Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

18 December 2025*

(Reference for a preliminary ruling – Trade marks – Directive 2008/95/EC – Article 12(2)(b) – Directive (EU) 2015/2436 – Article 20(b) – Grounds for revocation of a mark – Trade mark liable to mislead the public as a result of the use made of it – Trade mark corresponding to the name of a fashion designer – Assignment of the trade mark – Use of the trade mark in such a way as to make the public actually believe that the designer is still involved in the design of the goods bearing the trade mark – Misled belief)

In Case C-168/24,

REQUEST for a preliminary ruling under Article 267 TFEU from the Cour de cassation (Court of Cassation, France), made by decision of 28 February 2024, received at the Court on the same day, in the proceedings

PMJC SAS

v

[W] [X],

[M] [X],

[X] Créative SAS,

THE COURT (Third Chamber),

composed of C. Lycourgos, President of the Chamber, O. Spineanu-Matei, S. Rodin (Rapporteur), N. Piçarra and N. Fenger, Judges,

Advocate General: N. Emiliou,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– PMJC SAS, by M. Le Guerer, avocat,

* Language of the case: French.

– [W] [X], [M] [X], [X] Créative SAS, by E. Fortunet, avocat,

– the French Government, by R. Bénard and E. Timmermans, acting as Agents,

– the European Commission, by C. Auvret and P. Němečková, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 27 March 2025,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 12(2)(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) and of Article 20(b) of 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, and corrigendum OJ 2016 L 110, p. 5).

2 The request has been made in proceedings between PMJC SAS, on the one hand, and [W] [X], [M] [X] and [X] Créative SAS, on the other, concerning the partial revocation of the rights of PMJC regarding two trade marks corresponding to the surname of a fashion designer.

Legal context

European Union law

Directive 2008/95

3 Article 12 of Directive 2008/95, entitled ‘Grounds for revocation’, stated, in paragraph 2:

‘… A trade mark shall be liable to revocation if, after the date on which it was registered:

…

(b) in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.’

Directive 2015/2436

4 Article 20 of that directive, entitled ‘Trade mark having become generic or misleading indication as grounds for revocation’, is worded as follows:

‘A trade mark shall be liable to revocation if, after the date on which it was registered:

…

(b) as a result of the use made of it by the proprietor of the trade mark or with the proprietor's consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.'

5 Article 54 of that directive, entitled 'Transposition', states, in paragraph 1:

'Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with Articles 3 to 6, Articles 8 to 14, Articles 16, 17 and 18, Articles 22 to 39, Article 41, Articles 43 and 44 and Articles 46 to 50 by 14 January 2019. …

…'

6 Article 55 of Directive 2015/2436, entitled 'Repeal', states:

'Directive [2008/95] is repealed with effect from 15 January 2019 …

References to the repealed Directive shall be construed as references to this Directive …'

7 Article 56 of Directive 2015/2436, entitled 'Entry into Force', is worded as follows:

'This Directive shall enter into force on the twentieth day following that of its publication in the *Official Journal of the European Union*.

Articles 1, 7, 15, 19, 20 and 21 shall apply from 15 January 2019.'

French law

8 Article L. 714-6 of the code de la propriété intellectuelle (French Intellectual Property Code), in the version applicable to the main proceedings, states:

'The proprietor of a trade mark may have his or her rights the mark revoked where the mark has become, as a result of his or her acts:

…

(b) liable to mislead, in particular as to the nature, quality or geographical origin of the goods or service.'

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

9 It is apparent from the order for reference that [W] [X], a company founded in 1978 by [W] [X] to market fashion clothing and accessories, became the subject of insolvency proceedings, at the conclusion of which PMJC made an offer to take over all the company's assets. That offer was accepted by a judgment of 13 September 2011, and followed by a deed of assignment of tangible and intangible assets dated 3 February 2012, relating in particular to the French word marks '[W] [X]', one of them registered by [W] [X] and then assigned in 1999 to the company [W] [X], and the other one registered in 2002 by the company [W] [X].

10 Under a provision of services agreement entered into on 21 July 2011, [W] [X] continued to work with PMJC until the end of the contractually agreed term, namely 31 December 2015.

11 On 21 June 2018, PMJC brought an action against [W] [X] for infringement of the trade marks referred to in paragraph 9 of the present judgment, as well as for unfair competition and reputational free-riding, by arguing that [W] [X] was engaging in acts of unfair competition and was infringing PMJC's trade mark rights by pursuing professional and artistic activities through a company named [X] Créative.

