OPINION OF ADVOCATE GENERAL CRUZ VILLALÓN delivered on 14 September 2010[1]

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I — Introduction

1. The present appeal forms another chapter in the long history of proceedings between the North American brewery Anheuser-Busch and the Czech brewery Budějovický Budvar, národní podnik ('Budvar'), which already includes a number of judgments of the Court of Justice. [2] Although those earlier judgments may have some influence on certain aspects of the instant case, this dispute raises a legal issue which has hitherto not been addressed in the case-law of the Court.

2 — The latest is the judgment of 29 July 2010 in Case C-214/09 P *Anheuser-Busch, Inc.* v *OHIM and Budějovický Budvar* [2010] ECR I-7665. For more information about the historical roots of the dispute and its most recent judicial chapters, see the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-478/07 *Budějovický Budvar* [2009] ECR I-7721.

2. In *Budějovický Budvar* v *Anheuser-Busch* (BUD), [3] against which this appeal has been lodged, the Court of First Instance (now the General Court) upheld the actions for annulment brought by Budvar against a number of decisions of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') dismissing the opposition proceedings brought by Budvar against the application for registration of Bud as a Community trade mark, filed by Anheuser-Busch.

3. The distinctive feature of this case lies in the fact that Budvar filed its opposition to the registration of Bud as a Community trade mark under Article 8(4) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, [4] claiming the existence of an earlier right to the name Bud consisting in an appellation of origin which was protected in Austria and in France by means of two international instruments.

4. The Court of Justice is therefore required to interpret Article 8(4) of Regulation No 40/94 for the first time, and to do so in a case which does not appear to be the most typical of the kind involving the application of that article. The internal logic of Article 8(4) adapts more readily to rights which are created by the simple use of a particular sign (non-registered marks, for example, but also, depending on the national law concerned, certain company names, establishment or store names and other distinctive signs) than to rights whose protection is derived from formal registration, as occurs in the instant case.

5. The latter factor may have shaped the general tenor of the decision of the Court of First Instance but, to my mind, it should not influence the manner in which the appeal is disposed of. The interpretation of Article 8(4) should certainly be flexible enough to adapt to the wide variety of signs which are covered by the provision. However, this interpretation must also seek to take a unified approach. Otherwise, the requirements laid down in the provision would be unable to fulfil their basic function of ensuring the reliability and real substance of the signs concerned, which is the function assigned to them by the Community legislature.

6. Those requirements are situated on a predominantly factual plane and it is from that perspective that the determination of whether they have been satisfied must be made. That also holds, in my opinion, for cases such as this, in which the existence of formal international legal protection might perhaps suggest that it is necessary to modify

3 — Joined Cases T-225/06, T-255/06, T-257/06 and T-309/06 *Budějovický Budvar* v *OHIM* [2008] ECR II-3555.

4 — OJ 1994 L 11, p. 1.

the requirements relating to the 'use' and 'significance' of the sign.

II — Legal framework

A — *The Lisbon Agreement*

7. Article 1(2) of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration [5] provides that the countries which are contracting parties to the agreement [6] undertake to protect on their territories the appellations of origin of products of the other countries of the 'Special Union', recognised and protected as such in the country of origin and registered at the international office referred to in the Convention establishing the World Intellectual Property Organisation ('WIPO').

8. In accordance with Article 5 of the agreement, the registration of appellations of origin is to be effected at the request of the Offices of the contracting countries, in the name of any natural persons or legal entities, public or private, having, according to their national legislation, a right to use such appellations. In that context, an Office of a contracting country may declare, stating grounds and within a period of one year from the receipt of the notification of registration, that it cannot ensure the protection of an appellation of origin.

9. Pursuant to Articles 6 and 7(1), an appellation of origin registered under the Lisbon Agreement cannot be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.

10. Further, according to Rule 16 of the Regulations under the Lisbon Agreement, where the effects of an international registration are invalidated in a contracting country and the invalidation is no longer subject to appeal, that invalidation must be notified to the International Bureau by the competent authority of that contracting country.

11. The appellation of origin 'Bud' was registered with WIPO on 10 March 1975 with the number 598, under the Lisbon Agreement.

5 — Adopted on 31 October 1958, revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaty Series*, Vol. 828, No 13172, p. 205).

6 — The 'Lisbon Union' (http://www.wipo.int/treaties/en) currently comprises 26 countries, which include the Czech Republic.

B — *The bilateral convention*

12. On 11 June 1976, the Republic of Austria and the Czechoslovak Socialist Republic concluded a treaty on the protection of indications of source, appellations of origin and other designations referring to the source of agricultural and industrial products ('the bilateral convention'). [7]

13. According to Article 2 of the convention, the terms "indications of source', 'appellations of origin' and other designations referring to source are used, for the purposes of the bilateral convention, for all indications which relate directly or indirectly to the source of a product.

14. Under Article 3(1), 'the Czechoslovak designations listed in the agreement to be concluded under Article 6 shall, in the Republic of Austria, be reserved exclusively for Czechoslovak products'. Point 2 of Article 5(1)B refers to beers as one of the categories of Czech products covered by the protection afforded by the bilateral convention, and Annex B to the agreement, to which Article 6 of the convention refers, includes 'Bud' as one of the Czechoslovak designations relating to agricultural and industrial products (under the heading 'beer').

7 — As far as Austria is concerned, it was published in the *Bundesgesetzblatt für die Republik Österreich* of 19 February 1981 (BGBl. No 75/1981) and entered into force on 26 February 1981 for an indefinite period.

C — *European Union law*

15. Since 13 April 2009, the Community trade mark has been governed by the new Regulation (EC) No 207/2009. [8] However, for the purposes of disposing of this appeal, the provisions of Regulation No 40/94 are applicable *ratione temporis*.

16. Article 8(4) of Regulation No 40/94, the interpretation of which is at issue in the instant case, provides as follows:

'Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the law of the Member State governing that sign,

(a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.'

8 — Council regulation of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

17. Article 43(2) and (3) of Regulation No 40/94 provide as follows:

'2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'

18. In accordance with Article 74(1) of Regulation No 40/94, '[i]n proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, [OHIM] shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.'

III — The facts before the Court of First Instance and the judgment under appeal

A — *Facts and procedure before OHIM*

19. On 1 April 1996, 28 July 1999, 11 April and 4 July 2000, Anheuser-Busch, Inc., filed four applications with OHIM for registration of the (figurative and word) mark Bud as a Community trade mark.

20. On 5 March 1999, 1 August 2000, 22 May and 5 June 2001, Budvar filed notices of opposition under Article 42 of Regulation No 40/94, relying, first of all, under Article 8(1)(b) of Regulation No 40/94, on the international figurative mark No 361 566, effective in Austria, Benelux and Italy, and,

second, under Article 8(4) of the regulation, on the appellation of origin 'Bud', registered with WIPO on 10 March 1975, under the Lisbon Agreement, effective in France, Italy and Portugal, and an appellation of origin with the same name protected in Austria under the bilateral convention.

21. By decision of 16 July 2004 (No 2326/2004), the Opposition Division partially upheld the opposition filed against registration of one of the trade marks applied for. However, by decisions of 23 December 2004 (Nos 4474/2004 and 4475/2004) and of 26 January 2005 (No 117/2005), the Opposition Division rejected the oppositions filed by Budvar against registration of the three remaining marks. Budvar appealed against the latter three decisions of the Opposition Division rejecting the oppositions, while Anheuser-Busch also contested the decision of 16 July 2004 partially upholding the opposition concerned.

22. By decisions of 14 June (Case R 234/2005-2), 28 June (Case R 241/2005-2) and 1 September 2006 (Case R 305/2005-2), the Second Board of Appeal of OHIM dismissed the appeals brought by Budvar. By decision of 28 June 2006 (Case R 802/2004-2), the Board of Appeal upheld the appeal brought by Anheuser-Busch and dismissed the opposition filed by Budvar in its entirety.

23. In those four decisions, the Board of Appeal of OHIM stated, first of all, that Budvar no longer appeared to refer to the international figurative mark No 361 566 as the basis of its opposition, but solely to the appellation of origin 'Bud'.

24. Second, the Board of Appeal held that it was difficult to see how the sign BUD could be considered to be an appellation (or designation) of origin, or even an indirect indication of geographical origin, from which it concluded that an opposition could not succeed under Article 8(4) of Regulation No 40/94 on the basis of a right that was presented as an appellation of origin, but was in fact not one at all.

25. Third, the Board of Appeal held, applying by analogy Article 43(2) and (3) of Regulation No 40/94 and Rule 22 of Regulation (EC) No 2868/95, [9] that the evidence provided by Budvar to show use of the appellation of

9 — Commission regulation of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1).

origin 'bud' in Austria, France, Italy and Portugal was insufficient.

26. Fourth and finally, the Board of Appeal held that the opposition had also to be rejected on the ground that Budvar had not demonstrated that the appellation of origin in question gave it the right to prohibit use of the word Bud as a trade mark in Austria or France.

