

Court of Justice EU, 22 March 2012, Genesis v Boys Toys



TRADE MARK LAW

Only the day, not the hour and minute of filing an application for a Community trade mark, is relevant to determine which application is older

- 63 In light of all of the foregoing, the answer to the question referred is that Article 27 of Regulation No 40/94 as amended must be interpreted as precluding account being taken not only of the day but also of the hour and minute of filing of an application for a Community trade mark with OHIM for the purposes of establishing that trade mark's priority over a national trade mark filed on the same day, where, according to the national legislation governing the registration of national trade marks, the hour and minute of filing are relevant in that regard.

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Court of Justice EU, 31 March 2010

(A. Tizzano, A. Borg Barthet, E. Levits (rapporteur), J.-J. Kasel and M. Berger)

JUDGMENT OF THE COURT (First Chamber)

22 March 2012 (*)

(Community trade mark — Definition and acquisition — Earlier trade mark — Procedure for filing — Filing by electronic means — Method enabling precise identification of the day, hour and minute when the application was filed)

In Case C-190/10,

REFERENCE for a preliminary ruling under Article 267 TFEU from the Tribunal Supremo (Spain), made by decision of 24 February 2010, received at the Court on 16 April 2010, in the proceedings

Génesis Seguros Generales Sociedad Anónima de Seguros y Reaseguros (Génesis)

v

Boys Toys SA,

Administración del Estado,

THE COURT (First Chamber),

composed of A. Tizzano, President of the Chamber, A. Borg Barthet, E. Levits (Rapporteur), J.-J. Kasel and M. Berger, Judges,

Advocate General: N. Jääskinen,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– Génesis Seguros Generales Sociedad Anónima de Seguros y Reaseguros (Génesis), by M. D. Garayalde Niño and A. I. Alpera Plazas, abogadas, and by V. Venturini Medina, procurador,

– the Spanish Government, by B. Plaza Cruz, acting as Agent,

– the Greek Government, by K. Georgiadis and by Z. Chatzipavlou and G. Alexaki, acting as Agents,

– the Italian Government, by G. Palmieri, acting as Agent, assisted by S. Fiorentino, avvocato dello Stato,

– the European Commission, by E. Gippini Fournier, acting as Agent,

after hearing [the Opinion of the Advocate General](#) at the sitting on 31 March 2011,

gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation of Article 27 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

2 The reference has been made in proceedings between Génesis Seguros Generales Sociedad Anónima de Seguros y Reaseguros ('Génesis') and, first, Boys Toys SA ('Boys Toys'), the legal successor to Pool Angel Tomás SL, and, second, the Administración del Estado concerning the Oficina Española de Patentes y Marcas (Spanish Patents and Trade Marks Office) ('the OEPM')'s rejection of the opposition filed by Génesis against the registration of the national Spanish trade mark Rizo's.

Legal context

European Union law

3 First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) has been repealed by 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 (codified version) (OJ 2008 L 299, p. 25). Nevertheless, having regard to the date of the facts, First Council Directive 89/104 is still relevant to the dispute in the main proceedings.

4 Article 4 of that directive, entitled 'Further grounds for refusal or invalidity concerning conflicts with earlier rights', states:

'1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

2. "Earlier trade marks" within the meaning of paragraph 1 means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the

date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;

(i) Community trade marks;

...

...

(c) applications for the trade marks referred to in (a) and (b), subject to their registration;

...

...’

5 Regulation No 40/94 has been repealed by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (OJ 2009 L 78, p. 1), which came into force on 13 April 2009. However, having regard to the date of the facts, the present dispute is governed by the former regulation, as amended by Council Regulation (EC) No 1992/2003 of 27 October 2003 (OJ 2003 L 296, p. 1) (*‘Regulation No 40/94 as amended’*).

6 Article 8(1) and (2) of Regulation No 40/94 as amended, entitled *‘Relative grounds for refusal’*, provided:

‘1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. For the purposes of paragraph 1, “Earlier trade marks” means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) Community trade marks;

...

(b) applications for the trade marks referred to in subparagraph (a), subject to their registration;

...

7 Article 14(1) of Regulation No 40/94 as amended, under the heading *‘Complementary application of national law relating to infringement’*, provided that the effects of Community trade marks are to be governed solely by the provisions of that regulation and that, in other respects, infringement of a Community trade mark is to be governed by the national law relating to infringement of a national trade mark in accordance with the provisions of Title X of that regulation.

8 Article 26 of Regulation No 40/94 as amended, laying down the conditions with which applications for a Community trade mark must comply, stated:

‘1. An application for a Community trade mark shall contain:

(a) a request for the registration of a Community trade mark;

(b) information identifying the applicant;

(c) a list of the goods or services in respect of which the registration is requested;

(d) a representation of the trade mark.

2. The application for a Community trade mark shall be subject to the payment of the application fee and, when appropriate, of one or more class fees.

3. An application for a Community trade mark must comply with the conditions laid down in the implementing Regulation referred to in Article 157.’

9 Article 27 of Regulation No 40/94 as amended, entitled *‘Date of filing’*, stated:

‘The date of filing of a Community trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Office [for Harmonisation in the Internal Market (trade marks and designs) (OHIM)] by the applicant or, if the application has been filed with the central office of a Member State or with the Benelux Trade Mark Office, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents.’

10 Article 32 of Regulation No 40/94 as amended, entitled *‘Equivalence of Community filing with national filing’*, provided that a *‘Community trade mark application which has been accorded a date of filing shall, in the Member States, be equivalent to a regular national filing, where appropriate with the priority claimed for the Community trade mark application.’*

11 Article 97 of Regulation No 40/94 as amended, entitled *‘Applicable law’*, provided:

‘1. The Community trade mark courts shall apply the provisions of this Regulation.

2. On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.

3. Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State where it has its seat.’

12 Rule 5 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), entitled *‘Filing of the application’*, provided:

‘(1) [OHIM] shall mark the documents making up the application with the date of its receipt and the file number of the application. The Office shall issue to the applicant without delay a receipt which shall include at least the file number, a representation, description or other identification of the mark, the nature and the number of the documents and the date of their receipt.

(2) If the application is filed with the central industrial property office of a Member State or at the Benelux Trade Mark Office in accordance with Article 25 of the Regulation, the office of filing shall number all the

pages of the application with arabic numerals. Before forwarding, the office of filing shall mark the documents making up the application with the date of receipt and the number of pages. The office of filing shall issue to the applicant without delay a receipt which shall include at least the nature and the number of the documents and the date of their receipt.

(3) If [OHIM] receives an application forwarded by the central industrial property office of a Member State or the Benelux Trade Mark Office, it shall mark the application with the date of receipt and the file number and shall issue to the applicant without delay a receipt in accordance with the second sentence of paragraph 1, indicating the date of receipt at [OHIM].⁷

National law

13 Article 6(2)(a) and (c) of Law No 17/2001 of 7 December 2001 on trade marks (Ley 17/2001 de Marcas, BOE No 294 of 8 December 2001, p. 45579) defines earlier trade marks as follows:

‘(a) registered trade marks of the following kinds with a date of filing or date of priority of the application for registration which is earlier than the date of the application under consideration:

- (i) Spanish trade marks;
- (ii) trade marks registered under international arrangements which have effect in Spain;
- (iii) Community trade marks.

...

(c) applications for the trade marks referred to in subparagraph (a) and (b), subject to confirmation of their registration.

...⁷

14 Article 11(6) of Law No 17/2001, under the heading ‘Filing of applications’, provides:

‘The body competent to receive the application shall, upon receipt of the application, record the number of the application and the date, hour and minute of its receipt, in the manner to be determined by regulation.’

15 Article 13 of Law No 17/2001 provides:

‘(1) The date of filing of an application shall be the date on which the competent body, as defined in Article 11, receives the documents containing the information specified in Article 12(1).

(2) The date of filing of applications filed at a post office shall be the time at which that office receives the documents containing the information specified in Article 12(1), provided that those documents are filed in an unsealed envelope, by registered post and with acknowledgment of receipt, addressed to the body competent to receive the application. The post office shall record the day, hour and minute of the filing of the application.

