of its use. That application was rejected by the Cancellation Division of EUIPO. The appeal brought against that decision was also dismissed by the Board of Appeal.

On appeal against that decision, which it dismisses, the General Court notes, first, that it is apparent from the case-law of the Court of Justice applicable, by analogy, to Article 51(1)(b) of Regulation No 207/2009 that that article covers a situation in which the mark is no longer capable of fulfilling its function as an indication of origin. Of the various functions of a trade mark, the indication of origin function plays an essential part, since it serves to identify the goods or services designated by the mark as originating from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. That undertaking is that under the control of which the goods or services are marketed. That essential function of trade marks has been incorporated by the European Union legislature into Article 4 of Regulation No 207/2009, which provides that signs capable of being represented graphically may constitute a trade mark provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Thus, while Article 7 of Regulation No 207/2009 specifies circumstances in which the mark is from the outset incapable of fulfilling its function of an indication of origin, Article 51(1)(b) of that regulation concerns the situation in which the use of a mark has become so widespread that the sign constituting that mark has come to designate the kind, the type or the nature of the goods or services covered by the registration rather than the specific goods or services originating from a particular undertaking. The mark, having become the common name of a product, has therefore lost its distinctive character, with the result that it no longer fulfils that function. The rights conferred on the proprietor of a mark under Article 9 of Regulation No 207/2009 may then be revoked provided, first, that that mark has become, in the trade, a common name for a product or service for which it is registered and, second, that that transformation is due to acts or inactivity of that proprietor. Those conditions are cumulative.

Secondly, the Court recalls the case-law according to which, where intermediaries are involved in distribution to the consumer or end user of a product covered by a registered trade mark, the relevant class of persons to be taken into account in assessing whether that mark has become the common name, in trade, of the product at issue consists of all consumers or end users and, depending on the characteristics of the market for the product concerned, by all the professional operators involved in the marketing of that mark. The trade mark is an integral part of a process of communication between vendors and purchasers. That process produces its intended result and the trade mark fulfils the function justifying its existence only where both parties involved in the communication 'understand' the trade mark, in the sense that they are aware of its function of an indication of origin. If either party considers the trade mark to be a generic name, the information which the trade mark conveys is not transmitted. Nevertheless, a trade mark may, even if the purchaser does not know that it is a trade mark, continue to perform its function of an indication of origin when an intermediary exerts decisive influence over the purchaser's decision to purchase and the intermediary's knowledge of the trade mark's function as an indication of origin thus leads to the success of the communication process. That is the case when it is customary in the relevant market for the intermediary to give advice which has a decisive bearing on the decision to purchase or where the intermediary actually makes the decision for the consumer himself, as is the case with pharmacists and doctors in relation to medicinal products available only on prescription.

Thus, while the relevant circles include primarily consumers and end users, intermediaries playing a part in the assessment of the customary nature of the mark must also be taken into account. It follows from that case-law that the relevant circles, whose point of view must be taken into account when it is assessed whether the contested mark has become, in the trade, the common name of the product marketed under it, must be defined in the light of the characteristics of that product's market.

5. Signs consisting exclusively of the shape of the product

Judgment of 14 September 2010 (Grand Chamber), Lego Juris v OHMI (C-48/09 P, EU:C:2010:516)

(Appeal – Regulation (EC) No 40/94 – Community trade mark – Suitability of a shape of goods for registration as a trade mark – Registration of a three-dimensional sign consisting of the upper surface and two sides of a Lego brick – Declaration of invalidity of that registration on application by an undertaking marketing toy bricks having the same shape and dimensions – Article 7(1)(e)(ii) of that regulation – Sign which consists exclusively of the shape of goods which is necessary to obtain a technical result)

Kirkbi A/S, the predecessor in title of Lego Juris A/S, registered as an EU trade mark the three-dimensional sign consisting of a red Lego brick. Mega Brands Inc. filed an application for a declaration of invalidity against that registration on the basis of Article 7(1)(a), (e), (ii) and (iii) and (f) of Regulation No 40/94, which was upheld by the Cancellation Division of OHIM. That decision was confirmed, first, by the Grand Board of Appeal of OHIM and, subsequently, by the General Court, [34] on the ground that the contested mark consisted exclusively of the shape of goods which was necessary to obtain a technical result.

On appeal, which it dismisses, the Court of Justice clarifies the scope and criteria for assessing the absolute ground for refusal relating to signs consisting exclusively of the shape of the goods. [35]

In the first place, the Court states that the condition relating to the fact that that ground for refusal covers any sign consisting 'exclusively' of the shape of goods which is necessary to obtain a technical result is satisfied when all the essential characteristics of the shape perform a technical function, the presence of non-essential characteristics with no technical function being irrelevant in that context. That interpretation reflects the idea that the presence of one or more minor arbitrary elements in a three-dimensional sign, all of whose essential characteristics are dictated by the technical solution to which that sign gives effect, does not alter the conclusion that the sign consists exclusively of the shape of goods necessary in order to obtain a technical result. In addition, since that interpretation implies that the ground for refusal under Article 7(1)(e)(ii) of Regulation No 40/94 is applicable only where all the essential characteristics of the sign are functional, the interpretation ensures that such a sign cannot be refused registration as a trade mark under that provision if the shape of the goods at issue incorporates a major non-functional element, such as a decorative or imaginative element which plays an important role in the shape.

In the second place, the Court clarifies that the condition that registration of a shape of goods as a trade mark may be refused only if the shape is 'necessary' to obtain the technical result intended does not mean that the shape at issue must be the only one capable of obtaining that result. It is true that, in some cases, the same technical result may be achieved by various solutions. Thus, there may be alternative shapes, with other dimensions or another design, capable of achieving the same technical result. However, that fact does not in itself mean that registering the shape at issue as a trade mark would have no effect on the availability, to other economic operators, of the technical solution which it incorporates. In that connection, under Article 9(1) of Regulation No 40/94 registration as a trade mark of a purely functional product shape is likely to allow the proprietor of that trade mark to prevent other undertakings not only from using the same

34 Judgment of 12 November 2008, Lego Juris v OHIM – Mega Brands (Red lego brick) (T-270/06, EU:T:2008:483).

35 Within the meaning of Article 7(1)(e)(ii) of Regulation No 40/94.

shape, but also from using similar shapes. A significant number of alternative shapes might therefore become unusable for the proprietor's competitors. That would in particular be so if various purely functional shapes of goods were registered at the same time, for that might completely prevent other undertakings from manufacturing and marketing certain goods having a particular technical function.

In the third place, the Court states that the position of an undertaking which has developed a technical solution cannot be protected – with regard to competitors placing on the market slavish copies of the product shape incorporating exactly the same solution – by conferring a monopoly on that undertaking through registering as a trade mark the three-dimensional sign consisting of that shape, but can, where appropriate, be examined in the light of rules on unfair competition.

In the fourth place, the Court points out that correct application of Article 7(1)(e)(ii) of Regulation No 40/94 requires that the essential characteristics of the three-dimensional sign at issue be duly identified by the authority deciding on the application for registration of that sign as a trade mark. Thus, the expression 'essential characteristics' must be understood as referring to the most important elements of the sign. The identification of those essential characteristics must be carried out on a case-by-case basis. There is no hierarchy that applies systematically between the various types of elements of which it may consist. Moreover, in determining the essential characteristics of a sign, the competent authority may either base its assessment directly on the overall impression produced by the sign, or first examine in turn each of the components of the sign concerned. Moreover, the identification of the essential characteristics of a three-dimensional sign with a view to a possible application of the ground for refusal under Article 7(1)(e)(ii) of the regulation may, depending on the case, and in particular in view of its degree of difficulty, be carried out by means of a simple visual analysis of the sign or, on the other hand, be based on a detailed examination in which relevant criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned. Once the sign's essential characteristics have been identified, the competent authority still has to ascertain whether they all perform the technical function of the goods at issue. Article 7(1)(e)(ii) of Regulation No 40/94 cannot apply when the application for registration as a trade mark relates to a shape of goods in which a non-functional element, such as a decorative or imaginative element, plays an important role. In that case, competitor undertakings easily have access to alternative shapes with equivalent functionality, so that there is no risk of impairing the availability of the technical solution. That solution may, in that case, be incorporated without difficulty by the competitors of the mark's proprietor in shapes which do not have the same non-functional element as that contained in the proprietor's shape and which are therefore neither identical nor similar to that shape.

In the fifth and final place, the Court takes the view that the presumed perception of the sign by the average consumer is not a decisive factor when applying the ground for refusal under Article 7(1)(e)(ii) of Regulation No 40/94, but, at most, may be a relevant criterion of assessment for the competent authority when it identifies the essential characteristics of the sign.

Judgment of 6 October 2011, Bang & Olufsen v OHIM (Representation of a loudspeaker) (T-508/08, EU:T:2011:575)

(Community trade mark – Application for a three-dimensional Community trade mark – Representation of a loudspeaker – Compliance by OHIM with a judgment annulling a decision of one of its Boards of Appeal – Article 63(6) of Regulation (EC) No 40/94 (now Article 65(6) of Regulation (EC) No 207/2009) – Absolute ground for refusal – Sign which consists exclusively of the shape which gives substantial value to the goods – Article 7(1)(e)(iii) of Regulation No 40/94 (now Article 7(1)(e)(iii) of Regulation No 207/2009))

Bang & Olufsen A/S filed an application with OHIM for registration as a Community trade mark of the three-dimensional sign consisting of the shape of a loudspeaker. The examiner rejected the application on the ground that the mark was devoid of distinctive character and that it had not acquired distinctiveness through use. [36] That decision was upheld by the Board of Appeal but was later annulled by the General Court. [37] Giving due effect to that General Court judgment, the Board of Appeal annulled the examiner's decision regarding the distinctive character of the mark and also rejected the application for registration on the ground that the sign at issue consisted exclusively of the shape which gives substantial value to the goods.

On appeal against the latter decision, which it dismisses, the Court upholds the decision of the Board of Appeal and clarifies the relationship between the absolute ground for refusal relating to signs consisting exclusively of the shape which gives substantial value to the goods within the meaning of Article 7(1)(e)(iii) of Regulation No 40/94 and the acquisition of distinctive character through use within the meaning of Article 7(3) of that regulation.

In that regard, the Court points out that a sign falling within the scope of Article 7(1)(e) of Regulation No 40/94 can never acquire distinctive character for the purposes of Article 7(3) of the regulation, through the use made of it, although that possibility exists, according to that last provision, for signs covered by the grounds for refusal provided for in Article 7(1)(b) to (d) of Regulation No 40/94.

Consequently, if the examination of a sign under Article 7(1)(e) of Regulation No 40/94 leads to the conclusion that one of the criteria mentioned in that provision is met, this results in a release from examination of the sign under Article 7(3) of that regulation,

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[36] Within the meaning of Article 7(1)(b) and (3) of Regulation No 40/94.

[37] Judgment of 10 October 2007, Bang & Olufsen v OHIM (Shape of a loudspeaker) (T-460/05, *EU:T:2007:304*).

since registration of the sign in such circumstances is clearly impossible. That release explains the advantage of undertaking a prior examination of the sign under Article 7(1)(e) of Regulation No 40/94 where several of the absolute grounds for refusal provided for in paragraph 1 may apply, although such a release may not be interpreted as implying that there is an obligation to examine that sign first under Article 7(1)(e) of Regulation No 40/94.

6. Trade marks contrary to public policy or to accepted principles of morality

Judgment of 15 March 2018, La Mafia Franchises v EUIPO – Italy (La Mafia SE SIENTA A LA MESA) (T-1/17, EU:T:2018:146)

(EU trade mark – Invalidity proceedings – EU figurative mark La Mafia SE SIENTA A LA MESA – Absolute ground for refusal – Whether contrary to public policy or to accepted principles of morality – Article 7(1)(f) of Regulation (EC) No 207/2009 (now Article 7(1)(f) of Regulation (EU) 2017/1001))

La Honorable Hermandad, SL, to which La Mafia Franchises, SL was the successor, was the proprietor of the EU figurative mark La Mafia SE SIENTA A LA MESA. The Italian Republic filed an application for a declaration of invalidity of that mark, maintaining that it was contrary to public policy and to accepted principles of morality. That application was upheld by the Cancellation Division of EUIPO and the decision of the latter confirmed by the Board of Appeal.

On appeal, which it dismisses, the General Court provides clarification on the assessment of the absolute ground relating to the infringement of public policy or accepted principles of morality within the meaning of Article 7(1)(f) of Regulation No 207/2009.

The General Court states, first of all, that the public interest underlying the absolute ground for refusal laid down in Article 7(1)(f) of Regulation No 207/2009 is to ensure that signs which, would be contrary to public policy or to accepted principles of morality when used in the European Union. The registration of a mark as an EU mark is caught by that absolute ground for refusal if, inter alia, it is deeply offensive.

The assessment of the existence of that ground for refusal cannot be based on the perception of the part of the relevant public that does not find anything shocking, nor can it be based on the perception of the part of the public that may be very easily offended, but must be based on the standard of a reasonable person with average sensitivity and tolerance thresholds. Moreover, the relevant public cannot be limited, for the purpose of the examination of that ground for refusal, to the public to which the goods and services in respect of which registration is sought are directly addressed. Consideration must be given to the fact that the signs caught by that ground for refusal will shock not only the public to which the goods and services designated by the sign are addressed, but also other persons who, without being concerned by those goods and services, will encounter that sign incidentally in their day-to-day lives.

Moreover, the Court points out that the relevant public within the European Union is, by definition, within a Member State and that the signs likely to be perceived as being contrary to public policy or to accepted principles of morality are not the same in all Member States, inter alia for linguistic, historic, social and cultural reasons. It follows that, in order to apply that absolute ground for refusal, it is necessary to take account both of the circumstances common to all Member States of the European Union and of the particular circumstances of individual Member States which are likely to influence the perception of the relevant public within those States.

Lastly, it states that, when a sign is particularly shocking or offensive, it must be regarded as being contrary to public policy or to accepted principles of morality, irrespective of the goods and services for which it is registered. Moreover, it follows from a combined reading of the various subparagraphs of Article 7(1) of Regulation No 207/2009 that they refer to the intrinsic qualities of the mark in question and not to circumstances relating to the conduct of the person applying for the trade mark.

Judgment of 27 February 2020, Constantin Film Produktion v EUIPO (C-240/18 P, EU:C:2020:118)

(Appeal – EU trade mark – Regulation (EC) No 207/2009 – Article 7(1)(f) – Absolute ground for refusal – Mark contrary to accepted principles of morality – Word sign 'Fack Ju Göhte' – Rejection of the application for registration)

Constantin Film Produktion filed an application with EUIPO for registration of an EU trade mark for the word sign 'Fack Ju Göhte' which is, in fact, the title of a German film comedy produced by the applicant, for various goods and services. [38] The registration application was, however, rejected by the examiner on the ground that it was contrary to public policy and to accepted principles of morality. [39] That rejection was upheld, firstly, by the Board of Appeal of EUIPO and then by the General Court. [40]

On appeal by the applicant, the Court of Justice sets aside the judgments of the General Court and of the Board of Appeal of EUIPO and rules on the concept of 'accepted principles of morality' and on the criteria for assessing the ground for refusal laid down in Article 7(1)(f) of Regulation No 207/2009.

At the outset, the Court states that, since the concept of 'accepted principles of morality' is not defined by Regulation No 207/2009, it must be interpreted in the light of its usual

[38] The goods and services concerned were in Classes 3, 9, 14, 16, 18, 21, 25, 28, 30, 32, 33, 38 and 41 of the Nice Agreement.

[39] Within the meaning of Article 7(1)(f) of Regulation No 207/2009, read in conjunction with Article 7(2) of that regulation.

[40] Judgment of 24 January 2018, Constantin Film Produktion v EUIPO (Fack Ju Göhte) (T-69/17, *EU:T:2018:27*).

meaning and the context in which it is generally used. That concept refers, in its usual meaning, to the fundamental moral values and standards to which a society adheres at a given time, which are likely to change over time and vary in space and should therefore be determined according to the social consensus prevailing in that society at the time of the assessment, taking into account the social context, including, where appropriate, the cultural, religious or philosophical diversities that characterise it.

In addition, the Court notes that the question as to whether a sign for which registration is sought is contrary to accepted principles of morality requires an examination of all the elements specific to the case in order to determine how the relevant public would perceive such a sign if it were used as a trade mark for the goods or services claimed. In that connection, the Court points out that it is not sufficient for the sign concerned to be regarded as being in bad taste, but that it must, at the time of the examination, be perceived by the relevant public as contrary to the fundamental moral values and standards of society as they exist at that time. To establish whether that is the case, the examination is to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered and, where appropriate, the particular circumstances of the part of the Union concerned. To that end, elements such as legislation and administrative practices, public opinion and, where appropriate, the way in which the relevant public has reacted in the past to that sign or similar signs, as well as any other factor which may make it possible to assess the perception of that public, are relevant. Therefore, such an examination cannot be confined to an abstract assessment of the mark applied for, or even of certain components thereof, but it must be established that the use of that mark in the concrete and current social context would indeed be perceived by that public as being contrary to the fundamental moral values and standards of society. Furthermore, freedom of expression, enshrined in Article 11 of the Charter of Fundamental Rights of the European Union, must also be taken into account, which is corroborated by both recital 21 of Regulation 2015/2424, [41] which amended Regulation No 207/2009, and by recital 21 of Regulation 2017/1001, which expressly emphasise the need to apply those regulations in such a way as to ensure full respect for fundamental rights and freedoms, in particular freedom of expression.

As regards, more specifically, the sign under consideration, the Court takes the view that the title of a film need not be descriptive of its content in order to constitute a relevant contextual factor in assessing whether the relevant audience perceives that title and an eponymous word sign as contrary to accepted principles of morality. Moreover, although the success of a film does not automatically prove the social acceptance of its title and of a word sign of the same name, it is at least an indication of such acceptance which must

[41] Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Regulation (EC) No 40/94, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

be assessed in the light of all the relevant factors in the case in order to establish, in concrete terms, the perception of that sign in the event of use of that sign as a trade mark. Under those circumstances, and in view of the fact that no concrete evidence has been put forward plausibly to explain why the German-speaking public at large will perceive the word sign examined as going against the fundamental moral values and standards of society when it is used as a trade mark, even though that same public does not appear to have considered the title of the eponymous comedies to be contrary to accepted principles of morality, the Court of Justice holds that both the Board of Appeal of EUIPO and the General Court misinterpreted and misapplied Article 7(1)(f) of Regulation No 207/2009.

