Reports of Cases

JUDGMENT OF THE COURT (Tenth Chamber)

2 June 2022 *

[Text rectified by order of 1 July 2022]

(Reference for a preliminary ruling – Approximation of laws – Trade marks – Directive 2008/95/EC – Article 5 – Rights conferred by a trade mark – Article 6(2) – Limitation of the effects of the trade mark – Impossibility for the proprietor of a trade mark to prevent a third party from using, in the course of trade, an earlier right applying in a particular locality – Requirements – Concept of 'earlier right' – Trade name – Proprietor of a later trade mark with an even earlier right – Relevance)

In Case C-112/21,

REQUEST for a preliminary ruling under Article 267 TFEU from the Hoge Raad der Nederlanden (Supreme Court of the Netherlands), made by decision of 19 February 2021, received at the Court on 25 February 2021, in the proceedings

X BV

v

Classic Coach Company vof,

Y,

Z,

THE COURT (Tenth Chamber),

composed of I. Jarukaitis, President of the Chamber, M. Ilešič (Rapporteur) and D. Gratsias, Judges,

Advocate General: G. Pitruzzella,

Registrar: A. Calot Escobar,

having regard to the written procedure,

* Language of the case: Dutch.

after considering the observations submitted on behalf of:

– X BV, by F.I. van Dorsser, advocaat,

– [As rectified by order of 1 July 2022] Classic Coach Company vof, Y and Z, by M.G. Jansen, advocaat,

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

– the European Commission, initially by É. Gippini Fournier and P.-J. Loewenthal, and subsequently by P.-J. Loewenthal, acting as Agents,

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

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 6(2) 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. 25, and corrigendum OJ 2009 L 11, p. 86).

2 The request has been made in proceedings between X BV, a coach passenger transport undertaking, and Classic Coach Company vof, also a coach passenger transport undertaking ('Classic Coach'), and two natural persons, Y and Z, concerning an alleged infringement by Classic Coach, Y and Z of the Benelux trade mark of which X is the proprietor.

Legal context

International law

The Paris Convention

3 Article 1(2) of the Paris Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883, last revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaties Series*, vol. 828, No 11851, p. 305; 'the Paris Convention'), provides:

'The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.'

4 Article 8 of the Paris Convention provides:

'A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.'

The TRIPs Agreement

5 The Agreement on Trade-Related Aspects of Intellectual Property Rights ('the TRIPs Agreement') appears in Annex 1C to the Agreement establishing the World Trade Organisation (WTO), which was signed in Marrakesh on 15 April 1994 and approved by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1).

6 Article 1 of the TRIPs Agreement, headed 'Nature and Scope of Obligations', provides in paragraph 2:

'For the purposes of this agreement, the term "intellectual property" refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.'

7 Article 2 of that agreement, entitled 'Intellectual Property Conventions', provides in paragraph 1:

'In respect of Parts II, III and IV of this agreement, Members shall comply with Articles 1 through 12, and Article 19, of the [Paris Convention].'

8 Article 16 of the TRIPs Agreement, which is headed 'Rights Conferred', provides in paragraph 1:

'The owner of a registered trade mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.'

European Union law

9 Recital 5 of Directive 2008/95 states:

'This Directive should not deprive the Member States of the right to continue to protect trade marks acquired through use but should take them into account only in regard to the relationship between them and trade marks acquired by registration.'

10 Article 1 of that directive, entitled 'Scope', provides:

'This Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.'

11 Article 4 of that directive, entitled 'Further grounds for refusal or invalidity concerning conflicts with earlier rights', provides in paragraph 4:

'Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

…

(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;

(c) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraph 2 and point (b) of this paragraph and in particular:
(i) a right to a name;
(ii) a right of personal portrayal;
(iii) a copyright;
(iv) an industrial property right;

…'

12 Article 5 of that directive, entitled 'Rights conferred by a trade mark', states:

'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;

(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, 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.

2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are 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, inter alia, may be prohibited under paragraphs 1 and 2:

(a) affixing the sign to the goods or to the packaging thereof;

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

(c) importing or exporting the goods under the sign;

(d) using the sign on business papers and in advertising.

