Reports of Cases

JUDGMENT OF THE GENERAL COURT (First Chamber)

7 May 2013 **

(Community trade mark — Invalidity proceedings — Community figurative mark makro — Company name macros consult GmbH — Right acquired prior to the application for registration of a Community trade mark and entitling its holder to prohibit the use of the Community trade mark applied for — Non-registered signs protected under German law — Article 5 of the Markengesetz — Article 8(4), Article 53(1)(c), and Article 65 of Regulation (EC) No 207/2009)

In Case T-579/10,

macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie, established in Ottobrunn (Germany), represented initially by T. Raible, and subsequently by M. Daubenmerkl, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by R. Manea, and subsequently by G. Schneider, acting as Agents,

defendant,

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

MIP Metro Group Intellectual Property GmbH & Co. KG, established in Düsseldorf (Germany), represented by J.-C. Plate and R. Kaase, lawyers,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 18 October 2010 (Case R 339/2009-4) relating to opposition proceedings between macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie and MIP Metro Group Intellectual Property GmbH & Co. KG,

THE GENERAL COURT (First Chamber),

composed of J. Azizi, President, S. Frimodt Nielsen (Rapporteur) and E. Buttigieg, Judges,

Registrar: C. Heeren, Administrator,

having regard to the application lodged at the Court Registry on 21 December 2010,

having regard to the response of OHIM lodged at the Court Registry on 12 April 2011,

* Language of the case: German.

having regard to the response of the intervener lodged at the Court Registry on 1 April 2011,

having regard to the reply lodged at the Court Registry on 19 July 2011,

having regard to the rejoinder of OHIM lodged at the Court Registry on 19 October 2011,

having regard to the rejoinder of the intervener lodged at the Court Registry on 19 October 2011,

having regard to the parties' replies to the Court's written question,

further to the hearing on 5 February 2013,

gives the following

Judgment

Legal context

1. *Regulation (EC) No 207/2009*

1 Article 8(4) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1) is worded as follows:

'Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

(a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.'

2 Article 53(1)(c) of Regulation No 207/2009 provides the following:

'A Community trade mark shall be declared invalid on application to the Office … where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled.

2. *Regulation (EC) No 2868/95*

3 Rule 37 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), reads as follows:

'An application to the Office for revocation or for a declaration of invalidity … shall contain:

...

(b) as regards the grounds on which the application is based:

...

ii) in the case of an application pursuant to Article 52 (1) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and if necessary particulars showing that the applicant is entitled to adduce the earlier right as grounds for invalidity;'

3. *Markengesetz*

4 Article 5 of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen of 25 October 1994 (law on the protection of marks and other distinguishing signs, BGBl. I, p. 3082, 'the Markengesetz'), as amended, under the heading 'Trade descriptions', provides as follows:

'1. Trade signs and work titles are protected as trade descriptions.

2. Trade signs are signs which, in the course of trade, are used as trade names, company names, or specific designations of a commercial activity or undertaking. Trade descriptions comprise all business signs and other specific signs which distinguish one commercial activity from others and which are considered, by the relevant public, to be distinguishing signs of an undertaking.'

Background to the dispute

5 On 23 March 1998, the intervener, MIP Metro Group Intellectual Property GmbH & Co. KG, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009).

6 The mark in respect of which registration was sought, as referred to in paragraph 5 above ('the conflicting mark'), is the figurative sign reproduced below:



7 The goods and services in respect of which registration of the conflicting mark was sought are in Classes 9, 35, 36 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended.

8 On 7 November 2003, the applicant, macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie, filed an application for registration of a Community trade mark at OHIM, pursuant to Regulation No 40/94.

9 The mark in respect of which registration was sought, as referred to in paragraph 8 above ('the mark applied for'), is the word sign macros.

10 The services in respect of which registration of the mark applied for was sought are in Classes 35, 36 and 41 within the meaning of the Nice Agreement.