(3) If any of the bodies or administrative units referred to in the preceding paragraphs fails to record, at the time the application is received, the hour of its filing, the application shall be assigned the final hour of the day. If the minute has not been recorded, the application shall be assigned the final minute of the hour. If neither the hour nor the minute of filing has been recorded, the application shall be assigned the final hour and minute of the day in question.’

The dispute in the main proceedings and the question referred for a preliminary ruling

16 It is stated in the order for reference that, on the morning of 12 December 2003, at 11:52 hours and 12:13 hours respectively, Génesis filed with OHIM, by electronic means, two applications for Community trade marks, namely the word mark Rizo for goods in Classes 16, 28, 35 and 36 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and the word mark Rizo, El Erizo for goods in Classes 16, 35 and 36 of that agreement.

17 It is also stated in the order for reference that, on the same day but at 17:45 hours, Pool Angel Tomás SL applied to the OEPM for registration of the word mark Rizo’s for goods in Class 28 of that agreement.

18 Génesis opposed the application for registration of the national trade mark, as it took the view that the Community word marks Rizo and Rizo, El Erizo had priority over that trade mark.

19 After the OEPM rejected the opposition by decision of 9 December 2004, Génesis brought an appeal seeking a declaration by the OEPM that the Community trade marks of which Génesis is the proprietor have priority, based on the fact that the application for those trade marks had been filed, by electronic means, on 12 December 2003 and that it is that date which should have been taken into consideration.

20 By decision of 29 June 2005, the OEPM dismissed that appeal. It held once again that, under Article 27 of Regulation No 40/94 as amended, it had to be held that the filing of the application for the Community trade marks at issue in the main proceedings had been carried out on 7 January 2004, the date on which the documentation was actually submitted, and that that date was later than the date of filing of the application for registration of the Spanish trade mark Rizo’s.

21 After Génesis brought an appeal against that decision, the Second Section of the Chamber for Contentious Administrative Proceedings of the Tribunal Superior de Justicia de Madrid (High Court of Justice, Madrid) confirmed, by judgment of 7 February 2008, that the decision granting registration of the Spanish trade mark applied for (Rizo’s) was well-founded. That court considered that the date of filing of the application for the opposing Community trade marks was the date on which the documentation was actually submitted and not 12 December 2003, the date on which the application was filed by electronic means.

22 Génesis then brought an appeal against that judgment before the referring court. In its appeal, first, Génesis challenges the interpretation of the Tribunal Superior de Justicia de Madrid as regards the date of filing of the Community trade mark applications and states that the correct interpretation of Articles 26 and 27 of Regulation No 40/94 as amended is the one which results in the date of filing of the applications being regarded as the date on which those applications were transmitted to and received by OHIM.

Accordingly, in the case in the main proceedings, 12 December 2003 should be accepted as the date of filing. Secondly, Génesis considers that, by failing to recognise the priority of the Community trade marks Rizo and Rizo, El Erizo, the Tribunal Superior de Justicia de Madrid infringed Article 6(2)(a) and (c) of Law No 17/2001.

23 In those circumstances the Tribunal Supremo decided to stay proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

'May Article 27 of [Regulation No 40/94 as amended] be interpreted in such a way as to enable account to be taken not only of the day but also of the hour and minute of filing of an application for registration of a Community trade mark with OHIM (provided that such information has been recorded) for the purposes of establishing temporal priority over a national trade mark application filed on the same day, where the national legislation governing the registration of national trade marks considers the time of filing to be relevant?'

Consideration of the question referred

Admissibility of the reference for a preliminary ruling

24 It should be noted that the question referred by the national court is based on the premise that the Community trade mark applications and the national trade mark application were filed on the same day.

25 Although it is stated in the reference for a preliminary ruling that the OEPM and the court which ruled on the appeal held that the date of filing of the Community trade mark applications was later than the date of filing of the national trade mark application, that fact does not affect the admissibility of the reference for a preliminary ruling.

26 Indeed, according to settled case-law, there is a presumption of relevance in favour of questions on the interpretation of European Union law referred by a national court, and it is a matter for the national court to define, and not for the Court to verify, in which factual and legislative context they operate (Case C-300/01 Salzmann [2003] ECR I-4899, paragraphs 29 and 31; Joined Cases C-222/05 to C-225/05 van der Weerd and Others [2007] ECR I-4233, paragraph 22; and Case C-210/06 Cartesio [2008] ECR I-9641, paragraph 67). The Court declines to rule on a reference for a preliminary ruling from a national court only where it is quite obvious that the interpretation of European Union law that is sought is unrelated to the actual facts of the main action or to its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it (Cartesio, paragraph 67 and the case-law cited).

27 As Génesis has challenged, both before the court of first instance and the referring court, the argument that the date of filing of the application for the Community trade marks is later than the date of filing of the

application for registration of the national trade mark, that issue is part of the subject-matter of the dispute before the referring court. Accordingly, it is not apparent, or at least it is not quite obvious, that the interpretation of European Union law that is sought is unrelated to the actual facts of the main action or to its purpose or that it concerns a hypothetical problem.

28 It is therefore necessary to answer the question referred.

Substance

29 By its question, the referring court asks, in essence, whether Article 27 of Regulation No 40/94 as amended is to be interpreted as enabling account to be taken not only of the day but also of the hour and minute of filing of an application for a Community trade mark with OHIM for the purposes of establishing the priority of that trade mark over a national trade mark filed on the same day, where, according to the national legislation governing the registration of national trade marks, the hour and minute of filing are relevant in that regard.

30 As a preliminary point, it should be borne in mind that the protection of trade marks is characterised, within the European Union, by the coexistence of several systems of protection.

31 First, according to the first recital in the preamble thereto, the purpose of Directive 89/104 is to approximate national trade mark laws in order to remove any existing disparities which may impede the free movement of goods and the freedom to provide services and which may distort competition within the common market.

32 Although the third recital in the preamble to Directive 89/104 states that *'it does not appear to be necessary at present to undertake full-scale approximation of the trade mark laws of the Member States'*, the directive none the less provides for harmonisation in relation to substantive rules of central importance in this sphere, that is to say, according to the same recital, the rules concerning the provisions of national law which most directly affect the functioning of the internal market, and that recital does not preclude the harmonisation relating to those rules from being complete ([Case C-355/96 Silhouette International Schmied](#) [1998] ECR I-4799, paragraph 23; [Case C-40/01 Ansul](#) [2003] ECR I-2439, paragraph 27; and [Case C-482/09 Budějovický Budvar](#) [2011] ECR I-8701, paragraph 30).

33 However, the fifth recital in the preamble to Directive 89/104 states, inter alia, that the *'Member States ... remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration; ... they can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both'*.

34 It must therefore be held that Directive 89/104 does not contain any provisions relating to the procedure for filing or to establishing the date of filing of applications for national trade marks. Since the Member States remain free to determine their own provisions on the subject, those provisions may, consequently, differ from one Member State to another.

35 Second, it follows from the second recital in the preamble to Regulation No 40/94 as amended that the objective of that regulation is the creation of a Community regime for trade marks to which uniform protection is given and which produce their effects throughout the entire area of the European Union (see, to that effect, Case C-235/09 [DHL Express France](#) [2011] ECR I-2801, paragraph 41).

36 That Community trade mark system is an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system (see, inter alia, [Case C-238/06 P Develev v OHIM](#) [2007] ECR I-9375, paragraph 65; Joined Cases C-202/08 P and C-208/08 [P American Clothing Associates v OHIM and OHIM v American Clothing Associates](#) [2009] ECR I-6933, paragraph 58; and judgment of 30 September 2010 in Case C-479/09 P *Evets v OHIM*, paragraph 49).

37 As an autonomous system which is independent from national systems, the Community trade mark regime has its own rules relating to the procedure for filing an application for a Community trade mark, contained in Regulations No 40/94 as amended and Regulation No 2868/95. In particular, Article 27 of Regulation No 40/94 as amended contains a specific provision relating to the date of filing of an application for a Community trade mark and does not refer to the provisions of national law in that regard.

38 In those circumstances, in order to answer the question referred, it is necessary, first, to determine whether the concept of ‘*date of filing of a Community trade mark application*’ contained in Article 27 of Regulation No 40/94 as amended should be interpreted as requiring account to be taken not only of the day but also of the hour and minute of filing of that application.

