JUDGMENT OF THE COURT (Fourth Chamber)

29 July 2010 *

In Case C-214/09 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 12 June 2009,

Anheuser-Busch Inc., established in Saint Louis (United States), represented by V. von Bomhard and B. Goebel, Rechtsanwälte,

appellant,

the other parties to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Folliard-Monguiral, acting as Agent,

defendant at first instance,

* Language of the case: English.

Budějovický Budvar, národní podnik, established in České Budějovice (Czech Republic), represented by K. Čermák, advokát,

intervener at first instance,

THE COURT (Fourth Chamber),

composed of J.-C. Bonichot (Rapporteur), President of Chamber, C. Toader, K. Schiemann, L. Bay Larsen and J.-J. Kasel, Judges,

Advocate General: P. Cruz Villalón,
Registrar: C. Strömholm, Administrator,

having regard to the written procedure and further to the hearing on 11 May 2010,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

Judgment

1 By its appeal, Anheuser-Busch Inc. ('Anheuser-Busch') seeks to have set aside the judgment of the Court of First Instance of the European Communities (now 'the General Court') of 25 March 2009 in Case T-191/07 *Anheuser-Busch* v *OHIM - Budějovický Budvar (BUDWEISER)* [2009] ECR II-691 ('the judgment under appeal'), by which the General Court dismissed its action against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 20 March 2007 (Case R 299/2006-2) ('the contested decision') refusing registration of the word mark BUDWEISER and upholding the opposition to registration entered by Budějovický Budvar, národní podnik ('Budvar').

Legal context

Regulation (EC) No 40/94

2 Article 8, entitled 'Relative grounds for refusal', of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), which applies to the dispute and which was subsequently repealed and replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), provides as follows in paragraph 1:

'Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.'

3 Under Article 15 of Regulation No 40/94, entitled 'Use of Community trade marks':

'1. If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

2. The following shall also constitute use within the meaning of paragraph 1:

(a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

…'

4 Article 42(3) of Regulation No 40/94 provides:

'Opposition must be expressed in writing and must specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid. Within a period fixed by [OHIM], the opponent may submit in support of his case facts, evidence and arguments.'

5 Paragraphs 1 to 3 of Article 43 of Regulation No 40/94 read as follows:

'1. In the examination of the opposition [OHIM] shall invite the parties, as often as necessary, to file observations, within a period set them by [OHIM], on communications from the other parties or issued by itself.

2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five

years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'

6 Article 74 of Regulation No 40/94, which is in Section 1, entitled 'General provisions', of Title IX, which relates to procedure, provides, under the heading 'Examination of the facts by [OHIM] of its own motion':

'1. In proceedings before it [OHIM] shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, [OHIM] shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. [OHIM] may disregard facts or evidence which are not submitted in due time by the parties concerned.'

7 Article 76(1) of Regulation No 40/94 provides as follows:

'In any proceedings before [OHIM], the means of giving or obtaining evidence shall include the following:

(a) hearing the parties;

(b) requests for information;

(c) the production of documents and items of evidence;

(d) hearing witnesses;

(e) opinions by experts;

(f) statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.'

The implementing regulation (1995)

8 Rule 16 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, 'the implementing regulation (1995)') provides as follows:

'1. Every notice of opposition may contain particulars of the facts, evidence and arguments presented in support of the opposition, accompanied by the relevant supporting documents.

2. If the opposition is based on an earlier mark which is not a Community trade mark, the notice of opposition shall preferably be accompanied by evidence of the registration or filing of that earlier mark, such as a certificate of registration. …

3. The particulars of the facts, evidence and arguments and other supporting documents as referred to in paragraph 1, and the evidence referred to in paragraph 2 may, if they are not submitted together with the notice of opposition or subsequent thereto, be submitted within such period after commencement of the opposition proceedings as [OHIM] may specify pursuant to Rule 20(2).'

9 Rule 20(2) of the implementing regulation (1995) is worded as follows:

'Where the notice of opposition does not contain particulars of the facts, evidence and arguments as referred to in Rule 16(1) and (2), [OHIM] shall call upon the opposing party to submit such particulars within a period specified by [OHIM]. Any submission by the opposing party shall be communicated to the applicant who shall be given an opportunity to reply within a period specified by [OHIM].'

10 Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4), which entered into force on 25 July 2005, amended the implementing regulation (1995) which, as amended, is hereinafter referred to as 'the implementing regulation (2005)'.

