Reports of Cases

JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

18 November 2015*

(Community trade mark — Invalidity proceedings — Community word mark VIGOR — Earlier Community figurative mark and earlier international figurative mark VIGAR — Admissibility of evidence of use submitted on a CD-ROM — Taking into account of additional evidence which was not submitted within the time-limit set — Genuine use of the earlier marks — Articles 15 and 57(2) of Regulation (EC) No 207/2009 — Form differing in elements which do not alter the distinctive character)

In Case T-361/13,

Menelaus BV, established in Amsterdam (Netherlands), represented by A. von Mühlendahl and H. Hartwig, lawyers,

applicant,

v

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

defendant,

the other parties to the proceedings before the Board of Appeal of OHIM, interveners before the General Court, being

Vicente Garcia Mahiques and **Felipe Garcia Mahiques**, residing in Jesus Pobre (Spain), represented by E. Pérez Crespo,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 23 April 2013 (Case R 88/2012-2), relating to invalidity proceedings between, on the one hand, Vicente Garcia Mahiques and Felipe Garcia Mahiques and, on the other hand, Menelaus BV,

THE GENERAL COURT (Ninth Chamber),

composed of G. Berardis, President, O. Czúcz (Rapporteur) and A. Popescu, Judges,

Registrar: J. Weychert, Administrator,

having regard to the application lodged at the Court Registry on 9 July 2013,

having regard to the response of OHIM lodged at the Court Registry on 25 October 2013,

* Language of the case: English.

having regard to the response of the interveners lodged at the Court Registry on 8 November 2013,

having regard to the written questions put to the parties by the General Court and the replies to those questions lodged at the Court Registry on 10 and 11 December 2014,

further to the hearing on 21 January 2015,

gives the following

Judgment [1] …

Forms of order sought

12 The applicant claims, in essence, that the Court should:

— annul the contested decision;

— dismiss the interveners' appeal against the decision of the Cancellation Division;

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

13 OHIM and the interveners contend, in essence, that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law …

The first plea, alleging, in essence, infringement of procedural rules concerning the submission of evidence of use

16 The applicant claims, in essence, that the use of two CD-ROMs for the submission of evidence before the Cancellation Division and of one additional CD-ROM before the Board of Appeal does not comply with Rule 22(4) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), as amended, read in conjunction with Rules 79 and 79a thereof. It submits that that evidence is therefore inadmissible, as was previously found by another Board of Appeal of OHIM in another case.

17 OHIM, supported by the interveners, maintains, in essence, first, that there is no limit on the methods and means of proving genuine use of a mark and, secondly, that the procedural rules at issue do not exclude such a submission.

18 In that regard, it is clear from recital 10 in the preamble to Regulation No 207/2009 that the legislature considered that there was no justification for protecting an earlier trade mark except where the mark had actually been used. In keeping with that recital, Article 57(2) and (3) of Regulation No 207/2009 provides that the proprietor of a Community trade mark may request proof that the earlier mark has

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

been put to genuine use in the territory in which it is protected during the period of five years preceding the date of filing of the application for a declaration of invalidity and, as the case may be, during the five-year period preceding the date on which the Community trade mark application was published.

19 It is apparent from paragraphs 6 and 20 of the contested decision that, in response to the applicant's request for proof of genuine use of the earlier marks, the interveners submitted to the Cancellation Division two CD-ROMs containing, inter alia, photographs, invoices, catalogues and printouts of web pages. As the Cancellation Division, however, took the view that genuine use had to be established cumulatively in respect of the two periods referred to in Article 57(2) of Regulation No 207/2009 — namely, in the present case, the period running from 12 December 2000 to 11 December 2005 inclusive (five years prior to the publication of the Community trade mark application, 'the first period') and that running from 23 December 2005 to 22 December 2010 inclusive (five years prior to the date of filing of the application for a declaration of invalidity, 'the second period') — and that no proof had been submitted as regards the first period, with the result that the application for a declaration of invalidity had to be rejected, the interveners submitted, in the appeal proceedings before the Board of Appeal, a new CD-ROM that contained, among other documents, several invoices relating to the years 2001 to 2010, as is stated in paragraph 40 of the contested decision.

20 The Board of Appeal took all the items of evidence submitted into account. As stated in paragraph 22 of the contested decision, the applicant's argument criticising the fact that the evidence was submitted in CD-ROM format because that made it extremely difficult to examine that evidence was rejected by the Board of Appeal, which found, in essence, that that argument was not sufficient to invalidate the probative value of the content of the CD-ROMs at issue.

21 In that regard, it must be pointed out at the outset that, in response to a written question from the Court and at the hearing, OHIM confirmed that it was not maintaining, against this plea in law, the plea of inadmissibility mentioned in the response, namely that the applicant could not put forward for the first time before the Court the inappropriate nature of submitting evidence by means of a CD-ROM.

22 In any event, the Court states that it holds the plea to be admissible. Since the Board of Appeal applied the rules of procedure in question in agreeing to examine the items of evidence submitted on CD-ROMs, that issue is part of the proceedings before it. Consequently, the applicant may put forward that plea for the first time before the Court since the examination of that plea is not contrary to Article 135(4) of the Rules of Procedure of the General Court of 2 May 1991, according to which the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

23 As regards the substance, Rule 22 of Regulation No 2868/95, which is applicable in invalidity proceedings, as is apparent from Rule 40(6) of that regulation, states in paragraph 4 thereof that '[t]he evidence shall be filed in accordance with Rules 79 and 79a and shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing'.

