

European Court of Justice, 7 July 2005, *Praktiker v Deutsche Patent- und Markenamt*



TRADEMARK LAW

Services

- The concept of ‘services’ referred to by the directive, in particular in Article 2, covers services provided in connection with retail trade in goods.
- For the purposes of registration of a trade mark for such services, it is not necessary to specify the actual service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.

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European Court of Justice, 7 July 2005

(C.W.A. Timmermans, C. Gulmann, R. Schintgen, N. Colneric and J.N. Cunha Rodrigues)

JUDGMENT OF THE COURT (Second Chamber)

7 July 2005 (*)

(Trade marks – Directive 89/104/EEC – Trade marks in respect of services – Registration – Services provided in connection with retail trade – Specification of content of services – Similarity between the services in question and goods or other services)

In Case C-418/02,

REFERENCE for a preliminary ruling under Article 234 EC from the Bundespatentgericht (Germany), made by decision of 15 October 2002, received at the Court on 20 November 2002, in the proceedings

Praktiker Bau- und Heimwerkermärkte AG,

THE COURT (Second Chamber),

composed of C.W.A. Timmermans, President of the Chamber, C. Gulmann (Rapporteur), R. Schintgen, N. Colneric and J.N. Cunha Rodrigues, Judges,

Advocate General: P. Léger,

Registrar: M. Múgica Arzamendi, Principal Administrator,

having regard to the written procedure and further to the hearing on 1 July 2004,

after considering the observations submitted on behalf of:

– Praktiker Bau- und Heimwerkermärkte AG, by M. Schaeffer, Rechtsanwalt,

– the French Government, by G. de Bergues and A. Bodard-Hermant, acting as Agents,

– the Austrian Government, by E. Riedl, acting as Agent,

– the United Kingdom Government, by K. Manji, acting as Agent, and M. Tappin, Barrister,

– the Commission of the European Communities, by N.B. Rasmussen and S. Fries, acting as Agents,

after hearing the [Opinion of the Advocate General at the sitting on 13 January 2005](#),

gives the following

Judgment

1 The reference for a preliminary ruling concerns the interpretation of Articles 2, 4(1)(b) and 5(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1, ‘the directive’).

2 That reference was made in proceedings between Praktiker Bau- und Heimwerkermärkte AG (‘Praktiker Märkte’) and the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) concerning the registration of a trade mark in respect of services provided in connection with retail trade.

Law

3 Article 2 of the directive provides:

‘A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

4 Article 4(1) of that directive states:

‘A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.’

5 Article 5(1) provides:

‘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, which includes the likelihood of association between the sign and the trade mark.’

6 The 12th recital in the preamble to the directive states that it is necessary that its provisions are entirely consistent with those of the Convention for the Protection of Industrial Property, signed at Paris on 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (United Nations Treaty Series, vol. 828, No 11851, p. 305, ‘the Paris Convention’), which is binding on all the Member States of the Community.

7 The Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended ('the Nice Agreement'), was concluded on the basis of Article 19 of the Paris Convention, which reserves for the countries of the Union the right to make separately between themselves special agreements for the protection of industrial property.

8 In the classification which it establishes ('the Nice Classification'), Class 35, relating to services, is headed as follows:

'Advertising;
business management;
business administration;
office functions.'

9 The Explanatory Note relating to that class states:

'...

This Class includes, in particular:

– the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods;

...

This Class does not include, in particular:

– activity of an enterprise the primary function of which is the sale of goods, i.e., of a so-called commercial enterprise;

...'

10 Article 2 of the Nice Agreement states:

'(1) Subject to the requirements prescribed by this Agreement, the effect of the Classification shall be that attributed to it by each country of the Special Union. In particular, the Classification shall not bind the countries of the Special Union in respect of either the evaluation of the extent of the protection afforded to any given mark or the recognition of service marks.

(2) Each of the countries of the Special Union reserves the right to use the Classification either as a principal or as a subsidiary system.

(3) The competent Office of the countries of the Special Union shall include in the official documents and publications relating to registrations of marks the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong.

...'

The main proceedings and the questions referred for a preliminary ruling

11 Praktiker Märkte filed for registration with the Deutsches Patent- und Markenamt the mark Praktiker in relation to, inter alia, the service described as 'retail trade in building, home improvement, gardening and other consumer goods for the do-it-yourself sector'.

12 The Deutsches Patent- und Markenamt rejected that application. It considered that the concept of 'retail trade' claimed did not denote independent services having autonomous economic significance. That concept related only to the distribution of goods as such. The economic activities which formed the core of goods

distribution, in particular the purchase and sale of goods, were not services for which a trade mark could be registered. Trade-mark protection could be achieved only by applying for registration of a trade mark in respect of the goods distributed in each case.

13 Praktiker Märkte brought an appeal before the Bundespatentgericht (Federal Patents Court) against the decision rejecting its application. It argued inter alia that the economic trend towards a service society necessitated a re-appraisal of retail trade as a service. The consumer's purchasing decision would increasingly be influenced not only by the availability and price of a product, but also by other aspects such as the variety and assortment of goods, their presentation, the service provided by staff, advertising, image and the location of the store, etc. Such services provided in connection with retail trade enabled retailers to be distinguishable from their competitors. Such services ought to be eligible for protection by service trade marks. Trade-mark protection was now accepted in relation to the services provided by a retailer, not only by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM'), but also by the majority of Member States. A uniform assessment of this question within the Community was imperative.

14 Against that background, the Bundespatentgericht decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

'1. Does retail trade in goods constitute a service within the meaning of Article 2 of the directive?

If the answer to this question is in the affirmative:

2. To what extent must the content of such services provided by a retailer be specified in order to guarantee the certainty of the subject-matter of trade-mark protection that is required in order to:

(a) fulfil the function of the trade mark, as defined in Article 2 of the directive, namely, to distinguish the goods or services of one undertaking from those of other undertakings, and

(b) define the scope of protection of such a trade mark in the event of a conflict?

3. To what extent is it necessary to define the scope of similarity (Article 4(1)(b) and Article 5(1)(b) of the directive) between such services provided by a retailer and

(a) other services provided in connection with the distribution of goods, or

(b) the goods sold by that retailer?'

15 The referring court points out that Article 2 of the directive does not contain any definitions of the terms 'goods' and 'services' which it uses.

16 In that court's view, the core of the independent activity of a retailer, by which he comes into direct competition with other traders and for which separate protection of a service trade mark could be necessary, remains the specific activities of a trader which make distribution of goods possible, without being confined to carrying out such distribution. They include bringing together goods from a variety of undertakings to form a range and offering them for sale from a single distribu-

tion entity, whether by way of traditional retailing, mail order or e-commerce. Even if those services are not charged separately to individual customers, they can nevertheless be considered to be provided for remuneration, through the profit margin.

17 However, in the opinion of the Bundespatentgericht, for the function of the trade mark as an indication of origin to be fulfilled, the subject-matter of the protection conferred must be determined with sufficient precision. General concepts such as 'retail services' do not satisfy the requirement of certainty in relation to exclusive rights. Restrictions confining such protection only to the goods distributed do not overcome the indeterminate nature of the words 'retail trade' in the individual sector concerned. They leave open the question of what services are covered, apart from the mere sale of those goods. Similar objections can be raised with regard to the provision of details relating to the type of sales location, such as 'department store' or 'supermarket', for example.

18 The need for a restriction, when registering trade marks, of the content of 'services provided by a retailer' applies to an even greater extent to the interpretation of 'likelihood of confusion' in Article 4(1)(b) and Article 5(1)(b) of the directive. Even a reasonable specification, at the time of the registration procedure, of the content of 'services provided by a retailer' would ultimately prove insufficient if the service trade mark registered were to be granted a scope of protection which was not capable of review as a result of a wide interpretation of 'similarity of [the] goods or services'.

The questions referred for a preliminary ruling

The first two questions

19 By its first two questions, which must be considered together, the Bundespatentgericht seeks in essence to ascertain whether the concept of 'services' referred to by the directive, in particular in Article 2, is to be interpreted as including services provided in connection with retail trade in goods and, if so, whether the registration of a service trade mark in respect of such services is subject to the specification of certain details.

Observations submitted to the Court

20 Praktiker Märkte submits that retail trade in goods constitutes a service within the meaning of the directive. A trade mark protecting it as a service is capable of fulfilling the function of the trade mark as an indication of origin. It is not necessary to specify the content of the services provided in order to determine the subject-matter of protection.

21 The French Government stated at the hearing that it now accepts that certain specific services ancillary to retailing, the content of which would have to be specified, may constitute services separate from selling and may therefore be eligible for trade-mark protection.

22 The Austrian Government submits that the central core of retail trade, namely the sale of goods, is not a service capable of forming the subject-matter, as such, of trade-mark protection, as is confirmed, in its view, by the Explanatory Note to Class 35 of the Nice Classification. Only services provided over and above

that central core, the content of which would have to be specified, could give rise to registration of a service trade mark.