39 Second, if the concept of ‘*date of filing of a Community trade mark application*’ under Article 27 of Regulation No 40/94 as amended is to be interpreted as not requiring account to be taken of the hour and minute of filing of that application, it must be ascertained whether European Union law precludes those elements from nevertheless being taken into account under national law for the purposes of establishing a Community trade mark’s priority over a national trade mark filed on the same day, where the national legislation governing the registration of that national trade mark considers the hour and minute of filing to be relevant.

Meaning and scope of the concept of ‘*date of filing*’ laid down in Article 27 of Regulation No 40/94 as amended

40 First of all, it should be observed that the need for a uniform application of European Union law and the

principle of equality require that the terms of a provision of European Union law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must normally be given an independent and uniform interpretation throughout the European Union; that interpretation must take into account the context of the provision and the objective of the relevant legislation (see, inter alia, Case 327/82 *Ekro* [1984] ECR 107, paragraph 11; Case C-287/98 *Linster* [2000] ECR I-6917, paragraph 43; [Case C-467/08 Padawan](#) [2010] ECR I-10055, paragraph 32; and [Budějovický Budvar](#), paragraph 29).

41 Next, it follows from case-law that the meaning and scope of terms for which European Union law provides no definition must be determined by considering their usual meaning in everyday language, while also taking into account the context in which they occur and the purposes of the rules of which they form part (see, inter alia, Case C-336/03 *easyCar* [2005] ECR I-1947, paragraph 21; Case C-549/07 *Wallentin-Hermann* [2008] ECR I-11061, paragraph 17; Case C-151/09 *UGT-FSP* [2010] ECR I-7591, paragraph 39; and [Budějovický Budvar](#), paragraph 39).

42 Lastly, the need for a uniform interpretation of the various language versions of a provision of European Union law also requires, in the case of divergence between those language versions, that the provision in question be interpreted by reference to the purpose and general scheme of the rules of which it forms part (Case C-72/95 *Kraaijeveld and Others* [1996] ECR I-5403, paragraph 28; Case C-63/06 *Profisa* [2007] ECR I-3239, paragraph 14; and Case C-585/10 *Møller* [2011] ECR I-13407, paragraph 26).

43 It is clear from a comparison of the various language versions of Article 27 of Regulation No 40/94 as amended that those versions do display certain differences.

44 Thus, the Czech, German, Hungarian, Slovak, Finnish and Swedish versions of that article refer - in both the heading and the main text thereof - to the day of filing (‘*Den podání*’, ‘*Anmeldetag*’, ‘*A bejelentés napja*’, ‘*Deň podania*’, ‘*Hakemispäivi*’, ‘*Ansökningsdag*’), while the Lithuanian and Polish versions of that article state that the date of filing (‘*Padavimo data*’, ‘*Data zgłoszenia*’) corresponds to the day (‘*diena*’, ‘*dzień*’) when the application was filed.

45 By contrast, the other language versions simply use the expression ‘*date of filing*’ of the Community trade mark application.

46 Nevertheless, the differences between those language versions must be placed in perspective since, according to its ordinary meaning, the term ‘*date*’ generally designates the day of the month, the month and the year when an act has been adopted or an event has taken place. In the same way, stating the day when an act has been adopted or an event has taken place means, according to its ordinary meaning, that it is also necessary to state the month and the year.

47 However, an obligation to state the date or the day does not imply, according to the ordinary meaning, that it is necessary to state the hour and, a fortiori, the minute. Therefore, in the absence of any express reference in Article 27 of Regulation No 40/94 as amended to the hour and minute of filing of a Community trade mark application, it is apparent that that information was not considered by the Community legislature to be necessary for the purposes of establishing the time of filing of a Community trade mark application and hence its priority over another trade mark application.

48 That interpretation also follows from the context of Article 27 of Regulation No 40/94 as amended. In particular, Rule 5 of Regulation No 2868/95, which details the formalities to be completed by OHIM, by the central industrial property office of a Member State or by the Benelux Trade Mark Office upon the filing of an application for a Community trade mark, only establishes an obligation to indicate on the application the date of receipt of that application and not the hour and minute thereof.

49 It must be held that, if the Community legislature had considered that the hour and minute of filing of a Community trade mark application ought to be taken into account as constituent elements of the ‘*date of filing*’ of that application within the meaning of Article 27 of Regulation No 40/94 as amended, that information should have been included in Regulation No 2868/95.

50 In that regard, the fact that, according to the information on OHIM’s website, the date of filing of a Community trade mark application is that on which the documents referred to in Article 26 of Regulation No 40/94 as amended are filed with OHIM, Central European Time (GMT +1), none the less does not permit the conclusion that the hour and minute of filing of that application are relevant for the purposes of establishing that trade mark’s priority. As the Advocate General observes in [point 61 of his Opinion](#), that indication of time only allows the date of filing before OHIM to be established.

51 The fact — noted by Génesis in the main proceedings — that, when applications for Community trade marks are submitted by electronic means, OHIM de facto certifies the date and the time of filing of those applications, is also irrelevant.

52 It is true that, under Article 10(2) of Decision No EX-11-3 of the President of the Office of 18 April 2011 concerning electronic communication with and by the Office (‘Basic Decision on Electronic Communication’), an electronic communication confirming receipt of the — also electronic — Community trade mark application, indicating the date and hour of receipt of that application, is to be issued to the sender. However, it also follows from Article 10(2) that the communication confirming receipt of that application is to include a statement that the date of receipt will be considered to be the filing date provided that a fee is paid in time, and there is no reference in that regard, to the hour of receipt of the application.

53 In any event, given that an application for a Community trade mark may be filed, according to Article 25(1) of Regulation No 40/94 as amended, with OHIM, with the central industrial property office of a Member State or with the Benelux Trade Mark Office (according to preference), if it was necessary to take the hour and minute of filing of an application for a Community trade mark into account, that obligation would have to stem explicitly from provisions of general application and not from the decision of the President of OHIM relating to the filing of applications for Community trade marks by electronic means.

54 It follows from all of the foregoing that the concept of ‘*date of filing of a Community trade mark application*’ contained in Article 27 of Regulation No 40/94 as amended requires the calendar day of filing of an application for a Community trade mark to be taken into account, but does not require the hour and minute of filing to be taken into account.

Taking the hour and minute of filing into account pursuant to national law

55 That having been stated, it must still be ascertained whether European Union law precludes the hour and minute of filing of an application for a Community trade mark from nevertheless being taken into account under national law for the purposes of establishing a Community trade mark’s priority over a national trade mark filed on the same day, where the national legislation governing the registration of national trade marks considers the hour and minute of filing to be relevant.

56 In that regard, it is sufficient to note — as has been observed in paragraph 37 of this judgment — that, as an autonomous system, the Community trade mark regime has its own rules relating to the date of filing of an application for a Community trade mark and does not refer to provisions of national law.

57 Accordingly, the date of filing of an application for a Community trade mark may only be established according to the rules of European Union law, the approaches adopted by the law of the Member States not having any effect in that regard.

58 Indeed, first, as the Advocate General observes in [point 63 of his Opinion](#), it follows from Article 14 read in conjunction with Article 97 of Regulation No 40/94 as amended that the applicability of national law is limited to questions which fall outside the scope of Regulation No 40/94 as amended.

59 Second, in a situation such as that at issue in the main proceedings, where a Community trade mark is invoked for the purposes of opposing the registration of a national trade mark, if the date of filing of the application for that Community trade mark were to be established by taking account of provisions of national law, that would in effect undermine the uniform nature of the protection of a Community trade mark. Since, as noted in paragraph 34 of this judgment, the Member States remain free to determine the procedure for filing applications for national trade marks, the extent of the protection given to that Community trade mark might differ from one Member State to another.

60 The conclusion that the date of filing of an application for a Community trade mark can only be established according to the rules of European Union law is not called into question by Article 32 of Regulation No 40/94 as amended according to which a Community trade mark application which has been accorded a date of filing is, in the Member States, to be equivalent to a regular national filing, where appropriate with the priority claimed for the Community trade mark application.

