



## Reports of Cases

### JUDGMENT OF THE COURT (Fifth Chamber)

12 June 2019\*

(Reference for a preliminary ruling — Trade marks — Directive 2008/95/EC — Article 4(1)(b) — Likelihood of confusion — Overall impression — Earlier trade mark registered with a disclaimer — Effects of such a disclaimer on the extent of protection of the earlier trade mark)

In Case C-705/17,

REQUEST for a preliminary ruling under Article 267 TFEU from the Svea hovrätt, Patent- och marknadsöverdomstolen (Svea Court of Appeal, Patents and Market Court of Appeal, Stockholm, Sweden), made by decision of 20 November 2017, received at the Court on 15 December 2017, in the proceedings

**Patent- och registreringsverket**

v

**Mats Hansson,**

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: G. Pitruzzella,

Registrar: C. Strömholm, Administrator,

after considering the observations submitted on behalf of:

- Patent- och registreringsverket, by K. Isaksson, M. Nowicka and M. Ahlgren, acting as Agents,
- the European Commission, by K. Simonsson, É. Gippini Fournier, E. Ljung Rasmussen and G. Tolstoy, acting as Agents,

having regard to the written procedure and further to the hearing on 13 December 2018,

after hearing the Opinion of the Advocate General at the sitting on 6 March 2019,

gives the following

\* Language of the case: Swedish.

## Judgment

- 1 This request for a preliminary ruling concerns the interpretation of Article 4(1)(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 (OJ 2008 L 299, p. 25).
- 2 The request has been made in proceedings between the Patent- och registreringsverket (Patent and Registration Office, Sweden, 'the PRV') and Mr Mats Hansson, a Swedish national, concerning the refusal to register the word sign 'ROSLAGSÖL' as a national trade mark.

### Legal context

#### *EU law*

- 3 Recitals 4, 6, 8, 10 and 11 of Directive 2008/95 state:
  - '(4) It does not appear to be necessary to undertake full-scale approximation of the trade mark laws of the Member States. It will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market.
  - ...
  - (6) Member States should also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration. They can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an *ex officio* examination procedure or both. ...
  - ...
  - (8) Attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark be, in general, identical in all Member States. ...
  - ...
  - (10) It is fundamental, in order to facilitate the free movement of goods and services, to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States. This should not, however, prevent the Member States from granting at their option extensive protection to those trade marks which have a reputation.
  - (11) 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. It is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion. The likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for

such protection. The ways in which likelihood of confusion may be established, and in particular the onus of proof, should be a matter for national procedural rules which should not be prejudiced by this Directive.’

4 In accordance with Article 3(1)(c) of Directive 2008/95:

‘1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

...

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services.’

5 Article 4(1)(b) of that directive provides:

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

...

(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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.’

6 Article 5(1)(b) of the directive reads as follows:

‘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:

...

(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.’

7 Article 6(1)(b) of the directive provides:

‘1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

...

(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services.’

8 Directive 2008/95 was repealed 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), which entered into force on 12 January

2016. In view of the date of the application for registration at issue in the main proceedings, the present reference for a preliminary ruling must however be examined by reference to the provisions of Directive 2008/95.

- 9 Article 37(2) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1), which replaced the identically worded Article 38(2) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), provided:

‘Where the trade mark contains an element which is not distinctive, and where the inclusion of that element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the [European Union Intellectual Property Office (EUIPO)] may request, as a condition for registration of said trade mark, that the applicant state that he disclaims any exclusive right to such element. Any disclaimer shall be published together with the application or the registration of the [European Union] trade mark, as the case may be.’

- 10 Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Regulation No 40/94, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21), repealed Article 37(2) of Regulation No 207/2009.

