

What constitutes genuine use of a trade mark?

By Corinne Day, Field Fisher Waterhouse, United Kingdom

First published on Field Fisher Waterhouse SnIPpets IP Blog and on www.ffw.com

The Court of Justice of the European Union (CJEU) has ruled on what constitutes genuine use of a trade mark within the meaning of Article 15(1) of Community Trade Mark Regulation 40/94 in the recent case of *Colloseum Holding AG v Levi Strauss & Co.* (Case C-12/12).

Background

Levi Strauss is the owner of German word and figurative trade mark (which contains the word element LEVI'S in a red rectangular element at the left upper edge of a pocket): (referred to as Mark 3) for trousers, shirts, blouses and jackets for men, women and children, registered in 1977.



It also owns figurative Community trade mark in red and blue:(referred to as Mark 6) for trousers, shorts, skirts. According to its description in the register, it is a position mark and consists of a rectangular red label, made of textile, sewn into and protruding from the upper part of the left-hand seam of the rear pocket of trousers, shorts or skirts, registered in 2005. Mark 6 was registered on the basis of having become distinctive through use, pursuant to Article 7(3) of Regulation No 40/94.



Levi Strauss sued Colloseum, a retailer of outerwear, which started to sell jeans under the trade marks COLLOSEUM; S.MALIK and EURGIULIO, for trade mark infringement. The jeans sold by Colloseum had small rectangular red fabric tags, on which appeared the relevant brands or the word 'SM JEANS', sewn on the upper right seam of the right rear pocket. Colloseum argued that the mark Levi Strauss was relying on, Mark 6, had never been in use at all.

The German court (where the case was first heard) observed that the outcome of the case would turn on the interpretation of Article 15(1) of Community Trade Mark Regulation 40/94. It stated that there

would be a likelihood of confusion between Mark 6 and the trouser styles marketed by Colloseum, should Mark 6 still be valid.

Questions to be determined

So the question was: had Mark 6 been put to genuine use within the meaning of Article 15(1)? Article 15(1) states that:

“If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use”.

The problem for Levi Strauss was that it had only used Mark 6 in the form of Mark 3.

The German court referred the following questions to the ECJ:

‘Is Article 15(1) of Regulation 40/94 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?’*

CJEU decision

The CJEU held that genuine use of a trade mark within Article 15(1) of the Community Trade Mark Regulation 40/94 might be satisfied “where a registered trade mark that had become distinctive as a result of the use of another composite mark, the first mark constituting one of its elements, was used only through that other composite mark, or only in conjunction with another mark and the combination of those two marks was itself registered as a trade mark”.

The CJEU stated that distinctiveness of a mark means that the mark serves to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings, its essential function being to identify, in the eyes of consumers, the undertaking of origin of the goods.

Acquisition of distinctive character may result both from the use, as part of a registered trade mark, of a component thereof and from the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the goods or service, designated exclusively by the mark applied for, as originating from a given undertaking.

Comment

The ECJ’s ruling is a logical extension of previous case law. So, regardless of whether the sign is used as part of a registered trade mark or in conjunction with the registered trade mark, the fundamental condition is that, as a consequence of that use, the sign for which registration as a trade mark is sought may serve to identify, in the minds of the relevant class of persons, the goods to which it relates as originating from a particular undertaking.

For more information, please contact:



Corinne Day
Solicitor in IP protection and enforcement group
Field Fisher Waterhouse
www.ffw.com
<http://intellectualpropertyblog.ffw.com/>