B — *Summary of the judgment under appeal*

27. On 26 August,[10] 15 September[11] and 14 November 2006,[12] Budvar brought before the Court of First Instance actions against those decisions of the Board of Appeal. In support of its action, the applicant put forward a single plea in law claiming infringement of Article 8(4) of Regulation No 40/94. That single plea in law was structured in two parts: the first concerned the validity of the appellation of origin 'bud' (the Board of Appeal had refused to accept that the sign BUD constituted an appellation of origin), while the second concerned the applicability of the requirements laid down in Article 8(4) of Regulation No 40/94 (which the Board of Appeal did not accept and which Budvar claimed).

28. In its judgment of 16 December 2008, which is the subject of this appeal, the Court of First Instance upheld Budvar's action, accepting the first and the second parts of the single plea in law.

29. The Court of First Instance accepted the first part of the single plea in law, drawing a distinction for the purposes of its analysis between the appellation of origin 'bud' registered under the Lisbon Agreement and the appellation of origin 'bud' protected under the bilateral convention.

30. With regard to the former, the Court of First Instance recalled that, in accordance with its case-law, 'the validity of a national trade mark may not be called in question in proceedings for registration of a Community trade mark' (paragraph 88), from which it concluded that 'the system set up by Regulation No 40/94 presupposes that OHIM takes into account the existence of earlier rights which are protected at national level' (paragraph 89). Since the effects of the appellation of origin 'bud' had not been declared definitively to be invalid in France, the Court of First Instance held that the Board of Appeal ought to have taken account of the relevant national law and the registration made under the Lisbon Agreement, and did not have the power to call into question the fact that the claimed earlier right was an 'appellation of origin' (paragraph 90).

10 — Case T-225/06.

11 — Cases T-255/06 and T-257/06.

12 — Case T-309/06.

31. With regard to the latter appellation of origin, the Court of First Instance pointed out that, under Article 2 of the bilateral convention, 'if the indications or appellations concerned relate directly or indirectly to the source of a product, that is sufficient to permit it to be listed under the bilateral convention and thereby to enjoy the protection conferred by the bilateral convention' (paragraph 94). In the light of those matters, the Court of First Instance found that the Board of Appeal held, wrongly, that the protection of the name 'Bud' was specifically attached to its status as an 'appellation of origin' under the bilateral convention (paragraph 95). In addition, the Court of First Instance stated that the bilateral convention is still effective in Austria for the purposes of protecting the appellation 'bud', since there is no indication that Austria or the Czech Republic have denounced that convention and the ongoing proceedings in Austria have not led to the adoption of a final judicial decision (paragraph 98).

32. In the light of the foregoing, the Court of First Instance held that the Board of Appeal infringed Article 8(4) of Regulation No 40/94 by holding, first, that the claimed earlier right was not an 'appellation of origin' and, second, that the question whether the sign Bud was treated as a protected appellation of origin, in France in particular, was of 'secondary importance', and by concluding that an opposition based on that right could not succeed (paragraphs 92 and 97 of the judgment under appeal).

33. The Court of First Instance also upheld the second part of the single plea of annulment, concerning the application of the requirements laid down in Article 8(4) of Regulation No 40/94. Within that second part, Budvar had in turn put forward two complaints.

34. The first complaint concerned the requirement of use of the sign in the course of trade and the requirement that it must be 'of more than mere local significance'.

35. With regard to verification of the requirement relating to use of the signs concerned in the course of trade, the Court of First Instance held that the Board of Appeal made an error of law by deciding to apply, by analogy, the provisions of Community law relating to the 'genuine' use of an earlier trade mark (Article 43(2) and (3) of Regulation No 40/94). First of all, Article 8(4) of Regulation No 40/94 does not refer to the 'genuine' use of the sign relied on in support of the opposition (paragraph 164 of the judgment under appeal). Secondly, in connection with Article 9(1) of Regulation No 40/94 and Articles 5(1) and 6(1) of Directive 89/104/EEC, [13] the Court of Justice and the Court of First Instance have consistently held that 'a sign is

13 — Council directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1).

used in the "course of trade" when that use occurs in a commercial activity with a view to economic advantage and not as a private matter' (paragraph 165). Thirdly, under Article 8(4) of Regulation No 40/94, 'it is possible for certain signs not to lose the rights attached to them, notwithstanding the fact that no 'genuine' use is made of them' (paragraph 166). Fourthly, the Court of First Instance pointed out that, by applying by analogy Article 43(2) and (3) of Regulation No 40/94 and Rule 22 of Regulation No 2868/95 to the case before it, the Board of Appeal analysed, inter alia, use of the sign concerned in each of Austria, France, Italy and Portugal separately, in other words, in each of the territories where, according to Budvar, the appellation 'bud' is protected, notwithstanding the fact that the signs referred to in Article 8(4) of Regulation No 40/94 'may enjoy protection in a particular territory, even though they are not used in that particular territory, but only in another territory' (paragraph 167).

36. The Court of First Instance also held that 'an indication which serves to indicate the geographical origin of a product may be used, like a trade mark, in the course of trade', without it meaning that the appellation concerned is used 'as a trade mark' and consequently loses its primary function (paragraph 175 of the judgment under appeal).

37. As concerns the requirement of significance, the Court of First Instance held that Article 8(4) of Regulation No 40/94 refers to the significance of the sign concerned and not to the significance of its use. The significance of the sign concerned covers the geographical extent of its protection, which must not be merely local. Accordingly, the Court of First Instance found that the Board of Appeal also made an error of law when, as regards France, it linked proof of use of the sign concerned to the requirement that the right concerned must have a significance which is not merely local (paragraphs 180 and 181).

38. In the light of the foregoing, the Court of First Instance concluded that it was appropriate to uphold as well founded the first complaint in the second part of the single plea in law.

39. The second complaint in the second part of the single plea in law concerned the right arising from the sign relied on in support of the opposition. In that connection, the Board of Appeal had referred to the judicial decisions delivered in Austria and France in order to conclude that Budvar had not provided evidence that the sign concerned conferred on it the right to prohibit use of a subsequent mark. The Court of First Instance observed, however, that none of the judicial decisions relied on had acquired the authority of *res judicata*, from which it followed that the Board of Appeal could not rely solely on those decisions as the basis for its conclusion and should also have taken account of the provisions

of national law relied on by Budvar, including the Lisbon Agreement and the bilateral convention (paragraph 192). In that regard, the Court of First Instance pointed out that OHIM must of its own motion acquaint itself, by whatever means appear necessary for that purpose, with the national law of the Member State concerned (paragraph 193). The Court concluded as a result that the Board of Appeal made an error by not taking into account all the relevant elements of fact and law in determining whether, under Article 8(4) of Regulation No 40/94, the law of the Member State concerned confers on Budvar the right to prohibit use of a subsequent mark (paragraph 199).

IV — Proceedings before the Court of Justice and the forms of order sought by the parties

40. Anheuser-Busch's appeal was received at the Court Registry on 10 March 2009, while the responses of Budvar and OHIM were received on 22 and 25 May 2009 respectively. No reply or rejoinder was lodged.

41. Anheuser-Busch asks the Court to set aside the judgment under appeal (with the exception of the first point of the operative part concerning the joinder of the cases), to give final judgment on the dispute by dismissing the action brought at first instance or, in the alternative, to refer the case back to the General Court, and to order Budvar to pay the costs.

42. OHIM seeks identical forms of order, while Budvar contends that the judgment under appeal should be upheld and that the appellant should pay the costs.

43. At the hearing, held on 2 June 2010, the representatives of Anheuser-Busch, Budvar and OHIM presented oral argument and replied to the questions raised by members of the Grand Chamber and the Advocate General.

V — Some preliminary considerations concerning Article 8 of Regulation No 40/94

44. Before turning to the analysis of the present appeal, it is appropriate to carry out a general appraisal of Article 8(4) of Regulation No 40/94, since the interpretation of that provision, which has yet to be examined in the case-law of the Court, is at the centre of the dispute. A proper understanding of the provision also calls for an examination of the other paragraphs of Article 8.

A — *Opposition based on an earlier registered trade mark: Article 8(1) and (2)*

45. Article 8(1) and(2) of Regulation No 40/94 govern opposition to the registration of a Community trade mark based on an earlier trade mark. In particular, paragraph 2 provides that an opposition may be based on an earlier registered trade mark (Community, national or international) and affords the same treatment to national marks which, even though they have not been registered, [14] have become well known in a Member State as a result of particularly intensive use. [15]

46. For an opposition based on such an earlier mark to succeed, Regulation No 40/94 lays down a number of requirements.

47. First of all, in accordance with Article 43(2) and (3) of Regulation No 40/94, the earlier trade mark relied on must have been put to 'genuine use' in the European Union or in the Member State concerned in connection with the goods or services in respect of which it is registered, during the period of five years preceding the date of publication of the Community trade mark application.

