

Court of Justice EU, 11 April 2019, ÖKO-Test Verlag v Dr. Rudolf Liebe



Trade mark consisting of a quality label



Quality label applied on packaging

#### TRADE MARK LAW

Proprietor of a ‘quality label’ trade mark (for consumer information and –advice) is not entitled by Article 9(1)(a) and (b) (former) CTMR and Article 5(1)(a) and (b) of Directive 2008/95 to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are not similar to, the registered goods or services

- that Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 must be interpreted as meaning that they do not entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

33. In the present case, subject to verification by the referring court, it appears that the affixing by Dr. Liebe of a sign allegedly identical to the ÖKO-TEST marks has neither the purpose nor the effect of carrying out, in the same way as ÖKO-Test Verlag or on its behalf, an economic activity consisting in the provision of consumer information and consultancy services. Nor does there appear to be any indication to suggest either that, by affixing that sign, Dr. Liebe seeks to present itself to the public as specialist in the field of product testing or that there is a specific and indissociable link between its economic activity, which consists in the manufacturing and marketing of toothpaste, and that of

ÖKO-Test Verlag. On the contrary, it is apparent that the sign that is identical with, or similar to, those marks is affixed to the toothpaste packaging marketed by Dr. Liebe for the sole purpose of drawing consumers’ attention to the quality of those toothpastes and thus promoting the sale of Dr. Liebe products. Therefore, the situation at issue in the main proceedings differs from the specific case referred to in paragraphs 31 and 32 of the present judgment.

38. It follows from all of the foregoing that the proprietor of an individual trade mark that consists of a quality label registered in relation to printed matter and services of conducting tests and providing consumer information and consultancy may, if all the conditions are fulfilled, rely on the right of prohibition set out in Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 against third parties, such as potential competitors, who use a sign identical with, or similar to, that mark in relation to printed matter or services of conducting tests and providing consumer information and consultancy, or in relation to similar goods and services, but that he may not rely on that right against manufacturers of tested consumer products who affix the sign identical with, or similar to, that mark to those consumer products.

For a trade mark to have a “reputation” it is required that a significant part of the relevant public knows that sign:

- not required that the public must be aware that the quality label has been registered as a trade mark

49. As the Advocate General has noted in [point 79 of his Opinion](#), that requirement of knowledge cannot be interpreted as meaning that the public must be aware that the quality label has been registered as a trade mark. It is sufficient that a significant part of the relevant public knows that sign.

51. The sign of which the ÖKO-TEST marks consist, that is to say, the quality label reproduced in paragraph 11 of the present judgment, is, according to the findings contained in the order for reference, known by a significant part of the relevant public throughout Germany. It follows that the ÖKO-TEST marks enjoy a reputation, within the meaning of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95, with the result that ÖKO-Test Verlag enjoys the protection afforded by those provisions

Proprietor of an ‘quality label’ trade mark (for consumer information and –advice) with a reputation is entitled by Article 9(1)(c) and (b) (former) CTMR and Article 5(2) of Directive 2008/95 to oppose the affixing by a third party of a identical sign to non-similar products, if it takes unfair advantage of the mark concerned, or causes detriment to that distinctive character or reputation

- when there is no existence of a ‘due cause’, in support of such affixing

52. It will therefore be for the referring court to examine whether the affixing by Dr. Liebe, of a sign

identical with, or similar to, the ÖKO-TEST marks to its products enabled Dr. Liebe to take unfair advantage of the distinctive character or the reputation of those marks or was detrimental to that distinctive character or reputation. Should it find that to be the case, the referring court will, in addition, have to assess whether Dr. Liebe has established, in this case, a ‘due cause’, within the meaning of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95, in relation to the affixing of that sign to those products. In the latter case, it would have to be concluded that ÖKO-Test Verlag does not have the right to prohibit that use on the basis of those provisions (see, by analogy, judgment of 6 February 2014, [Leidseplein Beheer and de Vries](#), C-65/12, EU:C:2014:49, paragraphs 43 and 44).

53. In the light of the foregoing, the answer to the second question is that Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a ‘due cause’, within the meaning of those provisions, in support of such affixing.

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### Court of Justice EU, 11 April 2019

(E. Regan, C. Lycourgos, E. Juhász, M. Ilešič (Rapp) and I. Jarukaitis)

JUDGMENT OF THE COURT (Fifth Chamber)

11 April 2019 (\*)

(Reference for a preliminary ruling — Intellectual property — Trade marks — Regulation (EC) No 207/2009 — Article 9(1) — Directive 2008/95/EC — Article 5(1) and (2) — Rights afforded by a trade mark — Individual trade mark consisting of a quality label)

In Case C-690/17,

REQUEST for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by decision of 30 November 2017, received at the Court on 8 December 2017, in the proceedings

ÖKO-Test Verlag GmbH

v

Dr. Rudolf Liebe Nachf. GmbH & Co. KG,

THE COURT (Fifth Chamber),

composed of E. Regan, President of the Chamber, C. Lycourgos, E. Juhász, M. Ilešič (Rapporteur) and I. Jarukaitis, Judges,

Advocate General: M. Campos Sánchez-Bordona,

Registrar: D. Dittert, Head of Unit,

having regard to the written procedure and further to the hearing on 7 November 2018,

after considering the observations submitted on behalf of:

– ÖKO-Test Verlag GmbH, by N. Dinig, Rechtsanwältin,

– Dr. Rudolf Liebe Nachf. GmbH & Co. KG, by M. Wieme, Rechtsanwalt,

– the German Government, by T. Henze, M. Hellmann, J. Teichert and U. Bartl, acting as Agents,

– the European Commission, by É. Gippini Fournier, W. Mölls and G. Braun, acting as Agents,

after hearing the [Opinion of the Advocate General](#) at the sitting on 17 January 2019,

gives the following

### Judgment

1. This request for a preliminary ruling concerns the interpretation of Article 9 of Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1), and of Article 5 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).

2. The request has been made in proceedings between ÖKO-Test Verlag GmbH and Dr. Rudolf Liebe Nachf. GmbH & Co. KG (‘Dr. Liebe’) concerning use of a sign that is identical with, or similar to, an individual trade mark consisting of a quality label.

### Legal context

#### EU law

#### Regulation No 207/2009

3. Regulation No 207/2009 was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. It was subsequently repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1). However, having regard to the date of the facts giving rise to the dispute the main proceedings, the present reference for a preliminary ruling will be considered in the light of Regulation No 207/2009, in its initial version.

4. According to recital 8 of Regulation No 207/2009:

‘The protection afforded by a [European Union] trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in cases of similarity between the mark and the sign and the goods or services ...’

5. Article 9(1) and (2) of that regulation provided:

‘1. A [European Union] 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 [European Union] trade mark in relation to goods or services

which are identical with those for which the Community trade mark is registered;

(b) any sign where, because of its identity with, or similarity to, the [European Union] trade mark and the identity or similarity of the goods or services covered by the [European Union] 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;

(c) any sign which is identical with, or similar to, the [European Union] trade mark in relation to goods or services which are not similar to those for which the [European Union] trade mark is registered, where the latter has a reputation in the [Union] 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 [European Union] trade mark.

2. The following, *inter alia*, may be prohibited under paragraph 1:

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

...'

#### Directive 2008/95

6. Directive 2008/95, which repealed and replaced 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), was in turn 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). However, having regard to the date of the facts giving rise to the dispute in the main proceedings, the present reference for a preliminary ruling will be considered in the light of Directive 2008/95.

7. Recital 11 of Directive 2008/95 stated:

*'The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services ...'*

8. According to Article 5(1) to (3) of Directive 2008/95:

*'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;

...'

#### German law

9. The Federal Republic of Germany availed itself of the option provided for in Article 5(2) of Directive 2008/95 by adopting Paragraph 14(2)(3) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (the Law on trade marks and other signs).

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

10. ÖKO-Test Verlag is an undertaking which evaluates products through performance and compliance tests and then informs the public of the results of those evaluations. It sells a magazine that is published in Germany and contains those results, as well as providing general consumer information.

11. Since 2012, ÖKO-Test Verlag has been the proprietor of an EU trade mark, consisting of the following sign, which represents a label intended to present the results of tests to which products have been subjected ('the quality label'):



12. It is also the proprietor of a national mark consisting of the same quality label.

13. Those marks (together 'the ÖKO-TEST marks') are registered, *inter alia*, for printed matter and for services that consist in conducting tests and providing consumer information and consultancy.

14. ÖKO-Test Verlag selects the products that it wishes to test and evaluates them on the basis of scientific parameters also selected by it, without requesting the manufacturers' consent. It then publishes the results of those tests in its magazine.

15. In some circumstances, ÖKO-Test Verlag invites the manufacturer of a tested product to conclude a licensing agreement with it. Under the terms of such an agreement, the manufacturer is authorised, in return for

the payment of a sum of money, to affix the quality label with the result (which must be shown in the box whose outline is part of that label) to its products. Such a licence remains valid until a new test is organised for the product concerned by ÖKO-Test Verlag.

16. Dr. Liebe is an undertaking that produces and markets toothpastes, in particular the ‘Aminomed’ range. Among the toothpastes in that range, the product ‘Aminomed Fluorid-Kamillen-Zahncreme’ was tested by ÖKO-Test Verlag in 2005 and was rated ‘sehr gut’ (‘very good’). Dr. Liebe concluded a licensing agreement with ÖKO-Test Verlag in the same year.