11 The conflicting mark was registered on 21 April 2005 and its validity was extended until 23 March 2018.

12 On 28 June 2005 the intervener filed a notice of opposition under Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) to registration of the trade mark applied for in respect of all the services referred to in paragraph 10 above.

13 The opposition was based on the conflicting mark. The ground relied on in support of the opposition was that referred to in Article 8(1)(b) of Regulation No 40/94 (now Article 8(1)(b) of Regulation No 207/2009).

14 On 21 August 2007, the applicant submitted an application for a declaration of invalidity under Article 55 of Regulation No 40/94 (now Article 56 of Regulation No 207/2009). That application ('the application for a declaration of invalidity') was directed against the conflicting mark, in respect of all the goods and services referred to in paragraph 7 above.

15 The application for a declaration of invalidity was based in particular on the German company name macros consult GmbH.

16 The grounds relied on in support of that application for a declaration of invalidity included the ground referred to in Article 52(1)(c) of Regulation No 40/94 (now Article 53(1)(c) of Regulation No 207/2009).

17 By decision of 11 September 2007, OHIM suspended the opposition proceedings referred to in paragraphs 12 and 13 above pending the outcome of the invalidity proceedings at issue in the present case.

18 On 19 January 2009, the Cancellation Division rejected the application for a declaration of invalidity. The Cancellation Division found inter alia that, in essence, the existence of an earlier right based on the applicant's company name had not been established, as the applicant had failed to demonstrate that the company name was used in the course of trade at the date of the application for registration of the conflicting mark.

19 On 20 March 2009, the applicant filed a notice of appeal at OHIM, pursuant to Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009), against the decision of the Cancellation Division.

20 By decision of 18 October 2010 ('the contested decision'), the Fourth Board of Appeal of OHIM dismissed the appeal.

21 It found, in particular, that the applicant had not proved the existence of an earlier right within the meaning of Article 53(1)(c) of Regulation No 207/2009.

22 As regards the application of Article 53(1)(c) of Regulation No 207/2009, the Board of Appeal found that, in making a general reference to Article 5 of the Markengesetz, which protects several types of different rights, and invoking the company name macros consult GmbH, the applicant had not indicated with sufficient precision what earlier right it relied on.

23 Moreover, the Board of Appeal found that the existence of an earlier right could not be established from the evidence presented by the applicant. First, the copy of an application for a national mark of 14 March 1998 did not allow the conclusion that an economic activity began at that time, all the more so because the applicant did not pursue the registration application procedure. Furthermore, the application for registration of a company named macros consult GmbH – Unternehmensberatung für

Wirtschafts- und Finanztechnologie differs from the company name relied on by the applicant, without it being necessary, according to the Board of Appeal, to rule on the issue of whether that request constituted the beginning of its use in the course of trade.

24 Lastly, the Board of Appeal found that the documents relating to the participation in a specialised fair and the accounting records lodged by the applicant all related to the years 2006 and 2008 and could not, therefore, be used to establish the existence of a right prior to the application for registration of the conflicting mark.

Forms of order sought

25 In its application, the applicant claims that the Court should:

— alter the contested decision so that the applicant's action before the Board of Appeal of OHIM is acknowledged as being well-founded and the claim for annulment is upheld;

— order OHIM and the intervener to pay the costs and the expenses incurred before the Board of Appeal and before the Cancellation Division.

26 In the reply, however, the applicant indicated that its action sought that the Court annul the contested decision on the basis of a new legal assessment and that the Board of Appeal, taking account of the Court's conclusions and after clarification of other legal questions, uphold its application for annulment by acknowledging that the applicant's action before it is well-founded.

27 At the hearing, the applicant maintained that its action was limited to an application for annulment of the contested decision and confirmed this in writing.

28 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

1. *The subject-matter of the action*

29 In support of its action, the applicant relies on a single plea in law, alleging infringement of Article 53(1)(c) and (2)(a) of Regulation No 207/2009.

