Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

1 August 2025 *

(Reference for a preliminary ruling – Intellectual property – Trade marks – Directive (EU) 2015/2436 – Approximation of the laws of the Member States relating to trade marks – Article 10(3)(b) – Rights conferred by a trade mark – Right to prevent a third party from offering the goods, putting them on the market or stocking them for those purposes under the sign – Online trade – Goods offered for sale from a Member State other than that in which the mark is registered – Concept of 'stocking')

In Case C-76/24,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Federal Court of Justice, Germany), made by decision of 23 January 2024, received at the Court on 1 February 2024, in the proceedings

Tradeinn Retail Services S.L.

v

PH,

THE COURT (Third Chamber),

composed of C. Lycourgos, President of the Chamber, S. Rodin, N. Piçarra, O. Spineanu-Matei (Rapporteur) and N. Fenger, Judges,

Advocate General: D. Spielmann,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– PH, by T. Kiphuth and N. Tretter, Rechtsanwälte,

– the European Commission, by P. Němečková and G. von Rintelen, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 27 March 2025,

* Language of the case: German.

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 10(3)(b) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1).

2 The request has been made in proceedings between Tradeinn Retail Services S.L. ('TRS') and PH, a proprietor of German trade marks for diving equipment and accessories, concerning an action for an injunction prohibiting the use of signs identical to those marks in connection with diving accessories.

Legal context

European Union law

3 Article 10 of Directive 2015/2436, entitled 'Rights conferred by a trade mark', provides:

'1. The registration of a trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

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

(b) the sign is identical with, or similar to, the trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

3. The following, in particular, may be prohibited under paragraph 2:

(a) affixing the sign to the goods or to the packaging of those goods;

(b) offering the goods or putting them on the market, or stocking them for those purposes, under the sign, or offering or supplying services thereunder;

…

(e) using the sign on business papers and in advertising;

…’

German law

4 Paragraph 14(2) and (3) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen – Markengesetz (Law on the protection of trade marks and other distinctive signs) of 25 October 1994 (BGBl. 1994 I, p. 3082), as amended by the Gesetz zur Umsetzung der Richtlinie (EU) 2015/2436 des Europäischen Parlaments und des Rates vom 16. Dezember 2015 zur Angleichung der Rechtsvorschriften der Mitgliedstaaten über die Marken (Markenrechtsmodernisierungsgesetz) (Law transposing Directive 2015/2436) of 11 December 2018 (BGBl. 2018 I, p. 2357) (‘the MarkenG’), is intended to transpose Article 10(2) and (3) of Directive 2015/2436 into German law.

5 Under the first subparagraph of point 1 of Paragraph 14(2) of the MarkenG, third parties are to be prohibited from using in the course of trade, without the consent of the proprietor of the trade mark, 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 protected.

6 In accordance with points 1, 2 and 6 of Paragraph 14(3) of the MarkenG, if the requirements specified in subparagraph 2 of that paragraph are met, the following, in particular, are to be prohibited: affixing a sign identical to the trade mark at issue to goods or their presentation or packaging; offering the goods, putting them on the market or stocking them for those purposes under the sign; and using the sign on business papers or in advertising.

7 Paragraph 14(5) of the MarkenG provides:

‘Anyone who uses a sign infringing subparagraphs 2 to 4 may be sued by the proprietor of the trade mark and enjoined to cease and desist where there is a risk that the infringement will be repeated. That right also exists where there is a risk that an infringement will be committed for the first time.’

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

8 PH is the proprietor of the following two German figurative marks, which also include word elements (‘the marks at issue’):





9 The trade marks at issue were registered with the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office, Germany) for, inter alia, diving equipment, diving suits, diving gloves, diving masks and breathing apparatus for diving.

10 TRS, which is established in Spain, advertised, on its website www.scubastore.com and via the online trading platform www.amazon.de, the sale of diving accessories using signs identical to the marks at issue, in particular by means of photographs of goods bearing those signs.

