

**Court of Justice EU, 2 July 2020, mk advokaten v MBK Rechtsanwälte**



**TRADE MARK LAW**

A person operating in the course of trade that has arranged for an advertisement which infringes another person's trade mark to be placed on a website is not using a sign which is identical with that trade mark when:

- [the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites](#)

23 The term 'using' in Article 5(1) of Directive 2008/95 involves active conduct and direct or indirect control of the act constituting the use. However, that is not the case if that act is carried out by an independent operator without the consent of the advertiser ([judgment of 3 March 2016, Daimler, C-179/15, EU:C:2016:134](#), paragraph 39).

24 That provision cannot therefore be interpreted as meaning that a person may, irrespective of its conduct, be considered to be a user of a sign that is identical with or similar to another person's trade mark on the sole ground that such use is capable of providing a financial benefit to the former (see, to that effect, [judgment of 3 March 2016, Daimler, C-179/15, EU:C:2016:134](#), paragraph 42).

25 According to that line of case-law of the Court, in the present case, it is for the referring court to examine whether it follows from the conduct of mk advokaten, in the context of either a direct or indirect relationship between mk advokaten and the operators of the websites in question, that those operators had placed the advertisement online by order and on behalf of mk advokaten.

Source: [curia.europa.eu](http://curia.europa.eu)

**Court of Justice EU, 2 July 2020**

(I. Jarukaitis, M. Ilešič and C. Lycourgos)

JUDGMENT OF THE COURT (Tenth Chamber)

2 July 2020(\*)

(Reference for a preliminary ruling — Trade marks — Directive 2008/95/EC — Article 5(1) — Use in the course of trade of a sign that is identical with or similar to another person's trade mark for goods or services that are identical with or similar to those for which that mark is registered — Scope of the term 'using' — Advertisement placed on a website by order of a person operating in the course of trade and subsequently reproduced on other websites)

In Case C-684/19,

REQUEST for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by

decision of 9 September 2019, received at the Court on 17 September 2019, in the proceedings  
mk advokaten GbR

v

MBK Rechtsanwälte GbR,

THE COURT (Tenth Chamber),

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

Advocate General: M. Szpunar,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– MBK Rechtsanwälte GbR, by M. Boden, Rechtsanwalt,

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

– the European Commission, by É. Gippini Fournier and W. Mölls, 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 Article 5(1) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2 The request has been made in proceedings between mk advokaten GbR and MBK Rechtsanwälte GbR concerning a prohibition imposed on mk advokaten on using the group of letters 'mbk' in the course of trade.

**Legal context**

3 Under Article 5 of Directive 2008/95:

*'1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade: (a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered; (b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.*

*2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.*

*3. The following, inter alia, may be prohibited under paragraphs 1 and 2:*

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

(b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

(d) using the sign on business papers and in advertising.

...

4 Directive 2008/95 was repealed and replaced, with effect from 15 January 2019, by Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1). The content of Article 5 of Directive 2008/95 now appears, in essence, with changes, in Article 10 of Directive 2015/2436. However, having regard to the material time in the dispute in the main proceedings, the present reference for a preliminary ruling will be considered in the light of Directive 2008/95.

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

5 The law firm MBK Rechtsanwälte, established in Mönchengladbach (Germany), is the proprietor of a German trade mark constituted by the name of that firm, 'MBK Rechtsanwälte'. That trade mark is registered for legal services.

6 mk advokaten, established in Kleve (Germany), is also a law firm. Initially, it carried on its activities under the name 'mbk rechtsanwälte' and the corresponding name in Dutch, 'mbk advokaten'. However, following an action for infringement brought by MBK Rechtsanwälte, the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), by judgment of 17 October 2016, prohibited mk advokaten, under pain of a fine, from using, in the course of trade, the group of letters 'mbk' for legal services. That judgment became final.

7 Subsequently, it was shown that, when using the search engine operated by the company Google, entering the terms 'mbk Rechtsanwälte' led to several company referencng websites, such as the website [www.kleveniederrhein-stadtbranchenbuch.com](http://www.kleveniederrhein-stadtbranchenbuch.com), that displayed an advertisement for the legal services of mk advokaten.

8 MBK Rechtsanwälte took the view that it was thus shown that the prohibition imposed by the Landgericht Düsseldorf (Regional Court, Düsseldorf) was not being complied with, and requested that that court impose a fine on mk advokaten.

