Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fourth Chamber)

17 January 2018*

(EU trade mark — Revocation proceedings — Figurative mark representing a cross on the side of a sports shoe — Position mark — Genuine use of the mark — Articles 15(1) and 51(1)(a) of Regulation (EC) No 207/2009 (now Articles 18(1) and 58(1)(a) of Regulation (EU) 2017/1001))

In Case T-68/16,

Deichmann SE, established in Essen (Germany), represented by C. Onken, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by D. Gája, acting as Agent,

defendant,

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

Munich, SL, established in Capellades (Spain), represented by J. Güell Serra and M. del Mar Guix Vilanova, lawyers,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 4 December 2015 (Case R 2345/2014-4), relating to revocation proceedings between Deichman and Munich,

THE GENERAL COURT (Fourth Chamber),

composed of H. Kanninen, President, J. Schwarcz (Rapporteur) and C. Iliopoulos, Judges,

Registrar: X. Lopez Bancalari, Administrator,

having regard to the application lodged at the Court Registry on 15 February 2016,

having regard to the response of EUIPO lodged at the Court Registry on 11 April 2016,

having regard to the response of the intervener lodged at the Court Registry on 29 July 2016,

further to the hearing on 27 June 2017,

gives the following

* Language of the case: English.

Judgment

Background to the dispute

1 On 6 November 2002, the intervener, Munich SL, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to 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 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended, itself replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).

2 The figurative mark for which registration was sought was represented as follows:



3 The goods in respect of which registration was sought are in 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: ‘Sports footwear’.

4 The mark was registered on 24 March 2004 under number 2923852.

5 In infringement proceedings brought by the intervener before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) against the applicant, Deichmann SE, the latter filed a counterclaim on 29 June 2010 under Articles 100(1), 51(1)(a) and 52(1)(a) of Regulation No 207/2009 (now Articles 128(1), 58(1)(a) and 59(1)(a) of Regulation 2017/1001). The Landgericht Düsseldorf (Regional Court, Düsseldorf) duly notified EUIPO of the counterclaim and that information was recorded in the register of EU marks, in accordance with Article 100(4) of Regulation No 207/2009 (now Article 128(4) of Regulation 2017/1001). On 26 October 2010, the Landgericht Düsseldorf (Regional Court, Düsseldorf) decided to stay the infringement proceedings pursuant to Article 100(7) of Regulation No 207/2009 (now Article 128(7) of Regulation 2017/1001) and requested that the applicant submit an application to EUIPO for revocation and for a declaration of invalidity within a period of three months.

6 On 26 January 2011, the applicant filed an application with EUIPO for the revocation of the mark at issue pursuant to Article 51(1)(a) of Regulation No 207/2009 on the ground that the mark had not been put to genuine use in the European Union in connection with the goods in respect of which it had been registered, in particular during the five-year period preceding the date of the applicant’s counterclaim (Case 5141 C, being the subject matter of the present action). In addition, on the same day, the applicant filed an application with EUIPO for a declaration of invalidity of the mark at issue on absolute grounds, on the basis of Article 52(1)(a) of Regulation No 207/2009 (Case 5143 C).

7 On 31 January 2011, EUIPO invited the intervener to submit evidence of use of the mark at issue. On 28 April 2011, the intervener submitted a body of evidence of use. This included, in a first annex, invoices dated between 26 January 2006 and 26 January 2011, issued by Berneda SA, which is an undertaking affiliated to the intervener and authorised by it to use the mark at issue. Those invoices

were addressed to customers in various Member States and referred to the numbers of specific shoe models. Tables were included by the intervener for each Member State, linking the model numbers of shoes sold to the corresponding catalogue entries, in a second annex. That annex concerned general and seasonal catalogues from 2006 to 2011, showing photographs of shoes whose model numbers corresponded to those in the invoices set out in the first annex. The intervener stated that it understood the relevant period to be the five-year period preceding the date of the application to EUIPO for revocation. However, should EUIPO consider the relevant period to be the five-year period preceding the date of filing of the counterclaim before the Landgericht Düsseldorf (Regional Court, Düsseldorf), the intervener maintained that it could file additional documents showing use of the mark at issue for the period from 29 June 2005 to 26 January 2006. On 29 April 2011, the intervener again produced a table, of six pages, cross-referencing each of the invoices and shoe models sold with the model number set out in the catalogues in the second annex, referred to above, in respect of some additional invoices issued by Berneda, and relating to the period from 25 August 2009 to 26 January 2011.

8 On 25 June 2014, the intervener stated, 'as a precaution', that it also relied upon documents it had filed with EUIPO in other proceedings, to which it referred.

