Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

19 September 2013*

(Trade marks — Directive 89/104/EEC — Article 5 — Consent on the part of the proprietor of a trade mark to the use, by a third party, of a sign which is identical with that mark — Consent given in a situation where there is shared use — Possibility for that proprietor to put an end to the shared use and regain the exclusive use of its mark)

In Case C-661/11,

REQUEST for a preliminary ruling under Article 267 TFEU from the Cour de cassation (Belgium), made by decision of 2 December 2011, received at the Court on 23 December 2011, in the proceedings

Martin Y Paz Diffusion SA

v

David Depuydt,

Fabriek van Maroquinerie Gauquie NV,

THE COURT (Third Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, K. Lenaerts, Vice-President of the Court, acting as Judge of the Third Chamber, E. Jarašiūnas, A. Ó Caoimh and C.G. Fernlund, Judges,

Advocate General: P. Cruz Villalón,

Registrar: V. Tourrès, Administrator,

having regard to the written procedure and further to the hearing on 10 January 2013,

after considering the observations submitted on behalf of:

— Martin Y Paz Diffusion SA, by R. Byl, avocat,

— Mr Depuydt and Fabriek van Maroquinerie Gauquie NV, by P. Maeyaert and S. Lens, avocats,

— the Polish Government, by B. Majczyna, acting as Agent,

— the European Commission, by F.W. Bulst, T. van Rijn and J. Hottiaux, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 18 April 2013,

* Language of the case: French.

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Articles 5 and 8 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), as amended by the Agreement on the European Economic Area of 2 May 1992 (OJ 1994 L 1, p. 3) ('Directive 89/104').

2 The request has been made in proceedings between, on the one hand, Martin Y Paz Diffusion SA ('Martin Y Paz'), a company governed by Belgian law, and, on the other, Mr Depuydt and Fabriek van Maroquinerie Gauquie NV ('Fabriek van Maroquinerie Gauquie'), also a company governed by Belgian law, concerning the use of trade marks of which Martin Y Paz is the proprietor.

Legal context

3 The sixth recital in the preamble to Directive 89/104 provided that that directive 'does not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection'.

4 Article 5 of Directive 89/104, headed 'Rights conferred by a trade mark', provided:

'1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;

…'

5 Article 6 of Directive 89/104, headed 'Limitation of the effects of a trade mark', provided:

'1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade,

(a) his own name or address;

(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;

(c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;

provided he uses them in accordance with honest practices in industrial or commercial matters.

2. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Member State in question and within the limits of the territory in which it is recognised.'

6 Article 7 of Directive 89/104 in its original version, headed 'Exhaustion of the rights conferred by a trade mark', provided:

'1. The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that trade mark by the proprietor or with his consent.

2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.'

7 In accordance with Article 65(2) of the Agreement on the European Economic Area of 2 May 1992, read in conjunction with Annex XVII, Point 4, to that agreement, the original version of Article 7(1) of Directive 89/104 was amended for the purposes of that agreement, with the expression 'in the Community' being replaced by the words 'in a Contracting Party'.

8 Article 8 of Directive 89/104 provided:

'1. A trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Member State concerned. A license may be exclusive or non-exclusive.

2. The proprietor of a trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract …'.

9 Directive 89/104 was repealed by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), which came into force on 28 November 2008. Having regard to the date of the facts, however, the dispute in the main proceedings continues to be governed by Directive 89/104.

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

10 By a contract concluded on 6 June 1990, Mr Baquet, a leather goods manufacturer and the owner of a business deriving from a company governed by Belgian law declared insolvent in 1989, sold the name of that company, namely 'Nathan', to Martin Y Paz 'with a view to the production of a line of small leather goods'.

11 That contract stipulated that Mr Baquet retained 'property in the name for the manufacture of handbags'. Martin Y Paz undertook not to create unfair competition as regards the manufacture and distribution of such goods, whereas Mr Baquet guaranteed Martin Y Paz the exclusive use of the name 'Nathan' as regards the manufacture and distribution of small leather goods.

12 By a contract of 2 May 1995, Mr Baquet sold his handbags business to Mr Depuydt, the manager of Fabriek van Maroquinerie Gauquie.

