



Reports of Cases

JUDGMENT OF THE COURT (Grand Chamber)

22 December 2022*

(Reference for a preliminary ruling – EU trade mark – Regulation (EU) 2017/1001 – Article 9(2)(a) – Rights conferred by an EU trade mark – Concept of ‘use’ – Operator of an online sales website incorporating an online marketplace – Advertisements published on that marketplace by third-party sellers using, in those advertisements, a sign which is identical with a trade mark of another person for goods which are identical with those for which that trade mark is registered – Perception of that sign as forming an integral part of the commercial communication of that operator – Method of presenting the advertisements which does not make it possible to distinguish clearly the offerings of that operator from those of the third-party sellers)

In Joined Cases C-148/21 and C-184/21,

REQUESTS for a preliminary ruling under Article 267 TFEU from the Tribunal d’arrondissement de Luxembourg (District Court, Luxembourg, Luxembourg) and the Tribunal de l’entreprise francophone de Bruxelles (Brussels Companies Court (French-speaking), Belgium), made by decisions of 5 March 2021 and 22 March 2021, received by the Court on 8 March 2021 and 24 March 2021 respectively, in the proceedings

Christian Louboutin

v

Amazon Europe Core Sàrl (C-148/21),

Amazon EU Sàrl (C-148/21),

Amazon Services Europe Sàrl (C-148/21),

Amazon.com Inc. (C-184/21),

Amazon Services LLC (C-184/21),

THE COURT (Grand Chamber),

composed of K. Lenaerts, President, L. Bay Larsen, Vice-President, A. Prechal, K. Jürimäe, C. Lycourgos, M. Safjan, P. G. Xuereb, D. Gratsias, M. L. Arastey Sahún, Presidents of Chambers, M. Ilešič (Rapporteur), F. Biltgen, I. Ziemele and J. Passer, Judges,

* Language of the case: French.

Advocate General: M. Szpunar,

Registrar: V. Giacobbo, Administrator,

having regard to the written procedure and further to the hearing on 22 February 2022,

after considering the observations submitted on behalf of

- Christian Louboutin, by M. Decker, N. Decker and T. van Innis, avocats,
- Amazon Europe Core Sàrl, Amazon EU Sàrl and Amazon Services Europe Sàrl, by S. Ampatziadis, H. Bälz, A. Conrad, F. Seip, Rechtsanwälte, and E. Taelman, advocaat,
- Amazon.com Inc. and Amazon Services LLC, by L. Depypere, advocaat, R. Dupont, avocat, and T. Heremans, advocaat,
- the German Government, by J. Möller, U. Bartl and M. Hellmann, acting as Agents,
- the European Commission, by É. Gippini Fournier, S.L. Kaléda and J. Samnadda, acting as Agents,

after hearing the Opinion of the Advocate General at the hearing on 2 June 2022,

gives the following

Judgment

- 1 The requests for a preliminary ruling concern the interpretation of Article 9(2)(a) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).
- 2 These requests have been made in connection with proceedings brought by Christian Louboutin, in Case C-148/21, against Amazon Europe Core Sàrl, Amazon EU Sàrl and Amazon Services Europe Sàrl and, in Case C-184/21, against Amazon.com Inc. and Amazon Services LLC (together and interchangeably in each of those two cases; ‘Amazon’) concerning the alleged use, without his consent, of signs which are identical with the EU trade mark of which Mr Louboutin is the proprietor, by Amazon, for goods which are identical with those for which that trade mark is registered.

Legal context

Regulation 2017/1001

- 3 Article 9 of Regulation 2017/1001, entitled ‘Rights conferred by an EU trade mark’, under Section 2, entitled, ‘Effects of an EU trade mark’, of Chapter II thereof, provides, in paragraphs 1 to 3:
 - ‘1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

...

3. The following, in particular, may be prohibited under paragraph 2:

...

(b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;

...

(e) using the sign on business papers and in advertising;

(f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC [of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising (OJ 2006 L 376, p. 21)].'

