

**GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS**

**EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)**

Part C

Opposition

Section 4

Rights under Article 8(4) and 8(6) EUTMR

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Obsolete

1 Introduction

The relationship between the European Union trade mark system and national law is characterised by the principle of coexistence. This means that both the European Union trade mark system and the national laws exist and operate side by side. The same sign can be protected by the same proprietor as an EUTM and as a national trade mark in one (or all) of the Member States. The principle of coexistence further implies that the EUTM system actively acknowledges the relevance of national rights and their scope of protection. Where conflicts arise between EUTMs and national trade marks or other national rights, there is no hierarchy determining that one system prevails over the other; instead, these conflicts apply the principle of priority. If the respective requirements are met, earlier national trade marks or other earlier national rights can prevent registration of, or invalidate a later EUTM.

Although Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks and its subsequent implementation have harmonised the laws relating to registered trade marks, no such harmonisation has taken place on an EU scale with regard to non-registered trade marks nor for most other earlier rights of a similar nature. These unharmonised rights remain completely governed by national laws. Furthermore, there are rights other than trade marks whose acquisition and/or scope of protection is governed by EU law.

Article 8(4) EUTMR is the ground for opposition against an EUTM application based on an earlier non-registered trade mark or other sign used in the course of trade protected under EU law or the laws of the Member States, subject to the conditions of that provision. Article 8(6) EUTMR is the ground for opposition against an EUTM application based on an earlier designation of origin or geographical indication protected under EU law or the laws of the Member States, subject to the conditions of that provision.

2 Structure of Article 8(4) EUTMR

Article 8(4) EUTMR reads:

Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or the law of the Member State governing that sign:

1. rights to that sign were acquired prior to the date of application for registration of the EU trade mark, or the date of the priority claimed for the application for registration of the EU trade mark;
2. that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Article 8(4) EUTMR means that in addition to the earlier trade marks specified in Article 8(2) EUTMR, non-registered trade marks and other signs protected at EU or

Member State level used in the course of trade of more than mere local significance can be invoked in an opposition provided that such rights confer on their proprietors the right to prohibit the use of a subsequent trade mark.

Article 8(4) EUTMR does not expressly or exhaustively enumerate the particular rights that can be invoked under this provision, but rather outlines a broad spectrum of rights that might serve as a basis for an opposition against an EUTM application. Therefore, Article 8(4) EUTMR can be regarded as a general 'catch-all provision' for oppositions based on non-registered trade marks and other signs used in the course of trade.

Nevertheless, the broad scope of earlier rights to be relied upon in opposition proceedings under Article 8(4) EUTMR is subject to a number of restrictive conditions: these rights must confer an entitlement to the proprietor to exercise them, they must be of more than local significance, they must be protected by the applicable law governing them against the use of a subsequent trade mark and the rights must have been acquired prior to the EUTM application under the applicable law governing that sign.

The 'more than mere local significance' requirement aims to restrict the number of potential opposing non-registered rights, thus avoiding the risk of a collapse or paralysis of the EUTM system by being flooded with opposing, relatively insignificant rights.

The 'national protection' requirement is deemed necessary as the non-registered national rights are not easily identifiable and their protection is not harmonised on an EU level. Consequently, only national law governing the earlier signs may define the scope of their protection.

While the requirements of 'use in the course of trade' and 'use of more than mere local significance' are to be interpreted in the context of EU law (European standard), national law applies when determining whether a particular right is recognised and protected under the national law, whether its holder is entitled to prohibit the use of a subsequent trade mark, and what conditions need to be met under national law for the right to be successfully exercised.

As a consequence of this dualism, the Office must apply both the relevant provisions of the EUTMR and the national law governing the earlier opposing right. In view of the two-tier examination to be applied under Article 8(4) EUTMR, this provision, as the link between EU and national law, displays a somewhat 'hybrid' nature.

3 Conditions of Article 8(4) EUTMR

The conditions for successfully invoking Article 8(4) EUTMR are:

1. the opponent must be the proprietor of a non-registered trade mark or of another sign used in the course of trade or a person authorised under the applicable law to exercise such a right (see paragraphs 3.1 and 3.2 below);
2. use in the course of trade of more than mere local significance (see paragraph 3.3 below);

3. acquisition prior to the EUTM application under the applicable law governing that sign (see paragraph 3.4 below);
4. right to prohibit the use of a subsequent trade mark under the applicable law governing that sign (see paragraph 3.5 below).

3.1 Entitlement: direct right conferred on the opponent

The legal systems of the EU Member States provide various means of preventing the use of later marks on the basis of earlier signs used in the course of trade. However, in order to come within the meaning of Article 8(4) EUTMR, the earlier right must be vested in a particular owner or a precise class of user that has a quasi-proprietorial interest over it, in the sense that it can exclude or prevent others from unlawfully using the sign. This is because Article 8(4) EUTMR is a 'relative' ground for opposition and Article 46(1)(c) EUTMR provides that oppositions may be filed only by the proprietors of earlier marks or signs referred to in Article 8(4) EUTMR and by persons authorised under the relevant national law to exercise these rights. In other words, only persons having an interest directly recognised by law in initiating proceedings are entitled to file an opposition within the meaning of Article 8(4) EUTMR.

For example, in some Member States, the use of a sign may be prohibited if it results in unfair or misleading business practices. In such cases, if the earlier right lacks any 'proprietary quality', it will not fall within Article 8(4) EUTMR. It does not matter whether these signs are protected against misleading or unfair use under trade mark law, the law relating to unfair competition, or any other set of provisions. An example in this respect is the German regulation governing the use of the geographical indication 'Solingen' for specific goods (cutlery, scissors, knives, etc.). This law would not be a proper basis for an opposition under Article 8(4) EUTMR because the sign in question lacks any proprietary quality and, as such, is more public in nature.

Earlier right	Case No
A.O. CUBA	23/10/2008, R 51/2007-4, CUBAO / CUBA
Where the national law does not confer on a legal entity (whether public or private) a subjective right allowing it to prohibit the use of a subsequent trade mark, the 'proprietary requirement' is not met. The Board found that the Spanish law giving effect to the bilateral agreement between Spain and Cuba for the protection of the appellation of origin 'Cuba' was not sufficient to grant such a subjective right (paras 23-27).	

In assessing the proprietorship of a sign used in the course of trade, the Office must analyse specifically whether the opponent has acquired rights over the sign 'in accordance with the national law' (18/01/2012, T-304/09, BASmALI, EU:T:2012:13).

3.2 Types of rights falling under Article 8(4) EUTMR

3.2.1 Introduction

When assessing which kind of intellectual property rights can be invoked under Article 8(4) EUTMR and which cannot, a European standard applies. The distinction follows from the scheme of the EUTMR and, in particular, from the differentiation made between the kinds of earlier signs upon which an opposition may be based under Article 8(4) EUTMR and the types of further rights that may be the basis for invalidity under Article 60(2) EUTMR. While Article 8(4) EUTMR refers to signs ('non-registered trade mark or ... another sign'), Article 60(2) EUTMR refers to a broader set of rights: (a) a right to a name; (b) a right of personal portrayal; (c) a copyright; and (d) an industrial property right.

Therefore, although the signs covered by Article 8(4) EUTMR fall within the broad category of 'industrial property rights', not all industrial property rights are 'signs' for the purposes of Article 8(4) EUTMR. Since this distinction is contained in the EUTMR, the classification of a right under the respective national law is not decisive, and it is immaterial whether the national law governing the respective sign or industrial property right treats both types of rights in one and the same law.

The types of rights falling under Article 8(4) EUTMR are:

- 'non-registered trade marks'; and
- 'other signs used in the course of trade' such as:
 - trade names
 - corporate names
 - establishment names
 - titles of publications or similar works
 - domain names.

The category of 'other signs used in the course of trade' within the meaning of Article 8(4) EUTMR mainly covers non-registered signs. However, the fact that a sign is also registered in accordance with the requirements of the respective national law does not bar it from being invoked under Article 8(4) EUTMR.

3.2.2 Non-registered trade marks

Non-registered use-based trade marks exist in a number of the Member States⁴² and are signs that indicate the commercial origin of a product or service. Therefore, they are signs that function as a trade mark. The rules and conditions governing acquisition of rights under the relevant national law vary from simple use to use having acquired a reputation. Neither is their scope of protection uniform, although it is generally quite

⁴² Benelux, Cyprus, Croatia, Estonia, France, Hungary, Lithuania, Poland, Romania, Slovenia and Spain do not protect unregistered trade marks (unless, for some jurisdictions, they are considered well known within the meaning of Article 6bis of the Paris Convention).

similar to the scope of protection under the provisions in the EUTMR concerning registered trade marks.

Article 8(4) EUTMR reflects the existence of such rights in Member States and grants the proprietors of non-registered marks the possibility of preventing the registration of an EUTM application where they would succeed in preventing use of that EUTM application under the relevant national law, by showing that the conditions set by the national law for prohibiting use of the later EUTM are satisfied and the other conditions of Article 8(4) EUTMR are met. As non-registered trade marks are not protected at European Union level, a 'European Union non-registered trade mark' is not an eligible basis for opposition.

Example: 17/03/2011, R 1529/2010-1, GLADIATOR / GLADIATOR, where a non-registered trade mark in the Czech Republic was invoked and 05/11/2007, R 1446/2006-4, RM2000T / RM2000T, where a non-registered trade mark in Belgium was invoked and the opposition rejected as unfounded because non-registered trade marks are not protected in Belgium.



