

Court of Justice EU, 20 July 2017, Ornu v Tindale



## TRADE MARK LAW

The fact that EU trade mark and national mark peacefully coexist in part of the European Union does not allow the conclusion that in another part of the European Union, where peaceful coexistence between that EU trade mark and the sign identical to that national mark is absent, there is no likelihood of confusion

• Article 9(1)(b) of Regulation No 207/2009 must be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark and a national mark peacefully coexist, does not allow the conclusion that in another part of the European Union, where peaceful coexistence between that EU trade mark and the sign identical to that national mark is absent, there is no likelihood of confusion between that EU trade mark and that sign.

The European Union trade marks court hearing an infringement action, may take into account a part of the European Union not covered by that action, provided that the market conditions and the sociocultural circumstances are not significantly different in both of those parts of the European Union

• Article 9(1)(b) of Regulation No 207/2009 must be interpreted as meaning that the elements which, according to the European Union trade marks court hearing an infringement action, are relevant for assessing whether the proprietor of an EU trade mark is entitled to prohibit the use of a sign in part of the European Union not covered by that action, may be taken into account by that court to assess whether that proprietor is entitled to prohibit the use of that sign in the part of the European Union which is the subject of the infringement action, provided that the market conditions and the sociocultural circumstances are not significantly different in one of those parts of the European Union and in the other.

46. Although, for the purpose of assessing whether Ornu is entitled to prohibit the use of the sign KERRYMAID in Spain, the referring court should consider taking into account elements present in Ireland and the United Kingdom, it should first of all ensure that there is no significant difference between the market conditions or the sociocultural circumstances which may be observed, respectively, in the part of the European Union covered by the infringement action and in that in which the geographical area corresponding to the geographical word contained in the sign at issue. It cannot be excluded that the conduct

which can be expected of the third party so that its use of the sign follows honest practices in industrial or commercial matters must be analyzed differently in a part of the European Union where consumers have a particular affinity with the geographical word contained in the mark and the sign at issue than in a part of the European Union where that affinity is weaker.

The fact that an EU trade mark and sign coexist peacefully in part of the European Union, does not allow the conclusion that in another part of the European Union, where that peaceful coexistence is absent, there is due cause legitimizing the use of that sign

• Article 9(1)(c) of Regulation No 207/2009 must be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark with a reputation and a sign peacefully coexist, does not allow the conclusion that in another part of the European Union, where that peaceful coexistence is absent, there is due cause legitimizing the use of that sign.

57. As has already been pointed out in paragraph 35 of the present judgment, it is also common ground that such peaceful coexistence is absent in the part of the territory of the European Union which is the subject of the infringement action, namely Spain, and that T & S's use of the sign KERRYMAID takes place there without Ornu's consent.

[...]

59. It follows that, in the present case, where there is due cause legitimizing the use of the sign KERRYMAID in Ireland and the United Kingdom because of the peaceful coexistence between the KERRYGOLD EU trade marks and the national mark at issue in those two Member States, the European Union trade marks court hearing an infringement action in respect of the use of that sign in another Member State cannot merely base its assessment on that peaceful coexistence in Ireland and the United Kingdom, but must, on the contrary, make a global assessment of all the relevant factors.

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## Court of Justice EU, 20 July 2017

(M. Ilešič (Rapporteur), A. Prechal, A. Rosas, C. Toader and E. Jarašiūnas)

JUDGMENT OF THE COURT (Second Chamber)

20 July 2017 (\*)

(Reference for a preliminary ruling — Intellectual property — EU trade mark — Unitary character — Regulation (EC) No 207/2009 — Article 9(1)(b) and (c) — Uniform protection of the right conferred by an EU trade mark against the likelihood of confusion and detriment to reputation — Peaceful coexistence of that mark with a national mark used by a third party in part of the European Union — Absence of peaceful coexistence elsewhere in the European Union — Perception of the average consumer — Differences of

perception may exist in different parts of the European Union)

In Case C-93/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Audiencia Provincial de Alicante (Provincial Court, Alicante, Spain), made by decision of 8 February 2016, received at the Court on 15 February 2016, in the proceedings

Ornu Co-operative Ltd, formerly The Irish Dairy Board Co-operative Ltd,

v

Tindale & Stanton Ltd España SL,

THE COURT (Second Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, A. Prechal, A. Rosas, C. Toader and E. Jarašiūnas, Judges,

Advocate General: M. Szpunar,

Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 18 January 2017, after considering the observations submitted on behalf of:

– Ornu Co-operative Ltd, formerly The Irish Dairy Board Co-operative Ltd, by E. Armijo Chávarri, abogado,

– Tindale & Stanton Ltd España SL, by A. von Mühlendahl and J. Güell Serra, abogados,

– the German Government, by T. Henze and M. Hellmann, acting as Agents,

– the French Government, by D. Colas and D. Segoin, acting as Agents,

– the European Commission, by É. Gippini Fournier and T. Scharf and J. Samnadda, acting as Agents,

after [hearing the Opinion of the Advocate General at the sitting on 29 March 2017](#), gives the following

#### Judgment

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

2. The request has been made in proceedings between Ornu Co-operative Ltd, formerly The Irish Dairy Board Co-operative Ltd ('Ornu'), and Tindale & Stanton Ltd España SL ('T & S') concerning the use by the latter of a sign which, according to Ornu, gives rise to a likelihood of confusion with the EU trade marks of which it is the proprietor and affects the reputation of those marks.

#### Legal context

3. Regulation No 207/2009, which repealed and replaced Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. However, given the date of the facts at issue in the main proceedings, the present reference for a preliminary ruling will be considered in the light of Regulation No 207/2009 such as it was in force before that amendment.

4. Under recital 3 of that regulation:

*'For the purpose of pursuing the [EU's] ... objectives it would appear necessary to provide for ... arrangements for trade marks whereby undertakings can by means of one procedural system obtain [EU] trade marks to which uniform protection is given and which produce their effects throughout the entire area of the [European Union]. The principle of the unitary character of the [EU] trade mark thus stated should apply unless otherwise provided for in this Regulation.'*

5. Article 1(2) of that regulation, which forms part of Title I thereof, headed 'General provisions', provides *'A[n EU] trade mark shall have a unitary character. It shall have equal effect throughout the [European Union]: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole [of the European Union]. This principle shall apply unless otherwise provided in this Regulation.'*

6. Title II of that regulation is entitled 'The law relating to trade marks'. Section 2, entitled 'Effects of [EU] trade marks', includes, inter alia, Articles 9 and 12, which are entitled 'Rights conferred by a[n EU] trade mark' and 'Limitation of the effects of a[n EU] trade mark' respectively.

