

Alicante, 15/06/2016  
R0238/2015-4

DR. HELEN G. PAPACONSTANTINO AND PARTNERS, LAW FIRM  
2, Coumbari Street Kolonaki  
GR-106 74 Athens  
GRECIA

Subject: Appeal No. R0238/2015-4 5 21000 603856 520Barcode Hellas (fig.) / 520  
barcode (fig.)  
Your ref.: COMTM/238

### **Notification of a decision of the Boards of Appeal**

Please find enclosed the decision of the Fourth Board of Appeal dated 14/06/2016 concerning the appeal R0238/2015-4.

Article 65 EUTMR provides that an action may be brought before the General Court against decisions of the Boards of Appeal. The action shall be brought within two months from the date of notification of the decision of the Board of Appeal.

Please be informed that the texts governing the procedure before the General Court, in particular the Rules of Procedure and the Decision on the lodging and service of procedural documents by electronic means (e-Curia) may be consulted on the Curia web site at <http://curia.europa.eu/jcms/jcms/Jo27040/>.

To the extent that you are adversely affected by the attached decision and you nonetheless decide not to challenge it, please inform us accordingly as soon as possible.

Christelle BERAT  
Registry

Enc.: 1 (8 pages)

**DECISION**  
**of the Fourth Board of Appeal**  
**of 14 June 2016**

In Case R 238/2015-4

**Greek Association of Businesses for the Management of International GS1 Standards (GS1 Association Greece)**

Argiroupoli Attikis, Greece

Opponent / Appellant

represented by G.S. KOSTAKOPOULOS & COLLABORATEURS, Athenes, Greece

v

**520 BARCODE ΕΛΛΑΣ - ΑΝΩΝΥΜΗ ΕΤΑΙΡΕΙΑ ΔΙΑΧΕΙΡΙΣΗΣ ΔΙΕΘΝΩΝ ΠΡΟΤΥΠΩΝ ΚΑΙ ΠΑΡΟΧΗΣ ΣΥΜΒΟΥΛΕΥΤΙΚΩΝ ΥΠΗΡΕΣΙΩΝ με δ.τ.**

**520 BARCODE ΕΛΛΑΣ Α.Ε. (trading as 520 BARCODE HELLAS)**

ΚΗΦΙΣΙΑ ΑΤΤΙΚΗΣ, Greece

Applicant / Respondent

represented by DR. HELEN G. PAPACONSTANTINOU AND PARTNERS, LAW FIRM, Athens, Greece

APPEAL relating to Opposition Proceedings No B 2 098 674 (European Union trade mark application No 10 881 861)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairperson), C. Bartos (Rapporteur) and E. Fink (Member)

Registrar: H. Dijkema

gives the following

## Decision

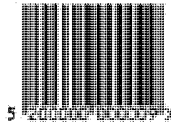
### Summary of the facts

- 1 By an application filed on 14/05/2012, the respondent sought to register



for various goods and services in Classes 6, 7, 9, 11, 14, 16, 20, 29, 30, 35, 36, 37, 38, 39, 41, 42, 43 and 45.

- 2 On 13/11/2012, the appellant filed an opposition against the registration of the trade mark application for all the goods and services.
- 3 The grounds of opposition were those laid down in Article 8(4) EUTMR. The opposition was based on the non-registered trade mark



used in Greece for all goods and services in Classes 1 to 45.

- 4 The appellant submitted ample evidence to prove the national law and use of this sign with more than mere local significance which can be summarized as follows:

Exhibit	Short description
1	Letter of GS1 to GS1 Association Greece, dated 14/04/2011
2	a) Brochure 'What is GS1?' undated b) Several printouts from sub site of the GS1 homepage, <a href="http://www.gs1.org">www.gs1.org</a>
3	'GS1 – The global language of business', printout from a sub site of the GS1 homepage, <a href="http://www.gs1.org">www.gs1.org</a>
4	GS1 – prefix list, printout from a sub site of the GS1 homepage, <a href="http://www.gs1.org">www.gs1.org</a>
5	Letter concerning the assignation of the prefix '520', dated 13/02/1985
6	a) Letter of GS1 to Greek Secretary General of Commerce, dated 19/08/2011 b) Document 'Users of the GS1 Standards System in Greece', dated 01/09/2011 c) Document 'Prefix 520 and related issues', dated 30/03/2012
7	Declaration of the GS1 AISBL, dated 12/11/2012
8	a) List of Members of the GS1 Association – Greece b) GS1 System Protection Guideline, Version 1.2, November 2007
9	Copies from the Official Government Gazette of the Hellenic Republic, accompanied by translations
10	Declaration of the GS1 AISBL

Exhibit	Short description
11	a) Decision of the Court of Brussels, Injunction Proceedings 08/932/C, only in English b) Document in Greek, without any translation
12	Decision of a Court of Athens, No 2803/2011, in Greek with a partial translation into English
13	Licence Contract
14	Article 124(3) Greek Law No. 4072/2012, in Greek and a translation into English
15	Article 13 Greek Law No. 146/1914, in Greek and a translation into English

