

# ARNOLD RUESS

RECHTSANWÄLTE UND FACHANWÄLTE  
FÜR GEWERBLICHEN RECHTSSCHUTZ

## ***Recent CJEU case law***

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**Prof. Dr. Peter Ruess, LL.M.**

# The Case *FCI v FCIPPR*

CJEU C-561/11



- Fédération Cynologique Internationale (FCI) is proprietor of the following trademark, which was registered in 2006:



- In favour of Federación Canina Internacional de Perros de Pura Raza (FCIPPR) the following marks are registered thereafter:



- FCI sought declaration of invalidity for FCIPPR's national marks and an action for infringement based on FCIPPR's use of its CTM.

# The Case *FCI v FCIPPR*

CJEU C-561/11



- Problem: Does a trade mark imply a “positive right of use”?
- Thus, the national court decided to refer the following question to the Court of Justice for a preliminary ruling:

*“In proceedings for infringement of the exclusive right conferred by a Community trade mark, does the right to prevent the use thereof by third parties in the course of trade provided for in Article 9(1) CTMR extend to any third party who uses a sign that involves a likelihood of confusion (because it is similar to the Community trade mark and the services or goods are similar) or, on the contrary, is the third party who uses that sign (capable of being confused) which has been registered in his name as a Community trade mark excluded until such time as that subsequent trade mark registration has been declared invalid?”*

# The Case *FCI v FCIPPR*

CJEU C-561/11



- The Court of Justice decided:

*“Article 9(1) CTMR must be interpreted as meaning that the exclusive right of the proprietor of a Community trade mark to **prohibit all third parties** from using, in the course of trade, signs identical with or similar to its trade mark extends to a third-party proprietor of a later registered Community trade mark, without the need for that latter mark to have been declared invalid beforehand.”*

- Consequence: The proprietor of a Community trade mark is able to prevent the proprietor of a later registered Community trade mark from using that later trade mark.

# The Case *Env. Manufacturing v OHIM*

CJEU C-383/12



- Environmental Manufacturing LLP applied to register a figurative trade mark for a sign depicting a wolf's head:



- Société Elmar Wolf (Wolf) opposed the registration citing Article 8(5) CTMR; the opposition was based, *inter alia*, on the following earlier French and international word and figurative trade marks:



# The Case *Env. Manufacturing v OHIM*

CJEU C-383/12



- The Court of Justice held that proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer, resulting from the use of the later mark, or a serious likelihood that such a change will occur in the future.

# The Case *Env. Manufacturing v OHIM*

CJEU C-383/12



- The mere fact that consumers note the presence of a new sign similar to the earlier mark is not sufficient to establish the existence of detriment or a risk of detriment to the distinctive character of the earlier mark, inasmuch as that similarity does not cause any confusion in their minds.
- The change in economic behaviour of the average consumer is an **objective condition**; it cannot be deduced solely from subjective elements such as consumer perceptions.

# The Case *Env. Manufacturing v OHIM*

CJEU C-383/12



- The Court's case-law does not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions
- Nonetheless, any deductions must not be the result of mere suppositions but must be founded on an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case
- Consequence: High threshold required to prove detriment to a well-known/reputable trade mark



# The Case *Colloseum v Levi Strauss*

CJEU C-12/12



- Levi Strauss & Co (Levi Strauss) is, inter alia, proprietor of the following trade marks:



(referred to as Mark No. 3)



(referred to as Mark No 6)

# The Case *Colloseum v Levi Strauss*

CJEU C-12/12



- Colloseum Holding AG (Colloseum), a retailer of outerwear, started to sell “SM Jeans”:



- Levi Strauss sued for trade mark infringement based on Mark No 6
- Colloseum objected that Mark No 6 had not been put to genuine use

# The Case *Colloseum v Levi Strauss*

CJEU C-12/12



- Problem: Levi Strauss had used Mark No. 6 only in the form of Mark No. 3.
- The German Federal Supreme Court stated that the two marks did not differ from each other only in elements which did not alter their distinctive character; thus, Article 15(2)(a) CTMR, which counts use of a mark that is only trivially different from the registered mark as being use of that mark applied, is not applicable.

# The Case *Colloseum v Levi Strauss*

CJEU C-12/12



- The German Federal Supreme Court therefore decided to refer the following questions to the Court of Justice for a preliminary ruling:

*“Is Article 15(1) CTMR to be interpreted as meaning that:*

- 1. a trade mark which is part of a composite mark and has become distinctive only as a result of the use of the composite mark can be used in such a way as to preserve the rights attached to it if the composite mark alone is used?*
- 2. a trade mark is being used in such a way as to preserve the rights attached to it if it is used only together with another mark, the public sees independent signs in the two marks and, in addition, both marks are registered together as a trade mark?”*

# The Case *Colloseum v Levi Strauss*

CJEU C-12/12



- The Court of Justice decided:

*“The condition of genuine use of a trade mark, within the meaning of Article 15(1) CTMR may be satisfied where a registered trade mark, which has become distinctive as a result of the use of another composite mark of which it constitutes one of the elements, is used only through that other composite mark, or where it is used only in conjunction with another mark, and the combination of those two marks is, furthermore, itself registered as a trade mark.”*

- Consequence: It does not matter whether the sign is used as part of/in conjunction with a registered trade mark; important is only that the sign serves to identify, in the minds of the relevant public, the goods and services to which it relates as originating from a particular undertaking.

Speaker is done. Wake up and discuss!



Feedback : [ruess@arnold-ruess.com](mailto:ruess@arnold-ruess.com)