9 By decision of 7 August 2014, the Cancellation Division upheld the application for revocation, revoked the mark at issue with effect from 26 January 2011 and ordered the intervener to pay the costs. In essence, it held that the evidence adduced had not enabled it to find that there was genuine use of that mark during the relevant period, which it considered, without explaining the reason for that view, to be the five-year period immediately preceding the date of filing of the application for revocation before EUIPO. In particular, the Cancellation Division took the view that the evidence adduced concerned use of forms which differed from the mark at issue in respect of elements which altered the distinctive character, within the meaning of Article 15(1)(a) of Regulation No 207/2009 (now Article 18(1) of Regulation No 2017/1001).

10 On 10 September 2014, the intervener filed a notice of appeal against the decision of the Cancellation Division.

11 By decision of 4 December 2015 ('the contested decision'), the Fourth Board of Appeal of EUIPO annulled the decision of the Cancellation Division and rejected the application for revocation. In essence, the Board found that the evidence of use showed use of the mark at issue for 'sports footwear' in Class 25 for the relevant period, which it defined as the five years preceding the date of filing the counterclaim, in other words, the period from 29 June 2005 to 28 June 2010 ('the relevant period').

12 In particular, concerning the character of the mark at issue, the Board of Appeal, after observing that it consisted in the graphic representation as shown in paragraph 2 above and after describing it in detail, held that 'as it [was] this graphic representation which defin[ed] the mark, ... whether the mark [was] a position mark or a figurative mark [was] irrelevant'. In reality, according to the Board of Appeal, position marks are similar to the categories of figurative and three-dimensional marks as they relate to the application of figurative or three-dimensional elements to the surface of a product. The decisive factor for the scope of protection of the mark is not the categorisation of the sign in question as a figurative, three-dimensional or position sign but the way in which the mark will be perceived by the relevant public in relation to the goods concerned. That way of perceiving the mark is liable to be influenced only by the nature of the sign as registered. According to the Board of Appeal, the mark at issue 'is designed to protect a specific cross-shaped pattern placed on a specific part of the surface of the designated product, namely, a sports shoe'. The Board of Appeal found that the mark at issue was indistinguishable from the form of a part of that product, namely, the upper of a sports shoe.

13 Next, the Board of Appeal carried out an analysis of the evidence adduced by the intervener, consisting, inter alia, of a large number of invoices and product catalogues, concluding, in essence, that on the whole it showed genuine use of the mark at issue, that is, its real commercial exploitation as regards the extent, duration, geographical scale and nature of use. In that last regard, the Board of Appeal held that the Cancellation Division's finding that the images in the numerous catalogues submitted by the intervener showed different types of sports shoes bearing various crossed lines altering the distinctive character of the mark at issue could not be endorsed. On the contrary, according to the Board of Appeal, the differences between the mark as used and the mark at issue were 'negligible ... barely noticeable if at all'. The Board of Appeal held that, in the circumstances of the present case, it could also take into consideration, in order to establish genuine use of the mark at issue, the elements in colour, notwithstanding the fact that the mark had been registered in black and white.

14 Lastly, the Board of Appeal referred to certain additional elements confirming its findings, such as the judgment of the Juzgado de marca comunitaria d'Alicante (Community Trade Mark Court, Alicante, Spain) of 31 July 2007 '[establishing] that the mark [at issue] was considered to be strong and known in the field of sports shoes in Spain', or evidence relating to the period after 28 June 2010, which confirms the existence of a 'general pattern of consistent and continued use', as established in respect of the relevant period.

Forms of order sought

15 The applicant claims that the Court should:

– annul the contested decision;

– order EUIPO and the intervener to pay the costs.

16 EUIPO contends that the Court should:

– dismiss the application;

– order the applicant to pay the costs.

17 The intervener claims that the Court should:

– dismiss the application;

– confirm the contested decision;

– order the applicant to pay the costs.

Law

18 The applicant puts forward three pleas in support of its action: The first alleges infringement of Article 51(1) of Regulation No 207/2009, inasmuch as the Board of Appeal wrongly assessed the subject matter of the mark at issue, by holding that it was irrelevant whether the mark was a figurative mark or a position mark. The second plea alleges infringement of Articles 51(1) and 15(1) of that regulation, inasmuch as, in order to determine whether the mark at issue was used in its registered form or in a form that did not alter its distinctive character, the Board of Appeal merely compared a part of the mark, namely two intersecting stripes, with the two intersecting stripes placed

on the sports shoes allegedly marketed by the intervener. The third plea alleges infringement of Article 51(1) of Regulation No 207/2009, inasmuch as the contested decision was based on models of shoe whose marketing by the intervener had not been proved.

19 It should be stated that, by its pleas, the applicant maintains, in essence, that the Board of Appeal erred in respect of the actual subject matter of the mark at issue and claims that the mark was not used in the form in which it was registered, namely, according to the applicant, as the representation of the outline of a sports shoe without soles with two intersecting stripes on the side.

