



Reports of Cases

Judgment of the General Court (Second Chamber) of 5 February 2020 – Globalia Corporación Empresarial v EUIPO — Touring Club Italiano (TC Touring Club)

(Case T-44/19)

(EU trade mark — Opposition proceedings — Application for the EU figurative mark TC Touring Club — Earlier EU word mark TOURING CLUB ITALIANO — Relative ground for refusal — Likelihood of confusion — Article 8(1)(b) of Regulation (EU) 2017/1001 — Genuine use of the earlier mark — Article 47(2) of Regulation 2017/1001 — Additional evidence that was submitted for the first time before the Board of Appeal — Article 95(2) of Regulation 2017/1001 — Cross-claim)

1. *EU trade mark — Appeals procedure — Action before the EU judicature — Jurisdiction of the General Court — Re-evaluation of the facts in the light of evidence produced for the first time before it — Precluded*

(Rules of Procedure of the General Court, Art. 188; European Parliament and Council Regulation 2017/1001, Art. 72)

(see para. 21)

2. *EU trade mark — Appeals procedure — Persons entitled to appeal and to be parties to the proceedings — Persons whose claims are not upheld by a decision — Decision upholding an opposition to registration of a trade mark, based on the existence of the likelihood of confusion with an earlier mark, without recognising the latter as having enhanced distinctiveness — No interest in bringing proceedings — Inadmissibility*

(European Parliament and Council Regulation 2017/1001, Art. 72(4))

(see paras 27-31)

3. *EU trade mark — Appeals procedure — Appeal against a decision of the Opposition Division of EUIPO — Examination by the Board of Appeal — Scope — Facts and evidence not produced in support of the opposition within the period prescribed for that purpose — Account taken — Discretion of the Board of Appeal — New or supplementary evidence*

(European Parliament and Council Regulation 2017/1001, Art. 95(2); Commission Regulation No 2868/95, Art. 1, Rule 50(1), third para.)

(see paras 37-41)

4. *EU trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Definition — Interpretation taking account of the rationale of Article 47(2) and (3) of Regulation 2017/1001*

(European Parliament and Council Regulation 2017/1001, recital 24, Art. 47(2) and (3); Commission Regulation No 2868/95, Art. 1, Rule 22(3))

(see para. 51)

5. *EU trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Definition — Criteria for assessment — Requirement of solid and objective evidence*

(European Parliament and Council Regulation 2017/1001, Arts 18(1), second para. (a), and 47(2) and (3))

(see paras 52-57)

6. *EU trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Definition — Criteria for assessment — Company name, commercial name or trade name*

(European Parliament and Council Regulation 2017/1001, Arts 18(1), second para. (a), and 47(2) and (3))

(see paras 63, 64)

7. *EU trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Simultaneous use of several signs*

(European Parliament and Council Regulation 2017/1001, Arts 18(1) and 47(2) and (3))

(see para. 72)

8. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Criteria for assessment*

(European Parliament and Council Regulation 2017/1001, Art. 8(1)(b))

(see paras 78, 79, 81, 116)

9. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Earlier trade mark constituted by an EU trade mark — Refusal to register where there is a relative ground for refusal, even if limited to part of the Union*

(European Parliament and Council Regulation 2017/1001, Art. 8(1)(b))

(see paras 84)

10. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Similarity between the goods or services in question — Criteria for assessment*

(European Parliament and Council Regulation 2017/1001, Art. 8(1)(b))

(see paras 90, 91)

11. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Similarity of the marks concerned — Criteria for assessment*

(European Parliament and Council Regulation 2017/1001, Art. 8(1)(b))

(see paras 94, 95)

12. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Figurative mark TC Touring Club and word mark TOURING CLUB ITALIANO*

(European Parliament and Council Regulation 2017/1001, Art. 8(1)(b))

(see paras 117-122)

Re:

Action brought against the decision of the Fourth Board of Appeal of EUIPO of 9 November 2018 (Case R 448/2018-4), relating to opposition proceedings between Touring Club Italiano and Globalia Corporación Empresarial.

Operative part

The Court:

1. Dismisses the action;

2. Dismisses the cross-claim as inadmissible;
3. With regard to the main action, orders Globalia Corporación Empresarial, SA, to pay the costs, including those incurred by Touring Club Italiano for the purposes of the proceedings before the Board of Appeal;
4. With regard to the cross-claim, orders Touring Club Italiano to bear its own costs and to pay the costs incurred by Globalia Corporación Empresarial and by EUIPO.