### *Swedish law*

- 11 In accordance with Paragraph 6 of Chapter 1 of the Varumärkslagen (2010:1877) (Law No 1877 of 2010 on trade marks, ‘the Law of 2010’), the exclusive right to a trade mark is acquired by registration.
- 12 Point 2 of the first subparagraph of Paragraph 10 of Chapter 1 of the Law of 2010 provides that the exclusive right to a registered trade mark means that no one other than the proprietor may, without his consent, use in the course of trade any sign where, because of its identity with or similarity to the trade mark and because of the identity or similarity of the goods covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, including the risk of an impression that there is an association between the user of the sign and the proprietor of the trade mark.
- 13 Paragraph 5 of Chapter 2 of the Law of 2010 provides that one of the general conditions of registration laid down by that chapter is that the trade mark must be distinctive for the goods or services which it covers.
- 14 Under point 2 of the first subparagraph of Paragraph 8 of Chapter 2 of the Law of 2010, a trade mark is not to be registered if it is similar to an earlier trade mark and the goods or services designated by the two marks are identical or similar, where there exists a likelihood of confusion, including the likelihood of an impression that there is an association between the user of the trade mark and the proprietor of the registered trade mark.
- 15 The first subparagraph of Paragraph 12 of Chapter 2 of the Law of 2010 provides that, if a trade mark contains an element which cannot be registered by itself and there is a clear risk that registration may give rise to uncertainty as to the scope of the exclusive right, that element may be excluded from protection at the time of registration, by a disclaimer.

- 16 The second subparagraph of Paragraph 12 provides that, if that element subsequently satisfies the conditions for registration, the element or the entire trade mark may be registered on a fresh application without such a disclaimer.

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

- 17 In 2007 the Swedish company Norrtelje Brenneri Aktiebolag registered, for alcoholic drinks in Class 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, as a national trade mark the following word and figurative sign ('the earlier trade mark'):



Fig. 1.

- 18 That registration was accompanied by a disclaimer stating that 'registration does not give an exclusive right over the word RoslagsPunsch'. The disclaimer was required by the PRV as a condition of registration of the earlier trade mark, in so far as the term 'Roslags' refers to a region of Sweden and the term 'Punsch' describes one of the goods covered by the registration.

- 19 By document of 16 December 2015, Mr Hansson applied to the PRV for registration of the word sign 'ROSLAGSÖL' as a national trade mark for goods in Class 32 of the Nice Agreement, in particular non-alcoholic beverages and beers.
- 20 By decision of 14 July 2016, the PRV rejected the application for registration because of the likelihood of confusion between the sign and the earlier trade mark. The PRV found that the signs at issue started with the descriptive term 'Roslags'. The fact that they also included other words or figurative elements did not reduce the similarity, since the word 'Roslags' was a dominant element of both signs. Moreover, the signs referred to identical or similar products which could be distributed by the same sales networks and could address the same customers.
- 21 Mr Hansson brought an action before the Patent- och marknadsdomstolen (Patents and Market Court, Sweden) against that decision, arguing that there was no likelihood of confusion between the signs in question. As regards the effect of the disclaimer relating to the earlier trade mark on the outcome of the action, the PRV argued before that court that an element of a trade mark which has been excluded from protection by means of a disclaimer must in principle be regarded as not distinctive. In the present case, registration of the earlier trade mark had been granted with such a disclaimer because the trade mark included a term that was descriptive of a geographical region, 'Roslags'.
- 22 The practice of the PRV concerning the non-distinctive character of geographical names had developed in the meantime, in particular with the aim of putting into practice the conclusions in paragraphs 31 and 32 of the judgment of 4 May 1999, *Windsurfing Chiemsee* (C-108/97 and C-109/97, EU:C:1999:230). The term 'Roslags' was now capable of registration in itself as a trade mark and was distinctive for the goods at issue in the present case, so that it could even dominate the overall impression given by the earlier trade mark. It thus followed from a global assessment of the signs at issue that because of the common element 'Roslags' the relevant public could have the impression that the goods referred to by those signs had the same commercial origin.
- 23 The Patent- och marknadsdomstolen (Patents and Market Court), contrary to the position put forward by the PRV, allowed Mr Hansson's application and approved the registration of his sign as a trade mark, finding that there was no likelihood of confusion. The court also stated that, despite the disclaimer, the terms to which it related had to be taken into account in the assessment of that likelihood, in so far as they could have an effect on the overall impression created by the earlier trade mark, and hence on the extent of protection of that mark. According to the court, the purpose of the disclaimer was to make it clear that the exclusive right deriving from registration of the earlier trade mark did not relate to the terms referred to as such.
- 24 The PRV appealed against the judgment of the court of first instance to the Svea hovrätt, Patent- och marknadsöverdomstolen (Svea Court of Appeal, Patents and Market Court of Appeal, Stockholm, Sweden).
- 25 That court explains that in its view Directive 2008/95 and the associated case-law confirm that the substantive rules on the protection of a national trade mark are in principle fully harmonised at the level of EU law, while the procedural rules are within the competence of the Member States. It therefore asks whether a national rule allowing a disclaimer to be made may be categorised as a procedural rule, even though it has the effect of changing the criteria on which is based the global assessment to be carried out in order to examine the likelihood of confusion within the meaning of Article 4(1)(b) of that directive.
- 26 That court is uncertain whether that provision, having regard in particular to the settled case-law of the Court according to which the assessment of the likelihood of confusion must be based on an overall impression and the perceptions of consumers play a dominant part in the global assessment of that likelihood, may be interpreted as meaning that a disclaimer can affect that assessment because an



