Reports of Cases

OPINION OF ADVOCATE GENERAL
JÄÄSKINEN
delivered on 31 March 2011 [1]

Case C-190/10

Génesis Seguros Generales Sociedad Anónima de Seguros y Reaseguros (GENESIS)
v
Boys Toys SA
and
Administración del Estado

(Reference for a preliminary ruling from the Tribunal Supremo (Spain))

(Community trade mark — Procedure for filing — Article 27 of Regulation (EC) No 40/94 — Electronic filing of an application — Taking into account the date, hour and minute of filing)

I – Introduction

1. By its reference for a preliminary ruling, the Tribunal Supremo (Spain) submits to the Court a question on the interpretation of the concept of 'date of filing' of a Community trade mark application. That question seeks to ascertain whether it is possible, for the purposes of applying Article 27 of Regulation (EC) No 40/94, [2] to take into consideration, in addition to the date of filing of an application, the hour and minute of filing in order to be able to claim priority of the Community trade mark.

II – Legal framework

A – *International law*

2. Article 4(A) of the Paris Convention for the Protection of Industrial Property of 20 March 1883 [3] ('the Paris Convention') provides as follows:

'(1) Any person who has duly filed an application for … a trademark, in one of the countries of the Union, … shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

1 — Original language: French.

2 — Council Regulation of 20 December 1993 on the Community trade mark (OJ 1993 L 11, p. 1), repealed by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. In the light of the date of the facts in the main proceedings, this request for interpretation relates to Regulation No 40/94.

3 — The Paris Convention for the Protection of Industrial Property of 20 March 1883 is accessible at the following address: http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognised as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.'

3. Under Article 4(C) of the Paris Convention:

'(1) The periods of priority referred to above shall be … six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.'

B – *EU law*

4. Article 8 of Regulation No 40/94, entitled 'Relative grounds for refusal', provides:

'1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. For the purposes of paragraph 1, "Earlier trade marks" means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

  (i) Community trade marks;

  (ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Trade Mark Office;

  (iii) trade marks registered under international arrangements which have effect in a Member State;

(b) applications for the trade marks referred to in subparagraph (a), subject to their registration;

(c) trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words "well known" are used in Article 6 *bis* of the Paris Convention.

…'

5. Article 14 of Regulation No 40/94, entitled 'Complementary application of national law relating to infringement', provides, in paragraph 1, that the effects of Community trade marks are to be governed solely by the provisions of that regulation.

6. Article 26(1) of Regulation No 40/94 lays down the conditions with which applications for a Community trade mark must comply, which include: (a) a request for the registration of a Community trade mark; (b) information identifying the applicant; (c) a list of the goods or services in respect of which the registration is requested, and (d) a representation of the trade mark. Article 26(2) provides that the application for a Community trade mark is to be subject to the payment of the application fee.

7. Article 27 of Regulation No 40/94, entitled 'Date of filing', is worded as follows:

'The date of filing of a Community trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Office by the applicant or, if the application has been filed with the central office of a Member State or with the Benelux Trade Mark Office, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents.'

8. Under Article 29 of that regulation, the right of priority is to apply during a period of six months from the date of filing of the first application. Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements is to be recognised as giving rise to a right of priority. By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

9. Article 32 of Regulation No 40/94 provides that a Community trade mark application which has been accorded a date of filing is, in the Member States, to be equivalent to a regular national filing, where appropriate with the priority claimed for the Community trade mark application.

10. Article 97 of Regulation No 40/94, entitled 'Applicable law', provides:

'1. The Community trade mark courts shall apply the provisions of this Regulation.

2. On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.

3. Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State where it has its seat.'

11. Rule 5 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94,[4] entitled 'Filing of the application', provides:

'(1) The Office shall mark the documents making up the application with the date of its receipt and the file number of the application. The Office shall issue to the applicant without delay a receipt which shall include at least the file number, a representation, description or other identification of the mark, the nature and the number of the documents and the date of their receipt.

…'

4 — OJ 1995 L 303, p. 1.

C – National law

12. Article 6(2) of Law No 17/2001 of 7 December 2001 on trade marks (Ley 17/2001, de 7 de diciembre, de Marcas, BOE No 294 of 8 December 2001, p. 45579, 'Law No 17/2001 on trade marks') defines what is meant by earlier trade marks as follows:

'(a) registered trade marks of the following kinds with a date of filing or date of priority of the application for registration which is earlier than the date of the application under consideration: (i) Spanish trade marks; (ii) trade marks registered under international arrangements which have effect in Spain; (iii) Community trade marks.

(b) registered Community trade marks whose proprietor, in accordance with the legislation on Community trade marks, validly claims seniority over one of the trademarks referred to in subparagraph (a)(i) and (ii), even if that latter trade mark has been surrendered or has lapsed.

(c) applications for the trade marks referred to in subparagraph (a) and (b), subject to confirmation of their registration.

