Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fourth Chamber)

25 March 2015*

(Community trade mark — Opposition proceedings — Application for Community word mark English pink — Earlier Community word mark PINK LADY and earlier Community figurative mark Pink Lady — Obligation to state reasons — Duty of diligence — Decisions by a Community trade mark court — No res judicata)

In Case T-378/13,

Apple and Pear Australia Ltd, established in Victoria (Australia),

Star Fruits Diffusion, established in Caderousse (France),

represented by T. de Haan and P. Péters, lawyers,

applicants,

v

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

defendant,

the other party to the proceedings before the Board of Appeal of OHIM being

Carolus C. BVBA, established in Nieuwerkerken (Belgium),

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 29 May 2013 (Case R 1215/2011-4) relating to opposition proceedings between Apple and Pear Australia Ltd and Star Fruits Diffusion, on the one hand, and Carolus C. BVBA, on the other,

THE GENERAL COURT (Fourth Chamber),

composed of M. Prek (Rapporteur), President, I. Labucka and V. Kreuschitz, Judges,

Registrar: C. Heeren, Administrator,

having regard to the application lodged at the Registry of the General Court on 23 July 2013,

having regard to the response lodged at the Court Registry on 28 November 2013,

having regard to the decision of 13 January 2014 refusing to allow a reply to be lodged,

* Language of the case: French.

further to the hearing on 16 July 2014, during which a question was put to the parties,

having regard to the written responses lodged at the Court Registry on 28 July and 31 July 2014,

gives the following

Judgment

Background to the dispute

1 On 13 October 2009, Carolus C. BVBA filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The mark for which registration was sought is the word sign English pink.

3 The goods in respect of which registration was sought are in Class 31 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Agricultural, horticultural and forestry products (neither prepared nor processed) and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt’.

4 The application for a Community trade mark was published in *Community Trade Marks Bulletin* No 2010/014 of 25 January 2010.

5 On 20 April 2010, the applicants, Apple and Pear Australia Ltd and Star Fruits 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 marks:

— Community word mark PINK LADY, registered on 27 February 2003 under number 2042679 and designating the following goods in Class 31 and corresponding to the following description: ‘Agricultural, horticultural products, including fruit, grains, plants and trees, in particular apples and apple trees’;

— Community figurative mark No 4186169, registered on 15 December 2005, represented below and designating inter alia the following goods in Class 31 and corresponding to the following description: ‘Fresh fruit; apples, fruit trees; apple trees’:



— Community figurative mark No 6335591, registered on 30 July 2008, represented below and designating goods in Class 31 and corresponding to the following description: ‘Agricultural, horticultural products, including fruit, grains, plants and trees, in particular apples and apple trees’:



7 The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) and Article 8(5) of Regulation No 207/2009.

8 By decision of 27 May 2011, the Opposition Division rejected the opposition.

9 On 7 June 2011 the applicants filed an appeal with OHIM, under Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.

10 By judgment of 28 June 2012, delivered pursuant to an action for infringement brought by the applicants on the basis of the earlier Community word and figurative marks and Benelux mark No 559177, the Tribunal de commerce de Bruxelles (Commercial Court, Brussels) (Belgium), in its capacity as a Community trade mark court, annulled the Benelux mark ENGLISH PINK and ordered Carolus C. to refrain from using that mark in the European Union. By correspondence of 4 July 2012, the applicants provided OHIM with that judgment. By letter of 29 August 2012, they informed OHIM that Carolus C. had accepted the judgment, which had accordingly become final.