20 On account of the applicant's submissions in respect of the second and third pleas, those pleas will be examined together after the first plea has been examined.

21 Moreover, in so far as the intervener seeks, inter alia, confirmation of the contested decision, it should be noted that, since 'confirming the contested decision' is tantamount to dismissing the action, the intervener's second head of claim seeks, in essence, dismissal of the action and is thus indissociable from its first head of claim (see, to that effect, judgment of 5 February 2016, *Kicktipp* v *OHIM — Italiana Calzature (kicktipp)*, T-135/14, EU:T:2016:69, paragraph 19 (not published) and the case-law cited).

The first plea in law

22 According to the applicant, the mark at issue was not registered under the category 'other marks' and may not be regarded as a 'position' mark but only as a figurative mark. It is defined by its graphic representation, as it is apparent from the registration certificate, and the 'public's perception' does not play a decisive role in that regard. According to the applicant, it cannot be accepted that it concerns 'any ordinary sports shoe' or a shoe 'with soles'. Nothing in particular turns on the fact that the outlines of the picture of a shoe, which constitute the trade mark at issue, are represented in dotted lines. Likewise, according to the applicant, the reference made by the intervener to the fact that the seniority of the Spanish 'position' mark registered under number 1658216 was accepted by EUIPO, in respect of the mark at issue, has no effect on the outcome of the present case. In its request for a hearing, dated 5 September 2016, the applicant referred to a decision of the Fourth Board of Appeal of EUIPO of 6 July 2016 (Case R 408/2015–4). It submitted that that case was similar to the present case and that the mark representing two parallel lines changing direction a number of times, placed on the side of a sports shoe, was held to be a figurative mark and not a 'position' mark. At the hearing, the applicant argued that its reference to the abovementioned decision was admissible since it was published in the language of the proceedings, namely English, on EUIPO's website.

23 EUIPO and the intervener dispute the applicant's arguments. At the hearing, the intervener claimed, in addition, that the applicant's reference to the decision of the Board of Appeal of 6 July 2016 was inadmissible, first, because it had not been presented in its entirety in the language of the proceedings and, secondly, because the applicant had not sufficiently explained why that decision should be taken into consideration in the present case.

24 Under Article 51(1)(a) of Regulation No 207/2009, the rights of the proprietor of the EU trade mark are to be declared to be revoked, on application to EUIPO or on the basis of a counterclaim in infringement proceedings, if, within a continuous period of five years, the trade mark has not been put to genuine use in the European Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

25 Pursuant to Rule 22(3) and (4) 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) (now Article 10(3) and (4) of Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and

repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 (OJ 2017 L 205, p.1)), which is applicable to revocation proceedings in accordance with Rule 40(5) of that regulation (now Article 19(1) of Regulation No 2017/1430), the evidence of use must concern the place, time, extent and nature of use of the mark and it is to be limited, in principle, to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing, as referred to in Article 78(1)(f) of Regulation No 207/2009 (now Article 97(1)(f) of Regulation 2017/1001).

26 For the interpretation of the notion of genuine use, account must be taken of the fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks (see judgment of 27 September 2007, *La Mer Technology* v *OHIM — Laboratoires Goëmar (LA MER)*, T-418/03, not published, EU:T:2007:299, paragraph 53 and the case-law cited).

27 As is clear from the case-law, there is 'genuine use' of a mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, the condition of genuine use of the mark requires that that mark, as protected on the relevant territory, be used publicly and outwardly (see judgment of 6 October 2004, *Vitakraft-Werke Wührmann* v *OHIM — Krafft (VITAKRAFT)*, T-356/02, EU:T:2004:292, paragraph 26 and the case-law cited).

28 In the assessment of whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see judgment of 10 September 2008, *Boston Scientific* v *OHIM — Terumo (CAPIO)*, T-325/06, not published, EU:T:2008:338, paragraph 30 and the case-law cited).

29 Moreover, genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see judgment of 23 September 2009, *Cohausz* v *OHIM — Izquierdo Faces (acopat)*, T-409/07, not published EU:T:2009:354, paragraph 36 and the case-law cited). An overall assessment must be made which takes account of all the relevant factors in the particular case and which implies a certain interdependence between the factors taken into account (see judgment of 18 January 2011, *Advance Magazine Publishers* v *OHIM — Capela & Irmãos (VOGUE)*, T-382/08, not published, EU:T:2011:9, paragraph 30 and the case-law cited).

30 It must be borne in mind that it is not possible to prescribe a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use was genuine or not and that a *de minimis* rule, which would not allow EUIPO or, on appeal, the Court, to appraise all the circumstances of the dispute before it, cannot be laid down. Thus, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use (judgment of 11 May 2006, *Sunrider* v *OHIM*, C-416/04 P, EU:C:2006:310, paragraph 72).