12 By way of counterclaim, [W] [X] sought to have PMJC's rights in those trade marks revoked on the grounds that the company had been using the trade marks in a deceptive manner from the end of 2017 to the beginning of 2019. In particular, PMJC had used those trade marks in such a way as to make the public believe that [W] [X] is the author of the designs to which those trade marks are affixed.

13 By a judgment of 12 October 2022, the cour d'appel de Paris (Court of Appeal, Paris, France) partially revoked PMJC's rights to the trade marks subject to the assignment of 3 February 2012 referred to in paragraph 9 of the present judgment.

14 That court considered, inter alia, that EU law did not preclude the revocation of a trade mark corresponding to a designer's surname where, by its conduct, the assignee of that trade mark leads the public actually to believe that the designer is still involved in the design of the goods, or creates a sufficiently serious risk of such a deception.

15 According to that court, that is the case in the main proceedings, as PMJC had twice been found guilty of infringing [W] [X]'s copyright in his recent works that had not been assigned to PMJC. As those judgments had become final, the cour d'appel de Paris (Court of Appeal, Paris) concluded that, affixed to goods bearing decorations that constitute infringements of [W] [X]'s copyright and presented as original designs made by the latter, the trade marks in question had become deceptive.

16 PMJC brought an appeal against that judgment before the Cour de cassation (Court of Cassation, France), which is the referring court.

17 Before that court, PMJC claims, inter alia, that by finding that the judgment of 30 March 2006, *Emanuel* (C-259/04, EU:C:2006:215) in no way excludes the possibility of revocation of a trade mark corresponding to the name of a designer in the event that its proprietor makes deceptive use of it and, furthermore, leaves it open to that designer to attempt to show that the use made of that trade mark by its proprietor is fraudulent, the cour d'appel de Paris (Court of Appeal, Paris) infringed Article L. 714-6(b), of the French Intellectual Property Code as it is to be interpreted in the light of Article 12(2)(b) of Directive 2008/95.

18 PMJC claims, in fact, that, in the light of that judgment, any conduct on its part intended to make the consumer believe that [W] [X] is still involved in the design of the goods marked with his name cannot affect the trade mark itself, even if that conduct were held to be deceptive.

19 In that regard, the referring court states, first of all, that, in paragraphs 47 to 49 of the judgment of 30 March 2006, *Emanuel* (C-259/04, EU:C:2006:215), which concerned a trade mark consisting of the name of a person, the Court, after having pointed out that the circumstances for refusing registration due to the deceptiveness of a trade mark presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived, held that, even if the average consumer might be influenced in his or her purchase by imagining that the natural person was

involved in the design of the good bearing the trade mark, that circumstance cannot be regarded in itself as being of such a nature as to deceive the public as to the nature, quality or geographical origin of that good.

20 Next, the Cour de Cassation (Court of Cassation) noted that, in paragraph 50 of that judgment the Court stated that if, in the presentation of the trade mark, there was an intention on the part of the undertaking to make the consumer believe that that designer is still at the origin of the goods bearing the trade mark or that he or she is involved in their design, this would be conduct which might be held to be fraudulent but which would not constitute deception capable of affecting the trade mark itself and, therefore, its prospects of being registered.

21 Lastly, the referring court observes that, in paragraph 53 of that judgment, the Court, after having found that the conditions for revocation due to the deceptiveness of a trade mark were the same as those for the refusal of registration, held that the proprietor of a trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that that trade mark would mislead the public, in particular where the goodwill associated with that trade mark has been assigned together with the business making the goods to which the mark relates.

22 However, according to PMJC, in its judgment of 12 October 2022, the cour d'appel de Paris (Court of Appeal, Paris) held that the finding in paragraph 50 of the judgment of 30 March 2006, *Emanuel* (C-259/04, EU:C:2006:215), according to which a trade mark corresponding to the surname of a designer cannot be regarded as deceptive merely because that designer is no longer involved in the design of the goods bearing trade marks consisting of his or her surname, does not extend to the interpretation of Article 12(2)(b) of the 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). The cour d'appel de Paris (Court of Appeal, Paris) thus had held that that provision had to be interpreted as not precluding the revocation of a trade mark on the ground that it is used in such a way as to make the public actually believe that the designer is still involved in the design of the goods bearing trade marks consisting of his or her surname, when that is no longer the case.