3.2.3 Other signs used in the course of trade

'Other signs used in the course of trade' is a broad category that is not enumerated in Article 8(4) EUTMR. In order for such signs to come within the ambit of Article 8(4) EUTMR, they must have an identifying function as to commercial origin, that is to say, they must serve to identify an economic activity engaged in by their proprietor (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 149). Article 8(4) EUTMR does not cover other types of intellectual property rights that are not 'commercial signs' — such as patents, copyrights or design rights that do not have a primarily identifying function but protect technical or artistic achievements or the 'appearance' of something.

Some examples of cases dealing with whether a right is a 'sign' for the purposes of Article 8(4) EUTMR are set out below.

Earlier right	Case No
JOSE PADILLA (copyright)	22/06/2010, T-255/08, EU:T:2010:249
The Court found that copyright cannot constitute a 'sign used in the course of trade' within the meaning of Article 8(4) EUTMR. It is apparent from the scheme of Article 52 of Regulation No 40/94 [now Article 60 EUTMR] that copyright is not such a sign. Article 52(1)(c) of Regulation No 40/94 [now Article 60(1)(c) EUTMR] provides that an European Union trade mark is to be declared invalid where there is an earlier right as referred to in Article 8(4) EUTMR and the conditions set out in that paragraph are fulfilled. Article 52(2)(c) of Regulation No 40/94 [now Article 60(2)(c) EUTMR] provides that an European Union trade mark is also to be declared invalid where the use of such a trade mark may be prohibited pursuant to any 'other' earlier right and in particular a copyright. It follows that copyright is not one of the earlier rights referred to in Article 8(4) EUTMR.	

Earlier right	Case No
Dr. No (copyright)	T-435/05
[...] the protection provided for by copyright cannot be relied on in opposition proceedings, but only in proceedings for a declaration of invalidity of the European Union trade mark in question (para. 41).	

Earlier rights	Case No
 and  (Community designs)	B 1 530 875
Designs are a form of intellectual property dealing with the ornamental or aesthetic aspects of an article's appearance. Designs are deemed to be the result of a creative work that needs to be protected against unauthorised copying or imitation by third parties in order to ensure a fair return on investment. They are protected as intellectual property, but they are not business identifiers or trade signs. Therefore, designs do not qualify as signs used in the course of trade for the purpose of Article 8(4) EUTMR.	

3.2.3.1 Trade names

Trade names are the names used to identify businesses, as distinguished from trade marks that identify goods or services as produced or marketed by a particular undertaking.

A trade name is not necessarily identical with the corporate name or commercial name entered in a commercial or similar register as trade names can cover other non-registered names such as a sign that identifies and distinguishes a certain establishment. Trade names are protected as exclusive rights in all Member States.

Pursuant to Article 8 of the Paris Convention, trade names enjoy protection without any registration requirement. If national legislation requires registration for national trade names, the respective provision is not applicable by virtue of Article 8 of the Paris Convention with respect to trade names held by a national of another contracting party to the Paris Convention. This applies as well in respect of nationals of a member of the WTO Agreement.

As regards the application of Article 8(4) EUTMR to trade names, where the trade name is invoked on the basis of the law of one of the Member States where a registration is a condition for the enforcement of rights in a trade name, the Office will apply this requirement where the Member State and the nationality of the opponent are the same, but will not apply this requirement in all other cases, since this would violate the provisions of Article 8 of the Paris Convention.

Examples: 16/08/2011, R 1714/2010-4, where the Spanish trade name 'JAMON DE HUELVA' was invoked.

3.2.3.2 Corporate names

A corporate name or company name is the official designation of an undertaking, in most cases registered in the respective national commercial register.

Article 8(4) EUTMR requires that actual use be shown, even if national law vests in the holder of such a name the right to prohibit the use of a subsequent trade mark on the basis of registration alone. However, if under national law registration is a prerequisite for protection, registration must be demonstrated as well. Otherwise, there would be no national right that the opponent could invoke.

Examples: 14/09/2011, T-485/07, O-live, EU:T:2011:467, where the Spanish commercial name 'OLIVE LINE' was invoked and 08/09/2011, R 21/2011-1, where the French company name 'MARIONNAUD PARFUMERIES' was invoked.

3.2.3.3 Domain names

A domain name is a combination of typographical characters corresponding to one or several numeric IP addresses that are used to identify a particular web page or set of web pages on the internet. As such, a domain name functions as an 'address' used to refer to a specific location on the internet (euipo.europa.eu) or an email address (@euipo.europa.eu).

Domain names are registered with organisations or commercial entities called 'domain name registrars'. Although a domain name is unique and may be a valuable commercial asset, a domain name registration per se is not an intellectual property right. Such registrations do not create any form of exclusive right. Instead, 'registration' in this context refers to a contractual agreement between a domain name registrant and the domain name registrar.

However, the use of a domain name may give rise to rights that can be the basis for an opposition under Article 8(4) EUTMR. This can occur if through the use of the domain name it acquires protection as a non-registered trade mark or a trade sign identifying commercial origin under the applicable national law.

Examples: 07/12/2011, R 275/2011-1, where rights based on the use of the German domain name 'lucky-pet.de' were invoked; B 1 719 379, where rights based on the use of the French domain name 'Helloresto.fr' were invoked; 14/05/2013, T-321/11 & T-322/11, Partito della libertà, EU:T:2013:240, where rights based on the use of the

Italian domain name 'partidodellaliberta.it' were invoked and the Court considered that references to this site in the Italian press did not in themselves substantiate its use in the context of a commercial activity.

3.2.3.4 Titles

Titles of magazines and other publications, or titles of similar categories of works such as films, television series, etc. fall under Article 8(4) EUTMR only if, under the applicable national law, they are protected as a trade sign identifying commercial origin.

The fact that the copyright in a title of a work can be invoked under the respective national law against a subsequent trade mark is not material for the purposes of Article 8(4) EUTMR. As set out above, whilst a right in copyright may be used to invalidate an EUTM under Article 60(2) EUTMR, it is only where a title has an 'identifying' function and acts as a trade sign identifying commercial origin that it comes within the scope of Article 8(4) EUTMR. Therefore, for such signs to be relied on under Article 8(4) EUTMR in the context of opposition proceedings, the national law must envisage a protection that is independent from that recognised by copyright law (30/06/2009, T-435/05, Dr. No, EU:T:2009:226, § 41-43.)

As with all rights under Article 8(4) EUTMR, the title must have been used in the course of trade. This will normally require that the work to which the title relates must have been placed on the market. Where the title relates to a service (such as a television programme), the service must have been made available. However, there will be circumstances where pre-use advertising may be sufficient to create rights, and where such advertising will constitute 'use' within the meaning of Article 8(4) EUTMR. In all cases, the title must have been used as an indicator of the commercial origin of the goods and services in question. Where a title is used only to indicate the artistic origin of a work, such use falls outside the scope of Article 8(4) EUTMR (30/06/2009, T-435/05, Dr. No, EU:T:2009:226, § 25-31).

Example: 12/01/2012, R 181/2011-1, where the magazine title 'ART' was invoked.

3.3 Use requirements

In order to successfully invoke Article 8(4) EUTMR in opposition proceedings, the earlier rights must be used. There are two different use requirement standards which must be taken into account:

- national standard
- European standard.

The two use requirement standards, however, clearly overlap. They must not be viewed in isolation but have to be assessed together. This applies, in particular, to the 'intensity of use' under the national standard and 'use in trade of more than mere local significance' under the European standard.

3.3.1 National standard

The national standard is relevant as it defines the scope of protection of the earlier rights, which are often not easily identifiable, all the more so since their protection is not harmonised on an EU level (see paragraph 3.5.2 below on the scope of protection). This standard determines the existence of the national right and the conditions of protection. For non-registered trade marks and other trade signs identifying commercial origin that do not require registration, use constitutes the only factual premise justifying the existence of the right, including ascertainment of the beginning of its existence. The national standard also prescribes the intensity of use under the relevant national law, which may vary from mere first use in trade to use requiring recognition or reputation.

For example, right to an unregistered trade mark in Denmark is acquired by mere commencement of use of the mark in Danish territory.

In Germany, however, the right to an unregistered trade mark is acquired through use that has led to recognition by the relevant public of it as a trade mark (Verkehrsgeltung). According to case-law, distinctive signs require 20 to 25 % recognition whereas non-distinctive signs must demonstrate recognition by 50 % of the relevant public.

3.3.2 European standard — use in the course of trade of more than mere local significance

Under Article 8(4) EUTMR, the existence of an earlier non-registered trade mark or of another sign gives good grounds for opposition if the sign satisfies, inter alia, the following conditions: it must be used in the course of trade and the use must be of more than mere local significance.

The above two conditions are apparent from the very wording of Article 8(4) EUTMR (reiterated in Article 7(2)(d) EUTMDR), and must, therefore, be interpreted in the light of EU law. The common purpose of the two conditions laid down in Article 8(4) EUTMR is to limit conflicts between signs by preventing an earlier right that is not sufficiently definite — that is to say, important and significant in the course of trade — from preventing registration of a new European Union trade mark. A right of opposition of that kind must be reserved to signs which actually have a real presence on their relevant market (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 157).

3.3.2.1 Use in the course of trade

The first requirement under Article 8(4) EUTMR is that the sign must be used in the course of trade.

The notion of 'use in the course of trade' in accordance with Article 8(4) EUTMR is not the same as 'genuine use' in accordance with Article 47(2) and (3) EUTMR (30/09/2010, T-534/08, Granuflex, EU:T:2010:417, § 24-27). The aims and conditions connected with proof of genuine use of registered European Union or national trade marks are different from those relating to proof of use in the course of trade of the signs

referred to in Article 8(4) EUTMR (09/07/2010, T-430/08, Grain Millers, EU:T:2010:304, § 26; 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 143). Therefore, use must be interpreted according to the particular type of right at issue.

