



Reports of Cases

JUDGMENT OF THE COURT (Fifth Chamber)

11 April 2019*

(Reference for a preliminary ruling — Intellectual property — Trade marks — Regulation (EC) No 207/2009 — Article 9(1) — Directive 2008/95/EC — Article 5(1) and (2) — Rights afforded by a trade mark — Individual trade mark consisting of a quality label)

In Case C-690/17,

REQUEST for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by decision of 30 November 2017, received at the Court on 8 December 2017, in the proceedings

ÖKO-Test Verlag GmbH

v

Dr. Rudolf Liebe Nachf. GmbH & Co. KG,

THE COURT (Fifth Chamber),

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

Advocate General: M. Campos Sánchez-Bordona,

Registrar: D. Dittert, Head of Unit,

having regard to the written procedure and further to the hearing on 7 November 2018,

after considering the observations submitted on behalf of:

- ÖKO-Test Verlag GmbH, by N. Dinig, Rechtsanwältin,
- Dr. Rudolf Liebe Nachf. GmbH & Co. KG, by M. Wiume, Rechtsanwalt,
- the German Government, by T. Henze, M. Hellmann, J. Techert and U. Bartl, acting as Agents,
- the European Commission, by É. Gippini Fournier, W. Mölls and G. Braun, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 17 January 2019,

gives the following

* Language of the Case: German

Judgment

- 1 This request for a preliminary ruling concerns the interpretation of Article 9 of Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1), and of Article 5 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 ÖKO-Test Verlag GmbH and Dr. Rudolf Liebe Nachf. GmbH & Co. KG ('Dr. Liebe') concerning use of a sign that is identical with, or similar to, an individual trade mark consisting of a quality label.

Legal context

EU law

Regulation No 207/2009

- 3 Regulation No 207/2009 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. It was subsequently repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1). However, having regard to the date of the facts giving rise to the dispute the main proceedings, the present reference for a preliminary ruling will be considered in the light of Regulation No 207/2009, in its initial version.
- 4 According to recital 8 of Regulation No 207/2009:

'The protection afforded by a [European Union] trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in cases of similarity between the mark and the sign and the goods or services ...'
- 5 Article 9(1) and (2) of that regulation provided:

'1. 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:

- (a) any sign which is identical with the [European Union] trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;
- (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 [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.

2. The following, inter alia, may be prohibited under paragraph 1:

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

...'

Directive 2008/95

6 Directive 2008/95, which repealed and replaced 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), was in turn 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). However, having regard to the date of the facts giving rise to the dispute in the main proceedings, the present reference for a preliminary ruling will be considered in the light of Directive 2008/95.

7 Recital 11 of Directive 2008/95 stated:

'The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services ...'

8 According to Article 5(1) to (3) 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;

...'

German law

- 9 The Federal Republic of Germany availed itself of the option provided for in Article 5(2) of Directive 2008/95 by adopting Paragraph 14(2)(3) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (the Law on trade marks and other signs).

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

- 10 ÖKO-Test Verlag is an undertaking which evaluates products through performance and compliance tests and then informs the public of the results of those evaluations. It sells a magazine that is published in Germany and contains those results, as well as providing general consumer information.
- 11 Since 2012, ÖKO-Test Verlag has been the proprietor of an EU trade mark, consisting of the following sign, which represents a label intended to present the results of tests to which products have been subjected ('the quality label'):



- 12 It is also the proprietor of a national mark consisting of the same quality label.
- 13 Those marks (together 'the ÖKO-TEST marks') are registered, inter alia, for printed matter and for services that consist in conducting tests and providing consumer information and consultancy.
- 14 ÖKO-Test Verlag selects the products that it wishes to test and evaluates them on the basis of scientific parameters also selected by it, without requesting the manufacturers' consent. It then publishes the results of those tests in its magazine.
- 15 In some circumstances, ÖKO-Test Verlag invites the manufacturer of a tested product to conclude a licensing agreement with it. Under the terms of such an agreement, the manufacturer is authorised, in return for the payment of a sum of money, to affix the quality label with the result (which must be shown in the box whose outline is part of that label) to its products. Such a licence remains valid until a new test is organised for the product concerned by ÖKO-Test Verlag.
- 16 Dr. Liebe is an undertaking that produces and markets toothpastes, in particular the 'Aminomed' range. Among the toothpastes in that range, the product 'Aminomed Fluorid-Kamillen-Zahncreme' was tested by ÖKO-Test Verlag in 2005 and was rated '*sehr gut*' ('very good'). Dr. Liebe concluded a licensing agreement with ÖKO-Test Verlag in the same year.

