

# World Trademark Review *Daily*

**Application for declaration of invalidity of Lancôme's mark held not to be abusive**

**Cancellation  
International procedures**

**European Union - Bureau DA Casalonga-Josse**

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In *Lancôme parfums et beauté & Cie v Office for Harmonisation in the Internal Market* (OHIM) (Case T-204/10, October 5 2012), the General Court has dismissed an appeal against a decision of the Board of Appeal of OHIM in which the latter had upheld a Cancellation Division decision finding that the Community trademark (CTM) COLOR FOCUS for goods in Class 3 of the [Nice Classification](#) was invalid.

Before the General Court, *Lancôme parfums et beauté & Cie* argued that the Board of Appeal had erred in:

- holding that there was a likelihood of confusion between its CTM COLOR FOCUS and the earlier CTM FOCUS for goods in Class 3, owned by [Focus Magazin Verlag GmbH](#); and
- finding that the application for a declaration of invalidity filed by Focus Magazin did not constitute an abuse of right.

With respect to the likelihood of confusion, the court first rejected Lancôme's complaint that the board had breached its duty to state reasons, as required by Article 75 of the [Community Trademark Regulation](#) (207/2009), by allegedly failing to analyse the degree of similarity between the signs. The court considered that it was sufficient that the board had concluded that there was an "overall similarity" between the marks due to the overlap in the distinctive word element 'focus'.

Further, the court rejected Lancôme's complaint that the marks were conceptually very different because the combination of the terms 'color' and 'focus' carried a "brand message" that was totally different from the message carried by one of these terms alone. The court considered that Lancôme had not described the "brand message" of the mark COLOR FOCUS or explained how it was different from that conveyed by the terms 'color' and 'focus' taken separately. Consequently, the complaint was held to be inadmissible, as it failed to fulfil the requirements of Article 44(1)(c) of the [Rules of Procedure](#).

Finally, the court rejected Lancôme's claim that the earlier mark FOCUS had a very weak distinctive character and that, therefore, there was no likelihood of confusion between the marks. It considered that the evidence provided in support of this claim (a list of marks consisting of, or containing, the element 'focus' covering goods in Class 3), was insufficient. In order to support such a claim, Lancôme should have submitted evidence that:

- the marks COLOR FOCUS and FOCUS already coexist in the marketplace; and
- there was no actual likelihood of confusion between them.

Lancôme further argued that the declaration of invalidity constituted an abuse of right because it was based on the prior mark FOCUS, which had been registered fraudulently. According to Lancôme, Focus Magazin never intended to use the mark, but simply sought to prevent other undertakings from registering marks containing the term 'focus'.

The court noted that, in order to establish a claim of this nature, Lancôme was required to demonstrate:

- the objective circumstances in which, despite the formal observance of the conditions laid down by the Community rules, the purpose of those rules had not been achieved; and
- a subjective element consisting in the intention to obtain an advantage from the Community rules by creating artificially the conditions laid down for obtaining it.

As Lancôme had not submitted any actual evidence that the earlier mark FOCUS was registered with the fraudulent intention of not using it, the court found that it had not demonstrated the subjective element. Therefore, this claim was also rejected.

The court dismissed the appeal in its entirety and ordered that Lancôme pay the costs incurred by OHIM and Focus Magazin.

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