30 However, at the hearing, the applicant acknowledged that it had not, in its written pleadings, presented any argument concerning the legality of the Board of Appeal's application, in the contested decision, of Article 53(2)(a) of Regulation No 207/2009 in conjunction with Article 12 of the Bürgerliches Gesetzbuch (German Civil Code) and that, consequently, that issue had no bearing on the subject-matter of the dispute before the Court.

31 It must therefore be considered that the present dispute exclusively concerns the legality of the Board of Appeal's application of Article 53(1)(c) and of Article 8(4) of Regulation No 207/2009 in the contested decision.

32 In its response to the General Court's written question prior to the hearing, the applicant referred to Article 15 of the Markengesetz, without, however, accompanying that reference with any details that would allow an assessment of the scope of that potential argument. As it acknowledged at the hearing, it did not rely on that provision during the procedure before OHIM or in the present proceedings. At the hearing, the applicant accepted that the issue of that provision had therefore no bearing on the present dispute and confirmed this in writing. The present dispute therefore concerns only the substance of the assessment and the application of Article 5 of the Markengesetz, over which the parties disagree.

2. *The application of Article 53(1)(c) in conjunction with Article 8(4) of Regulation No 207/2009 and Article 5 of the Markengesetz*

Arguments of the parties

33 The applicant claims that, at the date on which the application for registration of the conflicting mark was lodged, namely 23 March 1998, it was already using the designation 'macros consult' as a name, company name, and trade sign, and could therefore benefit from the protection afforded that sign by Article 5 of the Markengesetz.

34 According to the applicant, the company name of a pre-incorporation legal person governed by private law (Vorgesellschaft) is protected under Article 5 of the Markengesetz, subject to the condition that the future company has operated in relation to third parties and that the commercial activity thus carried out suggests a lasting economic activity. Moreover, the protection of the name and the company name extends to the elements of which they are composed, if those elements are of a distinctive nature. The activation of a telephone line, the registration in a trade register, or the use of the trade sign in correspondence with a national trade mark office for the purposes of obtaining the registration of a trade mark would each be sufficient to constitute the beginning of the use of the trade sign. In that respect, the beginning of the protection of trade signs under Article 5 of Markengesetz does not require that the company has already made itself known to all the other operators and all of its customers.

35 In support of its argument, the applicant refers to a scholarly article (Ingerl, R., and Rohnke, C., *Markengesetz, Kommentar*, 3rd edition, C.H. Beck, Munich, 2010) and 14 judgments of the Bundesgerichtshof (Federal Court of Justice, Germany).

36 To establish the beginning of the use of its trade sign prior to the date of the application for registration of the conflicting mark, namely 23 March 1998, the applicant relies on its application for registration in the commercial register of 19 February 1998, its registration in that register on 5 March 1998, and the use of its trade sign in correspondence with the Deutsches Patent- und Markenamt (German patent and trade mark office). An acknowledgement of receipt by the Deutsches Patent- und Markenamt shows that the applicant lodged an application for registration of the trade mark macros consult at that office on 14 March 1998. Those factual elements were, according to the applicant, wrongly assessed both by the Cancellation Division and by the Board of Appeal in the contested decision.

37 The applicant also contests the Board of Appeal's finding in paragraph 26 of the contested decision, according to which the application for registration of the company name macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie is not relevant evidence in the context of the application for a declaration of invalidity. Even if the Board of Appeal considered that the application for a declaration of invalidity was based on elements comprising its company name and not on that name itself, the applicant claims that the terms 'macros' and 'macros consult' are distinctive elements of its trade sign and that they are therefore protected as such, even used in isolation, under Article 5 of the Markengesetz.

38 The applicant adds that it has operated under its trade sign since, at the least, the application for registration in the commercial register referred to in paragraph 36 above. Thus, in 2006, it had a total turnover of EUR 1.7 million. Before OHIM, it produced its annual accounts for 2005 and 2006 and documents from 2005, 2006 and 2008 proving its participation in the Centrum für Büroautomation, Informationstechnologie und Telekommunikation (CeBIT, office and information technologies exhibition). Therefore, in the applicant's view, the Board of Appeal wrongly failed to take account of the fact that it had pursued a continuous economic activity since its creation.