48. Second, under Article 8(1) of the regulation, the proprietor of such an earlier trade mark must also prove that the mark whose registration he opposes is identical or similar to his and that there is a likelihood of confusion in the territory in which the earlier trade mark is protected because of the identity or similarity of the goods or services covered by the two trade marks. [16]

49. The third requirement is, therefore, the so-called principle of speciality, according to which an opposition may be filed only where registration is applied for in respect of identical or similar goods or services to those protected by the earlier trade mark. There is, however, an exception to the application of the principle of speciality in the case of trade marks which have a reputation in the Community or in a Member State. In such cases, an opposition will succeed even if the goods or services are not similar, where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark (Article 8(5)).

14 — Article 8(2)(c) is silent in that regard.

15 — Article 6 bis of the Paris Convention for the Protection of Industrial Property of 20 March 1883 (*United Nations Treaty Series*, Vol. 828, No 11847, p. 108), to which Regulation No 40/94 refers in that connection, requires the protection of well-known marks belonging to persons entitled to the benefits of the convention.

16 — However, where the trade marks are identical and the goods or services are identical, the likelihood of confusion is presumed; that appears to follow from Article 8(1)(a) of the regulation.

B — *Opposition based on other signs: Article 8(4)*

50. Irrespective of the foregoing, Article 8 of Regulation No 40/94 also provides for other signs which are not registered or well-known trade marks to be relied on in opposition to the registration of a Community trade mark.

51. More specifically, under Article 8(4), an opposition may be filed by 'the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance'. The provision thus leads to a relatively undefined category of signs (1), while requiring that they must satisfy certain requirements designed to ensure their soundness (2).

1. Article 8(4) covers a very wide variety of signs

52. The lack of precision regarding the nature of the signs which may be relied on under it means that paragraph 4 operates in practice as a kind of 'catch-all' provision or as a heteroclitic group of signs to which must belong not only non-registered trade marks which do not satisfy the requirement of being well known [17] but also any other signs used in the course of trade of more than mere local significance.

53. That initial lack of a precise definition of the material scope of the provision is largely due to the fact that non-registered trade marks and the other signs covered by paragraph 4 are created, recognised and protected by the laws of the Member States and may, therefore, be of a highly disparate nature. An account of that disparate nature is provided by the Opposition Guidelines, published by OHIM, [18] which contain an approximate inventory of signs capable of constituting, in the Member States, 'earlier rights' within the meaning of Article 8(4) of Regulation No 40/94. In addition to non-registered marks, the Guidelines include among such signs trade names, corporate names, establishment or store names, titles of publications and geographical indications. Broadly speaking, therefore, the provision can be said to

17 — Otherwise an opposition would have to be based on paragraph 2(c).

18 — Guidelines concerning Proceedings before the Office for Harmonisation in the Internal Market (Trade Marks and Designs). Part C: Opposition Guidelines (pp. 312 to 339).

cover both diverse signs which fulfil the function of distinguishing or identifying the business activities to which they refer and other signs which indicate the origin of the goods or services for which they are used.

54. The majority of those signs (whether or not they are trade marks) are not suited to the typical registration model, since the right to use them exclusively is acquired or consolidated by use without the need for formal registration. [19] However, Article 8(4) also covers signs which have been the subject of prior registration, including, although this is not the most typical situation to which the provision applies, geographical indications protected in a Member State because they have been registered under the Lisbon Agreement or another international instrument.

55. At this juncture, it would perhaps be appropriate to digress in order to establish which specific geographical indications may or may not be relied on under Article 8(4).

56. First of all, geographical indications which have been registered at Community level must be excluded, since although Regulation No 40/94 is silent in that regard, Article 14 of Regulation (EC) No 510/2006 [20] provides: 'Where a designation of origin or a geographical indication is registered under this Regulation, the application for registration of a trade mark corresponding to one of the situations referred to in Article 13 and relating to the same class of product shall be refused if the application for registration of the trade mark is submitted after the date of submission of the registration application to the Commission.' In line with the foregoing, Article 7(1)(k) of the new regulation on the Community trade mark [21] has included Community designations of origin and geographical indications among the absolute grounds for refusal of registration of a Community trade mark.

57. Consequently, Article 8(4) will be effective only for geographical indications which *are not* registered at Community level but which benefit from protection at national level. These may include geographical indications which have been registered under the

19 — Information taken from the list of signs contained in the Opposition Guidelines.

20 — Council regulation of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 2006 L 93, p. 12).

21 — Regulation No 207/2009.

Lisbon Agreement or another international instrument. [22]

58. This type of sign has more formal protection, involving prior registration. To my mind, in so far as such registration creates rights, its continued existence will be the only factor to take into account for the purposes of determining the validity of the geographical indication concerned. That does not mean, however, that registration alone is sufficient to enable recourse to Article 8(4): the requirements relating to the use, significance and characteristics of the right provided for in that provision must also be satisfied in the case of non-Community geographical indications, which may only be invoked in opposition to an application for registration of a Community trade mark under Article 8(4).

59. Consequently, contrary to Budvar's assertion at the hearing, [23] it is my view that the specific nature of this type of sign and the protection to which it is entitled as a result of registration at international level does not exempt it from compliance with the conditions laid down in Article 8(4). Only compliance with those conditions will make it possible to ensure that, despite being a simple geographical indication (and therefore excluded from the right to Community protection), such a sign has a substance and soundness which mean that it warrants this special protection. Otherwise, the sign would be treated in the same way as Community designations of origin and geographical indications.

22 — It is my view that, in the light of the ruling of the Court of Justice of 8 September 2009 in *Budějovický Budvar*, the survival of this type of geographical indications is possible provided that they are simple indications which do not fall within the scope of Regulation No 510/2006. However, it may be inferred from that judgment that eligible designations of origin and geographical indications which could have been registered at Community level – but have not been – cannot continue to receive protection at national level, in particular, under a bilateral convention between two Member States. According to the case-file, the sign BUD was expressly relied on by Budvar in its capacity as an 'appellation of origin'. In addition to the uncertainties which may exist concerning its true nature, the mere fact that the sign was presented as an appellation of origin which has not been registered at Community level could lead, in accordance with the case-law cited on the exhaustive nature of Regulation No 510/2006, to it being held to be invalid for the purposes of the opposition. The fact is, however, that the foregoing considerations have no effect at all on the present proceedings, since Anheuser-Busch has not raised that possible defect of the sign relied on and it is not a ground which the Court may or must consider of its own motion, particularly in the context of an appeal.
In relation to grounds of 'public interest', see the Opinion of Advocate General Jacobs in Case C-210/98 P *Salzgitter* v *Commission* [2000] ECR I-5843, points 141 to 143, and the Opinion of Advocate General Mengozzi in Case C-443/05 P *Common Market Fertilizers* v *Commission* [2007] ECR I-7209, points 102 and 103. Reference may also be made to Vesterdorf, B., 'Le relevé d'office par le juge communautaire', *Une Communauté de droit: Festschrift für G.C. Rodríguez Iglesias*, Nomos, 2003, p. 551 et seq.

23 — Budvar adopted the same position before OHIM in the opposition proceedings, as is clear from point 13(b) of the decision of the Board of Appeal of 14 June 2006.

2. The requirements laid down in Article 8(4) are designed to ensure the soundness of signs relied on thereunder

— On the other hand, two conditions (use 'in the course of trade' and 'more than mere local significance') designed to ensure that, in addition to being protected at national level, the signs concerned have a certain commercial presence and importance.

60. The initial broad scope of Article 8(4), which is generous with regard to the type of signs giving rise to the right to file an opposition thereunder, is immediately restricted by a number of conditions which signs must satisfy if they are to serve as the basis for refusal to register a Community trade mark.

62. The Community legislature thus took as its starting point the need to protect signs recognised nationally but created two levels of protection: the first, for signs which have special importance because they are 'used in the course of trade' and are 'of more than mere local significance' and may block the registration of a Community trade mark under Article 8(4) of Regulation No 40/94; and the second, for rights of local significance which are not permitted to preclude the registration of a Community trade mark but may preclude its use in the territory where the right is protected, in accordance with Article 107 of the regulation.

61. The main purpose of those conditions is specifically to limit the scope of this ground of opposition, so that it may be relied on only by the proprietors of particularly strong, important signs. Thus, Article 8(4) lays down:

— On the one hand, two conditions aimed at ensuring that the sign concerned is specially protected at national level (in particular, that it 'confers on its proprietor the right to prohibit the use of a subsequent trade mark'), and that its proprietor acquired the right to use it prior to the Community trade mark application or the date of the priority claimed. These two conditions, set out in points (a) and (b) of Article 8(4) must, logically, be examined under 'the law of the Member State governing that sign'.

