

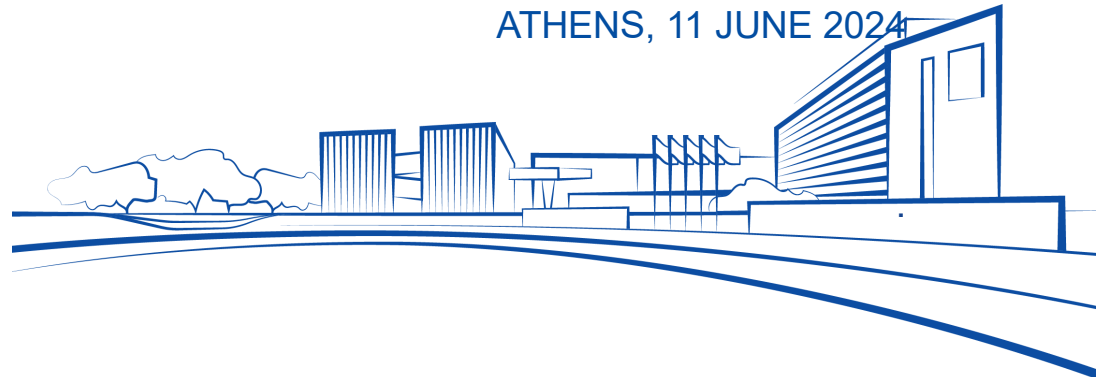
# Relative Grounds - Selected topics on the use of a trademark

## Recent EU case law

Session with IP Practitioners

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## Use of trademarks– how we asses it?

- a) Use of the trademark in the new era - Internet evidence
- a) Genuine use – “Subcategories”



# Internet evidence

## Background

### Relevance of online evidence

- Given the increasing importance of e-commerce, online evidence is increasingly relied upon by the parties and considered by the Boards in their decisions.
- It is important for trademark owners to know how they can prove the use, reputation or acquired distinctiveness of their trade marks.
- Traditional means of evidence are supplemented and increasingly replaced by new means of evidence obtained by new technologies, proving online presence of the mark.

**Types of online evidence** most commonly addressed in the decisions of the EU Courts and the Boards, and in the Guidelines.

**Editable websites** : the content can be changed by anyone (e.g. Wikipedia, Acronym Finder), and social networks where the content is created by their owners/users (Facebook, Instagram, etc.).

**Non-editable websites:** the content cannot be changed, they usually belong to a third party.

**Audio and video:** e.g. advertisements on Youtube, constitute another type of online evidence.

**Hyperlinks:** to a website address (e.g. [www.ralphlauren.com](http://www.ralphlauren.com)) - to be distinguished from the information contained in the URL.

**Printouts of webpages belonging to one of the parties:** quite popular type of evidence (.e.g. webpage of the provider of goods or services at issue).

**Reporting and statistics:** another type of online-evidence. Some pages (e.g. Facebook), can provide data such as number of followers, number of views of a publication, number of likes, etc.; More advanced e-shopping platforms, can extract data such as the location of the visitors, the number of visits, the products viewed or purchased, etc.

## **Probative Value of Online Evidence in a nutshell :**

- The Court and the Boards consider online evidence to be valid, admissible means of evidence. They generally assign to it the same probative value as to tangible evidence. Online and traditional evidence are taken into account in an overall assessment.
- The probative value of online evidence is dependent on the reliability of the source. Thus editable websites (ex. Wikipedia, Acronym finder) are generally assigned a lower probative value and should be corroborated by other evidence.
- Moreover, online content is easily modified/updated over time. This makes it more difficult to authenticate the date of the evidence. This issue can be overcome by providing evidence with metadata (e.g. date of creation/capture/publication of a photo), or by using web archive tools (e.g. ‘Wayback Machine’, etc.) which preserve copies of older versions of webpages.
- Mere presence on the internet is not sufficient. Simple hyperlinks to a website address (e.g. “www.ralphlauren.com”), or even evidence of the simple presence of a mark on a website, do not prove the use of the mark.
- Online presence does not prove the extent of use or the degree of exposure of the public to the mark. This requires tangible evidence of online interactions (views, transactions, etc.). We need reporting and statistics of the traffic on the website, etc.