11 By decision of 29 May 2013 (‘the contested decision’), the Fourth Board of Appeal of OHIM dismissed the appeal.

12 The Board of Appeal began by examining the opposition as being based on the earlier word mark. It began by comparing the goods, observing that the goods concerned by the conflicting marks were to a large extent identical. Next, it found that those marks were visually dissimilar. It noted that each of the word components were more or less the same length and had the same prominence in the mark, that the common word component ‘pink’ was in a different position in the marks and that neither of the two components making up each of the marks was more dominant than the other. It stated that the mark applied for reproduced only half of the earlier word mark, meaning that the applicants could

not rely on the judgment of 6 October 2005 in *Medion* (C-120/04, ECR, EU:C:2005:594) and that the word component 'pink' was not distinctive. It went to hold that the reasoning was the same for the phonetic comparison, so that the marks were therefore phonetically dissimilar. It further noted that the conflicting marks were not similar conceptually, because the concepts did not focus on the same thing, which was a certain class of lady in the case of the earlier word mark and a particular type of colour in the case of the mark applied for. Lastly, in the overall assessment of the likelihood of confusion, the Board of Appeal considered that the marks were not visually, conceptually or phonetically similar and held that there was no likelihood of confusion.

13 The Board of Appeal added, for the sake of completeness, that neither the reputation of the earlier word mark nor even a slightly higher degree of distinctiveness than normal had been made out. It found that the Opposition Division had given an accurate summary of the ample evidence provided by the applicants and a proper set of reasons as to why all that evidence was insufficient and inconclusive. In that connection, it observed that only those documents which were appended to the statement of 7 September 2010 submitted to the Opposition Division could be taken into account, whilst those appended to the statement of 23 September 2011 had been lodged out of time pursuant to Rule 19(2) 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), and therefore could not be taken into account. It examined the documents appended to the statement of 7 September 2010 submitted to the Opposition Division and stated that, for the sake of completeness, it would nevertheless also examine the documents attached to the statement of 23 September 2011. It concluded from that examination that the evidence of a high degree of distinctiveness failed to show clearly that the expression 'pink lady' did not actually refer to a variety of apple and, more specifically, on what basis the sale of apples referred to as 'pink lady' could be linked to the applicants, as opposed to any producer of a particular variety of apples.

Forms of order sought

14 The applicants claim that the Court should:

— by way of principal claim, alter the contested decision so that its action is held to be well founded and, consequently, their opposition upheld;

— in the alternative, annul the contested decision;

— order OHIM to pay the costs.

15 OHIM contends that the Court should:

— dismiss the action for annulment in its entirety;

— order the applicants to pay the costs.

Law

16 As a preliminary point, it should be borne in mind that, by their pleas put forward by way of principal claim seeking alteration, the applicants ask the Court, in essence, to adopt the decision which, in their view, OHIM ought to have adopted, namely a decision finding that the conditions for opposition were fulfilled. Exercise of the power to alter decisions must, in principle, be limited to situations in which the General Court, after reviewing the assessment made by the Board of Appeal, is in a position to

determine, on the basis of the matters of fact and of law as established, what decision the Board of Appeal was required to take (judgment of 5 July 2011 in *Edwin* v *OHIM*, C-263/09 P, ECR, EU:C:2011:452, paragraph 72).

17 The Court takes the view that a review should be made of the Board of Appeal's assessment, which means that it is appropriate to begin by examining the pleas put forward by the applicants seeking, in essence, annulment of the contested decision. Only afterwards will an examination be made of the pleas seeking alteration of the contested decision.

Pleas in law put forward to support the heads of claim seeking annulment of the contested decision

18 The applicants put forward seven pleas in law in support of their action. The first plea alleges infringement of Article 75 of Regulation No 207/2009 on the ground that the contested decision contains no statement of reasons as to the inferences to be drawn from the judgment of 28 June 2012 of the Tribunal de commerce de Bruxelles. The second plea alleges an infringement of the principle of res judicata. *By the third plea* the applicants allege infringement of the general principles of legal certainty, sound administration and protection of legitimate expectations. The fourth plea alleges infringement of Article 76 of Regulation No 207/2009. The fifth and sixth pleas allege infringement of Article 8(1)(b) and Article 8(5) of Regulation No 207/2009 respectively. The seventh plea alleges infringement of Article 75 of Regulation No 207/2009 on the ground that the Board of Appeal based its decision on grounds on which the parties had not expressed their position.

