



## Reports of Cases

**Case T-157/23**

(Published in extract form)

**Kneipp GmbH**

**v**

**European Union Intellectual Property Office**

**Judgment of the General Court (Eighth Chamber) of 24 April 2024**

(EU trade mark – Opposition proceedings – Application for EU word mark Joyful by nature – Earlier EU word mark JOY – Relative ground for refusal – Damage to reputation – Article 8(5) of Regulation (EU) 2017/1001 – Evidence in support of the reputation – Taking unfair advantage of the distinctive character or repute of the earlier mark)

1. *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 enjoying a reputation – Extension of protection of the earlier mark with a reputation to dissimilar goods or services – Conditions – Reputation of the mark in the Member State or in the European Union – Concept – Criteria for assessment*  
(European Parliament and Council Regulation 2017/1001, Art. 8(5))

(see paragraphs 15, 19)

2. *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 enjoying a reputation – Extension of protection of the earlier mark with a reputation to dissimilar goods or services – Conditions – Reputation of the mark in the Member State or in the European Union – Evidence in support of the reputation – Burden of proof*  
(European Parliament and Council Regulation 2017/1001, Art. 8(5))

(see paragraphs 20-22, 38-42)

3. *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 enjoying a reputation – Extension of protection of the earlier mark with a reputation to dissimilar goods or services – Word marks Joyful by nature and JOY*  
(European Parliament and Council Regulation 2017/1001, Art. 8(5))

(see paragraphs 31-36, 58-60, 73-75, 88, 92)

## Résumé

By its judgment, the General Court dismisses the action of the applicant, Kneipp GmbH, the applicant for a trade mark, and rules on the question of the burden of proof in relation to the reputation of a mark. It considers that, while the burden of proof in relation to the reputation of a mark lies with the proprietor of that mark, reputation is lost gradually and it was therefore for the applicant to prove that the reputation, acquired progressively by the earlier mark over many years, suddenly disappeared during the last year under examination.

On 29 November 2019, the applicant filed an application for registration of an EU trade mark in respect of the word sign Joyful by nature with the European Union Intellectual Property Office (EUIPO).<sup>1</sup>

Jean Patou filed a notice of opposition to the registration of that mark, claiming a likelihood of confusion and detriment to the reputation of several of its earlier rights, including the EU word mark JOY, registered in 2016.

The Opposition Division of EUIPO upheld the opposition on the basis of Article 8(5) of Regulation 2017/1001, in the light of the reputation of that earlier word mark.<sup>2</sup>

Following an appeal by the applicant, the Board of Appeal of EUIPO partially annulled the Opposition Division's decision in respect of certain services. However, it dismissed the appeal concerning the other goods and services, finding in particular that Jean Patou had demonstrated that the earlier mark had a strong reputation for perfumery and fragrances.

It is in that context that the applicant brought its action, alleging infringement of Article 8(5) of Regulation 2017/1001.

### *Findings of the Court*

In the context of the assessment of whether the earlier mark has a reputation, the Court points out, at the outset, that reputation must be established as at the filing date of the application for registration of the mark applied for, that is to say 29 November 2019 in the present case.

In the first place, the Court finds that the evidence submitted by Jean Patou establishes that the earlier mark had, on that date, a reputation in a substantial part of the territory of the European Union, so far as concerns perfumery and fragrances. The earlier mark is widely known by the general public concerned, even though the prestigious awards won by the perfume Joy referred to in that evidence date back several years and sales figures fell between 2013 and 2018. In any event, the Court finds that the earlier mark enjoyed a high degree of reputation in the past,

<sup>1</sup> The mark applied for designated, inter alia, goods and services in Classes 3, 4, 35 and 44 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

<sup>2</sup> Under Article 8(5) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1: 'Upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, 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'.

which, even if it were to be assumed that it may have diminished over the years, still survived at the date of filing the application for registration of the mark applied for; accordingly, a certain 'surviving' reputation remained at that date.

In the second place, the Court rules on the burden of proof in relation to reputation, recalling that a document drawn up some time before or after the filing date of the application for registration of the mark at issue may contain useful information in view of the fact that the reputation of a trade mark is, in general, acquired progressively. It specifies that the same reasoning applies to the loss of such a reputation, which is also, in general, lost gradually. The evidential value of such a document is likely to vary depending on whether the period covered is close to or distant from the filing date. In that regard, it is apparent from the case-law that even the mere fact that evidence bears a date which predates that filing date by five years cannot, in itself, deprive it of its probative value. Furthermore, according to the case-law, the burden of proof in relation to reputation lies with the proprietor of the earlier mark.

In the present case, the Board of Appeal emphasised that most of the evidence submitted related to the period between 2013 and 2017 and that some of that evidence dated back to 1990, 2000 or 2006 but that the evidence in fact contained indications concerning the continuous efforts of Jean Patou to maintain its market share in 2018. It added that the loss of reputation rarely happens as a single occurrence but is rather a continuing process over a long period of time, as reputation is usually built up over a period of years and cannot simply be switched on and off. Thus, according to the Board of Appeal, it was for the applicant to prove such a drastic loss of reputation over a short period of time.

The Court finds that that assessment does not constitute a reversal of the burden of proof and is consistent with the case-law referred to. In the absence of concrete evidence showing that the reputation progressively acquired by the earlier mark over many years suddenly disappeared during the last year under examination, the Board of Appeal was entitled to conclude that the earlier mark still had a reputation on the relevant date.

Accordingly, the Court continues its analysis, ruling that the Board of Appeal did not make an error of assessment in finding that the relevant public was likely to establish a link between the marks at issue. Thus, after having found, first, that there is a future risk, which is non-hypothetical, that the applicant would take unfair advantage of the reputation of the earlier mark and, second, that there was no due cause for the use of the mark applied for, the Court dismisses the action in its entirety.