Reports of Cases

OPINION OF ADVOCATE GENERAL
CAMPOS SÁNCHEZ-BORDONA
delivered on 17 March 2016 [1]

Case C-207/15 P

Nissan Jidosha KK

(Appeal — Community trade mark — Figurative mark which includes the word element 'CVTC' — Partial refusal of renewal by the examiner)

1. By this appeal, Nissan Jidosha KK ('Nissan') requests that the judgment given by the General Court of 4 March 2015 in Case T-572/12, *Nissan Jidosha* v *OHIM* (CVTC) [2] ('the judgment under appeal') be set aside.

2. In the judgment under appeal, the General Court dismissed the action brought by Nissan against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') of 6 September 2012 (Case R 2469/2011-1), which, for its part, confirmed the partial refusal by OHIM of the request for renewal of the registration of Community trade mark No 2188118, CVTC.

3. The appeal turns on the application of Article 47(3) of Regulation No 207/2009 on the Community trade mark, [3] a provision which has hitherto not been interpreted by the Court. In addition to the unprecedented nature of the legal issue raised is its importance in relation to trade mark renewal procedures; more specifically, its importance in affording certainty to the rules on the applicable time-limits.

I – **Legislative framework**

A – *Regulation No 207/2009 on the Community trade mark*

4. Article 46 provides:

'Community trade marks shall be registered for a period of 10 years from the date of filing of the application. Registration may be renewed in accordance with Article 47 for further periods of 10 years.'

1 — Original language: Spanish.

2 — *Nissan Jidosha* v *OHIM* (T-572/12, EU:T:2015:136).

3 — Council Regulation (EC) of 26 February 2009 (OJ 2009 L 78, p. 1).

5. Article 47 provides:

‘1. Registration of the Community trade mark shall be renewed at the request of the proprietor of the trade mark or any person expressly authorised by him, provided that the fees have been paid.

2. The Office shall inform the proprietor of the Community trade mark, and any person having a registered right in respect of the Community trade mark, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office.

3. The request for renewal shall be submitted within a period of six months ending on the last day of the month in which protection ends. The fees shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the day referred to in the first sentence, provided that an additional fee is paid within this further period.

4. Where the request is submitted or the fees paid in respect of only some of the goods or services for which the Community trade mark is registered, registration shall be renewed for those goods or services only.

5. Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be registered.’

6. Article 48 is worded as follows:

‘1. The Community trade mark shall not be altered in the Register during the period of registration or on renewal thereof.

2. Nevertheless, where the Community trade mark includes the name and address of the proprietor, any alteration thereof not substantially affecting the identity of the trade mark as originally registered may be registered at the request of the proprietor.

3. The publication of the registration of the alteration shall contain a representation of the Community trade mark as altered. Third parties whose rights may be affected by the alteration may challenge the registration thereof within a period of three months following publication.’

7. Article 50 is worded as follows:

‘1. A Community trade mark may be surrendered in respect of some or all of the goods or services for which it is registered.

2. The surrender shall be declared to the Office in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register.

…’

B – *Regulation (EC) No 2868/95 implementing the regulation on the Community trade mark*[4]

8. In order to clarify the application of the regulation on the Community trade mark, Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94[5] on the Community trade mark ('the Implementing Regulation') was adopted in 1995; Rule 30 ('Renewal of registration') of the Implementing Regulation provides:

'1. An application for renewal shall contain:

(a) the name of the person requesting renewal;

(b) the registration number of the Community trade mark to be renewed;

(c) if the renewal is requested for only part of the goods and services for which the mark is registered, an indication of those classes or those goods and services for which renewal is requested or those classes or those goods and services for which renewal is not requested, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs and presented in the order of the classes of that classification.

…

4. Where the application for renewal is filed within the periods provided for in Article 47(3) of the regulation, but the other conditions governing renewal provided for in Article 47 of the regulation and these Rules are not satisfied, the Office shall inform the applicant of the deficiencies found.

5. Where an application for renewal is not submitted or is submitted after expiry of the period provided for in the third sentence of Article 47(3) of the regulation, or where the fees are not paid or are paid only after the period in question has expired, or where the deficiencies are not remedied within that period, the Office shall determine that the registration has expired and shall so notify the proprietor of the Community trade mark.

Where the fees paid are insufficient to cover all the classes of goods and services for which renewal is requested, such a determination shall not be made if it is clear which class or classes are to be covered. In the absence of other criteria, the Office shall take the classes into account in the order of classification.

6. Where the determination made pursuant to paragraph 5 has become final, the Office shall cancel the mark from the register. The cancellation shall take effect from the day following the day on which the existing registration expired.

