

Role of national judgements in the context of recent case law of the Court of Justice of the European Union

T – 96/13 - the Macka case

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The case T-96/13 (ECLI EU:T:2015:813)

Opposition

Macka



Application for goods class 29,30

Unregistered mark used in course of trade
of more than mere local significance

Definition of relevant public decisive

- relevant public = entirety of the German population?
- relevant public = solely Russian-speaking consumers?

Reference to decisions and academic texts admissible

- Applicant is entitled to submit documents and arguments relating to national legislation and the national courts' judicial practice before the Court
- According to case-law neither the parties nor the Court can be precluded from drawing on national legislation, case-law or academic writing when applying a provision of national law

What must be taken into consideration?

- the question of the extent to which a national sign confers the right to prohibit the use of a subsequent trade mark must be examined in the light of the applicable national law, and not in the light of the case-law of the Court concerning the application of Regulation No 207/2009
- account must be taken of the national legislation relied on and the judicial decisions delivered in the Member State concerned

Who has to provide information on the national law?

- opponent must establish
 - that the earlier sign relied on falls within the scope of the law of the Member State
 - and allows use of a subsequent mark to be prohibited
- opponent bears the burden of providing
 - particulars showing that he satisfies the necessary conditions, in accordance with the national law
 - particulars establishing the content of that law

Who has to provide information on the national law?

- EUIPO, of its own motion and by whatever means considered appropriate, must obtain information about that national law
- Accordingly EUIPO must take into consideration, in addition to the facts which have been expressly put forward by the parties, facts which are likely to be known by anyone or which may be learnt from generally accessible sources

Who has to provide information on the national law?

- EUIPO is under an obligation to obtain, of its own motion, information about national law where it already has before it information relating to national law, either in the form of claims as to its content, or in the form of evidence submitted and whose probative value has been claimed

Who has to provide information on the national law?

EUIPO should

- use all means available to it in order to obtain information about the applicable national law
- carry out further research into the wording and scope of the provisions of national law
 - either of its own motion or
 - by inviting the applicant to corroborate its claims

German Law and Jurisprudence

Judgement of the Bundespatentgericht (Federal Patent Court) **Берёзка (28 W (pat) 40/10)**:

- the relevant public for goods may be confined to consumers with knowledge of the Russian language, having regard in particular to the presentation, the packaging and the name of the goods referred to in Cyrillic letters.