63. As regards national signs, it is those having certain characteristics which justify blocking the registration of a trade mark at Community level which are selected and given special protection using the double test of 'use' and 'significance'. As the appellant rightly points out, if it were possible for any national sign whatsoever to prevent the registration of a Community trade mark, it would be virtually impossible to achieve a unified trade mark for the whole of the European Union. Once registered, a Community trade mark is valid and is protected throughout the territory of

the European Union (Article 1 of Regulation No 40/94). Accordingly, for a national sign, or one which is protected in a number of Member States, to be able to hinder the registration process, it must have special force, that is certain characteristics which enable it to block the registration of a trade mark, with effect throughout the European Union.

64. In my view, those characteristics do not immediately arise as a result of any registration that may have occurred. The terms used by the legislature appear to indicate the need to carry out an assessment which is rather more factual and linked to the importance of the trade mark in the course of trade. In short, the conditions in question are ones which the legislature consciously placed on a factual level and which are more closely related to the facts than to the abstract matter of legal protection.

65. In the case of most signs which are covered by Article 8, both elements occur in parallel. When that is not the case – as in this instance – Article 8(4) requires additional checks of factual information concerning where, when and in what conditions the sign concerned has been used. Even where its legal protection at national level is independent of those facts and exists even without the need for any use, a sign may be relied on in opposition proceedings only if it satisfies these conditions which are designed to ensure it has a minimum of soundness.

66. Lastly, I believe that it is necessary to point out, in this preliminary outline, that those conditions or characteristics laid down in Article 8(4) constitute a framework which was created for a particular situation by the legislature and that they are not comparable to the conditions laid down for other grounds of opposition to the registration of a Community trade mark.

C — *Whether it is appropriate to apply by analogy the requirements of Article 8(1) to (4)*

67. The judgment under appeal and the appeal itself repeatedly put forward arguments concerning whether it is appropriate or inappropriate, as the case may be, to apply to the context of Article 8(4) the requirements for an opposition based on an earlier trade mark, laid down in Article 8(1) and other related provisions such as Article 43. Resorting in part to such application by analogy has, as will be seen below, led to inconsistent results. The main argument used in support of the application by analogy of Articles 8(1) and 43(2) and (3) is that trade marks warrant more favourable treatment than other signs because both (harmonised) national trade marks and the Community trade mark are governed by

homogeneous standards which are acceptable throughout the European Union and therefore provide greater guarantees than a non-registered trade mark or any of the other signs referred to in Article 8(4).

68. In my view, there are insufficient grounds for the above arguments in their entirety. Regulation No 40/94 has divided the grounds for opposition to registration of a Community trade mark into various groups and has assigned different requirements to each one, and it would simplify matters excessively to grade them at a higher or lower level by reference to how much confidence the Community legislature may have in the sign concerned. A closer inspection of the abovementioned requirements reveals that this approach cannot be sound.

69. Registration and Community harmonisation are certainly factors which the legislature took into account, but in conjunction with the nature of the sign concerned; that alone explains why no requirement of use is attached to Community designations of origin [24] but, by contrast, registered trade marks must have been put to genuine use for a period of five years. With regard to signs covered by Article 8(4), the legislature wished to create a different set of requirements, strict enough to ensure that the scope of the provision does not extend beyond what is appropriate but also flexible enough to adapt to the many kinds of signs to which the provision may apply.

70. That diversity is, to my mind, the only factor which can explain the fact that Article 8(4) does not lay down the principle of speciality for oppositions filed under it. Unlike an opposition based on an earlier registered trade mark, which is only possible where that trade mark covers goods or services identical or similar to the ones covered by the trade mark whose registration is opposed, where a non-registered trade mark or any other sign is invoked the requirement that the goods or services must be identical or similar is not necessary (unless it is required by national law in order to confer on the proprietor of the sign 'the right to prohibit the use of a subsequent trade mark'). That may appear all the more surprising in view of the fact that the principle of speciality is required in order to rely successfully on a Community designation of origin or geographical indication as an absolute ground for refusal to register a subsequent Community trade mark. [25]

24 — Article 14 of Regulation No 510/2006 and Article 7(1)(k) of the new regulation on the Community trade mark (Regulation No 207/2009).

25 — See the provisions cited in the previous footnote.

71. In my opinion, all the foregoing is proof that the greater 'guarantees' afforded, at least in theory, by Community or harmonised trade marks are not the only factor to be taken into account when interpreting the conditions necessary for relying on a particular sign in opposition to a subsequent Community trade mark. In particular, the conditions laid down in Article 8(4) must be treated as a whole and may not be compared with the remedies provided for by the legislature for different situations.

VI — Analysis of the appeal

72. The appellant puts forward two grounds of appeal, the first claiming infringement of Article 8(4) of Regulation No 40/94, and the second claiming infringement of Articles 8(4) and 74(1) of the regulation.

A — *First ground of appeal: infringement of Article 8(4) of Regulation No 40/94*

73. The first ground of appeal, concerning infringement of Article 8(4) of Regulation No 40/94, is divided into three parts.

1. First part of the first ground of appeal: the competence of OHIM to assess the validity of the right claimed under Article 8(4)

(a) Definition of positions

74. Anheuser-Busch submits that the Court of First Instance erred in law when it held, in paragraphs 79 to 100 of the judgment under appeal, that the Board of Appeal was not competent to determine whether Budvar had established the validity of the earlier rights claimed under Article 8(4) of Regulation No 40/94.

75. In its appeal, Anheuser-Busch maintains that OHIM should determine whether the rights on which the opposition is based actually exist as claimed, whether they are applicable and whether they may be invoked against the Community trade mark application. Merely referring to the registration of the right at national level is not, the appellant submits, sufficient to establish the existence of that right, since registration creates only a simple legal presumption.

76. In support of its view, Anheuser-Busch also complains that the Court of First Instance relied on its case-law concerning Article 8(1)

of Regulation No 40/94,[26] asserting that it should be applied by analogy. In accordance with that case-law, the validity of a national trade mark cannot be called into question in a procedure for registration of a Community trade mark. The appellant submits that there is no legal basis for drawing that analogy with Article 8(1), since the existence of harmonisation in the field of trade marks guarantees that the same criteria and standards are applied to registered trade marks throughout the territory of the European Union, whereas signs covered by Article 8(4) are not harmonised.

(b) Assessment

77. In my opinion, it is not correct to assert that the Court of First Instance applied Article 8(1) of Regulation No 40/94 by analogy. In fact, the judgment under appeal merely extends the reasoning developed by the case-law in relation to national registered trade marks to signs covered by Article 8(4), concluding that OHIM is not competent to give a ruling on the validity of such signs, since, like the trade marks referred to, they are governed by the national law of the Member State concerned and their validity may be determined only in that context.

78. To my mind, the fact that national trade marks are harmonised and other signs are not is not a decisive factor for these purposes.

79. By creating the ground for opposition under Article 8(4), the Community legislature also gave a vote of confidence to the laws of the Member States referred to therein, subject solely to the requirement to check that the conditions designed to restrict the scope of the provision are satisfied (the temporal priority of the right, the requirement that the sign must be specially protected at national level, that it must be used in the course of trade and that it must be of more than mere local significance). The European Union authorities are entitled only to verify that those conditions have been satisfied but not to call into question the validity of the national law concerned or whether the protection it provides is effective in the Member State. If that were not the case, it would be tantamount to granting OHIM the power to interpret and apply national rules, something which is wholly outside its jurisdiction and which could lead to serious interference in the existence and protection of the sign at national level.

26 — Case T-6/01 *Matratzen Concord* v *OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 55; Case T-186/02 *BMI Bertollo* v *OHIM - Diesel (DIESELIT)* [2004] ECR II-1887, paragraph 71; Case T-269/02 *PepsiCo* v *OHIM - Intersnack Knabber-Gebäck (RUFFLES)* [2005] ECR II-1341, paragraph 26; and Case T-364/05 *Saint-Gobain Pam* v *OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 88.

80. Accordingly, in my view, only if the protection of the sign had been definitively annulled in the Member State concerned (by judicial decision or by the appropriate procedure) could and should OHIM have taken that factor into consideration and rejected the opposition based on that sign.

81. The foregoing is particularly clear when, as is the case here, protection of the sign is derived from a formal act such as registration. In those circumstances, it is normal that the validity of the registration cannot be called into question in a procedure to register a Community trade mark but only in the appropriate proceedings for a declaration of invalidity in accordance with the provisions governing that registration.

82. Under the Lisbon Agreement, only an administrative authority of one of the contracting countries may declare invalid the effects of a registered appellation of origin, either by declaring, within a period of one year from receipt of the notification of registration, that it cannot ensure the protection of an appellation of origin (Article 5 of the Lisbon Agreement) or by declaring that its protection in the country of origin is invalid (Articles 6 and 7 of the Lisbon Agreement). Apart from those two methods, the validity of an international registration and the effectiveness of the protection which it ensures in the contracting countries may not be called into question.