23 The United Kingdom Government submits that a trade mark can properly be registered for a service if consumers are provided, by reference to that trade mark, with an identifiable service over and above mere trade in goods. The Explanatory Note to Class 35 in the Nice Classification confirms that mere sale of goods does not constitute an identifiable service, but that aspects of the retail activity relating to the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods, can constitute a service eligible for protection by a trade mark. For the purpose of registering such a trade mark, the aspects of the activity constituting the service as well as the sector(s) of retail activity covered should be specifically stated in order to guarantee the certainty of the subject-matter of protection.

24 The Commission submits that retail trade in goods constitutes a service within the meaning of the directive where the conditions of Article 50 EC are satisfied. Protection by a service trade mark may apply to any activities which are not pure selling. It is not possible to list exhaustively all the services in question. They may include arrangement of the goods, the site, general ease of use, the attitude and commitment of staff, and customer care.

25 In the Commission's view, the question of specification of the content of services arises, from a formal legal point of view, with respect to registration of the trade mark. That question is a matter for the Member States, as is clear from the fifth recital in the preamble to the directive, according to which it is for Member States to determine the provisions of procedure concerning registration, namely, for example, the form of registration procedures. In that regard, only Class 35 of the Nice Classification can be contemplated for the registration of a trade mark for retail trade. The Nice Agreement does not, for its part, lay down any conditions concerning description of the service.

Reply of the Court

26 It follows from the first recital in the preamble to the directive that the purpose of the latter is to approximate the laws of the Member States in order to remedy disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market.

27 Under Article 1, the directive applies to 'every trade mark in respect of goods or services'.

28 It does not contain a definition of 'services', which Article 50 EC describes as 'normally provided for remuneration'.

29 Nor does it specify the conditions to which registration of a trade mark for a service is subject, where such registration is provided for by national legislation.

30 In that regard, it should be noted that the fifth recital in the preamble to the directive states that Member States remain free to fix the provisions of procedure concerning the registration of trade marks, in order, for example, to determine the form of registration proce-

dures. The seventh recital nevertheless emphasises that attainment of the objectives sought by the approximation of laws requires that the conditions for obtaining a registered trade mark be, in general, identical in all Member States.

31 However, determination of the nature and content of the service eligible for protection by a registered trade mark is subject, not to the provisions on registration procedures, but to the substantive conditions for acquiring the right conferred by the trade mark.

32 If the concept of ‘services’ were a matter for the Member States, conditions for the registration of service trade marks could vary according to the national legislation concerned. The objective that acquisition of the right in the trade mark should be subject to ‘conditions ... identical’ in all Member States would not be attained.

33 It therefore falls to the Court to supply a uniform interpretation of the concept of ‘services’ within the meaning of the directive (see, by analogy, [Joined Cases C-414/99 to C-416/99 Zino Davidoff and Levi Strauss \[2001\] ECR I-8691](#), paragraphs 42 and 43).

34 In that regard, it should be noted that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.

35 No overriding reason based on the directive or on general principles of Community law precludes those services from being covered by the concept of ‘services’ within the meaning of the directive or, therefore, the trader from having the right to obtain, through the registration of his trade mark, protection of that mark as an indication of the origin of the services provided by him.

36 That consideration is illustrated by the Explanatory Note to Class 35 of the Nice Classification, according to which that class includes ‘the bringing together, for the benefit of others, of a variety of goods ... enabling customers to conveniently view and purchase those goods’.

37 With regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), it must be observed that OHIM now accepts that the services provided by retail undertakings are, as such, eligible for registration as Community trade marks and that they will fall under Class 35 of the Nice Classification (see Communication No 3/01 of the President of [OHIM] of 12 March 2001 concerning the registration of Community trade marks for retail services).

38 Moreover, it must be noted that, firstly, all the parties concerned which have submitted observations to the Court have accepted that at least certain services provided in connection with retail trade can constitute services within the meaning of the directive and that,

secondly, according to the information before the Court, such an analysis underlies a practice now widely adopted in the Member States.

39 Consequently, it must be concluded that the concept of ‘services’ within the meaning of the directive includes services provided in connection with retail trade in goods.

40 The question arises as to whether, in the particular case of the retail trade, the concept of ‘services’ within the meaning of the directive needs further specification.

41 In that regard, in the observations submitted to the Court, it was maintained that the services eligible for protection as retail services should be identified in a way which distinguishes them from services which, being closely connected with the sale of goods, could not give rise to registration of a trade mark. It was pointed out, moreover, that the application for registration of the trade mark should specify in detail the service(s) for which the applicant seeks protection.

42 It is argued that such details are necessary, in particular, to safeguard the essential function of the trade mark, namely, as the guarantee of the identity of the origin of the goods or services covered by the trade mark, and to prevent trade marks for retail services from being afforded over-wide and indeterminate protection.

43 The difficulty of the questions thus raised is illustrated by the different answers proposed by the parties which submitted observations and by the information available to the Court regarding the current practices of the Member States.

44 For the reasons set out below, there is no need to rely on a definition of ‘retail services’ for the purposes of the directive which is more restrictive than that which follows from the description contained in paragraph 34 of this judgment.

45 It must first be stated that any distinction between the various categories of services provided with the sale of goods which involved a more restrictive definition of ‘retail services’ would prove artificial in the light of the reality of the important economic sector represented by retail trade. It would inevitably raise difficulties both as regards the general definition of the criteria to be adopted and as regards the application of those criteria in practice.

46 Admittedly, a more restrictive definition of ‘retail services’ would reduce the protection afforded to the proprietor of the trade mark, so that questions concerning the application of Articles 4(1) and 5(1) of the directive would arise less often.

47 However, that is not sufficient to justify a restrictive interpretation.

48 There is nothing to indicate that any problems resulting from the registration of trade marks for retail services could not be resolved on the basis of the two relevant provisions of the directive, as they have been interpreted by the Court. In that regard, it should be recalled that, according to the Court’s case-law, the likelihood of confusion must be assessed globally, taking into account all the factors relevant to the

circumstances of the case (see [Case C-251/95 SABEL \[1997\] ECR I-6191](#), paragraph 22, and [Case C-39/97 Canon \[1998\] ECR I-5507](#), paragraph 16). In the context of that global assessment, it is possible to take into consideration, if need be, the particular features of the concept of ‘retail services’ that are connected with its wide scope, having due regard to the legitimate interests of all interested parties.

49 In those circumstances, for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service(s) for which that registration is sought. To identify those services, it is sufficient to use general wording such as ‘bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods’.

50 However, the applicant must be required to specify the goods or types of goods to which those services relate by means, for example, of particulars such as those contained in the application for registration filed in the main proceedings (see paragraph 11 of this judgment).

51 Such details will make it easier to apply Articles 4(1) and 5(1) of the directive without appreciably limiting the protection afforded to the trade mark. They will also make it easier to apply Article 12(1) of the directive, which states that ‘[a] trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the ... services in respect of which it is registered, and there are no proper reasons for non-use’.

52 The answer to the first two questions referred for a preliminary ruling must therefore be that the concept of ‘services’ referred to by the directive, in particular in Article 2, covers services provided in connection with retail trade in goods.

For the purposes of registration of a trade mark for such services, it is not necessary to specify the actual service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.

The third question

53 By its third question, the referring court seeks, in essence, to ascertain whether the concept of ‘similarity’ referred to in Articles 4(1)(b) and 5(1)(b) of the directive, giving rise, in some circumstances, to a likelihood of confusion within the meaning of those provisions, must be interpreted by reference to specific restrictive criteria with regard to service trade marks protecting services provided in connection with retail trade in goods.

54 It is apparent from the order for reference that, in the main proceedings, the application for registration of the trade mark Praktiker in respect of retail services was refused on the ground that the definition claimed, ‘retail trade’, did not denote services eligible for registration as a trade mark.

55 The reference for a preliminary ruling does not contain any indication that the referring court could find it necessary to rule on the concept of ‘similarity’

referred to in Articles 4(1)(b) and 5(1)(b) of the directive in connection with a likelihood of confusion within the meaning of those provisions.

56 Consequently, those provisions, while relevant for the purposes of answering the first two questions, are not relevant in the context of the third question.

57 The Court has no jurisdiction to answer questions referred for a preliminary ruling where it is obvious that the interpretation of Community law sought bears no relation to the actual facts of the main proceedings or to their purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted (see, in particular, [Case C-421/01 Traunfellner \[2003\] ECR I-11941](#), paragraph 37).

58 In those circumstances, the third question referred for a preliminary ruling must be held to be hypothetical in the light of the main proceedings and, accordingly, must be declared inadmissible.

Costs

59 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 (Second Chamber) hereby rules:

1. The concept of ‘services’ referred to by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, in particular in Article 2, covers services provided in connection with retail trade in goods.

