



BMM Autumn meeting 2020

# Overview of ECJ Case law Focus on trademark and designs in the online world

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ALTIUS





## / POSSIBLE SITUATIONS

Disputed sign used...

- ...as a keyword in referencing service
- ...in ad displayed on search engine
- ...on market place
- ...on competitor's website
- ...on counterfeiter's website
- ...to promote / offer for sale...
  - ...(original) authentic goods
  - ...counterfeits
  - ...second-hand goods, accessories, spare parts, etc.



## / POSSIBLE ISSUES

Exclusive right =

Prevent third parties [1] not having consent from [2] using [3] in the course of trade, [4] in relation to goods or services, any sign where [...]

Art.10.2 Directive 2015/2436 Art.9.2 EUTMR

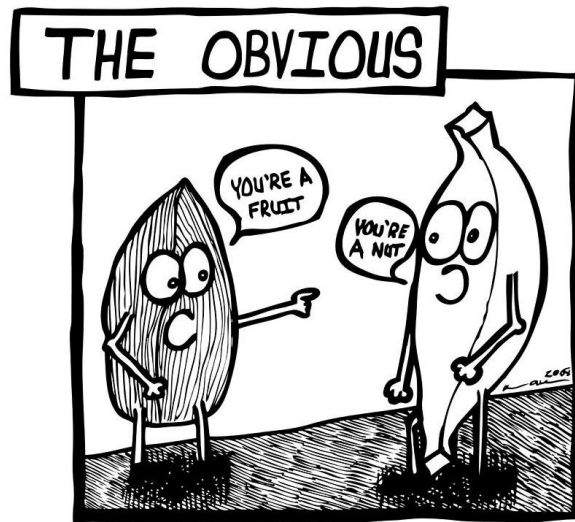
→ **Conditions to exercise** exclusive right =

Use must be

- 1. Without consent
- 2. Effective
- 3. In the course of trade
- 4. In relation to goods / services

## / POSSIBLE ISSUES

### UNAUTHORIZED USE



BUT what about

- Possible exceptions for
  - Second-hand TM goods
  - Accessories to TM goods
  - Spare parts to TM goods
 → Art.14 Directive 2015/2436 and Art.14 EUTMR
- Exhaustion of rights
  - Art.15 Directive 2015/2436 and Art.15 EUTMR



## / POSSIBLE ISSUES

### EFFECTIVE USE

Person likely to be held **liable** for disputed use

- Advertiser
- Referencing service provider
- Marketplace operator
- Website host
- Internet provider
- Etc.

? Mere fact of deriving economic advantage from disputed use = “using” ?



## / POSSIBLE ISSUES

USE “IN THE COURSE OF TRADE”

- Private individual vs Trader
- Person “using” disputed sign
  - Advertiser
  - Referencing service provider
  - Marketplace operator
  - Website host
  - Internet provider
  - Etc.



## / POSSIBLE ISSUES

USE “AS A TRADEMARK”

- In relation to goods / services
- Likely to
  - Affect TM essential functions (a)
    - Indication of origin
    - Guarantee of quality
    - Communication
    - Investment
    - Advertising
  - Create risk of confusion (b)  
// Function of indicating origin
  - Take undue advantage of TM reputation (c)





## / POSSIBLE ISSUES

### MEASURES AGAINST INFRINGER

- ? Injunction as soon as infringement is established?
- ? Territorial scope of injunction
  - According to scope of earlier TM invoked (national or EU)?
  - Depending on territory(ies) where infringement is established?



## / POSSIBLE ISSUES

### MEASURES AGAINST INTERMEDIARY

Who?

- Referencing service provider
- Marketplace operator
- Website host
- Internet provider
- Etc.



