

OPINION OF ADVOCATE GENERAL  
JACOBS

delivered on 21 March 2002 <sup>1</sup>

1. Under the Trade Marks Directive,<sup>2</sup> the proprietor of a valid trade mark must be entitled to prevent a third party from using a sign or registering it as a mark if either (a) the sign is identical to his earlier mark and the goods or services in question are identical to those for which that mark is protected or (b) it is identical or similar to the earlier mark, the goods or services covered are also identical or similar *and* there is a likelihood of confusion on the part of the public.

2. The Directive also allows Member States to accord the proprietor protection where the sign which the third party seeks to register or use is at least similar to the registered trade mark but relates to goods or services which are *not similar* to those for which that earlier mark is valid, where the earlier mark has a reputation in the Member State concerned and where the use of the sign without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. The protection which may be accorded in such cases is not dependent on the existence of any likelihood of confusion.

3. In the present reference for a preliminary ruling, the German Bundesgerichtshof (Federal Court of Justice) wishes to know, essentially, (a) whether Member States may also accord such additional protection in cases where the relevant goods or services *are* identical or similar, but there is no likelihood of confusion, and/or (b) whether the only cases in which the additional protection may be granted are those in which the use of the sign would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark, or whether other national rules — perhaps those concerning unfair competition — may also be applied.

### Legislative background

#### *Community legislation*

4. According to its preamble, the aim of the Directive is to approximate the trade mark laws of the Member States in so far as — but only in so far as — they may impede free trade, distort competition and directly

<sup>1</sup> — Original language: English.

<sup>2</sup> — First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, OJ 1989 L 40, p. 1, hereinafter 'the Directive'.

affect the functioning of the internal market.<sup>3</sup> Registered trade marks must therefore enjoy the same protection in all Member States, although the latter may still grant 'extensive protection to those trade marks which have a reputation'.<sup>4</sup> The basic protection afforded — the function of which is in particular to guarantee the trade mark as an indication of origin — is absolute in the case of identity between the mark and the sign and goods or services, but applies also in the case of similarity between the mark and the sign and the goods or services, in which case likelihood of confusion is the specific condition for such protection.<sup>5</sup>

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

...

5. Article 4 provides, in so far as is relevant:

4. Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

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

(a) the trade mark is identical with, or similar to, an earlier national trade mark... and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

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

...'

3 — See in particular the first and third recitals in the preamble.

4 — Ninth recital. I suggested in note 3 to my Opinion in Case C-375/97 *General Motors* [1999] ECR I-5421, that the recital should probably read, in English, not 'extensive protection' but 'more extensive protection' (in the French text 'une protection plus large').

5 — Tenth recital.

6. Article 5 contains parallel provisions, which read as follows:

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.

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

7. It appears from the Commission's observations that the provisions of Articles 4(4)(a) and 5(2), although optional under the Directive, have in fact been implemented by all the Member States.

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

8. Articles 4 and 5 both contain provisions under which aspects of national law as it stood prior to transposition of the Directive may continue to have effect after transposition. Under Article 4(6), a Member State may provide that the grounds for refusal of registration or invalidity in force prior to the date of transposition of the Directive are to apply to trade marks applied for before that date. And under Article 5(4) it may provide that, where the use of a sign could not be prohibited before the date of transposition, the rights conferred by a (subsequent) trade mark may

not be relied on to prevent the continued use of the sign.

9. In addition, although they are not directly in issue here, it may be noted that Articles 8(1) and (5), and 9(1), of the Community Trade Mark Regulation<sup>6</sup> contain provisions substantially identical to those of, respectively, Articles 4(1) and (4)(a), and 5(1) and (2), of the Directive. Moreover, if a national trade mark clashes with an earlier Community trade mark having a reputation in the Community, Article 4(3) of the Directive provides in terms substantially the same as those of Article 4(4)(a) that its registration must be refused or may be invalidated if the goods or services in question are not similar.

### *German legislation*

10. Prior to the transposition of the Directive, the German Trade Mark Law was known as the Warenzeichengesetz; that has now been replaced by the Markengesetz, which came into force on 1 January 1995.<sup>7</sup> Paragraph 9(1)(1) to (3) of the Markenge-

setz transposes Article 4(1) and (4)(a) of the Directive, while Paragraph 14(2)(1) to (3) transposes Article 5(1) and (2), in both cases in terms substantially similar to those of the Directive.