2. For the purposes of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.

OPINION OF ADVOCATE GENERAL LÉGER

delivered on 13 January 2005 (1)

Case C-418/02

Praktiker Bau- und Heimwerkermärkte AG

(Reference for a preliminary ruling from the Bundespatentgericht (Germany))

(Trade marks – Directive 89/104/EEC – Service marks – Services supplied in connection with the retail sale of goods – Registration – Specification of the nature of such services and of the goods to which they apply – Similarity of such services and the goods sold or services provided in the general context of the sale of goods)

1. Trade mark law has undergone significant development in recent years led by business undertakings, which is a good indication of the importance of trade marks in our modern, so-called ‘consumer’ society. After the extension of signs capable of constituting marks

to a scent, a sound and one or more colours in themselves, without shape or delineation, (2) the Court is confronted in the present case with a further evolution in trade mark law, sought by retailing companies.

2. This time it is necessary to determine whether, and if so on what conditions, a mark may be registered for retailing services. Thus, the Bundespatentgericht (Germany) asks whether ‘retail trading’ may constitute a service within the meaning of Article 2 of First Council Directive 89/104/EEC, (3) and if so on what conditions a mark for such a service may be registered.

I – The legal context

A – The international agreements concerning trade mark law

1. The Paris Convention

3. The Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883 and last revised at Stockholm on 14 July 1967, (4) is the legal reference framework to which the States parties to the Convention undertook to adhere for the protection of marks. All the Member States of the European Community (‘the Member States’) are parties to the Convention. (5)

4. Article 6 *sexies* of the Paris Convention, which was adopted at the conference for revising the Convention held at Lisbon in 1958, is worded as follows:

‘The countries [to which the Convention applies] undertake to protect service marks. They shall not be required to provide for the registration of such marks.’ (6)

2. The Nice Agreement

5. The Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, revised at Stockholm on 14 July 1967 and at Geneva on 13 May 1977 and amended on 28 September 1979, (7) falls within the framework of the agreements which the parties to the Paris Convention reserved the right to make between themselves in Article 19 of the Convention. (8) The Nice Agreement has the object of facilitating the registration of marks by means of a common classification of goods and services for which a mark is registered. (9)

6. The Nice Classification comprises a list of headings of 34 classes of goods and 11 classes of services. The goods and services falling within the different classes are described therein in general terms. The headings are usually accompanied by explanatory notes. The Nice Classification also includes an alphabetical list of approximately 10 000 products and 1 000 services. The Classification is regularly revised by a committee of experts established by the Nice Agreement. The version in force at the time of the relevant facts in the main proceedings was the seventh edition, published in 1996. It was replaced by the eighth edition, which was published in June 2001 and took effect on 1 January 2002.

7. Class 35 of the Nice Classification is described in the following terms, which are the same in both the abovementioned versions:

‘Advertising;

business management;
business administration;
office functions.

Explanatory note

...

This class includes in particular:

...

– the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods;

This class does not include, in particular:

– the activity of an enterprise the primary function of which is the sale of goods, i.e., of a so-called commercial enterprise;

...’

8. Article 2 of the Nice Agreement defines the legal effect and use of the Nice Classification. It is worded as follows:

‘(1) Subject to the requirements prescribed by this Agreement, the effect of the Classification shall be that attributed to it by each country of the Special Union. In particular, the Classification shall not bind the countries of the Special Union in respect of either the evaluation of the extent of the protection afforded by any given mark or the recognition of service marks.

(2) Each of the countries of the Special Union reserves the right to use the Classification either as a principal or as a subsidiary system.

(3) The competent Offices of the countries of the Special Union shall include in the official documents and publications relating to registrations of marks the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong.

(4) The fact that a term is included in the alphabetical list in no way affects any rights which might subsist in such a term.’

9. The Member States are parties to the Nice Agreement, with the exception of Cyprus and Malta.

(10) The Nice Classification must be used in applications for and the registration of Community marks. (11) It is also used for the international registration of marks by the International Office of WIPO, by virtue of the Madrid Agreement concerning the International Registration of Marks of 14 April 1891, last revised at Stockholm in 1967 and amended on 28 September 1979, (12) and of the Protocol relating to the Madrid Agreement.(13)

B – Community law

10. The purpose of the Directive is to lay down the same conditions for obtaining and continuing to hold a registered trade mark in all Member States in order to abolish disparities in the laws of the Member States which may impede the free movement of goods and freedom to provide services and may distort competition within the common market. (14) According to the twelfth recital in the preamble, the provisions of the Directive must be entirely consistent with those of the Paris Convention and they must not affect the obliga-

tions resulting from the Convention for the States which are parties to it.

11. Article 1 of the Directive provides that it 'shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Trade Mark Office or of an international registration having effect in a Member State'.

12. Article 2 of the Directive specifies the signs which are capable of constituting a trade mark. It is worded as follows:

'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

13. Article 4 of the Directive deals with the grounds for refusing registration of a mark and the causes of invalidity of a registered mark in the event of conflict with an earlier mark. It provides as follows:

'A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

- (a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;
- (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.'

14. Article 5 lays down the rights conferred by the trade mark. It provides as follows:

'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, which includes the likelihood of association between the sign and the trade mark.'

15. In order to complete the internal market, the Regulation aims to establish, side by side with national trade marks, a Community mark which is acquired by means of one procedural system, which has uniform protection and which produces effect throughout the territory of the Member States. (15) The registration and administration of the Community mark are to be carried out by the Office for Harmonisation in the Internal Market (Trade Marks and Designs). (16)

16. The Regulation contains, in Articles 4, 8 and 9, provisions similar to those of Articles 2, 4, and 5 of the Directive.

C – National law

17. The Gesetz über den Schutz von Marken und sonstigen Kennzeichen (German Law on the Protection of Trade Marks and Other Identification Marks) of 25 October 1994, (17) contained in Article 1 of the Gesetz zur Reform des Markenrechts and zur Umsetzung der Ersten Richtlinie (German Law Reforming Trade Mark Law and Implementing the First Directive), which entered into force on 1 January 1995, aims to implement the First Directive in German national law.

18. The provisions of Articles 2, 4(1) and 5(1) of the Directive are taken up in Paragraphs 3(1), 9(1) and 14(2) of the Markengesetz.

II – The main proceedings and the questions referred for a preliminary ruling

19. On 19 March 2001 Praktiker Bau- und Heimwerkermärkte AG (18) applied to the competent German Patent and Trade Mark Office for the registration of the mark 'Praktiker', represented graphically and in colour, for a service described as follows: 'retail trade in building, home improvement, gardening and other consumer goods for the do-it-yourself sector'.

20. The German Patent Office refused the application on the ground that the term 'retail trading' did not denote independent services of autonomous economic significance, but only related to the retailing of goods as such. According to the Office, protection under trade-mark law can be obtained only by the registration of a trade mark covering the different products marketed.

21. Praktiker appealed against this decision to the Bundespatentgericht. It argued that the evolution of a service economy meant that retail trading had to be assessed differently. According to the applicant, consumers' decisions to purchase goods are more and more influenced by aspects such as the bringing together and display of products, the service provided by staff, advertising, etc. Such services go beyond the mere activity of selling and enable a retailer to be distinguished from its competitors. Consequently they should be able to obtain the protection of a service mark, which is now accepted by OHIM and most similar trade mark offices of Member States.

22. The Bundespatentgericht decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

'1. Does retail trade in goods constitute a service within the meaning of Article 2 of the Directive?

2. To what extent must the content of such services provided by a retailer be specified in order to guarantee the certainty of the subject-matter of trade-mark protection that is required in order to

- (a) fulfil the function of the trade mark, as defined in Article 2 of the Directive, namely, to distinguish the goods or services of one undertaking from those of other undertakings, and
- (b) define the scope of protection of such a trade mark in the event of a conflict?

3. To what extent is it necessary to define the scope of similarity (Article 4(1)(b) and Article 5(1)(b) of the Directive) between such services provided by a retailer and

(a) other services provided in connection with the distribution of goods, or

(b) the goods sold by that retailer?

23. In the order for reference the Bundespatentgericht states that it is referring these questions to the Court for the following reasons.

24. In carrying on his business, a retailer does not differ from a manufacturer who sells his products himself. A retailer can therefore distinguish himself from such a competitor by means of a goods mark. Furthermore, the services associated with the marketing of goods, such as advice to customers, providing information, advertising, etc., do not appear to be independent services in the eyes of buyers and they are afforded protection by the goods mark. Finally, the additional services offered by large department stores, such as financial, insurance and travel services, meals and refreshments, which appear to be independent of the marketing of goods, fall within specific classes of the Nice Classification and may therefore be the subject of independent marks.

25. The activity of a retailer for which the protection of a service mark may be found necessary is therefore reduced to specific trading activities which permit the marketing of goods but is not limited to marketing, that is to say, to the bringing together of goods from different enterprises so as to form a range of goods and offering them for sale from a sales outlet. These services, which are consequently paid for by means of the profit margin on the goods, may be deemed to be provided for remuneration, in accordance with the definition of services in Article 50 EC.

26. The Nice Classification, which is binding on the Member States and OHIM, must also be taken into account. On the basis of the explanatory note relating to Class 35, the German Patents and Trade Marks Office has refused to register marks for retail services on the ground that they relate exclusively to the sale of goods. The protection afforded by a service mark has been granted only where a commercial undertaking supplies services which go beyond the activity of selling goods and which may be offered to third parties as independent services.