17. In 2014, ÖKO-Test Verlag became aware that Dr. Liebe was marketing one of its products with the following packaging:



18. ÖKO-Test Verlag brought infringement proceedings against Dr. Liebe before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), submitting that in 2014, Dr. Liebe was not authorised to use the ÖKO-TEST marks on the basis of the licensing agreement concluded in 2005, since, in particular, a new test based on new parameters in respect of toothpastes had been published in 2008 and, additionally, Dr. Liebe’s product was no longer the same as that actually tested in 2005, as its name, description and packaging had changed.

19. Dr. Liebe claimed before that court that the licensing agreement, referred to in paragraph 16 of the present judgment, remained in force. It also denied that it had used the quality label as a trade mark.

20. That court ordered Dr. Liebe, by instructing it to stop using the quality label for products in the ‘Aminomed’ range, to withdraw the products concerned from the market and to destroy them. It held that Dr. Liebe had infringed the ÖKO-TEST marks by using the quality label for ‘consumer information and consultancy’ services, which are covered by the services for which those marks are registered.

21. Dr. Liebe brought an appeal against that decision before the referring court, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany). In turn, ÖKO-Test Verlag lodged a cross-appeal requesting the extension of the court of first instance’s decision to the use, by Dr. Liebe, of some word and figurative signs that have not been registered as a mark but are identical to the ÖKO-TEST marks.

22. The referring court considers that the court at first instance correctly found that the licensing agreement referred to in paragraph 16 of the present judgment had been terminated before 2014. That court deduces therefrom that Dr. Liebe used, in the course of trade and without ÖKO-Test Verlag’s consent, a sign that is identical with, or similar to, the ÖKO-TEST marks.

23. On the other hand, it is not clear that ÖKO-Test Verlag may rely on its exclusive right referred to in Article 9(1)(a) and (b) of Regulation No 207/2009 and in Article 5(1) of Directive 2008/95 against Dr. Liebe. The sign identical with, or similar to, the ÖKO-TEST marks had been affixed by Dr. Liebe to products that are neither identical with, nor similar to, those in respect of which the ÖKO-TEST marks are registered. Furthermore, it could be considered that that sign was not used ‘as a trade mark’.

24. The referring court has doubts, therefore, as to the approach followed by the court of first instance, which equated the use, by Dr. Liebe, of the sign identical with, or similar to, the ÖKO-TEST marks to a use in respect of services for which those marks are registered.

25. Furthermore, the referring court is uncertain as regards the scope of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95. Admittedly, it is established that the quality label that was registered as a trade mark has a reputation throughout Germany. However, that reputation concerns that label and not, as such, the registration of that label as a trade mark. It should be clarified whether, in such circumstances, the proprietor of the mark enjoys the protection afforded by those provisions.

26. In those circumstances, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

‘(1) Is an individual trade mark used in such a way as to infringe rights for the purposes of point (b) of the second sentence of Article 9(1) of [Regulation No 207/2009] or point (a) of the second sentence of Article 5(1) of [Directive 2008/95] in the case where

– the individual trade mark is affixed to a product in respect of which the individual trade mark is not protected;

– the affixing of the individual trade mark by a third party is perceived by the public as a “test seal” [(quality label)], which is to say that, although the product has been manufactured and placed on the market by a third party not acting under the control of the trade mark proprietor, the trade mark proprietor has tested some of the characteristics of that product and, on that basis, given it a particular rating shown on the quality label; and

– the individual trade mark is registered for, inter alia, “consumer information and consultancy with regard to the selection of goods and services, in particular using test and investigation results and by means of quality judgments”?’

(2) Should the Court of Justice answer Question 1 in the negative:

Is an individual trade mark used in such a way as to infringe rights for the purposes of point (c) of the second sentence of Article 9(1) of [Regulation 207/2009] and Article 5(2) of [Directive 2008/95] in the case where

– the individual trade mark has a reputation only as a quality label as described in Question 1; and  
– the individual trade mark is used as a quality label by the third party?’

#### Consideration of the questions referred

##### The first question

27. By its first question, the referring court asks, in essence, whether Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

28. As regards, first of all, Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, it should be noted that those provisions refer to the so-called ‘double identity’ situation, in which use by a third party of a sign identical with the trade mark is made in relation to goods or services that are identical with those for which the trade mark is registered (judgment of 22 September 2011, [Interflora and Interflora British Unit](#), C-323/09, EU:C:2011:604, paragraph 33).

29. The wording ‘in relation to goods or services’, which features in those provisions, relates, in principle, to goods or services of a third party who uses a sign identical with the mark. Should the case arise, it can also refer to goods or services of another person on whose behalf the third party is acting (judgment of 23 March 2010, [Google France and Google](#), C-236/08 to C-238/08, EU:C:2010:159, paragraph 60 and the case-law cited).

30. On the other hand, that wording does not, in principle, cover goods and services of the proprietor of that mark: they are covered, in Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, by the expression ‘*those for which the trade mark is registered*’. The requirement for identity ‘*between the goods or services*’, referred to in recital 8 of Regulation No 207/2009 and in recital 11 of Directive 2008/95, which is contained in Article 9(1)(a) of that regulation as well as in Article 5(1)(a) of that directive, is intended to limit the right of prohibition granted by those provisions to the proprietors of individual trade marks to cases in which there is identity not only between the sign used by the third party and the trade mark, but also between the goods marketed and the services supplied by the third party — or by a person on whose behalf that third party is acting — and the goods and services for which the proprietor registered his mark.

31. As the Court has already held, use of the sign by the third party to identify the goods of the trade mark proprietor where those goods constitute the actual subject matter of services provided by that third party can, exceptionally, be covered by those provisions. In such a case, that sign is used to identify the origin of the goods that are the subject matter of those services

and there is a specific and indissociable link between the goods bearing the trade mark and those services. However, apart from that specific case, Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95 must be interpreted as covering the use of a sign identical to the trade mark in respect of goods marketed or services supplied by the third party that are identical to those for which the trade mark is registered (see, to that effect, judgment of 25 January 2007, [Adam Opel](#), C-48/05, EU:C:2007:55, paragraphs 27 and 28).

32. The specific case referred to in the preceding paragraph concerns, in particular, situations in which a service provider makes unauthorised use of a sign identical to the trade mark of a manufacturer of goods in order to inform the public that he has specialised or is a specialist in those products (see, to that effect, judgment of 3 March 2016, [Daimler](#), C-179/15, EU:C:2016:134, paragraph 28 and the case-law cited).

33. In the present case, subject to verification by the referring court, it appears that the affixing by Dr. Liebe of a sign allegedly identical to the ÖKO-TEST marks has neither the purpose nor the effect of carrying out, in the same way as ÖKO-Test Verlag or on its behalf, an economic activity consisting in the provision of consumer information and consultancy services. Nor does there appear to be any indication to suggest either that, by affixing that sign, Dr. Liebe seeks to present itself to the public as specialist in the field of product testing or that there is a specific and indissociable link between its economic activity, which consists in the manufacturing and marketing of toothpaste, and that of ÖKO-Test Verlag. On the contrary, it is apparent that the sign that is identical with, or similar to, those marks is affixed to the toothpaste packaging marketed by Dr. Liebe for the sole purpose of drawing consumers’ attention to the quality of those toothpastes and thus promoting the sale of Dr. Liebe products. Therefore, the situation at issue in the main proceedings differs from the specific case referred to in paragraphs 31 and 32 of the present judgment.

34. As regards, next, Article 9(1)(b) of Regulation No 207/2009 and Article 5(1)(b) of Directive 2008/95, which grant the proprietor of the mark specific protection against the use, by a third party, of signs identical with, or similar to, the mark leading to a likelihood of confusion on the part of the public, it is apparent from the wording of those provisions, read in the light of recital 8 of that regulation and recital 11 of that directive, that that protection granted to the proprietor of the trade mark applies only in cases where there is an identity or similarity — not only between the sign used by the third party and the mark — but also between the goods or services covered by that sign, on the one hand, and those covered by the mark, on the other.

35. Like the expression ‘*in relation to goods or services*’, which appears in Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, the words ‘goods or services covered by ... the sign’ referred to in paragraph 1(b) of

those articles cover, in principle, the goods marketed or services supplied by the third party (judgment of 12 June 2008, [O2 Holdings and O2 \(UK\)](#), C-533/06, EU:C:2008:339, paragraph 34). In the absence of any similarity between the goods or services of the third party and those for which the mark is registered, the protection granted by those provisions is not applicable (see, in particular, judgment of 15 December 2011, [Frisdranken Winters](#), C-119/10, EU:C:2011:837, paragraphs 31 to 33).

36. Article 9(1)(b) of Regulation No 207/2009 and Article 5(1)(b) of Directive 2008/95 thus contain, like paragraph 1(a) of those articles, a requirement that the goods or services of a third party, on the one hand, and those of the proprietor of the trade mark, on the other, be comparable. Points (a) and (b) differ fundamentally, in that regard, from point (c) of Article 9(1) of that regulation and from Article 5(2) of that directive, which expressly state that such comparability is not required where the mark has a reputation.