11 Rule 18(1) of the implementing regulation (2005) states:

'When the opposition is found admissible pursuant to Rule 17, [OHIM] shall send a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication. This period may be extended up to a total of 24 months if both parties submit requests for such an extension before the period expires.'

12 Rule 19 of the implementing regulation (2005) provides as follows:

'1. [OHIM] shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time limit specified by it and which shall be at least 2 months starting on the date on which the opposition proceedings shall be deemed to commence in accordance with Rule 18(1).

2. Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:

(a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting:

…

(ii) 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;

…

4. [OHIM] shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by [OHIM].'

Background to the dispute

13 The background to the dispute brought before the General Court, as stated in the judgment under appeal, may be summarised as follows.

14 On 1 April 1996 Anheuser-Busch filed an application with OHIM for registration as a Community trade mark of the word sign 'BUDWEISER' for goods falling within Class 32 of the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponding to the following description: 'beer, ale, porter, malted alcoholic and non-alcoholic beverages'.

15 On 28 September 1999, Budvar brought opposition proceedings against the registration of the mark applied for in respect of all goods concerned, relying, first, under Article 8(1)(a) and (b) of Regulation No 40/94, on the existence of three trade marks, namely:

— the international word mark BUDWEISER (R 238 203) ('trade mark R 238 203'), registered for 'beer of any kind', with effect in Germany, Austria, Benelux and Italy;

— the international figurative mark including the words 'Budweiser Budvar' (No 674 530) ('trade mark 674 530'), registered for 'malt' and 'beer', with effect in Austria, Benelux, France and Italy; and

— the international figurative mark including the words 'Budweiser Budvar' (No 614 536) ('trade mark 614 536'), registered for 'beers', with effect in Germany, Austria, Benelux, France and Italy.

16 Budvar relied, second, under Article 8(4) of Regulation No 40/94, on a number of appellations of origin including the word 'Budweiser'.

17 OHIM had originally set 24 June 2000 as the end of the period within which Budvar was to submit facts, evidence and arguments in support of its opposition. That period was subsequently extended until 26 February 2002. The documents that Budvar transmitted by fax to that end were filed as a whole at OHIM on 27 February 2002.

18 On 8 July 2002, Anheuser-Busch requested, pursuant to Article 43(2) and (3) of Regulation No 40/94, that Budvar furnish proof that the marks referred to in support of its opposition had been put to genuine use.

19 Budvar responded to that request by a letter of 8 November 2002, the period specified for that purpose by OHIM in a letter of 10 September 2002 expiring on 11 November 2002.

20 In its letter, Budvar expressly referred to the documents received by OHIM on 27 February 2002, which served to prove the use of appellations of origin including the word 'Budweiser', and submitted that those documents applied, inter alia, to trade mark R 238 203.

21 Before the Opposition Division, Budvar also produced, as an annex to its observations of 21 January 2004, an extract issued by the World Intellectual Property Organisation (WIPO) certifying that registration of trade mark R 238 203 had been renewed on 5 December 2000 ('the certificate of renewal').

22 By a first decision of 10 June 2004, the Opposition Division upheld the opposition entered by Budvar, holding in essence that there was a likelihood of confusion in Austria and France between the mark applied for and trade mark 674 530.

23 By a decision of 11 July 2005 the Second Board of Appeal of OHIM upheld Anheuser-Busch's appeal against the decision of 10 June 2004, on the ground that trade mark 674 530 was protected in Austria and France only after the application for the Community trade mark concerned had been filed. It referred the case back to the Opposition Division.

24 By a second decision of 22 December 2005, the Opposition Division once again upheld the opposition entered by Budvar. Considering, first of all, that the evidence of use of trade mark R 238 203 was insufficient, it limited its examination to trade mark 614 536, in relation to which it decided to take into account the documents produced by Budvar in support of its opposition. In conclusion, the Opposition Division considered, in essence, that there was a likelihood of confusion in Germany, Austria, Benelux, France and Italy between the mark applied for and that earlier trade mark.

25 By the contested decision, the Second Board of Appeal of OHIM dismissed Anheuser-Busch's appeal against the decision of 22 December 2005.

26 It held, contrary to the Opposition Division, that trade mark R 238 203 could be taken into account, concluding, on the basis of the documents produced by Budvar, that proof of genuine use of that mark had been furnished.

