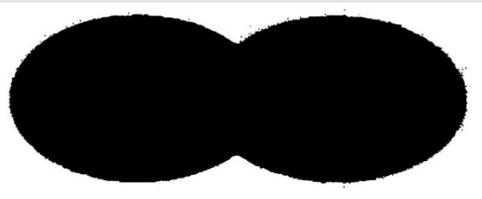


Court of Justice EU, 18 July 2013, Specsavers v Asda



v



## TRADEMARK LAW

Genuine use of registered trade mark used only in conjunction with a word mark which is superimposed over it is possible, to the extent that the differences between used and registered do not change the distinctive character

- that Article 15(1) and Article 51(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition of ‘genuine use’, within the meaning of those provisions, may be fulfilled where a Community figurative mark is used only in conjunction with a Community word mark which is superimposed over it, and the combination of those two marks is, furthermore, itself registered as a Community trade mark, to the extent that the differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of that trade mark as registered.

Fact that significant portion of public associates a color with third party is relevant for the global

assessment of (i) likelihood of confusion, (ii) unfair advantage or (iii) allegedly infringing sign

- that Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.

Therefore, in the main proceedings, the fact that Asda is itself associated with the colour green, which it uses for the signs alleged to infringe the trade marks of the Specsavers group, could, inter alia, result in a reduction of the likelihood of confusion or association between those signs and the trade marks of the Specsavers group, to the extent that the relevant public could perceive that the colour green of those signs is that of Asda, a matter which is to be determined by the referring court.

Secondly, as the Commission argued in its observations before the Court, the fact that the third party making use of a sign which is alleged to infringe the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign can be relevant to determining whether the use of that sign has a ‘due cause’ within the meaning of Article 9(1)(c) of Regulation No 207/2009.

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## Court of Justice EU, 18 July 2013

(M. Ilešič (Rapporteur), E. Jarašiūnas, A. Ó Caoimh, C. Toader and C.G. Fernlund,)

JUDGMENT OF THE COURT (Third Chamber)

18 July 2013 (\*)

“Trade marks – Regulation (EC) No 207/2009 – Articles 9(1)(b) and (c), 15(1) and 51(1)(a) – Grounds for revocation – Definition of ‘genuine use’ – Trade mark used together with another trade mark or as part of a compound trade mark – Colour or combination of colours in which a trade mark is used – Reputation”

In Case C-252/12,

Request for a preliminary ruling under Article 267 TFEU from the Court of Appeal (England & Wales) (Civil Division) (United Kingdom), made by decision of 26 April 2012, received at the Court on 16 May 2012, in the proceedings

Specsavers International Healthcare Ltd,  
Specsavers BV,  
Specsavers Optical Group Ltd,  
Specsavers Optical Superstores Ltd

v

Asda Stores Ltd,

THE COURT (Third Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, E. Jarašiūnas, A. Ó Caoimh, C. Toader and

C.G. Fernlund, Judges, Advocate General: J. Kokott, Registrar: L. Hewlett, Principal Administrator, having regard to the written procedure and further to the hearing on 20 March 2013, after considering the observations submitted on behalf of:

- Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd and Specsavers Optical Superstores Ltd, by A. Gold and K. Mattila, Solicitors, and by J. Mellor and A. Speck QC,
  - the United Kingdom Government, by L. Christie, acting as Agent, assisted by S. Malynicz, Barrister,
  - the German Government, by T. Henze, J. Kemper and V. Cramer, acting as Agents,
  - the European Commission, by F. Bulst and J. Samnadda, acting as Agents,
- having decided, after hearing the Advocate General, to proceed to judgment without an Opinion, gives the following

#### **Judgment**

1 This request for a preliminary ruling concerns the interpretation of Articles 9(1)(b) and (c), 15(1) and 51(1)(a) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The request has been made in proceedings between Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd and Specsavers Optical Superstores Ltd (together, ‘the Specsavers group’) and Asda Stores Ltd (‘Asda’) concerning an alleged infringement of Community trade marks registered by the Specsavers group.

