



Reports of Cases

OPINION OF ADVOCATE GENERAL
MENGOZZI
delivered on 16 February 2012¹

Case C-100/11 P

**Helena Rubinstein SNC
and
L'Oréal SA
v**

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

(Appeal — Community trade mark — Trade mark which has a reputation for the purposes of Article 8(5) of Regulation No 40/94 — Conditions governing protection — Invalidity proceedings — Rule 38 of Regulation No 2868/95 — Obligation to produce, in the language of the proceedings, the documents supporting the application for a declaration of invalidity — Decisions of the Boards of Appeal of OHIM — Review by the Courts (Article 63 of Regulation No 40/94) — Duty to state reasons (Article 73 of Regulation No 40/94))

1. The present case concerns the appeal brought by Helena Rubinstein SNC and L'Oréal SA ('Helena Rubinstein' and 'L'Oréal'; or, collectively, 'the appellants') against the judgment by which the General Court dismissed the actions which they had brought against the decisions of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) declaring invalid Community trade marks which they own: BOTOLIST and BOTOCYL.

I – Background to the dispute, proceedings before the General Court and the judgment under appeal

2. The facts and the procedure before OHIM, as described in the judgment under appeal, are reproduced briefly as follows.

3. On 6 May 2002 and 9 July 2002 respectively, Helena Rubinstein and L'Oréal filed an application with OHIM for registration of Community trade marks under Regulation No 40/94, as amended.² They sought to register the word signs BOTOLIST (Helena Rubinstein) and BOTOCYL (L'Oréal) for goods in Class 3 of the Nice Agreement,³ including, in particular, cosmetics such as creams, milks, lotions, gels and powders for face, body and hands. The Community trade marks BOTOLIST and BOTOCYL were registered on 19 November 2003 and 14 October 2003 respectively. On 2 February 2005, Allergan, Inc. ('Allergan') filed an application with OHIM for a declaration of invalidity, in respect of both marks, on the basis of various earlier Community and national figurative and word

¹ — Original language: Italian.

² — Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1). With effect from 13 April 2009, Regulation No 40/94 was replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

³ — Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957.

marks having the sign BOTOX as their subject and registered between 12 April 1991 and 7 August 2003, chiefly for goods in Class 5 of the Nice Agreement, including — in so far as is relevant for present purposes — pharmaceutical preparations for the treatment of wrinkles. The applications were based on Article 52(1)(a) of Regulation No 40/94, read in conjunction with Article 8(1)(b) and Article 8(4) and (5) of that regulation. By decisions of 28 March 2007 (BOTOLIST) and 4 April 2007 (BOTOCYL), the Cancellation Division of OHIM rejected the applications for a declaration of invalidity. On 1 June 2007, Allergan filed a notice of appeal against those decisions under Articles 57 to 62 of Regulation No 40/94. By decisions of 28 May 2008 (BOTOLIST) and 5 June 2008 (BOTOCYL), the First Board of Appeal of OHIM upheld the appeals brought by Allergan in so far as they were based on Article 8(5) of Regulation No 40/94 ('the contested decisions').

4. Helena Rubinstein and L'Oréal brought actions for the annulment of those decisions before the General Court. In support of their actions, they raised two pleas in law: (i) infringement of Article 8(5) of Regulation No 40/94 and (ii) infringement of Article 73 of Regulation No 40/94. OHIM lodged a response in both cases, contending that the actions should be dismissed and the applicants ordered to pay the costs. Allergan did not defend those actions.

5. The General Court joined the proceedings and, by judgment of 16 December 2010 ('the judgment under appeal'), dismissed both actions and ordered Helena Rubinstein and L'Oréal to pay the costs.⁴ The judgment under appeal was notified to Allergan, as well as to Helena Rubinstein, L'Oréal and OHIM.

II – Procedure before the Court of Justice

6. By application lodged at the Court Registry on 2 March 2011, Helena Rubinstein and L'Oréal appealed against that judgment. The appeal was notified to OHIM and to Allergan, which contended in their respective responses that the Court should dismiss the appeal and order the appellants to pay the costs. At the hearing on 11 January 2012, oral argument was put forward by the representatives of Helena Rubinstein, L'Oréal and Allergan, and by the agent of OHIM.

III – Appeal

7. In support of their appeal, Helena Rubinstein and L'Oréal rely on four grounds: (i) infringement of Article 52(1) of Regulation No 40/94, read in conjunction with Article 8(5) thereof; (ii) infringement of Article 115 of Regulation No 40/94 and Rule 38(2) of Regulation No 2868/95; (iii) infringement of Article 63 of Regulation No 40/94; and (iv) infringement of Article 73 of Regulation No 40/94.

A – First ground of appeal: infringement of Article 52 of Regulation No 40/94, read in conjunction with Article 8(5) thereof

8. Paragraph 1(a) of Article 52 of Regulation No 40/94, which is entitled 'Relative grounds for invalidity', provides that '[a] Community trade mark shall be declared invalid on application to [OHIM] ... where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in ... paragraph 5 of that Article are fulfilled'. Paragraph 5 of Article 8 of Regulation No 40/94, which is entitled 'Relative grounds for refusal', provides that, upon opposition by the proprietor of an earlier trade mark, 'the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade

⁴ — Joined Cases T-345/08 and T-357/08 *Rubinstein v OHIM-Allergan* (BOTOLIST).

mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.'