Generally accepted that intermediary does not “use” TM when simply acting on order and instructions of third party

→ Not “liable”, but still “actionable” → → →



## / POSSIBLE ISSUES

### MEASURES AGAINST INTERMEDIARY

Where not liable,  
but actionable



**IF**

services provided are  
covered by Art.12, 13 or 14  
of Directive 2000/31

Art.9.1(a) + Art.11  
Directive 2004/48

Possible  
injunction against  
intermediaries

Art.15.1  
Directive 2000/31

Liability exemption for  
intermediary service  
providers



## **/ POSSIBLE ISSUES**

### **MEASURES AGAINST INTERMEDIARY**

- Balance to be achieved between freedom of trade and TM protection
- Injunction must be fair, effective and proportionate
- Geographical scope of injunction

# BACK TO THE FUTURE





/ ECJ, 23/03/2010, C-236/08 - C-238/08

Google



**LV**  
LOUIS VUITTON

**BDV**.fr  
BOURSE DES VOLS

**Eurochallenges**

### Issues =

- ? Use of sign corresponding to TM as keyword to display ads = infringement where...
- ... Selection of keyword by advertiser?
- ... Storage of keyword by referencing service provider?
- ... Display of ad?

About 1.220.000.000 results (0,67 seconds)

Ad www.jdsports.be/ ▾

**adidas - Shop Onze Black Friday Deals**

Black Friday is begonnen met aanbiedingen tot 50% op al je favoriete merken. Shop nu!

📍 48-50 Rue Neuve, Bruxelles - 02 793 09 23 - Hours &amp; services may vary

Ad www.adidas.be/ ▾

**Boutique officielle adidas® - Explore les derniers produits**Sur le terrain ou en ville, booste tes performances et ton style avec la boutique **adidas**.Parcours notre vaste sélection d'articles et trouve tous tes essentiels dès aujourd'hui. **adidas**Training. **adidas** Football. **adidas** Running. Marques: **adidas** Originals, **adidas**

Skateboarding.

[adidas® homme](#) · [adidas® femme](#) · [adidas® enfant](#) · [Outlet adidas®](#) · [Nouveautés](#)

Ad www.zalando.be/ ▾

**adidas | 2020 - Gratis verzending & retour****adidas** Collectie Online. Tot 100 dagen retourrecht. Veilige betaling. De nieuwste mode & beauty. Veilige betaling. Gratis levering. 100 dagen retourrecht. Designermerken. Betaal met Bancontact. Typen: Jassen, Truien, Vesten, Tops, T-shirts, Broeken, Rokken, Blouses.[Sale](#) · [Cadeaubonnen](#) · [Sportkleding](#) · [Meer dan 2500 merken](#) · [Accessoires](#) · [Beauty](#)

Ad www.douglas.nl/ ▾

**Adidas bij Douglas - Your Partner in Beauty - douglas.nl**

Spaar Beauty Points en profiteer van exclusieve voordelen met de Douglas Beauty Card. Onze klantbelofte voor u: exclusieve voordelen, speciale cadeaus en topaanbiedingen!

[Douglas Beauty Card](#) · [25% korting op BOSS](#) · [25% korting op Mugler](#) · [25% korting op D&G](#)[Deal: 25% korting op alles](#)

www.adidas.be &gt; ...

**adidas Online Shop | adidas BE**

Sports shop for adidas shoes and sportswear: Originals, Running, Football &amp; Training on the official adidas BE website. Return for free for 100 days!

**Originals**

Click now to discover our iconic

**Men**

Shoes - Clothing - Jackets - Men's

Ads · Shop now

PRICE DROP

**Adidas Chaussure Coast**

€43.98

Was €61

[adidas.be](#)

By Kelkoo

**Adidas Duramo SL Schoenen - ...**

€54.95

[adidas.be](#)

Free shipping

By Kelkoo

SALE

**adidas Originals Gazelle Sneakers**

€38.45 €55

[nl.zalando.be](#)

Free shipping

By Shoptail

**adidas Daily 2.0 Baskets en Bleu**

€59.95

[torfs.be/fr/home](#)

Free shipping

By Google

SALE

**adidas Originals Swift RUN ...**

€34.95 €50

[nl.zalando.be](#)

Free shipping

By Shoptail

**Adidas Ultraboost 19 Schoenen - ...**

€125.97

[adidas.be](#)

Free shipping

By Kelkoo

SALE

**adidas Originals USA 84 Sneakers**

€63.95 €80

[nl.zalando.be](#)

SALE

**Stan Smith Adidas Originals**

€50.00 €65

[Courir - BE](#)

SALE

**Sneakers Tensaur adidas ...**

€24.46 €35

[La Redoute](#)AdWords  
results"Natural"  
results



**/ ECJ, 23/03/2010, C-236/08 - C-238/08**

UNAUTHORIZED USE

☒ (§54)





