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Opponent fails to establish existence of well-known mark and use of company name

European Union - Casalonga Avocats

**Examination/opposition
International procedures**

July 10 2014

In *Fundação Calouste Gulbenkian v Office for Harmonisation in the Internal Market* (OHIM) (Case T-541/11, June 26 2014), the General Court has confirmed the decision rendered by the Second Board of Appeal on July 15 2011 finding that the applicant had not proven the existence of the well-known mark FUNDAÇÃO CALOUSTE GULBENKIAN or the use of the company name Fundação Calouste Gulbenkian in respect of "technical and management services related to the oil industry".

On November 17 2005 the intervener, Mr Micael Gulbenkian, filed an application for registration of the mark GULBENKIAN as a Community trademark in Classes 4, 33, 35 to 37, 41, 42 and 44 of the [Nice Classification](#).

On May 18 2007 the applicant, Fundação Calouste Gulbenkian, filed a notice of opposition against the registration of the mark in respect to all the goods and services claimed. The opposition was based on the following earlier well-known mark and rights:

- the well-known mark FUNDAÇÃO CALOUSTE GULBENKIAN, covering "arts (plastic arts and music); charity (health and human development); science (research and promotion); education (support and development); technical and management services related to the oil industry" ('the well-known mark');
- the company name Fundação Calouste Gulbenkian, used for all of the areas listed above ('the company name'); and
- Portuguese registrations No 5351 and No 5352 ('the logos'), covering all of the goods and services listed above and consisting of the following graphic sign:



The opposition was based on Articles 8(1)(b) and (4) of the [Community Trademark Regulation](#) (207/2009).

On May 28 2010 the Opposition Division of OHIM partially upheld the opposition on the basis of Article 8(1)(b), finding that there was a likelihood of confusion between the well-known mark and the mark applied for with regard to educational services in Class 41 and healthcare in Class 44.

However, the opposition was rejected insofar as it was based on Article 8(4), as it was found that the applicant had not provided evidence that the logos satisfied all of the conditions set out in Article 8(4), in particular the condition that the signs must confer on their proprietors the right to prohibit the use of a subsequent trademark. Second, the Opposition Division took the view that the applicant had failed to submit evidence that the company name had been used, in the field of science (research and promotion) or technical and management services related to the oil industry, before the date on which the application for registration of the mark applied for was filed.

The applicant filed an appeal, which was partially upheld by the Second Board of Appeal, in respect of the services relating to development of studies and projects, as well as to consultancy, in Class 42. The appeal was dismissed as to the remainder.

The Board of Appeal took the view that the applicant had not submitted evidence of use of the well-known mark with regard to science and technical and management services related to the oil industry. Therefore, it found that the goods and services covered by the mark applied for in Classes 4, 33, 35, 36, 37 and 42 did not bear any similarity to the services for which use of the well-known mark had been proven, and that there was no likelihood of confusion between the mark applied for and the well-known mark with regard to those goods and services.

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In respect to the application of Article 8(4), the Board of Appeal confirmed the Opposition Division's finding that the applicant had not submitted evidence of use of the company name in the field of technical and management services related to the oil industry.

Nevertheless (and unlike the Opposition Division), the Board of Appeal took the view that the applicant had submitted evidence of use of the company name in the field of biomedicine, but not in the field of science in general, that predated the filing date of the application. As a result, the board found that there was a likelihood of confusion between the company name and the mark applied for in respect of the services relating to development of studies and projects, as well as to consultancy, in Class 42.

The board also rejected as irrelevant the intervener's arguments that, first, he was the proprietor of rights which were older than those invoked by the applicant and, second, the term 'Gulbenkian' was his family name.

Finally, the board exercised its discretionary power not to take into account the evidence submitted for the first time by the applicant during the appeal proceedings, on the ground that that new evidence simply confirmed the evidence that had been submitted in due time before the Opposition Division.

An appeal was filed before the General Court on the basis of infringement of Article 8(5) of the regulation and of Article 16(3) of the [Agreement on Trade-Related Aspects of Intellectual Property Rights](#) (TRIPs), as well as on the admissibility of the evidence submitted for the first time before the court.

In support of its action, the applicant submitted that, irrespective of the comparison of the goods and services, the reputation of its earlier rights was such that, pursuant to Article 8(5) of the regulation, it should have led the Board of Appeal to refuse registration of the mark applied for in its entirety. The applicant relied, in support of that argument, on a number of Portuguese judicial decisions, which had become final. Further, the applicant alleged infringement of Article 16(3) of the TRIPs Agreement of April 15 1994 (OJ 1994 L 336, p 214), which constitutes Annex 1C to the [Agreement establishing the World Trade Organisation](#) (WTO) (OJ 1994 L 336, p 3).

