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## EUROPEAN UNION

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In the recent Judgment of 11/11/2020, the CJEU ruled on an appeal for annulment against an earlier Judgment of the General Court on an issue that does not have ample precedent and that relates to the interpretation of Article 8(3) EUTMR on the opposition to new trademark applications filed by the agent or representative of an earlier trademark.

EUIPO’s Board of Appeal had upheld the opposition filed by a US company JEROME ALEXANDER CONSULTING (hereinafter JAC) against the trademark application “MINERAL MAGIC” filed by a British company JOHN MILLS (hereinafter JM).

The General Court upheld the appeal filed by JM on the basis of the claim by JM that the aforementioned provision (Art. 8(3) EUTMR) was not applicable if the conflicting signs were not identical (JAC claimed the prior existence of a trademark registered in the USA “MAGIC MINERALS BY JEROME ALEXANDER”).

The deliberations of the CJEU and its rationale for revoking the earlier Judgment of the General Court are very important to address the matter at hand.

Indeed, in paragraph 69 of its judgment, it states that **“an interpretation according to which, to the extent that Article 8, section 3 of Regulation no. 207/2009 does not mention the identity or similarity between the earlier trademark and the trademark applied for by the agent or representative of the holder of the earlier trademark, the application of said provision is exclusively limited to cases in which the conflicting trademarks are identical, excluding any other factor, cannot be considered acceptable”**.

In fact, as stated by the CJEU in paragraph 72 of its Judgment, the purpose of the provision at hand is to prevent the agent or representative of the holder of a trademark from wrongly assuming ownership of the same. It is for this reason that Article 8(3) EUTMR must not be interpreted in a strict or literal sense, but in a way that is flexible and ultimately final.

The CJEU also proceeds to assess other disputed aspects that are relevant. Indeed, JM claimed that it could not be considered as an “agent” or “representative”, arguing that there was no proof that an agreement linking a principal to its agent had been entered into with JAC, or that said relationship in fact existed, concluding that the examination of the clauses of the distribution agreement existing between the parties must lead them to consider that JM was not an agent of JAC nor was it linked by a contractual relationship in which it represented the interests of JAC.



Therefore, the CJEU states that it should be noted (paragraph 83 of the Judgment) that the purpose of Article 8(3) is to prevent the agent or representative of the holder of a trademark from assuming ownership of the same, since the latter may exploit the knowledge and experience acquired during the business relationship linking them to this holder and, therefore, take unfair advantage of the efforts and investment made by the former. **As such, the CJEU maintains that the attainment of this objective requires a broad interpretation of the concepts of “agent” and “representative”.** And, therefore, in paragraph 85 of the Judgment, it is stated that **these concepts must be interpreted in a way that encompasses all types of relationships based on a contractual agreement** by virtue of which one of the parties represents the interests of the other, such that for the purposes of applying the provision in question (Art. 8(3) EUTMR), **it is enough that there exists a business cooperation agreement between the parties which can create a relationship of trust**, expressly or implicitly imposing on the applicant of the mark a general obligation of trust and loyalty with respect to the interests of the holder of the earlier trademark.

The CJEU also reiterates (paragraph 91 of the Judgment) that Article 8(3) of EUTMR **applies to the applications for registration filed by the agent or representative of the holder of the earlier trademark both when the trademark applied for is identical to that earlier mark and when it is similar to it.**

And, along the same line of reasoning, the CJEU also considers (paragraph 99 of the Judgment) that, in view of the objective pursued by Article 8(3) EUTMR, **the application of this provision cannot be excluded by the fact that the goods or services referred to in the application for registration and those designated by the prior trademark are not identical, but similar.**

This is a very important Judgment, which extends the scope of application of Article 8(3) EUTMR and which, furthermore, will also be used to interpret Article 6 septies of the Paris Convention, as well as the national rules of EU member states which contain provisions that are similar (if not identical) in every respect to the cited Article 8(3) EUTMR. As such, ultimately this Judgment and its rationale will also certainly have a significant impact on those disputes that may arise in each of the EU member states in this regard.