7. Under Article 9(1):

*'A[n EU] 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 [EU] trade mark in relation to goods or services which are identical with those for which the [EU] trade mark is registered;*

*(b) any sign where, because of its identity with, or similarity to, the [EU] trade mark and the identity or similarity of the goods or services covered by the [EU] 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 [EU] trade mark in relation to goods or services which are not similar to those for which the [EU] 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 [EU] trade mark.'*

8. Article 12 provides:

*'A[n EU] trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:*

*(a) his own name or address;*

*(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;*

*(c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts, provided he uses them in*

*accordance with honest practices in industrial or commercial matters.'*

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

9. Ornu is a company incorporated under Irish law whose economic activities are in the food sector. It markets, inter alia, butter and other dairy products.

10. It is the proprietor of several EU trade marks, including the word mark KERRYGOLD, registered in 1998 for goods in Class 29 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, namely, in particular butter and other dairy products, and the following two figurative marks registered respectively in 1998 and 2011 for the same class of goods (together, 'the KERRYGOLD EU trade marks'):



11. The goods on which those marks are affixed are exported to several countries. In the European Union, those goods are mainly sold in Spain, Belgium, Denmark, Germany, Ireland, Greece, France, Cyprus, Luxembourg, Malta, the Netherlands and the United Kingdom.

12. T & S is a company incorporated under Spanish law which imports and distributes, in Spain, margarines under the sign KERRYMAID. Those goods are manufactured in Ireland by Kerry Group plc.

13. Kerry Group has registered, in Ireland and the United Kingdom, the national mark KERRYMAID.

14. On 29 January 2014, the Irish Dairy Board Co-operative, which became Ornu on 31 March 2015, brought an infringement action against T & S before the Juzgado de lo Mercantil de Alicante (Alicante Commercial Court, Spain) in its capacity as a court dealing with EU trade marks, for a declaration that T & S, in so far as it imports and distributes margarines in Spain under the sign KERRYMAID, infringes the rights conferred by the KERRYGOLD EU trade marks. The use of the sign KERRYMAID by T & S would, in its view, give rise to a likelihood of confusion and would, without due cause, take unfair advantage of the distinctive character and repute of those marks.

15. That court first held that the only similarity between the sign KERRYMAID and the KERRYGOLD EU trade marks relates to the element 'kerry', which refers to an Irish county known for its cattle breeding.

16. That court then stated that it was common ground between the parties that in Ireland and in the United Kingdom the KERRYGOLD EU trade marks and the KERRYMAID national trade mark peacefully coexisted.

17. That court held that there was no likelihood of confusion between the KERRYGOLD EU trade marks and the sign KERRYMAID in Spain. Since Ireland and the United Kingdom together have a significant demographic weight in the European Union, the peaceful coexistence between those marks and that sign in those two Member States should, in view of the unitary character of the EU trade mark, lead to the conclusion that there is no likelihood of confusion between those marks and that sign throughout the entire area of the European Union.

18. Lastly, the same court held that, because of the peaceful coexistence in Ireland and the United Kingdom, there cannot be an unfair advantage taken by T & S in Spain of the distinctive character or repute of the KERRYGOLD EU trade marks.

19. On the basis of those considerations, the Juzgado de lo Mercantil de Alicante (Commercial Court, Alicante), by judgment of 18 March 2015, dismissed the infringement action.

20. That judgment was the subject of an appeal before the referring court.

21. Having regard to the finding that the peaceful coexistence between the KERRYGOLD EU trade marks and the sign KERRYMAID is established only in Ireland and the United Kingdom, the referring court has doubts as to the compatibility with Regulation No 207/2009 of the extrapolation which the court of first instance has made. If the peaceful coexistence between those marks and that sign in Ireland and the United Kingdom leads to the result that there is no likelihood of confusion in those two Member States, it does not follow that, according to the referring court, there is also no likelihood of confusion between those marks and that sign in the other Member States. Such an extrapolation would render redundant the rights conferred on the proprietor of the EU trade mark under Article 9 of Regulation No 207/2009.

22. In those circumstances, the Audiencia Provincial de Alicante (Provincial Court of Alicante, Spain) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

*'(1) In so far as Article 9(1)(b) of [Regulation No 207/2009] requires that, in order for the proprietor of an [EU] trade mark to prevent a third party not having his consent from using a sign in the course of trade in the cases set out in that provision, there should exist a likelihood of confusion, can this provision be interpreted as meaning that there is no likelihood of confusion where the earlier [EU] trade mark has, owing to the acquiescence of the proprietor, peacefully coexisted for some years with similar national trade marks in two Member States of the European Union, so that the absence of a likelihood of confusion in those two Member States is extended to other Member States, or to the European Union as a whole, regard being had to the unitary treatment that the [EU] trade mark requires?*

*(2) In the situation set out in the previous paragraph, can the geographical, demographic, economic or other*

*circumstances of the States in which the coexistence has occurred be taken into consideration for the purpose of assessing the likelihood of confusion, so that the absence of a likelihood of confusion in those Member States can be extended to a third Member State, or to the European Union as a whole?*

*(3) With regard to the case referred to in subparagraph (c) of Article 9(1) of [Regulation No 207/2009], must this provision be interpreted as meaning that, where an earlier trade mark has coexisted with the contested sign for a certain number of years in two European Union Member States without the proprietor of the earlier trade mark opposing it, this acquiescence on the part of the proprietor towards the use of the later sign in these two States in particular can be extended to the remaining territory of the European Union for the purpose of determining whether there is due cause for a third party's use of the later sign, on account of the unitary treatment that the [EU] trade mark requires?'*

23. The Court sent the referring court a request for clarification as to whether that court is required to include, in its application of Regulation No 207/2009, an examination of the assessment made by the court of first instance according to which, in view of the presence of the geographical indication of origin 'kerry' in the signs at issue and the lack of similarity between the elements 'gold' and 'maid', there cannot in any event be a likelihood of confusion.

24. The referring court replied in the affirmative to that request for clarification.

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

##### **The first question**

25. By its first question, the referring court asks, in essence, whether Article 9(1)(b) of Regulation No 207/2009 is to be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark and a national mark peacefully coexist, allows, in view of the unitary nature of the EU trade mark, the conclusion that in another part of the European Union, where peaceful coexistence between that EU trade mark and the sign identical to that national mark is absent, there is an absence of the likelihood of confusion between that EU trade mark and that sign.

26. As that question is referred from the perspective of the unitary character of the EU trade mark, it should be stated at the outset that, pursuant to that principle, expressed in recital 3 of Regulation No 207/2009 and specified in Article 1(2) thereof, EU trade marks are given uniform protection and produce their effects throughout the entire area of the European Union. Under Article 1(2), the EU trade mark may not, save as otherwise provided in that regulation, be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole [of the European Union].