Directive 2004/48/EC

4 Article 11 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45, and corrigendum OJ 2004 L 195, p. 16), entitled 'Injunctions', provides:

'Member States shall ensure that, where a judicial decision is taken finding an infringement of an intellectual property right, the judicial authorities may issue against the infringer an injunction aimed at prohibiting the continuation of the infringement. Where provided for by national law, non-compliance with an injunction shall, where appropriate, be subject to a recurring penalty payment, with a view to ensuring compliance. Member States shall also ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an intellectual property right, without prejudice to Article 8(3) of Directive 2001/29/EC [of the European Parliament and of the Council of 22 May 2001 on the sur harmonisation of certain aspects of copyright and related rights in the information society (OJ 2001 L 167, p. 10)].'

Directive 2000/31/EC

- 5 Article 14 of Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market ('Directive on electronic commerce') (OJ 2000 L 178, p. 1), entitled 'Hosting', provides in paragraph 1 thereof:

'Where an information society service is provided that consists of the storage of information provided by a recipient of the service, Member States shall ensure that the service provider is not liable for the information stored at the request of the recipient of the service, on condition that:

- (a) the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent;

or

- (b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.'

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

- 6 Mr Louboutin is a French designer of luxury footwear and handbags whose best-known goods are high-heeled women's shoes. Since the mid-1990s, he has added to his high-heeled shoes an outer sole in a red colour (Pantone 18-1663TP).
- 7 That colour, applied to the sole of a high-heeled shoe, is registered as a Benelux trade mark under the Benelux Convention on intellectual property (trade marks and designs) of 25 February 2005, signed in The Hague by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of The Netherlands. That trade mark has been registered as an EU trade mark since 10 May 2016 ('the trade mark at issue').
- 8 Amazon operates websites selling various goods which it offers both directly, in its own name and on its own behalf, and indirectly, by also providing a sales platform for third-party sellers. The shipping of goods offered for sale on that online marketplace may be handled either by those sellers or by Amazon, which then stocks those goods in its distribution centres and ships them to purchasers from its own warehouses.
- 9 Those websites regularly display advertisements for red-soled shoes which, according to Mr Louboutin, relate to goods which have been placed on the market without his consent.

Case C-148/21

- 10 On 19 September 2019, Mr Louboutin, relying on an infringement of the exclusive rights conferred by the trade mark at issue, brought an action for infringement against Amazon before the tribunal d'arrondissement de Luxembourg (District Court, Luxembourg, Luxembourg), the referring court in Case C-148/21. Mr Louboutin seeks a declaration that (i) Amazon is liable for infringement of the trade mark at issue, (ii) it should cease the use, in the course of trade, of signs

which are identical with that trade mark throughout the territory of the European Union, with the exception of the Benelux territory, failing which it must make a periodic penalty payment, and (iii) it should be ordered to pay damages for the harm allegedly caused by that use.