7. Misleading trade marks

Judgment of 13 May 2020, SolNova v EUIPO – Canina Pharma (BIO-INSECT Shocker) (T-86/19, EU:T:2020:199)

(EU trade mark – Invalidity proceedings – EU word mark BIO-INSECT Shocker – Absolute ground for refusal – Mark likely to deceive the public – Article 7(1)(g) of Regulation (EC) No 207/2009)

By its judgment in SolNova v EUIPO – Canina Pharma (BIO-INSECT Shocker) (T-86/19), delivered on 30 April 2020, the Court annulled in part EUIPO's decision on the ground that it had committed an error of assessment in finding that the word mark BIO-INSECT Shocker was not deceptive in respect of biocidal products.

SolNova AG, the applicant, had applied for a declaration of invalidity of the word mark BIO-INSECT Shocker in respect of all the goods covered by that mark, including biocidal products, on the ground, inter alia, that it was likely to deceive the public as to the nature or quality of the goods. EUIPO had dismissed that application on the ground that the contested mark was not likely to deceive the public, since the applicant had not proved that the mark could be classed as deceptive for the purposes of Article 7(1)(g) of Regulation No 207/2009 and that a non-deceptive use of the mark was possible. In its action before the Court, the applicant claimed, in particular, that the contested mark was perceived by the relevant public as relating to organic goods or goods associated with respect for the environment.

First of all, the Court referred to its settled case-law under which the circumstances for refusing registration laid down in Article 7(1)(g) of Regulation No 207/2009 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived.

Next, having cited the provisions of Regulation No 528/2012 [42] defining the concept of biocidal product and laying down requirements for the labelling and advertising of such products, the Court found that it followed from those provisions that the presence of indications on a biocidal product, such as those for which the contested mark was registered, which gave the impression that that product was natural, did not harm health or was environmentally friendly, were liable to mislead and deceive the consumer. The presence of such an indication on a biocidal product was therefore sufficient to establish a sufficiently serious risk that the consumer would be deceived.

In that connection, as regards the word 'bio' in the contested mark, the Court pointed out that that word had already acquired a highly suggestive connotation which, in general, refers to the idea of environmental protection, the use of natural materials or even ecological manufacturing processes.

Thus, the Court found that the presence of the word 'bio' on biocidal products is sufficient to establish a sufficiently serious risk that the consumer will be deceived.

Finally, the Court, unlike EUIPO, held that the fact that a non-deceptive use of the mark was possible, even assuming that were proved, could not rule out an infringement of Article 7(1)(g) of Regulation No 207/2009.

Judgment of 29 June 2022, Hijos de Moisés Rodríguez González v EUIPO – Ireland and Ornua (La Irlandesa 1943) (T-306/20, EU:T:2022:404 [43])

(EU trade mark – Invalidity proceedings – EU figurative mark La Irlandesa 1943 – Absolute grounds for invalidity – Declaration of invalidity by the Grand Board of Appeal of EUIPO – Evidence submitted for the first time before the Court – Relevant date for the examination of an absolute ground for invalidity – Mark of such a nature as to deceive the public – Article 7(1)(g) of Regulation (EC) No 207/2009 (now Article 7(1)(g) of Regulation (EU) 2017/1001) – Bad faith – Article 52(1)(b) of Regulation No 207/2009 (now Article 59(1)(b) of Regulation 2017/1001))

For decades, the applicant, Hijos de Moisés Rodríguez González, SA, purchased Irish butter from Ornua Co-operative Ltd and sold it in the Canary Islands (Spain) under trade marks containing the element 'la irlandesa'. After that business relationship came to an end in 2011, the applicant continued to sell goods under those trade marks. In 2014, it obtained European Union trade mark registration from EUIPO for the figurative mark La Irlandesa 1943 for various foodstuffs. [44] Ireland and Ornua Co-operative applied to EUIPO

[42] Article 3(1)(a), Article 69(2) and Article 72(3) of Regulation (EU) No. 528/2012 of the European Parliament and of the Council of 22 May 2012 concerning the making available on the market and use of biocidal products (OJ 2012 L 167, p. 1)

[43] The appeal against the judgment was not allowed to proceed (order of 8 March 2023, Hijos de Moisés Rodríguez González v EUIPO (C-605/22 P, *EU:C:2023:199*).

[44] The goods concerned were meat and dairy products in Class 29 of the Nice Agreement.

for a declaration that that mark was invalid on the ground that it was deceptive and that its registration had been applied for in bad faith. [45] The Cancellation Division of EUIPO rejected the application for a declaration of invalidity. However, the Grand Board of Appeal of EUIPO annulled the Cancellation Division's decision and declared the contested mark invalid. It found that, at the time when the application for registration was filed, that mark was of such a nature as to deceive the public as to the geographical origin of the goods at issue and that the registration of that mark had been applied for in bad faith.

The applicant brought an action before the General Court seeking annulment of the decision of the Grand Board of Appeal. The Court dismisses that action, finding that the contested mark was not misleading at the time of the application for registration, but that the applicant acted in bad faith at the time of that application. On this occasion, it clarifies the conditions for applying the concepts of 'deceptive mark' and 'bad faith on the part of the applicant' in the context of trade marks indicating a geographical origin of goods.

First of all, the Court notes that, when seeing the contested mark affixed to the goods at issue, Spanish-speaking consumers, who constitute the relevant public, will believe that those goods originate in Ireland.

Next, as regards the deceptive nature of the contested mark, the Court points out that, unlike the examination of an application for revocation, [46] which requires that account be taken of evidence subsequent to the filing of the mark, such as the use made of that mark, the examination of an application for a declaration of invalidity based on the deceptive nature of the mark [47] requires that it be established that the sign filed for the purposes of registration as a mark was per se of such a nature as to deceive the consumer at the time of filing of the application for registration, since the subsequent management of that sign is irrelevant. In the case of invalidity, it is necessary to assess whether the mark should not have been registered ab initio for reasons already existing on the date of that application, since the consideration of subsequent evidence can serve only to clarify the circumstances as they were on that date.

In the present case, the Grand Board of Appeal should have ascertained whether, on the date of the application for registration, there was any inconsistency between the information which the contested mark conveyed and the characteristics of the goods designated in that application. Since the list of goods did not contain any indication of their geographical origin and could therefore cover goods originating from Ireland, there was no such inconsistency at the time of the application, with the result that it was not possible to find that the contested mark was deceptive on that date. Thus, the Grand Board of Appeal erred in criticising the applicant for not having limited that list to goods

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45 Within the meaning of Article 7(1)(g) and Article 52(1)(a) and (b) of Regulation No 207/2009.

46 Within the meaning of Article 51(1)(c) of Regulation No 207/2009.

47 Introduced pursuant to Article 52(1)(a) in conjunction with Article 7(1)(g) of Regulation No 207/2009.

originating from Ireland. Furthermore, since the contested mark could not be regarded as misleading on the date of the application for registration, the subsequent evidence, which did not concern the situation on that date, could not confirm such a misleading nature. Consequently, the Grand Board of Appeal erred in that regard.

Lastly, as regards bad faith on part of the applicant when filing the contested mark, [48] the Court states that, in order to decide that question, the Grand Board of Appeal could legitimately rely on evidence – and even on the use of that mark – subsequent to the date of that filing, since that evidence constituted evidence relating to the situation on the relevant date.

In the present case, first, a not insignificant part of the goods sold by the applicant under the contested mark was not of Irish origin and therefore did not correspond to the relevant public's perception of those goods. Although that fact is irrelevant for the purpose of examining whether the trade mark is misleading, it is not irrelevant for the purpose of examining bad faith on the part of the applicant. Since Spanish-speaking consumers had become accustomed over the course of several decades to the contested mark being affixed to butter originating from Ireland, they could be misled as to the geographical origin of those goods once the applicant had extended the use of the mark to goods other than butter of Irish origin.

Secondly, cases in which marks which were similar to the mark at issue in the present case were declared to be invalid or refused by EUIPO and the Spanish authorities confirm that the contested mark could be perceived as indicating the Irish origin of goods. They also indicate that the use of the mark for goods not of Irish origin was controversial as regards its potential deceptive nature; a fact of which the applicant was necessarily aware on the date of the application for registration and which is therefore capable of supporting the existence of bad faith on the part of the applicant on that date.

Thirdly, the applicant had adopted a commercial strategy of association with the marks containing the element 'la irlandesa' which were linked to the applicant's former business relationship with Ornua Co-operative, in order to continue to take advantage of that relationship, which has been terminated, and the marks which were linked to it.

Accordingly, the Court finds that registration of the contested mark was contrary to honest commercial and business practices and that the Grand Board of Appeal was correct in finding that the applicant acted in bad faith. Since that finding is such as to justify, by itself, the operative part of the decision of the Grand Board of Appeal, the Court dismisses the action.

[48] Within the meaning of Article 52(1)(b) of Regulation No 207/2009.

8. Bad faith on the part of the applicant

Judgment of 12 September 2019, Koton Mağazacilik Tekstil Sanayi ve Ticaret v EUIPO (C-104/18 P, EU:C:2019:724)

(Appeal – EU trade mark – Regulation (EC) No 207/2009 – Absolute grounds for invalidity – Article 52(1)(b) – Bad faith at the time that an application for a trade mark is filed)

In the judgment in Koton Mağazacilik Tekstil Sanayi ve Ticaret v EUIPO (C-104/18 P), delivered on 12 September 2019, the Court of Justice set aside the judgment of the General Court [49] and clarified the concept of 'bad faith' at the time that an application for a European Union trade mark is filed.

Mr Nadal Esteban and Koton Mağazacilik Tekstil Sanayi ve Ticaret, an undertaking which is the proprietor of KOTON figurative marks, had a business relationship until 2004. On 25 April 2011, Mr Esteban filed an application for registration as a European Union trade mark of the figurative sign STYLO & KOTON for goods and services in Classes 25, 35 and 39 of the Nice Agreement. Following the partial upholding of the opposition filed by Koton Mağazacilik Tekstil Sanayi ve Ticaret, based on its KOTON marks registered for goods and services in Classes 18, 25 and 35, the mark STYLO & KOTON was registered for services in Class 39. Koton Mağazacilik Tekstil Sanayi ve Ticaret then brought an application for a declaration of invalidity on the basis of Article 52(1)(b) of Regulation No 207/2009, pursuant to which the bad faith of an applicant when filing the application for the trade mark is an absolute ground for invalidity.

The General Court, upholding EUIPO's decision rejecting the application for a declaration of invalidity, held that there could be no bad faith since there was neither identity nor confusing similarity between the goods or services in respect of which the marks had been registered. Hearing the appeal, the Court of Justice was called upon to clarify the concept of 'bad faith'.

First of all, the Court stated that while, in accordance with its usual meaning in everyday language, the concept of 'bad faith' presupposes the presence of a dishonest state of mind or intention, that concept must moreover be understood in the context of trade mark law, which is that of the course of trade. The rules on the EU trade mark are aimed, in particular, at contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin. Consequently, the Court held that a trade mark

[49] Judgment of the General Court of 30 November 2017, Koton Mağazacilik Tekstil Sanayi ve Ticaret v EUIPO – Nadal Esteban (STYLO & KOTON) (T-687/16, EU:T:2017:853).

must be declared invalid on the ground of bad faith where it is apparent from relevant and consistent indicia that the proprietor of that trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition, but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin.

Next, the Court of Justice held that it is not apparent from the judgment of 11 June 2009, Chocoladefabriken Lindt & Sprüngli (C-529/07, EU:C:2009:361), that the existence of bad faith may only be established in the situation where there is use on the internal market of an identical or similar sign for identical or similar goods capable of being confused with the sign for which registration is sought. There may be situations where the application for registration of a trade mark is liable to be regarded as having been filed in bad faith notwithstanding the fact that, at the time of that application, there was no use by a third party on the internal market of an identical or similar sign for identical or similar goods. In the case of an application for a declaration of invalidity based on Article 52(1)(b) of Regulation No 207/2009, there is no requirement whatsoever that the applicant for that declaration be the proprietor of an earlier mark for identical or similar goods or services. Moreover, in cases where it transpires that, at the time of the application for the contested mark, a third party was using, in at least one Member State, a sign identical with or similar to the contested mark, the existence of a likelihood of confusion between those signs on the part of the public need not necessarily be established. In the absence of any likelihood of confusion between the sign used by a third party and the contested mark, or if there has been no use, by a third party, of a sign identical with, or similar to, the contested mark, other factual circumstances may, depending on the circumstances, constitute relevant and consistent indicia establishing the bad faith of the applicant.

Lastly, the Court of Justice found that the General Court had not taken into consideration, in its overall assessment, all the relevant factual circumstances as they appeared at the time the application was filed, whereas that point in time is decisive. Since it was claimed in the application that the mark should be declared invalid in its entirety, the application had to be examined by assessing Mr Esteban's intention at the time he sought registration of that mark. Consequently, the Court of Justice set aside the judgment under appeal.

Judgment of 6 July 2022, Zdút v EUIPO – Nehera and Others (nehera) (T-250/21, EU:T:2022:430)

(EU trade mark – Invalidity proceedings – EU figurative mark NEHERA – Absolute ground for invalidity – No bad faith – Article 52(1)(b) of Regulation (EC) No 207/2009 (now Article 59(1)(b) of Regulation (EU) 2017/1001))

In 2014, Mr Ladislav Zdút, the applicant, obtained from EUIPO registration of the EU figurative mark NEHERA for goods in the textile sector.

In 2019, Ms Nehera, Mr Nehera and Ms Sehnal filed an application for a declaration of invalidity against that mark, based on the applicant's bad faith when he filed the application for registration. [50] They claimed that in Czechoslovakia in the 1930s, their grandfather, Mr Jan Nehera, had established a business marketing clothing and accessories, and had filed and used a national mark identical to the contested mark, enjoying a reputation. That application was upheld by the Second Board of Appeal of EUIPO. That Board found that the applicant's intention was to take unfair advantage of the reputation of Mr Jan Nehera and of the former Czechoslovak trade mark and, therefore, that the applicant was acting in bad faith when he filed the application for registration of the contested mark. The applicant brought an action before the General Court seeking the annulment of that decision of the Board of Appeal of EUIPO.

The Court annuls the contested decision and clarifies the concept of bad faith where that is based on an intention to take unfair advantage of the reputation of an earlier trade mark or of the celebrity of a person's name.

First of all, the Court notes that, in order to assess the applicant's bad faith, it is possible to take into account the extent of the reputation enjoyed by the sign at issue at the time its registration was sought, including where that sign had previously been registered or used by a third party as a trade mark. The fact that use of a sign for which registration is sought would enable the applicant to take unfair advantage of the reputation of an earlier trade mark or sign or even of the name of a famous person is such as to establish bad faith on the part of the applicant. The relevant public for the purpose of assessing the existence of the reputation and of the unfair advantage taken thereof is the average consumer of the goods for which the contested mark was registered.

Next, the Court considers that parasitic behaviour with regard to the reputation of a sign or of a name is, in principle, only possible if that sign or that name actually and currently enjoys a certain reputation or a certain celebrity. In the present case, on the date on which the application for registration of the contested mark was filed, the former Czechoslovak trade mark and Mr Jan Nehera's name were no longer either registered or protected, or used by a third party to market clothing, or even well known among the relevant public. In that context, the Court specifies that the mere fact that the applicant knew or ought to have known that a third party had, in the past, used a mark similar or identical to the mark applied for is not sufficient to establish the existence of bad faith on the part of that applicant.

In addition, the Court points out that the existence on the part of the relevant public of a link between the contested mark and the former sign cannot be sufficient, on its own, to support a finding that unfair advantage was taken of the reputation of the sign or of the former name. In that regard, it underlines that the applicant made his own commercial

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[50] Within the meaning of Article 52(1)(b) of Regulation No 207/2009.

efforts in order to revive the image of the former Czechoslovak trade mark and that the mere fact of having referred to that mark and to the historic image of its creator for promotional purposes does not appear to be contrary to honest practices in industrial or commercial matters.

Furthermore, the Court recognises that it cannot be ruled out that, in certain specific circumstances, reuse by a third party of a previously renowned former mark or of the name of a previously famous person may give a false impression of continuity or of inheritance with that former mark or with that person. That could be the case, in particular, where the trade mark applicant presents itself to the relevant public as the legal or economic successor of the holder of the former mark, whereas there is no continuity or inheritance relationship between the holder of the former mark and the applicant. Such a circumstance could be taken into account in order to establish, where appropriate, bad faith on the part of the applicant. In the present case, it does not appear, according to the Court, that the applicant deliberately sought to establish a false impression of continuity or inheritance between his undertaking and that of Mr Jan Nehera.

Lastly, the Court rules on the alleged intention on the part of the applicant to defraud Mr Jan Nehera's descendants and heirs and to usurp their rights. In that regard, it notes that at the time the application for registration of the contested mark was filed, the former Czechoslovak trade mark and Mr Jan Nehera's name no longer benefited from any legal protection. Therefore, Mr Jan Nehera's descendants and heirs did not hold any right that might be susceptible to fraud or to being usurped by the applicant.

Consequently, the Court finds no bad faith on the part of the applicant and annuls the decision of the Second Board of Appeal of EUIPO.

9. Acquisition of distinctive character through use

Judgment of 12 December 2002, eCopy v OHIM (ECOPY) (T-247/01, EU:T:2002:319)

(Community trade mark – ECOPY – Misuse of powers – Distinctiveness acquired through use after the date of filing – Article 7(3) of Regulation (EC) No 40/94)

ECopy, Inc., previously called Simplify Development Corporation, filed an application at OHIM for registration of the word mark ECOPY in respect of goods corresponding to 'computer software and apparatus for scanning and electronic distribution of documents'. That application was, however, refused by the examiner on the ground that the trade mark applied for was descriptive of the goods in question and devoid of any distinctive character. The appeal brought against that decision was also dismissed by the Board of Appeal.

On appeal against the latter's decision, which it dismisses, the General Court clarifies the criteria for assessing distinctive character acquired through use within the meaning of Article 7(3) of Regulation No 40/94 and the scope of the examination carried out by OHIM.

According to the General Court, Article 7(3) of Regulation No 40/94 must be interpreted as meaning that a mark must have become distinctive through use before the application was filed. Accordingly, it is irrelevant that the mark may have acquired distinctiveness through use after the application was filed but before OHIM, in the person of the examiner or, where appropriate, the Board of Appeal, has determined whether there are any absolute grounds for refusing registration of the mark. It follows that OHIM may not have regard to evidence of use that occurred after the date of filing.