element of the earlier trade mark was, at the time of registration, expressly excluded from protection by means of that disclaimer, so that that element must be given less importance in the analysis of the overall impression than it would have had in the absence of the disclaimer.

- 27 If Directive 2008/95 were to preclude such an approach, the question would then arise of whether it allows a disclaimer to have the effect that the element to which it relates is considered not to have been the subject of the registration of the earlier trade mark, and therefore not to enjoy the protection of that mark, so that it can be excluded from the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of that directive. That approach, according to the referring court, would appear to have been followed by EUIPO in the application of Article 37(2) of Regulation No 207/2009.
- 28 That court observes, moreover, that the case-law of the national courts is not uniform concerning the effect of a disclaimer, as provided for in national law, on the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95.
- 29 In those circumstances, the Svea hovrätt, Patent- och marknadsöverdomstolen (Svea Court of Appeal, Patents and Market Court of Appeal, Stockholm), decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

- ‘(1) Must Article 4(1)(b) of [Directive 2008/95] be interpreted as meaning that the global assessment of all relevant factors which is to be made in an assessment of the likelihood of confusion may be affected by the fact that an element of the trade mark has expressly been excluded from protection on registration, that is to say, that a so-called disclaimer has been entered on registration?
- (2) If the answer to the first question is in the affirmative, can the disclaimer in such a case affect the global assessment in such a way that the competent authority has regard to the element in question but gives it a more limited importance so that it is not regarded as being distinctive, even if the element would de facto be distinctive and prominent in the earlier trade mark?
- (3) If the answer to the first question is in the affirmative and the answer to the second question in the negative, can the disclaimer even so affect the global assessment in any other way?’

### **Consideration of the questions referred**

- 30 By its questions, which should be considered together, the referring court asks in substance whether Article 4(1)(b) of Directive 2008/95 must be interpreted as precluding national legislation making provision for a disclaimer whose effect would be to exclude an element of a complex trade mark, referred to in that disclaimer, from the analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision, or to attribute to such an element, in advance and permanently, limited importance in that analysis.
- 31 As a preliminary point, it should be recalled that the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, to that effect, judgments of 16 September 2004, *SAT.1 v OHIM*, C-329/02 P, EU:C:2004:532, paragraph 23, and of 8 June 2017, *W. F. Gözze Frottierweberei and Gözze*, C-689/15, EU:C:2017:434, paragraph 41).
- 32 Directive 2008/95, which applies, in accordance with Article 1, in particular to trade marks for goods or services which are the subject of registration or of an application in a Member State for registration, approximates, as stated in recitals 4, 6, 8 and 10, those national provisions of law which

most directly affect the functioning of the internal market. According to those recitals, it is fundamental, for that purpose, to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States and that the conditions for obtaining a registered trade mark are, in general, identical in all Member States, while leaving the Member States free to fix the procedural provisions concerning inter alia the registration of those trade marks.