83. As regards protection under the bilateral convention, it is my view that only the denunciation or amendment of the convention, or a final judicial decision declaring that protection in the country concerned no longer exists, would make it possible to exclude the existence of a sign which is viable for the purposes of an opposition based on Article 8(4) of Regulation No 40/94.

84. In the instant case, the Board of Appeal regarded as 'of secondary importance' the question whether the sign Bud was treated as a protected appellation of origin in France, Italy and Portugal pursuant to the Lisbon Agreement, and in Austria pursuant to the bilateral convention concluded between that Member State and the Czech Republic, since 'an opposition cannot succeed... on the basis of a right that is presented as an appellation of origin but is not in fact an appellation of origin at all'. In that connection, OHIM relied on the characteristics which case-law and Community legislation [27] lay down for the classification of a sign as a 'designation of origin', concluding that the sign relied on did not satisfy those characteristics. In the light of the points set out above, those considerations are far from conclusive. In so far as the rights

27 — Regulation No 510/2006.

claimed have not been definitively declared invalid in accordance with the procedures laid down in the legal system which affords them protection, the Board of Appeal could not call into question their validity or whether they constituted an 'appellation of origin'.

85. Accordingly, in my view, it is appropriate to reject the first part of the first ground of appeal.

2. Second part of the first ground of appeal: the requirement of 'use in the course of trade'

86. The appellant maintains that the Court of First Instance misconstrued the requirement of 'use in the course of trade', laid down in Article 8(4), from a threefold perspective: first of all, with regard to the quantity and quality of use, by not assimilating it to the 'genuine use' required for registered trade marks; second, with regard to the place of use, by stating that account may be taken of evidence from the territory of Member States other than those where the right claimed is protected; and third, with regard to the relevant period for proving use, by rejecting the date of application for registration as the material date and replacing it with the date of publication of that application.

87. In that way, the appellant submits, the Court of First Instance interpreted the requirement of 'use in the course of trade' in the least stringent manner possible, thereby committing an error of law.

(a) Quantity and quality of use

(i) Definition of positions

88. The first of these three complaints concerns paragraphs 160 to 178 of the judgment under appeal. In those paragraphs, the Court of First Instance stated that the requirement of 'use in the course of trade', laid down in Article 8(4) of Regulation No 40/94, must not be interpreted in the same way as the requirement of 'genuine use' laid down in Article 43(2) and (3) of the regulation for oppositions based on an earlier trade mark – which was how the Board of Appeal proceeded with its interpretation.

89. The appellant criticises that choice of interpretation, arguing that if the condition of 'genuine use' were not applied in the context

of Article 8(4), registered trade marks would be made subject to more rigorous requirements than signs covered by paragraph 4 for the purposes of their use in opposition to the registration of a subsequent Community trade mark. Just as the requirements for a finding of infringement of a trade mark (Article 9(1) of Regulation No 40/94) are less stringent than those pertaining to the continued use of a trade mark (Articles 15 and 43(2) and (3) of the regulation), Anheuser-Busch submits that the greatest rigour should apply where, as with Article 8(4), the right concerned '[constitutes] a right that is allowed to interfere with other traders' commercial activities.

90. Thus, in the view of Anheuser-Busch, the application of the criterion of 'genuine use' means, on the one hand, that it is not possible to take into account, as evidence of such use, the handing-out of free samples, which, according to the appellant, are excluded from the definition by the judgment in *Silberquelle*. [28] In addition, the appellant submits that, to be classified as genuine, the use of an appellation of origin or a geographical indication relied on under Article 8(4) must be effected in accordance with the essential function of such a sign, which is simply to guarantee to consumers the geographical origin of the goods and their inherent qualities.

28 — Case C-495/07 [2009] ECR I-137, paragraphs 21 and 22.

(ii) Assessment

91. Budvar has adopted the same approach in its interpretation of the phrase 'use in the course of trade' as the judgment under appeal. Basically, that approach involves deciding between (i) assimilating the phrase to the concept of 'genuine use' in Article 43(2) of Regulation No 40/94 and (ii) interpreting it in the same way as case-law has interpreted the identical terms 'using in the course of trade' in Article 9(1) of Regulation No 40/94 and Articles 5(1) and 6(1) of Directive 89/104.

92. There are, in fact, important differences between these two degrees of use. First of all, according to case-law, there is 'genuine use' of a trade mark, within the meaning of Article 43 of Regulation No 40/94, 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 token use for the sole purpose of preserving the rights conferred

by the mark'.[29] As regards the concept of 'use in the course of trade', the Court has so far only had the opportunity to interpret this term in relation to Article 9(1) of Regulation No 40/94 and Articles 5(1) and 6(1) of Directive 89/104, holding that a sign is used in the course of trade where that use occurs 'in the context of commercial activity with a view to economic advantage and not as a private matter'.

93. In my opinion, however, this dual approach disregards the *ratio legis* of Article 8(4). First, that provision lays down a special set of conditions which must be interpreted independently of those laid down for the other grounds of opposition; second, the provision has its own underlying rationale which differs from that of Article 43(2) and, above all, from that of Article 9(1) of the regulation.

94. The argument relating to legal certainty put forward by Budvar (the requirement must be interpreted identically in respect of all the provisions of the regulation in which it appears) should certainly not be overlooked but it is not sufficient to support the view of the Court of First Instance. As a general rule, that principle requires that the interpretation of an indeterminate legal concept must be uniform, particularly when two provisions in the same set of rules, or sets of rules with related subject-matter, use the same terminology (as certainly occurs in the instant case with Articles 8(4) and 9(1) of Regulation No 40/94 and Articles 5(1) and 6(1) of Directive 89/104). However, this criterion for interpretation, according to which a single definition must be applied to identical terms, may not be so rigid that it completely ignores the context in which the concept in question is used. In this case, the requirement carries out entirely different functions according to which provision it is used in.

95. Article 8(4) of Regulation No 40/94 requires a sign to be 'used in the course of trade' as a condition for relying on that sign in opposition to an application to register a new Community trade mark; it therefore seeks to create a ground of opposition against an attempt to register a Community trade mark. Article 9(1) of the regulation, however, uses the term to describe the use of a sign identical or similar to a Community trade mark, which the proprietor of the Community mark may prohibit; in this latter case, therefore, the aim is to guarantee, in terms that, logically, are as broad as possible, the scope of the exclusive

29 — Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237, paragraph 70, and Case C-234/06 P *Il Ponte Finanziaría* v *OHIM* [2007] ECR I-7333, paragraph 72. See also, in connection with Article 10(1) of Directive 89/104, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 27.

right of use vested in the proprietor of a Community trade mark. [30]

96. In those circumstances, Article 8(4) uses the term in a positive sense, requiring a minimum 'threshold of use' for the purposes of opposing the registration of a Community trade mark. Article 9(1), on the other hand, uses the term in a negative sense, for the purposes of prohibiting types of conduct which are 'hostile' to a registered trade mark in the broadest terms possible.

97. However, that does not mean that it is correct to interpret Article 8(4) by reference to Article 43(2), as the Court of First Instance did in the judgment under appeal. What I am saying is that the concept of use in the course of trade requires its own interpretation, namely that an opposition brought on the basis of one of these signs must establish a 'use' worthy of being called such.

98. Accordingly, in my opinion, the requirement of 'use in the course of trade' in Article 8(4) of Regulation No 40/94 is, like the other requirements in that provision, an independent concept [31] which warrants its own interpretation.

99. First of all, it is my view that, although it is not essential that a sign be used in order to 'create or preserve an outlet', there must be specific use in a commercial context, which does not include use as a private matter, and the distribution of free samples, for example, will not suffice.

100. Second, it also appears reasonable to require use which accords with the essential function of the sign concerned. In the case of geographical indications, that function consists in guaranteeing that the public is able to identify the geographical origin and/or certain inherent characteristics of the product concerned.

30 — Articles 5(1) and 6(1) of Directive 89/104 serve the same purpose. I agree with the assertion of my colleague Advocate General Sharpston that the interpretation of Directive 89/104 must be coherent with that of Regulation No 40/94 (Opinion in Case C-529/07 *Chocoladefabriken Lindt & Sprüngli* [2009] ECR I-4893, point 16), but I do not believe that it is possible to conclude from that, as Budvar appears to, that such 'coherence' must be sought without taking account of the function which each article carries out. In the present case, coherence would be required between Articles 5(1) and 6(1) of the directive and Article 9(1) of the regulation, which are the articles containing comparable subject-matter (and to which the case-law refers at the moment). In my view, the extension to Article 8(4) of the definition given to them by case-law is not as clear.

31 — In fact, in addition to satisfying this Community requirement of use in the course of trade, a sign must satisfy the level of use which, where appropriate, is required of it in the provisions of the Member State concerned in order to confer on its proprietor 'the right to prohibit the use of a subsequent trade mark' (Article 8(4)(b) of Regulation No 40/94).