…

5. Paragraphs 1 to 4 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, 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.'

13 Article 6 of Directive 2008/95, entitled 'Limitation of the effects of a trade mark', provides:

'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;

…

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.'

14 Article 9 of that directive, entitled 'Limitation in consequence of acquiescence', provides:

'1. Where, in a Member State, the proprietor of an earlier trade mark … has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.

2. Any Member State may provide that paragraph 1 shall apply *mutatis mutandis* to the proprietor of … an other earlier right referred to in Article 4(4)(b) or (c).

3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later registered trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trade mark.'

15 Directive 2008/95 was repealed and replaced, with effect from 15 January 2019, by 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). The content of Article 6(2) of Directive 2008/95 now appears, in essence, with only drafting changes, in Article 14(3) of Directive 2015/2436. However, in view of the date of the events in the main proceedings, this request for a preliminary ruling must be examined in the light of Directive 2008/95.

The Benelux Convention

16 The convention Benelux en matière de propriété intellectuelle (marques et dessins ou modèles) (Benelux Convention on Intellectual Property (Trade Marks and Designs)) of 25 February 2005, signed at The Hague by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands, entered into force on 1 September 2006 ('the Benelux Convention'). Article 2.20 thereof is entitled 'Extent of protection' and provides, in paragraph 1:

'The registered trade mark shall confer on the proprietor exclusive rights therein. Without prejudice to the possible application of ordinary law in matters of civil liability, the exclusive right to a trade mark shall permit the owner to prevent any third party, without its consent, from:

…

(b) using in the course of trade any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, 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;

…

(d) using a sign for purposes other than for the purposes of distinguishing goods or services, 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.'

17 Article 2.23 of the Benelux Convention, entitled 'Restriction of the exclusive right', states in paragraph 2:

'The exclusive right to a trade mark shall not imply the right to prohibit use in the course of trade of a similar sign which draws its protection from an earlier right which only applies in a particular locality, if that right is recognised under the legal provisions of any Benelux country, within the limits of the territory in which it is recognised.'

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

18 Between 1968 and 1977, two brothers were partners of a general partnership, established in Amersfoort (Netherlands), engaged in passenger transport by coach, under the name 'Reis- en Touringcarbedrijf Amersfoort's Bloei'. Until 1971, occasional coach transport services were provided by their father, who had been engaged in that activity since 1935.

19 In 1975, one of those brothers ('brother 1') created X, which used, from 1975 or 1978, two trade names, one of which corresponded, in part, to the surname of those brothers.

20 In 1977, following brother 1's departure from the company created in 1968, the other brother ('brother 2') continued that company's activity with his wife as a joint partner, in the form of a limited liability company, while retaining the same company name as that of the company established in 1968.

21 In 1991, for tax reasons, brother 2 also formed, with his wife, a general partnership The two companies belonging to brother 2 and his wife coexisted and both displayed signs on their coaches containing a name corresponding to brother 2's name.

22 In 1995, after the death of brother 2, his activity was continued by his two sons, Y and Z, who created, for that purpose, Classic Coach, also established in the Netherlands. For a number of years, the Classic Coach coaches have carried a sign on the back of the coach displaying, inter alia, brother 2's name, or, more precisely, the initial of his first name followed by his surname.

23 Furthermore, X is the proprietor of a Benelux word mark, which was registered on 15 January 2008, for, inter alia, services in Class 39 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, including services provided by a coach company. That mark corresponds to the surname common to brothers 1 and 2.

24 In those circumstances, X brought an action before the rechtbank Den Haag (District Court, The Hague, Netherlands), seeking, inter alia, an order that the defendants in the main proceedings definitively cease all infringement of its Benelux word mark and of its trade names.

25 X based its action on the fact that, by using the sign corresponding to the name of brother 2, the defendants in the main proceedings had infringed its trade mark rights, as referred to in Article 2.20(1)(b) and (d) of the Benelux Convention, and its trade name rights, as referred to in Article 5 of the Handelsnaamwet (Law on trade names).