- 33 In this respect, Article 5(1)(b) of Regulation No 2008/95 states that 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 inter alia from using in the course of trade 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.
- 34 Article 4(1)(b) of Directive 2008/95 provides for its part that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.
- 35 Those provisions thus aim to protect the individual interests of proprietors of earlier trade marks, and guarantee the trade mark as an indication of origin if there is a likelihood of confusion (see, to that effect, judgment of 6 October 2005, *Medion*, C-120/04, EU:C:2005:594, paragraphs 24 and 26, and of 22 October 2015, *BGW*, C-20/14, EU:C:2015:714, paragraph 26).
- 36 Neither those provisions nor any other provisions of Directive 2008/95 contain an obligation for Member States to introduce, or a prohibition on their introducing, provisions in their national law under which the registration of a sign as a trade mark may be accompanied by a disclaimer. Nor do those provisions specify the effects of such a disclaimer on the examination of the likelihood of confusion within the meaning of that directive.
- 37 In those circumstances, it must be stated, as the Advocate General observes in points 22 and 24 of his Opinion, that the Member States in principle remain free to lay down provisions in their national law allowing disclaimers to be recorded at the time of registration of signs as trade marks, whether those disclaimers are entered voluntarily by the applicant or at the request of the national authority with competence for registration, provided that the disclaimers do not impair the effectiveness of the provisions of Directive 2008/95, in particular the protection given to proprietors of earlier trade marks against the registration of trade marks liable to create a likelihood of confusion on the part of consumers or end users.
- 38 In addition, such disclaimers must not have the effect of calling in question the objectives pursued by Directive 2008/95, referred to in recitals 8 and 10 of the directive, namely to ensure that the conditions for obtaining a registered trade mark are, in general, identical in all Member States, and to guarantee equal protection of trade marks under the legal systems of all the Member States (see, by analogy, judgments of 26 April 2007, *Boehringer Ingelheim and Others*, C-348/04, EU:C:2007:249, paragraphs 58 and 59; of 19 June 2014, *Oberbank and Others*, C-217/13 and C-218/13, EU:C:2014:2012, paragraphs 66 and 67; and of 22 September 2011, *Budějovický Budvar*, C-482/09, EU:C:2011:605, paragraphs 30 and 32).
- 39 In the present case, the referring court sets out three possible effects of a disclaimer, as provided for by national law, on the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95. According to that court, a first interpretation of national law would be that the element of a complex mark that is the subject of such a disclaimer is excluded from the analysis of the likelihood of confusion. A second interpretation of that law would be that such an element is indeed taken into account in that analysis, but its importance for that purpose must be limited, even



if it is in reality the distinctive and dominant element of the trade mark. A third interpretation would, in substance, be that in the analysis of the likelihood of confusion account must be taken of such an element in a manner consistent with the principles applicable to that analysis identified in the settled case-law of the Court.

- 40 On this point, it must be recalled that the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 (see, to that effect, judgments of 29 September 1998, *Canon*, C-39/97, EU:C:1998:442, paragraph 29, and of 8 May 2014, *Bimbo v OHIM*, C-591/12 P, EU:C:2014:305, paragraph 19 and the case-law cited).
- 41 According to settled case-law of the Court, the existence of a likelihood of confusion depends on numerous elements, in particular the recognition of the trade mark on the market, the association which can be made with the used or registered sign, and the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion must therefore be appreciated globally, taking into account all the relevant factors of the particular case (see, to that effect, judgments of 29 September 1998, *Canon*, C-39/97, EU:C:1998:442, paragraph 16; of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 18; and of 10 April 2008, *adidas and adidas Benelux*, C-102/07, EU:C:2008:217, paragraph 29).
- 42 Those factors also include the distinctiveness of the earlier trade mark, which determines the extent of protection. The Court has previously stated that the more distinctive the earlier mark, the greater the likelihood of confusion will be (see, to that effect, judgment of 8 November 2016, *BSH v EUIPO*, C-43/15 P, EU:C:2016:837, paragraph 62 and the case-law cited).
- 43 A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the trade marks, and vice versa. The interdependence of these factors is expressly mentioned in recital 11 of Directive 2008/95, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion (see, to that effect, judgments of 29 September 1998, *Canon*, C-39/97, EU:C:1998:442, paragraph 17, and of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 19).
- 44 Similarly, according to the Court's case-law, the fact that a trade mark is of weak distinctiveness does not exclude a likelihood of confusion, in particular where the signs and the goods or services covered are similar (see, to that effect, judgment of 8 November 2016, *BSH v EUIPO*, C-43/15 P, EU:C:2016:837, paragraph 63 and the case-law cited).
- 45 That global assessment must, as regards the visual, phonetic or conceptual similarity of the trade marks at issue, be based on the overall impression created by them. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, judgments of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 23; of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 25; and of 22 October 2015, *BGW*, C-20/14, EU:C:2015:714, paragraph 35).
- 46 In the light of those principles and of all the case-law referred to in paragraphs 40 to 45 above, it must be concluded, in the first place, that a disclaimer provided for by national law whose effect was to exclude an element of a complex trade mark, mentioned in the disclaimer, from the analysis of the relevant factors for establishing the existence of a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 because that element is descriptive or not distinctive would not be compatible with the requirements of that provision.

