

**General Court considers scope of protection of marks filed before <I>IP  
TRANSLATOR</I> decision**  
**European Union - Casalonga Avocats**

**Examination/opposition  
International procedures**

July 28 2015

In *Cactus SA v Office of Harmonisation in the Internal Market* (OHIM) (Case T-24/13, July 15 2015), the General Court has annulled points 1 and 2 of the operative part of the decision of the Second Board of Appeal of OHIM in Case R 2005/2011-2.

On August 13 2009 Isabel Del Rio Rodríguez filed the following Community trademark (CTM) application for goods and services in Classes 31, 39, and 44 of the [Nice Classification](#):

**CACTUS OF PEACE**

**CACTUS DE LA PAZ**

Cactus SA filed an opposition pursuant to Article 8(1)(b) of the [Community Trademark Regulation](#) (207/2009) based on the prior word mark CACTUS and the prior figurative mark depicted below, both registered in 2002 in connection with goods and services in Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42.



The Opposition Division of OHIM upheld the opposition for “seeds, natural plants and flowers” in Class 31 and “gardening, plant nurseries, horticulture” in Class 44, but accepted the application for registration in connection with the services claimed in Class 39.

During the opposition proceedings, the applicant requested proof of the genuine use of the earlier marks. The opponent submitted proof of use for “natural plants and flowers, grains; fresh fruits and vegetables” in Class 31 and “retailing of natural plants and flowers, grains; fresh fruits and vegetables” in Class 35. The Opposition Division held that the evidence was sufficient to prove the genuine use of the earlier marks for such services.

The applicant appealed. The Second Board of Appeal of OHIM upheld the appeal and dismissed the opposition in its entirety. It held that the opponent’s prior marks were not registered for the services claimed in Class 35 and that the opponent had not proven the genuine use of its marks for any of the goods/services for which they were registered.

The opponent filed an appeal before the General Court on the basis of the three following pleas:

- infringement of Article 42(2) of the regulation;
- infringement of Articles 75 and 76(1); and
- infringement of Article 76(2).

The court first looked at the second plea, the alleged infringement of Articles 75 and 76(1). The opponent argued that the Board of Appeal had infringed Article 76(1) by examining of its own motion (i) whether “retailing of natural plants and flowers, grains, fresh fruits and vegetables” services in Class 35 were covered by the earlier marks, and (ii) whether the prior marks were genuinely used for such services, on the grounds that such issues had not been raised by either party in the opposition proceedings before the Opposition Division.

Additionally, the opponent argued that Article 75 had been violated because it had not been given a chance to respond to the board’s findings.

Although neither party had contested the Opposition Division’s finding regarding genuine use of the marks for the Class 35 services, the court considered that this did not bind the Board of Appeal, which was entitled to examine whether or not those services were covered by the prior marks, as well as whether the marks were genuinely used in connection therewith, of its own motion under Article 76(1). The court did hold, however, that the board was required to give the parties an opportunity to respond to the issue of genuine use. Thus, it found that the board had committed a procedural error under Article 75 by not allowing the

parties to present comments regarding the genuine use of the earlier marks.

With regard to whether the Class 35 services were protected by the prior marks, the opponent argued that its marks covered all the services contained in Class 35 because, at the time of filing (ie, before the [IP TRANSLATOR decision](#) (C-307/10)), the general class heading, which included "retailing", had been claimed. In this respect, it referred to Point IV of Communication No 4/03 of the President of the Office of June 16 2003, which stated that the use of the general indications listed in a class heading, such as 'retailing', constituted a claim to all the goods and services within that class.

The court agreed with the opponent, reversing the board's holding. It found that, while Communication No 4/03 was repealed and replaced by [Communication No 2/12](#), which required more clarity and precision from an applicant in identifying the goods and services to be protected by a CTM, the marks at issue were registered prior to those changes and, in light of the principle of legal certainty and the opponent's intention at the time of filing, the earlier marks covered all retailing services in Class 35.

The General Court then examined the opponent's first plea, asserting that the board had infringed Article 42 (2) by holding that the opponent had failed to demonstrate the genuine use of its marks for "natural flowers and plants, grains" in Class 31.

Under Article 15(1)(a), use of a CTM includes use "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered". In this case, the opponent had used only the graphic element of its figurative mark, without the verbal element 'Cactus'. The court found that this constituted use of the figurative mark in an abbreviated form, but still amounted to use of the mark because consumers would equate the abbreviated form with the mark as registered.

Further, despite the fact that the earlier marks were not directly affixed to the flowers or plants, the court found that there was sufficient use, as, in particular, there is no requirement that the marks be affixed to the goods. It held that the opponent's abbreviated mark and company name both established a link between the signs and the goods and services, as the opponent had submitted evidence that (i) showed the earlier marks next to the names of plants and flowers, (ii) demonstrated that the opponent had expertise in the plants and flower sector and (iii) proved that the opponent's stores had their own bakery, butcher, fish and flower departments.

Therefore, the court concluded that the board had erred in deciding that the opponent had not proved genuine use of the earlier marks in relation to "natural flowers and plants, grains" in Class 31.

Lastly, the court examined the opponent's plea claiming that the board had infringed Article 76(2) by rejecting evidence of genuine use of the earlier marks for services in Class 39. Article 76(2) states that "[OHIM] may disregard facts or evidence which are not submitted in due time by the parties concerned". The court found that the board was correct to reject the evidence of use of the earlier marks in relation to services in Class 39 because such evidence was produced for the first time before the Board of Appeal, and not as a supplement to prior evidence submitted in connection with the Class 39 services. Thus, the opponent's third plea was rejected.

This decision should be welcomed as it respects the legitimate expectations of owners of CTMs filed before the *IP TRANSLATOR* decision concerning the scope of protection of their marks. However, the situation will change as soon as the new legislative package is approved and enters into force, since according to the future Article 28, a declaration clarifying the scope of protection shall be filed with OHIM within a six-month period, failing which the CTM will be considered to protect only the goods and services covered by the literal meaning of the specification.

*Cristina Bercial-Chaumier, Casalonga & Associés, Alicante, and Karina Dimidjian-Lecomte, Casalonga Avocats, Paris*

*World Trademark Review* ([www.worldtrademarkreview.com](http://www.worldtrademarkreview.com)) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.