- 17 In 2014, ÖKO-Test Verlag became aware that Dr. Liebe was marketing one of its products with the following packaging:



- 18 ÖKO-Test Verlag brought infringement proceedings against Dr. Liebe before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), submitting that in 2014, Dr. Liebe was not authorised to use the ÖKO-TEST marks on the basis of the licensing agreement concluded in 2005, since, in particular, a new test based on new parameters in respect of toothpastes had been published in 2008 and, additionally, Dr. Liebe's product was no longer the same as that actually tested in 2005, as its name, description and packaging had changed.
- 19 Dr. Liebe claimed before that court that the licensing agreement, referred to in paragraph 16 of the present judgment, remained in force. It also denied that it had used the quality label as a trade mark.
- 20 That court ordered Dr. Liebe, by instructing it to stop using the quality label for products in the 'Aminomed' range, to withdraw the products concerned from the market and to destroy them. It held that Dr. Liebe had infringed the ÖKO-TEST marks by using the quality label for 'consumer information and consultancy' services, which are covered by the services for which those marks are registered.
- 21 Dr. Liebe brought an appeal against that decision before the referring court, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany). In turn, ÖKO-Test Verlag lodged a cross-appeal requesting the extension of the court of first instance's decision to the use, by Dr. Liebe, of some word and figurative signs that have not been registered as a mark but are identical to the ÖKO-TEST marks.
- 22 The referring court considers that the court at first instance correctly found that the licensing agreement referred to in paragraph 16 of the present judgment had been terminated before 2014. That court deduces therefrom that Dr. Liebe used, in the course of trade and without ÖKO-Test Verlag's consent, a sign that is identical with, or similar to, the ÖKO-TEST marks.
- 23 On the other hand, it is not clear that ÖKO-Test Verlag may rely on its exclusive right referred to in Article 9(1)(a) and (b) of Regulation No 207/2009 and in Article 5(1) of Directive 2008/95 against Dr. Liebe. The sign identical with, or similar to, the ÖKO-TEST marks had been affixed by Dr. Liebe to products that are neither identical with, nor similar to, those in respect of which the ÖKO-TEST marks are registered. Furthermore, it could be considered that that sign was not used 'as a trade mark'.
- 24 The referring court has doubts, therefore, as to the approach followed by the court of first instance, which equated the use, by Dr. Liebe, of the sign identical with, or similar to, the ÖKO-TEST marks to a use in respect of services for which those marks are registered.

25 Furthermore, the referring court is uncertain as regards the scope of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95. Admittedly, it is established that the quality label that was registered as a trade mark has a reputation throughout Germany. However, that reputation concerns that label and not, as such, the registration of that label as a trade mark. It should be clarified whether, in such circumstances, the proprietor of the mark enjoys the protection afforded by those provisions.

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

‘(1) Is an individual trade mark used in such a way as to infringe rights for the purposes of point (b) of the second sentence of Article 9(1) of [Regulation No 207/2009] or point (a) of the second sentence of Article 5(1) of [Directive 2008/95] in the case where

- the individual trade mark is affixed to a product in respect of which the individual trade mark is not protected;
- the affixing of the individual trade mark by a third party is perceived by the public as a “test seal” [(quality label)], which is to say that, although the product has been manufactured and placed on the market by a third party not acting under the control of the trade mark proprietor, the trade mark proprietor has tested some of the characteristics of that product and, on that basis, given it a particular rating shown on the quality label; and
- the individual trade mark is registered for, inter alia, “consumer information and consultancy with regard to the selection of goods and services, in particular using test and investigation results and by means of quality judgments”?

(2) Should the Court of Justice answer Question 1 in the negative:

Is an individual trade mark used in such a way as to infringe rights for the purposes of point (c) of the second sentence of Article 9(1) of [Regulation 207/2009] and Article 5(2) of [Directive 2008/95] in the case where

- the individual trade mark has a reputation only as a quality label as described in Question 1; and
- the individual trade mark is used as a quality label by the third party?’

