

The Community Trade Mark (CTM) system creates a uniform registration system in Europe, which provides protection throughout all EU Member States. Once the CTM is registered, it must actually be used, otherwise registration could cease to have effect. In particular, if within a period of 5 years following the date of registration, the trademark has not been put to “genuine use” for the goods and services covered under registration, in the absence of valid reasons for no use, the trademark could be revoked.

Until the case C-149/11 of the Court of Justice of the European Union (ECJ) of 19 December 2012, the interpretation of “genuine use” with respect to a defined territorial area maintained that the use of a trademark in a single Member State was sufficient to constitute “genuine use” of the trademark within the EU.

The case C-149/11 provides that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been or not put to “genuine use” in the EU. According to the judgment, a CTM is put to “genuine use” when it is used in accordance with its essential function and for the purpose of maintaining or creating a market share within the Community for the goods or services covered by it. Further, the determination of that will be assessed on a case-by-case basis, taking into account all the relevant facts and circumstances, including the “characteristics of the market” concerned, the “nature of the goods or services” protected by the trademark, the “territorial extent” and the “scale of the use”, as well as its “frequency and regularity”.

The ECJ judgment C-149/11 brings about legal uncertainty. The development of case law, in the forthcoming years, will potentially establish the elements required for “genuine use” in the EU.