**The decisions of Boards in which online evidence played a role are coherent with the EU case law and followed in the Guidelines.**

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General Principles	EU Courts	BoA
<p>Online evidence is a valid means of evidence which is assessed freely as the other “traditional” means of evidence (resulting implicitly from all the analysed decisions).</p>	<p>from all the analysed judgments</p>	<p>from all the analysed decisions</p>
<p>Online evidence must be considered in the context of the remaining evidence</p>		<p>NATURLI, R1850/2016-1</p>
<p>A simple printout mentioning a number of webpages containing the trade mark cannot demonstrate commonplace and ordinary use of the mark as there is nothing to confirm that the web pages in question have been consulted by a portion of the relevant public and the latter uses this term customarily.</p>	<p>BASICS, T-164/06; BITTORENT, T-771/15</p>	<p>CYBERGESTION, R68/2006-1</p>
<p>The mere presence of a sign on a website does not show whether or to what extent, the website has been visited by third parties or the mark has been seen.</p>	<p>FUNNY BANDS, T-344/13</p>	
<p>Simple printouts of a website which do not demonstrate a single sale of product are not sufficient to prove use.</p>		<p>CYBERGESTION, R68/2006-1; MOULDPRO, R2154/2015-4</p>

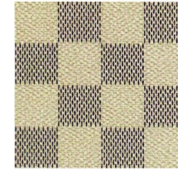
<p>The fact that multiple language versions of a website have been made may indicate that the goods and services were addressed to consumers of multiple countries (depending on the languages) even if the main use of the mark is proven to be only in relation to one of the languages</p>		<p>(LR LAROME AFFAR AROMAPERDU RA (fig)).</p>
<p>The mere number of redirections from third-parties websites to the applicant's website does not give a reliable indication of use of the contested mark use (especially when the trade mark is composed by descriptive terms)</p>	<p>BET 365, T-304/16</p>	
<p>Extracts from distributors' websites and on line auction or second-hand websites may prove that the shape the mark takes gives substantial value to the goods</p>	<p>LOUDSPEAKER, T-508/08</p>	
<p>The use of a mark on the Internet can demonstrate outward and public use, and may establish a link between the mark and any services which are advertised on the page.</p>	<p>ARANTAX, T-387/10</p>	
<p>The high ranking of a webpage, <u>inn</u> terms of visitors and new subscribers, may help to establish that the trade mark acquired distinctive character through use.</p>	<p>BET 365, T-304/16</p>	

Specific types of evidence	EU Courts	BOA
Printouts retrieved through the <u>Wayback</u> Machine (a digital archive of information on the Internet) are reliable means of evidence as the content includes indications of dates	Funny Bands, T344/13 (implicitly, at para. 30)	NEVILLE/ <u>Nevill</u> e, R462/2017-2
Printouts of Google Analytics data showing the number of visits to a website and news articles available on internet are a relevant means of evidence.		N <u>neguru</u> , R 514/2017-5
Undated website screenshots of Vimeo and You Tube videos are insufficient to prove genuine use if they do not indicate the date on which the video became available or the number of views actually received by the video.		NEVILLE/ <u>Nevill</u> , R462/2017-2
Acronym Finder is not a reliable source of information as it is freely editable.		EFT, R2501/2017-4
As the content of WIKIPEDIA may be amended at any time, even anonymously, information taken from its articles lacks of certainty and therefore has low probative value.	HOMEZONE, T-344/07 COYOTE UGLY, T-778/14	
Where social media such as Facebook is concerned, the information on each page which is not freely editable or cannot be changed by the user of the website is considered to be originating form a reliable source and therefore relevant evidence.		NATURLI, R1850/2016-1



## 19/10/2022, T- 275/21, Damier Azur (Luis Vuitton) – Invalidity proceedings - Distinctiveness acquired through use- Assessment of the evidence of use for the purpose of Article 7(3) EUTMR

Luis Vuitton Malletier , IR No 986207, designating the EU, for goods in Class 18.



Various kinds of evidence of use were provided and extensively analysed by the Board and the Court. One of the main issues was **how to assess internet evidence for the purpose of Article 7(3) EUTMR** (§ 78-97)

- § 80 with the expansion of electronic commerce and, more generally, the growing importance of the internet in the course of trade, the relevant public's perception may, nowadays, be largely influenced by the presence and promotion of a brand in the virtual realm. Such evidence may thus be likely to play an increasingly important role in assessing distinctive character acquired through use of a trade mark. For that type of evidence to be relevant for that purpose, however, the proprietor of the mark at issue must demonstrate that the websites in question and, in particular, the internet pages on which that mark was displayed, promoted or marketed, target or are consulted by a significant part of the relevant public in the Member States in which the mark is, ab initio, devoid of inherent distinctiveness.
- § 82. the fact that the top-level domain and the language of a website are associated with a particular Member State is an indication of the fact that that website specifically targets the relevant public of that Member State. .. The proprietor must demonstrate, for example by presenting a traffic analysis report for that site during the relevant period, that a significant number of internet users in the Member State concerned consulted or interacted with the content of the website in question. So for example, data relating to the number of visits to that website, of comments or of other forms of web user interactions in the Member State concerned may be taken into consideration.

