

## The EU Trade Mark in Infringement Proceedings

### **Exceptions to the principle of uniformity**

The principle of uniformity applies in registration proceedings, but not with the same strictness in infringement proceedings (*Sosnitza*, GRUR 2011, 465 et seq.).

#### **1. Likelihood of confusion, Art. 9 (2) (b) EUTMR**

In principle, the plaintiff does not have to show and prove that there is a likelihood of confusion in *all* Member States, since this is presumed. However, due to the language differences, a split traffic perception is conceivable. Thus, if the defendant proves that there is no likelihood of confusion in one Member State, an application for an injunction may not be granted for that Member State (ECJ, GRUR, 2011, 518, para. 48 - *DHL/Chronopost*; cf. *Sosnitza* MarkenR 2011, 193 et seq. GRUR 2011, 465, 468).

#### **2. Extended protection of well known marks, Art. 9 para. 2 lit. c) EUTMR**

A reputation "in the Union" is given if it exists "in a substantial part" of the Union. For this purpose, the reputation in one Member State can be sufficient (ECJ, GRUR 2009, 1158 para. 30 - *PAGO*).

It is disputed whether in this case the right to injunctive relief is also limited to this Member State (according to *Sosnitza*, GRUR 2011, 468).

### **3. Rights-preserving use**

For a long time, the question of the territorial area in which the use preserving the right must take place according to Art. 18 I EUTMR was disputed. It was sometimes argued that the use must take place in at least three member states, whereas the Council and the Commission also considered the use within a single Member State to be sufficient. The ECJ, on the other hand, has ruled that the assessment of use must be based on the single internal market and that state borders are therefore disregarded (ECJ, GRUR 2013, 182, para. 42, 44 - *ONEL/OMEL*; *Sosnitza*, GRUR 2013, 105, 108 et seq.).