11. The Markengesetz also contains transitional provisions reflecting those in the Directive. Paragraph 153(1) provides, in essence, that rights conferred by the new legislation cannot be invoked against a trade mark in existence before 1 January 1995 if no challenge could have been brought under the previous legislation, and Paragraph 163(1) adds that proceedings for the annulment of a registration made before 1 January 1995 cannot be successful unless they are well founded under both the old and the new legislation.

12. According to the judgment making the reference, before 1995 it was possible under the relevant provisions of the Warenzeichengesetz, read in conjunction with those of the Gesetz gegen den unlauteren Wettbewerb (Law prohibiting unfair competition), for a trade-mark proprietor to prevent the use or registration of a sign similar to his mark where the latter was well known in the relevant sections of the public, enjoyed a particular reputation and prestige value and was therefore very valuable to him, if the sign was deliberately, and without any overriding necessity, made to resemble the earlier mark.

6 — Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ 1994 L 11, p. 1, hereinafter 'the Regulation'.

7 — Although the provisions of the Directive had to be implemented by 31 December 1992 at the latest (Article 16).

## The proceedings

13. Davidoff & Cie SA and Zino Davidoff SA (together 'Davidoff') are two linked Swiss companies in whose names the trade mark 'Davidoff' is registered internationally, as a figurative mark in an underlined script based on, but slightly differentiated from, a standard type of font known as 'English 157' (or 'Englische Schreibschrift' in German):



14. In Germany, the registrations took effect on 28 January 1982 and 3 August 1989 respectively. They cover, *inter alia*, goods of classes 14 and 34 in the Nice classification.<sup>8</sup> Class 14 is for 'precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments'; class 34 is for 'to-

bacco; smokers' articles; matches'. The former are apparently marketed principally by Davidoff & Cie SA, the latter — in particular cigars — by Zino Davidoff SA.

15. Gofkid Ltd ('Gofkid') is a Hong Kong company which owns a German-registered figurative trade mark, dating from 1991<sup>9</sup> and consisting of the word 'Durffee' in English 157 script (again slightly modified), but not underlined, preceded by two capital 'D's — a smaller one inset in the upper right-hand corner of a larger one — in a plainer style. It again covers, *inter alia*, goods in classes 14 and 34, and takes the following form:



16. Davidoff sets considerable store by the prestige attaching to the quality of the products it sells under its registered mark and the reputation thereby accruing to the mark. It considers that the 'Durffee' mark is deliberately designed to take advantage of that reputation by the similarity of script, particularly in the capital 'D' and

<sup>8</sup> — See the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979.

<sup>9</sup> — Registration was applied for on 5 April 1991 and seems to have been completed by 1993, although the precise date is not immediately clear from the case-file.

double ‘ff’ of the name, and at the same time damages it because the products sold under ‘Durffee’ are cheaper and of lower quality, or are at least perceived as such. Davidoff therefore, first, objected to the registration of ‘Durffee’ by the German Patent and Trade Marks Office and, second, following the rejection of that objection by decisions of 17 February 1993 and 28 August 1995, brought court proceedings in 1996, seeking an order that Gofkid desist from using the ‘Durffee’ mark and consent to its withdrawal or annulment.

17. Davidoff was unsuccessful in its action, both at first instance and on appeal, and now seeks review on a point of law by the Bundesgerichtshof. In the judgment making the reference, that court considers (disagreeing with the appeal court below it) that the two marks are clearly similar but that further findings of fact are required in order to determine correctly whether there is a likelihood of confusion between them. However, it finds also that under the pre-1995 German legislation<sup>10</sup> Davidoff would have been entitled on the facts established to prevent the use of the ‘Durffee’ mark, even without a likelihood of confusion; it cannot now be so entitled, though, unless it may also do so under the

current legislation and thus in accordance with the Directive.

18. The Bundesgerichtshof, having examined Articles 4(4)(a) and 5(2) of the Directive, considers that further guidance is required as to their interpretation. On their wording, those provisions apply only where there is no similarity between the goods or services concerned, but that interpretation might be disputed — it would seem more, rather than less, important to prevent undue advantage being taken of well-known marks where the supplies in question are similar than where they are not. It might be relevant in that regard that, in determining whether there is a likelihood of confusion, a lower level of similarity between the marks can be offset by a higher level of similarity between the goods for which they are used and vice versa.<sup>11</sup> If the provisions are to be interpreted literally, the question arises whether they limit continued protection of well-known marks under national law to the grounds they mention, or whether they permit supplementary national provisions (particularly against unfair competition) to protect well-known marks against later signs which are used or intended to be used for identical or similar goods.