19 The Court finds it appropriate to begin by examining the first and third pleas.

Consideration of the first plea: infringement of Article 75 of Regulation No 207/2009 due to the lack of statement of reasons in the contested decision as to the inferences to be drawn from the judgment of 28 June 2012 of the Tribunal de commerce de Bruxelles

20 Under their first plea, the applicants observe that the Tribunal de commerce de Bruxelles, in its capacity as a Community trade mark court, delivered judgment holding that the mark ENGLISH PINK undermined their subjective rights as proprietors of the earlier word mark. They submit that the judgment — which has, moreover, become final — is a decisive or, at the very least, a highly relevant matter of fact and law for the present case because: (i) it was delivered in respect of the same parties concerning the same Community marks and for the same relative grounds pursuant to Regulation No 207/2009; and (ii) the harm caused by the mark ENGLISH PINK was definitively recognised in the Union. Yet, they observe, nowhere in the contested decision is there any mention of the judgment of the Tribunal de commerce de Bruxelles. Therefore, in refusing to include in the reasons for its decision the possible inferences to be drawn from that judgment, the Board of Appeal infringed Article 75 of Regulation No 207/2009.

21 OHIM observes that the Board of Appeal in all likelihood did take account of the judgment of the Tribunal de commerce de Bruxelles, but did not consider itself to be bound by it as it arose from an action for trade mark infringement. It points out that the Union trade mark regime is an autonomous system which applies independently of any national system.

22 It must be borne in mind, first of all, that under Article 75 of Regulation No 207/2009 decisions of OHIM must contain a statement of the reasons on which they are based. That duty to state reasons has the same scope as that under Article 296 TFEU, pursuant to which the reasoning of the author of the act must be shown clearly and unequivocally. That duty has two purposes: to allow interested parties to know the justification for the measure taken so as to enable them to protect their rights and to enable the European Union Courts to exercise their power to review the legality of the decision (see judgment of 12 July 2012 in *Guccio Gucci* v *OHIM — Chang Qing Qing (GUDDY)*, T-389/11, EU:T:2012:378, paragraph 16 and the case-law cited).

23 Next, it results from the wording of Article 76(2) of Regulation No 207/2009 that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time-limits to which such submission is subject under the provisions of Regulation No 207/2009 and that OHIM is in no way prohibited from taking account of facts and evidence which are submitted or produced late. In stating that the latter 'may', in such a case, decide to disregard evidence, that provision grants OHIM broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account (see, to that effect, judgment of 3 October 2013 in *Rintisch* v *OHIM*, C-120/12 P, ECR, EU:C:2013:638, paragraphs 22 and 23 and the case-law cited).

24 Moreover, Article 95 of Regulation No 207/2009 provides that the Member States are to designate in their territories those national courts and tribunals which are to assume the role of 'Community trade mark courts', which are to perform the functions assigned to them by that regulation. In that regard Article 96 of Regulation No 207/2009 states that the Community trade mark courts are to have jurisdiction inter alia for infringement actions and for counterclaims for revocation or for a declaration of invalidity of the Community trade mark. The Belgian legislature has designated the Tribunal de commerce de Bruxelles as a Community trade mark court of first instance.

25 Second, recital 16 in the preamble to Regulation No 207/2009 states that 'decisions regarding the validity and infringement of Community trade marks must have effect and cover the entire area of the Community, as this is the only way of preventing inconsistent decisions on the part of the courts and [OHIM] and of ensuring that the unitary character of Community trade marks is not undermined'. Similarly, recital 17 in the preamble to Regulation No 207/2009 states that contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought concerning the same facts on the basis of a Community trade mark and parallel national trade marks. The mechanisms put in place by Regulation No 207/2009 are therefore aimed at guaranteeing uniform protection of the Community mark throughout the territory of the Union. The legislature has thus confirmed the unitary character of the Community trade mark.

26 Lastly, it must be borne in mind that, according to the case-law, the Community trade mark court has jurisdiction to give judgment prohibiting the pursuance of acts of infringement or threatened infringement of a Community mark extending throughout the territory of the Union (see judgment of 12 April 2011 in *DHL Express France*, C-235/09, ECR, EU:C:2011:238, paragraph 38). Thus, the system provided for by Regulation No 207/2009 enables such disputes to be limited to a single set of proceedings in order to guarantee uniform protection of the Community trade mark throughout the territory of the Union.