- § 83- 84 Evidence showing that search engine and social network algorithms display non-sponsored search results for search terms describing the trade mark at issue, which systematically return the trade mark proprietor’s goods, may also be relevant. By contrast, the mere fact that a website on which the mark at issue was promoted is accessible in certain MSs is not sufficient to demonstrate that a significant part of the relevant public in those MSs has been exposed to that mark. The mere existence of a website does not establish the intensity of use of a trade mark or of the relevant public’s exposure to that mark
- § 85-86 LV submits screen shots from websites, containing images of goods in Class 18 bearing the mark, with specific country related top-level domains and language. The fact remains that LV did not submit any information regarding the intensity of use of the mark on those websites, such as the number of visits or of interactions with their content during the period concerned. That evidence does not, per se establish that a significant part of the relevant public in those MS was exposed to the mark.
- § 88 LV filed results of an image search on ‘www.google.it’ using the keywords ‘Damier Azur’, but failed to explain how that evidence is relevant to the relevant public in the MSs concerned (Bulgaria, Estonia, Latvia, Lithuania, Slovakia and Slovenia).
- § 89-92 LV submitted two reports on the use of the keywords ‘Damier Azur’ on social media. While, in principle, the fact that a search engine or social network algorithm associates the name of the mark with the goods of the proprietor may be a relevant indicator, given the small percentages of data concerning some of the relevant territories, and the low number of repetitions of the keywords, that evidence did not demonstrate an exposure of a significant part of that public to the mark. Examples of use of the keywords on social media, shows that these keywords were often used by sellers of fakes or of second-hand goods. Moreover, the reports contain only data at the worldwide level without distinction between the countries of origin of internet users who had used the keywords, thus they do not specifically provide information on the perception of the contested mark by the relevant public in the MSs concerned.
- § 93 LV filed press cuttings and screenshots of websites containing photographs of celebrities wearing goods in Class 18 bearing the mark. The press cuttings come from paper magazines originating in other MSs. However, there are no arguments or evidence that those magazines were distributed in the MSs concerned, or that that public would have become aware of them otherwise
- § 95-97 Some screenshots of websites specifically target the relevant territories (top/level domain), but there is no data on the intensity of use of the mark on those websites. Other websites, are not associated with the MSs concerned. As for the sites with general top-level domain (.com) there is no evidence that the public in the relevant MSs consulted them.

**07/02/2024, T-74/23, DEVICE OF A STYLISED O (fig.) / DEVICE OF A STYLISED O (fig.) et al. ) Opposition proceedings – Proof of use – Nature of use – Use in the course of trade – Use on social media – Market practice**

Oriflame cosmetics AG  
Earlier IR No 822 851, with effect in  
Bulgaria, Latvia, Lithuania, Poland,  
Czech Republic and Slovenia  
For goods in Class 3.



Contested IR application, in Class 3.



- The opponent claimed that it was commercially exploiting the earlier mark ('the O Logo'), both in its principal trade mark ('its main brand') and as a stand-alone trade mark ('a standalone brand') on its goods and marketing materials. Provided various types of evidence of use (guidelines relating to the earlier mark, its online presence and its choice to market and promote its goods by direct selling by means of independent sales consultants promoting the goods on social media such (Facebook, Instagram, etc), distributing catalogues and organising events where samples were offered and orders were taken.
- The OD held that genuine use was not established.
- The BoA confirmed, that the opponent had not proven genuine use of the earlier mark, either on its own or in combination with other elements such as 'Oriflame' or 'One', Apart from the reference to the earlier mark in the guidelines relating to that mark, 'there [wa]s ... no further evidence that [the earlier mark] as an abbreviation of the main logo ha[d] actually been used in the course of trade'.

