

Case T-156/01

Laboratorios RTB, SL

v

Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)

(Community trade mark — Invalidity proceedings —
Article 52(1)(a) of Regulation (EC) No 40/94 — Earlier figurative and word
marks containing the word GIORGI — Application for Community word mark
GIORGIO AIRE — Relative ground for refusal — Article 8(1)(b) of Regulation
No 40/94 — Proof of use — Article 56(2) and (3) of Regulation No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 9 July 2003 . . . II-2792

Summary of the Judgment

1. *Community trade mark — Surrender, revocation and invalidation — Consideration of the application — Proof of use of the earlier mark — Genuine use — Meaning (Council Regulation No 40/94, Art. 56(2))*

2. *Community trade mark — Surrender, revocation and invalidation — Consideration of the application — Proof of use of the earlier mark — Genuine use — Criteria for assessment — Particular circumstances of owners — Not relevant*
(Council Regulation No 40/94, Art. 56(2); Commission Regulation No 2868/95, Art. 1, Rules 22(2) and 40(5))
3. *Community trade mark — Surrender, revocation and invalidation — Causes of relative invalidity — Existence of an earlier identical or similar mark registered for identical or similar products or services — Risk of confusion with the earlier mark — Word mark ‘GIORGIO AIRE’ and figurative marks including the word ‘GIORGI’*
(Council Regulation No 40/94, Arts 8(1)(b) and 52(1)(a))
1. Genuine use of an earlier Community trade mark, for the purposes of Article 56(2) of Regulation No 40/94 on the Community trade mark implies real use of the mark on the market concerned for the purpose of identifying goods or services. It therefore excludes all use which is minimal and insufficient for regarding a mark as being actually used in a given market. In that regard, even if it is the owner's intention to make real use of his trade mark, if the trade mark is not objectively present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign, so that it cannot be perceived by consumers as an indication of the origin of the goods or services in question, there is no genuine use of the trade mark.
2. For the purposes of assessing whether a Community trade mark is being genuinely used for the purposes of Article 56(2) of Regulation No 40/94 on the Community trade mark, account must be taken, under Rule 40(5) of Regulation No 2868/95 implementing Regulation No 40/94, of the facts and circumstances of each case, regard being had to the wording of Rule 22(2) of Regulation No 2868/95, which states that the indications and evidence for the furnishing of proof of use are to consist of indications concerning the place, time, extent and nature of the use.

(see para. 35)

The particular circumstances of the current or previous proprietors of the trade marks are irrelevant, since evidence of genuine use must establish that the trade mark was effectively present on the market concerned during the five years preceding the date of

the application for a declaration of invalidity, irrespective of who owned them during that period.

As for the concept of ‘proper reasons’ for non-use referred to in Article 56(2) of Regulation No 40/94, this essentially refers to circumstances unconnected with the trade mark owner which prohibit him from using the mark, rather than to circumstances associated with his commercial difficulties.

(see paras 36, 40-41)

3. There is no risk of the Spanish public being confused between the word mark ‘GEORGIO AIRE’, for which registration as a Community trade mark is sought in respect of toilet articles and soaps falling within class 3 of the Nice Agreement, and figurative marks including the word signs ‘GIORGI LINE’ and ‘MISS GIORGI’, previously registered in Spain to designate perfumes and cosmetics in the same class. Even though there is identity or similarity between the goods covered by the conflicting marks, the visual, aural and conceptual differences between the signs constitute sufficient grounds for discounting the existence of that risk, so that the conditions for applying Articles 8(1)(b) and 52(1)(a) of Regulation No 40/94 on the Community trade mark are not satisfied.

(see paras 83-84)