(d) non-registered trade marks which, on the date of filing or on the date of priority of the application for registration of the trade mark under consideration, are "well known" in Spain, in the sense in which the words "well known" are used in Article 6 *bis* of the Paris Convention.'

13. Article 11 of that law, entitled 'Filing of applications', provides:

'(1) An application for registration of a trade mark shall be filed at the competent body of the Autonomous Community in which the applicant has his domicile or a real and effective industrial or commercial establishment. …

…

(6) The body competent to receive the application shall, upon receipt of the application, record the number of the application and the date, hour and minute of its receipt, in the manner to be determined by regulation.'

14. Article 12 of Law No 17/2001 on trade marks, which lays down the conditions with which applications must comply, is worded as follows:

'(1) An application for registration of a trade mark shall contain, at least: a request for the registration of the trade mark; the identity of the applicant; a representation of the trade mark; a list of the goods or services in respect of which the registration is requested.

…'

15. Article 13 of Law No 17/2001 on trade marks provides:

'(1) The date of filing of an application shall be the date on which the competent body, as defined in Article 11, receives the documents containing the information specified in Article 12(1).

(2) The date of filing of applications filed at a post office shall be the time at which that office receives the documents containing the information specified in Article 12(1), provided that those documents are filed in an unsealed envelope, by registered post and with acknowledgment of receipt, addressed to the body competent to receive the application. The post office shall record the day, hour and minute of the filing of the application.

(3) If any of the bodies or administrative units referred to in the preceding paragraphs fails to record, at the time the application is received, the hour of its filing, the application shall be assigned the final hour of the day. If the minute has not been recorded, the application shall be assigned the final minute of the hour. If neither the hour nor the minute of filing has been recorded, the application shall be assigned the final hour and minute of the day in question.'

III – The dispute in the main proceedings, the question referred and the procedure before the Court

16. Génesis Seguros Generales Sociedad Anónima de Seguros y Reaseguros ('Génesis') filed with the Office for Harmonisation of the Internal Market ('OHIM'), by electronic means, two applications for registration of Community trade marks: the word mark RIZO, No 3 543 361, in Classes 16, 28, 35 and 36 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, ('the Nice Classification') and the word mark RIZO, EL ERIZO, No 3 543 386, in Classes 16, 35 and 36 of that classification.

17. The referring court points out that, in the light of the evidence which was presented before it, the electronic applications for those two Community trade marks were transmitted [5] to OHIM at 11.52 and at 12.13, respectively, on 12 December 2003.

18. It is also stated in the order for reference that, at 17.45 on 12 December 2003, the company Pool Angel Tomas SL applied to the Oficina Española de Patentes y Marcas ('the OEPM') for registration in Spain of the word mark RIZO'S, No 2 571 979-3, in Class 28 of the Nice Classification.

19. Génesis opposed the application for registration of the aforementioned national trade mark RIZO'S, relying on its right of priority based on the Community trade marks RIZO, No 3 543 361, and RIZO, EL ERIZO, No 3 543 386.

20. By decision of 9 December 2004, the OEPM rejected the opposition, on the ground that the trade marks relied on did not have priority over the trade mark applied for, and granted registration of the trade mark RIZO'S.

21. Génesis brought an appeal seeking a declaration by the OEPM that the Community trade marks of which Génesis is the proprietor have priority, based on the fact that the application for registration of those Community trade marks had been filed, by electronic means, on 12 December 2003 and that that date should be taken into consideration for that purpose.

22. By decision of 29 June 2005, the OEPM dismissed that appeal, pointing out that the date of filing of the Community trade marks of which the appellant was the proprietor was later than the date of filing of the Spanish trade mark RIZO'S, since, on the basis of Article 27 of Regulation No 40/94, the applications for the Community trade marks were not assigned a date of filing until 7 January 2004.

23. In appeal proceedings brought by Génesis against the latter decision, the Second Section of the Chamber for Contentious-Administrative Proceedings of the Tribunal Supremo de Justicia de Madrid confirmed, by judgment on 7 February 2007, that the decision granting registration of the Spanish trade mark applied for, RIZO'S, was well founded. That court considered that the date of filing of the opposing Community trade marks was the date on which the documentation was actually submitted and not 12 December 2003, the date on which the application was filed by electronic means.

5 — But not received or registered by OHIM.

24. In its appeal against the judgment of 7 February 2007, Génesis challenges, first, the interpretation of the Tribunal Superior de Justicia de Madrid concerning the date of filing of the Community trade mark application and states that the correct interpretation of Articles 26 and 27 of Regulation No 40/94 would result in the date of filing of the applications being regarded as the date on which they were transmitted to and received by OHIM, that is to say 12 December 2003. Secondly, Génesis considers that, by failing to recognise the priority of the Community trade marks RIZO, No 3 543 361, and RIZO, EL ERIZO, No 3 543 386, the Tribunal Superior de Justicia de Madrid infringed Article 6(2) of Law No 17/2001 on trade marks, which provides, in subparagraphs (a) and (c), that priority is to be given to applications for Community trade marks with a date of filing prior to the applications for registration filed with the OEPM.

