

**General Court upholds decision on prior non-registered national trademarks**  
**European Union - Grau & Angulo**

**Examination/opposition  
Confusion**

November 06 2017

- **EU General Court confirmed three decisions of the EUIPO Second Board of Appeal**
- **Moravia Consulting opposed Citizen Systems applications for three marks in Class 9 for “pocket calculators; calculators”**
- **Oppositions were dismissed for lack of evidence concerning the existence, validity and scope of protection of the non-registered prior trademarks**

In *Moravia Consulting spol sro v EU Intellectual Property Office (EUIPO)* (Cases T-316/16, T-317/16 and T-318/16, October 12 2017), the EU General Court confirmed three decisions of the EUIPO Second Board of Appeal in which oppositions were dismissed for lack of evidence concerning the existence, validity and scope of protection of the non-registered prior trademarks invoked.

## Background

On April 10 2014 Citizen Systems filed three applications for the registration of EU word marks SDC-554S, SDC-888TII RU and SDC-444S in Class 9 of the Nice Classification for “pocket calculators; calculators”.

On July 22 2014 Moravia Consulting opposed the applications in their entirety, invoking non-registered word marks identical to the marks applied for and related to calculators, alleging the existence of such rights, at least in the Czech Republic. As evidence of the existence and use of the non-registered prior marks, the opponent submitted a two-page document entitled “Sales Confirmation” dated October 8 2013, consisting of an order for the delivery of calculators from Hong Kong.

The opponent also alleged bad faith and that the marks applied for were devoid of distinctive character, although since these were not valid grounds in opposition proceedings they were not taken into account either by the EUIPO or by the EU General Court.

The EUIPO Opposition Division rejected the oppositions, considering that the opponent had failed to submit information or evidence concerning the applicable national law on which it was relying and pursuant to which the use of the marks applied for could have been prohibited in the Czech Republic.

The opponent appealed the decisions and attached to its statements of grounds information concerning the relevant Czech trademark law and, in particular, the legal protection granted to non-registered signs.

The EUIPO Second Board of Appeal dismissed the appeals, holding that:

- the applicant had not provided, in the course of the opposition proceedings, the necessary information to demonstrate that the earlier marks came within the scope of application of Czech law and that such law conferred the right to prohibit the use of the marks applied for, noting that the burden of proof was on the opponent; and
- the information on Czech law submitted by the applicant for the first time before the board of appeal was inadmissible, as it could not be held to be ‘additional’ or ‘supplementary’, and, even if it could, the EUIPO would have exercised the discretion foreseen in Article 76.2 of Regulation 207/2009 (now Article 95.2 of Regulation 2017/1001) and would have not taken it into consideration, since the circumstances surrounding the late filing of that evidence were not capable of justifying such a delay.

The opponent appealed the decisions alleging infringement of Articles 8.4 and 76.1 of Regulation 207/2009 (now Article 95.1 of Regulation 2017/1001) and of Rule 50.1 of Commission Regulation (EC) 2868/95.

## Decision

The EU General Court stated that the application of Article 8.4 has four cumulative conditions:

- the sign must be used in the course of trade;
- it must be of more than mere local significance;
- the right to that sign must have been acquired in accordance with EU law or the law of the member state in which the sign was used before the date of application of the EU trademark; and

- the sign must confer on its proprietor the right to prohibit the use of a subsequent trademark.

The first two conditions must be interpreted in light of EU law, while the other two must be assessed in light of the criteria set by the law governing the sign relied on. The burden of proving the content of such law lies with the opponent.

As per the interpretation of Article 76.2, the general rule is that the EUIPO can take account of facts and evidence invoked or produced after the time limits, and it enjoys a wide discretion to decide whether to take such information into account.

However, regarding the proof of the existence, validity and scope of protection of a trademark, according to the European Court of Justice when no evidence is submitted within the time limit set by the EUIPO, the opposition must automatically be rejected, while if some evidence was submitted within the time limit, it is possible to submit additional evidence.

Taking into account that the only evidence relating to the use of the earlier mark submitted by the opponent before the EUIPO Opposition Division was the two-page document entitled “Sales Confirmation” (which provided no information on the place and duration of the use or on the requirements needed according to Czech law), the board of appeal was right to find that the opponent had produced no evidence within the time limit as to the content of the relevant national law at issue.

Consequently, the information concerning the relevant Czech law submitted by the opponent before the board of appeal for the first time was not ‘additional’ or ‘supplementary’ evidence and therefore the board of appeal did not err in considering it inadmissible.

The board of appeal was also right to hold that, even if the evidence had to be considered ‘additional’ or ‘supplementary’, it would not have taken it into consideration as the opponent should have known that it was obliged to provide evidence on the content of Czech law.

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