

Court of Justice EU, 10 May 2012, L'Oréal v OHIM



v
Botocil and Botolist

TRADEMARK LAW

Reputation of trade mark with respect to each of the categories comprising the relevant public

65 It is apparent from paragraphs 48, 49 and 50 of the judgment under appeal that the General Court examined, as evidence intended to establish the reputation of the earlier marks, the promotion of the BOTOX mark carried out, inter alia, through the publication of articles in English both in scientific journals, which are specifically aimed at practitioners, and in the general-interest press.

- Also, as OHIM has stated, if a trade mark enjoys a reputation with the general public then, in principle, it is assumed to be known to professionals. It cannot be reasonably maintained, therefore, that the reputation enjoyed by the BOTOX mark, on account of the significant media coverage for the general public of products marketed under that mark or the inclusion of the term 'BOTOX' in English language dictionaries, could have been unknown to healthcare professionals.

67 Accordingly, the General Court, having made these findings – from which it emerges that it took into account both the general public and health-care professionals – did not err in law by holding in paragraph 64 of the judgment under appeal that, as at the date on which the disputed marks were filed, namely 6 May or 19 July 2002, the trade mark BOTOX had a reputation in the United Kingdom as regards 'pharmaceutical preparations for the treatment of wrinkles' with respect to each of the categories comprising the relevant public.

Reputation examined in relation to the entire territory of the United Kingdom

- Also, it is apparent from the various items of evidence taken into consideration by the General Court – such as the press articles in English published in scientific journals or English daily newspapers, the inclusion of the word 'BOTOX' in English language dictionaries and the decision of the United Kingdom Intellectual Property Office – that the reputation of the earlier marks was examined in relation to the entire territory of the United Kingdom.

Actual and present harm to mark is required, which can be based on prima facie evidence of a future risk, which is not hypothetical,

- such a conclusion may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case.

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Court of Justice EU, 10 May 2012

JUDGMENT OF THE COURT (First Chamber)

10 May 2012 (*)

(Appeal – Community trade mark – Regulation (EC) No 40/94 – Article 8(5) – Community word marks BOTOLIST and BOTOCYL – Community and national figurative and word marks BOTOX – Declaration of invalidity – Relative grounds for refusal – Damage to reputation)

In Case C-100/11 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 28 February 2011,

Helena Rubinstein SNC, established in Paris (France),
L'Oréal SA, established in Paris,

represented by A. von Mühlendahl, Rechtsanwalt,
appellants,

the other parties to the proceedings being:

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

represented by A. Folliard-Monguiral, acting as Agent,
defendant at first instance,

Allergan Inc., established in Irvine (United States),
represented by F. Clark, Barrister,

party to the proceedings before the Board of Appeal of OHIM,

THE COURT (First Chamber),

composed of A. Tizzano, President of the Chamber, A. Borg Barthet (Rapporteur), E. Levits, J.-J. Kasel and M. Berger, Judges, Advocate General: P. Mengozzi,

Registrar: L. Hewlett, Principal Administrator,
having regard to the written procedure and further to the hearing on 11 January 2012,

after hearing the Opinion of the Advocate General at the sitting on 16 February 2012,

gives the following

Judgment

1 By their appeal, Helena Rubinstein SNC ('Helena Rubinstein') and L'Oréal SA ('L'Oréal') seek the setting aside of the judgment of 16 December 2010 in Joined Cases T-345/08 and T-357/08 Rubinstein and L'Oréal v OHIM – Allergan (BOTOLIST and BOTOCYL) ('the judgment under appeal'), by which the General Court of the European Union dismissed (i) the action brought by Helena Rubinstein for annulment of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 28 May 2008 (Case R 863/2007-1) relating to cancellation proceedings between Allergan, Inc. ('Allergan') and Helena Rubinstein (Case T-345/08) and (ii) the action brought by L'Oréal for annulment of the decision of the First

Board of Appeal of OHIM of 5 June 2008 (Case R 865/2007-1) relating to cancellation proceedings between Allergan and L'Oréal (Case T-357/08).

Legal context

2 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) was replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. However, the dates of the facts of the present dispute mean that this remains governed by Regulation No 40/94. 3 Paragraph 5 of Article 8 of Regulation No 40/94, which is entitled 'Relative grounds for refusal', provides:

'... upon opposition by the proprietor of an 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 the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, 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.'

4 Paragraph 1(a) of Article 52 of Regulation No 40/94, which is entitled 'Relative grounds for invalidity', provides that a Community trade mark is to be declared invalid on application to OHIM 'where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled'.

5 Paragraphs 1, 2 and 3 of Article 63 of Regulation No 40/94, which is entitled 'Actions before the Court of Justice' provide:

'1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.

3. The Court of Justice has jurisdiction to annul or to alter the contested decision.'

6 Article 73 of Regulation No 40/94 provides that decisions of OHIM must state the reasons on which they are based and may be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

7 Article 115(2) of Regulation No 40/94 provides that the languages of OHIM are English, French, German, Italian and Spanish. Article 115(5) provides that a notice of opposition and an application for revocation or invalidity must be filed in one of the languages of OHIM.

8 Rule 38(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1) provides:

'Where the evidence in support of the application is not filed in the language of the revocation or invalidity proceedings, the applicant shall file a translation of that evidence into that language within a period of two months after the filing of such evidence.'

The facts giving rise to the dispute

9 On 6 May 2002, Helena Rubinstein filed an application with OHIM under Regulation No 40/94 for registration of the word sign 'BOTOLIST' as a Community trade mark. L'Oréal filed a similar application on 19 July 2002 with regard to the word sign 'BOTOCYL'.

10 The goods in respect of which registration was sought fall within Class 3 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks, as revised and amended, and correspond to the following description: 'Perfumes, eau de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics among other creams, milks, lotions, gels and powders for face, body and hands, sun-tanning and after-sun milks, gels and oils (cosmetics); make-up preparations; shampoos; gels, mousses and balms, preparations in aerosol form for hairdressing and haircare; hair lacquers, hair dyes and preparations for bleaching hair; permanent waving and curling preparations; essential oils.'

11 The Community trade marks BOTOLIST and BOTOCYL (collectively, 'the disputed marks') were registered on 14 October 2003 and 19 November 2003 respectively.

12 On 2 February 2005, Allergan applied for a declaration that the registration of the disputed marks was invalid in respect of the goods referred to in paragraph 10 above.

13 The applications for a declaration of invalidity were based on a number of earlier Community and national figurative and word marks, relating to the sign 'BOTOX' and registered chiefly for goods in Class 5 of the Nice Agreement, corresponding to the following description: 'pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain'. The earliest of those marks had been registered on 12 April 1991 and the most recent on 7 August 2003.

14 The grounds relied on in support of those applications were those referred to in Article 52 (1)(a) of Regulation No 40/94, read in conjunction with Article 8(1)(b) and Article 8(4) and (5) of that regulation.

15 By decisions of 28 March 2007 and 4 April 2007, the Cancellation Division rejected both applications for a declaration of invalidity.

16 On 1 June 2007, Allergan filed a notice of appeal with OHIM against each of those two decisions of the Cancellation Division.

17 By decisions of 28 May 2008 and 5 June 2008 ('the contested decisions'), the First Board of Appeal of

OHIM upheld the two appeals. In particular, it found that, although there was no likelihood of confusion between the disputed marks and the earlier mark, the applications for a declaration of invalidity on the basis of Article 8(5) of Regulation No 40/94 were well founded.

The proceedings before the General Court and the judgment under appeal

18 By applications received by the Registry of the General Court on 22 August 2008 and 1 September 2008 respectively, Helena Rubinstein and L'Oréal brought actions for the annulment of the contested decisions.

19 By order of 11 May 2010 of the President of the Third Chamber of the General Court, Cases T-345/08 and T-357/08 were joined for the purposes of the oral procedure and the judgment.

20 In support of their applications, Helena Rubinstein and L'Oréal relied on two identical pleas in law in each case: (i) infringement of Article 8(5) of Regulation No 40/94 and (ii) infringement of Article 73 of that regulation.

21 With regard to the first plea, the General Court observed in paragraphs 38 to 41 of the judgment under appeal, in the course of its preliminary observations, that the applications for a declaration of invalidity were based on a number of national and Community figurative and word marks relating to the sign 'BOTOX', almost all of which had been registered before the marks applied for, BOTOLIST and BOTOCYL, were filed on 6 May 2002 and 19 July 2002 respectively.

22 The General Court noted that the Board of Appeal *'took a different approach from that taken by the Cancellation Division, which had based its decisions merely on the registration of the earlier Community trade mark No 2015832 for the figurative sign BOTOX, finding that a reputation had been acquired in respect of both the figurative and the word marks BOTOX registered before 6 May 2002, whether they were Community or national trade marks'*.

According to the General Court, that approach on the part of the Board of Appeal could be illustrated by the fact that, in the contested decisions, it did not refer to the figurative element of the Community trade mark BOTOX.

23 In that context, the General Court found, in paragraph 40 of the judgment under appeal, that it could limit its examination to the two earlier national marks registered on 14 December 2000 in the United Kingdom for the treatment of wrinkles and relating to the sign 'BOTOX' ('the earlier marks'), since the United Kingdom was the territory in respect of which most of the evidence had been submitted by Allergan and in so far as the mere fact that a relative ground for refusal is found to exist in one Member State is sufficient to justify the application of Article 8(5) of Regulation No 40/94.

24 The General Court accordingly stated, in paragraph 41 of the judgment under appeal, that it would ascertain whether the conditions for the application of Article

8(5) of Regulation No 40/94 were met in the case before it, that is to say: (i) 'whether [the earlier marks] have a reputation in the United Kingdom'; (ii) 'whether the disputed marks are similar to those earlier marks'; and, lastly, (iii) 'whether the use without due cause of the disputed marks would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks'. The General Court added that, since those conditions are cumulative, failure to satisfy one of them was sufficient to render inapplicable Article 8(5) of Regulation No 40/94.

25 First of all, regarding the repute of the earlier marks, the General Court undertook in paragraphs 46 to 63 of the judgment under appeal an examination of the various evidence produced by Allergan in support of the applications for a declaration of invalidity and the appeals before the Board of Appeal: the volume of sales of the products marketed under the trade mark BOTOX from 1999 to 2003 in 14 Member States; the promotion of that mark in articles published in English in scientific journals in 1999 and 2001; the significant media coverage since 2001, particularly in the English press, of products marketed under that mark; the inclusion of the word 'BOTOX' in a number of English language dictionaries, which recognise this word as a trade mark; a decision of 26 April 2005 of the United Kingdom Intellectual Property Office on an application for a declaration of invalidity of the registration in the United Kingdom of the trade mark BOTOMASK for cosmetics; a witness statement from a director of Allergan; and a market survey carried out in the United Kingdom in September and October 2004.

26 As regards, specifically, the admissibility of the English-language press articles, which was disputed by Helena Rubinstein and L'Oréal before the General Court on the ground that they had been published after the date on which the disputed marks had been filed, the General Court referred, in paragraph 52 of the judgment under appeal, to the line of case-law establishing that, 'although the reputation of an earlier mark must be established as at the filing date of the application for the disputed mark, documents bearing a date after that date cannot however be deprived of evidential value if they enable conclusions to be drawn with regard to the situation as it was on that date.'

