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General Court confirms that EUIPO may accept supplementary evidence of use filed belatedly

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

- **The EUIPO may accept supplementary proof of use of an earlier mark which has not been submitted in due time**
- **The use of a trademark is genuine when it guarantees the identity of the origin of the goods/services for which the trademark is registered**
- **The weak distinctive character of the earlier mark does not, in itself, preclude a likelihood of confusion with a later mark**

On 5 February 2020 the General Court rendered its judgment in [Case T-44/19](#) between Globalia Corporación Empresarial SA ('the applicant'), the European Union Intellectual Property Office (EUIPO) and Touring Club Italiano ('the intervener').

Background

On 1 April 2016 the applicant filed an application with the EUIPO for registration of the EU figurative trademark depicted below for travel agency services in Class 39.



On 14 July 2016 the intervener - owner of the EU word mark TOURING CLUB ITALIANO for services in Class 39, including travel agencies - filed an opposition against the application, relying, among other things, on a likelihood of confusion with its earlier trademark.

On 12 January 2018 the Opposition Division of the EUIPO rejected the opposition, finding that the intervener had failed to submit adequate documentation to prove the genuine use of the earlier trademark.

On 8 March 2018 the intervener filed an appeal with the EUIPO, submitting further evidence of use of its trademark. The Board of Appeal annulled the Opposition Division's decision, holding that:

- the additional documentation submitted by the intervener appeared to be relevant as supplementary proof of use corroborating the initial evidence; and
- the stage of the proceedings did not preclude it from being taken into account.

General Court decision

The applicant appealed to the General Court, raising three pleas in law.

By its first plea, the applicant claimed that the Board of Appeal, by accepting the additional evidence of genuine use of the earlier trademark, had infringed Articles 95(1) and (2) of [Regulation 2017/1001](#) and Articles 10(2) and (7) of [Delegated Regulation 2018/625](#).

The court held that, pursuant to Article 95(2) of Regulation 2017/1001, the EUIPO has a broad discretion in assessing whether facts or evidence which are not submitted in due time by the parties concerned may or may not be relevant. In the present case, the Board of Appeal considered the supplementary documentation submitted by the intervener to be genuinely relevant to prove the use of the earlier trademark, especially in light of the decision of the Opposition Division considering the initial evidence to be insufficient.

By its second plea, the applicant submitted that the intervener had not proven the genuine use of its earlier trademark pursuant to Article 47(2) of Regulation 2017/1001. The General Court clarified that genuine use is not to be confused with proof of use on a large scale or with the level of commercial success of a trademark. It is, instead, the use of a trademark in a manner which guarantees the identity of the origin of the goods/services for which the trademark is registered. It also includes, under Article 18(1) of Regulation 2017/1001, the use of the earlier mark in a form differing in elements which do not alter the general distinctive character of the mark.

The third plea referred to the assessment of the likelihood of confusion between marks under of Article 8(1) (b) of Regulation 2017/1001, from a visual, phonetical and conceptual point of view. The General Court confirmed the likelihood of confusion between the marks, specifying that the weak distinctive character of the prior mark ('touring club' is weakly distinctive with reference to the services at issue and '*italiano*' is purely descriptive of the services) did not, in itself, preclude a finding that there was a likelihood of confusion.

The General Court therefore dismissed the action.

Comment

The clarifications provided by the General Court are relevant to the extent that supplementary evidence may often be needed in proceedings before the EUIPO, and the criteria to determine the type and scope of evidence required to prove use, laid down by previous decisions of the EUIPO, are not always clear and univocal.

Giulia Panigazzi

Carnelutti

Margherita Barié

Carnelutti

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