New impulse for non-use cases in Lithuania

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The Supreme Court of Lithuania on 7 February, 2011 in civil case No. 3K-3-36/2011 adopted the new ruling in very rare non-use cases. The court have not adopted the final decision in this case, however the rules that have been formulated will have very significant impact to the same case as far as to other future cases.

The defendant, Zentiva k.s. as the subject of counter claim has sought to cancel registration of the plaintiff's DAIICHI SANKYO COMPANY, LIMITED trademark MESAR No. 44280 for the part of goods in class 5. The marks has been registered more than 5 years ago for „pharmaceutical preparations; dietetic substances (for medical use)", however it has been discovered that it has been used for the particular medicine, namely „antihypertonics with active substance olmesartanum". Also it was obvious that the mark has not been used for "dietetic substances (for medical use) "at all.

The court of the first instance – Vilnius regional court - and the Lithuanian court of appeals have dismissed the counter claim by indicating that the defendant has no interest to request the cancellation of the plaintiff's mark for "dietetic substances (for medical use)" because the claim against defendant's mark has not been based on the earlier mark's registration covering these goods. These courts have also decided that it is not allowed to limit the category „pharmaceutical preparations" on the basis of the purpose of the medicine and it's active substance.

The Supreme Court of Lithuania has reversed the decisions of the lower courts and returned the case in this part for re-examination to the court of the first instance.

The Supreme Court has ruled out that the Law on Trademarks does not require that the trademark cancellation action due to non-use should be filed by the interested person only. Of course, the right to apply to the court needs to be supported by the certain interest in the procedure, however this does not mean that the plaintiff in such case must prove any earlier right.

As regards the cancelation of the registration of the mark for the wide category of goods by leaving trademark registration valid for the particular sub-category, the Supreme Court of Lithuania agreed with arguments of the plaintiff, based on the case-law of The Court of the First Instance of EU (cases No. T—126/03, T-256/04). As already mentioned, the evidences filed in the case showed the use of the plaintiff's mark for „antihypertonics with active substance olmesartanum"only and there were no dispute as regards the nature of the use of the mark. However the lower courts did not examine this circumstances in essence, therefore the Supreme Court of Lithuania was unable to evaluate whether such limitation of the list of goods on the basis of the purpose of the medicine and it's active substance corresponds to the rules formulated by the case of ECJ and is correct.

The Supreme Court of Lithuania has also made the reference to the earlier case No. 3K-3-391/2010 examined by the court where it has been stated that the use of the mark for the particular goods does not prove the use of the mark for all other goods and if the mark is registered for the wide enough category of goods which could be divided into separate –sub-categories, the use of the mark may cover only one of such sub-categories. However if the list of goods is described as precisely and properly so that it would be impossible to exclude separate sub-categories, the proof of use would be applied for all such goods.

Therefore this ruling of the Supreme Court of Lithuania has finally explained that the cancellation of trademark registration due to non-use should not be limited to the verification of the use of the mark for the exact list of goods for the marking of which the mark has been registered.

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