- 5 By decision of 28/11/2014 ('the contested decision'), the Opposition Division rejected the opposition for all the contested goods and services. After carefully assessing the evidence submitted by the appellant, the Opposition Division considered that while the evidence suggested that some use of the sign had been made, it did not meet the minimum threshold of 'more than local significance' set out in Article 8(4) EUTMR.
- 6 The appellant filed a notice of appeal against the decision, followed by a statement of grounds. It requests that the Board annul the Opposition Division's decision and order the respondent to bear the costs.
- 7 The arguments raised in the statement of grounds may be summarised as follows:
- The opposition is based on the sign '520' which corresponds to a country prefix used by the GS1 international identification system, even though it is not meant to distinguish products as a trade mark, it distinguishes them as part of the GS1 coding system and not on the non-registered trade mark '5 200000 000009'. '520' has been a country prefix in the GS1 international identification system for Greece since 1985. Other prefixes are 'blocked' for other countries.
  - The GS1 country prefix is part of a unique number assigned by local GS1 Member Organizations to companies so that they can use them for their barcoding and identification purposes. It explains that GS1 is an internationally recognised standards system used by more than 2 million companies worldwide to uniquely identify products in the supply chain.
  - '520' is linked to the image of uniqueness, reliability, high quality and exclusivity which leads to the high reputation of GS1's country prefix '520'. It alleges an investment of EUR 1.5 million every year to promote and protect GS1 barcodes.
  - After 40 years of use, GS1 has established owner rights in the system which it has built and maintained on behalf of its 2 million users. The '520' sign is arbitrary and unique to the GS1 System.
  - The evidence submitted is sufficient to prove that the earlier sign was used in the course of trade of more than mere local significance, in connection

with the goods and services on which the opposition is based, before the relevant date, in the relevant territory.

- 8 During the appeal proceedings, the appellant submitted further judgments.
- 9 In reply, the respondent supports the decision and briefly argues as follows:
  - The sign on which the opposition is based is ‘5 200000 0009’ with a device, as mentioned on the opposition form. It is, therefore, completely different from the number ‘520’ which is alleged in the appellant’s submissions.
  - The prefix and barcode systems are not distinctive signs. The sign does not distinguish products or services as a trade mark but is a part of GS1’s coding system. The scope and mission of the barcode is not to identify goods and services or the business it originates from. Prefix 520 does not identify the country of origin as it is exclusively licensed to its members. The first three digits of the GS1 prefix on a bar code usually identify the national GS1 member to which the manufacturer is registered.
  - The appellant’s evidence is challenged and it is claimed that the appellant has not explicitly shown use of the prefix ‘520’ in the course of trade, the place, time, extent and nature of use of the earlier right. It also alleges that the appellant has no right under Greek law to prohibit the use of the contested mark.
  - The goods and services in relation to which the appellant claims use are not clearly determined. In any event, there is no likelihood of confusion between the trade marks.

### **Reasons**

- 10 The appeal is admissible but not well founded. The appellant’s unregistered trade mark is neither clear nor precise; neither is the list of goods and services, on which the opposition is based. Furthermore, none of the evidence submitted shows use in commerce of more than mere local significance.
- 11 Under Article 8(4) EUTMR the existence of a sign other than a mark makes it possible to reject a EUTM application following an opposition if that sign satisfies all of four conditions: the sign must be used in the course of trade; it must be of more than mere local significance; the right to that sign must have been acquired in accordance with the law of the Member State in which the sign was used prior to the filing date of the application; and, lastly, the sign must confer on its proprietor the right to prohibit the use of a subsequent trade mark. Those four conditions are cumulative.
- 12 The first two conditions, namely those relating to use of the sign relied on and its significance, which must be more than merely local, are apparent from the very wording of Article 8(4) EUTMR and must, therefore, be interpreted in

light of European Union law. The EUTMR thus sets out uniform standards, relating to the use of signs and their significance.