- 11 Mr Louboutin's action is based on Article 9(2)(a) of Regulation 2017/1001. He submits that Amazon has used, without his consent, a sign which is identical with the trade mark at issue for goods which are identical with those for which that trade mark is registered, on account of, inter alia, it displaying, on that company's online sales websites, advertisements relating to goods bearing that identical sign, but also on account of the stocking, shipment and delivery of those goods. According to Mr Louboutin, such use is attributable to Amazon, in so far as that company has played an active role in the use of the sign at issue and the advertisements relating to the infringing goods formed part of its own commercial communication. Amazon cannot therefore be regarded as a mere website host or a neutral intermediary, since it provides assistance to third-party sellers, in particular regarding how best to present their offers.
- 12 Amazon challenges whether the use of the trade mark can be attributed to it. It relies on several judgments of the Court involving online marketplace operators, such as eBay, to claim that it too, as an online marketplace operator, cannot be held liable for the use of a sign which is identical with the trade mark at issue by third-party sellers who use its online marketplace. Amazon maintains that the operating method of the marketplaces incorporated into its online sales websites is not significantly different from that of other marketplaces and that the fact that Amazon's logo is included in the advertisements of third-party sellers does not mean that it adopts those advertisements. Furthermore, according to Amazon, the ancillary services it offers to third-party sellers cannot justify their offerings being regarded as forming part of its own commercial communication. The fact that a service provider creates the technical conditions necessary for the use of a sign which is identical with a protected trade mark and is remunerated for that service does not mean that that service provider itself makes use of the sign at issue.
- 13 According to the referring court in Case C-148/21, the operating method of the online sales websites operated by Amazon consists in grouping, for the same category of goods, both its own advertisements and those of third-party sellers active on the online marketplace included on those websites. In that, it is different from the operating method of other companies, such as eBay or Rakuten, which merely operate an online marketplace and, thus, publish only third-party advertisements, without themselves carrying out any sales activity. However, Amazon is not the only company to have adopted that 'hybrid' business model. Operators such as Cdiscount also host third-party sellers' goods alongside their own range of goods.
- 14 Consequently, it is necessary to determine, in the light of the Court's case-law and, in particular, of the judgment of 12 July 2011, *L'Oréal and Others*, (C-324/09, EU:C:2011:474), whether that operating method of the Amazon online sales websites may lead to the use, by the operator of those sites, of a sign which is identical with the trade mark at issue owing to the incorporation of third-party sellers' advertisements by displaying that sign in its own commercial communication.
- 15 That court is in doubt as to whether, as regards the more or less active role played by the operator of online sales websites incorporating an online marketplace in the publication of advertisements, the public's perception may be significant.

- 16 Lastly, that court is uncertain whether such an operator should be regarded as using a sign which is identical with a protected trade mark if it undertakes to ship the goods bearing that sign. In the judgment of 2 April 2020, *Coty Germany* (C-567/18, EU:C:2020:267), the Court did not rule on that point, since, in the case which gave rise to that judgment, shipping was carried out by an external service provider.
- 17 In those circumstances, the Tribunal d'arrondissement de Luxembourg (District Court, Luxembourg) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

(1) Is Article 9(2) of [Regulation 2017/1001] to be interpreted as meaning that the use of a sign identical with a trade mark in an advertisement displayed on a website is attributable to the website operator or to entities economically linked with it owing to the combination on that website of the operator or its economically linked entities' own offers and those of third-party sellers, by the incorporation of those advertisements in the operator's or its economically linked entities' own commercial communication?

Is such incorporation strengthened by the fact that:

- the advertisements are presented uniformly on the website?
- the operator's own advertisements and those of economically linked entities and the advertisements of third-party sellers are displayed without distinction as to their origin, but clearly display the logo of the operator or of economically linked entities, in the advertising categories of third-party websites in the form of "pop-ups"?
- the operator or economically linked entities offer a comprehensive service to third-party sellers, including providing assistance in preparing the advertisements and setting selling prices, stocking the goods and shipping them?
- the website of the operator and economically linked entities is designed in such a way as to be presented in the form of shops and labels such as "best sellers", "most sought after" or "most popular", without apparent distinction, at first sight, between the operator's and economically linked entities' own goods and third-party sellers' goods?

(2) Is Article 9(2) of [Regulation 2017/1001] to be interpreted as meaning that the use of a sign identical with a trade mark in an advertisement displayed on an online store is, in principle, attributable to its operator or to economically linked entities if, in the perception of a reasonably well-informed and reasonably observant internet user, that operator or an economically linked entity has played an active role in the preparation of that advertisement or if that advertisement is perceived as forming part of that operator's own commercial communication?

Is such a perception influenced by:

- the fact that that operator and/or economically linked entities is a well-known distributor of a vast range of goods, including goods in the category of those featured in the advertisement; or

- the fact that the advertisement thus displayed shows a heading in which the service mark of that operator or economically linked entities is reproduced, that mark being well known as a distributor’s mark; or
- the fact that that operator or economically linked entities offer, together with that display, services traditionally offered by distributors of goods in the same category as that to which the goods featured in the advertisement belongs?