In this respect, OHIM contended that the opposition had not been based on Article 8(5) of the regulation.

On the substance, it must be kept in mind that the Opposition Division had partially upheld the opposition on the basis of Article 8(1)(b) of the regulation, finding that the applicant had proven the existence of the well-known mark in regards to arts (plastic arts and music), charity (health and human development) and education (support and development). Consequently, the Opposition Division had upheld the opposition in respect to the services covered by the mark applied for that it regarded as similar, namely the educational services in Class 41 and healthcare in Class 44.

In the contested decision, the Board of Appeal had confirmed that assessment. Further, the board had taken the view that the applicant had submitted evidence that the company name satisfied the conditions set out in Article 8(4) and had proved its use in the field of biomedicine. Consequently, it had also upheld the opposition in respect to the services relating to development of studies and projects, as well as to consultancy, in Class 42.

However, the Board of Appeal had found, as had the Opposition Division, that the applicant had not proved the use of the earlier mark or the company name in particular with regard to technical and management services related to the oil industry.

In this respect, the court found that it was necessary to uphold the Board of Appeal's assessments in the contested decision - which were, moreover, not disputed by the applicant - with regard to the definition of the relevant public, the finding that the signs at issue were similar, the finding that there was no similarity between the goods and services covered by the mark applied for and those in respect to which the Board of Appeal found that the use of the well-known mark and the company name had been proved, and the finding that the applicant had not established that the logos satisfied the conditions set out in Article 8(4).

Nevertheless, the court considered that it was necessary to examine the arguments by which the applicant sought to show that the Board of Appeal should have upheld its opposition to a greater extent.

In this respect, it should be noted that the applicant was not entitled to submit for the first time before the court arguments alleging the reputation of its earlier rights or items of evidence that were not submitted in the course of the proceedings before OHIM. The court said that the new evidence could not be taken into account since, under Article 135(4) of the [Rules of Procedure of the General Court](#), the parties' pleadings may not change the subject matter of the proceedings before the Board of Appeal. It follows that the parties

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to the proceedings cannot, on pain of inadmissibility, request that the court undertake an assessment of facts or legal issues that have not previously been examined by the Board of Appeal (see *Edwin v OHIM* (Case C-263/09 P), Paragraphs 71 to 74).

Therefore, it was necessary to examine whether the applicant was justified in claiming that, with regard to the items of evidence that were submitted in due time, the Board of Appeal had erred in finding that the use of the well-known mark and the company name had not been proved with regard to technical and management services related to the oil industry.

The applicant criticised the assessment of the evidence undertaken by the Opposition Division and the Board of Appeal regarding a number of documents but, in particular, as presented in Annex A.7 to the application, a 2006 article devoted to the applicant by a Portuguese newspaper, the title of which attributed the following phrase to the applicant's company president: "We sell 14 million barrels of oil per year."

In paragraphs 20 and 41 of the contested decision, the Board of Appeal had referred to a number of items of evidence, including the referred article, and concluded from the examination of that evidence that the applicant was carrying out a commercial activity in the oil industry sector through its subsidiary P. Further, the Board of Appeal had not in any way excluded the possibility of consumers establishing a link between the applicant's company name and the oil sector.

In contrast, the Board of Appeal had found that there was no evidence which made it possible for it to conclude that the applicant, whether through the intermediary of the company P or directly, offered third-party companies technical and management services related to the oil industry, that is to say the services referred to by the applicant in its notice of opposition.

Consequently, the court held that the applicant had not put forward any argument or any evidence already submitted in the course of the proceedings before OHIM that made it possible to prove the existence of the well-known mark or the use of the company name in respect to "technical and management services related to the oil industry".

In view of the above, the court found that it was necessary to uphold the Board of Appeal's assessment - which the applicant did not dispute - that the goods and services covered by the mark applied for, in respect to which the opposition was not upheld, did not bear any similarity to the goods and services in respect to which the existence of the earlier rights of which the applicant was the proprietor had been recognised as proved.

Therefore, the court found that the applicant was not justified in claiming that, in respect to the goods and services covered by the mark applied for which did not bear any degree of similarity to the goods and services in respect to which its earlier rights had been proven, the Board of Appeal had erred in rejecting its opposition both on the basis of Article 8(1) of the regulation with regard to the well-known mark, and on the basis of Article 8(4) with regard to the company name. The appeal was therefore dismissed in its entirety.

This decision should be welcomed to the extent that it confirms that, for an opposition on the basis of Article 8(1)(b) to be upheld, the cumulative conditions of identity or similarity of the signs and identity or similarity of the goods and services must be met. In the absence of one of these conditions, the opposition will be rejected, as in the present case, on the ground that there is no likelihood of confusion on the part of the public.

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