61 As the Advocate General observes in [point 65 of his Opinion](#), that provision neither amends the Community concept of the ‘*date of filing*’ nor presupposes the secondary application of national law, but simply recognises that Community trade mark applications filed with OHIM are legally equivalent to those filed with national offices.

62 It follows that European Union law precludes the hour and minute of the filing of an application for a Community trade mark from being taken into account under national law for the purposes of establishing that Community trade mark’s priority over a national trade mark filed on the same day, where the national legislation governing the registration of national trade marks considers the hour and minute of filing to be relevant in that regard.

63 In light of all of the foregoing, the answer to the question referred is that Article 27 of Regulation No 40/94 as amended must be interpreted as precluding account being taken not only of the day but also of the hour and minute of filing of an application for a Community trade mark with OHIM for the purposes of establishing that trade mark’s priority over a national trade mark filed on the same day, where, according to the national legislation governing the registration of national trade marks, the hour and minute of filing are relevant in that regard.

Costs

64 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (First Chamber) hereby rules:

Article 27 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, as amended by Council Regulation (EC) No 1992/2003 of 27 October 2003 must be interpreted as precluding account being taken not only of the day but also of the hour and minute of filing of an application for a Community trade mark with the Office for Harmonisation in the Internal Market (trade marks and designs) (OHIM) for the purposes of establishing that trade mark’s priority over a national trade mark filed on the same day, where, according to the national legislation governing the registration of national trade marks, the hour and minute of filing are relevant in that regard.

[Signatures]

OPINION OF ADVOCATE GENERAL

JÄÄSKINEN

delivered on 31 March 2011 (1)

Case C-190/10

Génesis Seguros Generales Sociedad Anónima de Seguros y Reaseguros (GENESIS)

v

Boys Toys SA

and

Administración del Estado

(Reference for a preliminary ruling from the Tribunal Supremo (Spain))

(Community trade mark — Procedure for filing — Article 27 of Regulation (EC) No 40/94 — Electronic filing of an application — Taking into account the date, hour and minute of filing)

I – Introduction

1. By its reference for a preliminary ruling, the Tribunal Supremo (Spain) submits to the Court a question on the interpretation of the concept of ‘*date of filing*’ of a Community trade mark application. That question seeks to ascertain whether it is possible, for the purposes of applying Article 27 of Regulation (EC) No 40/94, (2) to take into consideration, in addition to the date of filing of an application, the hour and minute of filing in order to be able to claim priority of the Community trade mark.

II – Legal framework

A – International law

2. Article 4(A) of the Paris Convention for the Protection of Industrial Property of 20 March 1883 (3) (*‘the Paris Convention’*) provides as follows:

‘(1) Any person who has duly filed an application for ... a trademark, in one of the countries of the Union, ... shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognised as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.’

3. Under Article 4(C) of the Paris Convention:

‘(1) The periods of priority referred to above shall be ... six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.’

B – EU law

4. Article 8 of Regulation No 40/94, entitled ‘*Relative grounds for refusal*’, provides:

‘1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. For the purposes of paragraph 1, “Earlier trade marks” means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) Community trade marks;

(ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Trade Mark Office;

(iii) trade marks registered under international arrangements which have effect in a Member State;

(b) applications for the trade marks referred to in subparagraph (a), subject to their registration;

(c) trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words “well known” are used in Article 6 bis of the Paris Convention.

...’

5. Article 14 of Regulation No 40/94, entitled ‘*Complementary application of national law relating to infringement*’, provides, in paragraph 1, that the effects of Community trade marks are to be governed solely by the provisions of that regulation.

6. Article 26(1) of Regulation No 40/94 lays down the conditions with which applications for a Community trade mark must comply, which include: (a) a request for the registration of a Community trade mark; (b) information identifying the applicant; (c) a list of the goods or services in respect of which the registration is requested, and (d) a representation of the trade mark. Article 26(2) provides that the application for a Community trade mark is to be subject to the payment of the application fee.

7. Article 27 of Regulation No 40/94, entitled ‘*Date of filing*’, is worded as follows:

‘The date of filing of a Community trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Office by the applicant or, if the application has been filed with the central office of a

Member State or with the Benelux Trade Mark Office, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents.’

8. Under Article 29 of that regulation, the right of priority is to apply during a period of six months from the date of filing of the first application. Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements is to be recognised as giving rise to a right of priority. By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

9. Article 32 of Regulation No 40/94 provides that a Community trade mark application which has been accorded a date of filing is, in the Member States, to be equivalent to a regular national filing, where appropriate with the priority claimed for the Community trade mark application.

10. Article 97 of Regulation No 40/94, entitled ‘*Applicable law*’, provides:

‘1. The Community trade mark courts shall apply the provisions of this Regulation.

2. On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.

3. Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State where it has its seat.’

11. Rule 5 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94, (4) entitled ‘*Filing of the application*’, provides:

‘(1) The Office shall mark the documents making up the application with the date of its receipt and the file number of the application. The Office shall issue to the applicant without delay a receipt which shall include at least the file number, a representation, description or other identification of the mark, the nature and the number of the documents and the date of their receipt. ...’

C – National law

12. Article 6(2) of Law No 17/2001 of 7 December 2001 on trade marks (Ley 17/2001, de 7 de diciembre, de Marcas, BOE No 294 of 8 December 2001, p. 45579, ‘*Law No 17/2001 on trade marks*’) defines what is meant by earlier trade marks as follows:

‘(a) registered trade marks of the following kinds with a date of filing or date of priority of the application for registration which is earlier than the date of the application under consideration: (i) Spanish trade marks; (ii) trade marks registered under international arrangements which have effect in Spain; (iii) Community trade marks.

(b) registered Community trade marks whose proprietor, in accordance with the legislation on Community trade marks, validly claims seniority over one of the trademarks referred to in subparagraph

(a)(i) and (ii), even if that latter trade mark has been surrendered or has lapsed.

(c) applications for the trade marks referred to in subparagraph (a) and (b), subject to confirmation of their registration.

(d) non-registered trade marks which, on the date of filing or on the date of priority of the application for registration of the trade mark under consideration, are “well known” in Spain, in the sense in which the words “well known” are used in Article 6 bis of the Paris Convention.’

13. Article 11 of that law, entitled ‘Filing of applications’, provides:

‘(1) An application for registration of a trade mark shall be filed at the competent body of the Autonomous Community in which the applicant has his domicile or a real and effective industrial or commercial establishment. ...

...

(6) The body competent to receive the application shall, upon receipt of the application, record the number of the application and the date, hour and minute of its receipt, in the manner to be determined by regulation.’

14. Article 12 of Law No 17/2001 on trade marks, which lays down the conditions with which applications must comply, is worded as follows:

‘(1) An application for registration of a trade mark shall contain, at least: a request for the registration of the trade mark; the identity of the applicant; a representation of the trade mark; a list of the goods or services in respect of which the registration is requested.

...

15. Article 13 of Law No 17/2001 on trade marks provides:

‘(1) The date of filing of an application shall be the date on which the competent body, as defined in Article 11, receives the documents containing the information specified in Article 12(1).

(2) The date of filing of applications filed at a post office shall be the time at which that office receives the documents containing the information specified in Article 12(1), provided that those documents are filed in an unsealed envelope, by registered post and with acknowledgment of receipt, addressed to the body competent to receive the application. The post office shall record the day, hour and minute of the filing of the application.

(3) If any of the bodies or administrative units referred to in the preceding paragraphs fails to record, at the time the application is received, the hour of its filing, the application shall be assigned the final hour of the day. If the minute has not been recorded, the application shall be assigned the final minute of the hour. If neither the hour nor the minute of filing has been recorded, the application shall be assigned the final hour and minute of the day in question.’

III – The dispute in the main proceedings, the question referred and the procedure before the Court

16. Génesis Seguros Generales Sociedad Anónima de Seguros y Reaseguros (‘Génesis’) filed with the Office for Harmonisation of the Internal Market (‘OHIM’), by electronic means, two applications for registration of Community trade marks: the word mark RIZO, No 3 543 361, in Classes 16, 28, 35 and 36 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, (‘the Nice Classification’) and the word mark RIZO, EL ERIZO, No 3 543 386, in Classes 16, 35 and 36 of that classification.