…'

4 — Commission Regulation of 13 December 1995 (OJ 1995 L 303, p. 1); last amended by Commission Regulation (EC) No 355/2009 of 31 March 2009 (OJ 2009 L 109, p. 3). There is a consolidated version on EurLex.

5 — Predecessor of Regulation No 207/2009 (OJ 1994 L 11, p. 1).

9. The amendments inserted into the regulation on the Community trade mark and the Implementing Regulation by Regulation (EU) 2015/2424,[6] adopted on 16 December 2015, are not applicable *ratione temporis* to the case.[7]

II – **Background to the dispute**

10. According to the facts set out in the judgment under appeal, Nissan filed an application for registration of a Community trade mark at OHIM on 23 April 2001, in respect of the following figurative sign:



11. The goods which the trade mark was to cover were in Classes 7,[8] 9[9] and 12[10] of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of Registration of Marks of 15 June 1957.[11]

12. On 29 October 2003, OHIM registered the mark at issue in respect of those three classes of goods.

13. On 27 September 2010, OHIM informed Nissan, as the rightholder and for the purposes of renewal, that the registration of its trade mark was due to expire shortly (on 23 April 2011).

14. On 27 January 2011, Nissan filed a request for renewal of its trade mark, which was limited to goods in Classes 7 and 12.

15. By letter of 9 May 2011, OHIM informed Nissan, first, that the renewal of its trade mark had been recorded in the Register (on 8 May 2011) in respect of the goods in Classes 7 and 12, and, second, that it had cancelled the registration of the trade mark in respect of the goods in Class 9.

16. By letters dated 14, July, 22 July and 1 August 2011, Nissan requested OHIM to include the Class 9 goods in the renewal of its trade mark.

17. On 26 August 2011, OHIM refused Nissan's request. On 28 September 2011, the Administration of Trade Marks Division confirmed that decision, refusing Nissan's request for annulment of it.

18. By a notice of appeal filed on 25 November 2011, pursuant to Articles 58 to 64 of Regulation No 207/2009, Nissan contested the decision of 28 September 2011 before the OHIM Boards of Appeal.

6 — Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

7 — Its provisions do not enter into force until 23 March 2016. In any event, those provisions do not alter substantially the articles relevant to the determination of this appeal.

8 — Class 7 lists: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.

9 — Class 9 includes: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus.

10 — Class 12 refers to: Vehicles; apparatus for locomotion by land, air or water.

11 — The agreement was amended on 28 September 1979.

19. By decision of 6 September 2012,[12] the Board of Appeal dismissed Nissan's appeal, holding that the (first) request for renewal of the trade mark in respect of the goods in Classes 7 and 12 constituted an express and unequivocal partial surrender, for the purposes of Article 50 of Regulation No 207/2009, in relation to the goods in Class 9, which took effect vis-à-vis the proprietor of the mark as soon as it was received by OHIM.

20. The Board of Appeal also held that, in view of the declaration of surrender, which was binding on the proprietor of the mark, the further period of six months provided for in Article 47(3) of Regulation No 207/2009 was not applicable. In view of the fact that the partial renewal had been registered and subsequently notified to the applicant, and because of the *erga omnes* effects resulting from both acts, the Board of Appeal found that, for reasons of legal certainty, Nissan could not reverse its decision not to renew the mark in respect of certain goods.

III – **The judgment under appeal**

21. On 21 December 2012, Nissan brought an action before the General Court, seeking the annulment of the decision of the Board of Appeal. In support of its action, Nissan relied on a single plea in law alleging the infringement of Articles 47 and 50 of Regulation No 207/2009.

22. In its judgment of 4 March 2015, the General Court dismissed Nissan's action. Although it found that the Board of Appeal had erred in law in treating the lack of a request for renewal as equivalent to a declaration of surrender,[13] the General Court refused to annul the contested decision because, in its view,[14] the application of Article 47 of Regulation No 207/2009 led to the same outcome as that adopted by OHIM and confirmed by the Board of Appeal.

23. According to the General Court, the further period provided for in Article 47(3) (that is, sixth months following the date on which the period of protection of the trade mark ends)[15] is, by its nature, an exception vis-à-vis the initial period. Neither the wording nor the broad logic of Article 47(3) allow for the possibility of submitting successive requests for partial renewal. In particular, the expression 'failing this' means that the exceptional period is not applicable if a request for renewal has been filed during the ordinary period. Given the effects *erga omnes* of partial renewal, from the day after the end of the previous period of registration, the principle of legal certainty precludes the subsequent supplementation of requests for renewal.

24. Lastly, the General Court rejected as unfounded the other arguments put forward by Nissan in its action; in those arguments, Nissan claimed: a) that there had been an infringement of Article 5 *bis* of the Paris Convention for the Protection of Industrial Property[16] and Article 17 of the Charter of Fundamental Rights of the European Union;[17] b) that the cancellation of the coverage of Class 9

12 — Case R 2469/2011-1.

13 — Paragraphs 27 to 30 of the judgment under appeal. Given that this point is not in dispute in the appeal, suffice it to state that the General Court based its reasoning on three premises: a) the proprietor of the mark had not filed a written declaration of surrender, as required by Article 50 of Regulation No 207/2009; b) the renewal form did not include any express declaration of surrender either in respect of the classes of goods not referred to; and c) in Nissan's case, a surrender could not be deduced from the form since it was completed by a representative of Nissan and not by the proprietor undertaking itself, contrary to Article 50.

14 — Paragraphs 38 to 43 of the judgment under appeal.

15 — That period is 10 years from the date of the original application, according to Article 46 of Regulation No 207/2009 (see point 4 of this Opinion).

16 — Paris Convention for the Protection of Industrial Property of 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979; English version available at the following website: http://www.wipo.int/treaties/en/text.jsp?file_id= 288514.

17 — In reference to the judgment in *Eurohypo* v *OHIM* (EUROHYPO) (T-439/04, EU:T:2006:119, paragraph 21).

goods under its trade mark right constituted an unlawful alteration, contrary to Article 48 of Regulation No 207/2009; c) that the decision to renew the mark solely in respect of the goods in Classes 7 and 12 was premature; and d) that, in previous decisions, OHIM had allowed successive requests for renewal. [18]

IV – **Procedure before the Court of Justice and forms of order sought by the parties**

25. Nissan's appeal was received at the Court Registry on 4 May 2015 and OHIM's response was received on 19 August 2015.

26. There was no reply or rejoinder, in accordance with Article 175(1) of the Rules of Procedure of the Court of Justice.

27. Nissan, the appellant, requests that the Court set aside the judgment under appeal, annul the decision of the First Board of Appeal of 6 September 2012, and order OHIM to bear the costs. Nissan relies on two grounds of appeal, alleging, respectively, the infringement of Articles 47 and 48 of Regulation No 207/2009.

28. OHIM claims that the Court should dismiss the appeal and order Nissan to pay the costs.

29. No hearing was held as it was not requested by either of the parties.

V – **Examination of the appeal**

A – *The first ground of appeal, alleging the infringement of Article 47 of Regulation No 207/2009*

1. Submissions of the parties

30. In its first ground of appeal, Nissan complains that, in holding that Article 47(3) does not permit successive requests for partial renewal, the General Court infringed Article 47 of Regulation No 207/2009. Nissan contends that a trade mark proprietor may have legitimate reasons for acting in that way, such as: a) not incurring expenditure which may be unnecessary in relation to certain classes of goods and services which may cease to be of interest to him for the purposes of protection of his trade mark; b) assignment of the mark to a third party, before the end of the further period, in respect of the classes which the proprietor did not originally include in the renewal; and c) correction of errors in the initial request for partial renewal.

31. Nissan submits, contrary to the view of the General Court, [19] that there are no grounds for interpreting Article 47 of Regulation No 207/2009 as meaning that it does not allow successive requests for partial renewal. No aspect of its wording precludes the renewal of a trade mark by means of a number of requests. Nissan contends, first, that the further period starts to run either because no request for renewal was filed or because the fees were not paid during the initial renewal period. The General Court failed to take account of that twofold possibility when it declared, at paragraph 38 of the judgment under appeal, that the further period is conditional on no request for renewal having been submitted during the initial period.

18 — Paragraphs 45 to 50 of the judgment under appeal.

19 — Paragraphs 38 and 39 of the judgment under appeal.

32. In addition, Nissan contends that the interpretation adopted by the General Court leads to depriving trade mark proprietors who make the effort to comply with the initial period (Article 47(3), first sentence) of the further period and benefits those who are able to pay the additional fee inherent in the further period.

33. Second, Nissan maintains that a request for partial renewal of a mark (to cover certain goods) cannot be treated as a request for cancellation of the same mark in respect of the rest of the goods. Otherwise, a request for partial renewal would be treated as the same as a surrender, a legal concept referred to in Article 50 of Regulation No 207/2009. Although the General Court rightly ruled that there was no surrender in this case,[20] its interpretation of Article 47 reintroduces the same error, this time by a different route.

34. Third, Nissan submits, again contrary to the view of the General Court,[21] that when a trade mark proprietor clearly and unequivocally submits a request for partial renewal he does not imply that, in doing so, his subsequent requests must be refused. Nissan refers to two examples of OHIM's prior administrative practice in which successive partial renewal requests were accepted. According to Nissan, those two examples reinforce the expectation of trade mark proprietors that they will be able to stagger their renewal requests over time. In addition, Nissan refers to Rule 30 of the Implementing Regulation, paragraph 5 of which, in its submission, permits the payment of renewal fees covering only some of the classes requested. Nissan contends that the fees relating to the other classes may be paid later during the further period, at the choice of the trade mark proprietor, which shows that there are no obstacles to successive partial renewals.

35. Fourth and finally, Nissan contends that reliance on the principle of legal certainty as an obstacle to successive partial renewals, once the first request for renewal has been accepted and registered (paragraph 40 of the judgment under appeal), arises only if OHIM, as occurred in this case, adopts and registers its decision on the request for partial renewal before the end of the further period. In Nissan's submission, that decision again involves treating that type of request as akin to partial surrender of the mark.

36. OHIM submits that the appeal is unfounded because the General Court correctly construed and applied Articles 47 and 48 of Regulation No 207/2009.

37. OHIM contends, in line with paragraph 38 of the judgment under appeal, that a request for renewal must normally be submitted in good time during the initial period or time-limit of six months before the date on which the trade mark registration expires, in accordance with the first two sentences of Article 47(3). A request for renewal made during the further, or 'grace', period of an additional six months constitutes an exception.

38. The arguments which, according to OHIM, support its interpretation of the exceptional nature of renewal during the further period are, first, the very structure of Article 47, which reflects the dialectical pair of 'general rule/exception'; second, the wording of the provision, since it uses the expression '[f]ailing this'[22] at the beginning of its final sentence; third, the fact that renewal during that period is conditional on payment of an additional fee of 25% of the normal fee, up to a limit of

20 — The conditions required for acceptance of surrender include, inter alia, that the holder must state in writing his intention to waive his right.

21 — Paragraph 49 of the judgment under appeal.

22 — OHIM also refers to other language versions of Regulation No 207/2009 in which that aspect is made clear, specifically, the English and French versions.

EUR 1 500;[23] and fourth, the negative implications which allowing partial renewal during the grace period, with registration taking effect retroactively, would have for the European trade mark system,[24] since in such cases registration would not accurately reflect the degree of protection afforded to a trade mark, leading to legal uncertainty.

39. On that basis, OHIM submits that the judgment under appeal did not infringe Article 47(3) of Regulation No 207/2009. The General Court applied Article 47(3) correctly in holding that a complete request for renewal, clearly and unequivocally filed during the initial period in accordance with the first two sentences of that provision, precludes the application of the third sentence. OHIM submits that the same finding is valid if renewal is requested in respect of only some of the goods and services protected by the mark: such a request cannot come within the third sentence since it is not a situation which can be equated to failure to file a request ('failing this').

40. OHIM claims that, in accordance with Article 47(4) of Regulation No 207/2009, renewal of a trade mark is possible only in respect of the goods and services expressly identified in the appropriate request. OHIM infers from that rule that when a trade mark proprietor seeks renewal in respect of some of the goods or services covered by registration, he declares or implicitly admits that he does not wish to extend protection to the other goods or services. According to OHIM, that inference is not tantamount to treating a request for partial renewal as a partial surrender for the purposes of Article 50 of Regulation No 207/2009.

41. In OHIM's submission, where a request satisfies the conditions of the first two sentences of Article 47(3) of Regulation No 207/2009, the second sentence of Article 47(5) requires that the renewal must be registered without waiting for the end of the further period. Owing to requirements of legal certainty, neither the competent authorities nor the public can be expected to anticipate that a trade mark which has already been partially renewed may be extended to other goods and services for which renewal was not requested.

42. Lastly, OHIM submits that, for the purposes of interpretation of the provision at issue, the reasons advanced by Nissan to explain why the proprietor of a mark may have an interest in delaying the request for renewal in respect of certain goods or services are irrelevant.

2. Analysis of the ground of appeal

a) Preliminary remarks and basic position

43. This appeal makes clear the conflict between two approaches to interpretation of the procedure for renewal of Community trade marks, where a determination is required of whether successive partial renewals are possible, in the light of Article 47(3) of Regulation No 207/2009.

44. The first approach, put forward by OHIM and endorsed by the General Court, concerns an interpretation of the procedure which I would describe as 'strict'. The proprietor of a trade mark nearing expiry may only renew that mark in a single act, by duly completing a single form and sending it to OHIM within the renewal period (either the initial or the further period). The proprietor must also pay the fees related to that procedural step. If the proprietor has taken those steps, OHIM will register the request for renewal in respect of the goods and services stated on the form.

23 — OHIM refers to Article 2(16) of Commission Regulation (EC) No 2869/95 **of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)** (OJ 1995 L 303, p. 33).

24 — Pursuant to Article 47(5) of Regulation No 207/2009.

45. The second approach, advocated by Nissan (and apparently accepted by OHIM in a number of previous decisions),[25] postulates that there are no legal barriers to the submission of partial requests for renewal at different times, provided that this is done within the prescribed periods and the fees are paid. According to that approach, Article 47(3) of Regulation No 207/2009 is open to a more 'dynamic' interpretation, in so far as it affords the trade mark proprietor some flexibility to choose whether to renew the protection afforded to his sign through registration in respect of all or only some of the goods and services previously covered, a decision which he may put into effect through two or more successive requests, within the period laid down in law.

46. It is therefore for the Court of Justice to determine the scope of the provision at issue, by opting for one of the two approaches concerned. Since this is an unprecedented legal problem, it will have to be resolved — without the assistance of case-law precedents — using the traditional criteria for interpretation, including the adjustments derived from EU law.

47. The appeal brought by Nissan will be properly addressed through the examination of the two basic pillars of argument adopted by the General Court: 1) the exceptional nature of the further period, which precludes the submission of supplementary requests for renewal, and 2) the need to preserve legal certainty following registration of the first request for renewal. My analysis will therefore keep to that same structure in its reasoning.

b) The renewal procedure and, in particular, the exceptional nature of the further period

48. According to the General Court,[26] it may be inferred from the wording of Article 47(3) of Regulation No 207/2009 and, more specifically, from the expression 'failing this', that a request for renewal may be made after the expiry of the initial period only if no request for renewal was submitted during that period. The request for renewal must, as a general rule, be submitted during the initial period and only by way of exception during the further period. Therefore, the latter option is possible only where no request was submitted during the initial period.

49. Nissan disputes that argument of the General Court and I believe that it is right to do so.

50. The General Court adopts a literal interpretation of the provision, placing the emphasis on the expression 'failing this', which, in its view, means that failure to request renewal during the 'ordinary' period is a factor triggering the application of paragraph 3.

51. However, use of that criterion of interpretation is applied to a number of language versions of Article 47 of Regulation No 207/2009 and does not take account of the overall sense which may be inferred from its wording in other official EU languages. The expression 'failing', or other, similar expressions, appears in the French,[27] English,[28] Spanish[29] and Italian[30] versions, but does not appear as such, at least, in the German,[31] Portuguese[32] and Dutch[33] versions, among others.

25 — The General Court acknowledged the existence of those previous administrative decisions at paragraph 50 of the judgment under appeal but then went on to state that it was not bound by them.

26 — Paragraph 38 of the judgment under appeal.

27 — 'À défaut'.

28 — 'Failing this'.

29 — 'A falta de ello'.

30 — 'In caso contrario'.

31 — 'Der Antrag und die Gebürhen können noch innerhalb einer Nachfrist von sechs Monaten … eingereicht oder gezahl warden …'.

32 — 'O pedido pode ainda ser presentado e as taxas pagas num prazo suplementar de seis meses …'.

33 — 'De indiening van de aanvrage en de voldoening van de taksen kunnen nog binen een extra termin van zes maanden …'.

52. There is well known case-law of the Court, according to which '… the wording used in one language version of a provision of EU law cannot serve as the sole basis for the interpretation of that provision, or be made to override the other language versions. EU provisions must be interpreted and applied uniformly in the light of the versions existing in all EU languages. Where there is a divergence between the various language versions of an EU text, the provision in question must thus be interpreted by reference to the general scheme and the purpose of the rules of which it forms part'. [34]

53. Yet that criterion is not enough, on its own, to determine whether the General Court erred in law. According to the case-law cited in the previous point, a finding that there is divergence in the wording of a disputed provision of EU legislation merely invalidates the usefulness of the literal approach to interpretation in that particular case, [35] from which it follows that recourse must be had to the systematic and teleological approaches.

54. Since the General Court inferred from the expression 'failing' that the second renewal period applies by way of exception vis-à-vis the first period, the language differences indicated preclude, *eo ipso*, the view that the wording of Article 47(3) of Regulation No 207/2009 affords the second period the status of an 'exception'.

55. Moreover, the expression used in the versions mentioned above (French, Spanish, English and Italian, among others) does not even have the unambiguous meaning which the judgment under appeal appears to attribute to it and, without straining its meaning, allows for the second period to be construed as an alternative to the first.

56. Even if Article 47(3) did lay down a 'rule' that the request for renewal must be submitted within the initial period of six months, the reference to the further period is not accompanied by any determining factor which enables identification of the situations where that period may be used as an exception. The only truly distinguishing factor between the two periods is the additional fee included in the second period.

57. In short, it cannot be inferred with total clarity from the versions which include the expression 'failing', or a similar expression, that successive requests for partial renewal must be refused automatically. I suspect that the finding of a prohibition of that nature in the disputed provision is the result of projecting onto the legislative text — perhaps subconsciously — the 'strict' approach to which I referred above, rather than a logical deduction reached from a reading of the provision.

