

# Trade marks becoming common names

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## **Article 12(2)a Directive 2008/95/EC („Trade Mark Directive“)**

„A trade mark shall be liable to revocation if, after the date on which it was registered in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered.“

- **Objective characteristics** = trade mark becoming a common name in the trade for a product or service in respect of which it is registered
- **Subjective characteristics** = acts or inactivity of the trade mark proprietor

## Objective Characteristics: Relevant Public (I)

- End users/consumers vs. those in the trade that deal with the product commercially
- **ECJ** – contrary to wording of the provision („in the trade“) and relevant case-law in most Member States – **focuses on understanding of end users/consumers** (see ECJ, 29 April 2004, C-371/02 – *Björnekulla Fruktindustrier*, Opinion of Advocate General, 12 September 2013, C-409/12 – *Kornspitz*)

## Objective Characteristics: Relevant Public (II)

- **Risk:** end users/consumers often tend to use (especially well-known) marks as terms for the products (e.g. FRISBEE [CTM 2995231] for toy flying saucers for toss games; SELLOTAPE [CTM 543256] for adhesive tapes; CARTE BLEUE [CTM 2387736] for payment cards or cash cards; JEEP [CTM 188185] for vehicles; JACUZZI [UK 2464129] for hot tubs and whirlpool tubs; TEMPO [DE 407752] for paper tissues)
- **Possible result:** artificial facilitation of revocation of (often well-known) trade marks, which – being intellectual property – enjoy fundamental rights protection

## Objective Characteristics: Other Issues

- **Which part/percentage of the relevant public has to perceive a trade mark as a common name for a product/service?** Means of assessment of the relevant public's understanding?
- **Time of assessment** (time of revocation request vs. time of last oral hearing/decision)?

## Subjective Characteristics

- **Which kind of activities may reasonably be expected from a trade mark proprietor** (e.g. taking into account economic possibilities of trade mark proprietor [SMEs vs. global corporations]; transfer of trade mark proprietor's duty to act on licensees and monitoring of licensee's obligations by trade mark proprietor)?

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Thank you for your attention!