27 The Board of Appeal concluded that, for 'beer, ale, porter, malted alcoholic … beverages', the opposition could be upheld on the basis of Article 8(1)(a) of Regulation No 40/94 and that, for the remaining products ('non-alcoholic beverages'), in view of the identity of the marks and the obvious similarities between the goods, the opposition could be upheld for those goods on the basis of Article 8(1)(b) of Regulation No 40/94.

Proceedings before the General Court and the judgment under appeal

28 By application lodged at the Registry of the General Court on 31 May 2007, Anheuser-Busch brought an action for annulment of the contested decision.

29 OHIM and Budvar contended that the action should be dismissed.

30 Since Anheuser-Busch's appeal is directed against only certain parts of the judgment under appeal, only those parts will be considered below.

31 By its second plea, alleging infringement of Article 74(2) of Regulation No 40/94, Anheuser-Busch complained, in particular, that the Board of Appeal had not excluded the certificate of renewal, as that document had been provided by Budvar on 21 January 2004.

32 In that regard, the General Court held, in paragraphs 63 to 71 of the judgment under appeal, (i) that no infringement of Article 74(2) of Regulation No 40/94 could be found in the contested decision, since it did not appear from that decision that the Board of Appeal considered that the certificate of renewal had not been submitted in due time and had applied Article 74(2) for the purpose of taking the certificate into account and (ii) that, for the reasons stated in paragraphs 78 and 79 of the judgment under appeal, the certificate had been produced in due time.

33 In paragraphs 78 and 79 of the judgment under appeal, the General Court held, inter alia, that although it results from a reading of Rule 16 in conjunction with Rule 20 of the implementing regulation (1995) that OHIM is entitled to require proof that an earlier mark has been renewed where that mark expires after the notice of opposition has been filed, paragraph 2 of Rule 20 does not require the opposing party, on its own initiative, to submit such evidence, nor does it specify that OHIM is required to exclude a document where it is brought late to its attention.

34 As regards Rule 20(2) of the implementing regulation (1995), the General Court also held, in paragraph 73 of the judgment under appeal, that under Article 74(2) of Regulation No 40/94, OHIM has a discretion as to whether or not to take account of evidence produced after the expiry of a time-limit and the rule cannot be interpreted in a manner which is contrary to the clear wording of the regulation.

35 For the sake of completeness, the General Court held, in paragraphs 74 to 77 of the judgment under appeal that, in view of the principle of legal certainty as affirmed by the case-law of the Court of Justice, the provisions introduced by the implementing regulation (2005) into the implementing regulation (1995), in particular Rule 19(4) thereof, could not be applied with retroactive effect in the present case.

36 Accordingly, the General Court rejected Anheuser-Busch's second plea as unfounded.

37 By its third plea, alleging infringement of Article 43(2) and (3) of Regulation No 40/94, Anheuser-Busch claimed that the evidence produced by Budvar was insufficient to prove genuine use of trade mark R 238 203.

38 After recalling, in paragraphs 99 to 105 of the judgment under appeal, the case-law relating to the interpretation of the concept of genuine use, the General Court stated, in paragraph 106 of the judgment, that in the present case the Board of Appeal had found that 'the evidence which Budvar produced was clearly sufficient to prove genuine use of … [trade] mark [R 238 203]' and that the Board had referred, in particular, to advertisements showing images of Budvar beer bearing the mark BUDWEISER, to invoices sent to customers in Germany and Austria and to the fact that those documents related to the period relevant for the purposes of Article 43(2) and (3) of Regulation No 40/94.

39 As regards, first, the advertisements, which appeared in an Austrian magazine and in German magazines, sent by Budvar to OHIM on 8 November 2002, the General Court stated, in paragraph 110 of the judgment under appeal, that Anheuser-Busch did not dispute that those documents provided evidence as to the nature of the goods (beer), the place (Germany and Austria) and the time (1995 for Austria and between 1996 and 1998 for Germany) of the use of the word 'Budweiser'. The General Court, also in paragraph 110 of that judgment, added that nor did Anheuser-Busch dispute that the use of the word 'Budweiser', in the various forms used in the advertisements submitted by Budvar, could be linked to trade mark R 238 203.

40 With regard, next, to the advertisements and invoices received as a whole by OHIM on 27 February 2002, the General Court stated, in paragraph 111 of the judgment under appeal, that Budvar had transmitted those documents in order to prove use of appellations of origin including the word 'Budweiser' but that, in its letter of 8 November 2002 in response to Anheuser-Busch's request that it furnish proof of genuine use of the earlier trade marks relied on in support of the opposition, Budvar had expressly referred to those documents, considering that they applied, inter alia, to trade mark R 238 203.