As regards the examination carried out by OHIM, the General Court states that, when assessing the distinctive character of a Community trade mark acquired through use, OHIM is not bound to examine facts showing that the mark claimed has become distinctive through use unless the applicant has relied on them. Whilst with regard to Article 7(3) of Regulation No 40/94 it is true that there is no rule stipulating that the examination by OHIM (that is, by the examiner or, if appropriate, the Board of Appeal) must be limited to the facts relied on by the parties, contrary to what is stated at the end of Article 74(1) of the regulation with regard to the relative grounds for refusal, if the applicant for the mark does not plead distinctiveness acquired through use, OHIM is in practical terms unable to take account of the fact that the mark claimed may have become distinctive. Similarly, OHIM is required to take account of evidence establishing that the mark claimed has become distinctive through use only if the applicant for the mark produced that evidence during the administrative procedure before OHIM because there is no material difference between claiming that the mark sought has become distinctive through use on the one hand, and adducing evidence in support of such a claim on the other.

Judgment of 19 June 2014, Oberbank and Others C-217/13 and C-218/13, EU:C:2014:2012

(Request for a preliminary ruling – Trade marks – Directive 2008/95/EC – Article 3(1) and Article 3(3) – Mark consisting of a contourless red colour, registered for banking services – Application for a declaration of invalidity – Distinctive character acquired through use – Evidence – Consumer survey – Time when distinctive character through use is acquired – Burden of proof)

DSGV was the proprietor of a national trade mark consisting of a contourless red colour, which was registered with the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office, 'DPMA') for banking services. Oberbank applied for a declaration of invalidity in respect of the mark at issue, maintaining, inter alia, that it had not acquired distinctive character through use. That application was dismissed by the DPMA. In addition, Banco Santander and Santander Consumer Bank also filed an application for a declaration of invalidity of the mark at issue on the basis that distinctive character had not been acquired through use, which was also dismissed.

Hearing two actions, one brought by Oberbank, the other by Banco Santander and Santander Consumer Bank, the Bundespatentgericht (Federal Patent Court, Germany) asked the Court to clarify the degree of recognition required for a trade mark to be considered to have acquired distinctive character through use, and the relevant date to be taken into account for such an examination.

In the first place, the Court notes that Article 3(1) and Article 3(3) of Directive 2008/95 on trade marks [51] must be interpreted as precluding an interpretation of national law according to which, in proceedings raising the question whether a contourless colour mark has acquired distinctive character through use, it is necessary in every case that a consumer survey indicate a degree of recognition of at least 70%.

In the second place, the Court held that where a Member State has not exercised the power laid down in the second sentence of Article 3(3) of Directive 2008/95, the first sentence of Article 3(3) of that directive must be interpreted as meaning that, in the context of invalidity proceedings in respect of a mark which is intrinsically devoid of distinctive character, in order to assess whether that mark has acquired distinctive character through use, it is necessary to examine whether such character was acquired before the date of filing of the application for registration of that mark. It is irrelevant in that regard that the proprietor of the mark at issue maintains that the mark has, in any event, acquired a distinctive character through use after the date of filing of the application for registration, but before the date of registration of that mark.

In the third and last place, the Court found that where a Member State does not exercise the power laid down in the second sentence of Article 3(3) of Directive 2008/95 to approximate the laws of the Member States relating to trade marks, the first sentence of Article 3(3) of that directive must be interpreted to the effect that it does not preclude, in the context of invalidity proceedings, the mark at issue from being declared invalid where it is intrinsically devoid of distinctive character and the proprietor of that mark has failed to show that it has acquired distinctive character through the use made of it before the date of filing of the application for registration.

Judgment of 21 April 2015, Louis Vuitton Malletier v OHIM – Nanu-Nana (Representation of a brown and beige chequerboard pattern) (T-359/12, EU:T:2015:215 [52])

(Community trade mark – Invalidity proceedings – Community figurative mark representing a brown and beige chequerboard pattern – Absolute ground for refusal – No distinctive character – No

[51] 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).

[52] The appeal against that judgment was dismissed by order of the President of the Court on 21 July 2016, Louis Vuitton Malletier v EUIPO (C-363/15 P and C-364/15 P, *EU:C:2016:595*).

distinctive character acquired through use – Article 7(1)(b) and Article 7(3) of Regulation (EC) No 207/2009 – Article 52(1) and (2) of Regulation No 207/2009)

Louis Vuitton Malletier was the proprietor of the Community figurative mark representing a brown and beige chequerboard pattern. Nanu-Nana Handelsgesellschaft mbH für Geschenkartikel & Co. KG filed an application for a declaration of invalidity, which was accepted by the Cancellation Division of OHIM on the ground that the mark was devoid of distinctive character and had not acquired distinctiveness through use. The Board of Appeal of OHIM confirmed that decision.

On appeal against the decision of the Board of Appeal, which it dismisses, the General Court ruled that the absolute ground for refusal relating to a sign's lack of distinctive character [53] does not preclude registration of a trade mark if that mark has become distinctive in relation to the goods for which registration is sought in consequence of the use which has been made of it. Proof of distinctive character acquired through use must be produced only for the States that were members of the European Union at the time of filing the application for registration of the contested mark. Thus, a sign devoid of any inherent distinctive character which, by reason of the use made of it prior to the filing of the application for its registration as a Community trade mark, has acquired such distinctive character for the goods or services referred to in the registration application is accepted for registration, given that it is not a mark 'registered contrary to the provisions of Article 7'. Article 52(2) of Regulation No 207/2009 is therefore wholly irrelevant to that situation since it covers trade marks whose registration was contrary to the grounds for refusal set out in Article 7(1) (b) to (d) of Regulation No 207/2009 and which, in the absence of such a provision, should have been declared invalid. The very purpose of Article 52(2) of Regulation No 207/2009 is to maintain the registration of such of those marks which, because of the use that has been made of them, have in the meantime – that is to say, after their registration – acquired distinctive character for the goods or services for which they were registered, in spite of the fact that, when it took place, such registration was contrary to Article 7 of Regulation No 207/2009.

A Community trade mark has a 'unitary character', which implies that 'it shall have equal effect throughout the Community'. It follows that, in order to be accepted for registration, a sign must have distinctive character throughout the European Union. Thus, a mark must be refused registration if it lacks distinctive character in part of the Union. Article 7(3) of Regulation No 207/2009 must be read in the light of those requirements. Consequently, it is necessary to establish the acquisition of distinctive character through use in all the territory in which the mark did not, ab initio, have such character. It necessarily follows from the foregoing that, when a contested mark is devoid of any distinctive character in the European Union as a whole, the acquisition of distinctive character by that mark must

[53] Within the meaning of Article 7(1)(b) of Regulation No 207/2009.

be established in relation to each of the Member States. Admittedly, the Court has held that even though it is the case that the acquisition by a mark of distinctive character through use must be established for the part of the European Union in which that mark did not, ab initio, have such character, it would be unreasonable to require proof of such acquisition for each individual Member State. Nevertheless, it must be stated that, by referring to the case-law holding that a mark could be registered only if it was established that it had acquired, through the use which had been made of it, distinctive character in the part of the European Union in which it did not, ab initio, have such character, which had to be the European Union as a whole, the Court did not depart from its case-law.

Judgment of 25 July 2018, Société des produits Nestlé and Others v Mondelez UK Holdings & Services (C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596)

(Appeal – EU trade mark – Three-dimensional mark representing the shape of a four-fingered chocolate bar – Appeal directed against the grounds – Inadmissibility – Regulation (EC) No 207/2009 – Article 7(3) – Evidence of distinctive character acquired through use)

La Société des produits Nestlé SA applied to EUIPO for registration as an EU trade mark of the three-dimensional sign representing the shape of a four-fingered chocolate bar for goods classified as sweets and bakery products. [54] Cadbury Schweppes plc (subsequently Cadbury Holdings, now Mondelez) filed an application with EUIPO for a declaration of invalidity based on the lack of distinctive character of that sign, [55] which was upheld by the Cancellation Division of EUIPO. However, the Board of Appeal of EUIPO annulled that decision on the ground that the contested sign had acquired distinctive character through the use which had been made of it. [56]

On appeal against that decision, the General Court [57] subsequently annulled it in its entirety, finding that the latter had not ruled on the perception of the contested mark by the relevant public in several Member States.

Following appeals brought by Nestlé and EUIPO, which it dismisses, the Court clarifies the territorial extent of the use of a sign which is necessary for it to be regarded as having acquired distinctive character within the meaning of Article 7(3) of Regulation No 207/2009.

In the first place, the Court clarifies the scope of the judgment of 18 April 2013, Colloseum Holding (C-12/12, EU:C:2013:253). In that regard, it points out that, admittedly, it has

[54] These were goods falling within Class 30 within the meaning of the Nice Agreement.

[55] Within the meaning of Article 7(1)(b) of Regulation No 207/2009.

[56] Within the meaning of Article 7(3) of Regulation No 207/2009.

[57] Judgment of 15 December 2016, Mondelez UK Holdings & Services v EUIPO – Société des produits Nestlé (Shape of a chocolate bar) (T-112/13, *EU:T:2016:735*).

already held that the requirements applying to the verification of genuine use of a trade mark [58] are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration [59] and that, in order to assess whether there has been 'genuine use in the Community', the territorial borders of the Member States must be disregarded. However, the judgment in Colloseum Holding does not relate to the geographic scope relevant for assessing whether there has been genuine use within the meaning of Article 15(1) of Regulation No 207/2009, but to the possibility of concluding that the requirement for genuine use of a trade mark within the meaning of that provision is satisfied when a registered mark that has acquired its distinctive character as a result of the use of another composite mark, of which it is one of the elements, is used only as part of that composite mark, or when it is used only in combination with another mark. Therefore, paragraph 34 of the Colloseum Holding judgment cannot be read as meaning that the requirements for assessing the territorial scope that permits the registration of a mark in consequence of its use are analogous to the requirements permitting the preservation of the rights of the proprietor of a registered mark.

The Court also notes that, with regard to the genuine use of an EU mark that is already registered, there is no analogous provision to that in Article 7(2) of Regulation No 207/2009, with the result that it cannot automatically be assumed that there is no such use simply because that the mark concerned has not been used in part of the European Union. Thus, whilst it was justified to expect that an EU trade mark should be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which an EU trade mark has been registered is in fact restricted to the territory of a single Member State, with the result that use of that trade mark on that territory might satisfy the condition for genuine use of an EU trade mark.

In the second place, as regards the acquisition by a trade mark of distinctive character in consequence of the use which has been made of it, the Court refers to its case-law, whereby a sign can be registered as an EU trade mark under Article 7(3) of Regulation No 207/2009 only if evidence is provided that it has acquired, in consequence of the use which has been made of it, distinctive character in the part of the European Union in which it did not, ab initio, have such character. That part of the Union may, in some circumstances, be comprised of a single Member State. Therefore, with regard to a mark that is, ab initio, devoid of distinctive character across all Member States, such a mark can be registered pursuant to that provision only if it is proved that it has acquired distinctive character through use throughout the territory of the European Union. In addition, the Court points out that it does not follow from the judgment of 24 May 2012,

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[58] Within the meaning of Article 15(1) of Regulation No 40/94 and Article 15(1) of Regulation No 207/2009.

[59] Judgment of 19 December 2012, Leno Merken (C-149/11, EU:C:2012:816).

Chocoladefabriken Lindt & Sprüngli v OHIM (C-98/11 P, EU:C:2012:307, paragraph 62), that, where a mark is devoid of inherent distinctive character throughout the European Union, it is sufficient, in order for it to be registered as an EU trade mark, to prove that it has acquired distinctive character through use in a significant part of the European Union, even though such evidence has not been provided in respect of every Member State.

In the third and last place, as regards evidence of the acquisition of distinctive character through use, the Court finds that as no provision of Regulation No 207/2009 requires that the acquisition of distinctive character through use be established by separate evidence in each individual Member State, it is not inconceivable that the evidence provided to establish that a particular sign has acquired distinctive character through use is relevant with regard to several Member States, or even to the whole of the European Union. In particular, it is possible that, for certain goods or services, the economic operators have grouped several Member States together in the same distribution network and have treated those Member States, especially for marketing strategy purposes, as if they were one and the same national market. In such circumstances, the evidence for the use of a sign within such a cross-border market is likely to be relevant for all Member States concerned. The same is true when, due to geographic, cultural or linguistic proximity between two Member States, the relevant public of the first has sufficient knowledge of the goods and services that are present on the national market of the second.

It follows from those findings that, although it is not necessary, for the purposes of registering, on the basis of Article 7(3) of Regulation No 207/2009, a mark that is, ab initio, devoid of distinctive character throughout all the Member States of the European Union, that evidence be submitted, in respect of each individual Member State, of the acquisition by that mark of distinctive character through use, the evidence submitted must be capable of establishing such acquisition throughout the Member States of the European Union. That said, the question of whether the evidence submitted is sufficient to prove a particular sign's acquisition through use of distinctive character in the part of the territory of the European Union in which that sign did not, ab initio, have distinctive character is a matter of the assessment of evidence, for which the bodies of EUIPO are primarily responsible. Such an assessment is subject to the scrutiny of the General Court, which, where an action is brought before it against a decision of a Board of Appeal, has exclusive jurisdiction to find the facts and, therefore, to appraise them. However, that assessment of the facts does not, save where the evidence has been distorted by the General Court, constitute a point of law which is subject, as such, to review by the Court of Justice in an appeal. Nevertheless, if the bodies of EUIPO or the General Court, after having assessed all of the evidence that has been submitted to them, find that some of that evidence is sufficient to prove the acquisition by a particular sign of distinctive character through use in the part of the European Union in which it is, ab initio, devoid of distinctive character and therefore to justify its registration as an EU trade mark, they must clearly state that that is the case in their respective decisions.

II. Relative grounds for refusal of registration

1. Likelihood of confusion

Judgment of 9 July 2003, Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO BEVERLY HILLS) (T-162/01, [EU:T:2003:199])

(Community trade mark – Opposition procedure – Earlier figurative and word marks containing the word GIORGI – Application for Community word mark GIORGIO BEVERLY HILLS – Relative ground for refusal – Article 8(1)(b) of Regulation (EC) No 40/94)

Giorgio Beverly Hills, Inc. filed an application with OHIM for registration of a Community for the word sign GIORGIO BEVERLY HILLS for products in various classes within the meaning of the Nice Agreement. [60]

Laboratorios RTB filed a notice of opposition in relation to the registration of that Community trade mark on the ground that there was a likelihood of confusion between the mark claimed and the earlier figurative marks containing the word signs J GIORGI, GIORGI LINE and MISS GIORGI, owned by the applicant.

OHIM's Opposition Division rejected the opposition on the ground that the differences between the conflicting signs was unlikely to cause confusion in the mind of the public in Spain, where the earlier marks are protected.

The applicant filed an appeal with OHIM against the Opposition Division's decision, which was dismissed the Board of Appeal. The Board essentially held that, notwithstanding the identity of the goods, there were sufficient differences between the mark claimed GIORGIO BEVERLY HILLS and the earlier figurative marks containing the word signs J GIORGI, GIORGI LINE and MISS GIORGI to exclude any likelihood of confusion.

The applicant filed an appeal with the Court against the Board's decision.

In that regard, the Court holds that there is no risk of the Spanish public being confused between the word mark GIORGIO BEVERLY HILLS, for which registration as a Community trade mark is sought in respect of toilet soaps, perfumes, etc. falling within class 3 of the Nice Arrangement and figurative marks including the word signs J GIORGI, GIORGI LINE and MISS GIORGI, previously registered in Spain to designate perfumes and cosmetics in the same class. Even though there is identity and similarity between the goods covered by the conflicting marks, the visual, aural and conceptual differences between the signs constitute sufficient grounds for discounting the existence of that risk, so that one of the

[60] The goods concerned were in Classes 3, 14, 18 and 25 of the Nice Agreement.

conditions for applying Article 8(1)(b) of Regulation No 40/94 on the Community trade mark is not satisfied.

Judgment of 22 January 2009, Commercy v OHIM – easyGroup IP Licensing (easyHotel) (T-316/07, EU:T:2009:14)

(Community trade mark – Invalidity proceedings – Community word mark easyHotel – Earlier national word mark EASYHOTEL – Relative ground for refusal – Lack of similarity of the goods and services − Articles 8(1)(b) and 52(1)(a) of Regulation (EC) No 40/94 – Legal aid – Application lodged by the receiver for a commercial company – Article 94(2) of the Rules of Procedure)

EasyGroup IP Licensing Ltd filed an application for registration of a Community trade mark with OHIM for the word sign easyHotel for various goods and services. [61] Commercy AG filed an application for a declaration that the trade mark at issue was invalid based on the earlier national word mark EASYHOTEL, registered in Germany for various goods and services. EasyGroup IP Licensing surrendered the trade mark at issue in respect of certain goods and services.

The Cancellation Division rejected the application for invalidity on the ground that one of the necessary conditions for the application of Article 8(1)(b) of Regulation No 40/94 was not fulfilled, namely the identical nature or similarity of the goods and services covered by the two marks. In its decision, the Board of Appeal dismissed the appeal and upheld the decision of the Cancellation Division. In essence, it found that the goods and services concerned were neither identical nor similar and that, consequently, Article 8(1)(b) of Regulation No 40/94 did not apply.

The Court dismissed the appeal against the decision of the Board of Appeal, taking the view, in the first place, that a declaration of invalidity based on Article 8(1) of the regulation can be brought only by the proprietors of the earlier marks cited in support of that application, or by licensees authorised by those proprietors. [62] A receiver in insolvency proceedings regarding a commercial undertaking which is the proprietor of the earlier marks in question does not fall into either of those two categories. Therefore, an application for a declaration of invalidity brought by that receiver in his own name has to be declared inadmissible.

Where the undertaking concerned made the application for a declaration that a Community trade mark is invalid, relying on earlier marks of which it is the proprietor, it is that company – where appropriate, represented by a receiver – which is entitled to bring proceedings against the decisions of the Cancellation Division and the Board of Appeal.

[61] The goods and services in respect of which registration of the mark was sought are in Classes 9, 16, 25, 32, 33, 35, 36, 38, 39, 41 and 42 of the Nice Agreement.

[62] Article 55(1)(b) of Regulation No 40/94 on the Community trade mark, read in conjunction with Article 42(1) and Article 52(1) of that regulation.