27 It is in the light of the foregoing that the plea alleging infringement of Article 75 of Regulation No 207/2009 must be examined.

28 To recapitulate: by application of 8 June 2010, the applicants requested the Tribunal de commerce de Bruxelles to annul the Benelux mark ENGLISH PINK on the ground that it infringed inter alia the earlier Community word and figurative marks and Benelux mark No 559177. By judgment of 28 June 2012, that court annulled Benelux mark ENGLISH PINK and ordered Carolus C. to refrain from using it in the Union.

29 On the substance, the Tribunal de commerce de Bruxelles observed, first of all, that the threshold for the likelihood of confusion had to be set quite low when the goods covered by the marks at issue were identical. Next, it observed that a mark or marks consisting only of a word could give rise to a likelihood of confusion with a composite mark. It also found that the use of a specific colour, calligraphy, font and capital letters at the beginning of each word 'did not in any way diminish the overall image of the mark'. It found that there was a likelihood of confusion for the average attentive consumer between the marks ENGLISH PINK and PINK LADY. It further found, in the light of the

evidence in the file, that the applicants had proven to the requisite legal standard that the expression 'pink lady' conferred a highly-regarded reputation on apples and that this was common knowledge. It accordingly held that the degree of protection to be given to the mark PINK LADY had to be high.

30 By letter of 4 July 2012, the applicants sent the judgment of 28 June 2012 to OHIM. The English translation of the judgment was also sent to OHIM by letter of 15 July 2012. By letter of 29 August 2012, the applicants informed OHIM that Carolus C. had acquiesced in the judgment and that it had therefore become final. On 25 September 2012, the applicants indicated that the Benelux Office for Intellectual Property had withdrawn the mark ENGLISH PINK from the Benelux trade marks register.

31 It follows from all the foregoing that the Board of Appeal had been duly notified — on several occasions — several months before the adoption of the contested decision that a new fact — namely, the judgment of the Tribunal de commerce de Bruxelles — had arisen.

32 It is clear that nowhere in the contested decision did the Board of Appeal refer to the existence of the judgment of the Tribunal de commerce de Bruxelles, much less give reasons for its appraisal of the issue of taking that new fact into consideration.

33 As is clear from paragraphs 22 and 24 above, the Board of Appeal was required to state in the contested decision the reasons for its decision on the issue of taking that new fact into consideration.

34 Therefore, the Board of Appeal did not comply with the requirement to state reasons as referred to in paragraph 33 above, either explicitly or implicitly.

35 In that context, it is clear that, in the circumstances of the present case, the arguments put forward by OHIM in its written pleadings to the effect that 'the Board of Appeal in all likelihood did take account of the judgment of 28 June 2012 of the Tribunal de commerce de Bruxelles' but 'did not consider itself to be bound by it as it arose from an action for trade mark infringement under Article [96] of [Regulation No 207/2009]' is a belated attempt to state reasons for the contested decision, which is inadmissible before the General Court. According to settled case-law, the statement of reasons must in principle be notified to the person concerned at the same time as the act adversely affecting him as a failure to state the reasons cannot be remedied by the fact that the person concerned learns the reasons for the act during the proceedings before the Courts of the European Union (judgments of 26 November 1981 in *Michel* v *Parliament*, 195/80, ECR, EU:C:1981:284, paragraph 22; 28 June 2005 in *Dansk Rørindustri and Others* v *Commission*, C-189/02 P, C-202/02 P, C-205/02 P to C-208/02 P and C-213/02 P, ECR, EU:C:2005:408, paragraph 463; and 13 November 2012 in *Antrax It* v *OHIM — THC (Radiators for heating)*, T-83/11 and T-84/11, ECR, EU:T:2012:592, paragraph 90).