9. By their first ground of appeal, Helena Rubinstein and L'Oréal take issue with the judgment under appeal in so far as the General Court found that the earlier trade marks have a reputation and concluded that use of the appellants' marks without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier marks. That ground of appeal is presented as four complaints.

1. First complaint

a) Arguments of the parties and the judgment under appeal

10. In support of the first complaint, Helena Rubinstein and L'Oréal submit that the General Court erred in law in basing its appraisal on two earlier marks registered in the United Kingdom, which had not been taken into consideration by the Board of Appeal. They argue that the Board of Appeal based its findings solely on the earlier Community figurative and word mark, No 2015832, registered on 12 February 2002 ('the earlier Community trade mark' or 'the Community trade mark BOTOX'). OHIM interprets the first complaint as a claim alleging distortion of the facts which is not, however, evident from the documents in the file. OHIM also contends that the appellants did not state how the choice of earlier trade marks to be taken into consideration had any effect on the resolution of the dispute. According to Allergan, the complaint is unfounded since it is clear from the contested decisions that the Board of Appeal based its findings on all the earlier rights relied on in support of the applications for a declaration of invalidity.

11. The first complaint is directed at paragraphs 38 to 40 of the judgment under appeal. In paragraph 38, the General Court notes, as a preliminary point, that the applications for a declaration of invalidity submitted to OHIM are based on a number of national and Community figurative and word marks containing the sign BOTOX, almost all of which were registered before the marks applied for, BOTOLIST and BOTOCYL, were filed. It points out that all those trade marks — and not merely the earlier Community trade mark — constitute the earlier marks relied on by Allergan, the applicant for a declaration of invalidity. In paragraph 39, the General Court observes that the Board of Appeal 'implicitly but necessarily' took a different approach from that taken by the Cancellation Division, which had based its decisions solely on the earlier Community trade mark. According to the General Court, that approach on the part of the Board of Appeal is illustrated by the fact that it does not refer, in the contested decisions, to the figurative element of the earlier Community trade mark. In paragraph 40 of the judgment under appeal, the General Court stated that its examination of the various earlier rights relied on would be limited to the two marks registered in the United Kingdom⁵ and, as justification for that choice, stated that most of the evidence submitted by Allergan concerned the territory of that Member State.

b) Appraisal

12. I would point out, first, that the definition of the earlier rights to be taken into consideration for the purposes of assessing whether the conditions relating to reputation, laid down in Article 8(5) of Regulation No 40/94, are satisfied is not without effect on the outcome of that examination. The Community trade mark BOTOX, which — according to Helena Rubinstein and L'Oréal — is the only

⁵ — Registrations No 2255853 and 2255854. They are national marks which, of those on which Allergan relies, were registered earlier, inter alia for pharmaceutical preparations for the treatment of wrinkles.

earlier right taken into account by the Board of Appeal, was registered just a few months before the applications for registration of the marks BOTOCYL and BOTOLIST were filed.⁶ Accordingly, it is less easy to prove that that trade mark had acquired a reputation by that time than it is in the case of the national trade marks considered by the General Court.⁷

13. That said, I would observe that the arguments which the appellants put forward in the context of the complaint under consideration are no more than statements of the obvious, devoid of anything to corroborate their argument that the Board of Appeal — like the Cancellation Division — based its appraisal solely on the earlier Community trade mark. Moreover, that argument appears to be contradicted, or at least not to be supported, by the wording of the contested decisions, in which the Board of Appeal refers generally to the 'mark BOTOX' to denote all the rights invoked by Allergan. That, in my view, is made sufficiently clear in paragraph 3 of the contested decisions, in which, after listing the Community and national marks on which Allergan relies, the Board of Appeal sets out the arguments put forward by Allergan, referring to the 'mark BOTOX' as including national, Community and international registrations.⁸ Later in the decisions, the Board of Appeal refers repeatedly to the 'mark BOTOX', both when rehearsing Allergan's arguments and when setting out its own reasons (see, for example, paragraph 34 of the Helena Rubinstein decision and paragraph 35 of the L'Oréal decision). Furthermore, in paragraph 23 of those decisions, the Board of Appeal states *that 'la marque contestée ... est à comparer avec la marque BOTOX, enregistrée sous différentes versions (verbale, figurative, accompagnée de la légende "Botulinum Toxin").'* That statement is incompatible with the appellants' claim — that the Board of Appeal, like the Cancellation Division, took account solely of Community trade mark No 2015832 — since it is both a word and a figurative mark and is not accompanied by any caption. At that point in the contested decisions, the Board of Appeal clearly refers to all the rights invoked by Allergan and not only to the mark mentioned by Helena Rubinstein and L'Oréal. Lastly, as both OHIM and Allergan point out, the fact that the General Court did not take any account of the figurative element of the Community trade mark in assessing the similarity of the marks under comparison militates against the appellants' argument.

14. On the basis of the considerations set out above, I consider that the first complaint under the first ground of appeal should be dismissed.

2. Second complaint: reputation of the earlier marks

15. By the second complaint, Helena Rubinstein and L'Oréal claim that the General Court made various errors in law by concluding that proof had been furnished of the reputation of the earlier marks. Those criticisms — the admissibility or merits of which OHIM and Allergan contest on the basis of largely convergent arguments — are examined separately below.

a) The relevant public

16. First, the appellants argue that, although it is common ground that the relevant public is composed of health professionals and actual or potential users of BOTOX therapy, the General Court failed to assess the reputation of the earlier marks separately in relation to those two categories.

