Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

5 February 2016 *

(Community trade mark — Opposition proceedings — Application for Community word mark kicktipp — Earlier national word mark KICKERS — Rule 19 of Regulation (EC) No 2868/95 — Rule 98(1) of Regulation No 2868/95 — Relative ground for refusal — No likelihood of confusion — Article 8(1)(b) of Regulation (EC) No 207/2009)

In Case T-135/14,

Kicktipp GmbH, established in Dusseldorf (Germany), represented by A. Dreyer, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by I. Harrington, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being

Società Italiana Calzature Srl, established in Milan (Italy), represented by G. Cantaluppi, lawyer,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 12 December 2013 (Case R 1061/2012-2), relating to opposition proceedings between Società Italiana Calzature Srl and Kicktipp GmbH,

THE GENERAL COURT (Fifth Chamber),

composed of A. Dittrich (Rapporteur), President, J. Schwarcz and V. Tomljenović, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Registry of the General Court on 20 February 2014,

having regard to the response of OHIM lodged at the Court Registry on 27 May 2014,

having regard to the response of the intervener lodged at the Court Registry on 24 June 2014,

having regard to the reply lodged at the Court Registry on 7 October 2014,

* Language of the case: English.

having regard to the responses of the parties to the written question put by the General Court,

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided to rule on the action without an oral procedure pursuant to Article 135a of the Rules of Procedure of the General Court of 2 May 1991,

gives the following

Judgment [1] …

Forms of order sought

16 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

17 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

18 The intervener contends that the Court should:

— dismiss the action and uphold both the contested decision and the Opposition Division's decision of 5 April 2012;

— order the applicant to pay the costs, including those incurred before the Board of Appeal and the Opposition Division of OHIM.

Law …

2. *Substance …*

First plea in law: infringement of Rule 19(1) and (2) of Regulation No 2868/95 …

Admissibility of the first plea in law …

– Whether the submission of a renewal certificate may be sufficient to establish the existence, validity and scope of protection of a mark on which an opposition is based

55 The applicant observes that, under Rule 19(2)(a)(ii) of Regulation No 2868/95, the opposing party must provide a copy of the registration certificate for the marks on which the opposition is based and, as the case may be, of the latest renewal certificate, whereas the intervener provided only renewal certificates.

1 — Only the paragraphs of this judgment which the Court considers it appropriate to publish are reproduced here.

56 It must be pointed out that the intervener, in fact, did not produce the registration certificate for the earlier trade mark: it merely appended a certificate concerning the latest application for renewal to the notice of opposition and appended a renewal certificate to the statement of 8 November 2010.

57 It should also be borne in mind that, according to the first sentence of Rule 19(2) of Regulation No 2868/95, the opposing party must provide 'proof of the existence, validity and scope of protection of his earlier mark'. The second sentence of Rule 19(2) of Regulation No 2868/95 indicates the evidence which the opposing party must provide '[i]n particular'.

58 According to the wording of the first part of Rule 19(2)(a)(ii) of Regulation No 2868/95, in the French version thereof, an opposing party is required to provide the registration certificate 'et' (and), as the case may be, the latest renewal certificate for an earlier registered trade mark which is not a Community trade mark. On the basis of that wording, the opposing party must therefore, in principle, provide the registration certificate even if he has also provided the renewal certificate. Other language versions of that regulation confirm that, in principle, the registration certificate must also be produced, as they contain the equivalent of the conjunction 'et' — for example 'and' in the English version, 'y' in the Spanish version, 'ed' in the Italian version, 'e' in the Portuguese version and 'en' in the Dutch version.

59 It is true that, in the German version of Rule 19(2)(a)(ii) of Regulation No 2868/95, the conjunction 'oder' (or) is used. However, in view of the fact that the French, English, Spanish, Italian, Portuguese and Dutch versions of the provision in question all contain the conjunction 'and', or its equivalent in each of those languages, the fact that the conjunction 'oder' is used in the German version is not decisive.

60 According to the last part of Rule 19(2)(a)(ii) of Regulation No 2868/95, it is also possible for the opposing party to produce 'equivalent documents emanating from the administration by which the trade mark was registered'.