Consideration of the questions referred

The first question

27 By its first question, the referring court asks, in essence, whether Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

- 28 As regards, first of all, Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, it should be noted that those provisions refer to the so-called ‘double identity’ situation, in which use by a third party of a sign identical with the trade mark is made in relation to goods or services that are identical with those for which the trade mark is registered (judgment of 22 September 2011, *Interflora and Interflora British Unit*, C-323/09, EU:C:2011:604, paragraph 33).
- 29 The wording ‘in relation to goods or services’, which features in those provisions, relates, in principle, to goods or services of a third party who uses a sign identical with the mark. Should the case arise, it can also refer to goods or services of another person on whose behalf the third party is acting (judgment of 23 March 2010, *Google France and Google*, C-236/08 to C-238/08, EU:C:2010:159, paragraph 60 and the case-law cited).
- 30 On the other hand, that wording does not, in principle, cover goods and services of the proprietor of that mark: they are covered, in Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, by the expression ‘those for which the trade mark is registered’. The requirement for identity ‘between the goods or services’, referred to in recital 8 of Regulation No 207/2009 and in recital 11 of Directive 2008/95, which is contained in Article 9(1)(a) of that regulation as well as in Article 5(1)(a) of that directive, is intended to limit the right of prohibition granted by those provisions to the proprietors of individual trade marks to cases in which there is identity not only between the sign used by the third party and the trade mark, but also between the goods marketed and the services supplied by the third party — or by a person on whose behalf that third party is acting — and the goods and services for which the proprietor registered his mark.
- 31 As the Court has already held, use of the sign by the third party to identify the goods of the trade mark proprietor where those goods constitute the actual subject matter of services provided by that third party can, exceptionally, be covered by those provisions. In such a case, that sign is used to identify the origin of the goods that are the subject matter of those services and there is a specific and indissociable link between the goods bearing the trade mark and those services. However, apart from that specific case, Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95 must be interpreted as covering the use of a sign identical to the trade mark in respect of goods marketed or services supplied by the third party that are identical to those for which the trade mark is registered (see, to that effect, judgment of 25 January 2007, *Adam Opel*, C-48/05, EU:C:2007:55, paragraphs 27 and 28).
- 32 The specific case referred to in the preceding paragraph concerns, in particular, situations in which a service provider makes unauthorised use of a sign identical to the trade mark of a manufacturer of goods in order inform the public that he has specialised or is a specialist in those products (see, to that effect, judgment of 3 March 2016, *Daimler*, C-179/15, EU:C:2016:134, paragraph 28 and the case-law cited).
- 33 In the present case, subject to verification by the referring court, it appears that the affixing by Dr. Liebe of a sign allegedly identical to the ÖKO-TEST marks has neither the purpose nor the effect of carrying out, in the same way as ÖKO-Test Verlag or on its behalf, an economic activity consisting in the provision of consumer information and consultancy services. Nor does there appear to be any indication to suggest either that, by affixing that sign, Dr. Liebe seeks to present itself to the public as specialist in the field of product testing or that there is a specific and indissociable link between its economic activity, which consists in the manufacturing and marketing of toothpaste, and that of ÖKO-Test Verlag. On the contrary, it is apparent that the sign that is identical with, or similar to, those marks is affixed to the toothpaste packaging marketed by Dr. Liebe for the sole purpose of drawing consumers’ attention to the quality of those toothpastes and thus promoting the sale of Dr. Liebe products. Therefore, the situation at issue in the main proceedings differs from the specific case referred to in paragraphs 31 and 32 of the present judgment.