(3) Must Article 9(2) of [Regulation 2017/1001] be interpreted as meaning that the shipment, in the course of trade and without the consent of the proprietor of a trade mark, to the final consumer of goods bearing a sign identical with the mark, constitutes use attributable to the shipper only if the shipper has actual knowledge that the sign has been affixed to the goods?

Is such a shipper the user of the sign concerned if the shipper itself or an economically linked entity has informed the final consumer that it will undertake the shipment after it or an economically linked entity has stocked the goods for that purpose?

Is such a shipper the user of the sign concerned if the shipper itself or an economically linked entity has previously made an active contribution to the display, in the course of trade, of an advertisement for the goods bearing that sign or has taken the final consumer’s order on the basis of that advertisement?’

Case C-184/21

- 18 On 4 October 2019, Mr Louboutin, relying on an infringement of the exclusive rights conferred by the trade mark at issue, brought before the tribunal de l’entreprise francophone de Bruxelles (Brussels Companies Court (French-speaking), Belgium) the referring court in Case C-184/21, an action for infringement of that trade mark against Amazon, seeking the cessation, by Amazon, of the use of that trade mark and damages for the harm caused by that use, on the basis, in essence, of the same arguments as those put forward in support of the claim he brought before the referring court in Case C-148/21.
- 19 According to Amazon, however, the fact that it publishes, on the online marketplaces incorporated in its online sales websites, the commercial offers of third-party sellers of shoes alleged to be counterfeit and that it ships those shoes, does not constitute use of the trade mark at issue by that company.
- 20 The referring court in Case C-184/21 considers that, for the purposes of resolving the dispute before it, it needs to know, first, in what circumstances the use of an infringing sign in a commercial offer from a third-party seller may be attributed to the operator of an online sales website incorporating an online marketplace, second, whether, and in what circumstances, the perception of the public in relation to that offer must be taken into account in order to determine the attributability of such use, and third, whether and, if appropriate, in what circumstances the fact that Amazon ships goods bearing a sign which is identical with a trade mark constitutes, in itself, use of that trade mark, which may be attributed to that company, under Article 9(2)(a) of Regulation 2017/1001.

21 In those circumstances, the tribunal de l'entreprise francophone de Bruxelles (Brussels Companies Court (French-speaking)) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Must Article 9(2) of [Regulation 2017/1001] be interpreted as meaning that the use of a sign identical with a trade mark in an advertisement displayed on a website is, in principle, attributable to its operator if, in the perception of a reasonably well-informed and reasonably observant internet user, that operator has played an active part in the preparation of that advertisement or if that advertisement may be perceived by such an internet user as forming part of that operator's own commercial communication?

Will such perception be influenced:

- by the fact that that operator is a well-known distributor of a wide range of goods, including goods in the category of those featured in the advertisement; or
- by the fact that the advertisement thus displayed presents a heading in which the service mark of that operator is reproduced, that mark being well known as a distributor's trade mark; or
- furthermore, by the fact that, as well as displaying that advertisement, that operator offers services traditionally offered by distributors of goods in the same category as that to which the goods featured in the advertisement belong?

(2) Must Article 9(2) of [Regulation 2017/1001] be interpreted as meaning that the shipment, in the course of trade and without the consent of the proprietor of a trade mark, to the final consumer of goods bearing a sign identical with the mark constitutes a use attributable to the shipper only if the shipper has actual knowledge that that sign has been affixed to those goods?

Is such a shipper the user of the sign concerned if the shipper itself or an economically linked entity has informed the final consumer that it will undertake the shipment after it or an economically linked entity has stocked the goods for that purpose?

Is such a shipper the user of the sign concerned if the shipper itself or an economically linked entity has previously made an active contribution to the display, in the course of trade, of an advertisement for the goods bearing that sign or has taken the final consumer's order on the basis of that advertisement?

22 By decision of the President of the Court of 16 April 2021, Cases C-148/21 and C-184/21 were joined for the purposes of the oral proceedings and of the judgment.

