General Court: Board of Appeal erred in maintaining LUTAMAX registration only for Class 5 sub-category

Maria Athanassiadou
Dr Helen G Papaconstantinou and Partners Law Firm
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- **The court partially annulled the Board of Appeal decision in revocation proceedings against the mark LUTAMAX**
- **The board infringed Article 51(2) insofar as it maintained the registration in respect of "dietary supplements adapted for medical or dietetic use" in Class 5 only with regard to a specific sub-category**
- **"Dietary supplements adapted for medical or dietetic use" form a sufficiently clear category within Class 5**

In **Joined Cases T-221/22 and T-242/22** (with Pharmaselect International Beteiligungs GmbH as applicant in Case T-221/22, OmniActive Health Technologies Ltd as applicant in Case T-242/22, and the European Union Intellectual Property Office (EUIPO) as defendant), the Eighth Chamber of the General Court has partially annulled the decision of the First Board of Appeal of the EUIPO of 24 February 2022 (Joint Cases R 524/2021-1 and R 649/2021-1).

Background

In May 2005 Pharmaselect International Beteiligungs GmbH obtained the registration of the EU word mark LUTAMAX (No 1516387), covering goods in Classes 5, 29 and 30. Upon an application for revocation pursuant to Article 51(1)(a) of **Regulation 207/2009**, filed by OmniActive Health Technologies Ltd, the trademark was maintained only for "dietary supplements adapted for medical or dietetic use for the treatment of age-related macular degeneration, eye care preparations (for pharmaceutical purposes) for the treatment of age-related macular degeneration - none of the aforesaid goods for veterinary purposes" in Class 5. Pharmaselect appealed the decision in March 2021 insofar as the trademark had been partially revoked; OmniActive also appealed insofar as its application for revocation had been partially rejected.

The First Board of Appeal of the EUIPO ordered that the mark remain on the register only for "dietary supplements adapted for medical or dietetic use for supporting eye health - none of the aforesaid goods for veterinary purposes" in Class 5 and revoked the mark as regards "eye care preparations (for pharmaceutical purposes) for the treatment of age-related macular degeneration - none of the aforesaid goods for veterinary purposes", dismissing the two appeals as to the remainder.

Both Pharmaselect and OmniActive turned to the General Court, contesting the Board of Appeal's decision as regards the parts of their respective appeals which had been rejected.

General Court decision

Addressing the pleas of the parties, the General Court first found that the Board of Appeal had not infringed the obligation to state reasons, as it had sufficiently set out the reasons why the product at issue should be regarded as a dietary supplement adapted for medical or dietetic use in Class 5, for which Pharmaselect had claimed genuine use.

However, the court found that the Board of Appeal had erred in rejecting the relevance of **Directive 2002/46** relating to food supplements, and **Directive 1999/21** relating to dietary foods for special medical purposes, in ascertaining the goods for which the mark LUTAMAX had been put to genuine use. The General Court stressed in this regard that the Nice Classification is intended to serve exclusively administrative purposes and cannot determine in itself the nature and characteristics of the goods at issue, while the directives in question, although not necessarily having an influence on the way the product was classified in the Nice Classification, might be decisive in determining the type of products in connection with which the contested trademark was actually being used. However, the General Court found that this error in law had not prevented the Board of Appeal from reaching a correct conclusion, namely that the product at issue was categorised as a dietary supplement adapted for medical or dietetic use as registered.

Further, the court found that the Board of Appeal had infringed Article 51(2) of Regulation 207/2009, because instead of maintaining the registration of LUTAMAX for "dietary supplements adapted for medical or dietetic use, none of the aforesaid goods for veterinary purposes", it had limited it only to the sub-category "for supporting eye health". Such limitation constituted an error in law according to the court, which held that "dietary supplements adapted for medical or dietetic use" form a sufficiently clear category within Class 5, which does not require to be divided into any sub-categories.

The court also found that the Board of Appeal had not erred in ruling out any genuine use as regards the categories in question. Finally, the board had not erred in finding that the product at issue, in connection with which genuine use as "dietary supplements adapted for medical or dietetic use" had been proved, could not also fall within Class 29 or 30.

Based on the above, the General Court decided that the decision of the Board of Appeal should be annulled insofar as it had maintained the registration of LUTAMAX in respect of "dietary supplements adapted for medical or dietetic use, none of the aforesaid goods for veterinary purposes" in Class 5 only with regard to the sub-category "for supporting eye health".

Maria Athanassiadou

Author | Partner

m_athanasiadou@hplaw.biz

Dr Helen G Papaconstantinou and Partners Law Firm

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