

11/2008

TRADEMARK PROTECTION, ECJ RULING

On 27 November 2008 the European Court of Justice (ECJ) handed down a decision interpreting article 4(4)(a) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Members States relating to trade marks, with respect to the possibility of protection of reputable trademarks.

Said ruling was passed in case C-252/07, based on an application filed by the Court of Appeal (England & Wales), Civil Division, for a decision under article 234 of the EC Treaty (prejudicial question).

The Court of Appeal considered the case for invalidation of INTEL MARK mark (registered in the UK for marketing and telecommunication services by CPM United Kingdom Ltd.), instigated upon an application of Intel Corporation which argued that the use of the trademark leads to deriving unfair advantage from the distinctive nature and reputation of the earlier trademark INTEL (registered mainly for computer and computer-related goods and services), or is detrimental to Intel Corporation.

The case was based on domestic law originating in the provisions of article 4 (4)(a) of the Council Directive 89/104/EEC concerning the possibility of invalidation of a trade mark that is identical with, or similar to, an earlier reputable trade mark registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trade mark¹.

In the said ruling, ECJ provided guidance as to the required similarity, and held that if the fact that the later mark is linked, in the mind of the average consumer, reasonably well informed and reasonably observant and circumspect, to the earlier mark is proven, then the existence of a link between the marks is established. So far it was unclear how to interpret the 'link' between the two trademarks as mentioned in the Community rulings.

Moreover, ECJ, in accordance with the prejudicial question, specified the requirements for acknowledging that the use of the later trademark may take unfair advantage or be detrimental to the distinctive character or the repute of the earlier trade mark. The ECJ was of the opinion 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 of the*

¹ In Polish law the legal basis for affording protection for a trademark using the repute of a previously registered trademark was established under article 132 (2) (2) of the Industrial Property Law of 30 June 2000



goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

Additionally, ECJ held, *inter alia*, that the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of Directive 89/104.

Said ruling will significantly influence the ruling practice in the Member States, including Poland. The claimants seeking to invalidate a protection right for a trademark will have to adduce evidence demonstrating change or serious likelihood of change of the consumer's economic behaviour as a result of the use of such mark. Indication of circumstances whereby the later trademark, used for goods and services related thereto, is linked in the mind of the average consumer to the earlier reputable mark will not be sufficient.

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We hope the above information proves useful. It should not be construed as legal advice or opinion. If you wish to obtain further information or legal advice, please do not hesitate to contact us.

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