

# World Trademark Review Daily

Combination of items held to evidence genuine use of earlier mark  
European Union - MAQS Law Firm

Cancellation  
National procedures

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In *Luna International Ltd v Office for Harmonisation in the Internal Market* (OHIM) (Case T-454/11, April 19 2013), the General Court has confirmed a decision of the Second Board of Appeal of OHIM holding that the form of use of the earlier trademark AL BUSTAN did not alter its distinctive character, despite the lack of documents directly proving its genuine use.

The applicant in this case, Luna International Ltd, was granted registration in 2005 of the following Community trademark (CTM) for a broad list of goods in Classes 29, 30, 31 and 32 of the [Nice Classification](#):

Al bustan البستان

In 2006 Asteris Industrial and Commercial Company SA filed an application for a declaration of invalidity of the mark. The application was based on an earlier Greek trademark granted in 2000 for goods falling within Class 29:



The reputation of the earlier trademark was mainly based on the "tomato paste and tomato products" in Class 29, but the invalidation application was directed against all the goods covered by the AL BUSTAN registration.

In accordance with Article 43(2) and (3) of the [Community Trademark Regulation](#) (40/94) (now Article 42(2) and (3) of the [Community Trademark Regulation](#) (207/2009)), Asteris was asked to prove the genuine use of the earlier trademark during the five-year period preceding its application for a declaration of invalidity. Rule 22 of the [Community Trademark Implementation Regulation](#) (2868/95) states that acceptable evidence of genuine use must prove the place, time, extent and nature of such use.

Asteris produced evidence of use in 2006 and, in 2008, its application for invalidity was granted by the Cancellation Division of OHIM with respect to some of the goods, namely "preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; edible oils and fats" in Class 29, "salt, mustard; vinegars, sauces (condiments); spices" in Class 30, "fresh fruits and vegetables" in Class 31, and "fruit drinks and fruit juices" in Class 32.

The applicant lodged an appeal against the decision of the Cancellation Division, disputing the proof of use of the earlier mark and the similarity of the trademarks at issue. The Second Board of Appeal of OHIM, having requested and received further evidence of genuine use from Asteris, dismissed the appeal.

The board found that Asteris had failed to provide proof of use of the earlier trademark as registered, but accepted that the form of use of the earlier mark did not alter its distinctive character. The board concluded that genuine use of the earlier mark had been proven for "tomato paste of various concentrations and packages, in cans; peeled tomatoes, in cans; various tomato products (tomato juice, concasse, pumarro, etc) in cans; fruit juices, in cans"; however, genuine use had not been proven for "preserved fruits, in cans" in Class 29. The board accepted that the affixing of the earlier trademark to goods or their packaging that were exported to consignees outside of the European Union (ie, from Greece to Arabic countries) was proper use of the mark in Greece.

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The board thus affirmed the decision of the Cancellation Division in its entirety, noting that:

- the fruits and vegetables in various forms, jellies, jams, compotes and sauces (condiments) covered by the mark at issue and the various tomato products in cans covered by the earlier mark were identical or similar;
- the other goods covered by the mark at issue - namely, edible oils and fats, salt, mustard, vinegars, spices - and the goods covered by the earlier mark were similar to a low degree; and
- the trademarks at issue were similar to a medium degree.

The applicant appealed to the General Court, claiming that the evidence submitted by Asteris was insufficient to establish genuine use of the earlier mark.

The General Court dismissed the appeal and confirmed the Board of Appeal's decision. In particular, it held as follows:

- Genuine use of an earlier mark can be established when the mark is used in accordance with its essential function and when the mark is used publicly and externally (see *Ansul* (Case C-40/01), Paragraph 43). In the present case, the board had noted that the signs used in trade by Asteris differed only in negligible elements from the form in which the mark was registered. Therefore, genuine use of the mark had been established.
- Each item of evidence must not necessarily give information about all four elements to which proof of genuine use must relate - namely the place, time, nature and extent of use (see *Buffalo Milke Automotive Polishing Products v OHIM* (Case T-308/06), Paragraph 61). Assessment of genuine use of the earlier trademark must take all facts and circumstances that are relevant into consideration, including the reality of its commercial exploitation. A combination of elements can be used in order to establish whether or not the use of the mark altered its distinctive character.
- The sole fact that some photographs were undated was not sufficient to deprive them of all evidential value. The assessment of the evidential value of a document depends on its credibility, that is to say the origin of the document, the circumstances in which it came into being, the person to whom it was addressed and, overall, whether the document seemed sound and reliable. In addition, invoices are commercial documents that are not meant to represent the products; they cannot be excluded from the evidence only because they do not include the figurative mark alongside the name of each product.
- The reproduction of the label, though undated, matched one of the photographs of a can of tomato paste submitted by Asteris. This established that the use of the earlier mark did not alter its distinctive character. The court noted that it is not precluded to take account of circumstances that are subsequent to the expiry of the relevant period (see *La Mer Technology* (Case C-259/02), Paragraph 31).
- By providing a number of third-party documents (certificates of origin and shipment records, as well as invoices), Asteris was able to establish the sale of a significant quantity of products bearing the AL BUSTAN mark.

Therefore, the General Court accepted that the combination of photographs and other items of evidence provided by Asteris constituted evidence of genuine use of the earlier mark during the relevant period. It approved the pragmatic approach taken by the Board of Appeal and by OHIM, which consisted of cross-checking the various items of evidence submitted by Asteris, and eventually finding that there had been genuine use of the earlier mark. The form of use of the earlier mark did not alter the distinctive character of the mark as registered. The General Court explained that the assessment of whether an earlier trademark has been put to genuine use should take into consideration all the relevant facts and circumstances, including a combination of the relevant elements.

The case confirms that new evidence of use can be filed on appeal. It also signals a softer approach with regard to opponents, in that the evidence of genuine use can be garnered from several sources, and documentation of the place, time, nature and extent of use does not have to appear on each piece of evidence. It is somewhat surprising that the court affirmed in effect that there was a likelihood of confusion where some of the goods covered by the marks were similar to a low degree and the trademarks at issue were similar to a medium degree. All in all, this decision strengthens the rights of owners of prior rights against later CTMs, and further demonstrates that the General Court is generally reluctant to overturn decisions of the boards of appeal of OHIM.

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