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CJEU: 'electrical energy' not included in Class 4 of eighth edition of Nice Classification

European Union - [Carnelutti Studio Legale Associato](#)

- **The examiner rejected Edison's request to include 'electrical energy' in the list of goods in Class 4 claimed at the time of registration of its EDISON mark**
- **The General Court confirmed the decision and the CJEU dismissed the appeal**
- **The General Court correctly excluded 'electrical energy' from Class 4 of the eighth edition of the Nice Classification**

On 16 September 2020 the Court of Justice of the European Union (CJEU) rendered its judgment in [Case C-121/19](#) between Edison SpA (the applicant) and the European Union Intellectual Property Office (EUIPO) (the defendant at first instance).

Background

On 18 August 2003 Edison SpA filed an application for registration of the EU figurative trademark EDISON with the EUIPO for all goods in Class 4 of the eighth edition of the Nice Classification. The mark was registered on 19 August 2013.

On 15 June 2015 Edison requested a surrender to be entered in respect of a portion of the goods in Class 4 for which the mark was registered. More precisely, it proposed that the list of goods originally claimed in that class be reworded to include, among others, the words 'electrical energy'.

The examiner rejected Edison's request solely insofar as it tried to include 'electrical energy' in the list of goods in Class 4 claimed at the time of registration.

On 25 July 2016 Edison lodged an appeal before the EUIPO against the examiner's decision, which was dismissed by the Fifth Board of Appeal. Subsequently, Edison brought an action before the Registry of the General Court seeking the annulment of such decision, which was dismissed on 7 December 2018.

By its appeal brought on 15 February 2019, Edison sought to set aside the judgment of the General Court, relying on two grounds:

- incorrect interpretation of the terms 'illuminants', 'fuels (including motor spirit)' and 'carburants'/'motor fuel' within the meaning of the eighth edition of the Nice Classification;
- infringement of its procedural rights and of Article 75 of Regulation 207/2009.

Decision

With regard to the first plea, the CJEU reasoned as follows:

- The goods for which protection is sought must be identified in the application for registration with sufficient clarity and precision to enable the competent authorities and the economic operators, on that basis alone, to determine the extent of the protection sought.
- In accordance with their customary and ordinary meaning, the terms 'illuminants', 'fuels (including motor spirit)' and 'carburants'/'motor fuel' do not include electrical energy.
- Although the General Court affirmed that electrical energy is considered analogous to other tangible fuels in Class 4 (even though it is intangible), it added that, despite that similarity from a functional perspective, electrical energy is not covered by the literal meaning of the concept of 'fuel'.
- When the application for registration was filed, the decision to include 'electrical energy' on the indicative and non-exhaustive list published by EUIPO was still being drawn up. Therefore, such decision was not probative.
- It was not sufficiently proven that the economic operators perceived the concept of 'carburants'/'motor fuel', at the date of the filing of the application for registration, as covering electrical energy.

Regarding the second plea, the CJEU did not consider the decision of the General Court as contradictory. Although 'certain' car models powered partially or entirely by electrical energy had already been placed on the market, the General Court nevertheless held that the development on the European market of those car models had not "in reality" taken place until several years after the application for registration at issue had been filed.

In conclusion, the CJEU deemed that 'electrical energy' was not included in the list of goods in Class 4 of the eighth edition of the Nice Classification.

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