17. In that respect, it must above all be made clear that, according to the finding made by the General Court in paragraph 26 of the judgment under appeal, the parties agree that the relevant public is composed here of the *general public* (and thus not merely, as Helena Rubinstein and L'Oréal argue, of actual or potential users of BOTOX treatments) and of health professionals. In those circumstances, it

6 — A little under three months in the case of the mark BOTOLIST and a little over five months in the case of BOTOCYL.

7 — Registered on 14 December 2000.

8 — The relevant passages are worded as follows: '*la demanderesse en nullité a expliqué que la marque BOTOX identifie un produit pharmaceutique vendu sous prescription, fabriqué à partir de la toxine botulique ...'* 'Elle a indiqué que sa marque a été enregistrée aux Etats-Unis en 1991, qu'elle est utilisée dans l'Union européenne depuis 1992 et qu'elle est enregistrée dans la plupart des pays du monde ...'

does not seem to me that the appellants' argument can succeed, primarily for the obvious reason — accepted by both OHIM and Allergan — that a separate assessment, for each category, of the reputation of the earlier marks did not appear necessary, as the category of 'health professional' is covered by the more general category of the 'general public'. In any event, contrary to the assertions made by the appellants, the General Court did draw the distinction when, in reviewing the evidence produced by Allergan in support of its application for a declaration of invalidity, it carried out a separate examination of the evidence intended to show the reputation of the earlier marks with the general public (media coverage in the general-interest press) and that intended to show such reputation in specialist medical circles (promotional activity through the publication of articles in specialist journals).

b) The relevant territory

18. Secondly, Helena Rubinstein and L'Oréal argue that, in common with the contested decisions, the judgment under appeal contains no findings concerning the territory in respect of which the reputation of the BOTOX marks was assessed.

19. That criticism, too, has no basis in fact. Contrary to the assertions made by the appellants, the General Court made it clear, in paragraphs 40 and 41 of the judgment under appeal, that the conditions laid down in Article 8(5) of Regulation No 40/94 would be examined in the light of the perception of consumers in the United Kingdom, since that was the territory in respect of which Allergan had produced most evidence.

c) Evidence of reputation

20. Thirdly, the appellants submit that the General Court made a number of errors in assessing the evidence produced for the purposes of establishing the reputation of the earlier marks. Before turning to consider the individual allegations, it is relevant to observe that in the judgment under appeal the General Court examined that evidence separately in order to respond to the various arguments by which Helena Rubinstein and L'Oréal were contesting its admissibility, relevance or evidential value. However, as OHIM and Allergan have correctly pointed out, it is clear from the grounds of the judgment under appeal that the conclusions which the General Court reaches as to the reputation of the earlier marks are based on an assessment of all the evidence and, accordingly, even if the Court of Justice were to hold that the arguments on one item or other of that evidence were well founded, that would not necessarily invalidate those conclusions, as it is still necessary to determine the weight, in the overall assessment carried out by the General Court, of the evidence to be disregarded. No reference to this is made in the appeal.

21. That said, it should also be noted, as a preliminary point, that the essential purpose of some of the submissions made by the appellants is to bring about a re-examination of the evidence, which — save where the clear sense of the evidence has been distorted — the Court of Justice does not have jurisdiction to carry out in appeal proceedings.⁹ For those reasons, the arguments which the appellants put forward in order to contest the evidential value of the *data relating to the volume of sales in the United Kingdom* of the goods covered by the earlier marks (paragraphs 46 and 47 of the judgment under appeal) and of the *articles published in scientific journals* (paragraphs 48 and 49 of the judgment under appeal) are, in my view, inadmissible.

22. As regards the evidence examined by the General Court in paragraphs 50 to 54 of the judgment under appeal, which consists of certain *articles published in Newsweek and The International Herald Tribune*, the appellants argue that, in order to avoid *distorting* that evidence, it should have been considered together with further evidence such as the 'distribution area' of those publications. The appellants also allege

⁹ — See Case C-551/03 P *General Motors v Commission* [2006] ECR I-3173, paragraph 52; judgment of 22 May 2008 in Case C-266/06 P *Evonik Degussa v Commission*, paragraph 73; and Case C-419/08 P *Trubowest Handel and Makarov v Council and Commission* [2010] ECR I-2259, paragraph 31.

distortion of the evidence as regards a *market survey carried out in September and October 2004 in the United Kingdom* and produced by Allergan as an annex to the appeals before the Board of Appeal of OHIM. More specifically, the appellants contest the relevance of that survey in the absence of evidence, which it was for Allergan to furnish, that the data reported in that survey were capable of providing information on the situation existing on the date on which the applications for registration of the contested marks were filed. Lastly, the appellants allege *distortion of the facts* to contest the relevance of the evidence, examined in paragraphs 55 and 56 of the judgment under appeal, consisting in the *inclusion of the word BOTOX in various dictionaries* published in the United Kingdom.

23. As regards all the claims set out in the preceding point, I would observe that, according to settled case-law, distortion of the facts must be obvious from the documents in the case-file, without there being any need to carry out a new assessment of the facts and the evidence.¹⁰ In the present case, far from meeting the stringent standard of proof required to establish distortion of the evidence or the facts by the General Court, the arguments put forward by Helena Rubinstein and L'Oréal in the appeal are no more than statements so general and unsubstantiated as to cast doubt on their own admissibility, since they fail to satisfy the requirements regarding the clarity and precision with which grounds of appeal must be framed.

