Judgment of the General Court (Third Chamber) of 16 December 2010 — Rubinstein and L'Oréal v OHIM — Allergan (BOTOLIST and BOTOCYL)

(Joined Cases T-345/08 and T-357/08)

(Community trade mark — Invalidity proceedings — Community word marks BOTOLIST and BOTOCYL — Earlier national figurative and word marks BOTOX — Relative ground for refusal — Damage to reputation — Article 8(5) of Regulation (EC) No 40/94 (now Article 8(5) of Regulation (EC) No 207/2009) — Duty to state reasons — Article 73 of Regulation No 40/94 (now Article 75 of Regulation No 207/2009))

1. *Community trade mark — Surrender, revocation and invalidity — Relative grounds of invalidity — Registration contrary to Article 8(5) of Regulation No 40/94 (Council Regulation No 40/94, Arts 8(5) and 52(1)(a)) (see paras 40, 64, 79, 88)*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation — Protection of well-known earlier mark extended to dissimilar goods or services — Condition — Link between the marks — Criteria for assessment (Council Regulation No 40/94, Art. 8(5)) (see paras 65-66)*

3. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation — Protection of well-known earlier mark extended to dissimilar goods or services — Proof to be adduced by proprietor — Future, non-hypothetical risk of unfair advantage or damage (Council Regulation No 40/94, Art. 8(5)) (see para. 82)*

4. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation — Protection of well-known earlier mark extended to dissimilar goods or services — Conditions — Taking unfair advantage of the distinctive character or repute of the earlier mark — Detriment to the distinctive character or repute of the earlier mark — Criteria for assessment (Council Regulation No 40/94, Art. 8(5)) (see paras 83-85)*

5. *Community trade mark — Procedural provisions — Statement of reasons for decisions — Aim (Council Regulation No 40/94, Art. 73) (see para. 92)*

Re:

ACTIONS brought against, in Case T-345/08, the decision of the First Board of Appeal of OHIM of 28 May 2008 (Case R 863/2007-1), relating to cancellation proceedings between Allergan, Inc. and Helena Rubinstein SNC, and, in Case T-357/08, the decision of the First Board of Appeal of OHIM of 5 June 2008 (Case R 865/2007-1), relating to cancellation proceedings between Allergan, Inc. and L'Oréal SA.

Information relating to the case

Registered Community trade marks subject of the application for a declaration of invalidity:	Community word mark BOTOLIST for goods in Class 3 and Community word mark BOTOCYL for goods in Class 3 — Community trade mark registration Nos 2686392 and 2782282
Proprietors of the Community trade marks:	Helena Rubinstein SNC and L'Oréal SA

Party requesting the declaration of invalidity of the Community trade mark:	Allergan, Inc.
Trade mark right of the party requesting the declaration of invalidity:	Community trade mark registration No 2015832 of the figurative mark BOTOX for goods in Class 5; Community trade mark registration No 2575371 of the figurative mark BOTOX for goods in Class 5; Community trade mark registration No 1923986 of the figurative mark BOTOX for goods in Classes 5 and 16; Community trade mark registration No 1999481 of the word mark BOTOX for goods in Class 5; various national trade marks BOTOX
Decision of the Cancellation Division:	Applications for a declaration of invalidity dismissed
Decision of the Board of Appeal:	Decisions of the Cancellation Division annulled

Operative part

The Court:

1. Dismisses the actions;

2. Orders Helena Rubinstein SNC to pay the costs in Case T-345/08;

3. Orders L'Oréal SA to pay the costs in Case T-357/08.