17. The referring court points out that, in the light of the evidence which was presented before it, the electronic applications for those two Community trade marks were transmitted (5) to OHIM at 11.52 and at 12.13, respectively, on 12 December 2003.

18. It is also stated in the order for reference that, at 17.45 on 12 December 2003, the company Pool Angel Tomas SL applied to the Oficina Española de Patentes y Marcas (‘the OEPM’) for registration in Spain of the word mark RIZO’S, No 2 571 979-3, in Class 28 of the Nice Classification.

19. Génesis opposed the application for registration of the aforementioned national trade mark RIZO’S, relying on its right of priority based on the Community trade marks RIZO, No 3 543 361, and RIZO, EL ERIZO, No 3 543 386.

20. By decision of 9 December 2004, the OEPM rejected the opposition, on the ground that the trade marks relied on did not have priority over the trade mark applied for, and granted registration of the trade mark RIZO’S.

21. Génesis brought an appeal seeking a declaration by the OEPM that the Community trade marks of which Génesis is the proprietor have priority, based on the fact that the application for registration of those Community trade marks had been filed, by electronic means, on 12 December 2003 and that that date should be taken into consideration for that purpose.

22. By decision of 29 June 2005, the OEPM dismissed that appeal, pointing out that the date of filing of the Community trade marks of which the appellant was the proprietor was later than the date of filing of the Spanish trade mark RIZO’S, since, on the basis of Article 27 of Regulation No 40/94, the applications for the Community trade marks were not assigned a date of filing until 7 January 2004.

23. In appeal proceedings brought by Génesis against the latter decision, the Second Section of the Chamber for Contentious-Administrative Proceedings of the Tribunal Supremo de Justicia de Madrid confirmed, by judgment on 7 February 2007, that the decision granting registration of the Spanish trade mark applied for, RIZO’S, was well founded. That court considered that the date of filing of the opposing Community trade marks was the date on which the documentation was actually submitted and not 12 December 2003, the date on which the application was filed by electronic means.

24. In its appeal against the judgment of 7 February 2007, Génesis challenges, first, the interpretation of the

Tribunal Superior de Justicia de Madrid concerning the date of filing of the Community trade mark application and states that the correct interpretation of Articles 26 and 27 of Regulation No 40/94 would result in the date of filing of the applications being regarded as the date on which they were transmitted to and received by OHIM, that is to say 12 December 2003. Secondly, Génesis considers that, by failing to recognise the priority of the Community trade marks RIZO, No 3 543 361, and RIZO, EL ERIZO, No 3 543 386, the Tribunal Superior de Justicia de Madrid infringed Article 6(2) of Law No 17/2001 on trade marks, which provides, in subparagraphs (a) and (c), that priority is to be given to applications for Community trade marks with a date of filing prior to the applications for registration filed with the OEPM.

25. The Tribunal Supremo notes that, whilst providing that the filing date of the Community trade mark application is that on which that application is filed at OHIM or at bodies referred to by that provision, Article 27 of Regulation No 40/94 lays down no other order of filing where filings take place on the same day. However, the rule used in Spain to determine the priority of trade marks where applications are filed on the same day is that priority is to be given according to the hour and minute of filing with the OEPM.

26. In those circumstances, the Tribunal Supremo decided to stay proceedings and to refer the following question to the Court for a preliminary ruling:

'May Article 27 of ... Regulation ... No 40/94 ... be interpreted in such a way as to enable account to be taken not only of the day but also of the hour and minute of filing of an application for registration of a Community trade mark with OHIM (provided that such information has been recorded) for the purposes of establishing temporal priority over a national trade mark application filed on the same day, where the national legislation governing the registration of national trade marks considers the time of filing to be relevant?'

27. That application was lodged at the Court Registry on 16 April 2010. Written observations have been submitted by Génesis, by the Spanish, Italian and Greek Governments and by the European Commission.

IV – The question referred

A – General remarks on the trade mark system

28. As a preliminary point, I would like to emphasise the characteristics of the trade mark system, namely, first, its inherently international dimension and, secondly, its necessary territorial limitation. Moreover, it is important to take into account the existence of several systems of trade mark protection, which include that of the European Union. (6)

29. The characteristic features of trade marks were already apparent from the travaux préparatoires for the Paris Convention. (7) As regards establishing the system applicable to the protection of industrial property, the first proposal consisting in the adoption of uniform supranational legislation was rejected as utopian and unrealistic. The second proposal for the adoption of rules of conflict of laws under which it

would be necessary to apply the law of the country of origin of the invention or of registration of the trade mark was regarded as unfair. Under Article 2 of the convention, its authors therefore opted for the third proposal, namely the national treatment principle. (8) In accordance with the principle of territoriality (*lex loci protectionis*), the legal effects of a trade mark are limited to the territory of the particular State of protection. (9)

30. In European Union law, trade mark law constitutes an essential element in the system of undistorted competition. In that system, each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs enabling the consumer, without any possibility of confusion, to distinguish those goods or services from others which have another origin. (10)

31. The harmonisation of laws in the field of trade mark law is based on two series of texts applied in parallel, but nevertheless linked in several respects. They are, on the one hand, the Community trade mark system, that is to say the industrial property law provided for by Regulation No 40/94, which established a uniform system of trade mark law extending to the entire territory of the European Union. On the other hand, by means of Directive 89/104, the EU legislature made an effort to harmonise national laws without altering the principle of territoriality, that is to say, the linking of the legal effects of a trade mark to the territory of the particular Member State.

32. It should be pointed out, however, that, in accordance with the fifth recital in the preamble to Regulation No 40/94, Community law relating to trade marks does not replace the laws of the Member States on trade marks. National trade marks continue to exist because they are judged to be necessary for undertakings which do not wish to opt to protect their trade mark at the EU level. (11)

33. The Community trade mark therefore supplements the national systems of protection. As stated in the first and third recitals in the preamble to Directive 89/104, that directive seeks partial harmonisation, limited to those national provisions of law which most directly affect the functioning of the internal market. (12)

34. The protection of trade marks is therefore characterised, within the European Union, by the coexistence of several systems of protection, which may lead to multiple trade mark filings and, as we shall see, in exceptional cases, to the existence of valid concurrent registrations.

B – The registration and filing date of a trade mark in EU law

35. With regard to registration of a Community trade mark, the provisions of Regulation No 40/94 attach to the filing of such a trade mark consequences in various respects.

36. First, under Article 46 of Regulation No 40/94, the 10-year period of protection of the trade mark starts to run from the date of filing. Secondly, as is clear from Article 8(2)(a) and (b) of Regulation No 40/94, the date of filing of the application, as defined in Article 27 of

that regulation, determines the priority of one trade mark over another. (13) Thirdly, the date of filing is relevant for assessing any distinctive character of a trade mark capable of having been acquired through use prior to the filing of the application for the purposes of Article 7(3) of Regulation No 40/94. Finally, the time of filing the application for registration is relevant for determining whether there was bad faith on the part of the applicant, within the meaning of Article 51(1)(b) of Regulation No 40/94, in the context of determining absolute grounds for the invalidity of a trade mark. (14) 37. It follows that precise determination of the date of filing is a constituent of the Community trade mark system. In so far as this reference for a preliminary ruling is concerned with determining the meaning and scope of Article 27 of Regulation No 40/94, it is necessary, first of all, to determine the nature of the concept of ‘*date of filing*’ within the meaning of that provision.

38. It must be pointed out, as a preliminary point, that the Paris Convention does not include substantive rules governing the conditions of filing, but, on the contrary, provides in Article 4(A)(2) thereof that the regularity of filings is to be determined by the domestic legislation of any country of the Union or by bilateral or multilateral treaties concluded between them. Indeed, although that convention stated that the contracting States constitute a Union for the protection of industrial property, it included several provisions requiring those States to legislate in the field of intellectual property or allowing them to do so. (15)

39. However, Regulation No 40/94 contains a specific provision governing the conditions for filing a Community trade mark. Under Article 27 of that regulation, the date of filing of a Community trade mark application is to be the date on which documents containing the information specified in Article 26(1) are filed with OHIM by the applicant or, if the application has been filed with the central office of a Member State or with the Benelux Trade Mark Office, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents. (16)

40. It is therefore apparent from Article 27 of Regulation No 40/94 that that provision makes no express reference to the law of the Member States.