The questions referred for a preliminary ruling

23 By their questions, which should be considered together, the referring courts ask, in essence, whether Article 9(2)(a) of Regulation 2017/1001 must be interpreted as meaning that the operator of an online sales website incorporating, as well as its own sales offerings, an online marketplace may be regarded as itself using a sign which is identical with an EU trade mark of another person for goods which are identical with those for which that trade mark is registered, where third-party sellers offer for sale, on that marketplace, without the consent of the

proprietor of that trade mark, such goods bearing that sign. They are uncertain, in particular, whether the fact that that operator publishes offers on its website in a uniform manner, displaying at the same time advertisements relating to the goods which it sells in its own name and on its own behalf and those relating to goods offered by third-party sellers on that marketplace, the fact that it displays its own logo as a renowned distributor on all those advertisements, and the fact that it offers third-party sellers, for the marketing of their goods, additional services consisting in providing support in the presentation of their advertisements, and in stocking and shipping the goods offered on the same marketplace, are relevant in that regard. In that context, the referring courts also raise the issue of whether, where appropriate, the perception of the users of the website in question should be taken into consideration.

- 24 Under Article 9(2)(a) of Regulation 2017/1001, registration of an EU trade mark confers on its holder the right to prevent all third parties from using, in the course of trade, any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered.
- 25 In that regard, it should be noted at the outset that the concept of ‘using’ within the meaning of Article 9(2) of Regulation 2017/1001 is not defined by that regulation.
- 26 It is apparent from the Court’s settled case-law that the proprietor of the trade mark is entitled to prohibit the use, without his consent, of the sign which is identical with that trade mark by a third party, if that use takes place in business life, and is made for goods or services which are identical with those for which the trade mark is registered, and infringes or is likely to infringe the functions of the trade mark, which include inter alia the essential function of the trade mark which is to guarantee in particular to the consumers the provenance of the good or service (see, to that effect, judgment of 3 March 2016, *Daimler*, C-179/15, EU:C:2016:134, paragraph 26 and the case-law cited).
- 27 The Court has also stated that, according to its ordinary meaning, the expression ‘using’ involves active behaviour and direct or indirect control of the act constituting the use and noted that Article 9(3) of Regulation 2017/1001, which lists in a non-exhaustive manner the types of use which the trade mark proprietor may prohibit, refers exclusively to active behaviour on the part of the third party (see, to that effect, judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 37 and the case-law cited), which include, in Article 9(3)(b), offering the infringing goods, putting them on the market or stocking them for those purposes.
- 28 In that context, the Court has noted that Article 9 of Regulation 2017/1001 is intended to provide a proprietor of an EU trade mark with a legal instrument allowing him to prohibit, and thus to prevent, any use of that trade mark by a third party without his consent. However, only a third party who has direct or indirect control of the act constituting the use is effectively able to stop that use and therefore comply with that prohibition (judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 38 and the case-law cited).
- 29 Furthermore, the Court has repeatedly held that the use, by a third party, of a sign which is identical or similar to the proprietor’s trade mark, within the meaning of Article 9(2) of Regulation 2017/1001, implies, at the very least, that that third-party uses the sign in its own commercial communication. A person may thus allow its clients to use signs which are identical or similar to trade marks without itself using those signs (judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 39 and the case-law cited).