27. Although Article 1(2) of Regulation No 207/2009 refers only to the registration of the trade mark, the transfer thereof, the loss of the rights conferred by the trade mark and the prohibition on making use of the latter, it is, however, clear from a combined reading of

that article and recital 3 of that regulation that the effects of the EU trade mark listed under Section 2 of Title II of that regulation apply, as well, in a uniform manner throughout the entire territory of the European Union.

28. Accordingly, the Court has already held that the exclusive right conferred by an EU trade mark on its proprietor, under Article 9(1) of Regulation No 207/2009, extends, as a rule, to the entire area of the European Union (see, to that effect, judgment of 12 April 2011, [DHL Express France, C-235/09, EU:C:2011:238](#), paragraph 39).

29. As regards Article 9(1)(b) of that regulation, it is clear from the settled case-law of the Court that that article protects the proprietor of an EU trade mark against any use which adversely affects that trade mark's function of indicating origin or is liable to do so (judgment of 22 September 2016, [combit Software, C-223/15, EU:C:2016:719](#), paragraph 27 and the case-law cited).

30. The uniform protection thus conferred on the proprietor of the EU trade mark by that article is to entitle that proprietor, throughout the European Union, to prohibit a third party from using, in the course of trade and without the consent of that proprietor, an identical or similar sign for identical or similar goods or services which adversely affects that trade mark's function of indicating origin or is liable to do so and thus gives rise to a likelihood of confusion.

31. In order for the proprietor of the EU trade mark to avail himself of that right, there is no need for the use of the identical or similar sign creating a likelihood of confusion to take place throughout the entire territory of the European Union.

32. If the proprietor of the EU trade mark was only protected against infringements committed throughout the entire territory of the European Union, he would not be able to contest the use of identical or similar signs which give rise to a likelihood of confusion in only part of that territory, even though Article 9(1)(b) of Regulation No 207/2009 is intended to protect that proprietor, throughout the European Union, against any use which adversely affects his trade mark's function of indicating origin.

33. Consequently, when the use of a sign gives rise, in one part of the European Union, to a likelihood of confusion with an EU trade mark, whilst, in another part of the European Union, that same use does not give rise to such a likelihood of confusion, there is an infringement of the exclusive right conferred by that trade mark. In that case, the European Union trade marks court hearing the case must prevent the marketing of the goods concerned under the sign at issue throughout the entire territory of the European Union, with the exception of the part in respect of which there has been found to be no likelihood of confusion (judgment of 22 September 2016, [combit Software, C-223/15, EU:C:2016:719](#), paragraphs 25 and 36).

34. In the present case, it is clear from the documents before the Court that it is common ground between the

parties to the main proceedings that there is peaceful coexistence between the KERRYGOLD EU trade marks and the national mark KERRYMAID in Ireland and the United Kingdom, since Ornu does not therefore oppose the use of that national mark in those Member States.

35. It is also common ground that such peaceful coexistence is absent in the part of the territory of the European Union which is the subject of the infringement action, namely Spain, and that T & S's use of the sign KERRYMAID takes place there without Ornu's consent.

36. It is clear, moreover, from the case-law of the Court that the examination of the likelihood of confusion in part of the European Union must be based on a global assessment of all the relevant factors in the case concerned and that that assessment must include a visual, phonetic or conceptual comparison of the mark and the sign used by the third party, which may lead, in particular for linguistic reasons, to different conclusions for one part of the European Union and for another (see, to that effect, judgment of 22 September 2016, [combit Software, C-223/15, EU:C:2016:719](#), paragraphs 31 and 33 and the case-law cited).

37. It follows, as the [Advocate General stated in point 39 of his Opinion](#), that in a situation such as that in the case in the main proceedings, in which peaceful coexistence between EU trade marks and a sign has been found in Ireland and the United Kingdom, the European Union trade marks court hearing infringement proceedings on the use of that sign in another Member State, here the Kingdom of Spain, cannot merely base its assessment on the peaceful coexistence prevailing in Ireland and the United Kingdom. That court must, on the contrary, make a global assessment of all the relevant factors.

38. Having regard to those considerations, the answer to the first question is that Article 9(1)(b) of Regulation No 207/2009 must be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark and a national mark peacefully coexist, does not allow the conclusion that in another part of the European Union, where peaceful coexistence between that EU trade mark and the sign identical to that national mark is absent, there is no likelihood of confusion between that EU trade mark and that sign.

#### **The second question**

39. By its second question, the referring court asks, in essence, whether Article 9(1)(b) of Regulation No 207/2009 must be interpreted as meaning that the elements which, according to the European Union trade marks court hearing an infringement action, are relevant to assess whether the proprietor of an EU trade mark is entitled to prohibit the use of a sign in part of the European Union not covered by that action, may be taken into account by that court to assess whether that proprietor is entitled to prohibit the use of that sign in the part of the European Union which is the subject of that infringement action.

40. As has been stated in paragraph 36 of the present judgment, the examination to be carried out by the

competent European Union trade marks court must be based on a global assessment of all of the relevant factors of the case before it.

41. That global assessment must, as regards the visual, auditory or conceptual comparison between the EU trade mark at issue and the sign used by the third party, be based on the overall impression produced by that mark and that sign on the relevant public, which comprises the average consumer of the goods or services concerned, who is reasonably well informed and reasonably observant and circumspect (see, to that effect, judgment of 25 June 2015, [Loutfi Management Propriété Intellectuelle, C-147/14, EU:C:2015:420](#), paragraphs 21 and 25 and the case-law cited).

42. As the [Advocate General stated in points 41 and 42 of his Opinion](#), where the market conditions and the sociocultural or other circumstances contributing to the overall impression produced by the EU trade mark and the sign at issue on the average consumer do not vary significantly from one part of the European Union to another, there is nothing to prevent the relevant factors, the presence of which in part of the European Union has been established, being taken into account in assessing whether the proprietor of that trade mark is entitled to prohibit the use of that sign in another part of the European Union or throughout the entire territory of the European Union.

43. In the present case, as is clear from the reply to the request for clarification and to the observations submitted to the Court, T & S claims inter alia that the sign KERRYMAID, used by it in Spain, is not similar to Ornu's KERRYGOLD EU trade marks and cannot therefore give rise to a likelihood of confusion within the meaning of Article 9(1)(b) of Regulation No 207/2009, since the element 'kerry' is an indication of geographical origin which, according to Article 12 of that regulation, is not covered by the exclusive right conferred on Ornu by Article 9 thereof.