24. Lastly, the appellants contest the relevance of the *decision of 26 April 2005 of the United Kingdom Intellectual Property Office*, given in proceedings brought by Allergan for cancellation of the registration of the mark BOTOMASK for cosmetics in the United Kingdom. They maintain that a decision adopted in different proceedings, brought by different parties, cannot constitute evidence in the dispute between them and Allergan. In basing its findings on that decision, the General Court erred in law.

25. Those claims should, in my view, be rejected as unfounded. Although, according to settled case-law, the General Court is not bound by the content of decisions of national judicial or administrative bodies, the fact remains that, where such decisions are submitted by the parties, the findings contained therein may, where relevant, be taken into account by the General Court for the purposes of assessing the facts, as evidence which it is free to appraise. The fact that the decisions were given in connection with disputes in which the parties and the matters at issue were different from those in the dispute pending before the General Court is immaterial in that regard. I also note that the appellants have not put forward any argument to contest the correctness of the findings made in that decision of the United Kingdom Intellectual Property Office, either before OHIM or before the General Court, as is clear from paragraph 58 of the judgment under appeal. Nor do the appellants contest, in the present proceedings, the correctness of the interpretation which the General Court placed on the content of that decision.

d) Conclusion on the second complaint

26. In the light of the foregoing, I consider that the second complaint under the first ground of appeal should be rejected in its entirety.

3. Third complaint: existence of a link between the earlier marks and the appellants' marks

27. By the third complaint under the first ground of appeal, the appellants contest the finding made in the judgment under appeal that the relevant public will establish a link between the earlier marks BOTOX and the marks BOTOLIST and BOTOCYL, which the appellants own. According to the appellants, such a link cannot, in particular, be based on the common element 'BOT' or 'BOTO', since that is a descriptive element which refers to the botulinum toxin. The appellants claim the right to include that element, which is used in general to indicate the toxin in question, in their mark without being accused, on that ground, of attempting to link their marks with Allergan's marks.

10 — See *General Motors*, paragraph 54; *Degussa*, paragraph 74; and *Trubowest Handel and Makarov v Council and Commission*, paragraph 32.

28. In so far as they are seeking to obtain from the Court of Justice a ruling on the purportedly distinctive character of the mark BOTOX or of its components, the arguments on which the appellants rely are in any event inadmissible in that they entail an assessment of the facts by the Court. On the other hand, a point of law was raised by the argument that the appellants are entitled to use in their own marks an element shared by a different mark where that element has descriptive character. However, that argument is based on the claim that the element BOT or the element BOTO — common to the appellants' marks and the earlier marks — does in fact have distinctive character, a claim which not only is absent from the judgment under appeal,¹¹ but was expressly contradicted in the contested decisions¹² and which, as I have just noted, the Court of Justice does not have jurisdiction to revisit.

29. In the light of the foregoing, the third complaint under the ground of appeal should, in my view, be rejected.

4. Fourth complaint: damage caused to the earlier marks

30. In the context of their first ground of appeal, the appellants contest, lastly, the grounds set out in paragraphs 87 and 88 of the judgment under appeal concerning the 'effects of the use' of the marks at issue. Before explaining the substance of those criticisms, it is appropriate to summarise, in accordance with the case-law as it currently stands, the principles underlying the protection of trade marks which have a reputation, especially in the case of 'parasitism', which is the issue which arises in the present case.

31. So far as is relevant for present purposes, those principles were laid down by the Court of Justice in three preliminary rulings — in *Intel*, *L'Oréal* and *Interflora*¹³ — on the interpretation of Articles 4(4)(a) and 5(2) of Directive 89/104, which lay down, as we know, provisions similar to that made under Article 8(5) of Regulation No 40/94. As will become clearer below, the circumstances of the present case do not require a detailed examination of those rulings or consideration of the merits of the choices made by the Court, which inevitably attracted criticism, especially from academic legal writers across the Channel in that they were deemed to be excessively favourable to the owners of trade marks with a reputation.¹⁴ It is sufficient for present purposes to recall, generally, that in those judgments the Court of Justice made it clear that the specific condition for the protection which the above provisions of Directive 89/104 grant to trade marks which have a reputation consists in 'a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark'.¹⁵ The resulting damage to the earlier trade mark is, according to the Court, 'the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them'.¹⁶ The existence of such a link in the mind of the relevant public constitutes a condition which is necessary but not, of itself, sufficient to support the conclusion that the conditions for the protection

11 — Before the General Court, Helena Rubinstein and L'Oréal contested the Board of Appeal's appraisal on the ground that it had compared the marks in question by taking into consideration the prefix BOTO and not the syllable BOT which had distinctive character since it referred obviously and clearly to the active ingredient of the pharmaceutical preparation marketed under the mark BOTOX (the botulinum toxin). The General Court responded to that argument in paragraphs 72 and 73 of the judgment under appeal, rejecting it as unfounded. It observed in particular that the syllable BOT has no particular meaning and that Helena Rubinstein and L'Oréal had put forward no reason as to why it should be preferred, in the appraisal of the similarity of the marks, to the prefix 'BOTO', which was taken into consideration by the Board of Appeal. The General Court added that, even if the mark BOTOX were originally descriptive, it had acquired distinctive character through use, at least in the United Kingdom.

12 — See paragraph 40 of the L'Oréal decision and paragraph 39 of the Helena Rubinstein decision.