25. The Tribunal Supremo notes that, whilst providing that the filing date of the Community trade mark application is that on which that application is filed at OHIM or at bodies referred to by that provision, Article 27 of Regulation No 40/94 lays down no other order of filing where filings take place on the same day. However, the rule used in Spain to determine the priority of trade marks where applications are filed on the same day is that priority is to be given according to the hour and minute of filing with the OEPM.

26. In those circumstances, the Tribunal Supremo decided to stay proceedings and to refer the following question to the Court for a preliminary ruling:

'May Article 27 of … Regulation … No 40/94 … be interpreted in such a way as to enable account to be taken not only of the day but also of the hour and minute of filing of an application for registration of a Community trade mark with OHIM (provided that such information has been recorded) for the purposes of establishing temporal priority over a national trade mark application filed on the same day, where the national legislation governing the registration of national trade marks considers the time of filing to be relevant?'

27. That application was lodged at the Court Registry on 16 April 2010. Written observations have been submitted by Génesis, by the Spanish, Italian and Greek Governments and by the European Commission.

IV – The question referred

A – *General remarks on the trade mark system*

28. As a preliminary point, I would like to emphasise the characteristics of the trade mark system, namely, first, its inherently international dimension and, secondly, its necessary territorial limitation. Moreover, it is important to take into account the existence of several systems of trade mark protection, which include that of the European Union.[6]

29. The characteristic features of trade marks were already apparent from the travaux préparatoires for the Paris Convention.[7] As regards establishing the system applicable to the protection of industrial property, the first proposal consisting in the adoption of uniform supranational legislation was rejected as utopian and unrealistic. The second proposal for the adoption of rules of conflict of laws under which it would be necessary to apply the law of the country of origin of the invention or of

6 — Müller, B.K., *Multinational Trademark Registration Systems*, Bern, 2002.

7 — It should be pointed out that, in accordance with the 12th recital in the preamble to First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), all Member States of the Community are bound by the Paris Convention, so that it is necessary that the provisions of that directive are entirely consistent with those of the Paris Convention.

registration of the trade mark was regarded as unfair. Under Article 2 of the convention, its authors therefore opted for the third proposal, namely the national treatment principle.[8] In accordance with the principle of territoriality (*lex loci protectionis*), the legal effects of a trade mark are limited to the territory of the particular State of protection.[9]

30. In European Union law, trade mark law constitutes an essential element in the system of undistorted competition. In that system, each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs enabling the consumer, without any possibility of confusion, to distinguish those goods or services from others which have another origin.[10]

31. The harmonisation of laws in the field of trade mark law is based on two series of texts applied in parallel, but nevertheless linked in several respects. They are, on the one hand, the Community trade mark system, that is to say the industrial property law provided for by Regulation No 40/94, which established a uniform system of trade mark law extending to the entire territory of the European Union. On the other hand, by means of Directive 89/104, the EU legislature made an effort to harmonise national laws without altering the principle of territoriality, that is to say, the linking of the legal effects of a trade mark to the territory of the particular Member State.

32. It should be pointed out, however, that, in accordance with the fifth recital in the preamble to Regulation No 40/94, Community law relating to trade marks does not replace the laws of the Member States on trade marks. National trade marks continue to exist because they are judged to be necessary for undertakings which do not wish to opt to protect their trade mark at the EU level.[11]

33. The Community trade mark therefore supplements the national systems of protection. As stated in the first and third recitals in the preamble to Directive 89/104, that directive seeks partial harmonisation, limited to those national provisions of law which most directly affect the functioning of the internal market.[12]

34. The protection of trade marks is therefore characterised, within the European Union, by the coexistence of several systems of protection, which may lead to multiple trade mark filings and, as we shall see, in exceptional cases, to the existence of valid concurrent registrations.

B – *The registration and filing date of a trade mark in EU law*

35. With regard to registration of a Community trade mark, the provisions of Regulation No 40/94 attach to the filing of such a trade mark consequences in various respects.

8 — Beier, F-K., 'One Hundred Years of International Cooperation — The Role of the Paris Convention in the Past, Present and Future', *International Review of Industrial Property and Copyright Law*, Vol. 15, No 1-6/1984, p. 1.

9 — Sabatier, M., *Pratique de la marque internationale*, Institut de Recherche en Propriété intellectuelle Henri-Desboi, Year 2007, No 8. See, in that regard, point 50 et seq. of the Opinion of Advocate General Trstenjak in Case C-482/09 *Budějovický Budvar*, pending before the Court.

10 — See, to that effect, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraphs 21 and 22; Case C-206/01 *Arsenal Football Club* [2002] ECR I-10273, paragraphs 47 and 48; Case C-228/03 *Gillette Company and Gillette Group Finland* [2005] ECR I-2337, paragraph 25; Case C-412/05 P *Alcon* v *OHIM* [2007] ECR I-3569, paragraphs 53 and 54; and Case C-48/09 P *Lego Juris* v *OHIM* [2010] ECR I-8403, paragraph 38.