13 That contract stated that the business concerned included the Benelux word mark Nathan ('the word mark Nathan'), which Mr Baquet had had registered in 1991 for goods in Classes 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended ('the Nice Agreement'). Those goods include leather items (Class 18) and clothing and shoes (Class 25).

14 Mr Depuydt therefore became the proprietor of that word mark.

15 That contract of 2 May 1995 referred, moreover, to the undertaking given by Mr Baquet, with regard to Martin Y Paz, not to manufacture or distribute small leather goods under the name 'Nathan'.

16 Following the conclusion of that contract, Mr Depuydt began to put on the market, through Fabriek van Maroquinerie Gauquie and under the word mark Nathan, handbags to which is affixed a horizontally stretched letter N.

17 Since a date regarding which the parties to the main proceedings are in disagreement, Martin Y Paz has also been affixing a horizontally stretched letter N to its goods.

18 By fax of 18 July 1998, Martin Y Paz complained to Fabriek van Maroquinerie Gauquie of a lack of cooperation between those two companies. It suggested collaboration as regards the materials and colours for the goods and also an exchange of customer lists.

19 On 14 August 1998, Martin Y Paz had a Benelux figurative mark consisting of the letter N stretch horizontally ('the mark N') and a Benelux figurative mark consisting of a stylised version of the word sign 'Nathan' ('the figurative mark Nathan') registered for goods in inter alia Classes 18 and 25 of the Nice Agreement.

20 Since 2002, both Martin Y Paz and Fabriek van Maroquinerie Gauquie have also been using the word sign 'Nathan Baume'. On 24 January 2002, Martin Y Paz had that sign registered as a Benelux trade mark for goods in Classes 18 and 25 of the Nice Agreement ('the mark Nathan Baume').

21 Those two companies sold their goods (the handbags and shoes manufactured by Fabriek van Maroquinerie Gauquie and the other leather items manufactured by Martin Y Paz) to each other and displayed them in their respective shops.

22 Relations between the two companies deteriorated progressively.

23 On 24 May 2005, Mr Depuydt and Fabriek van Maroquinerie Gauquie (together 'Gauquie') sued Martin Y Paz before the tribunal de commerce de Nivelles (Commercial Court, Nivelles) (Belgium) seeking to have the mark N, the figurative mark Nathan and the mark Nathan Baume declared invalid or, in the alternative, seeking a ruling that those marks are valid only with respect to small leather goods.

24 By judgment of 19 October 2006, the tribunal de commerce de Nivelles dismissed the action which had been brought before it.

25 On 11 January 2007, Martin Y Paz requested the President of the tribunal de commerce de Nivelles to order Gauquie to stop using signs which are identical or similar to the marks N and Nathan Baume for goods in Classes 18 and 25 of the Nice Agreement. Gauquie counterclaimed before that court for an order to prohibit Martin Y Paz from using those marks and any sign which is identical or similar to the word mark Nathan for leather goods other than small leather goods.

26 By judgment of 9 May 2007, Martin Y Paz's application was dismissed and that company was ordered not to manufacture or put on the market, under the sign 'N', 'Nathan' or 'Nathan Baume', handbags which are identical or similar to those distributed by Gauquie.

27 Martin Y Paz appealed to the cour d'appel de Bruxelles (Court of Appeal, Brussels) against the judgment of 9 May 2007, while Gauquie cross-appealed to the same court against that judgment and also appealed to that court against the judgment of 19 October 2006 referred to in paragraph 24 above.

28 By judgment of 8 November 2007, that court held that Gauquie could not use signs which are identical or similar to the marks N or Nathan Baume for goods other than handbags and shoes and that Martin Y Paz could not use the mark N, the figurative mark Nathan and the mark Nathan Baume for handbags and shoes. As to the remainder, it dismissed Gauquie's appeal against the judgment of 19 October 2006.

29 As regards the rights which the marks N and Nathan Baume conferred on their proprietor Martin Y Paz, the cour d'appel de Bruxelles held that that company had, until the submission of its application for an injunction to the President of the tribunal de commerce de Nivelles, always recognised that Gauquie could use signs which are identical to those marks for handbags and shoes. That recognition was, moreover, highlighted by Martin Y Paz's repeated proposals for joint management of the marketing of its goods and those of Gauquie.