- 30 The Court thus considered, with regard to the operator of an online marketplace, that the use of signs which are identical with or similar to trade marks in offers for sale displayed on that marketplace is made only by the sellers who are customers of that operator and not by the operator itself, since the latter does not use that sign in its own commercial communication (see, to that effect, judgments of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraphs 102 and 103, and of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 40).
- 31 The mere fact of creating the technical conditions necessary for the use of a sign and being paid for that service does not mean that the party offering the service itself uses the sign, even if it is in its own financial interest (see, to that effect, judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 43 and the case-law cited).
- 32 In the same vein, the Court held, in essence, in paragraphs 45 and 53 of the judgment of 2 April 2020, *Coty Germany* (C-567/18, EU:C:2020:267), that, where the operator of an online marketplace offers storage services to the third-party sellers active on that marketplace, so that it stores for those third-party sellers goods which infringe a trade mark right, without however being aware of the infringing nature of the goods at issue and without having the aim of itself offering the goods which it stores or of itself putting them on the market, it is not the operator, but those sellers alone which make use of the signs affixed to the stored goods.
- 33 However, it is important to point out that, although the case which gave rise to that judgment concerned the operator of the same online sales website incorporating the online marketplace, namely Amazon, the referring court in that case, which alone had jurisdiction to make the necessary factual findings, had made it clear that that operator was unaware of the fact that the goods at issue infringed a trade mark right, that it had not itself offered the goods concerned for sale or put them on the market and that it also did not intend to do it itself. That court had also pointed out that those goods were dispatched by external service providers (see judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraphs 9, 30 and 47).
- 34 Moreover, the Court was not asked in that case or in the case which gave rise to the judgment of 12 July 2011, *L'Oréal and Others* (C-324/09, EU:C:2011:474), relied on by Amazon and cited in paragraph 30 of this judgment, about the impact of the fact that the online sales website in question incorporates, as well as the online marketplace, sales offers of the operator of that site itself.
- 35 However, in the present cases, the referring courts specifically raise the issue of that impact and the significance, in that context, of the perception of the users of the website in question and of other circumstances, such as the fact that the operator presents the sales offers published on its website in a uniform manner, displaying at the same time its own advertisements and those of third-party sellers and attaching its own logo as a renowned distributor to all those advertisements, and also the fact that it offers additional services to those third-party sellers in connection with the marketing of their goods, such as support in the presentation of their advertisements and the storing and shipping of their goods.
- 36 In that connection, the referring courts are uncertain, in particular, whether, in such circumstances, as well as the third-party seller, the operator of the online sales website incorporating an online marketplace may be regarded, as using, in some cases, in its own commercial communication, a sign which is identical with a trade mark of another person for goods which are identical with those for which that trade mark is registered, and may thus be

held liable for the infringement of the rights of the proprietor of that trade mark, within the meaning of Article 9(2)(a) of Regulation 2017/1001, where that third-party seller offers goods bearing that sign for sale on that marketplace.

- 37 It must be stated, in that regard, that that issue arises irrespective of the fact that the role of that operator, in so far as it enables another economic operator to make use of the trade mark, may, if necessary, be examined from the point of view of other rules of law such as Article 14(1) of Directive 2000/31 or the first sentence of Article 11 of Directive 2004/48 (see, to that effect, judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 49 and the case-law cited).
- 38 Although, in the end, it is for the referring courts to assess whether, in each of the cases in the main proceedings, Amazon, in its capacity as operator of an online sales website incorporating an online marketplace, makes use of a sign which is identical with the trade mark at issue for goods which are identical with those for which that trade mark is registered, within the meaning of Article 9(2)(a) of Regulation 2017/1001, the Court may nevertheless provide those courts with the elements of interpretation under EU law which may be useful to them in that regard (see, by analogy, judgment of 7 April 2022, *Berlin Chemie A Menarini*, C-333/20, EU:C:2022:291, paragraph 46 and the case-law cited).
- 39 In that regard, it should be pointed out, as the Advocate General did in points 55 and 56 of his Opinion, that the ‘commercial communication’ of an undertaking, within the meaning of the case-law cited in paragraph 29 of this judgment, generally designates any form of communication to third parties designed to promote its activity, goods or services or to indicate the exercise of such an activity. The use of a sign in that undertaking’s own commercial communication thus presupposes that that sign appears, in the eyes of third parties, to be an integral part of the communication and, consequently, a part of that undertaking’s activity.
- 40 In that context, the Court has already found that, in a situation in which the supplier of the service uses a sign which is identical or similar to the trade mark of another person in order to promote goods which one of its customers is marketing with the assistance of that service, that operator does itself make use of that sign if it uses it in such a way that it establishes a link between the sign and the services provided by that operator (judgments of 12 July 2011, *L’Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 92, and of 15 December 2011, *Frisdranken Industrie Winters*, C-119/10, EU:C:2011:837, paragraph 32).
- 41 Accordingly, the Court has held that such a service provider does not itself make use of a sign which is identical with or similar to a trade mark of another person when the service it provides is not, by its very nature, comparable to a service aimed at promoting the marketing of goods bearing that sign and does not imply the creation of a link between the sign and that service, since the service provider in question is not apparent to the consumer, which excludes any association between its services and the sign at issue (see, to that effect, judgment of 15 December 2011, *Frisdranken Industrie Winters*, C-119/10, EU:C:2011:837, paragraph 33).
- 42 On the other hand, the Court has held that such a link does exist where the operator of an online marketplace, by means of an internet referencing service and on the basis of a keyword which is identical with a trade mark of another person, advertises goods bearing that trade mark which are offered for sale by its customers on the online marketplace. For internet users carrying out a search on the basis of a keyword, such advertising creates an obvious association between those trade-marked goods and the possibility of buying them through that marketplace. That is why