39 Lastly, the applicant challenges all the pleas of inadmissibility put forward by OHIM and the intervener. In response to OHIM's argument alleging the loss of any earlier right which the applicant might have acquired, because of the lack of proof of the existence of an activity in relation to third parties between 1998 and 2005, the applicant produces, in annex to the reply, its annual accounts for the financial years 1998 to 2005. It submits that this evidence cannot be dismissed as out of time, since it was produced only in order to respond to an argument presented by OHIM in its reply, and states that it is at the disposal of the Court should further evidence be required.

40 As regards the similarity of the signs at issue, the applicant refers to the entire procedure before OHIM and to the statement submitted by the intervener in the opposition proceedings mentioned in paragraphs 12 and 13 above.

41 OHIM contends that the application is inadmissible in its entirety and must be dismissed. First, it submits that the application does not expressly refer to the pleas raised against the contested decision but rather claims that the Court should rule on the substance of the applicant's claims relating to the existence of an earlier right following an initial assessment of the facts. The Court can only hear a challenge to the legality of the contested decision.

42 Secondly, OHIM contests the admissibility of the applicant's general reference to the opposition proceedings referred to in paragraphs 12 and 13 above, for the purposes of establishing the existence of a risk of confusion between the earlier rights which it relies on and the conflicting mark. Furthermore, since the Board of Appeal did not analyse the likelihood of confusion between the alleged earlier mark and the conflicting mark, it is not for the Court to carry out such an assessment for the first time.

43 Thirdly, OHIM claims that the extract from the commercial register produced in Annex A4 to the application is dated 21 December 2010 and that, consequently, it dates from after the adoption of the contested decision. That annex therefore constitutes new evidence and is, accordingly, inadmissible. Likewise, OHIM submits that the decisions of German courts referred to in paragraph 35 above cannot be taken into consideration by the Court. They are factual elements which the applicant should have put forward during the administrative procedure, since the proof of the existence of an earlier right within the meaning of Article 53 of Regulation No 207/2009 is considered as a factual issue, which must be proved by the party which relies on it, in accordance with Rule 37(b)(iii) of Regulation No 2868/95. Lastly, OHIM claims that the factual elements put forward by the applicant in annex to the reply (see paragraph 39 above) are new and are, accordingly, inadmissible.

44 As regards the substance, OHIM claims that it is apparent from the case-law that the burden of proof of the existence of an earlier right protected under a national legal system rests on the party seeking to rely on that right and that this proof must be produced during the administrative procedure. OHIM claims that, since the applicant did not produce that proof, the Board of Appeal was right to find that the application for a declaration of invalidity should be rejected.

45 OHIM claims, like the intervener, that the mere filing of an application for registration of a national trade mark, which is the sole factual element put forward by the applicant besides its registration in the commercial register, does not constitute a beginning of use within the meaning of Article 5 of the Markengesetz.

46 Moreover, the application for registration at issue was abandoned by the applicant and the first documents which demonstrate actual activity on its part date to 2005. Thus, even if the applicant had acquired a right to a trade sign under Article 5 of the Markengesetz in 1998, the period of interruption of six years would have extinguished any potential right. In any event, a new right to the sign, acquired in 2005, would have no priority over the application for registration of the conflicting mark.

47 Furthermore, according to OHIM, the registration of the applicant in the commercial registry does not constitute use in the course of trade within the meaning of Article 5 of the Markengesetz.

48 Lastly, the applicant did not rely on Article 15 of the Markengesetz, which is the sole provision which provides for the prohibition of a sign, of which the right of use has been acquired under Article 5 of that law.

49 The intervener claims that, in the application, the applicant did not indicate with sufficient detail the provisions allegedly infringed by the Board of Appeal in the contested decision. Therefore, the application does not satisfy the requirements of Article 44(1)(c) of the Rules of Procedure of the General Court.

