Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

9 December 2014*

(Community trade mark — Revocation proceedings — Community figurative mark ORIBAY ORIginal Buttons for Automotive Yndustry — Admissibility of the application for revocation)

In Case T-307/13,

Capella EOOD, established in Sofia (Bulgaria), represented initially by M. Holtorf, subsequently by A. Theis, and lastly by F. Henkel, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by G. Schneider, and subsequently by J. Crespo Carrillo, acting as Agents,

defendant,

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

Oribay Mirror Buttons, SL, established in San Sebastián (Spain), represented by A. Velázquez Ibañez, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 22 March 2013 (Case R 164/2012-4), relating to revocation proceedings between Capella EOOD and Oribay Mirror Buttons, SL,

THE GENERAL COURT (Second Chamber),

composed of M.E. Martins Ribeiro, President, S. Gervasoni and L. Madise (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 4 June 2013,

having regard to the response of OHIM lodged at the Court Registry on 19 November 2013,

having regard to the response of the intervener lodged at the Court Registry on 25 November 2013,

* Language of the case: Spanish.

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur, to give a ruling without an oral procedure, pursuant to Article 135a of the Rules of Procedure of the General Court,

gives the following

Judgment

Background to the dispute

1 On 22 June 2005, the intervener, Oribay Mirror Buttons SL, was granted registration, under No 3611282, of the Community figurative mark reproduced below ('the mark at issue') by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) 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 Community trade mark (OJ 2009 L 78, p. 1)):



2 The goods and services covered by the mark at issue are in Classes 12, 37 and 40 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

— Class 12: 'Vehicles and parts for vehicles not included in other classes';

— Class 37: 'Building construction; repair; repair and maintenance';

— Class 40: 'Treatment of materials'.

3 On 11 January 2011, the applicant, Capella EOOD, filed an application for revocation of the mark at issue pursuant to Article 51(1)(a) of Regulation No 207/2009. In that application, the applicant submitted that the mark at issue had not been put to genuine use in the European Union for a continuous period of five years in connection with: (i) certain goods in Class 12 and (ii) the services in Class 37, in respect of which that mark had been registered. The list of goods and services against which the application for revocation was directed was worded as follows:

'Class 12 — Vehicles and parts for vehicles not included in other classes with the exception of mirror buttons for car-windscreens, sensor holders for car-windscreens, optical couplers for car-windscreens, stoppers for car-windscreens, camera brackets for car-windscreens.

Class 37 – Repair; repair and maintenance.'

4 By decision of 23 November 2011, the Cancellation Division revoked the mark at issue in relation to the following goods and services:

— Class 12: Vehicles and parts for vehicles not included in other classes with the exception of parts for vehicle windows and windscreens.

— Class 37: Repair; repair and maintenance.

5 On 23 January 2012, the intervener filed an appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Cancellation Division.

6 By decision of 22 March 2013 ('the contested decision'), the Fourth Board of Appeal of OHIM annulled the decision of the Cancellation Division, rejected the applicant's request for revocation in its entirety and, finally, ordered the applicant to pay the costs. More specifically, first, as regards the goods in Class 12, the Board of Appeal declared the application for revocation inadmissible on the ground that it was not directed against the goods for which the mark at issue was registered. In that respect, the Board of Appeal took the view that the applicant could not challenge a mark for lack of genuine use and, at the same time, acknowledge the use of that mark. It also stated that, in the application for revocation, the applicant had not listed the registered goods and services against which that application was directed. Secondly, the Board of Appeal found that since the application for revocation was inadmissible in so far as it was directed against goods in Class 12, it could not be declared partially admissible as regards the services in Class 37, for which the mark at issue had also been registered.

Forms of order sought

7 The applicant claims that the Court should:

— annul the contested decision;

— declare the mark at issue to be revoked in respect of goods and services in Class 12 (vehicles and parts for vehicles not included in other classes with the exception of parts for vehicle windows and windscreens) and Class 37 (repair; repair and maintenance);

— order OHIM to pay the costs, including those incurred in the proceedings before the Board of Appeal.

8 OHIM contends that the Court should:

— allow the action;

— order each of the parties to bear its own costs.

9 The intervener contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

Admissibility of the applicant's second head of claim

10 Under its second head of claim, the applicant requests the Court to declare the mark at issue revoked in respect of goods and services in Class 12 (vehicles and parts for vehicles not included in other classes with the exception of parts for vehicle windows and windscreens) and Class 37 (repair; repair and maintenance). That request must be interpreted as an application for the Court to issue directions to OHIM.