#### **Legal context**

##### **International law**

3 Article 5.C(1) and (2) of the Convention for the Protection of Industrial Property signed in Paris on 20 March 1883, as last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (United Nations Treaties Series, No 11851, vol. 828, p. 305, ‘the Paris Convention’), provides:

*‘(1) If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.*

*‘(2) Use of a trade mark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union [for the Protection of Industrial Property, established pursuant to Article 1 of the Paris Convention] shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.’*

##### **European Union law**

4 Recital 10 in the preamble to Regulation No 207/2009 states:

*‘There is no justification for protecting Community trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used.’*

5 Article 7 of that regulation, which is entitled ‘Absolute grounds for refusal’, provides:

*‘(1) The following shall not be registered: ...*

*(b) trade marks which are devoid of any distinctive character;*

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;*

*(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;*

...

*(3) Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.’*

6 Article 9(1) of that regulation, entitled ‘Rights conferred by a Community trade mark’, provides:

*‘A Community 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:*

...

*(b) any sign where, because of its identity with, or similarity to, the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;*

*(c) any sign which is identical with, or similar to, the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the [European Union] and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.’*

7 Article 15(1) of that regulation, entitled ‘Use of Community trade marks’, is worded as follows:

*‘If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the [European Union] in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.*

*The following shall also constitute use within the meaning of the first subparagraph:*

*(a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;*

...

8 Article 51(1) of Regulation No 207/2009, entitled ‘Grounds for revocation’, states:

*‘The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office [for Harmonisation in the Internal Market*

(Trade Marks and Designs)] or on the basis of a counterclaim in infringement proceedings:

(a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the [European Union] in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;

...

**The background to the main proceedings and the questions referred for a preliminary ruling**

9 In October 2009, Asda, owner of a chain of supermarkets, launched an advertising campaign for optical products targeting the Specsavers group, since the latter is both the largest chain of opticians in the United Kingdom and Asda's main competitor. In the context of that campaign, Asda used the slogans 'Be a real spec saver at Asda' and 'Spec savings at ASDA', and the following logos:



10 Shortly after the beginning of that advertising campaign, on 19 October 2009, the Specsavers group brought an action before the High Court of Justice (England & Wales) (Civil Division) against Asda, alleging infringement of the following Community trade marks:

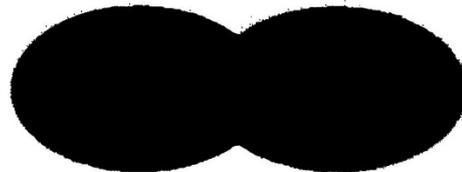
- the Community word marks No 1321298 and No 3418928, consisting of the word 'Specsavers';
- the Community figurative marks No 449256 and No 1321348, which cover the following sign ('the shaded logo marks');



- the Community figurative mark No 5608385, which covers the following sign:



- and the Community figurative mark No 1358589, which covers the following sign ('the wordless logo mark');



11 By judgment of 6 October 2010, the High Court of Justice (England & Wales) held that Asda had not infringed the Community trade marks of the Specsavers group. That court, moreover, revoked the wordless logo mark for non-use. The Specsavers group appealed to the Court of Appeal (England & Wales) (Civil Division) against that judgment.

12 By judgment of 31 January 2012, the referring court ruled on the dispute concerning the alleged infringement of Community word marks No 1321298 and No 3418928 and Community figurative marks No 449256, No 1321348 and No 5608385 of the Specsavers group. It held that the latter was, on the basis of those trade marks and in accordance with Article 9(1)(c) of Regulation No 207/2009, entitled to prevent Asda from using the slogans 'Be a real spec saver at Asda' and 'Spec savings at Asda' and the logo used by Asda in its advertising campaign.

13 The referring court considered, on the other hand, that, in order to rule on the aspect of the dispute concerning the wordless logo mark, it was necessary for it to refer questions to the Court on the following points.

14 First, and to the extent that Asda requested revocation of the rights in the wordless logo mark for non-use, the referring court raises the question whether use of the shaded logo marks can constitute use of the wordless logo mark.

