

Furrowed brows for L'Oréal at end of Allergan BOTOX® battle

On 10th May 2012 the First Chamber of the Court of Justice of the European Union (CJEU) gave its judgment on the appeal brought jointly by Helena Rubenstein and L'Oréal against the 16th December 2010 judgment of the General Court of the European Union, which dismissed appeals filed by the two parties.

Background

The advocate general delivered his opinion in the case on 16th February 2012 (for further details please see ["Wrinkles for L'Oréal during BOTOX® battle with Allergan"](#)).

The decision marks the end of the road for a case with a long history. In February 2005 Allergan, Inc, proprietor of the BOTOX® trademark, which is registered worldwide, filed applications with the Office for Harmonisation in the Internal Market (OHIM) to declare the registrations of the trademarks BOTOLIST (filed by Helena Rubenstein) and BOTOCYL (filed by L'Oréal) invalid based on Articles 8(1) (b), 8(4) and 8(5) of the Community Trademark Regulation (40/94).

Initially, the Cancellation Division of OHIM rejected the applications for a declaration of invalidity. On 1st June 2007 Allergan filed a notice of appeal against those decisions under Articles 57 to 62 of Regulation 40/94. By decisions of 28th May 2008 and 5th June 2008, the First Board of Appeal of OHIM upheld the appeals. In particular, it found that although there was no likelihood of confusion between the disputed marks

and the earlier mark, the applications for declarations of invalidity on the basis of Article 8(5) of Regulation 40/94 were well founded. From there, appeal was made to the General Court as outlined above.

This case is significant in that it sets out the latest views of the CJEU on Article 8(5). Article 8(5) reads:

"Furthermore, 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 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.**" (Emphasis added.)

The key issues are as follows:

Whether the earlier and later trademarks were "similar".

Whether the earlier trademark has a reputation.

Whether the use of the later trademark "without due cause... would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier trade mark".

The appellants raised several objections to the judgment of the General Court, but the Court of Justice rejected all the grounds of appeal and dismissed the appeal.

The key findings of the Court on the issue of Article 8(5) are:

Paragraphs 93, 94 and 95 on the general approach in such assessments.

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."

On the specifics of this case, the Court analysed the particular circumstances, and concluded in paragraphs 96 and 97:

96. "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."

The complete judgment can be found [here](#).

This case has finally reached the end of the road – the ECJ's decision both confirms the status of BOTOX® as a trademark with reputation, and adds definition to the boundaries of protection around it.

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