11 — Bonet, G., 'La marque communautaire', *Revue trimestrielle de droit européen,* No 1, 1995, p. 59.

12 — By way of illustration of that limitation, see point 79 of the Opinion of Advocate General Cruz Villalón in Case C-96/09 P *Anheuser-Busch* v *Budějovický Budvar*, pending before the Court. Moreover, the Court has already held that partial harmonisation does not preclude the harmonisation relating, in particular, to the provisions of national law which most directly affect the functioning of the internal market from being complete. See Case C-355/96 *Silhouette International Schmied* [1998] ECR I-4799, paragraph 23, and Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 27.

36. First, under Article 46 of Regulation No 40/94, the 10-year period of protection of the trade mark starts to run from the date of filing. Secondly, as is clear from Article 8(2)(a) and (b) of Regulation No 40/94, the date of filing of the application, as defined in Article 27 of that regulation, determines the priority of one trade mark over another. [13] Thirdly, the date of filing is relevant for assessing any distinctive character of a trade mark capable of having been acquired through use prior to the filing of the application for the purposes of Article 7(3) of Regulation No 40/94. Finally, the time of filing the application for registration is relevant for determining whether there was bad faith on the part of the applicant, within the meaning of Article 51(1)(b) of Regulation No 40/94, in the context of determining absolute grounds for the invalidity of a trade mark. [14]

37. It follows that precise determination of the date of filing is a constituent of the Community trade mark system. In so far as this reference for a preliminary ruling is concerned with determining the meaning and scope of Article 27 of Regulation No 40/94, it is necessary, first of all, to determine the nature of the concept of 'date of filing' within the meaning of that provision.

38. It must be pointed out, as a preliminary point, that the Paris Convention does not include substantive rules governing the conditions of filing, but, on the contrary, provides in Article 4(A)(2) thereof that the regularity of filings is to be determined by the domestic legislation of any country of the Union or by bilateral or multilateral treaties concluded between them. Indeed, although that convention stated that the contracting States constitute a Union for the protection of industrial property, it included several provisions requiring those States to legislate in the field of intellectual property or allowing them to do so. [15]

39. However, Regulation No 40/94 contains a specific provision governing the conditions for filing a Community trade mark. Under Article 27 of that regulation, the date of filing of a Community trade mark application is to be the date on which documents containing the information specified in Article 26(1) are filed with OHIM by the applicant or, if the application has been filed with the central office of a Member State or with the Benelux Trade Mark Office, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents. [16]

40. It is therefore apparent from Article 27 of Regulation No 40/94 that that provision makes no express reference to the law of the Member States.

41. In that regard, according to settled case-law, the need for a uniform application of Community law and the principle of equality require that the terms of a provision of European Union law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must normally be given an independent and uniform interpretation throughout the European Union; that interpretation must take into account the context of the provision and the objective of the relevant legislation. [17]

42. In the context of the registration of a Community trade mark, registrations of earlier national trade marks are to be taken into consideration as legally relevant facts, to which EU rules attach specific legal consequences.

13 — The date of filing is therefore relevant for establishing whether there is an 'earlier trade mark' within the meaning of Article 8 of Regulation No 40/94 and a trade mark with a date of application for registration which is earlier than the date of application for registration of the trade mark [in accordance with Article 4(2)(a)(i) of Directive 89/104].

14 — See, in that regard, Case C-529/07 *Chocoladefabriken Lindt & Sprüngli* [2009] ECR I-4893.

15 — Bodenhausen, G.H.C., *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, BIRPI, 1969, p. 11.

16 — It should be noted that the principle of a single international filing nonetheless based on the registration of a trade mark in the country of origin was introduced by the Madrid Agreement of 14 April 1891 and by the Madrid Protocol of 27 June 1989 on international marks. See Sabatier, M., *Pratique de la marque internationale,* pp. 5 to 7.

17 — See, *ex multis*, Case C-245/00 *SENA* [2003] ECR I-1251, paragraph 23, and Case C-467/08 *Padawan* [2010] ECR I-10055, paragraph 32.

43. It follows that OHIM is under no obligation to follow the assessment of the authority with jurisdiction over trade marks in the country of origin or to lay down the same requirements, or to register the mark applied for on the basis of the registration decisions taken by national patent and trade mark offices. [18]

44. Accordingly, I consider that determining the 'date of filing' of a Community trade mark is a question governed solely by EU law, which takes into account, in that regard, the relevant international conventions. In so far as Regulation No 40/94 provides no legal definition of the expression 'date of filing', the scope and meaning of that expression must be sought in that regulation.

C – *The date of filing of the application in the main proceedings*

45. Before commencing the analysis of the key concept for the purpose of these proceedings, I must point out, from reading the order for reference, the uncertainty surrounding a factual element which lies at the heart of the dispute in the main proceedings, that is the determination of the filing date of the trade mark applications at issue. [19]

46. It is clear from the order for reference that the two applications for the Community word marks RIZO and RIZO, EL ERIZO were filed with OHIM, by electronic means, on 12 December 2003. The referring court therefore asks whether that date of transmission by electronic means must be regarded as the authentic filing date for the Community trade mark.