37. That difference expressly provided for by the EU legislature between the protection that is granted to proprietors of any individual trade mark and the additional protection that the proprietor enjoys where his mark also has a reputation has been maintained during successive amendments to EU trade mark legislation. Thus, the wording *‘in relation to goods or services which are identical with those for which the EU trade mark is registered’* and *‘in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered’* is now contained in Article 9(2)(a) and (b) of Regulation 2017/1001 and in Article 10(2)(a) and (b) of Directive 2015/2436, thus distinguishing the protection afforded by any individual trade mark from that provided for in Article 9(2)(c) of that regulation and in Article 10(2)(c) of that directive, which is applicable where the mark has a reputation and a third party uses a sign that *‘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’*.

38. It follows from all of the foregoing that the proprietor of an individual trade mark that consists of a quality label registered in relation to printed matter and services of conducting tests and providing consumer information and consultancy may, if all the conditions are fulfilled, rely on the right of prohibition set out in Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 against third parties, such as potential competitors, who use a sign identical with, or similar to, that mark in relation to printed matter or services of conducting tests and providing consumer information and consultancy, or in relation to similar goods and services, but that he may not rely on that right against manufacturers of tested consumer products who affix the sign identical with, or similar to, that mark to those consumer products.

39. In so far as ÖKO-Test Verlag and the German Government submitted, in their written observations,

that such an interpretation, even though founded on the wording and scheme of Regulation No 207/2009 and Directive 2008/95, would unduly reduce the protection of proprietors of individual trade marks consisting of a quality label, such as that at issue in the main proceedings, it should be noted, as the European Commission has indicated in its written observations, that the exclusive right afforded by the mark is not absolute, since the EU legislature has, on the contrary, precisely delimited the scope of that right.

40. Furthermore, nothing in the objectives of EU trade mark legislation, such as the objective of contributing to the system of undistorted competition in the Union (see, in particular, to that effect, judgments of 4 October 2001, [Merz & Krell](#), C-517/99, EU:C:2001:510, paragraphs 21 and 22, and of 14 September 2010, [Lego Juris v OHIM](#), C-48/09 P, EU:C:2010:516, paragraph 38), supports the conclusion that the purpose of that legislation requires that the proprietor of an individual trade mark consisting of a quality label must be able to oppose, on the basis of Article 9(1)(a) and (b) of Regulation No 207/2009 or Article 5(1)(a) and (b) of Directive 2008/95, the affixing, by the manufacturer of a product, of that label together with the result of the test to which the product was subjected.

41. This is particularly true in view of the fact that the EU legislature supplemented the EU trade mark regime by providing in Article 74a et seq. of Regulation No 207/2009, now Article 83 et seq. of Regulation 2017/1001, for the possibility of registering as an EU certification mark certain signs, including those that are capable of distinguishing the goods or services that are certified by the proprietor of the mark in respect of quality from goods and services that are not so certified. In contrast to an individual trade mark, such a certification mark allows the proprietor to specify in regulations governing use the persons authorised to use the mark.

42. In so far as ÖKO-Test Verlag maintains that the affixing of a quality label by Dr. Liebe was not covered by the previously concluded licensing agreement, it is lastly necessary to add that the fact that the proprietor of a mark, such as ÖKO-Test Verlag, cannot, with regard to manufacturers whose products it has tested, rely on Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 does not mean that it is without legal protection against those manufacturers, but merely that the conflicts between it and those manufacturers must be assessed from the point of view of other rules of law. Those rules may include rules relating to contractual or non-contractual liability, as well as the rules, referred to in the second question, which are set out in Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95.

43. In the light of all of the foregoing considerations, the answer to the first question is that Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 must be interpreted as meaning that they do not entitle the proprietor of an

individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

#### The second question

44. By its second question, the referring court asks, in essence, whether Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

45. The provisions referred to in the preceding paragraph determine the scope of the protection that is afforded to the proprietors of marks with a reputation. They entitle those proprietors to prohibit any third party from making, in the course of trade and without the consent of the proprietor, use without due cause of an identical or similar sign — whether for similar goods or services or for goods or services not similar to those for which those marks are registered — that takes unfair advantage of the distinctive character or the repute of those marks or is detrimental to that distinctive character or repute. The exercise of that right is not conditional upon there being a likelihood of confusion on the part of the relevant section of the public (see, to that effect, *inter alia*, judgments of 22 September 2011, [Interflora and Interflora British Unit](#), C-323/09, EU:C:2011:604, paragraphs 68, 70 and 71, and of 20 July 2017, [Ornua](#), C-93/16, EU:C:2017:571, paragraph 50).

46. As is apparent from the request for a preliminary ruling, the referring court considers that, in the present case, Dr. Liebe affixed to its products a sign identical with, or similar to, the ÖKO-TEST marks without ÖKO-Test Verlag's consent. It has some doubts, however, as to whether those marks afford ÖKO-Test Verlag the protection laid down by those provisions. It draws attention to the fact that, for the relevant German public, it is the quality label that has a reputation and not its registration as a trade mark. Additionally, that public perceives the affixing of the sign at issue by Dr. Liebe as the display of a quality label and not as the use of such a label as a trade mark.

47. In that regard, it should be recalled that the concept of '*reputation*' referred to in Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95, assumes a certain degree of knowledge amongst the relevant public. That public must be determined by reference to the product or service marketed under the trade mark concerned and the degree of knowledge required must be considered to be reached when the trade mark is known by a significant part of that public (see, to that effect, judgments of 6 October 2009, [PAGO International](#), C-301/07, EU:C:2009:611, paragraphs 21 to 24, and of 3

September 2015, [Iron & Smith](#), C-125/14, EU:C:2015:539, paragraph 17).

48. It follows from those principles that the '*reputation*', within the meaning of those provisions, of the ÖKO-TEST marks depends on whether a significant part of the public that ÖKO-Test Verlag targets with its consumer information and consultancy service and its magazine, knows the sign of which those marks consist, in this case, the quality label.

49. As the Advocate General has noted in [point 79 of his Opinion](#), that requirement of knowledge cannot be interpreted as meaning that the public must be aware that the quality label has been registered as a trade mark. It is sufficient that a significant part of the relevant public knows that sign.

50. As regards, in particular, Article 9(1)(c), it should also be recalled that it suffices, in order for the proprietor of an EU trade mark to enjoy the protection granted by that provision, that that mark has a reputation in a substantial part of the territory of the European Union, and that part may, in some circumstances, correspond to the territory of a single Member State. If that condition is satisfied, the EU trade mark at issue must be considered to have a reputation in the whole of the European Union (see, to that effect, judgments of 6 October 2009, [PAGO International](#), C-301/07, EU:C:2009:611, paragraphs 27, 29 and 30, and of 20 July 2017, [Ornua](#), C-93/16, EU:C:2017:571, paragraph 51).

51. The sign of which the ÖKO-TEST marks consist, that is to say, the quality label reproduced in paragraph 11 of the present judgment, is, according to the findings contained in the order for reference, known by a significant part of the relevant public throughout Germany. It follows that the ÖKO-TEST marks enjoy a reputation, within the meaning of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95, with the result that ÖKO-Test Verlag enjoys the protection afforded by those provisions.

52. It will therefore be for the referring court to examine whether the affixing by Dr. Liebe, of a sign identical with, or similar to, the ÖKO-TEST marks to its products enabled Dr. Liebe to take unfair advantage of the distinctive character or the reputation of those marks or was detrimental to that distinctive character or reputation. Should it find that to be the case, the referring court will, in addition, have to assess whether Dr. Liebe has established, in this case, a '*due cause*', within the meaning of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95, in relation to the affixing of that sign to those products. In the latter case, it would have to be concluded that ÖKO-Test Verlag does not have the right to prohibit that use on the basis of those provisions (see, by analogy, judgment of 6 February 2014, [Leidseplein Beheer and de Vries](#), C-65/12, EU:C:2014:49, paragraphs 43 and 44).

53. In the light of the foregoing, the answer to the second question is that Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be

interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a 'due cause', within the meaning of those provisions, in support of such affixing.

#### Costs

54. 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 (Fifth Chamber) hereby rules:

1. Article 9(1)(a) and (b) of Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark, and Article 5(1)(a) and (b) 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 they do not entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

2. Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a 'due cause', within the meaning of those provisions, in support of such affixing.

[Signatures]

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#### OPINION ADVOCATE GENERAL M. CAMPOS SÁNCHEZ-BORDONA

Case C-690/17

ÖKO-Test Verlag GmbH

v

Dr. Rudolf Liebe Nachf. GmbH & Co. KG

(Request for a preliminary ruling from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany))

(Reference for a preliminary ruling — European Union trade mark — Rights conferred by the trade mark — Right to oppose the use by a third party of an identical or similar sign — Unauthorised affixing to a product of a trade mark acting as a quality test label)

1. This request for a preliminary ruling concerns whether the proprietor of a trade mark (ÖKO-TEST) made up of a quality label (2) and registered in order to identify a number of services is entitled to prohibit its use by a third party which has used it on the packaging of a toothpaste (Aminomed) without the trade mark proprietor's consent.

2. In circumstances such as these, in which there does not appear to be any identity or similarity between the dental products and the services provided by the proprietor of the quality label, is any purpose served in resorting to actions for infringement of trade mark law? That, in essence, is the question raised by the referring court with a view to resolving the issues arising from the fact that the proprietor of the ÖKO-TEST trade mark cannot bring against anyone using that quality label without its consent an action for breach of contract or any other action based on the German rules governing unfair competition.