15 Secondly, that court wishes to know whether the enhanced reputation of the device in the colour green, which the Specsavers group has always used to represent its wordless logo mark, can be taken into account in the context of Article 9(1)(b) and (c) of Regulation No 207/2009, despite the fact that that trade mark was registered in black and white. The referring court considers that that should be the case, but is nevertheless of the opinion that European Union law leaves room for interpretation in that regard.

16 In those circumstances, the Court of Appeal (England & Wales) (Civil Division) decided to stay

proceedings and refer the following questions to the Court for a preliminary ruling:

*'1. Where a trader has separate registrations of Community trade marks for*

*(a) a graphic device mark*

*(b) a word mark*

*and uses the two together, is such use capable of amounting to use of the [figurative] mark for the purposes of Articles 15 and 51 of Regulation [No 207/2009]? If yes, how is the question of use of the graphic mark to be assessed?*

*2. Does it make a difference if:*

*(a) the word mark is superimposed over the [figurative element]?*

*(b) the trader also has the combined mark comprising [the figurative element] and [the] word mark registered as a Community trade mark?*

*3. Does the answer to [the first and second questions] depend upon whether the graphic device and the words are perceived by the average consumer as [on the one hand] being separate signs; or [on the other hand] each having an independent distinctive role? If so, how?*

*4. Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours such that it has become associated in the mind of a significant portion of the public (in a part but not the whole of the [European Union]) with that colour or combination of colours, is the colour or colours with which the defendant uses the sign complained of relevant in the global assessment of [either the] likelihood of confusion under Article 9(1)(b) [of Regulation No 207/2009], or unfair advantage under Article 9(1)(c) of [that regulation]? If so, how?*

*5. If so, is it relevant as part of the global assessment that the defendant itself is associated in the mind of a significant portion of the public with the colour or particular combination of colours which it is using for the sign complained of?'*

#### **Consideration of the questions referred**

##### **The first three questions**

17 By its first three questions, which it is appropriate to consider together, the referring court asks, in essence, whether the condition of genuine use of a Community trade mark within the meaning of Article 15(1) and Article 51(1)(a) of Regulation No 207/2009 is fulfilled where a Community figurative mark is used only in conjunction with a Community word mark which is superimposed over it, and the combination of those two marks is, furthermore, itself registered as a Community trade mark.

18 All the parties which have submitted observations before the Court maintain, in essence, that the use of a Community figurative mark in conjunction with another word mark which is superimposed over it can amount to genuine use within the meaning of Article 15(1) and Article 51(1)(a) of Regulation No 207/2009, to the extent that that figurative mark retains an independent distinctive role in the overall design.

19 First of all, it should be pointed out that a situation such as that at issue in the main proceedings, in which a word mark is superimposed over a figurative mark, falls within the scope of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, namely, use of the trade mark in a form different from that under which that trade mark was registered.

20 The superimposition of the word sign 'Specsavers' over the wordless logo mark changes the form in which that trade mark was registered, in so far as it is not a mere juxtaposition, since certain parts of the wordless logo mark are thereby hidden by the word sign.

21 It should be noted, next, that it follows directly from the wording of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 that the use of the trade mark in a form which is different from the form in which it was registered is considered as a use for the purposes of the first subparagraph of that article, to the extent that the distinctive character of the trade mark in the form in which it was registered is not changed.

22 For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see, to that effect, [Joined Cases C-468/01 P to C-472/01 P Procter & Gamble v OHIM \[2004\] ECR I-5141, paragraph 32](#); [Case C-304/06 P Eurohypo v OHIM \[2008\] ECR I-3297, paragraph 66](#); and [Case C-311/11 P Smart Technologies v OHIM \[2012\] ECR I-0000, paragraph 23](#)).

23 That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking (see, by analogy, [Case C-353/03 Nestlé \[2005\] ECR I-6135, paragraph 30](#)).

