

Court of Justice of the European Union (CJEU) Confirms Autonomy of Community Trade Mark (CTM) System

Article By:

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In **Rivella International v OHIM** [2013] C-445/12 P, the **Court of Justice of the European Union (CJEU)** has upheld a decision by the EU General Court that, in **Community Trade Mark (CTM)** opposition proceedings, the genuine use of a defensive national trade mark must be assessed exclusively and exhaustively in accordance with CTM law.

BACKGROUND

In 2007, Italian company Baskaya di Baskaya Alim e C. Sas applied for a figurative CTM featuring the word element BASKAYA in relation to food products in Class 29 and beers and non-alcoholic beverages in Class 32. In 2008, Swiss-based Rivella-International AG filed an opposition against this application based on an earlier international figurative mark including the word mark “Passaia” in Class 32, designating Austria, the Benelux countries, France, Germany and Italy.

Baskaya asked Rivella to provide proof of use. Rivella only maintained the opposition in respect of having earlier rights in Germany. Rivella then submitted proof that it had used “Passaia” in Switzerland and invoked Article 5 of the Swiss-German Convention concerning the mutual protection of patents, designs and trade marks (the Convention), arguing that use of a trade mark in Switzerland is considered equivalent to use in Germany pursuant to Article 5 of the Convention.

The Opposition Division of the Office of Harmonization (OHIM) for the Internal Market dismissed Rivella’s opposition, holding that “Passaia” had not been put to genuine use in a Member State and that the Convention did not affect CTM law. Rivella’s subsequent appeal was dismissed by OHIM’s Board of Appeal and Rivella appealed to the General Court. The General Court dismissed Rivella’s action and upheld the OHIM Board of Appeal’s decision.

DECISION

Rivella appealed to the CJEU, arguing that the General Court had erroneously applied the criteria for genuine use pursuant to Article 42(2),(3) of CTM Regulation No 207/2009 to Rivella’s international registration of “Passaia”, as Article 42 did not apply to international registrations.

In any event, Ravella argued, the General Court had erroneously found that the German part of

Rivella's international registration of "Passaia" had not been put to genuine use in a Member State as, in accordance with the Convention, Rivella's use of "Passaia" in Switzerland was equivalent to use of "Passaia" in Germany.

The CJEU rejected Rivella's appeal and upheld the General Court's decision. The CJEU dismissed Rivella's primary argument, finding that, pursuant to Article 42(3) in conjunction with Article 8(2)(a)(iii) of the CTM Regulation, Article 42(2) was applicable to international trade mark registrations that have effect in a Member State. Although Article 43(3) expressly mentions "national trade marks", its general reference to Article 8(2)(a) encompassed all forms of trade marks. Consequently, the German part of Rivella's international registration of "Passaia" would have had to have been put to genuine use in a Member State in order to be an eligible, defensive trade mark for the purposes of Rivella's opposition.

The CJEU also found that Rivella's use of "Passaia" in Switzerland did not constitute use or equivalent use in a Member State pursuant to Article 42(2) of the CTM Regulation. In an earlier decision, the CJEU had held that the national concept of a defensive trade mark under which an earlier trade mark was protected on the basis of national law, even if its use could not be established, could not be used to oppose the registration of a CTM. The CJEU found in this instance that if the autonomous CTM system referred to national trade mark law, it only did so to the extent that the national law was itself harmonised by CTM law.

The General Court had therefore correctly decided that the concept of use of a CTM in the European Union was exhaustively and exclusively governed by CTM law. Any legal protection the German part of the international registration of "Passaia" might have had pursuant to the Convention was irrelevant for assessing genuine use under Article 42(2) of the CTM Regulation.

COMMENT

The case illustrates the importance of carefully considering which prior rights to rely upon in opposition proceedings. This is particularly true where such rights are potentially vulnerable to cancellation for non-use and the opponent does not have sufficient evidence to establish proof of use in the relevant territory.

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National Law Review, Volume IV, Number 77

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