

Stung by the CACTUS - the CJEU strikes twice



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The CJEU judgment of 11 October 2017 in the CACTUS matter (C-501/15 P) surprised twofold: first, the CJ held that EUTMs from before July 2005 that covered all class headings in class 35 automatically covered “retail services for any goods”, and then, it considered the use of the cactus device alone as genuine use of the registered trademark containing both the device and the word “Cactus”:

Mark as registered	Mark as used - an “abbreviation”
	

With respect to “retail store services”, the Court firstly confirmed that its judgment in **IP TRANSLATOR** (rendered on 19 June 2012, C-307/10) had **no retroactive effect** for EUTM applications and registrations pre-dating it. Stated more clearly, this means that “pre-IP TRANSLATOR” EUTMs designating full class headings were to be seen as continuing to cover the entire class and not only those goods or services that fall under the literal meaning of the general indications. While the CJEU had already stated the same in Brandconcern (LAMBRETTA - Case C-577/14), one might have expected it to at least address the fact that the entire legal community including the EUIPO and the EU Legislator (Commission, Parliament and Council of Ministers) understood that differently, which led to the adoption of Article 28(8) EUTMR (now, after re-codification: 33(8)), allowing owners of pre-IP-TRANSLATOR EUTMs to declare before 24 September 2016 that their trademark was meant to cover also goods or services not covered by the literal meaning of

the general indications. At hindsight, this – and the resulting hype among some parts of the EUTM community – would have been superfluous.

Secondly, the CJEU stated that pre-IP TRANSLATOR EUTMs covering **full class headings** were **not limited to the Alphabetical List** of the Nice Classification in the class in question, but extended to all goods or services. That is new.

Thirdly, with a view, specifically, to retail services in Class 35, the CJEU held that **EUTMs that pre-dated the PRAKTIKER judgment** of 7 July 2005 (C-418/02), and covered the full class headings in class 35, automatically extended to **“retail services for any goods”**. For recollection, in PRAKTIKER, the CJEU stated that trademark applications could cover retail services *provided* these referred to specific goods or types of goods. Again, the CJEU considered that that judgment had no retroactive effect. As a result, the CACTUS EUTMs filed in 1998 and registered in April 2001 and October 2002, respectively, which covered the full class heading of class 35, were confirmed to cover also retail services. This was based on “legitimate expectations” of trademark applicants. That is particularly interesting because, *in 1998*, when the CACTUS marks were filed, the EUIPO (OHIM as it was) *Examination Guidelines expressly excluded retail services*, as did the Explanatory Notes in the Nice Classification. It was not until March 2001 that the Office decided to change its mind and allow retail services (without further specification) – Communication 3/01. And OHIM’s Communication 4/03 of June 2003, whereby trademark applications that covered full class headings were to be understood as covering all goods and services, post-dated both the application and registration dates for the CACTUS mark, making the contention of “legitimate expectations” particularly questionable in this case.

The second – similarly as surprising – strand of the CACTUS judgment concerns the use of the registered mark in an altered form. To say that the distinctive character of the cactus device *per se* is the same as that of the device combined with the word “Cactus” because it has the same “semantic content” and is an “abbreviated form” is something that most experienced trademark practitioners would likely have seen (and expected) differently.

Coming back to the retail services – is there reason to rejoice for all owners of old EUTMs covering class headings in class 35 (and in other classes, for that matter)? In this author’s opinion, there is not, as now, Article 33(5) EUTMR clearly provides that EUTMs cover only the literal meaning of the goods and services in the

specification. There is, therefore, legislation in force that leads to a different result and does not differentiate between old and new EUTMs. The CJEU judgment was based on the old law. Do readers see this the same way?