61 In that regard, the question arises as to whether the possibility of providing an equivalent document relates only to the obligation to provide the renewal certificate or whether it relates to the obligation to submit both of the items under consideration, that is to say, both the registration certificate and the renewal certificate. From a grammatical point of view, both interpretations are possible: in the phrase 'if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered', the element 'or equivalent documents' may relate either to both items — both the registration certificate and the renewal certificate — or to the second item only.

62 It is necessary to interpret that provision as meaning that the possibility of providing an equivalent document does not relate only to the renewal certificate, but to both the registration certificate and the renewal certificate. The requirement to produce the registration certificate is not an end in itself, but is intended to ensure that OHIM has available to it reliable proof of the existence of the mark on which the opposition is based. It should be borne in mind that the first sentence of Rule 19(2) of Regulation No 2868/95 provides that the opposing party must provide 'proof' of the existence, validity and scope of protection of his earlier mark and that the second sentence of Rule 19(2) of Regulation No 2868/95 merely specifies the items which must be provided in order to furnish such 'proof'. A teleological interpretation of Rule 19(2) of Regulation No 2868/95 thus permits the conclusion that, ultimately, what is crucial is that OHIM should have available to it reliable 'proof' of the existence, validity and scope of protection of an earlier trade mark on which an opposition is based.

63 The production of a document emanating from the competent authority and containing the same information as that which appears in a registration certificate meets that requirement. An opposing party cannot be required to produce a registration certificate when he is providing a document emanating from the same authority — which is therefore just as reliable as a registration certificate — which contains all the necessary information.

64 It is therefore possible to provide an 'equivalent' document which serves just as well as a replacement for the registration certificate as it does for the renewal certificate. It is also possible that the second item mentioned in Rule 19(2)(a)(ii) of Regulation No 2868/95 (the renewal certificate) may at the same time constitute a document 'equivalent' to the first item (the registration certificate). Where the renewal certificate contains all the information necessary to assess the existence, validity and scope of protection of the mark on which the opposition is based, the submission of that document constitutes 'proof of the existence, validity and scope of protection of his earlier mark' as referred to in the first sentence of Rule 19(2) of Regulation No 2868/95. It should be borne in mind that, according to a teleological interpretation of Rule 19(2) of Regulation No 2868/95, the content of the document is what counts, together with the fact that it emanates from the competent authority.

65 It follows from the foregoing that the submission of a renewal certificate is sufficient to establish the existence, validity and scope of protection of the mark on which the opposition is based, if it contains all the information necessary for that purpose.

…

– Whether the documents appended to the notice of opposition are sufficient …

71 The applicant observes in that regard that, under Rule 98(1) of Regulation No 2868/95, when a translation of a document is to be filed, the translation is to identify the document to which it refers and reproduce the structure and contents of the original document.

72 In the present case, the translation provided by the intervener does not contain any explicit reference indicating the original document which has been translated. However, when the original document and the translation are produced together, there is no need for an explicit reference of that kind in order to identify the document to which the translation refers. In the present case, it is apparent from the documents produced before OHIM that the translation appears directly after the original document. In those circumstances, there is no doubt as regards the original document to which the translation refers.

…

74 It should be noted that, where the application for renewal has been made in good time but the competent authority has not yet reached a decision regarding that application, it is sufficient to produce a certificate providing evidence of the application, if that certificate emanates from the competent authority and contains all the necessary information relating to the registration of the mark, such as would be included in a registration certificate. As long as the mark on which the opposition is based has not been renewed, it is impossible for the proprietor of the mark to produce a renewal certificate, and he cannot be penalised for the time taken by a competent authority to reach a decision regarding his application. The same idea is also expressed in Rule 19(2)(a)(i) of Regulation No 2868/95, pursuant to which, if the trade mark is not yet registered, it is sufficient to produce a copy of the filing certificate.

75 By contrast, where the mark on which an opposition is based is registered, it is no longer sufficient under Rule 19(2)(a)(ii) of Regulation No 2868/95 to submit the filing certificate. It is thus necessary to produce the registration certificate or an equivalent document. Following that same line of thought, it is not sufficient to produce a certificate providing evidence of an application for renewal where the renewal has taken place.

…

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

1. **Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 12 December 2013 (Case R 1061/2012-2);**

2. **Orders OHIM to bear its own costs and to pay those incurred by Kicktipp GmbH;**

3. **Orders Società Italiana Calzature Srl to bear its own costs.**

Dittrich Schwarcz Tomljenović

Delivered in open court in Luxembourg on 5 February 2016.

[Signatures]