58. Nor do I conclude from a systematic interpretation of Regulation No 207/2009 that successive requests for partial renewal are prohibited; quite the contrary, in fact. OHIM has relied on Article 47(4) and (5) of Regulation No 207/2009 while Nissan, putting forward the opposing view, has relied on Rule 30(5) of the Implementing Regulation. However, I do not believe that either of those arguments is valid for the purpose of resolving the dispute concerning Article 47(3) of Regulation No 207/2009 from a systematic perspective.

59. As concerns Article 47(4) of Regulation No 207/2009, its aim is not to limit requests for renewal to a single request; nor does it contribute to that being the effect of Article 47(3). It merely provides, by application of the request principle [36] and the principle of consistency, [37] that if the trade mark proprietor so requests (and pays the applicable fee), OHIM will renew the registration for the goods and services in respect of which the request for renewal was submitted. It is, therefore, merely a

34 — Judgments in *Institute of the Motor Industry* (C-149/97, EU:C:1998:536, paragraph 16); *Kurcums Metal* (C-558/11, EU:C:2012:721, paragraph 48); and *GSV* (C-74/13, EU:C:2014:243, paragraph 27).

35 — That is the adjustment due to the specific features of EU law, to which I referred in point 46.

36 — That principle, which means that a decision is to be given only at the request of a party, is one of the most distinctive principles of trade mark law.

37 — The principle of consistency (or procedural cohesion) requires judgment to be given on claims as formulated, without *ultra petita* abuses.

warning, with the force of law, to all interested parties, advising them to act with due care and precision when submitting requests for renewal. It also outlines the approach taken by OHIM in relation to such requests. It says nothing, one way or the other, regarding whether successive requests are possible or prohibited.

60. Contrary to OHIM's view, Article 47(5) of Regulation No 207/2009 does not require that organisation to register a renewal before the end of the further period. In providing that renewal will take effect from the day following the date on which the existing registration expires, the provision is simply stating that, once effected, registration of a renewal neither shortens the 10-year registration period of a mark (if the request was submitted before the expiry date) nor unduly lengthens it (if, for any reason, registration was effected after that date). In other words, the legislature wished to ensure that, whenever a renewal is registered, the protection of a registered trade mark will continue without interruption from the day following the date on which it expired.

61. Therefore, Article 47(5) of Regulation No 207/2009 is aimed solely at ensuring that there is scrupulous respect for the period of registration, that is, an uninterrupted period of 10 years for each registration. In that way, it prevents, inter alia, any delay in dealing with a request for renewal from adversely affecting the continuous protection of a mark through registration. In short, it does not follow from Article 47(5) that OHIM has any obligation to register a renewal before the end of the further period, as that organisation itself alleges.

62. As regards Rule 30(5) of the Implementing Regulation, on which Nissan relies in support of its contention, I do not believe that it constitutes an argument either for or against successive requests for partial renewal. That rule sets out, first, the cases (no request submitted or request submitted out of time after the period of grace, non-payment of fees, failure to remedy deficiencies identified) in which OHIM must declare that the registration has expired. It then goes on to make provision for the situation where the fees paid are 'insufficient to cover all the classes of goods and services for which renewal is requested', in which case OHIM must not declare that the registration has expired 'if it is clear which class or classes are to be covered'. To my mind, neither of those provisions presupposes acceptance or rejection of the possibility of filing successive requests.

63. Although I do not believe that the approach of systematic interpretation is particularly useful for the purposes of the dispute, perhaps, in the light of the considerations set out above, Article 47(3) of Regulation No 207/2009 should be read in conjunction with the duty, incumbent on OHIM under Article 47(2), to inform the trade mark proprietor that the protection granted to his sign will shortly expire. Since Article 47(2) provides that '[f]ailure to give such information shall not involve the responsibility of' OHIM, it seems logical to assume that the legislature, through the doubling of the initial period, wished to temper the harshness resulting from the cancellation of a trade mark registration without prior notice that that registration is about to expire. The exemption of OHIM from responsibility for failure to send such a notice is to some extent offset by a further period granted to trade mark proprietors, who still have another six months in which to realise, through their own means, that their protected signs are about to expire and to react accordingly.

64. Therefore, the literal and systematic approaches are not, in any way, favourable to an interpretation of the provision which suggests that successive requests for partial renewal are prohibited. Accordingly, recourse must be had to the teleological approach and to the inherent function of the procedure for renewal of Community trade marks. While that procedure involves the need to comply with certain formalities and time-limits, it does so not to impose burdens on trade mark proprietors that are difficult to interpret but rather to provide trade mark proprietors, in a homogenous and orderly fashion, with an extension of the period during which trade marks will continue to be protected.