27 Similarly, in paragraph 54 of the judgment under appeal, the General Court rejected the arguments put forward by Helena Rubinstein and L'Oréal to the effect that the articles published in scientific journals and in the general-interest press were inadmissible because they had not been translated into French, the language of the proceedings before OHIM. The General Court found that the very existence of those articles constituted 'a relevant factor in establishing the reputation of the ... mark BOTOX with the general public, irrespective of the positive or negative content of those articles.'

28 As regards the argument put forward by Helena Rubinstein and L'Oréal to the effect that the decision of 26 April 2005 of the United Kingdom Intellectual Property Office was inadmissible because it postdated

the date on which the disputed marks had been filed, the General Court rejected that argument on the basis of the case-law cited in paragraph 52 of the judgment under appeal.

29 As regards the argument by which Helena Rubinstein and L'Oréal claimed that the witness statement of the director of Allergan and the market survey were inadmissible because that evidence was first lodged before the Board of Appeal, the General Court pointed out in paragraph 62 of the judgment under appeal that, under Article 74(2) of Regulation No 40/94, '[OHIM] may disregard facts or evidence which are not submitted in due time by the parties concerned', which meant that the Board of Appeal had a broad discretion. The General Court found that, as the Board of Appeal had not expressly decided on the admissibility of those items of evidence, it implicitly but necessarily found that they were admissible.

30 In paragraph 64 of the judgment under appeal, the General Court found that, having regard to all the evidence submitted by Allergan, the Board of Appeal had not infringed Article 8 (5) of Regulation No 40/94 in finding that, as at the filing date of the disputed marks, the trade mark BOTOX had a reputation in the United Kingdom as regards 'pharmaceutical preparations for the treatment of wrinkles'.

31 Secondly, as regards the similarity of the marks at issue, the General Court considered in paragraphs 69 to 79 of the judgment under appeal whether the Board of Appeal had not erred in law in finding that there was a certain degree of similarity between the earlier marks and the disputed marks, such that the public would establish a connection between those marks.

32 In essence, the General Court upheld the reasoning of the Board of Appeal, which had taken into consideration, for the purposes of assessing the similarity of the marks at issue, the fact that the prefix 'boto' is common to those marks. According to the General Court, the syllable 'bot' has no particular meaning and, contrary to the assertion made by Helena Rubinstein and L'Oréal, does not refer to the botulinum toxin, the active ingredient of the pharmaceutical product sold by Allergan. The General Court added that no particular reason had been given to explain why it was preferable to take into consideration the syllable 'bot' rather than the prefix 'boto' taken into consideration by the Board of Appeal. 33 The General Court observed that, even if the sign 'BOTOX' could be broken down into 'bo' for 'botulinum' and 'tox' for 'toxin' in reference to the active ingredient which it uses, that sign would then have acquired a distinctive character, inherent or through use, in the United Kingdom at the very least.

34 The General Court also found, in paragraph 76 of the judgment under appeal, that 'the size of the market share of BOTOX in the United Kingdom, 74.3% in 2003, like the degree of awareness of the trade mark of 75% among the specialised public accustomed to pharmaceutical treatments against wrinkles, is sufficient to substantiate the existence of a considerable degree of recognition on the market'.

35 According to the General Court, the Board of Appeal was right to conclude that the goods covered by the marks at issue – albeit different, since Allergan markets pharmaceutical products for the treatment of wrinkles, whereas Helena Rubinstein and L'Oréal market cosmetic products – concerned 'related market sectors'.

36 Consequently, the General Court found that the Board of Appeal had acted correctly in finding that the relevant public would naturally be led to establish a link between the disputed marks and the mark with a reputation – BOTOX – even before associating it with 'botulinum'.

37 Thirdly, as regards the assessment of the effects on the earlier marks of the use of the disputed marks, the General Court observed in paragraph 81 of the judgment under appeal that, in that respect, there are three distinct types of risk. First, the use of the trade mark applied for without due cause may adversely affect the distinctive character of the earlier mark. Secondly, that use may also cause detriment to the repute of the earlier mark. Lastly, the holder of a trade mark applied for may, through the use of its mark, take unfair advantage of the distinctive character or repute of the earlier mark. The presence of one of those three types of risk is sufficient for Article 8(5) of Regulation No 40/94 to apply.

38 Whilst acknowledging, in paragraph 87 of the judgment under appeal, that the Board of Appeal had been rather terse when it set out the effects of the use of the disputed marks, the General Court nevertheless observed that the reason given by the Board of Appeal for that inadequacy – namely the fact that the relevant public would necessarily see a link between the marks at issue – had been the subject of significant arguments in the course of the administrative proceedings and before the General Court.

39 In paragraph 88 of the judgment under appeal, the General Court referred to Allergan's argument that the disputed marks were actually intended to take advantage of the distinctive character and repute acquired by BOTOX for the treatment of wrinkles, which would have the effect of decreasing the value of that mark. According to the General Court, those risks were sufficiently serious and real to justify the application of Article 8(5) of Regulation No 40/94. The General Court observed that Helena Rubinstein and L'Oréal had acknowledged at the hearing that, even though their products did not contain the botulinum toxin, they nevertheless intended to take advantage of the image which was associated with that product, which was to be found in the trade mark BOTOX, a trade mark which is unique in that regard.

40 The General Court accordingly rejected the first plea in its entirety.

41 With regard to the second plea, the General Court found in paragraph 93 of the judgment under appeal that the Board of Appeal had set out in the contested decisions the reasons which made it possible to understand why the trade mark BOTOX has a reputation.

42 In paragraph 94 of the judgment under appeal, the General Court also expressed the view that, with regard to the effects of the use without due cause of the marks applied for, the reasons given in the contested decisions were sufficiently apparent to give Helena Rubinstein and L'Oréal all the relevant information needed to dispute before the General Court the grounds relied on by the Board of Appeal.

43 The General Court therefore rejected the second plea and dismissed the actions for annulment in their entirety.

Forms of order sought before the Court of Justice

44 By their appeal, Helena Rubinstein and L'Oréal claim that the Court should:

- set aside the judgment under appeal;
- dismiss the actions brought by Allergan for annulment of the decisions of the Cancellation Division of 28 March and 4 April 2007; and
- order OHIM to bear the costs of the appeal proceedings, of the proceedings before the General Court and of the proceedings before the Board of Appeal of OHIM.

45 OHIM and Allergan contend that the Court should dismiss the appeal and order Helena Rubinstein and L'Oréal to pay the costs.

The appeal

46 Helena Rubinstein and L'Oréal rely on four grounds of appeal: (i) infringement of Articles 52(1) and 8(5) of Regulation No 40/94; (ii) infringement by the General Court of Article 115 of Regulation No 40/94, read in conjunction with Rule 38(2) of Regulation No 2868/95; (iii) infringement of Article 63 of Regulation No 40/94; and (iv) infringement of Article 73 of that regulation.

The first ground of appeal

47 The first ground of appeal is divided into four parts.

The first part

– Arguments of the parties

48 By the first part of their first ground of appeal, Helena Rubinstein and L'Oréal claim that the General Court erred in law in finding that the examination of the application for a declaration of invalidity could legitimately be carried out by reference to two earlier marks, registered in the United Kingdom, which formed no part of the basis of the contested decisions. They argue that the Board of Appeal of OHIM had based its decisions solely on the earlier Community trade mark No 2015832 composed of the figurative sign 'BOTOX'.

49 OHIM and Allergan contend that the first part of the first ground of appeal must be dismissed as unfounded because the Board of Appeal did not, in the contested decisions, refer expressly to the registration of that earlier Community figurative mark.

– Findings of the Court

50 In paragraph 38 of the judgment under appeal, the General Court found that the applications for a declaration of invalidity submitted by Allergan were based on the registration of a number of national and Community figurative and word marks relating to the sign 'BOTOX', almost all of which had been registered before the applications for the disputed marks

BOTOLIST and BOTOCYL were filed on 6 May and 19 July 2002 respectively. The General Court referred in that regard to paragraph 2 of the contested decisions, which lists those marks.

51 In paragraph 39 of the judgment under appeal, the General Court held that the Board of Appeal had not followed the approach of the Cancellation Division, which had based its decisions merely on the registration of the earlier Community figurative mark No 2015832, and that the Board of Appeal had found that a reputation had been acquired in respect of both the figurative and the word marks BOTOX registered before 6 May 2002, whether Community or national. The General Court also stated that that approach on the part of the Board of Appeal can be illustrated by the fact that, in the contested decisions, it does not refer to the figurative element of the earlier Community trade mark No 2015832.

52 In view of those various factors, the General Court was legitimately able to confine its review to the earlier national marks registered in the United Kingdom on 14 December 2000 for the treatment of wrinkles, since the United Kingdom was the territory in respect of which Allergan had produced most evidence.

53 It should also be noted that Helena Rubinstein and L'Oréal merely claim in a general way that the Board of Appeal, like the Cancellation Division, had based its assessment exclusively on the earlier Community figurative mark and do not put forward any arguments at all to substantiate that line of reasoning.

54 It follows that the first part of the first ground of appeal must be rejected.

The second part

– Arguments of the parties

55 By the second part of the first ground of appeal, Helena Rubinstein and L'Oréal claim that the General Court erred in law in finding that the earlier marks had a reputation.

56 As regards the relevant public, while Helena Rubinstein and L'Oréal do not dispute the General Court's assessment on that point, to the effect that the relevant public consists of the general public and health-care professionals, they claim that it nevertheless did not specifically consider whether those marks enjoyed a reputation with each of the two categories of person comprising the relevant public.

57 As regards the relevant territory, the judgment under appeal contains no information, according to Helena Rubinstein and L'Oréal, concerning the territory within which the earlier marks were considered to have a reputation.

58 As regards the proof of reputation, Helena Rubinstein and L'Oréal dispute the probative force of some of the evidence produced by Allergan, namely the volume of sales of products marketed under the BOTOX mark, mentioned in paragraphs 46 and 47 of the judgment under appeal, and the promotion of the BOTOX mark in scientific journals, described in paragraphs 48 and 49 of that judgment. As regards the significant media coverage of those products, referred to in paragraphs 50 to 54 of the judgment under appeal,

Helena Rubinstein and L'Oréal maintain that the General Court distorted the clear sense of that evidence in so far as it was not substantiated by proof of the circulation, in the United Kingdom, of the newspapers or magazines in which the articles concerning the products marketed under the BOTOX mark were published. They submit that the findings made by the General Court in paragraphs 55 and 56 of the judgment under appeal regarding the inclusion of the term 'BOTOX' in a number of dictionaries is based on a distortion of the facts. Helena Rubinstein and L'Oréal also argue that, in paragraphs 60 to 63 of the judgment under appeal, the General Court distorted the clear sense of the evidence in relation to the market survey undertaken in the United Kingdom in September and October 2004. On that point, they dispute the relevance of that survey in so far as it does not contain any evidence – which, they claim, it was for Allergan to adduce – capable of establishing a link between the data contained therein and the situation existing at the date on which the application for registration of the disputed marks was filed.