31 Lastly, it should be noted that, under the provisions of Article 15(1)(a) of Regulation No 207/2009 (now Article 18(1)(a) of Regulation No 2017/1001) the proof of genuine use of an earlier national or EU mark also includes proof of use of the earlier 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.

32 Concerning the classification of a mark as a 'position' mark, it should be noted that neither Regulation No 207/2009 nor Regulation No 2868/95 refer to such marks as a specific category of marks. However, in so far as Article 4 of Regulation No 207/2009 (now Article 4 of Regulation No 2017/1001) does not contain an exhaustive list of signs capable of being EU trade marks, that circumstance is irrelevant to the registrability of 'position marks' (see, to that effect, judgment of 15 June 2010, *X Technology Swiss* v *OHIM (Orange colouring of the toe of a sock)*, T-547/08, EU:T:2010:235, paragraph 19).

33 In addition, 'position marks' are similar to the categories of figurative and three-dimensional marks as they relate to the application of figurative or three-dimensional elements to the surface of a product (see, to that effect, judgment of 15 June 2010, *Orange colouring of the toe of a sock*, T-547/08, EU:T:2010:235, paragraph 20). It is apparent from that case-law that, when assessing the distinctiveness of a mark, the classification of a 'position mark' as a figurative or three-dimensional mark, or as a specific category of marks, is irrelevant (judgment of 15 June 2010, *Orange colouring of the toe of a sock*, T-547/08, EU:T:2010:235, paragraph 21).

34 Moreover, it should be noted that the case-law recognises that figurative marks may in fact be 'position' marks (see, to that effect, judgments of 18 April 2013, *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraph 13, and of 28 September 2010, *Rosenruist* v *OHIM (Representation of two curves on a pocket)*, T-388/09, not published, EU:T:2010:410, paragraphs 2 and 17).

35 In the present case, it should be stated, first, that on the application form for registration lodged by the intervener, the latter expressly stated that it was applying for the registration of a figurative mark by ticking the corresponding box and not the boxes for 'word', 'three-dimensional' or 'other' marks. It should also be noted that it has not been argued, nor is it apparent from the file, that the application forms for registration of EU trade marks provided, at the time of the application for the mark at issue, a separate box for 'position' marks. It is, moreover, common ground, that the mark at issue was applied for only in respect of 'sports footwear'. It is possible to establish a certain connection between the mark at issue and the appearance of the goods covered by it, in so far as that mark is represented by a specific graphic design, in the form of a cross on the side of a sports shoe, although the exact outline of that shoe is not claimed under the mark, since it appears in dotted lines. It should also be noted that the cross at issue is in a contrasting colour to that of the sports shoe and is placed below the laces.

36 Contrary to the applicant's submission, it cannot be inferred from the mere fact that the 'figurative mark' box was ticked when the mark at issue was registered that it may not be regarded, at the same time, as a 'position' mark. In that last regard, it should be taken into account, in particular, that the graphic representation of the mark clearly identifies, in solid lines, the element in respect of which protection is applied for and, in dotted lines, the outline of the goods at issue, on which that element is placed. Furthermore, it should be noted that there was not, on the relevant date in the present case, a formal requirement to attach a verbal description to the application form for registration of a trade mark, in order for that mark to be regarded as a 'position' mark. It must, however, be recalled that the mark at issue, whilst being regarded as a position mark, also remains a figurative mark.

37 At the hearing, the applicant again referred to EUIPO's guidelines on practices for the examination of trade marks in submitting, in essence, that it was necessary, concerning 'position' marks, first, to include a description of the mark specifying its position on the goods at issue and, secondly, to state expressly that it was a 'position' mark. In that regard, it should be noted, without it even being necessary to assess whether the abovementioned reference was to the version of the EUIPO guidelines applicable at the date of the application for registration of the mark at issue, that in accordance with the case-law, such directives are not binding legal acts for the purpose of interpreting provisions of EU law (see, to that effect, judgment of 19 December 2012, *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 48).

38 For the sake of completeness, as an additional factor for regarding the trade mark at issue as a 'position' mark, it is necessary to add that, as EUIPO and the intervener before the Court rightly maintain, the intervener had claimed a priority, on the basis of Spanish Mark No 1658216, applied for on 27 September 1991 and registered on 5 June 1992, whose graphic representation was identical to the mark at issue and which contained, in addition, a description specifying that the mark consisted of the representation of a cross placed on the side of a sports shoe.

39 It is also necessary to examine the applicant's contention that the Board of Appeal interpreted the trade mark at issue as including elements which were not part of that mark and which were added at 'someone's discretion', like, for example, soles, contravening the requirements derived, inter alia, from paragraphs 48 to 55 of the judgment of 12 December 2002, *Sieckmann* (C-273/00, EU:C:2002:748), concerning the graphic representation of a mark.