101. An interpretation of that kind (which, in my view, has the virtue of being adaptable to the numerous different signs which are caught by Article 8(4)) could, provided that evidence is produced, render relevant the arguments of Anheuser-Busch to the effect that Budvar has used the sign BUD as a trade mark rather than for the purpose of indicating the geographical origin of the product.

(b) Relevant territory for the establishment of 'use in the course of trade'

(i) Definition of positions

102. The second complaint concerns the relevant territory for the establishment of the requirement of 'use in the course of trade'.

103. The appellant submits that the Court of First Instance infringed the principle of territoriality and misconstrued Article 8(4) of Regulation No 40/94 by stating, in paragraphs 167 and 168 of the judgment under appeal, that 'it does not follow from the wording of [that provision] that the sign concerned must be used in the territory whose law is invoked in support of the protection of that sign'. In particular, the Court of First Instance referred to the need to take into account the evidence produced by Budvar on the use of Bud in Benelux, Spain and the United Kingdom, even though the opposition was based on exclusive rights existing only in Austria and France.

104. According to Anheuser-Busch, the requirement of 'use in the course of trade' refers only to the use to which the sign is put in the territory where it benefits from the protection invoked. Anheuser-Busch submits that this is required by the principle of territoriality, which is applicable to intellectual property rights in general and designations of origin in particular. Lastly, the appellant again puts forward the argument relating to a comparison with the rules on trade marks: if account were taken of use in those other territories, unharmonised signs covered by Article 8(4) would receive more favourable treatment than trade marks under Article 8(1) and (2), since, in the case of the latter, the article requires genuine use in the territory concerned.

(ii) Assessment

105. In connection with the second complaint, I agree with the appellant's arguments based on the principle of territoriality, although not with the argument based on a comparison with the trade mark rules for the reasons given earlier.

106. In my view, a territorial assessment of the requirement of use is essential whatever the sign relied on. In the case of trade marks, Article 43(2) and (3) of Regulation No 40/94 explicitly stipulate that proof must be provided of genuine use 'in the Community' (where a Community trade mark is invoked) or 'in the Member State in which the earlier national trade mark is protected'. However, the silence of Article 8(4) on this point may not be interpreted as an intention to exclude a requirement resulting naturally from the effect of the principle of territoriality, which is generally applicable to all intellectual property rights. [32]

107. Community legislation and case-law provide numerous examples of the application of that principle.

108. It follows from Article 8(1)(b) of Regulation No 40/94, for example, that the existence of a likelihood of confusion resulting from the similarity between the trade mark whose registration is sought and an earlier trade mark and between the goods or services covered by the trade marks must be assessed in relation to the public in the territory in which the earlier trade mark is protected. [33]

109. Article 3(3) of Directive 89/104, which excludes the application of the grounds for invalidity or refusal to register a trade mark where it has acquired a distinctive character 'following the use which has been made of it', does not specify where such use must be verified. However, the Court has held that, for those purposes, 'only the situation prevailing in the part of the territory of the Member State concerned (or, as the case may be, in the part of the Benelux territory) where the grounds for refusal have been noted is relevant.' [34]

110. Likewise, Article 7(3) of Regulation No 40/94 excludes the application of the grounds for absolute refusal to register a Community trade mark where it has 'become distinctive... in consequence of the use

32 — Among the first to recognise this principle was Hagens who, as early as 1927, disputed the traditional view concerning the universality of trade marks held by German academic writers, stating that that view was untenable because its application would entail interference in the legal sphere of foreign sovereign States (Hagens, A., *Warenzeichenrecht*, Berlin and Leipzig, 1927). The German Supreme Court adopted the view of Hagens in a judgment of 20 September 1927 and today it is commonly accepted as a principle of trade mark law, while, in my view, the international treaties, which are mainly founded on the principle of reciprocity, do not lessen its importance.

33 — To that effect, see Case C-412/05 P *Alcon* v *OHIM* [2007] ECR I-3569, paragraph 51, and *Il Ponte Financiaría* v *OHIM*, paragraph 60.

34 — Case C-108/05 *Bovemij Verzekeringen* [2006] ECR I-7605, paragraph 22. In addition, in her Opinion in that case, Advocate General Sharpston takes as a starting point the necessary territorial assessment of these requirements and states that, unlike what may be required for national trade marks, in the case of Community trade marks it is reasonable to require the mark's owner to demonstrate 'distinctive character acquired through use over a greater geographical area' (point 45).

which has been made of it', while the Court has stated that a trade mark can be registered under that provision only if evidence is provided 'that it has acquired, through the use which has been made of it, distinctive character in the part of the Community in which it did not, *ab initio*, have such character for the purposes of Article 7(1)(b). The part of the Community referred to in Article 7(2) may be comprised of a single Member State.' [35] It suffices, therefore, for the purposes of blocking registration at Community level, if a trade mark lacks distinctive character in a single Member State; however, as soon as the mark for which Community registration is sought acquires distinctive character in the territory where it lacked such character, the ground for refusal is no longer applicable.

111. Finally, I consider that only if the principle of territoriality is strictly applied can the purpose of Article 8(4) be fulfilled. If, through the requirement of 'use in the course of trade', the objective is to ensure that a sign relied on thereunder is of some significance to the public, it is logical that such significance, acquired through use, should be proved in relation to the territory where the sign is protected, and that it is not sufficient that the sign has been used in a different territory (which might even be outside the European Union) where it has no protection.

35 — Case C-25/05 P *Storck* v *OHIM* [2006] ECR I-5719, paragraph 83.

(c) Relevant period for the purposes of assessing 'use in the course of trade'

(i) Definition of positions

112. The third complaint concerns the relevant period of time for assessing the requirement of 'use in the course of trade' and, in particular, its *dies ad quem.*

113. In the opinion of Anheuser-Busch, the Court of First Instance misconstrued Article 8(4) of Regulation No 40/94 by stating, in paragraph 169 of the judgment under appeal, that it does not follow from that provision 'that the opposing party must show that the sign concerned was used prior to the Community trade mark application', and that instead, '[a]t most it may be required, as for earlier trade marks, and to avoid situations where the earlier right is used solely because of opposition proceedings, that the sign concerned was used before publication of the trade mark application in the *Community Trade Marks Bulletin*'.

114. The appellant submits, on the contrary, that all the conditions for opposing the registration of a trade mark must be satisfied at the time the application for the subsequent mark is filed and that it is not appropriate to allow

the opposing party a longer time-limit to use in the course of trade the sign opposing the trade mark applied for.

(ii) Assessment

115. In this connection, I consider to be correct the appellant's assessment to the effect that use of the sign must, where appropriate, be proved before the date of filing, rather than at any time up to the date of publication of the application for registration.

116. First, for the reasons already stated in Section V of this Opinion, the silence of the legislature means that, in connection with this point also, an autonomous interpretation must be effected with regard to the ground of opposition under Article 8(4) of Regulation No 40/94.

117. On the one hand, it is necessary to reject the application by analogy of Article 43 of Regulation No 40/94 proposed by the Court of First Instance in the judgment under appeal. [36] That reasoning of the Court of First Instance entails a serious internal contradiction, since only a few paragraphs earlier it ruled out the application by analogy of Article 43 in connection with the concept of 'use in the course of trade'. For the sake of consistency, if 'use in the course of trade' is interpreted as being different from 'genuine use' under Article 43(2), the interpretation of the temporal requirement in the judgment under appeal must be rejected. Nor does that mean, on the other hand, that that conclusion may be reached by simply applying by analogy the case-law on Article 8(5), [37] which was devised for a totally different situation (an opposition based on an earlier trade mark which has a reputation). The judgments cited by the appellant involve clear applications of the principle of priority, which governs industrial property rights and which must also be taken into account in the context of Article 8(4).

118. In my opinion, the reference point for the principle of priority must be the date of the application for registration of the new Community trade mark, and not the date on which the application is published in the *Community Trade Marks Bulletin*. If the aim is to ensure that the use in the course of trade of the sign relied on in opposition consolidates that sign and gives it the necessary weight so that it may legitimately be relied on in opposition to the registration of a new Community trade mark, then it seems reasonable to require the sign to have been used

36 — Although it does not specifically cite Article 43 of the regulation for those purposes, paragraph 169 of the judgment under appeal states that the criterion of the publication date is required 'as for earlier trade marks' in a clear reference to the requirements laid down in that article.

37 — See footnote 36.

before the date of application for registration in question.