26 The defendants in the main proceedings contested the alleged infringement, relying, in particular, on Article 2.23(2) of the Benelux Convention transposing, in essence, Article 6(2) 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), which corresponds to Article 6(2) of Directive 2008/95. Furthermore, the defendants in the main proceedings objected to the alleged trade name infringement by, inter alia, invoking estoppel.

27 By judgment of 10 May 2017, the rechtbank Den Haag (District Court, The Hague) upheld X's action but, by judgment of 12 February 2019, the Gerechtshof Den Haag (Court of Appeal, The Hague, Netherlands) set aside that judgment and dismissed X's appeal.

28 X appealed on a point of law against that judgment to the Hoge Raad der Nederlanden (Supreme Court of the Netherlands), which states that it has doubts about the answer to the question of what constitutes an 'earlier right' within the meaning of Article 6(2) of Directive 2008/95.

29 In that regard, according to that court, it is conceivable that the assumption of an earlier right would require that that right be capable, under the applicable national legislation, of prohibiting the trade mark holder's use of the mark. It is apparent from the legislative history of that provision that wording appearing in the initial proposal and extending its scope to earlier rights of local significance which can no longer be relied on against the later registered mark was ultimately not adopted.

30 Moreover, it is also conceivable that, in order to assume the existence of an earlier right of a third party, it is important whether the trade mark holder has an even earlier right, recognised by the legislation of the Member State concerned, with regard to the sign filed as a trade mark and, if so, whether the use of the alleged earlier right of that third party can be prohibited on the basis of that even earlier right.

31 In the present case, the Gerechtshof Den Haag (Court of Appeal, The Hague) held that X, the proprietor of the Benelux trade mark, had even earlier trade name rights than those of the defendants in the main proceedings in respect of the sign which is registered as a trade mark. However, according to that court, X, as a result of limitation in consequence of acquiescence, lost its right to prohibit, on the basis of those earlier trade name rights, the use by the defendants in the main proceedings of the trade name corresponding to brother 2's name. Thus, X finds itself in a situation in which it cannot prohibit the use by the defendants in the main proceedings of that trade name on the basis of its even earlier trade name rights.

32 The assessment of the merits of the appeal on a point of law brought against that assessment of the Gerechtshof Den Haag (Court of Appeal, The Hague) would depend on the scope of the concept of 'earlier right' in Article 6(2) of Directive 2008/95. In that regard, the Hoge Raad der Nederlanden (Supreme Court of the Netherlands) states that it must be assumed that all the trade names at issue in the main proceedings are rights recognised in the Netherlands for the purpose of that article 6(2).

33 In those circumstances, the Hoge Raad der Nederlanden (Supreme Court of the Netherlands) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) For the purposes of determining whether there is an "earlier right" of a third party as referred to in Article 6(2) of [Directive 2008/95],
   (a) is it sufficient that, prior to the filing of the trade mark, that third party had made use in the course of trade of a right which is recognised by the laws of the Member State in question; or
   (b) is there a requirement that that third party, on the basis of that earlier right, under the applicable national legislation, is entitled to prohibit the use of the trade mark by the trade mark holder?

(2) In answering Question 1, is it also relevant whether the trade mark holder has an even earlier right (recognised by the laws of the Member State in question) in relation to the sign registered as a trade mark and, if so, is it relevant whether the trade mark holder may, on the basis of that even earlier recognised right, prohibit the use by the third party of the alleged "earlier right"?'

Consideration of the questions referred

The first question

34 By its first question, the referring court asks, in essence, whether Article 6(2) of Directive 2008/95 must be interpreted as meaning that, for the purposes of establishing the existence of an 'earlier right' within the meaning of that provision there is a requirement that the proprietor of that right must be able to prohibit the use of the later trade mark by the proprietor of that mark.

35 As is apparent from the order for reference, the dispute in the main proceedings concerns a conflict between several identical or similar trade names, which are all recognised by national legislation, one of which has subsequently been registered by its proprietor as a trade mark. However, according to the information contained in that decision, as a result of limitation in consequence of acquiescence, the proprietor of the registered trade mark can no longer, under the applicable national law, oppose, on the basis of the earlier trade name which it itself uses, the use of the identical or similar trade name used by a third party.

