

Crossed rights examined by the General Court in VOGUE way
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In *Advance Magazine Publishers Inc v Office for Harmonisation in the Internal Market (OHIM)* (Case T-40/09), the General Court dismissed the action and confirmed the decision of the Fourth Board of Appeal regarding proof of use and conditions for the suspension of opposition proceedings pending the outcome of another case concerning the same marks before a national court (November 19 2008 – Case R 0280/2008-4).

Advance Magazine filed an application in 2003 for registration of a Community trademark for VOGUE CAFÉ for goods, among other things, in Class 25 of the Nice Classification. This was opposed by Selecciones Americanas SA, based on two Spanish registrations for VOGUE & device and VOGUE studio & device (Nos 255186 and 2529728), and a pending Community trademark (CTM) application (No 3064219) for a third VOGUE & device mark.

However, Advance Magazine lodged an opposition in 2004 against the pending CTM application. It was a classic crossed-rights situation, as the decision in that application affected the fate of the VOGUE CAFÉ application.

The Opposition Division of OHIM upheld the opposition against the VOGUE CAFÉ mark, finding that there was a likelihood of confusion between the two Spanish trademarks and the mark applied for, and that there was evidence of genuine use of the opponent's mark.

Advance Magazine appealed to the Fourth Board of Appeal. However, the board dismissed the appeal for the same reasons given by the Opposition Division and rejected the applicant's request for suspension on the grounds that the opposition was not solely based on the application; therefore, the validity of that application would have been decisive for the outcome of the opposition proceedings only if the opposition had been rejected for the earlier Trademarks 255186 and 2529728.

Advance Magazine then appealed to the General Court, claiming [three grounds for annulment](#). First, it claimed that the opponent had not proved genuine use of the earlier Trademark 255186. Second, it argued that there was no likelihood of confusion between the mark applied for and the earlier two marks. Third, it claimed an infringement of Rule 20(7) of EU Regulation 2868/95, regarding the rejection of its request for the suspension of proceedings by the board of appeal.

During the General Court proceedings, the conclusion of the opposition proceedings in the Spanish courts resulted in cancellation of Trademark 2529728 and revocation of Trademark 255186. Advance Magazine duly informed the General Court. The question was whether the opposition proceedings before the General Court should continue after the decision of the Spanish court.

Advance Magazine argued that the revocation of Trademark 255186 took effect after the board of appeal's ruling and therefore the object of the proceedings had ceased to exist. It asked the General Court to rule in its favour. Advance Magazine based its arguments on the OHIM Guidelines, which state:

if the decision taken in the national proceedings invalidates, revokes or results in some other way in the extinguishment of the right or transfers the opponent's earlier right, the opposition will be deemed unfounded in so far as it is based on that earlier right.

However, OHIM observed that only Trademark 2529728 was to be considered as having never produced any legal effect, that that Trademark 255186 was valid and effective at the time the contested decision was issued, and that its revocation took effect only after the conclusion of the proceedings before the Spanish court. Therefore, OHIM affirmed that the General Court could rule on the legality of the contested decision in relation to that mark.

The General Court, in agreement with OHIM's observations and with the settled case law, held that the proceedings should continue.

The second inquiry was to determine whether, after cancellation of Trademark 2529728 and revocation of Trademark 255186, annulment of the contested decision could still procure an advantage for the applicant. The General Court concluded that it was unnecessary to adjudicate on the appellant's second plea in law in relation to the earlier Trademark 2529728, given that this mark had expired. Otherwise, the proceedings continued for the other pleas in law.

With reference to the proof of genuine use of Trademark 255186, the General Court found that the use was genuine, even though it was not proven that the mark was physically attached to the goods.

Therefore, the General Court confirmed that part of the contested decision in which the board of appeal affirmed that the items of evidence adduced by the opponent, taken together, provided sufficient information concerning the cited topics.

As regards the final plea in law concerning the infringement of Rule 20(7), the General Court observed that the board of appeal can suspend opposition proceedings under its discretion. However, "in exercising that discretion, the Board of Appeal must take into account not only the interests of the party whose Community mark is contested, but also those of the other parties".

As a consequence, the General Court supported the board of appeal decision not to suspend the proceedings, explaining that:

since the opposition to the mark applied for was not based solely on Community trade mark application No 3064219, but also on earlier marks Nos 255186 and 2529728, the outcome of the opposition to Community trade mark application No 3064219 would have been decisive in respect of the opposition to the mark applied for only if that opposition had been rejected for earlier marks Nos 255186 and 2529728. In conclusion, the General court upheld entirely the Board of Appeal's decision.

This case is interesting for several reasons. First, it shows that the OHIM system, including the General Court, takes a formalistic approach to crossed rights. Second, it confirms that the OHIM boards of appeal have wide discretion concerning suspension. Finally, it shows that such crossed rights cases can take more than a decade to resolve.

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