47. It is clear from the order for reference that the appeal brought by Génesis against the contested decision of the OEPM was dismissed by judgment of the Tribunal Superior de Justicia de Madrid on the ground, in essence, that the date of filing of the opposing Community trade marks is 7 February 2004, the date the documentation was actually produced, and not 12 December 2003, the date on which the application was filed by electronic means.

48. In that regard, it should be pointed out that OHIM makes an electronic filing ('e-filing') service available to users, allowing them to file their applications for Community trade marks online. That service offers several advantages, including the guarantee of the date of filing within the meaning of Article 27 of Regulation No 40/94.

49. In the light of the wording of that provision, it must be recalled that the date of filing the application by electronic means accompanied by all the documents required by Regulation No 40/94 and followed by payment of the application fee within a period of one month must be regarded as the date of filing within the meaning of Article 27 of that regulation. OHIM has provided interested persons with the technical means necessary to annex the required documents. [20]

50. However, in the case of a simple electronic filing of an application for registration which does not result in the concomitant filing of the required documents, the date of filing within the meaning of Article 27 of Regulation No 40/94 will be that on which all the required documentation is actually filed with OHIM. This is therefore a date subsequent to the electronic filing of that application.

18 — See, in that regard, Case C-238/06 P *Develey* v *OHIM* [2007] ECR I-9375, paragraphs 71 to 73, and judgment of 17 December 2010 in Case T-395/08 *Chocoladefabriken Lindt & Sprüngli* v *OHIM (Shape of a chocolate rabbit)*.

19 — The order for reference contains no definitive ruling on this factual element and the observations submitted by Génesis are not unambiguous on this matter. Only the Commission, in its written observations, has produced annexes which support the argument that the filing date is 12 December 2003.

20 — See: http://oami.europa.eu/help/html/help_en.html. It seems that OHIM does not officially record the hour and minute of filing of the trade mark. Consequently, the details on that matter provided by the referring court are not based on information recorded by OHIM. Neither the Community Trade Marks Bulletin (http://oami.europa.eu/bulletin/ctm/ctm_bulletin_en.htm) nor the OHIM database (CTM-Online) refer to the hour or minute of filing.

51. Accordingly, for the purposes of applying the expression 'the date of filing' within the meaning of Article 27 of Regulation No 40/94, it is for the referring court to ascertain the date on which all the required documents were actually produced by Génesis, for the purposes of its applications for registration, and then the date of payment of the fee.

52. It is only after dealing with that aspect that it is appropriate to address the more precise temporal aspects referred to by the referring court.

D – *Taking into account the hour and minute in the context of applying the concept of 'date of filing' within the meaning of Regulation No 40/94*

53. By its question, the referring courts asks, in essence, whether it is possible to take into account, for the purposes of applying Article 27 of Regulation No 40/94, the hour and minute of filing of the application for registration, since those elements may contribute in determining any priority over a national trade mark whose registration has been applied for on the same date. In such a situation in which the filing dates coincide, Spanish law determines the priority of trade marks on the basis of the hour and minute of filing.

54. That question therefore deals with the principle of priority under which an earlier right makes it possible to oppose all subsequent signs which conflict with it.[21] The opposition procedure initiated on the basis of national law by Génesis seeks, therefore, to establish that the two Community trade marks are 'earlier trade marks' within the meaning of the national legislation, which reproduces the definition of precedence set out in Regulation No 40/94.[22]

55. The analyses of the scope of the concept of 'date of filing' proposed by the parties which submitted observations in the course of these proceedings differ substantially. Like the Spanish and Italian Governments and the Commission, I am of the view that the hour and minute of filing a Community trade mark application are not elements which are relevant for the purposes of applying Article 27 of Regulation No 40/94. It seems to me that the 'date of filing' refers only to the 'calendar day'. The latter concept is, in my view, equivalent to a calendar day from midnight to midnight, the month and year of which are numbered according to the Gregorian calendar, and to a corresponding day in the other calendar systems.[23] A calendar day may therefore be the same notwithstanding real-time variations due to time zones.[24]

56. There are several elements which, in my view, support that interpretation.

57. In the first place, I note that the Paris Convention system, to which all the Member States are parties, selected the date understood as a single day or calendar day as the basic unit of calculation. Indeed, the regularity of a filing is assessed solely in the light of that element. Such a filing is regarded as having taken place as soon as, in accordance with the national legislation of the country in which it occurs, an application which complies with the formal requirements has been filed, and even if that application was formally incomplete or incorrect, it is adequate to establish the date of filing.[25]

21 — Under Article 6 of Law No 17/2001 on trade marks, signs may not be registered if they are identical with an earlier trade mark or if there exists a likelihood of confusion. See Articles 4(1) and 5(1) of Directive 89/104.

22 — See Article 8(2) of Regulation No 40/94.

