Reports of Cases

JUDGMENT OF THE GENERAL COURT (First Chamber)

15 December 2015*

(Community trade mark — Opposition proceedings — Application for the word mark ARTHUR & ASTON — Earlier national figurative mark Arthur — No genuine use of the mark — Article 15(1)(a) of Regulation (EC) No 207/2009 — Form differing in elements which alter the distinctive character of the mark)

In Case T-83/14,

LTJ Diffusion, established in Colombes (France), represented initially by S. Lederman, and subsequently by F. Fajgenbaum, lawyers,

applicant,

v

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

defendant,

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

Arthur et Aston SAS, established in Giberville (France), represented by N. Boespflug, lawyer,

ACTION brought against the decision of the First Board of Appeal of OHIM of 2 December 2013 (Case R 1963/2012-1), concerning opposition proceedings between LTJ Diffusion and Arthur et Aston SAS,

THE GENERAL COURT (First Chamber),

composed of H. Kanninen, President, I. Pelikánová and E. Buttigieg (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 4 February 2014,

having regard to the response of OHIM lodged at the Court Registry on 16 May 2014,

having regard to the response of the intervener lodged at the Court Registry on 2 May 2014,

having regard to the reply lodged at the Court Registry on 12 August 2014,

* Language of the case: French.

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, acting upon a report of the Judge-Rapporteur and pursuant to Article 135a of the Rules of Procedure of the General Court of 2 May 1991, to give a ruling without an oral procedure,

gives the following

Judgment

Background to the dispute

1 On 10 November 2010, the intervener, Arthur et Aston SAS, filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The mark in respect of which registration was sought is the word sign ARTHUR & ASTON.

3 The goods in respect of which registration was sought are in, inter alia, Class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Shoes; sports shoes; beach shoes; sandals; boots; ankle boots; wooden shoes; esparto shoes or sandals; shoes’.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 10/2011 of 17 January 2011.

5 On 14 April 2011 the applicant, LTJ Diffusion, filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.

6 The opposition was based on the following earlier French figurative mark, registered under number 17731:



7 The earlier mark relied on in support of the opposition had been registered in France on 16 June 1983 and renewed on 11 April 2003 for the following goods in Class 25: 'Ready-made and custom-made textile goods, including boots, shoes and slippers'.

8 The grounds relied on in support of the opposition were those set out in Article 8(1)(b) of Regulation No 207/2009.

9 Following the intervener's request that proof of genuine use of the earlier mark be provided in accordance with Article 42(2) and (3) of Regulation No 207/2009, the applicant provided proof only of use of the following sign:



10 On 27 August 2011, the Opposition Division rejected the opposition in its entirety on the ground that the applicant had not provided proof of genuine use of the earlier mark in the form in which it had been registered ('the earlier mark in its registered form') within the meaning of Article 15(1)(a) of Regulation No 207/2009.

11 On 23 October 2012, the applicant filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the Opposition Division's decision.

12 By decision of 2 December 2013 ('the contested decision'), the First Board of Appeal of OHIM dismissed the appeal. The Board of Appeal, like the Opposition Division, held that the sign reproduced at paragraph 9 above ('the sign used') differed from the form of the earlier mark in its registered form in such a way as to alter its distinctive character. It accordingly concluded that use of the earlier mark on which the opposition was based had not been established in accordance with Article 15(1)(a) of Regulation No 207/2009.

Forms of order sought

13 The applicant claims that the Court should:

— set aside the contested decision;

— refer the case to the competent body of OHIM for a decision to be taken on the merits of the opposition, in the event that the Court should take the view that it does not itself have power to rule on those merits.

14 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

15 In support of its action, the applicant raises a single plea in law, alleging infringement of Article 15(1)(a) of Regulation No 207/2009. It maintains that the Board of Appeal incorrectly interpreted that provision.

16 According to Article 15(1)(a) of Regulation No 207/2009, proof of genuine use of a Community trade mark also includes proof of its use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

17 Although that article refers only to use of the Community mark, it must also apply, by analogy, to use of a national mark inasmuch as Article 42(3) of Regulation No 207/2009 provides that paragraph 2 of that article is to apply to earlier national trade marks referred to in Article 8(2)(a) of that regulation 'by substituting use in the Member State in which the earlier mark is protected for use in the [Union]' (judgment of 14 July 2014 in *Vila Vita Hotel und Touristik* v *OHIM — Viavita (VIAVITA)*, T-204/12, EU:T:2014:646, paragraph 24).