#### I. Legislative framework

##### A. EU law

3. The legislation on the protection of trade marks is comprised of both the measures aimed at harmonising national laws (in particular, Directive 2008/95/EC) (3) and the provisions regulating the EU trade mark (Regulation No 207/2009) (4) and applies to operators that choose to acquire this form of industrial property right.

##### 1. Directive 2008/95

4. Article 5(1) to (3) provides:

*'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;

...

## 2. Regulation 2017/1001

5. Article 9(1) to (3) (5) states:

'1. The registration of an EU 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 EU trade mark, the proprietor of that EU 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 EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

(b) the sign is identical with, or similar to, the EU 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 EU 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 EU 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 EU trade mark is registered, where the latter has a reputation in the Union 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 EU 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, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;

...

## B. German law. Gesetz über den Schutz von Marken und sonstigen Kennzeichen (6)

6. In Paragraph 14(3) of that Law, the Federal Republic of Germany avails itself of the option provided for in Article 5(2) of Directive 2008/95 in relation to trade marks with a reputation.

## II. Facts giving rise to the dispute and questions referred for a preliminary ruling

7. Öko-Test Verlag GmbH is the publisher of 'ÖKO-TEST', a magazine in circulation throughout Germany. In addition to providing general consumer information, it publishes analyses of goods and services carried out

by independent laboratories. Those tests and analyses are undertaken without the knowledge of the manufacturers concerned.

8. On 23 April 2012, Öko-Test Verlag registered the following trade mark, at national level, with the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) and, on 31 August 2012, at EU level, with the European Union Intellectual Property Office (EUIPO): (7)



9. The services (8) covered by the trade mark that are most relevant to this dispute appear in classes 35 (consumer information and consultancy with regard to the selection of goods and services using test and investigation results; conduct and assessment of opinion polls and surveys) and 42 (conduct and assessment of science-based product testing and service reviews; conduct and assessment of quality analyses; conduct and assessment of technical testing and analyses).

10. Öko-Test Verlag finances itself primarily from the revenue it generates from sales of its magazine and from licensing agreements for the use of its trade mark which it enters into with the manufacturers of the products it has analysed. Licensees receive a file containing the ÖKO-TEST quality label and use it on their products, once they have entered the test result and its source in the blank space below the label. (9)

11. The licensing agreement expires either when the results of earlier tests carried out on the licensee's product are superseded by a more recent analysis (based on new parameters), even if the licensee did not submit its product for retesting, (10) or when the properties or characteristics of the product change.

12. The company Dr. Rudolf Liebe Nachf. GmbH & Co.KG (11) manufactures toothpastes, including Aminomed. Öko-Test Verlag analysed a number of toothpastes including Aminomed Fluorid-Kamillen-Zahncreme (Aminomed fluoride/camomile toothpaste) and published the test results in the Jahrbuch Kosmetik 2005 (2005 Cosmetics Yearbook), where it was given a 'very good' ('sehr gut') rating.

13. In August 2005, the two undertakings concluded a licensing agreement on the use of the ÖKO-TEST quality label (which had not yet been registered as a trade mark), following which Dr. Liebe began using that quality label to advertise its product.

14. In October 2014, Öko-Test Verlag became aware that Aminomed was being distributed in the manner indicated below:



The packaging had been changed from its original format.

15. Öko-Test Verlag brought an action for infringement of trade mark law before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany). It claimed that the licensing agreement did not entitle Dr. Liebe to use the ÖKO-TEST quality label because: (a) that label had not formed the subject of the agreement; (b) since a later toothpaste analysis based on new parameters had been published in 2008, Dr. Liebe was not authorised to use the sign in question for that reason alone; and (c) the product being sold by Dr. Liebe under that sign was not the same as that actually tested for the purposes of the licensing agreement, given that its name, description and packaging, at least, had changed.

16. Dr. Liebe opposed the action on the ground that the licensing agreement remained in force and it was entitled to use the ÖKO-TEST quality label. It further stated that, since the national and EU trade marks were registered, it had not used them again.

17. The Landgericht (Regional Court) took the view that Dr. Liebe was using the trade mark at issue for the ‘consumer information and consultancy’ service and that it could no longer rely on the licensing agreement. Since Dr. Liebe had not provided specific information on the cessation of production, the court presumed that the defendant had continued to market the toothpaste under the aforementioned quality label even after that trade mark was registered. It therefore ordered Dr. Liebe to stop using the ÖKO-TEST quality label in the retailing of Aminomed and to withdraw it from the market.

18. Dr. Liebe appealed against that judgment to the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf), which, in the order for reference: (a) concurs with the court of first instance that the licensing agreement expired some time ago; and (b) recognises, therefore, that Dr. Liebe was using the trade mark in the course of trade without the trade mark proprietor’s consent.

19. In the view of the referring court:

– if it were to accept the proposition that the trade mark at issue has been used in connection with a product (toothpaste), it would have to reject the claims made by Öko-Test Verlag on the basis of Article 9(2)(a) and (b) of Regulation 2017/1001, since neither of the two registrations of ÖKO-TEST included toothpaste or ‘similar goods’.

– Öko-Test Verlag could rely on the right it enjoys as proprietor of the trade mark under that article only if the use of a quality label on a product were regarded as being the same as its use in connection with one of the services protected by that trade mark, such as

‘consumer information and consultancy with regard to the selection of goods and services’.

20. The referring court also points out that, owing to the differences between them, quality labels are not comparable with quality seals and are not suitable for registration as certification marks. (12) It notes, however, that, as the Court found in *Gözze*, (13) consumers’ perception of a quality label is similar to their perception of a quality seal. The fact that the quality label is affixed to the product guarantees a certain level of quality which has been tested, but it does not guarantee that that product was manufactured under the supervision of the proprietor of the trade mark constituted by the quality label. Consequently, the public does not associate the ÖKO-TEST trade mark with the manufacturers of the products analysed because it knows and attaches particular importance to the fact that the proprietor of that trade mark is independent of those manufacturers.

21. If the affixing of the quality label were regarded as use in connection with the registered service, Dr. Liebe would have infringed the trade mark, (14) from the point of view of both its function as an indication of origin and its function as a guarantee of quality. If, on the other hand, the answer to the first question referred for a preliminary ruling is in the negative, the national court is faced with another point of uncertainty, this time in relation to Article 9(2)(c) of Regulation 2017/1001 and Article 5(2) of Directive 2008/95.

22. After all, although the ÖKO-TEST trade mark has a reputation in the territory of the Federal Republic of Germany, it is known not as an industrial property sign but as a quality label. It would be difficult therefore, in the light of the judgment in *Gözze*, to take the view that Dr. Liebe used that trade mark in connection with the toothpaste product rather than in connection with the service provided by Öko-Test Verlag. Hence the referring court’s inquiry as to whether an individual mark can be regarded as having a reputation where its reputation is due to its nature as a quality label.

23. In this regard, it goes on to say that the case-law on trade marks with a reputation (15) does not provide it with a sufficient foundation on which to determine whether the marketing of the toothpaste under the quality label constitutes a use such as to infringe rights, or, in particular, whether such an infringement may be constituted by use other than as a trade mark. It ends by noting that instances of abuse of reputation or image transfer, which the aforementioned provisions prohibit, also occur where the third party is not using the individual mark in order to guarantee the identity of the goods as originating from its undertaking.

24. It is in those circumstances that the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) refers the following questions to the Court of Justice for a preliminary ruling:

*‘(1) Is an individual trade mark used in such a way as to infringe rights for the purposes of point (b) of ... Article 9[2] of ... Regulation [2017/1001] or point (a) of the second sentence of Article 5(1) of ... Directive [2008/95] in the case where*

– the individual trade mark is affixed to a product in respect of which the individual trade mark is not protected;

– the affixing of the individual trade mark by a third party is perceived by the public as a [“quality mark”], which is to say that, although the product has been manufactured and placed on the market by a third party not acting under the control of the trade mark proprietor, the trade mark proprietor has tested some of the characteristics of that product and, on that basis, given it a particular rating shown on the [quality mark], and

– the individual trade mark is registered for, inter alia, “consumer information and consultancy with regard to the selection of goods and services, in particular using test and investigation results and by means of quality judgments”?

(2) Should the Court of Justice answer Question 1 in the negative:

Is an individual trade mark used in such a way as to infringe rights for the purposes of point (c) ... of Article 9(2) of ... Regulation [2017/2001] and Article 5(2) of ... Directive [2008/95] in the case where

– the individual trade mark has a reputation only as a [quality mark] as described in Question 1; and

– the individual trade mark is used as a [quality mark] by a third party?’

### III. Procedure before the Court of Justice

25. The order for reference was registered at the Court of Justice on 8 December 2017. Written observations have been submitted by Öko-Test Verlag, the German Government and the European Commission, which parties took part in the hearing held on 7 November 2018, which was also attended by Dr. Liebe.