59 So far as concerns the decision of 26 April 2005 of the United Kingdom Intellectual Property Office, Helena Rubinstein and L'Oréal argue that the General Court should have ruled this inadmissible as evidence because it related to a different dispute to which they were not party.

60 OHIM contends that the second part of the first ground of appeal must be rejected as, in part, inadmissible and, in part, unfounded.

61 First, as regards the extent of the reputation enjoyed by the earlier marks with respect to each of the categories of person comprising the relevant public, OHIM maintains that every trade mark which enjoys a reputation with the public at large must be assumed to be known to professionals.

62 Secondly, as regards the relevant territory, OHIM argues that, by confining its examination to the two earlier marks registered in the United Kingdom, the General Court clearly indicated that the relevant territory was the United Kingdom.

63 Thirdly, as regards the proof of reputation, OHIM and Allergan contend that the arguments put forward by Helena Rubinstein and L'Oréal in that connection are, on the one hand, misconceived, inasmuch as they seek to call into question the probative force of each item of evidence, whereas that evidence must be assessed as a whole, and, on the other hand, inadmissible, inasmuch as they concern factual issues.

– Findings of the Court

64 It should first be observed that the argument put forward by Helena Rubinstein and L'Oréal alleging that the General Court erred in law as regards the reputation of the earlier marks with the two categories of person comprising the relevant public is based on a misreading of the judgment under appeal.

65 It is apparent from paragraphs 48, 49 and 50 of the judgment under appeal that the General Court examined, as evidence intended to establish the reputation of the earlier marks, the promotion of the

BOTOX mark carried out, inter alia, through the publication of articles in English both in scientific journals, which are specifically aimed at practitioners, and in the general-interest press.

66 Also, as OHIM has stated, if a trade mark enjoys a reputation with the general public then, in principle, it is assumed to be known to professionals. It cannot be reasonably maintained, therefore, that the reputation enjoyed by the BOTOX mark, on account of the significant media coverage for the general public of products marketed under that mark or the inclusion of the term 'BOTOX' in English language dictionaries, could have been unknown to healthcare professionals.

67 Accordingly, the General Court, having made these findings – from which it emerges that it took into account both the general public and health-care professionals – did not err in law by holding in paragraph 64 of the judgment under appeal that, as at the date on which the disputed marks were filed, namely 6 May or 19 July 2002, the trade mark BOTOX had a reputation in the United Kingdom as regards 'pharmaceutical preparations for the treatment of wrinkles' with respect to each of the categories comprising the relevant public.

68 Consequently, it is necessary to reject the argument that the General Court did not carry out any specific analysis as to whether the earlier marks had a reputation with each of the two categories of person comprising the relevant public.

69 Secondly, as regards the lack of information concerning the territory within which the earlier marks were held to enjoy a reputation, it should be observed that the fact that the General Court confined its examination to the two national marks registered in the United Kingdom on 14 December 2000 gives rise to the clear inference that the General Court considered the relevant territory to be the United Kingdom.

70 Also, it is apparent from the various items of evidence taken into consideration by the General Court – such as the press articles in English published in scientific journals or English daily newspapers, the inclusion of the word 'BOTOX' in English language dictionaries and the decision of the United Kingdom Intellectual Property Office – that the reputation of the earlier marks was examined in relation to the entire territory of the United Kingdom.

71 Accordingly, the argument that the General Court erred in law as regards the delimitation of the relevant territory must be rejected.

72 Thirdly, as regards proof of the reputation of the BOTOX mark, it should first of all be observed that the General Court undertook an overall assessment of the evidence adduced by Allergan in that connection, as is apparent from paragraph 64 of the judgment under appeal. As it is, the arguments by which Helena Rubinstein and L'Oréal dispute the proof of that reputation relate to each of those items of evidence taken separately. Consequently, as the Advocate General stated in point 20 of his Opinion, even if the Court of Justice were to hold that some of the arguments put forward by Helena Rubinstein and

L'Oréal were well founded, that would not necessarily invalidate the conclusions reached by the General Court, as it would still be necessary to determine the weight, in the overall assessment carried out by the General Court, of the evidence to be disregarded. No argument to that effect has been put forward by Helena Rubinstein and L'Oréal in the context of this appeal.

73 That said, inasmuch as Helena Rubinstein and L'Oréal are disputing the probative force of certain evidence, such as the volume of sales of products marketed under the BOTOX mark and the promotion of that mark in scientific journals, it need only be stated that their true goal in pursuing that line of argument is to obtain a fresh assessment of that evidence before the Court of Justice.

74 However, it is settled case-law that the Court of Justice has no jurisdiction to establish the facts or, in principle, to examine the evidence which the General Court accepted in support of those facts. Provided that the evidence has been properly obtained and the general principles of law and the rules of procedure in relation to the burden of proof and the taking of evidence have been observed, it is for the General Court alone to assess the value which should be attached to the evidence produced before it. Save where the clear sense of the evidence has been distorted, that appraisal does not therefore constitute a point of law which is subject, as such, to review by the Court of Justice ([Case C-304/06 P Eurohypo v OHIM \[2008\] ECR I-3297, paragraph 33 and the case-law cited](#)).

75 It follows that, since no distortion has been alleged in the present case, the argument by which Helena Rubinstein and L'Oréal seek to dispute the probative force of certain items of evidence must be rejected as inadmissible.

76 Inasmuch as Helena Rubinstein and L'Oréal submit that the General Court distorted the clear sense of the evidence relating to the significance of the media coverage of the products marketed under the BOTOX mark and to the market survey undertaken in the United Kingdom in September and October 2004, and that its assessment relating to the inclusion of the word 'BOTOX' in a number of dictionaries was based on a distortion of the facts, it should be stated that, while referring to a distortion of the clear sense of that evidence or of the facts, Helena Rubinstein and L'Oréal merely challenge the relevance of that evidence or of those facts by means of general and unsubstantiated assertions and are really seeking a fresh assessment of that evidence by the Court of Justice.

77 As is apparent from the settled case-law of the Court of Justice, as recalled in paragraph 74 above, such arguments must be rejected as inadmissible.

78 Lastly, as regards the submission made by Helena Rubinstein and L'Oréal that the decision of 26 April 2005 of the United Kingdom Intellectual Property Office is inadmissible, in so far as it concerns a different set of proceedings, it should be observed that the findings set out in that decision constitute, in themselves, a fact which may, if relevant, be taken into consideration by the General Court in the exercise of its

absolute discretion in relation to the facts, in order to establish the reputation of the earlier marks in the United Kingdom. Moreover, Helena Rubinstein and L'Oréal have not put forward, whether before OHIM or before the General Court, any argument to dispute the accuracy of the findings made in that decision, as is apparent from paragraph 58 of the judgment under appeal.

79 The argument put forward by Helena Rubinstein and L'Oréal alleging the inadmissibility of the decision of 26 April 2005 of the United Kingdom Intellectual Property Office must therefore be rejected as unfounded.

80 It follows that the second part of the first ground of appeal must be rejected as in part inadmissible and in part unfounded.

The third part

– Arguments of the parties

81 By the third part of the first ground of appeal, Helena Rubinstein and L'Oréal claim that the General Court erred in law in confirming the existence of a link between the earlier BOTOX marks and the disputed marks on the basis of the common element 'bot' or 'boto', in so far as that common element is descriptive or generic in that it refers to the 'botulinum toxin'. Such a link, they argue, should not be made since an applicant for a mark should be allowed to include a descriptive element of that kind in his mark.

82 According to OHIM and Allergan, this third part must be rejected as inadmissible, on the ground that it relates to a question of fact in respect of which the General Court has exclusive jurisdiction.

– Findings of the Court

83 In so far as Helena Rubinstein and L'Oréal seek, by the third part of the first ground of appeal, to dispute the analysis carried out by the General Court in paragraphs 70 to 73 of the judgment under appeal for the purposes of establishing that the prefix 'bot' or 'boto' is not descriptive, it should be noted that such an assessment is of a factual nature.

84 As is clear from Article 256 TFEU and Article 58 of the Statute of the Court of Justice of the European Union, an appeal lies on points of law only and, accordingly, the General Court alone has jurisdiction to find and appraise the facts, save where the factual inaccuracy of its findings results from the documents in the case before it. The appraisal of the facts by the General Court does not therefore constitute, save where the clear sense of the evidence produced before it is distorted, a question of law which is subject, as such, to review by the Court of Justice (see, inter alia, Case C-121/01 P O'Hannrachain v Parliament [2003] ECR I-5539, paragraph 35, and Case C-431/07 P Bouygues and Bouygues Télécom v Commission [2009] ECR I-2665, paragraph 137).

85 Since it has not been claimed, in relation to the appraisal in paragraphs 70 to 73 of the judgment under appeal, that there was any distortion of the facts or evidence produced before the General Court, this third part of the first ground of appeal must be rejected as

inadmissible in so far as it seeks to dispute that appraisal.

86 On the other hand, Helena Rubinstein and L'Oréal also submit, by this third part, that it must be permissible for an applicant for a trade mark to include, in the mark which it seeks to have registered, an element which forms part of an earlier mark owned by a third party to the extent that that common element is descriptive. It must be observed that this line of argument raises a question of law which is subject to review by the Court of Justice on appeal.

87 It should be noted, in this connection, that that line of argument relies on the premiss that the common element 'bot' or 'boto' is descriptive.

88 First, however, paragraphs 70 to 73 of the judgment under appeal show that the General Court held that the prefix 'bot' or 'boto' is not descriptive. Secondly, as is apparent from paragraphs 83 to 85 above, the arguments by which Helena Rubinstein and L'Oréal seek to call into question that appraisal cannot be submitted to the Court of Justice in an appeal.

89 In those circumstances, in so far as Helena Rubinstein and L'Oréal claim that they should have the right to include in the disputed marks an element shared with an earlier mark to the extent that that element is descriptive, the third part of the first ground of appeal is ineffective.

90 It follows from the foregoing that the third part of the first ground of appeal must be rejected.

The fourth part

– Arguments of the parties

91 By the fourth part of the first ground of appeal, Helena Rubinstein and L'Oréal claim that the General Court erred in law in accepting it as established that there was a risk of detriment to the reputation of the earlier marks. They submit that the General Court's assessment in paragraph 88 of the judgment under appeal, according to which the disputed marks actually seek to take advantage of the distinctive character and repute acquired by the earlier BOTOX marks for the treatment of wrinkles, is unsubstantiated by any evidence. They also argue that, although the disputed marks might have contained a reference to the botulinum toxin, they neither sought nor intended to be associated with the BOTOX mark, nor could they be associated with that mark, which is registered in respect of pharmaceutical products issued solely on medical prescription.

92 According to OHIM and Allergan, this part of the first ground of appeal must be rejected as unfounded. The link between the earlier marks and the disputed marks is likely to lead to misappropriation of the earlier marks' repute because it suggests that the cosmetic products of Helena Rubinstein and L'Oréal have an effect comparable to that achieved with BOTOX. That would have the effect of reducing the value of the earlier marks.

– Findings of the Court

93 It should be observed that, in order to benefit from the protection introduced by Article 8(5) of Regulation No 40/94, the proprietor of the earlier mark must prove

that use of the mark for which registration is sought would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 8(5). When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for this actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future (see, by analogy, [Case C-252/07 Intel Corporation \[2008\] ECR I-8823, paragraphs 37 and 38](#)).