65. The aim of Regulation No 207/2009 in this regard is to favour successive renewals for periods of 10 years of distinctive signs which are already registered, given their economic importance to the lives of proprietor undertakings and the fact that those undertakings have property rights in relation to such signs. That enables a better understanding of why two consecutive periods were provided for and why the Union legislature permits, as a final remedy once those two periods (the ordinary period and the grace period) have expired, a subsequent request from the trade mark proprietor to have his rights re-established where the conditions laid down in Article 81 of Regulation No 207/2009 are complied with (*restitutio in integrum*).

66. Article 47(3) of Regulation No 207/2009 must therefore be interpreted by reference to the criterion of facilitating, in so far as is legally possible, the renewal of Community trade marks. Just as judicial proceedings are generally governed by the *pro actione* (or *favor actionis*) principle as a guideline for disposing of a case in the event of interpretative uncertainties, that principle may also be applied to administrative proceedings for securing, at the request of a party, the renewal of existing registrations for a further, fresh period.

67. From that perspective, OHIM's stance — endorsed by the General Court — would be admissible only if a specific prohibition of successive requests for partial renewal could be inferred without difficulty from Article 47 of Regulation No 207/2009. In the absence of such a prohibition, I can see no legal obstacle to the submission of two requests which, as in the present case, specify the goods and services separately and consecutively, provided that this is done within the time-limits and the fees and additional fees are paid.

68. In summary, Article 47(3) of Regulation No 207/2009 actually grants the proprietor of a registered trade mark one year to renew that mark, divided into two six-month periods; that time-limit starts to run six months before the last day of the month in which the protection period ends and finishes six months after that date. Neither the division of the period into two parts — where the sole difference between those parts is the additional fee provided for in relation to requests submitted in the second part — nor the wording or scheme of the provision preclude the submission of successive requests for partial renewal, in particular, for the purpose of specifying the goods and services to be covered by such a renewal.

c) Legal certainty in the renewal procedure

69. Nissan disputes the finding of the General Court [38] according to which the submission of a request for partial renewal which supplements a previous request is contrary to the principle of legal certainty where the first request has already been entered in the register. Paragraph 41 of the judgment under appeal elaborates on the essential protection of legal certainty in view of the fact that registration of the renewal has effect *erga omnes* from the day following the date on which the trade mark registration expires.

70. I also agree with this part of Nissan's appeal. As I pointed out above, [39] there is no requirement in Article 47(5) of Regulation No 207/2009 which obliges OHIM to register a renewal before the end of the further period. Where there is a delay, either owing to the need to correct irregularities, [40] or for other reasons which prevent registration being effected swiftly and before the end of the further period, it must be possible, by means of an annotation in the register, to suspend renewal until such time as the problem identified is dealt with.

38 — Paragraph 40 of the judgment under appeal.

39 — Point 61 of this Opinion.

40 — See Rule 30(4) of the Implementing Regulation.

71. Further, as regards legal certainty, I believe that it is important to recall that the legislature's interest in ensuring that the registration of Community trade marks reflects reality underlies a number of provisions of Regulation No 207/2009 and of the Implementing Regulation. That view is clear in the mechanisms created to deal with discrepancies between the reality of protection, as perceived by the proprietor of a mark, and the form it takes in the register. Thus, pursuant to Rule 30(4) of the Implementing Regulation, OHIM must notify an applicant for renewal of any irregularities found in his application; Article 26(2) of Regulation No 207/2009 permits, within certain limits, the amendment of a trade mark application even after publication; and Article 81 of that regulation provides for the right, subject to satisfaction of a number of conditions, to request *restitutio in integrum* where a trade mark proprietor has been unable to comply with a time-limit.

72. Against this background, I am not persuaded by the sole ground put forward by the General Court in relation to legal certainty; on the contrary, it confirms that it was OHIM's own attitude, in rushing to register the request for renewal before the further period had even expired, which gave rise to the alleged legal uncertainty on which it relies. In short, OHIM's 'automatic' and hasty action with regard to registration of the request led to the refusal of the later request for partial renewal in order to avoid legal uncertainty.

73. Nissan further contends [41] that, in the instant case, it paid at the outset the amount of fees to cover the cost of renewal in all three classes protected by its mark, which should have led OHIM to check whether its request was complete. Although that fact cannot be taken into account on appeal, since it is not included in the judgment under appeal, it has not been explicitly refuted by the other party.

74. In the light of those considerations, I believe that the first ground of appeal is well-founded in law and must therefore be allowed. Accordingly, the judgment under appeal must be set aside.

75. Although the success of the first ground of appeal renders examination of the second ground superfluous, I shall very briefly set out below my view on that ground in case the Court should decide to reject the first ground.