### IV. Legal analysis

#### A. Preliminary observations

26. Although the referring court asks about the applicability of Article 9 of Regulation 2017/1001 and Article 5 of Directive 2008/95, it points out that the action that gave rise to the dispute was concerned with the EU trade mark and only in the alternative with the national trade mark. (16) Consequently, in the interests of ease of reading, my analysis will look primarily at the provisions of Regulation 2017/1001, concerning EU trade marks, although the results of that analysis will be amenable to extrapolation, mutatis mutandis, to the corresponding provisions of Directive 2008/95. (17)

27. As I have already said, the referring court has ruled out the possibility that the legal protection sought by Öko-Test Verlag can be granted to it by way of an action for breach of contract (it states that the licensing agreement ceased to bind both parties some time ago) (18) or by an action for unfair competition, since the latter requires the applicant and defendant undertakings to be in competition with each other, which is not the case here. (19)

28. Just as I have no reservations with respect to the bar to any action for an injunction under German law on unfair competition, it may not be possible to explore the feasibility of an action for breach of contract, in the

light of certain judgments of the Court of Justice to the effect that:

– in order to ascertain whether an action is a ‘matter relating to a contract’ rather than ‘a matter relating to tort [or] delict’ within the meaning of Article 5(1) and (3) of the ‘Brussels I Regulation’, (20) it must be investigated whether the conduct complained of constitutes an infringement of contractual obligations as determined by reference to the purpose of the contract; (21) and

– in order to settle an action for compensation for non-contractual liability on the part of the EU institutions, it must be verified whether there exists between the parties, even if the contractual relationship has come to an end, a genuine contractual context, linked to the subject matter of the dispute, the in-depth examination of which proves to be indispensable for the resolution of the said action. (22)

29. The legal context of this case is clearly different from that in the judgments which I have just cited in footnotes 21 and 22. The methodological approach taken in those judgments may nonetheless be useful, by analogy, here too. Although the order for reference had appeared to indicate otherwise, the parties to the dispute confirmed at the hearing that the right to use the logo (23) had been authorised as part of the contractual relationship. If, as the documents before the Court indicate, Dr. Liebe carried on using that quality label, it would have been infringing the (possibly explicit) contractual obligation to stop affixing that emblem to the packaging of its toothpaste once the relationship arising from that contract had ceased to exist.

30. The referring court could therefore, if it sees fit, take the foregoing approach as the basis for a possible action for breach of contract in favour of Öko-Test Verlag. However, I wish only to note this as a possibility here, conscious as I am that, in the context of a request for a preliminary ruling such as this, it falls to the Court to answer the questions raised, rather than to suggest alternative solutions which, ultimately, are a matter of national law.

#### B. First question: use such as to infringe rights

##### 1. Summary of the parties’ observations

31. Öko-Test Verlag submits that its quality mark is used as a trade mark not for toothpaste but for a service (which it itself provides), and proposes that this question be answered in the affirmative. It argues that a quality label is not the same as a quality seal, since the former provides information on how a product performs against certain pre-established standards, while a quality seal serves only to make the quality of a product recognisable at first sight to the consumer. It concurs with the referring court and the German Government in ruling out any similarity with guarantee and certification marks. (24)

32. Öko-Test Verlag takes the view that the public concerned will perceive the use of ÖKO-TEST on the toothpaste at issue as having been authorised by its proprietor and as indicating: (a) that that product received a ‘very good’ rating in the tests to which Öko-Test Verlag subjected it; and (b) that that rating is

consistent with the content of its publication and its neutral, objective and expert standards. Consequently, Dr. Liebe's use of ÖKO-TEST affects not only the trade mark's function as an indication of origin but also other functions recognised by the Court of Justice. (25)

33. The German Government states that the first question asks not about the double identity referred to in Article 5(1)(a) of Directive 2008/95 but about the likelihood of confusion mentioned in subparagraph (b) of that article, since there are certain differences between the original ÖKO-TEST sign and the one used on the toothpaste (in particular, the test results and the publication reference). It suggests that this question be answered in the affirmative, on the basis that a trade mark registered for a service can be used for a product where the public recognises the autonomy of the service and that the latter is linked to the product.

34. The German Government considers that the decisive criterion is the perception of the public, which is used to organisations with no links to manufacturers carrying out analyses of everyday goods and then reporting the results to consumers immediately afterwards. Consumers could readily deduce that Öko-Test Verlag had tested the toothpaste and given it a 'very good' rating. What is more, it is common for undertakings to exhibit on those goods various marks or signs including quality or certification seals (organic farming, EU energy efficiency, fair trade), and to affix a supplier's trade marks to them as an indication of the quality of the components of the end product (for example, Intel Inside in the case of computer processors).

35. The Commission takes the view, on the other hand, that the question actually relates to subparagraph (a), rather than (b), of both Article 9(1) of Regulation No 207/2009 and Article 5(1) of Directive 2008/95. It accepts that the affixing of the ÖKO-TEST trade mark to the toothpaste's packaging necessarily refers to the services provided by the trade mark proprietor (Öko-Test Verlag), but considers that reference to be inherent in the advertising of the dental product and does not imply that Dr. Liebe is advertising the same services as those offered by Öko-Test Verlag.

36. The Commission highlights the impact in terms of advertising which the toothpaste manufacturer is looking to obtain from using the ÖKO-TEST quality label: that the public will remember the service provided by the quality label proprietor as being the only possible source of an independent analysis. The clauses of the licensing agreement, it submits, are intended to ensure that any loss of quality on the part of the product tested does not adversely affect Öko-Test Verlag's own trade mark, which it would if the product's diminished quality were associated with the undertaking responsible for its testing.

## 2. Assessment

37. By the first question, the referring court wishes to ascertain, in essence, whether the ÖKO-TEST quality label, which is protected as a registered trade mark, serves, in the manner in which Dr. Liebe uses it on toothpaste packaging, to identify the services provided

by the proprietor of that mark and not only the goods sold by Dr. Liebe.

38. The Court of Justice held in the judgment in Gözze that 'there is no use in accordance with the essential function of the individual mark where it is affixed on goods for the sole purpose of being a label of quality for those goods and not that of guaranteeing, in addition, that the goods come from a single undertaking under the control of which they are manufactured and which is responsible for their quality'. (26)

39. If that ruling were followed to the letter, the solution to the present dispute would be relatively simple, inasmuch as Öko-Test Verlag does not manufacture toothpaste and its trade mark is not affixed to the packaging in order to identify the product's origin. It would therefore have to be found that that undertaking cannot prohibit Dr. Liebe from using the ÖKO-TEST trade mark in the course of trade under Article 9(2)(a) and (b) of Regulation 2017/1001.

40. Although, in the present case, such an approach could (as I shall later propose) be corrected by recourse to subparagraph (c) of the same provision, given the reputation which ÖKO-TEST enjoys on the German market, I am nonetheless of the view that proprietors of signs not having a reputation should have access to some form of legal instrument under trade mark law to enable them to take action against the use of their sign by third parties without their consent in circumstances such those at issue here. (27) An investigation of the differences between a quality seal and a quality label might come up with a more detailed answer than that offered by the judgment in Gözze.

41. As regards whether the situation at issue here is properly caught by the scenario provided for in subparagraph (a) or (b) of Article 9(2) of Regulation 2017/1001, there has been some inconsistency in the parties' interpretation of the first question. A better approach is to set out the criteria for determining whether the conditions of application common to both scenarios are met (28) in order then to determine which one is applicable.

### (a) Basis of adjudication

#### (1) Starting point

42. In principle, the proprietor of a registered trade mark may prohibit the use of a sign by a third party, pursuant to Article 9(2)(a) and (b) of Regulation 2017/1001, only where the following conditions are fulfilled:

– First, the sign must be identical with (29) or similar to the proprietor's registered trade mark;

– Secondly, use of the registered trade mark: (a) must occur in the course of trade; (b) must be without the consent of the trade mark proprietor; (c) must be in connection with goods or services identical with or similar to those for which the trade mark was registered; and (d) must adversely affect or be capable of adversely affecting one of the functions performed by the trade mark. (30)

43. It follows from the documents sent by the referring court that the (first) condition, relating to the identity of the sign, (31) should not pose any problems, given that

Dr. Liebe does not deny having used the ÖKO-TEST quality label on its toothpaste packaging.

44. In this regard, I am unconvinced by the German Government's view on the differences between the registered trade mark version of ÖKO-TEST and the emblem that features on Dr. Liebe's toothpaste packaging. The fact that, as it appears on that packaging, the trade mark includes within it the test results and a publication reference, is irrelevant, for two reasons: the first is that the public is used to seeing the ÖKO-TEST trade mark with those details (without them, there would be little if any value in its being featured on the product's advertising); and the second, which follows from the first, is that those differences would go unnoticed by the average consumer, inasmuch as they would not make him think that this is a different trade mark (although, as a point of fact, this is a matter for the referring court to examine). (32)

45. Neither is there any dispute as to the fulfilment of the conditions with respect to use in the course of trade and lack of consent on the part of the trade mark proprietor. The latter does not have to be a competitor of the product manufacturer: since Article 9(2) of Regulation 2017/1001 allows the proprietor of the trade mark to prohibit its use by 'all third parties' using it without the proprietor's consent, status as a competitor is not essential. The fact that subparagraphs (a) and (b) of that provision apply primarily to competitors does not mean that the legislature confined to them alone the right of action enjoyed by the trade mark proprietor.

46. It therefore remains to be determined whether there was any 'coincidence' between the goods and services and, once that question has been answered, whether the use of the ÖKO-TEST trade mark by Dr. Liebe was sufficient to adversely affect one of the characteristic functions of that trade mark.