11 PH brought an action before the Landgericht Nürnberg-Fürth (Regional Court, Nuremberg-Fürth, Germany) seeking, inter alia, to prohibit TRS from using signs identical to the marks at issue in Germany. In particular, PH requested that TRS be prohibited from affixing those signs to diving accessories and to their presentation or packaging, from offering, manufacturing, distributing or otherwise putting on the market diving accessories under those signs and from promoting or stocking them for those purposes.

12 By judgment of 3 February 2022, the Landgericht Nürnberg-Fürth (Regional Court, Nuremberg-Fürth), after finding that TRS partially acknowledged those claims, decided, inter alia, to order TRS to cease offering for sale or promoting diving accessories bearing signs identical to the marks at issue.

13 On appeal by PH, the Oberlandesgericht Nürnberg (Higher Regional Court, Nuremberg, Germany) held, by judgment of 29 November 2022, that the fact that TRS was established in Spain and held the goods concerned in that Member State did not prevent that undertaking from being convicted of unlawful possession of goods bearing signs identical to those marks in order to offer them or put them on the market in Germany. That court ordered TRS to cease offering for sale or promoting diving accessories bearing those signs 'and from distributing or stocking them for that purpose'.

14 In order to challenge that extension of the scope of the injunction granted at first instance, TRS brought an appeal on a point of law against that judgment before the Bundesgerichtshof (Federal Court of Justice, Germany), which is the referring court.

15 According to that court, the possession of goods in order to offer them and put them on the market, as referred to in point 2 of Paragraph 14(3) of the MarkenG, contains a material element, consisting of possession and an intentional element, namely the intention of putting those goods on the market.

16 The referring court expresses doubts as to the interpretation of that provision in the light of Article 10(3)(b) of Directive 2015/2436.

17 In the first place, that court observes that, under the principle of territoriality, the protection of a trade mark registered in Germany is limited to the territory of that Member State and that only actions carried out in that territory are punishable. It asks whether, in the light of that principle of territoriality, Article 10(3)(b) of Directive 2015/2436 allows the proprietor of a trade mark protected in one Member State to prohibit a third party from stocking in another Member State goods bearing a sign identical to that trade mark, on the ground that those goods are intended to be offered for sale or put on the market in the Member State in which that mark is protected.

18 According to that court, that provision could give rise to two interpretations. According to a first interpretation, based on the principle of territoriality, the stocking of goods under that sign in a Member State other than that in which the mark is protected would not infringe the trade mark concerned, even if such stocking is intended to offer for sale or to put those goods on the market in the Member State in which the mark is protected.

19 According to a second interpretation, infringement of a national trade mark is established where the goods concerned are held in a Member State other than that in which the mark is protected, with a view to offering them for sale or putting them on the market, under that sign, in the Member State in which the mark is protected.

20 In the second place, the referring court asks whether the use of the verb *besitzen* (to stock) in the German-language version of Article 10(3)(b) of Directive 2015/2436 must be interpreted as meaning that that provision requires a third party to have direct access to the goods concerned or whether it is sufficient for that third party to be able to influence the person who has such access.

21 In that regard, that court states that, under German law, the concept of '*Besitz*' (stocking, or possession) encompasses both 'direct possessing' and 'indirect possession'. Direct possession refers to de facto power over something which ends when the possessor abandons or loses actual control over that thing. Where a person possesses something temporarily by virtue of a right or obligation in relation to a third party, that third party is regarded as 'indirectly possessing'. Thus, when a seller delivers the item sold to a carrier, the carrier becomes the direct possessor and that seller becomes the indirect possessor.

22 Although, under German law, TRS could thus be classified as an indirect possessor, that court doubts that that is also the case under Article 10(3)(b) of Directive 2015/2436. It notes, in that regard, that EU trade mark legislation does not use terms in all language versions which have the same meaning as the verb *besitzen*. Some language versions use terms referring, in essence, to storage rather than possession, which implies the existence of direct access to the goods concerned. That said, the referring court does not rule out the possibility that it may be inferred from the case-law of the Court that the scope of Article 10(3)(b) of Directive 2015/2436 extends to the indirect possessor of those goods.

23 In those circumstances, the Bundesgerichtshof (Federal Court of Justice) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Is a proprietor of a national trade mark, under Article 10(3)(b) of [Directive 2015/2436] allowed to prohibit a person in another country from stocking goods that infringe his or her trade mark for the purpose of offering those goods or putting them on the market in the country in which the trade mark is protected?

