

EUIPO affirms opposition rejection in trademark dispute over use of barcodes

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**Examination/opposition
Passing off**

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In Case R0238/2015-4 the Appeal Division of the EU Intellectual Property Office (EUIPO) confirmed Decision B 002098674 of the EUIPO Opposition Division, which had rejected the opposition filed by the Greek Association of Businesses for the Management of International GS1 Standards (GS1 Association Greece) against company 520 Barcode Hellas based on Article 8(4) of the EU Trademark Regulation (before the amendment).

The opponent based its opposition on the following non-registered trademark which, according to its claim, was used in Greece for all goods and services of the Nice Classification (Classes 1 to 45) and invoked Article 8(4) of the EU Trademark Regulation:



The opposition was filed against the following EU trademark application (10881861) covering 18 classes (goods and services):



The opponent submitted several documents in order to prove use of the non-registered sign in Greece, as well as its proprietary rights to the prefix '520'.

Having considered the issues of the case and the submitted evidence, the Opposition Division stated that while the evidence suggested that some use of the sign had been made, it did not meet the minimum threshold of "more than local significance" set out in Article 8(4) of the EU Trademark Regulation. According to the Opposition Division, the documents submitted did not provide sufficient information concerning the commercial volume, duration and frequency of use of the non-registered sign.

Most importantly, the Opposition Division stated that the opponent did not file documents relating to the earlier non-registered mark, as depicted in the notice of opposition. Although the opponent claimed proprietary rights in the number 520 only, the Opposition Division took the view that the opposition was based on the above-depicted representation reflecting a 13-digit barcode, as the notice of opposition reflected.

The Opposition Division did not consider the proprietary rights in the prefix '520'.

The opponent appealed the decision. The EUIPO Fourth Board of Appeal upheld the Opposition Division's decision.

First, the board found that "the Appellant's unregistered trademark is neither clear nor precise, neither is the list of goods and services". More specifically, the appellant failed to identify the earlier trademark. The appellant submitted a representation of a typical barcode with 13 digits, as indicated above, and explained that the word element was '520'.

The board ruled that the appellant based its opposition on any EAN-13 barcode starting with the number 520. The appellant therefore sought protection not for a specific unregistered trademark, but for a concept. However, as the board explained, the mere fact that two or more barcodes have a common feature (ie, they start with 520), does not mean that they may be considered as a unique trademark.

Second, the board considered that Rule 15(2)(f) of the EU Trademark Regulation, which provides that the opponent must indicate the goods and services on which the opposition is based, is also applicable in the case of an opposition based on Article 8(4) of the EU Trademark Regulation,. Thus, the general statement of the opponent that its unregistered sign covered all goods and services in the 45 classes of the Nice Classification cannot be considered as a sufficient clear and precise indication of the opposing goods and services.

Third, the board stated that even if the representation of the unregistered sign were clear and precise, or if it were based only on the number '520' and the goods and services covered were considered precise and clear, the opposition should fail because the board could find no use of the unregistered sign in the submitted documents. The board clarified that any barcode shown in the exhibits did not refer to trademark use. Nothing allowed for the conclusion that by using a barcode, companies were aiming to distinguish their goods and services from those of other undertakings or that end consumers would see a barcode as a badge of origin. In order to reach this conclusion, the board also considered the explanations of the appellant itself, which admitted that there is nothing particularly distinctive about a GS1 barcode, which is ubiquitous and broadly similar to other barcodes.

Comment

This decision is being contested before the EU General Court. It will be interesting to see how the court handles the issue of the meaning of the earlier sign on which the opposition was based in the case of Article 8(4) of the EU Trademark Regulation, as well as the issue of the use of a sign "of more than local significance". The particular character of the unregistered sign in this case – namely a barcode or a prefix – makes the case intriguing, since the topic is of considerable importance for companies and the markets.

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