30 The cour d'appel de Bruxelles concluded from those facts that there was 'irrevocable consent' on the part of Martin Y Paz to the use, by Gauquie, of those signs in respect of handbags and shoes. It held, first, that by seeking a prohibition of that use in particularly stringent terms, Martin Y Paz had abused the exclusive right conferred by its marks, and, secondly, that the marketing by Martin Y Paz of handbags or shoes under those marks constitutes an act of unfair competition since it takes unfair advantage of the investments which Gauquie has made in order to make its high quality goods known and is also liable to cause confusion in consumers' minds.

31 Martin Y Paz appealed on a point of law against the judgment of 8 November 2007 referred to in paragraph 28 of the present judgment.

32 While admitting that it had consented, for an indeterminate period, to the use by Gauquie of signs which are identical to the mark N and the mark Nathan Baume in respect of handbags and shoes, Martin Y Paz submits that the Cour d'appel de Bruxelles erred in law in categorising its consent as 'irrevocable'. That company takes the view that that consent could be withdrawn unilaterally at any time. As it had ceased to consent to Gauquie's use of signs which are identical or similar to its marks, its application for Gauquie to be prohibited from using those signs at all is in no way abusive, but is a legitimate exercise of the exclusive right conferred upon it by the marks of which it is the proprietor.

33 The cour d'appel de Bruxelles is also claimed to have erred in law in holding that Martin Y Paz could not manufacture and market handbags and shoes under the marks N and Nathan Baume. In that regard, Martin Y Paz states that the marks concerned were registered for classes of goods covering, among other things, handbags and shoes. To prohibit that company from using its own trade marks for those goods would therefore deprive it of its exclusive right.

34 In a judgment delivered on 2 December 2011, the Cour de cassation (Court of Cassation) rejected Martin Y Paz's argument that its application for an injunction was only an expression of the exclusive right conferred by its marks and could not therefore be categorised as abusive. In this respect, that court states that the finding, by the cour d'appel de Bruxelles, that Martin Y Pas had committed an abuse was based not only on the consent which that company had given, but also on the terms in which it had formulated its application for an injunction and on the underlying motivation of retaliation.

35 By contrast, the Cour de cassation questions whether the cour d'appel de Bruxelles could, without erring in law, have deprived Martin Y Paz of the possibility of invoking its marks against Gauquie and of the possibility of itself using its marks in respect of handbags and shoes. It therefore decided, in that judgment of 2 December 2011, to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) (a) Must Article 5(1) and Article 8(1) of [Directive 89/104] be interpreted as meaning that the exclusive right conferred by the registered mark can definitively no longer be asserted by its proprietor against a third party, in respect of all goods covered by it at the time of registration:

— where, for an extended period, the proprietor has shared the use of that mark with that third party in a form of co-ownership for part of the goods covered;

— where, when that sharing was agreed, the proprietor gave the third party its irrevocable consent to use of that mark by the third party in respect of those goods?

(b) Must those articles be interpreted as meaning that application of a national rule, such as that according to which the proprietor of a right cannot exercise that right in a wrongful or abusive manner, can lead to a definitive prohibition on the exercise of that exclusive right for part of the goods covered or as meaning that that application must be restricted to penalising the wrongful or abusive exercise of that right in another way?

(2) (a) Must Article 5(1) and Article 8(1) of [Directive 89/104] be interpreted as meaning that, where the proprietor of a registered mark ends its undertaking to a third party not to use that mark for certain goods and thus intends to recommence that use itself, the national court can none the less definitively prohibit it from recommencing that use of the mark on the ground that it amounts to unfair competition because of the resulting advantage to the proprietor of the publicity previously made for the mark by the third party and possible confusion in customers' minds, or must they be interpreted as meaning that the national court must adopt a different penalty which does not definitively prohibit the proprietor from recommencing use of the mark?