<sup>10</sup> — See paragraph 12 above.

<sup>11</sup> — Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 17 of the judgment.

19. The Bundesgerichtshof has therefore stayed the proceedings and seeks a ruling from the Court on the following questions:

20. Written observations have been submitted by the parties, the Portuguese Government and the Commission. The parties, the United Kingdom Government and the Commission presented oral argument at the hearing.

(1) Are the provisions of Article 4(4)(a) and Article 5(2) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) to be interpreted (and where appropriate applied) as also entitling the Member States to provide more extensive protection for marks with a reputation in cases where the later mark is used or to be used for goods or services identical with or similar to those in respect of which the earlier mark is registered?

**The first question**

*Scope*

21. Davidoff has queried the import of the Bundesgerichtshof's first question, suggesting that it may be imprecisely worded. The question should, it considers, be read as asking whether Member States may grant more extensive protection to marks having a reputation where the products in question are similar but there is no similarity between the two marks — or between the sign and the mark, as the case may be.

(2) Are the grounds mentioned in Articles 4(4)(a) and 5(2) of the Trade Mark Directive (use which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the earlier mark) exhaustive in regulating when it is permissible for provisions protecting marks with a reputation to be retained under national law, or may those articles be supplemented by national rules protecting marks with a reputation against later signs which are used or to be used in respect of identical or similar goods or services?

22. That is not in my view a correct interpretation of the question.

23. It is true that the judgment making the reference evokes the possibility that Articles 4(4)(a) and 5(2) of the Directive might allow protection to be granted where a lack of likelihood of confusion stems from lack of similarity between marks as

well as where it stems from lack of similarity between products. However, the referring court is clearly satisfied that the ‘Durffee’ and ‘Davidoff’ marks are similar and that its decision will depend on whether Davidoff can found a claim on that similarity. It explicitly rejects the hypothesis that the two marks are dissimilar, but raises the question whether the protection authorised by the Directive in cases where products are not similar may not be extended by analogy (and *a fortiori*) to cases where they are. In its discussion, the Bundesgerichtshof then goes on to wonder whether similarity between marks is necessary if similarity between products is established, but the terms of its questions make no reference to that conjecture.

24. The first question must therefore be read in that light as asking whether the more extensive protection authorised by Articles 4(4)(a) and 5(2) may be granted where the goods or services in question are similar, as well as where they are not. There does not appear to me to be any reason to suppose that the Bundesgerichtshof also needs or wishes to know, in order to decide the case before it, whether the criterion of similarity between products and that of similarity between marks, or between mark and sign, may be substituted for each other in the interpretation of those provisions — although that might have been the case if it

had agreed with the first-instance and appeal courts that the ‘Durffee’ and ‘Davidoff’ marks were insufficiently similar within the meaning of the Directive.

25. In any event, it would not appear consistent with the scheme of the Directive, or with the principles of trade mark protection in general, for the owner of a trade mark, whatever its reputation, to be able to prevent third parties from using or registering a sign or mark bearing no similarity to his own, in respect of similar products. And if the use without due cause of a competing sign or mark is such as to take unfair advantage of, or be detrimental to, the distinctive character or the repute of a protected mark, then it seems to me that there must be a sufficient degree of similarity between the two.

### *Substance*

26. Davidoff, the Portuguese Government and the Commission all broadly take the view, to which the national court itself seems inclined, that Articles 4(4)(a) and 5(2) of the Directive, since they allow a trade mark having a reputation to be protected against the use of similar marks or signs for products which are not similar to those for which the mark is registered, must also, *a fortiori*, allow such protection where products are similar. Gofkid and the United Kingdom Government, however,

argue on a number of grounds for a stricter interpretation of those provisions; in particular, they submit, the wording is clearly circumscribed and it is neither necessary nor desirable to extend further the protection already authorised.

27. The former view does indeed appear attractive — the literal terms of the Directive seem to leave a gap in the protection of marks having a reputation.

