

JUDGMENT OF THE COURT (Second Chamber)

6 October 2009*

In Case C-301/07,

REFERENCE for a preliminary ruling under Article 234 EC from the Oberster Gerichtshof (Austria), made by decision of 12 June 2007, received at the Court on 26 June 2007, in the proceedings

PAGO International GmbH

v

Tirolmilch registrierte Genossenschaft mbH,

THE COURT (Second Chamber),

composed of C.W.A. Timmermans, President of the Chamber, J.-C. Bonichot, K. Schiemann, J. Makarczyk and L. Bay Larsen (Rapporteur), Judges,

* Language of the case: German.

Advocate General: E. Sharpston,
Registrar: B. Fülöp, Administrator,

having regard to the written procedure and further to the hearing on 5 June 2008,

after considering the observations submitted on behalf of:

— PAGO International GmbH, by C. Hauer, Rechtsanwalt,

— Tirolmilch registrierte Genossenschaft mbH, by G. Schönherr, Rechtsanwalt,

— the Commission of the European Communities, by W. Wils and H. Krämer, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 30 April 2009,

gives the following

Judgment

- 1 This reference for a preliminary ruling concerns the interpretation of Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) ('the regulation').

- 2 The reference has been made in proceedings between PAGO International GmbH ('PAGO') and Tirolmilch registrierte Genossenschaft mbH ('Tirolmilch') concerning the Community trade mark which is held by PAGO.

Legal context

- 3 Article 1(2) of the regulation provides:

'A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: it shall not be registered ... or be the subject of a decision ... declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle shall apply unless otherwise provided in this Regulation.'

4 Article 9(1)(c) of the regulation sets out:

‘1. A Community 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:

...

(c) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community 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 Community trade mark.’

5 Article 5(2) 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) (‘the directive’) is worded as follows:

‘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.’

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

- 6 Since 2001, PAGO has been the proprietor of a Community figurative mark for, inter alia, fruit drinks and fruit juices. The essential element of the mark is the representation of a green glass bottle with a distinctive label and lid. PAGO markets in Austria a fruit juice called 'Pago' in such bottles. The Community trade mark held by PAGO is widely known in that Member State.

- 7 Tirolmilch markets, also in Austria, a fruit and whey drink called 'Lattella'. That drink was initially sold in cartons. Subsequently, it has also been packaged in glass bottles. Two bottle designs resemble in several respects the Community trade mark held by PAGO. In its advertising, Tirolmilch uses a representation which, like the Community trade mark held by PAGO, shows a bottle next to a full glass.

- 8 PAGO initiated interlocutory proceedings before the Handelsgericht Wien (Commercial Court, Vienna) seeking to prohibit Tirolmilch from promoting, offering for sale, marketing or otherwise using its drink in the bottles at issue and from advertising by means of a representation of the bottles together with a full glass of fruit juice.

- 9 The Handelsgericht Wien granted the application. On appeal against the order made, PAGO's application was dismissed by the Oberlandesgericht Wien (Higher Regional Court, Vienna). PAGO thereupon lodged an appeal on a point of law with the Oberster Gerichtshof (Austrian Supreme Court).

- 10 The Oberster Gerichtshof takes the view that there is no likelihood of confusion between the bottles used by Tirolmilch and PAGO's Community trade mark, even on the basis of an overall examination, in so far as the labels affixed to the bottles at issue

bear, respectively, the names ‘Pago’ and ‘Lattella’, both of which are widely known in Austria.

- 11 Nevertheless, as PAGO claims that, for the purposes of Article 9(1)(c) of the regulation, Tirolmilch is, without due cause, taking unfair advantage of the reputation, in Austria, of the Community trade mark held by PAGO, the Oberster Gerichtshof expressed uncertainty as to the meaning of the words ‘has a reputation in the Community’ used in that provision of the regulation.
- 12 It presumes that, by analogy with the judgment of the Court in Case C-375/97 *General Motors* [1999] ECR I-5421 concerning the expression ‘reputation in the Member State’ featuring in Article 5(2) of the directive, it suffices that the Community trade mark has a reputation in a ‘substantial part’ of the Community.
- 13 However, as PAGO applied for an injunction restraining use throughout the entire Community and as its mark has a reputation only in Austria, the Oberster Gerichtshof is unsure whether a comprehensive prohibition can be issued even though the Community trade mark has a reputation in only one Member State or whether, where a reputation exists in only one Member State, a ‘prohibition’ for the purposes of Article 9(1)(c) of the regulation may be issued which is limited to that State.
- 14 In those circumstances, the Oberster Gerichtshof decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:
- ‘1. Is a Community trade mark protected in the whole Community as a “trade mark with a reputation” for the purposes of Article 9(1)(c) of [the regulation] if it has a “reputation” only in one Member State?’

2. If the answer to the first question is in the negative: is a mark which has a “reputation” only in one Member State protected in that Member State under Article 9(1)(c) of [the regulation], so that a prohibition limited to that Member State may be issued?’

The questions referred for a preliminary ruling

- 15 First of all, it must be noted that, in the main proceedings, the Community trade mark of which PAGO is the proprietor covers fruit drinks and fruit juices and that the product marketed by Tirolmilch is a fruit and whey drink.
- 16 It is not apparent from the order for reference that the national court has already assessed whether the goods at issue are similar or not.
- 17 In order to provide that court with an answer which will in any event be useful, it should be noted that, according to its terms, Article 9(1)(c) of the regulation does indeed benefit a Community trade mark in respect of goods or services which are not similar to those for which that mark is registered.
- 18 However, notwithstanding its wording and in the light of the overall scheme and objectives of the system of which Article 9(1)(c) of the regulation is part, the protection accorded to Community trade marks with a reputation cannot be less where a sign is used for identical goods and services than where a sign is used for non-similar goods or services (see, by way of analogy, Case *C-292/00 Davidoff* [2003] ECR I-389, paragraphs 24 and 25 with regard, in particular, to Article 5(2) of the directive).

19 It must for that reason be accepted that Article 9(1)(c) of the regulation also benefits a Community trade mark with a reputation in respect of goods or services similar to those for which that mark is registered (*Davidoff*, by way of analogy, paragraph 30).

The first question

20 By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21 The concept of ‘reputation’ assumes a certain degree of knowledge amongst the relevant public.

22 The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23 It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

- 24 The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).
- 25 In examining this condition, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it (*General Motors*, by way of analogy, paragraph 27).
- 26 In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.
- 27 Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).
- 28 It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).
- 29 As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.

The second question

31 In view of the answer to the first question referred and of the circumstances of the main proceedings, there is no need to reply to the second question.

Costs

32 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 (Second Chamber) hereby rules:

Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services

covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.

[Signatures]