36 In that context, it should be recalled that the concept of an 'earlier right', within the meaning of Article 6(2) of Directive 2008/95, must be interpreted in the light of the equivalent concepts contained in the texts of international law and in such a way that it is consistent with them, also taking account of the context in which those concepts are found and the purpose of the relevant provisions of the agreements as regards intellectual property (see, by analogy, judgment of 2 April 2020, *Stim and SAMI*, C-753/18, EU:C:2020:268, paragraph 29 and the case-law cited).

37 It is apparent from the case-law of the Court that a trade name is a right falling within the scope of the term 'intellectual property' within the meaning of Article 1(2) of the TRIPs Agreement. Moreover, it follows from Article 2(1) of the TRIPs Agreement that the protection of trade names, for which specific provision is made in Article 8 of the Paris Convention, is expressly incorporated into that agreement. Therefore, by virtue of the TRIPs Agreement, the members of the WTO are under an obligation to protect trade names (judgment of 16 November 2004, *Anheuser-Busch*, C-245/02, EU:C:2004:717, paragraph 91).

38 Furthermore, in accordance with the last sentence of Article 16(1) of the TRIPs Agreement, it must be an existing earlier right, the word 'existing' meaning that the right concerned must fall within the temporal scope of the TRIPs Agreement and still be protected at the time when it is relied on by its proprietor in order to counter the claims of the proprietor of the trade mark with which it is alleged to conflict (see, to that effect, judgment of 16 November 2004, *Anheuser-Busch*, C-245/02, EU:C:2004:717, paragraph 94).

39 Moreover, even though, under Article 8 of the Paris Convention, the protection of trade names is to be guaranteed and such protection may not be made subject to any registration requirement, neither Article 16(1) of the TRIPs Agreement nor Article 8 of the Paris Convention precludes, in principle, under national law, the existence of a trade name from being subject to conditions relating to minimum use or minimum awareness thereof (see, to that effect, judgment of 16 November 2004, *Anheuser-Busch*, C-245/02, EU:C:2004:717, paragraphs 96 and 97).

40 As regards the concept of priority, it means that the basis for the right concerned must have arisen at a time prior to the grant of the trade mark with which it is alleged to conflict. That requirement is an expression of the principle of the primacy of the prior exclusive right, which is one of the basic principles of trade-mark law and, more generally, of all industrial-property law (see, to that effect, judgment of 16 November 2004, *Anheuser-Busch*, C-245/02, EU:C:2004:717, paragraph 98).

41 Furthermore, under Article 4(4)(c) of Directive 2008/95, the concept of an 'earlier right' means, inter alia, an industrial property right, which is merely one type of intellectual property. It is apparent from Article 1(2) of the Paris Convention that a trade name constitutes an industrial property right.

42 In that context, although Article 4(4)(c) of Directive 2008/95 primarily serves purposes other than those referred to in Article 6(2) of Directive 2008/95, namely to enable the proprietor of an earlier right to oppose the registration of a mark or to request that a registered trade mark be declared invalid, the fact remains that the concept of 'earlier right' used in those two provisions must have the same meaning, since, in this instance, the European Union legislature has not expressed a different intention (see, by analogy, judgment of 4 October 2011, *Football Association Premier League and Others*, C-403/08 and C-429/08, EU:C:2011:631, paragraph 188).

43 Consequently, a trade name may constitute an earlier right for the purposes of the application of Article 6(2) of Directive 2008/95.

44 As regards the conditions for the application of Article 6(2) of Directive 2008/95, it should be noted, as a preliminary point, that the terms of a provision of EU law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must normally be given an autonomous and uniform interpretation throughout the European Union, irrespective of its treatment in the Member States, having regard to its wording, its context and the objectives pursued by the legislation of which it forms part (see, to that effect, judgment of 30 November 2021, *LR Ģenerālprokuratūra*, C-3/20, EU:C:2021:969, paragraph 79 and the case-law cited).