## / ECJ, 23/03/2010, C-236/08 - C-238/08

### USE “IN THE COURSE OF TRADE”



= Commercial activity with view to economic advantage >< private matter (§50)



Advertiser (§§51-52)



Referencing service provider (§§53-54 and 58)



“Operates” vs “use” “in the course of trade”



**/ ECJ, 23/03/2010, C-236/08 - C-238/08**

## EFFECTIVE USE

✓ Advertiser (§§51-52)

✗ Referencing service provider (§§99 + 105)

→ Does not “use” disputed signs for its own commercial communication



## / ECJ, 23/03/2010, C-236/08 - C-238/08

USE “AS A TRADEMARK”

In relation of goods / services

- ✓ Whether disputed sign is used in displayed ads or not?
  - List of uses in Art.10.3 Directive 2015/2436 and Art.9.3 EUTMR
    - Non-exhaustive (§65)
    - Drawn up before full emergence of electronic commerce and advertising (§66)
  - Purpose of keyword = make users click on ad link (§67)
  - User may
    - Confuse ads with those of TM proprietor (§§68 + 72)
    - Perceive ads as alternative to TM proprietor’s goods / services (§§68 + 71)



## / ECJ, 23/03/2010, C-236/08 - C-238/08

USE “AS A TRADEMARK”

Adverse effect on TM functions



- Exclusive right = protection of TM function
  - Exercise only to oppose use liable to cause detriment thereto (§§75-76)
- |                                |   |                         |
|--------------------------------|---|-------------------------|
| Protection under (a)           |   | Protection under (b)    |
| Adverse effect on TM functions | > | Likelihood of confusion |



## / ECJ, 23/03/2010, C-236/08 - C-238/08

USE “AS A TRADEMARK”

Adverse effect on TM functions



- Adverse effect on
  - Function of indicating origin
    - Ad immediately after entry of TM as search term (which remains on screen)
      - User may err as to origin of goods / services when
        - Ad’s presentation / terms suggest(s) economic link (§89)
        - Ad too vague as to origin of goods / services (§90)
  - ☒ Advertising function (§98)
    - Possible repercussions on TM proprietor’s comm strategy **BUT**
      - Possibility to register keyword to also appear in “Ads”
      - TM proprietor’s home / ad page still in natural results

https://www.google.be/search?source=hp&ei=TJ6-X7rVIMHolwTEnC4Aw&q=louis+vuitton&oq=louis+vuitton&gs\_lcp=CgZwc3ktYWIQAzIOCC4QxwEQowlQyQMqk

Search...

louis vuitton - Google Search

File Edit View Favorites Tools Help

abouttabs

BCE

BNB

BSA

cass.be

DeepL Translator

e-Deposit

eRegistre

EUIPO

EUR-Lex

Google Translate

Google

InfoBase

Moniteur

OBPI

OEB

PersMorale

Reg.Lux

Strada lex - Base de donn...

Google

louis vuitton

X

Q

Sign in

Q All

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News

More

Settings

Tools

About 209.000.000 results (0,91 seconds)

Ad · en.louisvuitton.com/official-site/-

Discover the new collections - Louis Vuitton Official Site

Buy online the new collections: Iconic Monogram Bags & Accessories, Ready-to-Wear and more. Shop Luxury Handbags, Shawls, Belt, Wallets, Sunglasses, Shoes, Perfumes, Watches & more. Online Store. Free Delivery. Christmas Gift Wrapping.

Boulevard de Waterloo 59/60, Bruxelles - 02 626 46 02 - Hours & services may vary

LV Women Latest Products

Find all Louis Vuitton Women's novelties, on the Official Website

Iconic Monogram Bags

Shop now your Perfect Monogram Bag: Cross-body Bag, Shoulder Bag & more

Xmas Shopping starts now

Explore the Louis Vuitton world and find the Perfect Gifts for Her

Louis Vuitton Pochettes

Félicie, Métis or multi accessoires buy online your favorite small Bag

eu.louisvuitton.com · eng-e1

LOUIS VUITTON - Official International Website

LOUIS VUITTON Official International Website - Explore the World of Louis ...