However, an appeal before the Board of Appeal and an action before the Court brought by the receiver in insolvency proceedings of the same company in its own name must be dismissed on the ground that they were brought [63] by a person who is not entitled to bring proceedings against those decisions.

In the second place, the Court takes the view that there is no likelihood of confusion [64] for the public at large between the word sign easyHotel, for which registration as a mark is sought for services in classes 39 and 42 within the meaning of the Nice Agreement and for goods and services in classes 16, 25, 32, 33, 35, 36 and 41, and the word sign EASYHOTEL, previously registered in Germany for computer software in classes 9 and 42, respectively, within the meaning of that agreement.

The goods and services concerned differ in respect of their nature, intended purpose and method of use and are neither in competition with each other nor complementary. The relevant goods and services covered by the earlier trade mark are computer-related whereas the information, booking and reservation services covered by the mark applied for are different and use computer technology only to support the transmission of information or to make it possible to reserve hotel accommodation or travel.

The relevant goods and services covered by the earlier trade mark are especially intended for businesses in the hotel and travel sector and the information, booking and reservation services covered by the trade mark applied for are intended for the public at large. In addition, the goods and services covered by the earlier mark are used to enable a software system, and, more specifically, an internet shop, to function, whereas the information, booking and reservation services covered by the trade mark applied for are used to reserve hotel accommodation or travel. The mere fact that the information, booking and reservation services covered by the trade mark applied for are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

In the third and last place, complementary goods or services are those between which there is a close connection, in the sense that one is indispensable or important for the use of the other with the result that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services.

That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the

[63] Contrary to what is envisaged by Articles 58 and 63(4) of Regulation No 40/94, respectively.

[64] Within the meaning of Article 8(1)(b) of Regulation No 40/94.

other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.

Judgment of 18 June 2009, L'Oréal and Others (C-487/07, EU:C:2009:378)

(Directive 89/104/EEC – Trade marks – Article 5(1) and (2) – Use in comparative advertising – Right to have such use prevented – Taking unfair advantage of the repute of a trade mark – Impairment of the functions of the trade mark – Directive 84/450/EEC – Comparative advertising – Article 3bis (1)(g) and (h) – Conditions under which comparative advertising is permitted – Taking unfair advantage of the reputation of a trade mark – Presentation of goods as imitations or replicas)

L'Oréal SA, Lancôme parfums et beauté & Cie SNC and Laboratoire Garnier & Cie are members of the L'Oréal group, which produces and markets fine fragrances. They are proprietors of the well-known trade marks Trésor, Miracle, Anaïs-Anaïs and Noa.

Malaika and Starion market imitations of those fine fragrances in the United Kingdom, produced by Bellure. The bottles and packaging used to market those imitations are generally similar in appearance to those used by L'Oréal, which are protected by word and figurative marks. Those companies use comparative lists, which they provide to their retailers and which indicate the word mark of the fine fragrance of which the perfume being marketed is an imitation.

L'Oréal brought proceedings before the High Court of Justice of England & Wales, Chancery Division, [United Kingdom], against Bellure, de Malaika et de Starion, alleging infringement of their trade mark rights.

The national court asked the Court of Justice to clarify the interpretation of certain provisions of the Trade Mark Directive and of the Directive concerning misleading and comparative advertising. [65]

As regards the use of packaging and bottles similar to those of the fine fragrances marketed by L'Oréal, the Court was asked whether a third party using a sign similar to a trade mark with a reputation can be held to take unfair advantage of the mark where such use gives that party an advantage in the marketing of his goods or services, without, however, giving rise, as far as the public is concerned, to a likelihood of confusion or causing detriment to the proprietor of the mark.

The Court's reply to that question is in the affirmative. It accordingly holds that the taking of unfair advantage of the distinctive character or the repute of a trade mark does not

[65] Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising (OJ L 250, p. 17), as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 (OJ L 290).

require that there be a likelihood of confusion or a likelihood of detriment to the proprietor of the mark. It considers that in order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of a mark, it is necessary to undertake a global assessment, taking into account in particular the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods concerned. In the present case, Malaika and Starion obtain a commercial advantage from the fact that, in the marketing of their 'downmarket' imitations, they use packaging and bottles similar to those used by L'Oréal for its luxury fragrances. Moreover, the similarity was intentionally created in order to create an association in the mind of the public with the aim of facilitating the marketing of the products. The Court finds that in those circumstances account must in particular be taken of the fact that the use of packaging and bottles similar to those of the fragrances that are being imitated is intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances are marketed. The Court holds that where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make any efforts of its own in that regard, the marketing effort expended by the proprietor of the mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.

As regards the comparison lists of perfumes indicating the names of L'Oréal's luxury fragrances protected by the word marks, the Court holds, first, that such lists may constitute comparative advertising. Next, it points out that the use by an advertiser, in a comparative advertisement, of a sign identical with or similar to the mark of a competitor may be prevented, where appropriate, by virtue of the Trade Marks Directive, unless it satisfies all the conditions laid down in the Directive concerning misleading and comparative advertising under which comparative advertising is permitted. The Court considers in that context that the proprietor of a trade mark is entitled to prevent the use by a third party of a sign identical with that mark, even where such use is not capable of jeopardising the essential function of the mark, which is to indicate the origin of the goods or services, provided that such use affects or is liable to affect one of the other functions of the mark, such as, in particular, the functions of communication, investment or advertising. As regards the question whether the comparison lists of perfumes satisfy all of the conditions laid down by the Directive on misleading and comparative advertising as regards the circumstances in which comparative advertising is permitted, the Court holds that that directive prohibits an advertiser from stating in comparative advertising that the product marketed by him constitutes an imitation or replica of the product or the service covered by the trade mark. The object and effect of the comparison lists is to draw the attention of the relevant public to the original fragrance of which the perfumes marketed by Malaika and Starion are purportedly an imitation. The Court holds that those lists thus attest to the fact that those perfumes are imitations of the fragrances marketed by L'Oréal and that they consequently present the goods marketed by the advertiser as being imitations of goods bearing a protected trade mark. Lastly, the Court clarifies that the advantage gained by an advertiser as a result of such unlawful comparative advertising must be considered to be an advantage unduly taken of the reputation of the mark, which also contravenes the requirements laid down under the Directive on misleading advertising and comparative advertising.

Judgment of 22 September 2016, combit software (C-223/15, EU:C:2016:719)

(Reference for a preliminary ruling – Regulation (EC) No 207/2009 – European Union trade mark – Unitary character – Finding of a likelihood of confusion in respect of only part of the European Union – Territorial scope of the prohibition referred to in Article 102 of that regulation)

Combit Software GmbH, a company governed by German law, is the proprietor of the German and EU word marks, combit, for goods and services in the computer industry.

Commit Business Solutions, a company governed by Israeli law, sells software bearing the word sign 'Commit' in a number of countries through its website www.commitcrm.com.

Combit Software brought proceedings against Commit Business Solutions before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), seeking, principally, an order that Commit Business Solutions refrain from using, in the European Union, the word sign 'Commit' for the software it was marketing. In the alternative, it requested, in reliance on its German trade mark, an order that Commit Business Solutions refrain from using that word sign in Germany.

The Landgericht Düsseldorf (Regional Court, Düsseldorf) dismissed combit Software's principal claim but upheld its alternative claim.

combit Software brought an appeal before the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), asking the Court to rule on the use of a European Union sign that creating a likelihood of confusion with an EU mark in one part of the European Union, whilst not creating such a likelihood in another part thereof.

In the first place, the Court points out that it has already held, in a case concerning the right of the proprietor of an EU trade mark to oppose registration of a similar EU trade mark which would create a likelihood of confusion, that such an opposition must be upheld where it is established that there is a likelihood of confusion in part of the European Union, a Member State, for example, being capable of constituting such a part. From that the Court infers that a similar approach is necessary in cases concerning the right of the proprietor of an EU trade mark to prohibit the use of a sign which creates a likelihood of confusion because the proprietor of an EU trade mark is protected against any use which adversely affects that trade mark's function of indicating origin or is liable to do so. The proprietor is therefore entitled to prohibit such use, even if the latter adversely affects the abovementioned function only in part of the European Union.

In the second place, the Court takes the view that in order to guarantee the uniform protection which EU trade marks are afforded throughout the entire area of the European Union, the prohibition on proceeding with acts which infringe or would infringe an EU trade mark must, as a rule, extend to the whole of that area.

However, in a situation in which an EU trade mark court finds that the use of the similar sign in question for goods that are identical to those for which the EU trade mark at issue is registered does not, in a given part of the European Union, create any likelihood of confusion, in particular for linguistic reasons, and therefore cannot, in that part of the Union, adversely affect the trade mark's function of indicating origin, that court must limit the territorial scope of the aforementioned prohibition.

Where an EU trade mark court concludes, on the basis of information which must, as a rule, be submitted to it by the defendant, that there is no likelihood of confusion in a part of the European Union, legitimate trade arising from the use of the sign in question in that part of the European Union cannot be prohibited. Such a prohibition would go beyond the exclusive right conferred by the EU trade mark, as that right merely permits the proprietor of that mark to protect his specific interests as such, that is to say, to ensure that the mark is able to fulfil its functions.

A finding that there is no likelihood of confusion in a part of the European Union may, in accordance with the Court's settled case-law, be based only on an examination of all the relevant factors in the case concerned. The assessment must include a visual, phonetic or conceptual comparison of the signs at issue, bearing in mind, in particular, their distinctive and dominant components.

It is also important that the EU trade mark court concerned identifies with precision the part of the European Union in respect of which it finds there to be no actual or potential adverse effect on the functions of the trade mark, so that it is absolutely clear from the order issued under Article 102 of Regulation No 207/2009 on the European Union trade mark which part of the Union is not covered by the prohibition on using the sign in question. Where that court intends to exclude from the prohibition on use certain linguistic areas of the European Union such as those designated by the term 'English-speaking', it must state comprehensively which areas it intends that term to cover.

An interpretation whereby a prohibition on the use of a sign creating a likelihood of confusion with an EU trade mark applies to the entire area of the European Union, with the exception of the part of that area for which there has been found to be no such likelihood of confusion, does not undermine the unitary character of the EU trade mark referred to in Article 1(2) of Regulation No 207/2009, since the right of the proprietor of the trade mark to prohibit all use which adversely affects the functions inherent in that mark is preserved.

Finally, the Court concludes that Article 1(2), Article 9(1)(b) and Article 102(1) of Regulation No 207/2009 must be interpreted as meaning that, where an EU trade mark court finds that the use of a sign creates a likelihood of confusion with an EU trade mark in one part of the European Union whilst not creating such a likelihood in another part thereof, that court must conclude that there is an infringement of the exclusive right conferred by that trade mark and issue an order prohibiting the use in question for the entire area of the European Union with the exception of the part in respect of which there has been found to be no likelihood of confusion.

Judgment of 25 July 2018, Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe (C-129/17, EU:C:2018:594)

(Reference for a preliminary ruling – EU trade mark – Directive 2008/95/EC – Article 5 – Regulation (EC) No 207/2009 – Article 9 – Trade mark proprietor entitled to oppose removal by a third party of all the signs identical to that trade mark and the affixing of new signs on goods identical to those for which the trade mark has been registered with a view to importing or placing them on the market in the European Economic Area (EEA))

Mitsubishi Shoji Kaisha Ltd (Mitsubishi), established in Japan, was the proprietor of the EU word mark MITSUBISH, [66] the EU figurative mark MITSUBISHI, [67] the Benelux word mark MITSUBISHI [68] and the Benelux figurative mark MITSUBISHI [69] (the Mitsubishi marks).

Mitsubishi Caterpillar Forklift Europe BV (MCFE), established in the Netherlands, was exclusively authorised to manufacture and place on the market in the European Economic Area (EEA) forklift trucks supplied under the Mitsubishi mark.

Duma Forklifts NV, established in Belgium, had as its main activity the worldwide purchase and sale of new and second hand forklift trucks. It also offers for sale its own forklift trucks under the names GSI, GS and Duma. It was previously an official subdealer of Mitsubishi forklift trucks in Belgium.

G.S. International BVBA (GSI), also established in Belgium, was affiliated with Duma, and they had the same director and head office. It constructed and repaired forklift trucks which it imported and exported wholesale, with their components, on the world market. It

[66] Registered on 24 September 2001 under number 118042 for, inter alia, goods in Class 12 of the Nice Agreement, including motor vehicles, electric vehicles and forklift trucks.

[67] Registered on 3 March 2000 under number 117713 designating, in particular, goods in Class 12 of the Nice Agreement, including motor vehicles, electric vehicles and forklift trucks.

[68] Registered on 1 June 1974 under number 93812, designating inter alia goods in Class 12, including land vehicles and means of transport, and Class 16, including books and printed matter.

[69] Registered on 1 June 1974 under the number 92755, designating inter alia goods in Class 12, including land vehicles and means of transport, and Class 16, including books and printed matter, identical with the EU trade mark.

adapted them to the applicable European standards, gave them their own serial numbers and delivered them to Duma, providing EU declarations of conformity.

Asked to rule in particular on the question of whether the parallel import into the EEA of forklift trucks bearing the Mitsubishi marks was a breach of the law on trade marks, the hof van beroep te Brussel (Court of Appeal, Brussels, Belgium) decided to stay proceedings and to refer the question to the Court of Justice for a preliminary ruling.

In the first place, the Court takes the view that Article 5(1) of Directive 2008/95 and Article 9(1) of Regulation No 207/2009, which are identical in their content, must be interpreted in the same way.

In the second place, the Court holds that in order to ensure the protection of the rights conferred by the trade mark, it is essential that the proprietor of the trade mark registered in one or several Member States can control the first placing of goods bearing that mark on the market in the EEA. It also follows from the Court's case-law that that right of the proprietor applies to every individual type of that product.

In the third place, according to the Court, the function of the advertising of the mark is that of using a mark for advertising purposes designed to inform and persuade consumers. Accordingly, the proprietor of a trade mark is entitled inter alia to prohibit a third party from using, without the proprietor's consent, a sign identical with its trade mark in relation to goods or services which are identical to those for which that trade mark is registered, when that use adversely affects the proprietor's use of its mark as a factor in sales promotion or as an instrument of commercial strategy.

In the fourth place, the Court notes that as regards the concept of 'use in the course of trade', the list of types of use that the proprietor of the trade mark may prohibit, contained in Article 5(3) of Directive 2008/95 and Article 9(2) of Regulation No 207/2009, is not exhaustive.

In the fifth place, the Court concludes that Article 5 of Directive 2008/95 and Article 9 of Regulation No 207/2009 on the EU trade mark must be interpreted as meaning that the proprietor of a mark is entitled to oppose a third party, without his consent, removing all the signs identical to that mark and affixing other signs on the products placed in the customs warehouse, such as in the main proceedings, with a view to importing them or trading them in the EEA where they have never yet been marketed.

Nevertheless, it must be observed, first, that the removal of signs identical to the mark prevents the goods for which that mark is registered from bearing that mark the first time that they are placed on the market in the EEA and, hence, deprives the proprietor of that trade mark of the benefit of the essential right, which is conferred on him by the case-law recalled in paragraph 31 above, to control the initial marketing in the EEA of goods bearing that mark.

Secondly, the removal of the signs identical to the mark and the affixing of new signs on the goods with a view to their first placing on the market in the EEA adversely affects the functions of the mark.

Thirdly, by infringing the trade mark proprietor's right to control the first placing of goods bearing that mark on the market in the EEA and by adversely affecting the functions of the mark, the removal of the signs identical to the mark and affixing of new signs on the goods by a third party, without the consent of the proprietor, with a view to importing into or placing those goods on the market in the EEA and with the aim of circumventing the proprietor's right to prohibit the importation of those goods bearing its mark, is contrary to the objective of ensuring undistorted competition.

Finally, the Court considers that, concerning the concept of 'use in the course of trade', an operation consisting, on the part of the third party, of removing signs identical to the trade mark in order to affix its own signs, involves active conduct on the part of that third party, which, since it is done with a view to importing those goods into the EEA and marketing them there and is therefore carried out in the exercise of a commercial activity for economic advantage, may be regarded as a use in the course of trade. In that context, the Court also observes that Article 9(4) of the regulation on the EU trade mark, [70] which applies to the facts in the main proceedings with effect from 23 March 2016, entitles the proprietor from that date to prevent all third parties from bringing goods, in the course of trade, into the European Union without being released for free circulation there, where those goods, including packaging, come from third countries and bear without authorisation a mark which is identical to the EU trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that mark. That entitlement of the trade mark proprietor lapses only if, during the proceedings to determine whether the registered trade mark has been infringed, evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

2. Non-registered trade mark used in the course of trade

Judgment of 11 November 2020, EUIPO v John Mills (C-809/18-P, EU:C:2020:902)

(Appeal – EU trade mark – Regulation (EC) No 207/2009 – Opposition proceedings – Relative ground for refusal – Article 8(3) – Scope – Identity or similarity of the mark applied for to the earlier mark – EU word mark MINERAL MAGIC – Application for registration by the agent or representative of the

[70] Regulation No 207/2009, as amended by Regulation No 2015/2424.

proprietor of the earlier mark – Earlier national word mark MAGIC MINERALS BY JEROME ALEXANDER)

Jerome Alexander Consulting Corp. is the proprietor of the American word mark 'MAGIC MINERALS BY JEROME ALEXANDER', designating the goods 'Face powder featuring mineral enhancements'. John Mills Ltd is responsible, under a distribution agreement, for distributing the goods of Jerome Alexander Consulting within the European Union and worldwide.

On 18 September 2013, John Mills applied, in its own name, for registration of the word sign 'MINERAL MAGIC' as a European Union trade mark for cosmetics. Jerome Alexander Consulting filed a notice of opposition relying on Article 8(3) of Regulation No 207/ 2009 1, according to which 'a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent'.

The opposition was rejected. However, the Board of Appeal of EUIPO annulled the Opposition Division's decision and refused to register the mark MINERAL MAGIC. In that regard, the Board of Appeal found that that mark had been applied for by John Mills in its capacity as an 'agent' and without the proprietor's consent. It also noted that the goods covered by the marks at issue were identical or similar and that the signs were similar.

John Mills brought an action before the General Court in which the latter annulled the Board of Appeal's decision on the ground that Article 8(3) of Regulation No 207/2009 applies only where marks are identical.

The Court of Justice, hearing an appeal lodged by EUIPO, sets aside the judgment of the General Court and rules that the application of Article 8(3) of Regulation No 207/2009 is not limited solely to the situation in which the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark are identical.

