



Reports of Cases

Judgment of the General Court (Sixth Chamber) of 3 May 2018 – J-M.-E.V. e hijos v EUIPO – Masi (MASSI)

(Case T-2/17)

(EU trade mark — Invalidity proceedings — Application for registration of the EU word mark MASSI — Earlier national word mark MASI — Article 56(3) of Regulation (EC) No 207/2009 (now Article 63(3) of Regulation (EU) 2017/1001) — Res judicata — Article 53(1)(a) and Article 8(2)(c) of Regulation No 207/2009 (now Article 60(1)(a) and Article 8(2)(c) of Regulation 2017/1001) — Well-known mark within the meaning of Article 6bis of the Paris Convention)

1. *EU trade mark — Surrender, revocation and invalidity — Invalidity proceedings — Admissibility — Conditions*

(Council Regulation No 207/2009, Art. 56(3))

(see para. 24)

2. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an identical or similar earlier mark well known in a Member State — Conditions*

(Council Regulation No 207/2009, Arts 8(2)(c) and 53(1)(a))

(see paras 40, 75)

3. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an identical or similar earlier mark well known in a Member State — Likelihood of confusion with the earlier mark — Word marks MASSI and MASI*

(Council Regulation No 207/2009, Art. 8(2)(c))

(see paras 43, 76, 77)

4. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation — Protection of well-known earlier mark extended to dissimilar goods or services — Conditions — Reputation of the mark in the Member State or the EU — Meaning — Criteria for assessment*

(Council Regulation No 207/2009, Art. 8(5))

(see paras 53, 54)

5. *EU trade mark — Appeals procedure — Action before the EU judiciary — Jurisdiction of the General Court — Review of the lawfulness of decisions of the Boards of Appeal — Account taken by the General Court of matters of law and fact not previously raised before the departments of EUIPO — Not included*

(Council Regulation No 207/2009, Art. 65)

(see para. 81)

6. *EU trade mark — Appeals procedure — Action before the EU judiciary — Power of the General Court to alter the contested decision — Limits*

(Council Regulation No 207/2009, Art. 65)

(see para. 82)

Re:

Action brought against the decision of the First Board of Appeal of EUIPO of 4 October 2016 (R 793/2015-1), relating to invalidity proceedings between Mr Masi and J-M.-E.V. e hijos.

Operative part

The Court:

1. Annuls the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 4 October 2016 (R 793/2015-1);
2. Orders EUIPO to pay, in addition to its own costs, those incurred by J-M.-E.V. e hijos, SRL;
3. Orders Mr Alberto Masi to bear his own costs.