



## Reports of Cases

Case T-342/20

**Indo European Foods Ltd**

v

**European Union Intellectual Property Office**

**Judgment of the General Court (Third Chamber) of 6 October 2021**

(EU trade mark – Opposition proceedings – Application for EU figurative mark Abresham Super Basmati Sela Grade One World's Best Rice – Earlier non-registered word mark BASMATI – Agreement on the withdrawal of the United Kingdom from the European Union and Euratom – Transition period – Interest in bringing proceedings – Relative ground for refusal – Article 8(4) of Regulation (EC) No 207/2009 (now Article 8(4) of Regulation (EU) 2017/1001) – Rules governing common law actions for passing off – Likelihood of misrepresentation – Likelihood of dilution of the reputation of the earlier mark)

1. *EU trade mark – Appeals procedure – Action before the EU judicature – Opposition by the proprietor of a trade mark that is protected in the United Kingdom – Withdrawal of the United Kingdom from the European Union – Effect – Decision of the Board of Appeal made during the transition period – Subject matter of the action retained – Interest in bringing proceedings retained*  
(*European Parliament and Council Regulation No 2017/1001; Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community, Art. 127*)

(see paragraphs 16-21, 26, 27)

2. *Action for annulment – Natural or legal persons – Interest in bringing proceedings – Need for a vested and present interest*  
(*Art. 263, fourth para., TFEU*)

(see paragraph 25)

3. *EU trade mark – Definition and acquisition of the EU trade mark – Relative grounds for refusal – Opposition by the proprietor of an unregistered trade mark or other sign used in the course of trade – Conditions – Interpretation in the light of EU law – Assessment by reference to the criteria determined by the national law governing the sign relied on*  
(*European Parliament and Council Regulation No 2017/1001, Art. 95(1); Council Regulation No 207/2009, Art. 8(4)*)

(see paragraphs 32-35, 50, 63, 66)

4. *National law – Reference to national law – United Kingdom law – Action for passing off*  
(see paragraphs 37-40, 51, 55, 57, 70)

5. *EU trade mark – Definition and acquisition of the EU trade mark – Relative grounds for refusal – Opposition by the proprietor of an unregistered trade mark or other sign used in the course of trade – Figurative mark Abresham Super Basmati Selaa Grade One World’s Best Rice and non-registered word mark BASMATI*  
(Council Regulation No 207/2009, Art. 8(4))

(see paragraphs 52, 53, 58-62, 64, 69, 71)

### **Résumé**

Mr Chakari applied to the European Union Intellectual Property Office (EUIPO) for registration of an EU figurative mark Abresham Super Basmati Selaa One World’s Best Rice for rice flour and other food products made of rice. Indo European Foods Ltd filed a notice of opposition to registration of that mark on the basis of the non-registered word mark in the United Kingdom, BASMATI, used to refer to rice, which, under the applicable law in the United Kingdom, would allow it to prohibit the use of the mark applied for.

By decision of 2 April 2020, the Board of Appeal of EUIPO rejected the opposition on the ground that Indo European Foods had failed to prove that the name ‘basmati’ allowed it to prohibit the use of the mark applied for in the United Kingdom.

The General Court annuls the decision of the Board of Appeal of EUIPO and adjudicates on the effects of the withdrawal of the United Kingdom from the European Union on pending cases relating to EU trade marks.

#### *Findings of the Court*

In the first place, the Court holds that the withdrawal of the United Kingdom from the European Union has not rendered the dispute devoid of purpose.

First, it points out that the withdrawal agreement,<sup>1</sup> which sets out the arrangements for the withdrawal of the United Kingdom from the European Union, entered into force on 1 February 2020 and provides for a transition period from 1 February to 31 December 2020, during which EU law continues to be applicable in the United Kingdom.

Next, the Court notes that the decision of the Board of Appeal was taken on 2 April 2020, that is to say, during the transition period. Until the end of that period, the earlier mark continued to receive the same protection as it would have received had the United Kingdom not withdrawn from the European Union.

<sup>1</sup> Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (OJ 2020 L 29, p. 7).

Finally, since the purpose of the action before the Court is to review the legality of decisions of the Boards of Appeal of EUIPO, the Court must take into account the date of the contested decision when assessing that legality. For the Court to find that the litigation becomes devoid of purpose following the withdrawal of the United Kingdom from the European Union would amount, for the Court, to taking into account matters arising after the adoption of the contested decision, which do not affect its merits.

In the second place, the Court finds that Indo European Foods retains an interest in bringing proceedings. In that regard, the Court recalls that the interest in bringing proceedings must continue until the final decision, which presupposes that the action must be able to procure an advantage to the party bringing it. First, it rejects EUIPO's argument that the trade mark applicant had no interest in bringing proceedings because, if the opposition were upheld, the applicant would be able to convert his mark into national trade mark applications in all EU Member States. Those considerations apply, in principle, to any opposition proceedings. Secondly, the Court finds that if it were to annul the decision of the Board of Appeal and refer the case back, the Board of Appeal would not be obliged to dismiss the action in the absence of an earlier trade mark protected by the law of a Member State. Following the annulment of a decision of the Board of Appeal, the Board of Appeal must take a new decision on that same action by reference to the situation at the time that the action was brought, since the action is again pending at the same stage as it was before the contested decision.

Moreover, the Court annuls the decision of the Board of Appeal on the ground that the Board of Appeal misapplied the legal tests for the extended form of passing off under the law applicable in the United Kingdom, in that it ruled out the risk of misrepresentation and damage to the goodwill enjoyed by the term 'basmati'.