QORTI CIVILI PRIM' AWLA

ONOR. IMHALLEF MARK CHETCUTI LL.D.

Illum It-Tnejn, 5 ta' Ottubru, 2015

Numru 23

Rikors Guramentat Nru. 438/2015

King.com Limited

vs

Dr. Louis Cassar Pullicino
nominat kuratur deputat sabiex jirrapprezenta lil Storm8 Studios LLC, entita' estera ta' nazzjonalita' Amerikana registrata fl-Istat ta' Delaware fl-Istati Uniti tal-Amerika bin-numru tal-file relattiv 5681701 u b'indirizz fl-Istat ta' Delaware ta' Incorporating Services, Ltd., 3500 South Dupont Highway, Dover, Delaware 19901 fl-Istati Uniti tal-Amerika, oltre ghal indirizz operattiv li jinsab f'1000 Bridge Pkwy, Redwood City, CA 94065, fl-Istati Uniti tal-Amerika b'digriet tal-25 ta' Mejju 2015

Il-Qorti,

Rat ir-rikors guramentat tas-socjeta attrici tat-13 ta' Mejju 2015 li jghid hekk:

1. illi l-kumpannija attrici tizviluppa u tikkummercjalizza online games u downloadable games, fosthom is-serje ta' loghob famuza Candy Crush li tinkludi Candy Crush Saga, loghba li hija popolari mmens fuq Facebook, iTunes u bosta pjattaformi ohrajn f'hafna pajjizi madwar id-dinja kif ukoll fl-Unjoni Ewropeja;

2. illi b'hila u b'invenzjoni, kif ukoll b'hafna sagrificcju finanzjarju u promozzjoni reklamattiva da parti taghha u ta' kumpanniji ohrajn affiljati maghha, il-kumpannija attrici kisbet reputazzjoni u avvjament enormi in konnessjoni mas-serje ta' loghob

famuza "Candy Crush" u mat-trademarks relatati mal-istess serje, fosthom it-trade marks Komunitarji:

(a) "Candy Crush" [wordmark, numru 011106713, registrat dwar diversi prodotti u servizzi, b'effett mit-tmienja (8) ta' Awwissu tas-sena elfejn u tnax (2012)];

(b) "Candy Crush Saga" [wordmark, numru 010718542, registrat dwar diversi prodotti u servizzi, b'effett mit-tnax (12) ta' Marzu tas-sena elfejn u tnax (2012)];

(c)

[figurattiv, numru 011560604, registrat dwar diversi prodotti u servizzi, b'effett mit-tmienja (8) ta' Frar tas-sena elfejn u tlettax (2013)];

(d)

[figurattiv, numru 011560448, registrat dwar diversi prodotti u servizzi, b'effett mit-tmienja (8) ta' Frar tas-sena elfejn u tlettax (2013)]; u

(e) "Candy" [wordmark, numru 011538147, registrat dwar diversi prodotti u servizzi, b'effett mill-ewwel (1) ta' Frar tas-sena elfejn u tlettax (2013)];

3. illi I-kumpannija attrici ghandha fil-pussess taghha evidenza tara Ii turi Ii minghajr il-kunsens taghha s-socjeta konvenuta, Ii giet inkorporata fis-sebgha u ghoxrin (27) ta' Jannar tas-sena elfejn u hmistax (2015), qed toffri u tikkummercjalizza fl-Unjoni Ewropeja, online and downloadable games u servizzi tal-intratteniment in konnessjoni mal-istess, taht sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", bl-uzu wkoll ta' sinjali "CANDY BLAST" / "Candy Blast" / "Candy Mania" oltre ghal sinjali "CANDY" / "Candy" (wahedhorn jew b'"CANDY" / "Candy" bhala I-ewwel element abbinat ma' xi element iehor);