The Court of Justice ruled that the ‘use of the sign in the course of trade’ within the meaning of Article 8(4) EUTMR refers to the use of the sign ‘in the course of a commercial activity with a view to economic advantage and not as a private matter’ (12/11/2002, C-206/01, Arsenal, EU:C:2002:651, § 40; 25/01/2007, C-48/05, Opel, EU:C:2007:55, § 18; 11/09/2007, C-17/06, Céline, EU:C:2007:497, § 17).

However, the Court of Justice also ruled that deliveries made without charge may be taken into account in order to ascertain whether the requirement for use of the earlier right in the course of trade has been met, since those deliveries could have been made in the context of a commercial activity with a view to economic advantage, namely to acquire new outlets (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 152).

As far as the time of use of the sign is concerned, an opponent must prove that use took place before the filing of the EUTM application or the priority date if relevant (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 166-168).

Earlier sign	Case No
BUD	C-96/09 P
<p>The Court discussed whether use that takes place exclusively or to a large extent between the filing of an application for registration and its publication was sufficient to meet the use requirement. One of the parties had argued that only the acquisition of the right had to take place before filing of the EUTM application but not its use. The Court applied the same temporal condition as to the acquisition of the right and concluded that use had to take place before the filing of the application. The Court of Justice considered that in view of the considerable period of time which may elapse between the filing of an application for registration and its publication, the obligation of use in the course of trade of the sign before the filing of the application guarantees that the use claimed for the sign concerned is real and not an exercise whose sole aim has been to prevent registration of a new trade mark (paras 166-168).</p>	

Moreover, it must be clear from the evidence that the use continues on the date of the filing of the opposition. In this context, Article 7(2)(d) EUTMDR expressly states that if an opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, the opponent must provide evidence of its acquisition, continued existence (emphasis added) and scope of protection of that right.

The following is an example of an inter partes case relating to invalidity proceedings. The reasoning and the findings also apply to oppositions, given that Article 8(4) EUTMR is a ground that can be invoked both in opposition and in invalidity.

Earlier sign	Case No
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BAMBOLINA (non-registered mark in a number of MS)	30/07/2010, 3 728 C (confirmed 03/08/2011, R 1822/2010-2; 23/10/2013, T-581/11, EU:T:2013:553)
<p>The evidence showed use in the course of trade of the non-registered trade mark for 3 years, not covering the last 2 years before the date of filing of the invalidity request. The Cancellation Division held that an earlier non-registered sign relied on in an invalidity action must be in use at the time of filing the request. Since for these signs use constitutes the factual premise justifying the existence of the right, the same factual premise must still exist, and be proven, on the date of filing of the invalidity request (30/07/2010, 3 728 C, paras 25-28). The Board confirmed the finding of the Cancellation Division, adding that Rules 19(1) and (2)(d) of Regulation No 2868/95 [now Article 7(1) and (2)(d) EUTMDR] state that where an opposition is based on Article 8(4) EUTMR, evidence of, inter alia, its 'continued existence' must be adduced within the period given by the Office for presenting or completing facts, evidence or arguments in support of the opposition. Failure to prove the existence, validity and scope of protection of the earlier mark or right within that period will lead to the opposition being rejected as unfounded. In the Board's opinion, these provisions applied mutatis mutandis to cancellation proceedings (03/08/2011, R 1822/2010-2, para. 15).</p>	

The requirement that the sign be used in the course of trade must, as stated above, be interpreted in the light of EU law. It must be distinguished from the requirements provided for under the applicable national laws that might set specific requirements as far as the intensity of the use is concerned.

The European Union use requirement as prescribed by Article 8(4) EUTMR applies independently of whether national law allows prohibition of a subsequent trade mark on the basis of the registration of a sign alone, that is, without any requirement relating to use. The following is an example where the opponent relied on the registration, at national level, of a trade name, but failed to prove that the sign was used in trade.

Earlier sign	Case No
NACIONAL (Portuguese name of establishment)	07/02/2010, R 693/2011-2
<p>Under Article 8(4) EUTMR, the fact that the opponent may, in accordance with the law of Portugal, have acquired exclusive rights plainly enforceable against subsequent trade marks on the basis of the registration of a 'name of establishment', does not exempt it from the burden of proving that the sign in question has been used in the course of trade of more than local significance. The mere fact that the sign is registered in accordance with the requirements of the respective Portuguese law is not in itself sufficient for the application of Article 8(4) EUTMR (paras 20-26).</p>	

Depending on the applicable national law, an opponent might have to prove not only that the sign relied on is used in the course of trade (this being, as stated, a requirement under EU law), but also that it has been registered with the competent

national authorities. It would not be sufficient that the European Union requirement of 'use in trade' is met if the registration requirement is not fulfilled. However, under certain national laws, rights in a company name may be invoked, as long as the company name has been used, prior to the registration of the entity in the companies register. The following is an example where the opponent invoked prior rights in a company name used in the course of trade in Germany that was not registered at the time of filing the contested EUTM application.

Earlier sign	Case No
Grain Millers GmbH & Co. KG (German company name)	T-430/08
<p>The opponent invoked under Article 8(4) EUTMR the company name 'Grain Millers GmbH & Co. KG' used in the course of trade in Germany for 'flour, in particular wheat flour and rye flour'. Therefore, the opponent claimed the name of a GmbH (Gesellschaft mit beschränkter Haftung, 'limited liability company' in English). The applicant argued that, according to Article 11(1) German Limited Companies Act (GmbH Gesetz), a GmbH does not exist before its registration and that the opponent was therefore not entitled, in support of its opposition, to rely on its business name, because the company was registered only after the filing of the contested EUTM application. The Court took a different view and held that, according to the case-law of the German courts, the right to a business name exists pursuant to paragraph 5(2) of the Markengesetz from the first use in the course of trade, without the obligation to register (para. 36).</p>	

A sign is used in the course of trade where that use occurs in the context of commercial activity with a view to economic advantage and not as a private matter.

Therefore, the Office will reject an opposition in the absence of actual use of the invoked sign. The following are examples where the opponent failed to meet this basic requirement.

Earlier sign	Case No
Octopussy (film title, claimed to have been used in the course of trade in, inter alia, Germany)	20/04/2010, R 526/2008-4

The opponent merely submitted general information explaining the content of the film, its characters, gross figures, video offers on the internet and advertisements without any details as regards the relevant market. The information as regards turnover is also insufficient since it is too broad a general reference to the activities carried out by the opponent and does not specify either the type of activity or the territories concerned. For the same reason, the figures from a periodical, relating to the box office receipts generated by the film, have no bearing on the use of the sign in Germany. The remaining press articles furnished by the opponent concern subjects which cannot corroborate the use of the sign in the Member States indicated. The licence agreements for merchandising do not constitute any evidence with regard to the use of the sign as a film title. Lastly, the mere fact that the film was a worldwide success cannot substitute the obligation of the opponent to file concrete evidence with regard to the Member States in which it claims protection under Article 8(4) EUTMR (para. 26).

Earlier sign	Case No
'lucky-pet.de' (German domain name)	R 275/2011-1
<p>The opponent invoked under Article 8(4) EUTMR the domain name 'lucky-pet.de' used in the course of trade in Germany for 'mats for animals; retail services with respect to pet supplies'. It has not been proven that the domain has been used with more than local significance for the claimed goods and services. The invoices provided and the catalogue only show the internet address www.lucky-pet.de. However, they do not prove that the website www.lucky-pet.de has been visited and, if so, to what extent. It has neither been stated nor proven by any document how many people visited the website and ordered products via email (para. 31).</p>	

3.3.2.2 Use of more than mere local significance

Rights falling under Article 8(4) EUTMR may only be invoked if their use is of more than mere local significance. This requirement applies for all the rights within the scope of Article 8(4) EUTMR, that is, both to unregistered trade marks and to other trade signs identifying commercial origin. The proprietors of rights the use of which is of mere local significance retain their exclusive rights under the applicable national law pursuant to Article 138 EUTMR.

The question whether the use of a non-registered sign is of more than mere local significance will be answered by applying a uniform European standard (18/04/2013, T-506/11 & T-507/11, Peek & Cloppenburg, EU:T:2013:197, § 19, 47-48).

The General Court held that the significance of a sign used to identify specific business activities must be established in relation to the identifying function of that sign. That consideration means that account must be taken, firstly, of the geographical dimension of the sign's significance, that is to say, of the territory in which it is used to identify its proprietor's economic activity, as is apparent from a textual interpretation of Article 8(4)

EUTMR. Account must be taken, secondly, of the economic dimension of the sign's significance, which is assessed in view of the length of time for which it has fulfilled its function in the course of trade and the degree to which it has been used, of the group of addressees among which the sign in question has become known as a distinctive element, namely consumers, competitors or even suppliers, or even of the exposure given to the sign, for example, through advertising or on the internet (24/03/2009, T-318/06 – T-321/06, General Optica, EU:T:2009:77, § 36-37; 30/09/2010, T-534/08, Granuflex, EU:T:2010:417, § 19).

The Court of Justice clarified that the significance of a sign cannot be a function of the mere geographical extent of its protection, since, if that were the case, a sign whose protection is not merely local could, by virtue of that fact alone, prevent registration of a European Union trade mark, even though the sign might be used only to a very limited extent in the course of trade. The sign must be used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local, which implies, where the territory in which that sign is protected may be regarded as other than local, that the sign must be used in a substantial part of that territory (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 158-159).

