

In Case T-312/11 Süd-Chemie AG v OHIM (13 June 2012), the General Court has rejected an application for annulment brought by the owner of the mark CERATOFIX of a decision of the Fourth Board of Appeal annulling the Opposition Division's decision upholding an opposition to a CTM application for CERATIX.

In November 2007, Byk-Cera BV applied to register as a CTM the word CERATIX for the following goods in class 1: Chemical additives for improving the surface and application of dye, lacquer, printing ink and related products, in particular solvent-based wax dispersions.

The application was published in March 2008. In June of that year, Süd-Chemie AG opposed the application under Article 8(1) (b) of Regulation No 40/94 (now Regulation No 207/2009) on the basis of an earlier German registration of CERATOFIX dating from 2000 and covering the following goods in class 1: Chemical products for industrial use, in particular aluminosilicates as admixtures for the production of fireproof materials and shaped bodies and for glazings.

During the course of the proceedings, Süd-Chemie AG filed evidence which it alleged demonstrated that CERATOFIX had been put to genuine use in connection with the goods for which it had been registered within the five years preceding the date of publication of the CTM application (which, in the case in point, was the period between 3 March 2003 and 2 March 2008). The evidence included:

- A statement dated 2 June 2009 given by a director of the company's 'speciality products' team. The statement focussed on the range and application of the products for which the earlier mark had been used;
- Photographs of packaging and bags labelled CERATOFIX;
- 104 invoices rendered to customers in Germany between 2004 and 2008. The invoices displayed the word mark, packaging and item number only; and
- A page from a newsletter dated April 2007.

In July 2010, the Opposition Division considered that the above evidence demonstrated genuine use and, relying on the average visual and phonetic similarity of the marks and the identical nature of the goods, held that there was a risk of confusion.

Byk-Cera BV appealed to OHIM's Boards of Appeal, and the Fourth Board of Appeal upheld the appeal in April 2011 finding that the evidence did not prove genuine use because it did not identify the goods.

Süd-Chemie AG appealed to the General Court to annul the Board of Appeal's decision.

### Concept of genuine use

The Court reiterated the underlying principles established by Community case law in relation to the concept of genuine use. It emphasised that the earlier mark will be considered to have been put to genuine use if it has been used as a badge of origin in relation to the relevant goods in order to create, or retain, a market for those goods. The Court highlighted the need for concrete and objective evidence of genuine use but confirmed that it was not necessary to prove that the earlier mark had substantial success or had been widely exploited and there was no requirement for a minimum amount of use.

### Insufficient evidence

The Court then moved on to consider whether the Board had erred in deciding that the director's statement, photographs of packaging, invoices and newsletter (as described above) did not demonstrate genuine use.

The Court dealt with the director's statement first, noting that an employee statement was not necessarily inadmissible in opposition proceedings, but that all of the circumstances surrounding the document would need to be taken into account in determining whether it was reliable and, in line with existing jurisprudence, the statement would have to be substantiated by other evidence.

In support of its appeal, Süd-Chemie AG submitted that the Board had failed to consider that chemical products are commonly sold as powders or liquids, so the nature of the products would not be immediately apparent from their outward appearance. This, it alleged, made it more difficult for Süd-Chemie AG to prove use of the mark in relation to the products. The Court disagreed and, on the basis of evidence supplied by the applicant, summarised that chemical additives were commonly sold by reference to an item number (which would allow the relevant public to determine the nature of the product by reference to a product list).

In relation to the invoices, Süd-Chemie AG submitted that the Board had not borne in mind that chemical additive producers invoiced customers in the industry directly, so that invoices would not generally include the chemical formulae of the products. The Court considered that all invoices, whether to industry customers or end users, should display information on the nature of the products and, as the invoices in the case failed to do so, either alone or by reference to a product list, it was impossible for the Court to establish the essential link between the mark and the products that would support a claim of genuine use.

In relation to the photographs, the Court highlighted that it was impossible to identify the product contained within the packaging from the photographs.

Finally, it was noted that the newsletter gave information on the launch of a new range of CERATOFIX products. Süd-Chemie AG accepted that, in order to prove genuine use, use of the mark must be shown in relation to products which were already on the market or to be launched imminently. It submitted that the newsletter was a promotional campaign. The Court disagreed, as the newsletter did not promote or sell products but merely made reference to 'promising trials'. Therefore, the newsletter could not be seen as a promotional campaign relating to the imminent marketing of specific products.

Accordingly, it was held that Süd-Chemie AG had failed to substantiate the director's statement by the other evidence, and, the other evidence being insufficient on its own, the appeal was rejected.

## Comment

This case demonstrates the importance for trade mark owners who have passed the hurdle of registration to use their marks in their relevant market in an open and public way, and to keep detailed records of such use. In particular, where possible, invoices to clients or customers should display the trade mark and a description of the nature of the product or service, which will strengthen the case in question in any future proceedings where the owner may be required to prove genuine use.

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