

Board of Appeal rebuked by General Court for ruling of its own motion on earlier mark's genuine use
European Union - Bugnion SpA

**Cancellation
International procedures**

June 26 2018

- **Glaxo sought declaration of invalidity of Celon Pharma's mark based on earlier national mark**
- **Board of Appeal examined of its own motion issue of earlier mark's genuine use**
- **Court found that board did not have competence to do so**

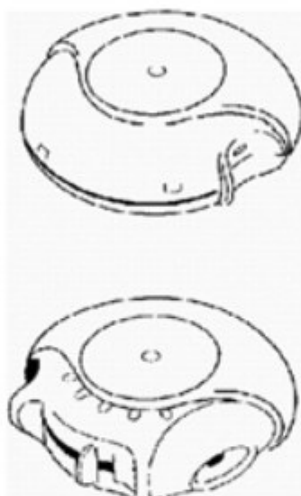
In *Glaxo Group Ltd v European Union Intellectual Property Office* (EUIPO) (Case T-803/2016, 6 June 2018), the General Court (Sixth Chamber) has found that the Board of Appeal of the EUIPO does not have the competence to examine the issue of genuine use if that issue has not been expressly raised by the parties before it. This is true even if the parties raised the issue at the Cancellation Division level.

On 29 March 2011 Celon Pharma SA filed an application for registration of the following figurative sign in Classes 5 (inhalation products) and 10 (inhalers):



It was registered on 5 October 2011 under No 9849191.

On 4 April 2013 Glaxo Group Ltd filed an application for a declaration of invalidity against the mark at issue based on, among others, the following French mark (No 97685112), registered on 1 July 1997:



While the Cancellation Division found the trademarks to be confusingly similar (establishing that there had been genuine use of the earlier mark), the Board of Appeal disregarded the assessment of confusing similarity. Instead, the Board of Appeal focused - this time without the express request of Celon Pharma - on the threshold for genuine use. As a result, the Board of Appeal found that there had been no proper and

sufficient genuine use pursuant to Article 57(2) of [Regulation 207/2009](#) (now Article 64(2) of [Regulation 2017/1001](#)).

The General Court annulled the Board of Appeal's decision.

The first and main issue to determine was whether the Board of Appeal was competent to rule, of its own motion, on the genuine use of the earlier mark.

The court stated as follows:

It should be noted that an application for a declaration of invalidity based on the existence of a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation 207/2009 does not necessarily bring the issue of genuine use of the earlier mark before the EUIPO. Genuine use is a preliminary issue which leads to a determination of whether, for the purposes of the examination of the application for a declaration of invalidity, the earlier trademark can be deemed to be registered in respect of the goods or services in question. It is therefore outside the scope of the examination of the application for a declaration of invalidity in the strict sense, based on a likelihood of confusion with that mark (see, to that effect, and by analogy, judgment of 13 September 2010, Inditex v OHIM - Marín Díaz de Cerio (OFTEN), T-292/08, EU:T:2010:399, Paragraphs 30, 31 and 33).

The court then stated that a request for proof of genuine use of the earlier mark constitutes a new, specific claim:

It follows that the Board of Appeal can examine the issue of genuine use of the earlier mark only if a party raises it specifically before it (see, to that effect, judgment of 24 September 2015, Rintisch v OHIM - Compagnie laitière européenne (PROTICURD), T-382/14, not published, EU:T:2015:686, Paragraph 24 and the case-law cited). In other words, when the issue of genuine use of the earlier mark is not specifically raised before the Board of Appeal, it must be considered as not being part of the subject matter of the proceedings before the Board of Appeal (see, to that effect, judgment of 12 March 2014, El Corte Inglés v OHIM - Technisynthese (BTS), T-592/10, not published in the ECR, EU:T:2014:117, Paragraph 21).

Therefore, the rationale of the General Court for overturning the decision of the Board of Appeal was based on the fact that the genuine use of the earlier mark was not debated in any way by the parties before the Board of Appeal. Consequently, the Board of Appeal ruled on the issue of its own motion, and did not afford the parties with the opportunity to state their views in that respect.

In light of the General Court's findings, the parties must raise the issue of genuine use before both the Cancellation Division and the Board of Appeal.

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