the proprietor of that trade mark is entitled to prohibit that operator from such use, where that advertising infringes the trade mark right owing to the fact that it does not enable well-informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods concerned originate from the proprietor of the trade mark or from an undertaking economically linked to that proprietor or, on the contrary, originate from a third party (see, to that effect, judgment of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraphs 93 and 97).

- 43 It is apparent from that case-law that, as the Advocate General pointed out, in essence, in points 58, 59 and 72 of his Opinion, in order to determine whether the operator of an online sales website incorporating an online marketplace does itself make use of a sign which is identical with a trade mark of another person, which appears in advertisements relating to goods offered by third-party sellers on that marketplace, it is necessary to assess whether a well-informed and reasonably observant user of that website establishes a link between that operator's services and the sign in question.
- 44 The relevance of such an analysis is by no means called into question by the argument put forward by Amazon and the European Commission in their written observations, that the Court's existing case-law has not taken the perception of users into consideration.
- 45 It is true that, in paragraphs 102 and 103 of the judgment of 12 July 2011, *L'Oréal and Others*, (C-324/09, EU:C:2011:474), the substance of which is set out in paragraph 30 of this judgment, the Court did not expressly mention the perception of the user of the online marketplace, to whom the commercial communication at issue is addressed.
- 46 However, that does not mean that the Court precluded consideration of the perception of the users of the online marketplace as a relevant factor for determining whether the sign in question is used in the market place operator's own commercial communication.
- 47 In the case which gave rise to that judgment, the website in question comprised only an online marketplace and did not also include sales offers of the operator of that site.
- 48 Therefore, in order to determine whether an advertisement, published on an online sales website incorporating an online marketplace by a third-party seller active on that marketplace, using a sign which is identical with a trade mark of another person may be regarded as forming an integral part of the commercial communication of the operator of that website, it is necessary to ascertain whether that advertisement may establish a link between the services offered by that operator and the sign in question, on the ground that a well-informed and reasonably observant user might believe that the operator is marketing, in its own name and on its own account, the goods for which the sign in question is being used.
- 49 In the overall assessment of the circumstances of the present case, the method of presenting the advertisements, both individually and as a whole, on the website in question and the nature and scope of the services provided by the operator of the website are particularly important.
- 50 As regards, first, the method of presenting those advertisements, it should be pointed out that the need for transparency in the display of those advertisements is provided for in EU legislation on electronic commerce (judgment of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 95). Advertisements displayed on an online sales website incorporating an online marketplace must, therefore, be presented in a way which enables a well-informed and

reasonably observant user to distinguish easily between offers originating, on the one hand, from the operator of that website and, on the other, from third-party sellers active on the online marketplace which is incorporated therein (see, by analogy, judgment of 12 July 2011, *L'Oréal and Others*, C-324/09, EU:C:2011:474, paragraph 94).

