

Case T-136/11 pelicantravel.com s.r.o. v OHIM (with Pelikan Vertriebsgesellschaft mbH & Co. KG as an intervening party) – 13 December 2012

The General Court has confirmed a decision of OHIM's second Board of Appeal, in rejecting an appeal to overturn an unsuccessful application by pelicantravel.com (Appellant), to have one of Pelikan Vertriebsgesellschaft mbH & Co. KG's (Pelikan) Community trade marks (CTM) declared invalid on the grounds of bad faith pursuant to Article 52(1)(b) of CTM Regulation (207/2009/EC).

The Law

The Appellant relied on Article 52(1)(b) of the CTM Regulation, which states that a CTM shall be declared invalid on application to OHIM where the applicant for registration of the relevant CTM was acting in bad faith when it filed the application.

The CTMs

There were three CTMs relevant to the case. The contested CTM was a figurative representation of the word 'Pelikan' alongside an image of a pelican and a chick in a circle.

Two earlier CTMs were cited by the Appellant. They were almost identical to the contested CTM, although the font used and the figurative representation of the pelican and chicks differed and covered similar classes of goods and services.

The Case

The Appellant made three submissions demonstrating the bad faith of Pelikan. Each was rejected by the General Court. These submissions and the court's reasons for rejecting them can be summarised as follows:

1. The first submission was that the CTM was practically identical to two earlier CTMs owned by Pelikan, including one that had been revoked for non-use, and the Appellant alleged that Pelikan had only applied for the new CTM to prevent the loss of rights in the earlier CTMs. The General Court agreed that a repeat application for a revoked CTM registration, in respect of the same services, could potentially amount to bad faith. However, citing the European Court of Justice Cases C-529/07 (*Lindt*) and T-33/11 (*BIGAB*), the General Court held that although the CTM was very similar to the two earlier marks, there was insufficient evidence of bad faith and that it was normal for trade mark owners to file modernised versions of marks that had evolved over time, as was the case here, and that because the new CTM was for a narrower list of services and goods than the earlier marks, it was not a mere repeat application.
2. The Appellant's second submission was that because Pelikan could not have intended to use the CTM for all the services listed in the specification, together with the fact that Pelikan had not used the CTM for those services listed since the date of registration, it had acted in bad faith. Although the General Court agreed that the use of a mark is relevant in determining bad faith, it held that the court should only be interested in whether the applicant intended to use the CTM at the date of registration and should not be concerned with whether the applicant had used the CTM since that date. The General Court consequently rejected the submission, as there was insufficient evidence that Pelikan had not intended to use the CTM for the services listed in its specification at the date of registration. It added that acceptance of this submission would render void the five-year grace period granted under the CTM Regulation.
3. The third submission was that Pelikan's sole reason for registering the CTM in classes 35 and 39 was the dishonest intention of preventing other entities from engaging in activity in the European Union using the mark "PELIKAN". The Appellant used as evidence Pelikan's pending application in Slovakia to revoke the Appellant's Slovakian trade mark containing the word element "pelikan". Although the General Court did not find this evidence admissible, it noted that it did not prove that Pelikan had acted in bad faith when registering the CTM and added that Pelikan's applications to have the Appellant's trade marks declared invalid were entirely legitimate. As there was no other evidence supporting this submission it was rejected by the General Court.

Comment

The case reaffirms the factors listed in Case C-529/07 (*Lindt*) as relevant when determining whether an applicant has acted in bad faith when registering a CTM. However, citing Case T-33/11 (*BIGAB*), the General Court went on to add that the factors listed in *Lindt* are only examples of the factors that can be taken into account when assessing whether the applicant for registration of a CTM has acted in bad faith. The relevant factors will thus depend on the facts of the case.

The court's rejection of the Appellant's first submission highlights the ease with which companies and individuals can protect their trade marks by registering similar, new marks for classes of goods and services that differ only slightly from their earlier trade marks.

The case also demonstrates that, unless there is evidence to the contrary, the act of registering a CTM for new classes of goods and services will not on its own demonstrate bad faith.

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