Louis Vuitton Brussels

LOUIS VUITTON Official International Website - Discover ...

Belgium

... Locate all Louis Vuitton Stores in Belgium and in the World. Find ...

Handbags

LOUIS VUITTON Official International Website - Discover ...

Shoulder and Cross Body Bags

... our latest Women's Shoulder and Cross Body Bags collection ...

LOUIS VUITTON Official ...


LOUIS VUITTON Official Europe Website - Explore the World of ...

LV Volt Collection

Louis Vuitton presents LV Volt, a graphic new collection of unisex ...

Louis Vuitton

Fashion company



LOUIS VUITTON

Louis Vuitton Malletier, commonly known as Louis Vuitton or shortened to LV, is a French fashion house and luxury goods company founded in 1854 by Louis Vuitton. [Wikipedia](#)

Parent organization: LVMH

Founder: [Louis Vuitton](#)

Founded: 1854, Paris, France


CEO: [Michael Burke](#) (Dec 19, 2012–)


Headquarters: [Paris, France](#)


Revenue: 15 billion USD (2020)


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View 10+ more













## / ECJ, 23/03/2010, C-236/08 - C-238/08

### MEASURES AGAINST INTERMEDIARY



Liability exemption only if

- Service provided qualifies as “information society service” under Directive 2000/31
- Service consists of “mere conduit” (Art.12), “caching” (Art.13) or “hosting” (Art.14)
- Service provider plays neutral / passive role  
→ No knowledge of, or control over data
- Service provider is unaware of any illegal activity / info



## / ECJ, 23/03/2010, C-236/08 - C-238/08

### MEASURES AGAINST INTERMEDIARY



“Information society service”? (§110)

- Services provided at a distance
- By means of electronic equipment
- For processing / storage of data
- At third party's request
- In return for remuneration



Exemption (→ only if no knowledge of, or control over)

- Irrelevant
  - Intermediary is paid
  - Keyword = search term
- Relevant = intermediary's role in
  - Drafting of commercial message accompanying ad link
  - Establishing / selecting keyword





/ ECJ, 25/03/2010, C-278/08



**trekking.at Reisen**



### Issues =

- ? Is TM proprietor entitled to prohibit third party from displaying – on basis of keyword identical or similar to TM – ad for goods / services identical or similar to TM's?



## / ECJ, 25/03/2010, C-278/08

### USE OF KEYWORD TO DISPLAY AD

Disputed signs	Bergspechte?	Edi Koblmüller? Bergspechte?
	(a)	(b)
Unauthorized use	<input checked="" type="checkbox"/>	
Use “in the course of trade”	<input checked="" type="checkbox"/> (§18)	
Effective use	☹	
Use “as a trademark”	<input checked="" type="checkbox"/> In relation to goods / services (§19) <input type="checkbox"/> Adverse effect on TM functions <input checked="" type="checkbox"/> Advertising function (§§33-34) <input type="checkbox"/> Function of indicating origin (§§35-36)	← <input type="checkbox"/> Likelihood of confusion (§§39-40)

// ECJ, 23/03/2010, Google, C-236/08-C-238/08



/ ECJ, 08/07/2010, C-558/08



portakabin  
portacabin  
portokabin  
portocabin

Advertentie - [www.primakabin.nl/](http://www.primakabin.nl/)

**Primakabin.nl - Primakabin - Perfecte Maatoplossingen**

Kabins voor Kantoren, Scholen, Kinderdagverblijven en Bouwketen. Snelle levering. Onbeperkte voorraad. Lage transportkosten. Nieuwe en Gebruikte Units Services: Tijdelijke kantoorruimte, Tijdelijke huisvesting, Permanente huisvesting, Noodlokalen.