(b) Must those articles be interpreted as meaning that a definitive prohibition on use by the proprietor is justified where the third party has, over a number of years, made investments in order to bring to the attention of the public the goods in respect of which the proprietor has authorised it to use the mark?'

Admissibility of the request for a preliminary ruling

36 Gauquie submits that the questions referred are inadmissible or must at the very least be reformulated.

37 It maintains that the dispute between it and Martin Y Paz is governed not by Directive 89/104, but by the national law transposing that directive. As the Court has no jurisdiction to interpret national law, the present request for a preliminary ruling may not be examined.

38 In any event, according to Gauquie, an answer to the questions referred would be irrelevant to the resolution of the dispute in the main proceedings. In that regard, Gauquie states that Article 5 of Directive 89/104 concerns the scope of the exclusive right conferred by the mark where there is no consent, whereas the present reference for a preliminary ruling is based on the existence of 'irrevocable consent'. Article 8 of that directive, which relates to licences, does not, moreover, have any connection with the dispute in the main proceedings as no licensing contract was concluded between Martin Y Paz and Gauquie.

39 Furthermore, the questions as formulated by the Cour de cassation suggest that the cour d'appel de Bruxelles prohibited Martin Y Paz from any exercise of the exclusive right conferred by its marks, whereas, in actual fact, the company was only prohibited from exercising that right in respect of handbags and shoes.

40 The European Commission is in agreement with Gauquie's argument alleging that Article 8 of Directive 89/104 is irrelevant to the resolution of the dispute in the main proceedings. As regards, by contrast, Article 5 of that directive, it takes the view that that provision may be relevant, even if, according to that institution, the dispute in the main proceedings will, above all, have to be resolved on the basis of Belgian civil law and the rules on fair competition.

41 Martin Y Paz and the Polish Government have not disputed the admissibility of the request for a preliminary ruling.

42 As regards, first, Gauquie's argument that the referring court is in actual fact seeking an interpretation of the national law transposing Directive 89/104, it must be stated that that company does not dispute that the application of the national or Benelux law concerning marks must be consistent with the directive to approximate the laws of the Member States relating to trade marks. The referring court is seeking an interpretation of Directive 89/104 precisely in order to ascertain whether the cour d'appel de Bruxelles could, without infringing that directive, prohibit Martin Y Paz from using its marks in respect of handbags and shoes and from invoking the exclusive right conferred by those marks against Gauquie. In those circumstances, it cannot be maintained that the purpose of the request for a preliminary ruling is anything other than the interpretation of European Union law (see, by analogy, Case C-6/01 *Anomar and Others* [2003] ECR I-8621, paragraph 38).

43 So far as concerns, secondly, the argument that Articles 5 and 8 of Directive 89/104 are irrelevant to the resolution of the dispute in the main proceedings, it is apparent from settled case-law that such an argument can succeed only where it is quite obvious that the interpretation that is sought bears no relation to the actual facts of that dispute or to its purpose (see, inter alia, Case C-379/98 *PreussenElektra* [2001] ECR I-2099, paragraph 39; Joined Cases C-94/04 and C-202/04 *Cipolla and Others* [2006] ECR I-11421, paragraph 25; and Case C-414/11 *Daiichi Sankyo and Sanofi-Aventis Deutschland* [2013] ECR, paragraph 35).

44 Although it is true, as stated by Gauquie, that Article 5 of Directive 89/104 concerns the use of signs which are identical or similar to a mark without the consent of the proprietor of that mark, it does not by contrast necessarily follow from the reference, by the referring court, to the existence of 'irrevocable consent', that Martin Y Paz consents to the use, by Gauquie, of signs which are identical to its marks and that one of the fundamental elements for the purposes of the application of the rule set out in Article 5 of Directive 89/104, namely the absence of consent, is therefore lacking in the case in the main proceedings.

45 It may, on the contrary, follow from the facts summarised in paragraph 25 of the present judgment that Martin Y Paz no longer consents to the affixing of its marks to Gauquie's goods.

