Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

25 October 2012*

(Trade marks — Directive 89/104/EEC — Article 10(1) and (2)(a) — Genuine use — Use in a form, itself registered as a trade mark, differing in elements which do not alter the distinctive character of the mark — Temporal effects of a judgment)

In Case C-553/11,

REFERENCE for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Germany), made by decision of 17 August 2011, received at the Court on 2 November 2011, in the proceedings

**Bernhard Rintisch**

v

**Klaus Eder,**

THE COURT (Third Chamber),

composed of R. Silva de Lapuerta, acting as President of the Third Chamber, K. Lenaerts (Rapporteur), E. Juhász, T. von Danwitz and D. Šváby, Judges,

Advocate General: V. Trstenjak,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

— Mr Eder, by M. Douglas, Rechtsanwalt,

— the German Government, by T. Henze and J. Kemper, acting as Agents,

— the European Commission, by F. Bulst, acting as Agent,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

* Language of the case: German.

## Judgment

1 This reference for a preliminary ruling concerns the interpretation of Article 10(1) and (2)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1).

2 The reference has been made in proceedings between Mr Rintisch and Mr Eder concerning the genuine use of a trade mark, used in a form differing in elements which do not alter its distinctive character from the form in which that trade mark was registered, the form used being itself registered as a trade mark.

## Legal context

### *International law*

3 Article 5.C(2) of the Convention for the Protection of Industrial Property signed in Paris on 20 March 1883, as last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaties Series*, No 11851, vol. 828, p. 305, 'the Paris Convention'), provides:

'Use of a trade mark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union [constituted by the States to which the Paris Convention applies] shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.'

### *European Union law*

4 The twelfth recital in the preamble to Directive 89/104 is worded as follows:

'Whereas all Member States of the Community are bound by the Paris Convention for the Protection of Industrial Property; whereas it is necessary that the provisions of this Directive are entirely consistent with those of the Paris Convention; whereas the obligations of the Member States resulting from this Convention are not affected by this Directive; whereas, where appropriate, the second subparagraph of Article [267 TFEU] is applicable'.

5 Article 10(1) and (2)(a) of Directive 89/104, as reproduced without amendment in Article 10 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 5), only the numbering of the paragraphs of the article having been altered, provides under the title 'Use of the trade mark':

'1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Directive, unless there are proper reasons for non-use.

2. The following shall also constitute use within the meaning of paragraph 1:

(a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered'.

*National law*

6 Paragraph 26(3) of the Law on the protection of trade marks and other distinctive signs (Gesetz über den Schutz von Marken und sonstigen Kennzeichen) of 25 October 1994, (BGBl. 1994 I, p. 3082, the 'MarkenG'), provides:

'Use of the trade mark in a form different from the form in which it was registered shall also be regarded as use of a registered trade mark, provided that the differences do not alter the distinctive character of the mark. The first sentence must also be applied if the trade mark is also registered in the form in which it has been used.'

**The dispute in the main proceedings and the questions referred for a preliminary ruling**

7 Mr Rintisch, the claimant in the main proceedings, is the proprietor of the word marks PROTIPLUS, registered on 20 May 1996 under number 395 49 559.8, and PROTI, registered on 3 March 1997 under number 397 02 429, as well as of the word/figurative mark Proti Power, registered on 5 March 1997 under number 396 08 644.6. Those national trade marks are registered for, amongst other things, protein-based products.

8 Mr Eder, the defendant in the main proceedings, is the proprietor of the later word mark Protifit, registered on 11 February 2003 under number 302 47 818, for food supplements, vitamin preparations and dietetic foodstuffs.

9 Mr Rintisch brought an action seeking, firstly, consent from Mr Eder to cancellation of the trade mark Protifit and, secondly, prohibition on use of that trade mark, relying on the rights deriving from his earlier trade marks. In that respect, he based his claims primarily on the trade mark PROTI and, in the alternative, on the marks PROTIPLUS and Proti Power. He also sought an order that the defendant compensate him for the damage that he claimed he had sustained.

