

# ECJ clarifies position on use of mark in different form

The Court of Justice of the European Union (ECJ) has confirmed that use of a trademark in a form that is different from the mark as registered is sufficient to prove genuine use if the differing elements do not alter the distinctive character of the mark, even if that mark itself is registered.

In *Rintisch v Eder* (Case C-553/11), a reference for a preliminary ruling from the German Federal Court of Justice, the ECJ considered the interpretation of Article 10 of the EU First Trademarks Directive (89/104/EEC). Bernhard Rintisch owned the German registrations for PROTIPLUS, PROTI POWER and PROTI. Klaus Eder owned a later German registration for PROTIFIT. Rintisch brought an action seeking cancellation of the PROTIFIT mark and prohibition of use of that mark, relying on the rights deriving

from his earlier marks. He based his claims mainly on his earlier PROTI mark and, alternatively, on the PROTIPLUS and PROTI POWER marks. As Rintisch's earlier marks had been registered for over five years, he was required to prove use of those marks. Rintisch argued that he had put the trademarks PROTIPLUS and PROTI POWER to genuine use during the relevant period. However, Eder claimed that Rintisch had failed to use the PROTI mark.

The German court referred questions to the ECJ for a preliminary ruling, seeking to ascertain whether use of PROTIPLUS and PROTI POWER could be regarded as genuine use of the PROTI mark, even though PROTI was also registered.

The ECJ found that, under Article 10(2)(a) of the directive, "the proprietor of a registered trademark is not precluded from relying, in order to establish use of the trademark...

on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trademark, even though that different form is itself registered as a trademark".

The ECJ referred to its decision in *Il Ponte Finanziaria v OHIM* (Case C-234/06 P), in which it held that "it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trademark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former". However, it clarified that the findings in that case should be understood within the context of a claim that there was a 'family' of trademarks.

The ECJ further held that Article 10(2)(a) should be interpreted as "precluding an

interpretation of the national provision intended to transpose it into domestic law whereby Article 10(2)(a) does not apply to a 'defensive' trademark which is registered only in order to secure or expand the protection of another registered trademark that is registered in the form in which it is used".

According to Georgina Harris of Field Fisher Waterhouse LLP, the decision offers some comfort for brand owners that have updated their portfolio of trademarks: provided that they are using a mark which does not substantially alter the distinctive character of the registered mark, this will be sufficient to demonstrate use. The decision also reminds brand owners that they should keep accurate records of use of their trademarks and consider refiling where trademarks are being used in a way that alters their distinctive character. Finally, Harris points out that the decision may "open the door to the registration of close variations of a mark for defensive purposes, since such registrations may now be supportable by use of the primary mark".