

CJEU, C-684/19: Trade mark use and online advertising

On 2 July 2020, the CJEU ruled in a case concerning the notion of trade mark use, in the context of an advertisement placed on a website by a third party.

Indeed, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) had made a reference for a preliminary ruling to the EUCJ, pertaining to the correct interpretation of the term “using” in the framework of Art. 5(1) of the EU trade mark Directive (Dir. 2008/95/EC). The facts in the main proceedings concern a trade mark dispute between two companies - two law firms – regarding the prohibition imposed on one of the parties - mk advokaten - over the use of the letters “mbk” - considered confusingly similar to the prior (national) trade mark held by the other party, MBK rechtsanwälte (hereinafter, “MBK”). After that judgment became final, MBK noted that several company referencing websites still displayed an advertisement for the legal services of mk advokaten, using the contested sign, MBK; thus, MBK brought a new suit, claiming noncompliance with the previous ruling.

The referring court thus asked to the CJEU whether Art. 5(1) of Directive 2008/95 must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement which infringes a third party’s trade mark to be placed on a website is using a sign which is identical with that trade mark, where other websites reproduce that advertisement by placing it online on other websites.

The Court recalled its relevant case-law on trade mark use in this type of circumstances. The offering of goods or services under a sign which is identical or similar to another mark and advertising those goods or services under that sign constitutes “use” of that sign (see *Google France and Google*, C-236/08 to C-238/08). Such use exists where that sign, selected by an advertiser as a keyword in an online referencing service, is the means used by the advertiser to trigger the display of its advertisement, no matter if that sign does not appear in the advertisement itself (see *Interflora and Interflora British Unit*, C-323/09).

Thus, where a person orders the publication of an advertisement, the display of which contains or is triggered by a sign which is identical or similar to a previous trade mark, that person must be considered to be using that sign, within the meaning of Art. 5(1) of the trade mark Directive (see *Daimler*, C-179/15).

On the other hand, that person cannot be held liable, under Art. 5(1) of the Directive, for the independent actions of other economic operators, such as those of referencing website operators with whom that person has no direct or indirect dealings and who do not act by order and on behalf of that person, but on their own initiative and in their own name. Indeed, the term “using” used in Art. 5(1) involves an active conduct and direct or indirect control of the act constituting the use, hence, if that act is carried out by an independent operator, the consent of the advertiser.

The Court explained that it is for the national Court to apply those principles to the facts of the case. Besides, it noted that, on the basis of national law, the party may also be entitled to a claim for the restitution for financial benefits, and to one independent claim against the operators of the websites in question.

In light of the above, the Court concluded that Art. 5(1) of Directive 2008/95 must be interpreted as meaning that a person operating in the course of trade that has arranged for an advertisement which infringes another

person's trade mark to be placed on a website is not using a sign which is identical with that trade mark where the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites.