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General Court clarifies that marks must be identical for Article 8(3) to apply

European Union - [NJORD](#)

- Jerome Alexander opposed registration of MINERAL MAGIC based on earlier mark MAGIC MINERALS BY JEROME ALEXANDER under Article 8(3)
- Board of Appeal found that applicant was agent within meaning of Article 8(3) and upheld opposition
- Court held that signs must be identical for Article 8(3) to apply

In [John Mills Ltd v European Union Intellectual Property Office](#) (EUIPO) (Case T-7/17, 15 October 2018), the General Court has annulled a decision of the First Board of Appeal of the EUIPO in which the latter had annulled an Opposition Division decision holding that the opponent's claim under Article 8(3) of [Regulation 207/2009](#) (now [Regulation 2017/1001](#)) had failed.

Background

In 2011 the parties entered into a distribution agreement, whereby John Mills Ltd distributed the MAGIC MINERALS BY JEROME ALEXANDER-branded cosmetics products of US company Jerome Alexander Consulting Corp. The case arose when John Mills filed an application in 2013 for registration of the word sign MINERAL MAGIC as an EU trademark for the goods in Class 3 of the Nice Classification.

Jerome Alexander filed a notice of opposition based on the earlier US word mark MAGIC MINERALS BY JEROME ALEXANDER, covering "face powder featuring mineral enhancements". It claimed that John Mills was an agent and that the application for MINERAL MAGIC was in contravention of Article 8(3) of the regulation.

The Opposition Division of the EUIPO rejected the opposition under Article 8(3) because the two marks were not identical.

Board of Appeal decision

Jerome Alexander appealed and the First Board of Appeal of the EUIPO annulled the Opposition Division's decision. The Board of Appeal gave five reasons for its decision, namely:

- It recalled the purpose of Article 8(3), which is to prevent the misuse of a trademark by the trademark proprietor's agent, and also the conditions which, in its view, must be fulfilled for an

opposition on that basis to succeed - namely:

- the opposing party must be the proprietor of the earlier mark;
 - the applicant for the mark must be, or have been, the agent or representative of the proprietor of the mark;
 - the application must 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; and
 - the application must relate in essence to identical or similar signs and goods.
- It examined the condition above and concluded that the applicant was an agent within the meaning of Article 8(3).
 - It pointed out that Article 8(3) relates not only to cases where the goods or services compared are identical, but also to cases where they are similar.
 - The signs were found to be similar.

General Court decision

This time it was John Mills' turn to appeal, claiming that:

- it was not "an agent" of Jerome Alexander;
- the marks were not identical; and
- the goods were not identical.

The General Court began by examining the second claim, namely whether Article 8(3) was erroneously applied in a case concerning only similar, and not identical, signs. The court mentioned that this provision, in essence, requires that there should be a direct link between the proprietor's trademark and the applied-for trademark. Such a link can exist only if the trademarks in question match.

The court then examined the legislative history of Article 8(3) and recalled that, in the Council of the European Union's Document No 11035/82 of 1 December 1982, the Working Group noted that it had agreed that the provision at issue should be interpreted as applying internationally within the meaning of Article 6*septies* of the [Paris Convention for the Protection of Industrial Property](#), as revised and amended.

Taking into account the fact that there is no ambiguity in the wording of Article 6*septies* of the Paris Convention, the EUIPO could not base an argument on the *travaux préparatoires* of this convention to support the claim that this article should also be interpreted as encompassing cases where the signs are merely similar. Furthermore, the court noted that the council had not adopted the suggestion of a delegation that the provision concerned should also apply in cases of 'similar' trademarks for 'similar' products, in the final version of the regulation it passed.

Thus, the General Court held that, for Article 8(3) to apply, the signs must be identical. Since the signs at issue were not identical, it concluded that the Board of Appeal had erroneously held that it could rely on Article 8(3) to refuse the registration of the trademark applied for. These findings led the court to annul the decision of the Board of Appeal, and it did not have to address the appellant's other claims.

Comment

In this well-reasoned decision going all the way back to the Paris Convention and legislative documents from 1982, the General Court has clarified a cloudy issue and stated, once and for all, that the marks must be identical for Article 8(3) to apply. However, the court left the main issue - whether the applicant was “an agent” and thus covered by that article - for another day.

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