40 In that regard, it is sufficient to note that, in the present case, it may be inferred directly from the graphic representation of the mark at issue, and with sufficient precision, that the protection sought covered only a cross, consisting of two black intersecting lines, represented in solid lines. By contrast, the 'dotted' lines, forming the outline of the sports shoe and its laces, must be understood as enabling the position of that cross to be specified. That is so, independently of the type of sole attached to those shoes, whether normal or ridged, as the Board of Appeal was correct to find in paragraph 20 of the contested decision.

41 It should be noted that that is how dotted lines are normally used in similar situations, namely for various goods on which a mark is affixed, without necessarily detailing all of the outline or other characteristics of those goods (judgments of 7 February 2007, *Kustom Musical Amplification* v *OHIM (Shape of a guitar)*, T-317/05, EU:T:2007:39; by analogy, of 14 June 2011, *Sphere Time* v *OHIM — Punch (Watch attached to a lanyard)*, T-68/10, EU:T:2011:269, paragraphs 62 to 64; of 26 February 2014, *Sartorius Lab Instruments* v *OHIM (Yellow curve at the bottom edge of an electronic display unit)*, T-331/12, EU:T:2014:87; and of 14 March 2014, *Lardini* v *OHIM (Affixing of a flower to a collar)*, T-131/13, not published, EU:T:2014:129; see also, to that effect, judgment of 4 December 2015, *K-Swiss* v *OHIM (Representation of parallel stripes on a shoe)*, T-3/15, not published, EU:T:2015:937; and, by analogy, judgment of 21 May 2015, *adidas* v *OHIM — Shoe Branding Europe (Two parallel stripes on a shoe)*, T-145/14, not published, EU:T:2015:303).

42 In the present case, the use of a dotted line was clearly intended to demonstrate that only the protection of the cross, represented in solid lines, was covered by the mark at issue, and indeed in a specific position on the sports shoes. Besides, it is apparent from the judgment of 12 November 2013, *Gamesa Eólica* v *OHIM — Enercon* (*Blended shades of green*) (T-245/12, not published, EU:T:2013:588, paragraph 38) that there is no rule requiring the outline of a sign to be represented by dotted lines in order to indicate, where appropriate, that that outline is not protected. The use of dotted lines in the present case may be interpreted as permitting a clearer delimitation of what constitutes the mark at issue.

43 It can be concluded that, if the mark at issue is intended to protect a representation of a cross comprised of two solid intersecting black lines, that protection is not claimed in the abstract but for the application of the graphic design at issue on the side of a sports shoe, as appears on the registration application form, with a contrast in colour in relation to the shoe itself. The shape of the shoe, as such, is not covered by the mark, nor the type of sole used.

44 Accordingly, contrary to the applicant's submission, the Board of Appeal was entitled to take the view that 'in so far as [it was] the graphic representation that defin[ed] the mark, ... whether the mark is a position mark or a figurative mark is irrelevant' (see paragraph 12 above). The Board of Appeal was also entitled to proceed on the basis that the mark at issue could not be dissociated from the shape of

a part of the goods in respect of which it was protected, namely the upper part of a sports shoe, and that the determining factor in the light of the scope of its protection was the way in which it will be perceived on the sole basis of the sign as registered.

45 In addition, it must be held that that conclusion is not undermined by the applicant's reference to the decision of the Fourth Board of Appeal of EUIPO of 6 July 2016 (Case R 408/2015–4), the factual and legal circumstances of which are different to those of the present case.

46 In that regard, the intervener's criticism concerning the absence of translation of the abovementioned decision into the language of the case and its claim concerning the inadmissibility of the applicant's reference to that decision must be rejected as unfounded. First, the applicant directly translated into English the relevant part in its request for a hearing of 5 September 2016. Secondly, that decision is published in its entirety in English on EUIPO's website. Furthermore, in reply to a question from the Court at the hearing, the intervener confirmed being aware of the text of that decision.

47 Furthermore, it should be noted that, unlike in the present case, in the case that gave rise to the decision of the Fourth Board of Appeal of EUIPO of 6 July 2016, the goods covered by the trade mark application were not limited to 'sports footwear' but also included other goods in Class 25, such as 'clothing, ... caps, belts or gloves'. Therefore, the question whether the mark bearing a kind of graphic design consisting of two parallel lines changing direction several times and placed on the side of a sports shoe had a connection with the form of the goods covered is framed differently to the question in the present case, where it has been found that the mark at issue cannot be dissociated from the form of a part of the goods, namely, the upper of a sports shoe (see paragraphs 12 and 44 above).

48 Accordingly, the applicant's reference to paragraph 17 of the decision adopted in Case R 408/2015–4, where it was held that the mark was a figurative and not a 'position' mark, does not permit an analogy to be drawn with the present case. Furthermore, it should be added that, in any event, in paragraph 18 of that decision, the Board of Appeal stated that the question of whether the mark applied for should be considered to be a 'position' mark was not relevant for the purposes of its assessment.