However, it is not possible to establish a priori, in an abstract manner, which part of a territory must be used to prove that the use of a sign is of more than mere local significance. Therefore, the assessment of the sign's significance must be made in concreto, according to the circumstances of each case.

Therefore, the criterion of 'more than mere local significance' is more than just a geographical examination. The economic impact of the use of the sign must also be evaluated. Consideration must be given, and the evidence must relate, to these elements:

1. the intensity of use (sales made under the sign)
2. the length of use
3. the spread of the goods (location of the customers)
4. the advertising under the sign and the media used for that advertising, including the distribution of the advertising.

In the following examples, both the geographic and the economic dimension of use of the sign were found to meet the standards.

Earlier sign	Case No
GLADIATOR (non-registered trade mark in the Czech Republic)	R 1529/2010-1

The around 230 invoices are sufficient to conclude that the sign 'GLADIATOR' has been used in the course of trade for 'all terrain vehicles'. They are issued to the opponent's clients in Czech cities such as 'Praha', 'Kraslice', 'Dolní Lánov', 'Pelhřimov', 'Opava', 'Bozkov', 'Plzeň' and many other Czech cities which cover many different areas of the Czech Republic. Furthermore, the catalogues and the magazines '4X4 Style' from 2007 are written in Czech and it is very likely that they are distributed in different venues within the Czech Republic. The documents such as the list of distributors, catalogues and magazines support the findings that the sign has been used in the course of trade (paras 22-33).

Earlier sign	Case No
PORTO (Portuguese appellation of origin)	B 998 510, (confirmed 12/03/2010, R 1101/2009-2)
<p>The evidence filed, and the amount and content of the legislation, regulation and registration certificates indicate that Port wine has been and is being used as an appellation of origin for wine. It is clear from the evidence in its totality that the significance of the appellation of origin is not merely local, but rather has an international impact, as reflected in its history and its use as a tool to attract tourists. The promotion of the appellation of origin has taken place, among others, through the establishments 'SOLAR DO VINHO DO PORTO' in Lisbon and Oporto, as well as through the 'PORT WINE ROUTE', in the Douro region. Taking this into consideration, the Office finds that the opponent has proved that it has used its appellations of origin in the course of trade and that the use is of more than mere local significance.</p>	

As far as the use of the sign is concerned, in general, neither the territory of a city alone, even a large one, nor a regional district or province, is of more than mere local significance. It will depend on the circumstances of the case (see examples below). The leading judgment in this respect is the one rendered by the General Court in the General Óptica case, where use of the sign was confined to a specific locality and was, therefore, insufficient to meet the prescribed requirements.

Earlier sign	Case No
Generalóptica (Portuguese establishment name)	T-318/06 – T-321/06

It is not apparent from the evidence provided by the opponent that the significance of the sign relied on in the present case is more than merely local within the meaning of Article 8(4) EUTMR. As the Board of Appeal stated in paragraph 33 of the contested decisions, it is apparent from the documents submitted by the opponent that at the time when registration of the first two European Union trade marks was applied for, the sign in question had been used for almost 10 years merely to designate a business establishment open to the public in the Portuguese town of Vila Nova de Famalicão, which has 120 000 inhabitants. In spite of its explanations at the hearing, the applicant did not provide any evidence of recognition of the sign by consumers or of its business relationships outside the abovementioned town. Likewise, the applicant has not shown that it had developed any advertising activity in order to ensure that its business establishment was promoted outside that town. It must therefore be held that the business establishment name Generalóptica is of mere local significance within the meaning of Article 8(4) EUTMR (para. 44).

Earlier sign	Case No
FORTRESS	
FORTRESS INVESTMENTS	01/04/2011, R 354/2009-2
FORTRESS INVESTMENT GROUP (non-registered trade marks in the UK)	08/03/2011, R 355/2009-2
<p>The fact that the invalidity applicant was involved in the acquisition, lease-back and management of nationwide property portfolios of major UK institutions and companies proves that the use was of more than mere local significance. The fact that use is limited to London is relevant in the sense that London is the seat of nearly all governmental institutions and bodies and home to the City of London, one of the leading financial centres of the world. The economic dimension of the sign's significance was important since by mid 2000, the invalidity applicant had already an equity capital under management in excess of USD 1 billion. Furthermore, the group of addressees among which the sign was known is significant since it included major players in the financial field and UK public institutions. The exposure given to the sign was also significant, cf. the national and specialised press coverage. Therefore, use in the course of trade was of more than mere local significance (paras 49-51).</p>	

The notion that the use in trade of the sign relied on must be proven in the territory of the Member State/s where protection is sought is not incompatible with use of the sign in connection with cross-border commercial transactions.

Earlier sign	Case No
GRAIN MILLERS (German business name)	T-430/08


The use of a business name in the context of the importation of goods from another State (in this case, documents of the transaction concluded by opponent concerning the import of wheat from Romania to Germany) is indeed use in the context of a commercial activity with a view to economic advantage, since import-export constitutes a normal, everyday activity of an undertaking, necessarily involving at least two States (para. 41).

The following are examples where the opponent failed to prove that the economic dimension of the use of the signs concerned was sufficient to meet the prescribed legal requirements.

Earlier sign	Case No
BUD (appellation of origin protected in France and Austria)	22/01/2013, T-225/06 RENV, T-255/06 RENV, T-257/06 RENV & T-309/06 RENV, EU:T:2013:31
Four very small invoices for only three cities, without any advertisements, did not meet the requirement for use in the course of trade of a sign of more than mere local significance (para. 56). The same conclusion applied to Austria since the GC found that use was limited to deliveries of 12-25 hectolitres per year, for a marginal turnover (around EUR 1 200), almost exclusively in Vienna (paras 59-61).	

Earlier sign	Case No
BRIGHTON (non-registered mark in several MS)	30/06/2010, R 408/2009-4
The sales chart provided by the opponent shows that the sale activities in the Member States concerned were not consistent over time to the extent that for certain years no sales at all appear to have taken place and that for others the sales revenue was very low indeed. Therefore, the sales figures show that the opponent was not able to maintain an intensity of use of the signs over three consecutive years. It is unlikely in those cases that the public was able to memorise the mark as an indication of origin. The opponent did not submit any evidence relating to the advertising and promotion of the marks invested in the concerned Member States, or other material showing that the signs in question had established themselves in the marketplace to such an extent as to justify the acquisition of exclusive rights in non-registered trade marks (paras 12-21).	

Earlier sign	Case No

 (Greek non-registered mark)	01/06/2011, R 242/2010-1
<p>Although the documents confirm the geographical extent of the trade mark to Greece, the evidence regarding the extent of time of the alleged use is clearly insufficient. The last dated document is from 1997, i.e. seven years before the contested application was submitted. Moreover, the most recent documents in which the trade mark 'ESKIMO' can be seen are the invoices dating from 1991 to 1994. They only reflect the sales of a little less than 100 units throughout these four years, which cannot be deemed sufficient to prove the use of the mark as a business identifier by the opponent (paras 27-28).</p>	

Earlier sign	Case No
Up Way Systems – Representações Unipessoal LDA (Portuguese company name)	25/01/2013, R 274/2012-5
<p>Three invoices, addressed to companies in the Porto region of Portugal, for a total sales amount of EUR 16 314, are not sufficient to show that the sign was used in the course of trade, considering the price level of building materials and building services in general (paras 20-23).</p>	

3.3.2.3 Nature of the use

Use of a sign relied on under Article 8(4) EUTMR must be made in accordance with the essential function of such a sign. This means that if an opponent relies on a non-registered trade mark, proof of use of the sign as a company name would not be sufficient to substantiate the earlier right.

The following is an example where the evidence shows use of a sign whose function does not correspond to that of the sign relied on.

Earlier sign	Case No
JAMON DE HUELVA (Spanish trade name)	R 1714/2010-4

The proof furnished in order to substantiate the use of 'Jamón de Huelva' almost exclusively relates to the designation of origin 'Jamón de Huelva'. Designations of origin are very different legal concepts from trade names, as, instead of identifying a particular commercial origin, they are geographical indications relating to an agricultural or food product of which the quality or characteristics are fundamentally or exclusively due to the geographical environment in which they are produced, processed or prepared. The opposition based on the use in Spain of the trade name 'Jamón de Huelva' must be dismissed in view of the fact that the proof furnished does not relate to this legal concept and does not identify a specific commercial activity, but instead the activities relating to a designation of origin and the Supervisory Council thereof (paras 34-37).

The requirement that the sign must be used in trade for its own particular economic function does not exclude that the same sign might be used for several purposes.

It is common market practice to also use company or trade names as trade marks, either alone, or together with other product identifiers. This is the case when use of a 'house mark' is concerned, that is, an indication which usually coincides with the manufacturer's company or trade name and which not only identifies the product or service as such, but also provides a direct link between one or more product/service lines and a specific undertaking.

Therefore, depending on the specific circumstances of the case, in a case where an opponent relies on a non-registered trade mark, the use of the same sign as a company name or trade name may well also accomplish the function of indicating the origin of the goods/services concerned (thus, a trade mark function), as long as the sign is used in such a way that a link is established between the sign that constitutes the company or trade name and the goods marketed or the services provided (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 22-23).

As Article 8(4) EUTMR continues to apply to oppositions based on geographical indications filed before the entry into force on 23/03/2016 of Regulation (EU) 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trade mark, the opponent is still required to prove that the geographical indication is used in the course of trade of more than mere local significance (see paragraph 5.1 below). Use must be made in accordance with the essential function of such a sign, namely to guarantee to consumers in the course of trade the geographical origin of the goods and the special qualities inherent in them (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 147, 149.). Therefore, documents mentioning a geographical indication exclusively in a non-trade context are not sufficient for the purposes of Article 8(4) EUTMR.