44. The restriction of the exclusive right conferred by Article 9 of Regulation No 207/2009 to which T & S refers is subject to the condition that the use of the sign with the indication of geographical origin complies with honest practices in industrial or commercial matters. In order to examine whether that condition, which is an expression of an obligation of loyalty to the legitimate interests of the proprietor of the mark, is satisfied, the court hearing the case must make a global assessment of all the relevant circumstances (see, inter alia, judgments of 7 January 2004, [Gerolsteiner Brunnen, C-100/02, EU:C:2004:11](#), paragraphs 24 and 26; of 16 November 2004, [Anheuser-Busch, C-245/02, EU:C:2004:717](#), paragraphs 82 and 84; and of 17 March 2005, [Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraph 41).

45. In that regard, account should be taken, in particular, of the overall presentation of the product marketed by the third party, the circumstances in which a distinction is made between that mark and the sign used by that third party, and the effort made by that third party to ensure that consumers distinguish its

products from those of which it is not the trade mark owner (see, to that effect, judgment of 17 March 2005, [Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraph 46).

46. Although, for the purpose of assessing whether Ornu is entitled to prohibit the use of the sign KERRYMAID in Spain, the referring court should consider taking into account elements present in Ireland and the United Kingdom, it should first of all ensure that there is no significant difference between the market conditions or the sociocultural circumstances which may be observed, respectively, in the part of the European Union covered by the infringement action and in that in which the geographical area corresponding to the geographical word contained in the sign at issue. It cannot be excluded that the conduct which can be expected of the third party so that its use of the sign follows honest practices in industrial or commercial matters must be analysed differently in a part of the European Union where consumers have a particular affinity with the geographical word contained in the mark and the sign at issue than in a part of the European Union where that affinity is weaker.

47. In the light of the foregoing, the answer to the second question is that Article 9(1)(b) of Regulation No 207/2009 must be interpreted as meaning that the elements which, according to the European Union trade marks court hearing an infringement action, are relevant for assessing whether the proprietor of an EU trade mark is entitled to prohibit the use of a sign in part of the European Union not covered by that action, may be taken into account by that court to assess whether that proprietor is entitled to prohibit the use of that sign in the part of the European Union which is the subject of the infringement action, provided that the market conditions and the sociocultural circumstances are not significantly different in one of those parts of the European Union and in the other.

#### **The third question**

48. By its third question, the referring court seeks, in essence, to ascertain whether Article 9(1) (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark with a reputation and a sign peacefully coexist, having regard to the unitary character of the EU trade mark, allows the conclusion that in another part of the European Union, where that peaceful coexistence is absent, there is due cause legitimising the use of that sign.

49. As was pointed out in paragraph 28 of the present judgment, the exclusive right conferred by the EU trade mark on its proprietor pursuant to Article 9(1) of Regulation No 207/2009, extends, as a rule, to the entire territory of the European Union.

50. The extended protection conferred by Article 9(1)(c) of that regulation on proprietors of EU trade marks with a reputation consists in empowering those holders to prohibit any third party from making, in the course of trade and without the consent of the proprietor, use without due cause of an identical or similar sign — whether for similar goods or services or

for goods or services not similar to those for which those marks are registered — which takes unfair advantage of the distinctive character or the repute of those marks or is detrimental to that distinctive character or repute (see, to that effect, judgment of 22 September 2011, [Interflora and Interflora British Unit, C-323/09, EU:C:2011:604](#), paragraphs 68 and 70).

51. So that the proprietor of an EU trade mark has that extended protection, it must be established, within the meaning of Article 9(1)(c) of that regulation that that mark has a ‘reputation in the [European Union]’. To that end, it is sufficient that it be established that the mark has such a reputation in a substantial part of the territory of the European Union, and that part may, in some circumstances, correspond to the territory of a single Member State. If that condition is satisfied, the EU trade mark at issue must be held to have a reputation in the whole of the European Union (judgments of 6 October 2009, [PAGO International, C-301/07, EU:C:2009:611](#), paragraphs 27, 29 and 30, and of 3 September 2015, [Iron & Smith, C-125/14, EU:C:2015:539](#), paragraphs 19 and 20).

52. That case-law ensures that the proprietor of an EU trade mark can either be entitled to the extended protection conferred by Article 9(1)(c) of Regulation No 207/2009 throughout the European Union, or cannot rely on it at all. Accordingly, the scope of the protection conferred by any EU trade mark has a uniform character on the entire territory of the European Union.

53. In contrast, in order for the proprietor of an EU trade mark having that extended protection to be able to rely on his right conferred by Article 9(1)(c), it is not at all necessary that the use of the sign infringing that right takes place on the entire territory of the European Union.

54. If that proprietor were only protected against infringements committed on the entire territory of the European Union, it would be impossible to contest infringements committed in only part of that territory, even though the purpose of Article 9(1)(c) of Regulation No 207/2009 is to protect that proprietor, throughout the European Union, from any use without due cause of an identical or similar sign which takes unfair advantage of the distinctive character or the repute of those marks or is detrimental to that distinctive character or repute.

55. In the present case, subject to verification by the referring court, it does not appear to be disputed that the KERRYGOLD EU trade marks have a reputation within the meaning of Article 9(1)(c) of Regulation No 207/2009.

56. Moreover, it is clear from the documents submitted to the Court that it is common ground between the parties to the main proceedings that there is, because of the peaceful coexistence in Ireland and the United Kingdom between those marks and the national mark KERRYMAID, due reason for the use of that sign in that part of the European Union.

57. As has already been pointed out in paragraph 35 of the present judgment, it is also common ground that such peaceful coexistence is absent in the part of the territory of the European Union which is the subject of the infringement action, namely Spain, and that T & S's use of the sign KERRYMAID takes place there without Ornu's consent.

58. Moreover, it is clear from the settled case-law of the Court that the examination of the existence of an infringement referred to in Article 9(1)(c) of Regulation No 207/2009 must be based on a global assessment which takes into account all the factors relevant to the case (judgments of 18 June 2009, [L'Oréal and Others, C-487/07, EU:C:2009:378](#), paragraph 44, and of 18 July 2013, [Specsavers International Healthcare and Others, C-252/12, EU:C:2013:497](#), paragraph 39).

59. It follows that, in the present case, where there is due cause legitimising the use of the sign KERRYMAID in Ireland and the United Kingdom because of the peaceful coexistence between the KERRYGOLD EU trade marks and the national mark at issue in those two Member States, the European Union trade marks court hearing an infringement action in respect of the use of that sign in another Member State cannot merely base its assessment on that peaceful coexistence in Ireland and the United Kingdom, but must, on the contrary, make a global assessment of all the relevant factors.

60. Therefore, the answer to the third question is that Article 9(1)(c) of Regulation No 207/2009 must be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark with a reputation and a sign peacefully coexist, does not allow the conclusion that in another part of the European Union, where that peaceful coexistence is absent, there is due cause legitimising the use of that sign.