In the first place, the Court finds that the provision of Article 8(3) of the regulation on EU trade marks does not explicitly state whether it applies only in the case where the mark applied for by an agent or representative is identical to the earlier mark. The Court's examination of the travaux préparatoires reveals that it cannot be inferred from these that the scope of that provision is limited solely to cases in which the marks at issue are identical. By contrast, it is apparent from the travaux préparatoires that Article 8(3) of Regulation No 207/2009 reflects the choice of the EU legislature to reproduce, in essence, Article 6 septies(1) of the Paris Convention. [71] The Court concluded that the General Court should have taken into account the travaux préparatoires relating to that convention, [72]

[71] Paris Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883, last revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaties* Series, Vol. 828, No. 11851, p. 305).

[72] Proceedings at the Lisbon Conference, held from 6 to 31 October 1958 for the purpose of revising the Paris Convention, during which Article 6 septies was introduced.

from which it is apparent that the mark applied for by the agent or representative of the proprietor of the earlier mark may also be covered by the Paris Convention where the mark applied for is similar to that earlier mark.

In the second place, the Court states that a different interpretation would have the effect of calling into question the general scheme of Regulation No 207/2009, in that it would result in the proprietor of a mark being deprived of the possibility of opposing the registration of a similar mark by his agent or representative, even though the latter would be entitled to file a notice of opposition to the application for subsequent registration of the initial mark by that proprietor on the ground of its similarity to the mark registered by the agent or representative of that proprietor.

In the third place, the Court finds that the objective of Article 8(3) of Regulation No 207/2009 is to prevent the misuse of the earlier mark by the agent or representative of the proprietor of that mark, as those persons may improperly benefit from the effort and investment which the proprietor himself has made. Such misuse is also likely to occur where the marks at issue are similar.

Lastly, the Court finds that the action brought by John Mills is in a state ready to be adjudicated on and that it is appropriate to give a final ruling on it.

John Mills criticised the Board of Appeal for finding that it was an ‘agent’ of Jerome Alexander Consulting. According to the Court, the concepts of ‘agent’ and ‘representative’ must be interpreted broadly, so as to cover all forms of relationship based on a contractual agreement under which there is some agreement or commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark.

In that regard, the Court finds that John Mills was a preferred distributor of Jerome Alexander Consulting goods and that there was a non-competition clause and provisions relating to the intellectual property rights with respect to those goods. The Board of Appeal was therefore right to find that John Mills was an ‘agent’ of Jerome Alexander Consulting.

With regard to the assessment of similarity between the marks at issue, the Court emphasises that, for the purposes of applying Article 8(3) of Regulation No 207/2009, similarity is not determined on the basis of the existence of a likelihood of confusion. So far as the goods are concerned, the Court recalls that the essential function of a trade mark is to indicate the commercial origin of the goods or services covered. Consequently, the application of Article 8(3) of Regulation No 207/2009 cannot be precluded where the goods or services covered by the mark applied for and those covered by the earlier mark are similar.

In the present case, the Court holds that the signs at issue are similar and that the goods are, in part, identical and, in part, similar.

Accordingly, the action brought by John Mills is dismissed in its entirety.

3. Reputed trade mark

Judgment of 22 March 2007, Sigla v OHIM – Elleni Holding (VIPS) (T-215/03, EU:T:2007:93)

(Community trade mark – Opposition proceedings – Application for the Community word mark VIPS – Earlier national word mark VIPS – Article 8(5) of Regulation (EC) No 40/94 – Article 74 of Regulation (EC) No 40/94 – Principle that the parties delimit the subject matter of the proceedings – Rights of the defence)

On 7 February 1997, Elleni Holding BV filed an application at OHIM for a Community trade mark. The trade mark in respect of which registration was sought ('the mark applied for') is the word mark VIPS. [73] On 14 September 1999, Sigla filed a notice of opposition [74] against the registration of the mark applied for.

The Opposition Division of OHIM [75] upheld the opposition in respect of the services in Class 42 and rejected it in respect of the goods and services in Classes 9 and 35. The Board of Appeal, [76] however, upheld Elleni Holding's appeal and annulled the decision of the Opposition Division. According to the Board of Appeal, the applicant had proven the reputation of its earlier mark in Spain, but had not put forward the grounds on which the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Hearing an appeal brought by Sigla SA, the Court annuls the decision of the Board of Appeal.

In this regard, the Court states, first, that Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services, must be interpreted as meaning that it may be relied on in support of an opposition lodged against an application for a Community trade mark covering goods and services which are not identical and not similar to those described by the earlier mark as well as against an application for a Community trade mark covering goods which are identical or similar to

[73] The goods and services in respect of which registration was sought are 'computers and computer programs recorded on tapes and disks' (Class 9), 'Business consultancy; services relating to the processing of data recorded by computer' (Class 35); services relating to the processing of data recorded by computer' (Class 35) and 'Computer programming; hotel services, restaurants, cafés' (Class 42) of the Nice Agreement.

[74] Under Article 42(1) of Regulation No 40/94.

[75] Decision 2221/2000 of 28 September 2000.

[76] Decision of 1 April 2003 (the contested decision), notified to the applicant on 3 April 2004.

those of the earlier mark. That article cannot be given an interpretation which would lead to marks with a reputation having less protection where a sign is used for identical or similar goods or services than where a sign is used for non-similar goods or services. The Court clarifies that said provision, Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services, allows, inter alia, the proprietor of the earlier mark to oppose registration of marks liable to be detrimental to the distinctive character of the earlier mark. That detriment can occur where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used. That risk thus refers to the 'dilution' or 'gradual whittling away' of the earlier mark through the dispersion of its identity and its hold upon the public mind. However, the risk of dilution appears, in principle, to be lower if the earlier mark consists of a term which, because of a meaning inherent in it, is very common and frequently used, irrespective of the earlier mark consisting of the term at issue. In such a case, reuse of the term in question by the mark applied for is less likely to result in a dilution of the earlier mark. Detriment as referred to in Article 8(5) of Regulation No 40/94 also occurs where the goods or services covered by the mark applied for may appeal to the public's senses in such a way that the earlier mark's power of attraction is diminished. The risk of that detriment can, inter alia, occur where those goods or services have a characteristic or a quality which may have a negative influence on the image of an earlier mark with a reputation on account of its being identical or similar to the mark applied for.

The Court then states that the concept of the unfair advantage taken of the distinctive character or the repute of the earlier mark by the use without due cause of the mark applied for encompasses instances where there is clear exploitation and 'free-riding on the coat-tails' of a famous mark or an attempt to trade upon its reputation. In other words, the risk of free-riding is the risk that the image of the mark with a reputation or the characteristics which it projects will be transferred to the goods covered by the mark applied for, with the result that the marketing of those goods will be made easier by that association with the earlier mark with a reputation. That last type of risk must be distinguished from the likelihood of confusion covered by Article 8(1)(b) of Regulation No 40/94. In cases covered by Article 8(5) of Regulation No 40/94, the relevant section of the public makes a connection, that is to say, establishes a link, between the marks at issue without, however, confusing them. Therefore, the existence of a likelihood of confusion is not a condition for the application of that provision.

According to the Court, the purpose of Article 8(5) of Regulation No 40/94 is not to prevent the registration of any mark which is identical or similar to a mark with a reputation. Thus, the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark. He must however adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment. In that context, it is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non- hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it cannot be assumed that this is always the case.

Lastly, the Court clarifies that the existence of a link between the mark applied for and the earlier mark is an essential condition for the application of Article 8(5) of Regulation No 40/94. In the present case, the existence of a connection between the services covered by the word mark VIPS, for which registration as a mark is sought for software and services in Classes 9, 35 and 42 of the Nice Agreement, and services covered by the word mark VIPS, previously registered in Spain for services in Class 42 of the Nice Agreement, is not sufficient, in the absence of other relevant factors, to adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or that use of the mark is detrimental to the distinctive character or repute of the earlier mark or takes unfair of it within the meaning of Article 8(5) of Regulation No 40/94. First, since the term 'VIPS' is the plural form, in English, of the abbreviation VIP, which is widely and frequently used both internationally and nationally to describe famous personalities, the risk that the use of the mark applied for would be detrimental to the distinctive character of the earlier mark is limited. That same risk is also even less probable in the present case as the mark applied for covers services which are directed at a special and necessarily more limited public. Second, the services covered by the mark applied for do not have any characteristic or quality capable of establishing the likelihood of detriment to the earlier mark by use of the mark for which registration is sought. The mere existence of a connection between the services covered by the conflicting marks is neither sufficient nor determinative. It is true that the existence of such a connection strengthens the probability that the public, faced with the mark applied for, would also think of the earlier mark. However, that factor is not, in itself, sufficient to diminish the earlier mark's power of attraction. Such an outcome can arise only if it is established that the services covered by the mark applied for have characteristics or qualities which are potentially detrimental to the reputation of the earlier mark. Third, the risk of unfair advantage being taken of the distinctive character or the repute of the earlier mark would occur only if the relevant public, without confusing the origin of the services covered by the conflicting marks, were particularly attracted to applicant's software solely because it is covered by a mark which is identical to the earlier mark with a reputation. In the absence of an explanation by the applicant of the particular characteristics which it claims its earlier mark has and of the way in which those characteristics are capable of facilitating the marketing of the services covered by the mark applied for, the characteristics normally associated with a mark with a reputation for a fast food chain cannot be considered in themselves to be such as to bring any advantage to computer programming services, even those intended for hotels or restaurants.

Judgment of 22 September 2011, Interflora and Interflora British Unit (C-323/09, EU:C:2011:604)

(Trade marks – Keyword advertising on the internet – Selection by the advertiser of a keyword corresponding to a competitor's trade mark with a reputation – Directive 89/104/EEC –

Article 5(1)(a) and (2) – Regulation (EC) No 40/94 – Article 9(1)(a) and (c) – Condition that one of the trade mark's functions be adversely affected – Detriment to the distinctive character of a trade mark with a reputation ('dilution') – Unfair advantage taken of the distinctive character or repute of that trade mark ('free-riding'))

Interflora British Unit is a licensee of Interflora Inc, a company incorporated in the United States that operates a worldwide flower-delivery network. The network of Interflora is made up of florists with whom customers may place orders in person, by telephone, or via the internet, those orders then being fulfilled by the network member closest to the place where the flowers are to be delivered.

INTERFLORA is a national trade mark in the United Kingdom and also a Community trade mark. Those marks have a substantial reputation both in the United Kingdom and in other Member States of the European Union.

Marks & Spencer plc ('M & S'), a company governed by English law, is one of the main retailers in the United Kingdom. One of those services is the sale and delivery of flowers. That commercial activity is in competition with that of Interflora.

It transpires that M & S, in the Google referencing service AdWords, selected the term 'Interflora' and its variants ('Interflora Flowers', 'Interflora Delivery', 'Interflora.com', 'Interflora co uk', etc.) as keywords. Consequently, when internet users entered the word 'Interflora' or one of those variants as a search term in the Google search engine, an M & S advertisement appeared.

Hearing proceedings brought by Interflora against M & S for alleged trade mark infringement, the High Court of Justice (England & Wales), Chancery Division, referred a number of questions to the Court of Justice for a preliminary ruling on several aspects of unauthorised use by a competitor, in an internet referencing service, of keywords identical to a trade mark. [77]

The Court observes that in the event of use by a third party of a sign identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, the proprietor of the mark is entitled to prevent such use only if it is liable to have an adverse effect on one of the 'functions' of the mark. Its essential function is to guarantee to consumers the origin of the goods or service covered by the trade mark (providing an indication of origin), the other functions being in particular, advertising and investment. The Court notes in this regard that the function of indicating the origin of the mark is not the only function worthy of protection against injury by third parties. A trade mark is often – in addition to an indication of the origin of the goods or services – an instrument of commercial strategy used, inter alia, for advertising purposes or to acquire a reputation in order to develop consumer loyalty.

[77] Directive 89/104 and Regulation No 40/94.

Referring to its Google case-law, [78] the Court recalls that the trade mark's origin function is adversely affected when the third party's advertisement displayed as a result of clicking a keyword corresponding to the trade mark does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the advertisement originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party. However, use of a sign identical with another person's trade mark in a referencing service such as 'AdWords' does not have an adverse effect on the trade mark's advertising function.

The Court also examines, for the first time, the protection of the trade mark's investment function. Thus, the use by a competitor of a sign identical to the trade mark in relation to identical goods or services has an adverse effect on that function where that use substantially interferes with the proprietor's use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty. In a situation in which the trade mark already enjoys a reputation, the investment function is adversely affected where such use affects that reputation and thereby jeopardises its maintenance.

However, it cannot be accepted that the proprietor of a trade mark may prevent such use by a competitor if the only consequence of that use is to oblige the proprietor of that trade mark to adapt its efforts to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty. Similarly, the trade mark proprietor cannot rely on the fact that such use may prompt some consumers to switch from goods or services bearing that trade mark.

In the present case, it is for the national court to determine whether the use, by M & S, of the sign identical with the INTERFLORA trade mark jeopardises the maintenance by Interflora of a reputation capable of attracting consumers and retaining their loyalty.

Also asked about enhanced protection for marks of repute, and in particular, on the scope of the concepts of 'dilution' (detrimental to that distinctive character) or free-riding (taking unfair advantage of the distinctive character or repute of the trade mark), the Court finds, inter alia, that selection, without due cause, in a referencing service, of a sign identical with another person's trade mark can be construed as free-riding. That is particularly likely to be the conclusion in cases in which internet advertisers offer for sale, by means of the selection of keywords corresponding to trade marks with a reputation, goods which are imitations of the goods of the proprietor of those marks.

By contrast, where the advertisement displayed on the internet on the basis of a keyword corresponding to a trade mark with a reputation puts forward an alternative to the goods or services of the proprietor of the trade mark with a reputation – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without causing

[78] Judgment of 23 March 2010, Google France and Google, Joined cases C-236/08 to C-238/08, EU:C:2010:159.

dilution of the mark or detriment to its repute (tarnishment) and without, moreover, adversely affecting the functions of the trade mark – such use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned.

III. Other questions of substantive law

1. Effects of trade marks

Judgment of 12 July 2011 (Grand Chamber), L'Oréal and Others C-324/09, EU:C:2011:474)

(Trade marks – Internet – Offer for sale, on an online marketplace targeted at consumers in the European Union, of trade-marked goods intended, by the proprietor, for sale in third States – Removal of the packaging of the goods – Directive 89/104/EEC – Regulation (EC) No 40/94 – Liability of the online-marketplace operator – Directive 2000/31/EC ('Directive on electronic commerce') – Injunctions against that operator – Directive 2004/48/EC ('Directive on the enforcement of intellectual property rights').

eBay operates a global electronic marketplace on the internet, where individuals and businesses can buy and sell a broad variety of goods and services.

L'Oréal is the owner of a wide range of well-known trade marks. Its products (especially cosmetics and perfumes) are distributed through a closed distribution network, in which authorised distributors are restrained from supplying products to other distributors.

L'Oréal alleged that eBay was involved in trade mark infringements committed by users of its website. Moreover, it claimed that, by purchasing from paid internet referencing services (such as Google's AdWords) keywords corresponding to the names of L'Oréal trade marks, eBay directs its users towards goods that infringe trade mark law, which are offered for sale on its website According to L'Oréal, eBay's efforts to prevent the sale of counterfeit goods on its website were inadequate. L'Oréal identified various forms of infringement, including, inter alia, the sale and offer for sale, to consumers in the EU, of goods bearing L'Oréal's trade marks intended, by L'Oréal, for sale in third States (parallel importation).

Hearing the case, the High Court of Justice (England & Wales), Chancery Division, asked the Court of Justice a number of questions concerning the obligations to which a company operating an internet marketplace may be subject in order to prevent trade mark infringements by its users.

The Court states, as a preliminary point, that the proprietor of the trade mark may rely on his exclusive right as against an individual who sells trade-marked goods online only when those sales take place in the context of a commercial activity. That is the case, in particular, if the sales, owing to their volume and frequency, go beyond the realms of a private activity.

The Court rules first of all on commercial activities directed towards the EU by means of online marketplaces such as eBay. It states that the EU trade mark rules apply to offers for sale and advertisements relating to trade-marked goods located in third States as soon as it is clear that those offers for sale and advertisements are targeted at consumers in the EU.

It is for the national courts to assess, on a case-by-case basis, whether there are any relevant factors on the basis of which it may be concluded that an offer for sale or an advertisement, displayed on an online marketplace, is targeted at EU consumers. Thus, the national courts will be able to take into account the geographic areas to which the seller is willing to dispatch the product.

Next, the Court holds that the operator of an internet marketplace does not itself 'use' trade marks within the meaning of the EU legislation if it provides a service consisting merely in enabling its customers to display on its website, in the course of their commercial activities, signs corresponding to trade marks.

The Court also specifically mentions certain matters concerning the liability of the operator of an online marketplace. Whilst making clear that it is for the national courts to carry out the assessment concerned, the Court considers that the operator plays an active role of such a kind as to give it knowledge of, or control over, the data relating to the offers for sale, when it provides assistance which entails, in particular, optimising the presentation of the online offers for sale or promoting those offers.

When the operator has played an 'active role' of that kind, it cannot rely on the exemption from liability which EU law confers, under certain conditions, on online service providers such as operators of internet marketplaces.

Moreover, even in cases in which the operator has not played an active role of that kind, it cannot rely on that exemption from liability if it was aware of facts or circumstances on the basis of which a diligent economic operator should have realised that the online offers for sale were unlawful and, in the event of it being so aware, failed to act promptly to remove the data concerned from its website or to disable access to them.

Finally, the Court rules on the question of injunctions which may be granted against the operator of an online marketplace when it does not decide, on its own initiative, to bring to an end infringements of intellectual property rights and to prevent further such infringements occurring.

Thus, the operator may be ordered to take measures making it easier to identify the sellers who are its customers. In that regard, although it is necessary to respect the protection of personal data, the fact remains that when the perpetrator of the infringement is operating in the course of trade, and not in a private matter, that person must be clearly identifiable.

Consequently, the Court holds that EU law requires the Member States to ensure that the national courts with jurisdiction in relation to the protection of intellectual property rights are able to order the operator to take measures which contribute, not only to bringing to an end infringements of those rights by the users, but also to preventing further infringements of that kind. Those injunctions must be effective, proportionate, and dissuasive and must not create barriers to legitimate trade.