36 Consequently, in failing to give reasons for its appraisal of the issue of taking into consideration the new fact, that is to say, the judgment of the Tribunal de commerce de Bruxelles which was delivered between the time of adoption of the decision of the Opposition Division and the adoption of the contested decision, the Board of Appeal infringed Article 75 of Regulation No 207/2009.

37 In the light of the foregoing, the first plea in law, alleging infringement of Article 75 of Regulation No 207/2009, must be upheld.

38 It is clear that that infringement in itself is grounds for annulling the contested decision. However, given the particular circumstances of the present dispute in which the decision of a Community trade mark court was given before the contested decision, the Court still finds it necessary to examine the third plea, alleging infringement of the general principles of legal certainty, sound administration and the protection of legitimate expectations.

Consideration of the third plea: infringement of the general principles of legal certainty, sound administration and the protection of legitimate expectations

39 Under the third plea, the applicants allege that the general principles of legal certainty, sound administration and the protection of legitimate expectations were infringed. They consider that, in the light of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1) and the importance accorded to the principles of *res judicata* and legal certainty, the final judgment of a Community trade mark court gave rise to a legitimate expectation that the harm caused by the mark ENGLISH PINK to their subjective rights was definitively recognised in the Union.

40 They add that the principle of sound administration precludes OHIM, when ruling on opposition proceedings, from adopting a decision which undermines legal certainty and legitimate expectations based on an earlier final judicial decision of a Community trade mark court. That principle requires OHIM to pay particular attention to a judgment of a Community trade mark court.

41 OHIM submits that the principles of legal certainty, sound administration and the protection of legitimate expectations were not infringed on the ground that it has not been established that it is bound by decisions of Community trade mark courts as a matter of *res judicata* in the exercise of its jurisdiction over registration of Community trade marks.

42 It should be noted, first of all, that the present plea in reality comprises two complaints. Under the first complaint, the applicants submit, in essence, that given the important role conferred on Community trade mark courts by Regulation No 207/2009, the Board of Appeal ought to have taken account of the judgment of the Tribunal de commerce de Bruxelles. In ignoring that judgment, the Board of Appeal did not conduct its appraisal of the facts before it with the required diligence and thus failed to observe the principle of sound administration; in other words, it failed in its duty of diligence.

43 Under a second complaint, the applicants submit in essence that the judgment of the Tribunal de commerce de Bruxelles in some way 'froze' the rights of the parties by conferring definitive protection on the earlier word mark against any harm caused by the mark ENGLISH PINK. In adopting a decision which ran counter to that judgment, the Board of Appeal undermined the legitimate expectations and legal certainty created by that judgment.

44 As regards the first complaint, to the effect that the Board of Appeal did not conduct its assessment of the facts before it with the required diligence, it must be borne in mind that OHIM is under a duty to exercise its powers in accordance with the general principles of EU law, such as the principle of sound administration (judgment of 10 March 2011 in *Agencja Wydawnicza Technopol* v *OHIM*, C-51/10 P, ECR, EU:C:2011:139, paragraph 73).

45 For reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (see, to that effect, judgment in *Agencja Wydawnicza Technopol* v *OHIM*, paragraph 44 above, EU:C:2011:139, paragraph 77).

46 Similarly, it must be borne in mind that Article 76(1) of Regulation No 207/2009 provides that '[OHIM] shall examine the facts of its own motion' but that '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'. That provision is a statement of the duty of diligence, under which the relevant institution is required to examine carefully and

impartially all the relevant factual and legal aspects of the case in question (see judgment of 15 July 2011 in *Zino Davidoff* v *OHIM — Kleinakis kai SIA (GOOD LIFE)*, T-108/08, ECR, EU:T:2011:391, paragraph 19 and the case-law cited).

47 It is clear that the judgment of the Tribunal de commerce de Bruxelles is, prima facie, a relevant factual element for resolving the case at hand. The Board of Appeal could not fail to recognise that there were essential common points between the factual aspects at issue in the infringement proceedings initiated and the opposition proceedings brought to contest the registration of the mark sought. Not only were the parties to both sets of proceedings identical, but also the earlier word mark relied on in support of the infringement proceedings before the Tribunal de commerce de Bruxelles was the same as the one relied on in support of the opposition proceedings before the various departments of OHIM. Moreover, the Benelux mark ENGLISH PINK, annulment of which was ordered by that court, and the mark sought were highly similar.