13 — Case C-252/07 *Intel Corporation* [2008] ECR I-8823; Case C-487/07 *L'Oréal and Others* [2009] ECR I-5185; and Case C-323/09 *Interflora and Others* [2011] ECR I-8625.

14 — See, for example, D. Gangjee and R. Burrell, *Because You're Worth It: L'Oréal and the Prohibition on Free Riding*, *The Modern Law Review*, Vol. 73 (2010), No 2, pp. 282 to 304.

15 — See *Intel*, paragraph 26.

16 — See *Intel*, paragraph 30.

granted to trade marks with a reputation are satisfied.¹⁷ Furthermore, the owner of the earlier trade mark must furnish proof that use of the later sign or mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'. To that end, the owner of the earlier trade mark is required to prove, not that there is actual and present injury, but rather that 'there is a serious risk that such an injury will occur in the future'.¹⁸ Where such proof is furnished, it is for the proprietor of the later mark to establish due cause for using that mark.¹⁹

32. As regards, more specifically, the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark' (also referred to as 'parasitism' or 'free-riding'), the Court stated in *L'Oréal* that that concept relates not to the detriment caused to the mark but 'to the advantage taken by the third party as a result of the use of the identical or similar sign'. According to the Court, it covers, in particular, 'cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation'. It follows that 'an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor'.²⁰ The Court subsequently made it clear, as from *Intel*, that in order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the earlier mark, it is necessary to undertake an overall assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned.²¹ As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has held that the stronger the distinctive character and reputation of the mark, the easier it will be to accept that detriment has been caused to it²² and the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them.²³ Any such overall assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark.²⁴ Lastly, the Court ruled that where it is clear from such an overall assessment that 'a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark'.²⁵ In *Interflora* the Court confirmed the above principles.²⁶ It emphasised in particular that the advantage described above must be regarded as gained unfairly where there is no 'due cause' for the purposes of the relevant provisions of Directive 89/104.²⁷ With reference to the case referred to it by the national court, concerning an advertisement accessible on the Internet on the basis of a key word corresponding to a mark with a reputation, the Court held that where an advertisement puts forward — without offering for sale a

17 — See *Intel*, paragraphs 31 and 32.

18 — See *Intel*, paragraphs 37 and 38.

19 — See *Intel*, paragraph 39.

20 — See *L'Oréal*, paragraphs 41 and 43. These are the grounds on which the academic legal writers, mentioned in footnote 14, focus their criticisms.

21 — See *Intel*, paragraphs 67 to 69 and *L'Oréal*, paragraph 44.

22 — See *L'Oréal*, paragraph 44.

23 — See *Intel*, paragraphs 67 to 69.

24 — See *L'Oréal*, paragraph 45.

25 — See *L'Oréal*, paragraph 49.

26 — See, in particular, paragraphs 74 and 89.

27 — Paragraph 89.

mere imitation of the goods or services of the proprietor of that trade mark,²⁸ without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark with a reputation — an alternative to the goods or services of the proprietor of that mark, such use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without 'due cause' for the purposes of the above provisions.²⁹

33. In the paragraphs of the judgment under appeal which are criticised in the submission under consideration, the General Court — after describing as 'terse' the reasons set out in the Board of Appeal's decisions concerning the existence of any 'detriment' for the purposes of Article 8(5) of Regulation No 40/94 (paragraph 87) — pointed out that this matter had 'been the subject of significant arguments in the course of the administrative proceedings and before the [General] Court'. It went on to explain that Allergan had 'stated that both the mark BOTOLIST and the mark BOTOCYL, which were registered together by the L'Oréal group, actually seek to take advantage of the distinctive character and repute acquired by BOTOX for the treatment of wrinkles, which will have the effect of decreasing the value of that mark'. According to the General Court, '[t]hose risks are sufficiently serious and real to justify the application of Article 8(5) of Regulation No 40/94'. It then recalled that the applicants had acknowledged at the hearing that, even though their goods did not contain the botulinum toxin, they nevertheless intended to take advantage of the image which was associated with that product, which is to be found in the trade mark BOTOX, a trade mark which is unique in that regard³⁰ (paragraph 88).

34. Paragraph 80 of the judgment under appeal supplements the grounds set out in paragraphs 87 and 88. In paragraph 80, the General Court observes, as a preliminary point, that Helena Rubinstein and L'Oréal had not adduced any evidence to show that there was 'due cause' for the use of the marks BOTOCYL and BOTOLIST and, since it was a ground of defence, it was for Helena Rubinstein and L'Oréal to set out the content of such 'due cause'. I would point out that the appellants make no criticism either of the finding of failure to identify 'due cause' or of the statement, consistent with case-law,³¹ that the burden of proving due cause lay with Helena Rubinstein and L'Oréal.³² Consequently, the question whether there was due cause for the use of the appellants' marks in this case goes beyond the subject-matter of the present proceedings.³³

35. The criticisms made by the appellants in connection with the objection under consideration are the subject of an extremely succinct account in the appeal document. Essentially, the appellants do no more than assert that there is no proof that they had intended, as alleged, to take unfair advantage of the distinctive character or the repute of the mark BOTOX. They also submit that the General Court misinterpreted the statements made by their counsel at the hearing and that, although their marks might possibly contain a reference to the botulinum toxin, they did not intend to be associated with the mark BOTOX; nor could they hope to establish such an association, since it was a mark registered for pharmaceutical preparations available only on prescription.

28 — The situation at issue in *L'Oréal*.

29 — Paragraph 91.