10 Mr Eder contended in defence that Mr Rintisch had failed to use the trade mark PROTI. Mr Rintisch responded that he had put that trade mark to use by using the trade names 'PROTIPLUS' and 'Proti Power'. At first instance Mr Rintisch's claims were rejected, on the ground that the rights deriving from the trade mark PROTI could not be relied on as against the trade mark 'Protifit'. The Oberlandesgericht Köln (Cologne Higher Regional Court), hearing the case on appeal, confirmed that Mr Rintisch's claims should be dismissed.

11 Mr Rintisch appealed to the Bundesgerichtshof (Federal Court of Justice) on a point of law. The Bundesgerichtshof states, first of all, that, under the rules of German procedural law, it must, at the current stage of the proceedings, be taken as established – since these points have not been challenged – that, despite differing from the trade mark PROTI, the trade names 'PROTIPLUS' and 'Proti Power' do not alter the distinctive character of that trade mark and that the applicant put the trade marks PROTIPLUS and Proti Power to genuine use prior to the publication of the registration of the trade mark Protifit. The referring court thus starts from the premiss that PROTI must be regarded as having been put to genuine use for the purposes of Paragraph 26(3) of the MarkenG.

12 However, the referring court expresses uncertainty as to whether and, if so, in what circumstances the second sentence of Paragraph 26(3) of the MarkenG is consistent with Article 10(1) and (2)(a) of Directive 89/104.

13 In those circumstances the Bundesgerichtshof decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

‘1. Must Article 10(1) and (2)(a) of Directive [89/104] be interpreted as meaning that in principle this provision generally precludes a national rule pursuant to which the use of a trade mark (Trade Mark 1) must be presumed even if the trade mark (Trade Mark 1) is used in a form differing from the form in which it was registered, without the differences altering the distinctive character of the trade mark (Trade Mark 1), and if the trade mark in the form used is also registered (Trade Mark 2)?

2. If question 1 is answered in the negative:

Is the national provision described in the first question compatible with Directive [89/104] if the national provision is interpreted restrictively as meaning that it is not applicable to a trade mark (Trade Mark 1) which is registered only in order to secure or expand the protection of another registered trade mark (Trade Mark 2) that is registered in the form in which it is used?

3. If question 1 is answered in the affirmative or question 2 is answered in the negative:

(a) Is there no use of a registered trade mark (Trade Mark 1) within the meaning of Article 10(1) and (2)(a) of Directive [89/104]:

(i) if the trade mark proprietor uses the form of a sign which differs only in elements from the form in which it (Trade Mark 1) and a further trade mark (Trade Mark 2) of the trade mark proprietor are registered but the differences do not alter the distinctive character of the trade marks (Trade Mark 1 and Trade Mark 2);

(ii) if the trade mark proprietor uses two forms of sign, neither of which corresponds to the registered trade mark (Trade Mark 1), but one of the forms used (Form 1) is the same as another registered trade mark (Trade Mark 2) of the trade mark proprietor and the second form used by the trade mark proprietor (Form 2) differs in elements from both registered trade marks (Trade Mark 1 and Trade Mark 2), without the differences altering the distinctive character of the trade marks, and if this form of sign (Form 2) displays greater similarity to the other trade mark (Trade Mark 2) of the trade mark proprietor?

(b) Is a court of a Member State permitted to apply a national provision (here the second sentence of Paragraph 26(3) of the [MarkenG]) which conflicts with a provision of a directive (here Article 10(1) and (2)(a) of Directive [89/104]) in cases in which the facts of the case had already occurred prior to a decision of the Court of Justice of the European Union in which indications of the incompatibility of the Member State’s legislation with the provision of the directive became apparent for the first time (the judgment of 13 September 2007 in Case C-234/06 P *Il Ponte Finanziaria* v *OHIM* … [2007] ECR I-7333) if the national court values the reliance of a party to the court proceedings on the validity of his position, secured under constitutional law, more highly than the interest in the implementation of a provision of the directive?’