41. In that regard, according to settled case-law, the need for a uniform application of Community law and the principle of equality require that the terms of a provision of European Union law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must normally be given an independent and uniform interpretation throughout the European Union; that interpretation must take into account the context of the provision and the objective of the relevant legislation. (17)

42. In the context of the registration of a Community trade mark, registrations of earlier national trade marks are to be taken into consideration as legally relevant

facts, to which EU rules attach specific legal consequences.

43. It follows that OHIM is under no obligation to follow the assessment of the authority with jurisdiction over trade marks in the country of origin or to lay down the same requirements, or to register the mark applied for on the basis of the registration decisions taken by national patent and trade mark offices. (18)

44. Accordingly, I consider that determining the ‘*date of filing*’ of a Community trade mark is a question governed solely by EU law, which takes into account, in that regard, the relevant international conventions. In so far as Regulation No 40/94 provides no legal definition of the expression ‘*date of filing*’, the scope and meaning of that expression must be sought in that regulation.

C – The date of filing of the application in the main proceedings

45. Before commencing the analysis of the key concept for the purpose of these proceedings, I must point out, from reading the order for reference, the uncertainty surrounding a factual element which lies at the heart of the dispute in the main proceedings, that is the determination of the filing date of the trade mark applications at issue. (19)

46. It is clear from the order for reference that the two applications for the Community word marks RIZO and RIZO, EL ERIZO were filed with OHIM, by electronic means, on 12 December 2003. The referring court therefore asks whether that date of transmission by electronic means must be regarded as the authentic filing date for the Community trade mark.

47. It is clear from the order for reference that the appeal brought by Génesis against the contested decision of the OEPM was dismissed by judgment of the Tribunal Superior de Justicia de Madrid on the ground, in essence, that the date of filing of the opposing Community trade marks is 7 February 2004, the date the documentation was actually produced, and not 12 December 2003, the date on which the application was filed by electronic means.

48. In that regard, it should be pointed out that OHIM makes an electronic filing (‘*e-filing*’) service available to users, allowing them to file their applications for Community trade marks online. That service offers several advantages, including the guarantee of the date of filing within the meaning of Article 27 of Regulation No 40/94.

49. In the light of the wording of that provision, it must be recalled that the date of filing the application by electronic means accompanied by all the documents required by Regulation No 40/94 and followed by payment of the application fee within a period of one month must be regarded as the date of filing within the meaning of Article 27 of that regulation. OHIM has provided interested persons with the technical means necessary to annex the required documents. (20)

50. However, in the case of a simple electronic filing of an application for registration which does not result in the concomitant filing of the required documents, the date of filing within the meaning of Article 27 of

Regulation No 40/94 will be that on which all the required documentation is actually filed with OHIM. This is therefore a date subsequent to the electronic filing of that application.

51. Accordingly, for the purposes of applying the expression '*the date of filing*' within the meaning of Article 27 of Regulation No 40/94, it is for the referring court to ascertain the date on which all the required documents were actually produced by Génesis, for the purposes of its applications for registration, and then the date of payment of the fee.

52. It is only after dealing with that aspect that it is appropriate to address the more precise temporal aspects referred to by the referring court.

D – Taking into account the hour and minute in the context of applying the concept of '*date of filing*' within the meaning of Regulation No 40/94

53. By its question, the referring courts asks, in essence, whether it is possible to take into account, for the purposes of applying Article 27 of Regulation No 40/94, the hour and minute of filing of the application for registration, since those elements may contribute in determining any priority over a national trade mark whose registration has been applied for on the same date. In such a situation in which the filing dates coincide, Spanish law determines the priority of trade marks on the basis of the hour and minute of filing.

54. That question therefore deals with the principle of priority under which an earlier right makes it possible to oppose all subsequent signs which conflict with it. (21) The opposition procedure initiated on the basis of national law by Génesis seeks, therefore, to establish that the two Community trade marks are '*earlier trade marks*' within the meaning of the national legislation, which reproduces the definition of precedence set out in Regulation No 40/94. (22)

55. The analyses of the scope of the concept of '*date of filing*' proposed by the parties which submitted observations in the course of these proceedings differ substantially. Like the Spanish and Italian Governments and the Commission, I am of the view that the hour and minute of filing a Community trade mark application are not elements which are relevant for the purposes of applying Article 27 of Regulation No 40/94. It seems to me that the '*date of filing*' refers only to the '*calendar day*'. The latter concept is, in my view, equivalent to a calendar day from midnight to midnight, the month and year of which are numbered according to the Gregorian calendar, and to a corresponding day in the other calendar systems. (23) A calendar day may therefore be the same notwithstanding real-time variations due to time zones. (24)

56. There are several elements which, in my view, support that interpretation.

57. In the first place, I note that the Paris Convention system, to which all the Member States are parties, selected the date understood as a single day or calendar day as the basic unit of calculation. Indeed, the regularity of a filing is assessed solely in the light of that element. Such a filing is regarded as having taken

place as soon as, in accordance with the national legislation of the country in which it occurs, an application which complies with the formal requirements has been filed, and even if that application was formally incomplete or incorrect, it is adequate to establish the date of filing. (25)

58. In that regard, it should be pointed out that the introduction of that basic unit of calculation was closely linked to what is commonly known as the '*convention priority*' adopted by the Paris Convention, according to which a person who files a trade mark in another country within a period of six months from the filing of his trade mark in his country of origin benefits there from the initial date of protection which he obtained in the country of origin. (26) Indeed, under Article 4(C)(2) of that convention, the six-month period starts from the date of filing of the first application, the day of filing not being included in the period. Consequently, the hour and minute of filing have no relevance for the purposes of calculating the priority period. (27)

59. Regulation No 40/94 contains its own rules which follow the system laid down in the convention by establishing, in Article 29, a right of priority that includes applications for registration made in any country that is party to the convention or in a country that is party to the Agreement establishing the World Trade Organisation. (28) By virtue of the right of priority, the rights attached to the Community trade mark are deemed to arise from the date of priority, that is to say the day of filing the national application. (29)

60. I therefore consider that it is not possible to record with greater precision the date of filing referred to in Article 27 of Regulation No 40/94. It would seem to me to be particularly impossible, since from the outset that concept has been attributed a precise function when applying the priority principle referred to above, not only at EU level, but also for the purposes of applying international rules on the effects of trade mark registration. In that regard, it should be noted that an earlier trade mark may also be protected by means of registration under an international arrangement. (30) 61. It is true that it is clear from the information on OHIM's site that the date of filing is that on which the documents referred to in Article 26 are filed with OHIM, Central European Time (GMT +1). (31) I consider, however, that the time which is specified there serves to establish the date of filing with OHIM and not to confer temporal priority based on the hour and minute of filing.

62. That argument is also confirmed by a literal interpretation of the wording of Article 27 of Regulation No 40/94, which merely refers to the '*date*'. Moreover, it is apparent from Rule 5 of Regulation No 2868/95 that OHIM is to mark the documents making up the application only with the date of its receipt and the file number of the application. It is to issue to the applicant without delay a receipt which is to include at least the file number and the date of receipt of the application.

63. Secondly, an interpretation which does not take into account the hour and minute of filing is also supported by the purpose and the nature of EU legislation. As I have already stated in points 30 to 34 and 39 to 43 of this Opinion, the objective of Regulation No 40/94 was not to harmonise the laws of the Member States, but to establish a single system of industrial property law which is valid throughout the European Union. Moreover, having regard to the autonomous nature of the concepts of EU law contained in Regulation No 40/94, the legal solutions adopted in national law cannot be taken into account for the purpose of interpreting the Community trade mark system. Lastly, as the Commission correctly states, such an approach is confirmed by Articles 14 and 97 of that regulation, read in conjunction, since it is clear that the applicability of national law is limited to questions which fall outside the scope of Regulation No 40/94.

64. Thirdly, it is important to emphasise the relevance of Article 32 of Regulation No 40/94, from which it follows that the filing of a Community trade mark is equivalent to the filing of a national trade mark in the Member States, for the purpose of determining, where necessary, the right attached to the Community trade mark application. That article refers only to the date of filing.

