

Court upholds opposition by GS1 Association Greece

03
NOV 17

European Union - Dr Helen G Papaconstantinou and Partners Law Firm

- **Due to an IT error an opposition was recently wrongly filed against a barcode prefix as a separate sign**
- **EU General Court therefore found that the EUIPO appeal division had failed to examine the correct conditions for the application**
- **The court overruled the decision and sent it back for re-examination**

In a recent case involving the Greek Association of Businesses for the Management of International GS1 Standards (GS1 Association Greece) and 520 Barcode Hellas (Case T-453/16), the EU General Court has overturned a decision of the European Intellectual Property Office (EUIPO) Appeal Division. The decision had confirmed the Opposition Division's rejection of an opposition filed by GS1 Association Greece Hellas, based on Article 8(4) of the EU Trademark Regulation.

The court was called on to determine the exact nature of the opponent's sign cited in the opposition proceedings. The identification of the earlier right turned out to be crucial for the outcome of the case.

The opposition was based, according to the notice of opposition, on the following claims:

Basis of the Opposition #1 - Non-registered trade mark	
Trade Mark number:	N/A
Nature of rights	GS1 barcode and prefix
Countries in which the trademark is well-known:	European Union
Type Of Mark:	Other
Word element(s) of the Mark:	520
Image representation:	

When filing an online opposition, the opponent selected 'other' from a list of various rights while completing the section headed 'Type of Mark'. The selection was intended to narrow down a previous option by which the opponent had described the right cited in opposition as being a 'non-registered trademark or other sign used in the course of trade'. However, by selecting 'other', the opponent indicated that the sign cited in opposition was opposed as another sign rather than as a non-registered trademark.

According to the court's assessment, the fact that the opponent's notice of opposition as published by the EUIPO included section headings that were inappropriate because they referred unambiguously to the notion of a trademark – while the right that was expressly cited in opposition was 'another sign' and not a 'mark' – constituted an IT error by the EUIPO, as recognised by the EUIPO in its replies to the court's written questions.

As a result, the court decided that despite and beyond the reference in the notice of opposition, to the 'GS1 Barcode and prefix' and to the graphic representation of a barcode with the 13-digit sequence '5 200000 000009' below it, the opposition was based on the trigraph '520' as 'another sign'.

Having considered the issues and the submitted evidence, the court stated that the EUIPO Board of Appeal had proceeded with two different assumptions. The first was that of the alleged non-registered trademark cited in opposition being construed as unique or as one example of a multitude of marks consisting of any EAN-13 barcode starting with the number '520'; the second was that of the opposition being based exclusively on the non-registered trademark '520'.

Regarding the first assumption, the court held that although a correct analysis of the notice of opposition, read as a whole, required a finding that the opposition was based on 'another sign' (ie, '520') taken in isolation, the board of appeal failed to acknowledge this.

As a result, the board of appeal's findings concerning the alleged non-registered trademark cited in opposition and, therefore, the barcode corresponding to the number sequence 5 200000 000009 or its numerous variations should not be taken into consideration since they concerned a sign other than the sign '520' cited in opposition. Therefore, the board of appeal failed to provide a response to the opposition put forward by the opponent.

As for the second assumption, the board of appeal erroneously perceived the sign '520' as 'an unregistered trademark' only and not as 'another sign', and considered the evidence produced by the opponent under that perspective.

During the hearing the EUIPO admitted that following the court's written questions and the investigations carried out in that context, it could no longer claim that the opponent based its opposition on a mark and accepted that the opponent based its opposition on 'another sign'. As a result, the board of appeal erroneously demanded proof of use of the sign cited in opposition construed as a mark and not as 'another sign', and decided that such proof was lacking.

Based on the above, the court had no difficulty in finding that as a result of this error the board of appeal failed to examine the conditions for the application of Article 8(4) in respect of '520' as 'another sign'.

It is now for the board of appeal to re-examine the case and decide whether the conditions put forward under Article 8(4) have been met, and in particular examine:

- whether use of the sign in the course of trade is of more than local significance;
- the issue of the nature of a potential right over the sign;
- the proprietor of such right; and
- whether the owner of that right may prohibit the use of a subsequent mark.

The question remains whether the proof of use submitted by the opponent in support of the trigraph '520', which was considered insufficient if it referred to a non-registered mark, will be now considered differently if it refers to 'another sign'. In other words, it remains to be seen whether the correct identification of the nature of the earlier right under Article 8(4) may lead to a different outcome in this case.

Anna Roussou, Dr Helen G Papaconstantinou & Partners, Athens