30 — The General Court refers to paragraph 56 of *Intel*, in which the Court of Justice stated that the distinctive character of a mark is all the stronger if that mark is unique, that is to say, as regards a word mark, 'if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets'.

31 — See *Intel*, paragraph 39.

32 — At first instance, Helena Rubinstein and L'Oréal merely submitted that the file examined by the Board of Appeal contained no proof that they had acted without 'due cause' in filing their trade marks (judgment under appeal, paragraph 31). However, as we have seen, it has been made clear in case-law that, where the owner of the earlier trade mark furnishes proof of that mark's reputation and the existence of an unfair advantage arising from the use of the later sign or mark, it is for the owner of the later mark to assert due cause for such use.

33 — When questioned on this point at the hearing before the Court of Justice, the appellants' representative explained that the appellants were not required to show any due cause for the use of their marks, given that they had previously disputed the claim that proof of the earlier marks' reputation had been furnished in this case.

36. It is apparent from all the grounds of the judgment under appeal that the existence of parasitic intent is inferred from a number of findings which concern, on the one hand, the fact that Helena Rubinstein and L'Oréal opted to use in their marks a prefix which reproduces almost all of the earlier mark — a decision which, in the view of the General Court and, before it, the Board of Appeal,³⁴ cannot be justified by the intention to refer to the botulinum toxin which, moreover, does not form part of the goods covered by the contested marks³⁵ — and, on the other, the characteristics of the earlier mark, that is to say, its strong distinctive character, owing also to its uniqueness and widespread reputation. Contrary to the assertions made by the appellants, therefore, the General Court specifically made an overall assessment, in line with the case-law of the Court of Justice referred to above, of the factors relevant to the case. In those circumstances, the appellants' argument that the determination of parasitic intent is not supported by any evidence is unfounded. As for the findings on which that determination is based, they are not, given their factual nature,³⁶ amenable to review by the Court of Justice.

37. Referring solely to the decisions of the Board of Appeal, the appellants contest the relevance of the reference to the 'specificity' and 'uniqueness' of the mark BOTOX, which, in their view, are relevant factors in the case of dilution of the mark, but not in the case of parasitism. If that criticism is to be regarded as applying to the judgment under appeal, in which the General Court also refers to those factors and to the risk of 'decreasing the value of that mark' (paragraph 88), then it should be rejected. As we have seen above, the Court of Justice has already had occasion to state that the risk of detriment to the distinctive character or repute of the mark, albeit not a necessary condition for there to be parasitism, constitutes, where it is found, a factor to be taken into consideration in determining whether or not an unfair advantage exists.

38. On the basis of the considerations set out above, I consider that the fourth complaint under the first ground of appeal should also be rejected.

5. Conclusion on the first ground of appeal

39. In the light of all the foregoing considerations, the first ground of appeal should, in my view, be rejected in its entirety.

*B – Second ground of appeal: infringement of Article 115 of Regulation No 40/94, read in conjunction with Rule 38(2) of Regulation No 2868/95*³⁷

1. References to legislation, arguments of the parties, and the judgment under appeal

40. Under Article 115(5) of Regulation No 40/94, the notice of opposition and an application for revocation or invalidity are to be filed in one of the languages of OHIM.

41. Rule 38(2) of Regulation No 2868/95 provides that, where the evidence in support of the application is not filed in the language of the revocation or invalidity proceedings, the applicant is to file a translation of that evidence into that language within a period of two months after the filing of such evidence. The provisions relating to those proceedings do not specify the consequences of failure

34 — See paragraphs 43 and 44 respectively of the contested decisions.

35 — That claim, which is mentioned in paragraph 88 of the judgment under appeal, is not contested by the appellants.

36 — The Court ruled to that effect in Case C-48/05 *Adam Opel* [2007] ECR I-1017, paragraph 36.

37 — Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1).

to fulfil that obligation. However, as regards opposition proceedings, Rule 19(4) of Regulation No 2868/95, as amended by Regulation No 1041/2005,³⁸ provides that OHIM 'shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by [OHIM]'.

42. The appellants submit that the General Court infringed Article 115 of Regulation No 40/94 and Rule 38 of Regulation No 2868/95 by confirming the admissibility as evidence of certain articles published in English in the specialist and general-interest press and not translated into French, which was the language of the proceedings, and by basing findings on those documents. OHIM responds by stating that, in contrast with the provision made under Rule 19 of Regulation No 2868/95 in relation to opposition proceedings, Rule 38(2) of that regulation does not provide for any penalty if an applicant for revocation or for a declaration of invalidity fails to file translations into the language of proceedings of the documents submitted as evidence. According to OHIM, such documents are therefore admissible, unless a translation thereof is requested, of the adjudicating authority's own motion or at the request of a party, within a specified period and that translation is not filed or is not filed in good time. OHIM, supported on that point by Allergan, adds that the absence of those translations in no way impeded the exercise by the appellants of their rights of defence, either in the course of the administrative procedure or before the General Court.

43. In paragraph 54 of the judgment under appeal, the General Court notes that 'the very existence' of the articles in question 'constitutes a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX with the general public, irrespective of the positive or negative content of those articles'. It goes on to state that '[t]he evidential value of those documents cannot be dependent as such on their translation into the language of the proceedings ...' and that '[s]uch a translation ... cannot be set up as a condition of admissibility of a document provided as evidence'.