45 In this respect, as regards the wording of Article 6(2) of Directive 2008/95, it must be observed that, in addition to the conditions relating, first, to the use of such a right in the course of trade, second, to the priority of that right, third, to its applicability in a particular locality and, fourth, to the recognition of that right by the laws of the Member State in question, that provision does not in any way provide that, in order to be able to assert the same right against the proprietor of a later mark, the third party must be able to prohibit the use of that mark.

46 That interpretation is borne out both by the context of that provision and by the general scheme of Directive 2008/95. Under Article 4(4)(b) and (c) of that directive, a Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid, in particular, first, where and to the extent that the rights to a sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark and, second, where and to the extent that the use of the trade mark may be prohibited by virtue of an earlier right, such as an industrial property right.

47 Unlike the grounds for refusal or invalidity concerning conflicts with earlier rights laid down, inter alia, in Article 4(4)(b) and (c) of Directive 2008/95 which are intended either to prevent the registration of a mark, or to have it cancelled, Article 6(2) of that directive provides only for a limitation of the rights conferred by a registered trade mark, as provided for in Article 5 of that directive.

48 Furthermore, 'earlier rights', within the meaning of Article 6(2) of Directive 2008/95, must only apply in a particular locality, which means that, from a geographical point of view, they cannot cover a territory as large as that covered by a registered trade mark, since that mark normally covers the whole of the territory for which it was registered.

49 Such an approach, according to which the limitation of the rights conferred by a registered trade mark is subject to more flexible conditions than those required in order to prevent registration of a mark or to declare it invalid, is also consistent with the objectives pursued by Directive 2008/95, which seeks generally to strike a balance between the interest of the proprietor of a trade mark to safeguard its essential function, on the one hand, and the interests of other economic operators in having signs capable of denoting their goods and services, on the other (see, to that effect, judgment of 22 September 2011, *Budějovický Budvar*, C-482/09, EU:C:2011:605, paragraph 34 and the case-law cited).

50 That interpretation cannot be called into question by the legislative history of that provision, even if the legislative history of an EU act may provide information relevant to its interpretation (see, to that effect, judgment of 13 January 2022, *Germany and Others* v *Commission*, C-177/19 P to C-179/19 P, EU:C:2022:10, paragraph 82). In the present case, it should be noted that, at the time of the adoption of Directive 89/104, which was subsequently codified by Directive 2008/95, the text of the current Article 6(2) of that directive, as proposed by the Italian delegation to the Council of the European Union, was not adopted in its entirety. According to the proposal of that delegation, the limitation of the effects of the mark would apply 'even though that [earlier] right may no longer be invoked against the later registered trade mark'.

51 Nevertheless, it cannot be inferred from this that the EU legislature intended to limit the scope of Article 6(2) of Directive 2008/95 solely to earlier rights which entitle their proprietor to prohibit the use of the subsequent mark. Such a condition would deprive that provision of all practical effect, in so far as it would treat the conditions for the application of that provision in the same way as the conditions for the application of the further grounds for refusal or invalidity laid down in Article 4(4)(b) and (c) of that directive.

52 Consequently, under Article 6(2) of Directive 2008/95, in order to be enforceable against the proprietor of a subsequent trade mark, it is sufficient, in principle, that the earlier right which only applies in a particular locality, such as a trade name, is recognised by the laws of the Member State in question and that it is used in the course of trade.

53 National legislation under which the earlier right is required to confer on its proprietor the right to prohibit local use of a trade mark registered subsequently would go beyond the requirements laid down in Article 6 of Directive 2008/95, given that that provision, together with Articles 5 and 7 of that directive, 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, to that effect, judgment of 22 September 2011, *Budějovický Budvar*, C-482/09, EU:C:2011:605, paragraph 32 and the case-law cited).

54 It should also be borne in mind that a long period of honest concurrent use of two identical signs designating identical products neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services. However, in the event that, in the future, there is any dishonesty associated with the use of those signs, such a situation could, where necessary, be examined in the light of the rules relating to unfair competition (see, by analogy, judgment of 22 September 2011, *Budějovický Budvar*, C-482/09, EU:C:2011:605, paragraphs 82 and 83).