119. Any other solution might encourage fraud, by allowing the proprietor of an earlier right to 'improvise' an artificial use of his sign in the transitional period between the date of filing of the application (which, as was confirmed at the hearing, may be ascertained through informal channels) and the date of its publication in the *Community Trade Marks Bulletin*, merely so that he could then claim that use in opposition. [38]

120. In its statement in intervention, Budvar claims that Article 8(4)(a) specifically requires that the right to use the sign must have been acquired prior to the date of filing of the Community trade mark application or, where applicable, prior to the date of the priority claimed in support of the Community trade mark application, but that that same temporal condition does not apply to the requirement of use in the course of trade. In Budvar's view, it would therefore suffice for the right on which the opposition is based to have been acquired prior to the date of filing of the trade mark application, even though use of that right only took place afterwards during the period leading up to the official publication of the application. I disagree with that interpretation of the provision. In my opinion, the wording of the provision does not prevent the same temporal condition being extended to the requirement of use; moreover, it would be more logical if all the requirements laid down in Article 8(4) were coordinated in terms of time. Otherwise, as I have indicated, the system could readily lend itself to fraud; if, as the judgment under appeal itself states, the aim is to 'to avoid situations where the earlier right is used solely because of opposition proceedings', there must be a guarantee that use of the sign concerned would have taken place whether or not the Community trade mark was applied for and that is something which it is only possible to ensure by requiring use to have occurred before the application was filed.

121. Lastly, Budvar also claims that an application for registration may be relied on vis-à-vis third parties only when it has been published. In my opinion, that argument is ineffective because, in this case, it is not a question of determining the fact giving rise to a possible right of opposition but rather of proving that the sign relied on has a degree of commercial substance.

38 — It was also confirmed at the hearing that this period may last several months or even more than a year, as in the case of a number of the applications with which the present proceedings are concerned. In such cases, there is clearly a greater likelihood that certain circles will learn of the filing of the application before it is published. It can only be a cause for concern if the only proved usage of the sign relied on has taken place in the period between the date of the trade mark application and its publication.

(d) Corollary

122. In view of the fact that the three complaints are well founded, I consider that it is appropriate to allow the second part of the first ground of appeal.

3. Third part of the first ground of appeal: the requirement 'of more than mere local significance'

(a) Definition of positions

123. In the third part of the first ground of appeal, Anheuser-Busch contends that the Court of First Instance in paragraphs 179 to 183 of the judgment under appeal misconstrued the expression 'of more than mere local significance'.

124. Even accepting that, according to Article 8(4), it is the sign (rather than its use) which must have 'more than mere local significance', the appellant submits that the term 'significance' must necessarily be linked to the market of the country where that sign is protected and that a sign may have 'significance' in trade only if it is used in that market. The mere fact that the laws of two or more States grant exclusive rights to an individual in respect of a specific sign does not mean that, for that reason alone, the sign already has 'significance' in trade in those States.

125. Further, Anheuser-Busch contends that the geographical scope of the protection provided under national law is not an appropriate criterion for these purposes since, otherwise, the requirement would be made subject to the national law of the Member States, which would be contrary to the case-law according to which Community trade mark law is autonomous and is not subject to national law (Case C-238/06 P *Develey* v *OHIM* [2007] ECR I-9375, paragraphs 65 and 66).

(b) Assessment

126. In my view, the judgment under appeal supplies an interpretation which is excessively literal and sticks too closely to the wording of Article 8(4).

127. First, as the judgment under appeal states,[39] it is true that the expression 'more than mere local significance' describes the

39 — Paragraph 180.

sign concerned rather than its use in the course of trade; in short, it refers to the significance of the sign concerned and not to the significance of its use. That is confirmed by an analysis of a number of the different language versions of the provision. The Italian version is one of the clearest, since it includes the conjunction 'and' ('contrassegno utilizzato nella normale prassi commerciale e di portata non puramente locale'), but the French ('signe utilisé dans la vie des affaires dont la portée n'est pas seulement locale'), Portuguese ('sinal utilizado na vida comercial cujo alcance não seja apenas local') and German ('eingetragenen Marke oder eines sonstigen im geschäftlichen Verkehr benutzten Kennzeichenrechts von mehr als lediglich örtlicher Bedeutung') versions do not leave any room for uncertainty either, and it is difficult to opt for another interpretation even where the wording could sow some seeds of doubt, such as the Spanish ('signo utilizado en el tráfico económico de alcance no únicamente local') and English ('sign used in the course of trade of more than mere local significance') versions.

128. Notwithstanding the assertion of the Court of First Instance in the judgment under appeal, the foregoing cannot mean that the significance of the sign is equivalent to the geographical extent of its legal protection or that a sign is of more than local significance merely because it is legally protected in more than one country.

129. As I have already pointed out, the requirements laid down in Article 8(4) are not confined to the strictly legal sphere. The terms used by the Community legislature and the actual purpose of the provision call for an interpretation which is linked to the facts and to the importance of the sign in trade. [40]

130. First of all, the term 'significance', and the equivalent terms used in the other language versions, appears to be concerned with factual matters rather than with the territorial

40 — I refer to a kind of interpretation which is closer, although not necessarily identical in all respects, to the one set out by OHIM in its Opposition Guidelines. According to OHIM, the assessment of the significance of a sign for the purposes of Article 8(4) cannot be carried out from a geographical perspective alone and must also be based on the 'economic dimension of the use of the sign', having regard to the intensity of use, the length of use, the spread of the goods or services for which it is used, and the advertising carried out under that sign. The Court of First Instance itself accepted, point for point, that interpretation of OHIM in another judgment dated only shortly after the judgment under appeal in Joined Cases T-318/06 to T-321/06 *Moreira da Fonseca* v *OHIM - General Óptica (GENERAL OPTICA)* [2009] ECR II-649. At the request of the Court of Justice, the differences between the two judgments of the Court of First Instance were the focus of many of the submissions at the hearing. Anheuser-Busch and OHIM, while acknowledging that the judgments are based on different facts and rights, stated that the different natures of the signs relied on (a geographical indication in *Budějovický Budvar* and an establishment name in *General Óptica*) were immaterial and did not justify the difference in the decisions. Budvar, on the other hand, asserted that *General Óptica* concerned a sign protected only through use, a factor which, it submitted, is immaterial for appellations of origin, which exist and are protected merely by registration, from which Budvar concluded that the judgments do not contradict one another and that the requirements of Article 8(4) must be assessed case by case, having regard to the nature of the sign relied on. I do not share Budvar's view.

scope of a protective provision.[41] That view is consistent with the fact, to which I have already drawn attention, that Article 8(4) covers a heteroclitic group of signs, some of which are protected simply by use and others as a result of registration.

131. Second, that conclusion is reached as a result of an analysis of all the requirements which Regulation No 40/94 lays down in order for a sign to be relied on as a relative ground for refusal under Article 8(4). As I indicated above, these requirements can be classified into two main groups: first, two national law requirements (the ones set out in Article 8(4)(a) and (b)), which are intended to ensure that the sign is, and was beforehand, specially protected at national level; and, second, two requirements ('use in the course of trade' and 'more than mere local significance') which the appellant rightly regards as autonomous conditions 'of Community law', aimed at restricting this ground of opposition to signs which, in addition to being protected at national level, have a certain commercial presence and importance.

132. The fact is that it is difficult to separate the term 'significance' from the market in which the sign is present and from the use of the sign. It is not by chance that the requirement of use of the sign 'in the course of trade' is mentioned first; although that requirement refers to the sign, the interpretation of it is inextricably linked to the context. The article must be interpreted as a whole.

133. Consequently, non-registered trade marks and the other signs covered by Article 8(4) may act as a relative ground for refusal only when, in the course of trade, they have more than mere local significance.[42] The territorial area by reference to which that significance must be assessed is the territory in which the sign benefits from legal protection,[43] but the mere existence of such protection throughout the territory of a Member State, or even in a number of them, does not ensure that the requirement of significance is met.

134. Third, the foregoing is also confirmed by a teleological interpretation. As I have repeatedly stated, the inclusion of the requirement of significance reflects the intention of the legislature to prohibit access to Article 8(4) for signs which do not 'deserve' to have the

41 — The dictionary of the Real Academia Española defines the word 'alcance' as 'capacidad de alcanzar o cubrir una distancia'; the Académie française defines the term 'portée' as, inter alia, 'distance maximale à laquelle une chose peut exercer son effet, étendue, champ d'action d'un phénomène'. Particularly expressive is the term 'significance' which the English version uses and which the *Cambridge Advanced Learner's Dictionary* regards as synonymous with 'importance' and 'special meaning'.

42 — In that connection, see Fernández Novoa, C., *El sistema comunitario de marcas*, Montecorvo, Madrid, 1995, p. 167, and von Mühlendahl, A., Ohlgart, D. and Bomhard, V., *Die Gemeinschaftsmarke*, Bech, Munich, 1998, p. 38.

43 — That follows from the principle of territoriality, examined above.

capacity to prevent the registration of a similar trade mark at Community level. [44]

135. Under Article 1 of Regulation No 40/94, once registered, a Community trade mark is valid and is protected throughout the European Union. As a result, for an earlier non-registered right to be able to prevent the registration of a Community trade mark intended to cover the territory of the 27 Member States, it must have an importance capable of justifying its taking precedence over that subsequent Community trade mark. Its 'significance" must be such that it is potentially able to block, with effect throughout the European Union, the registration of a trade mark, and that significance may not refer solely to the territorial scope of protection of the right claimed.

