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## Press and Information

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Judgment of the Court of First Instance in Joined Cases T-114/07 and T-115/07

*Last Minute Network Ltd v OHIM*

### **THE COURT ANNULS OHIM'S DECISION CONFIRMING THE REGISTRATION OF THE FIGURATIVE COMMUNITY TRADE MARK 'LAST MINUTE TOUR'**

*OHIM must re-examine the application for a declaration of invalidity made by proprietor of the earlier national trade mark 'lastminute.com'*

According to the Community trade mark regulation<sup>1</sup>, the proprietor of a non-registered national mark may obtain the cancellation of a more recent Community trade mark where national law gives him the right to prohibit the use of such a mark. In the United Kingdom, the law of passing off protects a non-registered mark against a more recent trade mark where a reputation attaches to the services of the proprietor of the non-registered mark in the mind of the relevant public by association with their get-up; the offer of the goods and services by the other company under the more recent trade mark constitutes misrepresentation; and, as a result, the proprietor of the non-registered mark is liable to suffer commercial damage.

In 2000, Last Minute Network (LMN), the proprietor of the web site [www.lastminute.com](http://www.lastminute.com), applied for registration of the word sign LASTMINUTE.COM as a Community trade mark. OHIM, the office which manages Community trade marks, refused that application on the ground that the sign was devoid of distinctive character.

In 2003, Last Minute Tour (LMT) obtained the Community registration of the following figurative sign for travel services and the corresponding goods:



The opposition brought by LMN against that registration was dismissed on the ground that it had not provided evidence, within the prescribed period, of the use of the earlier right relied on in support of its opposition.

<sup>1</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1)

LMN then submitted an application for a declaration that 'LAST MINUTE TOUR' was invalid. In support of its application, it submitted that the law in the United Kingdom on passing off gave it the right to prohibit the use of that mark in the United Kingdom and, therefore, to obtain its cancellation.

OHIM rejected that application. It took the view that the relevant public, in this case the average consumer in the United Kingdom, faced with the mark 'LAST MINUTE TOUR', would think that the undertaking in question offered 'last minute' holidays, without imagining that those offers might originate from the proprietor of the mark LASTMINUTE.COM. OHIM held that LMN's reputation was associated with the sign LASTMINUTE.COM as a whole and not with the generic term 'last minute'. It added that as the distinctive character of the two marks was very limited, the public would concentrate its attention on their distinctive and dominant elements, in particular, the extension '.com' of the non-registered mark and the graphic element of the Community mark.

LMN appealed against that decision before the Court of First Instance.

In its judgment today, **the Court finds that OHIM misinterpreted the applicable criteria of the relevant national law and, therefore, annuls OHIM's decision.**

The Court considers that the Board of Appeal made an incorrect assessment of the relevant public. According to the relevant national case-law, the misrepresentation of the goods and services by the defendant in an action for passing off must be determined with regard to the claimant's customers. OHIM could not therefore take the view that the relevant public was constituted of average users of the goods and services concerned residing in the United Kingdom who are reasonably well informed and reasonably observant and circumspect; rather it should have considered the customers of the proprietor of the non-registered national mark.

Next, the Court observes that it is clear from the case-law of the courts of the United Kingdom on passing off that a mark, including its constituent elements, may acquire an independent reputation on account of the way in which it is used, even though it is descriptive or is devoid of distinctive character. Consequently, OHIM could not refuse to acknowledge the possibility that the words 'last minute' had an independent reputation solely on account of their generic nature.

Finally, the Court declares that, by failing to take account of the possible existence of an independent reputation for the expression 'last minute' with respect to LMN's customers, and by concentrating on the elements specific to each of the two marks at issue when it examined whether the goods and services concerned were misrepresented, OHIM's comparison of the two marks was too formal.

As a result of the annulment of the decision, OHIM must re-examine the application for cancellation of the Community trade mark 'LAST MINUTE TOUR' in the light of all the conditions for an action for passing off.

**REMINDER: An appeal, limited to points of law only, may be brought before the Court of Justice of the European Communities against a decision of the Court of First Instance, within two months of its notification.**

*Unofficial document for media use, not binding on the Court of First Instance.*

*Languages available: ES, DE, EN, FR, IT, NL, RO*

*The full text of the judgment may be found on the Court's internet site  
<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=rechercher&numaff=T-114/07>  
and T-115/07*

*It can usually be consulted after midday (CET) on the day judgment is delivered.*

*For further information, please contact Christopher Fretwell  
Tel: (00352) 4303 3355 Fax: (00352) 4303 2731*