- 47 Such an exclusion could lead to an incorrect assessment both of the similarity between the signs at issue and of the distinctiveness of the earlier trade mark, which would lead to a distorted global assessment of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95, all the more so as those factors are interdependent, as stated in paragraph 43 above, that interdependence being directed, as the Advocate General observes in point 41 of his Opinion, to bringing the assessment of the likelihood of confusion into line as far as possible with the actual perception of the relevant public.
- 48 As regards, first, the assessment of the similarity between the signs at issue, it should be recalled that it cannot be confined to taking one sole component of a complex trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, taking account in particular of their distinctive and dominant elements (see, to that effect, judgment of 22 October 2015, *BGW*, C-20/14, EU:C:2015:714, paragraph 36 and the case-law cited).
- 49 It is therefore necessary in each individual case to analyse the components of a sign and their relative weight in the perception of the public, in order to determine in the light of the particular circumstances of the case the overall impression made on the public by the signs at issue (see, to that effect, judgment of 8 May 2014, *Bimbo v OHIM*, C-591/12 P, EU:C:2014:305, paragraphs 34 and 36). It cannot therefore be considered in advance and in general that the descriptive elements of signs at issue must be excluded from the assessment of their similarity (see, in that respect, order of 7 May 2015, *Adler Modemärkte v OHIM*, C-343/14 P, not published, EU:C:2015:310, paragraph 38).
- 50 As regards, second, the distinctiveness of the earlier trade mark, it follows from the Court's case-law that the determination of distinctiveness depends on the inherent characteristics of the trade mark, including the presence or absence of elements that are descriptive of the goods or services for which it has been registered as a mark (see, to that effect, judgment of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraphs 20, 22 and 23 and the case-law cited).
- 51 As the Advocate General observes in point 43 of his Opinion, the power of a trade mark to identify the goods or services for which it has been registered as a mark as coming from a particular undertaking must be assessed in relation to the sign as a whole, and hence in the light of all its components, so that the exclusion of one of the elements of the earlier trade mark from the analysis of the distinctiveness of that mark may have an effect on the extent of protection of that mark.
- 52 It must be stated, in the second place, that, for reasons analogous to those set out in paragraphs 48 to 51 above, a disclaimer provided for in national law whose effect were to attribute, in advance and permanently, a lack of distinctiveness to the element of a complex trade mark mentioned by it, so that the element has only limited importance in the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95, would also be incompatible with the requirements of that provision.
- 53 In this respect, it must be observed, first, that the descriptive, non-distinctive or weakly distinctive elements of a complex trade mark, whether or not mentioned in a disclaimer such as that at issue in the main proceedings, generally have less weight in the analysis of the similarity between the signs than the elements of greater distinctiveness, which are also more able to dominate the overall impression created by the mark (see, in that respect, judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 23, and order of 27 April 2006, *L'Oréal v OHIM*, C-235/05 P, not published, EU:C:2006:271, paragraph 43).