9 In its defence, mk advokaten submitted that, as regards advertisements on the internet, the only initiative on its part had been to register itself in the online directory Das Örtliche and that, following the judgment of 17 October 2016 of the Landgericht Düsseldorf (Regional Court, Düsseldorf), it had withdrawn that registration for all signs containing the group of letters 'mbk'. According to mk advokaten, it was not under any other obligation, as it had never requested inclusion on other websites.

10 The Landgericht Düsseldorf (Regional Court, Düsseldorf) upheld the request of MBK Rechtsanwälte. That court held that the advertisement placed online on the websites at issue benefited mk advokaten and was based on the one that mk advokaten had arranged to be

placed in the Das Örtliche directory. It imposed a fine on mk advokaten, since the latter had, following the judgment of 17 October 2016, merely arranged for the advertisement appearing in that directory to be deleted. 11 mk advokaten brought an appeal against that decision before the referring court, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany).

12 According to that court, the outcome of the dispute before it depends on the interpretation of Article 5(1) of Directive 2008/95.

13 That court states that it follows from settled German case-law that, where an advertisement placed online on a website infringes another person's rights, the person who had ordered that advertisement must not only arrange for it to be deleted from that website but also ascertain, with the help of the usual search engines, that the operators of other websites have not reproduced that advertisement and, if that is the case, make a serious attempt to have subsequent referencng deleted.

14 According to that court, that case-law is based on the consideration that any display of the advertisement benefits the person whose goods or services are thus promoted. It is consequently for that person to take, in the event of infringement of another person's rights, the requisite steps so that all instances of the advertisement concerned appearing on the internet are removed.

15 The referring court expresses doubts as to the compatibility of that German case-law with the principles set out in [the judgment of 3 March 2016, Daimler \(C-179/15, EU:C:2016:134\)](#), since in that case, the Court followed a different approach as regards advertisements infringing another person's trade mark. That approach might be applicable to the dispute before the referring court.

16 It is true that in the case that gave rise to that judgment of the Court, the advertisement which was the subject of the dispute in question had initially been lawful, whereas in the present case, the advertisement that mk advokaten ordered to be placed online infringed another person's trade mark from the outset. Nevertheless, the relevance of that difference for the interpretation of the term 'using', within the meaning of Article 5(1) of Directive 2008/95, is not clear.

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

*'Is a third party referencng on a website in an entry that contains a sign identical with a trade mark "using" that trade mark, within the meaning of Article 5(1) of Directive 2008/95, if the entry was not placed there by the third party itself, but was reproduced by the website's operator from another entry that the third party had placed in infringement of the trade mark?'*

#### **Consideration of the question referred**

18 By its question, the referring court asks, in essence, whether Article 5(1) of Directive 2008/95 must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement

which infringes another person's trade mark to be placed on a website is using a sign which is identical with that trade mark where the operators of other websites reproduce that advertisement by placing it online on other websites.

19 In that regard, it must first of all be noted that the offering of goods or services under a sign which is identical with or similar to another person's trade mark and advertising those goods or services under that sign constitutes 'use' in relation to that sign (see, to that effect, [judgment of 23 March 2010, Google France and Google, C-236/08 to C-238/08, EU:C:2010:159](#), paragraphs 45 and 61 and the case-law cited).

20 In addition, it is settled case-law that such use of a sign that is identical with or similar to another person's trade mark exists where that sign, selected by an advertiser as a keyword in an online referencing service, is the means used by the advertiser to trigger the display of its advertisement, even where that sign does not appear in the advertisement itself (see, to that effect, [judgment of 22 September 2011, Interflora and Interflora British Unit, C-323/09, EU:C:2011:604](#), paragraphs 30 and 31 and the case-law cited).

21 Thus, where a person operating in the course of trade orders, from the operator of a referencing website, the publication of an advertisement the display of which contains or is triggered by a sign which is identical with or similar to another person's trade mark, that person must be considered to be using that sign, within the meaning of Article 5(1) of Directive 2008/95 (see, to that effect, [judgment of 3 March 2016, Daimler, C-179/15, EU:C:2016:134](#), paragraphs 29 and 30).