## T-74/23, DEVICE OF A STYLISED O (fig.) / DEVICE OF A STYLISED O (fig.) et al. )

### Key points

- The Court noted that the in file showed use of the earlier mark not only in combination with other elements, but also as such, on the goods and marketing materials or in order to designate the undertaking (e.g. in screenshots of Bulgarian, Latvian, Lithuanian and Slovenian websites, featuring the O logo on the lid of bottles)
- Court found that BoA did not give sufficient weight to the use made of the earlier mark on social media.
- The earlier mark was used as such on social media in a way that was particularly visible not only to subscribers, but also to visitors. The accounts that referred to the earlier mark on social media were often viewed on small screens, such as those of smartphones, on which there was not much space, and therefore the accounts favoured the stand-alone use of that mark, without verbal elements (§ 44-45).
- In the context of the analysis of genuine use, the presence on social media constitutes a relevant factor, since it is a means that is commonly used in order to promote and even sell cosmetic products in the economic sector concerned (§ 46).
- It is necessary to assess the scope of the use of the earlier mark on social media, in particular in order to determine whether that use made it possible to associate the goods that appeared on those media with the undertaking that marketed them (§ 47).

## T-74/23, DEVICE OF A STYLISED O (fig.) / DEVICE OF A STYLISED O (fig.) et al. )

### Lessons learned

- In the ‘O logo’ case, use on social media was considered part of the commercial use of the earlier mark.
- Market practice needs to be taken into account.
- Use on social media is a relevant factor in the assessment of genuine use if it is commonly used to promote and sell products in the economic sector concerned.

### Next steps

- Case-law on this topic to be followed (see [WTR article](#))
- Consistency report on this topic would be useful when more case-law is available

# Genuine use - Subcategories

## The theory of 'Partial use' and subcategories – Case law

### Regulations – partial use

- Article 47(2) EUTMR In the absence of proof of genuine use, the opposition shall be rejected. If the earlier EU trade mark has been used in relation to only part of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.
- Article 58(2) EUTMR A mark which has not been genuinely used for the goods and services for which it is registered, in accordance with paragraph 1, shall be revoked. Where the grounds for revocation exist in respect of only some of the goods or services for which the mark is registered, the rights of the proprietor shall be revoked in respect of those goods or services only.

### Case law

14/07/2005, [T-126/03](#), Aladin,  
13/02/2007, [T-256/04](#), Respicur,  
16/06/2010, [T-487/08](#), Kremezin  
06/03/2014, [T-71/13](#), Annapurna  
18/10/2016, [T-367/14](#), Fruitfuls,  
23/09/2020, [T-677/19](#), Syrena, - confirmed by 28/01/2021, C-626/20 P, Syrena,  
01/02/2023, [T-772/21](#), Efbet,  
12/07/2023, [T-585/22](#), Artisan

11/12/2014, [C-31/14 P](#), Premeno  
16/07/2020, [C-714/18 P](#), Taiga, and [Opinion](#) of Advocate General Shapston, of 19/12/1019  
22/10/2020, [C-720/18](#) and C-721/18, Ferrari

**The theory of 'partial use' aims to strike a fair balance** between, on the one hand, the preservation of the exclusive rights conferred on the proprietor and, on the other hand, the limitation of those rights in order to prevent a trade mark which has been used only for part of the G&S being afforded extensive protection merely because it has been registered for a wide range of G&S.

## The theory of 'Partial use' and subcategories – Basic principles – General Court

- If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been genuinely used for a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition (14/07/2005, T-126/03, Aladin, § 45; 13/02/2007, T-256/04, Respicur, §23; 01/02/2023, T-772/21, Efbet, §59).
- However, although the principle of partial use aims to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not result in the proprietor of that trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. It must be observed in that regard that it is in practice impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories (14/07/2005, T-126/03, Aladin, § 46; 06/03/2014, T-71/13, Annapura, §63; 23/09/2020, T-677/19, Syrena, §115)
- As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for goods or services which can meet their specific needs, the purpose or intended use of the goods or services at issue is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services. In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (18/10/2016, T-367/14, Fruitfuls, § 32).



## Theory ‘Partial use’ and subcategories – the “TAIGA” case - Opposition proceedings - Genuine use of the mark – Subcategories

### Earlier EUTM : TAIGA

*Registered inter alia for*

**Class 9:** ‘Protective clothing; protective footwear, headwear, gloves; clothing for protection against fire; safety clothes, safety gloves and safety caps’;

**Class 25:** ‘Clothing; outer clothing; underwear; footwear; headgear for wear and headwear; work shoes and boots; working overalls; gloves; belts and socks’.

