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Session 10A

EU Trade mark law

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Recent Jurisprudence of the CJEU

- C–553/11 Rintisch
- C–149/11 Leno Merken BV
- C–307/10 IP Translator

C–553/11 Rintisch

- Genuine Use – Use of a form, itself registered as a trade mark, differing in elements which do not alter the distinctive character of the mark
- PROTIPLUS/PROTI/PROTI POWER for protein based products
- Defendant: PROTIFIT
- Only PROTIPLUS and PROTI POWER used but cancellation based principally on PROTI

Referral by BGH

- Doubts as to whether last sentence of DE law Art 26 (3) is consistent with Art 10(1) and (2)a) Dir 89/104
- In C-234/06 P BAINBRIDGE (par. 86)

“...it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation of the former”.

Judgment CJEU

- Par 86 Bainbrigde only in context of series or families of marks
- Use of a mark in a form which differs but does not alter distinctive character can be relied on even though that different form is itself registered as a trade mark
- Concept of “defensive” trade marks is unknown in EU law
- Commission proposal incorporates in Art 15(1)

C-149/11 - Leno Marken BV

- ONEL CTM (Class 35,41,42)
- Opposition against BX application
- OMEL (class 35,41,45)
- Opposition rejected by BOIP because genuine use not shown
- Parties agree on similarity and LoC but not on genuine use

Referral NL Court

- Use in NL proved – not in other MS
- Case law Ansul C-40/01, Sunrider C-416/04P, La Mer C-259/02
- Quid statement No 10 : “Council and Commission consider that use which is genuine within the meaning of Art 15 CTMR in a country constitutes genuine use in the Community”
- Can use of a CTM in a single MS be sufficient to constitute use according to Art 15(1) CTMR?



Background

- Tension between OHIM and National Offices
- Competition between CTM and national marks?
- Made up case?
- Observations from: NL, B, DK, D, F, Hu
UK

Reasoning CJEU

- Mark must be used according to its essential function: guarantee origin, preserve outlet, not token use
- Case by case assessment
- Unitary character of CTM
- To offer on the internal market conditions similar to national market

Answer CJEU

- Territorial borders of MS should be disregarded in the assessment of “genuine use in the community”
- CTM is put to genuine use if used in accordance with its essential function and for the purpose of maintaining or creating market share
- National Court must assess

C-307/10 - IP Translator

- UK TM application “IP Translator” for class 41
- Class heading “education; providing of training; entertainment; sporting and cultural activities”
- Registrar refuses application because:
 - Communication 4/03 OHIM says that if class heading all services of the class are covered
 - Since “translation services” are in class 41 the sign is descriptive

Two interpretations of class headings

- Communication OHIM N° 4/03

all goods and services included in a class are covered even if they do not fall clearly under the wording of the class heading

- Only those G&S covered by meaning



Reference

- Need clarity and precision?
- Risk of different scope of protection from one MS to another?
- Can interpretation re Communication N° 4/03 be maintained?



CJEU responses

- Clarity and precision are necessary so that competent authorities and economic operators can determine extent of protection
- Use of class headings permitted provided clarity and precision
- For past applications, the applicants must specify whether intention was to cover all G & S included in alphabetical Nice List or only some of them



Conclusions

- CJEU has saved OHIM's practice from major negative consequences
- OHIM needs to take measures immediately (done) and change its practice
- Taxonomy: the solution



Thank You

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