94 In addition, in order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case ([Case C-487/07 L'Oréal and Others \[2009\] ECR I-5185, paragraph 44](#)).

95 Accordingly, the General Court was correct in holding, in paragraph 82 of the judgment under appeal, that the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark but must, however, adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment, and such a conclusion may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case.

96 It should also be noted that it was only after analysing various factors that the General Court concluded that there was a link between the earlier marks and the disputed marks. It thus found, inter alia, in paragraphs 70 to 72 of the judgment under appeal, that the prefix 'boto' was common to the trade marks at issue and could not be regarded as an abbreviation of 'botulinus' or 'botulinum'; in paragraphs 73 and 74 of that judgment, it found that the sign 'BOTOX' had acquired a distinctive character; in paragraph 76 of that judgment, it noted the significance of the reputation of the earlier marks; and, in paragraph 78 of the judgment, it noted the fact that the goods concerned fell within 'related market sectors'. The General Court also stated that the relevant public would establish that link before even associating the disputed marks with 'botulinum'. It also observed in paragraph 88 of the judgment under appeal that Helena Rubinstein and L'Oréal had acknowledged at the hearing that, even if their products did not contain the botulinum toxin, they nevertheless intended to take advantage of the image which was associated with that product, which is to be found in the BOTOX trade mark.

97 In those circumstances, it was after an overall assessment of the factors relevant to the case – as the Advocate General observed in point 36 of his Opinion – that the General Court concluded in paragraph 88 of

the judgment under appeal that the disputed marks sought to take advantage of the distinctive character and repute acquired by the earlier BOTOX marks. Consequently, the argument by which Helena Rubinstein and L'Oréal claim that the determination of parasitic intent is not supported by any evidence is unfounded.

98 Moreover, the argument put forward by Helena Rubinstein and L'Oréal to the effect that, even if the disputed marks contained a reference to the botulinum toxin, they were not intended to be associated with the BOTOX mark, must be rejected. That argument seeks to call into question the General Court's assessment – on which its finding in paragraph 88 of the judgment under appeal is based – that the prefix 'boto' is not descriptive and cannot be considered to be a reference to the botulinum toxin. Since an assessment of that nature is factual, it is not open to review by the Court of Justice on appeal, in accordance with the case-law referred to in paragraph 84 above.

99 It follows that the fourth part of the first ground of appeal must be rejected. Consequently, the first ground of appeal must be rejected in its entirety.

The second ground of appeal

Arguments of the parties

100 By their second ground of appeal, Helena Rubinstein and L'Oréal claim that the General Court infringed Article 115 of Regulation No 40/94 and Rule 38(2) of Regulation No 2868/95 in so far as it rejected the plea challenging the Board of Appeal's decision declaring that the press articles in English were admissible, whereas those articles should have been translated into the language of the proceedings before the Board of Appeal, namely French.

101 OHIM, supported by Allergan, contends that the second ground of appeal must be rejected as unfounded in so far as Rule 38(2) of Regulation No 2868/95, which deals with invalidity proceedings, does not provide for a penalty if an applicant for a declaration of invalidity does not submit translations, into the language of the proceedings, of the evidence adduced in support of its application.

Findings of the Court

102 It is settled law that the rule according to which the evidence submitted in support of an opposition or of an application for invalidity or revocation of the trade mark must be submitted in the language of the proceedings or be accompanied by a translation into that language is justified by the need to observe the principle of the right to be heard and to ensure equality of arms between the parties in inter partes proceedings (see, to that effect, Case T-107/02 GE Betz v OHIM – Atofina Chemicals (BIOMATE) [2004] ECR II-1845, paragraph 72, and Case T-407/05 SAEME v OHIM – Racke (REVIAN's) [2007] ECR II-4385, paragraph 35).

103 In the present case, it cannot be held that the lack of a translation of the press articles produced in English adversely affected the rights of defence of Helena Rubinstein and L'Oréal, since they were able to challenge the evidential value of those articles before

the General Court, since they admit, in paragraph 112 of their appeal, that they understood the contents of those articles and since English was the language of the case in the action before the General Court.

104 Moreover, it should be noted that, as the General Court observed in paragraph 54 of the judgment under appeal, Helena Rubinstein and L'Oréal did not, whether before the Cancellation Division or before the Board of Appeal, submit any objection or challenge as regards the taking into account of evidence adduced in English and accompanying the application for invalidity in respect of the disputed marks.

105 Consequently, the second ground of appeal must be rejected as unfounded. The fourth ground of appeal 106 In the interests of the sound administration of justice, it is appropriate to address the fourth ground of appeal before the third ground.

Arguments of the parties

107 By their fourth ground of appeal, Helena Rubinstein and L'Oréal allege that the General Court infringed Article 73 of Regulation No 40/94 by rejecting their plea that the contested decisions failed to state sufficient reasons in relation to the finding that the earlier BOTOX marks had a reputation and that there was a likelihood of detriment to those marks. 108 OHIM contends that the fourth ground of appeal must be rejected as inadmissible in so far as Helena Rubinstein and L'Oréal are merely repeating the plea on which they have already relied before the General Court.

109 In any event, according to OHIM and Allergan, that plea must be rejected as unfounded in so far as the Board of Appeal is not required to give express reasons for its assessment of the probative force of each item of evidence submitted to it; nor is it required to support its reasoning with facts.

Findings of the Court

110 It should first be observed that, by claiming that the General Court infringed Article 73 of Regulation No 40/94 in rejecting their plea concerning failure to state sufficient reasons for the contested decisions, Helena Rubinstein and L'Oréal are disputing the General Court's interpretation of European Union law or its application of that law. Accordingly, the points of law examined at first instance may be discussed again in the course of an appeal. Indeed, if an appellant could not in that way base his appeal on pleas in law and arguments already relied on before the General Court, an appeal would be deprived of part of its purpose (see, inter alia, Case C-41/00 P Interporc v Commission [2003] ECR I-2125, paragraph 17, and [Case C-16/06 P Les Éditions Albert René v OHIM \[2008\] ECR I-10053, paragraph 110](#)). The fourth ground of appeal is therefore admissible.

111 Secondly, it should be observed that – as the General Court correctly stated in paragraph 92 of the judgment under appeal – the obligation on OHIM, referred to in Article 73 of Regulation No 40/94, to state reasons for its decisions has the dual purpose of enabling interested parties to know the purported justification for the measure taken so as to be able to

defend their rights and of enabling the Courts of the European Union to exercise their jurisdiction to review the legality of the decision.

112 Such an obligation may be discharged without it being necessary to respond expressly and exhaustively to all the arguments put forward by an applicant.

113 In the present case, the General Court observed in paragraph 93 of the judgment under appeal that the Board of Appeal had set out in the contested decisions the reasons why the BOTOX mark had a reputation. The General Court stated in that regard that those 'reasons are apparent both from the summary of the facts relevant for the analysis and from the legal analysis in the strict sense carried out by the Board of Appeal in the contested decisions'.

114 Clearly also, the detailed arguments submitted by Helena Rubinstein and L'Oréal before the General Court – summarised in paragraph 27 of the judgment under appeal – in order to challenge the probative force of the various items of evidence of the reputation of that mark, or the admissibility of that evidence, demonstrate that Helena Rubinstein and L'Oréal were able to exercise their rights of defence.

115 Consequently, the General Court was able, without erring in law, to reject the plea alleging failure to state sufficient reasons for the contested decisions in relation to the reputation of the BOTOX mark.

116 As regards the reasons relating to the risk of detriment to the earlier marks, although the General Court admittedly observed that these were tersely stated, it nevertheless held that the contested decisions contain grounds proving that, by the disputed marks, Helena Rubinstein and L'Oréal were seeking to take unfair advantage of the distinctive character of the earlier marks. The General Court referred in that connection to paragraphs 42 to 44 of the Helena Rubinstein decision and to paragraphs 43 to 45 of the L'Oréal decision, which are reproduced in paragraph 86 of the judgment under appeal. The General Court added that Helena Rubinstein and L'Oréal had in their possession all the relevant information to enable them to dispute those reasons in their action before it.

117 Moreover, it should also be noted that Helena Rubinstein and L'Oréal do no more than claim, in peremptory fashion, that the contested decisions give no reasons in that connection, and put forward no arguments to support their contention or to demonstrate how that alleged failure to state reasons impaired the exercise of their right of action.

118 In those circumstances, the General Court did not err in law in rejecting the plea alleging failure to state sufficient reasons for the contested decisions in relation to the risk of detriment to the earlier marks.

119 It follows that the fourth ground of appeal must be rejected as unfounded.

The third ground of appeal

Arguments of the parties

120 By their third ground of appeal, Helena Rubinstein and L'Oréal maintain that the General Court infringed Article 63 of Regulation No 40/94. This ground is divided into two parts.

121 By the first part of this ground of appeal, Helena Rubinstein and L'Oréal submit that, in its analysis of the reputation of the earlier marks, the General Court took into account different marks from those selected by the Cancellation Division and the Board of Appeal and undertook a specific examination of the evidence submitted by Allergan, which had not been examined by the Board of Appeal.

122 By the second part of this ground of appeal, Helena Rubinstein and L'Oréal allege that the General Court, wrongly, took into account evidence of the reputation of the earlier BOTOX marks which had not been produced until the proceedings before the Board of Appeal and the admissibility of which was challenged by Helena Rubinstein and L'Oréal, that evidence being a witness statement by a director of Allergan and a market survey. The Board of Appeal had not taken that evidence into account because it based its findings exclusively on the indirect advertising and intensive media coverage.

123 OHIM, supported by Allergan, contends that the third ground of appeal must be rejected as unfounded on the ground that the General Court did not exceed the limits of its jurisdiction to review the legality of measures.

124 As regards the first part of this ground of appeal, OHIM states that the Board of Appeal is not required to give express reasons for its assessment of the probative force of each item of evidence submitted to it. The General Court merely addressed each of the arguments raised by Helena Rubinstein and L'Oréal in their action.

125 As regards the second part of this ground of appeal, OHIM contends that it must be assumed that the Board of Appeal found the witness statement of the director of Allergan and the market survey to be admissible as evidence because, if it had considered that they had been submitted belatedly, it would have been compelled, under Article 74(2) of Regulation 40/94, to adopt an express position on their admissibility.

Findings of the Court

126 As regards the first part of the third ground of appeal, it is necessary to reject – for the reasons set out in the examination of the first part of the first ground of appeal – the allegation that the General Court erred in law by basing its findings, not on the marks selected by the Cancellation Division and Board of Appeal, but on different earlier marks, namely the two national marks registered in the United Kingdom.

127 As regards the allegation relating to the General Court's specific examination of each item of evidence of the reputation of the earlier marks submitted by Allergan, it should be observed that this is based on the premiss that the Board of Appeal did not carry out an individual examination of that evidence, which in turn is based on the view that insufficient reasons were stated in the contested decisions in relation to the probative force of each item of evidence. However, as emerged from the examination of the fourth ground of appeal, sufficient reasons are stated in the contested

decisions in relation to the finding that the earlier marks had a reputation and, accordingly, the Board of Appeal was not required to give express reasons for its findings in relation to the probative force of each item of evidence.

