


## TRADE MARKS

## Decisions of the CJ and GC

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>CJ  <b>C-207/15 P</b>  <i>Nissan Jidosha KK v EUIPO</i>            (22.06.16)            Reg 207/2009</p>	 <p>Goods in Classes 7, 9 and 12</p>	<p>The GC had erred in finding that <b>Art 47(3)</b> prohibited the submission of partial renewal requests staggered over time which related to different classes of goods or services.</p> <p>Nissan appealed to the CJ following an attempt to renew the goods covered by the mark at issue in stages: the renewal request in respect of goods in Classes 7 and 12 was submitted prior to the expiry of the protection period and the request to renew Class 9 was filed under the 'further period' as provided for under <b>Art 47(3)</b>. The EUIPO had refused the renewal of Class 9 and the BOA and GC had both upheld this decision.</p> <p>The CJ confirmed that <b>Art 47(3)</b> granted the proprietor of a mark one year to renew the mark, divided into two six-month periods falling either side of the date on which the existing registration expired. The CJ considered the wording of <b>Art 47(3)</b> in several languages, and concluded that it could not be clearly and unequivocally inferred that a request for renewal of an EUTM may be submitted only exceptionally during the 'further period', i.e. the six months following the expiry of protection. The only condition imposed under <b>Art 47(3)</b> was the payment of an additional fee.</p> <p>The CJ endorsed AG Campos Sanchez-Bordona's opinion that the possibility for successive renewal requests within the two consecutive renewal periods provided for by <b>Art 46</b> and <b>Art 47</b> was consistent with the general objective of <b>Regulation No 207/2009</b> to facilitate the retention by proprietors of their exclusive trade mark rights.</p>
<p>[C-280/15 – Ahalya]</p>		

<p>GC  <b>T-134/15</b>  <i>salesforce.com, Inc. v EUIPO</i>  (28.06.16)  Reg 207/2009</p>	<p><b>SOCIAL.COM</b></p> <ul style="list-style-type: none"> <li>- computer programs; games programs for computers; computer software related to multimedia data on computer networks; electronic publications (9)</li> <li>- online and mobile telephone advertising services; commercial transactions; consultancy and office functions (35)</li> <li>- printed and electronic publication services and other internet, entertainment and social media services (41)</li> <li>- various scientific and technological services (42)</li> <li>- brand engagement and online communications investigations; monitoring online content for others (45)</li> </ul>	<p>The GC upheld the BoA's decision that the mark was descriptive pursuant to <b>Art 7(1)(c)</b>.</p> <p>The relevant public would perceive the word 'social' as having its normal and immediate meaning, which was related to the concept of 'society' and would recognise the element '.com' as referring to a website.</p> <p>The BoA was correct to find that 'SOCIAL.COM', taken as a whole would be understood as an internet-based social interaction. In relation to the goods and services at issue, the mark applied for would be perceived as a reference to the contemporary expressions 'social media' and 'social networks'.</p> <p>All of the goods and services covered by the mark applied for related to social media or social networks in a sufficiently direct manner and formed a group of goods and services of sufficient homogeneity such that it was not necessary for the BoA to examine the descriptive nature of the mark separately for each type of good or service concerned.</p> <p>The GC endorsed the BoA's decision that the mark was descriptive within the meaning of <b>Art 7(1)(c)</b>.</p>
<p>[T-727/14 &amp; T-728/14 – Ahalya]</p>		
<p>[T518/13 – Rebekah]</p>		