3.4 Earlier right

The right invoked under Article 8(4) EUTMR must be earlier than the EUTM application. In order to determine which of the conflicting rights is earlier, the relevant dates on which the rights were obtained must be compared.

- For the EUTM application, this is the filing date or any priority date validly claimed (EUTM date). Seniority claims, even if they relate to the Member State where the other earlier right is claimed to exist, are not relevant.
- As regards the right falling under Article 8(4) EUTMR, the relevant date of acquisition of exclusive rights under the national law is decisive (07/05/2013, T-579/10, makro, EU:T:2013:232, where the Court confirmed the Board's rejection of evidence submitted by the invalidity applicant, which related to periods subsequent to the owner's application for the EUTM (§ 70).

Where mere use is sufficient under the national law, this must have begun before the EUTM date. Where recognition in the trade or reputation is required, this must have been acquired before the EUTM date. Where these conditions are fulfilled only after the EUTM date, the opposition will have to be rejected.

3.5 Right to prohibit the use of a subsequent trade mark under the applicable law

Earlier rights falling under Article 8(4) EUTMR are protected if they confer on their proprietors under the applicable law the right to prohibit use of a later trade mark.

This requires, firstly, a finding that under the applicable law, rights of the type involved, in the abstract, are exclusive rights enforceable by means of an injunction vis-à-vis later marks and, secondly, a finding that in the actual case under consideration the conditions for obtaining such injunctive relief, if the mark that is the subject of the opposed EUTM application were used in the territory in question, are present (scope of protection) (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 190). Both questions have to be answered in accordance with the applicable law.

3.5.1 The right of prohibiting use

Article 8(4) EUTMR explicitly requires a right that confers on its proprietor the right to prohibit use of a subsequent mark. The Office, however, applies the provision broadly, based on an interpretation oriented by its purpose, meaning that an opposition based on provisions of national law on the prohibition of a later registration would not be rejected automatically.

In several cases the General Court and the Boards of Appeal accepted that a provision prohibiting registration of a subsequent trade mark can be validly invoked within the opposition pursuant to Article 8(4) EUTMR.

Case No	Provision involved	Reasoning
21/10/2014, T-453/11, LAGUIOLE, EU:T:2014:901 (01/06/2011, R 181/2007-1)	Articles L 714-3 and L 711-4 of the French Intellectual Property Code	According to the Court 'it is not disputed that the right to obtain the annulment of a subsequent trade mark based on a business name encompasses a fortiori the right to oppose the use of that trade mark' (para. 37).
07/07/2010, T-124/09, Carlo Roncato EU:T:2010:290	Article 12(1)(b) of the Italian Industrial Property Code	The Court based its judgment on the national provision that allows 'to oppose the registration of a sign as a trade mark' (para. 21).
24/03/2015, R 619/2014-2, DOHRE (fig.) / DOHE, S.A.	Article 9(1)(d) of the Spanish trade mark law	The Board decided, that 'although Articles 90 and 9(1)(d) of Spanish trade mark law do not perhaps expressly provide the right to prohibit use of a later mark, they do provide it implicitly'. It would be absurd, in the presence of the conditions required by the articles in question, that the holder of a previous trade name has the right to oppose registration of a later mark but could not prohibit its use, taking into account that confusion occurs not with the register but in the market (para. 24).

Case No	Provision involved	Reasoning
09/07/2012, R 2100/2011-2, BELOW (fig.) / VODKA 42 (fig.)	Article 7(1)(g) of the Czech trade mark law	The Board based its decision on a national provision stating that holders of unregistered trade marks acquired through use have the right to 'prohibit subsequent trade marks', with the reasoning that unregistered trade marks acquired through use in the course of trade prior to the filing date of application for registration enjoy identical protection to that of a Czech registered mark (paras 40-41).
03/06/2015, R 2216/2014-2, Sonicell (fig.) / SONICEL et al.	Article 239(1) and (2) of the Portuguese Industrial Property Code	The Board based its decision on a national provision prohibiting registration of the subsequent mark. It stated that Portuguese law confers a right in relation to conflicting signs based on 'a business or corporate name and other distinctive signs', and the scope of protection of this earlier right is the same as for registered trade marks. In other words, it is a ground for refusal when cited in an opposition if it concerns a reproduction, imitation or merely a characteristic part thereof, and is likely to mislead or confuse the consumer. A confusingly similar Community trade mark application therefore falls within this definition (paras 34-35).

Case No	Provision involved	Reasoning
07/05/2013, R 1027/2012-2, RECICLALIA	Article 9(1)(d) of the Spanish trade mark law	The Board based its decision on the provisions of the Spanish Trade Mark Act, for which protection conferred on an unregistered Spanish trade name and the company name of a legal person entitles the proprietor thereof to oppose the registration of, or seek a declaration of invalidity for any subsequent Spanish trade names or trade marks (para. 37).
R 1529/2010-1, GLADIATOR / GLADIATOR	Article 7(1)(g) of Czech Act No 441/2003 Coll. of 3 December 2003 on trade marks	The Board based its decision on a provision according to which the registration of a trade mark will be refused upon opposition by a user of a non-registered sign or another sign used in the course of trade for identical or similar goods or services, that is identical or similar to the sign applied for, if the earlier sign does not have merely local significance and the right to that sign originated before the date of application for the trade mark in question (para. 19).

Several considerations support this approach: it can be argued that the right to prohibit registration of a later sign implies a fortiori the prohibition to use of that sign in the market. Registration may be seen as the first form or at least an indication of will to use a mark (the purpose of a distinctive sign is to identify goods or services and not to remain in the Register). The right to prohibit registration encompasses, therefore, the right to prohibit use. What is important is the fact that national law contains provisions that protect unregistered marks.

3.5.2 Scope of protection

For many, if not most of the rights falling under Article 8(4) EUTMR, the prerequisites of national regulations are quite similar to those applied in conflicts between trade marks that Office examiners are familiar with, namely, likelihood of confusion, or damage to reputation or distinctiveness.

For example, unregistered marks are generally protected against subsequent marks in the event of a likelihood of confusion and, thus, in accordance with the same criteria that are applicable to conflicts between registered marks, namely, identity or similarity of the signs, identity or similarity of the goods or services, etc. In these cases, the criteria developed by the courts and by the Office for applying Article 8(1) EUTMR may easily be transported into Article 8(4) EUTMR, unless the party claims that the relevant case-law of the national courts follows a different approach.

Where the applicable national law provides protection for unregistered trade marks that is different from that found in Article 8(1) EUTMR, the scope of protection of the earlier right invoked follows from national law. If, for example, the applicable national law also grants protection to unregistered marks for dissimilar goods and services under certain conditions, the same protection will be granted under Article 8(4) EUTMR.

4 Proof of the Applicable Law Governing the Sign

4.1 The burden of proof

According to Article 95(1) EUTMR, in all inter partes cases, the burden is on the party making a particular claim or allegation to provide the Office with the necessary facts and arguments in order to substantiate the claim. Unlike other grounds in Article 8 EUTMR, Article 8(4) EUTMR does not specify the conditions governing the acquisition and scope of protection of the earlier right invoked. It is a framework provision where the particulars of the applicable law must be provided by the opponent.

Article 7(2)(d) EUTMDR provides that if an opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, the opponent must provide, inter alia, evidence of its acquisition, continued existence and scope of protection, including where the earlier right is invoked pursuant to the law of a Member State, a clear identification of the contents of the national law relied upon by adducing publications of the relevant provisions or jurisprudence.

It follows from the law and it has been interpreted by the Court that the opponent must provide the content of the relevant national law and show that it would succeed under that national law in preventing the use of a subsequent trade mark.

In that regard, it should be observed that Article 8(4)(b) of Regulation No 40/94 [now Article 8(4)(b) EUTMR] lays down the condition that, pursuant to the law of the Member State governing the sign relied on under Article 8(4), that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Furthermore, in accordance with Article 74(1) of Regulation No 40/94 [now Article 95(1) EUTMR], the burden of proving that that condition is met lies with the opponent before the Office.

In that context and in relation to the earlier rights relied on ... regard must be had, in particular, to the national rules advanced in support of the opposition and to the judicial

decisions delivered in the Member State concerned and that, on that basis, the opponent must establish that the sign concerned falls within the scope of the law of the Member State relied on and that it allows use of a subsequent mark to be prohibited.

(29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 188-190.)

The Court held that in applications for a declaration of invalidity brought under Article 52(2) of Regulation No 40/94 [now Article 60(2) EUTMR], it is for the party who seeks to rely on an earlier right protected under national law

to provide the Office not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of an EU trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law.

(05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452, § 50; 27/03/2014, C-530/12 P, Mano, EU:C:2014:186, § 34.)

Although these judgments referred to invalidity proceedings under Article 52(2) of Regulation No 40/94 [now Article 60(2) EUTMR], since Article 8(4) EUTMR also concerns the application of earlier rights protected under European Union legislation or under the law of the Member State governing the sign at issue, the cited case-law also applies to oppositions brought under Article 8(4) EUTMR.

The information on the applicable law must allow the Office to understand and apply the content of that law, the conditions for obtaining protection and the scope of this protection, and allow the applicant to exercise the right of defence. It may also be particularly useful to submit evidence of relevant case-law and/or jurisprudence interpreting the law invoked.