#### Costs

61. 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. Article 9(1)(b) Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark must be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark and a national mark peacefully coexist, does not allow the conclusion that in another part of the European Union, where peaceful coexistence between that EU trade mark and the sign identical to that national mark is absent, there is no likelihood of confusion between that EU trade mark and that sign.

2. Article 9(1)(b) of Regulation No 207/2009 must be interpreted as meaning that the elements which, according to the European Union trade marks court hearing an infringement action, are relevant for assessing whether the proprietor of an EU trade mark is

entitled to prohibit the use of a sign in part of the European Union not covered by that action, may be taken into account by that court to assess whether that proprietor is entitled to prohibit the use of that sign in the part of the European Union which is the subject of the infringement action, provided that the market conditions and the sociocultural circumstances are not significantly different in one of those parts of the European Union and in the other.

3. Article 9(1)(c) of Regulation No 207/2009 must be interpreted as meaning that the fact that, in part of the European Union, an EU trade mark with a reputation and a sign peacefully coexist, does not allow the conclusion that in another part of the European Union, where that peaceful coexistence is absent, there is due cause legitimising the use of that sign.

[Signatures]

\* Language of the case: Spanish.

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#### OPINION OF ADVOCATE GENERAL SZPUNAR

delivered on 29 March 2017 (1)

Case C-93/16

Ornu Co-operative Limited, formerly The Irish Dairy Board Co-operative Limited

v

Tindale & Stanton Ltd España SL

(Request for a preliminary ruling from the Audiencia Provincial de Alicante (Provincial Court, Alicante, Spain))

(Reference for a preliminary ruling — European Union trade mark — Regulation (EC) No 207/2009 — Unitary character — Article 1 — Likelihood of confusion — Detriment to reputation — Article 9(1)(b) and (c) — Trade marks at issue containing an indication of geographical origin — Peaceful coexistence of conflicting trade marks in part of the European Union)

#### Introduction

1. This request for a preliminary ruling was made in the course of a dispute arising from a conflict between the signs KERRYGOLD and KERRYMAID. While the signs at issue, which are protected as a European Union trade mark and a national trade mark, respectively, have coexisted peacefully in Ireland and the United Kingdom for more than 20 years, the present dispute (pending before a Spanish court hearing the matter in its capacity as a court dealing with EU trade marks) concerns a conflict between these two signs in the rest of the European Union.

2. The specific context of the present case presents the Court with an opportunity to develop its case-law relating to the principle of the unitary character of the EU trade mark. (2) It will be necessary, in particular, to clarify how the assessment of the likelihood of confusion, on the one hand, and detriment to reputation, on the other, under Article 9(1)(b) and (c) of Regulation (EC) No 207/2009, (3) must take two factors into account, namely, first, the fact that the trade marks at issue coexist peacefully in part of the

European Union and, secondly, the fact that they contain an indication of geographical origin. (4)

**Legal context**

3. Article 1(2) of Regulation No 207/2009 provides as follows:

*'A [European Union] trade mark shall have unitary character. It shall have equal effect throughout the [Union]: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole [Union]. This principle shall apply unless otherwise provided in this Regulation.'*

4. Article 9(1) of that regulation provides:

*'A [European Union] trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:*

...

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

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

5. Article 12 of that regulation provides:

*'A [European Union] trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:*

...

*(b) indications concerning ... geographical origin ...,*

...

*provided he uses them in accordance with honest practices in industrial or commercial matters.'*

**The dispute in the main proceedings**

6. The Irish company Ornu Co-operative Limited, formerly The Irish Dairy Board Co-operative Limited ('Ornu'), is the proprietor of the EU word mark KERRYGOLD, registered in 1998, and two figurative marks containing the same word element, registered respectively in 1998 and 2011 for food products (taken together, 'the KERRYGOLD marks').

7. The Spanish company Tindale & Stanton Ltd España SL ('T&S') imports and distributes in Spain, under the sign KERRYMAID, dairy products made by Kerry Group plc.

8. Kerry Group is the proprietor of the KERRYMAID national word marks, registered in Ireland and the United Kingdom.

9. On 29 January 2014, Ornu brought an infringement action against T&S before the Juzgado de lo Mercantil de Alicante (Commercial Court, Alicante, acting in its capacity as a court dealing with EU trade marks in Spain), claiming that the use of the sign KERRYMAID constituted an infringement of the KERRYGOLD marks. That action was based on Article 9(1)(b) and (c) of Regulation No 207/2009.

10. That court dismissed the action on the ground that the only similarity between the trade marks at issue lay in the common element 'Kerry', which refers to the Irish county known for cattle breeding, and that it had been established that those trade marks coexisted peacefully in Ireland and the United Kingdom.

11. Indeed, according to that court, the effects of the peaceful coexistence of the marks in those two Member States should, having regard to the unitary character of the EU trade mark, be extrapolated to the European Union as a whole. For the same reason, no unfair advantage is being taken of the distinctive character or of the repute of the trade marks relied on since the sign KERRYMAID is used in Spain for the purposes of marketing a product which has, for a number of years, been marketed in other Member States without being opposed by the proprietor of the KERRYGOLD marks.

12. Ornu appealed against that judgment before the referring court.

13. The referring court states that the KERRYGOLD marks have a reputation in the whole of the European Union. It observes that the proprietor of those trade marks recognises their peaceful coexistence with the KERRYMAID trade mark only in Ireland and in the United Kingdom. The referring court is therefore uncertain whether that fact can be taken into account in the assessment of the likelihood of confusion, on the one hand, and detriment to reputation, on the other in respect of the entire territory of the European Union.

The questions referred and procedure before the Court  
14. In those circumstances the Audiencia Provincial de Alicante (Provincial Court, Alicante, Spain) decided to stay the proceedings and refer the following questions to the Court for a preliminary ruling:

*'(1) In so far as Article 9(1)(b) of [Regulation No 207/2009] requires that, in order for the proprietor of [an EU] trade mark to prevent a third party not having his consent from using a sign in the course of trade in the cases set out in that provision, there should exist a likelihood of confusion, can this provision be interpreted as meaning that there is no likelihood of confusion where the earlier [EU] mark has, owing to the acquiescence of the proprietor, peacefully coexisted for some years with similar national trade marks in two Member States of the European Union, so that the absence of a likelihood of confusion in those two Member States is extended to other Member States, or to the European Union as a whole, regard being had to the unitary treatment that the [EU] mark requires?*

*(2) In the situation set out in the previous paragraph, can the geographical, demographic, economic or other circumstances of the States in which the coexistence has occurred be taken into consideration for the*



*purpose of assessing the likelihood of confusion, so that the absence of a likelihood of confusion in those Member States can be extended to a third Member State, or to the European Union as a whole?*

*(3) With regard to the case referred to in subparagraph (c) of Article 9(1) of the [Regulation No 207/2009], must this provision be interpreted as meaning that, where an earlier trade mark has coexisted with the contested sign for a certain number of years in two European Union Member States without the proprietor of the earlier trade mark opposing it, this acquiescence on the part of the proprietor towards the use of the later sign in these two States in particular can be extended to the remaining territory of the European Union for the purpose of determining whether there is due cause for a third party's use of the later sign, on account of the unitary treatment that the [EU] trade mark requires?'*

15. The order for reference was lodged at the Court Registry on 15 February 2016. Written observations were submitted by the parties to the main proceedings, the German and French Governments and the European Commission.