22 By contrast, that person cannot be held liable, under Article 5(1) of Directive 2008/95, for the independent actions of other economic operators, such as those of referencing website operators with whom that person has no direct or indirect dealings and who do not act by order and on behalf of that person, but on their own initiative and in their own name (see, by analogy, [judgment of 3 March 2016, Daimler, C-179/15, EU:C:2016:134](#), paragraphs 36 and 37).

23 The term 'using' in Article 5(1) of Directive 2008/95 involves active conduct and direct or indirect control of the act constituting the use. However, that is not the case if that act is carried out by an independent operator without the consent of the advertiser ([judgment of 3 March 2016, Daimler, C-179/15, EU:C:2016:134](#), paragraph 39).

24 That provision cannot therefore be interpreted as meaning that a person may, irrespective of its conduct, be considered to be a user of a sign that is identical with or similar to another person's trade mark on the sole ground that such use is capable of providing a financial benefit to the former (see, to that effect, [judgment of 3 March 2016, Daimler, C-179/15, EU:C:2016:134](#), paragraph 42).

25 According to that line of case-law of the Court, in the present case, it is for the referring court to examine whether it follows from the conduct of mk advokaten, in the context of either a direct or indirect relationship between mk advokaten and the operators of the websites

in question, that those operators had placed the advertisement online by order and on behalf of mk advokaten. In the absence of such conduct, it must be concluded that MBK Rechtsanwälte is not justified, under the exclusive rights provided for in Article 5(1) of Directive 2008/95, in bringing an action against mk advokaten on the ground that the advertisement was published online on websites other than the Das Örtliche directory.

26 This would not alter the fact that it would remain open to MBK Rechtsanwälte to claim from mk advokaten, where appropriate, restitution for financial benefits on the basis of national law, and to bring an action against the operators of the websites in question (see, by analogy, [judgment of 3 March 2016, Daimler, C-179/15, EU:C:2016:134](#), paragraph 43).

27 In that regard, it must be noted that, in a situation where the website operators reproduce an advertisement on their own initiative and in their own name, the economic operator whose goods or services are thus promoted cannot be regarded as their customer. Accordingly, the Court's case-law, according to which the operator of a referencing website does not itself use signs that are identical or similar to another person's trade marks where those signs are contained in its customer's advertisements or trigger the display of those advertisements (see, inter alia, [judgments of 23 March 2010, Google France and Google, C-236/08 to C-238/08, EU:C:2010:159](#), paragraph 56, and of [2 April 2020, Coty Germany, C-567/18, EU:C:2020:267](#), paragraphs 39 and 40), does not apply in such a situation.

28 In such a case, those website operators are using, within the meaning of Article 5(1) of Directive 2008/95, signs identical with or similar to another person's trade mark which are contained in offers for sale or advertisements that those operators display or which trigger the display of those advertisements (see, by analogy, [judgment of 2 April 2020, Coty Germany, C-567/18, EU:C:2020:267](#), paragraph 48). The proprietors of those marks may therefore bring an action against those operators under the exclusive rights provided for in Article 5(1), where those offers or advertisements promote goods or services that are identical with or similar to those for which those marks are registered.

29 Such an interpretation of that provision is compatible with its objective which is to provide a trade mark proprietor with a legal means whereby it may prohibit, and thus prevent, any use of its trade mark by a third party without its consent ([judgment of 2 April 2020, Coty Germany, C-567/18, EU:C:2020:267](#), paragraph 38).

30 Finally, as regards the fact, referred to in the order for reference, that, in the case which gave rise to [the judgment of 3 March 2016, Daimler \(C-179/15, EU:C:2016:134\)](#), the advertisement which infringed another person's trade mark was initially lawful, whereas the advertisement at issue in the dispute in the main proceedings infringed another person's trade mark from the outset, it is sufficient to note that that

circumstance is irrelevant as regards the only question under consideration in the present reference for a preliminary ruling, which is, where an advertisement infringing another person's trade mark is reproduced, who is using the sign which is identical with or similar to that mark.

31 In the light of the foregoing, the answer to the question referred is that Article 5(1) of Directive 2008/95 must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement which infringes another person's trade mark to be placed on a website is not using a sign which is identical with that trade mark where the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites.

**Costs**

32 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 (Tenth Chamber) hereby rules:

Article 5(1) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement which infringes another person's trade mark to be placed on a website is not using a sign which is identical with that trade mark where the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites.

[Signatures]

\* Language of the case: German.

---