(2) Does the concept of stocking within the meaning of Article 10(3)(b) of [Directive 2015/2436] depend on the possibility of actually accessing goods in infringement of [the] trade mark or is the possibility of being able to influence the person with actual access to those goods sufficient?'

Consideration of the questions referred

The first question

24 By its first question, the referring court asks, in essence, whether Article 10(3)(b) of Directive 2015/2436 must be interpreted as meaning that the proprietor of a trade mark protected in one Member State may prohibit a third party from stocking, in the territory of another Member State, goods under a sign in the circumstances referred to in Article 10(2) of that directive in order to offer those goods for sale or to put them on the market in the Member State in which that mark is protected.

25 In order to answer that question, it should be borne in mind that, in interpreting a provision of EU law, it is necessary to consider not only its wording but also the context in which it occurs and the objectives pursued by the rules of which it is part (judgments of 17 November 1983, *Merck*, 292/82, EU:C:1983:335, paragraph 12, and of 8 May 2025, *L. (Small non-commercial consignments)*, C-405/24, EU:C:2025:335, paragraph 28).

26 Article 10(3)(b) of Directive 2015/2436, read in conjunction with paragraph 2 of that article, provides that the proprietor of a registered trade mark may prevent all third parties not having his or her consent from using in the course of trade, in relation to goods or services, any sign which infringes that trade mark, and that the uses which may therefore be prohibited include 'offering the goods or putting them on the market, or stocking them for those purposes, under the sign, or offering or supplying services thereunder'.

27 As is apparent from that wording, in order for the proprietor of that mark to be able to prohibit the stocking of goods under that sign, the third party stocking those goods must itself pursue the aim of offering those goods or putting them on the market (see, to that effect, judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 45).

28 By contrast, that wording does not contain any express indication as to the possibility, for the proprietor of a trade mark registered in one Member State, of preventing a third party from stocking, in the territory of another Member State, goods under that sign.

29 As regards the context of Article 10(3)(b) of Directive 2015/2436, it should be recalled that the protection afforded by the registration of a national mark is, in principle, limited to the territory of the Member State in which it is registered, so that, in general, its proprietor cannot rely on that protection outside the territory (see, to that effect, judgments of 22 June 1994, *IHT Internationale Heiztechnik and Danzinger*, C-9/93, EU:C:1994:261, paragraph 22, and of 19 April 2012, *Wintersteiger*, C-523/10, EU:C:2012:220, paragraph 25).

30 As regards the purpose of the exclusive right conferred by the registration of a trade mark under Article 10(1) of Directive 2015/2436, it consists in enabling the trade mark proprietor concerned to protect his or her specific interests as proprietor of that mark, that is, to ensure that the trade mark can fulfil its functions. The exercise of that right must therefore be restricted to cases in which a third party's use of the sign adversely affects one of the functions of the trade mark or is liable to do so (see, to that effect, judgment of 12 November 2002, *Arsenal Football Club*, C-206/01, EU:C:2002:651, paragraphs 50 to 54). Amongst those functions is not only the essential function of the mark, which is to guarantee to consumers the origin of the goods or services concerned, but also its other functions, such as, in particular, that of guaranteeing the

quality of those goods or services, or those of communication, investment or advertising (see, to that effect, judgment of 25 January 2024, *Audi (Mounting element for emblem on a radiator grille)*, C-334/22, EU:C:2024:76, paragraph 42 and the case-law cited).

31 That purpose and the geographical scope of the protection conferred by the trade mark have a number of consequences for the interpretation of Article 10(3)(b) of Directive 2015/2436.

32 In the first place, the proprietor of a national trade mark is entitled to prevent a third party from putting on the market, in the Member State in which the mark is registered, goods under the sign of which the use infringes that trade mark, it being understood, however, that such goods are not considered to have been put on the market if they are covered by a customs suspensive procedure such as that of external transit and have not been released for free circulation (see, to that effect, judgment of 9 November 2006, *Montex Holdings*, C-281/05, EU:C:2006:709, paragraphs 19 to 21 and the case-law cited).

