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, EUIPO (HTTP://TRADEMARKBLOG.KLUWERIPLAW.COM/CATEGORY/EUIPO/)

Green is the new black. But in 2003 that was not the case, says the CJEU
(<http://trademarkblog.kluweriplaw.com/2020/10/22/green-is-the-new-black-but-in-2003-that-was-not-the-case-says-the-cjeu/>)

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(**Bugnion S.p.A** (<https://www.bugnion.eu/en/professionisti/fabio-angelini-2/>)) / **October 22, 2020**

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There are still many IP professionals who are nostalgic of the “good old times” when instead of having to laboriously and meticulously identify the list of goods/services it was sufficient to simply indicate the “class heading” and et voilà you got protection for everything in the class.

Yet, there were dangers lurking under this apparent simplicity. This has become apparent in case C-121/19P decided on 16 September 2020 where, in a nutshell, the CJEU had to decide whether “electricity” was a “fuel” back in 2003.

In 2003, Edison S.P.A. filed an EU trademark application for the figurative mark “EDISON” designating, among others, the heading of Class 4, which, according to the 8th edition of the Nice Classification in force at that time, read as follows: “Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting”. In 2015, Edison S.p.A filed a request for partial surrender in order to reword the list of goods including, inter alia, “Electrical energy”.

EUIPO, on the basis of the “Alphabetical List approach”, refused the request in so far as it concerned “electrical energy”. It considered this to extend the protection conferred by the mark, as “electrical energy” was not included in the Alphabetical List of Class 4 in force at that time – in fact it was introduced only in the 9th edition, which entered into force on 1 January 2007.

The Board of Appeal confirmed, inter alia refusing Edison’s argument that the specification ‘including motor spirit’ in the heading of class 4 encompassed any material capable of powering an engine, including non-combustible materials such as electrical energy. According to the Board, use of electricity as a means of powering an engine was still negligible within the EU at the filing date, and evidence produced by Edison was insufficient to establish that



electrical energy formed a portion of the goods in Class 4, as an ‘alternative fuel’.

Moreover, it held that the category of goods covered by the English term ‘fuel’ included only combustible materials that could be used to produce electrical energy and not electrical energy as such, which is an intangible product. The GC confirmed the Board’s decision and

Edison appealed to the CJEU alleging an erroneous interpretation of the concept of “fuel”.

(N.B. – this was before 1 May 2019 when the new procedure for admission of CJEU appeals under Article 58a of the Statute was implemented; otherwise we most likely would not have anything to report as the CJEU has since refused to admit a single appeal.)

Edison argued that fuel should have been considered to include in its usual and natural meaning also “electrical energy” (as an alternative “green” fuel). According to Edison, the GC erroneously took into account only the ontological characteristic of electrical energy, completely disregarding its functional characteristic and objective properties, namely, to be an intangible ecological fuel capable of powering an engine.

The CJEU was not impressed by such arguments and agreed with the GC that although ‘certain’ car models powered partially or entirely by electrical energy had already been placed on the market, the development, on the European market, of car models powered by electrical energy had not ‘in reality’ taken place until several years after the trademark application at issue (§ 67). In essence the CJEU held that Edison was basically trying to

back-date something that today we accept as a common fact (i.e. to have recharging stations for electric cars) but which almost 20 years ago was a technology still in its infancy and would take quite some time to become a “reality” for the average consumer.

The CJEU might or might not have got it right because after so many years it is difficult to ascertain what was the “reality” back in 2003. Nonetheless, regardless of the actual outcome and although this case deals with the use of “class headings”, it exemplarily illustrates still existing difficulties of the literal approach to determine the scope of protection of a trademark. The literal meaning of a certain good or service may in fact change over time and the problem of how to match the language of the list of goods/services of old registrations with the rapid advancement of technology and of our society remains. One suggestion? Try the “4 R” approach: Routinely Review the list, Reconsider the business environment, Refile with new goods/services if necessary.



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