

AG opines on BOTOLIST, BOTOCYL and BOTOX

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Summary: Advocate General Mengozzi has delivered his opinion in *Helena Rubinstein SNC v OHIM* following an appeal against the decision which the General Court had issued on December 16, 2010. The Advocate general confirmed the General Court's finding that the marks BOTOLIST and BOTOCYL would take advantage of the distinctiveness and reputation of the earlier BOTOX marks.

This February 16, 2012, Advocate General Mengozzi has delivered his opinion in [Helena Rubinstein SNC vs./ Office for Harmonisation in the Internal Market](#) (Case C-100/11 P). He confirmed the General Court's finding that the marks BOTOLIST and BOTOCYL would take advantage of the distinctiveness and reputation of the earlier BOTOX marks. So what the history behind all this?

In 2002 [Helena Rubinstein SNC](#) and [L'Oréal](#) respectively applied to register the Community word marks BOTOLIST and BOTOCYL in Class 3. The marks matured into registration but on February 2, 2005, [Allergan Inc](#) filed an application for a declaration of invalidity of these marks on the basis of Community and UK trademarks registrations for BOTOX (word and word-and-device marks) covering class 5.

On March 28, 2007, and April 4, 2007, the Cancellation Division of OHIM rejected Allergan's applications. The First Board of Appeal however annulled these decisions on May 28, 2008, and June 5, 2008, considering that the applications for a declaration of invalidity were well founded under Article 8(5) of the [Community Trademark Regulation](#) (40/94).

On December 16 2010 the [General Court upheld the declarations of invalidity](#) of BOTOLIST and BOTOCYL, in light of the reputation of the earlier BOTOX marks for '*pharmaceutical preparations for the treatment of wrinkles*' at the filing date of the challenged trademarks.

Helena Rubinstein and L'Oréal (collectively the complainants) appealed against that judgment. In his opinion of February 16 2012, the Advocate General recommended that the Court of Justice of the European Union (ECJ) dismiss the appeal.

The complainants first argued that the General Court had erred in law in basing its appraisal on two earlier UK marks, while the Board of Appeal had based its findings solely on the Community trademark No 2015832. According to the advocate general, the Board of Appeal had generally, repeatedly and properly referred to the 'BOTOX mark' as covering all the rights relied on by Allergan.

Second, the complainants argued that the General Court had erred in assessing the reputation of the earlier marks in relation to the relevant public, the relevant territory and the evidence of reputation. However, the advocate general stated that the essential purpose of some of these submissions was to bring about a re-examination of the evidence, which the ECJ does not have jurisdiction to carry out in appeal proceedings.

Third, the complainants contested the General Court's finding that the relevant public would establish a link between BOTOX on the one hand, and BOTOLIST and BOTOCYL on the other. According to the complainants, such a link could not be based on the common element 'BOT(O)', since it was a descriptive element referring to the botulinum toxin. The advocate general considered that these arguments were inadmissible, as they would entail a new assessment of facts that the ECJ was not entitled to carry out.

Fourth, the complainants claimed that the finding of parasitic intent (ie, the finding that the complainants intended to take unfair advantage of the distinctive character or the repute of the BOTOX marks) was not supported by any evidence before the General Court. However, according to the advocate general, it was apparent from all the grounds of the General Court's judgment that the existence of parasitic intent was inferred from a number of findings:

- The fact that the complainants chose to use a prefix which reproduces almost all of the earlier mark - a decision which could not be justified by the intention to refer to the botulinum toxin, which did not form part of the goods covered by the contested marks;
- The characteristics of the earlier BOTOX mark - that is, its strong distinctive character, uniqueness and widespread reputation.

Finally, on a more procedural note, the complainants stated that certain articles published in English in the press had been furnished as evidence without being translated into the language of the proceedings (ie, French). While the advocate general admitted that the General Court had erred on this point in confirming the admissibility of these articles as evidence, this error concerned the appraisal of the evidence and, as such, no objection could be raised in the proceeding at hand.

Should the ECJ follow the approach of the Advocate General, the monopoly enjoyed by the BOTOX marks would be substantial and provide a strong defence against 'boto'-prefixed marks. It would then be preferable to avoid using the prefix 'boto' for goods in Classes 3 and 5, at least at the Community level. This position also contradicts the approach of the French High Court, which held on July 1st, 2008, that 'botox' had become usual for products containing the botulinum toxin.

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