128 Also, in so far as Helena Rubinstein and L'Oréal challenged each item of evidence in terms of its probative force and/or its admissibility, the General Court had to examine their arguments and respond to them. Consequently, as the Advocate General observed in point 50 of his Opinion, it was at the end of its analysis of that evidence that the General Court held that the contested decisions were not vitiated by any error of law. The first part of the third ground of appeal must therefore be rejected.

129 As regards the second part of the third ground of appeal, it should be noted that Helena Rubinstein and L'Oréal merely argue that, in accepting the reputation of the BOTOX mark, the Board of Appeal based its findings exclusively on the indirect advertising and intense media campaign. However, it need only be pointed out that, according to the Board of Appeal, the reputation of that mark results mainly from the indirect advertising of the product by the media. By using the term 'mainly', the Board of Appeal favoured the probative evidence relating to the intense media campaign launched in the years just following the year 2000 for the purpose of establishing the reputation of the BOTOX mark, without none the less excluding the other evidence submitted by Allergan.

130 It follows that Helena Rubinstein and L'Oréal have failed to put forward any argument capable of calling in question the General Court's finding that the Board of Appeal took into consideration the witness statement of the director of Allergan and the market survey as evidence of the reputation of the BOTOX mark. On the contrary, as is apparent from paragraphs 44 and 45 of the applications submitted at first instance, Helena Rubinstein and L'Oréal claimed before the General Court that that evidence had been wrongly taken into consideration by the Board of Appeal.

131 In those circumstances, it cannot be claimed that the General Court infringed Article 63 of Regulation No 40/94 and, in consequence, the second part of the third ground of appeal must be rejected as unfounded.

132 The third ground of appeal must therefore be rejected as unfounded. 133 It follows from all of the foregoing considerations that the appeal must be dismissed in its entirety.

Costs

134 Under Article 69(2) of the Rules of Procedure, which applies to appeal proceedings by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has applied for costs and Helena Rubinstein and L'Oréal have been unsuccessful, Helena Rubinstein and L'Oréal must be ordered to pay the costs.

On those grounds, the Court (First Chamber) hereby:

1. Dismisses the appeal;

2. Orders Helena Rubinstein SNC and L'Oréal SA to pay the costs.

[Signatures]

* Language of the case: English.

OPINION OF ADVOCATE GENERAL MENGOZZI

delivered on 16 February 2012 (1)

Case C-100/11 P

Helena Rubinstein

and

L'Oréal

v

OHIM

(Appeal – Community trade mark – Trade mark which has a reputation for the purposes of Article 8(5) of Regulation No 40/94 – Conditions governing protection – Invalidity proceedings – Rule 38 of Regulation No 2868/95 – Obligation to produce, in the language of the proceedings, the documents supporting the application for a declaration of invalidity – Decisions of the Boards of Appeal of OHIM – Review by the Courts (Article 63 of Regulation No 40/94) – Duty to state reasons (Article 73 of Regulation No 40/94))

1. The present case concerns the appeal brought by Helena Rubinstein SNC and L'Oréal SA ('Helena Rubinstein' and 'L'Oréal'; or, collectively, 'the appellants') against the judgment by which the General Court dismissed the actions which they had brought against the decisions of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) declaring invalid Community trade marks which they own: BOTOLIST and BOTOCYL.

I – Background to the dispute, proceedings before the General Court and the judgment under appeal

2. The facts and the procedure before OHIM, as described in the judgment under appeal, are reproduced briefly as follows.

3. On 6 May 2002 and 9 July 2002 respectively, Helena Rubinstein and L'Oréal filed an application with OHIM for registration of Community trade marks under Regulation No 40/94, as amended. (2) They sought to register the word signs BOTOLIST (Helena Rubinstein) and BOTOCYL (L'Oréal) for goods in Class 3 of the Nice Agreement, (3) including, in particular, cosmetics such as creams, milks, lotions, gels and powders for face, body and hands. The Community trade marks BOTOLIST and BOTOCYL were registered on 19 November 2003 and 14 October 2003 respectively. On 2 February 2005, Allergan, Inc. ('Allergan') filed an application with OHIM for a declaration of invalidity, in respect of both marks, on the basis of various earlier Community and national figurative and word marks having the sign BOTOX as their subject and registered between 12 April 1991 and 7 August 2003, chiefly for goods in Class 5 of the Nice Agreement, including – in so far as is relevant for present purposes – pharmaceutical preparations for the treatment of wrinkles. The applications were based on

Article 52(1)(a) of Regulation No 40/94, read in conjunction with Article 8(1)(b) and Article 8(4) and (5) of that regulation. By decisions of 28 March 2007 (BOTOLIST) and 4 April 2007 (BOTOCYL), the Cancellation Division of OHIM rejected the applications for a declaration of invalidity. On 1 June 2007, Allergan filed a notice of appeal against those decisions under Articles 57 to 62 of Regulation No 40/94. By decisions of 28 May 2008 (BOTOLIST) and 5 June 2008 (BOTOCYL), the First Board of Appeal of OHIM upheld the appeals brought by Allergan in so far as they were based on Article 8(5) of Regulation No 40/94 ('the contested decisions').

4. Helena Rubinstein and L'Oréal brought actions for the annulment of those decisions before the General Court. In support of their actions, they raised two pleas in law: (i) infringement of Article 8(5) of Regulation No 40/94 and (ii) infringement of Article 73 of Regulation No 40/94. OHIM lodged a response in both cases, contending that the actions should be dismissed and the applicants ordered to pay the costs. Allergan did not defend those actions.

5. The General Court joined the proceedings and, by judgment of 16 December 2010 ('the judgment under appeal'), dismissed both actions and ordered Helena Rubinstein and L'Oréal to pay the costs. (4) The judgment under appeal was notified to Allergan, as well as to Helena Rubinstein, L'Oréal and OHIM.

II – Procedure before the Court of Justice

6. By application lodged at the Court Registry on 2 March 2011, Helena Rubinstein and L'Oréal appealed against that judgment. The appeal was notified to OHIM and to Allergan, which contended in their respective responses that the Court should dismiss the appeal and order the appellants to pay the costs. At the hearing on 11 January 2012, oral argument was put forward by the representatives of Helena Rubinstein, L'Oréal and Allergan, and by the agent of OHIM.

III – Appeal

7. In support of their appeal, Helena Rubinstein and L'Oréal rely on four grounds: (i) infringement of Article 52(1) of Regulation No 40/94, read in conjunction with Article 8(5) thereof; (ii) infringement of Article 115 of Regulation No 40/94 and Rule 38(2) of Regulation No 2868/95; (iii) infringement of Article 63 of Regulation No 40/94; and (iv) infringement of Article 73 of Regulation No 40/94.

A – First ground of appeal: infringement of Article 52 of Regulation No 40/94, read in conjunction with Article 8(5) thereof

8. Paragraph 1(a) of Article 52 of Regulation No 40/94, which is entitled 'Relative grounds for invalidity', provides that '[a] Community trade mark shall be declared invalid on application to [OHIM] ... where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in ... paragraph 5 of that Article are fulfilled'. Paragraph 5 of Article 8 of Regulation No 40/94, which is entitled 'Relative grounds for refusal', provides that, upon opposition by the proprietor of an earlier trade mark, 'the trade mark applied for shall not be registered where it is identical

with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, 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.'

9. By their first ground of appeal, Helena Rubinstein and L'Oréal take issue with the judgment under appeal in so far as the General Court found that the earlier trade marks have a reputation and concluded that use of the appellants' marks without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier marks. That ground of appeal is presented as four complaints.

1. First complaint

a) Arguments of the parties and the judgment under appeal

10. In support of the first complaint, Helena Rubinstein and L'Oréal submit that the General Court erred in law in basing its appraisal on two earlier marks registered in the United Kingdom, which had not been taken into consideration by the Board of Appeal. They argue that the Board of Appeal based its findings solely on the earlier Community figurative and word mark, No 2015832, registered on 12 February 2002 ('the earlier Community trade mark' or 'the Community trade mark BOTOX'). OHIM interprets the first complaint as a claim alleging distortion of the facts which is not, however, evident from the documents in the file. OHIM also contends that the appellants did not state how the choice of earlier trade marks to be taken into consideration had any effect on the resolution of the dispute. According to Allergan, the complaint is unfounded since it is clear from the contested decisions that the Board of Appeal based its findings on all the earlier rights relied on in support of the applications for a declaration of invalidity.

11. The first complaint is directed at paragraphs 38 to 40 of the judgment under appeal. In paragraph 38, the General Court notes, as a preliminary point, that the applications for a declaration of invalidity submitted to OHIM are based on a number of national and Community figurative and word marks containing the sign BOTOX, almost all of which were registered before the marks applied for, BOTOLIST and BOTOCYL, were filed. It points out that all those trade marks – and not merely the earlier Community trade mark – constitute the earlier marks relied on by Allergan, the applicant for a declaration of invalidity. In paragraph 39, the General Court observes that the Board of Appeal 'implicitly but necessarily' took a different approach from that taken by the Cancellation Division, which had based its decisions solely on the earlier Community trade mark. According to the General Court, that approach on the part of the Board of Appeal is illustrated by the fact that it does not refer,

in the contested decisions, to the figurative element of the earlier Community trade mark. In paragraph 40 of the judgment under appeal, the General Court stated that its examination of the various earlier rights relied on would be limited to the two marks registered in the United Kingdom (5) and, as justification for that choice, stated that most of the evidence submitted by Allergan concerned the territory of that Member State.

b) Appraisal

12. I would point out, first, that the definition of the earlier rights to be taken into consideration for the purposes of assessing whether the conditions relating to reputation, laid down in Article 8 (5) of Regulation No 40/94, are satisfied is not without effect on the outcome of that examination. The Community trade mark BOTOX, which – according to Helena Rubinstein and L'Oréal – is the only earlier right taken into account by the Board of Appeal, was registered just a few months before the applications for registration of the marks BOTOCYL and BOTOLIST were filed. (6) Accordingly, it is less easy to prove that that trade mark had acquired a reputation by that time than it is in the case of the national trade marks considered by the General Court. (7)

13. That said, I would observe that the arguments which the appellants put forward in the context of the complaint under consideration are no more than statements of the obvious, devoid of anything to corroborate their argument that the Board of Appeal – like the Cancellation Division – based its appraisal solely on the earlier Community trade mark. Moreover, that argument appears to be contradicted, or at least not to be supported, by the wording of the contested decisions, in which the Board of Appeal refers generally to the 'mark BOTOX' to denote all the rights invoked by Allergan. That, in my view, is made sufficiently clear in paragraph 3 of the contested decisions, in which, after listing the Community and national marks on which Allergan relies, the Board of Appeal sets out the arguments put forward by Allergan, referring to the 'mark BOTOX' as including national, Community and international registrations. (8) Later in the decisions, the Board of Appeal refers repeatedly to the 'mark BOTOX', both when rehearsing Allergan's arguments and when setting out its own reasons (see, for example, paragraph 34 of the Helena Rubinstein decision and paragraph 35 of the L'Oréal decision). Furthermore, in paragraph 23 of those decisions, the Board of Appeal states that 'la marque contestée ... est à comparer avec la marque BOTOX, enregistrée sous différentes versions (verbale, figurative, accompagnée de la légende "Botulinum Toxin").' That statement is incompatible with the appellants' claim – that the Board of Appeal, like the Cancellation Division, took account solely of Community trade mark No 2015832 – since it is both a word and a figurative mark and is not accompanied by any caption. At that point in the contested decisions, the Board of Appeal clearly refers to all the rights invoked by Allergan and not only to the mark mentioned by Helena Rubinstein and L'Oréal. Lastly, as both OHIM and Allergan point out, the fact

that the General Court did not take any account of the figurative element of the Community trade mark in assessing the similarity of the marks under comparison militates against the appellants' argument.