2. Appraisal

44. I am unconvinced by OHIM's argument, which, moreover, has no place in the line of reasoning of the General Court, which does not rule on the consequences of failure to file a translation for the purposes of Rule 38 of Regulation No 2868/95, but in essence merely states that, in the case before it, a translation was not necessary. OHIM's argument relies on an interpretation of that rule which is argued for *a contrario sensu* from Rule 19 of that regulation, as amended by Regulation No 1041/2005. It should be noted that Regulation No 1041/2005 also amended Rule 98 of Regulation No 2868/95, which is entitled 'Translations'. As now worded, that rule states that, save where Regulation No 40/94 or Regulation No 2868/95 provides otherwise, 'a document for which a translation is to be filed shall be deemed not to have been received by [OHIM] ... where the translation is received by [OHIM] after expiry of the relevant period for submitting the original document or the translation'. In consequence, even supposing that the amended version of Regulation No 2868/95 is applicable to the facts of the case, it is not possible, in my view, to infer from the absence, in Rule 38, of an express penalty for failure to file the translation of a document and from the different rules laid down in Rule 19 in respect of opposition proceedings, that such a document is nevertheless admissible, save where OHIM has provided otherwise. Such an interpretation is at odds with Rule 98, which is laid down as a closing provision for cases where a translation is filed out of time, and is applicable a fortiori where no translation is filed at all. It should also be noted that, before it was amended by Regulation No 1041/2005, Rule 19 was couched in substantially identical terms to Rule 38 and was interpreted by the General Court as meaning that failure to file a translation into the language of proceedings meant that the document concerned was inadmissible.³⁹

38 — Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4).

39 — See Case T-232/00 *Chef Revival USA v OHIM - Massagué Marín (Chef)* [2002] ECR II-2749, paragraphs 31, 33, 36, 41 and 44, and Case T-107/02 *GE Betz v OHIM - Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, paragraph 72, concerning the failure to produce a translation of the registration certificate.

45. However, it does not seem entirely possible to agree with the reasoning followed in the judgment under appeal, at least when applied to the circumstances of the case. While not absolutely excluding the admissibility of documentary evidence whose written elements do not need to be translated or translated in full, where their evidential value does not actually depend on their content or they are immediately comprehensible, that does not seem to me to be the position in the case of press articles which have been produced by a party in order to show that information had been disseminated regarding the therapeutic characteristics of a pharmaceutical preparation and that there was a broad awareness of that information among a specialist public and/or the public at large *at a date before* the date on which it was published (see paragraphs 51 and 52 of the judgment under appeal).

46. Accordingly, the General Court erred in confirming the admissibility as evidence of the articles produced by Allergan before OHIM which had not been translated into the language of proceedings. However, it is an error which concerns the appraisal of the evidence⁴⁰ and, as such, no objection can be raised to it in the present proceedings. In any event, even if that error could be categorised as an 'error in law', I do not consider it sufficient in itself to justify annulment of the judgment under appeal. The rule that evidence in support of the claims of the opponent or applicant for a declaration of invalidity or revocation of the trade mark must be submitted in the language of the proceedings or be accompanied by a translation into that language is justified by the need to observe the principle of *audi alteram partem* and to ensure equality of arms between the parties in *inter partes* proceedings.⁴¹ In the present case, the irregularity committed by the Board of Appeal, which was not pointed out by the General Court, did not prevent Helena Rubinstein and L'Oréal from defending themselves effectively either at first instance or in the present proceedings. By their own admission, they understood the content of the articles in question. Moreover, as is clear from their written submissions before the General Court and the Court of Justice, they fully understood the evidential value attached to those articles, first by the Board of Appeal, and then by the General Court.

47. In those circumstances, I consider that, although it is partially well-founded, the second ground of appeal must be rejected.

C – Third ground of appeal: infringement of Article 63 of Regulation No 40/94

48. By the third ground of appeal, the appellants essentially submit that the General Court substituted its own appraisal for that of the Board of Appeal, in breach of Article 63 of Regulation No 40/94, which defines the limits of the Court's jurisdiction to review OHIM decisions.

49. They also claim that the General Court above all substituted itself for the Board of Appeal in finding that the UK registrations of the mark BOTOX were relevant earlier rights. That criticism falls to be rejected, as it is based on the false premiss that the Board of Appeal, unlike the General Court, based its analysis solely on one of Allergan's Community trade marks.⁴²

50. At a general level, the appellants go on to allege that the General Court undertook an independent appraisal of the evidence, which replaced the inadequate appraisal by the Board of Appeal. That complaint must also, I think, be rejected. Although the grounds of the judgment under appeal show a more detailed analysis of the evidence produced by Allergan before the OHIM adjudicating bodies than that which is evident from the reasons for the contested decisions, this is because at first instance Helena Rubinstein and L'Oréal contested the admissibility and/or evidential value of each item of that

40 — In so far as this error consists in failing to consider that the evidential value of the documents concerned does not depend on a translation of them into the language of proceedings.

41 — See, to that effect, the judgments of the General Court in *Chef Revival*, paragraph 42, and in *GE Betz Inc.*, paragraph 72, cited in footnote 39.

42 — In that respect, see the examination of the first complaint under the first ground of appeal in point 12 et seq. above.

evidence. The findings which the General Court makes at the end of that analysis — that is to say, that the documents analysed show vast media coverage of BOTOX products — do not differ from those made by the Board of Appeal. In those circumstances, the appellants have failed to prove that their claims are well founded.