11 It is settled case-law that, in an action brought before the Courts of the European Union against the decision of a board of appeal of OHIM, OHIM is required, under Article 65(6) of Regulation No 207/2009, to take the measures necessary to comply with the judgments of those courts. Accordingly, it is not for the General Court to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part and grounds of the Court's judgments (see judgment of 11 July 2007 in *El Corte Inglés* v *OHIM — Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)*, T-443/05, ECR, EU:T:2007:219, paragraph 20 and the case-law cited).

12 Therefore, the applicant's second head of claim requesting the Court to issue directions to OHIM to grant the application for revocation of the mark at issue is inadmissible.

Substance

13 In support of its action, the applicant raises a single plea in law alleging infringement of Article 51(1)(a) and Article 56 of Regulation No 207/2009 and Rule 37(a)(iii) 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), as amended. That single plea in law is divided into two parts.

14 In the first part, the applicant essentially submits that the Board of Appeal was wrong, in declaring the application for revocation inadmissible, to uphold the ground alleging that, in relation to the goods in Class 12, the applicant had not listed the goods and services against which that application was directed. In the second part, the applicant essentially alleges that the Board of Appeal erred in law by holding that the application for revocation could not be declared partially admissible in relation to the services in Class 37.

15 OHIM essentially argues that, as regards the first part, the applicant simplified and facilitated the course of the administrative procedure by acknowledging that the mark at issue had been used in connection with certain goods and services. OHIM adds that such an acknowledgment does not contravene the general legal principle *nemo potest venire contra factum proprium* (no one may behave in disavowance of his past acts) but merely constitutes a restriction on the application for revocation which determines the scope of the examination OHIM is required to undertake in accordance with Article 76(1) of Regulation No 207/2009. Thus, while accepting that the applicant's application for revocation is admissible, OHIM defers the adjudication of the present action to the discretion of the Court. As regards the second part, OHIM considers the application for revocation to be admissible in so far as it concerns goods in Class 12 and hence it is not necessary to rule on that part of the single plea in law.

16 The intervener disputes the merits of the single plea in law raised by the applicant. In that regard, the intervener essentially submits, first, that under Article 51(1)(a) and Article 51(2) of Regulation No 207/2009 and Rule 37 of Regulation No 2868/95, only lack of genuine use of a mark in connection with the goods and services in respect of which it is registered may result in total or partial revocation of a registered mark. Accordingly, it is for the applicant for revocation to identify

the registered goods and services in respect of which revocation is sought. In the present case, as regards the goods in Class 12, the applicant failed to identify the registered goods and services against which the application for revocation was directed. Secondly, the intervener submits that the applicant could not apply for revocation of the mark at issue for lack of genuine use, in so far as concerns goods in Class 12, and, at the same time, argue that the mark in question had been put to genuine use in connection with certain goods falling within that class, but in respect of which the mark had not been registered, without contravening the general legal principle *nemo potest venire contra factum proprium*. Thirdly, the intervener contends that it has submitted sufficient proof of genuine use of the mark at issue in connection with the various goods and services within Classes 12 and 37 respectively.

17 As a preliminary point, it is appropriate to recall the case-law according to which there is nothing to prevent OHIM from endorsing a head of claim of the applicant's or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate for giving guidance to the Court (judgments of 30 June 2004 in *GE Betz* v *OHIM — Atofina Chemicals (BIOMATE)*, T-107/02, ECR, EU:T:2004:196, paragraph 36, and of 25 October 2005 in *Peek & Cloppenburg* v *OHIM (Cloppenburg)*, T-379/03, ECR, EU:T:2005:373, paragraph 22). Conversely, it may not seek an order annulling or altering the decision of the board of appeal on a point not raised in the application or put forward pleas in law not raised in the application (see, to that effect, judgments of 12 October 2004 in *Vedial* v *OHIM*, C-106/03 P, ECR, EU:C:2004:611, paragraph 34, and in *Cloppenburg*, EU:T:2005:373, paragraph 22).

18 It follows from the case-law referred to in paragraph 17 above that, in the present case, it is necessary to take into account the arguments put forward by OHIM when considering the lawfulness of the contested decision in the light of the pleas in law put forward in the application.

19 First and foremost, as regards the first part of the single plea in law, the provisions of Article 51(1)(a) of Regulation No 207/2009 should be noted:

'1. The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to [OHIM] …:

(a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered …'

20 Rule 37(a)(iii) of Regulation No 2868/95 provides:

'An application to [OHIM] for revocation or for a declaration of invalidity … shall contain:

(a) as concerns the registration in respect of which revocation or a declaration of invalidity is sought;

…

(iii) a statement of the registered goods and services in respect of which revocation or a declaration of invalidity is sought[.]'

