



Reports of Cases

Case C-320/12

Malaysia Dairy Industries Pte. Ltd
v
Ankenævnet for Patenter og Varemærker

(Request for a preliminary ruling from the Højesteret)

(Approximation of laws — Directive 2008/95/EC — Article 4(4)(g) — Trade marks — Conditions for obtaining and continuing to hold a trade mark — Refusal of registration or invalidation — Concept of ‘bad faith’ of the applicant — Whether the applicant knows of the existence of a foreign mark)

Summary — Judgment of the Court (Fifth Chamber), 27 June 2013

1. *EU law — Interpretation — Provision making no express reference to the law of the Member States — Independent and uniform interpretation*
2. *Approximation of laws — Trade marks — Directive 2008/95 — Registration of a trade mark refused or trade mark declared invalid — Applicant in bad faith at the time of lodging the trade mark application — Concept of ‘bad faith’ — Independent and uniform interpretation*

(European Parliament and Council Directive 2008/95, Art. 4(4)(g))

3. *Approximation of laws — Trade marks — Directive 2008/95 — Registration of a trade mark refused or trade mark declared invalid — Applicant in bad faith at the time of lodging the trade mark application — Criteria for assessment — Taking into account of all relevant factors at the time of filing the application for registration — Applicant’s knowledge of the use by a third party of an identical or similar sign — Circumstance not sufficient to establish bad faith*

(European Parliament and Council Directive 2008/95, Art. 4(4)(g))

4. *Approximation of laws — Trade marks — Directive 2008/95 — Registration of a trade mark refused or trade mark declared invalid — Optional grounds for refusal or invalidity — Introduction, by the Member States, of a system of specific protection of foreign marks — Not permissible*

(European Parliament and Council Directive 2008/95, Art. 4(4)(g))

1. See the text of the decision.

(see para. 25)

2. It is common ground that the wording of Article 4(4)(g) of Directive 2008/95 relating to trade marks contains no definition of the concept of ‘bad faith’; nor is that concept defined in the other articles of that directive. Further, that provision makes no express reference to the law of the Member

States in respect of that concept. Accordingly, the meaning and scope of that concept must be determined in the light of the context of the provision concerned of Directive 2008/95 and the objective of that directive.

As regards the subject-matter and purpose of Directive 2008/95, whilst it is true that, according to recital 4 in the preamble to that directive, it does not appear to be necessary to undertake full-scale approximation of the trade mark laws of the Member States, the directive none the less provides for harmonisation in relation to substantive rules of central importance in this sphere, that is to say, according to the same recital, the rules concerning the provisions of national law which most directly affect the functioning of the internal market, and that recital does not preclude the harmonisation relating to those rules from being complete.

Moreover, the optional nature of a provision of Directive 2008/95 has no effect on whether a uniform interpretation must be given to the wording of that provision.

Consequently, Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that the concept of 'bad faith', within the meaning of that provision, is an autonomous concept of EU law which must be given a uniform interpretation in the European Union.

(see paras 26-29, operative part 1)

3. Article 4(4)(g) of Directive 2008/95 relating to trade marks must be interpreted as meaning that, in order to permit the conclusion that the person making the application for registration of a trade mark is acting in bad faith within the meaning of that provision, it is necessary to take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration. The fact that the person making the application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.

(see para. 37, operative part 2)

4. Although the grounds set out in Article 4(4) of Directive 2008/95 are listed as an option by the EU legislature, the fact remains that a Member State's latitude is limited to providing or not providing for that ground, as specifically delimited by the legislature, in its national law

Consequently, Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that it does not allow Member States to introduce a system of specific protection of foreign marks which differs from the system established by that provision and which is based on the fact that the person making the application for registration of a mark knew or should have known of a foreign mark.

(see paras 41, 43, operative part 3)