4. illi s-socjeta konvenuta hija entita guridika b'xi mod relatata ma' TeamLava, LLC, entita estera ta' nazzjonalita Amerikana registrata fl-Istat tal-Kalifornja fl-Istati Uniti tal-Amerika bin-numru ta' registrazzjoni 200932910077 u wkoll b'indirizz ta' 1000 Bridge Pkwy, Redwood City, CA 94065 fl-lstati Uniti tal-Amerika, fil-konfront ta' min il-kumpannija attrici kienet pprezentat protest gudizzjarju [debitament innotifikat fis-sittax (16) ta' Dicembru tas-sena elfejn u erbatax (2014)], u fejn ukoll fit-tnax (12) ta' Frar tas-sena elfejn u hmistax (2015) kien gie milqugh provvizorjament rikors tal-kumpanniija attrici ghall-hrug ta' mandat ta' inibizzjoni fuq bazi U.E. / PAN-EU injunction fil-konfront tal-istess TeamLava, LLC [numru ta' riferenza 224/15EG, deciz definittivament fit-tletin (30) ta' Marzu tas-sena elfejn u hmistax (2015)]. Jidher Ii fil-mori tal-proceduri dwar dak il-mandat, l-uzu kontravvenjenti minn naha ta' TeamLava, LLC gie parzjalment imdawwar b'xi mod fuq is-socjeta konvenuta Storm8 Studios LLC f'cirkustanzi fejn din tal-ahhar ma kinitx kolpita mill-mizuri provvizorji ordnati kif hawn qabel indikat;

5. illi I-attivitajiet tas-socjeta konvenuta hawn qabel indikati qed isehhu bi ksur tal-jeddijiet dwar trade marks tal-kumpannija attrici provduti fl-artikolu disgha (9) subartikolu wiehed (1.) paragrafi "(c)", "(b)" u "(a)" tar-Regolament numru mitejn u

sebgha (207) tas-sena elfejn u disgha (2009) [Council Regulation (EC) No 207/2009] dwar it-trade mark Komunitarju, b'rimedji appoziti spettanti lill-kumpannija attrici skont il-ligi, enfurzabbli madwar it-territorju kollu tal-Unjoni Ewropeja stante ksur ta' jeddijiet dwar trade marks Komunitarji li qed isir fl-Unjoni Ewropeja;

6. illi l-artikolu disgha (9) subartikolu wiehed (1.) paragrafu "(c)" tar-Regolament U.E. 207/2009 fuq it-trade mark Komunitarju, jipprovdi li sid ta' trade mark Komunitarju "... shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is ... similar to, the Community trade mark ..., where the latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.";

7.illi f'dan il-kuntest, l-attivitajiet tas-socjeta konvenuta hawn qabel indikati jikkonfliggu mal-jeddijiet antecedenti tal-kumpannija attrici fir-rigward tat-trade marks Komunitarji bin-numri 011106713 - "Candy Crush" (word mark), 011560604 - (figurattiv), 010718542 - "Candy Crush Saga" (word mark), u 011560448 - (figurattiv), peress li dawn it-trade marks Komunitarji ghandhom reputazzjoni gewwa l-Unjoni Ewropeja dwar online games u downloadable games kif ukoll servizzi tal-intratteniment relatati mal-istess, u bl-uzu minn naha tas-socjeta konvenuta ta' sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", ta' sinjali "CANDY BLAST" / "Candy Blast" / "Candy Mania" u ta' sinjali "CANDY" / "Candy" (wahedhorn jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor), qed jittiehed vantagg mhux gust minn dawn l-istess trade marks Komunitarji. Inoltri, dan huwa detrimentali ghax-xorta distintiva ta' dawn l-istess trade marks Komunitarji u kif ukoll ghar reputazzjoni taghhom;

8. illi partikolarment f'dan il-kuntest, jigu rilevati s-segwenti:

fl-ewwel lok, free riding: bl-agir taghha, is-socjeta konvenuta qed tisfrutta r-reputazzjoni enormi madwar l-Unjoni Ewropeja tat-trade marks Komunitarji tal-kumpannija attrici ndikati fil-paragrafu enumerat precedenti u li huma assocjati mas-serje ta' loghob "Candy Crush", billi qed tirkeb minn fuq is-success taghhom u kwindi tibbenefika kummercjalrnent fuq skala enormi mill-attrazzjoni, mir-reputazzjoni u mill-prestigju tal-istess;

fit-tieni lok, detriment/dilution: l-uzu tas-sinjali kontravvenjenti minn naha tas-socjeta konvenuta qed ikollu l-effett li jiznatura u jippregudika l-funzjoni bazika tat-trade marks Komunitarji tal-kumpannija attrici ndikati fil-paragrafu enumerat precedenti, cioe dik li bihom il-prodotti u s-servizzi taghha jigu distinti minn prodotti u servizzi ta' terzi;

fit-tielet lok, tarnishment: kemm l-agir tas-socjeta konvenuta kif ukoll certi konsegwenzi ta' dan l-istess agir (li jinkludu l-fatt li numru ta' konsumaturi rilevanti jilmentaw dwar il-loghba "Candy Blast Mania" ghal diversi ragunijiet), qed iheggu

konsumaturi rilevanti sabiex jahsbu negattivament dwar is-serje ta' loghob "Candy Crush" tal-kumpannija attrici u b'daqstant dwar il-kumpannija attrici stess, u dan kollu ghad-detriment tar-reputazzjoni enormi tat-trade marks Komunitarji tal-kumpannija attrici ndikati fil-paragrafu enumerat precedenti;

