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“Burlington Arcade vs. Burlington” – ECJ provides guidance as to the applicability of the “Praktiker” decision on trademarks registered before the decision

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Last year, the European Court of Justice (ECJ) took a decision clarifying the effects of the “Praktiker” decision on trademarks registered for “retail services” without further specifications in class 35 before the date of that judgement’s delivery in 2005.

Regarding the background of the case, the German company Burlington Fashion GmbH, well-known for their argyle socks, filed International trademark applications with protection in the EU for the figurative marks “BURLINGTON” in classes 3, 14, 18 and 25 (including footwear, clothing, headgear and belts) as depicted in the following:



These applications were opposed by the UK company Tulliallan Burlington Ltd, the owner of the luxury Burlington Arcade shopping arcade in central London. The oppositions were based on Tulliallan’s earlier UK trademark registrations for the word “BURLINGTON” and on UK and EU trademark registrations for “BURLINGTON ARCADE” (figurative marks) as shown below:



The opposition marks were *inter alia* registered in class 35 for the services “the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase

those goods from a range of general merchandise retail stores”.

The decisions of the Opposition Division upholding the oppositions in respect of the contested goods were appealed by Burlington Fashion GmbH and ended several years and instances later before the ECJ.

The central question in the different instances was inter alia whether this broad wording of retail services registered in class 35 for the trademarks of Tulli Allan Burlington Ltd was considered to be similar to the goods registered for the trademark applications in the name of Burlington Fashion GmbH.

The General Court referred to the well-known judgement “*Praktiker*” of the ECJ of July 7, 2005 (C-418/02 – *Praktiker Bau- und Heimwerkermärkte*, ECLI:EU:C:2005:425). It found that since the “*Praktiker*” judgement it has been established case law that in the case of retail services in class 35, the goods offered must be precisely specified, otherwise no similarity of goods and services can be established.

Since Tulli Allan’s earlier marks do not contain any precise indication of the goods offered for sale by the shopping retail services, the General Court was of the opinion that this precludes any link between those shops and the goods covered by the contested marks of Burlington Fashion GmbH. Accordingly, a similarity of goods and services and consequently a likelihood of confusion was denied.

Contrary to this view, the ECJ decided that the General Court should not have referred to the 2005 judgement because the case only concerns trademark applications and does not concern the protection of trademarks registered at the date of the judgment’s delivery. Tulli Allan’s earlier UK marks were registered *before* the date of delivery of the “*Praktiker*” judgement, namely in 2003, and were therefore not covered by the obligation arising from that judgement. This consideration was based on the generally accepted principle of non-retroactivity of laws.

The ECJ further ruled that it cannot be inferred from the “*Praktiker*” judgment that a lack of clarity and unambiguity in the indication of the goods and services entails legal consequences. This finding would have to apply, inter alia, because the proprietor of an earlier mark must be able to exercise its right to oppose a later trademark application without the opposition failing merely because of the lack of precise information on the goods. Any other result would be contradictory, since otherwise a registered trademark would be precluded from being relied upon in opposition and would be consequently denied any distinctive character, even though it has not been declared invalid.

Moreover, according to the ECJ, even by requesting proof of genuine use of the earlier mark, it is possible to identify the exact goods covered by the services for which the earlier mark has been used and to take only those goods into account in the examination of the opposition.

The judgment of the ECJ in favour of Tulli Allan Burlington is a complete defeat of Burlington Fashion GmbH. The decision provides welcome clarifications inter alia on the effects of trademarks registered for retail services without further specifications in class 35 before the “*Praktiker*” decision.

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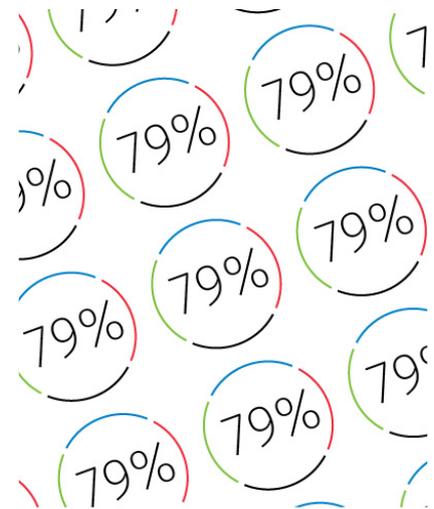
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