50 Likewise, it considers the factual elements produced for the first time by the applicant in support of the reply, namely three judgments of the Bundesgerichtshof, and the annual accounts concerning the complete financial years of 1998 to 2005, to be inadmissible.

51 As regards the substance of the case, first, it claims that the applicant has not proved that its company name is protected under German trade mark law. It claims that a party before OHIM which seeks to rely on an earlier right within the meaning of Article 8(4) of the Regulation No 207/2009, must, in accordance with Rule 19(2) of Regulation No 2868/95, produce poof of the existence of the right which it adduces. According to the intervener, the applicant failed to establish that its abridged company name macros consult was protected as a trade sign.

52 Secondly, the intervener claims that, if the applicant presents new evidence to establish the use of its company name or of the sign macros in the course of trade prior to the application for registration of the conflicting mark, that evidence should be dismissed by the Court as out of time, since it was not submitted to OHIM. It considers, moreover, that the Board of Appeal was right to find that the evidence relating to the financial years 2006 and 2008 could not establish the priority of an earlier right, since that evidence relates to facts which occurred more than ten years after the application for registration of the conflicting mark.

53 Thirdly, the intervener claims that, besides the lack of evidence of the existence of an earlier right prior to the application for registration of the conflicting mark, the condition which requires that the use of an unregistered sign must be of more than ‘mere local significance’ is not fulfilled. Moreover, it contests the existence of a likelihood of confusion between the alleged earlier right relied on by the applicant and the conflicting mark.

Findings of the Court

The scope of the conditions set out in Article 53(1)(c) of Regulation No 207/2009

54 Under Article 53(1)(c) of Regulation No 207/2009 in conjunction with Article 8(4) thereof, the existence of a sign other than a mark makes it possible to obtain a declaration that a Community trade mark is invalid 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 date of application for registration of the Community trade mark; and, lastly, the sign must confer on its

proprietor the right to prohibit the use of a subsequent trade mark. Those four conditions limit the number of signs other than marks which may be relied on to dispute the validity of a Community trade mark throughout the Community under Article 1(2) of Regulation No 207/2009. Given that the conditions laid down by Article 8(4) of Regulation No 207/2009 are cumulative, it is sufficient that only one of those conditions not be satisfied for an application for a declaration of invalidity of Community trade marks to be rejected (Joined Cases T-318/06 to T-321/06 *Moreira da Fonseca* v *OHIM - General Óptica (GENERAL OPTICA)* [2009] ECR II-649, paragraphs 32 and 47).

55 The first two conditions, namely those relating to the 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) of Regulation No 207/2009 and must therefore be interpreted in the light of European Union law. Regulation No 207/2009 thus sets out uniform standards, relating to the use of signs and their significance, which are consistent with the principles underlying the system established by that regulation (*GENERAL OPTICA*, paragraph 54 above, paragraph 33).

56 By contrast, it is apparent from the phrase 'where and to the extent that, pursuant to the law of the Member State governing that sign', that the other two conditions, set out subsequently in Article 8(4)(a) and (b) of Regulation No 207/2009, constitute conditions laid down by the regulation which, unlike the conditions above, must be assessed in the light of the criteria set by the law governing the sign relied on. That reference to the law governing the sign relied on is entirely justified, given that Regulation No 207/2009 makes it possible for signs which fall outside the Community trade mark system to be relied on against a Community trade mark. Therefore, only the law which governs the sign relied on can determine whether that sign predates the Community trade mark and whether it can justify a prohibition of the use of a subsequent trade mark (*GENERAL OPTICA*, paragraph 54 above, paragraph 34).

The rules on the burden of proof and taking of evidence concerning the existence of an earlier national right

57 It is apparent from the wording of Article 53(2) of Regulation No 207/2009 that when that provision refers to the situation in which the existence of an earlier right makes it possible to prohibit the use of a Community trade mark it distinguishes clearly between two situations, depending on whether the earlier right is protected under the European Union legislation 'or' under national law (Case C-263/09 P *Edwin* v *OHIM* [2011] ECR I-5853, paragraph 48).