- 54 However, the Court has held that the individual assessment of each sign for the purpose of determining the overall impression produced by it, as required by the Court's settled case-law, must be made in the light of the particular circumstances of the case and cannot be regarded as being subject to general presumptions (see, to that effect, judgment of 8 May 2014, *Bimbo v OHIM*, C-591/12 P, EU:C:2014:305, paragraph 36).
- 55 Second, where the earlier trade mark and the sign whose registration is sought coincide in an element that is weakly distinctive or descriptive with regard to the goods or services at issue, the global assessment of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 will admittedly not often lead to a finding that that likelihood exists. However, it follows from the Court's case-law that a finding that a likelihood of confusion exists cannot, because of the interdependence of the relevant factors, be ruled out in advance and in any event (see, in that respect, order of 29 November 2012, *Hrbek v OHIM*, C-42/12 P, not published, EU:C:2012:765, paragraph 63, and judgment of 8 November 2016, *BSH v EUIPO*, C-43/15 P, EU:C:2016:837, paragraphs 48 and 61 to 64).
- 56 It follows from the above that the attribution to an element of a complex trade mark, mentioned in a disclaimer, of non-distinctiveness and hence of limited weight in the global assessment of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 could indeed correspond in some situations to the relevant public's perception of the signs at issue. However, it cannot be considered that that will necessarily be so in every case, so that a disclaimer having that effect could lead to the registration of signs liable to produce a likelihood of confusion on the part of the public within the meaning of that provision.
- 57 In the third place, the interpretation set out in paragraphs 46 and 52 above cannot be called into question by the fact that the element mentioned in the disclaimer at issue in the main proceedings is, under national law and because of its descriptive character, excluded from the protection granted to a registered trade mark, so that taking it into account in the analysis of the relevant factors for finding a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 would allow it to enjoy a protection which it cannot have in the system of that directive.
- 58 A finding of a likelihood of confusion leads solely to the protection of a certain combination of elements without, however, a descriptive element which forms part of that combination being protected as such (see, by analogy, orders of 15 January 2010, *Messer Group v Air Products and Chemicals*, C-579/08 P, not published, EU:C:2010:18, paragraph 73, and of 30 January 2014, *Industrias ALEN v The Clorox Company*, C-422/12 P, EU:C:2014:57, paragraph 45). Consequently, the proprietor of a complex trade mark cannot in any event claim an exclusive right solely in one element of the trade mark, whether or not it is referred to in a disclaimer provided for by national law.
- 59 Moreover, as the Advocate General observes in points 26 and 50 of his Opinion, Directive 2008/95 provides sufficient guarantees to ensure that signs consisting exclusively of signs or indications that are descriptive of categories of goods or services for which registration is sought are, pursuant to Article 3(1)(c), not registered or are declared invalid, and may thus be freely used by other economic operators.
- 60 In addition, it follows from Article 6(1)(b) of that directive that, where a sign is validly registered as a trade mark, the exclusive right conferred by the mark does not allow its proprietor to prohibit a third party from using in the course of trade descriptive indications for the goods and services concerned, subject to compliance with certain conditions (see, in that respect, judgments of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraphs 25 and 28; of 10 April 2008, *adidas and adidas Benelux*, C-102/07, EU:C:2008:217, paragraphs 46 and 47; and of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraphs 59 to 62).

- 61 Furthermore, it must be observed that that interpretation is in line with the objectives of Directive 2008/95 referred to in paragraph 32 above, in so far as it aims to ensure that a registered national trade mark is protected against a likelihood of confusion in accordance with the same criteria and thus in a uniform manner in all the Member States, having regard in particular to the fact that numerous Member States do not provide for the possibility of registering signs as trade marks with such disclaimers and that the conditions of recording those disclaimers and the effects of the disclaimers may vary between the legal systems of the Member States.
- 62 It follows from all the above considerations that Article 4(1)(b) of Directive 2008/95 must be interpreted as precluding national legislation making provision for a disclaimer whose effect would be to exclude an element of a complex trade mark, referred to in that disclaimer, from the global analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision, or to attribute to such an element, in advance and permanently, limited importance in that analysis.

### **Costs**

- 63 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the referring 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:

**Article 4(1)(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 precluding national legislation making provision for a disclaimer whose effect would be to exclude an element of a complex trade mark, referred to in that disclaimer, from the global analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision, or to attribute to such an element, in advance and permanently, limited importance in that analysis.**

[Signatures]