European Union

“BOTOLIST, BOTOCYL and BOTOX”

Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark, Art. 8(5) – *Helena Rubenstein SNC and L’Oréal SA v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and Allergan Inc.*

**Decision of the European Court of Justice
(First Chamber)
10 May 2012 – Case No. C-100/11 P**

© Max Planck Institute for Intellectual Property and Competition Law, Munich 2013

1. It is assumed that a trade mark, which enjoys a reputation with the general public, is also known to professionals.
2. As established in Article 256 TFEU and Article 58 of the Statute of the Court of Justice of the European Union, an appeal lies on points of law only. As such, the appraisal of the facts by the General Court does not constitute a question of law subject to review by the Court of Justice, unless the evidence produced is distorted. Consequently, the assessment of the question whether the prefixes “bot” or “boto” are not descriptive cannot be undertaken by the Court of Justice due to its factual nature.
3. In order to benefit from the protection foreseen in Article 8(5) of Regulation No 40/94, the proprietor of the earlier mark must prove that there is serious risk that the 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 mark. Such may be established on the basis of logical deductions made from an analysis of probabilities and by taking into account of the normal practice in the relevant commercial sector as well as all other circumstances of the case.
4. Evidence submitted in support of an opposition or of an application for invalidity or revocation of the trade mark must be submitted in the language of the proceedings or be accompanied by a translation into that language, in order to guarantee the right to be heard and ensure equality of arms between the parties.