

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

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

### ***Part C***

#### ***Opposition***

##### ***Section 4***

### ***Non-registered trade marks and other signs used in the course of trade (Article 8(4) EUTMR)***

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## 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 the directives that preceded it 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.

## 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-propietorial 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.

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
  - company 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 States <sup>(72)</sup> 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 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 the opposition upheld on that basis; 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\(4\)](#)

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<sup>72</sup> Benelux, 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](#)).


[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<br>(copyright)  | 22/06/2010,<br><a href="#">T-255/08</a> , EU:T:2010:249 |
| The Court found that copyright cannot constitute a ‘sign used in the course of trade’ within the meaning of <a href="#">Article 8(4) EUTMR</a> . It is apparent from the scheme of Article 52 of Regulation No 40/94 [now <a href="#">Article 60 EUTMR</a> ] that copyright is not such a sign. Article 52(1)(c) of Regulation No 40/94 [now <a href="#">Article 60(1)(c) EUTMR</a> ] provides that a European Union trade mark is to be declared invalid where there is an earlier right as referred to in <a href="#">Article 8(4) EUTMR</a> and the conditions set out in that paragraph are fulfilled. Article 52(2)(c) of Regulation No 40/94 [now <a href="#">Article 60(2)(c) EUTMR</a> ] provides that a 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. <b>It follows that copyright is not one of the earlier rights referred to in <a href="#">Article 8(4) EUTMR</a>.</b> |   |

| Earlier right  | Case No  |
|--|--|
| Dr. No<br>(copyright)  | 30/06/2009, <a href="#">T-435/05</a> , EU:T:2009:226 |
| [...] the protection provided for by <b>copyright cannot be relied on in opposition proceedings</b> , but only in proceedings for a declaration of invalidity of the European Union trade mark in question (para. 41). |  |

| Earlier rights | Case No |
|----------------|---------|
|----------------|---------|

|  |  |
|--|--|
|  <p>and</p> <p>(Community designs)</p>  | <p>07/09/2010, <a href="#">B 1 530 875</a></p> |
| <p>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. <b>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 <a href="#">Article 8(4) EUTMR</a>.</b></p> |  |

### 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 Company names

A 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.

### 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   | 29/03/2011, <a href="#">C-96/09 P</a> , EU:C:2011:189 |
| <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 <b>acquisition</b> of the right had to take place before filing of the EUTM application but not its <b>use</b>. The Court applied the same temporal condition as to the acquisition of the right and concluded that use had to take place <b>before</b> 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  |
|---|--|
| BAMBOLINA<br>(non-registered mark in a number of MS)  | 30/07/2010, <a href="#">3 728 C</a><br>(confirmed 03/08/2011, <a href="#">R 1822/2010-2</a> ;<br>23/10/2013, <a href="#">T-581/11</a> , 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, <a href="#">3 728 C</a>, 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 <a href="#">Article 7(1) and (2)(d) EUTMDR</a>] state that where an opposition is based on <a href="#">Article 8(4) EUTMR</a>, 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 <i>mutatis mutandis</i> to cancellation proceedings (03/08/2011, <a href="#">R 1822/2010-2</a>, 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<br>(Portuguese name of establishment)  | 07/02/2010,<br><a href="#">R 693/2011-2</a> |
| Under <a href="#">Article 8(4) EUTMR</a> , 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 <a href="#">Article 8(4) EUTMR</a> (paras 20-26). |   |

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<br>(German company name) | 09/07/2010, <a href="#">T-430/08</a> , EU:T:2010:304 |

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).

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<br>(film title, claimed to have been used in the course of trade in, inter alia, Germany)  | 20/04/2010,<br><a href="#">R 526/2008-4</a> |
| 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 <a href="#">Article 8(4) EUTMR</a> (para. 26). |   |

| Earlier sign                           | Case No                                  |
|--|--|
| 'lucky-pet.de'<br>(German domain name) | 07/12/2011, <a href="#">R 275/2011-1</a> |



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](http://www.lucky-pet.de). However, they do not prove that the website [www.lucky-pet.de](http://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).

