

European Union

“Iron & Smith”

**Decision of the European Court of Justice (Fourth Chamber)
3 September 2015 – Case No. C-125/14**

Iron & Smith kft v. Unilever NV

Directive 2008/95/EC, Art. 4(3)

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Keywords Registration of national mark identical or similar to previous Community mark · Reputation · Geographical extent of reputation

1. Article 4(3) 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 must be interpreted as meaning that, if the reputation of an earlier Community mark is established in a substantial part of the territory of the European Union, which may, in some circumstances, coincide with the territory of a single Member State, which does not have to be the State in which the application for the later national mark was filed, it must be held that that mark has a reputation in the European Union. The criteria laid down by the case-law concerning the genuine use of the Community trade mark are not relevant, as such, in order to establish the existence of a ‘reputation’ within the meaning of Article 4(3) thereof.
2. If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.