9. illi l-artikolu disgha (9) subartikolu wiehed (1.) paragrafu "(b)" tar-Regolament U.E. 207/2009 fuq it-trade mark Komunitarju, jipprovdi li sid ta' trade mark Komunitarju "... shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign where, because of its identity with, or similarity to, the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;";

10. illi f'dan il-kuntest uzu minn naha tas-socjeta konvenuta ta' sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", ta' sinjali "CANDY BLAST" / "Candy Blast" / "Candy Mania" u ta' sinjali "CANDY" / "Candy" (wahedhorn jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor) kif hawn qabel indikat, jikkonfliggi mal-jeddijiet antecedenti tal-kumpannija attrici fir-rigward tat-trade marks Komunitarji bin-numri 011106713 - "Candy Crush" (word mark), 011560604 -

(figurattiv), 010718542 - "Candy Crush Saga" (word mark), 011560448 -

(figurattiv), u 011538147 - "Candy" (word mark) peress li, skond il-kaz, dan jikkonsisti f'uzu ta' sinjali identici u, jew simili ghal dawn it-trade marks Komunitarji, dwar oggetti u, jew servizzi identici u, jew simili ghal oggetti u, jew servizzi varji li dwarhom dawn jinsabu registrati , kif ukoll hemm probabbilta ta' konfuzjoni minn naha tal-pubbliku, inkluza l-probabbilita ta' assocjazzjoni bejn is-sinjali konfliggenti u dawn l-istess trade marks Komunitarji;

11. illi kemm is-serje ta' loghob "Candy Crush" kif ukoll il-loghbiet kontravvenjenti "CANDY BLAST MANiA" huma "Match 3 games", u b'daqstant il-prodotti de quo huma identici mill-perspettiva tal-konsumatur rilevanti. Tenut kont ukoll ta' dan u tal-fatt (fejn applikabbli) li l-espressjonijiet "Crush" u "Blast" irendu ideja simili hafna, il-probabbilta ta' konfuzjoni minn naha tal-pubbliku, inkluza l-probabbilita ta' assocjazzjoni bejn is-sinjali konfliggenti u dawn l-istess trade marks Komunitarji, hija cara u manifesta;

12 illi l-artikolu disgha (9) subartikolu wiehed (1.) paragrafu "(a)" tar-Regolament U.E. 207/2009 fuq it-trade mark Komunitarju, jipprovdi li sid ta' trade mark Komunitarju "... shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;";

13. illi f'dan il-kuntest, uzu minn naha tas-socjeta konvenuta, ta' sinjali "Candy" / "CANDY", jikkonfliggi mal-jeddijiet antecedenti tal-kumpannija attrici fir-rigward tat-

trade mark Komunitarju bin-numru 011538147 - "Candy" hawn qabel indikat, peress li l-element "Candy" / "CANDY" huwa identiku mal-kelma "Candy" registrar esklussivament f'isem il-kumpannija attrici, inter alia dwar prodotti identici fosthom games software downloadable to mobile phones, tablets and other electronic mobile devices fi klassi disgha (9) tal-Klassifikazzjoni Internazzjonali ta' Prodotti u Servizzi taht in-Nice Agreement (kif sussegwentement emendat), kif ukoll dwar servizzi identici fosthom electronic games services, including provision of computer games on line, on social networks, or by means of a global computer network; providing electronic games for use on mobile phones, tablets and other electronic mobile devices; ..., fi klassi wiehed u erbghin (41) tal-istess Klassifikazzjoni Internazzjonali;

14. illi dwar dawn is-sitwazzjonijiet ta' ksur ta' jeddijiet, il-kumpannija attrici ghandha rimedji appoziti spettanti lilha skont il-ligi in materja, u konsegwentement qed tippromwovi din il-kawza quddiem din l-Onorabbli Qorti bhala l-Community Trade Mark Court ta' prim'istanza kompetenti f'Malta u ghall-Unjoni Ewropeja fic-cirkustanzi ta' dan il-kaz;

