


Kluwer Trademark Blog

CTM with a reputation: CJEU provides guidance on the relevant geographical territory and public for establishing both reputation and infringement

Katharina Schmid (schmid-ip) · Wednesday, December 16th, 2015

For those who have been wondering ever since the PAGO International ruling (C-301/07) if the owner of a CTM with a (proven) reputation in one or a few member states can also enforce it as a „mark with a reputation“ in other member states, the CJEU has now provided clarification in its judgment of 3 September 2015, in case C-125/14 – Iron & Smith kft v. Unilever NV: The answer is: maybe...

In PAGO, the CJEU had stated that a CTM that was known to a substantial part of the relevant public in the EU, which could be a single member state, had a reputation “in the Community”, which is the relevant requirement for CTMs. The question had remained open whether this then entitled the CTM owner to full reputation protection against dilution, misappropriation and tarnishment across the EU. The Budapest Municipal Court, who had to decide on an opposition by Unilever based on its trade mark “Impulse” against Iron & Smith’s application for “be impulsive”, asked the CJEU for guidance. The Hungarian trade mark office had granted Unilever’s claims of dilution on the ground that reputation had been shown to exist in a substantial part of the European Union (UK and Italy). The Budapest Municipal Court wanted to disagree but the question whether the place within the EU where reputation exists, and the place where the infringement occurs, have to be the same or at least overlap, had not been addressed by the CJEU. So it referred the matter to Luxembourg.

 The CJEU held that, in a situation as the one described above, the CTM owner may benefit from the enhanced protection of a reputed mark against a later national trademark registration where it is shown that a commercially significant part of the public in the state where the application was filed is familiar with the earlier mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to the later mark or a serious risk that such injury may occur in the future.

The CJEU considered that if the earlier mark is unknown to the public in the relevant member state, in which registration of the later national mark has been applied for (para 29), the use of that national mark, is, in principle, not liable to cause misappropriation, dilution or tarnishment (see para 29, in connection with para 28). This makes sense in that it is difficult for a reputation to suffer detriment or to be taken advantage of where it does not exist at all

However, and this is the interesting twist of this case, where the earlier Community trade mark is

not known to a substantial part of the relevant public, but still a commercially significant part of the latter is familiar with it, it is conceivable that that public would make a connection between that mark and the later national mark, leading to one of the injuries against which European trade mark law protects owners of reputed marks.

We are eagerly awaiting cases of national courts and trade mark offices dealing with the criterion of a „commercially significant part“ of the national public, and, eventually, further references on this point to the CJEU.

To make sure you do not miss out on regular updates from the Kluwer Trademark Blog, please subscribe [here](#).

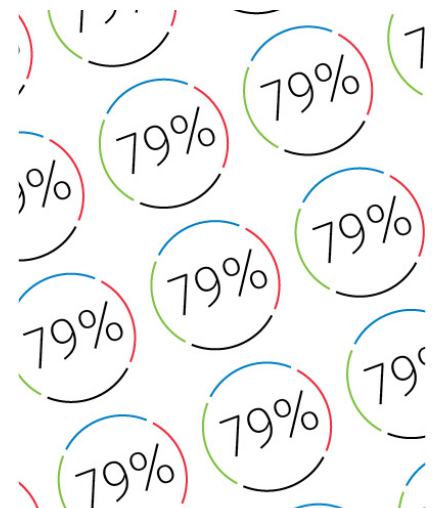
Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.
The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

Experience how the renewed **Manual IP** enables you to work more efficiently



[Learn more →](#)



This entry was posted on Wednesday, December 16th, 2015 at 10:10 am and is filed under [CJEU](#), [The EU is an economic and political association of certain European countries as a unit with internal free trade and common external tariffs.](#) [">European Union, EUTM](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.