[Nieuws lezen](#) · [Gebruikte units](#) · [Nieuwe units](#) · [Maak een afspraak](#) · [Over ons](#)

### Issues =

- ? Is TM proprietor entitled to prohibit third party from displaying – on basis of keyword identical or similar to TM – ad for goods / services identical or similar to TM's?
- ? Possible application of exceptions



/ ECJ, 08/07/2010, C-558/08

## USE OF KEYWORD TO DISPLAY AD

	(a)	(b)
Unauthorized use	☑	
Use “in the course of trade”	☑ (§27)	
Effective use	☹	
Use “as a trademark”	<ul style="list-style-type: none"><li>☑ In relation to goods / services (§42)</li><li>☐ Adverse effect on TM functions</li><li>☒ Advertising function (§33)</li><li>☐ Function of indicating origin (§§34-35)</li></ul>	← Likelihood of confusion (§§51-54)

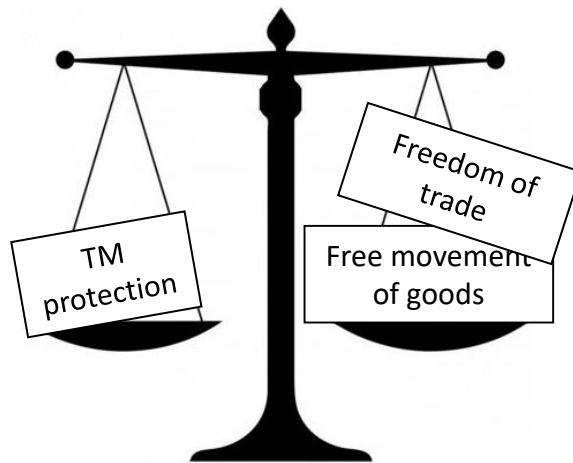
// ECJ, 23/03/2010, Google, C-236/08-C-238/08



/ ECJ, 08/07/2010, C-558/08

## EXCEPTIONS

### Limitation of effects of TM



- Exclusive right limited when disputed use =
  - Indications concerning kind, quality, quantity, value, geographical origin, etc.
  - Necessary to indicate intended purpose of product / service, “in particular as accessories or spare parts”
- **BUT** disputed use must be in accordance with honest industrial / commercial practices



/ ECJ, 08/07/2010, C-558/08

## EXCEPTIONS

### Limitation of effects of TM



- Disputed use for
  - (☒) Indications of goods / services characteristics (§§60-61)
  - ☐ Necessary to indicate intended purpose
    - “In particular as accessories or spare parts” → Non-exhaustive list (§63)
    - BUT objective = inform public of practical link between goods / services (§64)
- (☒) In accordance with honest industrial / commercial practices
  - = “Duty to act fairly” (§67)
    - ✍ Public’s perception of possible link
      - // Adverse effect on function of indicating origin / likelihood of confusion (§§68-69)
    - ✍ Extent to which third party ought to have been aware of possible ambiguity
      - Unlikely that third party can claim not to have been aware of ambiguity (§70)



## / ECJ, 08/07/2010, C-558/08

### EXCEPTIONS

#### Exhaustion of rights



- Exclusive right = exhausted after first placing on market “by” TM proprietor within EEA/EU
  - Third party = free to
    - Resell “original” TM goods
    - Use TM to this effect
- Unless “legitimate reasons”
  - Use of disputed sign = serious damage to TM reputation (§79)
  - Impression of commercial connection (§80)
    - // Adverse effect on function of indicating origin or likelihood of confusion (§81)
      - 💡 “De/re-branding” = damage to TM essential function of indicating and guaranteeing origin (§86)



/ ECJ, 08/07/2010, C-558/08

## EXCEPTIONS

### Exhaustion of rights



TM goods first placed on market by TM proprietor



“Legitimate reasons” to oppose resale?

- Sale of second-hand trademarked goods = well-established form of business
  - No legitimate reasons when
    - Use of TM with additional wording “used” / “second-hand” (§84)
    - Use of disputed sign to advertise resale activities, incl. resale of other second-hand TM goods (unless serious damage to TM reputation)
- Legitimate reasons
  - Removal of TM for used goods and replacement by third party’s TM





/ ECJ, 12/07/2011, C-324/09

L'ORÉAL



ebay



## Issues =

- ? (Offer for) sale within EU of “original” TM goods...
  - ... Only intended for sale in third States
  - ... Not intended for sale (e.g. testers, samples)
  - ... Without packaging
- ? Use of TM as keyword on search engine to promote marketplace and sellers
- ? Nature and scope of injunction against marketplace operator



**/ ECJ, 12/07/2011, C-324/09**

**(OFFER FOR) SALE OF TM GOODS**

**Use “in the course of trade”**



Private vs commercial activity



- ☒ Sellers
- ☒ Marketplace operator



/ ECJ, 12/07/2011, C-324/09

(OFFER FOR) SALE OF TM GOODS

Effective use

✓ Sellers (§103)

