

CASE COMMENT

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NEW BEFORE THE CJEU: THREE QUESTIONS ON THE ARTICULATION OF BAD FAITH AND PROTECTION OF TECHNICAL RESULT IN TRADEMARK REGISTRATIONS

Relationship between protection of shapes necessary to obtain a technical result and bad faith in trademark registrations: through three questions referred to the CJEU on 10 January 2024, the French Supreme court intends to gain clarity on the articulation of provisions of the Regulation No 207/2009 regarding absolute grounds of refusal for signs which consist of the shape of goods which is necessary to obtain a technical result, according to Article 7(1)(e)(ii), and on absolute ground of invalidity in case of bad faith, according to Article 52(1)(b).

CeramTec was the owner of an EP patent expired in 2011 on a ceramic composite material. A few days after the expiry, CeramTec filed for three EU trademarks consisting in a colour trademark of a Pantone pink and three-dimensional trademarks of a pink ball and representations of this ball from different angles and cross-sections, for products in class 10 related to surgical implants.

The Paris court of appeal considered that at the time of the application, CeramTec was convinced of the technical effect of the chromium oxide to guarantee the resistance of the ceramic material, which gave it its pink colour. The court ruled that CeramTec had had the intention not to register a sign guaranteeing the origin of the product but to extend the monopoly conferred by the expired patent rights, thus characterizing bad faith.



CeramTec seized the Cour de cassation. The Court pointed out that the Stuttgart court of appeal, seized of the same question, considered that the relevant ground for refusal lies with article 7(1)(e)(ii) of the Regulation. Faced with a difference of interpretation, the Court therefore decided to refer three questions to the CJEU:

- Is Article 52 of Regulation 207/2009 of 26 February 2009 on the Community trademark to be interpreted as meaning that the grounds for invalidity in Article 7, referred to in paragraph 1(a) are autonomous and exclusive of the bad faith referred to in paragraph 1(b)?
- If the answer to the first question is negative, can the applicant's bad faith be assessed solely based on the absolute ground for refusal of registration referred to in Article 7(1)(e)(ii) of Regulation No. 207/2009 without it being found that the sign applied for as a trademark consists exclusively of the shape of the product necessary to obtain a technical result?
- Is Article 52(1)(b) of Regulation (EC) No 207/2009 to be interpreted as precluding bad faith on the part of an applicant who has filed a trademark application with the intention of protecting a technical solution where it is discovered, subsequent to that application, that there was no link between the technical solution at issue and the signs constituting the trademark applied for?