136. The interpretation provided by the Court of First Instance in the judgment under appeal is readily adaptable to signs which, like Bud, have international protection that is formalised through registration. However, most of the signs covered by Article 8(4) do not have those characteristics.

137. On the one hand, Article 8(4) appears to be intended essentially for signs protected in only one Member State, [45] and not for the less numerous cases in which there is transnational protection. Interpreting the requirement of 'significance' as being synonymous with the territorial scope of legal protection would lead to the exclusion without prior analysis of the right to invoke under Article 8(4) signs which are protected in the whole territory of a Member State but not beyond its borders, since such signs would never have more than local significance. [46] In order to include those signs, it is necessary to construe the term 'significance' in a more factual sense, by requiring that the sign must be known in a territory larger than a city or region, for example.

138. On the other hand, nor is the solution proposed by the judgment under appeal adaptable to signs which, like non-registered trade marks, are created and earn protection through use without the need for prior registration. In such cases, which constitute the majority of those covered by the provision under scrutiny, significance of use and

44 — In that regard, see Kitchin, D., Llewelyn, D., Mellor, J., Meade, R., Moody-Stuart, T. and Keeling, D., *Kerly's Law of Trade Marks and Trade Names*, Sweet & Maxwell, London, 2005, p. 274.

45 — That is why it refers to 'the law of the Member State governing that sign'.

46 — It could be inferred from the interpretation of the Court of First Instance that only international protection guarantees such significance (in that connection, see paragraph 181 of the judgment under appeal: 'the earlier rights relied on have a significance which is not merely local inasmuch as their protection, under Article 1(2) of the Lisbon Agreement and Article 1 of the bilateral convention, extends beyond their territory of origin').

significance of legal protection are not easily distinguishable.

139. Lastly, and contrary to the assertion made in paragraph 180 of the judgment under appeal, I am of the view that Article 107 of Regulation No 40/94 does not preclude the interpretation I have put forward in this Opinion.

140. Article 8(4) operates in parallel with Article 107, which permits the 'coexistence' of a new Community trade mark and an earlier sign of merely local significance by providing that the proprietor of that earlier right of local significance (which, therefore, may not be relied on as the basis of an opposition to the registration of a Community trade mark, but which is protected in a Member State) 'may oppose the use of the Community trade mark in the territory where his right is protected'. It follows from the provision that where a sign has local significance its protection is limited to the territory of the Member State concerned, while where a sign has more than local significance it is protected throughout the European Union;[47] however, it does not follow that protection at Community level (as a result of a successful opposition to the registration of a subsequent trade mark) must be granted only where legal protection exists in more than one Member State. In my view, Article 107 is not sufficient for the purposes of establishing an indissoluble link between significance and the territorial extent of protection in the sense proposed by the judgment under appeal.

141. In the light of all the foregoing, it is my view that, even where a geographical indication like Bud is protected in more than one State under an international agreement, it would not satisfy the requirement of 'more than mere local significance' if (as appears to occur in the instant case) it could be proved only that that geographical indication is known and used in one of the States where it benefits from protection.

142. I am therefore of the opinion that the third part of the first ground of appeal must be allowed.

4. Conclusion

In the light of all the foregoing, I propose that the Court should allow the second and third parts of the first ground of appeal but dismiss the first part.

47 — Taking that view as a starting point, Fleckenstein considers that the two articles constitute a 'system'; Fleckenstein, J., *Der Schutz territorial beschränkter Kennzeichen*, Peter Lang – Europäische Hochschulschriften, Frankfurt am Main, 1999, p. 104.

B — *Second ground of appeal: infringement of Articles 8(4) and 74(1) of Regulation No 40/94*

1. Definition of positions

143. In the second ground of appeal, concerning the infringement of Articles 8(4) and 74(1) of Regulation No 40/94, the appellant maintains that the Court of First Instance erred in law in paragraph 199 of the judgment under appeal by holding that the Board of Appeal of OHIM should of its own motion investigate the applicable national law, including the case-law relating to the right of Budvar to prohibit use of a subsequent mark by invoking a geographical indication. By holding that the outcome of the national proceedings could be learnt from generally accessible sources and that, as a result, it was a well-known fact that was excluded from the burden of proof which, under Article 74 of the regulation, rests on the opponent, the appellant submits that the Court of First Instance infringed that provision, in accordance with which, in opposition proceedings, the examination carried out by OHIM must be restricted to the facts, evidence and arguments provided by the parties and the relief sought.

2. Assessment

144. The second ground of appeal in fact raises two separate issues.

145. First of all, consideration must be given to whether or not Article 74(1) of Regulation No 40/94 requires OHIM to examine of its own motion the status and the outcomes of court proceedings brought in the Member State concerned and, consequently, whether the decisions of national courts are, for those purposes, matters of common knowledge.

146. In the annulled decisions, the Board of Appeal of OHIM only took into account a number of French and German judicial decisions which refused to allow the proprietors of Bud to prohibit use of the sign by Anheuser-Busch in the national territories concerned. At that time, those national judgments were not final but the Board of Appeal did not take account of that matter which had not been raised by Budvar.

147. In my opinion, the Board of Appeal of OHIM complied fully with the rules governing opposition proceedings, and, in particular, with the general rules on the burden of proof set out in Article 74(1) of Regulation No 40/94. After laying down as a general rule the obligation of OHIM to examine the facts of its own motion, Article 74(1) provides: 'however, in proceedings relating to relative grounds for refusal of registration, [OHIM] shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.'

148. The burden of proof therefore rests squarely on the opponent and OHIM may not be accused of having failed to take into account the existence of judicial decisions which, notwithstanding the assertion of the Court of First Instance, were not 'facts which are well known'. Although the sources which might have provided that information were 'accessible' to the Board of Appeal, it was not the Board's responsibility but rather that of the interested party to verify all the information put forward in the proceedings and, in particular, to check whether or not a judgment given in national proceedings is final.

149. Second, within that main line of reasoning underpinning the second ground of appeal, the appellant indirectly advances, from an evidential point of view, a second complaint. In particular, Anheuser-Busch contends that 'the Board of Appeal had evidence before it that Budvar had unsuccessfully tried to enforce the very rights in national courts that it was now relying on against Anheuser-Busch's Community trade mark applications. … Budvar has not submitted one single decision allowing it to enforce its alleged Article 8(4) rights'. It might be concluded from the wording of the appeal that Anheuser-Busch submits that Article 8(4)(b) of the regulation must be construed as meaning that the opponent has to prove that it has succeeded in prohibiting the use of a subsequent trade mark and that it is not sufficient to hold an abstract right to prohibit the use of a more recent trade mark.

150. If that is the interpretation put forward by the appellant, I disagree with it. To my mind, it is clear that Article 8(4)(b) requires only that the opponent hold that abstract right in order to be able to protect its sign at national level. An opposition will be possible provided that the right is held, even if it has not been exercised or explicitly recognised by a court.

151. It could be argued that, by requiring there to be merely an abstract right, all the arguments concerning the status of national proceedings are rendered irrelevant (the question whether national judicial decisions recognising the right are final). However, the existence of national judgments (whether or not they are final) which, as in the present case, negate the right to prohibit the use of a subsequent mark may constitute evidence that that right does not exist.

152. Without prejudice to that last statement, it is my view that the second ground of appeal must be upheld.

C — *Upholding of the appeal and referral of the case back to the General Court*

153. In the light of the foregoing, it is my view that the appeal should be upheld, the second ground of appeal and the second and third parts of the first ground of appeal being allowed, and that the judgment under appeal should be set aside.

154. Since it appears that the errors identified may be corrected only by means of factual assessments, I am of the opinion that the case is not in a state such that the Court of Justice may give final judgment in the matter within the meaning of Article 61(1) of its Statute, and I therefore recommend that the case be referred back to the General Court so that it may carry out those assessments and give judgment afresh on that basis.

155. In particular, it will be for the General Court to determine whether Budvar has established use of the sign Bud 'in the course of trade' prior to the date on which Anheuser-Busch filed the first application to register Bud as a Community trade mark. For those purposes, the General Court will have to use an autonomous interpretation of the requirement of 'use in the course of trade', in other words, one which does not merely reflect the interpretation established by case-law in respect of that expression in the context of Article 9(1) of Regulation No 40/94.

VII — Costs

156. Since I propose that the case be referred back to the General Court, the costs relating to the present appeal should be reserved.

VIII — Conclusion

157. In the light of the foregoing considerations, I propose that the Court should:

(1) uphold the appeal brought by Anheuser-Busch against the judgment given on 16 December 2008 by the First Chamber of the Court of First Instance in Joined Cases T-225/06, T-255/06, T-257/06 and T-309/06;

(2) refer the case back to the General Court of the European Union;

(3) reserve the costs.