



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

7 November 2019*

(EU trade mark — Opposition proceedings — Application for the EU word mark INTAS — Earlier EU and national figurative trade marks including the word element ‘indas’ — Relative ground for refusal — Likelihood of confusion — Similarity of the signs and of the goods — Article 8(1)(b) of Regulation (EU) 2017/1001 — Proof of genuine use of the earlier marks — Article 47 of Regulation 2017/1001)

In Case T-380/18,

Intas Pharmaceuticals Ltd, established in Ahmedabad (India), represented by F. Traub, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by J. Crespo Carrillo and H. O'Neill, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

Laboratorios Indas, SA, established in Pozuelo de Alarcón (Spain), represented by A. Gómez López, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 16 April 2018 (Case R 815/2017-4), relating to opposition proceedings between Laboratorios Indas and Intas Pharmaceuticals,

THE GENERAL COURT (Ninth Chamber),

composed of S. Gervasoni, President, L. Madise (Rapporteur) and R. da Silva Passos, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Court Registry on 25 June 2018,

having regard to the response of EUIPO lodged at the Court Registry on 1 October 2018,

having regard to the response of the intervener lodged at the Court Registry on 5 October 2018,

further to the hearing on 8 May 2019,

* Language of the case: English.

gives the following

Judgment¹

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Law

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Admissibility

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The pleas of inadmissibility put forward by the intervener

- 34 The intervener contends that the applicant's complaints seeking to challenge the proof of genuine use of the earlier trade marks and the conceptual comparison of the signs at issue are inadmissible. According to the intervener, the legal and factual issues raised by those complaints were already definitively dealt with in a decision which the Opposition Division adopted on 16 March 2017 in different opposition proceedings between the same parties, regarding signs that are identical to those at issue in the present case and goods covered by the mark applied for that are different from those at issue in the present case (Cases R 816/2017-4 and R 1031/2017-4) ('the decision of 16 March 2017'). It submits that the decision of 16 March 2017 was challenged by the applicant and by the intervener before the same Board of Appeal as that which adopted the contested decision in the present case. It maintains that that Board of Appeal, which was called upon to rule on the issues of proof of genuine use of the earlier marks in question and the conceptual similarity of the signs at issue, confirmed the Opposition Division's findings in the decision of 16 March 2017. It takes the view that, consequently, since the Board of Appeal's decision as regards those issues was not challenged before the Court, the findings contained in the decision of 16 March 2017 have become final. More specifically, the intervener contends that, since it does not take any new factors into account or contain a re-examination of the parties' situation, the contested decision in the present case is a mere confirmation of the decision of 16 March 2017 because the Board of Appeal expressly referred to the analysis of those issues that had been carried out in the context of the earlier opposition proceedings between the same parties. The intervener maintains that, consequently, in seeking the annulment of the contested decision in the present case, the applicant is 'de facto' seeking the annulment of the decision of 16 March 2017. Lastly, the intervener submits that, if the Court were not to hold the complaints in question to be inadmissible, that would run counter to the principles of *res judicata* and *ne bis in idem* and would create a situation of uncertainty regarding its exclusive rights, contrary to its legitimate expectations and to the principle of legal certainty.
- 35 First, it is important to bear in mind that the principle of *res judicata*, which prohibits a final judicial decision being called into question, is not applicable so far as concerns the relationship between a decision of an Opposition Division and an opposition brought subsequently in different proceedings, given, inter alia, that proceedings before EUIPO are administrative and not judicial (see judgment of 8 December 2015, *Giand v OHIM — Flamagas (FLAMINAIRE)*, T-583/14, not published, EU:T:2015:943, paragraph 21 and the case-law cited). A fortiori, the grounds of a decision given by an

¹ Only the paragraphs of the present judgment which the Court considers it appropriate to publish are represented here.

Opposition Division in different opposition proceedings do not have the force of *res judicata*. Those grounds are not capable of creating acquired rights or legitimate expectations with regard to the parties concerned.