33 In the second place, the proprietor of a national trade mark may prohibit a third party from offering goods under that sign in the territory of the Member State in which the mark is registered. Accordingly, the trade mark proprietor may oppose such an offer, including where it relates to goods placed under the external transit customs procedure, provided that it necessarily entails the release of those goods for free circulation (see, to that effect, judgment of 18 October 2005, *Class International*, C-405/03, EU:C:2005:616, paragraph 61).

34 In addition, the Court has held that the proprietor of a trade mark may prohibit a third party from offering, inter alia by means of online advertising, goods under that sign, including where that third party, the server of the website which it uses or those goods are located outside the Member State of registration, if that offer or advertisement is targeted at consumers in the territory of that Member State. If it were otherwise, operators who use electronic commerce and offer to consumers in that territory goods situated outside that territory would escape any obligation to respect the rights conferred by that trade mark, which would undermine the effectiveness (*effet utile*) of the protection guaranteed by Directive 2015/2436 (see, to that effect, judgments of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraphs 62 and 63, and of 6 February 2014, *Blomqvist*, C-98/13, EU:C:2014:55, paragraph 32 and the case-law cited).

35 The Court has made clear that the mere fact that a website is accessible from the territory of a Member State in which the mark concerned is protected is not a sufficient basis for concluding that the offers for sale displayed on that website are targeted at consumers in that territory. It falls to the national courts to assess on a case-by-case basis whether there are any relevant factors, on the basis of which it may be concluded that an offer for sale displayed on a website or on an online marketplace accessible from that territory is targeted at consumers in that territory. Those indicia include the indication, in that offer, of details of the geographical areas to which the third party concerned is prepared to send the goods at issue (see, to that effect, judgment of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraphs 64 and 65).

36 Lastly, in the third place, Article 10(3)(b) of Directive 2015/2436 allows the proprietor of a trade mark to prevent a third party not only from offering and putting goods on the market under a sign, the use of which infringes that mark, but also from 'stocking them for those purposes', as recalled in paragraphs 26 and 27 above. That provision therefore applies to the stocking by a third party of such goods only if that is the preliminary step to offering or putting them on the market which the proprietor of a trade mark is entitled to prohibit.

37 As is apparent from paragraph 34 above, the proprietor of a trade mark may prohibit a third party from offering, inter alia by means of online advertising, goods under that sign notwithstanding the fact that that third party, the server of the website which it uses or those goods are located outside the Member State of registration, if that offer is targeted at consumers in the territory of that Member State. In such a situation, that proprietor is also entitled to prohibit that third party from stocking those goods outside that territory if that stocking constitutes a preliminary step to the making of such an offer or its implementation, with the result that it may be regarded as having been carried out for that purpose.

38 In the present case, it is apparent from the information provided by the referring court that, in the case in the main proceedings, the online trading platform www.amazon.de appears, in the absence of any evidence to the contrary, to be targeted at consumers in the territory covered by the marks at issue (see, to that effect, judgments of 7 December 2010, *Pammer and Hotel Alpenhof*, C-585/08 and C-144/09, EU:C:2010:740, paragraph 83, and of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 66). Therefore, the offers for sale appearing on that platform and referred to in the main proceedings fall, subject to the verifications which it is for the referring court to carry out, within the scope of Article 10(3)(b) of Directive 2015/2436.

39 In the light of all of those considerations, the answer to the first question is that Article 10(3)(b) of Directive 2015/2436 must be interpreted as meaning that the proprietor of a trade mark protected in one Member State may prohibit a third party from stocking, in the territory of another Member State, goods under a sign in the circumstances referred to in Article 10(2) of that directive in order to offer those goods for sale or to put them on the market in the Member State in which that mark is protected.

The second question

40 By its second question, the referring court asks, in essence, whether Article 10(3)(b) of Directive 2015/2436 must be interpreted as meaning that, in order to 'stock', within the meaning of that provision, goods under a sign in the circumstances referred to in Article 10(2) of that directive, it is necessary to have direct and actual control over those goods, or whether it is sufficient to have control or direction over the person who has direct and actual control over those goods.