27. However, OHIM and the trade mark offices of a majority of the Member States allow the registration of a mark for services supplied by a retailer, although there are differences as to whether particulars of the services covered must be given. Since national marks and Community marks may clash in proceedings before national courts and authorities and before OHIM a binding ruling by the Court of Justice is necessary; otherwise the principle of equal treatment of business undertakings will not be observed, bringing a risk of significant distortion of competition in the European Union.

28. However, the Bundespatentgericht submits that the principle of the registration of such service marks

can be allowed only if it is possible to specify the subject of such protection. The registration of a mark for 'retail services' must under no circumstances lead to the uncontrolled expansion of the trade mark protection that encompasses all the services provided in the context of the trading activity of a department store and all the goods sold by it. This requirement follows from the very function of a mark, which is to guarantee to the consumer the identity of the origin of the marked product or service. It is also necessary from the viewpoint of the free movement of goods and services, which requires the exclusive rights conferred by the registration of a mark to be clearly identified.

29. Therefore general terms such as 'retail services', 'retail trading' and 'in-store services' are not sufficiently specific. First, they do not make it possible to distinguish the services offered by the retailer from other services which may be offered by other legally and economically independent enterprises such as banks, travel agencies, transport undertakings and restaurants, which are covered by other classes of services. Second, such general terms do not make it possible to determine precisely what products are being sold. The same objections may arise where an application for registration merely specifies the type of outlet, such as 'department store' or 'supermarket'. On the basis of the explanatory note to Class 35 of the Nice Classification, the description of the services offered by a retailer which enables those services to be distinguished from services covered by another class of the Nice Classification must incorporate the wording referring to the bringing together, for the benefit of others, of a variety of goods, excluding the transport thereof, enabling customers to purchase those goods or making it more convenient for them to do so.

30. However, even a description of the services provided by a retailer at the time of registering the mark may not be sufficient to prevent a risk of uncontrolled monopoly. It is also necessary to define the concept of similarity as between, on the one hand, those services and, on the other hand, other services which may be offered on the premises of a department store and the goods sold.

III – Assessment

A – The first question

31. The first question from the Bundespatentgericht is whether retail trading constitutes a service within the meaning of Article 2 of the Directive.

32. Before replying to this question, I think the following points must be made regarding, first, the wording and the purpose of Article 2 of the Directive and, second, the meaning of 'retail trading' in the context of the present dispute.

33. First, with regard to Article 2 of the Directive, as the Commission of the European Communities ('the Commission') correctly observes, its purpose is not to define the services for which a mark may be registered by a national office. As its heading indicates, Article 2 relates to the 'signs of which a trade mark may consist'. It provides that a mark may consist of signs capable of being represented graphically and which are 'capable

of distinguishing the goods or services of one undertaking from those of other undertakings'. Consequently its purpose is to define the types of signs of which a trade mark may consist, irrespective of the goods or services for which protection might be sought. (19)

34. The other provisions of the Directive likewise give no definition of the services for which a mark may be registered. However, as the seventh recital of the preamble to the Directive indicates, its purpose is to ensure that the conditions for obtaining and continuing to hold a registered trade mark are identical in all Member States. Furthermore, as provided by Article 1 and as is clear from its content, the Directive applies not only to trade marks but also to service marks.

35. Taking these factors into account, it seems to me that, although the Directive must be understood, in view of the twelfth recital in the preamble and Article 6 sexies of the Paris Convention, as not obliging the Member States to recognise service marks in their national law, those States must nevertheless, if they accept that business undertakings can register such marks, (20) comply with the requirements of the Directive with regard to the substantive conditions for registering them. I therefore agree with all the interveners that the question whether a service such as 'retail trading' may constitute a service for which a mark can be registered falls within the scope of the Directive and must therefore find a reply in its general scheme and its purposes.

36. The second question relates to the definition of 'retail trading'. The Bundespatentgericht did not clarify exactly what the term covers. As the Commission states in its observations, this term, as defined in some of the official languages of different Member States, is used to designate an activity which consists in selling goods in small quantities to individuals and which thereby differs from 'wholesale trading'. Consequently 'retail trading' designates an activity consisting in selling goods in small quantities.

37. All the interveners and the applicant appear to accept that the sale of goods as such, that is to say, limited to the operation which consists in offering goods for sale and selling them, cannot, in conformity with the Directive, be regarded as a service for which a mark can be registered. As the Commission points out, that activity is taken into account in the context of the provisions of the Directive relating to the rights conferred by the registration of a mark for goods. Thus it is clear from Article 5(3) of the Directive that a mark registered for goods confers the right to offer the goods bearing the mark, to put them on the market and to stock them for that purpose. In accordance with the logic of the system of trade mark law, so far as the sale of goods is concerned, it is not the activity of selling which is taken into account, as an abstract or incorporeal entity, but the goods which are sold. In other words, in the logic of that system, the 'central core' of the act of sale, to use the expression of the Austrian Government in its written observations, is the goods which are sold and not the act of sale as the provision of a service.

38. In my view, this situation arises logically from the fact that a service has no physical substance, so that a mark can be affixed only to the materials used for supplying it, whereas goods, because of their physical nature, can have a mark affixed to them which can be recognised by consumers as attaching directly to the product covered by the mark. As the service of selling has precisely the purpose of selling goods to consumers, and the characteristics and price of the goods are generally the criteria which determine whether they are purchased, the trade mark of the goods which he sells can differentiate a retailer from his competitors. This is true even if the seller is not the maker of the goods in question. A retailer can distinguish himself from his competitors by selling goods under their maker's trade mark or his own brand name which he has registered for the goods in question.

39. However, the concept of 'retail trading' referred to in these proceedings is not confined to selling goods as such, but has a broader meaning. According to the applicant, it also covers activities such as the selection of goods, bringing them together and displaying them, the quality of the service and advice given by staff, the location and accessibility of the shop. Consequently these services are intended to promote the sale of goods and are provided in the course of marketing them. The question arising in the present case is therefore whether such services, provided in connection with the retail sale of goods, may, in accordance with the Directive, constitute a service as such, for which a service mark can be registered.

40. The Bundespatentgericht considers that the explanatory note to Class 35 of the Nice Classification is of assistance in replying to this question. As we have seen, Class 35 consists of services relating to advertising, business management, business administration and office functions. According to the accompanying explanatory note, it includes 'the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods'. However, it does not include 'the activity of an enterprise the primary function of which is the sale of goods, i.e., of a so-called commercial enterprise'.

41. I am not persuaded that the explanatory note can be of assistance in construing the Directive. The Federal Republic of Germany is of course a party to the Nice Agreement, (21) as has been observed by the Bundespatentgericht. However, it is necessary to bear in mind the legal scope of the Nice Classification, as expressly set out in Article 2 of the Agreement. Under the combined provisions of Article 2(2) and (3) the States which are parties to it have undertaken to ensure that their competent authorities will include in the official documents and publications relating to registrations of marks, as principal or as subsidiary information, the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong.

42. As the Court has already observed, the purpose of the Agreement is thus to facilitate the registration of

trade marks. (22) It enables persons applying for the registration of trade marks to refer to a single classification system. It thus facilitates their preparation of applications for registration because the goods and services to which a given mark applies will be classified in the same way in all the countries which have adopted this classification system. For the same reason, the system also has the advantage that it makes it easier for business undertakings and national trade mark offices to carry out searches for prior marks which could give rise to opposition to an application for registration. Finally, the system serves as the basis for calculating the registration fee payable on the registration of a mark. (23)

43. Hence the Nice Classification, the main purposes of which are thus to facilitate registration and searches, has an essentially practical value. In my view, it has no real legal effect in relation to the types of services for which a mark may be registered, as is confirmed by Article 2(1) of the Nice Agreement, which states that, subject to the requirements prescribed by the Agreement, the effect of the classification is that attributed to it by each country of the Union and, in particular, that it does not bind the countries which are parties to the Agreement in respect of either the evaluation of the extent of the protection afforded by any given mark or the recognition of service marks.

44. Consequently, I think it would be questionable to take the view that the absence, in the list of class headings and in the alphabetical list of goods and services of the Nice Classification, of an item or service corresponding exactly to the activity concerned in an application for the registration of a mark may justify the rejection of the application. The practical difficulty created by the registration of such a mark should not be treated as a legal impossibility. For the same reasons, I think the explanatory notes on the different classes of the Classification cannot properly serve to interpret the Directive.

45. Likewise, I cannot find in the other international agreements binding on all the Member States or the European Community anything which provides an immediate reply to the question whether services supplied in connection with the retail sale of goods may, in accordance with the Directive, constitute a service as such, for which a service mark can be registered. As we have seen, the Paris Convention merely lays down an obligation for the Member States to protect service marks, but it does not require them to provide for the registration of such marks. The Agreement on Trade-Related Aspects of Intellectual Property Rights, annexed to the Agreement establishing the World Trade Organisation, of 15 April 1994, approved on behalf of the Community, as regards matters within its competence, by Council Decision 94/800/EC of 22 December 1994, (24) in the light of the wording and purpose of which the Court has held that the Community legislation on trade marks must, so far as possible, be interpreted, (25) likewise contains no specific provisions on this point.