49 Having regard to all the foregoing considerations, it must be concluded that the Board of Appeal did not err, in the present case, in assessing whether the sports shoes, the sales of which were proved through various pieces of evidence concerning genuine use of the mark at issue, contained a graphic element consisting of a motif in the form of a specific cross placed on a particular part of the surface of the designated product which could be considered to be either identical, or corresponding to the graphic element appearing on the representation of the mark at issue, in accordance with Article 15(1)(a) of Regulation No 207/2009.

50 The first ground of appeal must therefore be rejected.

The second and third grounds of appeal

51 By its second plea, the applicant maintains that the Board of Appeal should have examined whether the mark at issue, consisting of the overall image of a sports shoe with intersecting stripes, was used on shoes or in connection with shoes. According to the applicant, that mark did not appear on the shoes in the evidence produced. The applicant claims that, in so far as the mark at issue is a figurative mark, the marketing of shoes that resemble it does not prove use of that mark, average consumers not being in the habit of making assumptions about the origin of products on the basis of their form. Furthermore, and in any event, the shoes actually sold by the intervener differ considerably from the shoe represented by the mark at issue. The applicant also relies on the lack of distinctive character of the mark at issue, or, at the very least, its extremely weak distinctive character, so that any difference in the use of the mark would alter such character.

52 By its third plea, the applicant maintains, in essence, that it has not been established that the shoe models REAGEE, TECNO and AVANT, to which the Board of Appeal refers in the contested decision, were marketed, even though the models concerned appeared in several catalogues submitted by the intervener. According to it, no sale has been proved. The mere display in a catalogue, the distribution of which has not been proved, is not sufficient to establish genuine use of a mark. In particular, the MARCELO model appears in only one catalogue, dating from 2006, which showed, at most, that the latest sales of that model dated back to January 2007. According to the applicant, that should necessarily lead to the conclusion that the Board of Appeal's finding that the items of evidence referred to were sufficient indications to establish genuine use of the mark is vitiated by errors.

53 EUIPO and the intervener dispute the applicant's arguments.

54 In that context, it is necessary to assess whether the evidence submitted by the intervener before EUIPO, as a whole, confirmed genuine use of the mark at issue, in accordance with the case-law referred to in paragraphs 24 to 30 above.

55 In the first place, it should be noted that the Board of Appeal correctly set, in paragraphs 17 and 18 of the contested decision, the relevant period as the five years preceding the date on which the counterclaim was filed, namely the period from 29 June 2005 to 28 June 2010, taking into account the wording of the applicant's applications submitted, first, in the proceedings in which the counterclaim was made and then before EUIPO.

56 In that regard, the Board of Appeal was fully entitled to find, and indeed it is not disputed in the present case, that the application for revocation before EUIPO was a direct consequence of the counterclaim filed by the applicant in the infringement proceedings brought against it by the intervener before the Landgericht Düsseldorf (Regional Court, Düsseldorf) and that any use of the mark at issue after the intervener received notice of that counterclaim had to be approached 'with the utmost caution'. The Board was also correct to find, in paragraph 18 of the contested decision, that evidence submitted as proof of genuine use of the mark at issue after the relevant period could, in certain circumstances, have probative value, in particular in so far as it supported the earlier evidence and showed a trend and method of use that were constant over time.

57 In the second place, contrary to the applicant's claims, the Board of Appeal correctly held, in paragraphs 19 to 30 of the contested decision, that the evidence submitted before the Cancellation Division sufficed to prove genuine use of the mark at issue.

58 First, it should be noted that the evidence referred to in the three first indents in paragraph 27 of the contested decision, concerning sales, made by the intervener or affiliated undertakings that it had authorised to use the mark at issue, of sport shoes in the MARCELO, MUNDIAL REVOLUTION, and GALES models, pictures of which are set out in paragraph 24 of that decision and in respect of which the Board of Appeal set out the specific references in EUIPO's administrative file, as supplied to the Court, already support the conclusion that the use of the mark at issue related to a sufficiently large and diverse territory covering several EU Member States, inter alia, the territory of Spain (including a number of towns such as Madrid, Barcelona, Cordoba, Grenada, Tarragona, Cadiz, Valencia, La Coruña and Girona), Italy, Portugal, Denmark, Slovakia, France and Hungary (it is clear from the invoices that, in respect of those countries also, sales took place in a number of different towns).

59 Secondly, the Court notes that the invoices submitted relating to those sport shoe models cover several years of the relevant period, and beyond, as the Board of Appeal found in paragraph 30 of the contested decision. Thus, although for shoes of the MARCELO model the evidence relates to the years 2006/2007, for the MUNDIAL REVOLUTION model the evidence submitted concerns use of the mark at issue during the years 2007 to 2011. Similarly, the catalogues for the GALES models relate to the years 2006 to 2011.