65. As the Spanish Government points out, Article 32 of Regulation No 40/94 neither amends the Community concept of the date of filing nor presupposes the secondary application of national law, but simply recognises that Community trade mark applications filed with OHIM are legally equivalent to those filed with national offices. If, notwithstanding the wording of Article 27 of Regulation No 40/94, the Court should adopt a broad interpretation of that provision, that would place all applicants for trade marks under an obligation to register them with OHIM in order to ensure their right of priority not only over other national trade marks, but also over other Community trade marks, which would be contrary to the principle that the Community trade mark does not replace the national trade marks.

66. Lastly, it is essential to point out that there are several practical difficulties connected with applying real-time priority rather than applying the concept of the calendar day in the context of the Community trade mark system.

67. First of all, the existence of various time zones throughout the European Union seems to me, at the present time, to make it impossible to establish the real-time priority of a Community trade mark. Indeed, the territory of Europe covers four time zones. (32)

68. In the light of that diversity, taking into account the hour and the minute of filing of a trade mark application would involve establishing a rule governing temporal conflicts between several national systems. It is not inconceivable that real-time priority would also lead to some confusion, given the many means of communication and their differing quality within several Member States. (33) In order to end that confusion, it would be necessary not only to record the

hour and minute of the application, but also to ensure that the information systems available to the national authorities exactly follow atomic time or Greenwich Mean Time. (34)

69. Accordingly, the issue of the date of filing would be pointlessly transformed into a debate on nominal, or even actual, units. Thus, for example, 00.30 on 1 January in Finland corresponds, in real time, to 23.30 on 31 December in the majority of the Member States.

70. It is true that the possibility of electronic registration is provided for in several Member States. (35) It seems to me, however, that it is important to distinguish between the possibility of filing an electronic application and the introduction of a system of real-time priority. The introduction by OHIM or by certain Member States of the possibility of electronic filing, in order to modernise and facilitate access to the protection of industrial property, does not necessarily entail taking into account the hour and minute of filing the application for registration in order to establish the precedence of the trade mark. (36)

71. Consequently, I consider that taking into account the hour and the minute in order to establish the precedence of a trade mark for the purposes of Article 27 of Regulation No 40/94 would be possible only if a uniform system of administrative procedures for the electronic registration of both Community and national trade marks were established throughout the European Union. That would also entail the application of the Greenwich Mean Time system, that is to say the complete harmonisation of the statutory time systems of the European States. It goes without saying that the introduction of such a system should be clearly provided for in EU legislation and in the national laws of the Member States, (37) and cannot arise from the case-law.

72. In that regard, it should also be observed that Article 27 of Regulation No 207/2009, relating to the date of filing, is worded in terms identical to those of the corresponding article of Regulation No 40/94, which is the subject of the present reference for a preliminary ruling. It follows that the EU legislature has not yet provided for precision as to the hour and minute of filing.

73. In the alternative, I would further point out that Regulation (EC) No 6/2002 (38) also fails to provide for any reference to the hour and minute in relation to the date of filing of an application for registration of Community designs. Moreover, under that regulation, an applicant for a registered Community design enjoys, under certain circumstances, a right of priority. That has the effect that the date of priority is regarded as corresponding to the date of filing of the application for registration of a Community design. (39)

74. In the light of the foregoing considerations, if it must be accepted, first, that the applications for the trade marks at issue were filed on the same day and, secondly, that taking into account the hour and minute must be precluded, it would follow that the two trade marks at issue could, in principle, be registered. The

question would therefore arise of the coexistence of the national trade mark with the Community trade mark.

E – The coexistence of trade marks on the market

75. The coexistence of two concurrent registrations of identical trade marks is a well known and sometimes inevitable phenomenon in the European Union. This is indisputably an imperfect situation, which stems from the multinational and diverse nature of the systems of trade mark protection and from the wide range of undertakings which are proprietors of trade marks.

76. It should be noted that such coexistence may have an effect on the outcome of opposition proceedings or of an application for a declaration of invalidity of a trade mark. That outcome varies according to whether the coexistence concerns the conflicting trade marks or an earlier trade mark and trade marks which are the property, not of the proprietor of the Community trade mark, but of third parties. Coexistence may, accordingly, be suffered by the proprietor of the earlier right or agreed upon by the parties under an agreement. (40)

77. It is common ground that, in order to remedy that phenomenon, the two proprietors may have recourse to a coexistence agreement to prevent any conflict. (41) Furthermore, national laws provide specific solutions, such as the principle of honest concurrent use, the lawfulness of which, from the perspective of EU law, seems to be open to dispute. (42)

78. As the Commission pointed out in its observations, coexistence has been recognised since the introduction of the Community trade mark, as on 1 April 1996, the date on which the register of Community trade marks was opened, OHIM registered all the trade marks whose registration had been applied for previously. (43)

79. In any event, the possibility of registering identical trade marks for identical products or services having the same date of priority has always existed in systems based on the Paris Convention. Coexistence, while being undesirable, thus forms an integral part of the concept of a trade mark.

V – Conclusion

In the light of all the foregoing considerations, I propose that the Court should answer the question referred by the Tribunal Supremo as follows:

As European Union law presently stands, Article 27 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark precludes taking into account, in addition to the day of filing the application for a Community trade mark, the hour and minute of that filing.

1 – Original language: French.

2 – Council Regulation of 20 December 1993 on the Community trade mark (OJ 1993 L 11, p. 1), repealed by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. In the light of the date of the facts in

the main proceedings, this request for interpretation relates to Regulation No 40/94.

3 – The Paris Convention for the Protection of Industrial Property of 20 March 1883 is accessible at the following address: http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html.

4 – OJ 1995 L 303, p. 1.

5 – But not received or registered by OHIM.

6 – Müller, B.K., *Multinational Trademark Registration Systems*, Bern, 2002.

7 – It should be pointed out that, in accordance with the 12th recital in the preamble to First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), all Member States of the Community are bound by the Paris Convention, so that it is necessary that the provisions of that directive are entirely consistent with those of the Paris Convention.

8 – Beier, F.-K., ‘*One Hundred Years of International Cooperation — The Role of the Paris Convention in the Past, Present and Future*’, *International Review of Industrial Property and Copyright Law*, Vol. 15, No 1-6/1984, p. 1.

9 – Sabatier, M., *Pratique de la marque internationale*, Institut de Recherche en Propriété intellectuelle Henri-Desbois, Year 2007, No 8. See, in that regard, point 50 et seq. of the Opinion of Advocate General Trstenjak in Case C-482/09 *Budějovický Budvar*, pending before the Court.

10 – See, to that effect, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraphs 21 and 22; Case C-206/01 *Arsenal Football Club* [2002] ECR I-10273, paragraphs 47 and 48; Case C-228/03 *Gillette Company and Gillette Group Finland* [2005] ECR I-2337, paragraph 25; Case C-412/05 *P Alcon v OHIM* [2007] ECR I-3569, paragraphs 53 and 54; and Case C-48/09 *P Lego Juris v OHIM* [2010] ECR I-8403, paragraph 38.

11 – Bonet, G., ‘*La marque communautaire*’, *Revue trimestrielle de droit européen*, No 1, 1995, p. 59.

12 – By way of illustration of that limitation, see point 79 of the Opinion of Advocate General Cruz Villalón in Case C-96/09 *P Anheuser-Busch v Budějovický Budvar*, pending before the Court. Moreover, the Court has already held that partial harmonisation does not preclude the harmonisation relating, in particular, to the provisions of national law which most directly affect the functioning of the internal market from being complete. See Case C-355/96 *Silhouette International Schmied* [1998] ECR I-4799, paragraph 23, and Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 27.

13 – The date of filing is therefore relevant for establishing whether there is an ‘*earlier trade mark*’ within the meaning of Article 8 of Regulation No 40/94 and a trade mark with a date of application for registration which is earlier than the date of application for registration of the trade mark [in accordance with Article 4(2)(a)(i) of Directive 89/104].

14 – See, in that regard, Case C-529/07 *Chocoladefabriken Lindt & Sprüngli* [2009] ECR I-4893.

15 – Bodenhausen, G.H.C., *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, BIRPI, 1969, p. 11.