48 It should also be noted that that judgment was delivered by a Community trade mark court which was established pursuant to Regulation No 207/2009 and which is as such part of the autonomous system that is the Union trade mark regime, as its role is to protect, throughout the territory of the Union, those Community trade marks which are targeted by infringement or threatened infringement. It thus pursues objectives which are specific to that system.

49 Moreover, as evidenced by paragraphs 24 to 26 above, the intention of the Union legislature must be understood as meaning that the mechanisms put in place by the legislation are aimed at guaranteeing uniform protection of the Community mark throughout the territory of the Union.

50 Given all the above circumstances, it is clear in the present case that the judgment of the Tribunal de commerce de Bruxelles was, prima facie, a relevant factual aspect the potential impact of which the Board of Appeal ought to have assessed for the outcome of the dispute before it.

51 In failing to do so, the Board of Appeal did not assess all the relevant factual aspects of the case before it with the required diligence.

52 In the circumstances of the case, that lack of diligence is such as to lead to annulment of the contested decision, with the result that the complaint alleging infringement of the principle of sound administration must be upheld.

53 Therefore, it follows from the analysis of the first plea and the first complaint forming part of the third plea that the Board of Appeal infringed, firstly, Article 75 of Regulation No 207/2009 — in failing to refer in the contested decision to the existence of the judgment of the Tribunal de commerce de Bruxelles and the potential impact of that judgment for the outcome of the dispute — and, secondly, in its duty of diligence in failing to assess with all the required care the relevant factual aspects submitted to it.

54 It follows that the contested decision must be annulled, without its being necessary to examine the second complaint forming part of the third plea or the five other pleas put forward by the applicants.

Consideration of the head of claim seeking alteration of the contested decision to uphold the opposition

55 Given that the contested decision must be annulled and having regard to the applicants' head of claim seeking alteration of that decision, it must be ascertained whether in the present case the Court is being called upon to exercise its power of alteration pursuant to Article 65(3) of Regulation No 207/2009. In support of that claim, the applicants submit in essence that *res judicata* attached to the judgment of the Tribunal de commerce de Bruxelles and was therefore binding on the Board of Appeal and, by extension, the General Court as well. The General Court is thus in a position and

indeed required to alter the contested decision, as required by that judgment, and to uphold the opposition proceedings. They state in that regard, under the second plea, inter alia that *res judicata* attaches not only to the operative part of a judicial decision, but also to the *ratio decidendi*, and refer in that regard to the unitary character of the Community trade mark and the need to avoid contradictory decisions between the Community trade mark courts and OHIM, as confirmed by Article 56(3), Article 100(2), (6) and (7), Article 104(1) and (2) and Article 109(2) and (3) of Regulation No 207/2009 and by the provisions of Regulation No 44/2001.

56 It must be remembered that the power of the General Court to alter decisions does not have the effect of conferring on that Court the power to carry out an assessment on which that Board of Appeal has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the General Court, after reviewing the assessment made by the Board of Appeal, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the Board of Appeal was required to take (judgment in *Edwin* v *OHIM*, paragraph 16 above, EU:C:2011:452, paragraph 72).

57 It is, moreover, clear that the decision of a national court sitting as a Community trade mark court in an action for infringement of a Community trade mark carries no such weight of *res judicata* for the departments of OHIM in opposition proceedings concerning the registration of a Community trade mark, even if it is identical to the national mark which is the subject of the action for infringement (see, to that effect, judgment of 10 May 2011 in *Emram* v *OHIM — Guccio Gucci (G)*, T-187/10, EU:T:2011:202, paragraph 76 and the case-law cited). It follows that the existence of a decision such as that of the Tribunal de commerce de Bruxelles in the present case, even if it has become final, is not in itself sufficient to enable the General Court to ascertain which decision the Board of Appeal was required to take.

