

ECJ rules on earlier rights based on day and hour

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Summary: *On March 22, 2012, the ECJ gave its ruling on the time factors to consider for assessing if a trademark predates or not another trademarks. Indeed, for the Court only the day of filing is to be taken into account and not the hour and minutes when a trademark the application was filed.*

On March 22, 2012, in Case C-190/10, the ECJ upheld that the date of filing of a Community trademark application (CTM) only implies the day of filing but not the hour and minutes relating thereto. For the ECJ, the European Union law precludes the hour and minutes of filing of a CTM from being taken into account also under national law when assessing whether that CTM has priority over a national trademark even if the national law governing that national trademark considers the hours and minutes to be relevant in that regards.

On December 12, 2003, at 11:52 am, Génésis electronically filed one CTM application for RIZO in classes 16, 28, 35 and 36 and, on the same day, at 12:13 pm, a CTM application for RIZO, EL ERIZO in classes 16, 35 and 36. The same day, at 5:45 pm, Pool Angel Tomas SL filed a national trademark application for RIZO'S in class 28 at the Spanish Trademark Office. Génésis filed an opposition against the Spanish trademark on the basis of its two CTM applications.

The Spanish Trademark Office rejected the opposition by upholding that the date of filing of the CTM applications was the day when the application was completed at the OHIM, namely on January 7, 2004. Génésis appealed. The Court confirmed the decision. Génésis then went before the Tribunal Supremo and challenged that the date of filing of the CTM applications was the date of transmission and of reception by the OHIM, namely on December 12, 2003.

The Tribunal decided to stay the proceeding and asked for a preliminary ruling of the ECJ on whether Article 27 of Community Regulation No 40/94 enabled to take into account the day and also the hour and minutes of filing of a CTM application for establishing temporal priority over a national trademark application filed on the same day where the national legislation governing that national trademark considers the time of filing as being of relevance.

The position of the ECJ shows that the European harmonization still encounters difficulties towards the various national rules which still apply on some particular aspects. It also leads to wonder how to solve the conflict and priority aspects between two CTMs or between one national trademark and one CTM which would be filed on the same day. If the hour and minutes are useless, the trademark rights might have to coexist, as it is the practice in some member states.

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