23 — See, in that regard, Article 4(2) of Regulation (EEC, Euratom) No 1182/71 of the Council of 3 June 1971 determining the rules applicable to periods, dates and time-limits (OJ, English Special Edition, Series I, 1971 (II), p. 354), from which it is clear that the entry into force, taking effect or application of acts of the Council or Commission - or of provisions of such acts - fixed at a given date is to occur at the beginning of the first hour of the day falling on that date. See Case T-146/00 *Ruf and Stier v OHIM ('DAKOTA' Image*) [2001] ECR II-1797, paragraphs 23, 27 and 55.

24 — As demonstrated, for example, by the celebration of the New Year throughout the world.

25 — According to Article 4(A)(3) of the Paris Convention, under that Convention a regular national filing means any filing that is adequate to establish the date on which the application was filed in the country concerned. See Bodenhausen, G.H.C., *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, op. cit., p. 42.

58. In that regard, it should be pointed out that the introduction of that basic unit of calculation was closely linked to what is commonly known as the 'convention priority' adopted by the Paris Convention, according to which a person who files a trade mark in another country within a period of six months from the filing of his trade mark in his country of origin benefits there from the initial date of protection which he obtained in the country of origin. [26] Indeed, under Article 4(C)(2) of that convention, the six-month period starts from the date of filing of the first application, the day of filing not being included in the period. Consequently, the hour and minute of filing have no relevance for the purposes of calculating the priority period. [27]

59. Regulation No 40/94 contains its own rules which follow the system laid down in the convention by establishing, in Article 29, a right of priority that includes applications for registration made in any country that is party to the convention or in a country that is party to the Agreement establishing the World Trade Organisation. [28] By virtue of the right of priority, the rights attached to the Community trade mark are deemed to arise from the date of priority, that is to say the day of filing the national application. [29]

60. I therefore consider that it is not possible to record with greater precision the date of filing referred to in Article 27 of Regulation No 40/94. It would seem to me to be particularly impossible, since from the outset that concept has been attributed a precise function when applying the priority principle referred to above, not only at EU level, but also for the purposes of applying international rules on the effects of trade mark registration. In that regard, it should be noted that an earlier trade mark may also be protected by means of registration under an international arrangement. [30]

61. It is true that it is clear from the information on OHIM's site that the date of filing is that on which the documents referred to in Article 26 are filed with OHIM, Central European Time (GMT +1). [31] I consider, however, that the time which is specified there serves to establish the date of filing with OHIM and not to confer temporal priority based on the hour and minute of filing.

62. That argument is also confirmed by a literal interpretation of the wording of Article 27 of Regulation No 40/94, which merely refers to the 'date'. Moreover, it is apparent from Rule 5 of Regulation No 2868/95 that OHIM is to mark the documents making up the application only with the date of its receipt and the file number of the application. It is to issue to the applicant without delay a receipt which is to include at least the file number and the date of receipt of the application.

63. Secondly, an interpretation which does not take into account the hour and minute of filing is also supported by the purpose and the nature of EU legislation. As I have already stated in points 30 to 34 and 39 to 43 of this Opinion, the objective of Regulation No 40/94 was not to harmonise the laws of the Member States, but to establish a single system of industrial property law which is valid

26 — Article 4 of the Paris Convention lays down a period of six months within which a person applying for registration of a trade mark in one of the countries of the Union may apply for the same mark in the other countries of the Union without any subsequent application or applications made by him being affected by applications for registration of the same mark made by third parties. The right of priority thus confers upon the applicant for a limited period of time immunity from the effects of any other applications for registration of the same trade mark that may be made by third parties during the priority period. See Case T-128/99 *Signal Communications* v *OHIM (TELEYE)* [2001] ECR II-3273, paragraphs 36 to 40.

27 — With regard to the calculation of the priority period, the same calculation applies at international level to patents (the day of filing of the earlier application is not to be included in that period. See Rule 2.4 of the Regulations: http://www.wipo.int/pct/en/texts/rules/r2.htm).

28 — The right of priority arises when an initial application for registration of a trade mark is made in one of the abovementioned countries. It is an autonomous right in that it exists independently of the eventual outcome of that initial application. Where a Community trade mark application is accompanied by a claim of priority, the right of priority becomes an essential component of the application in that it determines one of its essential features, namely the filing date, which, for the purpose of determining the precedence of rights, will be the same as that of the initial application. See *Signal Communications* v *OHIM*, cited above in footnote 26.

29 — If the required conditions are met, the Community trade mark takes effect retroactively on the day of the date of filing of the trade mark applied for. Bonet, G., 'La marque communautaire', op. cit.

30 — See Article 8(2)(a)(iii) of Regulation No 40/94 and Article 8(2)(a)(iv) of Regulation No 207/2009, which refer to trade marks registered under international arrangements which have effect in the Community.