58 As regards the procedural arrangements laid down by Regulation No 2868/95 in the case of an application pursuant to Article 52(2) of Regulation No 207/2009, based on an earlier right protected under national law, Rule 37 of Regulation No 2868/95 provides, in a situation such as that in the present case, that the applicant must provide particulars showing that he is entitled under the applicable national law to lay claim to that right (*Edwin* v *OHIM*, paragraph 57 above, paragraph 49).

59 That rule requires the applicant, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, to provide OHIM with not only particulars showing that he satisfies the necessary conditions under the national law whose application he is seeking, but also particulars establishing the content of that law (*Edwin* v *OHIM*, paragraph 57 above, paragraph 50).

60 Since Article 53(1)(c) of Regulation No 207/2009 expressly refers to Article 8(4) of that regulation, and the latter provision concerns earlier rights protected under European Union legislation or under the law of the Member State governing the sign at issue, the rules of evidence referred to in paragraphs 57 to 59 above also apply when a provision of national law is invoked on the basis of Article 53(1)(c) of Regulation No 207/2009. Rule 37(b)(ii) of Regulation No 2868/95 provides similar provisions in relation to the proof of an earlier right in the event of an application made under Article 53(1) of Regulation No 207/2009.

61 Furthermore, in accordance with Article 65 of Regulation No 207/2009, the General Court cannot examine the factual circumstances in the light of evidence produced for the first time before it. According to settled case-law, the purpose of an action before the General Court is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of that provision, and that legality must be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted (see Order of 13 September 2011 in Case C-546/10 P *Wilfer* v *OHIM*, not published in the ECR, paragraph 41 and the case-law cited).

62 If follows from the foregoing that the issue of the existence of a national right such as that relied on in the present case by the applicant is a question of fact. It is therefore for the party which alleges the existence of a right fulfilling the conditions set out in Article 8(4) of Regulation No 207/2009, to establish, before OHIM, not only that this right arises under the national law, but also the scope of that law.

63 Accordingly, in finding, in the directives relating to proceedings before OHIM (Part C, Chapter 4, paragraph 5.4), adopted by the decision of 28 October 1996, that the national law applicable under Article 8(4) of Regulation No 207/2009 would be considered in the same manner as a factual issue and that it was not in a position to automatically determine, with precision, the law of all of the Member States concerning the rights within the scope of Article 8(4) of Regulation No 207/2009, the president of OHIM correctly interpreted the rules governing the burden of proof.

64 In accordance with the usual rules for establishing facts before the Courts of the European Union ruling on matters concerning the Community trade mark in *inter partes* proceedings (see Article 76 of Regulation No 207/2009), it must be recalled that the European Union judicature cannot criticise the Board of Appeal for disregarding facts which were not submitted in due time by the parties concerned.

65 It follows that the Court cannot, in the present case, carry out an autonomous assessment of whether the applicant may rely on the sign protected by Article 5 of the Markengesetz. The Court cannot substitute its own interpretation of German law for that carried out by the Board of Appeal; its review extends only to the question of whether, in determining the scope of German law and concluding that the applicant had not established the existence of an earlier right protected under German law, the Board of Appeal correctly assessed the evidence which had been submitted to it prior to the contested decision.

66 It is in the light of the foregoing that the substance of the applicant's arguments contesting the legality of the contested decision must be assessed.

The legality of the contested decision

67 In the contested decision, the Board of Appeal found, in essence, that the applicant had not succeeded in establishing that the conditions set out in Article 5 of Markengesetz to allow the applicant to rely on a right to the protection of the sign macros consult GmbH were fulfilled, because of the lack of proof of the use of that sign in the course of trade prior to the application for registration of the conflicting mark (contested decision, paragraphs 21 to 28).

