

CTM Genuine Use Requirements and International Registrations?

By Jeremy Pennant, D Young & Co LLP, United Kingdom

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This decision of the Court of Justice of the European Union (CJ) confirms that the proof of use requirements in Council Regulation (EC) No 207/2009 on the Community trade mark (CTMR) apply to international registrations and, in addition, any bilateral convention about the equivalence of protection between two countries cannot apply or affect the autonomous nature of the Community trade mark (CTM) system.

Baskaya sought registration of their mark as a CTM. It was opposed by Rivella, the owner of the international registration which extended to Germany plus some other European Union (EU) territories for “beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages” (in class 32).

Leaving aside the highly questionable chances of a successful opposition based purely on a comparison of the marks, the applicant sought proof of use. The opponent submitted a number of documents as proof of use in Switzerland, but nowhere else.

It relied, in that regard, on Article 5 of the convention between Switzerland and Germany on the reciprocal protection of patents, designs and trademarks signed in Berlin on 13 April 1892 (the 1892 Convention) (which allows for the reciprocal protection of intellectual property rights between Germany and Switzerland). Under that convention, use in Switzerland is equivalent to use in Germany.

The Office for Harmonization in the Internal Market (OHIM) rejected the notion that the 1892 Convention could apply. So did the Board of Appeal and also the General Court (GC). The GC confirmed that proof of use could be required of international registrations on which an opposition is based.

The opponent appealed to the Court of Justice of the European Union (CJ) claiming that:

1. International registrations are not covered by the proof of use provisions;
2. nationally registered marks are governed exclusively by national law; and
3. the unitary character of a CTM is not absolute and therefore registration could be prevented by way of the 1892 Convention.

The CJ gave short shrift to all three grounds confirming, in relation to the second, that the CTM system is autonomous and has its own set of rules and objectives.

For more information, please contact:



Jeremy Pennant
Trade Mark Attorney and Partner
D Young & Co LLP
jbp@dyoung.com / www.dyoung.com

Jeremy has been practising in the field of trade marks and passing off since 1985. Jeremy's clients range from small entrepreneurial start-ups to multinational blue chip companies. He has extensive experience in many sectors including beverages, hotels, boats, charities, petroleum, chemicals, pharmaceuticals and medical equipment, aviation, courier services, film, television, music, sports teams and vehicle manufacturers. Jeremy was one of the original Independent Experts appointed by Nominet to adjudicate on domain name disputes in the UK. Jeremy has spoken and lectured extensively, not only in Europe, but also in the US and the Far East. Much of Jeremy's practice relates to the enforcement of clients' rights. Jeremy is a qualified Trade Mark & Design Litigator.