16. The Court sent the referring court a request for clarification to which the latter replied on 12 December 2016. The parties to the main proceedings and the Commission participated at the hearing on 18 January 2017.

#### **Analysis**

##### **Preliminary observations**

17. There are two aspects to the interpretation of Article 9(1)(b) and (c) of Regulation No 207/2009 which is required in the present case.

18. First, given that the two trade marks at issue coexist peacefully in Ireland and in the United Kingdom, the referring court expresses its uncertainty — by means of the three questions it has referred for a preliminary ruling — as to the conclusion that should be drawn from that fact for the purposes of assessing the likelihood of confusion and the risk of detriment to reputation in the remaining territory of the European Union.

19. Secondly, the present dispute will also allow the Court to specify the criteria for assessing the likelihood of confusion between trade marks which both include the same indication of geographical origin. (5)

20. It is clear from the order for reference that the term 'Kerry', which is common to the two trade marks at issue, is the name of an Irish county known for cattle breeding. The relevance of that fact — which is not explicitly referred to in the questions referred for a preliminary ruling — was confirmed by means of a request for clarification which the Court sent to the referring court, and the interested parties were able properly to express their views on this subject at the hearing. Therefore, the scope of the questions referred for a preliminary ruling should be broadened in that respect, in accordance with the settled case-law which permits such a step to be taken so that the Court may provide a useful answer to the referring court. (6)

The applicability of Article 9 of Regulation No 207/2009 where conflicting trade marks coexist peacefully in part of the European Union

21. By the three questions referred for a preliminary ruling, which I propose to examine together, the referring court asks, in essence, whether, and, if appropriate, how, the fact that the trade marks at issue coexist peacefully in part of the territory of the European Union can have a bearing on the assessment of the likelihood of confusion, on the one hand, and detriment to reputation, on the other, under Article 9(1)(b) and (c) of Regulation No 207/2009, in the remaining territory of the European Union.

22. First of all, I would observe that the peaceful coexistence of conflicting trade marks has been addressed only to a relatively limited extent in the case-law of the Court

23. As regards the assessment of the likelihood of confusion, it is clear from settled case-law that the existence of a likelihood of confusion on the part of the relevant public must be appreciated globally, taking into account all the factors relevant to the circumstances of the case. (7)

24. In that regard, the Court has acknowledged that the possibility cannot be ruled out that the coexistence of trade marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks. (8)

25. The same finding was made in the case-law of the General Court relating to opposition procedures, according to which that coexistence must not only be peaceful but must also be based on the absence of any likelihood of confusion on the part of the relevant public. (9)

26. Although the Court has not yet had the opportunity to specify the conditions for applying the concept of 'peaceful coexistence', it is, nonetheless, clear from that case-law that the peaceful coexistence of conflicting trade marks on the market in question is a relevant factor which must be taken into account in the global assessment of the likelihood of confusion.

27. In the present case, it has been established that the peaceful and long-standing coexistence of the trade marks at issue precludes the existence of a likelihood of confusion on the market in question in Ireland and in the United Kingdom.

28. This discussion, therefore, focusses on whether that fact should be taken into account for the purposes of assessing the existence of a likelihood of confusion in Spain, where the alleged infringement was committed, and in the rest of the European Union.

29. Ornu considers that, in order for peaceful coexistence to be taken into account in the assessment of the likelihood of confusion with the EU trade mark, it must be proven that the trade marks at issue coexist peacefully in the entire territory of the European Union. According to Ornu, this is based on the principle of the unitary character of the EU trade mark and on the fact that the effect of such a mark extends to the entire territory of the European Union. Ornu maintains that coexistence in part of the territory of the European

Union does not permit any conclusion to be drawn regarding the rest of that territory.

30. The German and French Governments essentially agree with this interpretation. The Commission also states that the peaceful coexistence of conflicting trade marks must, in principle, be demonstrated in the whole of the territory in which the alleged infringement is committed and, therefore, in the case of the EU trade mark, in the entire territory of the European Union. It adds, nevertheless, that it is not inconceivable that the situation in the territory in which the conflicting trade marks coexist could provide information which is useful to the assessment of the likelihood of confusion on other markets.

31. I would observe that a similar interpretation — according to which peaceful coexistence must be proven in the entire territory of the European Union — has also been adopted by the European Union Intellectual Property Office (EUIPO) as regards opposition procedures, (10) and this interpretation has been endorsed by the General Court. (11) According to that approach, if the scope of the EU trade mark is such that the likelihood of confusion potentially exists throughout the territory of the European Union, the absence of a likelihood of confusion by virtue of coexistence must itself be shown to exist throughout the territory of the European Union.

32. T&S gives a different interpretation and considers that peaceful coexistence is a relevant factor even where the marks in question coexist only in part of the European Union. According to T&S, where the conflicting trade marks have coexisted in a substantial part of the territory of the European Union without giving rise to a likelihood of confusion, it could be concluded that there is no such a likelihood in any part of the European Union.

33. I do not find either of those diametrically opposed interpretations convincing.

34. It is true that the EU trade mark system is based on the principle of the unitary character of the EU trade mark, which requires its uniform protection throughout the European Union.

35. Nevertheless, the nature of the system established by Regulation No 207/2009 is such that, in certain circumstances, the assessment of the likelihood of confusion between a sign and an EU trade mark does not lead to a single outcome that holds good throughout the territory of the European Union.

36. In *Combit Software*, the Court held that the principle of unitary character does not preclude a court dealing with EU trade marks from finding that the use of a sign creates a likelihood of confusion with an EU trade mark in one part of the European Union while not creating such a likelihood in another part thereof, or from drawing the appropriate conclusions from that finding by taking the exceptional step, based on the evidence adduced in principle by the defendant, of issuing an order prohibiting the use in question in part of the territory. (12)

37. Where it is found that there is no likelihood of confusion in a given part of the European Union,

legitimate trade arising from the use of the sign in question in that part of the European Union cannot be prohibited. (13)

38. It is apparent from that judgment that the finding of the infringement of the exclusive right conferred by the EU trade mark may, in exceptional circumstances, be limited to certain parts of the territory. It is also held in that judgment that the absence of a likelihood of confusion between conflicting trade marks in part of the territory of the European Union does not preclude a finding that such a likelihood exists in another part of that territory.