Judgment of 23 March 2010 (Grand Chamber), Google France and Google C-236/08 to C-238/08, [EU:C:2010:159](EU:C:2010:159))

(Trade marks – Internet – Search engine – Keyword advertising – Display, on the basis of keywords corresponding to trade marks, of links to sites of competitors of the proprietors of those marks or to sites offering imitation goods – Directive 89/104/EEC – Article 5 – Regulation (EC) No 40/94 – Article 9 – Liability of the search engine operator – Directive 2000/31/EC ('Directive on electronic commerce'))

The Community law on trade marks [79] entitles proprietors of trade marks, subject to certain conditions, to prohibit third parties from using signs which are identical with, or similar to, their trade marks for goods or services equivalent to those for which those trade marks are registered.

Google operates an internet search engine. When an internet user performs a search on the basis of one or more key words, the search engine will display the sites which appear best to correspond to those key words, in decreasing order of relevance. These are referred to as the 'natural' results of the search.

In addition, Google offers a paid referencing service called 'AdWords'. That service enables any economic operator, by means of the reservation of one or more keywords, to obtain the placing – in the event of a correspondence between one or more of those words and that/those entered as a request in the search engine by an internet user – of an advertising link to its site, accompanied by an advertising message. That advertising link appears under the heading 'sponsored links', which is displayed either on the right-hand side of the screen, to the right of the natural results, or on the upper part of the screen, above those results.

Louis Vuitton Malletier SA (Vuitton), which is the proprietor of the Community trade mark 'Vuitton' and of the French national trade marks 'Louis Vuitton' and 'LV', Viaticum, which is the proprietor of the French trade marks 'Bourse des Vols', 'Bourse des Voyages' and 'BDV', and Mr Thonet, the proprietor of the French trade mark 'Eurochallenges', became aware that the entry, by internet users, of terms constituting those trade marks into Google's search engine triggered the display, under the heading 'sponsored links', of links

[79] Directive 89/104.

to sites offering imitation versions of Vuitton's products and to sites of competitors of Viaticum and of the Centre national de recherche en relations humaines respectively. They therefore brought separate sets of proceedings against Google for declarations that it had infringed their trade marks.

The Cour de cassation, ruling at last instance in the proceedings brought against Google by the trade mark proprietors, asked the Court of Justice about the lawfulness of the use, as keywords in an internet referencing service, of signs which correspond to trade marks, without consent having been given by the proprietors of those trade marks.

In that regard, the Court notes that, by purchasing the referencing service and selecting, as a keyword, a sign corresponding to another person's trade mark, with the purpose of offering internet users an alternative to the goods or services of that proprietor, an advertiser uses that sign in relation to its goods or services. That is not, however, the case, as regards the referencing service provider when it permits advertisers to select, as keywords, signs identical with trade marks, stores those signs and displays its clients' advertisements on the basis thereof.

The Court states that the use, by a third party, of a sign which is identical with, or similar to, the proprietor's trade mark implies, at the very least, that that third party uses the sign in its own commercial communication. A referencing service provider, however, allows its clients, namely the advertisers, to use signs which are identical with, or similar to, trade marks, but does not itself use those signs.

If a trade mark has been used as a keyword, the proprietor of that trade mark cannot, therefore, rely, as against Google, on the exclusive right which it derives from its mark. By contrast, it can invoke that right against those advertisers which, by means of a keyword corresponding to its mark, arrange for Google to display ads which make it impossible, or possible only with difficulty, for average internet users to establish from what undertaking the goods or services covered by the ad originate.

In such a situation – which is characterised by the fact that the ad in question appears immediately after the trade mark has been entered as a search term by the internet user concerned and is displayed at a point when the trade mark, in its capacity as a search term, is also displayed on the screen – the internet user may err as to the origin of the goods or services in question. The function of the mark – to guarantee to consumers the origin of the goods or services ('function of indicating [the] origin' of the mark) – is then adversely affected.

It is for the national court to assess, on a case-by-case basis, whether the facts of the dispute before it point to an adverse effect, or a risk thereof, on the function of indicating origin.

With regard to the use, by internet advertisers, of a sign corresponding to another person's trade mark as a keyword for purposes of the display of advertising messages, the Court also takes the view that that use is liable to have certain repercussions on the advertising use of the mark by its proprietor and on the latter's commercial strategy. Nevertheless, those repercussions of use by third parties of a sign identical with the trade mark do not of themselves constitute an adverse effect on the 'advertising function' of the trade mark.

Regarding the liability of an operator such as Google in respect of the data of its clients which it stores on its server, the Court started by recalling that questions of liability are governed by national law However, European Union law lays down limitations of the liability of intermediary providers of information society services. [80]

In relation to whether an internet referencing service, such as 'AdWords', constitutes an information society service consisting in the storage of information supplied by the advertiser and whether, therefore, the referencing service provider's liability is limited, the Court observed that the referring court had to examine whether the role played by the service provider was neutral, in the sense that its conduct was merely technical, automatic and passive, pointing to a lack of knowledge or control of the data which it stored.

Judgment of 22 December 2022 (Grand Chamber), Louboutin (Use of an infringing sign on an online market) (C-148/21 and C-184/21, EU:C:2022:1016)

(*Reference for a preliminary ruling – EU trade mark – Regulation (EU) 2017/1001 – Article 9(2)(a) – Rights conferred by an EU trade mark – Concept of 'use' – Operator of an online sales website incorporating an online marketplace – Advertisements published on that marketplace by third-party sellers using, in those advertisements, a sign which is identical with a trade mark of another person for goods which are identical with those for which that trade mark is registered – Perception of that sign as forming an integral part of the commercial communication of that operator – Method of presenting the advertisements which does not make it possible to distinguish clearly the offerings of that operator from those of the third-party sellers)*

Amazon is both a well-known distributor and the operator of an online marketplace. Amazon publishes on its online shop both advertisements relating to its own goods, which it sells and ships under its own name, and advertisements from third-party sellers. Amazon also offers third-party sellers the additional services of stocking and shipping their goods uploaded to its online marketplace, by notifying potential purchasers when it is in charge of those activities.

Amazon websites regularly display advertisements for red-soled shoes. Mr Christian Louboutin, a French designer of women's high-heeled shoes whose reputation was built on their red outer sole, asserts that the goods were placed on the market without his

[80] Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market ('Directive on electronic commerce') (OJ L 178, p. 1).

consent. He brought two actions for infringement against Amazon before the tribunal d'arrondissement de Luxembourg (District Court, Luxembourg, Luxembourg), the referring court in Case C-148/21, and the tribunal de l'entreprise francophone de Bruxelles (Brussels Companies Court (French-speaking), Belgium), the referring court in Case C-184/21. He argues that Amazon unlawfully used a sign identical to the trade mark owned by him for goods identical to with those for which that trade mark is registered. He stresses in particular the fact that the contentious advertisements form an integral part of Amazon's commercial communication.

The two national courts are uncertain whether the operator of an online marketplace, such as Amazon, could be held directly liable for infringement of the rights of the proprietor of that trade mark resulting from an advertisement from a third-party seller. That question, contrary to the question relating to indirect liability, is subject to a harmonised regime under Union law. [81]

In its judgment, the Court, sitting as the Grand Chamber, answers the two national courts that such an operator may effectively be regarded as itself using a sign identical with an EU trade mark which appears in a third-party seller's advertising on its online market, where a well-informed and reasonably observant user of its website has the impression that that operator is marketing, in its own name and on its own behalf, the infringing goods at issue.

The Court first recalls that use, by a third party, of a sign which is identical with or similar to the proprietor's trade mark also implies, at the very least, that that third party uses the sign in its own commercial communication and that mere 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 the sign, even if it is in its own financial interest. The Court thus considered that, with regard to the operator of an online marketplace such as eBay, the use of signs which are identical with or similar to trade marks in offers for sale displayed on that marketplace is made only by the sellers which are customers of that operator and not by the operator itself, since the latter does not use that sign in its own commercial communication.

The Court observes, however, that, in its earlier case-law, it was not asked about the fact that the online sales website in question incorporates, as well as the online marketplace, sales offers of the operator of that site itself, whereas the present cases specifically raise the issue of that impact.

However, the Court finds that that fact could, depending on the circumstances, give users of the online marketplace the impression that advertising for the goods at issue originate, not from third-party sellers, but from the operator of that marketplace and that it is the latter that uses the sign at issue in its own commercial communication.

[81] Regulation 2017/1001.

Lastly, it is for the referring courts to assess whether that is the case. However, the Court clarifies that of relevance is the fact that Amazon uses a uniform method of presenting offers for sale published on its website, displaying both its own advertisements and those of third-party sellers and displaying its own logo as a renowned distributor on all those advertisements and the fact that it offers additional services to third-party sellers in connection with the marketing of their goods, consisting inter alia in the storing and shipping of those goods.

Such circumstances may make it difficult to draw such a clear distinction and give the well-informed and reasonably observant user the impression that Amazon is marketing, in its own name and on its own behalf, the Louboutin goods offered for sale by third-party sellers.

Judgment of 25 January 2024, Audi (Emblem attachment on radiator grille) (C-334/22, EU:C:2024:76)

(Reference for a preliminary ruling – EU trade mark – Regulation (EU) 2017/1001 – Article 9(2) and (3)(a) to (c) – Rights conferred by an EU trade mark – Concept of 'using in the course of trade any sign' – Article 14(1)(c) – Limitations of the effects of an EU trade mark – Right of the proprietor of an EU trade mark to oppose the use by a third party of a sign identical with, or similar to, the trade mark for motor vehicle spare parts – Component of a radiator grille designed for the attachment of an emblem representing the trade mark of a motor vehicle manufacturer)

In the context of a reference for a preliminary ruling, the Court of Justice provides clarification of the concept of 'using in the course of trade any sign', where a third party imports and offers for sale spare parts for motor vehicles without the consent of the motor vehicle manufacturer which is the proprietor of an EU trade mark. In addition, the Court clarifies the scope of that manufacturer's exclusive right to prohibit that third party from using a sign identical with, or similar to, that trade mark in respect of such spare parts.

GQ is a natural person engaged in the business of selling spare parts for motor vehicles via an internet site. As part of that business, GQ advertised and offered for sale radiator grilles that had been adapted and designed for older Audi models. Those radiator grilles included an element designed for the attachment of an emblem of the motor vehicle manufacturer Audi.

Audi, the proprietor of the figurative EU trade mark representing four overlapping circles ('the AUDI trade mark'), brought an action before the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland), the referring court, seeking an injunction to prohibit GQ from advertising, importing, offering for sale or placing on the market non-original radiator grilles bearing a sign identical with, or similar to, the AUDI trade mark.

The referring court decided to refer a question to the Court on the interpretation of Regulation 2017/1001, asking it to clarify the concept of 'use of a sign in the course of trade' and the scope of the right of a motor vehicle manufacturer, which is the proprietor of an EU trade mark, to prohibit a third party from using a sign identical with, or similar to, that trade mark for spare parts.

First, the Court notes that the EU legislature did not provide for a so-called 'repair' clause, such as that which exists in design law, [82] in Regulation 2017/1001 and points out that that clause applies without prejudice to the provisions of EU law relating to trade marks.

Consequently, the so-called 'repair' clause cannot be applied by analogy in order to pursue the objective of preserving undistorted competition between manufacturers of motor vehicles and sellers of non-original spare parts, that objective having been taken into account by the EU legislature in the context of Regulation 2017/1001, [83] and the right conferred on the proprietor of an EU trade mark cannot be limited on the basis of that clause. [84]

Second, the Court observes that the referring court considered that the shape of the element of those radiator grilles designed for the attachment of the emblem representing the AUDI trade mark was identical with, or similar to, that trade mark. That shape thus constitutes a sign within the meaning of Regulation 2017/1001. [85] Furthermore, the affixing of that sign on or incorporated into those radiator grilles, for the purposes of marketing them, represented use falling within that regulation [86] and, in so far as GQ imported and offered for sale radiator grilles incorporating that sign, it could be regarded as fulfilling the types of use falling within that regulation. The fact that that element is placed on the spare part, namely the radiator grille, in such a way that the sign identical with, or similar to, the trade mark of the vehicle manufacturer is visible to the relevant public when it sees that part is such as to establish the existence of a material link between that part, which a third party imports, advertised and offered for sale, and the proprietor of the AUDI trade mark.

Accordingly, the Court holds that a third party which, without the consent of the manufacturer of motor vehicles which is the proprietor of an EU trade mark, imports and offers for sale spare parts, namely radiator grilles for those motor vehicles, containing an element which is designed for the attachment of the emblem representing that trade mark and the shape of which is identical with, or similar to, that trade mark, is using a sign

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[82] Article 110 of Council Regulation (EC) No 6/2002 of 12 December 2001 on European Union designs (OJ 2002 L 3, p. 1), in the version prior to the entry into force of Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 (OJ L, 2024/2822). According to that article, 'protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance'.

[83] Article 14 of Regulation 2017/1001.

[84] Article 9 of that regulation.

[85] Article 9(2) of that regulation.

[86] Article 9(3)(a) to (c) of Regulation 2017/1001.

in the course of trade in a manner liable to impair one or more of the functions of that trade mark, which is a matter for the national court to determine.

Thirdly, the Court points out that the impossibility for the proprietor of a trade mark to prohibit a third party from using that trade mark where such use is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part, and is done in accordance with honest practices in industrial or commercial matters, is one of the circumstances in which the exclusive right conferred by the trade mark cannot be relied on against a third party.

The purpose of the limitation, referred to in that hypothesis, is to allow suppliers of goods or services which are complementary to goods or services offered by the proprietor of a trade mark to use that trade mark in order to inform the public, in a comprehensible and complete manner, of the intended purpose of the goods they market or of the services they offer or, in other words, of the practical link between their goods or services and those of the proprietor of the trade mark.

However, where a sign identical with, or similar to, an EU trade mark constitutes an element of a spare part for motor vehicles, which is designed for the attachment of the emblem of the manufacturer of those vehicles to it and is not used to designate or refer to goods or services as being those of the proprietor of that trade mark, but to reproduce as faithfully as possible a product of that proprietor, such use of that trade mark does not fall within the aforementioned hypothesis.

The Court therefore holds that a manufacturer of motor vehicles who is the proprietor of an EU trade mark is entitled to prohibit a third party [87] from using a sign identical with, or similar to, that trade mark in relation to spare parts for those motor vehicles, namely radiator grilles, where that sign consists of the shape of an element of the radiator grille, designed for the attachment thereto of the emblem representing that trade mark, regardless of whether or not there is a technical possibility of attaching that emblem to that radiator grille without affixing that sign to it.

[87] On the basis of Article 14(1)(c) of Regulation 2017/1001.

2. Genuine use

Judgment of 8 July 2004, Sunrider v OHIM – Espadafor (VITAFRUIT) (T-203/02, EU:T:2004:225 [88])

(Community trade mark – Opposition proceedings – Earlier word mark VITAFRUT – Application for Community word mark VITAFRUIT – Genuine use of the earlier trade mark – Similarity of products – Article 8(1)(b), Article 15 and Article 43(2) and (3) of Regulation (EC) No 40/94)

On 1 April 1996, the applicant filed an application for a Community trade mark at OHIM. The mark for which registration was sought is the word mark VITAFRUIT for various products. [89]

The other party to the proceedings before the Board of Appeal filed a notice of opposition [90] against registration of the trade mark in respect of all the products referred to in the trade-mark application. The opposition was based on the fact that a trade mark had already been registered in Spain, the date of priority for which was 19 October 1960 and consisting of the word mark VITAFRUT. [91]

The applicant requested that the other party to the proceedings before the Board of Appeal should furnish proof [92] that the earlier trade mark had been put to genuine use during the period of five years preceding the date of publication of the Community trade-mark application in the Member State in which it was protected.

By decision, the Opposition Division of OHIM rejected the trade-mark application [93] in respect of 'mineral and aerated waters and other non-alcoholic drinks; fruit and vegetable drinks, fruit juices; syrups and other preparations for making beverages; herbal and vitamin beverages'. [94]

By decision, the Board of Appeal of OHIM dismissed that appeal. In substance, it upheld the findings made by the Opposition Division in its decision, pointing out, however, that

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[88] The appeal against that judgment was dismissed by the judgement of 11 May 2006, Sunrider v OHMI (C-416/04 P, *EU:C:2006:310*).

[89] The products in respect of which registration of the trade mark was sought are in classes 5, 29 and 32 of the Nice Agreement and comprise, inter alia, 'concentrates or nutritional supplements on the basis of herbs, herbal teas, all for health care purposes' (Class 5), 'non-medical nutritional concentrates or nutritional supplements on herbal basis, herbal food, also in form of snack bars' (Class 29) and fruit and vegetable drinks' (Class 32).

[90] Under Article 42(1) of Regulation No 40/94.

[91] That trade mark was registered for goods in Classes 30 and 32, within the meaning of the Nice Agreement, corresponding to the following description: 'Non-alcoholic and non-therapeutic carbonic drinks, non-therapeutical cold beverages of all kind[s], gaseous, granulated effervescent; fruit and vegetable juices without fermentation (except must), lemonades, orangeades, cold beverages (except orgeat), soda water, Seidlitz water and artificial ice'.

[92] In accordance with Article 43(2) to (3) of Regulation No 40/94.

[93] Under Article 43(5), first sentence, of Regulation No 40/94.

[94] Under Article 43(5), first sentence, of Regulation No 40/94.

use of the earlier trade mark had been proven only for products identified as 'juice concentrates'.

The General Court dismisses the applicant's appeal against that decision, finding, in the first place, that in appeals before the Board of Appeal of OHIM, the extent of the examination which the Board of Appeal is required to conduct with regard to the decision under appeal does not depend upon whether or not the party bringing the appeal has raised a specific ground of appeal with regard to that decision, criticising the interpretation or application of a provision by the department at OHIM which heard the application at first instance, or upon that department's assessment of a piece of evidence Therefore, even if the party bringing the appeal before the Board of Appeal has not raised a specific plea, the Board of Appeal is nonetheless bound to examine whether or not, in the light of all the relevant matters of fact and of law, a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling.

Regarding opposition proceedings brought by the proprietor of an earlier trade mark, that examination must include consideration of whether, in the light of the facts and evidence put forward by the other party to the proceedings before the Board of Appeal, that party has furnished proof of genuine use, either by the proprietor of the earlier trade mark or by an authorised third party. [95] However, the relevance of OHIM's contention that the party applying for registration of the mark did not dispute, before either the Opposition Division or the Board of Appeal, that consent had been granted by the proprietor of the earlier mark pertains to the examination of the merits.