### Contested mark : TIGHA

*inter alia, in Class 25, for the class-heading ‘Clothing, footwear, headgear;’ and for specific items of clothing from the alphabetical list (e.g. ‘suits; Motorists’ clothing; Dresses; Gabardines [clothing]; Belts [clothing]; Trousers; Hats; Underwear; Outer clothing; Parkas; Ski gloves; Underpants; Socks; Boots; .*

**Board :** genuine use was proven for certain goods in Class 9 (protective clothing; protective headwear, gloves; safety clothes, safety gloves and safety caps) and in Class 25 (clothing; outer clothing; underwear; headgear for wear and headwear; working overalls; gloves; belts and socks).

## The theory of 'Partial use' and subcategories – 13/09/2018, T-94/17, tigha / TAIGA – no subcategory (clothing)

Before the GC, **the applicant** claimed that the evidence filed only proves genuine use for a 'coherent subcategory' in Class 25, namely 'special weather protective outdoor clothing for the purpose of protection against cold, windy and/or rainy weather conditions only'. The BoA erroneously found genuine use for 'clothing, outer clothing, underwear, headgear for wear and headwear' in general.

GC. Dismissed the argument (§ 33 - 35) :

- It must be determined whether the items in the evidence of use constitute an independent subcategory in relation to the goods covered by the earlier mark in Class 25, in so far as they refer only to weather-protective outdoor clothing.
- The items in the evidence of use, which are all clothing goods, have the same purpose, since they are intended to cover the human body, to conceal, adorn and protect it against the elements. Thus, they cannot, in any event, be regarded as 'substantially different', for the purpose of constituting a 'separate subcategory'.
- The fact that the clothing in the evidence has particular weather-protection characteristics is, in principle, irrelevant, as the characteristics of the goods are not, as such, relevant to the definition of subcategories. In particular since a characteristic of the 'outer garments', certain types of 'underwear' and 'headgear', 'gloves' and 'socks', by nature, is protection from cold, wind or rain.
- That common characteristic of the goods in the evidence of use cannot justify the definition of an independent subcategory in Class 25.

## Theory 'Partial use' and subcategories – Court of Justice 16/07/2020, C-714/18 P, TAIGA

Confirmed GC methodology relying on its previous case law (11/12/2014, C-31/14 P, Premeno) and on the Opinion of Advocate General Shapston, of 19/12/1019

### First step: 2 kinds of situations must be distinguished :

- a) The earlier mark is registered for **G&S which are defined particularly 'precisely and narrowly' and, thus, forming an homogenous category of G&S**: it is not possible to make any significant sub-divisions within the category. The proof of use of the mark for those G&S must cover the entire category → It is important not to limit unduly the exclusive rights of that proprietor to extend his range of goods within that homogenous category by requiring excessive proof of use, for every possible variation.
- b) **The earlier mark is registered for a broad heterogeneous category of G&S**. In that case, it is possible to identify a number of subcategories capable of being viewed independently, provided that those subcategories are coherent, which means that they contain goods or services which are 'similar' or which are not 'in essence different'. → Protection only for the subcategory(ies) of G&S for which proof of genuine use of the mark was proven. → No protection for G&S which, because they are 'sufficiently distinct', fall within another category or subcategory.

### Further steps are required (when the earlier mark covers broad heterogeneous category) :

- a) **Identify 'coherent subcategory of G&S capable of being viewed independently'**. The purpose or intended use of the G&S is decisive; adversely, the nature or characteristics of those G&S are irrelevant for the purposes of that assessment.  
→ By analogy: criteria for assessing the validity of a limitation of the list of G&S (clarity, precision) - Article 43(1) CTMR.
- b) **Examine whether the G&S for which the mark was genuinely used, fall within a subcategory capable of being viewed independently of the broader category of G&S for which the earlier mark is registered**. Rather than defining, in abstracto, subcategories of G&S, the assessment must be made in concreto, by comparing the G&S for which genuine use was proven, with the category(ies) of goods for which it is registered.