15. illi l-fatti hawn kollha dikjarati huma maghrufin personalment mill-esponenti;

16. illi ghalhekk kellha ssir din il-kawza;

Ghaldaqstant ghar-ragunijiet hawn qabel premessi il-kumpannija attrici umilment titlob li dina l-Onorabbli Qorti:

(1) tiddikjara li l-uzu fil-kors tal-kummerc fi hdan l-Unjoni Ewropeja da parti tas-socjeta konvenuta, ta' sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", ta' sinjali "CANDY BLAST" / "Candy Blast" / "Candy Mania" u ta' sinjali "CANDY" / "Candy" (wahedhom jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor), jikkontravvjeni l-jeddijiet tal-kumpannija attrici dwar it-trade marks Komunitarji bin-numri 011106713, 011560604, 010718542 u 011560448 stabbiliti fl-Artikolu disgha (9) subartikolu wiehed (1.) paragrafu "(c)" tar-Regolament numru mitejn u sebgha (207) tas-sena elfejn u disgha (2009) [Council Regulation (EC) No 207/2009] dwar it-trade mark Komunitarju;

(2) tiddikjara li l-uzu fil-kors tal-kummerc fi hdan l-Unjoni Ewropeja da parti tas-socjeta konvenuta, ta' sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", ta' sinjali "CANDY BLAST" / "Candy Blast" / "Candy Mania" u ta' sinjali "CANDY" / "Candy" (wahedhom jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor), jikkontravvjeni l-jeddijiet tal-kumpannija attrici dwar it-trade marks Komunitarji bin-numri 011106713, 011560604, 010718542, 011560448 u 011538147 stabbiliti fl-Artikolu disgha (9) subartikolu wiehed (1.) paragrafu "(b)" tar-Regolament numru mitejn u sebgha (207) tas-sena elfejn u disgha (2009) [Council Regulation (EC) No 207/2009] dwar it-trade mark Komunitarju;

(3) tiddikjara li l-uzu fil-kors tal-kummertc fi hdan l-Unjoni Ewropeja da parti tas-socjeta konvenuta, ta' sinjali "Candy" / "CANDY", jikkontravvjeni l-jeddijiet tal-kumpannija attrici dwar it-trade mark Komunitarju bin-numru 011538147 stabbiliti fl-Artikolu disgha (9) subartikolu wiehed (1.) paragrafu "(a)" tar-Regolament numru mitejn u sebgha (207) tas-sena elfejn u disgha (2009) [Council Regulation (EC) No 207/2009] dwar it-trade mark Komunitarju;

(4) tordna fil-konfront tas-socjeta konvenuta, projbizzjoni madwar l-Unjoni Ewropeja, ta' tkomplija tal-azzjonijiet kontravvenjenti taghha u dan taht kwalunkwe kundizzjoni li dina l-Onorabbli Qorti thoss li jkun gust u xieraq fic-cirkustanzi sabiex jigi assigurat li s-socjeta konvenuta tattjeni ruhha ma' tali ordni ta' projbizzjoni;

(5) tiddikjara li bhala konsegwenza ta' uzu fil-kors tal-kummerc fi hdan l-Unjoni Ewropeja da parti tas-socjeta konvenuta, ta' sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", ta' sinjali "CANDY BLAST" / "Candy Blast" / "Candy Mania" u ta' sinjali "CANDY" / "Candy" (wahedhom jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor), is-socjeta konvenuta tinsab responsabbli versu l-hlas ta' danni favur il-kumpannija attrici;

(6) tillikwida l-istess danni sofferti mill-kumpannija attrici, jekk ikun hemm bzonn bl-opera ta' perit jew periti nominandi;

(7) tordna lill-istess socjeta konvenuta sabiex thallas lill-kumpannija attrici l-ammont ta' danni hekk likwidat.

Bl-ispejjez ta' din l-istanza kif ukoll bl-imghaxijiet kalkolabbli bl-oghla rata skont il-ligi mid-data ta' meta bdew l-attivitajiet kontravvenjenti sad-data tal-pagament effettiv, ilkoll kontra s-socjeta konvenuta li tibqa' minn issa ngunta ghas-subizzjoni taghha.