<p>GC</p> <p><b>T-431/15</b></p> <p><i>Fruit of the Loom v EUIPO; Takko Holding GmbH</i></p> <p>(07.07.16)</p> <p>Reg 207/2009</p>	<p><b>FRUIT</b></p> <p>- clothing; footwear; headgear (25)</p>	<p>The GC annulled the BoA's decision to revoke the mark on the basis of a lack of genuine use under <b>Art 51(1)(a)</b>.</p> <p>The BoA wrongly held that to constitute genuine use of the mark, the acts of the trade mark owner had to be directed at end consumers which in this case comprised the general public and common consumers. For the purposes of genuine use, the GC confirmed that the relevant public might include specialists, commercial and trade customers and other professional users. Promotional acts, such as affixing the mark on catalogues, specialist press, and participation at trade fairs, might also be characterised as genuine use and taken into account in the overall assessment of genuine use.</p> <p>The GC confirmed that the decision of the proprietor to postpone or stop the launch of the goods bearing the mark should not constitute the only determining factor in the assessment of genuine use, and that this fact of itself was insufficient to establish purely token use. Such a decision would not necessarily deprive the earlier commercial acts of their capacity to preserve or create a market share for the goods at issue.</p> <p>The BoA failed to take into account practices of marking specific to the clothing sector and failed to explain why professionals from the sector would not have had the opportunity to notice the labels stitched on the goods at issue. The BoA had also erred by concluding that the use made by the proprietor was not genuine as such use was carried out towards the end of the relevant period. The GC held that the mere fact that a mark had been used for only a limited period was not a decisive factor in the overall assessment. The BoA also failed to analyse the</p>
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		number of brochures and catalogues distributed and orders for goods received by the proprietor.  In the light of this assessment, the GC annulled the BoA's decision on the basis that it was vitiated by an error of law and an assessment which did not satisfy the criteria established in earlier case law.
[T82/14 – Henry]		
[T567/15, T429/15 – Thomasin]		

## DESIGNS

### **Failure to register licence is not a bar to a licensee bringing infringement proceedings**

***Thomas Philipps GmbH & Co. KG ('Philipps') v Grüne Welle Vertriebs GmbH ('Grüne')* (CJ (Seventh Chamber); C-419/15; 22.06.16)**

The CJ held that a licensee to a Registered Community Design was entitled to bring infringement proceedings under **Article 32 (3)** of **Regulation 6/2002** notwithstanding that the licence had not been entered in the register of Community Designs. The CJ further held that a licensee was entitled to recover compensation for its own loss in infringement proceedings brought under that provision.

Grüne was the exclusive licensee for Germany of a RCD relating to laundry balls. With consent of the licensor, Grüne commenced proceedings in Germany against Philipps seeking compensation relating to Philipps' sales of laundry balls which were claimed to infringe the RCD. Grüne sought compensation for their losses arising from the infringement. The licensor was not a party to the proceedings. Philipps challenged Grüne's entitlement to bring proceedings on the basis that the licence had not been entered on the register of Community Designs. On appeal, the Oberlandesgericht Düsseldorf referred two questions to the CJ asking first whether Grüne was precluded from bringing proceedings because its licence was not registered and second whether Grüne was entitled to seek compensation for its losses in proceedings which did not also consider losses suffered by the licensor.

#### Unregistered licence

The CJ concluded that **Article 33(2)** did not preclude a licensee from bringing proceedings for infringement of an RCD where the licence had not been entered onto the register of Community Designs. In doing so, the CJ held that an interpretation of the first sentence of **Article 33(2)** which restricted the right of a licensee to bring infringement proceedings under **Article 32(3)** would be contrary to the purpose of **Article 33(3)** which was to regulate the rights of third parties with interests in a Community Design. Whilst **Article 28(b)** restricted the right of a proprietor to initiate infringement proceedings before registration of the transfer of the Community Design to them, **Article 32** contained no equivalent provision in relation to a licensee's ability to initiate infringement proceedings.

### Damages for licensees' losses

The CJ explained that **Article 32** provided two mechanisms by which a licensee could become involved in infringement proceedings, either by initiating proceedings in their own right under **Article 32(3)**; or intervening in infringement proceedings initiated by the proprietor under **Article 32(4)**. Whilst only **Article 32(4)** referred to compensation for damages suffered by the licensee, this did not preclude a licensee also seeking compensation for its losses in proceedings commenced in accordance with **Article 32(3)**. To limit **Article 32(3)** in this manner would frustrate the licensee's ability to defend the rights conferred upon it by its license and would be contrary to the objective of **Regulation 6/2006** and the purpose of **Articles 32(3)** and **(4)**.

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The reported cases marked \* can be found at <http://www.bailii.org/databases.html#ew> and the CJ and GC decisions can be found at [http://curia.europa.eu/jcms/jcms/j\\_6/home](http://curia.europa.eu/jcms/jcms/j_6/home)