46 It is, moreover, apparent from the order for reference that by using the expression 'irrevocable consent', the Cour de cassation reproduced the terminology which the cour d'appel de Bruxelles used to show, first, that Martin Y Paz had, in a situation where there was shared use of an indeterminate duration, undertaken as regards Gauquie not to oppose Gauquie's use of signs which are identical to its marks in respect of handbags and shoes and, secondly, that that undertaking could not be rescinded unilaterally or, at least, not abusively as in the present case. The use of that expression in the request for a preliminary ruling therefore seems to indicate that Martin Y Paz withdrew its consent unlawfully and does not lead to the conclusion that Article 5 of Directive 89/104 obviously bears no relation to the purpose of the case in the main proceedings.

47 Nor does the fact that the formulation of the questions referred suggests that the dispute in the main proceedings concerns a measure prohibiting a proprietor of trade marks from any exercise of the exclusive right conferred by those marks, whereas, in actual fact, that proprietor was only prohibited from exercising that right in respect of certain goods, mean that the request for a preliminary ruling is inadmissible. As regards that point, it is sufficient for the questions referred to be reformulated.

48 However, as regards Article 8 of Directive 89/104, it must be stated that an interpretation of that provision, which relates to licences, is irrelevant in regard to the resolution of the dispute in the main proceedings. The fact, highlighted by Gauquie and by the Commission, that relations between the parties to the main proceedings were never governed by a licence, is referred to in the order for reference and was confirmed by Martin Y Paz in answer to a question put by the Court during the oral procedure. In that regard, while it submitted that the shared use with Gauquie of the 'Nathan' goods and of the marks relating to those goods was similar to a contractual relationship in the nature of a licence, Martin Y Paz acknowledged that that use did not really have the characteristics of such a relationship.

49 It follows from the foregoing that the request for a preliminary ruling is inadmissible in so far as it relates to the interpretation of Article 8 of Directive 89/104 and that it must be held to be admissible as to the remainder.

Consideration of the questions referred

50 By its questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 5 of Directive 89/104 precludes a proprietor of trade marks which, in a situation where there has been use shared with a third party, had consented to the use by that third party of signs which are identical to its marks in respect of certain goods in classes for which those marks are registered, and which now seeks to prohibit that use, from being deprived of any possibility of asserting the exclusive right conferred upon it by those marks against that third party and of itself exercising that exclusive right in respect of goods which are identical to those of that third party.

51 Martin Y Paz takes the view that Article 5 of Directive 89/104 precludes such deprivation, which has, it submits, the effect of rendering the exclusive right conferred by the marks in question meaningless. The only permissible limitations on that exclusive right are those set out in Articles 6 and 7 of Directive 89/104.

52 Gauquie, by contrast, submits that the exclusive right conferred by a trade mark is also limited by the principle, recognised in the national legal system, that the proprietor of a right may not exercise that right abusively or in an unfair manner. That deprivation is therefore compatible with Article 5 of Directive 89/104.

53 The Polish Government and the Commission submit that that principle limits the exclusive right conferred by the mark, but that it may not lead to a definitive prohibition on the exercise of that exclusive right. Furthermore, that government submits that, in a dispute such as that in the main proceedings, it is necessary to examine whether the use which the proprietor of the trade mark seeks to prohibit may adversely affect one of the functions of that mark.

54 It is important to bear in mind, at the outset, that Articles 5 to 7 of Directive 89/104 effect a complete harmonisation of the rules relating to the rights conferred by a trade mark and accordingly define the rights of proprietors of trade marks in the European Union (see, inter alia, Joined Cases C-414/99 to C-416/99 *Zino Davidoff and Levi Strauss* [2001] ECR I-8691, paragraph 39; Case C-127/09 *Coty Prestige Lancaster Group* [2010] ECR I-4965, paragraph 27; and Case C-482/09 *Budějovický Budvar* [2011] ECR I-8701, paragraph 32).

55 Consequently, save for the specific cases governed by Article 8 et seq. of that directive, a national court may not, in a dispute relating to the exercise of the exclusive right conferred by a trade mark, limit that exclusive right in a manner which exceeds the limitations arising from Articles 5 to 7 of the directive.

56 As regards those limitations, it is, first, common ground that none of the limitations set out in Article 6 of Directive 89/104 is relevant in a situation such as that at issue in the case in the main proceedings.

