

European Court of Justice, 2 July 2009, Davidoff v Bundesfinanzdirektion Sudost



TRADEMARK LAW

Internationally registered trade mark

- [For purposes of customs action, an internationally registered trade mark and a Community trade mark have the same effects](#)

Therefore, the answer to the question referred for a preliminary ruling is that Article 5(4) of Regulation No 1383/2003, in conjunction with Article 146 of Regulation No 40/94, is to be interpreted as allowing the holder of an internationally registered trade mark to secure action by the customs authorities of one or more other Member States, besides that of the Member State in which it is lodged, just like the proprietor of a Community trade mark.

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European Court of Justice, 2 July 2009

(J.-C. Bonichot, J. Makarczyk and L. Bay Larsen)

JUDGMENT OF THE COURT (Sixth Chamber)

2 July 2009 (*)

(Trade marks – International registration – Protocol Relating to the Madrid Agreement – Regulation (EC) No 40/94 – Article 146 – International registration and a Community trade mark having the same effects in the Community – Regulation (EC) No 1383/2003 – Article 5(4) – Goods suspected of infringing a trade mark – Customs action – Proprietor of a Community trade mark – Right to secure action also in Member States other than the Member State in which the application is lodged – Extension to the holder of an international registration)

In Case C-302/08,

REFERENCE for a preliminary ruling under Article 234 EC from the Finanzgericht München (Germany), made by decision of 19 June 2008, received at the Court on 8 July 2008, in the proceedings

Zino Davidoff SA

v

Bundesfinanzdirektion Südost,
THE COURT (Sixth Chamber),

composed of J.-C. Bonichot, President of the Chamber, J. Makarczyk and L. Bay Larsen (Rapporteur), Judges, Advocate General: D. Ruiz-Jarabo Colomer, Registrar: R. Grass,

having regard to the written procedure, after considering the observations submitted on behalf of:

- Zino Davidoff SA, by U. Hildebrandt, Rechtsanwalt,
 - the Czech Government, by M. Smolek, acting as Agent,
 - the Italian Government, by I. Bruni, acting as Agent, assisted by G. Albenzio, avvocato dello Stato,
 - the Portuguese Government, by L. Inez Fernandes and R. Solnado Cruz, acting as Agents,
 - the Commission of the European Communities, by H. Krämer and B.-R. Killmann, acting as Agents,
- having decided, after hearing the Advocate General, to proceed to judgment without an Opinion, gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation of Article 5(4) of Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights (OJ 2003 L 196, p. 7) and Article 146 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended by Council Regulation (EC) No 1992/2003 of 27 October 2003 (OJ 2003 L 296, p. 1; ‘Regulation No 40/94’).

2 The reference has been made in the course of proceedings between Zino Davidoff SA (‘Davidoff’) and the Bundesfinanzdirektion Südost (South Eastern Federal Revenue Office) concerning Davidoff’s application for border seizure in respect of 12 internationally registered trade marks, of which it is the holder.

Legal context

3 Article 1 of Regulation No 1383/2003 states:

‘1. This Regulation sets out the conditions for action by the customs authorities when goods are suspected of infringing an intellectual property right in the following situations:

- (a) when they are entered for release for free circulation, export or re-export ...;
- (b) when they are found during checks on goods entering or leaving the Community customs territory ..., placed under a suspensive procedure ... in the process of being re-exported subject to notification ... or placed in a free zone or free warehouse

2. This Regulation also fixes the measures to be taken by the competent authorities when the goods referred to in paragraph 1 are found to infringe intellectual property rights.’

4 Article 2 of the same regulation specifies:

‘1. For the purposes of this Regulation, “goods infringing an intellectual property right” means:

- (a) counterfeit goods; namely:
- (i) goods, including packaging, bearing without authorisation a trade mark identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished in its essential aspects from such a trade mark, and which thereby infringes

the trade mark-holder's rights under Community law, as provided for by Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark or the law of the Member State in which the application for action by the customs authorities is made;

...

2. For the purposes of that Regulation, "right-holder" means;

(a) the holder of a trade mark, copyright ...

...

5 Article 5 reads as follows:

'1. In each Member State a right-holder may apply in writing to the competent customs department for action by the customs authorities when goods are found in one of the situations referred to in Article 1(1) (application for action).

...

4. Where the applicant is the right-holder of a Community trade mark ..., an application may, in addition to requesting action by the customs authorities of the Member State in which it is lodged, request action by the customs authorities of one or more other Member States.

...

6 The Community acceded with effect from 1 October 2004 to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989 ('the Protocol') pursuant to Council Decision 2003/793/EC of 27 October 2003 (OJ 2003 L 296, p. 20).

7 Article 4 of the Protocol states:

'Effects of international registration

(1)(a) From the date of the registration or recordal effected ..., the protection of the mark in each of the contracting parties concerned shall be the same as if the mark had been deposited direct with the office of that contracting party. If no refusal has been notified to the International Bureau ... or if a refusal notified ... has been withdrawn subsequently, the protection of the mark in the contracting party concerned shall, as from the said date, be the same as if the mark had been registered by the office of that contracting party.