24 It is apparent from that provision that the list of pieces of evidence (packages, catalogues, invoices, etc.) that it contains is not exhaustive given that it states that those pieces of evidence 'shall, in principle, be confined' to the list of examples mentioned.

25 Furthermore, the case-law confirms that there is no limit on the methods and means of proving genuine use of a mark (judgment of 15 September 2011 in *centrotherm Clean Solutions* v *OHIM — Centrotherm Systemtechnik (CENTROTHERM)*, T-427/09, ECR, EU:T:2011:480, paragraph 46). It is apparent from that judgment that the Court wished to point out, in essence, that there were many

means of proving use of a mark, in response to the argument of the intervener in that case relating to the difficulty, in view of the specific nature of the market and the business customers concerned, of gathering pieces of evidence that were typical, such as photographs or advertisements.

26 Beyond the context of the latter case, it is, however, clear that pieces of evidence like audio or video material, such as advertisements broadcast by radio or on television, are not precluded. However, they are generally available on a data carrier like a CD-ROM or a USB stick and cannot be submitted on paper or in a scanned file of such a document.

27 The same does not apply to the disputed pieces of evidence in the present case, such as invoices or a catalogue (see paragraph 19 above), which could have been submitted on paper or by means of a file containing scanned documents, but which were stored on a CD-ROM for submission.

28 Even though it is true that the principles referred to in paragraphs 23 to 26 above do not preclude evidence in the form of a CD-ROM, the question raised concerns, above all, the methods of submitting evidence to OHIM.

29 However, the provisions of Regulation No 2868/95 which relate specifically to the submission of communications to OHIM and on which the applicant relies do not preclude the submission of evidence on a CD-ROM, contrary to what the applicant claims.

30 In that regard, it is apparent from Rule 22(4) of Regulation No 2868/95, which is quoted in paragraph 23 above, that evidence is to be filed in accordance with Rules 79 and 79a of that regulation.

31 Rule 79 of Regulation No 2868/95 states:

‘Applications for the registration of a Community trade mark as well as any other application provided for in the Regulation and all other communications addressed to [OHIM] shall be submitted as follows:

(a) by submitting a signed original of the document in question at [OHIM], such as by post, personal delivery, or by any other means;

(b) by transmitting a document by telecopier in accordance with Rule 80;

…

(d) by transmitting the contents of the communication by electronic means in accordance with Rule 82.’

32 As OHIM rightly states, the present case is not covered by Rule 79(b) of Regulation No 2868/95, which concerns transmissions by fax machine, or by Rule 79(d) of that regulation, which concerns transmissions by electronic means, as the CD-ROMs at issue were submitted as an annex to a signed document sent by post. It is Rule 79(a) of Regulation No 2868/95 which applies to such a situation, without, however, limiting the types of media which make it possible to store evidence submitted as an annex to such submissions.

33 That analysis is not inconsistent with Rule 79a of Regulation No 2868/95 which states, as regards the annexes to the written communications referred to in Rule 79(a), that ‘[w]here a document or an item of evidence is submitted in accordance with Rule 79 point (a) by a party in a proceeding before [OHIM] involving more than one party to the proceedings, the document or item of evidence, as well as any annex to the document, shall be submitted in as many copies as the number of parties to the

proceedings'. In the present case, compliance with Rule 79a was ensured by the submission, at the request of OHIM, of two copies of the CD-ROMs at issue, one copy of which was sent to the applicant.

34 Admittedly, it is conceivable that the submission of evidence on a CD-ROM containing a number of electronic files may make the analysis of the items of evidence which have been submitted in that way more difficult than that of paper media or a straightforward file containing a scanned version of documents, which makes it possible for them easily to be reproduced identically by printing.

35 In that regard, it is for the parties submitting evidence of use on CD-ROMs to make sure that the legibility of that evidence does not undermine its evidential value.

36 In the present case, the applicant did not put forward any infringement of its rights of defence which could have been caused by the method of submission of the evidence in question. Furthermore, as the Board of Appeal rightly found (see paragraph 20 above), the probative value of the content of the CD-ROMs is not called in question as the scanned documents stored in the electronic files which they contain are identifiable and legible.

37 As regards, lastly, the applicant's argument relating to the decision of the Fourth Board of Appeal of OHIM of 26 October 2012 (Case R 1259/2011-4, Miquel Alimentcio Grup, SA v Aldo GmbH & Co. KG (GOURMET)) in which the evidence of use submitted on a CD-ROM was rejected as contrary to the applicable provisions on the ground, in essence, that it was a method of submission which was not provided for by those provisions, it must be borne in mind that the Court is not bound by OHIM's decision-making practice.

38 Furthermore, the case-law confirms that, although, in the light of the principles of equal treatment and of sound administration, OHIM must take into account the decisions already taken and consider with especial care whether it should decide in the same way or not, the way in which those principles are applied must, however, be consistent with respect for the principle of legality (see, by analogy, judgment of 10 March 2011 in *Agencja Wydawnicza Technopol* v *OHIM*, C-51/10 P, ECR, EU:C:2011:139, paragraphs 73 to 75).

39 It is apparent from the foregoing analysis that the Board of Appeal's approach in the present case complies with the applicable law, with the result that the applicant cannot reasonably rely on a contrary decision of another Board of Appeal.

40 It follows from the foregoing that the first plea must be rejected.

…

On those grounds,

THE GENERAL COURT (Ninth Chamber)

hereby:

1. **Dismisses the action;**

2. **Orders Menelaus BV to bear its own costs and to pay those incurred by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and by Messrs Vicente Garcia Mahiques and Felipe Garcia Mahiques.**

Berardis Czúcz Popescu

Delivered in open court in Luxembourg on 18 November 2015.

[Signatures]