

General Court provides guidance on what constitutes proof of reputation of earlier mark

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- In assessing the reputation of an earlier mark in the European Union, the evidential value of a document varies depending on whether the period covered is close to or distant from the filing date of the later mark
- Scientific or public-interest press resulting from independent research has evidential value in itself, while evidence consisting of promotional press shall be supported by proof of dissemination
- Presence on the Internet, through websites or social media, may contribute to the reputation of a mark when it is supported by independent data and information on the users and their activity on such platforms

In [Atomico Investment Holdings Ltd v European Union Intellectual Property Office](#) (EUIPO) (Case T-98/23, 28 February 2024), the General Court has ruled against Atomico Investment Holdings Ltd ('the applicant'), owner of the earlier ATOMICO trademarks, in favour of Augusto Gomes Tominaga and his application for the following EU trademark:

atomic  fund

The applicant relied on a single plea in law, alleging violation of Article 8(5) of [Regulation 2017/1001](#), which prevents the registration of a trademark which is identical or similar to an earlier registered trademark, even if the goods or services are not similar, when the earlier trademark has a reputation in the European Union.

General Court decision

The General Court, taking into account the evidence submitted by the applicant before the EUIPO, reasoned as follows:

- Market surveys or opinion polls are not indispensable to prove reputation.

- The relevant date for the assessment of the reputation of the earlier mark is the date on which the mark applied for is filed; therefore, the evidence with the greatest probative value refers a period close to such date.
- The evidential value of press articles and other publications depends on the type of publication: in the case of a scientific publication or a publication in the general-interest press, the very existence of that publication constitutes a relevant factor in establishing the reputation of the trademark, irrespective of its positive or negative content; promotional press, in contrast, shall be supported by proof of dissemination to ascertain the actual degree of knowledge of the mark among the public - which the applicant had failed to do in this case.
- Internal reports may be relevant only if supported by press articles or other objective documents, which were missing in this case.
- Presence on the Internet, through a website or on social media, according to the reasoning of the Board of Appeal, may prove that a mark has acquired some reputation. However, it is necessary to also produce independent reports and data on the number and location of users, the range of dates, the average duration of the sessions and the bounce rate. The applicant had failed to fulfil its obligation to provide such information and clarification.
- The mere fact of having won an award, in itself, does not provide any information on the reputation of a trademark: the evidential value of the assessment of reputation depends on various details, in particular, as regards the criteria for granting the award, the number and qualification of the competing candidates and whether the award was publicised among the relevant public at the relevant date.
- Evidence shall concern the European Union only: the applicant had not drawn a clear distinction between Europe and the European Union; most of the evidence submitted used the term 'Europe' as a geographical name, including the United Kingdom, and was therefore disregarded.

In light of the above, the General Court upheld the decision of the Board of Appeal and dismissed the applicant's action, finding that the latter had not proven the reputation of its trademark.

Comment

The reasoning of the court gives some noteworthy clarifications on the requirements that evidence shall meet in order to be considered as relevant proof of reputation of a trademark, including with regard to the presence of the mark on digital communication channels, such as websites and social networks.

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