41 In that regard, the General Court concluded, in paragraph 112 of the judgment under appeal, that Anheuser-Busch did not dispute before it the fact that the documents concerned related to the use of trade mark R 238 203 and that nor did it question the fact that those documents provided evidence of the place, time and extent of the use of that mark, factors which, moreover, in the General Court's view, were clearly apparent from those documents.

42 Finally, in paragraph 114 of the judgment under appeal, the General Court, with regard to Anheuser-Busch's argument that the Board of Appeal should have taken other factors into account, such as the nature of the use of trade mark R 238 203 in Germany and Austria, considered that it sufficed to state on that point that the Board of Appeal had referred to advertisements showing pictures of Budvar's 'beer' bearing the earlier mark. The General Court also found that the nature of the use of the mark, namely, as referring to beer, was clear from both the advertisements and the invoices submitted by Budvar and that, in referring to the invoices, the Board of Appeal had necessarily, albeit implicitly, found that same nature of use.

43 Consequently, the General Court rejected Anheuser-Busch's third plea as unfounded.

44 The General Court thus dismissed the action in its entirety.

Forms of order sought

45 By its appeal, Anheuser-Busch claims that the Court should:

— set aside the judgment under appeal, and

— order OHIM to pay the costs.

46 OHIM and Budvar contend that the appeal should be dismissed and that Anheuser-Busch should be ordered to pay the costs.

The appeal

47 In support of its appeal Anheuser-Busch raises three pleas in law: (i) infringement of Article 42(3) of Regulation No 40/94 in conjunction with Rules 16(1) and (3) and 20(2) of the implementing regulation (1995), (ii) infringement of Article 74(2) of Regulation No 40/94 and (iii) infringement of Article 43(2) and (3) of Regulation No 40/94.

First plea: infringement of Article 42(3) of Regulation No 40/94 in conjunction with Rules 16(1) and (3) and 20(2) of the implementing regulation (1995)

Arguments of the parties

48 By its first plea, Anheuser-Busch maintains that the General Court's interpretation, in paragraphs 78 and 79 of the judgment under appeal, of Article 42(3) of Regulation No 40/94 is wrong in law.

49 In its view, that interpretation stands in stark contrast to previous case-law of the General Court and to the consistent practice of OHIM over many years, more specifically until the codification of that case-law and practice in Rule 19 of the implementing regulation (2005).

50 In fact it is apparent from Case T-318/03 *Atomic Austria* v *OHIM - Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)* [2005] ECR II-1319 and Case T-191/04 *MIP Metro* v *OHIM - Tesco Stores (METRO)* [2006] ECR II-2855 that the General Court, like OHIM, took the view that, where requested to submit all facts, evidence and arguments in support of its case, the opponent had to act upon that within the time-limit set by OHIM, and that this obligation extended to submitting evidence of the renewal of the earlier mark where it had in the meantime been renewed, in so far as proof of that could not be seen from any documents submitted with the notice of opposition.

51 The consistent practice of OHIM to require a timely submission of evidence of renewal resulted in an amendment of OHIM's Guidelines and in codification in Rule 19(2)(a)(ii) of the implementing regulation (2005).

52 In those circumstances, by denying the obligation, on the part of Budvar, to submit the certificate of renewal of trade mark R 238 203 as at the date by which the facts, evidence and arguments in support of the opposition had to be filed, namely 26 February 2002, the General Court reached the wrong conclusion that the Board of Appeal was at liberty not to assess whether the later submission of that certificate, namely on 21 January 2004, was to be taken into account.

53 OHIM responds that the findings of the General Court are well founded in law since, although under Rules 16 and 20 of the implementing regulation (1995) OHIM or a party to opposition proceedings was entitled to require proof of the renewal of an earlier right whose term was to expire in the course of the proceedings, that did not mean – as is confirmed, moreover, by the case-law of the General Court cited by Anheuser-Busch – that the earlier right holder had the obligation to provide the renewal certificate on its own initiative.

54 OHIM also points out that the time-limit initially set by the Opposition Division for the submission of evidence in support of the opposition filed on 28 September 1999 was 24 June 2000 and that trade mark R 238 203 did not have to be renewed until 5 December 2000 at the latest. No provision of the implementing regulation (1995) required proof of a future event, in the present case proof of the aforementioned renewal. Although the time-limit initially set was subsequently extended until 26 February 2002, the Opposition Division did not explicitly require proof of renewal to be provided within that time-limit.