Rat ir-risposta guramentata tas-socjeta konvenuta li tghid hekk:

1. Preliminarjament, din l-Onorabbli Qorti ghandha tissoprassjedi l-kawza odjerna ai termini tal-artikolu 104 tar-Regolament K.E. 207/2009 u dan in vista tal-proceduri ghal dikjarazzjoni dwar l-invalidita tat-Trade Mark Komunitarju bin-numru 011538147 (il-wordmark "Candy"), li huwa fil-qofol tal-mertu tal-proceduri odjerni, li hemm pendenti quddiem l-Ufficju ghall-Armonizzazzjoni fis-Suq Intern (UASI, ossija OHIM);

2. L-obbligu tal-Community Trade Mark Court (fil-kaz odjern din l-Onorabbli Qorti) li tissoprassjedi f'kaz li jkun hemm gja nvestigazzjoni dwar invalidita ta' xi Trade Mark Komunitarju, li qed jigi allegat il-ksur tieghu. pendenti quddiem l-OHIM huwa indisputibbli u, fil-kaz li din l-Onorabbli Qorti jkollha xi dubju dwar l-applikabbilta ta' dan il-principju fil-kaz odjern ghandha ssir referenza preliminari lill-Qorti tal-Gustizzja tal-Unjoni Ewropeja;

3. Bla pregudizzju ghas-suespost, m'huwiex minnu illi s-socjeta konvenuta ghamlet xi uzu tal-marki "CANDY BLAST MANiA" / "Candy Blast Mania", "CANDY BLAST" / "Candy Blast", "Candy Mania" u/jew "CANDY" / "Candy" (wahedhom jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor), kif allegat mis-socjeta attrici, u ghaldaqstant ghandha tigi liberata mill-osservanza tal-gudizzju;

4. Bla pregudizzju ghas-suespost, it-Trade Marks Komunitarji li fuqhom tistrieh l-azzjoni attrici huma invalidi, u s-socjeta konvenuta qieghda tipprevalixxi ruhha mill-proceduri odjerni sabiex taghmel kontro-talba ghal dikjarazzjoni ta' invalidita fil-konfront ta' dawk it-Trade Marks, ad eskluzjoni tat-Trade Mark Komunitarju bin-numru 011538147 (il-wordmark "Candy"), li l-invalidita tieghu gja qed tigi investigata

mill-Ufficju ghall-Armonizzazzjoni fis-Suq Intern, u dan ai termini tal-artikoli 52(1) u 100 tar-Regolament K.E. 207/2009;

5. Bla pregudizzju ghas-suespost, m'huwiex minnu li l-uzu tas-sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", "CANDY BLAST" / "Candy Blast", "Candy Mania" u/jew "CANDY" / "Candy" (wahedhom jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor) minn min qed juzahom iledi d-drittijiet kontestati u li qed tivvanta s-socjeta attrici, b'mod partikolari taht l-artikoli 9(1)(a), (b) u (c) tar-Regolament K.E. 207/2009;

6. Bla pregudizzju ghas-suespost, u limitatament ghat-talba maghmula mis-socjeta attrici sabiex din l-Onorabbli Qorti tillikwida d-danni sofferti mis-socjeta attrici u tordna lis-socjeta konvenuta thallas l-istess danni hekk likwidati, m'huwiex minnu illi s-socjeta attrici sofriet xi danni jew pregudizzju kagun tal-uzu tas-sinjali "CANDY BLAST MANiA" / "Candy Blast Mania", "CANDY BLAST" / "Candy Blast", "Candy Mania" u/jew "CANDY" / "Candy" (wahedhom jew b'"CANDY" / "Candy" bhala l-ewwel element abbinat ma' xi element iehor) minn min qed juzahom;

L-ispejjez ta' dawn il-proceduri ghandha tbaghtihom unikament is-socjeta attrici, li minn issa hija ngunta ghas-subizzjoni.