41 That court stated that the doubts justifying its second question stem from divergences between the various language versions of Article 10(3)(b). The German-language version of that provision could be interpreted as meaning that 'to possess' goods does not necessarily imply having access to them, whereas other language versions of that provision use expressions suggesting the contrary.

42 In that regard, it should be noted that, although the French- (*détenir*), German- (*besitzen*) and Romanian- (*deținute*) language versions of Article 10(3)(b) of Directive 2015/2436 refer to possession, other language versions of that provision use expressions referring to the idea of storage or warehousing, such as those used in the Danish- (*oplagre*), English- (stocking), Italian- (*stoccare*), Spanish- (*almacenar*) or Swedish- (*lagra*) language versions. Those expressions could therefore suggest that that provision refers to the storage of a set of goods, whereas the expression 'possession' does not suggest such a quantitative aspect and has a broader meaning.

43 In accordance with settled case-law, where there is divergence between the language versions of an EU legislative text, that provision must be interpreted by reference to the general scheme and the purpose of the rules of which it forms part (judgments of 27 March 1990, *Cricket St Thomas*, C-372/88, EU:C:1990:140, paragraph 19, and of 8 May 2025, *Pielatak*, C-410/23, EU:C:2025:325,

paragraph 58 and the case-law cited). In addition, where a provision of EU law is open to several interpretations, preference must be given to that interpretation which ensures that the provision retains its effectiveness (judgments of 24 February 2000, *Commission* v *France*, C-434/97, EU:C:2000:98, paragraph 21, and of 23 November 2023, *EVN Business Service and Others*, C-480/22, EU:C:2023:918, paragraph 37 and the case-law cited).

44 Despite the linguistic variations referred to in paragraph 42 above, it should be noted that, in the context of Article 10(3)(b) of Directive 2015/2436, each language expression, whether it refers unambiguously to possession or rather to the idea of storage or warehousing, implies having de facto power, and therefore a certain degree of control, over the goods concerned. In any event, as the Advocate General noted in point 54 of his Opinion, that provision forms part of provisions which are intended to provide the proprietor of a trade mark with a legal instrument enabling him or her to prohibit, and thus to bring to an end, any conduct of a third party using a sign in the circumstances set out in Article 10(2) of that directive. In that regard, any third party who has direct or indirect control over the act constituting that conduct must be regarded as being actually able to stop that use (see, to that effect, judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraphs 37 and 38 and the case-law cited).

45 It follows that the term 'stocking' in Article 10(3)(b) of Directive 2015/2436 covers not only cases in which the third party has direct and actual control over the goods concerned, but also those in which he or she has indirect but nonetheless actual control over those goods in that he or she has control or direction over the person who has direct and actual control over those goods.

46 If that provision were applicable only to a third party with direct and actual control over the goods concerned, it would be impossible for the trade mark proprietor to have an injunction issued against an economic operator which, without the proprietor's consent, in order to offer or put those goods on the market, sends them to a service provider so that that operator can provide services such as the storage or transport of those goods for those purposes. Such an interpretation would, as the Advocate General noted in point 62 of his Opinion, be incompatible with the purpose of Directive 2015/2436 and would deprive the protection which it guarantees of part of its effectiveness.

47 In the light of those considerations, the answer to the second question is that Article 10(3)(b) of Directive 2015/2436 must be interpreted as meaning that, in order to 'stock', within the meaning of that provision, goods under a sign in the circumstances referred to in Article 10(2) of that directive, it is sufficient to have control or direction over the person who has direct and actual control over those goods.

Costs

48 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the referring 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(3)(b) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks**

   must be interpreted as meaning that the proprietor of a trade mark protected in one Member State may prohibit a third party from stocking, in the territory of another Member State, goods under a sign in the circumstances referred to in Article 10(2) of that directive in order to offer those goods for sale or to put them on the market in the Member State in which that mark is protected.

2. **Article 10(3)(b) of Directive 2015/2436**

   must be interpreted as meaning that in order to 'stock', within the meaning of that provision, goods under a sign in the circumstances referred to in Article 10(2) of that directive, it is sufficient to have control or direction over the person who has direct and actual control over those goods.

[Signatures]