55 Budvar points out that its notice of opposition contained annexes including detailed substantiation of its case and a number of evidential documents, including the certificate of registration of trade mark R 238 203 establishing the validity of that mark at the time the notice of opposition was filed. Budvar thus fulfilled its obligation to 'file facts, evidence and arguments in support of the opposition' and was not required to submit, after the date the notice of opposition was filed, the certificate of renewal.

Findings of the Court

56 By its first plea, Anheuser-Busch claims in essence that, contrary to what was held by the General Court in paragraph 79 of the judgment under appeal, it is clear from a reading of Article 42(3) of Regulation No 40/94 in conjunction with Rules 16(1) and (3) and 20(2) of the implementing regulation (1995) that an opponent must provide, on its own initiative, within the period fixed by OHIM pursuant to Article 42(3) of Regulation No 40/94, evidence of renewal of its earlier mark, relied on under Article 8(1) of Regulation No 40/94, with the other facts, evidence and arguments submitted in support of its opposition, where such renewal occurs after the date on which notice of opposition is filed but before expiry of the period fixed by OHIM.

57 In that regard, it must be stated that, as the General Court held, neither Article 42(3) of Regulation No 40/94 nor Rules 16(1) and (3) and 20(2) of the implementing regulation (1995) specify the facts, evidence and arguments which must be submitted in support of the opposition within the period fixed under Article 42(3) of Regulation No 40/94.

58 In particular, those provisions contain nothing to suggest that an opponent should automatically provide, within the period fixed by OHIM, evidence of renewal of the earlier mark relied on where the renewal is to occur after notice of opposition has been filed.

59 Furthermore and in any event, contrary to Anheuser-Busch's submission, such an interpretation does not follow either from the case-law of the General Court, in particular *Atomic Austria* v *OHIM – Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)* and *MIP Metro* v *OHIM – Tesco Stores (METRO)*, or from any consistent practice of OHIM prior to adoption of the implementing regulation (2005).

60 In the disputes giving rise to those two judgments of the General Court, OHIM had explicitly requested that the opponent produce evidence of renewal of the earlier marks within the period set under Article 42(3) of Regulation No 40/94 where that renewal was to take place before that period expired. In those two cases, the question was not, therefore, whether the opponent was required to produce such evidence on its own initiative. That question does, however, arise in these proceedings, since it is common ground that, in this instance, OHIM did not expressly request the opponent to provide such evidence.

61 Furthermore, in *Atomic Austria* v *OHIM – Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*, the General Court held that, even where there was a specific request for production of evidence of renewal of the earlier trade mark under Article 42(3) of Regulation No 40/94, OHIM could not reject the opposition because such evidence had not been produced.

62 In paragraph 40 of *Atomic Austria* v *OHIM – Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*, the General Court in fact held that an opponent is free to choose the evidence he considers useful to submit to OHIM in support of his opposition and that OHIM is obliged to examine all the evidence submitted in order

to determine whether it does prove that the earlier mark was registered or filed, and cannot reject out of hand a particular type of evidence on the basis of the form it takes. Further, in paragraph 46 of that judgment, the General Court considered that it was possible to determine from extracts from the trade mark register accompanying the notice of opposition the date on which protection for the earlier marks ended, and that it was possible to conclude that four of the five earlier marks were valid at the time of the Board of Appeal's decision.

63 In paragraph 46 of *MIP Metro* v *OHIM – Tesco Stores (METRO)*, the General Court held that, where the opponent had not produced evidence of renewal of the earlier mark, requested by OHIM under Article 42(3) of Regulation No 40/94, OHIM had made two errors of law in holding, first, that the fact that the term of protection of the earlier mark expired before the Opposition Division gave a decision on the opposition could not be taken into account by the latter and, second, that the Opposition Division does not have the power to request information on the renewal of the earlier mark after the initial evidence has been filed.

64 Contrary to Anheuser-Busch's submission and in any event, nor is it apparent that, prior to adoption of the implementing regulation (2005), a consistent practice had developed at OHIM whereby an opponent was required to furnish, automatically, evidence of renewal of the earlier mark with the other facts, evidence and arguments to be submitted in support of the opposition within the period fixed by OHIM to that end under Article 42(3) of Regulation No 40/94.

65 In that connection, it must be noted that, in the decision of the Second Board of Appeal of OHIM of 9 July 2003 at issue in the dispute in *Atomic Austria* v *OHIM – Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*, the Board had rejected the opposition because evidence of renewal of the earlier marks had not been produced

within the period fixed, pointing out that such evidence had been clearly and unequivocally requested in a note attached to a letter from OHIM to the opponent under Article 42(3) of Regulation No 40/94.