✗ Marketplace operator

→ Disputed signs “used” on its website BUT not for its own commercial communication (§§101-102)



## / ECJ, 12/07/2011, C-324/09

### (OFFER FOR) SALE OF TM GOODS

#### Unauthorized use - Exceptions

#### 1. “Original” TM goods only intended for sale in third States



- Exhaustion of rights principle = first placing on market within EEA/EU
- Quid possibility to oppose offers for sale of TM goods located in third State
  - Only if target consumers in territory(ies) covered by TM (§61)
  - Mere accessibility of website ≠ sufficient (§64)



- ✗ Exhaustion of rights (§60)
- ✓ Targeting of consumers located in territory covered by TM (§66)
  - [www.ebay.co.uk](http://www.ebay.co.uk) = targeting UK consumers



**/ ECJ, 12/07/2011, C-324/09**

**(OFFER FOR) SALE OF TM GOODS**  
**Unauthorized use - Exceptions**

## **2. Testers and samples**



- ≠ First placing on market “by” TM proprietor
  - TM testers / samples given away, free of charge, to promote sale of TM goods
  - Objects marked with “demonstration” / “not for sale”



-  Exhaustion of rights



**/ ECJ, 12/07/2011, C-324/09**

**(OFFER FOR) SALE OF TM GOODS**

**Unauthorized use - Exceptions**

### **3. Unboxed goods**

#### **□ Infringement of exclusive rights IF**

- Removal of packaging harms goods image / TM reputation
- Deletion of info required by law impairing with essential function of guarantee of origin and/of quality  
e.g. Identity of manufacturer or person responsible for marketing



/ ECJ, 12/07/2011, C-324/09

## USE OF KEYWORD TO PROMOTE MARKETPLACE / SELLERS

- ✓ Use “in the course of trade”
- ✓ Effective use by marketplace operator (= advertiser)
- Use “as a trademark”
  - For identical or similar goods / services
    - ✗ Promotion of online marketplace (§89)
    - ✓ Promotion of sellers’ offers for sale on marketplace (§§91-92)
  - Adverse effect on TM functions IF
    - Ad’s presentation / terms suggests economic link
    - Ad too vague as to origin of goods / services



**/ ECJ, 12/07/2011, C-324/09**

## MEASURES

### Injunction against marketplace operator



Liability exemption only if

- Service provided qualifies as “information society service” under Directive 2000/31
- Service consists of “mere conduit” (Art.12), “caching” (Art.13) or “hosting” (Art.14)
- Service provider plays neutral / passive role  
→ No knowledge of, or control over data
- Service provider is unaware of any illegal activity / info





/ ECJ, 12/07/2011, C-324/09

## MEASURES

### Injunction against marketplace operator



“Information society service” under Directive 2000/31 (§109)

- Services provided at a distance
- By means of electronic equipment
- For processing and storage of data
- At third party’s request
- In return for remuneration



Exemption → Only if no knowledge of, or control over



Neutral position ≠ assistance to help optimize presentation / promotion of sellers’ offers for sale (§§116 + 123)



## / ECJ, 12/07/2011, C-324/09

### MEASURES

#### Scope of injunction

- Goal =
  - Stop ongoing infringement
  - Prevent further infringement of “that” kind (§131)
    - // Art.18 Directive 2000/31 (§132)
    - Recital 24 Directive 2004/48 (§134)
- Measures =
  - ✓ Effective, proportionate, dissuasive (§136)
  - ✗ Active monitoring of all data of sellers to prevent future infringement (§139)
    - >< Art.15.1 Directive 2000/31
    - Art.3 Directive 2004/48 (fair, proportionate, not excessively costly)
  - ✗ Barriers to legitimate trade (§140)
  - ✓ Measures to make it easier to identify sellers (§142)



/ ECJ, 03/03/2016, C-179/15

DAIMLER



Mercedes-Benz



**Együd Garage**  
Authorized Mercedes-Benz Dealer

(until 31/03/2012)

**Issues =**

- ? Can advertiser be held liable for use of disputed sign in online ad featuring him if he...
  - ... did not order the disputed ad
  - ... tried to have removed