...

8 Article 146 of Regulation No 40/94, entitled 'Effects of international registrations designating the European Community', provides:

'1. An international registration designating the European Community shall ... have the same effect as an application for a Community trade mark.

2. If no refusal has been notified ... or if any such refusal has been withdrawn, the international registration of a mark designating the European Community shall ... have the same effect as the registration of a mark as a Community trade mark.

...

The main proceedings and the question referred to the Court

9 On 10 May 2007, on the basis of Article 5(4) of Regulation No 1383/2003, Davidoff lodged an application with the Oberfinanzdirektion Nürnberg, now the

Bundesfinanzdirektion Südost, for border seizure of goods suspected of infringing 12 internationally registered trade marks, of which it is holder.

10 That action was dismissed on 22 August 2007 on the grounds that Article 5(4) of Regulation No 1383/2003 concerns only 'the right-holder of a Community trademark' and that that regulation was not amended by the Community legislature despite the Community's accession to the Protocol.

11 Davidoff brought an appeal against that decision before the Finanzgericht München.

12 The referring court takes the view that the Community provisions at issue pose interpretation problems.

13 For its part, it is of the view that, by its very wording, Article 5(4) of Regulation No 1383/2003 also applies to the right-holder of an internationally registered trade mark, since such a trade mark is treated as a Community trade mark with regard to its effects in the Community.

14 In those circumstances, the Finanzgericht München decided to stay the proceedings and to refer the following question to the Court for a preliminary ruling:

'In the light of the accession of the Community to the [Protocol], is Article 5(4) of Regulation [No 1383/2003] to be interpreted as meaning that, despite the use of the term "Community trademark", marks with international registrations within the meaning of Article 146 et seq. of Regulation [No 40/94], are also covered?'

The question referred for a preliminary ruling

15 By its question, the national court asks, essentially, whether Article 5(4) of Regulation No 1383/2003, read in the light of Article 146 of Regulation No 40/94, allows the holder of an internationally registered trade mark to secure action by the customs authorities of one or more other Member States, besides that of the Member State in which it is lodged, just like the proprietor of a Community trade mark.

16 In this respect, it must be held that Regulation No 1383/2003 was adopted prior to the accession of the Community to the Protocol pursuant to Decision No 2003/793.

17 Pursuant to Article 4(1) of the Protocol, the protection of the mark in each of the Contracting Parties designated by the holder of that mark is to be the same as if the mark had been deposited direct with the Office of that Contracting Party.

18 Recital 8 in the preamble to Regulation No 1992/2003 states that the regulation contains the measures which are necessary to give effect to the accession of the Community to the Protocol.

19 Recital 6 in the preamble to the same regulation points out in particular that it is necessary to allow holders of international registrations under the Protocol to apply for protection under the Community trade mark system.

20 Recital 1 in the preamble specifies that uniform protection is given to Community trade marks and that

they produce their effects throughout the entire area of the European Community.

21 In the light of those recitals, Article 146(2) of Regulation No 40/94, as inserted by Regulation No 1992/2003, provides that the international registration of a trade mark designating the European Community is to have the same effect as the registration of a mark as a Community trade mark.

22 As the referring court, the applicant in the main proceedings, all Member States submitting observations, and the Commission of the European Communities maintain, the Community legislature thus meant, so far as their practical effects are concerned, to treat internationally registered marks as Community trade marks.

23 Article 5(4) of Regulation No 1383/2003 relates specifically to a procedure for the implementation in the Community of the protection of a Community trade mark, as regards its effects.

24 According to its wording, it only allows 'the right-holder of a Community trade mark', in the context of an application to intervene, to secure, in addition to action by the customs authorities of the Member State in which it is lodged, action by the customs authorities of one or more other Member States.

25 However, following the assimilation into Community trade marks of internationally registered trade marks, it must necessarily be accepted that, in conformity with the Community legislature's intention in adopting Regulation No 1992/2003, the application of Article 5(4) of Regulation No 1383/2003 may also be requested by the holder of an internationally registered trade mark.

26 Therefore, the answer to the question referred for a preliminary ruling is that Article 5(4) of Regulation No 1383/2003, in conjunction with Article 146 of Regulation No 40/94, is to be interpreted as allowing the holder of an internationally registered trade mark to secure action by the customs authorities of one or more other Member States, besides that of the Member State in which it is lodged, just like the proprietor of a Community trade mark.

Costs

27 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 (Sixth Chamber) hereby rules:

Article 5(4) of Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, read in the light of Article 146 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, as amended by Council Regulation (EC) No 1992/2003 of 27 October 2003, is to be interpreted as allowing the holder of an internationally registered trade mark to se-

cure action by the customs authorities of one or more other Member States, besides that of the Member State in which it is lodged, just like the proprietor of a Community trade mark.