14. On the basis of the considerations set out above, I consider that the first complaint under the first ground of appeal should be dismissed.

2. Second complaint: reputation of the earlier marks

15. By the second complaint, Helena Rubinstein and L'Oréal claim that the General Court made various errors in law by concluding that proof had been furnished of the reputation of the earlier marks. Those criticisms – the admissibility or merits of which OHIM and Allergan contest on the basis of largely convergent arguments – are examined separately below.

a) The relevant public

16. First, the appellants argue that, although it is common ground that the relevant public is composed of health professionals and actual or potential users of BOTOX therapy, the General Court failed to assess the reputation of the earlier marks separately in relation to those two categories.

17. In that respect, it must above all be made clear that, according to the finding made by the General Court in paragraph 26 of the judgment under appeal, the parties agree that the relevant public is composed here of the general public (and thus not merely, as Helena Rubinstein and L'Oréal argue, of actual or potential users of BOTOX treatments) and of health professionals. In those circumstances, it does not seem to me that the appellants' argument can succeed, primarily for the obvious reason – accepted by both OHIM and Allergan – that a separate assessment, for each category, of the reputation of the earlier marks did not appear necessary, as the category of 'health professional' is covered by the more general category of the 'general public'. In any event, contrary to the assertions made by the appellants, the General Court did draw the distinction when, in reviewing the evidence produced by Allergan in support of its application for a declaration of invalidity, it carried out a separate examination of the evidence intended to show the reputation of the earlier marks with the general public (media coverage in the general-interest press) and that intended to show such reputation in specialist medical circles (promotional activity through the publication of articles in specialist journals).

b) The relevant territory

18. Secondly, Helena Rubinstein and L'Oréal argue that, in common with the contested decisions, the judgment under appeal contains no findings concerning the territory in respect of which the reputation of the BOTOX marks was assessed.

19. That criticism, too, has no basis in fact. Contrary to the assertions made by the appellants, the General Court made it clear, in paragraphs 40 and 41 of the judgment under appeal, that the conditions laid down in Article 8(5) of Regulation No 40/94 would be examined in the light of the perception of consumers in the United Kingdom, since that was the territory in respect of which Allergan had produced most evidence.

c) Evidence of reputation

20. Thirdly, the appellants submit that the General Court made a number of errors in assessing the evidence produced for the purposes of establishing the reputation of the earlier marks. Before turning to consider the individual allegations, it is relevant to observe that in the judgment under appeal the General Court examined that evidence separately in order to respond to the various arguments by which Helena Rubinstein and L'Oréal were contesting its admissibility, relevance or evidential value. However, as OHIM and Allergan have correctly pointed out, it is clear from the grounds of the judgment under appeal that the conclusions which the General Court reaches as to the reputation of the earlier marks are based on an assessment of all the evidence and, accordingly, even if the Court of Justice were to hold that the arguments on one item or other of that evidence were well founded, that would not necessarily invalidate those conclusions, as it is still necessary to determine the weight, in the overall assessment carried out by the General Court, of the evidence to be disregarded. No reference to this is made in the appeal.

21. That said, it should also be noted, as a preliminary point, that the essential purpose of some of the submissions made by the appellants is to bring about a re-examination of the evidence, which – save where the clear sense of the evidence has been distorted – the Court of Justice does not have jurisdiction to carry out in appeal proceedings. (9) For those reasons, the arguments which the appellants put forward in order to contest the evidential value of the data relating to the volume of sales in the United Kingdom of the goods covered by the earlier marks (paragraphs 46 and 47 of the judgment under appeal) and of the articles published in scientific journals (paragraphs 48 and 49 of the judgment under appeal) are, in my view, inadmissible.

22. As regards the evidence examined by the General Court in paragraphs 50 to 54 of the judgment under appeal, which consists of certain articles published in Newsweek and The International Herald Tribune, the appellants argue that, in order to avoid distorting that evidence, it should have been considered together with further evidence such as the 'distribution area' of those publications. The appellants also allege distortion of the evidence as regards a market survey carried out in September and October 2004 in the United Kingdom and produced by Allergan as an annex to the appeals before the Board of Appeal of OHIM. More specifically, the appellants contest the relevance of that survey in the absence of evidence, which it was for Allergan to furnish, that the data reported in that survey were capable of providing information on the situation existing on the date on which the applications for registration of the contested marks were filed. Lastly, the appellants allege distortion of the facts to contest the relevance of the evidence, examined in paragraphs 55 and 56 of the judgment under appeal, consisting in the inclusion of the word BOTOX in various dictionaries published in the United Kingdom.

23. As regards all the claims set out in the preceding point, I would observe that, according to settled case-law, distortion of the facts must be obvious from the documents in the case-file, without there being any need to carry out a new assessment of the facts and the evidence. (10) In the present case, far from meeting the stringent standard of proof required to establish distortion of the evidence or the facts by the General Court, the arguments put forward by Helena Rubinstein and L'Oréal in the appeal are no more than statements so general and unsubstantiated as to cast doubt on their own admissibility, since they fail to satisfy the requirements regarding the clarity and precision with which grounds of appeal must be framed.

24. Lastly, the appellants contest the relevance of the decision of 26 April 2005 of the United Kingdom Intellectual Property Office, given in proceedings brought by Allergan for cancellation of the registration of the mark BOTOMASK for cosmetics in the United Kingdom. They maintain that a decision adopted in different proceedings, brought by different parties, cannot constitute evidence in the dispute between them and Allergan. In basing its findings on that decision, the General Court erred in law.

25. Those claims should, in my view, be rejected as unfounded. Although, according to settled case-law, the General Court is not bound by the content of decisions of national judicial or administrative bodies, the fact remains that, where such decisions are submitted by the parties, the findings contained therein may, where relevant, be taken into account by the General Court for the purposes of assessing the facts, as evidence which it is free to appraise. The fact that the decisions were given in connection with disputes in which the parties and the matters at issue were different from those in the dispute pending before the General Court is immaterial in that regard. I also note that the appellants have not put forward any argument to contest the correctness of the findings made in that decision of the United Kingdom Intellectual Property Office, either before OHIM or before the General Court, as is clear from paragraph 58 of the judgment under appeal. Nor do the appellants contest, in the present proceedings, the correctness of the interpretation which the General Court placed on the content of that decision. d)

Conclusion on the second complaint

26. In the light of the foregoing, I consider that the second complaint under the first ground of appeal should be rejected in its entirety.

3. Third complaint: existence of a link between the earlier marks and the appellants' marks

27. By the third complaint under the first ground of appeal, the appellants contest the finding made in the judgment under appeal that the relevant public will establish a link between the earlier marks BOTOX and the marks BOTOLIST and BOTOCYL, which the appellants own. According to the appellants, such a link cannot, in particular, be based on the common element 'BOT' or 'BOTO', since that is a descriptive element which refers to the botulinum toxin. The appellants claim the right to include that element, which is used in

general to indicate the toxin in question, in their mark without being accused, on that ground, of attempting to link their marks with Allergan's marks.

28. In so far as they are seeking to obtain from the Court of Justice a ruling on the purportedly distinctive character of the mark BOTOX or of its components, the arguments on which the appellants rely are in any event inadmissible in that they entail an assessment of the facts by the Court. On the other hand, a point of law was raised by the argument that the appellants are entitled to use in their own marks an element shared by a different mark where that element has descriptive character. However, that argument is based on the claim that the element BOT or the element BOTO – common to the appellants' marks and the earlier marks – does in fact have distinctive character, a claim which not only is absent from the judgment under appeal, (11) but was expressly contradicted in the contested decisions (12) and which, as I have just noted, the Court of Justice does not have jurisdiction to revisit.

29. In the light of the foregoing, the third complaint under the ground of appeal should, in my view, be rejected.

4. Fourth complaint: damage caused to the earlier marks

30. In the context of their first ground of appeal, the appellants contest, lastly, the grounds set out in paragraphs 87 and 88 of the judgment under appeal concerning the 'effects of the use' of the marks at issue. Before explaining the substance of those criticisms, it is appropriate to summarise, in accordance with the case-law as it currently stands, the principles underlying the protection of trade marks which have a reputation, especially in the case of 'parasitism', which is the issue which arises in the present case.

31. So far as is relevant for present purposes, those principles were laid down by the Court of Justice in three preliminary rulings – in Intel, L'Oréal and Interflora (13) – on the interpretation of Articles 4(4)(a) and 5(2) of Directive 89/104, which lay down, as we know, provisions similar to that made under Article 8(5) of Regulation No 40/94. As will become clearer below, the circumstances of the present case do not require a detailed examination of those rulings or consideration of the merits of the choices made by the Court, which inevitably attracted criticism, especially from academic legal writers across the Channel in that they were deemed to be excessively favourable to the owners of trade marks with a reputation. (14) It is sufficient for present purposes to recall, generally, that in those judgments the Court of Justice made it clear that the specific condition for the protection which the above provisions of Directive 89/104 grant to trade marks which have a reputation consists in 'a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark'. (15) The resulting damage to the earlier trade mark is, according to the Court, 'the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the

public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them'. (16) The existence of such a link in the mind of the relevant public constitutes a condition which is necessary but not, of itself, sufficient to support the conclusion that the conditions for the protection granted to trade marks with a reputation are satisfied. (17) Furthermore, the owner of the earlier trade mark must furnish proof that use of the later sign or mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'. To that end, the owner of the earlier trade mark is required to prove, not that there is actual and present injury, but rather that 'there is a serious risk that such an injury will occur in the future'. (18) Where such proof is furnished, it is for the proprietor of the later mark to establish due cause for using that mark. (19)

32. As regards, more specifically, the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark' (also referred to as 'parasitism' or 'free-riding'), the Court stated in L'Oréal that that concept relates not to the detriment caused to the mark but 'to the advantage taken by the third party as a result of the use of the identical or similar sign'. According to the Court, it covers, in particular, 'cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation'. It follows that 'an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor'. (20) The Court subsequently made it clear, as from Intel, that in order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the earlier mark, it is necessary to undertake an overall assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. (21) As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has held that the stronger the distinctive character and reputation of the mark, the easier it will be to accept that detriment has been caused to it (22) and the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them. (23) Any such overall assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark. (24) Lastly, the Court ruled that where it is clear from such an overall assessment

that 'a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark'. (25) In *Interflora* the Court confirmed the above principles. (26) It emphasised in particular that the advantage described above must be regarded as gained unfairly where there is no 'due cause' for the purposes of the relevant provisions of Directive 89/104. (27) With reference to the case referred to it by the national court, concerning an advertisement accessible on the Internet on the basis of a key word corresponding to a mark with a reputation, the Court held that where an advertisement puts forward – without offering for sale a mere imitation of the goods or services of the proprietor of that trade mark, (28) without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark with a reputation – an alternative to the goods or services of the proprietor of that mark, such use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without 'due cause' for the purposes of the above provisions. (29)

33. In the paragraphs of the judgment under appeal which are criticised in the submission under consideration, the General Court – after describing as 'terse' the reasons set out in the Board of Appeal's decisions concerning the existence of any 'detriment' for the purposes of Article 8(5) of Regulation No 40/94 (paragraph 87) – pointed out that this matter had 'been the subject of significant arguments in the course of the administrative proceedings and before the [General] Court'. It went on to explain that Allergan had 'stated that both the mark BOTOLIST and the mark BOTOCYL, which were registered together by the L'Oréal group, actually seek to take advantage of the distinctive character and repute acquired by BOTOX for the treatment of wrinkles, which will have the effect of decreasing the value of that mark'. According to the General Court, '[t]hose risks are sufficiently serious and real to justify the application of Article 8 (5) of Regulation No 40/94'. It then recalled that the applicants had acknowledged at the hearing that, even though their goods did not contain the botulinum toxin, they nevertheless intended to take advantage of the image which was associated with that product, which is to be found in the trade mark BOTOX, a trade mark which is unique in that regard (30) (paragraph 88).