66 Conversely, in the decision of the First Board of Appeal of OHIM of 23 May 2004 at issue in the dispute in *MIP Metro* v *OHIM – Tesco Stores (METRO)*, the Board upheld an appeal against the Opposition Division's decision rejecting the opposition on the ground that, although it had been requested to produce evidence of renewal of the earlier mark, the opponent had failed to provide that evidence. The Board of Appeal held that, on the date on which notice of opposition was filed and even on the date on which the evidence was requested, the earlier right was still in force and, accordingly, the opponent did not have to prove that registration of its trade mark had been renewed.

67 It thus also follows that, contrary to Anheuser-Busch's submission, nor is it apparent that the provisions of Rule 19(2) and (4) of the implementing regulation (2005) may be taken into account in this instance on the ground that they represent no more than a codification of the interpretation developed by the General Court, on the basis of OHIM's consistent practice, of Article 42(3) of Regulation No 40/94 and Rules 16(1) and (3) and 20(2) of the implementing regulation (1995).

68 In any event, while the abovementioned provisions of the implementing regulation (2005) now impose, within certain limits, an express obligation on an opponent to

produce proof of renewal of the earlier trade mark within the period referred to in Article 42(3) of Regulation No 40/94, they thereby clarify the general rule laid down by Article 42(3) of the regulation, which is intended to afford greater legal certainty to operators engaged in opposition proceedings before OHIM. In those circumstances, as the General Court correctly held in paragraph 76 of the judgment under appeal, the new rules laid down in the implementing regulation (2005) cannot be applied with retroactive effect in the present case.

69 It must therefore be concluded that the General Court did not err in law when it held, in paragraph 79 of the judgment under appeal, referring moreover to paragraph 41 of *MIP Metro* v *OHIM – Tesco Stores (METRO)*, that it results from a reading of Rule 16 in conjunction with Rule 20 of the implementing regulation (1995), first, that OHIM is entitled to require proof that an earlier mark has been renewed where that mark expires after the notice of opposition has been filed and, second, that those provisions do not require an opposing party, on its own initiative, to submit such proof.

70 It should be added, as the General Court stated in paragraphs 41 and 46 of *MIP Metro* v *OHIM – Tesco Stores (METRO)*, that the power thus conferred on OHIM to require proof that an earlier mark has been renewed can also be founded on Article 76 of Regulation No 40/94.

71 Accordingly, the first plea on appeal must be rejected as unfounded.

Second plea: infringement of Article 74(2) of Regulation No 40/94

Arguments of the parties

72 By its second plea, Anheuser-Busch criticises the General Court for having held that the Board of Appeal could take into account the certificate of renewal without having to exercise the discretion conferred on it by Article 74(2) of Regulation No 40/94 and recognised in Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraph 43.

73 In holding that the certificate of renewal had been submitted in due time and that Article 74(2) of Regulation No 40/94 did not apply, the General Court infringed not only the procedural provisions concerning the timely submission of evidence in opposition proceedings before OHIM (a complaint addressed in the first plea), but also Article 74(2) itself.

74 OHIM contends that, since Budvar was not subject to a specific time-limit for submitting evidence of renewal of trade mark R 238 203, Article 74(2) of Regulation N0 40/94 was not applicable to the facts of the case and the Board of Appeal therefore did not have to exercise the discretion provided for therein.

75 Budvar maintains that, since the opponent was under no obligation to file the certificate of renewal within any period of time, there was no 'belated submission' in the present case. Before issuing its decision on opposition, OHIM should consider of its own motion whether the rights invoked in support of the opposition are valid rights. It is therefore not important when the opponent submitted the certificate of renewal of its earlier mark or whether it has actually submitted it.

Findings of the Court

76 By its second plea, Anheuser-Busch complains that the General Court erred in law in holding, in paragraph 71 of the judgment under appeal, that no infringement of Article 74(2) of Regulation No 40/94 could be found against the contested decision in connection with the taking into account of the certificate of renewal.

77 Since, in Anheuser-Busch's view, the certificate was not submitted within the period fixed by OHIM under Article 42(3) of Regulation 40/94, it amounts to evidence which was not submitted in due time for the purposes of Article 74(2) of the regulation. As a consequence, OHIM – in Anheuser-Busch's submission – could disregard the certificate only by exercising its discretion to exclude evidence submitted out of time, which is conferred on it by Article 74(2). However, in the present case OHIM did not exercise that discretion since it wrongly believed that the evidence had been submitted in due time.