46. In order to reply to the question referred, I think, like the United Kingdom Government, that the essential function of the trade mark must be the starting point for reasoning. The Court has consistently held that the essential function of a trade mark is to guarantee the identity of the origin of the designated product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. The mark must offer the consumer a guarantee that all the goods or services bearing it have been manufactured and supplied under the control of a single undertaking to which responsibility for their quality may be attributed. (26)

47. It follows that, in so far as the purpose of a service mark is to enable consumers to identify the enterprise supplying the service, the registration of the mark implies that the service which it is intended to designate is itself identifiable as such, by means of a mark. In other words, it must be possible for consumers to perceive the activity, as such, for which applicant is seeking the registration of a mark as constituting a service. This requirement follows from the very function of the mark and its corollary, the principle of speciality, which means that the rights which it confers can be exactly determined. A mark cannot be registered for a service which cannot be perceived as such by consumers, with the result that the scope of protection could not be ascertained.

48. It seems to me, as it does to the Bundespatentgericht, possible to concede that services which are offered in connection with the sale of goods and which consumers can use only in connection with a particular purchase, but which form the subject-matter of a contract separate from the sale itself, may be identified as services as such and be covered by a service mark. To take the examples given by the national court, such services could relate to financing offered by the retailer for the purchase of one of his products, or insurance covering the product, or again a contract for the repair or maintenance of the product purchased. It should be possible for these services, which fall within particular classes of the Nice Classification, namely Classes 36 and 37, to be covered by a service mark.

49. The possibility of such identification may appear less obvious with regard to activities such as those referred to by the applicant, namely the selection of goods, bringing them together and displaying them, the quality of the service and advice given by staff, or the location and accessibility of the shop. Unlike the services mentioned above, these do not give rise to a separate contract and invoice. Consequently, they would appear in principle to be more difficult to identify as services as such, which could therefore be designated by a service mark. However, I think it would be difficult to exclude altogether the possibility of identifying them as services separate from the sale of goods as such.

50. As the applicant observes, in recent years there has been a significant change in the retailing of goods, with a considerable expansion in sales outlets in the

form of supermarkets and department stores, facilities used for that purpose, and the appearance of electronic means of communication and sales techniques such as marketing. The feature of this development which seems to me relevant to the present case is that the conditions under which the act of sale itself takes place may constitute, in the relationship between retailer and consumer, a reason for buying which is just as important as the quality and price of the goods sold. For example, in the case of what is conventionally known as 'hard discount', it happens that goods are offered for sale without a brand name. (27) Nevertheless, they are selected to meet a certain quality standard within a certain price range. In such a case, I think it can be accepted that it is the selection of the goods which is identified by consumers and which may induce them to return to make their purchases in a given shop, and not the presence of goods of a particular brand. In the same way, the example of a wine retailer cited by the applicant at the hearing seems to me relevant. I think the retailer's selection of wines which he offers for sale, like the advice which he is able to give his customers on choosing the best wines to accompany a meal, depending on what the consumer wishes to spend, can be identified by the customer as services as such.

51. It seems to me that this also applies in the case of a shop which, as in the present case, sells building, home improvement and gardening goods. According to the information given by the applicant, the products which it offers come from several hundred different manufacturers. I presume that the home improvement and gardening materials and tools offered by this kind of retailer may be of different brands and that some of the same brands of goods may also be sold by other retail chains. Nevertheless, I think it can be accepted that consumers may choose to buy from this particular retailer because he offers them a particular range of such kinds of products, or because they know that they will find there sales assistants who are available and can give appropriate advice regarding the home improvement work which they propose to carry out and the choice of suitable tools for that purpose.

52. In these different situations, it seems to me conceivable that, as those services are organized and permanent and may become an important selling point in the relationship between the retailer and consumers, the latter may identify them as services as such, separate from the actual selling of the goods.

53. Furthermore, I agree with all the interveners and the Bundespatentgericht in taking the view that these services, even if they are not separately invoiced, may nevertheless be deemed to be provided for remuneration because they are supplied in order to promote the sale of certain goods and not on a purely disinterested basis, and their cost to the retailer is recovered in his profit margin on the sale of the goods themselves. Consequently it may be concluded that the requirement laid down by Article 50 EC that services are to be provided for remuneration is fulfilled, and reference to this is justified when interpreting the Directive, taking ac-

count of its aim of promoting, inter alia, the free movement of services between the Member States.

54. In addition, it is possible that retailers may have an interest in the registration of such service marks. No doubt, as the French Government correctly points out, retailers already have legal tools other than service marks for keeping their customers and arranging things in such a way that consumers who have been satisfied by the selection of goods and the advice given by staff can distinguish those retailers from their competitors. In this way retailers benefit from the protection of the identity under which they carry on their business of selling through the protection of their trade name which, under Article 8 of the Paris Convention, must be protected by all the countries which are parties to it. (28) They also have the protection provided for by national law for their company or firm name which they use in their relations with third parties, and for the business name displayed at their sales outlet, which is the physical sign to consumers of its existence. However, these names, like brands of goods, do not specifically cover the services in question.

55. Finally, I think it is necessary to mention that many Member States now allow services provided in relation to the retail sale of goods to be covered by a mark, (29) although with differing requirements. The same position of principle was adopted by OHIM on the basis of the Regulation which, of course, covers the Community trade mark and not national marks, but its system of registration and the aim of completing the internal market are the same as those of the Directive. Thus, in the *Giacomelli Sport* decision, (30) the Second Appeal Chamber of OHIM found that a service supplied in connection with retail trading may constitute a service for which Community marks can be registered. (31) Following this decision, the President of OHIM, after obtaining the opinion of national offices and the WIPO, also stated in Notice 3/01 of 12 March 2001 that a Community mark could be registered for services provided in connection with the retail sale of goods, subject to the conditions set out in the notice, to which I shall revert when examining the second question from the national court.

56. Therefore, taking all these factors into account, I shall propose that the Court's reply to the first question should be that services provided in connection with retail trading, which are separate from the sale itself and which can be identified, may, in accordance with the Directive, constitute services for which a service mark may be registered.

B – The second question

57. By its second question the Bundespatentgericht asks, in substance, to what extent the nature of the services supplied by a retailer in connection with retail trading must be specified, in accordance with the Directive, so as to ensure that the subject-matter of the trade-mark protection is defined, as required by, first, the function of the trade mark described in Article 2 of the Directive, which is to distinguish the products or services of one undertaking from those of other undertakings and, second, the need to delimit the scope of

protection afforded by such a mark in the event of conflict.

58. The Commission considers that this question relates to the formal conditions for registration of the mark and that it is therefore a matter for the Member States alone. The Commission cites in support the fifth recital in the preamble to the Directive, which declares that the Member States remain free to fix the procedural provisions concerning the registration of trade marks. The Commission also cites the differing practices in the various Member States regarding the conditions required by national offices for the registration of service marks in the sector of retail trading. Finally, the Commission notes that, so far as the Community trade mark is concerned, the requirements relating to the description of the goods or service for which a mark is registered do not appear in the Regulation, but in Regulation No 2868/95 implementing it.

59. I do not agree with this argument. It is true that neither the Directive nor the Regulation contains provisions indicating the extent to which goods and services for which a mark may be registered must be specified. It is also common ground that the Directive does not seek to establish complete harmonisation of the laws of the Member States concerning trade marks and that the Member State retain the freedom to fix the procedural provisions concerning the registration of trade marks.

60. However, the aim of the Directive, as stated in the first and seventh recitals, is to harmonise the conditions for acquiring trade-mark rights. In my view, the scheme of the Directive shows that the extent to which the goods and services covered by an application for registration must be specified in order to ensure that the subject-matter of protection is defined is one of the substantive conditions for such registration.

61. As we know, the scheme of the Directive is based on registration. It is registration of the mark which confers upon it the rights provided for by the Directive and enables the exact extent of those rights to be determined. Accordingly, the Directive sets out a number of conditions which must be fulfilled by the sign which is to constitute the mark. In the Sieckmann judgment cited above, the Court had to clarify what is involved in registration in a public register. It stated that such registration 'has the aim of making [the mark] accessible to the competent authorities and the public, particularly to economic operators. On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of registration applications and to the publication and maintenance of an appropriate and precise register of trade marks. On the other hand, economic operators must, with clarity and precision, be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties. If the users of that register are to be able to determine the precise nature of a mark on the basis of its registration, its

graphic representation in the register must be self-contained, easily accessible and intelligible'. (32)

62. These requirements, according to which it must be possible to know with clarity and precision the sign in question so as to enable the competent authorities to fulfil their obligations of supervision and to enable the proprietor of the mark and other undertakings to ascertain the exact extent of the rights conferred by registration, apply equally to the goods and services for which the mark is registered.