## The theory of ‘Partial use’ and subcategories – Court of Justice 16/07/2020, C-714/18 P, TAIGA

- § 46 From the wording of the last sentence of Article 42(2) CTMR and the principles established by case-law it follows that it is important to assess in a concrete manner -principally in relation to the goods for which the proprietor of the earlier mark has submitted proof of use of the earlier mark- whether those goods constitute an independent subcategory in relation to the goods falling within the class of goods concerned, so as to link the goods for which genuine use of the earlier mark was proven to the category of goods covered by the registration of that trade mark
- § 50 The aim of the criterion of the purpose and intended use of the goods is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically
- § 51 Accordingly, if the goods concerned have several purposes and intended uses, determining whether there exists a separate subcategory of goods by considering in isolation each of the purposes that those goods may have will not be possible. Indeed, such an approach would not enable independent subcategories to be identified coherently and would have the effect of limiting excessively the rights of the proprietor of the earlier mark, inter alia in that their legitimate interest in expanding their range of goods or services for which their trade mark is registered would not be sufficiently taken into consideration.

Note: CJ echoes the [Opinion](#) of Advocate General Shapston (§71, 72), regarding goods having ‘multiple purposes’: ‘A product has purposes which progress and know-how tend to multiply’. E.g. cleansing products, no longer only aim to clean the skin, but also to care for it, whether in a medical sense or not. Likewise, clothing primary aim to cover, conceal or protect the human body, but may also have a common aesthetic function. Each of those purposes cannot be considered in isolation in determining whether there is a distinct subcategory of goods. Far from being mutually exclusive, those different uses are combined for the purpose of putting those goods on the market.

However, in the opinion of the Advocate General (§34), it was not for the Court of Justice to rule on whether genuine use of the earlier mark had actually been proven for a subcategory of goods different from the generic category of the clothing in Class 25. That is matter of fact (assessment of the evidence), which lies within the sole jurisdiction of the General Court.

## 20/12/2023, T-221/22 and T-242/22 – Lutamax - Revocation proceedings – Genuine use of the mark - Relevance of EU law - Subcategories

### EUTM Lutamax

#### Registered goods

**Class 5:** *Medicines for human and animal use, traditional plant remedies and treatments for human and animal use, dietetic substances adapted for medical use, dietary supplements adapted for medical or dietetic use, vitamin preparations adapted for medical or dietetic use, medicinal teas; eye care preparations (for pharmaceutical purposes), solutions and cleaning preparations for contact lenses; none of the aforesaid goods for veterinary purposes;*

**Class 29:** *Dietetic foodstuffs and food supplements not adapted for medical use (included in class 29); milk, milk products and milk drinks (milk predominating); powdered milk for human consumption, in particular powdered full-cream milk, skimmed milk and buttermilk; whey, whey products, and whey beverages, whey predominating; preserved, dried and cooked fruits and vegetables; edible oils and fats;*

**Class 30:** *Dietetic foodstuffs and food supplements not adapted for medical use (included in class 30).*

#### Genuine use only for Class 5

##### Cancellation Div. only for:

*'Dietary supplements adapted for medical or dietetic use for the treatment of age-related macular degeneration; eye care preparations (for pharmaceutical purposes) for the treatment of age-related macular degeneration; none of the aforesaid goods for veterinary purposes'.*

##### BOA partially annulled- only for:

*'Dietary supplements adapted for medical or dietetic use for supporting eye health, none of the aforesaid goods for veterinary purposes'.*

## Relevance of provisions of EU law in the assessment of the use of the mark

### Relevance of provisions of EU law

- ‘dietetic food for special medical purposes’ (Directive 1999/21) vs ‘dietary supplements for medical use’ (Directive 2002/46)
- Nice Classification serves administrative purposes (§ 45) – the classification of a product according to other EU rules of law is not in principle decisive for its classification for the purposes of trade mark registration (§ 42-44)
- Genuine use: The relevant question for the purposes of assessing genuine use under trade mark law, is whether the goods in connection with which the mark is used are the same as the goods in respect of which the mark was registered (§ 46)
- Although the norms of EU law do not necessarily influence how the good is classified in the Nice Classification, the norms may be relevant, or even decisive, when determining the type of goods actually used in connection with the contested mark (§ 47). // ECJ, C-400/20 P, Juvederm, § 17

## Definition of the product category

**Definitions of the product categories for which the earlier mark is registered**- under both Directives (§ 49-50) :

- **‘Dietary foods for special medical purposes’** (Dir. 1999/21): ‘a category of foods for particular nutritional uses specially processed or formulated and intended for the dietary management of patients (with food intolerances), to be used under medical supervision’
- **‘Food supplements’** (Dir. 2002/46): ‘foodstuffs the purpose of which is to supplement the normal diet and which are concentrated sources of nutrients or other substances with a nutritional or physiological effect, marketed in dose form (capsules, pastilles, pills, liquids, powders, etc.) to be taken in small quantity’.
- the BoA found that ‘dietary supplements’ were substances that might or might not be nutritional, such as proteins, vitamins, trace elements, herbs, dietary fibres, glucose and enzymes, in the form of pills, capsules, tablets, powders or liquids. It added that dietary supplements could be used to supplement a normal diet or just because they were considered beneficial for the health.

