

General Court: submitting evidence of genuine use by means of CD-ROM is acceptable
European Union - Burges Salmon LLP

**Cancellation
International procedures**

December 04 2015

In *Menelaus BV v Office for Harmonisation in the Internal Market* (OHIM) (Case T-361/13), the General Court has dismissed an appeal by Menelaus BV against a finding of invalidity of its word mark VIGOR, rejecting Menelaus' arguments that the Cancellation Division of OHIM had infringed a number of procedural rules concerning the submission of evidence of use. In particular, the General Court held that it was acceptable for proof of genuine use to be submitted on a CD-ROM, which is contrary to the conclusion reached by the Fourth Board of Appeal in a previous case.

Having successfully registered its VIGOR word mark for a number of goods within Class 21 of the [Nice Classification](#), Menelaus found its mark the subject of an application for a declaration of invalidity by Vicente and Felipe Mahiques in reliance upon an earlier Community figurative mark and international registration, both depicted below, on relative grounds (Article 53(1)(a), read in conjunction with Article 8(1)(b), of the [Community Trademark Regulation](#) (207/2009)).



Pursuant to Article 57(2), the Mahiques were requested to provide evidence of genuine use for both the five years prior to the publication of the VIGOR application (the 'first period') and the five years prior to filing the application for a declaration of invalidity (the 'second period').

The Cancellation Division of OHIM initially rejected the Mahiques' invalidity application on the grounds that genuine use of the earlier marks had not been proved to the requisite legal standard for the first period, but this decision was later partially annulled by the Second Board of Appeal. Taking into consideration some new evidence filed by the Mahiques for the appeal, the Board of Appeal found that genuine use of the earlier mark had been proved and that there was a likelihood of confusion in respect of a majority of the goods covered by the VIGOR mark.

Menelaus' appeal to the General Court comprised six pleas, including:

- infringement of procedural rules concerning the submission of evidence of use;
- that evidence of use of a variant of the earlier mark was incorrectly taken into account; and
- an absence of proof of genuine use.

Menelaus claimed that the evidence of genuine use submitted was inadmissible as it had been submitted on three CD-ROMs, arguing that this was contrary to Rule 22(4) of the [Implementation Regulation](#) (2868/95), read in conjunction with Rules 79 and 79a.

The evidence submitted on the CD-ROMs comprised photographs, invoices, catalogues and printouts of web pages which, the General Court noted, could have been submitted on paper or electronic file containing scanned documents, unlike evidence such as audio or video clips which would generally be made available by data carrier such as CD-ROM or USB stick.

However, the General Court found that the Implementation Regulation did not preclude the submission of evidence of use by CD-ROM. The CD-ROMs at issue were submitted as an annex to a signed document sent by post. This complied with Rule 79(a) of the Implementation Regulation, which does not limit the type of media on which evidence submitted as an annex to submissions may be provided. Further, the Mahiques had complied with the requirement in Rule 79(a) to provide copies for each party in the proceedings.

While it was acknowledged that submission of evidence by CD-ROM containing a number of electronic files could make analysis of the items of evidence more difficult than on paper, it was for the parties submitting the evidence to make sure that the legibility of the evidence did not undermine its evidential value. In the present case, the documents provided were identifiable and legible.

This decision is contrary to that reached by the Fourth Board of Appeal in *Miquel Alimentacio Grup SA v Aldo GmbH & Co KG* (Case R 1259/2011-4), where evidence of use was rejected as not being a method of

submission provided for by the Implementation Regulation.

Menelaus further claimed that the Board of Appeal should have found the evidence of genuine use relating to the earlier period that was submitted before the Board of Appeal for the first time inadmissible as out of time.

The General Court dismissed this argument. Article 76(2) of the Community Trademark Regulation gives OHIM (including the Boards of Appeal) a broad discretion whether or not to take such facts and evidence into account, and this discretion had been properly exercised.

Although the original evidence had been found to be insufficient, the Mahiques had submitted some evidence of use in respect of the earlier period to the Cancellation Division. Consequently, this was not a situation where Rule 40(6) of the Implementation Regulation, which provides that "[i]f the proof is not provided within the time limit set, the application for declaration of invalidity shall be rejected", applied, requiring automatic rejection of the invalidity application.

The new evidence submitted by the Mahiques supplemented the evidence that they had filed previously and was genuinely relevant to the outcome of the application for a declaration of invalidity. Further, the stage of the proceedings and circumstances surrounding the late submission of evidence did not preclude it being taken into account; there was no suggestion of manifest negligence or delaying tactics, for example.

Some of the evidence of use submitted by the Mahiques showed the earlier mark being used in two alternative forms as depicted below, and was accepted pursuant to Article 15(1)(a) of the Community Trademark Regulation, which provides that use of an earlier mark in a form "differing in elements which do not alter the distinctive character of the mark in the form in which it was registered" is also able to constitute use for the purposes of establishing proof of genuine use.



Menelaus claimed that use of the earlier marks had been in a form which altered its distinctive character. In particular, the three-pointed crown device was a prominent element of the earlier marks and the oval background played a significant role.

Again the General Court disagreed. The word 'vigar' was an invented word and inherently distinctive, whereas the oval in the earlier mark was a simple geometric shape that is commonly used and the crown device is a laudatory sign which had here been given a very simple stylisation. The Board of Appeal had rightly concluded that the alternative forms of the mark contained only minor differences that did not alter the distinctive character of the earlier mark as registered.

Menelaus also challenged the Board of Appeal's finding that proof of use had been provided for all of the goods for which the earlier Community trademark had been registered, and argued that sufficient reasons had not been provided by the Board of Appeal for those findings. According to Menelaus, the Board of Appeal should have provided specific reasons for each of the goods and detailed reference to the evidence submitted, including when, where, for how long, to what extent and in which territory the goods concerned were actually on the market.

While the General Court accepted Menelaus' criticisms in respect of the Board of Appeal's reasons in respect of evidence of use submitted for the earlier period, this did not lead to the annulment of the Board of Appeal's decision since an examination of the evidence made it possible to conclude that the requirements had been satisfied. It was apparent from the evidence submitted that there had been extensive use of the earlier mark.

Consequently, Menelaus' appeal was dismissed in its entirety.

Jennifer Gibson, Burges Salmon LLP, Bristol

World Trademark Review™

Daily

World Trademark Review (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.