28. Such marks are covered like any other by Articles 4(1)(a) and (b) and 5(1)(a) and (b) as well as having their own specific provisions in Articles 4(4)(a) and 5(2). Thus they are protected against (i) any identical mark or sign used for identical products (ii) any identical or similar mark or sign used for similar products and any similar mark or sign used for identical products, provided that there is a risk of confusion, and (iii) any identical or similar mark or sign used for products which are not similar, whether there is a risk of confusion or not, if the use is without due cause and takes unfair advantage of or is detrimental to their distinctive character or repute.

29. Yet there seems to be no provision for the case where the competing mark or sign is similar to the mark having a reputation and its use — for products which *are* similar to those covered by that mark — is without due cause and takes unfair advantage of or is detrimental to the latter's distinctive character or repute, unless there is a likelihood of confusion. If protection may be granted in comparable circumstances, despite the absence of any likelihood of confusion, where the products are *not* similar, surely the legislature cannot have intended to exclude such protection where they *are*?

30. There seems, moreover, to be some support in the Court's case-law for the view that the protection authorised by Articles 4(4)(a) and 5(2) where the products in question are not similar is an extension of a comparable protection available where they are similar. In *SABEL*,<sup>12</sup> the Court stated that Articles 4(4)(a) and 5(2) permit the proprietor of a trade mark which has a reputation to prohibit the use without due cause of signs identical with or similar to his mark and do not require proof of likelihood of confusion 'even where' there is no similarity between the goods in question. And in *General Motors*,<sup>13</sup> it again referred to the protec-

12 — Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 20 of the judgment.

13 — Case C-375/97, cited in note 4, paragraph 23 of the judgment.

tion afforded by Article 5(2) as applying ‘even when’ marks are used for non-similar products.

31. However, the use of ‘even where/when’ in those passages need not necessarily be taken to mean ‘including cases where’, that is to say ‘in cases where products are similar and also in cases where they are not’. It might also be seen as stressing the difference which was highlighted by the Court in *Canon*: ‘In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.’<sup>14</sup> Moreover, those statements were not findings of law underpinning the rulings in the two cases in question but rather commentaries on related points; in neither case was the use of the word ‘even’ by the Court germane to the matter under consideration. The point raised in the present case has not yet been specifically considered by the Court<sup>15</sup> and I think it desirable to examine it rather more closely.

14 — Cited above in note 11, paragraph 22 of the judgment; cf. also paragraph 21 of the judgment in *SABEL* itself, where the Court stresses the distinction with the words ‘unlike Article 4(1)(b)’.

15 — It is however raised again by the Hoge Raad der Nederlanden (Netherlands Supreme Court) in a very recent reference (Case C-408/01 *Adidas*) concerning the same mark as that in issue in Case C-425/98 *Marca Mode* [2000] ECR I-4861.

32. First and foremost in that context, there is considerable force in the arguments put forward by Gofkid and the United Kingdom Government as to the clarity of the literal wording of the provisions in question.

33. Articles 4(4)(a) and 5(2) of the Directive explicitly relate to signs or marks used for ‘goods or services which are not similar to those for which the [earlier] trade mark is registered’, without any qualification such as ‘even’ or ‘including’. Nor is there any indication in the preamble of an intention that the provisions should be interpreted to include goods or services which are similar.

34. Where a legislative provision is clear, it is in principle unnecessary and undesirable to look behind the terms adopted. That having been said, however, in the present case the drafting history of the Directive — which is closely linked to that of the Regulation — tends to support a literal interpretation.

35. In the original proposals for the Directive and for the Regulation submitted to the Council on 25 November 1980,<sup>16</sup> protection was in principle granted only against

16 — OJ 1980 C 351, pp. 1 and 5 respectively.

registration or use in respect of identical or similar goods. An exception for trade marks having a reputation appeared in the Regulation alone but was confined to actual use of a conflicting sign or mark 'in relation to goods or services which are not similar'. That was extended, in the text finally adopted, to cover protection against registration of a conflicting Community trade mark in the same circumstances, but neither the original nor the amended<sup>17</sup> proposal for a Directive contained any such provision. The reason for that deliberate omission was given in the explanatory memorandum;<sup>18</sup> it was intended that owners of trade marks having a reputation who wanted wider protection should obtain it through registration as a Community trade mark.

the protection in question should extend to use for both similar and dissimilar goods, the legislature chose a form of words which referred to dissimilar products alone. That, coupled with the fact that the provisions were added at a late stage, in derogation from the basic intention to give protection only where identical or similar products were concerned, militates in favour of a literal interpretation.

