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LAGUIOLE: national law in EUIPO proceedings – full review of legality by General Court

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On 5 April 2017, the Court of Justice handed down its judgment in the EUIPO vs. Gilbert Szajner matter (C-598/14 P), also known as LAGUIOLE – the EUTM that was at issue. The case concerns an opposition based on the French business name Forge de Laguiole. The use and, in principle, protection of the business name and its similarity with the EUTM LAGUIOLE were not in dispute. The core of the matter was, rather, the scope of protection of the business name under French law, namely, whether it enjoyed protection for all of the "objects" for which the company was registered, or whether the protection was confined to the business areas in which Forge de Laguiole had actually engaged.

The Board of Appeal had interpreted the national law in the broader sense. After the Board's decision, however, the French Supreme Court issued a judgment whereby French trade names are protected only in respect of the actual business activities. Based on this judgment, the General Court annulled the Board of Appeal's decision, holding that it was based on an erroneous interpretation of the national law.

EUIPO appealed, arguing that the General Court could not annul a Board decision based on facts that came to light only after it. The legality of the decision was to be judged on the basis of the situation as it was before the Board. A later national judgment that changed the interpretation of national law could not, as such, have an impact on the legality of the Board's decision.

The CJEU did not agree with this, holding that the General Court has jurisdiction to conduct a full review of EUIPO's assessment of the national law. This includes potentially filling the "*lacunae in the documents submitted*" by the parties, to confirm "*the content, the conditions of application and the scope of the rules of law relied upon*" (para. 37, 38). Moreover, the General Court must base its assessment on the correct interpretation given to the national law by the competent national courts at the time of its decision. It can therefore also take into account "*an evolution in the interpretation*" of national law (para. 45).

This author considers that the exact scope of protection under national law would not have needed to be resolved as the restriction to the actual use of the earlier trade name could have been based on Article 8(4) EUTMR itself. This requires use of the

sign in the course of trade of more than mere local significance, and the scope of this use must be taken into account. However, the Board had also judged the actual use of Forge de Laguiole to be broader than the General Court was able to confirm, and the appeal only concerned the question whether the General Court could take into account the more recent French judgment.

Is this judgment one step further in the direction of lifting the burden of proof off opponents or invalidity applicants to substantiate the national law relied upon? The judgment certainly confirms once again the capacity – and to an extent obligation – of the EUIPO to examine the national law of its own motion by taking into account what is available to it in order to ensure a correct interpretation. That said, the initial burden to properly indicate and substantiate the national law that is invoked continues to be on the opponent or invalidity applicant. This is reinforced by the new Delegated Regulation, which, in Article 7(2)(d), obliges opponents to provide "evidence of […] acquisition, continued existence and scope of protection including, where the earlier right is invoked pursuant to the law of a Member State, a *clear identification of the contents of the national law relied upon by adducing publications of the relevant provisions or jurisprudence*". This enters into force on 1 October 2017. Opponents and invalidity applicants before the EUIPO are therefore best advised to argue their case in full, including the national law relied upon.

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This entry was posted on Thursday, June 15th, 2017 at 4:17 pm and is filed under Article 8(4) EUTMR, Domain name, LAGUIOLE, National law, Opposition, A sign which is used to indicate the origin of goods and services can be said to be used in the course of trade and in many countries that use will generate unregistered rights in the sign.">Sign used in the course of trade, Trade name
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