- 13 In order for Article 8(4) EUTMR to be applicable, the opponent has to demonstrate that there is prior use of the sign of more than mere local significance (use according to uniform standards of EU law; 24/03/2009, T-318/06 - T-321/06, General Optica, EU:T:2009:77, § 33-35).
- 14 According to Article 76(1) EUTMR, in all inter partes cases, the burden is on the party making a particular claim or allegation to provide the Office with the necessary facts and arguments in order to substantiate the claim. Unlike other grounds in Article 8 EUTMR, Article 8(4) EUTMR does not specify the conditions governing the acquisition and scope of protection of the earlier right invoked. It is a framework provision where the particulars of the applicable law must be provided by the opponent.
- 15 The appellant failed in identifying the earlier trade mark. It submitted a representation of its trade mark which can be seen on the right. In accordance with the submissions of the appellant, an EAN-13 barcode is a 13 digit barcoding standard, defined by the NGO 'GS1'. The numbers encoded in EAN-13 barcodes are product identification numbers; the numbers are also known as Global Trade Item Numbers (GTIN). The GTIN is one of the main blocks of the GS1 system. GTIN-13 is the world's most widely used identification system with global uniqueness guaranteed by its structure, namely the GS1 prefix, a company number, an item reference, allocated by an authorized company with each different product receiving a different number and a check digit to provide extra security.
- 
- unregistered trade mark
- 16 The appellant further explained that the word element is '520'. This is only partly correct. The representation is a typical bar code with 13 digits, starting with the number '520' and followed by a further nine '0' and a '9'. Furthermore, in its submissions, the appellant states that the representation submitted is only a sample and explains that its earlier unregistered trade mark consist of any bar code with 13 digits, starting with '520'. The representation, therefore, contradicts the explanation.
- 17 A (registered) trade mark may consist of a sign which '*can be represented graphically [...] and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective*' (12/12/2002, C-273/00, Methylcinnamat, EU:C:2002:748, § 55); nothing in case-law or jurisprudence allows for the conclusion that a non-registered trade mark does not also have to comply with these seven criteria.
- 18 In accordance with the submissions, the appellant based its opposition on any EAN-13 barcode starting with the number '520'. It, therefore, wants to have protection not for a specific unregistered trade mark, but for a concept.
- 19 Contrary to what the appellant contends, the mere fact that two or more barcodes or GTIN-13 numbers have a common feature, i.e. that they start with

‘520’, does not mean that they may be considered as a unique trade mark. Neither the Office nor any undertaking would be in the position to clearly understand the sign, since such a concept would neither be ‘clear’ nor ‘precise’.

- 20 Consequently, the opposition must already fail for that reason.
- 21 Furthermore, the appellant indicated in its notice of opposition that its unregistered trade mark is protected for all goods and services in ‘Classes 1 - 45’.
- 22 The Court of Justice already held that the EUTMR and TMD require the goods and services for which the protection of the trade mark is sought be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought (19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 49).
- 23 Nothing in case-law or jurisprudence allows for the conclusion that a non-registered trade mark does not also have to comply with the same criteria.
- 24 Furthermore, Rule 15(2)(f) CTMIR requires the opponent to indicate the goods and services on which the opposition is based. A general statement such as the one made by the appellant cannot be considered as a sufficient clear and precise indication of the opposing goods and services.
- 25 Consequently, the opposition must also fail for that reason.
- 26 For the sake of clarity, the Board would like to continue to explain several further reasons why the opposition cannot be successful.
- 27 Even if the Board were to take into consideration the representation only and assume that the indication ‘Classes 1 – 45’ refers to all goods and services listed in the alphabetical list of the Nice Classification, the opposition must fail.
- 28 Nowhere in the submissions has the appellant shown use of the unregistered trade mark as represented in the notice of opposition. The Board could not find any example of use of the unregistered trade mark as represented in the notice of opposition. Consequently, the opposition must also fail on this ground.
- 29 Even if the Board were to consider that the representation provided or the GTIN-13 number was clear and precise or were to assume that the opposition was only based on the number ‘520’, the Board cannot see any use of an unregistered trade mark.
- 30 According to settled case-law, the essential function of a trade mark is to guarantee the origin of goods and services from one undertaking from those of another (12/11/2002, C-206/01, Arsenal, EU:C:2002:651, § 50).
- 31 As the appellant itself explains in its Exhibit 8a, under ‘Point 7.2.1 – Legal Protection of Trade marks’, that the ‘GS1 trade mark registrations [...] do not offer any direct legal protection from infringements to the GS1 system’.

Furthermore, 'Point 7.2.2. – Registration of GS1 barcodes as trade marks' states that 'there is nothing particularly distinctive about a GS1 barcode, which is ubiquitous and broadly similar to other barcodes. For this reason, trademark authorities would never agree to give GS1 exclusive rights in barcodes per se.'

32 Nothing can be added to the appellant's explanations.

33 Any bar code shown in the exhibits does not refer to trade mark use. Nothing allows for the conclusion that by using a barcode, companies are aiming to distinguish their goods and services from those of other undertakings. Nothing in the file allows for the conclusion that end consumers would see in a barcode any badge of origin.

34 Consequently, for that reason the opposition must also fail.

35 For these reasons, there is no need to assess any case-law submitted.

36 Therefore, the appeal is dismissed.

### **Costs**

37 As the appellant is the losing party within the meaning of Article 85(1) EUTMR, it must be ordered to bear the costs incurred by the respondent in the opposition proceedings as well as in the appeal proceedings.

### **Fixing of costs**

38 Pursuant to Article 85(6) EUTMR and Rule 94(6), (7)(d)(v) and (ii) CTMIR, the Board fixes the costs to be reimbursed at EUR 550 for the respondent's representation in the appeal proceedings and at EUR 300 for the respondent's representation in the opposition proceedings.



**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the appellant to bear the costs of the appeal proceedings;**
- 3. Fixes the total amount of costs to be paid by the appellant to the respondent for the opposition and appeal proceedings at EUR 850.**

Signed

D. Schennen

Signed

C. Bartos

Signed

E. Fink

Registrar:

Signed

H.Dijkema

