

## Distinctiveness acquired through use: General Court clarifies which type of evidence has greater evidential value

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### EUROPEAN UNION

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- The BIO-BEAUTÉ mark, while descriptive of cosmetics in Class 3, has acquired distinctive character through use in the EU
- To demonstrate acquired distinctiveness through use, advertising material and sale figures can be regarded only as secondary evidence; primary evidence is provided by surveys/market research and statements from trade and professional associations
- Acquired distinctiveness must be proven in the member states in which the mark did not have distinctive character *ab initio*

On 22 March 2023 the General Court issued its decision in [Case T-750/21](#) between Beauty Biosciences LLC ('the applicant'), the European Union Intellectual Property Office (EUIPO) and Société de Recherche Cosmétique SARL ('the intervener').

### Background

The intervener is the owner of the EU word mark BIO-BEAUTÉ, registered for goods in Class 3, among others. The applicant filed an application for a declaration of invalidity of the trademark on the grounds of descriptiveness and lack of distinctive character.

The Board of Appeal of the EUIPO held as follows:

- The words 'bio' and 'beauté' referred to the fact that the products were made organically/in a natural way and related to a person's appearance; consequently, the trademark was descriptive and invalid for beauty products in Class 3. The mark was not descriptive only for perfumes, essential oils, incense and dentifrices in Class 3, as the purpose of these goods is to give a pleasant smell/to clean.

- The intervener submitted sufficient evidence to prove that the trademark had acquired distinctiveness through use in the relevant territories of the European Union, which consisted of the French-speaking countries.
- The fact that the trademark was used with the additional wording “by Nuxe” did not prevent it from being recognised as a trademark on its own.

### General Court decision

Before the General Court, the applicant alleged, in particular:

- insufficient reasoning arising from a contradiction in the decision of the Board of Appeal; and
- infringement of Article 52(1)(a) and (2) of Regulation 207/2009 (now Article 59(1)(a) of Regulation 2017/1001), read in conjunction with Article 7(1)(b) and (c) and 7(3), as it considered that BIO-BEAUTÉ lacked distinctiveness *ab initio* and contended that it had not acquired distinctiveness through use.

The General Court first held that the Board of Appeal of the EUIPO must disclose in a clear and unequivocal matter, without internal inconsistency, the reasoning behind its decisions, so as to enable judicial review of the same. It was not clear why the Board of Appeal had considered BIO-BEAUTÉ to be descriptive for some goods (perfumes and dentifrices) in Class 3, but not for others (including deodorants, make-up removing preparations and soaps), which have the same purpose. The court therefore held that the findings of the Board of Appeal were vitiated by a contradiction in the reasoning.

The court then noted that certain evidence shall be regarded as having greater evidential value than other evidence: direct evidence of use is provided by surveys, market research, and statements from trade and professional associations, while sales volumes and advertising material shall be considered as secondary evidence, with less evidential value. Further, the evidence shall demonstrate use in the relevant part of the European Union in which the trademark did not have, *ab initio*, distinctive character - in this case, the French-speaking territories.

According to the court, although it is not necessary to submit evidence in all member states, the proof submitted must nonetheless be capable of establishing acquired distinctiveness throughout the member states. In this case, the intervener had submitted both direct and secondary evidence of use in French-speaking countries, and also with regard to many other EU member states, hence establishing the acquisition of distinctive character throughout the member states.

Finally, the court held that it is irrelevant that the sign is used as a portion of a more complex registered mark or in conjunction with a registered mark. What matters is that the sign itself identifies, in the mind of the relevant public, the goods as originating from a certain undertaking.

### Comment

The General Court’s decision gives some additional guidance on the conditions to prove that an EU trademark has acquired secondary meaning.

While the lines of the territorial extension of the proof of use still seem to be blurred, the court provided some relevant clarification on the degree of relevance of the different types of proof of use.

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