31 — http://oami.europa.eu/ows/rw/pages/QPLUS/forms/electronic/fileApplicationCTM.en.do

throughout the European Union. Moreover, having regard to the autonomous nature of the concepts of EU law contained in Regulation No 40/94, the legal solutions adopted in national law cannot be taken into account for the purpose of interpreting the Community trade mark system. Lastly, as the Commission correctly states, such an approach is confirmed by Articles 14 and 97 of that regulation, read in conjunction, since it is clear that the applicability of national law is limited to questions which fall outside the scope of Regulation No 40/94.

64. Thirdly, it is important to emphasise the relevance of Article 32 of Regulation No 40/94, from which it follows that the filing of a Community trade mark is equivalent to the filing of a national trade mark in the Member States, for the purpose of determining, where necessary, the right attached to the Community trade mark application. That article refers only to the date of filing.

65. As the Spanish Government points out, Article 32 of Regulation No 40/94 neither amends the Community concept of the date of filing nor presupposes the secondary application of national law, but simply recognises that Community trade mark applications filed with OHIM are legally equivalent to those filed with national offices. If, notwithstanding the wording of Article 27 of Regulation No 40/94, the Court should adopt a broad interpretation of that provision, that would place all applicants for trade marks under an obligation to register them with OHIM in order to ensure their right of priority not only over other national trade marks, but also over other Community trade marks, which would be contrary to the principle that the Community trade mark does not replace the national trade marks.

66. Lastly, it is essential to point out that there are several practical difficulties connected with applying real-time priority rather than applying the concept of the calendar day in the context of the Community trade mark system.

67. First of all, the existence of various time zones throughout the European Union seems to me, at the present time, to make it impossible to establish the real-time priority of a Community trade mark. Indeed, the territory of Europe covers four time zones. [32]

68. In the light of that diversity, taking into account the hour and the minute of filing of a trade mark application would involve establishing a rule governing temporal conflicts between several national systems. It is not inconceivable that real-time priority would also lead to some confusion, given the many means of communication and their differing quality within several Member States. [33] In order to end that confusion, it would be necessary not only to record the hour and minute of the application, but also to ensure that the information systems available to the national authorities exactly follow atomic time or Greenwich Mean Time. [34]

69. Accordingly, the issue of the date of filing would be pointlessly transformed into a debate on nominal, or even actual, units. Thus, for example, 00.30 on 1 January in Finland corresponds, in real time, to 23.30 on 31 December in the majority of the Member States.

32 — See Recommendation No 1432 (1999) of the Council of Europe on the Observance of the system of European time zones, available at the address http://assembly.coe.int/Documents/AdoptedText/ta99/erec1432.htm#1. In order to compare those time zones see: http://europa.eu/travel/time/index_en.htm

33 — It suffices to refer, in that regard, to the order for reference, which states that the applications were filed at 11.52 and 12.13, respectively, whereas the contested decision of the OEPM states that the applications were filed at 11.31.

34 — Civil time, now defined by the time of atomic clocks, is called universal coordinated time (UTC). A UTC day is approximately 0.9 seconds longer than the average day.

70. It is true that the possibility of electronic registration is provided for in several Member States.[35] It seems to me, however, that it is important to distinguish between the possibility of filing an electronic application and the introduction of a system of real-time priority. The introduction by OHIM or by certain Member States of the possibility of electronic filing, in order to modernise and facilitate access to the protection of industrial property, does not necessarily entail taking into account the hour and minute of filing the application for registration in order to establish the precedence of the trade mark.[36]

71. Consequently, I consider that taking into account the hour and the minute in order to establish the precedence of a trade mark for the purposes of Article 27 of Regulation No 40/94 would be possible only if a uniform system of administrative procedures for the electronic registration of both Community and national trade marks were established throughout the European Union. That would also entail the application of the Greenwich Mean Time system, that is to say the complete harmonisation of the statutory time systems of the European States. It goes without saying that the introduction of such a system should be clearly provided for in EU legislation and in the national laws of the Member States,[37] and cannot arise from the case-law.

72. In that regard, it should also be observed that Article 27 of Regulation No 207/2009, relating to the date of filing, is worded in terms identical to those of the corresponding article of Regulation No 40/94, which is the subject of the present reference for a preliminary ruling. It follows that the EU legislature has not yet provided for precision as to the hour and minute of filing.

73. In the alternative, I would further point out that Regulation (EC) No 6/2002[38] also fails to provide for any reference to the hour and minute in relation to the date of filing of an application for registration of Community designs. Moreover, under that regulation, an applicant for a registered Community design enjoys, under certain circumstances, a right of priority. That has the effect that the date of priority is regarded as corresponding to the date of filing of the application for registration of a Community design.[39]

74. In the light of the foregoing considerations, if it must be accepted, first, that the applications for the trade marks at issue were filed on the same day and, secondly, that taking into account the hour and minute must be precluded, it would follow that the two trade marks at issue could, in principle, be registered. The question would therefore arise of the coexistence of the national trade mark with the Community trade mark.