23 The Cour de cassation (Court of Cassation) also notes that, in its judgment of 14 May 2009, *Fiorucci* v *OHIM – Edwin (ELIO FIORUCCI)* (T-165/06, EU:T:2009:157, paragraph 37), the General Court of the European Union dismissed the application for revocation based on the deceptive use of the trade mark relating to the surname of a designer after registration, not on the ground that it could be ruled out that such deceptive use would lead to revocation of the trade mark due to deceptiveness, but on the ground that no evidence showing any use of the trade mark after its registration had been submitted.

24 In those circumstances the Cour de cassation (Court of Cassation) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

'Must Article 12(2)(b) of Directive [2008/95] and Article 20(b) of Directive [2015/2436] be interpreted as precluding the revocation of a trade mark consisting of the surname of a designer on the grounds that it is used after the assignment in such a way as to make the public actually believe that that designer is still involved in the design of the goods bearing the mark, when that is no longer the case?'

Consideration of the question referred

Preliminary observations

25 By its question, the referring court seeks an interpretation of Article 12(2)(b) of Directive 2008/95 and Article 20(b) of Directive 2015/2436.

26 The question as to which of those two directives is applicable *rationae temporis* to the dispute in the main proceedings is irrelevant as the terms of Article 12(2)(b) of Directive 2008/95 and of Article 20(b) of Directive 2015/2436 are essentially identical.

27 The fact, in that regard, that the French-language version of Article 12(2)(b) of Directive 2008/95 stated that the proprietor of a trade mark may have his or her rights revoked where the trade mark '*est propre … à induire le public en erreur*' ('is liable …. to mislead the public'), whereas Article 20(b) of Directive 2015/2436 states, in the same language version, that grounds for revocation exist where the trade mark '*risque … d'induire le public en erreur*' (literally 'risks … misleading the public', although the English-language version states 'is liable to mislead the public'), is without consequence.

28 First, as noted by the Advocate General in point 62 of his Opinion, it is apparent from the case-law of the Court that the expression 'to be liable to' already presupposes 'the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived' (judgment of 30 March 2006, *Emanuel*, C-259/04, EU:C:2006:215, paragraph 47 and the case-law cited).

29 Second, as noted by the Advocate General in point 64 of his Opinion, the wording of Article 20(b) of Directive 2015/2436 has, as regards the degree of probability that the public will be misled, remained essentially unchanged, as compared to the wording of Article 12(2)(b) of Directive 2008/95, in all the other language versions which, with the exception of the Hungarian- and Finnish-language versions, already relied on the idea of a mere risk, irrespective of whether or not it materialises.

30 Therefore, in accordance with settled case-law according to which the provisions of EU law must be interpreted and applied uniformly in the light of the versions existing in all the languages of the European Union (judgment of 13 February 2025, *Verbraucherzentrale Berlin (Concept of initial commitment period)*, C-612/23, EU:C:2025:82, paragraph 31 and the case-law cited), the change inserted into the French-language version of Article 20(b) of Directive 2015/2436, as explained in paragraph 27 of the present judgment, cannot be viewed as evidence of an intention on the part of the EU legislature to change the criterion relating to the degree of probability that the public will be misled.

31 Thus, for the purposes of the present reference for a preliminary ruling, Article 12(2)(b) of Directive 2008/95 and Article 20(b) of Directive 2015/2436 must be interpreted together and in the same way.

Consideration of the question

32 By its question, the referring court asks, in essence, whether Article 12(2)(b) of Directive 2008/95 and Article 20(b) of Directive 2015/2436 must be interpreted as precluding the revocation of a trade mark consisting of the name of a fashion designer on the ground that it is used by the

proprietor or with his or her consent in such a way as to make the public actually believe that that designer is still involved in the design of the goods bearing the trade mark, when that is no longer the case.

33 In accordance with those provisions, a trade mark may be liable to revocation if, after the date on which it was registered 'as a result of the use made of it' by the proprietor of the trade mark or with his or her consent in respect of the goods or services for which it is registered, it is liable to mislead the public, 'particularly as to the nature, quality or geographical origin' of those goods or services.

34 First of all, it must be pointed out that it follows from the wording of those provisions, and in particular from the use of the adverb 'particularly', that the list of characteristics of goods or services to which the deception might relate is not exhaustive, so that it cannot be excluded that the trade mark is revoked because there is a risk of deceit relating to the person having designed the goods bearing the trade mark or having contributed to their design.