63. On the one hand, the sign, and, on the other, the goods and services which the sign must serve to designate, are the two inseparable elements of registration, which make it possible to determine the rights conferred by every registered mark. Under the scheme of the Directive and of the Regulation, the purpose of applying for registration of a mark is always in order to designate certain goods and certain services. (33) The grounds for refusal set out in Article 3 of the Directive must be assessed by reference to those goods or services. (34) Likewise, the goods and services for which registration of the mark is sought must be taken into account to determine whether registration should be refused pursuant to Article 4 of the Directive on the ground that the mark is identical with, or could present a likelihood of confusion with, an earlier mark. Accordingly, under Article 4(1)(a) of the Directive, a trade mark is not to be registered or, if registered, is liable to be declared invalid 'on the ground that the mark is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected'. (35) Under Article 4(1)(b), a likelihood of confusion arises from interdependence between the similarity of the marks as between themselves and the similarity of the goods and services covered by the marks.

64. At the same time, it is necessary to know which goods and services are covered by the mark in order to ascertain the rights conferred by registration of the mark, pursuant to Article 5 of the Directive. Finally, a specification of the goods and services covered by the mark makes it possible to apply the grounds of revocation or invalidity and enables national offices, in accordance with Article 13, to limit the scope of a refusal of registration or revocation or invalidity of a mark strictly to the goods or services to which those grounds apply.

65. The requirements formulated by the Court in the Sieckmann judgment, cited above, concerning the perception of the sign will thus not be effective if the goods and services for which registration of the mark is sought or has been made cannot also be exactly known.

66. It is all the more necessary to know what they are in that, as the Court has already observed, the registration system for trade marks, which constitutes an essential element of their protection, is intended to contribute, in respect of both Community law and the different national laws, to legal certainty and sound administration. (36) Logically, therefore, and as the Court has consistently held, the examination of the

grounds for refusal listed in the Directive must be thorough and full in order to ensure that trade marks are not improperly registered. (37) A thorough and full examination prior to registration in order to ensure legal certainty thus also means that the goods and services to be covered by the mark which is to be registered must also be known precisely.

67. For these reasons, therefore, I take the view that the question of the extent to which the nature of the services supplied in the course of retail trading must be specified forms part of the conditions for obtaining the rights in the mark, which the Directive aims to harmonise. Consequently, it falls to the Court to determine the extent to which their nature must be specified.

68. The matter gives rise to varying practices in the different national offices and OHIM. The main features of these practices are as follows. (38) With regard to the description of the services covered by the mark, some national offices allow such services to be registered under the term 'retail trading' or 'retail sale services'. Other offices require a more specific description of the services offered, which may refer to the wording in the explanatory note to Class 35 of the Nice Classification, relating to 'the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods'. So far as the goods to which those services apply are concerned, most national offices recommend or require that the goods in question be specified, or that the sector to which they belong be stated. Other offices also allow this information to be given by stating the sector of the market in which the services are provided, such as a chemist's or a furniture shop.

69. So far as OHIM is concerned, in the *Giacomelli Sport* decision, cited above, the Second Board of Appeal stated that it was necessary for the applicant to give a comprehensible description of the service and a reference to the sector in which it is provided. It gave as an example 'retail services in the sector of sports equipment'.

70. In Notice 3/01, referred to above, the President of OHIM, for his part, adopted a slightly different position. According to him, services provided in connection with the retail sale of goods may be covered by a Community service mark and fall within Class 35 of the Nice Classification. He goes on to say that the term 'retail sale services' is clear and is accepted by the WIPO office, provided that the wording is understood to be that shown in the explanatory note to Class 35. With regard to specifying the sector of activity in which the services are offered, he states that, contrary to the position taken by the Second Board of Appeal, it cannot be considered legally necessary to do so because it is not required for services falling within the other classes of the Nice Classification, such as repair, maintenance or transport. According to the President of OHIM, it is nevertheless desirable to specify the sector in question. He suggests the following forms of wording: concerning the area of activity, 'retail services in respect of food and beverages'; concerning the specific

nature of the service provided, phrases such as 'retail sale services of a department store' or 'retail services of a supermarket', etc.

71. For my part, I think the registration of a mark for services supplied in connection with the retail sale of goods should clearly indicate both the specific nature of those services and the goods or types of goods to which they relate. In my opinion, this dual requirement is justified, in the light of the scheme and purpose of the Directive, by the particular nature of the services supplied in connection with retail trading.

72. As we have seen, registration of the mark must make it possible to determine the precise subject of the protection afforded by the registered mark to its proprietor. (39) Consequently, knowledge of the rights conferred by registration requires that it be possible to establish precisely what services are covered by the mark. A description of the services is also necessary to enable the competent authorities to determine, when carrying out a thorough and full examination, whether registration of the mark should be refused, pursuant to Article 4 of the Directive, on the ground that it is identical with an earlier mark or could give rise to a likelihood of confusion with an earlier mark because the marks in question are identical or similar and the goods or services covered by the marks are identical or similar. Finally, a description is necessary so that the competent authorities can determine whether there are grounds for refusing registration or for the revocation or invalidity of a mark and for limiting the effect of such refusal, revocation or invalidity to the goods or services to which those grounds relate.

73. In order to ascertain the conclusions which must be drawn from these requirements for services provided in the course of retail trading, I think account must be taken of the fact that such services differ from other services, such as repair, transport or dry-cleaning services. In these cases the service provider is carrying out work which is the actual subject of the contract with the consumer. A reference to such a service in an application for the registration of a mark therefore describes an activity which is clearly identifiable by the supervisory authorities and by business undertakings because it relates to a specific activity which anyone can picture mentally. However, as I have said, the services at issue in the present case are services provided by retailers in the course of selling their goods and the services have precisely the aim of promoting the sale of those goods. Therefore the services are not an aim in themselves. Consumers use them only in connection with buying goods and their cost is included in the price of the goods. Furthermore, as we have seen, in the system of trade-mark law, selling as such is not a service for which a mark can be registered. A retailer distinguishes his own selling activity from that of his competitors by the trade mark of the goods which he sells, which may be the manufacturer's or producer's mark or his own brand name.

74. It seems to me, therefore, that the services supplied in the course of retail trading can be described in a way which is specific and sufficiently exact to iden-

tify them clearly and to ensure that they are not confined to the mere sale of goods.

75. That is why I think phrases such as ‘retail trading’, used by the applicant in its application for registration, or ‘retail sale services’ are not specific enough to describe the nature of the services in question. No doubt they make it clear that the services described as such are not completely independent of the sale of goods, such as those provided within the premises of a department store by a travel agency, a dry-cleaning undertaking or a restaurant. These terms could also be understood as not covering services connected with the sale of goods but which are clearly identifiable, such as a credit agreement for financing a purchase or an insurance policy, which fall within particular classes of the Nice Classification. However, I consider that these terms do not indicate what specific services are provided by the retailer which are not the same as those mentioned above and which do not coincide with the act of selling either.

76. In the same way, I am inclined to think that the wording in the explanatory note to class 35 of the Nice Classification, concerning the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, is not specific enough, in the case of a retailer in goods, to characterise the services he provides which do not coincide with the mere placing on sale of the goods in question.

77. In my opinion, it is also necessary to specify the goods or kinds of goods to which those services apply. No doubt, as the President of OHIM pointed out in Notice 3/01, cited above, such specification is not required in connection with the registration of Community marks for services falling within the other classes of the Nice Classification, such as repair, maintenance or transport. However, this aspect does not seem to me decisive and could be overcome having regard to the general scheme and purpose of the Community legislation, taking account, once again, of the particular characteristics of the services in question.

78. As we have seen, these services are intended to promote the sale of certain goods. Unlike the other services, they are not supplied independently. They are supplied only in connection with the sale of certain particular goods. Without any indication of those goods or the category to which they belong, the scope of the protection conferred by registration of the mark would be practically unlimited. The registration of such a mark could have the effect of conferring upon the proprietor the right to the exclusive use of the mark in the sector of the services provided in connection with the retail sale of goods, irrespective of the kind of goods. In my view, that situation would not be consistent with the aim of the Directive, which is to promote the free movement of goods and services.

79. As we know, trade-mark law is somewhat paradoxical in conferring upon one retailer in particular exclusive rights in marks which serve the marketing of goods or services in order to promote the free move-

ment of those goods and services. To reconcile the interests of the protection afforded by the mark and free movement, in the trade-mark law registration system the applicant must, in consideration of the exclusive rights which he claims, indicate exactly the mark and the goods and services to which those rights relate. This requirement makes it possible to achieve at one and the same time the aim of protection afforded by the mark, by designating specifically the subject of such protection, and the aim of the free movement of goods and services, by limiting his exclusive rights to the actual function of the mark, which is to distinguish the proprietor’s goods and services. In so far as the services in question can, by nature, be provided only in connection with the sale of certain goods in particular, it seems to me that the general scheme and purpose of the Directive could be interpreted as meaning that the applicant must specify the goods to which those services relate.