39. Consequently — contrary to what is claimed by T&S — even if it was established, by means of the argument alleging the peaceful coexistence of the conflicting trade marks, that the use of those trade marks does not give rise to a likelihood of confusion in Ireland or in the United Kingdom, that fact does not in itself preclude a finding that such a likelihood exists in another part of the European Union.

40. However, in my view, and contrary to the position adopted by Ornu, nor does it follow that peaceful coexistence in part of the territory of the European Union is irrelevant to the assessment of the likelihood of confusion with an EU trade mark.

41. The assessment of a likelihood of confusion in a dispute relating to the infringement of the exclusive right conferred by the EU trade mark requires an overall assessment of all the relevant factors which potentially relate to the entire territory of the European Union. In the context of that assessment, a factor cannot be dismissed as irrelevant solely because it relates to circumstances prevailing in just one part of the territory of the European Union.

42. The peaceful coexistence of the two trade marks at national level may be attributable to a number of circumstances. It is not inconceivable, in that regard, that the absence of a likelihood of confusion in a part of the territory of the European Union where long-standing and intensive use has been made of the trade marks concerned may indicate that there is no such likelihood in other parts of the European Union, in cases where market conditions and public perception are not significantly different. (14)

43. Accordingly, where it has been established — as it has in the present case — that the use of the signs at issue does not give rise to a likelihood of confusion in a part of the territory of the European Union where those signs have coexisted peacefully for a long time, that factor is likely to have a bearing on the assessment of the likelihood of confusion in other areas where a conflict between the signs is possible.

44. It seems to me that this may have been what the Spanish court of first instance intended when it stated that the only similarity between the trade marks at issue lay in the geographical indication ‘Kerry’ and that, furthermore, those trade marks coexisted peacefully in Ireland and in the United Kingdom, so there was no reason to conclude that the activity of T&S would give rise to confusion in another part of the European Union.

45. After all, as is clear from my analysis below, (15) the fact that the trade marks at issue contain an indication of geographical origin, namely the reference to the Irish county — which could be one of the circumstances accounting for the peaceful coexistence of the signs in Ireland and in the United Kingdom — is relevant for the purposes of assessing the likelihood of confusion at European Union level.

46. It is true, as rightly observed by the German and French Governments and by the Commission, that peaceful coexistence in certain Member States cannot be extrapolated to the rest of the European Union. Such automatic extrapolation must be ruled out. However, the fact remains, in my opinion, that the circumstances in which the signs coexist peacefully in part of the territory of the European Union may be relevant for the purposes of assessing the likelihood of confusion in the European Union as a whole.

47. In the light of the foregoing, I consider therefore, that the peaceful coexistence of the signs at issue in part of the territory of the European Union is a factor which, although not decisive, can be taken into consideration as part of the global assessment of the likelihood of confusion with an EU trade mark in another part of that territory, under Article 9(1)(b) of Regulation No 207/2009.

48. The same applies, in my view, as regards the analysis referred to in Article 9(1)(c) of Regulation No 207/2009, which establishes broader protection for trade marks which have a reputation.

49. A finding that detriment has been caused to the distinctive character or reputation of the earlier trade mark, in one of the ways referred to in that provision, must be based, in particular, on the existence of a link between the trade marks at issue resulting from a certain degree of similarity between them. The existence of such a link must be assessed globally, taking into account all the factors relevant to the circumstances of the case, including the likelihood of confusion on the part of the public. (16)

50. For the reasons I have given with regard to Article 9(1)(b) of Regulation No 207/2009, it is necessary, in the context of the global assessment required under paragraph (c) of that article, to take into account, where appropriate, the fact that trade marks coexist peacefully in part of the territory of the European Union.

51. Accordingly, although in the third question referred for a preliminary ruling the referring court raises the possibility of considering the peaceful coexistence of the signs as due cause for use, I take the view that that circumstance must be taken into consideration in the context of the global assessment of the existence of a link between the trade marks. In the absence of such a link, there would be no need to examine whether there is due cause for use.

52. I would point out, in that regard, that the condition relating to reputation must be considered to be fulfilled when the EU trade mark has a reputation in a substantial part of the territory of the European Union, and such a part may, in some circumstances, correspond to the territory of a single Member State.

(17) In my view, the fact that the trade marks coexist peacefully could be of even greater relevance in this context, since the marks coexist in the part of the European Union used to establish the reputation of the earlier trade mark.

53. In the light of those observations, I consider that the provisions of Article 9(1)(b) and (c) must be interpreted as meaning that the fact that conflicting trade marks coexist peacefully in part of the territory of the European Union, without giving rise to confusion, does not automatically exclude a likelihood of confusion in another part of that territory. Nevertheless, that coexistence is a relevant factor since, in some circumstances, it can be taken into consideration as part of the global assessment of the likelihood of confusion, on the one hand, and the existence of a link between the trade marks at issue, on the other, these being the criteria forming the subject of each of those provisions respectively.

The applicability of Article 9 of Regulation No 207/2009 where trade marks include an indication of geographical origin

54. I would observe that, in adopting Regulation No 207/2009, the EU legislature has acknowledged that it is a matter of public interest that indications which may serve to designate the geographical origin of the goods concerned should remain available. That consideration underlies many of the provisions of that regulation, in particular those concerning absolute grounds for refusal, the limitation of the effects of a trade mark and the effects of a collective mark. (18)

55. Under Article 12(b) of Regulation No 207/2009, the proprietor of an EU trade mark may not prohibit a third party from using, in the course of trade, indications concerning, inter alia, the geographical origin of goods provided the third party uses them in accordance with honest practices in industrial or commercial matters. A similar restriction is provided for in Article 6(1)(b) of Directive 2008/95/EC. (19)

56. The aim of limiting the exclusive rights conferred by a trade mark is to reconcile the interests of the trade mark proprietor with those of other producers in the internal market, taking into account the axiology of trade mark law as an essential element of the system of undistorted competition which the Treaty seeks to establish and maintain. (20)

57. The Court has recognised in its case-law that it is a matter of public interest that signs or indications which may serve to designate geographical origin, in particular geographical names, should remain available. (21)

58. In order to demonstrate that the public interest at issue exists, it is sufficient that the geographical name is capable of designating the origin of the goods concerned. It is also necessary to assess whether a geographical name designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future. (22)

59. Accordingly, in the context of the dispute arising from a conflict between the sign ‘KERRY Spring’ and the trade mark GERRI, for cold drinks, the Court held that the proprietor of a national trade mark may prevent the use of the indication of geographical origin relating to another Member State only if that use is not in accordance with honest practices in industrial or commercial matters. The mere fact that there exists a likelihood of aural confusion between the two signs is insufficient to conclude that the use of that indication in the course of trade is not in accordance with honest practices. (23)

60. Those considerations, set out by the Court in the light of the great linguistic diversity in the European Community at that time, which was composed of 15 Member States, are even more relevant today.

