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General Court provides guidance on assessment of evidence of genuine use

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- **Use is genuine when the commercial exploitation of the mark is real and can be proven by solid and objective evidence, and not by means of probabilities or suppositions**
- **An accumulation of items of evidence may constitute adequate proof of use of a mark, even though each of those items, taken individually, would be insufficient**
- **Reproduction of a mark in advertisements constitutes public and external use sufficient to demonstrate genuine use of the mark**

On 28 May 2020 the General Court rendered its judgment in Case T-615/18 between Diesel SpA ('the applicant'), the European Union Intellectual Property Office (EUIPO) and Sprinter megacentros del deporte SL ('the intervener').

Background

On 6 December 2012 the intervener filed an application for registration with the EUIPO of the EU figurative trademark depicted below for goods in Classes 18 and 25.



On 5 April 2013 the applicant filed an opposition on the ground of a likelihood of confusion on the part of the public with:

- the earlier EU figurative mark No 583708:



- the international figurative mark No 881767:



Both earlier marks were registered for goods in Classes 18 and 25.

The Opposition Division of the EUIPO rejected the opposition.

The Board of Appeal of the EUIPO upheld the decision, dismissing the appeal on the ground that the applicant had not submitted material of a sufficient probative standard to prove the genuine use of the earlier trademarks.

The applicant appealed the decision before the General Court, claiming that the Board of Appeal had wrongly found that the evidence submitted was not sufficient to prove the genuine use of the earlier marks under Article 42(2) of Regulation 207/2009 (now article 47(2) of Regulation 2017/1001) during the five years preceding the publication of the intervener's trademark application.

General Court judgment

The court first specified that genuine use does not mean large-scale use or commercial success: in order to prove genuine use, it is sufficient to actually use the mark in the relevant sector, in accordance with its essential function of guaranteeing the identity of the origin of goods/services identified. Genuine use can be proven only by means of specific and complete evidence, which must include indications concerning the place, time, extent and nature of the use.

Concerning the proof of used submitted by the applicant, the court found as follows:

- Photographs and catalogues, without further indication on distribution, could only make it probable, but not certain, that goods bearing the marks were sold;

- An affidavit from the heads of the applicant's legal department was not sufficient in itself to prove the use of the marks: it could be relevant only if corroborated by other probative evidence;
- The reproduction of the marks on goods in advertisements intended for consumers in well-known magazines is sufficient to prove genuine use, since the circulation of the said magazines shall be considered as a well-known fact; and
- The presence of a mark on invoices is not sufficient in itself to prove use: a connection must be established between the goods sold and the mark at issue.

The court thus partially annulled the decision of the Board of Appeal insofar as it concerned some of the goods covered by the applicant's earlier marks, finding that the applicant had succeeded in proving genuine use of the marks in relation to such goods.

Comment

With this decision, the General Court gave some important guidance on the evaluation of the proof of genuine use of a mark. The findings of the court are particularly relevant in light of the case law of the EUIPO, which tends to follow non-univocal criteria to assess the genuine use of a mark and under which the burden of proof is often considered to be heavy and hard to satisfy.

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