18 The purpose of Article 15(1)(a) of Regulation No 207/2009, which avoids imposing strict conformity between the form of the trade mark as used and the form in which the mark was registered, is to allow its proprietor, in the commercial exploitation of the sign, to make variations which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that same mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in insignificant respects, and the two signs can therefore be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade (judgments of 10 June 2010 in *Atlas Transport* v *OHIM — Hartmann (ATLAS TRANSPORT)*, T-482/08, EU:T:2010:229, paragraph 30; of 21 June 2012 in *Fruit of the Loom* v *OHIM — Blueshore Management (FRUIT)*, T-514/10, EU:T:2012:316, paragraph 28; and of 12 March 2014 in *Borrajo Canelo* v *OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, EU:T:2014:119, paragraph 26).

19 In the present case, it is common ground that, for the relevant period from 17 January 2006 to 16 January 2011, genuine use only of the sign used was established in the proceedings before OHIM. It is, therefore, necessary to examine whether the Board of Appeal was fully entitled to conclude that that sign differed from the earlier mark in its registered form, altering the distinctiveness of the latter.

20 In that regard, it should be noted that, for a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see judgment of 18 July 2013 in *Specsavers International Healthcare and Others*, C-252/12, ECR, EU:C:2013:497, paragraph 22 and the case-law cited).

21 The earlier mark in its registered form represents the first name Arthur in the form of a handwritten signature in black on a white background, positioned at an angle and in a compressed form, with the letters shown in very cramped writing. The first letter of that mark is emphasised by being written as a capital and by the presence of a dot between the two oblique strokes of the 'A'. Although the word

element ‘arthur’ constitutes the dominant element of the earlier mark in its registered form, its distinctiveness comes not only from that word element but also from its visual presentation, which, although secondary, is neither negligible nor banal.

22 As the Board of Appeal correctly noted, at paragraph 27 of the contested decision, there are significant differences between the sign used and the earlier mark in its registered form. Even though the sign used reproduces the word element ‘arthur’, the characters used for the letters making up that word element are characters in a slightly stylised, white, capital typeface on a black background and are positioned horizontally. In addition, the sign used places the word ‘arthur’ within a rectangular, black frame which itself has a fine white border.

23 Those differences are such as to alter, from the perspective of the average French consumer to whom the goods in Class 25 are addressed, the distinctiveness of the earlier mark in its registered form. The graphic element of that mark, consisting of a stylised signature, disappears entirely from the sign used and is replaced by a radically different graphic element which is very classical, symmetrical and static, whereas, as OHIM rightly observes, the earlier mark in its registered form attracts attention by the asymmetry and the dynamism conferred by the movement of the letters from left to right. The differences between the abovementioned mark and sign are not negligible and the mark and sign cannot be regarded as being broadly equivalent within the meaning of the case-law cited at paragraph 18 above.

24 Having regard to the fact that the particular graphic design of the word ‘arthur’ contributes, with that word, to the distinctiveness of the earlier mark in its registered form and that it is radically altered in the sign used, the finding of the Board of Appeal that the differences between the mark and the sign at issue are such that the distinctiveness of the first has been altered must be upheld.

25 That finding is not called into question by the applicant’s arguments.

26 In the first place, the applicant’s contention that the Board of Appeal did not rule on a possible alteration to the distinctiveness of the earlier mark in its registered form and did not carry out, in that respect, a specific analysis of that mark and of the sign used, must be rejected as lacking any factual basis. It suffices to refer to paragraphs 26 to 30 and 34 to 36 of the contested decision to establish that the Board of Appeal carried out a specific and detailed analysis of the abovementioned mark and the sign in order to conclude, in paragraph 40 of that decision, that the sign used differed from the earlier mark in its registered form in a manner that altered the distinctiveness of the latter.

27 It is also necessary to reject the applicant’s contention that the Board of Appeal did not rule on the distinctive character of the graphic element of the earlier mark in its registered form or on whether the use of a new typeface, described by the Board of Appeal itself as ‘very classical’, could, on its own, lead to an alteration in the distinctiveness of the earlier mark as registered.