21 Pursuant to established case-law, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for those goods or services necessarily covers the entire category for

the purposes of the opposition (judgments of 14 July 2005 in *Reckitt Benckiser (España)* v *OHIM — Aladin (ALADIN)*, T-126/03, ECR, EU:T:2005:288, paragraph 45, and of 13 February 2007 in *Mundipharma* v *OHIM — Altana Pharma (RESPICUR)*, T-256/04, ECR, EU:T:2007:46, paragraph 23).

22 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. In that regard, it should be observed that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories (judgments in *ALADIN*, cited in paragraph 21 above, EU:T:2005:288, paragraph 46, and *RESPICUR*, cited in paragraph 21 above, EU:T:2007:46, paragraph 24).

23 In addition, it is essentially apparent from the case-law that, since proof of use of the mark on which the application for revocation is based need be furnished only when requested by the applicant, it is for the latter to determine the scope of its request for proof (see, by analogy, judgment in *RESPICUR*, cited in paragraph 21 above, EU:T:2007:46, paragraph 25).

24 It follows from the case-law cited in paragraphs 21 and 22 above that, where the mark at issue has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, it is possible that the proprietor of that mark may be able to furnish proof that the mark has been put to genuine use in relation only to a part of those goods or services, in which case the protection afforded by registration of the mark at issue applies only to the sub-category or sub-categories in which the goods or services for which the mark in question has actually been used belong.

25 Similarly, it is apparent from the case-law cited in paragraphs 21 and 23 above that, once again, where the mark at issue has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, an applicant for revocation which considers that the proprietor of the mark at issue has made genuine use of that mark in relation to a part of the goods and services for which it is registered, is entitled to exclude those goods or services from its application for revocation in order to determine the scope of its request for proof that the mark on which the application is based has been put to genuine use.

26 In the present case, it is not disputed that the mark at issue was registered, as regards goods in Class 12, for 'Vehicles and parts for vehicles not included in other classes'. Nor is it disputed that, in its revocation application, the applicant stated that, as regards goods in Class 12, its application was directed against 'Vehicles and parts for vehicles not included in other classes with the exception of mirror buttons for car-windscreens, sensor holders for car-windscreens, optical couplers for car-windscreens, stoppers for car-windscreens, camera brackets for car-windscreens'.

27 First, in those circumstances, it should be noted first of all that in its application for revocation, in so far as it relates to goods in Class 12, the applicant initially reproduced the description of the goods in that class, in respect of which the mark at issue was registered, expressly and fully. It was only subsequently that the applicant limited the scope of its application — which is based on proof of genuine use adduced by the proprietor of the mark at issue — by using the wording 'with the exception of' to exclude a number of sub-categories which it considered (i) capable of falling within the broader category of 'vehicles and parts for vehicles not included in other classes' and (ii) capable of being viewed independently within that category.

28 Thus, in so far as the applicant's application for revocation expressly reproduced the wording of the description of the goods in Class 12 in respect of which the mark at issue was registered, the Board of Appeal was wrong to criticise the applicant for not, as regards the goods in Class 12, having listed the goods in respect of which the mark at issue was registered as being those against which the application was directed, on the basis of Rule 37(a)(iii) of Regulation No 2868/95.

29 Next, contrary to what the intervener submits, a determination of the scope of an application for revocation such as that at issue in the present case cannot be classified as a reformulation of the list of goods in Class 12 in respect of which the mark at issue was registered. As was stated in paragraph 27 above, the applicant initially reproduced the description of the goods in Class 12, in respect of which the mark at issue was registered, expressly and fully and it was at a later date that it excluded from its application for revocation — which, once again, is based on proof of genuine use adduced by the proprietor of the mark at issue — a number of sub-categories of goods which it does not dispute have been put to genuine use. Thus, the applicant did no more than determine the scope of its request for proof that the mark at issue was put to genuine use, as it is entitled to do in accordance with the case-law cited in paragraph 23 above.

30 Finally, contrary to what arises implicitly from the objections formulated by the Board of Appeal in the contested decision (as referred to in paragraph 6 above), where — as in the present case with regard to goods in Class 12 — a list has been provided of the goods, in a given category, in respect of which the mark at issue was registered, an applicant for revocation cannot be required to identify all the sub-categories of goods and services which it considers capable of being individually distinguishable from one another while falling within the one broad category designated in the registration of the mark at issue, in order for its application to be declared admissible. First, as noted in paragraph 23 above, it is solely for the applicant for revocation to determine the scope of its request for proof that the mark at issue has been put to genuine use. In the present case, the applicant has clearly complied with that requirement by initially incorporating in the application for revocation the description of the category of goods falling within Class 12, in respect of which the mark at issue was registered, expressly and fully and subsequently limiting the scope of that application by excluding a number of sub-categories of goods which it did not dispute have been put to genuine use. Secondly, it should be noted that under Article 26(1)(c) of Regulation No 207/2009, an application for a Community trade mark must contain a list of the goods or services in respect of which registration is sought. It follows that only the applicant for registration of a Community mark is entitled to determine, under the control of the competent OHIM adjudicatory bodies, the scope of protection it would like to be granted to that mark. Therefore, in the present case, since, when registering the mark at issue, the intervener designated the goods in question by reference to a single broad category, without further identifying the sub-categories of goods and services which were capable of falling within it, the Board of Appeal was wrong to declare inadmissible the application for revocation on the ground that the applicant had failed to identify such sub-categories in that application.