80. Unlike the Commission, I think the situation of an applicant seeking the registration of a mark for services provided in connection with the retail sale of goods is not the same as that of an undertaking applying for the registration of a mark for a service such as advertising, without specifying a particular kind of advertising, or for an extended range of goods and services. In those situations, the extent of the protection afforded by registration is indeed very wide. However, it is not an established fact, nor can it be presumed, that the person concerned will use his mark only in a particular service sector or for only some of the goods referred to in the application for registration. In such a situation, we may therefore accept that Articles 10 and 12 of the Directive, concerning revocation of the rights of the proprietor of the mark where there is no genuine use of it for the goods and services for which it was registered, must be applied in order for the mark to be made available once again for the sector of activity or for the goods which it was not used to designate. However, I think it would be inappropriate to apply this system where it is established at the outset that the services can be applied to certain goods only.

81. The description of the goods or kinds of goods to which the services provided in connection with the retail sale of goods apply could, in my opinion, take the form of a list of the goods or a statement of the sector of activity concerned or the type of shop in which the services are provided, where the wording clearly refers to a particular type of goods, such as sports clothing or a furniture shop. On the other hand, a mere reference to services supplied in a ‘department store’ or ‘in a supermarket’, which may be appropriate for specifying the context in which the services in question are supplied, does not seem to me sufficient for ascertaining the products to which the services apply, in view of the great diversity of the goods which may be sold in outlets of that kind. In the case of retailing in department stores, the difficulty which may arise in listing the different types of goods sold because of their number does not seem to me a sufficient reason for waiving this requirement of specification.

82. On the basis of these considerations, therefore, I shall propose that the Court's reply to the second question from the national court should be that the nature of the services provided by a retailer in connection with retail trading and for which a service mark may be registered must, in accordance with the Directive, be specified in such a way that it is possible to ascertain what those services actually consist of. Terms such as 'retail trading' or 'retail sale services' are not sufficiently specific to describe the nature of the services provided in that way. The registration of a mark for services provided in connection with the retail sale of goods must also make it possible to ascertain the goods or types of goods to which the services apply.

C – The third question

83. The third question relates to the concept of similarity, referred to in Articles 4(1)(b) and 5(1)(b) of the Directive. We have seen that, according to the former, registration of a mark must be refused if, because of its identity with, or similarity to, an earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. In comparable terms, Article 5(1)(b) provides that the proprietor of a registered trade mark is entitled to prevent all third parties from using in the course of trade any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.

84. The Bundespatentgericht begins by observing that, according to the case-law of the Court of Justice, the fundamental criterion for assessing the similarity of goods or services, within the meaning of the above-mentioned provisions, is whether, taking into account all the circumstances, the sectors of the public concerned could take the view that the respective goods or services originated under the control of a single undertaking. The Bundespatentgericht adds that the relevant criteria for assessing whether goods and services are similar include, in particular, the nature, the intended purpose and the method of use of the goods or services in question and whether they are in competition with each other or are complementary.

85. The Bundespatentgericht goes on to note that many retailers carry out a quality control of the goods they sell. The court concludes from this that, with regard to marks for services provided in connection with the retailing of goods, this very wide definition of similarity, which considers common quality control in functionally linked goods or services to be sufficient, could result in giving the proprietor of such a service mark an uncontrollable area of protection.

86. Therefore the use of these criteria could result in those services being considered similar, first, to the other services which may be provided in the general context of the retailing of goods, such as financial, in-

surance or maintenance services, and, second, to the actual goods sold by the retailer.

87. On the last-mentioned point, the Bundespatentgericht states that, according to German case-law, in spite of their difference in nature, goods used for the supply of services and the services themselves may be deemed similar where service enterprises independently manufacture or sell the goods concerned or the manufacturers of goods engage independently in the provision of the corresponding services. Hence there is deemed to be similarity between the service of 'providing food and drink' and the goods classified as 'alcoholic beverages' because those products are offered for immediate consumption in the enterprises where they are produced or because they are served in restaurants for consumption on the premises and are also sold on a 'take-away' basis.

88. Consequently, in the third question the Bundespatentgericht asks the Court how far it is necessary to delimit the area of similarity, within the meaning of Articles 4(1)(b) and 5(1)(b) of the Directive, as between, on the one hand, services provided in connection with the retail sale of goods and, on the other, other services offered in connection with the marketing of the goods or the actual goods offered for sale by the retailer.

89. I agree with the Bundespatentgericht that it is desirable to avoid giving the proprietor of a mark registered for services supplied in connection with the retail sale of goods very extensive protection which would cover other services that may be offered in connection with selling goods, as well as all the goods sold by such proprietor. Like the national court, I consider that recognition of the possibility of registering such marks should not have the consequence of permitting them to replace goods marks or of impairing the advantages attaching to them.

90. It would not be in the general interest to call into question the system of trade mark law in this way. Even though the development of retailing may have the consequence that the services provided in connection with the marketing of certain kinds of goods are now important, or even decisive, for consumers, the fact remains that the purpose of every sale is to buy a particular product. It must be remembered that the protection afforded by goods marks has the effect of defending and promoting the quality of the goods. It encourages manufacturers to maintain the quality of their products and to invest for the purpose of improving them by enabling them to gain the loyalty of their customers thanks to the quality of the products identified by the mark. The same applies to the brand name which a retailer may decide to affix to the goods he sells. By identifying them in this way, it is in his interest that his brand name should designate only products which meet a certain quality standard. Thus the brand contributes to economic progress. In my opinion, therefore, in trade-mark law it is essential that the protection of the method of selling, by the registration of marks for the services provided in connection with the retail

sale of goods, should not have an adverse effect on the value of the marks designating the actual goods sold.

91. However, I do not think it is possible to delimit in advance, by means of set criteria, the area of similarity between services supplied in connection with the retail sale of goods and the other services which may be offered in the course of marketing in general or the actual goods. As stated in the tenth recital in the preamble to the Directive, the concept of similarity must be interpreted in relation to the likelihood of confusion. According to the case-law, such a likelihood exists where members of the public may make a mistake as to the origin of the goods and services in question, that is to say, where they may believe that the goods and services originate from the same undertaking, to which they may attribute responsibility for the quality thereof.

92. In accordance with this case-law, the likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. (40) This implies a degree of interdependence between the factors taken into account, in particular the similarity of the marks and that of the designated goods or services. Thus a slight similarity between the designated goods or services may be offset by a high degree of similarity between the marks, and vice versa. The more distinctive the mark, the greater the likelihood of confusion will be. In making that assessment, account should be taken, in particular, of the intrinsic characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations. (41) Likewise, in assessing the similarity of the goods or services concerned, all the relevant factors concerning the relationship between those goods or services should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary. (42)

93. Finally, in the assessment of the likelihood of confusion, the perception of the marks by the average consumer of the goods or services in question plays a decisive role. (43)

94. We may therefore conclude from this case-law that the assessment of the similarity of services and goods, which is closely connected with whether or not there is a likelihood of confusion, is a question of fact which proceeds from a consideration of all the circumstances of each particular case. Therefore it appears difficult to decide in advance that services provided in connection with retail trading will under no circumstances be similar to certain kinds of other services provided in the course of marketing in general or similar to the goods to which they apply. To rule out such

similarity from the outset could result in calling into question, in certain circumstances, the very function of the trade mark, which is to guarantee the origin of the goods and services which it designates.

95. The best method of complying with trade-mark law when limiting the likelihood of confusion and, thereby, the extent of the protection conferred by the registration of marks for services provided in connection with retail trading includes, in my opinion, an exact and complete specification of the services in question and the goods to which they apply.

96. If those particulars are given, the competent authorities will, in each particular case, have to refer to that description of the nature of the services and of the sector in which they are provided in order to determine whether there may be a likelihood of confusion on the part of the consumers concerned by reason of, first, the identity or similarity of the signs in question and, second, the identity or similarity of the services or goods covered by the third-party mark and the services provided in connection with the retail sale of goods by the retailer. It will be possible to find a likelihood of confusion only if, having regard to all the circumstances of the particular case, the consumers concerned might believe that the goods or services designated by the third-party mark have the same origin as the services supplied by the retailer in connection with the retail sale of goods, that is to say, according to the case-law cited by the Bundespatentgericht, that the goods or services of the third party were supplied or manufactured under the control of the retailer to whom the responsibility for their quality may be attributed.

97. Unlike the Bundespatentgericht, I do not think that the fact that retailers are considered, in the minds of consumers, to exercise a degree of control over the quality of the goods they sell, regardless of whether they are designated by the brand name of the retailer in question or by the producer's mark, justifies the assumption that, generally speaking, those goods must be deemed to be similar to the services provided in the course of retail trading. The goods are, by nature, different from the services. Consequently, it cannot be assumed that they are similar. Depending on the characteristics of the services and goods concerned in each case, therefore, it will be possible to determine whether, by reason of their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary, they can be considered similar.

