



## Reports of Cases

### **Judgment of the General Court (Second Chamber) of 7 June 2023 – Chocolates Lacasa Internacional v EUIPO – Esquitino Madrid (Conguitos)**

**(Case T-339/22)<sup>1</sup>**

(EU trade mark – Invalidity proceedings – EU figurative mark Conguitos – Earlier EU word mark Conguitos – Absolute ground for invalidity – Bad faith – Article 52(1)(b) of Regulation (EC) No 207/2009 (now Article 59(1)(b) of Regulation (EU) 2017/1001) – Relative ground for invalidity – Unfair advantage taken of the distinctive character or repute of the earlier mark – Article 8(5) of Regulation No 207/2009 (now Article 8(5) of Regulation 2017/1001) – Article 53(1)(a) of Regulation No 207/2009 (now Article 60(1)(a) of Regulation 2017/1001))

1. *Acts of the institutions – Temporal application – Substantive rule – Criteria for application*  
(see paragraph 12)
  
2. *EU trade mark – Surrender, revocation and invalidity – Relative grounds for invalidity – Existence of an earlier identical or similar mark enjoying a reputation – Extension of protection of earlier mark with a reputation to dissimilar goods or services – Aim*  
(Council Regulation No 207/2009, Arts 8(5) and 53(1)(a))  
(see paragraph 16)
  
3. *EU trade mark – Surrender, revocation and invalidity – Relative grounds for invalidity – Existence of an earlier identical or similar mark enjoying a reputation – Extension of protection of earlier mark with a reputation to dissimilar goods or services – Conditions*  
(Council Regulation No 207/2009, Arts 8(5) and 53(1)(a))  
(see paragraph 17)
  
4. *EU trade mark – Surrender, revocation and invalidity – Relative grounds for invalidity – Existence of an earlier identical or similar mark enjoying a reputation – Extension of protection of earlier mark with a reputation to dissimilar goods or services – Conditions – Link between the marks – Criteria for assessment*  
(Council Regulation No 207/2009, Arts 8(5) and 53(1)(a))

<sup>1</sup> OJ C 284, 25.7.2022.

*(see paragraphs 18-21)*

5. *EU trade mark – Surrender, revocation and invalidity – Relative grounds for invalidity – Existence of an earlier identical or similar mark enjoying a reputation – Figurative mark Conguitos and word mark Conguitos*

*(Council Regulation No 207/2009, Arts 8(5) and 53(1)(a))*

*(see paragraphs 56, 57, 76)*

6. *EU trade mark – Surrender, revocation and invalidity – Relative grounds for invalidity – Existence of an earlier identical or similar mark enjoying a reputation – Extension of protection of earlier mark with a reputation to dissimilar goods or services – Proof to be adduced by proprietor – Genuine future risk of undue profit or damage*

*(Council Regulation No 207/2009, Arts 8(5) and 53(1)(a))*

*(see paragraph 59)*

7. *EU trade mark – Surrender, revocation and invalidity – Relative grounds for invalidity – Existence of an earlier identical or similar mark enjoying a reputation – Extension of protection of earlier mark with a reputation to dissimilar goods or services – Conditions – Taking unfair advantage of the distinctive character or repute of the earlier mark – Concept*

*(Council Regulation No 207/2009, Arts 8(5) and 53(1)(a))*

*(see paragraphs 60, 61)*

8. *EU trade mark – Surrender, revocation and invalidity – Absolute grounds for invalidity – Applicant in bad faith when filing the trade mark application – Concept of bad faith – Scope*

*(Council Regulation No 207/2009, Art. 52(1)(b))*

*(see paragraphs 67, 68)*

9. *EU trade mark – Surrender, revocation and invalidity – Absolute grounds for invalidity – Applicant in bad faith when filing the trade mark application – Burden of proof*

*(Council Regulation No 207/2009, Art. 52(1)(b))*

*(see paragraph 69)*

10. *EU trade mark – Surrender, revocation and invalidity – Absolute grounds for invalidity – Applicant in bad faith when filing the trade mark application – Criteria for assessment – Taking into account all relevant factors at the time of filing of the application for registration*

*(Council Regulation No 207/2009, Art. 52(1)(b))*

*(see paragraph 70)*

### **Operative part**

The Court:

1. Dismisses the action;
2. Orders Chocolates Lacasa Internacional, SA to pay the costs.