- 36 Consequently, the intervener cannot maintain that the rejection of its pleas of inadmissibility would create a situation of uncertainty regarding its exclusive rights, contrary to its legitimate expectations and to the principle of legal certainty.
- 37 Secondly, the principle of *ne bis in idem*, which prohibits the same person from being penalised more than once for the same unlawful conduct in order to protect one and the same legal interest, constitutes a general principle of EU law, the observance of which the Courts ensure. However, that principle is applicable only to penalties, which is not the case as regards decisions given by EUIPO in the context of opposition proceedings (see judgment of 8 December 2015, *FLAMINAIRE*, T-583/14, not published, EU:T:2015:943, paragraph 19 and the case-law cited). Consequently, reliance on that principle is, in the present case, ineffective.
- 38 Thirdly, it is important to point out that a decision which merely confirms an earlier decision not challenged in due time is not an actionable measure. In order to prevent the time limit for bringing an action against the earlier decision to recommence, an action against such a confirmatory decision must be declared inadmissible. Thus, where the contested measure is merely confirmatory of an earlier measure, an action is admissible only if the measure confirmed has been challenged within the procedural time limits (see order of 13 July 2017, *myToys.de v EUIPO — Laboratorios Indas (myBaby)*, T-519/15, not published, EU:T:2017:502, paragraph 38 and the case-law cited).
- 39 A decision is regarded as a mere confirmation of an earlier decision if it contains no new factors as compared with that earlier decision and if it was not preceded by any re-examination of the situation of the addressee of that earlier decision (see order of 13 July 2017, *myBaby*, T-519/15, not published, EU:T:2017:502, paragraph 39 and the case-law cited).
- 40 In that regard, a decision of a Board of Appeal, even if it contains findings identical to those in an earlier decision adopted by an Opposition Division in different opposition proceedings, is the result of a re-examination of the legal and factual issues which have been submitted to it. It is true that that re-examination may lead to a result which is identical to that obtained previously before the Opposition Division in different proceedings between the same parties regarding signs that are identical to those at issue in subsequent proceedings before EUIPO. However, that identical outcome adopted by two different adjudicating bodies of EUIPO in different opposition proceedings does not, for that reason alone, imply that a decision given by a Board of Appeal is confirmatory of that previously given by an Opposition Division in different proceedings.
- 41 That is a fortiori the case when one considers that the proof of genuine use of the earlier marks is capable of varying over time and can never be regarded as having been definitively furnished in the context of opposition proceedings that are different from those in which it has been requested. Likewise, since the comparison of the signs at issue is capable of varying depending on the relevant public and is also capable of varying over time, such a comparison cannot be regarded as having been definitively dealt with by an earlier decision of EUIPO which has not been challenged before the Court.
- 42 It follows that the contested decision, in so far as it concerns the issues of proof of genuine use of the earlier marks and the conceptual similarity of the signs at issue, cannot be regarded as ‘confirmatory’ of a decision adopted by an Opposition Division in the context of different opposition proceedings concerning the same parties and the same trade marks.
- 43 In the light of the foregoing, the pleas of inadmissibility put forward by the intervener cannot succeed and must be rejected.

Substance

Proof of genuine use of the earlier marks

[omissis]