98. Furthermore, I do not think the Court's case-law justifies a wide interpretation of these criteria. As we have seen, the concept of similarity must be interpreted in relation to the likelihood of confusion and, as the Grand Chamber of the Court has recently observed, (44) such a likelihood cannot be presumed. The protection of the proprietor of the mark therefore requires proof that there is a likelihood of confusion on the part of the public. (45)

99. Taking these factors into account, I would be inclined to consider that the registration of marks for services supplied in connection with the retail sale of

goods should not, if the registration of such marks is subject to specification of the nature of the services and goods to which they apply, result in giving unlimited protection to the proprietors of such marks. On this point I agree with the position of the President of OHIM in Notice 3/01, cited above, who observes that although the risk of confusion between services provided in connection with the retail sale of goods and the goods sold cannot be excluded, it is nevertheless unlikely, save in particular circumstances, for example where the respective marks are identical or almost identical and are well established on the market. (46)

100. Therefore I shall propose that the Court's reply to the third question from the national court should be that it is unnecessary to delimit the scope of similarity within the meaning of Articles 4(1)(b) and 5(1)(b) of the Directive between services provided in connection with retail trading and other services offered in connection with the sale of goods or the goods themselves offered for sale by the retailer.

IV – Conclusion

101. On the foregoing grounds, I propose that the Court reply as follows to the questions referred for a preliminary ruling by the Bundespatentgericht (Germany):

(1) Services provided in connection with retail trading, which are separate from the sale itself and which can be identified, may, in accordance with First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, constitute a service for which a service mark may be registered.

(2) The nature of the services provided by a retailer in connection with retail trading of goods and for which a service mark may be registered must, in accordance with First Directive 89/104, be specified in such a way that it is possible to ascertain what those services actually consist of. Terms such as 'retail trading' or 'retail sale services' are not sufficiently specific to describe the nature of the services provided in that way. The registration of a mark for services provided in connection with the retail sale of goods must also make it possible to ascertain the goods or types of goods to which the services apply.

(3) It is unnecessary to delimit the scope of similarity within the meaning of Articles 4(1)(b) and 5(1)(b) of First Directive 89/104 between services provided in connection with retail trading and other services offered in connection with the sale of goods or the goods themselves offered for sale by the retailer.

relating to trade marks (OJ 1989 L 40, p. 1, 'the Directive').

4 – United Nations Treaty Series, Vol. 828, No 11851, pp. 305 to 388 ('the Paris Convention').

5 – The Court has already found that all the Member States of the European Community before the enlargement of 1 May 2004 were parties to the Paris Convention (Libertel, cited above, paragraph 3). With regard to the 10 new Member States, they became parties to the Convention on the following dates: the Republic of Hungary on 1 January 1909, the Republic of Poland on 10 November 1919, the Republic of Cyprus on 17 January 1966, the Republic of Malta on 20 October 1967, the Republic of Slovenia on 25 June 1991, the Czech Republic and the Slovak Republic on 1 January 1993, the Republic of Latvia on 7 September 1993, the Republic of Lithuania on 22 May 1994 and the Republic of Estonia on 24 August 1994.

6 – Note also that the 25 Member States have signed the Trade-mark Law Treaty, adopted at Geneva on 27 October 1994, Article 16 of which provides that any Contracting Party is to register service marks and apply to such marks the provisions of the Paris Convention which concern trade marks. Not all the Member States have ratified it on the date of the facts in the main proceedings, however. Germany did not ratify it until 16 October 2004. By that date 12 other Member States had become parties to the Treaty (the Czech Republic, the Kingdom of Denmark, the Republic of Estonia, the Kingdom of Spain, Ireland, the Republic of Cyprus, the Republic of Latvia, the Republic of Lithuania, the Republic of Hungary, the Republic of Slovenia, the Republic of Slovakia and the United Kingdom of Great Britain and Northern Ireland).

7 – 'The Nice Agreement'.

8 – Article 19 of the Paris Convention is worded as follows: 'It is understood that the countries [to which the Convention applies] reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.'

9 – 'The Nice Classification'.

10 – According to the situation of the States parties to the Agreement as at 24 September 2004, available on the internet site of the World Intellectual Property Organisation ('WIPO'). According to the information on the same site, these two countries nevertheless use the Nice Classification.

11 – See Article 28 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended ('the Regulation'), and Rules 1 and 2 of Commission Regulation No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1).

12 – United Nations Treaty Series, Vol. 828, No 11852, p. 389.

13 – The European Community acceded to the Protocol relating to the Madrid Agreement as from 1 October 2004 (Council Decision 2003/793/EC of 27

1 – Original language: French.

2 – See the judgments in Case C-273/00 Sieckmann [2002] ECR I-11737 (concerning olfactory signs); Case C-104/01 Libertel [2003] ECR I-3793; Case C-49/02 HeidelbergerBauchemie [2004] ECR I-6129 (concerning one or more colours without shape or delineation) and Case C-283/01 ShieldMark [2003] ECR I-14313 (concerning sound signs).

3 – First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States

- October 2003 approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989 (OJ 2003 L 296, p. 20).
- 14 – See the first and seventh recitals in the preamble.
- 15 – See the first and second recitals in the preamble.
- 16 – ‘OHIM’.
- 17 – Bundesgesetzblatt 1994 I, p. 3082 (the ‘Markengesetz’).
- 18 – ‘Praktiker’.
- 19 – Case C-363/99 KoninklijkeKPNNederland [2004] ECR I-1619, paragraph 80.
- 20 – Which, so far as I am aware, is the case in the 25 Member States.
- 21 – Since 29 January 1962.
- 22 – KoninklijkeKPNNederland, paragraph 111.
- 23 – With regard to the Community mark, Rule 4 of Regulation No 2868/95 provides that every application for registration gives rise to the payment of a basic fee and a class fee for each class exceeding three to which the goods or services belong.
- 24 – Council Decision of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1) (‘the TRIPs Agreement’).
- 25 – Case C-53/96 Hermès [1998] ECR I-3603, paragraph 28; HeidelbergerBauchemie, cited above, paragraph 20, and Case C-245/02 Anheuser-Busch [2004] ECR I-10989, paragraph 42.
- 26 – See, in particular, Case C-349/95 Loendersloot [1997] ECR I-6227, paragraphs 22 and 24; Case C-39/97 Canon [1998] ECR I-5507, paragraph 28; Case C-517/99 Merz& Krell [2001] ECR I-6959, paragraph 22, Case C-299/99 Philips [2002] ECR I-5475, paragraph 30, and Libertel, paragraph 62.
- 27 – See J.-N. Kapferer, *Les marques – Capital de l’entreprise – Les chemins de la reconquête*, Editions d’Organisation, Paris, 1995, p. 29.
- 28 – By virtue of the TRIPs Agreement, the members of the World Trade Organisation also have an obligation to protect trade names (see Anheuser-Busch, paragraph 91).
- 29 – In her note ‘Marks for Retail Services – An Example for Harmonising Trade Mark Laws’, *International Review of Industrial Property and Copyright Law*, vol. 34, No 5, 2003, pp. 503 to 520, Marianne Grabrucker examines the practice in this matter in the Benelux countries, Denmark, Germany, Greece, Spain, France, Ireland, Italy, Austria, Portugal, Finland, Sweden, the United Kingdom, the United States, Japan, Norway and Switzerland.
- 30 – Decision of 17 December 1999 in Case R 46/1998-2.
- 31 – Paragraph 22.
- 32 – Paragraphs 49 to 52.
- 33 – See the judgment in Koninklijke KPN Nederland, paragraph 33.
- 34 – See the judgments in Merz & Krell, paragraph 29, and Koninklijke KPN Nederland, paragraphs 33 and 34.
- 35 – Emphasis added.
- 36 – See the judgment in Sieckmann, paragraph 37.
- 37 – See the judgments in Libertel, paragraph 59, and Koninklijke KPN Nederland, paragraph 123. With regard to the Regulation, see Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 45.
- 38 – The note by Marianne Grabrucker, includes a description of the different national practices.
- 39 – See the Sieckmann judgment, paragraph 48.
- 40 – See the judgments in Case C-251/95 SABEL [1997] ECR I-6191, paragraph 22, and Canon, paragraph 16.
- 41 – See the judgments in Joined Cases C-108/97 and C-109/97 WindsurfingChiemsee [1999] ECR I-2779, paragraph 51, and Case C-342/97 LloydSchuhfabrik-Meyer [1999] ECR I-3819, paragraph 23.
- 42 – Canon, paragraph 23.
- 43 – Lloyd Schuhfabrik Meyer, paragraph 25.
- 44 – Anheuser-Busch, paragraph 63.
- 45 – See the judgment in Case C-425/98 Marca Mode [2000] ECR I-4861, paragraphs 33 and 34. See also, to that effect, the judgments in Case C-292/00 Davidoff [2003] ECR I-389, paragraph 28, and Case C-291/00 LTJ Diffusion [2003] ECR I-2799, paragraphs 48 and 49.
- 46 – The President of OHIM concluded his discussion of the risk of conflicting marks as follows: ‘Given that situation, those requesting registration of marks for retail (or similar) services should not expect that they thereby obtain protection against the use or registration of marks for goods. If such protection is required as well, it is clear that registration for goods must be requested as well.’