61. Even if the indication of geographical origin relating to a Member State could be considered by consumers in another Member State to be similar to the term incorporated in a trade mark, the proprietor of the trade mark cannot prevent such use if it is in accordance with honest practices. The similarity arising from that term cannot, therefore, be taken into consideration in order to conclude that there is a likelihood of confusion.

62. In this case, as is clear from the order for reference, the term ‘Kerry’, which is common to the two trade marks at issue, is the name of an Irish county known for cattle breeding, and may therefore serve as an indication of origin of the dairy products at issue in the case in the main proceedings.

63. Under those circumstances, the EU trade mark court cannot take into account such a similarity between the signs, which arises from a use of the geographical indication which is in accordance with honest practices, to find that there is a likelihood of confusion with the EU trade mark or a risk of detriment to the reputation of that mark.

64. After all, it falls to that court to ensure that the finding of infringement of the exclusive rights conferred by the European trade mark in such circumstances is not contrary to the limitation of the effects of that trade mark referred to in Article 12(b) of Regulation No 207/2009.

65. In the light of the foregoing, I consider that Article 9(1)(b) and (c) of Council Regulation No 207/2009 must be interpreted as meaning that the fact that conflicting trade marks contain the same term, constituting an indication of geographical origin used in accordance with honest practices, cannot serve as the basis for a finding that there is a likelihood of confusion with an EU trade mark or a risk of detriment to the reputation of that mark.

#### Conclusion

66. In the light of the foregoing considerations, I propose that the Court should respond to the request for a preliminary ruling made by the Audiencia Provincial de Alicante (Provincial Court, Alicante) as follows:

(1) Article 9(1)(b) and (c) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark must be interpreted as meaning that

the fact that conflicting trade marks coexist peacefully in part of the territory of the European Union, without giving rise to confusion, does not mean that any likelihood of confusion is automatically ruled out in another part of that territory. Nevertheless, such coexistence is a relevant factor capable, in some circumstances, of being taken into consideration as part of the global assessment of the likelihood of confusion, on the one hand, and the existence of a link between the trade marks at issue, on the other, these being the criteria forming the subject of each of those provisions respectively.

(2) Article 9(1)(b) and (c) of Council Regulation No 207/2009 must be interpreted as meaning that the fact that the trade marks at issue contain the same term, which is an indication of geographical origin used in accordance with honest practices, cannot serve as the basis for a finding that there is a likelihood of confusion with an EU trade mark or detriment to the reputation of that mark.

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1 Original language: French.

2 See judgments of 12 April 2011, DHL Express France (C-235/09, EU:C:2011:238) and of 22 September 2016, combit Software (C-223/15, EU:C:2016:719).

3 The version of Council Regulation of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1) applicable *ratione temporis* to the present case. Article 9(2)(b) and (c) of that regulation, as amended by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), contains essentially similar provisions.

4 This is the term used in Article 12 of Regulation No 207/2009. Various international and EU legal instruments use the terms ‘indication of origin’ and ‘geographical indication’, and their legal scope is determined by the instrument in question.

5 See judgments of 4 May 1999, Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230), and of 7 January 2004, Gerolsteiner Brunnen (C-100/02, EU:C:2004:11).

6 See, *inter alia*, judgments of 7 December 2000, Telaustria and Telefonadress (C-324/98, EU:C:2000:669, paragraph 59), and of 7 March 2013, Efir (C-19/12, not published, EU:C:2013:148, paragraph 27).

7 See, in particular, judgment of 22 June 1999, Lloyd Schuhfabrik Meyer (C-342/97, EU:C:1999:323, paragraph 18).

8 Judgment of 3 September 2009, Aceites del Sur-Coosur v Koipe (C-498/07 P, EU:C:2009:503, paragraph 82).

9 Judgments of 11 May 2005, Grupo Sada v OHIM — Sadia (GRUPO SADA) (T-31/03, EU:T:2005:169, paragraph 86), and of 11 December 2007, Portela & Companhia v OHIM — Torrens Cuadrado et Sanz

(Bial) (T-10/06, not published, EU:T:2007:371, paragraph 76).

10 The EUIPO Guidelines provide that, where the earlier trade mark relied on in support of the opposition is an EU trade mark, the applicant must show that the trade marks in question coexist in the whole of the European Union. See ‘Guidelines for Examination in the Office’, Part C-2-6, p. 7 (<https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>).

11 Judgment of 10 April 2013, Höganäs v OHIM — Haynes (ASTALOY) (T-505/10, not published, EU:T:2013:160, paragraphs 49 and 50).

12 Judgment of 22 September 2016, combit Software (C-223/15, EU:C:2016:719, paragraph 36).

13 Judgment of 22 September 2016, combit Software (C-223/15, EU:C:2016:719, paragraphs 31 and 32); see, also to that effect, judgment of 12 April 2011, DHL Express France (C-235/09, EU:C:2011:238, paragraphs 46 to 48).

14 I note that the Commission, although ruling out the possibility of automatic extrapolation, states that there is nothing to prevent the national court from taking account of the information regarding the circumstances in other Member States where the linguistic and socio-cultural characteristics in those Member States are comparable to those in the concerned market.

15 See point 65 of this Opinion.

16 See, by analogy, judgment of 27 November 2008, Intel Corporation (C-252/07, EU:C:2008:655, paragraphs 30, 41 and 42 and the case-law cited).

17 See, to that effect, judgments of 6 October 2009, PAGO International (C-301/07, EU:C:2009:611, paragraphs 27 and 29), and of 3 September 2015, Iron & Smith (C-125/14, EU:C:2015:539, paragraph 19).

18 Respectively, Article 7(1)(c), Article 12(b) and Article 66(2) of Regulation No 207/2009.

19 Directive of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

20 See, to that effect, in relation to the identical provision in Article 6(1)(b) of the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC) (OJ 1989 L 40, p. 1), judgment of 7 January 2004, Gerolsteiner Brunnen (C-100/02, EU:C:2004:11, paragraph 16).

21 See, by analogy, judgment of 4 May 1999, Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230, paragraph 26).

22 Judgment of 4 May 1999, Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230, paragraph 31).

23 Judgment of 7 January 2004, Gerolsteiner Brunnen (C-100/02, EU:C:2004:11, paragraphs 25 and 27).