Rat il-kontrotalba tas-socjeta konvenuta li tghid hekk:

1. Is-socjeta esponenti qieghda tipprevalixxi ruhha mill-proceduri migjuba kontriha mis-socjeta attrici rikonvenzjonata sabiex, ai termini tal-artikoli 52(1) u 100 tar-Regolament K.E. 207/2009, permezz ta' din l-azzjoni rikonvenzjonali, titlob bir-rispett li din l-Onorabbli Qorti, bhala l-Community Trade Mark Court, tiddikjara li t-Trade Marks Komunitarji registrati f'isem is-socjeta attrici u li jgibu n-numri 011106713, 011560604, 010718542 u 011560448 huma nvalidi ai termini tal-artikolu 52 tar-Regolament K.E. 207/2009;

2. Kif ser jigi muri fil-kors tal-proceduri odjerni jezistu c-cirkostanzi kollha msemmija fl-artikolu 52(l)(a), l-artikolu 7(1)(a), (b), (c) u (d), kif ukoll l-artikolu 52(1)(b) tar-Regolament K.E. 207/2009, li abbazi taghhom it-Trade Marks Komunitarji hawn fuq imsemmija ghandhom jigu dikjarati bhala invalidi minn din l-Onorabbli Qorti ai termini tal-istess artikolu 52 tal-imsemmi Regolament;

3. Fost ohrajn, it-Trade Marks Komunitarji registrati f'isem is-socjeta attrici huma privi mill-element tal-karattru distintiv, jiddeskrivu l-prodotti, u cioe l-loghob un-natura tal-loghobiet, offruti taht l-istess markji, jikkonsistu fi kliem u frazijiet deskrittivi assocjati mat-tip ta' loghob, u dan kollu kien ovvju meta saru r-registrazzjonijiet da parti tas-socjeta attrici meta fis-suq gja kien hemm trade marks simili uzati fl-istess swieq li ghalihorn is-socjeta konvenuta registrat it-trade marks taghha.

Ghaldaqstant is-socjeta konvenuta rikonvenzjonanti qieghda titlob bir-rispett illi din l-Onorabbli Qorti bhala l-Community Trade Mark Court, joghgobha tiddikjara illi t-Trade Marks Komunitarji bin-numri 011106713, 011560604, 010718542 u 011560448, registrati f'isem is-socjeta attrici rikonvenzjonata, huma nvalidi, u dan ai termini tal-artikoli 52(1) u 100 tar-Regolament K.E. 207/2009, u taghti kwalunkwe

direttivi u ordnijiet li jista' jidhrilha xieraq illi taghti inkluz dawk taht l-artikolu 100(4) u (6) tal- istess Regolament.

Bl-ispejjez ta' din il-procedura kontra s-socjeta attrici rikonvenzjonata, li minn issa hija ngunta ghas-subizzjoni.

Rat ir-risposta tas-socjeta attrici li tghid hekk:

illi t-talba tas-socjeta konvenuta rikonvenjenti hija nfondata fil-fatt u fid-dritt u ghandha tigi michuda bl-ispejjez kontra l-istess socjeta konvenuta rikonvenjenti stante li, kuntrarjament ghal dak minnha allegat, it-trade marks Komunitarji bin-numri 011106713, 011560604, 010718542 u 011560448 huma kollha validament irregistrati dwar l-oggetti u s-servizzi rispettivi;

illi noltri u minghajr pregudizzju ghas-sueccepit, anke li kieku ghall-grazzja tal-argument (dato ma non concesso) it-talba tas-socjeta konvenuta rikonvenjenti mibnija fuq allegazzjoni ta' ksur tal-artikoli 52(1.)(a) u 7(1.)(b), (c) u (d) tar-Regolament numru mitejn u sebgha (207) tas-sena elfejn u disgha (2009) [Council Regulation (EC) No 207/2009] dwar it-trade mark Komunitarju kellha tkun fondata, din kien ikollha fi kwalunkwe kaz tigi michuda bl-ispejjez kontra l-istess socjeta konvenuta rikonvenjenti fir-rigward ta' dawk l-oggetti u s-servizzi registrati kollha li dwarhom, bhala konsegwenza ta' uzu madwar l-Unjoni Ewropeja tat-trade marks Komunitarji registrati bin-numri 011106713, 011560604, 010718542 u 011560448, dawk l-istess trade marks Komunitarji registrati jkunu akkwistaw karattru distintiv skond l-artikolu 52(2.) tal-istess Regolament UE Nurnru 207/2009.

Salv kwalunkwe eccezzjoni ulterjuri permessa mill-ligi, u b'rizerva ta' talba b'rikors quddiem din l-Onorabbli Qorti ai termini tal-artikolu 100(7.) tar-Regolament UE Numru 207/2009 dwar it-trade mark Komunitarju.

Rat l-atti u noti ta’ sottomissjonijiet;

Rat li l-kawza thalliet ghall-provvediment fuq l-eccezzjoni preliminari ta’ soprasessjoni.