31 For the sake of completeness, it should be noted that, in order to give a decision, for example, on the admissibility of a request for revocation based on the lack of genuine use of a mark, such as that at issue in the present case, the competent OHIM adjudicatory bodies must first assess whether the mark at issue was registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. Thus, as is apparent from the case-law cited in paragraphs 21 and 22 above, whether or not it is possible to conceive of independent sub-categories within the category of goods in Class 12 in respect of which the mark at issue was registered, will directly influence the determination of the scope of the request made by the applicant for revocation. It should be noted that in the present case the Board of Appeal did not decide on that question in the contested decision.

32 Secondly, even though the Board of Appeal did not take a stance on that matter, if it is assumed that — as the applicant argued — the mark at issue was registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable

of being viewed independently, it follows that, as is apparent from the considerations set out in paragraph 25 above, the applicant was entitled to exclude from its application for revocation a number of goods and services which it did not dispute had been put to genuine use and the Board of Appeal was wrong to find that the applicant's application for revocation contravened the general legal principle *nemo potest venire contra factum proprium*. That is all the more so given that, as observed by OHIM in its written submissions, it is clear from the case-law that even if the party making an application seeking proof of the genuine use of a trade mark was aware of a use of that trade mark, even actual or extensive use, that would not necessarily mean that such an application had been made in bad faith. It is legitimate to want to submit for assessment by the competent bodies of OHIM the question whether the use that one is aware of is sufficient to constitute genuine use, within the meaning of Article 42(2) of Regulation No 207/2009 and of the relevant case-law (judgment of 8 March 2012 in *Arrieta D. Gross* v *OHIM — International Biocentric Foundation and others (BIODANZA)*, T-298/10, EU:T:2012:113, paragraph 87).

33 It follows from the foregoing considerations that, in dismissing the application for revocation as inadmissible in so far as it was directed against goods in Class 12 in respect of which the mark at issue was registered, the Board of Appeal infringed Article 51(1) of Regulation No 207/2009 and Rule 37(a)(iii) of Regulation No 2868/95. Therefore, the first part of the single plea in law must be upheld as being well founded.

34 The second part of the single plea in law alleges that the Board of Appeal erred in law by declaring the application for revocation inadmissible in its entirety, on the ground that an application for revocation could not be declared partially admissible. More specifically, it is apparent from the grounds of the contested decision that, since the Board of Appeal took the view that the application for revocation was inadmissible in so far as it was directed against goods in Class 12, that application had to be declared inadmissible in its entirety, that is to say, in so far as it was directed against both goods in Class 12 and services in Class 37.

35 As was held in paragraph 33 above, the contested decision is unlawful in that the Board of Appeal found the application for revocation to be inadmissible in so far as it was directed against goods in Class 12. Consequently, the Board of Appeal was also wrong to declare the application for revocation inadmissible in its entirety.

36 In view of all the foregoing considerations, the first part of the single plea in law must be upheld as being well founded and, therefore, the contested decision must be annulled in its entirety.

Costs

37 Under Article 87(2) 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.

38 Since OHIM has been unsuccessful, in so far as the contested decision has been annulled, it must be ordered to bear its own costs and to pay those incurred by the applicant, in accordance with the form of order sought by the latter, notwithstanding OHIM's head of claim requesting the Court to allow the appeal.

39 As the applicant has also applied for OHIM to be ordered to pay the costs incurred by the former in the course of the proceedings before the Board of Appeal, it should be borne in mind that, under Article 136(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are to be regarded as recoverable costs.

40 The intervener has been unsuccessful and must bear its own costs.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 22 March 2013 (Case R 164/2012-4);**

2. **Declares that OHIM is to bear its own costs and orders it to pay the costs incurred by Capella EOOD;**

3. **Declares that Oribay Mirror Buttons, SL is to bear its own costs.**

Martins Ribeiro Gervasoni Madise

Delivered in open court in Luxembourg on 9 December 2014.

[Signatures]