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## General Court: variations in use altered distinctive character of earlier word mark TACK

European Union - [Casalonga Avocats](#)

- LA Superquímica opposed registration of D-TACK based on earlier word mark TACK
- Board of Appeal found that evidence did not show use of earlier mark in form in which it had been registered
- Court confirmed that distinctive character of earlier mark, as registered, had been altered

On 10 October 2018 the General Court (Ninth Chamber) issued its decision in [LA Superquímica SA v European Union Intellectual Property Office](#) (EUIPO) (Case T-24/17).

### Background

On 21 December 2010 D-Tack GmbH filed an application for the registration of the word mark D-TACK as an EU trademark in Classes 1, 17 and 35. An opposition was filed by LA Superquímica SA (the applicant) on the basis of a likelihood of confusion pursuant to Article 8(1)(b) of Regulation 207/2009 (now Regulation 2017/1001), relying on a number of prior Spanish registrations:

- the word mark TACK and the following figurative marks, all three protected in Class 16:



- the following figurative mark in Class 17:


 The logo consists of the word "TACK" in large, bold, red capital letters, followed by "Ceys" in smaller, yellow capital letters with a black outline, all contained within a black rectangular background.

- the following figurative marks in Classes 16 and 17:



The Opposition Division rejected the opposition in its entirety on the grounds that proof of the existence of the earlier marks, other than the earlier word mark TACK, had not been provided, as no official documents concerning the representation of those marks or their renewals had been produced. Further, it considered that the evidence of use of the earlier word mark TACK was insufficient to demonstrate genuine use.

The applicant filed an appeal and produced new extracts from the Sitadex database, in Spanish and with representations of the marks, but without an English translation.

By its decision of 15 November 2016, the Fourth Board of Appeal of the EUIPO dismissed the appeal. Regarding the new extracts from the Sitadex database, the Board of Appeal took the view that it had to exercise its discretion in relation to the taking into consideration of late evidence in a restrictive manner and that the circumstances of the case did not justify the exercise of such discretion in favour of the applicant.

Regarding the earlier word mark TACK (the only mark accepted by the EUIPO for the examination of the opposition), the Board of Appeal noted that the evidence provided did not show use of that mark in the form under which it had been registered or in a form that could be regarded as acceptable under point (a) of the second subparagraph of Article 15(1) of Regulation 207/2009 (now point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001).

### General Court decision

The applicant filed an appeal against the Board of Appeal's decision on the basis of the following two pleas:

- infringement of the rules on the substantiation of the registrations of the earlier marks other than the earlier word mark TACK; and
- infringement of the rules on proof of use of the earlier word mark TACK.

With respect to the first plea, the applicant claimed, in essence, that the Board of Appeal should have taken into consideration all of the earlier figurative marks relied on in support of the opposition, since the applicant could not be criticised for not having provided evidence as to the existence of those marks

given that the Sitadex database was not accessible within the period prescribed by the EUIPO for producing that evidence.

The court reiterated that the Board of Appeal, when presented with facts and evidence submitted late, has discretion as to whether or not to take account of such information in its analysis and the resulting decisions. Furthermore, it held that, since the documents submitted late were all in Spanish and no translation into the language of the proceedings was provided, they would not have been taken into account in any event.

Therefore, it confirmed that the Board of Appeal had exercised its discretion and considered, rightly, that the new extracts from the Sitadex database could not be taken into account. The first plea was thus rejected as unfounded.

In respect of the second plea, the applicant argued, in essence, that it was wrong for its opposition to be rejected on the ground that it had not shown genuine use of the earlier word mark TACK. It produced many items of evidence of the use of the signs reproduced in the summary table below, including invoices, labels, brochures, a manual, catalogues and extracts from internet sites:

# TACK

Registered form



Actual use

In this respect, the court noted that all the items of evidence furnished by the applicant associated the element 'tack' with the element 'ceys'. Moreover, certain items of evidence involved one or more additional elements, such as 'bricocinta', 'crick' or 'cristal'. Those additional elements were never associated with the element 'tack' in isolation, but always with the element 'tackceys'.

The court reiterated that, according to the case law, there is no rule in the EU trademark system that obliges the opponent to prove the use of the earlier mark on its own, independently of any other mark or sign. Therefore, the case could arise where two or more trademarks are used jointly and autonomously, with or without the name of the manufacturer's company. Thus, as contended by the EUIPO, joint use of the company name or of a trademark with the earlier trademark cannot, in itself, undermine the function of the mark as a means of identifying the services at issue.

The use of the trademark in a form which is different from the form in which it was registered, however, is considered as genuine use only to the extent that the distinctive character of the trademark in the

form in which it was registered has not been altered.

The General Court stated that the relevant public in the case at hand was the Spanish public and that, in view of the goods at issue, the words 'tack' and 'ceys' would have at least an average distinctive character. The court found that the Board of Appeal had correctly concluded that:

- the invoices did not contain any indication of the earlier word mark TACK as such;
- reference was made instead to product names;
- the juxtaposition of the element 'ceys' could not be seen as an irrelevant or negligible addition to the element 'tack'; and
- on the invoices and in the brochures and catalogues, the elements 'tack' and 'ceys' appeared together as one single term or as a single word element made up of eight letters.

It was found that the element 'tackceys' on the invoices, and in the text of the brochures and catalogues, would be perceived as an indivisible unit, the two words being conjoined. Therefore, the court confirmed the Board of Appeal's conclusion that the use of the word 'tackceys' in the invoices and in the text of the brochures and catalogues altered the distinctive character of the earlier word mark TACK and therefore could not be considered to constitute an acceptable variation of the mark as registered.

Finally, the court also confirmed that the finding that the distinctive character of the earlier word mark TACK, as registered, had been altered was supported by the addition of other terms such as 'crick', 'cristal' or 'bricocinta. Those additions introduced extra differentiation factors in relation to the earlier word mark TACK.

In view of the above, the court concluded that the earlier word mark TACK and the combination 'tackceys' could not be regarded as broadly equivalent (see, to that effect, [Representation of a polygon](#) (Case T-146/15, 13 September 2016, Paragraph 27). In this regard, the court held that, even though it is not disputed that the element 'ceys' corresponds also to a mark used by the applicant, it must be stated that that element is still clearly visible and does not occupy a secondary position in the overall impression produced by the combination 'tackceys'. Therefore, the court confirmed that the variations in use shown altered the distinctive character of the earlier word mark TACK as it was registered, and upheld the board's decision.

### Comment

This decision is arguably stricter than previous decisions regarding the alteration of the distinctive character of a mark as registered.

## Karina Dimidjian-Lecomte

Casalonga Avocats

## Cristina Bercial-Chaumier

Casalonga

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