Reports of Cases

ORDER OF THE COURT (Third Chamber)

14 November 2013*

(Article 267 TFEU — Concept of 'court or tribunal' — Proceedings intended to lead to a decision of a judicial nature — Independence — Clear lack of jurisdiction of the Court)

In Case C-49/13,

REQUEST for a preliminary ruling under Article 267 TFEU from the Úřad průmyslového vlastnictví (Czech Republic), made by decision of 22 January 2013, received at the Court on 29 January 2013, in the proceedings

MF 7 a.s.

v

MAFRA a.s.,

THE COURT (Third Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, C.G. Fernlund, A. Ó Caoimh, C. Toader and E. Jarašiūnas, Judges,

Advocate General: P. Cruz Villalón,

Registrar: A. Calot Escobar,

having decided, after hearing the Advocate General, to give a decision by reasoned order, pursuant to Article 53(2) of the Rules of Procedure of the Court of Justice,

makes the following

Order

1 This request for a preliminary ruling concerns the interpretation of Article 3(2)(d) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2 The request has been made in proceedings between MF 7 a.s. ('MF 7') and MAFRA a.s. ('MAFRA') concerning an application, made by MF 7, for a declaration that the trade marks Mladá fronta DNES and MLADÁ FRONTA DNES owned by MAFRA are invalid.

* Language of the case: Czech.

Legal context

European Union law

3 Article 3(2)(d) of Directive 2008/95 states:

‘Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:

…

(d) the application for registration of the trade mark was made in bad faith by the applicant.’

Czech law

4 Article 3(2)(d) of Directive 2008/95 was transposed into Czech law by Paragraphs 4 and 32 of Law No 441/2003 on Trade Marks (zákon č. 441/2003 Sb., o ochranných známkách) of 3 December 2003.

5 Under Paragraph 4(m) of that law, a sign is not to be entered in the register where it is clear that the application for registration was made in bad faith.

6 Pursuant to Paragraph 32(1) of that law, the Úřad průmyslového vlastnictví (Industrial Property Office), in proceedings brought on the application of a third party or of its own motion, is to declare a trade mark invalid if it has been registered in breach of Paragraph 4.

The dispute in the main proceedings and the questions referred for a preliminary ruling

7 *Mladá fronta* is a daily newspaper published in the Czech Republic by the undertaking Mladá fronta since 1945. For the purposes of designating that publishing activity, the sign ‘Mladá fronta’ and the abbreviation ‘mf’ are used, even though neither of those signs was formally protected prior to 1991.

8 In 1990, [a company called] MaF a.s. (‘MaF’) was established by the members of the editorial board of the daily newspaper *Mladá fronta* and began to publish, that same year, the daily newspaper *Mladá fronta DNES*. On 31 August 1990 and 19 December 1990 respectively, two commercial contracts were concluded between the undertaking Mladá fronta and MaF, in which the conditions for the publication of the daily newspaper *Mladá fronta DNES* were established. MaF subsequently assigned its rights to publish that daily newspaper to MAFRA and the two abovementioned contracts were replaced by two contracts of 30 December 1991.

9 On 20 March 1991, Mladá fronta a.s., legal successor to the undertaking Mladá fronta, filed an application for registration of the national trade mark Mladá fronta, which was entered in the trade mark register on 28 July 1991 under the number 170613, for the publication of periodical and non-periodical newspapers, printed matter and printed business materials, the provision of advertising services and the creation of all kinds of advertisements and emergency printing, in Classes 16, 35 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

10 On 11 October 1991, MAFRA filed an application for registration of the national trade marks Mladá fronta DNES and MLADÁ FRONTA DNES, which were entered in the trade mark register on 17 February 1994 under the numbers 174995 and 174996, for newspapers, magazines, books, printed

matter, distribution, trade, sale, advertising, publicity, radio and television broadcasting services, agency and brokering activity, printing and computer services and public opinion polling, in Classes 16, 35, 38 and 41 of the Nice Agreement.

11 On 14 September 2012, the Úřad průmyslového vlastnictví received an application, made by MF 7, for a declaration that the trade marks Mladá fronta DNES and MLADÁ FRONTA DNES, owned by MAFRA, were invalid. In support of its application, MF 7 claimed that the applicant for the marks in question had not acted in good faith at the time of filing its application for registration, particularly with regard to the light of the existence over the sign 'Mladá fronta' of earlier rights [owned by] another operator, namely, Mladá fronta a.s.

12 In those circumstances, the Úřad průmyslového vlastnictví decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'1. Is Article 3(2)(d) of … Directive [2008/95] to be interpreted as meaning that, for the assessment of whether a trade mark applicant acted in good faith, only circumstances apparent before the date or on the date of the submission of the trade mark application are relevant, or can circumstances which occurred after the application was submitted also be used as supporting evidence of the fact that the applicant acted in good faith?

2. Is it necessary to apply the judgment [of 20 November 2001] in Joined Cases C-414/99 to C-416/99 [*Zino Davidoff and Levi Strauss* [2001] ECR I-8691] generally to all cases where it is being assessed whether a trade mark proprietor agreed to conduct which may result in weakening or limitation of his exclusive rights?