The Office must effectively assess the applicability of the ground for refusal invoked. In order to ensure the correct application of the law invoked, the Office has the power to verify, by whatever means it deems appropriate, the content, the conditions governing the application and the scope of the provisions of the applicable law relied upon by the opponent (27/03/2014, C-530/12 P, Mano, EU:C:2014:186, § 44-46), while respecting the parties' right to be heard. If, after verifying the evidence submitted, the Office is of the opinion that the parties' proposed interpretation or application of the law invoked was inaccurate, it can introduce new and/or additional elements. In order to respect the parties' rights to be heard, the Office will invite the parties to comment on these elements, where appropriate.

This power of verification is limited to ensuring the accurate application of the law relied upon by the opponent. It does not therefore discharge the opponent from the burden of proof and it cannot serve to substitute the opponent in adducing the appropriate law for the purposes of its case (02/06/2014, R 1587/2013-4, GROUP, § 26; 30/06/2014, R 2256/2013-2, (+) ENERGY / ENERGETIX, § 26).

4.2 Means of evidence and standard of proof

Pursuant to Article 8(4) EUTMR, the applicable law may be the law of a Member State or European Union law.

4.2.1 National law

As regards national law, the opponent must provide:

1. the provisions of the applicable law:
 - on the conditions governing acquisition of rights (whether there is a requirement of use and, if so, the standard of use required; whether there is a registration requirement, etc.); and
 - on the scope of protection of the right (whether it confers the right of prohibition of use; the injury against which protection is provided, e.g. likelihood of confusion, misrepresentation, unfair advantage, evocation).
2. particulars proving fulfilment of the conditions:
 - of acquisition (entitlement; earlier acquisition; whether it is in force; evidence of use if use-based; evidence of registration if registration-based, etc.); and
 - of the scope of protection (facts, evidence and/or arguments that the requirements laid down by the applicable law for a prohibition of use are met, e.g. the nature of the goods, services or business activity protected by the earlier right and their relation with the contested goods or services; a cogent argument showing that there is a risk of injury).

First, as regards the provisions of the applicable law (see paragraph 4.2.1 a) above), the opponent must provide a clear identification of the contents of the national law relied upon by adducing publications of the relevant provisions or jurisprudence (Article 7(2)(d) EUTMDR). The opponent must provide the reference to the relevant legal provision (article number and the number and title of the law) and the content (text) of the legal provision by adducing publications of the relevant provisions or jurisprudence (e.g. excerpts from an official journal, a legal commentary, legal encyclopaedias or court decisions). If the relevant provision refers to a further provision of law, this must also be provided to enable the applicant and the Office to understand the full meaning of the provision invoked and to determine the possible relevance of this further provision. Where the evidence concerning the content of the relevant national law is accessible online from a source recognised by the Office, the opponent may provide such evidence by making a reference to that source (Article 7(3) EUTMDR) (see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2.4.3).

As the opponent is required to prove the content of the applicable law, it must provide the applicable law in the original language. If that language is not the language of the proceedings, the opponent must also provide a complete translation of the legal provisions invoked in accordance with the standard rules of substantiation (Article 7(4) EUTMDR, first sentence). However, a mere translation of the applicable law does not

itself constitute proof and cannot substitute the original; therefore, the translation alone is not considered sufficient to prove the law invoked. Article 7(4) EUTMDR requires any provisions of the applicable national law governing the acquisition of the rights and their scope of protection, including evidence accessible online to be submitted in the language of the proceedings or accompanied by a translation into that language, which must be submitted within the time limit specified for submitting the original document. The same rules apply where the opponent provides the content of the relevant national law by making reference to a relevant online source recognised by the Office.

Where the opponent seeks to rely on national case-law or jurisprudence interpreting the law invoked, it must provide the relevant information in sufficient detail (e.g. a copy of the decision invoked or excerpts from the legal literature). The translation rules apply equally to that evidence, including cases when the opponent provides such evidence by making reference to a relevant online source recognised by the Office.

Second, as regards the particulars proving fulfilment of the conditions of the applicable law (see paragraph 4.2.1 b) above), apart from providing appropriate evidence of acquisition of the right invoked, the opponent must submit evidence that the conditions of protection vis-à-vis the contested mark are actually met and, in particular, put forward a cogent line of argument as to why it would succeed in preventing the use of the contested mark under the applicable law. Merely providing the applicable law itself is not considered sufficient, as it is not up to the Office to make the relevant argument on behalf of the opponent.

Furthermore, in an opposition under Article 8(4) EUTMR, what matters is whether the relevant provisions of the law conferring on the opponent the right to prohibit the use of a subsequent trade mark would apply to the contested mark in the abstract, and not whether the use of the contested mark could actually be prevented. Therefore, the applicant's argument in defence that the opponent had not hitherto invoked or had not hitherto been able to prevent the actual use of the contested mark in the relevant territory cannot succeed (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 191, 193).

Based on the above, the Office will reject the opposition if:

- the opponent invokes a right but does not include a reference to any specific national law and/or legal provision protecting that right (e.g. the opponent only indicates that the opposition is based on a commercial designation in Germany or that the opposition based on a commercial designation in Germany is protected under DE-TMA); or
- the opponent provides a reference to the applicable national law and legal provision(s) but the reference is not complete: the legal provision only indicates the conditions governing the acquisition of the right but not the scope of protection of the right (or vice versa) (e.g. the opponent indicates that the opposition is based on a commercial designation in Germany protected under Article 5 DE-TMA, which establishes the conditions for acquisition of the right, but the reference to the conditions governing the scope of protection, Article 15 DE-TMA, is missing); or
- the opponent provides the reference to the relevant legal provision but does not provide the content (text) of the legal provision (e.g. the opponent's submission refers to the DE-TMA but does not include the content of the law); or

- the opponent provides the content of the legal provision only in the language of the proceedings but not in the original language (e.g. the language of the proceedings is English but the text of the DE-TMA is submitted only in English, not in German); or
- the opponent does not provide any or sufficient evidence of the acquisition of the right invoked or does not provide arguments as to why it fulfils the conditions governing the scope of protection (e.g. the opponent refers to the relevant legal provisions and provides their content both in the original language and translated into the language of the proceedings, but does not provide any or sufficient evidence of the acquisition of protection or does not state whether it fulfils the conditions of the scope of protection).

4.2.2 European Union law

The above requirements also apply to European Union law, except that the opponent is not obliged to provide the content (text) of the law invoked. However, the opponent has to provide particulars proving the fulfilment of the conditions under the relevant provisions of European Union law (paragraph 4.2.1. b) above).

5 Article 8(6) EUTMR — the Protection of Geographical Indications

The essential function of the protection of a geographical indication is to guarantee to the consumer the geographical origin of the goods and the special qualities connected therewith (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 147).

A geographical indication identifies a product originating in a particular geographical area, where a given quality, reputation or other characteristic of that product is essentially attributable to its geographical origin.

EU legislation distinguishes between 'protected designations of origin' (PDOs), where the quality or characteristics of the product are essentially or exclusively due to a particular geographical environment, and 'protected geographical indications' (PGIs), where a given quality, reputation or other characteristic of the product is essentially attributable to its geographical origin, without the stages of production, processing or preparation all necessarily taking place in the same area⁴³. In essence, PDOs have a closer link with the geographical area of production. The distinction, however, does not affect their scope of protection, which is the same for PDOs and PGIs. For the purposes of this chapter, the term 'geographical indication' (GI) is used to refer to both PDOs and PGIs in general.

For a general overview of geographical indications see the Guidelines, Part B: Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Designations of Origins and Geographical Indications (Article 7(1)(j) EUTMR).

⁴³ GIs for spirit drinks and aromatised wine products are protected under EU law as 'geographical indications', not as PGIs or PDOs.

5.1 Relationship between Article 8(4) and 8(6) EUTMR

Regulation (EU) 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trade mark (Amending Regulation) introduced Article 8(4a) of Regulation No 207/2009 [now Article 8(6) EUTMR] as a specific ground of opposition for GIs. Prior to that, GIs could form the basis of an opposition pursuant to Article 8(4) EUTMR as 'another sign used in the course of trade'. However, the introduction of this specific ground means that as of the entry into force of Article 8(4a) of Regulation No 207/2009⁴⁴ [now Article 8(6) EUTMR], GIs can only be invoked under the new ground. GIs can no longer form the basis of an opposition under Article 8(4) EUTMR, even though the wording of that provision has not changed.

However, if an opponent files an opposition based on a GI after entry into force of the Amending Regulation, in which it indicates incorrectly Article 8(4) EUTMR as a ground for opposition, the Office will examine the opposition, to the extent that it is clearly based on a GI, as if the ground invoked were Article 8(6) EUTMR. In such a case, the notice of opposition leaves no doubt as to the opponent's intention to invoke the ground for opposition protecting earlier GIs.

Oppositions based on GIs filed before the date of entry into force of Article 8(4a) of Regulation No 207/2009 [now Article 8(6) EUTMR] will continue to be assessed under the conditions of Article 8(4) EUTMR. In the absence of transitory provisions, Article 8(4a) of Regulation No 207/2009 [now Article 8(6) EUTMR] applies in oppositions filed on or after its entry into force, regardless of whether the contested EUTM application was filed, or had a date of priority before or after such entry into force.

Article 8(6) EUTMR reads:

Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

1. an application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, prior to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;
2. that designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark.

The new ground of opposition for GIs specifies this particular type of earlier right, its beneficiary and its date of priority. However, apart from those evident specificities, the only substantial difference between Article 8(4) and 8(6) EUTMR is that the latter does

⁴⁴ 23 March 2016.

not require the opponent to prove use in the course of trade of more than mere local significance.

The other conditions, namely, entitlement and proof of the applicable law, apply as explained in paragraphs 3.1 and 4 above, respectively.

The rest of this chapter addresses the particularities of GIs as a basis for opposition.

