

## General Court digs deep into Class 3 in *ESSENCE* case European Union - NJORD

## Cancellation International procedures

June 12 2015

In *Bora Creations v Office for Harmonisation in the Internal Market* (OHIM), the General Court has upheld a decision of the Fifth Board of Appeal of OHIM finding that the registration for the word mark ESSENCE should be cancelled for “decorative cosmetics” and “nail varnishes” in Class 3 of the [Nice Classification](#) on grounds of descriptiveness, even though these goods are not usually scented.

On May 30 2011 Bora Creations SL was granted registration of the word mark ESSENCE as a Community trademark (CTM) for products in Classes 3, 4, 8, 14, 16, 21, 25 and 26. On August 18 2011 Beauté Prestige International filed an application for a declaration of invalidity of the mark for certain of the goods in Class 3.

The Cancellation Division of OHIM rejected the application in its entirety. Beauté Prestige appealed on the grounds that, both in English and in French, the term 'essence' would be perceived as a characteristic of the goods in Class 3, as it was purely descriptive, and so could not be registered as a trademark.

The Fifth Board of Appeal of OHIM overturned in part the Cancellation Division's decision. It decided that the term 'essence' had the unequivocal meaning of a product consisting of perfume or scent. As a result, the board found that such a term could not be used as a trademark for scented products in Class 3 such as hair products, decorative cosmetics, nails varnishes and other nail care products, as it lacked the ability to distinguish products as a purely descriptive term. The CTM registration was declared invalid for such products in Class 3, in accordance with Article 7(1)(c) of the [Community Trademark Regulation](#) (207/2009).

However, the board upheld the contested division in part, in that it found that the CTM was valid for those Class 3 products that the word 'essence' could not be said to describe, such as "false eyelashes" and "products for modelling and making false fingernails".

Bora Creations appealed this decision to the General Court with regard to two items only, namely decorative cosmetics and nail varnishes, on the ground that the board had not established the existence of a sufficiently direct and specific link between those goods, such that the mark ESSENCE could not be deemed to be descriptive in the sense of Article 7(1)(c) of the regulation.

The General Court upheld the board's decision in its entirety. It first reviewed the board's citation of the definition of 'essence' in six different English dictionaries, all of which stated that the word meant oils which could be tasted or smelled. The court thus held that, as the goods concerned were cosmetic products and, as such, can contain or consist of extracts, in particular plant extracts, perhaps in the form of a concentrate or a perfume, the Board of Appeal was entitled to hold that one of the possible meanings of the mark at issue would be a product manufactured on the basis of an essence or containing an essence. Accordingly, the connection between this meaning and the goods concerned was sufficiently direct and real to allow the relevant public to recognise directly, and without the need for further thought, the description of such a quality of the goods concerned, indeed of their nature.

Citing *DOUBLEMINT (OHIM v Wrigley, Case C-191/01 P)*, the court confirmed that a mark may be refused registration pursuant to Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned. Moreover, it is irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.

The Board of Appeal had held that, for “decorative cosmetics”, the word 'essence' was descriptive not because those goods are necessarily scented but in the sense of it being a concentrate, and that, upon seeing these goods bearing the word 'essence', the public would perceive that they consist of a concentrated version of a cosmetic preparation or active ingredient (which usually also exists in an ordinary, non-concentrated form). Bora Creations argued that “decorative cosmetics” are not used in a concentrated form, and are not manufactured from a concentrate. However, the court noted that the Board of Appeal had also taken the view that the mark at issue could be descriptive of “decorative cosmetics” in the sense that those products could be perfumed, in particular because the item is a very broad category of products.

As regards “nail varnishes”, Bora Creations argued that these products do not exist in a concentrated form - Article 7(1)(c) of the regulation prevents the registration of signs that indicate a characteristic of the product concerned and not a characteristic of a raw material of that product. However, the court held that the Board of Appeal was correct in determining that they could also be produced from “an extract that has fundamental properties of a substance in concentrated form” and that, therefore, the word 'essence' merely indicated the nature and content an essential characteristic of the product at issue.

Accordingly, the court dismissed the appeal.

This case is interesting, firstly, because it demonstrates that the General Court is capable of carrying out a very detailed, technical analysis of a descriptiveness citation for each individual item in a list of goods/services. Secondly, it is a very illustrative example of the line that the CTM system (OHIM and Boards of Appeal) draws - and should draw - when faced with a descriptiveness citation in relation to a diversified group of goods/services.

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