

JUDGMENT OF THE COURT (Sixth Chamber)

29 April 2004 \*

In Case C-371/02,

REFERENCE to the Court under Article 234 EC by the Svea hovrätt (Sweden) for a preliminary ruling in the proceedings pending before that court between

Björnekulla Frukthindustrier AB

and

Procordia Food AB,

on the interpretation of Article 12(2)(a) 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),

\* Language of the case: Swedish.

THE COURT (Sixth Chamber),

composed of: V. Skouris, acting as the President of the Sixth Chamber,  
C. Gulmann (Rapporteur), J.N. Cunha Rodrigues, J.-P. Puissechot and  
R. Schintgen, Judges,

Advocate General: P. Léger,  
Registrar: H. von Holstein,

after considering the written observations submitted on behalf of:

— Procordia Food AB, by B. Eliasson, *jur kand*,

— the Swedish Government, by K. Wistrand, acting as Agent,

— the Italian Government, by I.M. Braguglia, acting as Agent, and  
by O. Fiumara, *vice avvocato generale dello Stato*,

— the United Kingdom Government, by P. Ormond, acting as Agent, assisted by  
M. Tappin, barrister,

— the Commission of the European Communities, by C. Tufvesson and N.  
B. Rasmussen, acting as Agents,

having regard to the Report for the Hearing,

after hearing the oral observations of Björnekulla Frukthindustrier AB, represented by I. Bernhult and B.A. Samuelson, advokater, Procordia Food AB, represented by B. Eliasson and M. Plogell, advokat, and the Commission, represented by C. Tufvesson and N.B. Rasmussen, at the hearing on 10 September 2003,

after hearing the Opinion of the Advocate General at the sitting on 13 November 2003,

gives the following

### Judgment

1 By order of 14 October 2002, received at the Court on 16 October 2002, the Svea hovrätt (Svea Court of Appeal) referred for a preliminary ruling under Article 234 EC a question on the interpretation of Article 12(2)(a) 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) (hereinafter 'the Directive').

2 That question was raised in the course of proceedings between Björnekulla Frukthindustrier AB (hereinafter 'Björnekulla') and Procordia Food AB (hereinafter 'Procordia'), proprietor of the Bostongurka trade mark used in respect of a preserve consisting of chopped pickled gherkins, relating to the rights conferred by that trade mark, the revocation of which is sought by Björnekulla.

## Legal framework

### *Community law*

- 3 Under the heading ‘Grounds for refusal or invalidity’, the Directive states at Article 3(1)(b), (c) and (d):

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

...

(b) trade marks which are devoid of any distinctive character;

(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 service;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;’.

4 Under the heading ‘Grounds for revocation’, Article 12(2)(a) provides:

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

(a) in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered;’.

### *National law*

5 Under Article 25 of the Swedish Trade Marks Law 1960:644 of 2 December 1960, as amended for the purposes of transposing the Directive (hereinafter ‘the Swedish Trade Marks Law’) a trade mark may be revoked if it no longer has a distinctive character.

### **The main proceedings**

6 Björnekulla brought proceedings against Procordia before the tingsrätt (District Court) seeking revocation of the Bostongurka trade mark. It claimed that the trade mark had lost its distinctive character, as it was considered to be a generic name for chopped pickled gherkins.

- 7 In support of its application, it relied principally on two market research surveys of consumers.
- 8 Procordia contested that application, citing in particular a market research survey of leading operators in the grocery, mass catering and food stall sectors.
- 9 Relying principally on the *travaux préparatoires* for the Swedish Law on Trade Marks, the tingsrätt held that the relevant class of persons for determining whether or not the trade mark had lost its distinctive character was the distribution chain level which had been the subject of the research carried out by Procordia. It dismissed Björnekulla's application on the ground that Björnekulla had failed to prove that the trade mark no longer had a distinctive character.
- 10 The Svea hovrätt considers that it is not clear from either the wording of Article 25 of the Swedish Law on Trade Marks or that of Article 12(2)(a) of the Directive which classes of persons are relevant in determining whether a trade mark has lost its distinctive character. According to it, if the Swedish Law on Trade Marks is interpreted on the basis of the *travaux préparatoires*, the relevant classes of persons are those who deal commercially with the product. However, the Svea hovrätt is uncertain whether such an interpretation is consistent with the Directive.
- 11 Accordingly, it decided to stay the proceedings and refer the following question to the Court of Justice for a preliminary ruling:

‘In cases where a product is handled at several stages before it reaches the consumer what is or are, under Article 12(2)(a) of the Trade Mark Directive, the relevant class or classes of persons for determining whether a trade mark has become the common name in the trade for a product in respect of which it is registered?’