78 In that regard, it should be observed that it is apparent from paragraph 69 of this judgment that the General Court did not err in law when it held that, in this instance, the opponent was not required to submit proof of renewal of trade mark R 238 203 within the period fixed pursuant to Article 42(3) of Regulation No 40/94.

79 Since the certificate of renewal had been submitted in due time, the General Court correctly held that there was no need for OHIM to exercise the discretion conferred on it by Article 74(2) of Regulation No 40/94 in order to take that evidence into account.

80 Accordingly, the second plea on appeal must be rejected as unfounded.

Third plea: infringement of Article 43(2) and (3) of Regulation No 40/94

Arguments of the parties

81 By its third plea, Anheuser-Busch claims that the General Court infringed Article 43(2) and (3) of Regulation No 40/94, by holding that the evidence of use of trade mark R 238 203 submitted by Budvar in support of its opposition was sufficient.

82 The evidence of use submitted by Budvar almost exclusively showed use of another trade mark, namely trade mark 674 530, comprising, in stylised script, the words 'Budweiser Budvar'. This mark was not, however, taken into account by the Board of Appeal or the General Court since it is not an earlier right in relation to the trade mark for which registration is sought.

83 It is apparent, however, from paragraphs 81 to 86 of Case C-234/06 P *Il Ponte Finanziaria* v *OHIM* [2007] ECR I-7333, that evidence of use of one registered trade mark cannot at the same time be evidence of use of another registered trade mark. The General Court should have examined the applicability of that rule in the present case.

84 Anheuser-Busch argues that the General Court should have carried out that examination since it had submitted that the documents presented by Budvar as evidence of use did not comply with Article 43(2) and (3) of Regulation No 40/94, and since it had challenged the evidence inasmuch as it referred, in particular, to the nature of the use made of the trade mark, meaning the way the mark appeared on the products themselves.

85 The General Court was therefore incorrect in stating, in paragraph 112 of the judgment under appeal, that Anheuser-Busch had not disputed the fact that the documents in question related to the use of trade mark R 238 203.

86 OHIM maintains, first of all, that the third plea is inadmissible in two respects.

87 First, it is a new plea altering the subject-matter of the dispute as it stood before the General Court, although the introduction of a new plea of that kind is prohibited under Articles 113(2) and 116(2) of the Rules of Procedure of the Court of Justice, the review carried out by that Court being limited to the findings made by the General Court in reply to the pleas that were raised before it.

88 That is all the more so given that the judgment of the General Court which gave rise to the appeal in *Il Ponte Finanziaria* v *OHIM* had already been delivered when Anheuser-Busch's application was lodged at the General Court, so there was no reason why the appellant could not have raised a plea to this effect in that application.

89 Second, it is apparent from the judgment under appeal that the General Court took care to mention that the evidence submitted by Budvar reflects use of the word 'Budweiser' 'in different forms'. On the other hand, at no point did the General Court suggest that use of trade mark R 238 203 was demonstrated on the basis of evidence of use of trade mark 674 530. Had it done so, the General Court would indeed have made a statement regarding the application to the facts of the case of Article 15(2)(a) of Regulation No 40/94.

90 The conclusion drawn by the General Court from the evidence submitted by Budvar, namely that it confirmed the genuine use of trade mark R 238 203, including in the form of a word, is a finding of fact that cannot be reviewed by the Court of Justice.

91 Next, even if this plea were admissible, OHIM maintains that it is in any case unfounded since it is based on a distortion of the facts.

92 Finally, the principle laid down by the Court of Justice in *Il Ponte Finanziaria* v *OHIM* cannot apply in the present case because the factual circumstances in this case preclude any analogy. This principle applies only if two different trade marks are validly relied on by the opponent and both are subject to the use requirement. Only in such a case does the risk arise that proof of use relating to one trade mark may be used to circumvent the dismissal of the other trade mark for the purpose of the opposition.

93 That is not the case here, however, because trade mark 674 530, comprising, in stylised script, the words 'Budweiser Budvar', cannot be relied on in opposition proceedings since it does not constitute an earlier right.

94 Budvar maintains that both OHIM and the General Court concluded that the evidence submitted by it clearly demonstrated the nature of the use of the trade mark, namely for beer.

95 Budvar points out that it submitted documents proving the use of trade mark R 238 203 because at least that mark appears on the relevant products, namely beer, which are advertised by the documents submitted by it. Those facts were clearly taken into account in paragraphs 110 to 115 of the judgment under appeal.