34. Paragraph 80 of the judgment under appeal supplements the grounds set out in paragraphs 87 and 88. In paragraph 80, the General Court observes, as a preliminary point, that Helena Rubinstein and L'Oréal had not adduced any evidence to show that there was

'due cause' for the use of the marks BOTOCYL and BOTOLIST and, since it was a ground of defence, it was for Helena Rubinstein and L'Oréal to set out the content of such 'due cause'. I would point out that the appellants make no criticism either of the finding of failure to identify 'due cause' or of the statement, consistent with case-law, (31) that the burden of proving due cause lay with Helena Rubinstein and L'Oréal. (32) Consequently, the question whether there was due cause for the use of the appellants' marks in this case goes beyond the subject-matter of the present proceedings. (33)

35. The criticisms made by the appellants in connection with the objection under consideration are the subject of an extremely succinct account in the appeal document. Essentially, the appellants do no more than assert that there is no proof that they had intended, as alleged, to take unfair advantage of the distinctive character or the repute of the mark BOTOX. They also submit that the General Court misinterpreted the statements made by their counsel at the hearing and that, although their marks might possibly contain a reference to the botulinum toxin, they did not intend to be associated with the mark BOTOX; nor could they hope to establish such an association, since it was a mark registered for pharmaceutical preparations available only on prescription.

36. It is apparent from all the grounds of the judgment under appeal that the existence of parasitic intent is inferred from a number of findings which concern, on the one hand, the fact that Helena Rubinstein and L'Oréal opted to use in their marks a prefix which reproduces almost all of the earlier mark – a decision which, in the view of the General Court and, before it, the Board of Appeal, (34) cannot be justified by the intention to refer to the botulinum toxin which, moreover, does not form part of the goods covered by the contested marks (35) – and, on the other, the characteristics of the earlier mark, that is to say, its strong distinctive character, owing also to its uniqueness and widespread reputation. Contrary to the assertions made by the appellants, therefore, the General Court specifically made an overall assessment, in line with the case-law of the Court of Justice referred to above, of the factors relevant to the case. In those circumstances, the appellants' argument that the determination of parasitic intent is not supported by any evidence is unfounded. As for the findings on which that determination is based, they are not, given their factual nature, (36) amenable to review by the Court of Justice.

37. Referring solely to the decisions of the Board of Appeal, the appellants contest the relevance of the reference to the 'specificity' and 'uniqueness' of the mark BOTOX, which, in their view, are relevant factors in the case of dilution of the mark, but not in the case of parasitism. If that criticism is to be regarded as applying to the judgment under appeal, in which the General Court also refers to those factors and to the risk of 'decreasing the value of that mark' (paragraph 88), then it should be rejected. As we have seen above, the

Court of Justice has already had occasion to state that the risk of detriment to the distinctive character or repute of the mark, albeit not a necessary condition for there to be parasitism, constitutes, where it is found, a factor to be taken into consideration in determining whether or not an unfair advantage exists.

38. On the basis of the considerations set out above, I consider that the fourth complaint under the first ground of appeal should also be rejected.

5. Conclusion on the first ground of appeal

39. In the light of all the foregoing considerations, the first ground of appeal should, in my view, be rejected in its entirety.

B – Second ground of appeal: infringement of Article 115 of Regulation No 40/94, read in conjunction with Rule 38(2) of Regulation No 2868/95 (37)

1. References to legislation, arguments of the parties, and the judgment under appeal

40. Under Article 115(5) of Regulation No 40/94, the notice of opposition and an application for revocation or invalidity are to be filed in one of the languages of OHIM.

41. Rule 38(2) of Regulation No 2868/95 provides that, where the evidence in support of the application is not filed in the language of the revocation or invalidity proceedings, the applicant is to file a translation of that evidence into that language within a period of two months after the filing of such evidence. The provisions relating to those proceedings do not specify the consequences of failure to fulfil that obligation. However, as regards opposition proceedings, Rule 19(4) of Regulation No 2868/95, as amended by Regulation No 1041/2005, (38) provides that OHIM 'shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by [OHIM].'

42. The appellants submit that the General Court infringed Article 115 of Regulation No 40/94 and Rule 38 of Regulation No 2868/95 by confirming the admissibility as evidence of certain articles published in English in the specialist and general-interest press and not translated into French, which was the language of the proceedings, and by basing findings on those documents. OHIM responds by stating that, in contrast with the provision made under Rule 19 of Regulation No 2868/95 in relation to opposition proceedings, Rule 38(2) of that regulation does not provide for any penalty if an applicant for revocation or for a declaration of invalidity fails to file translations into the language of proceedings of the documents submitted as evidence. According to OHIM, such documents are therefore admissible, unless a translation thereof is requested, of the adjudicating authority's own motion or at the request of a party, within a specified period and that translation is not filed or is not filed in good time. OHIM, supported on that point by Allergan, adds that the absence of those translations in no way impeded the exercise by the appellants of their rights of

defence, either in the course of the administrative procedure or before the General Court.

43. In paragraph 54 of the judgment under appeal, the General Court notes that 'the very existence' of the articles in question 'constitutes a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX with the general public, irrespective of the positive or negative content of those articles'. It goes on to state that '[t]he evidential value of those documents cannot be dependent as such on their translation into the language of the proceedings ...' and that '[s]uch a translation ... cannot be set up as a condition of admissibility of a document provided as evidence'.

2. Appraisal

44. I am unconvinced by OHIM's argument, which, moreover, has no place in the line of reasoning of the General Court, which does not rule on the consequences of failure to file a translation for the purposes of Rule 38 of Regulation No 2868/95, but in essence merely states that, in the case before it, a translation was not necessary. OHIM's argument relies on an interpretation of that rule which is argued for a contrario sensu from Rule 19 of that regulation, as amended by Regulation No 1041/2005. It should be noted that Regulation No 1041/2005 also amended Rule 98 of Regulation No 2868/95, which is entitled 'Translations'. As now worded, that rule states that, save where Regulation No 40/94 or Regulation No 2868/95 provides otherwise, 'a document for which a translation is to be filed shall be deemed not to have been received by [OHIM] ... where the translation is received by [OHIM] after expiry of the relevant period for submitting the original document or the translation'. In consequence, even supposing that the amended version of Regulation No 2868/95 is applicable to the facts of the case, it is not possible, in my view, to infer from the absence, in Rule 38, of an express penalty for failure to file the translation of a document and from the different rules laid down in Rule 19 in respect of opposition proceedings, that such a document is nevertheless admissible, save where OHIM has provided otherwise. Such an interpretation is at odds with Rule 98, which is laid down as a closing provision for cases where a translation is filed out of time, and is applicable a fortiori where no translation is filed at all. It should also be noted that, before it was amended by Regulation No 1041/2005, Rule 19 was couched in substantially identical terms to Rule 38 and was interpreted by the General Court as meaning that failure to file a translation into the language of proceedings meant that the document concerned was inadmissible. (39)

45. However, it does not seem entirely possible to agree with the reasoning followed in the judgment under appeal, at least when applied to the circumstances of the case. While not absolutely excluding the admissibility of documentary evidence whose written elements do not need to be translated or translated in full, where their evidential value does not actually depend on their content or they are

immediately comprehensible, that does not seem to me to be the position in the case of press articles which have been produced by a party in order to show that information had been disseminated regarding the therapeutic characteristics of a pharmaceutical preparation and that there was a broad awareness of that information among a specialist public and/or the public at large at a date before the date on which it was published (see paragraphs 51 and 52 of the judgment under appeal).

46. Accordingly, the General Court erred in confirming the admissibility as evidence of the articles produced by Allergan before OHIM which had not been translated into the language of proceedings. However, it is an error which concerns the appraisal of the evidence (40) and, as such, no objection can be raised to it in the present proceedings. In any event, even if that error could be categorised as an 'error in law', I do not consider it sufficient in itself to justify annulment of the judgment under appeal. The rule that evidence in support of the claims of the opponent or applicant for a declaration of invalidity or revocation of the trade mark must be submitted in the language of the proceedings or be accompanied by a translation into that language is justified by the need to observe the principle of *audi alteram partem* and to ensure equality of arms between the parties in *inter partes* proceedings. (41) In the present case, the irregularity committed by the Board of Appeal, which was not pointed out by the General Court, did not prevent Helena Rubinstein and L'Oréal from defending themselves effectively either at first instance or in the present proceedings. By their own admission, they understood the content of the articles in question. Moreover, as is clear from their written submissions before the General Court and the Court of Justice, they fully understood the evidential value attached to those articles, first by the Board of Appeal, and then by the General Court.

47. In those circumstances, I consider that, although it is partially well-founded, the second ground of appeal must be rejected.

C – Third ground of appeal: infringement of Article 63 of Regulation No 40/94

48. By the third ground of appeal, the appellants essentially submit that the General Court substituted its own appraisal for that of the Board of Appeal, in breach of Article 63 of Regulation No 40/94, which defines the limits of the Court's jurisdiction to review OHIM decisions.

49. They also claim that the General Court above all substituted itself for the Board of Appeal in finding that the UK registrations of the mark BOTOX were relevant earlier rights. That criticism falls to be rejected, as it is based on the false premiss that the Board of Appeal, unlike the General Court, based its analysis solely on one of Allergan's Community trade marks. (42)

50. At a general level, the appellants go on to allege that the General Court undertook an independent appraisal of the evidence, which replaced the inadequate appraisal by the Board of Appeal. That complaint must also, I think, be rejected. Although the

grounds of the judgment under appeal show a more detailed analysis of the evidence produced by Allergan before the OHIM adjudicating bodies than that which is evident from the reasons for the contested decisions, this is because at first instance Helena Rubinstein and L'Oréal contested the admissibility and/or evidential value of each item of that evidence. The findings which the General Court makes at the end of that analysis – that is to say, that the documents analysed show vast media coverage of BOTOX products – do not differ from those made by the Board of Appeal. In those circumstances, the appellants have failed to prove that their claims are well founded.

