



## Reports of Cases

### Cases T-537/10 and T-538/10

Ursula Adamowski

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

(Community trade mark — Invalidity proceedings — Community word mark Fagumit and Community figurative mark FAGUMIT — Earlier national figurative mark FAGUMIT — Relative ground for invalidity — Article 8(3) and Article 165(4)(b) of Regulation (EC) No 207/2009)

Summary — Judgment of the General Court (Second Chamber), 29 November 2012

1. *Community trade mark — Provisions relating to the enlargement of the Community — Community trade mark lodged or registered before 1 May 2004 — Declaration of invalidity cannot be made on the basis of an earlier national right registered, applied for or acquired in a new Member State prior to the date of accession — Aim*

*(Council Regulation No 207/2009, Art. 165(4)(b))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Absence of trade mark proprietor's consent to registration applied for by an agent or representative in his own name — Concept — Mark registered in a country outside the Union — Included*

*(Council Regulation No 207/2009, Art. 8(3))*

3. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Absence of trade mark proprietor's consent to registration applied for by an agent or representative in his own name — Aim*

*(Council Regulation No 207/2009, Art. 8(3))*

1. The purpose of Article 165(4)(b) of Regulation No 207/2009 on the Community trade mark is to exclude the possibility of a Community trade mark registered or filed before 1 May 2004 from being challenged solely on the basis of the accession of certain States to the European Union, when that possibility did not exist before that accession. The provision in question does not therefore seek to preclude the proprietor of a mark from making, after 1 May 2004, an application for a declaration of invalidity where it had been possible to do so before that date, such as an application on the basis of Article 53(1)(b) of that regulation.

(see para. 18)

2. The ground of invalidity laid down in Article 53(1)(b) of Regulation No 207/2009 on the Community trade mark may be relied on by the proprietor of the mark referred to in Article 8(3) of that regulation, even if that mark was registered only in a country outside the European Union. Unlike Article 8(1), (2), (4) and (5) of Regulation No 207/2009, Article 8(3) of that regulation does not refer to

marks registered in a Member State or having effect in such a State. Moreover, if registration of the mark in a Member State were a condition for the application of Article 8(3) of Regulation No 207/2009, that provision would overlap with Article 8(1) and (5).

(see para. 19)

3. The application of Article 8(3) of Regulation No 207/2009 on the Community trade mark requires the applicant for the mark to be or to have been the agent or representative of the proprietor of the mark and the application to have been filed in the name of the agent or representative without the proprietor's consent and without there being legitimate reasons to justify the agent's or representative's action. That provision is designed to prevent the misuse of a mark by the trade mark proprietor's agent, as the agent may exploit the knowledge and experience acquired during its business relationship with the proprietor and therefore improperly benefit from the effort and investment which the trade mark proprietor himself made. Consent for the purposes of the registration of the mark in the name of the representative or agent must be clear, specific and unconditional.

(see paras 22, 23)