60 It is apparent from the above that there was use which was sufficiently constant over time. Contrary to the applicant's claims, those invoices show actual, constant and uninterrupted use. Furthermore, as the Board of Appeal rightly points out, although the applicant has taken the date of 26 January 2006 and not that of 29 June 2005 (see paragraph 7 above) as the start of the period to be taken into consideration, so that there is no evidence relating to the beginning of the relevant period, that is, from 29 June 2005 to 26 January 2006, that is of no relevance. It is settled case-law that it suffices that a mark has been put to genuine use for at least a part of the relevant period (see, to that effect, judgment of 16 December 2008, *Deichmann-Schuhe* v *OHIM — Design for Woman (DEITECH)*, T-86/07, not published, EU:T:2008:577, paragraph 52 and the case-law cited).

61 Thirdly, concerning the extent of use, the Board of Appeal was right to hold, in paragraph 27 of the contested decision, that the evidence taken as a whole showed real commercial exploitation of the mark at issue, which was not merely token but of a sufficient extent and constancy to maintain or create a share in the market for the goods protected by the mark.

62 In that regard, the figures set out in paragraph 27 of the contested decision, the veracity of which has not been disputed before the Court, are taken from invoices read in conjunction with catalogues. It is apparent from these figures that, between 2006 and 2011, the intervener consistently marketed a significant number of sports shoes with crosses on the side which did not differ, or only to a negligible extent, from the mark at issue, namely, the MARCELO, MUNDIAL REVOLUTION and GALES models. In particular, concerning the first model, which appears in a catalogue, the sales relate to several dozen shoes totalling several thousands of euros. The second model appears in several catalogues and several hundred pairs were sold totalling several thousand euros. Lastly, the third model also appears in several catalogues. Those sports shoes, a picture of which is reproduced in paragraph 24 of the contested decision, have a cross placed on the side of the shoe in clear contrast with the colour of the rest of the shoe. On account of the position of the cross and of those other characteristics, it must be concluded that those three models show use of the mark at issue.

63 It is true that the figures relating to the abovementioned sales may not seem to be particularly high. However, taken together with the catalogues, they show real use, as stated in paragraph 28 of the contested decision and in accordance with the case-law referred to in paragraphs 26 to 30 above. In particular, it should be recalled that it is not for EUIPO and, on appeal, the Court to assess commercial success or to review the economic strategy of an undertaking or to restrict trade mark protection to cases where large-scale commercial use has been made of the marks

64 In the third place, it is necessary to assess whether the Board of Appeal was right to find that the evidence submitted by the intervener as a whole showed use of a mark which was identical or sufficiently similar to that registered, without its distinctive character having been altered. It should be pointed out that it is not a question of examining whether a label on which the mark at issue appears has been placed on the goods at issue or of comparing the shoes sold with that same mark including the parts shown in dotted lines.

65 In that regard, it is clear that the differences between the mark at issue and the versions used on the sports shoes by the intervener are negligible. Contrary to the applicant's arguments, the cross represented by two overlapping bands is in the same place and position as the cross in the graphic representation of the mark at issue, namely on the outside of the shoe, going from the sole, or the lower part, to the laces. Several photographs submitted as evidence show use corresponding to the mark at issue, with one of the arms of the cross longer than the other. Furthermore, the thickness of the lines and their inclination correspond, in essence, in respect of a large number of shoes submitted as evidence before EUIPO, to what appears in the graphic representation of the mark at issue.

66 On some other shoes submitted as evidence, the graphics used are almost identical, although the proportions and the colour used for the cross may vary. However, as the Board of Appeal correctly stated, that evidence does not alter the distinctive characteristics of the mark at issue, registered in

black and white, since the colour cannot be regarded as being one of the main factors giving that mark its distinctive character. In particular, the use of different colours may be taken into consideration in the present case since the contrast between the base colours and the lines constituting the cross is respected. The fact that some of the shoes in question are in the form of 'a negative image', with the cross in white, yellow or other pale colour, does not invalidate the finding that such use, in so far as the cross matches the mark at issue in its position and its dimensions, remains relevant for the purposes of the individual examination.

67 The fact that some shoes also bear other graphic elements which could be memorised by consumers and which have an independent distinctive character, such as, for example, a sole or a back part, which is coloured and distinct from the rest, studs, a heal that differs in colour from the rest of the shoe, a 'crocodile leather pattern', a 'red cover on top of the shoelaces' or even, for some shoes, additional word elements, does not allow the genuine use of the mark to be called into question.

68 It should be noted that it is apparent from case-law that the condition of 'genuine use', within the meaning of Article 15(1) of Regulation No 207/2009, may be satisfied where an EU figurative mark is used only together with other elements which are juxtaposed to it, or even superimposed, inasmuch as that mark continues to be perceived as indicative of the origin of the product at issue (see, to that effect, judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraphs 19 to 27 and the case-law cited).