### (2) Nature of the trade mark

47. The ÖKO-TEST quality label is a mark registered for services. Signs of this kind are different from those that designate goods on account of their non-material nature, which deprives them of a tangible foundation, unlike goods protected by trade marks. (33)

48. The non-material nature of services allows them to interact with goods. Where the properties of a product are affected by services, one may find service marks along with the trade marks for the goods so affected. This is true of the extended use of the seals and quality labels to which the German Government refers.

49. Trade marks for goods that feature labels (such as quality labels) will usually be found in contracts including a licence for use. These authorise the manufacturer, as licensee, to use the label on its products, thus enhancing their reputation. The quality label is used precisely in order to communicate to the public that such products, after having undergone the relevant tests, have been favourably rated by the quality label proprietor (in this case, Öko-Test Verlag).

50. Where the label is registered as a trade mark, the agreement will allow the licensee to affix it, as a trade mark, to its own products. That same agreement, however, also enables the trade mark proprietor to

make its own services known to the public, in a symbiosis favourable both to itself and to the various licensees. What is created, as I shall explain further when describing the characteristics of the quality label, is a form of 'dual use' agreement. (34)

51. In this way, Dr. Liebe can, if duly authorised, imprint the quality label as a trade mark on its own products; at the same time, however, the use of the ÖKO-TEST label on those products leads to a wider dissemination of the services which Öko-Test Verlag offers to undertakings and consumers.

### (3) Characteristics of the services provided by Öko-Test Verlag

52. Regulation 2017/1001 and Directive 2015/2436 make provision for collective marks (35) and certification marks: (36)

– Collective marks serve to differentiate goods or services of the members of the association which is the proprietor of the mark from those of other undertakings.

– Certification or guarantee marks fulfil their function as indications or origin where they distinguish 'goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics [...] from goods and services which are not so certified'. (37)

53. The quality label, although it bears certain similarities to certification marks, is not the same as these and is not provided for in any of the legislative texts cited. Generally speaking, the quality label can be registered as an individual mark by any undertaking whose business is the objective and independent evaluation of goods and which offers a broad range of economic operators the opportunity, in the form of a licensing agreement, to demonstrate the quality of their goods by using the logo of the undertaking concerned.

54. Those differences explain why it is difficult to require proprietors of quality labels to draw up regulations within the meaning of Article 75 of Regulation 2017/1001, since, for one thing, they are not members of an association that have a duty to comply with those regulations, as is the case with collective certification marks, and, for another, the undertaking that is the proprietor of the mark may vary at will the products subject to testing and the parameters of those tests.

55. The referring court points out the differences between quality labels and quality seals (such as that which was analysed in the judgment in *Gözze*), which are, in essence, that, in the case of quality labels: (a) the tests are extended to a broad range of goods and services and are not confined to just one; (b) the criteria are tailored to the needs of the consumer and the tests are regularly modified; (c) the organisation offering testing services is not under the influence of the producer; and (d) rather than authorisation to use the label being dependent on compliance with certain requirements, a rating is awarded on the basis of the test results. (38)

56. An undertaking whose products have been tested in this way is entitled, after concluding a licensing agreement for the use of the mark, to mention this fact in the description or packaging of its products. In the present case, if Dr. Liebe secured the consent of Öko-Test Verlag, it could legitimately place the ÖKO-TEST sign in a visible location on its toothpaste, together with the rating obtained and a reference to the number of the magazine in which the results were published. It seems only logical, as the Commission submits, that an undertaking whose products are tested by Öko-Test Verlag and which obtains a satisfactory result will have an interest in putting that label on its products as a means of advertising the virtues of its goods.

57. In printing the ÖKO-TEST label in a visible format on the packaging of Aminomed, Dr. Liebe seeks first and foremost to reinforce the message that this is a quality toothpaste through the reputation and reliability which the ÖKO-TEST trade mark bestows upon it, these being borne out by the rating ('very good') achieved and the reference to the magazine in which the test results were published. (39) At the same time, however, that same practice helps to communicate to consumers the reliability of the services provided by Öko-Test Verlag, which is to say that it helps to identify the business from which the activity of analysing and evaluating consumer goods originates.

58. Consequently, it cannot be submitted, as Dr. Liebe did at the hearing, that the ÖKO-TEST sign was used descriptively, within the meaning of recital 21 of Regulation 2017/1001, in the manner of further information about the product. I do not share that view, inasmuch as:

– The way in which that sign was employed demonstrates the intention to use the trade mark to identify the services provided by Öko-Test Verlag. If the intention had simply been to furnish information about the rating, this could have been conveyed without the need for the logo.

– The aforementioned recital permits descriptive uses provided that they are fair and honest, qualities which are difficult to discern where the consent that was originally obtained no longer exists.

59. In short, given the close relationship between the services provided by the undertaking awarding the quality label (ÖKO-TEST) and the products that carry it (Aminomed), the use of that label after it has been registered as an individual trade mark has two important effects from the point of view of Article 9(2)(a) and (b) of Regulation 2017/1001: first, the label reinforces the indication as to the quality of the products that are authorised to use it, and it can therefore be said to be used for those products; (40) secondly, it also serves to advertise the services of the undertaking that awards it. It is, in short, a manifestation of the dual use to which I referred previously.

#### **(4) Perception of the consumer**

60. The view of the average consumer and the way in which he or she perceives the trade mark are matters of fact which fall to be determined by the national court.

(41) The Court of Justice may nonetheless provide the national court with answers that will be useful to it in connection with the judgment it must give. (42)

61. Öko-Test Verlag, the German Government and the Commission (the latter with some qualifications) all agree that the public concerned will view the use of the ÖKO-TEST trade mark on the packaging of the toothpaste at issue as a reference to the independent services of the undertaking that is the proprietor of that trade mark (Öko-Test Verlag). The average consumer will therefore associate that sign at least with the services of 'consumer information and consultancy with regard to the selection of goods and services using test and investigation results' (class 35) and the services of 'conduct and assessment of science-based product testing and service reviews' (class 42).

62. It is common for the packaging of many consumer goods to carry quality labels and seals (or other forms of certification or indication of environmentally-friendly origin or fair trade). It follows that, in a situation such as that at issue, the average consumer will readily understand that the ÖKO-TEST trade mark as used by Dr. Liebe refers to the services provided by Öko-Test Verlag, with which he or she will associate the quality label. The way in which Dr. Liebe utilises that mark thus constitutes 'use as a trade mark', (43) inasmuch as it operates to guarantee that the service of analysing the quality of the toothpaste was carried out by the undertaking that is the proprietor of the trade mark, that is to say Öko-Test Verlag.

#### **(5) Adverse effect on the functions of the trade mark**

63. According to the settled case-law of the Court of Justice, the exclusive right of the proprietor of the trade mark enables him to protect his specific interests, that is, to ensure that the trade mark can fulfil its function. The exercise of that right must be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark, a mere threat of such harm being sufficient for these purposes. (44)

64. Amongst those functions is not only the (essential) function of identifying the origin of the product or service but also that of guaranteeing its quality, as well as those of communication, investment or advertising. (45)

65. As regards the essential function, the trade mark serves in particular to 'guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality'. (46)

66. Now, according to the statement of facts contained in the order for reference, Dr. Liebe used the trade mark without the consent of Öko-Test Verlag and the rating it used, although corresponding to the evaluation it obtained in 2005, could not have borne any relation to the 2008 analyses, since its toothpaste was not included in these. In those circumstances, the average consumer might think that Öko-Test Verlag was still endorsing the quality of the toothpaste product as meeting the previous standard certified by the quality label, when, in truth, that toothpaste no longer had that

endorsement because it had not been subjected to the new tests.

67. On that premiss, the use which Dr. Liebe made of the ÖKO-TEST trade mark was potentially misleading, since it gave the impression that the ‘very good’ rating had been obtained following tests carried out under the control of Öko-Test Verlag. The essential function of the trade mark (47) was thus distorted, since, although Öko-Test Verlag conducted the original tests, the rating that features on the toothpaste’s packaging does not correspond either to the most recent toothpaste analyses carried out by Öko-Test Verlag, which the latter published in its magazine, or to the licences awarded after those new analyses. (48)

68. What is more, the differences between the result publicised by Dr. Liebe via the ÖKO-TEST sign and the true account of the analyses as I have just set it out could tarnish the prestige achieved by Öko-Test Verlag through its trade mark, thus adversely affecting the function of investment (defined as being the possibility for the proprietor of a mark to employ it in order to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty). (49)

#### **(b) Conclusion**

69. As I have already made clear, I was minded not to opt at the outset for the inapplicability of either subparagraph (a) or (b) of Article 9(2) of Regulation 2017/1001. However, in the interests of providing the referring court with a useful answer, I would say that the explanations I have set out up to now lead me to the following conclusions:

– Dr. Liebe made dual use of a trade mark coincidental with the original (ÖKO-TEST), in order both to make its toothpaste more attractive by featuring the quality label (displaying the ‘very good’ rating), and to designate the services offered by Öko-Test Verlag. Inasmuch as there is therefore an identity of signs and services, the ‘double identity’ condition laid down in Article 9(2)(a) of Regulation 2017/1001 is fulfilled.