5.2 Types of GIs falling under Article 8(6) EUTMR

GIs are protected on various levels, under EU law, national law or international agreements, and cover various product areas such as foodstuffs or handicrafts.

5.2.1 GIs protected under EU law

At EU level, there is protection for GIs for the following categories of products:

1. certain foodstuffs and certain non-food agricultural products (pursuant to Regulation (EU) No 1151/2012⁴⁵, the 'Foodstuffs Regulation');
2. wines and sparkling wines (pursuant to Regulation (EU) No 1308/2013⁴⁶, the 'Wines Regulation');
3. spirit drinks (pursuant to Regulation (EC) No 110/2008⁴⁷, the 'Spirit Drinks Regulation'); and
4. aromatised wine products (pursuant to Regulation (EU) No 251/2014⁴⁸, the 'Aromatised Wines Regulation').

5.2.1.1 GIs covered by the EU Regulations

The Foodstuffs Regulation protects GIs that existed in Member States and have been applied for to be registered in the EU system of protection (in a simplified registration procedure) within a 6-month period between 24/07/1993 and 23/01/1994⁴⁹ (with similar application periods provided to any new Member State on accession) subject to its registration, and any further GIs applied for and registered pursuant to the EU system of protection thereafter.

The Wines Regulation protects GIs that were already protected in a Member State on 01/08/2009⁵⁰ (or on the date of accession of a new Member State) subject to further conditions⁵¹, and any further GIs applied for and registered pursuant to the EU system of protection thereafter.

⁴⁵ Replaced and repealed Regulation (EC) No 510/2006, which had replaced and repealed Regulation (EEC) No 2081/92.

⁴⁶ Replaced and repealed Regulation (EC) No 1234/2007, which had integrated, through codification by Regulation (EC) No 491/2009, Regulation (EC) No 479/2008, which was repealed at the same time.

⁴⁷ Replaced and repealed Regulation (EEC) No 1576/89.

⁴⁸ Replaced and repealed Regulation (EEC) No 1601/91.

⁴⁹ See Article 17(1), first sentence, of Regulation (EEC) No 2081/1992 (in the version effective before 24/04/2003).

⁵⁰ See Article 51(1) of Regulation (EC) No 479/2008, and after its codification, Article 118s(1) of Regulation (EC) No 1234/2007.

⁵¹ Namely, forwarding the technical files and the national decisions of approval to the Commission by 31/12/2011 and final scrutiny by the Commission by 31/12/2014 (see Article 51(2) to (4) of Regulation (EC) No 479/2008, and after

The Spirit Drinks Regulation protects GIs that were already protected in a Member State on 20/02/2008⁵² (or on the date of accession of a new Member State) subject to further conditions⁵³, and any further GIs applied for and registered pursuant to the EU system of protection thereafter.

The Aromatised Wines Regulation protects GIs that were already protected in a Member State on 27/03/2014⁵⁴ subject to further conditions⁵⁵, and any further GIs applied for and registered pursuant to the EU system of protection thereafter.

GIs protected under the above Regulations are, thus, 'existing GIs' from Member States that existed before the uniform EU system of protection (subject to further conditions of full EU protection) and 'new GIs' from Member States that have been applied for and registered under the uniform system of EU protection. Furthermore, GIs originating from third countries are also protected under the above Regulations pursuant to direct applications filed with the Commission (as an alternative to their protection through international agreements, discussed in paragraph 5.2.3 below).

5.2.1.2 Specifics of substantiation

GIs protected under the above Regulations may be a valid basis for an opposition under Article 8(6) EUTMR, to the extent that they allow the person authorised under the applicable law to exercise those rights to prevent the use of a subsequent mark. Their ability to prevent use is governed by the relevant provisions of the Regulations cited above (Articles 13(1), 103(2), 16 and 20(2) of the Foodstuffs, Wines, Spirit Drinks and Aromatised Wines Regulations, respectively). In this context, it is important to distinguish the latter provisions preventing use from those that prevent registration⁵⁶ of a trade mark, which are not a basis for opposition under Article 8(6) EUTMR.

In order to substantiate its right, the opponent must provide the Office with the necessary facts and evidence regarding the existence of its right. A mere extract of, or reference to, the relevant online EU databases (DOOR, E-Bacchus or E-Spirit-Drinks) or in the case of spirit drinks, an extract from Annex III to the Spirit Drinks Regulation, is not sufficient, as they do not contain sufficient data to determine all the relevant particulars of the earlier right (e.g. entitlement of the opponent or goods protected by the GI). For example, the E-Bacchus and E-Spirit-Drinks extracts/database, or Annex III to the Spirits Drinks Regulation merely indicate the country of origin of the GI, which is not sufficient to prove the opponent's entitlement.

Where available, the opponent must provide the Office with copies of the publication and registration of the GI in the Official Journal (or a reference to the relevant online source recognised by the Office, pursuant to Article 7(3) EUTMDR), and, if these

its codification, Articles 118s(2) to (4) of Regulation (EC) No 1234/2007 and subsequently, Article 107(3) of Regulation (EU) No 1308/2013).

⁵² See Article 20(1) of Regulation (EC) No 110/2008.

⁵³ Namely, forwarding the technical files to the Commission by 20/02/2015 (see Article 20(1) of Regulation (EC) No 110/2008).

⁵⁴ See Article 26(1) of Regulation (EU) No 251/2014.

⁵⁵ Namely, forwarding the technical files and the national decisions of approval to the Commission by 28/03/2017 and final scrutiny by the Commission by 28/03/2018 (see Article 26(2) to (4) of Regulation (EU) No 251/2014).

⁵⁶ Articles 14(1), 102(1), 23(1) and 19(1) of the Foodstuffs, Wines, Spirit Drinks and Aromatised Wines Regulations respectively.

documents are not available or lack information about the opponent's entitlement, further documents must be submitted proving entitlement to file the opposition as an authorised person under the relevant law to exercise the rights arising from a GI (Article 46(1)(d) EUTMR and Article 7(2)(e) EUTMDR) (17/10/2013, R 1825/2012-4, Dresdner Striezel-Glühwein / Dresdner Stollen, § 37). For example, until such time that the so-called single documents summarising the particulars of the GI are available in E-Bacchus and E-Spirit-Drinks, opponents seeking to rely on the relevant GIs must provide any means of proof to substantiate their entitlement and other relevant particulars of the GI, including national laws or administrative decisions granting GI protection in force at the time of the automatic extension of EU protection⁵⁷.

5.2.1.3 The exhaustive nature of the EU system of protection

The EU system of protection of GIs for foodstuffs, wines and spirit drinks is exhaustive in nature and supersedes national protection for those goods. This arises from the findings of the Court in the Budějovický Budvar case (08/09/2009, C-478/07, Budějovický Budvar, EU:C:2009:521, § 95-129). Here the Court held that the aim of Regulation (EC) No 510/2006 (the predecessor of the current Foodstuffs Regulation) was to provide a uniform and exclusive system of protection of GIs for agricultural products and foodstuffs that superseded national laws for the relevant products⁵⁸. Although the Court has not specifically pronounced upon the exhaustive nature of the Wines, Spirit Drinks and Aromatised Wines Regulations, the same principle must apply because they contain substantively similar provisions to the Foodstuffs Regulation and they have the same purpose for the respective products.

5.2.2 GIs protected under the laws of Member States

GIs protected under the laws of Member States may be a basis for opposition under Article 8(6) EUTMR only to the extent that no uniform EU protection is in place for the given category of goods. This is the case, for example, for handicraft products (e.g. 'HEREND' for porcelain goods originating from Herend, Hungary).

For the reasons set out above, in the areas of foodstuffs, wines, spirit drinks and aromatised wine products, protection at EU level is exhaustive in nature, which means that opposition under Article 8(6) EUTMR cannot be based on national rights in these areas. This is because the EU system of protection comprising the above Regulations overrides and replaces national protection of GIs for foodstuffs, wines, spirit drinks and aromatised wine products.

Consequently, GIs for certain foodstuffs⁵⁹ and certain non-food agricultural products⁶⁰ (as set out in Annex I to the Treaty on the Functioning of the European Union (TFEU)

⁵⁷ The date of automatic extension of EU protection of national GIs for wines occurred on 01/08/2009 (see Article 51(1) of Regulation (EC) No 479/2008, and after its codification, Article 118s(1) of Regulation (EC) No 1234/2007) and for spirit drinks, on 20/02/2008 (see Article 20(1) of Regulation (EC) No 110/2008).

⁵⁸ For additional information, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Designations of Origin and Geographical Indications (Article 7(1)(j) EUTMR).

⁵⁹ e.g. meat, cheese, pastry, edible oils, vegetables, fruits, beverages made from plant extracts, vinegar (including wine vinegar), unmanufactured tobacco, beer, confectionery.

and Annex I to the Foodstuffs Regulation), wines and grapevine products⁶¹ (as set out in Annex VII, part 2, to the Wines Regulation), spirit drinks⁶² (as set out in Annex II to the Spirit Drinks Regulation) and aromatised wine products⁶³ (as set out in Annex II to the Aromatised Wines Regulation) that may claim protection under national laws are not a proper basis for opposition under Article 8(6) EUTMR. For the latter products, the opponent must invoke the relevant EU legislation in the notice of opposition.

