

Case C-278/08

**Die BergSpechte Outdoor Reisen und Alpenschule Edi
Kobl Müller GmbH**

v

Günther Guni and trekking.at Reisen GmbH

(Reference for a preliminary ruling
from the Oberster Gerichtshof)

(Trade marks — Internet — Keyword advertising — Display, on the basis of
keywords identical or similar to trade marks, of links to sites of competitors of the
proprietors of those trade marks — Directive 89/104/EEC — Article 5(1))

Judgment of the Court (First Chamber), 25 March 2010 I-2520

Summary of the Judgment

1. Approximation of laws — Trade marks — Directive 89/104 — Right, for the proprietor of a trade mark, to prevent the use by a third party of an identical or similar sign for identical or similar goods or services — Use of the mark within the meaning of Article 5(1) of the directive — Concept

(Council Directive 89/104, Art. 5(1)(a) and (b))

2. *Approximation of laws — Trade marks — Directive 89/104 — Right, for the proprietor of a trade mark, to prevent the use by a third party of an identical sign for identical goods — Advertising in the context of an internet referencing service — Adverse effect on the function of indicating origin*

(Council Directive 89/104, Art. 5(1)(a))

3. *Approximation of laws — Trade marks — Directive 89/104 — Right, for the proprietor of a trade mark, to prevent the use by a third party of an identical or similar sign for identical or similar goods or services — Advertising in the context of an internet referencing service — Likelihood of confusion*

(Council Directive 89/104, Art. 5(1))

1. The sign selected by the advertiser as keyword in the context of an internet referencing service is the means used to trigger that ‘ad’ display and is therefore use ‘in the course of trade’ within the meaning of Article 5(1) of Directive 89/104 relating to trade marks. That is, furthermore, use in relation to the advertiser’s goods or services, even where the sign selected as keyword does not appear in the advertisement itself.

mark is registered, the proprietor of the mark is entitled to prohibit that use if it is liable to have an adverse effect on one of the functions of the mark. In the other situation envisaged in Article 5(1)(b) of that directive, in which the third party uses a sign identical or similar to the trade mark in relation to goods or services identical or similar to those for which the trade mark is registered, the proprietor of the trade mark may oppose the use of that sign only where there is a likelihood of confusion.

Nevertheless, the proprietor of the trade mark cannot oppose such use of a sign identical or similar to its trade mark unless all the conditions set out to that effect in Article 5 of Directive 89/104 and in the Court of Justice’s case-law relating to that article are fulfilled. In the situation envisaged in Article 5(1)(a) of Directive 89/104, in which a third party uses a sign identical to a trade mark in relation to goods or services identical to those for which that

(see paras 18-22)

2. It follows from that case-law that the proprietor of the trade mark may not

oppose the use of a sign identical to the mark, under Article 5(1)(a) of Directive 89/104 relating to trade marks, if that use is not liable to cause detriment to any of the functions of that mark.

message attached thereto, whether the advertiser is a third party vis-à-vis the proprietor of the trade mark or, on the contrary, economically linked to that proprietor, the conclusion must also be that there is an adverse effect on that function of the trade mark.

In respect of the function of indicating origin, the question whether that function is adversely affected when internet users are shown, on the basis of a keyword identical to a mark, a third party's 'ad', depends in particular on the manner in which the latter is presented. The function of indicating the origin of the mark is adversely affected if that 'ad' does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the 'ad' originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party.

(see paras 30, 35, 36)

3. Article 5(1) of Directive 89/104 relating to trade marks must be interpreted as meaning that the proprietor of a trade mark is entitled to prohibit an advertiser from advertising, on the basis of a keyword identical or similar to that trade mark that that advertiser has, without the consent of the proprietor, selected in connection with an internet referencing service, goods or services identical to those for which that mark is registered, when that 'ad' does not enable an average internet user, or enables that user only with difficulty, to ascertain whether the goods or services referred to therein originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party.

On that point, when a third party's 'ad' suggests that there is an economic link between that third party and the proprietor of the trade mark, the conclusion must be that there is an adverse effect on the function of indicating origin. Similarly, in the case where the 'ad', while not suggesting the existence of an economic link, is to such an extent vague as to the origin of the goods or services at issue that normally informed and reasonably attentive internet users are unable to determine, on the basis of the advertising link and the commercial

(see para. 41)