

Order of the Court of 26 March 2010 (reference for a preliminary ruling from the Bundesgerichtshof (Germany)) — Eis.de GmbH v BBY Vertriebsgesellschaft mbH

(Case C-91/09) ⁽¹⁾

(First subparagraph of Article 104(3) of the Rules of Procedure — Trade marks — Internet — Keyword advertising — Display, on the basis of a keyword identical to a trade mark, of an advert of a competitor to the proprietor of that trade mark — Directive 89/104/EEC — Article 5(1)(a))

(2010/C 234/26)

Language of the case: German

Referring court

Bundesgerichtshof (Germany)

Parties to the main proceedings

Applicant: Eis.de GmbH

Defendant: BBY Vertriebsgesellschaft mbH

Re:

Reference for a preliminary ruling — Bundesgerichtshof Karlsruhe — Interpretation of Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) — Inscription of a sign similar to a trade mark with a service provider operating an Internet search engine in order automatically to have displayed on the screen, after entry of that sign as a search term, adverts for goods or services identical to those for which the trade mark in question was registered ('keyword advertising') — Absence of authorisation from the proprietor of the trade mark — Classification of that use of the mark as 'use' within the meaning of the provision cited above

Operative part of the order

Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States 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 with that trade mark which that advertiser has, without the consent of the proprietor, selected in connection with an internet referencing service, goods or services identical with those for which that mark is registered, in the case where that advertisement 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.

⁽¹⁾ OJ C 129, 6.6.2009.

Order of the Court (Eighth Chamber) of 4 March 2010 — Kaul GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs), Bayer AG

(Case C-193/09 P) ⁽¹⁾

(Appeal — Application for registration of Community word mark ARCOL — Opposition by proprietor of Community word mark CAPOL — Implementation by OHIM of a judgment annulling a decision of its Boards of Appeal — Right to be heard — Likelihood of confusion — Minimal degree of similarity of the marks required — Rejection for manifest irrelevance of new evidence adduced before the Board of Appeal — Articles 8(1)(b), 61(2), 63(6), 73, second sentence, and 74(2) of Regulation No 40/94)

(2010/C 234/27)

Language of the case: English

Parties

Appellant: Kaul GmbH (represented by: R. Kunze, Rechtsanwalt and Solicitor)

Other party to the proceedings: Office for Harmonisation in the Internal Market (Trade Marks and Designs) (represented by: G. Schneider, Agent), Bayer AG

Re:

Appeal brought against the judgment of the Court of First Instance (Fifth Chamber) of 25 March 2009 in Case T-402/07 *Kaul GmbH v OHIM* by which the Court of First Instance dismissed an action for annulment brought by the proprietor of the Community word mark 'CAPOL' for goods in Class 1 against Decision R 782/2000-2 of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (OHIM) of 1 August 2007, dismissing for the second time the appeal brought against the decision of the Opposition Division which rejected the opposition brought against the application for registration of the Community word mark 'ARCOL' for goods in Classes 1, 17 and 20, following the annulment in Case C-29/05 P *OHIM v Kaul* of the Third Board of Appeal's initial decision to reject the opposition