

European Union

“Formula 1”

Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark, Article 8 – *Formula One Licensing BV v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and Global Sports Media Ltd.*

**Decision of the European Court of Justice
(Third Chamber)
24 May 2012 – Case No. C-196/11 P**

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1. Due to the coexistence of the Community trade mark with national trade marks, the validity of an international or national trade mark may not be called into question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the respective Member State.
2. In light of this coexistence, and because the registration and judicial review of national trade marks does not fall under the scope of the Institutions of the EU, the validity of national trade marks may not be called into question in proceedings opposing the registration of a Community trade mark.
3. In such opposition proceedings it is thus not possible to find an absolute ground for refusal of the registration as a Community trade mark, such as the lack of distinctive character.
4. Despite OHIM's and the General Court's obligation to verify the way in which the relevant public perceives the sign which is identical to the national trade mark and to evaluate the degree of distinctiveness of that sign where an opposition against the registration of a Community trade mark is filed, this verification has limits. It may not result in a finding of the lack of distinctive character of a sign identical to a national trade mark, as such, by eliminating the national protection of marks, would be incompatible with the above-mentioned coexistence of the Community trade marks and national trade marks.
5. For such cases, Article 8(2)(a)(ii) expressly requires that national trade marks be taken into consideration as earlier trade marks.
6. Consequently, it is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based.