16 – It should be noted that the principle of a single international filing nonetheless based on the registration of a trade mark in the country of origin was introduced by the Madrid Agreement of 14 April 1891 and by the Madrid Protocol of 27 June 1989 on international marks. See Sabatier, M., *Pratique de la marque internationale*, pp. 5 to 7.

17 – See, ex multis, Case C-245/00 *SENA* [2003] ECR I-1251, paragraph 23, and Case C-467/08 *Padawan* [2010] ECR I-10055, paragraph 32.

18 – See, in that regard, Case C-238/06 *P Devey v OHIM* [2007] ECR I-9375, paragraphs 71 to 73, and judgment of 17 December 2010 in Case T-395/08 *Chocoladefabriken Lindt & Sprüngli v OHIM* (Shape of a chocolate rabbit).

19 – The order for reference contains no definitive ruling on this factual element and the observations submitted by Génesis are not unambiguous on this matter. Only the Commission, in its written observations, has produced annexes which support the argument that the filing date is 12 December 2003.

20 – See: http://oami.europa.eu/help/html/help_en.html. It seems that OHIM does not officially record the hour and minute of filing of the trade mark. Consequently, the details on that matter provided by the referring court are not based on information recorded by OHIM. Neither the Community Trade Marks Bulletin (http://oami.europa.eu/bulletin/ctm/ctm_bulletin_en.htm) nor the OHIM database (CTM-Online) refer to the hour or minute of filing.

21 – Under Article 6 of Law No 17/2001 on trade marks, signs may not be registered if they are identical with an earlier trade mark or if there exists a likelihood of confusion. See Articles 4(1) and 5(1) of Directive 89/104.

22 – See Article 8(2) of Regulation No 40/94.

23 – See, in that regard, Article 4(2) of Regulation (EEC, Euratom) No 1182/71 of the Council of 3 June 1971 determining the rules applicable to periods, dates and time-limits (OJ, English Special Edition, Series I, 1971 (II), p. 354), from which it is clear that the entry into force, taking effect or application of acts of the Council or Commission – or of provisions of such acts – fixed at a given date is to occur at the beginning of the first hour of the day falling on that date. See Case T-146/00 *Ruf and Stier v OHIM* ('*DAKOTA*' Image) [2001] ECR II-1797, paragraphs 23, 27 and 55.

24 – As demonstrated, for example, by the celebration of the New Year throughout the world.

25 – According to Article 4(A)(3) of the Paris Convention, under that Convention a regular national filing means any filing that is adequate to establish the date on which the application was filed in the country

concerned. See Bodenhausen, G.H.C., *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, op. cit., p. 42.

26 – Article 4 of the Paris Convention lays down a period of six months within which a person applying for registration of a trade mark in one of the countries of the Union may apply for the same mark in the other countries of the Union without any subsequent application or applications made by him being affected by applications for registration of the same mark made by third parties. The right of priority thus confers upon the applicant for a limited period of time immunity from the effects of any other applications for registration of the same trade mark that may be made by third parties during the priority period. See Case T-128/99 *Signal Communications v OHIM* (TELEYE) [2001] ECR II-3273, paragraphs 36 to 40.

27 – With regard to the calculation of the priority period, the same calculation applies at international level to patents (the day of filing of the earlier application is not to be included in that period. See Rule 2.4 of the Regulations: <http://www.wipo.int/pct/en/texts/rules/r2.htm>).

28 – The right of priority arises when an initial application for registration of a trade mark is made in one of the abovementioned countries. It is an autonomous right in that it exists independently of the eventual outcome of that initial application. Where a Community trade mark application is accompanied by a claim of priority, the right of priority becomes an essential component of the application in that it determines one of its essential features, namely the filing date, which, for the purpose of determining the precedence of rights, will be the same as that of the initial application. See *Signal Communications v OHIM*, cited above in footnote 26.

29 – If the required conditions are met, the Community trade mark takes effect retroactively on the day of the date of filing of the trade mark applied for. Bonet, G., '*La marque communautaire*', op. cit.

30 – See Article 8(2)(a)(iii) of Regulation No 40/94 and Article 8(2)(a)(iv) of Regulation No 207/2009, which refer to trade marks registered under international arrangements which have effect in the Community.

31 – <http://oami.europa.eu/ows/rw/pages/QPLUS/forms/electronic/fileApplicationCTM.en.do>

32 – See Recommendation No 1432 (1999) of the Council of Europe on the Observance of the system of European time zones, available at the address <http://assembly.coe.int/Documents/AdoptedText/ta99/rec1432.htm#1>. In order to compare those time zones see: http://europa.eu/travel/time/index_en.htm

33 – It suffices to refer, in that regard, to the order for reference, which states that the applications were filed at 11.52 and 12.13, respectively, whereas the contested decision of the OEPM states that the applications were filed at 11.31.

34 – Civil time, now defined by the time of atomic clocks, is called universal coordinated time (UTC). A

UTC day is approximately 0.9 seconds longer than the average day.

35 – According to my non-exhaustive research, the following States provide for such a possibility: the Kingdom of Belgium, the Czech Republic, the Kingdom of Denmark, the Kingdom of Spain, the French Republic, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Finland, the Kingdom of Sweden and the United Kingdom of Great Britain and Northern Ireland. See: <http://www.wipo.int/directory/en/urls.jsp>.

36 – By way of example, it is perfectly conceivable that, given the limited opening times of the national trade mark offices, an electronic transfer carried out at 23.00 would result in the registration of the application on the following day, or even the same day, and not a registration in real time, for the purpose of establishing precedence over another Community or national trade mark. As I pointed out in footnote 20, it seems that OHIM does not officially record the hour and minute of the filing of a trade mark.

37 – The efforts made with regard to the standardisation of time stem, in particular, from Directive 2000/84/EC of the European Parliament and of the Council of 19 January 2001 on summer-time arrangements (OJ 2001 L 31, p. 21), which provides that the 60 minutes by which clocks are put forward compared with the rest of the year is to be calculated in every Member State at 01.00, Greenwich Mean Time, on the last Sunday in March. It is also appropriate to note that, in the context of the Madrid Agreement and the Madrid Protocol, specific rules relating to the time of the filing apply (Rule 4 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, entitled ‘*Calculation of Time Limits*’ available at the following address: http://www.wipo.int/madrid/en/legal_texts/common_regulations.htm#rule_4). At the time of a filing, a record of the precise time is not one of the official entries which is to be included in the application. However, in accordance with Section 11 on electronic communications, (Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto) available at the following address: http://www.wipo.int/madrid/en/legal_texts/admin_instructions.htm#P120_6713, where, because of the time difference, the date on which the sending started is different from the date of receipt, the earlier date is to be considered as the date of receipt by the International Bureau. See, Sabatier, M., *Pratique de la marque internationale*, op. cit., p. 26.

38 – Council Regulation of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

39 – Under Rule 2 [point 2.4(a) of the Rules under the Patent Cooperation Treaty (PCT) (text available at the address:

http://www.wipo.int/pct/en/texts/rules/r2.htm#_2_4], the day of filing of the earlier application is not to be included in the priority period. Moreover, special rules

are provided for in case of expiration of a period on a non-working day or official holiday (see Rule 80, point 80.5, available at the address: http://www.wipo.int/pct/en/texts/rules/r80.htm#_80_5).

40 – Folliard-Monguiral, ‘*Conditions et effets de la coexistence de marques en droit communautaire*’, *Propriété industrielle*, No 9, September 2006, étude 24.

41 – Elsmore, M.J., ‘*Trade Mark Coexistence Agreements: What is all the (lack of) fuss about?*’, *SCRIPT*-ed, Vol. 5, Issue 1, April 2008. Such an agreement is not always relevant for the purposes of assessing the likelihood of confusion, see judgment of 6 November 2007 in Case T-90/05 Omega v OHIM — Omega Engineering (Ω OMEGA), paragraph 49.

42 – See the Opinion of Advocate General Trstenjak in Case C-482/09 Budějovický Budvar in which she invites the Court to rule that Article 4(1)(a) of Directive 89/104 precludes the long-established honest concurrent use of two identical marks covering identical goods by two different proprietors of the marks.

43 – See Joined Cases T-350/04 to T-352/04 Bitburger Brauerei v OHIM —Anheuser-Busch (BUD) [2006] ECR II-4255.