In the second place, the General Court notes that in interpreting the notion of 'genuine use' of a Community trade mark for the purposes of Article 43(2) and (3) of Regulation No 40/94, account must be taken of the fact that the ratio legis of the provision requiring that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade-mark application is to restrict the number of conflicts between two marks, where there is no good commercial justification deriving from active functioning of the mark on the market. However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks.

In the third place, the General Court indicates that there is 'genuine use' of a trade mark [96] where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include

[95] Within the meaning of Article 43(2) and (3) and Article 15(3) of Regulation No 40/94.

[96] Within the meaning of Article 43(2 3) of Regulation No 40/94.

token use for the sole purpose of preserving the rights conferred by the mark. In that respect, the condition concerning genuine use of the trade mark requires that, as protected in the relevant territory, it is used publicly and outwardly.

When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real; particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.

As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use.

In the fourth place, the General Court holds that in order to examine, in a particular case, whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment implies a certain interdependence between the factors taken into account. Therefore, a low volume of goods marketed under the trade mark may be compensated for by a high intensity or a certain consistency over time of the use of that trade mark or vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, use of the mark at issue need not always be quantitatively significant in order to be deemed genuine.

In the fifth and last place, according to the General Court, in assessing the similarity of the goods or services in question, [97] all relevant factors pertaining to the relationship between those goods and services should be taken into account and, in particular, their nature, purpose, method of use, and whether they are in competition with each other or are complementary.

In that regard, concentrated fruit juices which are protected by an earlier mark and herbal and vitamin beverages which are the subject matter of an application for registration of a mark are similar. The products share the same purpose, that of quenching thirst, and to a large extent they are in competition. As to their nature and use, in both cases the products concerned are non-alcoholic beverages normally drunk cold, the ingredients being admittedly different in most cases. The fact that their ingredients differ does not,

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[97] Within the meaning of Article 8(1)(b) of Regulation No 40/94.

however, affect the finding that they are interchangeable because they are intended to meet an identical need.

Judgment of 8 June 2017, W. F. Gözze Frottierweberei and Gözze (C-689/15, EU:C:2017:434)

(Reference for a preliminary ruling – Intellectual property – EU trade mark – Regulation (EC) No 207/2009 – Articles 9 and 15 – Filing of the cotton flower sign by an association – Registration as an individual trade mark – Licences to use the mark granted to cotton textile manufacturers affiliated with the association – Application for a declaration of invalidity or revocation – Concept of 'genuine use' – Essential function of indicating origin)

The Verein Bremer Baumwollbörse (the VBB) is an association exercising various activities linked to cotton. It is the proprietor of the EU figurative trade mark representing a cotton flower, registered on 22 May 2008 for goods, in particular for textiles ('the cotton flower mark').

For several decades preceding that registration, that figurative sign ('the cotton flower sign') had been used by manufacturers of textiles made from cotton fibres to certify the composition and the quality of their goods Since the registration, the VBB has concluded licence agreements in respect of its cotton flower mark with undertakings affiliated to the association. Those undertakings agreed to use the mark only for goods made from good-quality cotton fibres. Compliance with this commitment could be checked by the VBB.

Gözze, the director of which was Mr Gözze, which is not affiliated to the VBB and has not concluded a licence agreement with it, manufactured textiles made from cotton fibres and affixed the cotton flower sign to them for several decades.

The VBB brought infringement proceedings against Gözze and Mr Gözze before the competent EU trade mark court, the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) as a result of Gözze selling towels to which hangtags are attached. In the course of those proceedings, Gözze brought a counterclaim on for a declaration of invalidity of the cotton flower mark as from 22 May 2008 or, in the alternative, for revocation of the mark as from 23 May 2013.

By judgment of 19 November 2014, the Landgericht Düsseldorf (Regional Court, Düsseldorf) upheld the VBB's action and dismissed Gözze's counterclaim.

Gözze appealed that judgment to the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), which decided to stay the proceedings and to refer the matter to the Court of Justice for a preliminary ruling.

In its judgment, the Court clarifies, in the first place, that Article 15(1) of Regulation No 207/2009 must be interpreted as meaning that the affixing of an individual EU trade mark, by the proprietor or with his consent, on goods as a label of quality is not use as a trade mark that falls under the concept of 'genuine use' within the meaning of that provision. However, the affixing of that mark does constitute such genuine use if it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality. In that case, the proprietor of the mark is entitled to prevent, pursuant to Article 9(1)(b) of that regulation, the affixing by a third party of a similar sign on identical goods, if that affixing creates a likelihood of confusion on the part of the public.

In the second place, the Court notes that Article 52(1)(a) and Article 7(1)(g) of Regulation No 207/2009 on the European Union trade mark must be interpreted as meaning that an individual mark cannot be declared invalid, on the basis of a joint application of those provisions, because the proprietor of the mark fails to ensure, by carrying out periodic quality controls at its licensees, that expectations relating to the quality which the public associates with the mark are being met.

In the third and last place, the Court emphasises that the scope of application of Articles 66 to 74 of Regulation No 207/2009 on the European Union trade mark, relating to collective EU trade marks, is expressly confined, according to the wording of Article 66(1) of the regulation, to marks described as such when applied for. The demarcation of the applicability of those articles must be strictly adhered to, especially as the rules they introduce, such as those set out in Article 67 of the regulation concerning regulations governing use of the mark, go hand in hand with the requirement, when making the application for registration, to expressly describe the mark applied for as a collective mark. Therefore, it is not possible to apply those rules by analogy to individual EU trade marks.

Accordingly, the Court concludes that Regulation No 207/2009 must be interpreted as meaning that its provisions on collective EU trade marks may not be applied mutatis mutandis to individual EU trade marks.

Judgment of 7 May 2025, RTL Group Markenverwaltung v EUIPO – Örtl T-1088/23, EU:T:2025:446

(EU trade mark – Revocation proceedings – EU figurative mark RTL – Lack of genuine use of the mark – Article 58(1)(a) of Regulation (EU) 2017/1001 – Submission of facts and evidence for the first time before the Board of Appeal – Article 95(2) of Regulation 2017/1001 – Article 27(4) of Delegated Regulation (EU) 2018/625 – Misuse of rights)

In its judgment, the General Court alters the decision of the Board of Appeal of EUIPO. It provides clarifications on issues relating to the abusive nature of an application for revocation, the exercise by the Board of Appeal of EUIPO of its discretion as regards a refusal to take into account evidence produced for the first time before it other than in the written submissions provided for by Delegated Regulation 2018/625, [98] genuine use of a mark in respect of advertising, promotional and marketing services by an undertaking belonging to a group providing, inter alia, services for the broadcasting of advertisements, and the impact of the reputation of a mark on the assessment of whether that mark has been put to genuine use in connection with other goods or services.

Since 2016, RTL Group Markenverwaltungs GmbH, the applicant, has been the proprietor of the figurative EU mark RTL in respect of various goods and services. [99] In 2021, Marcella Örtl, the intervener, filed an application for a declaration of revocation [100] on the ground that that mark had not been put to genuine use in connection with the goods or services in respect of which it was registered within a continuous period of five years. The Cancellation Division of EUIPO partially upheld the application in respect of some goods and services.

Hearing an appeal brought by the applicant, the Board of Appeal of EUIPO, first, declared the application for revocation admissible and, secondly, partially annulled the Cancellation Division's decision in so far as that decision had declared the contested mark to be revoked, inter alia, in respect of a subcategory of 'advertising, marketing and promotional services', namely the 'broadcasting of television, radio and electronic media advertising' services, and dismissed the appeal as to the remainder. [101] By its action brought before the General Court, the applicant sought the annulment or, alternatively, the alteration of that decision.

In the first place, the Court observes that the grounds for revocation aim to protect the public interest underlying them, which explains why the applicant is not required to demonstrate an interest in bringing proceedings. That analysis is borne out by recital 24 of Regulation 2017/1001 and by the purpose of Article 63(1)(a) of that regulation, which is to allow the broadest possible range of people to challenge an EU trade mark which has not been put to genuine use for a given period of time without requiring them to demonstrate an interest in bringing proceedings. Since an application for revocation may be submitted by 'any natural or legal person' for no use or insufficient use of a mark, the question of whether there has been a misuse of rights is not relevant for the purposes of analysing the admissibility of such an application. Likewise, neither the admissibility or validity of an application for revocation are subject to good faith on the part of the

[98] Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 (OJ 2018 L 104, p. 1).

[99] The goods and services concerned were in Classes 3, 6, 8, 9, 12, 14, 16, 18, 20, 21, 24, 25, 28, 30, 32, 33, 35, 38, 41, 42, 43 and 45 of the Nice Agreement.

[100] On the basis of Article 58(1)(c) of Regulation 2017/1001.

[101] The other goods and services in respect of which the Cancellation Division's decision was annulled were 'Optical storage discs' in Class 9 and 'On-line social networking services; On-line dating services' in Class 45.

applicant for a declaration of revocation since the revocation for non-use of a mark during the five-year period is a legal consequence imposed by Regulation 2017/1001. [102]

While the applicant relies, in that regard, on the Sandra Pabst case, [103] the Court notes that that case was characterised by exceptional circumstances, which are absent in the present case. Unlike the Sandra Pabst case, the intervener is not a company that had been artificially established for the sole purpose of filing multiple applications for revocation. Furthermore, the applicant has not demonstrated that the application for revocation, in the present case, was doomed to fail and therefore served only to place an undue burden on it or to put pressure on it. On the contrary, the fact that the intervener intended to use a mark which is likely to cause confusion with the contested mark demonstrates the latter's actual interest in the register of marks being updated in so far as concerns the extent of the monopoly held by the applicant on the contested mark.

Accordingly, the Court rejects the applicant's submission concerning the inadmissibility of the application for revocation due to the alleged abusive nature of that application.

In the second place, the Court recalls the case-law regarding EUIPO's discretion for the purposes of taking into account facts and evidence which are submitted or produced late [104] and stresses that taking into account such facts and evidence must result from an objective, reasoned exercise of that discretion, which it is for the Court to review.

The Court finds that, in the present case, the applicant produced observations and evidence late, with the result that the Board of Appeal had to exercise its discretion in order to decide whether or not it was appropriate to take them into account when making the decision it was called upon to make. Such an objective, reasoned exercise of that discretion is lacking in the present case, in so far as the Board of Appeal rejected those elements on the sole ground that they had not been produced with one of the written submissions referred to in Delegated Regulation 2018/625, [105] without having examined whether the conditions referred to in Article 27(4) of that regulation were satisfied. The examination of the admissibility of the observations and evidence produced for the first time before the Board of Appeal cannot be limited to the facts and evidence produced with the written submissions referred to in Delegated Regulation 2018/625 since such a limitation does not follow either from Article 95(2) of Regulation 2017/1001 or from Article 27(4) of Delegated Regulation 2018/625.

[102] See Article 58(1)(a) and Article 64(2) of Regulation 2017/1001.

[103] The case that gave rise to the decision of the Grand Board of Appeal of 1 February 2020 (Case R 2445/2017-G, 'the Sandra Pabst case').

[104] Provided for in Article 95(2) of Regulation 2017/1001 and governed by Article 27(4) of Delegated Regulation 2018/625.

[105] Articles 22, 24 and 26 of Delegated Regulation 2018/625.

Consequently, the Board of Appeal made an error in excluding from its examination the observations and evidence produced late by the applicant without exercising the discretion conferred on it.

In the third place, the Court examines whether the evidence submitted by the applicant, relating to the activities of the companies in the group to which it belongs, demonstrates the use of the contested mark not only in respect of the subcategory of broadcasting of advertising services, as noted by the Board of Appeal, but also beyond that subcategory, in respect of the category of 'advertising, promotion and marketing' services as a whole.

First of all, it notes that the applicant demonstrated that the companies in the group to which it belonged had provided advertisers with services relating to the creation and production of advertisements, in particular, television advertisements. Thus, it submitted evidence in relation to services involving a creative contribution from those companies in the design of the advertisements, which were not limited to the mere broadcasting of advertising content created by a third party.

Next, it finds that it follows from the evidence produced by the applicant that the latter offered advertisers its services in the field of advertising strategy development in the media it owns, by offering them the possibility of participating in promotional operations created by the group to which it belongs.

Lastly, it rules that, in view of the evidence produced, the companies in the group to which the applicant belongs provided consultancy services relating to the marketing of television advertising, which fall within the scope of consultancy and specialised support services for undertakings seeking to promote their goods and services and develop their advertising strategies.

In those circumstances, the Court finds that the evidence produced by the applicant demonstrates that the group to which it belongs provided, under the contested mark and during the relevant period, third parties with advertising, promotion and marketing services, which were not limited to the broadcasting of advertisements but aimed to actively contribute to the development of an advertising strategy for those third parties. Accordingly, it alters the contested decision by rejecting the application for revocation of the contested mark in respect of the advertising, promotion and marketing services in Class 35.

In the last place, the Court states that the very wording and purpose of Article 58(1)(a) of Regulation 2017/1001 make preservation of the rights connected with an EU trade mark conditional on the mark being actually used. It would not be justifiable if a mark which is not used were to obstruct competition and restrict the free movement of goods and the freedom to provide services. Furthermore, the EU Courts have held that the provisions relating to the extended protection conferred on an EU trade mark that has a reputation in the European Union pursue a different objective from those which require proof of genuine use, with the result that those two types of provisions must therefore be interpreted independently. Therefore, assuming that the contested mark in the present case has a reputation in the media sector, that fact alone does not demonstrate that that mark has been put to genuine use in respect of the goods and services in question. Furthermore, neither the unitary character of the EU trade mark nor recital 7 of Delegated Regulation 2018/625, which concerns only procedural rules, can be usefully relied on by the applicant for the purpose of interpreting the substantive provisions of Regulation 2017/1001.

Judgment of 2 July 2025, Ferrari v EUIPO – Hesse (TESTAROSSA) (T-1103/23, EU:T:2025:659 [106])

(EU trade mark – Revocation proceedings – International registration designating the European Union – Word mark TESTAROSSA – Genuine use of the mark – Article 51(1)(a) of Regulation (EC) No 207/2009 (now Article 58(1)(a) of Regulation (EU) 2017/1001) – Use by third parties – Nature of the use – Implied consent of the proprietor of the mark – Proof of genuine use – Second-hand cars – Parts and accessories)

The General Court, ruling in extended composition, annuls the decision of the Board of Appeal of EUIPO [107] and rules on the concept of genuine use in the context of resale by third parties of second-hand goods bearing the contested mark with the implied consent of the proprietor of the mark. It thus clarifies the case-law arising from the judgment in Ferrari. [108]

Ferrari SpA, the applicant, is the proprietor of the international registration, designating the European Union, of the word mark TESTAROSSA inter alia in respect of vehicles. [109] On 7 September 2015, Mr Kurt Hesse, the intervener, filed an application for invalidation of the effects of that international registration. [110] The Cancellation Division partially granted the application for revocation and rejected it for 'automobiles'.

Both the intervener and the applicant brought an appeal seeking partial annulment of that decision. The Board of Appeal of EUIPO upheld the intervener's appeal and dismissed the applicant's appeal, whose rights in the contested mark were thus revoked for all the goods. The applicant brought an action before the Court for the annulment of that decision.

In the first place, the Court rules on the genuine use of the contested mark in respect of automobiles. First of all, it states that no new cars were produced or placed on the market under the contested mark during the relevant period and that the second-hand cars

[106] Appeal pending (Case C-597/25 P).

[107] Decision of the Fifth Board of Appeal of EUIPO of 29 August 2023 (Joined Cases R 334/2017-5 and R 343/2017-5), as corrected on 28 September 2023 ('the contested decision').

[108] Judgment of 22 October 2020, Ferrari, (C-720/18 and C-721/18, *EU:C:2020:854*).

[109] Goods falling within Class 12 within the meaning of the Nice Agreement.

[110] Based on Article 158(2 of Regulation No 207/2009, read in conjunction with Article 51(1)(a) of that regulation.

bearing the contested mark were marketed by authorised dealers or distributors. In that regard, it points out that, although the resale, as such, of a second-hand product bearing a trade mark does not necessarily constitute genuine use, [111] the fact remains that, if the proprietor of the trade mark concerned uses it when reselling in accordance with its essential function, such use may be regarded as 'genuine use' of that mark. Such an interpretation is confirmed by Article 13(1) of Regulation No 207/2009, from which it follows that a mark is capable of being put to use in respect of goods already put on the market under that mark, with the result that its proprietor cannot prohibit third parties from using that mark. On the other hand, that does not mean that the proprietor cannot itself use its trade mark in respect of such goods. That also applies to use of the mark by third parties with the consent of the proprietor, so that it remains open to the proprietor of the trade mark to show that it has been put to genuine use in respect of second-hand goods sold under that mark by third parties with its consent.

Next, while noting that the applicant did not produce any evidence showing its express consent to use of the contested mark by third parties during the relevant period, the Court states that such consent may also be inferred from facts and circumstances prior to, simultaneous with or subsequent to the use of the mark by a third party. That being said, in the specific context of the use of a trade mark in respect of second-hand goods, implied consent cannot be inferred from the mere fact that the proprietor was aware of the use of the mark by a third party, but requires that the proprietor be involved in that use. Furthermore, the relevant facts and circumstances potentially reflecting implied consent must be examined in the light of the practices regarded as warranted in the relevant economic sector and of the characteristics of the market.

Thus, first, the Court considers that the fact that a second-hand car bearing the contested mark is sold by a dealer or distributor authorised by the proprietor of that mark, and not by some unrelated third party, constitutes an indication that the sale is conducted with the implied consent of the proprietor. In that regard, it points out that the use of a production company's mark by a distribution company authorised by the proprietor of that mark may be regarded as having been made with the latter's consent, in so far as such authorisation establishes a link between those two companies which presupposes that the proprietor of the mark has authorised the approved dealer or distributor to use its trade mark. That assessment is supported by the practices regarded as warranted in the motor vehicle market, in which a distributor or dealer approved by the manufacturer is deemed to be authorised to market all of that manufacturer's car models. The same applies to the second-hand vehicle market, in which sales of second-hand cars by an independent third party are generally distinguished from sales by an authorised dealer or distributor.

[111] Within the meaning of Article 51(1) A) of Regulation No 207/2009.