68 Moreover, the Board of Appeal dismissed as irrelevant the evidence produced by the applicant concerning facts subsequent to the date of the application for registration of the conflicting mark (paragraph 27 of the contested decision). The applicant produced some of that evidence in annex to its application and it accompanied its reply with new evidence, also relating to facts subsequent to the application for registration of the conflicting mark.

69 It is therefore necessary to verify, first, whether the applicant is justified in its complaint that the Board of Appeal refused to take into consideration factual elements submitted to it which dated from after the application for registration of the conflicting mark, and, secondly, to review the assessment carried out by the Board of Appeal as to whether the applicant established the existence of an earlier right.

– The evidence relating to facts subsequent to the application for registration of the conflicting mark

70 It follows from the very wording of Article 53(1) and (2) of Regulation No 207/2009 that applications for a declaration of invalidity based on those provisions depend on the existence of an earlier right. Furthermore, 'earlier' is defined in Article 8(4) of that regulation, to which Article 53(1)(c) refers, as meaning that the right on which the application for a declaration of invalidity is based must have been acquired prior to the date of application for registration of the Community trade mark in respect of which the declaration of invalidity is sought or, as the case may be, the date of the priority of the latter (see, to that effect, *GENERAL OPTICA*, paragraph 54 above, paragraph 32).

71 In the present case, the application for registration of the conflicting mark was filed on 23 March 1998 (see paragraph 5 above). The applicant is therefore required to show that it had acquired the right on which it relies prior to that date. Consequently, the Board of Appeal was right to reject all of the evidence submitted by the applicant concerning facts which occurred between 2006 and 2008 (see paragraph 27 of the contested decision).

– The Board of Appeal's finding that the applicant had not established the existence of an earlier right on which an application for a declaration of invalidity could be based.

72 In that respect, it must be recalled that it is for the party making an application for a declaration of invalidity on the basis of a sign protected under a national legal system to prove before OHIM, first, the conditions laid down by the national legal order at issue which must be fulfilled in order to give rise to a protected right and, secondly, that those conditions are fulfilled (see paragraphs 57 to 60 above). Moreover, when reviewing the legality of the contested decision adopted by the Board of Appeal, the General Court can take into consideration only the elements existing at the time when that measure was adopted (see paragraph 61 above).

73 The Court must therefore examine, first, whether the applicant is right in claiming that the Board of Appeal was mistaken about the scope of German law.

74 In that respect, it must be observed, first of all, that all of the parties to the dispute agree that Article 5 of the Markengesetz requires, as a condition for protection of a right to a trade sign, the use of the sign at issue in the course of trade. That condition is clear from the wording of that provision (see paragraph 4 above). The parties disagree, however, on the interpretation of the scope of that condition.

75 For the reasons set out in paragraphs 57 to 64 above, OHIM is right to claim that, from the perspective of European Union law, the conditions to which the acknowledgement of rights protected under national law is subject is an issue of fact, which the parties must establish before OHIM.

76 It is therefore necessary to uphold the plea of inadmissibility submitted by OHIM and the intervener alleging that the applicant cannot put forward for the first time before the Court the interpretation of Article 5 of the Markengesetz carried out by the Bundesgerichtshof in several decisions and by German academic writing. It is not disputed that, as the applicant acknowledged at the hearing, it did not produce that evidence during the administrative procedure, but rather referred to it – while producing only a part – for the first time before the Court. The Court cannot therefore take that evidence into consideration in assessing the legality of the contested decision.

77 Moreover, the applicant does not claim to have provided the Board of Appeal with evidence relating to the scope of the German law that the Board of Appeal is said to have misinterpreted. Therefore, it is wrong to criticise the assessments relating to the scope of German law carried out by the Board of Appeal in the contested decision.

78 Secondly, it is necessary to verify whether the applicant succeeds in establishing that, in the contested decision, the Board of Appeal made an error of assessment in its application of German law, such as it was interpreted in that decision.

