

# Kluwer Trademark Blog

## Outside In, Inside Out – a new Standard?

Aron Laszlo (Oppenheim Legal) · Friday, December 2nd, 2022

*genuine use of an EU trademark within the EU for services provided outside the EU*

*a summary of decision T?768/20 of the General Court of the EU*

The background of this decision was an application for revocation for non-use against the EUTM owned by Standard International Management LLC, a US company.



Yes, this is how the trademark actually looks like, this [logo has turned upside down](#) well before the world around us did.

The applicant filed evidence of use for hotel and ancillary services provided in the United States and evidence of advertising and promotional campaigns aimed especially at customers located in the EU.

The Cancellation Division revoked the contested mark in its entirety, stating that the evidence submitted did not prove use within the EU (28 401 C). The applicant's appeal was dismissed (R 828/2020-5). The hotel and ancillary services in question were rendered outside the territory of the EU. The Board of Appeal considered it irrelevant that the advertisements or offers of services were intended for EU consumers. It also excluded all evidence concerning use in the US.

Before the General Court (GC), the applicant was successful. The GC stated that it could not be inferred from case-law that, just because the services are provided outside the EU, the promotion and offer for sale of such services necessarily took place outside the EU as well. The GC cited the EUIPO Guidelines, which state that where the goods or services covered by a mark are provided abroad, such as holiday accommodation or particular products, advertising alone may be sufficient to amount to genuine use.<sup>[1]</sup>

The GC found that even if the applicant supplied goods or services outside the EU, it was conceivable that the applicant would use the mark in order to create or preserve an outlet for those

goods and services in the EU. For this reason, it held that the BoA should have considered the evidence concerning the applicant's hotel and ancillary services in the US.

The GC further found that advertisements and offers for sale constituted acts of use of a trademark, noting that these acts were listed among those that could be considered infringing use. Therefore, evidence related to EU-focused advertising relating to the protected services was considered relevant.

The decision does not necessarily contribute to greater legal certainty. It is questionable whether it is correct to say that all uses that are possibly infringing uses also constitute use that can maintain a registration. The EU trademark law expressly includes among the infringing acts preparatory acts as well as labelling and stocking, which, if purely internal, are recognized not to amount to genuine use.

Another question is how much the offering or advertising of goods sold or services provided outside the EU must be focused on EU consumers to be accepted as genuine use in the EU. Can airline companies serving destinations exclusively outside the EU claim use for the actual transportation services in the EU just selling tickets to EU consumers, or making advertisement for EU consumers? Can a Swiss bespoke watchmaker claim use in the EU where the watches can only be collected personally in Switzerland but the watches are advertised in the EU?

Based on the GC ruling, the answer to these questions should be yes, provided that the advertisements and the offering of goods or services are directed especially and clearly towards EU consumers.

Maybe, this will be the new



[1] See the EUIPO Guidelines for examination of European Union trade marks, Part C Opposition, Section 7 Proof of use, paragraph 6.1.2.5 (use in advertising) available [here](#).

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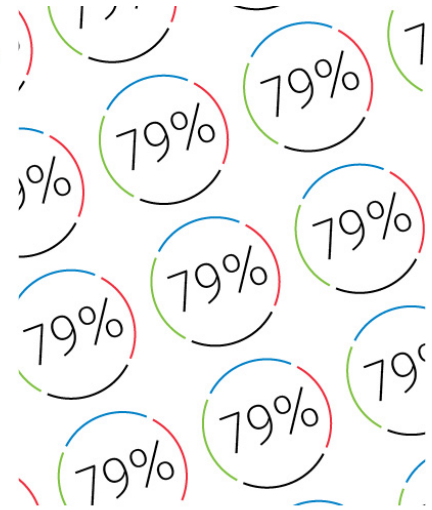
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