– Whether the use of the earlier EU trade mark is genuine

- 73 The applicant submits that the Board of Appeal erred in finding that the use of the earlier EU trade mark in Spain was sufficient to prove that the use of that mark within the European Union was genuine. According to the applicant, it is apparent from the judgment of 19 December 2012, *Leno Merken* (C-149/11, EU:C:2012:816), that an earlier EU trade mark must be used in a larger area than the territory of a single Member State in order for its use to be regarded as genuine and that it is only in certain specific circumstances that use in a single Member State is sufficient to prove that the use of that mark within the European Union is genuine.
- 74 In that regard, it is important to point out that, in the judgment of 19 December 2012, *Leno Merken* (C-149/11, EU:C:2012:816), which the applicant refers to, the Court of Justice held, first, with regard to Article 47(2) and (3) of Regulation 2017/1001, that it was apparent from the case-law that the expression ‘use in [the Union]’ has to be interpreted as meaning that the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors, and that the phrase ‘in [the Union]’ is intended to define the geographical market serving as the reference point for all consideration of whether an EU trade mark has been put to ‘genuine use’. Secondly, the Court of Justice held that the phrase ‘genuine use in [the Union]’, for the purposes of Article 18(1) of Regulation 2017/1001, means that use of the EU trade mark in third States cannot be taken into account (judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraphs 36 to 38 and the first point of the operative part).
- 75 Furthermore, the Court of Justice stated that Regulation 2017/1001 pursues the objective of removing the barrier of territoriality of the rights conferred on proprietors of trade marks by the laws of the Member States by enabling undertakings to adapt their activities to the scale of the European Union and carry them out without restriction. According to the Court of Justice, the EU trade mark enables its proprietor to distinguish his goods and services by identical means throughout the entire European Union, regardless of frontiers. On the other hand, undertakings which do not wish to protect their trade marks at European Union level may choose to use national trade marks and are not obliged to apply for registration of their marks as EU trade marks. The Court of Justice pointed out that the unitary character of the EU trade mark means that it enjoys uniform protection throughout the entire area of the European Union, in the sense that an EU trade mark may not, in principle, be registered, transferred or surrendered or be the subject of a decision revoking the rights of its proprietor or declaring it invalid and its use may not be prohibited, save in respect of the whole of the European Union. Consequently, according to the Court of Justice, to give, in the framework of the EU arrangements for trade marks, particular significance to the territories of the Member States would frustrate the abovementioned objective and would be detrimental to the unitary character of the EU trade mark. The Court of Justice concluded that the territorial borders of the Member States should be disregarded in assessing whether there is ‘genuine use in [the Union]’ (judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraphs 39 to 42 and 44).
- 76 By contrast, the Court of Justice expressly rejected, first, the submission before it that the territorial scope of the use of an EU trade mark cannot under any circumstances be limited to the territory of a single Member State (see, to that effect, judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 49) and, secondly, the submission that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of an EU trade mark

requires that the trade mark should be used in a substantial part of the European Union, which may correspond to the territory of a Member State (see, to that effect, judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraphs 52 and 53).

- 77 In that regard, it stated that, whilst it is reasonable to expect that an EU trade mark should be put to use in a larger area than the territory of a single Member State in order for that use to be capable of being deemed to be ‘genuine use’, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 54).
- 78 According to the Court of Justice, it cannot be ruled out that, ‘in certain circumstances’, the market for the goods or services for which an EU trade mark has been registered is in fact restricted to the territory of a single Member State. The Court of Justice stated that, in such a case, use of the EU trade mark on that territory might satisfy the conditions both for genuine use of an EU trade mark and for genuine use of a national trade mark (judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 50).
- 79 Consequently, contrary to what the applicant submits, when the Court of Justice, in paragraph 50 of the judgment of 19 December 2012, *Leno Merken* (C-149/11, EU:C:2012:816), used the expression ‘in certain circumstances’, it was not seeking to establish that acknowledging that the use of an EU trade mark that had been used in a single Member State was genuine constituted an exception to a general principle. The Court of Justice also referred to the conditions laid down by settled case-law for assessing whether the use of a mark is genuine, namely all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered. The Court stated that it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of an EU trade mark is genuine or not and that a *de minimis* rule cannot therefore be laid down (see judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 55 and the case-law cited). According to the Court of Justice, an EU trade mark is put to genuine use where it is used in accordance with its essential function and for the purpose of maintaining or creating market shares in the European Union for the goods or services covered by that mark. Consequently, when assessing genuine use, it is necessary to take into account the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity (judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 56).
- 80 It is apparent from the foregoing, first, that the territorial scope is only one of several factors that have to be taken into account in assessing whether use of an EU trade mark is genuine and, secondly, that a *de minimis* rule for establishing whether that factor is satisfied cannot be laid down. It is not necessary that an EU trade mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered (see, to that effect, judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 55). Moreover, for use of an EU trade mark to be deemed genuine, it is not required that that mark be used in a substantial part of the European Union. Furthermore, the possibility that the mark in question may have been used in the territory of a single Member State must not be ruled out, since the borders of the Member States must be disregarded and the characteristics of the goods or services concerned must be taken into account.