35 Next, as with geographical origin, which is expressly mentioned in the provisions referred to in paragraph 32 of the present judgment, the creative origin of a product may, depending on the circumstances, constitute a characteristic of that product giving rise to certain expectations in the public. Therefore, that origin is among the aspects which may 'mislead' the public, within the meaning of Article 12(2)(b) of Directive 2008/95 and of Article 20(b) of Directive 2015/2436.

36 However, as explained, in essence, by the Advocate General in point 35 of his Opinion, the fact that a trade mark consisting of the name of a fashion designer is used by an undertaking with which that designer no longer has a connection is not sufficient, in itself, to justify the revocation of that trade mark (see, to that effect, judgment of 30 March 2006, *Emanuel*, C-259/04, EU:C:2006:215, paragraph 53). The average consumer, who is reasonably well informed and reasonably observant and circumspect, is conscious of the fact that not all the goods bearing a trade mark corresponding to the name of a designer necessarily have been created by that designer.

37 Consequently, revocation on the basis of the provisions whose interpretation is sought presupposes that the existence of actual deceit or a sufficiently serious risk that the public will be deceived is proven, on the basis of the circumstances of the case (see, by analogy, judgment of 8 June 2017, *W.F. Gözze Frottierweberei and Gözze*, C-689/15, EU:C:2017:434, paragraph 54 and the case-law cited).

38 Lastly, it follows from the wording of Article 12(2)(b) of Directive 2008/95 and of Article 20(b) of Directive 2015/2436 that the assessment of the deceptiveness of a trade mark in the context of revocation proceedings requires the use which is made of it by the proprietor, or with his or her consent, to be taken into consideration.

39 It follows from the foregoing considerations that, in the case of a trade mark consisting of the name of a fashion designer, actual deceit or a sufficiently serious risk that the public will be deceived, within the meaning of Article 12(2)(b) of Directive 2008/95 and of Article 20(b) of Directive 2015/2436 as interpreted in the case-law referred to in paragraph 37 of the present judgment, may, depending on the circumstances, be the consequence of the public having been misled as a result of the use which is made of that trade mark by its proprietor, or with his or her consent, as to the creative origin of the goods bearing that trade mark.

40 The question whether the use made of the trade mark is such as to mislead the public must be examined having regard to all the circumstances relevant to the particular case. The fact stated in paragraph 15 of the present judgment, that is, the presence of decorations pertaining to the specific creative universe of a designer and infringing his or her copyright, on the goods covered by the trade marks consisting of the name of that fashion designer, as the Advocate General pointed out in point 95 of his Opinion, may constitute such a relevant circumstance, in so far as it increases the risk that the public may mistakenly perceive the creative origins of the goods covered by those trade marks.

41 That interpretation is consistent with the objective of consumer protection underlying Article 12(2)(b) of Directive 2008/95 and Article 20(b) of Directive 2015/2436 (see, to that effect, judgment of 30 March 2006, *Emanuel*, C-259/04, EU:C:2006:215, paragraph 46). In the light of that objective, the consumer must be able to make an informed choice between several competing goods or services.

42 That interpretation is further supported by the general objective pursued by the EU rules on trade marks of preserving undistorted competition in the European Union (see, to that effect, judgment of 12 September 2019, *Koton Mağazacilik Tekstil Sanayi ve Ticaret* v *EUIPO*, C-104/18 P, EU:C:2019:724, paragraph 45 and the case-law cited). In view of that objective, it cannot be permitted that a trade mark becomes, as a result of the use which is made of it, an unfair instrument for gaining customers.

43 In the light of all the foregoing considerations, the answer to the question referred is that Article 12(2)(b) of Directive 2008/95 and Article 20(b) of Directive 2015/2436 must be interpreted as not precluding the revocation of a trade mark consisting of the name of a fashion designer on the ground that, having regard to all the relevant circumstances, it is used by the proprietor of the trade mark, or with his or her consent, in such a way as to lead the average consumer who is reasonably well informed and reasonably observant and circumspect to believe, mistakenly, that that designer was involved in the design of the goods bearing that mark.

Costs

44 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 (Third Chamber) hereby rules:

Article 12(2)(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 and Article 20(b) of 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

must be interpreted as not precluding the revocation of a trade mark consisting of the surname of a fashion designer on the ground that, having regard to all the relevant circumstances, it is used by the proprietor of the trade mark, or with his or her consent, in such a way as to lead the average consumer who is reasonably well informed and reasonably observant and circumspect to believe, mistakenly, that that designer was involved in the design of the goods bearing that mark.

[Signatures]