**/ ECJ, 03/03/2016, C-179/15**

Exclusive right IF		
	2011-2012	After 31/03/2012
Unauthorized use	✗	✓
Use “in the course of trade”	✓	✓
Effective use	✓	✗
Use “as a trademark”	✓	✓



## / ECJ, 03/03/2016, C-179/15

### EFFECTIVE USE

= Active behavior and (in)direct control of disputed use

// Wording of

- “Using” / “faire usage” / “het gebruik” (§39)
- (3) Refers exclusively to active behavior (§40)

// Purpose of exclusive right = Tool to prohibit TM use without consent

→ To be able to stop it, third party needs (in)direct control of disputed use (§41)

≠

- Act carried out by independent operator without advertiser’s consent or against express will (§34 + 36)
- Sole fact to get financial benefit from disputed use (§42)



/ ECJ, 22/09/2016, C-223/15

*combit*®



  
COMMIT™



### Issues =

- ? Does unitary nature of EUTM prevent injunction from being pronounced in part of EU territory if disputed sign creates risk of confusion only in part of UE?

## / ECJ, 22/09/2016, C-223/15

### MEASURES AGAINST INFRINGER

- **“As a rule”** (§30)
  - Referring court = acting as EUTM court
    - Jurisdiction for infringement acts within any MS
  - Likelihood of confusion in all or part of EU
    - Infringement of exclusive right (§§25-28)
  - If infringement
    - Prohibition order for whole of UE (§30)
- **“However”** (§31), if no likelihood of confusion in part of EU
  - No adverse effect on TM function of indicating origin in that part
  - Since exclusive right = protection of TM essential functions
    - Territorial scope of prohibition must be limited (§31)
  - Clear identification of part of EU covered or not by prohibition order (§34)  
e.g. “English-speaking areas” NOT clear enough



/ ECJ, 02/04/2020, C-567/18

COTY

DAVIDOFF



amazon



### Issues =

- ? Does storage of goods on behalf of third party, without knowledge of infringing nature of goods = storage “for the purpose of offering for sale or putting on the market”?







## / ECJ, 02/04/2020, C-567/18

### EFFECTIVE USE



- No definition of “using” BUT
    - Involves active behavior and (in)direct control of disputed use (§37)  
// ECJ, 03/03/2016, Daimler, C-179/15
    - Must be for third party own commercial communication (§§39-40)  
// ECJ, 23/03/2010, Google, C-236/08-C-238/08  
// ECJ, 12/07/2011, L’Oréal, C-324/09
  - Creating technical conditions necessary for disputed use and being paid therefor ≠ “using”  
// ECJ, 23/03/2010, Google, C-236/08-C-238/08  
// ECJ, 15/12/2011, Frisdranken Industrie Winters, C-119/10  
// ECJ, 16/07/2015, TOP Logistics, C-379/14
  - Storage = “use” only if done “for purposes” of offering for sale or putting on the market (§44)
-   Effective use (§53)



/ ECJ, 02/07/2020, C-684/19

mk | advokaten

(formerly, mbk rechtsanwälte)



MBK  
Rechtsanwälte

**Issues =**

- ? Is third party referenced on website in entry containing disputed sign “using” the TM, if entry was not placed by third party, but was reproduced by website’s operator from another entry that third party placed in infringement of TM?



## / ECJ, 02/07/2020, C-684/19

### EFFECTIVE USE



- **In principle, “use” =**
  - Offering of goods / services under disputed sign
  - Selection of keyword in referencing service to trigger display of ad

→ Ordering publication of ad containing or being triggered by disputed sign = “using”
- **BUT need for active conduct and (in)direct control of disputed use**

→ Effective use ≠

  - Act carried out by independent operator without advertiser’s consent
  - Sole fact to get financial benefit from disputed use

// ECJ, 03/03/2016, Daimler



## / ECJ, 02/07/2020, C-684/19

### EFFECTIVE USE



mk advokaten

→ Need to examine its conduct (§25)