24 It follows that the use of the wordless logo mark with the superimposed word sign 'Specsavers', even if, ultimately, it amounts to a use as a part of a registered trade mark or in conjunction with it, may be considered to be a genuine use of the wordless logo mark as such to the extent that that mark as it was registered, namely without a part of it being hidden by the superimposed word sign 'Specsavers', always refers in that form to the goods of the Specsavers group covered by the registration, which is to be determined by the referring court.

25 That conclusion is not affected by the fact that the word sign 'Specsavers' and the combination of the wordless logo with the superimposed word sign 'Specsavers' are also registered as Community trade marks.

26 The Court has already held that the condition of genuine use of a trade mark, within the meaning of Article 15(1) of Regulation No 207/2009, may be satisfied where the trade mark is used only through

another composite mark, or where it is used only in conjunction with another mark, and the combination of those two marks is, furthermore, itself registered as a trade mark (see, to that effect, Case C-12/12 Collosum Holding [2012] ECR I-0000, paragraphs 35 and 36).

27 Moreover, the Court has also held, in relation to Article 10(2)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which provision corresponds, in essence, to the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, that the proprietor of a registered trade mark is not precluded from relying, in order to establish use of the trade mark for the purposes of that provision, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two altering the distinctive character of that trade mark, even though that different form is itself registered as a trade mark ([Case C-553/11 Rintisch \[2012\] ECR I-0000, paragraph 30](#)).

28 The arguments which led the Court to interpret Article 10(2)(a) of Directive 89/104 in that way may be applied mutatis mutandis to the context of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009.

29 That interpretation is, in particular, supported by the objective pursued by the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 which, by avoiding imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered, is to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. That objective would be jeopardised if, in order to establish use of the registered trade mark, an additional condition had to be met, whereby the different form in which that mark is used should not itself have been registered as a trade mark (see, [by analogy, Rintisch, paragraphs 21 and 22](#)).

30 Moreover, that reading of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 is compatible with Article 5.C(2) of the Paris Convention, to the extent that nothing in that provision suggests that when a sign is registered as a trade mark the consequence is that use of the sign can no longer be relied on to establish use of another registered trade mark from which the sign only differs in a way that does not alter the distinctive character of the trade mark ([see Rintisch, paragraph 23](#)).

31 In view of all the foregoing considerations, the answer to the first three questions is that Article 15(1) and Article 51(1)(a) of Regulation No 207/2009 must be interpreted as meaning that the condition of 'genuine use', within the meaning of those provisions, may be fulfilled where a Community figurative mark is used only in conjunction with a Community word mark which is superimposed over it, and the combination of those two marks is, furthermore, itself registered as a Community trade mark, to the extent that the

differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of that trade mark as registered.

#### The fourth question

32 By its fourth question, the referring court asks whether Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours so that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under those provisions.

33 The Specsavers group and the European Commission submit that this question should be answered in the affirmative, whereas the Government of the United Kingdom considers, on the contrary, that it should be answered in the negative.

34 Concerning, in the first place, the assessment of the likelihood of confusion within the meaning of Article 9(1)(b) of Regulation No 207/2009, it should be recalled that, according to settled case-law, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, inter alia, [Case C-251/95 SABEL \[1997\] ECR I-6191, paragraph 22](#); [Case C-120/04 Medion \[2005\] ECR I-8551, paragraph 27](#); and [Case C-334/05 P OHIM v Shaker \[2007\] ECR I-4529, paragraph 34](#)).

35 The Court has also held on several occasions that the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, inter alia, [SABEL, paragraph 23](#); [Medion, paragraph 28](#); and [OHIM v Shaker, paragraph 35](#)).

36 Furthermore, according to the case-law of the Court, the more distinctive the trade mark, the greater the likelihood of confusion. Therefore, trade marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than trade marks with a less distinctive character ([Case C-39/97 Canon \[1998\] ECR I-5507, paragraph 18](#)).

37 At the very least where there is a trade mark which is registered not in a particular colour or characteristic, but in black and white, the colour or combination of colours in which the trade mark is later used affects how the average consumer of the goods at issue perceives that trade mark, and it is, therefore, liable to

increase the likelihood of confusion or association between the earlier trade mark and the sign alleged to infringe it.