51. Lastly, and more specifically, the appellants allege that the General Court based its findings on certain documents – a statement by a director of Allergan and a market survey carried out in 2004 – which were first produced before the Board of Appeal and which, according to the appellants, were not taken into consideration by the Board of Appeal because they were submitted out of time. The appellants claim that the General Court exceeded its review jurisdiction by concluding that the Board of Appeal had found 'implicitly but necessarily' that that evidence was admissible.

52. I would observe that, in paragraph 62 of the judgment under appeal, the General Court – after pointing out that, under Article 74(2) of Regulation No 40/94, OHIM has broad discretion in deciding on the admissibility of evidence not submitted in due time – explains that, given that the Board of Appeal did not expressly declare inadmissible the evidence consisting in the above documents, it implicitly but necessarily found that they were admissible. The contested finding flows, therefore, from the application to this specific case of the interpretation of Article 74(2) of Regulation No 40/94 adopted by the General Court in the judgment under appeal. The appellants' arguments do not demonstrate how the General Court could have exceeded the limits of its jurisdiction to review decisions of the OHIM Board of Appeal, as provided for under Article 63 of Regulation No 40/94, merely by interpreting and applying the law in that way. The applicants' complaint should therefore be rejected.

53. On the other hand, what does give rise to uncertainty is the correctness of the interpretation of Article 74(2) which the General Court adopts in the judgment under appeal. It appears to interpret that provision as requiring the adjudicating bodies of OHIM to make an express declaration only as to the inadmissibility of evidence not submitted in due time and not also as to its admissibility. Such an interpretation is at odds with that of the Court of Justice, which undoubtedly takes greater heed of the conflicting interests involved in *inter partes* proceedings before OHIM. In *Kaul*, a judgment pronounced by the Grand Chamber, the Court of Justice clearly stated that OHIM is required to give reasons for its decision, either where it decides not to take such evidence into consideration or where, conversely, it does decide to do so. (43) However, since

the appellants have not in their appeal alleged an infringement, on the grounds set out, of Article 74(2) of Regulation No 40/94, no objection can be raised in the present proceedings to the error of interpretation committed by the General Court. 54. In the light of the foregoing, the third ground of appeal must, in my view, be rejected.

D – Fourth ground of appeal: infringement of Article 73 of Regulation No 40/94

55. By the fourth ground of appeal, the appellants allege the infringement of Article 73 of Regulation No 40/94, under which reasons must be stated for OHIM decisions. They claim that the General Court wrongly omitted to criticise the absence of a statement of reasons for the decisions on two points: (i) the finding that the marks BOTOX have a reputation and (ii) the finding that there is detriment to those trade marks from the use made of the appellants' marks.

56. The scope of Article 73 of Regulation No 40/94 can be defined by reference to the case-law on the duty to state reasons for acts of the European Union institutions. The same is true of the principles applicable to verifying that that duty has been fulfilled. Thus, the statement of reasons required under that provision must show in a clear and unequivocal manner the reasoning of the body responsible for the act. The duty imposed on the adjudicating bodies of OHIM to state reasons has two purposes: (i) to enable interested parties to know the justification for the measure, so as to enable them to protect their rights and (ii) to enable the Courts to exercise their jurisdiction to review the legality of the decision.

57. In paragraph 93 of the judgment under appeal, the General Court finds that the reasons stated for the contested decisions make it possible to understand why, in the view of the Board of Appeal, the trade mark BOTOX has a reputation. The appellants' arguments do not, in my view, make it possible for that finding to be called into question. It is clear from those decisions that the Board of Appeal considered that the mark BOTOX had a reputation in all the Member States; that that reputation was not only a consequence of the marketing of the BOTOX products but also of the indirect publicity for those products through the media; and, lastly, that that publicity had familiarised the general public with the botulinum toxin and its use for the treatment of wrinkles (paragraph 35 of the L'Oréal decision and paragraph 34 of the Helena Rubinstein decision). That statement of reasons makes it possible to reconstruct the Board of Appeal's line of argument and identify the reasons which led it to find that the earlier trade mark had a reputation. Contrary to the assertions made by the appellants, the Board of Appeal was not required to give an account of the examination of each individual item of evidence produced by Allergan, particularly in view of the fact that it is evident from the above reasons that the Board of Appeal considered that much of that evidence, considered as a whole, helped to demonstrate the same fact, that is to say, the media coverage of the BOTOX products.

58. In paragraph 94 of the judgment under appeal, the General Court states that although the statement of reasons for the contested decisions on the effects of the use of the appellants' marks was 'terse', it allowed them to have the necessary information to contest the Board of Appeal's findings in that regard. The appellants merely observe that what the General Court calls a statement of reasons consists of just two sentences and states the obvious, that is to say, that it does not constitute a 'statement of reasons in the legal sense'. Contrary to the assertions made by the appellants, paragraphs 42 and 43 of the Helena Rubinstein decision and paragraphs 44 and 45 of the L'Oréal decision show the reasons which led the Board of Appeal, on the one hand, to find that there was no due cause to use the appellants' marks and, on the other, to consider that the appellants had taken unfair advantage of the distinctive character of the mark BOTOX.

59. In the light of the foregoing, I consider that the fourth and final ground of appeal must be rejected.

IV – Conclusions

60. In the light of all the above considerations, I therefore propose that the Court dismiss the appeal and order the appellants to pay the costs.

1 – Original language: Italian.

2 – Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1). With effect from 13 April 2009, Regulation No 40/94 was replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

3 – Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957.

4 – Joined Cases T-345/08 and T-357/08 Rubinstein v OHIM- Allergan (BOTOLIST), [2010] ECR II-0000.

5 – Registrations No 2255853 and 2255854. They are national marks which, of those on which Allergan relies, were registered earlier, inter alia for pharmaceutical preparations for the treatment of wrinkles.

6 – A little under three months in the case of the mark BOTOLIST and a little over five months in the case of BOTOCYL.

7 – Registered on 14 December 2000.

8 – The relevant passages are worded as follows: 'la demanderesse en nullité a expliqué que la marque BOTOX identifie un produit pharmaceutique vendu sous prescription, fabriqué à partir de la toxine botulique ...' 'Elle a indiqué que sa marque a été enregistrée aux États-Unis en 1991, qu'elle est utilisée dans l'Union européenne depuis 1992 et qu'elle est enregistrée dans la plupart des pays du monde ...'

9 – See Case C-551/03 P General Motors v Commission [2006] ECR I-3173, paragraph 52; Case C-266/06 P Evonik Degussa v Commission [2008] ECR I-81, paragraph 73; and Case C-419/08 P Trubowest Handel and Makarov v Council and Commission [2010] ECR I-2259, paragraph 31.

10 – See General Motors, paragraph 54; Degussa, paragraph 74; and Trubowest Handel and Makarov v Council and Commission, paragraph 32.

11 – Before the General Court Helena Rubinstein and L'Oréal contested the Board of Appeal's appraisal on the ground that it had compared the marks in question by taking into consideration the prefix BOTO and not the syllable BOT which had distinctive character since it referred obviously and clearly to the active ingredient of the pharmaceutical preparation marketed under the mark BOTOX (the botulinum toxin). The General Court responded to that argument in paragraphs 72 and 73 of the judgment under appeal, rejecting it as unfounded. It observed in particular that the syllable BOT has no particular meaning and that Helena Rubinstein and L'Oréal had put forward no reason as to why it should be preferred, in the appraisal of the similarity of the marks, to the prefix 'BOTO', which was taken into consideration by the Board of Appeal. The General Court added that, even if the mark BOTOX were originally descriptive, it had acquired distinctive character through use, at least in the United Kingdom.

12 – See paragraph 40 of the L'Oréal decision and paragraph 39 of the Helena Rubinstein decision.

13 – Case C-252/07 Intel Corporation [2008] ECR I-8823; Case C-487/07 L'Oréal and Others [2009] ECR I-5185; and Case C-323/09 Interflora and Others [2011] ECR I-0000.

14 – See, for example, D. Gangjee and R. Burrell, *Because You're Worth It: L'Oréal and the Prohibition on Free Riding*, *The Modern Law Review*, Vol. 73 (2010), No 2, pp. 282 to 304.

15 – See Intel, paragraph 26.

16 – See Intel, paragraph 30.

17 – See Intel, paragraphs 31 and 32.

18 – See Intel, paragraphs 37 and 38.

19 – See Intel, paragraph 39.

20 – See L'Oréal, paragraphs 41 and 43. These are the grounds on which the academic legal writers, mentioned in footnote 14, focus their criticisms.

21 – See Intel, paragraphs 67 to 69 and L'Oréal, paragraph 44.

22 – See L'Oréal, paragraph 44.

23 – See Intel, paragraphs 67 to 69.

24 – See L'Oréal, paragraph 45.

25 – See L'Oréal, paragraph 49.

26 – See, in particular, paragraphs 74 and 89.

27 – Paragraph 89.

28 – The situation at issue in L'Oréal.

29 – Paragraph 91.

30 – The General Court refers to paragraph 56 of Intel, in which the Court of Justice stated that the distinctive character of a mark is all the stronger if that mark is unique, that is to say, as regards a word mark, 'if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets'.

31 – See Intel, paragraph 39.

32 – At first instance, Helena Rubinstein and L'Oréal merely submitted that the file examined by the Board

of Appeal contained no proof that they had acted without 'due cause' in filing their trade marks (judgment under appeal, paragraph 31). However, as we have seen, it has been made clear in case-law that, where the owner of the earlier trade mark furnishes proof of that mark's reputation and the existence of an unfair advantage arising from the use of the later sign or mark, it is for the owner of the later mark to assert due cause for such use.

33 – When questioned on this point at the hearing before the Court of Justice, the appellants' representative explained that the appellants were not required to show any due cause for the use of their marks, given that they had previously disputed the claim that proof of the earlier marks' reputation had been furnished in this case.

34 – See paragraphs 43 and 44 respectively of the contested decisions.

35 – That claim, which is mentioned in paragraph 88 of the judgment under appeal, is not contested by the appellants.

36 – The Court ruled to that effect in Case C-48/05 Adam Opel [2007] ECR I-1017, paragraph 36.

37 – Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1).

38 – Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4).

39 – See Case T-232/00 *Chef Revival USA v OHIM – Massagué Marín (Chef)* [2002] ECR II-2749, paragraphs 31, 33, 36, 41 and 44, and Case T-107/02 *GE Betz v OHIM – Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, paragraph 72, concerning the failure to produce a translation of the registration certificate.

40 – In so far as this error consists in failing to consider that the evidential value of the documents concerned does not depend on a translation of them into the language of proceedings.

41 – See, to that effect, the judgments of the General Court in *Chef Revival*, paragraph 42, and in *GE Betz Inc.*, paragraph 72, cited in footnote 39.

42 – In that respect, see the examination of the first complaint under the first ground of appeal in point 12 et seq. above.

43 – Case C-29/05 *P OHIM v Kaul* [2007] ECR I-2213, paragraph 43.