51. Lastly, and more specifically, the appellants allege that the General Court based its findings on certain documents — a statement by a director of Allergan and a market survey carried out in 2004 — which were first produced before the Board of Appeal and which, according to the appellants, were not taken into consideration by the Board of Appeal because they were submitted out of time. The appellants claim that the General Court exceeded its review jurisdiction by concluding that the Board of Appeal had found ‘implicitly but necessarily’ that that evidence was admissible.

52. I would observe that, in paragraph 62 of the judgment under appeal, the General Court — after pointing out that, under Article 74(2) of Regulation No 40/94, OHIM has broad discretion in deciding on the admissibility of evidence not submitted in due time — explains that, given that the Board of Appeal did not expressly declare inadmissible the evidence consisting in the above documents, it implicitly but necessarily found that they were admissible. The contested finding flows, therefore, from the application to this specific case of the interpretation of Article 74(2) of Regulation No 40/94 adopted by the General Court in the judgment under appeal. The appellants’ arguments do not demonstrate how the General Court could have exceeded the limits of its jurisdiction to review decisions of the OHIM Board of Appeal, as provided for under Article 63 of Regulation No 40/94, merely by interpreting and applying the law in that way. The applicants’ complaint should therefore be rejected.

53. On the other hand, what does give rise to uncertainty is the correctness of the interpretation of Article 74(2) which the General Court adopts in the judgment under appeal. It appears to interpret that provision as requiring the adjudicating bodies of OHIM to make an express declaration only as to the inadmissibility of evidence not submitted in due time and not also as to its admissibility. Such an interpretation is at odds with that of the Court of Justice, which undoubtedly takes greater heed of the conflicting interests involved in *inter partes* proceedings before OHIM. In *Kaul*, a judgment pronounced by the Grand Chamber, the Court of Justice clearly stated that OHIM is required to give reasons for its decision, either where it decides not to take such evidence into consideration or where, conversely, it does decide to do so.⁴³ However, since the appellants have not in their appeal alleged an infringement, on the grounds set out, of Article 74(2) of Regulation No 40/94, no objection can be raised in the present proceedings to the error of interpretation committed by the General Court.

54. In the light of the foregoing, the third ground of appeal must, in my view, be rejected.

D – *Fourth ground of appeal: infringement of Article 73 of Regulation No 40/94*

55. By the fourth ground of appeal, the appellants allege the infringement of Article 73 of Regulation No 40/94, under which reasons must be stated for OHIM decisions. They claim that the General Court wrongly omitted to criticise the absence of a statement of reasons for the decisions on two points: (i) the finding that the marks BOTOX have a reputation and (ii) the finding that there is detriment to those trade marks from the use made of the appellants’ marks.

56. The scope of Article 73 of Regulation No 40/94 can be defined by reference to the case-law on the duty to state reasons for acts of the European Union institutions. The same is true of the principles applicable to verifying that that duty has been fulfilled. Thus, the statement of reasons required under that provision must show in a clear and unequivocal manner the reasoning of the body responsible for

43 — Case C-29/05 P *OHIM v Kaul* [2007] ECR I-2213, paragraph 43.

the act. The duty imposed on the adjudicating bodies of OHIM to state reasons has two purposes: (i) to enable interested parties to know the justification for the measure, so as to enable them to protect their rights and (ii) to enable the Courts to exercise their jurisdiction to review the legality of the decision.

57. In paragraph 93 of the judgment under appeal, the General Court finds that the reasons stated for the contested decisions make it possible to understand why, in the view of the Board of Appeal, the trade mark BOTOX has a reputation. The appellants' arguments do not, in my view, make it possible for that finding to be called into question. It is clear from those decisions that the Board of Appeal considered that the mark BOTOX had a reputation in all the Member States; that that reputation was not only a consequence of the marketing of the BOTOX products but also of the indirect publicity for those products through the media; and, lastly, that that publicity had familiarised the general public with the botulinum toxin and its use for the treatment of wrinkles (paragraph 35 of the L'Oréal decision and paragraph 34 of the Helena Rubinstein decision). That statement of reasons makes it possible to reconstruct the Board of Appeal's line of argument and identify the reasons which led it to find that the earlier trade mark had a reputation. Contrary to the assertions made by the appellants, the Board of Appeal was not required to give an account of the examination of each individual item of evidence produced by Allergan, particularly in view of the fact that it is evident from the above reasons that the Board of Appeal considered that much of that evidence, considered as a whole, helped to demonstrate the same fact, that is to say, the media coverage of the BOTOX products.

58. In paragraph 94 of the judgment under appeal, the General Court states that although the statement of reasons for the contested decisions on the effects of the use of the appellants' marks was 'terse', it allowed them to have the necessary information to contest the Board of Appeal's findings in that regard. The appellants merely observe that what the General Court calls a statement of reasons consists of just two sentences and states the obvious, that is to say, that it does not constitute a 'statement of reasons in the legal sense'. Contrary to the assertions made by the appellants, paragraphs 42 and 43 of the Helena Rubinstein decision and paragraphs 44 and 45 of the L'Oréal decision show the reasons which led the Board of Appeal, on the one hand, to find that there was no due cause to use the appellants' marks and, on the other, to consider that the appellants had taken unfair advantage of the distinctive character of the mark BOTOX.

59. In the light of the foregoing, I consider that the fourth and final ground of appeal must be rejected.

IV – Conclusions

60. In the light of all the above considerations, I therefore propose that the Court dismiss the appeal and order the appellants to pay the costs.