– In so far as the average consumer will not believe that the ÖKO-TEST trade mark indicates that the analysis of the Aminomed toothpaste was carried out by Dr. Liebe and, given that that trade mark is well known to the German public, will not believe either that the toothpaste comes from the same undertaking or from economically linked undertakings, any likelihood of confusion within the meaning of Article 9(2) of Regulation 2017/1001 is ruled out.

70. Given, moreover, the risk that Dr. Liebe’s use of the ÖKO-TEST trade mark will adversely affect, at the very least, the functions of indication of origin and investment performed by that mark, the conditions of application laid down in Article 9(2)(a) of Regulation 2017/1001 are met and that use can therefore be classified as being such as to infringe rights.

71. It should be taken into account, finally, that, since the list of the forms of use which the proprietor of a trade mark can prohibit, set out in Article 9(3) of Regulation 2017/1001, (50) is not exhaustive, Dr. Liebe’s use of the trade mark at issue may be included therein, on the basis described above.

#### **C. Second question: use of a trade mark with a reputation in a manner such as to infringe rights**

72. As I have suggested an answer in the affirmative to the first question and the referring court raises the second question only in the event that the answer to the first is in the negative, there is no essential need to proceed any further. I shall, nonetheless, address the second question in the alternative, in the event that the Court of Justice answers the first question differently or takes the view that my proposed finding as to the double identity of signs, on the one hand, and of services and products, on the other, is excessively artificial.

##### **1. Summary of the parties’ observations**

73. Öko-Test Verlag recalls that the special protection conferred on trade marks with a reputation goes beyond the scope of the identity or similarity of goods and is predicated on the impairment and improper exploitation of such marks. There is, it submits, no doubt that the ÖKO-TEST trade mark has a reputation and the public associates that mark with the sign which Dr. Liebe affixes to its products.

74. In the view of Öko-Test Verlag, and the Commission, the ÖKO-TEST trade mark is used in such a way as to infringe rights where the person using it is not authorised to do so, and to the extent that its use adversely affects the functions of that trade mark. Furthermore, there is a risk that the public will lose confidence in its services if the product disappoints expectations. Consumers might project their frustration on to Öko-Test Verlag’s work, as manifested in its tests and publications.

75. Given its answer in the affirmative to the first question, the German Government has not commented on the second, as this is raised in the alternative.

76. The Commission takes the view that the conditions of application laid down in Article 9(2)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 are fulfilled where the individual trade mark enjoys a reputation as a quality label. Use in such a way as to infringe rights for the purposes of those provisions includes the affixing of that trade mark to its own products by a third party.

77. The Commission recalls that the trade mark at issue must be known to a significant proportion of the German public concerned by the goods or services protected by it. (51) It considers that the way in which the ÖKO-TEST sign is used may lend it prestige as a trade mark. Through the licensing agreement, Öko-Test Verlag ensures that its trade mark enters the public consciousness as a reference to its consumer information and consultancy services.

##### **2. Assessment**

78. The referring court wishes to ascertain whether, in the absence of any protection that might have been afforded to the ÖKO-TEST trade mark on the basis of Article 9(2)(a) of Regulation 2017/1001, reliance might be placed on the protection of trade marks with a reputation that is available under subparagraph (c) of that same article.

79. The obstacle that appears to be standing in the way of the referring court is that the ÖKO-TEST individual trade mark is known only as a quality label and is used as such by the third party. I do not believe this to be relevant, however.

– So far as concerns any attempt to suggest that there was no ‘use as a trade mark’ within the meaning of the judgment in *Gözze*, I would refer, for the purposes of refuting that proposition, to my foregoing submissions. (52)

– So far as concerns any attempt, on the other hand, to differentiate between the public’s knowledge of the trade mark, on the one hand, and the ‘quality label’, on the other, this, in my opinion, is an artificial difference. ÖKO-TEST was registered as an individual trade mark at national and EU level and must therefore enjoy the protection afforded to this type of mark, whether or not the public is unaware of this fact and whether or not a third party is seeking to use the trade mark only as a quality label. Any other approach would deprive trade marks of their legitimate protection, which would come to depend on the extent to which the public is aware of their registration.

80. What the second question is essentially asking, therefore, is whether the proprietor of the ÖKO-TEST quality label can avail itself of the protection available to trade marks with a reputation in order to take action against the use of that label by a third party in such a way as to infringe rights. It will, of course, have to be found that that trade mark enjoys the reputation required, given the extent to which that label is known to German consumers. This is an assessment which falls to the referring court alone. (53)

81. Article 9(2)(c) of Regulation 2017/1001 establishes, for the benefit of trade marks with a reputation a wider form of protection than that laid down in Article 9(2)(a) and (b). The — cumulative (54) — conditions of benefiting from that protection are: (a) that a sign is being used which is identical with or similar to a registered mark; (b) that that use is being made without due cause; (c) that the sign is being used for goods or services, whether identical, similar or not similar; (55) and (d) that use of that sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark. (56)

82. There is no dispute as regards conditions (a), (b) and (c): use of the quality label by Dr. Liebe was made without the consent of Öko-Test Verlag, and therefore without due cause, and in connection with goods or services in respect of which there is no need to establish identity or similarity.

83. Consequently, it is necessary to ascertain only whether, in using the ÖKO-TEST trade mark, Dr. Liebe performed any (57) of the actions described in Article 9(2)(c) of Regulation 2017/1001. These may consist either in impairing the distinctive character of that mark, damaging the repute of that mark or taking unfair advantage of the distinctive character or the repute of that mark.

84. In my opinion, for the reasons I have given in points 66 to 68 of this Opinion, the use which Dr. Liebe made of the ÖKO-TEST trade mark may tarnish the prestige of that mark by creating in the mind of the consumer confusion such as to reduce the trade mark’s power of attraction. (58)

85. Furthermore, Dr. Liebe would derive an advantage from using the ÖKO-TEST trade mark without due cause, inasmuch as the favourable connotations projected by that trade mark in terms of advertising and quality, as mentioned above, would be transferred to its toothpaste, which was not subjected to the new tests. This would amount to an unfair exploitation of the trade mark’s reputation within the meaning of the case-law of the Court of Justice. (59)

86. In any event, it is for the referring court to assess whether the facts of the dispute in the main proceedings are characterised by the sign’s being used, without due cause, in order to take unfair advantage of the distinctive character or the repute of the ÖKO-TEST trade mark. (60)

## V. Conclusion

87. In the light of the foregoing, I propose that the Court’s answers to the questions referred for a preliminary ruling by the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) should be as follows:

*(1) Article 9(2)(a) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, and point (a) of the second sentence of Article 5(1) 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, authorise the proprietor of an individual trade mark made up of a ‘quality label’ and registered for ‘consumer information and consultancy with regard to the selection of goods and services, in particular using test and investigation results and by means of quality judgments’ to oppose uses of his trade mark which he has not authorised where:*

– *a third party affixes the trade mark to a product for which it is not registered;*

– *the public perceives the trade mark as a ‘quality label’, in the sense that the product has been manufactured and marketed by a third party and not by the proprietor of the trade mark, but the latter has subjected it to certain tests, evaluated it and awarded it a rating which is marked on the quality label; and*

– *the use adversely affects one of the functions of the trade mark.*

*(2) The use by a third party of an individual trade mark exhibiting the features described, without the proprietor’s consent, constitutes a use such as to infringe rights for the purposes of Article 9(2)(c) of Regulation 2017/1001 and Article 5(2) of Directive 2008/95 where:*

– *the trade mark has a reputation, even if only as a ‘quality label’; and*

– *the prestige of the trade mark is tarnished and the third party obtains an unfair advantage from using the*



*sign, a matter which falls to be determined by the referring court.*

[1] Original language: Spanish.

[2] Although most of the language versions examined have translated the German ‘Testsiegel’ by reference to the word ‘test’ (‘label de test’ in French, ‘test seal’ in English, ‘sigillo di test’ in Italian, ‘testlabel’ in Dutch and ‘selo de teste’ in Portuguese), I shall use the term ‘quality label’, which I consider to be more appropriate. Öko-Test Verlag GmbH made clear at the hearing that it carries out comparative analyses of the products concerned rather than individual analyses of their intrinsic properties. Following that comparison, it gives each of the products in question a rating based on performance against certain predetermined quality criteria.

[3] Directive 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). Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 336, p. 1), the title of which is identical to the previous directive, amended the latter but is not applicable to this case *ratione temporis*.

[4] The version applicable here is, in principle, Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1). There is a later version, codified in Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1), which has a bearing *ratione temporis* on the facts of the dispute in so far as they concern the action for a prohibitory injunction and will therefore be the material version in this Opinion.

[5] This corresponds in essence to Article 9(1) to (3) of Regulation No 207/2009, including the amendments introduced by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

[6] Law on the protection of trade marks and other distinctive signs of 25 October 1994 (BGBl. I, p. 3082; 1995 I, p. 156; 1996 I, p. 682), as last amended by Paragraph 11 of the Law of 17 July 2017 (BGBl. I, p. 2541).

[7] Given the identity between the signs registered, at national and EU level, by Öko-Test Verlag, I shall henceforth refer to ‘the trade mark’, although it may on occasion be necessary to distinguish between them, in which event I shall refer to ‘the national trade mark’ or ‘the EU trade mark’.

[8] In accordance with the Nice Agreement Concerning the International Classification of Goods and Services

for the purposes of the Registration of Marks of 15 June 1957, as amended on 28 September 1979.