55 In the light of all the foregoing considerations, the answer to the first question is that Article 6(2) of Directive 2008/95 must be interpreted as meaning that, for the purposes of establishing the existence of an 'earlier right' within the meaning of that provision, there is no requirement that the proprietor of that right must be able to prohibit the use of the later mark by the proprietor of that mark.

The second question

56 By its second question, the referring court asks, in essence, whether Article 6(2) of Directive 2008/95 must be interpreted as meaning that an 'earlier right' within the meaning of that provision may be granted to a third party in a situation in which the proprietor of the later trade mark has an even earlier right recognised by the laws of the Member State in question over the sign registered as a trade mark and, where applicable, whether the fact that, under the laws of the Member State in question, the proprietor of the trade mark and of the even earlier right may no longer, on the basis of the latter right, prohibit the use by the third party of its more recent right has any bearing on the existence of an 'earlier right' within the meaning of that provision.

57 It should be noted at the outset that Directive 2008/95 governs, in principle, not the relationship between the various rights which may be classified as 'earlier rights' within the meaning of Article 6(2) of that directive, but the relationship of those rights with trade marks acquired by registration.

58 First, in accordance with Article 1 thereof, Directive 2008/95 applies, in essence, to trade marks which have been the subject of a registration or an application for registration.

59 Second, Article 4(4)(b) and (c) and Article 6(2) of that directive govern conflicts of registered trade marks or applications for trade marks with earlier rights.

60 That finding is supported both by the wording of recital 5 of Directive 2008/95, which refers to trade marks acquired through use with trade marks acquired by registration, and by Article 9(3) of that directive, from which it is apparent that, as regards limitation in consequence of acquiescence, that article governs only the relationship of earlier rights with later registered trade marks.

61 Consequently, the relationship between the various rights that can be classified as 'earlier rights' within the meaning of Article 6(2) of Directive 2008/95 is primarily governed by the domestic law of the Member State concerned.

62 Therefore, what matters, for the purposes of the application of Article 6(2) of that directive, is that the right relied on by the third party is recognised by the laws of the Member State in question and that that right is still protected at the time when it is relied on by its proprietor in order to counter the claims of the proprietor of the trade mark with which it is alleged to conflict, as is apparent from the case-law cited in paragraph 38 of the present judgment.

63 In that context, the fact that the proprietor of the later trade mark has an even earlier right recognised by the law of the Member State concerned over the sign registered as a trade mark may have a bearing on the existence of an 'earlier right' within the meaning of that provision, to the extent that, by relying on that even earlier right, the proprietor of the trade mark is actually able to counter the claim of an earlier right or limit it, which it is, in the present case, for the referring court to determine in accordance with its applicable national law.

64 In a situation where a right relied on by a third party is no longer protected under the laws of the Member State in question, it cannot be held that that right constitutes an 'earlier right' recognised by that law, within the meaning of Article 6(2) of Directive 2008/95.

65 In those circumstances, the answer to the second question is that Article 6(2) of Directive 2008/95 must be interpreted as meaning that an 'earlier right' within the meaning of that provision may be granted to a third party in a situation in which the proprietor of the later trade mark has an even earlier right recognised by the laws of the Member State in question over the sign registered as a trade mark, to the extent that, under those laws, the proprietor of the trade mark and of the even earlier right may no longer, on the basis of its even earlier right, prohibit the use by the third party of its more recent right.

Costs

66 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 (Tenth Chamber) hereby rules:

1. **Article 6(2) 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 must be interpreted as meaning that, for the purposes of establishing the existence of an 'earlier right' within the meaning of that provision, there is no requirement that the proprietor of that right must be able to prohibit the use of the later mark by the proprietor of that mark.**

2. **Article 6(2) of Directive 2008/95 must be interpreted as meaning that an 'earlier right' within the meaning of that provision may be granted to a third party in a situation in which the proprietor of the later trade mark has an even earlier right recognised by the laws of the Member State in question over the sign registered as a trade mark to the extent that, under those laws, the proprietor of the trade mark and of the even earlier right may no longer, on the basis of its even earlier right, prohibit the use by the third party of its more recent right.**

[Signatures]