## Consideration of the questions referred

*Admissibility*

14 Mr Eder submits that the reference for a preliminary ruling is inadmissible on the ground that it has no relevance for the outcome of the dispute in the main proceedings, since the Oberlandesgericht Köln decided on the questions of fact and law at the time of the proceedings before it.

15 In that regard, it should be recalled that, in accordance with settled case-law, in proceedings under Article 267 TFEU, which are based on a clear separation of functions between the national courts and the Court of Justice, the national court alone has jurisdiction to find and assess the facts in the case before it and to interpret and apply national law. Similarly, it is solely for the national court, before which the dispute has been brought and which must assume responsibility for the judicial decision to be made, to determine, in the light of the particular circumstances of the case, both the need for and the relevance of the questions that it submits to the Court. Consequently, where the questions submitted concern the interpretation of European Union law, the Court is in principle bound to give a ruling (Case C-145/03 *Keller* [2005] ECR I-2529, paragraph 33; Case C-119/05 *Lucchini* [2007] ECR I-6199, paragraph 43; and Case C-11/07 *Eckelkamp and Others* [2008] ECR I-6845, paragraphs 27 and 32).

16 Thus, the Court may refuse to rule on a question referred for a preliminary ruling by a national court only where it is quite obvious that the interpretation of European Union law that is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it (Case C-618/10 *Banco Español de Crédito* [2012] ECR, paragraph 77 and case-law cited).

17 It is clear that that is not the case here. The interpretation of Article 10(1) and (2)(a) of Directive 89/104 that is sought is likely to have an effect on the legal framework applicable to the main proceedings and, accordingly, on the outcome of those proceedings. The reference for a preliminary ruling must therefore be declared admissible.

*First question and third question, point (a)*

18 By its first question and point (a) of its third question, which it is appropriate to consider together, the referring court asks, in essence, whether Article 10(2)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of a registered trade mark is precluded from relying, in order to establish use of the trade mark for the purposes of that provision, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form is itself registered as a trade mark.

19 In that regard, it must, first, be borne in mind that for a trade mark to possess distinctive character for the purposes of Directive 89/104, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see, by analogy, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble* v *OHIM* [2004] ECR I-5141, paragraph 32; Case C-64/02 P *OHIM* v *Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66, and Case C-311/11 P *Smart Technologies* v *OHIM* [2012] ECR, paragraph 23).

20 It should then be stated that there is nothing at all in the wording of Article 10(2)(a) of Directive 89/104 to suggest that the different form in which the trade mark is used cannot itself be registered as a trade mark. Indeed, the only condition laid down in that provision is that the form in which the trade mark is used may differ from the form in which that trade mark was registered only in elements which do not alter the distinctive character of the mark.

21 As to the purpose of Article 10(2)(a) of Directive 89/104, that provision, which avoids imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered, is intended to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.

22 That purpose would be jeopardised if, in order to establish use of the registered trade mark, an additional condition had to be met, whereby the different form in which that mark is used should not itself have been registered as a trade mark. In fact, the registration of new forms of a trade mark makes it possible, where necessary, to anticipate changes that may occur in the trade mark's image and thus to adapt it to the realities of a changing market.

23 Furthermore, it is clear from the twelfth recital in the preamble to Directive 89/104 that the provisions of the directive must be 'entirely consistent with those of the Paris Convention'. Therefore, Article 10(2)(a) of Directive 89/104 must be interpreted consistently with Article 5.C(2) of the Convention. Nothing in the latter provision suggests that when a sign is registered as a trade mark the consequence is that use of the sign can no longer be relied on to establish use of another registered trade mark from which the sign only differs in a way that does not alter the distinctive character of the trade mark.

24 Accordingly, registration as a trade mark of the form in which another registered trade mark is used, a form which differs from that in which the latter mark is registered, while not altering its distinctive character, is not a bar to the application of Article 10(2)(a) of Directive 89/104.

25 That interpretation is not at variance with the interpretation resulting from the judgment in *Il Ponte Finanziaria* v *OHIM*, in particular paragraph 86 thereof, to which the order for reference alludes.

