

Barcelona Court of Appeal confirms revocation of AFTERSUN mark

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On 6 June 2018 the Barcelona Court of Appeal confirmed the Barcelona Commercial Court 8 decision which upheld the revocation action filed by L'Oréal Société Anonyme (L'Oréal) against Laboratorios Genesse's Spanish Trademark 0390096 AFTERSUN.

Facts

L'Oréal is a French company which manufactures, distributes and commercialises perfume and cosmetic products worldwide. It has a range of products which are distinguished under the trademark GARNIER, among which are its sun protection and after-sun products.

Garnier has been using the term 'after sun' since 1998 under the brand Garnier – Ambre Solaire After Sun *Leche Hidratante* and since 2002 has been commercialising the products Ambre Solaire Leche After Sun *Reparadora Intensiva* and Ambre Solaire Spray After Sun *Hidratante Refrescante*.

On 21 October 1961 Laboratorios Genesse filed the application for the AFTERSUN mark, which was registered on 30 July 1962 for several products in Class 3 of the Nice Classification.

Between January and June 2016 the parties exchanged correspondence in relation to the AFTERSUN mark but the conflict was not resolved.

L'Oréal filed a revocation action against the AFTERSUN mark due to the popularisation of the registered mark in the Spanish market. Its main arguments were that:

- in the Spanish market, the term 'aftersun' has been uniformly used for after-sun cosmetic products; and
- the defendant has tolerated this widespread use of the term by all types of operator, including its competitors and intermediaries.

The defendant responded to the complaint, arguing that:

- the usual nature of the market must be predicated on the specific sign AFTERSUN and not on similar expressions, such as 'after sun' and 'after-sun';
- there is a wide range of cosmetic or hygienic products designed to alleviate or repair the effects of intense sun exposure on the skin, designated with different expressions, such as '*después del sol*'; and
- the investment in advertising and the leadership position of Laboratorios Genesse's AFTERSUN post-sun products means that they are extremely well known.

Likewise, Laboratorios Genesse filed a counterclaim alleging that L'Oréal's use of the expressions 'after sun' and 'after-sun' infringed its trademark rights and ordered the defendant to cease using the sign.

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First-instance decision

Barcelona Commercial Court 8 upheld L'Oréal's revocation action and declared the cancellation of the mark due to its popularisation (objective element). The court considered that the AFTERSUN mark had become the normal designation for post-sun treatment products. It also held that the subjective element was fulfilled due to the fact that the trademark owner had been passive in its defence, which aided the popularisation of the term.

Laboratorios Genesse appealed the judgement and L'Oréal filed an opposition to the appeal.

Barcelona Court of Appeal decision

On 6 June 2018 the Barcelona Court of Appeal dismissed Laboratorios Genesse's appeal.

Under Spanish law, in order for a mark to be revoked due to popularisation it must satisfy the following requirements:

- the sign must have become the usual designation for the product genre or services (the objective element); and
- this must have occurred as a result of the activity or inactivity of the trademark owner (the subjective element).

Objective element

From the evidence presented at the proceedings, it appears that the terms 'aftersun' and 'after sun' have been used in the market as the standard way to describe cosmetic products used after sun exposure. In this regard, the Barcelona Court of Appeal considered L'Oréal's evidence to be significant; this included a study carried out by Thomson Reuters, which identified multiple cosmetic products commercialised in Spain on which the term 'after sun' appears. Specifically, the expression appears on the products of Amafi, Anne Möller, Kores, Montibelo, Coola, Piz Buin, La Chinata, Solcare, Apivita, Babaria, Bellanatura, Eucerin, Garnier, Guerlain, Hawaiian Tropic, Isdin, Lierac, Mary Kay, Nivea and Oriflame.

The report also included newspapers and magazines in which the after-sun cosmetic products were identified with the AFTERSUN sign, including *El Mundo*, *Style Lovely*, *Telva*, *Hola*, *Marie Claire* and *Mujerhoy*.

The complaint also included reproductions of Mercadona, Babaria, Avene and Shiseido products identified with the phrase 'after sun'.

Subjective element

The court held that the subjective element was fulfilled, given that the defendant had consented to the use of the trademark by its competitors and had not defended its trademark until 2016. Further, the defendant had actively contributed to the popularisation of the mark since it used the trademark AFTERSUN together with another mark, ECRAN. Laboratorios Genesse's sun care products are packaged and advertised under the marks ECRAN SUN for protection during sun exposure and ECRAN AFTERSUN for post-sun treatment.

Therefore, the defendant does not use AFTERSUN merely as a trademark, but as its competitors do; the term is reserved exclusively for the after-sun product range, meaning that it is merely descriptive. Instead, the trademark which identifies the defendant in the market and distinguishes it from other manufacturers is the ECRAN mark.

Similar signs

In response to the appellant's secondary arguments, the court held that the use of similar signs (not identical ones) can convert a sign registered in its usual name by consumers of the product or service with which it identifies; what is relevant is to assess whether the registered mark has become ineffective in distinguishing the business origin of the product.

According to the court, this was the case due to the close similarity of the expressions 'after sun' and

'after-sun' with the trademark AFTERSUN, all of which are phonetically and conceptually similar.

Inadmissible evidence

Finally, the Barcelona Court of Appeal dismissed the appeal arguments relating to the well-known nature of the mark and its perception by consumers, since the evidence on which they were based may not have been carried out properly.

The judgment is subject to appeal.

For further information on this topic please contact [Ana-Laura Morales](#) at Pérez-Llorca by telephone (+34 93 481 30 75) or email (lmorales@perezllorca.com). The Pérez-Llorca website can be accessed at www.perezllorca.com.

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