- 51 However, the fact that the operator of an online sales website incorporating an online marketplace uses a uniform method of presenting the offerings published on its website, displaying both its own advertisements and those of third-party sellers and placing its own logo as a renowned distributor on its own website and on all those advertisements, including those relating to goods offered by third-party sellers, may make it difficult to draw such a clear distinction and thus to give the well-informed and reasonably observant user the impression that that operator is marketing, in its own name and on its own behalf, the goods offered for sale by those third-party sellers. Consequently, when those goods bear a sign which is identical with a trade mark of another person, that uniform presentation may establish a link, in the eyes of those users, between that sign and the services provided by that same operator.
- 52 In particular, where the operator of an online sales website describes the various offerings, from itself or a third party, without distinguishing them as to their origin, as 'bestsellers' or 'most sought after' or 'most popular' for the purpose inter alia of promoting some of those offerings, that presentation is likely to strengthen the impression of the well-informed and reasonably observant user that those goods thus promoted are being marketed by that operator, in its own name and on its own behalf.
- 53 Second, the nature and scope of the services provided by the operator of an online sales website incorporating an online marketplace to the third-party sellers who offer goods bearing the sign at issue on that marketplace, such as the services consisting inter alia in dealing with the questions of the users relating to those goods or to the storage, shipping and management of returns of those goods, are also likely to give the impression, to a well-informed and reasonably observant user, that those same goods are being marketed by that operator, in its own name and on its own behalf, and may thus establish a link, in the eyes of those users, between its services and the signs placed on those goods and in the advertisements of those third-party sellers.
- 54 In the light of all the foregoing considerations, the answer to the questions referred should be that Article 9(2)(a) of Regulation 2017/1001 must be interpreted as meaning that the operator of an online sales website incorporating, as well as that operator's own sales offerings, an online marketplace may be regarded as itself using a sign which is identical with an EU trade mark of another person for goods which are identical with those for which that trade mark is registered, where third-party sellers offer for sale, on that marketplace, without the consent of the proprietor of that trade mark, such goods bearing that sign, if a well-informed and reasonably observant user of that site establishes a link between the services of that operator and the sign at issue, which is in particular the case where, in view of all the circumstances of the situation in question, such a user may have the impression that that operator itself is marketing, in its own name and on its own account, the goods bearing that sign. In that regard, the following are relevant: the fact that that operator uses a uniform method of presenting the offers published on its website, displaying both the advertisements relating to the goods which it sells in its own name and on its own behalf and those relating to goods offered by third-party sellers on that marketplace; the fact that it places its own logo as a renowned distributor on all those advertisements; and the fact that it offers third-party sellers, in connection with the marketing of goods bearing the sign at issue, additional services consisting inter alia in the storing and shipping of those goods.

Costs

- 55 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national courts, the decision on costs is a matter for those courts. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Grand Chamber) hereby rules:

Article 9(2)(a) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

must be interpreted as meaning that the operator of an online sales website incorporating, as well as that operator's own sales offerings, an online marketplace may be regarded as itself using a sign which is identical with an EU trade mark of another person for goods which are identical with those for which that trade mark is registered, where third-party sellers offer for sale, on that marketplace, without the consent of the proprietor of that trade mark, such goods bearing that sign, if a well-informed and reasonably observant user of that site establishes a link between the services of that operator and the sign at issue, which is in particular the case where, in view of all the circumstances of the situation in question, such a user may have the impression that that operator itself is marketing, in its own name and on its own account, the goods bearing that sign. In that regard, the following are relevant: the fact that that operator uses a uniform method of presenting the offers published on its website, displaying both the advertisements relating to the goods which it sells in its own name and on its own behalf and those relating to goods offered by third-party sellers on that marketplace; the fact that it places its own logo as a renowned distributor on all those advertisements; and the fact that it offers third-party sellers, in connection with the marketing of goods bearing the sign at issue, additional services consisting inter alia in the storing and shipping of those goods.

[Signatures]