

European Union: EUTM Registrations May be Enforced within First Five Years without Proving Use

By Ashford Tucker

Länsförsäkringar AB v Matek A/S, C-654/15, EU:C:2016:998, December 21, 2016

The Court of Justice of the European Union (ECJ) recently held that the actual use of a trademark does not affect the extent to which an owner of an EUTM registration can enforce its rights within the first five years following registration. [More](#)

By Ashford Tucker

Länsförsäkringar AB v Matek A/S, C-654/15, EU:C:2016:998, December 21, 2016

The Court of Justice of the European Union (ECJ) recently held that the actual use of a trademark does not affect the extent to which an owner of an EUTM registration can enforce its rights within the first five years following registration.

Länsförsäkringar AB, a Swedish bank and insurance company, owns a 2008 EUTM registration for the following logo covering, inter alia, building construction services in Class 37.

Matek A/S, an Estonian maker of timber frame houses, uses the following logo, for which it owns a 2009 Estonian registration covering various construction-related goods in Class 19, which it sought to extend into Sweden among other European countries, through an International Registration.

Länsförsäkringar asserted that Matek's use infringed its registered EUTM rights and won an injunction in the Stockholm District Court enjoining the use. The Svea Court of Appeal set that decision aside, requiring that the analysis of the similarity of goods and services focus not on Länsförsäkringar's

registered coverage, but instead on actual use. Given no relevant use by Länsförsäkringar, no likelihood of confusion was found.

On appeal, the Supreme Court of Sweden referred the issue to the ECJ, which decided in favor of Länsförsäkringar. As the ECJ concluded: “[D]uring the period of five years following registration of an EU trademark, its proprietor may, if there is a likelihood of confusion, prevent third parties from using in the course of trade a sign identical or similar to his mark in respect of all goods and services identical or similar to those for which that mark has been registered without having to demonstrate genuine use of that mark in respect of those goods or services.”

This decision is consistent with relevant EU law, which allows the owner of an EUTM registration a five-year grace period to begin use. Only after this grace period has expired is the registration subject to the use requirement and cancellation in whole or in part by a third-party based on the registrant’s lack of use.

Primary Contacts

Ashford Tucker