37. In those circumstances, it seems clear that the legislature meant precisely, and no more than, what it said. Only a particularly powerful argument may in my view justify any interpretation at odds both with that intention and with the clear terms of the legislation.

36. The wording finally adopted in Articles 4(4)(a) and 5(2) to allow for such protection at the option of Member States was the same as that used throughout the drafting history of the Regulation — 'in relation to goods or services which are not similar' — although the Economic and Social Committee in its Opinion had recommended that the Directive should follow the Regulation in specifying that signs similar to well-known marks 'may not be used for dissimilar goods *either*'.<sup>19</sup> Thus, despite having the suggestion before it that

38. Such an argument might perhaps be provided if there were an obvious gap in the protection of trade marks having a reputation, and the Commission in particular believes that there is such a gap, as outlined above. If so, then there might be grounds for giving the Directive provisions a broad interpretation to fill that gap.

39. In contrast, Gofkid and the United Kingdom contend that no such gap in protection exists and that the protection already afforded is sufficient.

17 — OJ 1985 C 351, p. 4.

18 — *Bulletin of the European Communities*, 1980 Suppl. 5/80, p. 13.

19 — OJ 1981 C 310, p. 22, at p. 24; emphasis added.

40. One limb of the United Kingdom's argument is that, if the use of a similar mark or sign for dissimilar products is without due cause and takes unfair advantage of, or is detrimental to, the distinctive character or the repute of an earlier trade mark having a reputation, then its use for similar products will normally give rise to a likelihood of confusion falling within Article 4(1)(b) or 5(1)(b) of the Directive.

principle precluding a likelihood of confusion.<sup>21</sup> Yet even in such cases, despite first appearances, there may well be a likelihood of confusion. If so, marks having a reputation will benefit in the same way as any other mark and there appears to be no reason to accord them a duplicate, optional protection under Article 4(4)(a) or 5(2). If not, however, does that mean that such marks will in those circumstances fall unprotected between the two stools of, on the one hand, Articles 4(1) and 5(1) and, on the other, Articles 4(4)(a) and 5(2)?

41. However, although that may well often be the case, to consider it always to be so seems to come dangerously close to assuming that, where a trade mark has a reputation, likelihood of confusion may always be inferred if a similar mark is used for similar products. That possibility was dismissed by the Court in *Marca Mode*<sup>20</sup> where there is a likelihood of association, a finding which must be all the more valid where there is none.

43. I think not. It is not in my view difficult to interpret those provisions as providing a continuum of protection, without going beyond their literal terms.

42. In any event, I agree that there is in fact no real gap in protection. A gap might none the less be thought to exist, for example, where use of a similar mark or sign plays on the use of an earlier mark but explicitly denies any connection with it, thus in

44. It is clear from the scheme of the directive, and is expressly stated in the tenth recital in the preamble, that the

21 — Such as, for example, the 'Anti-Monopoly' game to which I referred at paragraphs 40 and 19 of my Opinion in *SABEL*, although it appears that the Netherlands court found on the evidence in that case (*Edor v General Mills Fin* 1978 Ned. Jur. 83) that there was in fact a likelihood of confusion. Another instance of this type of case is currently pending before the Court in Case C-206/01 *Arsenal Football Club*, in which identical goods bearing a sign identical to the protected mark were offered for sale subject to a specific disclaimer as to origin.

20 — Cited above in note 15, at paragraph 41 of the judgment.

specific condition for the basic, compulsory protection under Articles 4(1) and 5(1) is the existence of a likelihood of confusion. (Admittedly, Articles 4(1)(a) and 5(1)(a) do not explicitly impose that criterion but, as I have explained in my Opinion in *LTJ Diffusion*,<sup>22</sup> it is implicit in the conditions of their application.)

origin, and it is with them that Articles 4(4)(a) and 5(2) are concerned. They may be seen as an extension (for such marks only) of the range of situations covered (for all marks) by Articles 4(1) and 5(1), beyond the point at which the products concerned cease to be similar. Marks having a reputation thus do not enjoy a separate and independent system of protection but rather the same general protection as is afforded to all marks, together with a specific, supplementary and optional protection.

