

## General Court rebuffs argument alleging error of interpretation of EU legal texts in revocation proceedings

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### EUROPEAN UNION

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- These revocation proceedings involved a trademark which had mistakenly been registered as a collective mark
- The court upheld a EUIPO decision revoking the mark on the ground of non-use
- The court dismissed the argument that an error of interpretation of the applicable texts had led the EUIPO to require the applicant to provide documents which it was not required to provide

On 4 October 2023 the General Court rendered its judgment in [Case T-510/22](#) between *Sastela doo* ('the applicant'), the European Union Intellectual Property Office (EUIPO) and *Zenergo doo* ('the intervener').

### Background

On 14 December 2012 an Italian resident applied with the EUIPO to register the EU figurative trademark depicted below, for coffee and cakes in Class 30. In the application form, he (mistakenly) indicated that he was claiming protection for a 'collective mark'.



The EUIPO registered the trademark under No 011425394, apparently overlooking the fact that the mark was applied for by a natural person, who cannot be the holder of a collective trademark. According to the then applicable Article 66 of [Regulation 207/2009](#), only the following could have applied for an EU collective mark:

“ Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law. ”

The provision of the currently valid Article 74 of [Regulation 2017/1001](#) is no different.

In 2020 the holder sold the trademark to the applicant. The EUIPO was, at first, reluctant to record the change of ownership and issued a notification of deficiency, because the applicant (a limited liability company) was not allowed to own an EU collective trademark. However, the EUIPO eventually corrected the nature of the trademark from 'collective' to 'individual'.

On 16 October 2020 the intervener filed an application for revocation of the trademark due to non-use.

The Cancellation Division of the EUIPO revoked the trademark in its entirety, because genuine use had not been proven - namely, the materials submitted were either unsuitable for proving use or did not contain sufficient indications as to the place, time and extent of use. It further stated that those documents did not provide any details on the turnover achieved, the number of goods sold or other information showing the extent of use of the mark.

The applicant appealed, asserting as follows:

- the contested trademark should not have been revoked because the applicant had submitted sufficient evidence of genuine use; and
- the Cancellation Division's decision was based on an erroneous interpretation of the EU trademark legislation, because holders of EU trademarks are not required to provide any specific type of evidence of use of EU trademarks challenged in revocation proceedings.

The Board of Appeal of the EUIPO upheld the decision, finding that the applicant had not submitted sufficient evidence to demonstrate genuine use of the mark. Further, the board found that the trademark was still a collective mark, and that the correction by which the trademark was identified as an individual mark remained without effect, as the requirements for rectification under Article 102 of Regulation 2017/1001 were not met. Under this provision, the EUIPO may correct linguistic or transcription errors and obvious errors in its decisions or technical errors attributable to it in the registration of the EU trademark or in the publication of the registration.

## Appeal to the General Court

The applicant appealed, relying on pleas that were essentially identical to those put forward in the previous appeal - namely, the applicant claimed to have submitted sufficient evidence of genuine use, and that it is not necessary, according to EU trademark legislation, to provide evidence relating to the turnover achieved or the quantity of goods sold or information on factors such as the volume of commercial exploitation, production or sales capacities and the regularity of sales.

## Decision

The General Court dismissed the action, finding that the Board of Appeal had correctly found that there was a lack of proof of genuine use of the mark.

With regard to the applicant's argument alleging an error of interpretation of Regulation 2017/1001 and [Delegated Regulation 2018/625](#), the court remarked that the board's decision was not based on the ground that specific evidence was not submitted by the applicant, but on the ground that the evidence which it provided was not such as to establish that the mark was put to genuine use in respect of the goods for which it had been registered.

The applicant had not disputed the Board of Appeal's finding that the contested trademark was still a collective mark; therefore, the General Court made no remarks on that point.

## Comment

This 'one of a kind' case shows, firstly, that applicants should exercise the utmost care when applying for a trademark, as some errors cannot be rectified. Secondly, those interested in purchasing a trademark that is vulnerable to non-use cancellation are advised to check beforehand whether the trademark has been used, and to obtain appropriate evidence of such use from the

previous holder. Thirdly, trademark holders are expected to exert themselves and be resourceful to prove trademark use in revocation proceedings. Lastly, a lack of evidence of genuine use cannot be overcome by accusing the authority of misinterpreting the EU trademark legal texts.

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