### The question referred

- 12 By the question referred, the national court is essentially asking whether Article 12 (2)(a) of the Directive must be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views must be taken into account for assessing whether that trade mark has become the common name in the trade for the product in question comprise all consumers or end users of the product and/or all those in the trade who deal with the product commercially.
- 13 Where a national court is called upon to interpret national law, whether the provisions in question were adopted before or after the directive concerned, it is required to do so, so far as possible, in the light of the wording and the purpose of the directive in order to achieve the result pursued by the latter and thereby comply with the third paragraph of Article 249 EC (see, inter alia, Case C-106/89 *Marleasing* [1990] ECR I-4135, paragraph 8, and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 60). That applies notwithstanding any contrary interpretation which may arise from the *travaux préparatoires* for the national rule.

- 14 The answer to the question referred by the national court depends principally on the meaning of the expression ‘in the trade’ used in Article 12(2)(a) of the Directive.
- 15 Björnekulla and the Italian Government argue that the relevant class of persons comprises solely consumers. Conversely, Procordia and the Swedish Government submit that the relevant class of persons comprises solely operators who deal with the product commercially. The Commission argues that the relevant class of persons comprises above all the consumers of the product but that, depending on the circumstances of the case, it may also include other groups, in particular intermediaries.
- 16 It must be noted in that regard that it is settled case-law that Community provisions must be interpreted and applied uniformly in the light of the versions existing in the other Community languages (see, to that effect, *inter alia*, Case 19/67 *Van der Vecht* [1967] ECR 345, 354, and Case C-219/95 P *Ferriere Nord v Commission* [1997] ECR I-4411, paragraph 15).
- 17 Consideration of the different language versions of Article 12(2)(a) of the Directive shows that the expressions used in the English and Finnish versions (‘in the trade’ and ‘elinkeinotoiminna’) refer to trade circles alone, while those used in the Spanish, Danish, German, Greek, French, Italian, Dutch, Portuguese and Swedish versions (‘en el comercio’, ‘inden for handeln’, ‘im geschäftlichen Verkehr’, ‘συνήθης εμπορική ονομασία’, ‘dans le commerce’, ‘la generica denominazione commerciale’, ‘in de handel’, ‘no comércio’ and ‘i handeln’) refer both to consumers and end users as well as to the operators who distribute the product.
- 18 It would thus appear that in the majority of those language versions the Community provision which must be interpreted is not restricted to those in the trade alone.



- 19 That view is supported by the general scheme and the objectives of the Directive.
- 20 The essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or service from others which have another origin (see, *inter alia*, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22). For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have been produced under the control of a single undertaking which is responsible for their quality (*Canon*, paragraph 28).
- 21 That essential function of trade marks has been incorporated by the Community legislature into Article 2 of the Directive, which provides that signs which are capable of being represented graphically may only constitute a trade mark if they are capable of distinguishing the goods or services of one undertaking from those of other undertakings (*Merz & Krell*, paragraph 23).
- 22 That condition is given effect to in, *inter alia*, Articles 3 and 12 of the Directive. While Article 3 specifies the circumstances in which a trade mark is incapable, *ab initio*, of fulfilling its function as an indication of origin, Article 12(2)(a) addresses the situation where the trade mark is no longer capable of fulfilling that function.
- 23 If the function of the trade mark as an indication of origin is of primary importance to the consumer or end user, it is also relevant to intermediaries who deal with the product commercially. As with consumers or end users, it will tend to influence their conduct in the market.

- 24 In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.
- 25 Accordingly, the relevant classes of persons comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.
- 26 The answer to the question referred must therefore be that Article 12(2)(a) of the Directive should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially.

## Costs

- 27 The costs incurred by the Swedish, Italian and United Kingdom Governments, and by the Commission, which have submitted observations to the Court, are not recoverable. Since the 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.

On those grounds,

THE COURT (Sixth Chamber),

in answer to the questions referred to it by the Svea hovrätt by order of 14 October 2002, hereby rules:

Article 12(2)(a) of the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially.

Skouris

Gulmann

Cunha Rodrigues

Puissochet

Schintgen

Delivered in open court in Luxembourg on 29 April 2004.

R. Grass

V. Skouris

Registrar

President