45. Articles 4(1) and 5(1) provide protection over a range of situations, progressing from that of absolute identity both between products and between marks or mark and sign to that of mere similarity in both regards. Where there is no similarity at all between marks, or between mark and sign, then it seems clear, as I have stated above, that there are no grounds for allowing the owner of a protected mark to prevent the use of another mark or sign, whatever the degree of similarity or dissimilarity between the products in question. There can be no extension of the range of protection in those circumstances.

46. Where however an identical or similar mark or sign is used in respect of dissimilar products, there may be situations in which protection is justified. Such situations will concern above all marks which enjoy a reputation in themselves rather than those which function only as a guarantee of

47. Yet in addition to being optional for the Member States and confined to trade marks having a reputation, the protection afforded by Articles 4(4)(a) and 5(2) is dependent on different criteria.<sup>23</sup> On the one hand, it is no longer necessary to show any likelihood of confusion but, on the other, it must be established that the use of the competing mark or sign is without due cause and would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the protected mark — criteria which need not be satisfied where products are similar. Thus, it seems to me that there is no gap in the continuity of protection for marks having a reputation but rather that, where it extends

22 — Case C-291/00 *LTJ Diffusion*, Opinion delivered on 17 January 2002, at paragraphs 34 to 39.

23 — Cf., for example, the judgment in *Marca Mode*, cited above in note 15, paragraphs 35 and 36.

beyond the point of similarity between products (at which point protection for other marks ceases completely), the criteria to be met change.

48. It must, moreover, be remembered that even under Articles 4(1) and 5(1) marks having a particularly distinctive character — whether *per se* or because of the reputation they enjoy with the public — benefit from broader protection than other marks. In *SABEL*,<sup>24</sup> the Court considered that the existence of such a distinctive character increased the likelihood of confusion. Thus such likelihood, although it must always be assessed on the basis of evidence presented to the national court,<sup>25</sup> will be easier to establish even when the degree of similarity between the products concerned is more tenuous. Again, the protection afforded to marks with a reputation extends beyond that afforded to other marks and reinforces the bridge over what might otherwise have been perceived as a gap.<sup>26</sup>

49. Proponents of the ‘gap’ theory might have in mind a situation such as the following. If the sign ‘Coca-Cola’, or a sign similar to it, were to be used by a third party for an industrial lubricant,<sup>27</sup> the Coca-Cola Company would be able to prevent such use on the basis of Article 5(2) of the Directive if, as seems likely, there were no justifiable reason for using that mark for that product and if, as again seems plausible, its use took unfair advantage of, or was detrimental to, the repute of ‘Coca-Cola’. If, however, such a sign were used for a product similar to Coca-Cola but in circumstances where there was no likelihood of confusion (improbable though that might seem), then surely it would be a perverse result if the company were to lose that right because of the increased similarity between the products?

50. But the answer lies in the interpretation given by the Court in *SABEL*, *Canon* and *Marca Mode*, as outlined above. Whilst the two products might not be easily confused in themselves, the reputation of the ‘Coca-Cola’ mark in relation to bottled beverages may be such that the public might believe that they came from the same undertaking or from economically-related undertakings,<sup>28</sup> although of course that would be a matter of fact to be assessed on the

24 — Cited above in note 12, at paragraph 24 of the judgment. See also paragraph 18 of the judgment in *Canon*, cited above in note 11 and paragraph 41 of *Marca Mode*, cited in note 15.

25 — See *Marca Mode*, at paragraph 39 of the judgment.

26 — That case-law is entirely in agreement with the tenth recital in the preamble to the Directive, which states that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’ (emphasis added).

27 — Class 4 in the Nice Classification: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks. To the best of my knowledge, the Coca-Cola Company, although it has registered its trade mark for products in a wide range of classes, has not sought to do so for those in Class 4. Even if it had done so, however, the example I am citing is a purely hypothetical illustration.

28 — See the operative parts of the judgments in both *Canon* and *Marca Mode*.

evidence. Such protection is available only to marks having a particularly distinctive character and, where they derive that distinctive character from their reputation, ensures a transition to the somewhat different protection offered under Articles 4(4)(a) and 5(2) of the Directive.