58 It is of course true, as observed in paragraphs 24 and 25 above, that through Regulation No 207/2009 the Union legislature put in place mechanisms aimed at guaranteeing uniform protection of the Community trade mark throughout the territory of the Union, thereby confirming the unitary character of the Community trade mark. In that context, it created the Community trade mark courts having jurisdiction to order the cessation of acts of infringement or threatened infringement of a Community trade mark extending throughout the territory of the Union.

59 According to settled case-law, however, the legality of decisions of the Boards of Appeal must be evaluated solely on the basis of Regulation No 207/2009, as interpreted by the Courts of the European Union, and not on the basis of earlier judicial decisions (see, to that effect, judgment of 26 April 2007 in *Alcon* v *OHIM*, C-412/05 P, ECR, EU:C:2007:252, paragraph 65), which considerations also hold true for opposition proceedings brought on the basis of Article 8(1)(b) of Regulation No 207/2009. A fortiori the same holds true for the effect of earlier national judicial decisions for the outcome of the present dispute. The Union trade mark regime is an autonomous system, made up of a set of rules pursuing objectives specific to it, its application being independent of any national system. It follows that a refusal to register must be assessed solely on the basis of the relevant Union legislation; earlier decisions by national courts cannot, in any event, cast doubt on the lawfulness of the decision at issue (see, to that effect, order of 22 March 2012 in *Emram* v *OHIM*, C-354/11 P, EU:C:2012:167, paragraphs 92 and 93).

60 It must also be noted that Regulation No 207/2009 does not contain any provision by which OHIM is bound by a decision by a Community trade mark court delivered in an action for infringement when it exercises its exclusive jurisdiction over registration of Community trade marks and when, in so doing, it examines oppositions lodged against applications to register Community trade marks.

61 The provisions which apply the principle of *res judicata* in fact concern other situations. Thus, Article 56(3) of Regulation No 207/2009 concerns the inadmissibility of counterclaims for revocation or for a declaration of invalidity before OHIM in the event of a claim on which a court of a Member

State has already ruled in respect of the same Community trade mark. In the same vein, Article 100(2), (6) and (7) of Regulation No 207/2009 covers cases of counterclaims for revocation or for a declaration of invalidity of a Community trade mark before OHIM or a Community trade mark court when the same question has already been ruled on in respect of the same mark before OHIM or that court. Article 109(2) of Regulation No 207/2009, for its part, provides that the court hearing an action for infringement on the basis of a Community trade mark is to reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical national trade mark valid for identical goods or services. Similarly, Article 109(3) of Regulation No 207/2009 provides that the court hearing an action for infringement on the basis of a national trade mark is to reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical Community trade mark valid for identical goods or services.

62 Moreover, the requirement of the unitary character of the Community trade mark, as referred to in recitals 16 and 17 in the preamble to Regulation No 207/2009, does not mean that the principle of *res judicata* precludes the departments of OHIM and, consequently, the European Union Courts, from examining the possible existence of a likelihood of confusion in the context of opposition proceedings concerning the registration of a new Community trade mark, even though it is identical to a national mark which has been held by a Community trade mark court to undermine the earlier Community trade mark.

63 OHIM is the only body empowered by the Union legislature to examine registration applications and, accordingly, authorise or refuse registration of a Community trade mark. In the exercise of that jurisdiction, the decisions which the Boards of Appeal are led to take under Regulation No 207/2009 concerning registration or protection of a sign as a Community trade mark are adopted in the exercise of circumscribed powers and are not a matter of discretion. Therefore, the lawfulness of Board of Appeal decisions must be assessed solely on the basis of that regulation, as interpreted by the European Union Courts. As observed in paragraphs 60 and 61 above, Regulation No 207/2009 does not contain any provision by which OHIM is bound, under the principle of *res judicata*, by a decision of a Community trade mark court upholding an action for infringement of a Community trade mark by a national mark.