3. Is it possible to infer good faith on the part of an applicant for a later trade mark from the situation in which the proprietor of an earlier trade mark concluded agreements with it, on the basis of which that proprietor consented to the publication of periodical printed material whose designation was similar to mark applied for by the later trade mark applicant, agreed with the registration of that printed material by the applicant for a later trade mark and offered that applicant support in its publication, but the agreements concerned nevertheless did not expressly regulate the issue of the intellectual property right?

4. In so far as circumstances occurring after a trade mark application was submitted may also be relevant for the purposes of the assessment of whether the trade mark applicant acted in good faith, is it possible, in the alternative, to infer the fact that the applicant acted in good faith from the situation in which the proprietor of the earlier trade mark knowingly tolerated the existence of the contested trade mark for a period of at least ten years?'

The jurisdiction of the Court

13 Under Article 53(2) of the Rules of Procedure of the Court, where it is clear that the Court has no jurisdiction to hear and determine a case or where a request or an application is manifestly inadmissible, the Court may, after hearing the Advocate General, at any time decide to give a decision by reasoned order without taking further steps in the proceedings.

14 In the context of the present request for a preliminary ruling, it is appropriate to apply that provision.

15 According to settled case-law, in order to determine whether a body making a reference is a 'court or tribunal' for the purposes of Article 267 TFEU, which is a question governed by Union law alone, the Court takes account of a number of factors, such as whether the body is established by law, whether it is permanent, whether its jurisdiction is compulsory, whether its procedure is *inter partes*, whether it applies rules of law and whether it is independent (see, inter alia, Case C-54/96 *Dorsch Consult* [1997]

ECR I-4961, paragraph 23; Case C-53/03 *Syfait and Others* [2005] ECR I-4609, paragraph 29; Case C-246/05 *Häupl* [2007] ECR I-4673, paragraph 16; and Case C-394/11 *Belov* [2013] ECR, paragraph 38).

16 In particular, a national body cannot be regarded as a 'court or tribunal', for the purposes of Article 267 TFEU, in circumstances where it decides [matters before it] by performing non-judicial functions, such as functions of an administrative nature (see, to that effect, *Belov*, paragraph 40 and the case-law cited).

17 In a case such as that at issue in the main proceedings, the decision that the Úřad průmyslového vlastnictví is called upon to make is akin to a decision of an administrative type.

18 In this connection, it should be pointed out that under Paragraph 32(1) of Law No 441/2003, proceedings before the Úřad průmyslového vlastnictví for a declaration that a trade mark is invalid may be brought not only on the application of a third party, but also of that body's own motion, which suggests that that body is not a 'court or tribunal', but has the characteristics of an administrative body.

19 In addition, as is apparent from the written observations of the Czech Government and the European Commission, actions may be brought against decisions of the Úřad průmyslového vlastnictví relating to the invalidity of a trade mark before the President of that body, and the decisions of the President are themselves open to review before the administrative court, in which [proceedings] the Úřad průmyslového vlastnictví has the status of defendant. That organisation of the legal remedies against a decision concerning the invalidity of a trade mark emphasises the administrative nature of the decisions delivered by that body.

20 The present request for a preliminary ruling is different, moreover, in two respects from that which gave rise to the judgment in *Häupl*, in which the Court recognised the Oberster Patent- und Markensenat (Supreme Patent and Trade Mark Adjudication Tribunal, Austria) as being a 'court or tribunal', within the meaning of Article 267 TFEU.

21 First, the Oberster Patent- und Markensenat has jurisdiction to hear appeals against decisions of the Nichtigkeitsabteilung des Patentamtes (Cancellation Division of the Austrian Patent Office) and of the Beschwerdeabteilung des Patentamtes (Board of Appeal of the Austrian Patent Office). By contrast, as is apparent from paragraph 19 of this order, the Úřad průmyslového vlastnictví, the body at issue in the present case, rules on applications for a declaration that a trade mark is invalid, a competence that seems similar to that of the Nichtigkeitsabteilung des Patentamtes.

22 Secondly, as is apparent from paragraph 18 of the judgment in *Häupl*, the members of the Oberster Patent- und Markensenat are to perform their duties entirely independently, without being bound by any directions. Their impartiality is strengthened by the fact that their mandate may be terminated early only for exceptional and well-defined reasons.

23 Such guarantees of independence and impartiality, which are necessary for a body to be regarded as a 'court or tribunal' for the purposes of Article 267 TFEU, require rules, particularly as regards the composition of the body and the appointment, length of service and the grounds for abstention, rejection and dismissal of its members, which are capable of dispelling any reasonable doubt in the minds of individuals as to the imperviousness of that body to external factors and its neutrality with respect to the interests before it (see, inter alia, order in Case C-109/07 *Pilato* [2008] ECR I-3503, paragraph 24, and judgment in Case C-175/11 *D. and A.* [2013] ECR, paragraph 97).

24 In this case, it appears from the written observations of the Czech Government and the European Commission that the grounds for the possible removal of the President of the Úřad průmyslového vlastnictví by the Czech Government, and the President's term of office, are not laid down by law.

25 It follows from all of the foregoing that the Court clearly has no jurisdiction to rule on the questions referred for a preliminary ruling by the Úřad průmyslového vlastnictví.

Costs

26 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the referring body, the decision on costs is a matter for that body. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby orders:

The Court of Justice of the European Union clearly has no jurisdiction to answer the questions referred by the Úřad průmyslového vlastnictví (Czech Republic) in its decision of 22 January 2013.

[Signatures]