Ikkunsidrat

Il-kawza attrici hi primrjament wahda ghal dikjarazzjoni kontra s-socjeta konvenuta ta’ vjolazzjoni ta’ drittijiet ta’ trademarks komunitarji bin-numri 011106713, 011560604, 010718542 u 011560448 u 011538147 u dan a bazi tal-artikolu 9(1)(c), 9(1)(b) u 9(1)(a) tal-Council Regulation 207/2009 dwar it-trade komunitarji.

> 1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

> (c) any sign which is identical with, or similar to, the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.
> (b) any sign where, because of its identity with, or similarity to, the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
> (a) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;

Is-socjeta konvenuta da parti taghha qed tirreleva illi quddiem l-Ufficcju ghall-Armonizzazzjoni fis-Suq Intern (OHIM) hemm gia procedura pendenti ghall-invalidita tat-trade mark 011538147 cioe dak tal-wordmark “Candy” li hi l-qofol tal-mertu tal-kontestazzjoni. Qed jinvokaw l-artikolu 104 tal-imsemmi regolament biex din il-Qorti tissoprassjedi pendenti dawn il-proceduri.

L-artikolu 104(1) ighid hekk:

> 1. A Community trade mark court hearing an action referred to in Article 96, other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue before another Community trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office.

Hu minnu illi din l-eccezzjoni qed issir b’referenza ghal wahda mill-hames trade marks li fuqhom saret it-talba attrici pero s-socjeta konvenuta ipprezentat kontrotalba f’dawn il-proceduri fejn qed titlob dikjarazzjoni ta’ invalidita dwar it-trade marks l-ohra registrati favur is-socjeta attrici li huma relatati ma’ xulxin permezz tal-kelma ‘candy’ u ghalhekk f’dan is-sens ghandu jiftiehem li s-socjeta konvenuta qed tinvoka l-istess artikolu tal-ligi fir-rigward tat-trade marks l-ohra registrati favur is-socjeta attrici billi decizjoni f’wahda jista’ jkollha effetti fuq it-trade marks l-ohra.

L-artikolu 104 jirreferi ghall-artikolu 96 bhala l-vertenza li tistabilixxi l-gurisdizzjoni tal-community trade mark courts, li f'dan il-kaz il-Qrati Maltin jitqiesu bhala community trade mark courts. L-artikolu 96(a) ighid hekk:

> The Community trade mark courts shall have exclusive jurisdiction:
> (a) for all infringement actions and – if they are permitted under national law – actions in respect of threatened infringement relating to Community trade marks;

Il-bazi tal-azzjoni ghall-invalidita mhix daqshekk rilevanti f'dan l-istadju izda li hu rilevanti hu d-diskrezzjoni afdata lil Community trade mark court li jkompli jisma' o meno kawza ta' vjolazzjoni meta hemm kawza ghall-invalidita.

Kif ighid l-awtur **Kelly's Law of Trade Marks and Trade Names**, 15th Edition

> It is clear that in both these sets of circumstances that there is a strong presumption in favour of the tribunal first seised to hear the proceedings while staying the later proceedings. This presumption is only rebutted where there are "special grounds" which are not defined within the CTM Regulation. It should be noted that these provisions apply even where the party attacking the trade mark is not the same in both jurisdictions (See **Kitfix Swallow Group Ltd v Great Gizmos Ltd** [2008] E.T.M.R. 11, para. 11. In this case the original CTM Infringement proceedings were brought against the UK distributor of the potentially infringing products who then counterclaimed for a declaration of invalidity of the CTM. The later OHIM proceedings, attacking the validity of the CTM, were brought by a different party, the manufacturer of the potentially infringing products).

Il-Qorti tqis illi l-artikolu 104(1) jimponi obbligu fuq il-Qorti tat-trade marks komunitarji, bhal ma hi din il-Qorti, illi tissposendi l-procedimenti fejn hemm gia applikazzjoni pendent quddiem l-OHIM ghal dikjarazzjoni ta' invalidita ta' trade marks.