96 Finally, in the present case, reference cannot be made to *Il Ponte Finanziaria* v *OHIM* since that judgment dealt with the issue of whether evidence of use of one trade mark can be evidence of use of another trade mark, whereas, in the present case, evidence of genuine use of trade mark R 238 203 was definitely provided by the opponent by means of the submission of several documents proving the use of the word 'Budweiser' in connection with beers.

Findings of the Court

97 By its third plea, Anheuser-Busch in essence complains that the General Court did not annul the contested decision on the ground that, in view of the conditions laid down in Article 43(2) and (3) of Regulation No 40/94, the documents submitted by Budvar were not sufficient to prove genuine use of trade mark R 238 203.

98 The judgment under appeal is, it claims, vitiated in that respect by an error of law since the documents concerned essentially prove use of another trade mark, namely trade mark 674 530, which was not, however, taken into account by the Board of Appeal as

it is not an earlier mark within the meaning of Article 8(1) of Regulation No 40/94. It is apparent from *Il Ponte Finanziaria* v *OHIM*, and in particular from paragraph 86 thereof, that proof of use of one registered mark cannot at the same time constitute proof of use of another registered mark on the ground that the latter mark is merely a slight variation on the former.

99 However, as OHIM correctly maintains, Anheuser-Busch is raising a plea which was not included in the action brought before the General Court against the contested decision.

100 It is therefore a new plea which extends the subject-matter of the dispute and which for that reason cannot be put forward for the first time at the appeal stage (see, in particular, Case C-16/06 P *Les Éditions Albert René* v *OHIM* [2008] ECR I-10053, paragraph 125).

101 Indeed, in paragraphs 110 and 112 of the judgment under appeal, the General Court noted that Anheuser-Busch had not disputed the fact that the documents in question related to the use of trade mark R 238 203. In paragraph 114 of the judgment under appeal, the General Court mentioned that Anheuser-Busch maintained before it that the Board of Appeal should have taken other factors into account, such as the nature of the use of that mark in Germany and Austria.

102 It is thus apparent that the General Court concluded that the subject-matter of the dispute before it concerned solely the question whether the documents in question were sufficient to prove genuine use of trade mark R 238 203, in particular with regard to the nature of the use of that mark, and did not concern the question whether those documents concerned use of that trade mark or use of another trade mark, also relied on by the opponent but excluded by OHIM during the opposition proceedings.

103 Accordingly, the General Court confined itself, in paragraph 114 of the judgment under appeal, to addressing the arguments raised before it concerning the first question and did not deal with the second question which, moreover, was not the subject of argument before it.

104 Before the Court of Justice, Anheuser-Busch asserts, however, that its application to the General Court, in particular its third plea, covers that second question.

105 However, it is clear from the actual wording of paragraphs 110, 112 and 114 of the judgment under appeal that the General Court in no way misconstrued the scope of that plea.

106 Furthermore, the argument that the evidence provided by Budvar concerned use of a trade mark other than the only mark to be considered by the Board of Appeal is not sufficiently connected with the third plea raised before the General Court – which alleged that that evidence failed to satisfy the conditions necessary for the earlier mark at issue to be regarded as having been put to genuine use – and, consequently, that argument cannot be regarded as merely expanding the third plea.

107 That argument in fact concerns paragraphs 81 to 86 of *Il Ponte Finanziaria* v *OHIM*, which relate to a plea based on Article 15(2)(a) of Regulation No 40/94, whilst the third plea raised by Anheuser-Busch before the General Court was based on Article 43(2) and (3) of that regulation.

108 In any event, that argument has a different purpose from the third plea in the action before the General Court, since it does not seek to dispute that the earlier trade mark was actually put to commercial use but addresses the question whether evidence relates to one trade mark rather than another.

109 The third plea on appeal must therefore be rejected as inadmissible.

110 It follows from the foregoing that none of the three pleas in law raised by Anheuser-Busch in support of its appeal can be accepted and that the appeal must therefore be dismissed in its entirety.

Costs

111 Under Article 69(2) of the Rules of Procedure, which applies to appeal proceedings by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM and Budvar have applied for costs and Anheuser-Busch has been unsuccessful, it must be ordered to pay the costs.

On those grounds, the Court (Fourth Chamber) hereby:

1. Dismisses the appeal;

2. Orders Anheuser-Busch Inc. to pay the costs.

[Signatures]