51. Thus, although there may be an area in which a trade mark having a reputation is not protected against the use of identical or similar marks or signs — namely where the products in question are similar and there is no likelihood of confusion — the very definition of that area means that it is likely to be insignificant in practice, and its extent is still further limited by the Court's case-law. In deliberately not providing for that area, moreover, the legislature may well have been expressing its intention that likelihood of confusion should be the normal criterion for protection. It may also have had in mind that the area of dissimilar products is one in which dishonest operators might well take unfair advantage of a well-known mark unless extra protection is granted, whereas it would be considerably more difficult to take such advantage in the area of similar products without giving rise to a likelihood of confusion.

52. It is true that, because of the difference in the nature of the evidential criteria to be satisfied under the two sets of provisions, some practical difficulties may ensue, in a limited number of cases, where there is real doubt as to whether the products covered may be classed as similar or not. The owner of the trade mark having a reputation may have to put forward two alternative claims, one under Article 4(1) or 5(1), the other under Article 4(4)(a) or 5(2). However, even assuming his reluctance to do so, such a problem does not seem insurmountable, and it appears clear from the Directive that the legislature intended there to be different tests in different circumstances.

53. I thus reach the view that the wording of the Directive is clear and that there is no compelling reason to interpret it in a manner contrary to its clear meaning.

54. In reaching that view, it is not necessary to consider whether, on balance, it would be preferable for the protection in issue to cover also cases where the products in question are similar. Such an analysis is a matter for the legislature. However, on the one hand, I have already pointed out the attraction of an *a fortiori* approach and yet, on the other, Gofkid and the United Kingdom have argued that such an inter-

pretation would be positively undesirable. It may be helpful to consider those latter arguments briefly.

55. I find very persuasive the argument of Gofkid and the United Kingdom that the proposed broader interpretation of Articles 4(4)(a) and 5(2) would blur the clear outlines of the protection afforded by the Directive, which is based essentially on the existence of a likelihood of confusion, by allowing in certain circumstances a concurrent or alternative protection based on other criteria and thus entailing legal uncertainty. Competitors wishing to use similar marks for similar products (and it must be remembered that a degree of similarity between marks may be justified or even conditioned by the nature of the product) would not only need to be satisfied that they had avoided any likelihood of confusion but would also have to ensure that no claim could lie against them under Articles 4(4)(a) or 5(2). Such a result would introduce a regrettable degree of confusion in the system itself.

56. Also important, as the United Kingdom Government has pointed out, is the 'knock-on' effect for Community trade marks. Under Article 8(5) of the Regulation, a sign may not be registered as a Community trade mark if an earlier national trade mark has a reputation in the Member State concerned and, essentially, the conditions of Article 4(4)(a) of the Directive are fulfilled. Thus, a finding by a national

court in a single Member State that a trade mark has a reputation there and that the use of a competing sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of that mark in that Member State is sufficient to preclude any registration of that competing sign as a Community trade mark. In those circumstances, it would seem undesirable to extend the scope of Articles 4(4)(a) and 5(2) of the Directive further than is necessary.

57. In the context of both those considerations, it may be borne in mind that the Directive was adopted on the basis of Article 100a of the EC Treaty (now, after amendment, Article 95 EC) — and thus for the achievement of the objectives set out in Article 7a of the Treaty (now, after amendment, Article 14 EC), namely the establishment of the internal market — and specifically seeks to eliminate disparities which may impede the free movement of goods and freedom to provide services.<sup>29</sup> To interpret its provisions in a way not only contrary to their literal wording but such as to increase the scope for objecting to the use or registration of marks or signs in circumstances where there is no likelihood of confusion does not appear particularly compatible with those aims.

29 — See the first recital in the preamble.

58. I therefore conclude on the first question that the optional protection specified in Articles 4(4)(a) and 5(2) of the Directive relates only to situations in which the goods or services in question are not similar to those for which the (earlier) trade mark is valid. Where goods or services are similar, the national court must examine, in the light of the Court's case-law concerning the protection enjoyed by marks with a highly distinctive character, whether there exists a likelihood of confusion.

### The second question

59. Neither the Portuguese Government nor the Commission has addressed the question whether Articles 4(4)(a) and 5(2) of the Directive, if they are to be read as confined to situations involving products which are not similar, may none the less be supplemented by national rules according marks having a reputation protection on other grounds against (later) marks or signs used for identical or similar products. Davidoff argues forcefully for an affirmative answer, whilst Gofkid and the United Kingdom Government take the opposite view.