Article 8(6)(i) EUTMR requires proof of registration of the GI invoked. Accordingly, the opponent must submit the relevant registration certificate or equivalent documents emanating from the competent national registration authority. By way of analogy, this provision applies also to national GIs granted not in a registration procedure, but through other administrative means (such as a law or administrative decision granting protection). Such evidence may be provided by making reference to an online source recognised by the Office (Article 7(3) EUTMDR). The evidence must prove all the particulars of the GI, including its name, that it is protected as a GI, the goods covered, that it was acquired prior to the date of priority of the contested mark, proof of entitlement and proof that protection pursuant to national law confers on the beneficiary of the GI a direct right of action against unauthorised use. Further, pursuant to Article 7(2)(e) EUTMDR, where the earlier GI is invoked pursuant to the law of a Member State, the opponent must provide a clear identification of the content of the national law relied upon by adducing publications of the relevant provisions or case-law. It may provide such evidence by making a reference to a relevant online source recognised by the Office. The opponent must prove the conditions of the scope of protection and particulars proving that those conditions are fulfilled in the given case.

5.2.3 GIs protected under international agreements

Notwithstanding that Article 8(6) EUTMR does not explicitly mention GIs protected under international agreements, the reference to ‘Union legislation’ and ‘national law’ naturally includes international agreements as they form part of the legal order of the European Union or the Member State that is a party to the international agreement.

In order for an opposition under Article 8(6) EUTMR to be successful on the basis of a right deriving from any international agreement, the provisions under the international agreement must be directly applicable and they must allow the beneficiary of the relevant GI to take direct legal action to prohibit the use of a subsequent trade mark (see paragraph 3.1 above concerning the requirement of a direct right of action).

In the latter respect, international agreements are not always self-executing. This depends on the characteristics of the agreement itself and on how they have been interpreted in the relevant jurisdiction. For example, the Office considers that the provisions of the Lisbon Agreement (in particular Articles 3 and 8) are not self-executing. As expressly indicated by Article 8 of the Lisbon Agreement, it is the relevant national legislation that must determine which type of legal actions may be

⁶⁰ e.g. wool, leather, essential oils.

⁶¹ e.g. wine, sparkling wine, liqueur wine, wine must, but not wine vinegar.

⁶² e.g. grain spirit, wine spirit, fruit spirit, brandy, liqueurs, rum, whisky, gin.

⁶³ e.g. vermouth, Glühwein, sangria.

taken, their scope and whether these legal actions include allowing the proprietor of an appellation of origin to prohibit the use of a subsequent trade mark. Therefore, in such cases, the requisite national legislation must be adduced as this is a necessary component in order for the opponent to prove that the GI in question can prevent use of the subsequent mark and that the opponent is entitled by the law governing the right to exercise this right.

5.2.3.1 International agreements entered into by the EU

GIs deriving from agreements between the EU and third countries can be invoked under Article 8(6) EUTMR, if the provisions of these agreements vest the GI in a particular beneficiary or a precise class of users that have a direct right of action.

5.2.3.2 International agreements entered into by Member States including the Lisbon Agreement ⁶⁴

For the reasons set out in paragraph 5.2.1.3 above, a GI protected under an international agreement concluded by Member States (either among Member States or with third countries) cannot be invoked as an earlier right under Article 8(6) EUTMR if it encroaches upon the exhaustive nature of EU law in the relevant areas (currently certain foodstuffs and other agricultural products, wines, spirit drinks and aromatised wine products).

In the *Budějovický Budvar* case (08/09/2009, C-478/07, *Budějovický Budvar*, EU:C:2009:521), the Court discussed the exhaustive nature of EU law as regards GIs originating from Member States. In the Office's interpretation, this also applies a fortiori to third-country GIs in the relevant product fields that enjoy protection in the territory of a Member State through an international agreement concluded between that Member State and a non-EU country ⁶⁵.

This equally applies to the Lisbon Agreement. The Lisbon Agreement creates an international registration and protection system for 'appellations of origin' (Article 2(1)). The definition of 'appellations of origin' for food and beverage products under this Agreement is largely equivalent to that of a 'designation of origin' under the relevant EU regulations. Therefore, appellations of origin protected in a Member State by virtue of the Lisbon Agreement cannot be a basis for opposition under Article 8(6) EUTMR.

The only exceptions in this regard are the following.

- International agreements that cover GIs that do not relate to foodstuffs, wines, spirit drinks or aromatised wine products.
- International agreements concluded with third countries by a Member State before its accession to the EU. This is because the obligations arising out of an international agreement entered into by a Member State before its accession to the

⁶⁴ .Some Member States (Bulgaria, the Czech Republic, France, Hungary, Italy, Portugal and Slovakia) are party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 (as revised at Stockholm on 14/07/1967, and as amended on 28/09/1979). The European Union is not a signatory to the Lisbon Agreement.

⁶⁵ To which the EU is not a contracting party.

EU have to be respected. However, Member States are required to take all appropriate steps to eliminate the incompatibilities between an agreement concluded before a Member State's accession and the Treaty (see Article 307, Treaty establishing the European Community, now Article 351, Treaty on the Functioning of the European Union (TFEU), as interpreted by the Court in its judgment of 18/11/2003, C-216/01, *Budějovický Budvar*, EU:C:2003:618, § 168-172).

- International agreements concluded with a third country by a Member State after its accession to the EU, but before the entry into force of the uniform EU system of protection in the given product area.

As Member States are under an obligation to eliminate incompatibilities with EU law, the Office will apply the last two exceptions (which exclusively concern third country GIs in the fields of foodstuffs, wines, spirit drinks or aromatised wine products) only when the opponent expressly refers to the exception and supports it by a coherent line of argument and relevant evidence (in particular, concerning the date of entry into force of the cited international agreement in the EU Member State where protection is claimed and its continued validity). General allegations by the opponent (such as merely citing the relevant international agreement) will not be sufficient in themselves for the Office to consider that one of the latter two exceptions applies.

Although Article 8(6)(i) EUTMR requires registration of the GI, it can be applied by way of analogy to third-country GIs protected under international agreements. In the case of international agreements to which the EU is a party, the date of entry into force of the international agreement is deemed to be the date of priority of such a GI (and in the case of a third-country GI added subsequently to the list, the date of entry into force of the amendment), unless the international agreement stipulates an earlier date of priority.

5.3 Scope of protection of GIs

The scope of protection of GIs protected under EU law is governed by Articles 13(1), 103(2), 16 and 20(2) of the Foodstuffs, Wines, Spirit Drinks and Aromatised Wines Regulations, respectively. The provisions preventing registration, Articles 14(1), 102(1), 23(1) and 19(1) of the Foodstuffs, Wines, Spirit Drinks and Aromatised Wines Regulations respectively, are not a basis for opposition under Article 8(6) EUTMR (12/06/2007, T-60/04 – T-64/04, *Bud*, EU:T:2007:169, § 78); such an opposition cannot depend on whether the opponent fulfilled the conditions required to prohibit registration under the said provisions (18/09/2015, T-387/13, *COLOMBIANO HOUSE / CAFE DE COLOMBIA*, EU:T:2015:647, § 40 et seq.). Therefore, under Article 8(6) EUTMR, a GI can prevail if the conditions set out in the provisions preventing use are met.

It must be emphasised that it is the specific conditions of the scope of protection as laid down in the applicable provisions that apply and not, for example, the 'similarity of signs', 'similarity of goods and services' or 'likelihood of confusion'. Detailed information on the scope of protection of GIs protected under the relevant EU regulations is included in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for

Refusal, Chapter 10, Trade Marks in Conflict with Designations of Origin and Geographical Indications (Article 7(1)(j) EUTMR) (e.g. definitions of direct and indirect use, imitation, evocation, comparable products).

The provisions of the EU regulations preventing use contemplate situations where a GI can be invoked against goods or services that do not necessarily fall within the scope of objectionable goods and services under the ex officio examination of absolute grounds, subject to the conditions of the relevant provisions of the corresponding EU regulations.

For instance, under Articles 13(1)(a), 103(2)(a)(ii), 16(a) and 20(2)(a)(ii) of the Foodstuffs, Wines, Spirit Drinks and Aromatised Wines Regulations respectively, a GI can be invoked against products and services that would not be objectionable ex officio under absolute grounds, subject to proof of reputation of the GI in the EU and proof that the use of the contested mark in relation to the contested goods and services would exploit the reputation of the GI. The mere existence of protection as a GI and references to its reputation in the registration documents, even if such a reputation had been a factor in granting GI protection, is not sufficient; independent and conclusive evidence attesting to the reputation of the GI within the European Union is required for the purposes of applying the wider scope of protection. As regards the standard of proof, the territorial and temporal scope of reputation, the standards for assessment of the reputation of an EUTM are applicable by way of analogy (with the obvious difference that any use must be in accordance with the function of a GI and not a trade mark). As regards the specific condition of 'exploitation of reputation', the established standards for assessment of the link between the signs and taking unfair advantage of the reputation of a trade mark are applicable by way of analogy (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR)).

The scope of protection of GIs protected under national law or international agreements is governed by the relevant provisions. (e.g. for the abovementioned Hungarian GI 'HEREND', Article 109 of Act XI of 1997 on the protection of trade marks and geographical indications.)

Nevertheless, either under EU or national legislation, the scope of protection of GIs cannot exceed what is required in order to safeguard the function of the GI; the function in question is to designate goods as being from a particular geographic origin and the special qualities connected therewith. Unlike other signs, GIs are not used to indicate the commercial origin of goods and they afford no protection in this regard. Therefore, where the specification of an EUTM application is limited to goods in conformity with the specification of the relevant protected GI, the function of the GI in question is safeguarded in relation to those products because the EUTM application only covers products from the particular geographic origin and the special qualities connected therewith. Consequently, opposition against an EUTM application that has been appropriately limited will not succeed. See in this regard Article 12(1) of the Foodstuffs Regulation or Article 103(1) of the Wines Regulation.