- 34 As regards, next, Article 9(1)(b) of Regulation No 207/2009 and Article 5(1)(b) of Directive 2008/95, which grant the proprietor of the mark specific protection against the use, by a third party, of signs identical with, or similar to, the mark leading to a likelihood of confusion on the part of the public, it is apparent from the wording of those provisions, read in the light of recital 8 of that regulation and recital 11 of that directive, that that protection granted to the proprietor of the trade mark applies only in cases where there is an identity or similarity — not only between the sign used by the third party and the mark — but also between the goods or services covered by that sign, on the one hand, and those covered by the mark, on the other.
- 35 Like the expression ‘in relation to goods or services’, which appears in Article 9(1)(a) of Regulation No 207/2009 and Article 5(1)(a) of Directive 2008/95, the words ‘goods or services covered by ... the sign’ referred to in paragraph 1(b) of those articles cover, in principle, the goods marketed or services supplied by the third party (judgment of 12 June 2008, *O2 Holdings and O2 (UK)*, C-533/06, EU:C:2008:339, paragraph 34). In the absence of any similarity between the goods or services of the third party and those for which the mark is registered, the protection granted by those provisions is not applicable (see, in particular, judgment of 15 December 2011, *Frisdranken Winters*, C-119/10, EU:C:2011:837, paragraphs 31 to 33).
- 36 Article 9(1)(b) of Regulation No 207/2009 and Article 5(1)(b) of Directive 2008/95 thus contain, like paragraph 1(a) of those articles, a requirement that the goods or services of a third party, on the one hand, and those of the proprietor of the trade mark, on the other, be comparable. Points (a) and (b) differ fundamentally, in that regard, from point (c) of Article 9(1) of that regulation and from Article 5(2) of that directive, which expressly state that such comparability is not required where the mark has a reputation.
- 37 That difference expressly provided for by the EU legislature between the protection that is granted to proprietors of any individual trade mark and the additional protection that the proprietor enjoys where his mark also has a reputation has been maintained during successive amendments to EU trade mark legislation. Thus, the wording ‘in relation to goods or services which are identical with those for which the EU trade mark is registered’ and ‘in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered’ is now contained in Article 9(2)(a) and (b) of Regulation 2017/1001 and in Article 10(2)(a) and (b) of Directive 2015/2436, thus distinguishing the protection afforded by any individual trade mark from that provided for in Article 9(2)(c) of that regulation and in Article 10(2)(c) of that directive, which is applicable where the mark has a reputation and a third party uses a sign that ‘is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered’.
- 38 It follows from all of the foregoing that the proprietor of an individual trade mark that consists of a quality label registered in relation to printed matter and services of conducting tests and providing consumer information and consultancy may, if all the conditions are fulfilled, rely on the right of prohibition set out in Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 against third parties, such as potential competitors, who use a sign identical with, or similar to, that mark in relation to printed matter or services of conducting tests and providing consumer information and consultancy, or in relation to similar goods and services, but that he may not rely on that right against manufacturers of tested consumer products who affix the sign identical with, or similar to, that mark to those consumer products.
- 39 In so far as ÖKO-Test Verlag and the German Government submitted, in their written observations, that such an interpretation, even though founded on the wording and scheme of Regulation No 207/2009 and Directive 2008/95, would unduly reduce the protection of proprietors of individual trade marks consisting of a quality label, such as that at issue in the main proceedings, it should be

noted, as the European Commission has indicated in its written observations, that the exclusive right afforded by the mark is not absolute, since the EU legislature has, on the contrary, precisely delimited the scope of that right.

40 Furthermore, nothing in the objectives of EU trade mark legislation, such as the objective of contributing to the system of undistorted competition in the Union (see, in particular, to that effect, judgments of 4 October 2001, *Merz & Krell*, C-517/99, EU:C:2001:510, paragraphs 21 and 22, and of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 38), supports the conclusion that the purpose of that legislation requires that the proprietor of an individual trade mark consisting of a quality label must be able to oppose, on the basis of Article 9(1)(a) and (b) of Regulation No 207/2009 or Article 5(1)(a) and (b) of Directive 2008/95, the affixing, by the manufacturer of a product, of that label together with the result of the test to which the product was subjected.

41 This is particularly true in view of the fact that the EU legislature supplemented the EU trade mark regime by providing in Article 74a et seq. of Regulation No 207/2009, now Article 83 et seq. of Regulation 2017/1001, for the possibility of registering as an EU certification mark certain signs, including those that are capable of distinguishing the goods or services that are certified by the proprietor of the mark in respect of quality from goods and services that are not so certified. In contrast to an individual trade mark, such a certification mark allows the proprietor to specify in regulations governing use the persons authorised to use the mark.

42 In so far as ÖKO-Test Verlag maintains that the affixing of a quality label by Dr. Liebe was not covered by the previously concluded licensing agreement, it is lastly necessary to add that the fact that the proprietor of a mark, such as ÖKO-Test Verlag, cannot, with regard to manufacturers whose products it has tested, rely on Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 does not mean that it is without legal protection against those manufacturers, but merely that the conflicts between it and those manufacturers must be assessed from the point of view of other rules of law. Those rules may include rules relating to contractual or non-contractual liability, as well as the rules, referred to in the second question, which are set out in Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95.

43 In the light of all of the foregoing considerations, the answer to the first question is that Article 9(1)(a) and (b) of Regulation No 207/2009 and Article 5(1)(a) and (b) of Directive 2008/95 must be interpreted as meaning that they do not entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

The second question

44 By its second question, the referring court asks, in essence, whether Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.

45 The provisions referred to in the preceding paragraph determine the scope of the protection that is afforded to the proprietors of marks with a reputation. They entitle those proprietors 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 — that takes unfair advantage of the distinctive character or the repute of those marks or is detrimental to that distinctive character or

repute. The exercise of that right is not conditional upon there being a likelihood of confusion on the part of the relevant section of the public (see, to that effect, inter alia, judgments of 22 September 2011, *Interflora and Interflora British Unit*, C-323/09, EU:C:2011:604, paragraphs 68, 70 and 71, and of 20 July 2017, *Ornuua*, C-93/16, EU:C:2017:571, paragraph 50).