[9] According to the referring court, this requirement derives from the German case-law on unfair competition, which makes the lawfulness of advertising based on test results subject to an indication of their source.

[10] There is no consensus between the parties to the dispute in the main proceedings as to the application of this clause.

[11] ‘Dr. Liebe’.

[12] Article 83 et seq. of Regulation 2017/1001 and, for the purposes of the national certification mark, Article 27 et seq. of Directive 2015/2436.

[13] Judgment of 8 June 2017, *W. F. Gözze Frottierweberei and Gözze* (C-689/15, ‘the judgment in Gözze’, EU:C:2017:434, paragraph 45 et seq.).

[14] It is referring to the judgments of 23 March 2010, *Google France and Google* (C-236/08 to C-238/08, EU:C:2010:159), and of 25 March 2010, *Die BergSpechte* (C-278/08, ‘the judgment in BergSpechte’, EU:C:2010:163).

[15] It has in mind the judgment of 23 October 2003, *Adidas-Salomon and Adidas Benelux* (C-408/01, EU:C:2003:582).

[16] Paragraph 8 of the order for reference.

[17] Nonetheless, I shall, where necessary, refer specifically to the provisions of Directive 2015/2436.

[18] Paragraph 10 of the order for reference. The fact remains, however, that, at the hearing, Dr. Liebe reaffirmed that, in its view, the agreement was still in force at the material time.

[19] Paragraph 8 of the *Gesetz gegen den unlauteren Wettbewerb* (German Law on unfair competition) of 3 July 2004, in the version contained in the notice of 3 March 2010 (BGBl. I, p. 254), as last amended on 17 February 2016 (BGBl. I, p. 233), does not confer standing to bring legal proceedings on competitors. Dr. Liebe and Öko-Test Verlag operate in different markets.

[20] Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1).

[21] This will be the case, a priori, if an interpretation of the contract is necessary in order to establish the lawfulness or unlawfulness of the conduct of which the defendant is accused, the investigation of whether that is the case being a matter for the referring court. See the judgments of 13 March 2014, *Brogstetter* (C-548/12; EU:C:2014:148, paragraphs 23 to 25), and of 14 July 2016, *Granarolo* (C-196/15; EU:C:2016:559, paragraphs 21 and 22).

[22] Judgment of 18 April 2013, *Commission v Systran and Systran Luxembourg* (C-103/11 P, EU:C:2013:245, paragraph 66), and Opinion of Advocate General Cruz Villalón in that case (EU:C:2012:714, points 49 and 50). In that case, notwithstanding that the contracts had come to an end, the Court of Justice declared that the EU judicature

lacked jurisdiction to hear and determine the claim for non-contractual liability precisely because of the contractual context, an examination of which was necessary in order to resolve the dispute.

[23] Öko-Test Verlag stated that this was the sign it used to license before making various modifications to it in order to modernise and unify it.

[24] Governed both by Article 27 of Directive 2015/2436 and by Article 83 of Regulation 2017/1001, cited in footnotes 2 and 4 respectively of this Opinion.

[25] Judgments of 18 June 2009, *L'Oréal and Others* (C-487/07, EU:C:2009:378, paragraph 58); of 23 March 2010, *Google France and Google* (C-236/08 to C-238/08, EU:C:2010:159, paragraphs 49, 77 and 79); and of 22 September 2011, *Interflora and Interflora British Unit* (C-323/09, EU:C:2011:604, paragraph 38).

[26] Paragraph 46.

[27] At the hearing, the German Government expressed the same view, arguing that protection would otherwise be afforded only to trade marks with a reputation, lesser known and new trade marks being left without any protection at all.

[28] For these purposes, I shall use the term 'coincidence', which is more in keeping with a combined analysis of the two subparagraphs of the provision in question and, moreover, avoids use of the terms 'identical' and 'similar'.

[29] Subparagraph (a) provides that the trade mark and the goods must be identical, not similar (this is usually called the condition of 'double identity').

[30] Judgment of 22 September 2011, *Interflora and Interflora British Unit* (C-323/09, EU:C:2011:604, paragraphs 33 and 34 and the case-law cited). Subparagraph (b) of the provision at issue nonetheless requires that there should be a 'likelihood of confusion' between the conflicting signs, from which the Court of Justice has inferred that it need only be examined whether the essential function of the trade mark is adversely affected (judgment in *BergSpechte*, paragraph 22).

[31] The identity of one sign with the other where the latter includes the use of the same registered trade mark. See the judgment of 23 February 1999, *BMW* (C-63/97, EU:C:1999:82, paragraph 38). Although not expressly mentioned there, this also follows from the context of the judgment of 25 January 2007, *Adam Opel* (C-48/05, EU:C:2007:55).

[32] Judgment of 8 July 2010, *Portakabin* (C-558/08, EU:C:2010:416, paragraphs 47 and 48 and the case-law cited).

[33] The Court has recognised both types of mark as enjoying the same protection, in the absence of any express indication in Regulation 2017/1001 that might represent a restriction of the protection afforded to services. See the judgment of 16 July 2009, *American Clothing Associates v OHIM and OHIM v American Clothing Associates* (C-202/08 P and C-208/08 P, EU:C:2009:477, paragraphs 75 to 78); and the Opinion

of Advocate General Ruiz-Jarabo Colomer in that case (EU:C:2009:299, points 111 to 114).

[34] The term usually used to describe goods amenable to use for both military and civil purposes.

[35] Article 74 et seq. of Regulation 2017/1001 and Articles 27 and 29 of Directive 2015/2436.

[36] Article 83 et seq. of Regulation 2017/1001 and Articles 27 and 28 of Directive 2015/2436. Article 27 of that directive treats the concepts of certification mark and guarantee mark as being one and the same.

[37] Judgment in *Gözze*, paragraph 50.

[38] Paragraph 14 of the order for reference. The German Government rules out the possibility of extrapolating the ruling given in that judgment to the present dispute, on account of both the differences identified by the referring court and the fact that that judgment is primarily concerned with the interpretation of Article 15 of Regulation No 207/2009.

[39] Dr. Liebe is not looking to be regarded as the author of the quality label, which would be counterproductive for it, since it would diminish the impact of the rating on the consumer.

[40] This is at least in part consistent with case-law, in particular that concerning Article 9(2)(a) of Regulation 2017/1001; see the judgment of 23 March 2010, *Google France and Google* (C-236/08 to C-238/08, EU:C:2010:159, paragraph 60 and the case-law cited).

[41] Judgments of 16 November 2004, *Anheuser-Busch* (C-245/02, EU:C:2004:717, paragraphs 60 and 61), and of 25 January 2007, *Adam Opel* (C-48/05, EU:C:2007:55, paragraph 25).

[42] Judgment of 5 June 2014, I (C-255/13, EU:C:2014:1291, paragraph 55 and the case-law cited).

[43] This is an unwritten condition of application; see the order of 19 February 2009, *UDV North America* (C-62/08, EU:C:2009:111, paragraph 42).

[44] Judgment in *BergSpechte*, paragraph 29 and the case-law cited.

[45] Judgment of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe* (C-129/17, EU:C:2018:594, paragraph 34 and the case-law cited).

[46] Judgments of 12 November 2002, *Arsenal Football Club* (C-206/01, EU:C:2002:651, paragraph 48), and of 12 July 2011, *L'Oréal and Others* (C-324/09, EU:C:2011:474, paragraph 80).

[47] See the definition of this function in the judgment of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe* (C-129/17, EU:C:2018:594, paragraph 35).

[48] It might be thought that this use also affected the function performed by the ÖKO-TEST trade mark as a guarantee of quality. However, I concur with Advocate General Wathelet that this is a consequence of the function as an indication of origin, since the guarantee of quality is linked to the product's origin (Opinion in *Gözze*, C-689/15, EU:C:2016:916, points 62 to 64).

[49] On the function of investment, see the judgment of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi*

Caterpillar Forklift Europe (C-129/17, EU:C:2018:594, paragraph 36).

[50] And the corresponding Article 5(3) of Directive 2008/95.

[51] It cites the judgment of 14 September 1999, General Motors (C-375/97, EU:C:1999:408, paragraph 31).

[52] Points 47 to 62 of this Opinion.

[53] Judgment of 6 October 2009, PAGO International (C-301/07, EU:C:2009:611, paragraphs 24 and 25).

[54] Judgment of 10 December 2015, El Corte Inglés v OHIM (C-603/14 P, EU:C:2015:807, paragraph 38).

[55] Judgment of 6 February 2014, Leidseplein Beheer and de Vries (C-65/12, EU:C:2014:49, paragraph 34).

[56] Judgment of 18 June 2009, L'Oréal and Others (C-487/07, EU:C:2009:378, paragraphs 34 and 35 and the case-law cited).

[57] Judgment of 22 September 2011, Interflora and Interflora British Unit (C-323/09, EU:C:2011:604, paragraph 72 and the case-law cited).

[58] Judgment of 18 June 2009, L'Oréal and Others (C-487/07, EU:C:2009:378, paragraph 40).

[59] Judgment of 18 June 2009, L'Oréal and Others (C-487/07, EU:C:2009:378, paragraph 41).

[60] Judgment of 20 July 2017, Ornuo (C-93/16, EU:C:2017:571, paragraph 58 and the case-law cited).