Second, as regards the certification service provided by the applicant, the purpose of which is to certify, in return for remuneration, the authenticity of second-hand cars bearing the contested mark, the Court points out that the actual use, by its proprietor, of a mark registered in respect of certain goods, for services which are directly connected with the goods previously sold and intended to meet the needs of customers of those goods, is capable of constituting 'genuine use' of that mark. In the present case, the certification service relates directly to sales of second-hand cars bearing the contested mark by authorised dealers and is intended to meet the needs of purchasers of such cars, with the consequence that such use is capable of constituting 'genuine use' of that mark. The simultaneous use of the Ferrari mark and the contested mark on the invoices for that service is consistent with normal practice on the market, since cars are commonly marketed under a mark designating the manufacturer and at the same time under a second mark designating the model.

Lastly, the Court concludes that the applicant has demonstrated that it had impliedly consented to the use of the contested mark by third parties in respect of 'automobiles'.

In the second place, the Court examines genuine use of the contested mark in connection with parts and accessories, which are mainly second-hand. It observes, first, that that use was made during the relevant period by authorised dealers and distributors and, second, that the applicant offers a certification service which includes verification of the commercial origin of the parts of the second-hand cars covered by the contested mark. Therefore, the applicant has shown that it impliedly consented to the use, by third parties, of the contested mark in respect of parts and accessories. Furthermore, the Court finds that the Board of Appeal did not take sufficient account of the fact that the sales of parts and accessories effected by authorised dealers also related to genuine parts designated specifically by the contested mark. For those reasons, the Court considers that the Board of Appeal's assessments are flawed.

Lastly, the Court observes that the use of the contested mark for parts and accessories may also constitute use of that mark for 'automobiles'. A trade mark registered in respect of a category of goods and replacement parts thereof is to be regarded as having been put to genuine use in connection with all the goods in that category and the replacement parts thereof if it has been so used only in respect of some goods or only in respect of replacement parts or accessories of some of those goods, unless it is apparent that a consumer will perceive them as an independent subcategory of the category of goods in respect of which the mark concerned was registered. In the present case, however, the Board of Appeal did not examine that evidence and did not find that those parts and accessories constituted an autonomous subcategory in relation to automobiles, such that proof of use in respect of the former was irrelevant as regards the latter. First, the Board of Appeal merely noted that there was a disproportion in economic value between the spare parts and accessories and the automobiles, without taking account of the case-law according to which the criterion of the purpose or intended use is of fundamental importance when defining a subcategory of goods or services. Second, it found that the relevant public would not consider that manufacturers of parts and accessories would have the technical capacity to build cars. The Court states that such a general rule, according to which the public necessarily considers that the cars and the parts and accessories come from two different manufacturers, is not established, since a number of spare parts and accessories are produced by the car manufacturers themselves. Consequently, the contested decision is also vitiated by errors in that regard.

Judgment of 2 July 2025, Ferrari v EUIPO – Hesse (TESTAROSSA) (T-1104/23, EU:T:2025:660)

(EU trade mark – Revocation proceedings – International registration designating the European Union – Word mark TESTAROSSA – Genuine use of the mark – Article 51(1)(a) of Regulation (EC) No 207/2009 (now Article 58(1)(a) of Regulation (EU) 2017/1001) – Use by third parties – Nature of the use – Implied consent of the proprietor of the mark – Proof of genuine use – Scale toy land motor vehicles)

The General Court, ruling in extended composition, partially annuls the decision of the Board of Appeal of EUIPO [112] and rules on the concept of genuine use in the context of use of a mark by third parties with the implied consent of the proprietor of the mark. It clarifies, in particular, the case-law arising from the judgment in Opel [113] and specifies the conditions under which genuine use of a mark may be demonstrated where the practices of the sector and the market in question allow, under certain conditions, use of the registered mark by certain operators in order to describe the goods in question.

Ferrari SpA, the applicant, is the proprietor of the international registration, designating the European Union, of the word mark TESTAROSSA inter alia in respect of scale models of vehicles and toys. [114] On 14 November 2014, Mr Kurt Hesse, the intervener, filed an application for invalidation of the effects of that international registration. [115] The Cancellation Division partially granted the application for revocation and rejected it in respect of 'scale toy land motor vehicles'.

Both the intervener and the applicant brought an appeal seeking partial annulment of that decision. The Board of Appeal of EUIPO upheld the intervener's appeal and dismissed the applicant's appeal, whose rights in the contested mark were therefore revoked in respect of all the goods. The applicant brought an action before the Court for the annulment of that decision.

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[112] Decision of the Fifth Board of Appeal of EUIPO of 29 August 2023 (Case R 887/2016-5).

[113] Judgment of 25 January 2007, Adam Opel (C-48/05, *EU:C:2007:55*).

[114] Goods falling within Class 28 within the meaning of the Nice Agreement.

[115] Based on Article 158(2 of Regulation No 207/2009, read in conjunction with Article 51(1)(a) of that regulation.

As a preliminary point, the Court notes that the affixing by a third party of a sign identical to a trade mark registered for toys to scale model vehicles cannot be prohibited unless it affects or is liable to affect the functions of that trade mark, which must be assessed according to the characteristics of the market for scale model vehicles. That market is characterised by the coexistence, on the one hand, of independent toy manufacturers, which use trade marks registered for automobiles simply to indicate that a scale model is a faithful reproduction of a real car, and, on the other hand, of scale model vehicles manufactured and sold by the proprietors of trade marks registered in respect of automobiles or by undertakings economically linked to them by virtue of a licence. The relevant public is therefore used to being exposed to scale model vehicles, both with and without a licence from the car manufacturer, and to distinguishing them depending on the information on the packaging. Thus, the Court states that a third party may use such a mark without the consent of its proprietor, provided that the use made of that mark on a scale model vehicle is limited to indicating to the relevant public that the scale model is a faithful reproduction of a real car. By contrast, where the use of the mark by a third party refers, for example, to a licensing agreement entered into with the proprietor of that mark, it will be perceived as an indication that those goods originate from the car manufacturer or from an undertaking economically linked to that manufacturer. In such a case, the trade mark proprietor is entitled to oppose such use if it has been made without its consent.

As regards the present case, in the first place, the Court examines whether the use of the mark by third parties is consistent with its essential function. It notes that the evidence produced by the applicant consists, inter alia, of several catalogues and photographs of scale models, on which the contested mark appears, third-party trade marks, but also the wording ‘Ferrari Official Licensed Product’. In that regard, it states that those indications enable the relevant public to understand that those scale models are manufactured by a third party under license from the applicant, even though the contested mark is affixed alongside third-party trade marks. Therefore, such use of the contested mark is consistent with its essential function, which is to guarantee to consumers the commercial origin of the goods. The fact that the scale model vehicles bearing the contested mark are marketed by different undertakings and vary in quality and price does not call that conclusion into question. Similarly, it is irrelevant that the wording ‘Ferrari Official Licensed Product’ does not refer to the contested mark, since the link between the use of the Ferrari mark and the contested mark on the packaging and catalogues is consistent with the practices of the market in question. The Court notes that, in the car market, cars are marketed under a first mark designating their manufacturer and, at the same time, under a second mark designating their model, and that those observations are also relevant to the market for scale model vehicles. Furthermore, the fact that the symbols ‘®’ or ‘TM’ do not appear alongside the contested mark does not alter the capacity of that mark to fulfil its essential function. In the light of the foregoing, the Court considers that the contested mark was used, during the relevant period, for scale model vehicles, in accordance with its essential function.

In the second place, the Court examines whether the proprietor consented to the use of the contested mark by third parties. It observes that the extracts from the licence agreements produced by the applicant do not contain a list of the marks they cover with the result that they do not establish that the applicant expressly consented to the use of its mark by the third parties. Nevertheless, it points out that the consent of the proprietor to the use of the mark by third parties may also be inferred from facts and circumstances prior to, simultaneous with or subsequent to that use, which must be examined in the light of the practices regarded as warranted in the relevant economic sector.

Thus, first, the Court states that, in the specific context of the market at issue, the implied consent of the proprietor of the contested mark stems from the fact that it was aware of the use of its mark by third parties and did not object to it, and the Court considers that that is the case here. Second, it states that the use of a production company's mark by another company marketing the goods in question as 'official' goods licensed by the first company may be regarded as having been made with the consent of the proprietor of that mark, in so far as such use establishes a link between those two companies which presupposes that the latter has authorised the use of its trade marks by the company in question. Third, it considers that, by producing invoices and order forms issued by third parties in relation to the sale of scale model vehicles bearing the contested mark for the purposes of establishing genuine use, the applicant claims by implication that it consented to that use. Consequently, the Court considers that the applicant impliedly consented to the use of the contested mark by third parties in respect of the goods at issue.

Accordingly, in the light of the foregoing considerations, the Court annuls the decision of the Board of Appeal in so far as the contested mark was revoked in respect of scale models of vehicles.

3. Collective mark

Judgment of 12 December 2019, Der Grüne Punkt v EUIPO (C-143/19 P, EU:C:2019:1076)

(Appeal – EU trade mark – Regulation (EC) No 207/2009 – Articles 15 and 66 – Genuine use of an EU collective trade mark – Mark concerning a system of collection and recovery of packaging waste – Affixing to the packaging of goods for which the mark is registered)

In the present judgment, the Court set aside the judgment of the General Court [116] on the ground that it had erred in law in applying the concept of 'genuine use' to an EU collective mark.

In the present case, the appellant, Der Grüne Punkt, had obtained registration of the collective figurative mark representing a circle with two arrows concerning a system of collection and recovery of packaging waste. Following an application for revocation, EUIPO had partially upheld that application, on the ground that that mark had not been put to genuine use in connection with all the goods in respect of which it had been registered, with the exception of goods consisting of packaging.

The action for annulment against the decision of the Board of Appeal of EUIPO brought by the appellant was dismissed by the General Court.

In support of its appeal, the appellant claimed that the General Court misinterpreted the concept of 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 and had failed to take proper account of the characteristics of collective marks set out in Article 66 of that regulation.

First of all, the Court observes that the essential function of a collective mark is to distinguish goods or services of the members of the association which is the proprietor of that mark from those of other undertakings. Thus, unlike an individual mark, a collective mark does not have the function of indicating to the consumer 'the identity of origin' of goods or services in respect of which it is registered. In that regard, the Court noted that Article 66 of Regulation No 207/2009 by no means requires that manufacturers, producers, suppliers or traders who are affiliated with the association which is the proprietor of a collective mark, form part of the same group of companies which manufacture or supply the goods or services under unitary control. Furthermore, the Court held that collective marks are, like individual marks, part of the course of trade. Their use must therefore, in order to be classified as 'genuine' within the meaning of Article 15(1) of Regulation No 207/2009, in fact be part of the objective of the undertakings concerned to create or preserve an outlet for their goods and services.

Next, the Court of Justice holds that such a mark is used in accordance with its essential function from the moment when it enables the consumer to understand that the goods or services covered originate from undertakings which are affiliated with the association, the proprietor of the mark, and to thereby distinguish those goods or services from those originating from undertakings which are not affiliated. In the present case, the Court of Justice held that it is clear from the findings made by the General Court that the collective mark was used in accordance with its essential function, in view of the fact that the producer or distributor of the goods at issue was part of the appellant's licensing system.

[116] Judgment of 12 December 2018, Der Grüne Punkt v EUIPO - Halston Properties (Representation of a circle with two arrows) (T-253/17, EU:T:2018:909).

Finally, the Court of Justice points out that the assessment of genuine use of the mark at issue should be carried out by evaluating, particularly, whether such use is viewed as warranted in the economic sector concerned to maintain or create share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark. In this respect, the Court of Justice found that the General Court had failed to apply those criteria to the present case. The Court of Justice held inter alia that it was for the General Court to examine whether the use properly established in that case, namely the affixing of the mark at issue to the packaging of the goods of undertakings affiliated with a system of local collection and of environmentally sound disposal of packaging waste, was viewed, in the economic sector concerned, as warranted to maintain or create a share in the market for the goods. According to the Court, it cannot be ruled out that the indication, by a manufacturer or a distributor on the packaging of everyday consumer goods, of the affiliation with such a recycling system may influence consumers' purchasing decisions and, thus, contribute to the maintenance or creation of a share in the market relating to those goods.

Taking the view that the General Court had erred in law in its application of the concept of 'genuine use', the Court of Justice set aside the judgment under appeal and annulled the decision of the Board of Appeal of EUIPO.

4. Certification mark

Judgment of 11 April 2019, ÖKO-Test Verlag GmbH (C-690/17, EU:C:2019:317)

(Reference for a preliminary ruling – Intellectual property – Trade marks – Regulation (EC) No 207/2009 – Article 9(1) – Directive 2008/95/EC – Article 5(1) and (2) – Rights afforded by a trade mark – Individual trade mark consisting of a quality label)

ÖKO-Test Verlag is an undertaking which evaluates products through performance and compliance tests and then informs the public of the results of those evaluations. It sells a magazine that is published in Germany and contains those results, as well as providing general consumer information.

Since 2012, ÖKO-Test Verlag has been the proprietor of an EU trade mark, consisting of a sign representing a label intended to present the results of tests to which products have been subjected ('the quality label'). It is also the proprietor of a national mark consisting of the same quality label. Those marks (together 'the ÖKO-TEST marks') are registered, inter alia, for printed matter and for services that consist in conducting tests and providing consumer information and consultancy.

ÖKO-Test Verlag selects the products that it wishes to test and evaluates them on the basis of scientific parameters also selected by it, without requesting the manufacturers' consent. It then publishes the results of those tests in its magazine.

Dr. Liebe is an undertaking that produces and markets toothpastes, in particular the 'Aminomed' range. Among the toothpastes in that range, the product 'Aminomed Fluorid-Kamillen-Zahncreme' was tested by ÖKO-Test Verlag in 2005 and was rated 'sehr gut' ('very good'). Dr. Liebe concluded a licensing agreement with ÖKO-Test Verlag in the same year.

In 2014, ÖKO-Test Verlag became aware that Dr. Liebe was marketing one of its products with packaging that reproduced the ÖKO-TEST mark.

ÖKO-Test Verlag brought infringement proceedings against Dr. Liebe before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), submitting that in 2014, Dr. Liebe was not authorised to use the ÖKO-TEST marks on the basis of the licensing agreement concluded in 2005, since, in particular, a new test based on new parameters in respect of toothpastes had been published in 2008 and, additionally, Dr. Liebe's product was no longer the same as that actually tested in 2005, as its name, description and packaging had changed.

That court ordered Dr. Liebe, by instructing it to stop using the quality label for products in the 'Aminomed' range, to withdraw the products concerned from the market and to destroy them. It held that Dr. Liebe had infringed the ÖKO-TEST marks by using the quality label for 'consumer information and consultancy' services, which are covered by the services for which those marks are registered.

Dr. Liebe brought an appeal against that decision before the referring court, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) (the referring court). In turn, ÖKO-Test Verlag lodged a cross-appeal requesting the extension of the court of first instance's decision to the use, by Dr. Liebe, of some word and figurative signs that have not been registered as a mark but are identical to the ÖKO-TEST marks.

The referring court took the view that the licensing agreement at issue had been terminated before 2014. That court deduced therefrom that Dr. Liebe used, in the course of trade and without ÖKO-Test Verlag's consent, a sign identical with, or similar to, the ÖKO-TEST marks. On the other hand, it is not clear that ÖKO-Test Verlag may rely on its exclusive right referred to in Article 9(1)(a) and (b) of Regulation No 207/2009 and in Article 5(1) of Directive 2008/95 against Dr. Liebe. The sign identical with, or similar to, the ÖKO-TEST marks had been affixed by Dr. Liebe to products that are neither identical with, nor similar to, those in respect of which the ÖKO-TEST marks are registered. Furthermore, it could be considered that that sign was not used 'as a trade mark'.

The referring court had doubts, therefore, as to the approach followed by the court of first instance, which equated the use, by Dr. Liebe, of the sign identical with, or similar to, the ÖKO-TEST marks to a use in respect of services for which those marks are registered. Furthermore, the referring court is uncertain as regards the scope of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95.

In those circumstances, the referring court decided to stay the proceedings and to refer several questions for a preliminary ruling.

In the first place, the Court notes that Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 must be interpreted as meaning that they do not entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

In that regard, it points out, firstly, that Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, refer to the 'double identity' situation, in which use by a third party of a sign identical with the trade mark is made in relation to goods or services that are identical with those for which the trade mark is registered. On the other hand, the wording 'in relation to goods and services' does not, in principle, cover goods and services of the proprietor of that mark: they are covered, in Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, by the expression 'those for which the trade mark is registered'. However, use of the sign by the third party to identify the goods of the trade mark proprietor where those goods constitute the actual subject matter of services provided by that third party can, exceptionally, be covered by those provisions. In such a case, that sign is used to identify the origin of the goods that are the subject matter of those services and there is a specific and indissociable link between the goods bearing the trade mark and those services.

Secondly, the Court points out that it follows from Article 9(1)(b) of Regulation No 207/2009 and Article 5(1)(b) of Directive 2008/95, which grant the proprietor of the mark specific protection against the use, by a third party, of signs identical with, or similar to, the mark leading to a likelihood of confusion on the part of the public that that protection granted to the proprietor of the trade mark applies only in cases where there is an identity or similarity – not only between the sign used by the third party and the mark – but also between the goods or services covered by that sign, on the one hand, and those covered by the mark, on the other. Thus, like the expression 'in relation to goods or services', which appears in Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, the words 'goods or services covered by … the sign' referred to in paragraph 1(b) of those articles cover, in principle, the goods marketed or services supplied by the third party In the absence of any similarity between the goods or services of the third party and those for which the mark is registered, the protection granted by those provisions is not applicable.

Secondly, the Courts clarifies that Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a 'due cause', within the meaning of those provisions, in support of such affixing. The provisions determine the scope of the protection that is afforded to the proprietors of marks with a reputation. They entitle those proprietors to prohibit any third party from making, in the course of trade and without the consent of the proprietor, use without due cause of an identical or similar sign – whether for similar goods or services or for goods or services not similar to those for which those marks are registered – that takes unfair advantage of the distinctive character or the repute of those marks or is detrimental to that distinctive character or repute. The exercise of that right is not conditional upon there being a likelihood of confusion on the part of the relevant section of the public. It will be for the referring court to examine whether the affixing by Dr. Liebe, of a sign identical with, or similar to, the ÖKO-TEST marks to its products enabled Dr. Liebe to take unfair advantage of the distinctive character or the reputation of those marks or was detrimental to that distinctive character or reputation. Should it find that to be the case, the referring court will, in addition, have to assess whether Dr. Liebe has established, in this case, a 'due cause', within the meaning of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95, in relation to the affixing of that sign to those products. In the latter case, it would have to be concluded that ÖKO-Test Verlag does not have the right to prohibit that use on the basis of those provisions.

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