79 In that regard, it is undisputed that the only factual elements produced by the applicant before the Board of Appeal which date from prior to the application for registration of the conflicting mark are documents relating to the registration of the applicant in the German commercial register (Annex A3 of the application) and to an application for registration of the national word mark macros, filed at the Deutsches Patent- und Markenamt (Annex A6 to the application).

80 By contrast, as OHIM and the intervener submit, the documents produced by the applicant in annex to the reply, namely the annual accounts for the fiscal years 1998 to 2005, are inadmissible, since they were not included in the file submitted to the Board of Appeal.

81 As regards, on the one hand, the registration of the applicant in the commercial registry, the Board of Appeal claimed that the company name under which the applicant was registered, namely macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie, is not identical to the company name macros consult GmbH on whose protection the applicant relies.

82 In that respect, it must be observed that the applicant did not present any evidence before the Board of Appeal capable of showing that, in German law, the company name whose protection is invoked on the basis of Article 5 of the Markengesetz (namely, in the present case, the sign macros consult GmbH) can differ from the designation in the evidence put forward to prove the existence of that protection (namely, in the present case, the registration of the applicant under the designation macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie). Therefore, the applicant cannot contest, for the first time before the Court, the Board of Appeal's interpretation of the scope of German law. In any event, even if it were accepted that the registration of the company name macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie in the commercial register should have been taken into consideration by the Board of Appeal, it suffices to point out that such a registration, while allowing the applicant to use the designation macros consult GmbH in the course of trade, does not in itself demonstrate the lasting nature of the use of that designation.

83 As regards, on the other hand, the application for registration of the word mark macros filed at the Deutsches Patent- und Markenamt, it is not disputed that that application shows the existence of correspondence between that office and the applicant, the latter acting under the designation macros consult GmbH.

84 As a preliminary, it should be recalled that, given the subject-matter of the application for a declaration of invalidity, based on the protection in German law of the company name macros consult GmbH, the present proceedings do not concern the issue of whether the mark macros, the registration of which was applied for at the Deutsches Patent- und Markenamt, is protected, but rather concern solely the issue of whether the filing of an application for registration of that mark allows the applicant to establish the use of the company name macros consult GmbH in the course of trade.

85 In finding that a mere application seeking the registration of a word mark filed at the Deutsches Patent- und Markenamt is not sufficient to prove the use of the company name macros consult GmbH in the course of business, the Board of Appeal did not make an error of assessment in the application of German law, such as its scope was defined in that decision.

86 As the Board of Appeal pointed out in paragraph 25 of the contested decision, the application for registration of a mark neither presupposes nor implies the use of that mark and it is undisputed that the registration procedure was not pursued by the applicant. Since the Board of Appeal considered that the condition relating to use in the course of trade laid down in Article 5 of the Markengesetz should show a certain degree of effectiveness and a sufficiently habitual character (paragraphs 23 and 25 of the contested decision), it was entitled to infer that, in order to establish habitual use in the course of trade of the applicant's company name, mere isolated correspondence was insufficient.

87 The applicant has not produced any admissible evidence to the contrary. It follows that it has not succeeded in showing that, in the contested decision, the Board of Appeal wrongly found that it had not established the existence of an earlier right on which an application for a declaration of invalidity brought under Article 53(1)(c) of Regulation No 207/2009 could be based.

88 Accordingly, the applicant's single plea in law must be rejected, and it is necessary, therefore, to dismiss the present action, without it being necessary to rule on the other pleas of inadmissibility made by OHIM and by the intervener (see, to that effect, Case C-23/00 P *Council* v *Boehringer* [2002] ECR I-1873, paragraph 52).

Costs

89 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs in accordance with the forms of order sought by OHIM and the intervener.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

1. Dismisses the action;

2. Orders macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie to pay the costs.

Azizi Frimodt Nielsen Buttigieg

Delivered in open court in Luxembourg on 7 May 2013.

[Signatures]