38 In those circumstances, it would not be logical to consider that the fact that a third party, for the representation of a sign which is alleged to infringe an earlier Community trade mark, uses a colour or combination of colours which has become associated, in the mind of a significant portion of the public, with that earlier trade mark by the use which has been made of it by its proprietor in that colour or combination of colours, cannot be taken into consideration in the global assessment for the sole reason that that earlier trade mark was registered in black and white.

39 Concerning, in the second place, the examination of whether any unfair advantage has been taken of the distinctive character or reputation of the trade mark within the meaning of Article 9(1)(c) of Regulation No 207/2009, it is necessary to undertake a global assessment, taking into account all the factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of its distinctive character, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it ([see Case C-487/07 L'Oréal and Others \[2009\] ECR I-5185, paragraph 44](#)).

40 In that regard, it is clear from the order for reference that the similarity between the trade marks of the Specsavers group and the signs used by Asda was created intentionally in order to create an association in the mind of the public between the two trade signs. The fact that Asda used a similar colour to that used by the Specsavers group with the intention of taking advantage of the distinctive character and reputation of the latter's trade marks is a factor which must be taken into account in order to ascertain whether it can be held that unfair advantage is being taken of the distinctive character or reputation of the trade mark ([see, by analogy, L'Oréal and Others, paragraph 48](#)).

41 In view of the above, the answer to the third question is that Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.

#### **The fifth question**

42 By its fifth question, the referring court asks whether Article 9(1)(b) and (c) of Regulation No

207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.

43 The Specsavers group proposes that this question should be answered in the affirmative, whereas the Commission considers, on the other hand, that that factor can be taken into consideration only for the purposes of assessing due cause under Article 9(1)(c) of Regulation No 207/2009. To the extent that it proposes that the fourth question should be answered in the negative, the Government of the United Kingdom considers that there is no need to answer the fifth question.

44 In that regard, it should be noted that, as was pointed out in paragraphs 34 and 39 of the present judgment, both the likelihood of confusion under Article 9(1)(b) of Regulation No 207/2009 and unfair advantage under Article 9(1)(c) of that regulation must be assessed globally, taking into account all the relevant factors of the present case.

45 Moreover, it is apparent from the case-law of the Court that those assessments must take account of the precise context in which the sign which is allegedly similar to the registered trade mark was used (see, to that effect, concerning Article 5(1) of Directive 89/104, [Case C-533/06 O2 Holdings and O2 \(UK\) \[2008\] ECR I-4231, paragraph 64](#)).

46 In those circumstances, it should be noted that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is a factor which, amongst others, may have a certain importance while determining the existence of a likelihood of confusion or unfair advantage under Article 9(1)(b) or (c) of Regulation No 207/2009.

47 First, it is not inconceivable that such a fact could influence the public's perception of the signs at issue, and, therefore, have an effect on the existence of a likelihood of confusion between those signs for the purposes of Article 9(1) of that regulation.

48 Therefore, in the main proceedings, the fact that Asda is itself associated with the colour green, which it uses for the signs alleged to infringe the trade marks of the Specsavers group, could, inter alia, result in a reduction of the likelihood of confusion or association between those signs and the trade marks of the Specsavers group, to the extent that the relevant public could perceive that the colour green of those signs is that of Asda, a matter which is to be determined by the referring court.

49 Secondly, as the Commission argued in its observations before the Court, the fact that the third party making use of a sign which is alleged to infringe

the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign can be relevant to determining whether the use of that sign has a '*due cause*' within the meaning of Article 9(1)(c) of Regulation No 207/2009.

50 The answer to the fifth question is, therefore, that Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.

#### **Costs**

51 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 (Third Chamber) hereby rules:**

1. Article 15(1) and Article 51(1)(a) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the condition of '*genuine use*', within the meaning of those provisions, may be fulfilled where a Community figurative mark is used only in conjunction with a Community word mark which is superimposed over it, and the combination of those two marks is, furthermore, itself registered as a Community trade mark, to the extent that the differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of that trade mark as registered.

2. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.

3. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.

\* Language of the case: English.