60. Davidoff's reasoning is based essentially on the third and ninth recitals in the preamble to the Directive: 'it does not appear to be necessary at present to undertake full-scale approximation of the trade mark laws of the Member States and it will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market'; 'it is fundamental, in order to facilitate the free circulation of goods and services, to ensure that henceforth registered trade marks enjoy the same protection under the legal systems of all the Member States;... this should however not prevent the Member States from granting at their option extensive protection to those trade marks which have a reputation'. In Davidoff's view, the Directive was thus drafted to lay down compulsory rules only for cases where there is a likelihood of confusion, leaving any further protection to be dealt with by the Member States at their discretion.

61. I cannot agree with that interpretation. Not only is it unsupported — as Davidoff accepts — by anything in the enacting terms of the Directive but it is at odds with the statement in the seventh recital that 'the grounds for refusal or invalidity concerning the trade mark itself, for example, the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights, *are to be listed in an exhaustive manner, even if some of these grounds are listed as an option for the*

*Member States* which will therefore be able to maintain or introduce those grounds in their legislation' (emphasis added).

62. It therefore seems clear that the legislature intended the more extensive optional protection to be confined to that set out in the relevant enacting terms. Indeed, had that not been the case, there would have been little purpose in specifying any details at all of the protection which might be accorded under Articles 4(4)(a) and 5(2). As matters stand, those provisions lay down very clearly the limits of the discretion available to the Member States.

63. In that context, it is again important to note that registration of a Community trade mark may be defeated by the existence of a prior right in any one of the Member States. If each Member State were free to enact the additional protection it chose, there would be a very great danger indeed of seeing the whole edifice of the Community trade mark system set at nought, together with the harmonising aim of the Directive itself, which is to prevent barriers to trade and distortion of competition in the interest of the internal market.<sup>30</sup>

64. Moreover, as the Court has consistently held,<sup>31</sup> Articles 5 to 7 of the Directive embody a complete harmonisation of the rules relating to the rights conferred by a trade mark. The same must be true of at least Article 4(4)(a) unless it is to be interpreted so as to conflict with the practically identical terms of Article 5(2).

65. Admittedly in its reasoning the Bundesgerichtshof indicates that its second question concerns in particular whether supplementary national provisions relating to protection against unfair competition are authorised; and the Directive, according to the sixth recital in its preamble, 'does not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection'.

66. However — quite apart from the fact that the national court's question is not specifically directed to that aspect, which has not moreover been addressed in the submissions to the Court — it seems to me that it is with a certain kind of unfair competition that Articles 4(4)(a) and 5(2) are intended to deal. In line with the sixth

<sup>30</sup> — See paragraphs 26 and 27 of the Court's judgment in Case C-355/96 *Silhouette International Schmied* [1998] ECR I-4799.

<sup>31</sup> — See, for example, paragraph 25 of the judgment in *Silhouette*, cited above in note 30, and paragraph 39 of the judgment of 20 November 2001 in Joined Cases C-414/99 to C-416/99 *Davidoff and Levi Strauss*.

recital, they specify the types of national provision relating to unfair competition whose application to trade marks is not excluded in the circumstances described. That being so, it appears plausible that the legislature did not intend to authorise other, more extensive, such provisions to be applied in those circumstances; had it so intended, it would either have stated so

explicitly or it would not have specified the type of provision which was authorised.

67. The answer to the second question should thus in my view be in the negative.

## Conclusion

68. I am therefore of the opinion that the Court should give the following answer to the Bundesgerichtshof:

The optional protection specified in Articles 4(4)(a) and 5(2) of Council Directive 89/104/EEC relates only to situations in which the goods or services in question are not similar to those for which the (earlier) trade mark is valid. Where goods or services are similar, the national court must examine, in the light of the Court's case-law concerning the protection enjoyed by marks with a highly distinctive character, whether there exists a likelihood of confusion in accordance with Articles 4(1) or 5(1), as the case may be.

The grounds specified in Articles 4(4)(a) and 5(2) on which such optional protection may be granted are exhaustive and may not be supplemented by national rules protecting well-known marks against later signs which are used or to be used in respect of identical or similar goods or services.