57 Secondly, it must be pointed out that consent, such as that allowing Gauquie to use signs which are identical to Martin Y Paz's trade marks in respect of handbags and shoes, does indeed result in the exhaustion of the exclusive right within the meaning of Article 7 of Directive 89/104, but only in respect of the individual items of the product which were first put on the market in the European Economic Area (EEA) by the party who received the consent (see, to that effect, Case C-173/98 *Sebago and Maison Dubois* [1999] ECR I-4103, paragraphs 19 and 20, and *Coty Prestige Lancaster Group*, paragraph 31). It is apparent from that case-law and from the actual wording of Article 7 of Directive 89/104 that the third party who receives that consent and who may therefore invoke the exhaustion of the exclusive right in respect of all the individual items of the goods covered by that consent which it puts on the market in the EEA, may no longer invoke such exhaustion once the consent is withdrawn.

58 Thirdly, as regards the limitations on the exclusive right which inherently follow from Article 5 of Directive 89/104 as such, it is settled case-law that the exclusive right under that provision was conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor of that mark, that is, to ensure that the trade mark can fulfil its functions. Therefore, the exercise of that right must be reserved to cases in which another party's use of the sign adversely affects or is liable adversely to affect one of the functions of the trade mark. Those functions include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services in question, but also its other functions, in particular that of guaranteeing the quality of those goods or services or those of communication, investment or advertising (see, to that effect, *Budějovický Budvar*, paragraph 71 and the case-law cited, and Case C-323/09 *Interflora and Interflora British Unit* [2011] ECR I-8625, paragraphs 32 to 41).

59 In the present case, the exclusive right conferred by its trade marks which Martin Y Paz now wishes to exercise may be covered by the situation referred to in Article 5(1)(a) of Directive 89/104, namely that where the proprietor of a mark opposes the use, without his consent, by a third party of a sign which is identical with that trade mark in relation to goods which are identical with those for which the trade mark is registered.

60 If, which it is for the referring court to examine, Gauquie is to be regarded, since the expression by Martin Y Paz of its wish to exercise its exclusive right against it, as using signs which are identical to Martin Y Paz's trade marks without its consent, it is a matter for that court, in accordance with what has been stated in paragraph 58 of the present judgment, to assess whether, in the circumstances of the present case, that use adversely affects or is liable adversely to affect one of the functions of those marks. If it were established that such a detriment or risk of detriment exists, it would have to be held that depriving Martin Y Paz of the possibility of exercising its exclusive right against that use by Gauquie exceeds the limitations arising from Articles 5 to 7 of Directive 89/104.

61 It is true, as borne out by the reference by the sixth recital in the preamble to Directive 89/104 to the national law on civil liability, that a national court may impose a penalty on the proprietor of a trade mark or order it to pay compensation for the damage suffered if it finds that that proprietor has unlawfully withdrawn the consent by which it allowed a third party to use signs which are identical to its marks. However, as was stated by the Polish Government and by the Commission, as well as by the

Advocate General in points 78 to 83 of his Opinion, a finding that there has been such conduct cannot have the effect of prolonging, by a court decision and for an unspecified period, the shared use of those marks where the companies concerned no longer have the joint intention of sharing their use.

62 In the light of the foregoing, the answer to the questions referred is that Article 5 of Directive 89/104 precludes a proprietor of trade marks which, in a situation where there has been use shared with a third party, had consented to the use by that third party of signs which are identical to its marks in respect of certain goods in classes for which those marks are registered and which no longer consents to that use, from being deprived of any possibility of asserting the exclusive right conferred upon it by those marks against that third party and of itself exercising that exclusive right in respect of goods which are identical to those of that third party.

Costs

63 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:

Article 5 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, as amended by the Agreement on the European Economic Area of 2 May 1992, precludes a proprietor of trade marks which, in a situation where there has been use shared with a third party, had consented to the use by that third party of signs which are identical to its marks in respect of certain goods in classes for which those marks are registered and which no longer consents to that use, from being deprived of any possibility of asserting the exclusive right conferred upon it by those marks against that third party and of itself exercising that exclusive right in respect of goods which are identical to those of that third party.

[Signatures]