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Judgment of the Court of Justice in Case C-487/07

L'Oréal and Others v Bellure NV and Others

A TRADE MARK PROPRIETOR MAY PREVENT THE USE OF A COMPARISON LIST PRESENTING THE PRODUCT OF A THIRD PARTY AS AN IMITATION OF ONE OF HIS PRODUCTS

The advantage gained by an advertiser through such a comparison list is achieved as the result of unfair competition and must, accordingly, be regarded as taking unfair advantage of the trade mark in question

L'Oréal SA, Lancôme parfums et beauté and Laboratoire Garnier are members of the L'Oréal group, which produces and markets luxury fragrances. They are proprietors of the well-known trade marks Trésor, Miracle, Anaïs-Anaïs and Noa.

Malaika and Starion market imitations of those fragrances in the United Kingdom, which are produced by Bellure. The bottles and packaging used to market those imitations are generally similar in appearance to those used by L'Oréal, which are protected by word and figurative trade marks. Malaika and Starion also use comparison lists, which are provided to retailers and which indicate the word mark of the luxury fragrance of which the perfume being marketed is an imitation.

L'Oréal brought proceedings before the High Court of Justice of England and Wales against Bellure, Malaika and Starion, alleging infringement of their trade mark rights.

The national court has requested the Court of Justice to clarify the interpretation of certain provisions of the Trade Mark Directive¹ and of the Directive concerning misleading and comparative advertising².

As regards the use of packaging and bottles similar to those of the fine fragrances marketed by L'Oréal, the Court is asked whether a third party who uses a sign similar to a trade mark with a reputation can be held to take unfair advantage of the mark where such use gives that party an

¹ 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).

² Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising (OJ 1984 L 250, p. 17), as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 L 290, p. 18).

advantage in the marketing of his goods, without, however, giving rise, as far as the public is concerned, to a likelihood of confusion or causing detriment to the proprietor of the mark.

The Court's reply to that question is in the affirmative. It accordingly holds that **the taking of unfair advantage of the distinctive character or the repute of a trade mark does not require that there be a likelihood of confusion or a likelihood of detriment to the proprietor of the mark.**

The Court considers that, in order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of a mark, it is necessary to undertake a global assessment, taking into account in particular the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity of the marks at issue and the nature and degree of proximity of the goods concerned.

In the present case, Malaika and Starion obtain a commercial advantage from the fact that, in the marketing of their 'downmarket' imitations, they use packaging and bottles similar to those used by L'Oréal for its luxury fragrances. Moreover, the similarity was intentionally created in order to create an association in the mind of the public with the aim of facilitating the marketing of the products. The Court finds that in those circumstances account must in particular be taken of the fact that the use of packaging and bottles similar to those of the fragrances that are being imitated is intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances are marketed.

The Court holds that **where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make any efforts of its own in that regard, the marketing effort expended by the proprietor of the mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.**

As regards the comparison lists of perfumes indicating the names of L'Oréal's luxury fragrances protected by the word marks, the Court holds, first, that such lists may constitute comparative advertising. Next, it points out that the use by an advertiser, in a comparative advertisement, of a sign identical with or similar to the mark of a competitor may be prevented, where appropriate, by virtue of the Trade Marks Directive, unless it satisfies all the conditions laid down in the Directive concerning misleading and comparative advertising under which comparative advertising is permitted.

The Court considers in that context that **the proprietor of a trade mark is entitled to prevent the use by a third party of a sign identical with that mark, even where such use is not capable of jeopardising the essential function of the mark, which is to indicate the origin of the goods or services, provided that such use affects or is liable to affect one of the other functions of the mark, such as, in particular, the functions of communication, investment or advertising.**

As regards the question whether the comparison lists of perfumes satisfy all of the conditions laid down by the Directive on misleading and comparative advertising as regards the circumstances in which comparative advertising is permitted, the Court holds that that directive **prohibits an advertiser from stating in comparative advertising that the product marketed by him constitutes an imitation or replica of the product or the service covered by the trade**

mark. The object and effect of the comparison lists is to draw the attention of the relevant public to the original fragrance of which the perfumes marketed by Malaika and Starion are purportedly an imitation. The Court holds that those lists thus attest to the fact that those perfumes are imitations of the fragrances marketed by L'Oréal and that they consequently present the products marketed by the advertiser as imitations of products bearing a protected trade mark.

Lastly, the Court holds that the **advantage gained by an advertiser as a result of such unlawful comparative advertising must be considered to be an advantage unduly taken of the reputation of the mark**, which also contravenes the requirements laid down under the Directive on misleading and comparative advertising.

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Languages available: BG ES CS DE EL EN FR IT HU NL PT RO SK

The full text of the judgment may be found on the Court's internet site

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=rechercher&numaff=C-487/07>

It can usually be consulted after midday (CET) on the day judgment is delivered.

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