- 46 As is apparent from the request for a preliminary ruling, the referring court considers that, in the present case, Dr. Liebe affixed to its products a sign identical with, or similar to, the ÖKO-TEST marks without ÖKO-Test Verlag's consent. It has some doubts, however, as to whether those marks afford ÖKO-Test Verlag the protection laid down by those provisions. It draws attention to the fact that, for the relevant German public, it is the quality label that has a reputation and not its registration as a trade mark. Additionally, that public perceives the affixing of the sign at issue by Dr. Liebe as the display of a quality label and not as the use of such a label as a trade mark.
- 47 In that regard, it should be recalled that the concept of 'reputation' referred to in Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95, assumes a certain degree of knowledge amongst the relevant public. That public must be determined by reference to the product or service marketed under the trade mark concerned and the degree of knowledge required must be considered to be reached when the trade mark is known by a significant part of that public (see, to that effect, judgments of 6 October 2009, *PAGO International*, C-301/07, EU:C:2009:611, paragraphs 21 to 24, and of 3 September 2015, *Iron & Smith*, C-125/14, EU:C:2015:539, paragraph 17).
- 48 It follows from those principles that the 'reputation', within the meaning of those provisions, of the ÖKO-TEST marks depends on whether a significant part of the public that ÖKO-Test Verlag targets with its consumer information and consultancy service and its magazine, knows the sign of which those marks consist, in this case, the quality label.
- 49 As the Advocate General has noted in point 79 of his Opinion, that requirement of knowledge cannot be interpreted as meaning that the public must be aware that the quality label has been registered as a trade mark. It is sufficient that a significant part of the relevant public knows that sign.
- 50 As regards, in particular, Article 9(1)(c), it should also be recalled that it suffices, in order for the proprietor of an EU trade mark to enjoy the protection granted by that provision, that that mark has 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 considered to have a reputation in the whole of the European Union (see, to that effect, judgments of 6 October 2009, *PAGO International*, C-301/07, EU:C:2009:611, paragraphs 27, 29 and 30, and of 20 July 2017, *Ornuua*, C-93/16, EU:C:2017:571, paragraph 51).
- 51 The sign of which the ÖKO-TEST marks consist, that is to say, the quality label reproduced in paragraph 11 of the present judgment, is, according to the findings contained in the order for reference, known by a significant part of the relevant public throughout Germany. It follows that the ÖKO-TEST marks enjoy a reputation, within the meaning of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95, with the result that ÖKO-Test Verlag enjoys the protection afforded by those provisions.
- 52 It will therefore be for the referring court to examine whether the affixing by Dr. Liebe, of a sign identical with, or similar to, the ÖKO-TEST marks to its products enabled Dr. Liebe to take unfair advantage of the distinctive character or the reputation of those marks or was detrimental to that distinctive character or reputation. Should it find that to be the case, the referring court will, in addition, have to assess whether Dr. Liebe has established, in this case, a 'due cause', within the meaning of Article 9(1)(c) of Regulation No 207/2009 and of Article 5(2) of Directive 2008/95, in relation to the affixing of that sign to those products. In the latter case, it would have to be concluded

that ÖKO-Test Verlag does not have the right to prohibit that use on the basis of those provisions (see, by analogy, judgment of 6 February 2014, *Leidseplein Beheer and de Vries*, C-65/12, EU:C:2014:49, paragraphs 43 and 44).

- 53 In the light of the foregoing, the answer to the second question is that Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a ‘due cause’, within the meaning of those provisions, in support of such affixing.

Costs

- 54 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 (Fifth Chamber) hereby rules:

- 1. Article 9(1)(a) and (b) of Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark, and Article 5(1)(a) and (b) 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 they do not entitle the proprietor of an individual trade mark consisting of a quality label to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered.**
- 2. Article 9(1)(c) of Regulation No 207/2009 and Article 5(2) of Directive 2008/95 must be interpreted as meaning that they entitle the proprietor of an individual trade mark with a reputation, consisting of a quality label, to oppose the affixing, by a third party, of a sign identical with, or similar to, that mark to products that are neither identical with, nor similar to, the goods or services for which that mark is registered, provided that it is established that, by that affixing, the third party takes unfair advantage of the distinctive character or the reputation of the mark concerned or causes detriment to that distinctive character or reputation and provided that, in that case, the third party has not established the existence of a ‘due cause’, within the meaning of those provisions, in support of such affixing.**

[Signatures]