Dan l-obbligu jista' jigi skartat biss fejn jezistu 'special grounds'. Fil-kawza **Nokia Corp. vs Joacim Wärdell** (C316/05) il-High Court Ingliza qalet hekk:

> 17. Although not concerned with tis Article of the CTMR, the ECJ has considered the meaning of "special reasons" in the context of what is now Article102 of the CTMR. The case in question is case C316/05 Nokia Corporation v. Wardell. The court held, first, that special reasons must be given an autonomous and uniform interpretation through the EU; and second, that special reasons must relate to factual circumstances specific to a given case. In addition in that case Advocate General Sharpston said that since special reasons were a derogation from a general mandatory rule, a derogation is to be narrowly construed. In my judgment, the same approach

applies to Article 104, although the phrase in Article 104 is "special grounds" as opposed to "special reasons".

In oltre l-Qorti tal-Appell Ingliz fil-kawzi konnessi **Starbuck (HK) Limited vs BskyB Group PLC** u **EMI (P) Limited vs BskyB PLC** (2012) ikkonkludiet illi l-prezunzjoni ta' soprasessjoni hi wahda qawwija mhux biss minhabba li deroga ghal regola generali tal-ligi Ewropea ghandha tinghata interpetazzjoni restrittiva izda wkoll biex jigu evitati decizjonijiet inkonsistenti. Minhabba f'hekk hu biss f'kazijiet rari u eccezzjonali li jigu riskontrati 'special reasons' ghal tali deroga li jridu jkunu specifici ghal fattispecie partikolari tal-kaz.

Hu minnu illi l-kontrotalba ghall-invalidita tal-erba' trade marks gia imsemmija saret wara l-prezentata tal-azzjoni ta' vjolazzjoni pero din il-Qorti tqis illi l-prezunzjoni tal-ligi li l-ewwel tigi deciza jekk it-trade mark hix invalida o meno qabel tikkunsidra kull allegazzjoni ta' vjolazzjoni taghha ghandha tigi irrispettata f'dan il-kaz. Ikun ferm imprattiku jekk mhux perikoluz li jigi deciz allegazzjoni ta' vjolazzjoni meta qed jigi kontestat l-istess dritt li bih qed tigi invokata l-vjolazzjoni. Din il-Qorti ma irriskontrat ebda 'special grounds' li ghalihom ghandha tiddepartixxi mill-principju regolatur tal-ligi fil-Council Regulation 207/2009.

Il-kontrotalba tas-socjeta konvenuta ghall-invalidita hi mibnija fuq l-artikolu 52(1)(a) u (b) u 7(1)(a), (b) u (c) cioe ragunijiet, li jekk fondati jinvalidaw it-trade marks registrati. Dawn l-artikoli jolqtu l-ezistenza tat-trade marks fl-essenza taghhom u sakemm dan il-mertu jkun deciz ma tistax il-Qorti thossha libera li tikkunsidra l-allegazzjonijiet ta' vjolazzjoni. Madankollu tqis illi safejn japplika ghal kontrotalba billi l-istess ragunament japplika ghal dak li intqal fir-rigward tal-azzjoni attrici u l-proceduri esteri pendenti fl-OHIM din il-Qorti tqis li wkoll ghandha tissoprasjedi sakemm ikun hemm ezitu finali fil-proceduri esteri. Hemm ukoll raguni ta' pratticita ghaliex din il-Qorti ma thossx li ghandha tisma' l-provi biss kemm fit-talba attrici u l-kontrotalba tal-konvenuti. Dan ghaliex l-OHIM tista' tiddeciedi b'tali mod illi din il-Qorti tkun indirizzat is-smigh tal-provi b'mod li ma jirriflettix il-konkluzjonijiet li jistghu jigu raggunti mill-OHIM u b'hekk tkun ipperikolat u possibilment ikkontaminat il-process kollu quddiemha.

Decide

Ghalhekk il-Qorti tqis illi t-talba ghal soprasessjoni hi gustifikata u ghalhekk ghandha tissoprassjedi li tkompli tisma' l-kawza in kwantu t-trade mark 011538147 sakemm tigi deciza finalment il-vertenza mill-OHIM u in kwantu ghat-trade marks 011106713, 011560604, 010718542 u 011560448 ghandha wkoll tissoprassjedi sakemm tigi deciza l-vertenza mill-OHIM. Il-Qorti tirriserva li tippronunzja ruhha fi stadju ulterjuri jekk jezitux cirkostanzi li ghalihom ghandha tiehu provvedimenti skond l-artikolu 104.3 tal-Council Regulation 207/2009 kemm-il darba titressaq talba dettaljata ad hoc. Spejjez jibqghu bla taxxa.

Onor. Mark Chetcuti LL.D.
Imhallef

Anne Xuereb
Deputat Registratur