69 Moreover, in the present case, it is clear from the evidence that the cross used on the various shoes, consisting of two overlapping bands, is clearly discernible independently from the possible presence of the other details mentioned by the applicant. The Board of Appeal was correct to find, in paragraph 25 of the contested decision, that, apart from negligible differences, barely noticeable if at all, such as the precise length of the struts of the cross, the thickness of the lines or their precise angle of inclination, the representation of that design was virtually identical to that of the mark at issue. Likewise, EUIPO was right to submit before the Court that other than setting out some additional details on the shoes depicted in photographs, the applicant did not put forward any argument explaining how those details altered the distinctiveness of the mark at issue. As EUIPO submits, those additional details do not involve the cross which is the distinctive element protected by the mark at issue.

70 In the fourth place, concerning the applicant's complaints put forward in the third plea and concerning the alleged inadequacy of the evidence relating to certain shoe models, namely the REAGEE, TECNO and AVANT models, it should be noted that the appellant does not dispute the fact that those shoe models, to which the Board of Appeal also refers in paragraph 27 of the contested judgment, were shown in one or more of the catalogues filed by the intervener. The applicant's contention relates only to the fact that there is nothing to show that the sales actually took place.

71 In that regard, it must be noted that the display of goods in catalogues may be taken into consideration as an additional indication of the genuine use of a mark, in so far as this is a public and outward use of the mark at issue or, at the very least, preparation for such use (see, to that effect, judgments of 6 October 2004, VITAKRAFT, T-356/02, EU:T:2004:292, paragraph 26 and the case-law cited, and of 4 July 2014, *Construcción, Promociones e Instalaciones* v *OHIM — Copisa Proyectos y Mantenimientos Industriales (CPI COPISA INDUSTRIAL)*, T-345/13, not published, EU:T:2014:614, paragraph 21). Therefore, the evidence concerning the REAGEE, TECNO and AVANT models, although not decisive in itself, may, nonetheless, be taken into consideration as confirmation of the facts already examined in paragraphs 57 to 63 above.

72 Moreover, concerning the MARCELO sports shoe model, it has already been stated that the fact that the evidence relates to the period 2006/2007, that is, to a relatively short period, does not mean that it is irrelevant. On the contrary, it belongs, as the Board of Appeal correctly stated, to the overall

assessment of genuine use of the mark at issue, in accordance with paragraph 30 of the judgment of 10 September 2008, *Boston Scientific* v *OHIM — Terumo (CAPIO)* (T-325/06, not published, EU:T:2008:338), referred to in paragraph 28 above.

73 In the fifth place, as regards the applicant's contention concerning the alleged weak distinctive character of the mark at issue, it is sufficient to note that, unlike the situation in the case giving rise to the order of 26 April 2012, *Deichmann* v *OHIM* (C-307/11 P, not published, EU:C:2012:254, paragraph 52), referred to by the applicant at the hearing and concerning another graphic element, namely that representing a 'chevron edged with dotted lines', there is not, in the present case, evidence showing that the mark at issue has a weak distinctive character. In particular, unlike the situation in the abovementioned case, it has not been shown that the mark at issue is a simple and banal shape which does not diverge significantly from the shapes commonly used in the footwear sector or that it will be perceived only as a decorative element or reinforcement for the designated goods.

74 Moreover, it should be added that it has already been found that the mark at issue has been used many times in an identical or very similar form to that registered, which shows actual use of that mark even if its distinctive character is rather weak. Furthermore, if the applicant's contention were to be understood as disputing that the mark at issue has any distinctive character, it is sufficient to note that that is a claim which is not effective in revocation proceedings, in which the validity itself of a mark may not be called into question.

75 Moreover, it should be added that the distinctiveness of the mark at issue was also noted by the Juzgado de marca comunitaria d'Alicante (Community Trade Mark Court, Alicante) in a judgment of 31 July 2007, *Munich SL, Berneda SL and Bernher SL* v *Umbro SL and Umbro Int. Ltd*, to which both the Board of Appeal, in paragraph 29 of the contested decision, and the intervener, in paragraph 13 of its statement of intervention, refer and in which it was also held that the mark at issue could be regarded, in Spain, as strong or having a highly distinctive character in the sports footwear sector.

76 Accordingly, the second and third pleas must also be dismissed and, therefore, the action in its entirety.

Costs

77 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.

78 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (Fourth Chamber),

hereby:

1. Dismisses the action;

2. Orders Deichmann SE to pay the costs of the European Union Intellectual Property Office (EUIPO) and of Munich, SL.

Kanninen Schwarcz Iliopoulos

Delivered in open court in Luxembourg on 17 January 2018.

E. Coulon
Registrar

A. M. Collins
President