### 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 example, both the geographic and the economic dimension of use of the sign were found to meet the standards.

| Earlier sign  | Case No                                   |
|---|---|
| GLADIATOR<br>(non-registered trade mark in the Czech Republic)  | 17/03/2011, <a href="#">R 1529/2010-1</a> |
| 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', 'Pelhrimov', '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). |   |

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<br>(Portuguese establishment name) | 24/03/2009, <a href="#">T-318/06</a> – <a href="#">T-321/06</a> , EU:T:2009:77 |



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, <a href="#">R 354/2009-2</a> |
| FORTRESS INVESTMENT GROUP  | 08/03/2011, <a href="#">R 355/2009-2</a> |
| (non-registered trade marks in the UK)   |  |
| <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) | 09/07/2010, <a href="#">T-430/08</a> , EU:T:2010:304 |

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  |
|---|--|
| <p>BRIGHTON</p> <p>(non-registered marks in the United Kingdom, Ireland, Germany and Italy)</p>   | <p>30/06/2010,</p> <p><a href="#">R 408/2009-4</a></p> <p>(confirmed 27/09/2011, <a href="#">T-403/10</a>, EU:T:2011:538, § 38-40; dismissed 27/09/2012, <a href="#">C-624/11 P</a>, EU:C:2012:598, § 40-50)</p> |
| <p>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).</p> |  |

| Earlier sign  | Case No  |
|---|--|
|  <p>(Greek non-registered mark)</p>  | <p>01/06/2011,</p> <p><a href="#">R 242/2010-1</a></p> |
| <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<br>(Portuguese company name)   | 25/01/2013,<br><a href="#">R 274/2012-5</a> |
| 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). |   |

### 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<br>(Spanish trade name)  | 16/08/2011, <a href="#">R 1714/2010-4</a> |
| 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**. 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](#) requires a right that confers on its proprietor the right to prohibit **use** of a subsequent mark. Therefore, the opponent should invoke and submit those provisions of law that could be relied on in an action for infringement to prevent unauthorised use.

However, provisions of law prohibiting or invalidating the **registration** of a later sign may also be accepted. The right to oppose the registration of a later sign, implicitly, encompasses the right to oppose use of that sign. By opposing the registration of a later mark, the proprietor of the earlier right seeks effective protection against any future use of that mark. The concept of ‘the right to prohibit the use of a subsequent trade mark’ encompasses the case in which the owner of a sign has, under the applicable law, the power to prevent that use through an invalidity action against a subsequent trade mark (21/10/2014, [T-453/11](#), Laguiole, EU:T:2014:901, § 37; 24/10/2018, [T-435/12](#), 42 BELOW (FIG. MARK) / VODKA 42 (FIG. MARK), EU:T:2018:715, § 98-102; 19/04/2018, [C-75/17P](#), PALLADIUM PALACE IBIZA RESORT & SPA (fig.), EU:C:2018:269, § 60).

### 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\(2\)\(d\) EUTMR](#) 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, or request clarification or supplementary evidence to that effect from the opponent (25/11/2020, [T-57/20](#), GROUP Company TOURISM & TRAVEL (fig.) / GROUP Company TOURISM & TRAVEL (fig.) et al., ECLI:EU:T:2020:559, § 34). 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 (02/12/2020, [T-35/20](#), DEVICE OF CLAW-LIKE SCRATCH (fig.) / DEVICE OF A CLAW-LIKE SCRATCH (fig.), EU:T:2020:579, § 79-85; 28/04/2021, [T-284/20](#), HB Harley Benton (fig.) / HB et al., EU:T:2021:218, § 139-144).

## 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](#)), 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, Opposition proceedings, paragraph 4.2.4.3](#)).

A mere reference to the case-law on which the applicant intends to rely in support of its argument in order to demonstrate the content of the legislation and the applicable case-law is insufficient to fulfil the obligations arising from [Article 7\(2\)\(d\) EUTMDR](#) (02/12/2020, [T-35/20](#), DEVICE OF CLAW-LIKE SCRATCH (fig.) / DEVICE OF A CLAW-LIKE SCRATCH (fig.), EU:T:2020:579, § 81).

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](#)), 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).