35 — According to my non-exhaustive research, the following States provide for such a possibility: the Kingdom of Belgium, the Czech Republic, the Kingdom of Denmark, the Kingdom of Spain, the French Republic, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Finland, the Kingdom of Sweden and the United Kingdom of Great Britain and Northern Ireland. See: http://www.wipo.int/directory/en/urls.jsp.

36 — By way of example, it is perfectly conceivable that, given the limited opening times of the national trade mark offices, an electronic transfer carried out at 23.00 would result in the registration of the application on the following day, or even the same day, and not a registration in real time, for the purpose of establishing precedence over another Community or national trade mark. As I pointed out in footnote 20, it seems that OHIM does not officially record the hour and minute of the filing of a trade mark.

37 — The efforts made with regard to the standardisation of time stem, in particular, from Directive 2000/84/EC of the European Parliament and of the Council of 19 January 2001 on summer-time arrangements (OJ 2001 L 31, p. 21), which provides that the 60 minutes by which clocks are put forward compared with the rest of the year is to be calculated in every Member State at 01.00, Greenwich Mean Time, on the last Sunday in March. It is also appropriate to note that, in the context of the Madrid Agreement and the Madrid Protocol, specific rules relating to the time of the filing apply (Rule 4 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, entitled 'Calculation of Time Limits' available at the following address: http://www.wipo.int/madrid/en/legal_texts/common_regulations.htm#rule_4). At the time of a filing, a record of the precise time is not one of the official entries which is to be included in the application. However, in accordance with Section 11 on electronic communications, (Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto) available at the following address: http://www.wipo.int/madrid/en/legal_texts/admin_instructions.htm#P120_6713, where, because of the time difference, the date on which the sending started is different from the date of receipt, the earlier date is to be considered as the date of receipt by the International Bureau. See, Sabatier, M., *Pratique de la marque internationale*, op. cit., p. 26.

38 — Council Regulation of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

39 — Under Rule 2 [point 2.4(a) of the Rules under the Patent Cooperation Treaty (PCT) (text available at the address: http://www.wipo.int/pct/en/texts/rules/r2.htm#_2_4)], the day of filing of the earlier application is not to be included in the priority period. Moreover, special rules are provided for in case of expiration of a period on a non-working day or official holiday (see Rule 80, point 80.5, available at the address: http://www.wipo.int/pct/en/texts/rules/r80.htm#_80_5).

E – *The coexistence of trade marks on the market*

75. The coexistence of two concurrent registrations of identical trade marks is a well known and sometimes inevitable phenomenon in the European Union. This is indisputably an imperfect situation, which stems from the multinational and diverse nature of the systems of trade mark protection and from the wide range of undertakings which are proprietors of trade marks.

76. It should be noted that such coexistence may have an effect on the outcome of opposition proceedings or of an application for a declaration of invalidity of a trade mark. That outcome varies according to whether the coexistence concerns the conflicting trade marks or an earlier trade mark and trade marks which are the property, not of the proprietor of the Community trade mark, but of third parties. Coexistence may, accordingly, be suffered by the proprietor of the earlier right or agreed upon by the parties under an agreement. [40]

77. It is common ground that, in order to remedy that phenomenon, the two proprietors may have recourse to a coexistence agreement to prevent any conflict. [41] Furthermore, national laws provide specific solutions, such as the principle of honest concurrent use, the lawfulness of which, from the perspective of EU law, seems to be open to dispute. [42]

78. As the Commission pointed out in its observations, coexistence has been recognised since the introduction of the Community trade mark, as on 1 April 1996, the date on which the register of Community trade marks was opened, OHIM registered all the trade marks whose registration had been applied for previously. [43]

79. In any event, the possibility of registering identical trade marks for identical products or services having the same date of priority has always existed in systems based on the Paris Convention. Coexistence, while being undesirable, thus forms an integral part of the concept of a trade mark.

V – Conclusion

In the light of all the foregoing considerations, I propose that the Court should answer the question referred by the Tribunal Supremo as follows:

As European Union law presently stands, Article 27 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark precludes taking into account, in addition to the day of filing the application for a Community trade mark, the hour and minute of that filing.

40 — Folliard-Monguiral, 'Conditions et effets de la coexistence de marques en droit communautaire', *Propriété industrielle*, No 9, September 2006, étude 24.

41 — Elsmore, M.J., 'Trade Mark Coexistence Agreements: What is all the (lack of) fuss about?', SCRIPT-ed, Vol. 5, Issue 1, April 2008. Such an agreement is not always relevant for the purposes of assessing the likelihood of confusion, see judgment of 6 November 2007 in Case T-90/05 *Omega* v *OHIM — Omega Engineering (Ω OMEGA)*, paragraph 49.

42 — See the Opinion of Advocate General Trstenjak in Case C-482/09 *Budějovický Budvar* in which she invites the Court to rule that Article 4(1)(a) of Directive 89/104 precludes the long-established honest concurrent use of two identical marks covering identical goods by two different proprietors of the marks.

43 — See Joined Cases T-350/04 to T-352/04 *Bitburger Brauerei* v *OHIM - Anheuser-Busch (BUD)* [2006] ECR II-4255.