

TRIBUNAL DE JUSTICIA DE LAS COMUNIDADES EUROPEAS
SODNÍ DVŮR EVROPSKÝCH SPOLEČENSTVÍ
DE EUROPÆISKE FÆLLESSKABERS DOMSTOL
GERICHTSHOF DER EUROPÄISCHEN GEMEINSCHAFTEN
EUROOPA ÜHENDUSTE KOHUS
ΔΙΚΑΣΤΗΡΙΟ ΤΩΝ ΕΥΡΩΠΑΪΚΩΝ ΚΟΙΝΟΤΗΤΩΝ
COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES
COUR DE JUSTICE DES COMMUNAUTÉS EUROPÉENNES
CÚIRT BHREITHIÚNAIS NA gCÓMHPHOBAL EORPACH
CORTE DI GIUSTIZIA DELLE COMUNITÀ EUROPEE
EIROPAS KOPIENU TIESA



EUROPOS BENDRIJŲ TEISINGUMO TEISMAS
EURÓPAI KÖZÖSSÉGEK BÍRÓSÁGA
IL-QORTI TAL-GUSTIZZJA TAL-KOMUNITAJIET EWROPEJ
HOF VAN JUSTITIE VAN DE EUROPESE GEMEENSCHAPPEN
TRYBUNAŁ SPRAWIEDLIWOŚCI WSPÓLNOT EUROPEJSKICH
TRIBUNAL DE JUSTIÇA DAS COMUNIDADES EUROPELAS
SÚDNY DVOR EURÓPSKÝCH SPOLOČENSTEV
SODIŠČE EVROPSKIH SKUPNOSTI
EUROOPAN YHTEISÖJEN TUOMIOISTUIN
EUROPEISKA GEMENSKAPERNAS DOMSTOL

Press and Information

PRESS RELEASE No 63/05

7 July 2005

Judgment of the Court of Justice in Case C-418/02

Praktiker Bau- und Heimwerkermärkte AG v. Deutsches Patent- und Markenamt

**THE COURT OF JUSTICE EXTENDS TRADE-MARK PROTECTION BY
ALLOWING SERVICE MARKS FOR RETAIL TRADE**

Parallel to the trade marks registered for its goods, a retailer may obtain protection for its trade marks, as service trade marks, in respect of the services which it provides in connection with the retail trade.

The Court of Justice of the European Communities today ruled that a service trade mark may be registered for services provided in connection with the retail trade. It is not necessary to specify in detail the service(s) in question, but details regarding the goods or types of goods to which those services relate are required. That judgment is given in response to a number of questions referred by the German Bundespatentgericht (Federal Patents Court) for a preliminary ruling on the interpretation of the Community directive harmonising national provisions on trade marks.¹

Praktiker had filed for registration, at national level, of the trade mark Praktiker for the service of 'retail trade in building, home improvement, gardening and other consumer goods for the do-it-yourself sector'. The Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) rejected its application on the ground that trade-mark protection could be achieved only in respect of the various goods marketed. The concept of 'retail trade' did not denote independent services having autonomous economic significance, but related only to goods distribution as such. The economic activities which formed the core of goods distribution, in particular purchasing and selling, were not services for which a trade mark could be registered.

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); in addition, Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) gave rise to the Community trade mark, the registration and administration of which are managed by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) in Alicante.

Praktiker brought an appeal before the Bundespatentgericht, arguing that the economic trend towards a service society necessitated a re-appraisal of retail trade as a service. The consumer's purchasing decision would increasingly be influenced not only by the availability and price of a product, but also by other aspects such as the variety and assortment of goods, their presentation, the service provided by staff, advertising, image and the location of the store, etc. Such services provided in connection with retail trade enabled retailers to be distinguishable from their competitors. Such services ought to be eligible for protection by service trade marks.

Since the German provisions for the registration of a **national trade mark** are based on the Directive on trade marks, the Bundespatentgericht asked the Court whether the concept of 'services' within the meaning of that directive includes services provided in connection with retail trade in goods and, if so, whether the registration of a service trade mark in respect of such services is subject to the provision of certain details

1. *Does the Community Directive on trade marks allow protection of service trade marks for the retail trade?*

The Court finds that, in the absence of a definition of 'services' in the directive and in order to attain the objectives pursued by it, in particular that acquisition of the right in the trade mark should be subject to 'conditions ... identical' in all Member States, it falls to the Court to supply a uniform interpretation.

It notes that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to selling per se, all activity carried out by the trader for the purpose of encouraging consumers to buy. This involves selecting an assortment of goods offered for sale and offering a variety of services aimed at inducing the consumer to buy from the trader in question rather than from a competitor.

No overriding reason based on the directive or on general principles of Community law precludes those services from being covered by the concept of 'services' within the meaning of the directive. Moreover, OHIM now accepts service trade marks for the retail trade as Community trade marks. The Court therefore concludes that the trader is entitled to acquire protection of his trade mark for services provided in connection with retail trade in goods.

2. *What details are required for registration?*

The Court holds that **it is not necessary to specify in detail the service(s) in question**. To identify the services provided, general wording such as '*bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods*' is sufficient.

However, to make it easier to apply the provisions concerning cases of conflict with a trade mark filed earlier and to determine the exclusive right conferred on the proprietor without appreciably limiting the protection afforded to the trade mark, **the applicant must be required to specify the goods or types of goods to which those services relate** by means, for example, of particulars such as those contained in the application for registration filed by Praktiker.

Unofficial document for media use, not binding on the Court of Justice.

Languages available: EN FR DE

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

<http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=en>

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

For further information, please contact Christopher Fretwell

Tel: (00352) 4303 3355 Fax: (00352) 4303 2731