Website operators

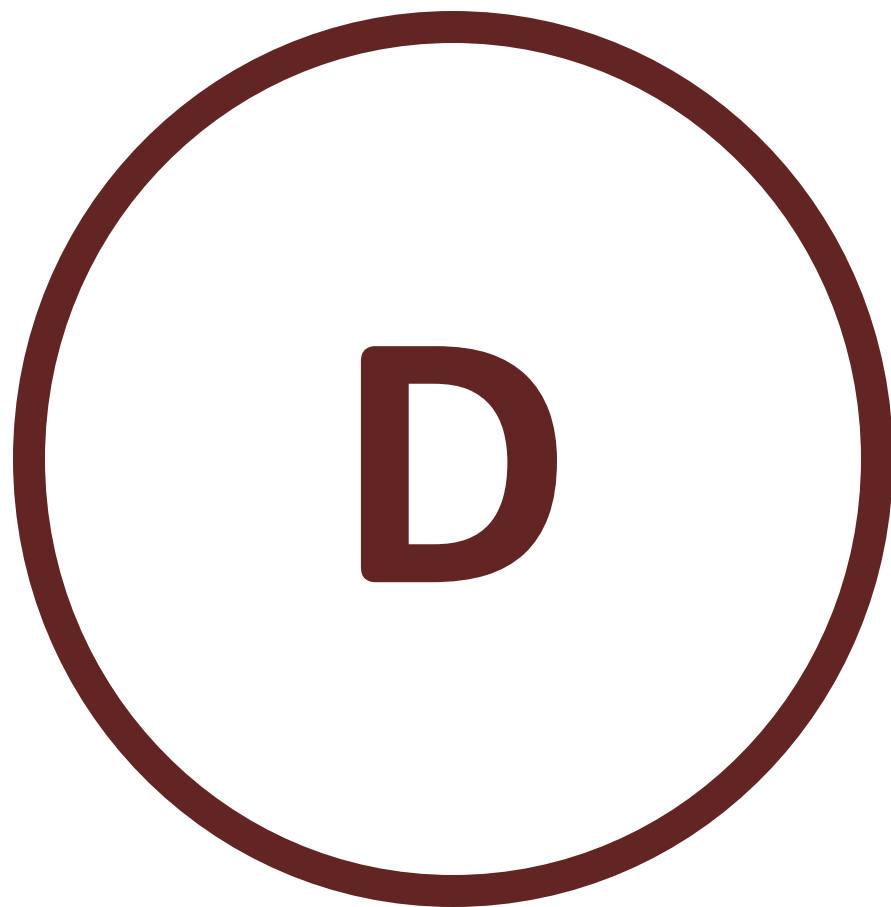
- Reproduction of disputed sign on own initiative and in own name
- mk advokaten ≠ customer

→ Possible to act against website operators

>< Referencing system operator does NOT use disputed sign contained in customer's ads or triggering display of ads (§27)

// ECJ, 23/03/2010, Google, C-236/08-C-238/08

// ECJ, 02/04/2020, Coty Germany, C-567/18





/ ECJ, 27/09/2017, C-24/16 - C-25/16



Issues =

- ? International jurisdiction & applicable law
- ? Use of images of protected designs to promote goods intended to be used as accessories to products incorporating original designs



/ ECJ, 27/09/2017, C-24/16 - C-25/16

ART.20.1(C)CDR =

Limitation of exclusive right for **acts of reproduction** ...

*Two-dimensional representation of a product corresponding to a design may constitute such an act (§69)*

...for the purpose of **making citations** (“illustration”)

*A third party that lawfully **sells** goods intended to be used with specific goods corresponding to design and reproduces the latter in order to **explain or demonstrate** the joint use of the goods it sells and a product corresponding to a design carries out an act of reproduction for the purpose of making “citations” (§77)*



## / ECJ, 27/09/2017, C-24/16 - C-25/16

ART.20.1(C)CDR =

**...provided that**

**1. Compatibility with fair trade practice**

= Duty to act fairly in relation to right holder's legitimate interests (§79)

→ Not the case where

- Impression of commercial connection
- Infringement of design rights
- Unfair advantage of right holder's commercial repute

**2. No undue prejudice to normal exploitation of design (§82)**

**3. "Mention" of source**

= Enable consumer to identify commercial origin of product incorporating design (§84)



If affixing of trademark → trademark law (§85)





Questions

?

?

Answers

?

Code word: SEE



**/ THANK YOU!**



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