

9(1)(a) and (c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) and Articles 12(1), 13(1) and 14(1) of Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market ('Directive on electronic commerce') (OJ 2000 L 178, p. 1) — Meaning of 'use' of a mark — Registration by a trader with a service provider which operates an Internet search engine of a sign identical to a trade mark in order to have displayed automatically on the screen, following the entry of that sign as a search term, the URL of that trader's website offering goods and services identical to those covered by the trade mark ('AdWords') — Flower delivery service

Operative part of the judgment

1. 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 and Article 9(1)(a) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that the proprietor of a trade mark is entitled to prevent a competitor from advertising — on the basis of a keyword which is identical with the trade mark and which has been selected in an internet referencing service by the competitor without the proprietor's consent — goods or services identical with those for which that mark is registered, where that use is liable to have an adverse effect on one of the functions of the trade mark. Such use:

— adversely affects the trade mark's function of indicating origin where the advertising displayed on the basis of that keyword does not enable reasonably well-informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods or services concerned by the advertisement originate from the proprietor of the trade mark or an undertaking economically linked to that proprietor or, on the contrary, originate from a third party;

— does not adversely affect, in the context of an internet referencing service having the characteristics of the service at issue in the main proceedings, the trade mark's advertising function; and

— adversely affects the trade mark's investment function if it substantially interferes with the proprietor's use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty.

2. Article 5(2) of Directive 89/104 and Article 9(1)(c) of Regulation No 40/94 must be interpreted as meaning that the proprietor of a trade mark with a reputation is entitled to prevent a competitor from advertising on the basis of a keyword corresponding to that trade mark, which the competitor has, without the proprietor's consent, selected in an internet referencing service, where the competitor thereby takes unfair advantage of the distinctive character or repute of the trade mark (free-riding) or where the advertising is detrimental to that distinctive character (dilution) or to that repute (tarnishment).

Advertising on the basis of such a keyword is detrimental to the distinctive character of a trade mark with a reputation (dilution) if, for example, it contributes to turning that trade mark into a generic term.

By contrast, the proprietor of a trade mark with a reputation is not entitled to prevent, *inter alia*, advertisements displayed by competitors on the basis of keywords corresponding to that trade mark, which put forward — without offering a mere imitation of the goods or services of the proprietor of that trade mark, without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark with a reputation — an alternative to the goods or services of the proprietor of that mark.

(¹) OJ C 282, 21.11.2009.

Judgment of the Court (First Chamber) of 22 September 2011 (reference for a preliminary ruling from the Court of Appeal (England & Wales) (Civil Division) — United Kingdom) — Budějovický Budvar, národní podnik v Anheuser-Busch Inc.

(Case C-482/09) (¹)

(Trade marks — Directive 89/104/EEC — Article 9(1) — Concept of acquiescence — Limitation in consequence of acquiescence — Starting point for limitation period — Prerequisites for the limitation period to run — Article 4(1)(a) — Registration of two identical marks designating identical goods — Functions of the trade mark — Honest concurrent use)

(2011/C 331/04)

Language of the case: English

Referring court

Court of Appeal (England & Wales) (Civil Division)

Parties to the main proceedings

Applicant: Budějovický Budvar, národní podnik

Defendant: Anheuser-Busch Inc.

Re:

Reference for a preliminary ruling — Court of Appeal (England & Wales) (Civil Division) — Interpretation of Articles 4(1)(a) and 9(1) 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) — Limitation in consequence of acquiescence — Concept of acquiescence — Concept of Community law? — Possibility of proceedings under relevant national law, including rules relating to honest concurrent use of two identical marks

Operative part of the judgment

1. Acquiescence, within the meaning of Article 9(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, is a concept of European Union law and the proprietor of an earlier trade mark cannot be held to have acquiesced in the long and well-established honest use, of which he has long been aware, by a third party of a later trade mark which is identical with that of the proprietor if that proprietor was not in any position to oppose that use.
2. Registration of the earlier trade mark in the Member State concerned does not constitute a prerequisite for the running of the period of limitation in consequence of acquiescence prescribed in Article 9(1) of Directive 89/104. The prerequisites for the running of that period of limitation, which it is for the national court to determine, are, first, registration of the later trade mark in the Member State concerned, second, the application for registration of that mark being made in good faith, third, use of the later trade mark by its proprietor in the Member State where it has been registered and, fourth, knowledge by the proprietor of the earlier trade mark that the later trade mark has been registered and used after its registration.
3. Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.

⁽¹⁾ OJ C 24, 30.1.2010.

Judgment of the Court (Fourth Chamber) of 22 September 2011 — European Commission v Kingdom of Spain

(Case C-90/10) ⁽¹⁾

(Failure of a Member State to fulfil obligations — ‘Habitats’ directive — Conservation of natural habitats — Wild fauna and flora — Articles 4(4) and 6(1) and (2) — Establishment of priorities for special areas of conservation and of adequate protection thereof — Failure to ensure adequate legal protection of the special areas of conservation in the Canary Islands)

(2011/C 331/05)

Language of the case: Spanish

Parties

Applicant: European Commission (represented by: S. Pardo Quintillán and D. Recchia, Agents)

Defendant: Kingdom of Spain (represented by: F. Díez Moreno, Agent)

Intervener in support of the defendant: Republic of Finland (represented by M. Pere, Agent)

Re:

Failure of a Member State to fulfil obligations — Infringement of Article 4(4) and Article 6(1) and (2) of Council Directive 92/43/EEC of 21 May 1992 on the conservation of natural habitats and of wild fauna and flora (OJ 1992 L 206, p. 7) — Sites of Community importance — Conservation measures — Macaronesian biogeographical region

Operative part of the judgment

The Court:

1. Declares that
 - by failing to establish, in accordance with Article 4(4) of Council Directive 92/43/EEC of 21 May 1992 on the conservation of natural habitats and of wild fauna and flora, conservation priorities in relation to the special areas of conservation corresponding to the sites of Community importance for the Macaronesian biogeographical region identified by the Commission Decision of 28 December 2001 adopting the list of sites of Community importance for the Macaronesian biogeographical region, pursuant to Council Directive 92/43/EEC (OJ 2002 L 5, p. 16), and
 - by failing to adopt and apply, in accordance with Article 6(1) and (2) of Directive 92/43/EEC, the appropriate conservation measures and a protection system to prevent the deterioration of habitats and significant disruption to species, ensuring the legal protection of the special areas of conservation corresponding to the sites referred to in Decision 2002/11/EC situated in Spanish territory,

the Kingdom of Spain has failed to fulfil its obligations under Article 4(4) and Article 6(1) and (2) of Directive 92/43/EEC;

2. Orders the Kingdom of Spain to pay the costs;
3. Orders the Republic of Finland to bear its own costs.

⁽¹⁾ OJ C 113, 1.5.2010.

Judgment of the Court (Third Chamber) of 22 September 2011 (reference for a preliminary ruling from the Bundesverwaltungsgericht — Germany) — Mesopotamia Broadcast A/S METV (C-244/10), Roj TV A/S (C-245/10) v Bundesrepublik Deutschland

(Joined Cases C-244/10 and C-245/10) ⁽¹⁾

(Directive 89/552/EEC — Television broadcasting activities — Possibility for a Member State to prohibit on its territory the activities of a television broadcaster established in another Member State — Ground based on infringement of the principles of international understanding)

(2011/C 331/06)

Language of the case: German

Referring court

Bundesverwaltungsgericht