Unite the Union fails to obtain cancellation of WATERFORD mark for glassware

Maria Athanassiadou
Dr Helen G Papaconstantinou and Partners Law Firm
08 July 2022

EUROPEAN UNION
Legal updates: case law analysis and intelligence

- **Unite the Union sought the revocation of the mark WATERFORD for "articles of glassware, earthenware, chinaware and porcelain"**
- **The EUIPO dismissed the application, finding, among other things, that the Waterford Study did not prove that the mark was misleading as to the geographical origin of the goods**
- **The General Court confirmed that the Board of Appeal had rightly considered that the poll lacked probative value**

In *Unite the Unionv European Union Intellectual Property Office* (EUIPO) (Case T-739/20, 22 June 2022), the Third Chamber of the General Court has dismissed the action brought by Unite the Union seeking annulment and alteration of a decision of the Second Board of Appeal of the EUIPO dated 25 September 2020 (Case R2863/2019-2) (the 'contested decision').

Background

The predecessor in law of WWRD Ireland IPCO LLC obtained the registration of the EU word mark WATERFORD (No 397521), covering goods in Classes 3, 8, 11, 21, 24 and 34.

On 24 January 2013 Unite the Union('the applicant') applied for the revocation of the trademark as far as "articles of glassware, earthenware, chinaware and porcelain" in Class 21 were concerned, alleging that, in consequence of its use, the mark could be misleading for the public as regards the geographical origin of these goods. The application for revocation was dismissed by the Cancellation Division of the EUIPO on 25 November 2014, on the ground that the applicant had not provided evidence supporting its allegation. The decision became final.

In May 2017 the applicant filed a new application for the revocation of the trademark WATERFORD, this time submitting an opinion poll entitled "Waterford Study" dated 20 March 2015. Following two communications stating that the application was inadmissible, the EUIPO finally found the application to be admissible. However, the Cancellation Division rejected it on the grounds that:

- the principle of *res judicata* did not apply; and
- the Waterford Study did not prove that the contested trademark was misleading as to the nature, quality or geographical origin of the goods in question.

The applicant appealed the decision, but the appeal was dismissed by the Board of Appeal of the EUIPO, which doubted the admissibility of the action and, on the merits, confirmed all the findings of the Cancellation Division.

The applicant contested this decision before the General Court, requesting that:

- the revocation action be considered admissible; and
- the contested decision be annulled and altered in such a way as to find that the mark should be revoked.

General Court decision

Admissibility

The General Court first examined the issue of the admissibility of the action. The EUIPO had based its plea of inadmissibility on Article 63(3) of Regulation 2017/1001, claiming that decisions issued on invalidity and revocation proceedings constitute a bar to further applications for a declaration of invalidity and revocation where the conditions are met.

The General Court stated that the conditions concerning the admissibility of an action before the court are governed by Article 263 of the Treaty on the Functioning of the European Union, which prevails over Article 63(3) of Regulation 2017/1001 (which constitutes secondary legislation). An interpretation to the contrary would contravene the principle of effective judicial protection, by virtue of the first sentence of Article 47 of the Charter of Fundamental Rights of the European Union, which provides that everyone whose rights and freedoms guaranteed by the law of the European Union are violated has the right to an effective remedy before a tribunal in compliance with the conditions laid down in that article. The General Court finally stressed that, in case of admissibility of an application for revocation, the examination of compliance with the provisions of Regulation 2017/1001 forms part of the substantive examination and necessarily presupposes that the action brought against that decision is admissible.

Substance

Turning to the substance of the case, the General Court first confirmed that the evidence submitted for the first time before the court was inadmissible. Further, the arguments of the applicant which had been considered in the first decision of the Cancellation Division dated 25 November 2014 had been definitively dealt with; these were thus rejected as inadmissible.

The court then examined the applicant's first complaint that the Board of Appeal had erred in finding that an applicant for revocation must show actual deceit or a sufficiently serious risk that the consumer would be deceived. Relying on ***Emanuel*** (Case C-259/04), the General Court dismissed the complaint, stating that said decision was still in compliance with the interpretation of Articles 51(1)(c) and 7(1)(g) of Regulation 207/2009 currently in force, and that it was applicable as the interpretation of the Court of Justice in that case had not been based on its factual circumstances.

Commenting on the applicant's second complaint relating to the admissibility of the Waterford Study, the General Court held that the probative value of evidence relates to its credibility and that, when it comes to surveys, their probative value depends on the method used. Therefore, surveys must be accompanied by sufficient evidence to ensure their reliability. The General Court stressed that the Board of Appeal had correctly relied on the fact that it was not aware of the methodology used in the Waterford Study, and taken into account the fact that the participants in the poll had not been chosen as a representative sample of the population but, rather, had selected themselves. The General Court thus confirmed that the Board of Appeal had been right to consider that the poll:

- lacked probative value; and
- did not prove the applicant's allegation that the Waterford Study demonstrated that the city of Waterford had a reputation for the production of crystal or glass and that, as a consequence, the relevant public could be misled as to the geographical origin of the goods in Class 21 bearing the mark WATERFORD.

Consequently, the General Court rejected the action in its entirety.

Maria Athanassiadou

Author | Partner

m_athanasiadou@hplaw.biz

Dr Helen G Papaconstantinou and Partners Law Firm

Copyright © Law Business Research Company Number: 03281866 VAT: GB 160 7529 10