

SPINNING out? The General Court annuls the EUIPO's decision to revoke the trademark "SPINNING"

Categories : [Trademark](#)

Date : Monday April 15th, 2019

Background

Mad Dogg Athletics Inc. (the applicant) obtained the registration of their trademark SPINNING on April 3rd, 2000, for goods in classes 9 (*audio and video cassettes*), 28 (*exercise equipment*) and 41 (*exercise training*). Aerospinning Master Franchising, s.r.o. (the intervenor) filed an application for partial revocation of the above trademark on February 8th, 2012 on the basis of Article 51(1)(b) of Regulation No. 207/2009 (what is now Article 58(1)(b) of Regulation 2017/1001) for classes 28 and 41.

Following the revocation of the contested mark in its entirety, and the subsequent annulment of this decision with regards to class 9 by the Cancellation Division further to an appeal by Mad Dog, the applicant has formed an appeal before the General Court requesting the annulment of the contested decision with regards to classes 28 and 41.

Decision

The applicant has relied on three pleas to challenge the prior decision rendered, namely: infringement of Article 51(1)(b) of Regulation No. 207/2009, Article 41(2)(a) of the Charter of Fundamental Rights of the European Union and Article 41(2)(c) of the same Charter.

Concerning the infringement of Article 51(1)(b) of Regulation No. 207/2009, the applicant alleged that there were errors of law with regards to the relevant **date, territory, public** to consider and assessment of **evidence** for evaluating the ground for revocation. Concerning the first complaint, the applicant claimed that the **date** to take into account is that on which the revocation decision responding to the application is adopted. However, the Court rejected this complaint, stating that **the revocation takes effect as of the date of the *application* for revocation**, or earlier should this be agreed between the parties.

Indeed, it was confirmed that in the case **where a revocation claim is made on the ground of absence of genuine use, only use arising prior to the revocation application can be considered**, without prejudice to the possibility to account for circumstances arising beforehand that may render it possible to confirm the nature of the use carried out.

The claimant further sought to demonstrate that they are entitled to submit evidence to show that actions were taken to educate the public as to the nature of the term SPINNING as a mark. However, the Court held that only evidence submitted within the permitted timeframe would be accepted.

The second complaint concerned the **territory** to be taken into account. The applicant argued that the assessment for revocation must extend beyond one Member State (Czech Republic in the present case) as the trademark has a reputation across the EU. Nevertheless, the Court disagreed with this point, invoking Recital 3 and Article 1(2) of Regulation No. 207/2009 (regarding the principle of unitary character of an EU trademark).

Indeed, the Court held that EU trademarks are offered uniform protection across the EU territory, and no adjustment is provided. **Thus, if such a mark has lost distinctive character or became a common name in one Member State, this is applicable to the entirety of the European Union.** As the regulation seeks to remove territorial barriers, an EU trademark confers upon the owner the possibility to distinguish the goods and services by identical methods throughout the Union territory.

The applicant further considered that to become a common term, the sign ought to have become a common name throughout the whole territory or at least the majority of the EU. However, the Court reminded that protection of a trademark across the EU signifies **that the owner must be vigilant and assert their rights throughout the entire territory.**

Concerning the third complaint regarding the **public** to take into account, the applicant argued that the Board of Appeal infringed the regulation no. 207/2009 by considering that the relevant public in question were limited to end users. Nevertheless, as the applicant had submitted that in 95% cases their indoor cycles were sold to professional customers, the Court held that the Board of Appeal erred in their determination of the relevant public. Indeed, the professionals played a crucial role in the market of exercise equipment and had an influence on the products purchased by end users.

Due to the error of assessment concerning the identification of the relevant public, the Court annulled the decision of the Board of Appeal with regards to Classes 28 and 41, the subject matter limited by the applicant, without considering the fourth complain and second and third pleas.

Comment:

Through its decision, the Court confirmed that the recognition of a trademark by a professional is sufficient for the sign to act as an indicator of origin. Indeed, this is an important point to consider for owners of trademarks covering goods and services that may be primarily targeted at professionals, who would then go on to sell the products to end users or influence their selection.



Nevertheless, it remains crucial to demonstrate active effort to ensure that a trademark remains an indicator of origin and keeping in consideration the Court's reminder of uniform protection and the aim of EU legislation to remove territorial barriers, thus that loss of distinctive character in one country has an impact on the entire territory. Therefore, it is of importance for trademark owners to evaluate the reach of their EU trademark portfolios and ensure that adequate efforts are made to maintain their trademark characteristic across the EU.

Case T-718/16, Mad Dogg Athletics, Inc., vs. EUIPO / Aerospinning Master Franchising, s.r.o.

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