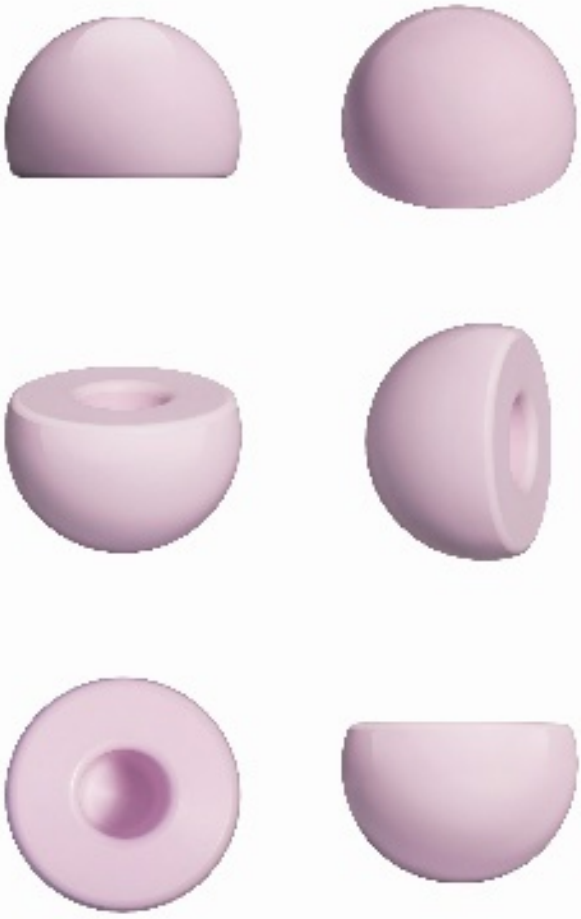
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RECENT TRADEMARK RULING BY THE ECJ

ECJ 19 JUNE 2025, C-17/24, ECLI:EU:C:2025:455

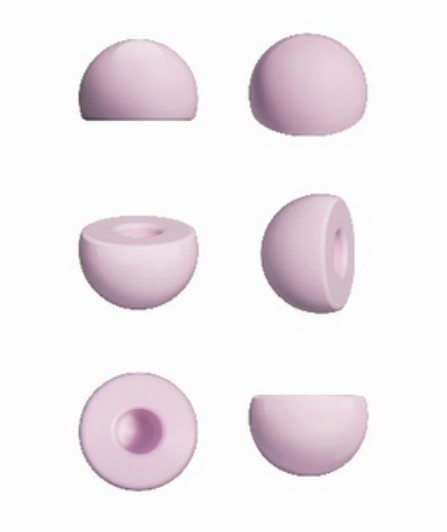
THE CERAMTEC/ COORSTEK CASE



Facts & judgement of the ECJ

Facts

CeramTec was the proprietor of a European patent relating to a composite ceramic material which patent expired on 5 August 2011. On 23 August 2011 CeramTec filed several EU trademark applications, among which a three-dimensional mark for ceramic parts for implants for osteosynthesis (class 10).



Facts

The trademarks were registered on the basis of acquired distinctiveness. In legal proceedings a competitor filed a counterclaim for a declaration of invalidity of the trademarks. The Court of Appeal in Paris cancelled the trademarks on the ground that CeramTec had filed the application in bad faith intending to extend its monopoly on a technical solution and prevent competitors from entering the market.

Facts

CeramTec lodged an appeal before the Cour de Cassation, which referred questions to the ECJ.

The questions concern the relationship between
- the absolute ground for invalidity in Article 7 (1)(e)(ii) in conjunction with[1] Article 52 (1)(a) Trademark Regulation 207/2009 (*shape necessary to obtain a technical result*); and
- the absolute ground for invalidity in Article[2] 52(1)(b) Trademark Regulation 207/2009 (*bad faith*).

1 Article 59(1)(a) of the current Trademark Regulation 2017/1001.
2 Article 59(1)(b) of the current Trademark Regulation 2017/1001.

Judgement of the ECJ

The ECJ clarifies that:

- The two grounds for invalidity have a different purpose.

Article 7 (1)(e)(ii) Trademark Regulation *(shape necessary to obtain a technical result*) censures a defect in the trademark itself and is intended to protect the public interest. It aims to prevent the exclusive and permanent right conferred by a trademark from serving to extend indefinitely the life of other rights which the EU legislator has sought to make subject to limited periods.

Article 52 (1)(b) Trademark Regulation (*bad faith*) aims to ensure that economic operators intending to use the EU trademark system compete fairly. Its purpose is therefore to penalize an inherent defect in the application for registration and not in the trademark itself.

Judgement of the ECJ

- The two grounds for invalidity are autonomous.

Thus, classification as bad faith does not require a finding that the sign at issue also consists exclusively of the shape of goods which is necessary to obtain a technical result and vice versa.

- The two grounds are not mutually exclusive.

Application of one of the grounds does not exclude application of the other. However, a court may consider it appropriate to confine itself to analyzing one of those grounds. If it is well founded, it is no longer necessary to examine the other ground in order to declare the mark invalid.

Concept of bad faith

The ECJ then recalls how bad faith as referred to in Article 52 (1)(b) Trademark Regulation can be established. According to the Court relevant circumstances for establishing bad faith can also include

- the nature of the contested mark
- the origin of the sign at issue and its use since its creation
- the scope of the expired patent
- the commercial rationale underlying the filing of the application for registration of the contested mark, and
- the chronology of events characterizing that filing.



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Concept of bad faith

The ECJ furthermore clarifies that applicant's bad faith may not be assessed on the basis of circumstances arising after the filing of the application for registration of the mark at issue.

Taking into account these clarifications of the ECJ, the French court must now assess whether one of the grounds for invalidity is applicable.

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