64 It follows that, in the present case, the *res judicata* which attached to the judgment of the Tribunal de commerce de Bruxelles is not binding on the Board of Appeal in the exercise of its jurisdiction to rule on the issue whether the sign English pink can be registered as a Community trade mark or on the European Union Courts in the exercise of their review of lawfulness and their power of alteration under Article 65(3) of Regulation No 207/2009.

65 It must also be observed that, although the same parties are involved in the proceedings before the Tribunal de commerce de Bruxelles and OHIM, the respective subject-matters of the different sets of proceedings — that is to say, the claims — examined by that court and by OHIM are in fact not identical. The action for infringement before the Belgian court sought annulment of the Benelux mark ENGLISH PINK and an order to refrain from using that mark throughout the territory of the Union, whilst the proceedings before OHIM concerned opposition to the registration of the Community trade mark English pink.

66 The causes of action — that is to say, the bases of the claims — of the two cases are also different. In the proceedings before the Tribunal de commerce de Bruxelles, the basis of the applicants' claim for an order aimed at preventing infringement of the Community trade marks referred to in paragraph 6 above was Article 9(1)(b) and (c) of Regulation No 207/2009. Similarly, the basis for the claim for a declaration of invalidity of the Benelux mark ENGLISH PINK was Article 2.3 and Article 2.28(3)(b) of the Benelux Convention on Intellectual Property (Trade Marks and Designs), signed in The Hague on 25 February 2005. That court held that there had been infringement of the aforementioned Community trade marks, annulled the Benelux mark ENGLISH PINK and ordered that sign not to be

used throughout the territory of the Union. By contrast, in the proceedings before OHIM, the applicants opposed the registration of a new Community trade mark on the basis of other provisions of Regulation No 207/2009, namely Articles 8(1)(b) and 5 of that regulation.

67 It is, moreover, common ground that the Benelux mark and the mark sought are two legally distinct marks. The judgment of the Tribunal de commerce de Bruxelles has the effect of protecting the earlier word mark only against the effects of the Benelux mark ENGLISH PINK.

68 If only on those grounds, namely that the subject-matters of the proceedings and causes of action before OHIM and before the Tribunal de commerce de Bruxelles were not identical, the applicants cannot argue that *res judicata* attaches to the judgment of that court in the context of the present proceedings.

69 For the same reasons, nor can the applicants rely on the application of Regulation No 44/2001 on the ground that the parties, subject-matter and causes of action involved are identical.

70 It follows from the foregoing that the applicants are wrong in arguing that, by virtue of the principle of *res judicata*, the Board of Appeal was bound by the judgment of the Tribunal de commerce de Bruxelles and that it therefore ought to have held that there was a likelihood of confusion of the conflicting signs.

71 Irrespective of the foregoing, as evidenced by the considerations set out in the analysis of the first and third pleas above, in the present case the Board of Appeal failed to take account of the judgment of the Tribunal de commerce de Bruxelles and to assess the potential impact of that judgment on the outcome of the present dispute. This Court is accordingly not in a position to determine, on the basis of the matters of fact and law as established, which decision the Board of Appeal was required to take and cannot therefore exercise its power of alteration. Consequently, the request for alteration of the contested decision put forward by the applicants must be rejected.

Costs

72 Pursuant to Article 87(3) of the Rules of Procedure, the General Court may order that the costs be shared or that each party bear its own costs where each party succeeds on some and fails on other heads. In the present case, it is appropriate to order OHIM to bear its own costs and half of the applicants' costs.

On those grounds,

THE GENERAL COURT (Fourth Chamber)

hereby:

1. **Annuls the decision of the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 29 May 2013 (Case R 1215/2011-4);**

2. **Dismisses the action as to the remainder;**

3. **Orders OHIM to bear its own costs and to pay half of those incurred by Apple and Pear Australia Ltd and by Star Fruits Diffusion;**

4. **Orders Apple and Pear Australia and Star Fruits Diffusion to bear half of their costs.**

Prek Labucka Kreuschitz

Delivered in open court in Luxembourg on 25 March 2015.

[Signatures]