28 In that regard, it should be noted that, at paragraph 34 of the contested decision, the Board of Appeal took the view that the figurative elements of the earlier mark in its registered form could not be considered to be negligible. At paragraph 35 of the contested decision it went on to note that the word ‘arthur’ was not represented in letters that were altogether ordinary and commonplace and to point out that the earlier mark on which the opposition was based was not registered as a word mark but as a figurative mark. Finally, at paragraph 36 of the contested decision, the Board of Appeal took the view that the sign used gave the consumer a very different impression to that given by the earlier mark in its registered form, in that it did not reproduce any of the figurative elements of the latter and was made up of other figurative elements, in particular, printed characters which were barely stylised.

29 It thus follows from paragraphs 34 to 36 of the contested decision that the Board of Appeal, contrary to the applicant’s assertions, examined the distinctiveness of the figurative elements of the earlier mark in its registered form and concluded that those elements were neither ordinary nor commonplace. It

thus held, implicitly but necessarily, that those figurative elements contributed to the distinctive character of the earlier mark in its registered form. It also follows from the abovementioned paragraphs of the contested decision, and in particular from paragraph 36 thereof, that the Board of Appeal took the view that the alteration of the distinctiveness of the earlier mark in its registered form resulted from the disappearance, in the sign used, of the figurative elements mentioned above and their replacement by other more commonplace and less stylised elements.

30 In the second place, the applicant maintained that the word element 'arthur' constituted the only dominant and distinctive element of the earlier mark in its registered form, the graphics of that word element being commonplace and secondary. Consequently, according to the applicant, a correct application of Article 15(1)(a) of Regulation No 207/2009 should have led the Board of Appeal to take the view that the sign used, which included the whole of that distinctive and dominant word element without the addition of any other word element or of any distinctive graphic element, but which was in a different font, also secondary and commonplace, did not alter the distinctiveness of the earlier mark in its registered form.

31 In support of the premise that the word element 'arthur' constituted the only distinctive and dominant element of the earlier mark in its registered form, the applicant has argued that numerous decisions by both French courts and the EU Courts reached that conclusion. The applicant referred, in particular, to the judgment of 24 November 2005 in *Sadas* v *OHIM — LTJ Diffusion (ARTHUR ET FELICIE)* (T-346/04, ECR, EU:T:2005:420) concerning its opposition, based on the earlier mark in its registered form, to the application for registration of the word sign ARTHUR ET FELICIE as a Community mark. The applicant also referred to the judgment of the Cour d'appel de Paris (Paris Court of Appeal) of 11 May 2005 delivered in infringement proceedings that it had brought against the use of the word mark ARTHUR ET FELICIE.

32 In addition, the applicant has criticised the Board of Appeal on the ground that it attached no importance whatsoever to the judgment in *ARTHUR ET FELICIE*, paragraph 31 above (EU:T:2005:420) or to the judgments of the national courts on which it had relied during the administrative procedure. In contesting the Board of Appeal's assessment that the findings in the abovementioned judgment and decisions were not relevant because they had been made in the context of a determination of the likelihood of confusion and not in that of the determination of the nature of the use made of the earlier mark in its registered form (paragraphs 32 and 38 of the contested decision), the applicant maintains, in essence, that the analysis of the distinctiveness of that mark had to be the same under Article 8 of Regulation No 207/2009, concerning the likelihood of confusion, as under Article 15 of that regulation, concerning the use of the registered mark.

33 In response to the applicant's line of argument, set out in paragraphs 30 to 32 above, it must be recalled, as is apparent from paragraph 21 above, that the word element 'arthur' constitutes the dominant element of the earlier mark in its registered form in the sense that it dominates the overall impression produced by that mark. The graphic presentation of that word element is secondary, but not negligible, in that overall impression.

34 However, it should be noted that it is not sufficient that the dominant element in the earlier mark in its registered form is included in the sign used, as is the situation in the present case in respect of the word element 'arthur', for that sign to be regarded as not altering the distinctiveness of the earlier mark in its registered form. Examination of the alteration of the distinctive character consists in comparing the earlier mark in its registered form with the sign used for the purpose of considering whether or not that mark and that sign differ in insignificant respects and whether they may be considered to be broadly equivalent (judgments in *ATLAS TRANSPORT*, paragraph 18 above, EU:T:2010:229; *FRUIT*, paragraph 18 above, EU:T:2012:316; and *PALMA MULATA*, paragraph 18 above, EU:T:2014:119). As has already been concluded, the findings of the Board of Appeal in that respect are not wrong.