- 81 In accordance with the principles laid down by the judgment of 19 December 2012, *Leno Merken* (C-149/11, EU:C:2012:816), the General Court has held on numerous occasions that use of an EU trade mark in a single Member State (for example, in Germany, in Spain, or in the United Kingdom), or even in a single city in a Member State of the European Union, like the United Kingdom (for example, in London), is sufficient to satisfy the criterion of territorial scope (see, to that effect, judgments of 30 January 2015, *Now Wireless v OHIM — Starbucks (HK) (now)*, T-278/13, not published, EU:T:2015:57, paragraphs 52 and 53; of 15 July 2015, *TVR Automotive v OHIM — TVR Italia (TVR ITALIA)*, T-398/13, EU:T:2015:503, paragraph 57; of 9 November 2016, *Gallardo Blanco v EUIPO — Expasa Agricultura y Ganadería (Representation of a branding iron (shape of an H-shaped horse bit))*, T-716/15, not published, EU:T:2016:649, paragraphs 41 to 44; of 30 November 2016, *K&K Group v EUIPO — Pret a Manger (Europe) (Pret A Diner)*, T-2/16, not published, EU:T:2016:690, paragraph 50; of 28 June 2017, *Tayto Group v EUIPO — MIP Metro (real)*, T-287/15, not published, EU:T:2017:443, paragraph 59; of 15 November 2018, *DRH Licensing & Managing v EUIPO — Merck (Flexagil)*, T-831/17, not published, EU:T:2018:791, paragraph 67; and of 6 March 2019, *Serenity Pharmaceuticals v EUIPO — Gebro Holding (NOCUVANT)*, T-321/18, not published, EU:T:2019:139, paragraphs 43 to 45).
- 82 In other words, as Advocate General Sharpston stated in the Opinion she gave in *Leno Merken* (C-149/11, EU:C:2012:422), whether an EU trade mark has been used in one Member State or several is irrelevant. What matters is the impact of the use in the internal market: more specifically, whether it is sufficient to maintain or create market share in that market for the goods and services covered by the mark and whether it contributes to a commercially relevant presence of the goods and services in that market. Whether that use results in actual commercial success is not relevant (Opinion of Advocate General Sharpston in *Leno Merken*, C-149/11, EU:C:2012:422, point 50).
- 83 In the present case, having regard, first, to the considerable number of items of evidence provided by the intervener, secondly, to the duration and frequency of use shown by those documents, thirdly, to the characteristics of the goods in connection with which that use has been proved and to the normal distribution channels, namely that they are goods relating to the health sector which are provided, in particular, by pharmacies and hospitals, and, fourthly, to the extent of that use both in terms of the volume of sales and turnover, it must be held, in the light of the principles laid down in the judgment of 19 December 2012, *Leno Merken* (C-149/11, EU:C:2012:816) and summarised in paragraph 80 above, that the Board of Appeal did not make an error of assessment when it found, in paragraph 22 of the contested decision, that the intervener had proved use of the mark INDAS in Spain and that, since the borders of the Member States had to be disregarded, that use was sufficient to prove use in the European Union.
- 84 It must be held that use of an earlier EU trade mark in one Member State is capable of producing effects on the internal market by, for example, ensuring that the goods are known — in a commercially relevant manner — by participants in a market that is larger than that corresponding to the territory where the mark is used (Opinion of Advocate General Sharpston in *Leno Merken*, C-149/11, EU:C:2012:422, point 54).
- 85 All the evidence provided by the intervener shows use that is sufficient to maintain or create market share in the market concerned and to contribute to a commercially relevant presence of the goods in Class 10 which have been referred to in paragraph 15 above and are covered by the earlier EU trade mark. As a result, the Board of Appeal also did not make an error of assessment in finding, in paragraph 34 of the contested decision, that genuine use of that mark had been proved in connection with those goods.
- 86 The applicant's second complaint, which has been referred to in paragraph 44 above, must therefore be rejected.

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Costs

[*omissis*]

On those grounds,

THE GENERAL COURT (Ninth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Intas Pharmaceuticals Ltd to pay the costs.**

Gervasoni

Madise

da Silva Passos

Delivered in open court in Luxembourg on 7 November 2019.

E. Coulon
Registrar

S. Gervasoni
President