26 In the case which gave rise to that judgment, the proceedings before the Court concerned a dispute in which one party invoked the protection of a 'family' or 'series' of similar trade marks, for the purpose of assessing the likelihood of confusion with the trade mark whose registration was sought. That dispute fell within the scope of Article 15(2)(a) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), a provision which corresponded, at the material time, to Article 10(2)(a) of Directive 89/104, the wording of those provisions being in essence identical.

27 Having held, in paragraph 63 of the judgment in *Il Ponte Finanziaria* v *OHIM*, that where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for, considering, erroneously, that that trade mark is part of that family or series of marks, the Court concluded that, in order to establish that there is a 'family' or 'series' of trade marks, use of a sufficient number of trade marks capable of constituting that 'family' or 'series' must be shown.

28 The Court went on to hold, in paragraph 64 of *Il Ponte Finanziaria* v *OHIM*, that no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a 'family' or a 'series', to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to

be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

29 It is in that particular context of a claim that there is a 'family' or 'series' of trade marks that the Court's statement in paragraph 86 of *Il Ponte Finanziaria* v *OHIM* should be understood, according to which it is not possible, under Article 15(2)(a) of Regulation No 40/94, and consequently under Article 10(2)(a) of Directive 89/104, to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former. The use of one trade mark cannot be relied on in order to prove the use of another trade mark where the aim is to establish use of a sufficient number of trade marks of a single family.

30 In view of the foregoing considerations, the answer to the first question and to point (a) of the third question is that Article 10(2)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of a registered trade mark is not precluded from relying, in order to establish use of the trade mark for the purposes of that provision, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form is itself registered as a trade mark.

*Second question*

31 By its second question, the referring court asks, in essence, whether Article 10(2)(a) of Directive 89/104 must be interpreted as precluding an interpretation of the national provision intended to transpose it into domestic law whereby Article 10(2)(a) does not apply to a 'defensive' trade mark which is registered only in order to secure or expand the protection of another registered trade mark that is registered in the form in which it is used.

32 In that regard, it should be stated that there are no grounds for interpreting Article 10(2)(a) of Directive 89/104 in such a way that it would be inapplicable to a case such as that described in the previous paragraph. The subjective intention prevailing when it is sought to register a trade mark is wholly irrelevant for the purpose of applying that provision and, in this respect, there is no basis in Directive 89/104 or in any other provisions of European law for a concept of 'defensive' trade marks to which that provision does not apply.

33 Accordingly, the answer to the second question is that Article 10(2)(a) of Directive 89/104 must be interpreted as precluding an interpretation of the national provision intended to transpose it into domestic law whereby Article 10(2)(a) does not apply to a 'defensive' trade mark which is registered only in order to secure or expand the protection of another registered trade mark that is registered in the form in which it is used.

*Third question, point (b)*

34 By point (b) of its third question, the referring court seeks, in essence, to ascertain in what circumstances a judgment of the Court, such as the judgment in *Il Ponte Finanziara* v *OHIM*, should take effect, in some or all respects, only for the period after the date on which it was delivered.

35 The referring court raises the whole of the third question 'if question 1 is answered in the affirmative or question 2 is answered in the negative'. The answer given here to the second question falls within that second case.

36 However, point (b) of the third question is based on the assumption that there is a conflict between a national provision, namely the second sentence of Paragraph 26(3) of the MarkenG, and a provision of a directive, in this instance Article 10(1) and (2)(a) of Directive 89/104. Neither the answer to the first question and point (a) of the third question nor the answer to the second question coincides with that assumption.

37 It follows that there is no need to answer point (b) of the third question.

## Costs

38 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby rules:

1. **Article 10(2)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the proprietor of a registered trade mark is not precluded from relying, in order to establish use of the trade mark for the purposes of that provision, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form is itself registered as a trade mark.**

2. **Article 10(2)(a) of Directive 89/104 must be interpreted as precluding an interpretation of the national provision intended to transpose it into domestic law whereby Article 10(2)(a) does not apply to a 'defensive' trade mark which is registered only in order to secure or expand the protection of another registered trade mark that is registered in the form in which it is used.**

[Signatures]