**The product at issue vs categories of registered goods** (§ 51-54)

- it is common ground that the product has a medical or dietetic purpose (dietary treatment of AMD, age-related macular degeneration), It is used to supplement a human diet and it is marketed in capsule form. The packaging indicates that it does not replace a balanced diet.
- It is not intended for patients with food intolerances.
- The product corresponds to a ‘food supplement’ (Dir. 2002/46), rather than ‘dietary food for special medical purposes’ (Dir. 1999/21)

## Use for registered goods - Subcategories? (dietary supplements)

### Category “dietary supplements adapted for medical or dietetic use” – Subcategory: ‘for supporting eye health’?

- § 61-65 GC reminds case-law stressing the importance of the purpose of the goods, when defining ‘independent subcategories’. The relevant question is whether a consumer who wishes to purchase a product or service falling within the category of goods or services covered by the trade mark in question will associate all the goods or services belonging to that category with that mark (22/10/2020, C-720/18 and C-721/18, Ferrari, §43).
- § 68 purpose and intended use of ‘dietary supplements adapted for medical or dietetic use’ in Class 5 and the purpose and intended use of the product at issue are not essentially different.
- § 69-70 The criterion of the purpose and intended use of the goods in question does not aim to provide an abstract or artificial definition of subcategories of goods, but must be applied coherently and specifically. If the goods (here ‘dietary supplements adapted for medical or dietetic use’), have several purposes and intended uses, determining whether a separate subcategory of goods exists by considering in isolation each of the purposes that those goods may have, will not be possible (16/07/2020, C-714/18 P, Taiga § 50, 51).
- § 71 it is common that manufacturers of dietary supplements do not limit themselves to the production or distribution of a single product and may have a legitimate interest in being able to expand their range of goods by including dietary supplements relating to other aspects of human health. Accordingly, the relevant public will associate all the goods or services belonging to that category with that mark
- § 72 Also, ‘dietary supplements adapted for medical or dietetic use’ already constitute a subcategory in Class 5.



## Use for registered goods - No Subcategories (dietary supplements)

- § 73 Thus, ‘dietary supplements adapted for medical or dietetic use’ constitute in themselves a sufficiently clear category which does not require division into subcategories (12/07/2023, T-585/22, Artesan, §75).
- § 74 dietary supplements may be consumed in order to prevent or cure medical conditions in the broad sense or in order to balance nutritional deficiencies. Unlike pharmaceutical preparations, dietary supplements adapted for medical or dietetic use do not necessarily have a precise and specific therapeutic indication. The systematic identification of coherent subcategories within the category of ‘dietary supplements adapted for medical or dietetic use’ on the basis of their therapeutic indication must therefore be ruled out, since that type of product does not necessarily have such an indication.

## T-74/23, DEVICE OF A STYLISED O (fig.) / DEVICE OF A STYLISED O (fig.) et al. ) Opposition proceedings – Proof of use – Nature of use – Use in the course of trade – Use on social media – Market practice

### Lessons learned

- The Lutamax judgment clarifies the relevance of EU law and subcategories.
- GC took into account the economic viewpoint of the EUTM proprietor
- Unlike pharmaceuticals, dietary supplements normally do not have a specific purpose, but can have many purposes

### Other issues

- the principle of ‘non-arbitrary’ subcategories is acknowledged, yet the precise definition of what constitutes ‘non-arbitrary’ remains open to interpretation. However, objective criteria are required.
- Procedural issues: who can argue on the subcategories: It is suggested that this can be done ex officio (well known fact) provided it is done in respect of the rights of defense and in a manner that is not deemed arbitrary. Potential challenges may arise if the involved parties fail to present any arguments on this matter.

### Next steps

- Case-law on these topics to be followed
- Consistency report on ‘subcategories’ is to be started soon
- On this topic ‘Avoiding arbitrariness: The role of subcategories in genuine use’ in IPCLC in April 2024



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Thank you