35 Next, with regard to the applicant's contention that the word element 'arthur' constitutes the only distinctive element of the earlier mark in its registered form, that contention is incorrect for the reasons set out at paragraphs 21 to 24 above inasmuch as the distinctiveness of that mark stems not only from that word element but also from the graphic presentation of that element, which is neither negligible nor commonplace.

36 Moreover, the applicant's contention, as set out above, is not supported by the judgment in *ARTHUR ET FELICIE*, paragraph 31 above (EU:T:2005:420). In that judgment, the Court did not in any way find that the word element 'arthur' constituted the only distinctive element of the earlier mark in its registered form. In the comparison of the signs at issue in the case which gave rise to the judgment in *ARTHUR ET FELICIE*, paragraph 31 above (EU:T:2005:420), and more specifically in paragraph 46 of that judgment, the Court established only, as in the present case (see paragraph 21 above), the dominant character of that word element and the secondary character of the figurative elements.

37 Lastly, as regards the applicant's reference to the judgment of the Cour d'appel de Paris of 11 May 2005 (see paragraph 31 above) and to other national judicial decisions, also referred to before OHIM, it should be noted that that judgment and those decisions are not such as to call into question the finding of the Court, at paragraph 24 above, in so far as it was not in any way held there that the graphic element of the earlier mark in its registered form was negligible and that it did not contribute, with the word element 'arthur', to the distinctive character of that mark. On the contrary, that graphic element, in the form of a handwritten signature, was described in that judgment as 'specific'. In particular, the Cour d'appel de Paris, in its judgment, described the earlier mark in its registered form as '[being] lodged with a specific graphic design in the form of a handwritten signature in an ascendant form, with a dot being placed under the letter A'. In any event, it must be borne in mind that the Community trade mark regime is autonomous and that the legality of decisions of the Boards of Appeal is assessed solely on the basis of Regulation No 207/2009, with the result that OHIM, or, on appeal, the General Court, is not required to reach the same conclusions as those arrived at by national authorities or courts in similar circumstances (see, to that effect, judgments of 12 January 2006 in *Deutsche SiSi-Werke* v *OHIM*, C-173/04 P, ECR, EU:C:2006:20, paragraph 49, and of 23 January 2014 in *Coppenrath-Verlag* v *OHIM — Sembella (Rebella)*, T-551/12, EU:T:2014:30, paragraph 61 and the case-law cited).

38 On the basis of the considerations set out in paragraphs 33 to 37 above, and without it being necessary to rule on the merits of the applicant's contention that the analysis of the distinctiveness of the mark as registered should be the same under both Articles 8 and 15 of Regulation No 207/2009 (see paragraph 32 above), it is necessary to reject the premise underlying the applicant's argument that the word element 'arthur' is the only distinctive and dominant element of the earlier mark in its registered form. It follows that the remainder of the applicant's argument based on that incorrect premise must be rejected (see paragraph 30 above).

39 In the third place, the applicant's argument that the ruling in the contested decision is contrary to the ruling in the decision of the Second Board of Appeal of OHIM of 4 October 2013 (Case R 737/2013-2) must be rejected. Suffice it to note that the factual backgrounds of those two decisions are different in so far as the relationship between the form of the earlier mark in its registered form and the form of the sign used, as defined in the contested decision, differs from the relationship between the form of the earlier mark and that of the sign used as defined in the above decision of the Second Board of Appeal of OHIM of 4 October 2013. In addition, it must be recalled that OHIM is required to decide on the basis of the circumstances of each individual case and that it is not bound by previous decisions taken in other cases. The legality of the decisions of the Boards of Appeal must be assessed solely on the basis of Regulation No 207/2009 and not on the basis of any previous decision-making practice of those boards. Furthermore, in its review of legality, the Court is not bound by the decision-making practice of OHIM (see judgment in *PALMA MULATA*, paragraph 18 above, EU:T:2014:119, paragraph 43 and the case-law cited).

40 On the basis of the foregoing considerations, the plea for annulment alleging infringement of Article 15(1)(a) of Regulation No 207/2009 must be rejected. It follows that the action must be dismissed in its entirety.

Costs

41 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

42 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 LTJ Diffusion to pay the costs.

Kanninen Pelikánová Buttigieg

Delivered in open court in Luxembourg on 15 December 2015.

[Signatures]