B – *The second ground of appeal, alleging the infringement of Article 48 of Regulation No 207/2009.*

1. Submissions of the parties

76. According to Nissan, the partial renewal registered by OHIM, which cancelled protection for the goods in Class 9, constitutes an alteration of the mark contrary to the prohibition in Article 48 of Regulation No 207/2009. Pursuant to that provision, a Community trade mark must not be altered during the period of registration or on renewal thereof.

77. Contrary to the view of the General Court, [42] Nissan contends that Article 48 does not relate solely to the sign of which the mark is composed, since, first, it does not mention the word 'sign' and, second, a Community trade mark is a right in respect of an indication of the commercial origin of specific goods or services.

78. OHIM responds that the interpretation of Article 48 suggested by Nissan conflicts with the wording of paragraph 3 thereof. Furthermore, the interpretation adopted by the General Court is borne out by Article 43(1) and (2) of Regulation No 207/2009, pursuant to which a trade mark proprietor may restrict — in other words, alter — the list of goods and services. In OHIM's submission, the General Court rightly held that the registration of a complete renewal, submitted

41 — Point 2 of its appeal.

42 — Paragraph 48 of the judgment under appeal.

within the time-limit, but relating to only some of the goods and services covered during the previous registration period, of necessity means that that proprietor was not seeking to extend coverage of the Community trade mark to the rest of the goods and services beyond the protection period which was about to end.

2. Analysis of the ground of appeal

79. Although I do not completely agree with the last part of OHIM's arguments against the second ground of appeal, I do agree with its view of Article 48 of Regulation No 207/2009. The prohibition on alteration of the trade mark during the registration period affects both the sign itself and the list of goods and services.[43] Article 48(2) refers only to alteration of 'the name and address of the proprietor' of the trade mark, where both are included in the trade mark. The alteration of those particulars is possible if it does 'not substantially [affect] the identity of the trade mark as originally registered'.

80. The difficulties raised by Article 48 of Regulation No 207/2009 are unconnected to those arising as a result of administrative actions carried out with a view to registering the renewal of a trade mark. Just as a partial renewal in accordance with Article 47 (for example, where the 'second' request is clearly out of time) does not mean that the outcome would be contrary to Article 48(2) of Regulation No 207/2009 — that is, would not involve a prohibited 'alteration' of the mark — nor does the fact that OHIM has incorrectly interpreted Article 47 in this case, and granted only a limited renewal, infringe Article 48.

81. The prohibition of alteration of a Community trade mark, laid down in Article 48 of Regulation No 207/2009, does not preclude the possibility that, when a Community trade mark is renewed, the scope of protection is restricted to certain classes of goods or services and does not cover all the goods or services which were hitherto covered by the trade mark. The provision refers only to alterations of the sign, which may be altered within the limits imposed by the provision, provided that the distinctive character is not affected.[44] Moreover, it would make no sense if Article 48(2) were to apply to goods and services when, I repeat, it is concerned exclusively with changes to the name and address originally included in the mark.

82. Accordingly, if the first ground of appeal is rejected, the second cannot succeed and should be rejected.

VI – **Effects of setting aside the judgment under appeal**

83. The success of the first ground of appeal means that the judgment under appeal must therefore be set aside in so far as it confirmed the decision not to accept Nissan's request for partial renewal.

84. Logically, the decision of the First Board of Appeal should also be annulled. However, given that the arguments in that decision were based on the treatment of the failure to mention Class 9 in the list of goods and services in the initial request for renewal submitted by Nissan, the considerations set out in paragraphs 25 to 30 of the judgment under appeal, which I consider to be correct, continue to be fully valid and justify the annulment of the decision contested by Nissan before the General Court. The judgment of the chamber of the Court of Justice seised of this appeal may adopt those considerations as its own, subject to any alterations it may make to them based on its understanding of the dispute.

43 — Bender, A., 'Eintragung und Verlängerung einer Gemeinschaftsmarke', in Fezer, K.-H., *Handbuch der Markenpraxis, Band I –Markenverfahrensrecht*, ed. C.H. Beck, Munich, 2007, p. 651.

44 — Ibid.; see also Geroulakos, P., 'Título V: Vigencia, renovación y modificación de la marca comunitaria — Artículo 48', in Casado Cerviño, A./Llobregat Hurtado, M.-L., *Comentarios a los reglamentos sobre la marca comunitaria*, ed. La Ley, 2nd ed., Madrid, 2000, p. 442.

85. Lastly, the setting aside of the judgment under appeal means that the Court must also decide on the costs of the proceedings at first instance. In accordance with Article 137(1), in conjunction with Article 184(2), of the Rules of Procedure of the Court of Justice, OHIM must be ordered to pay the costs at first instance and on appeal because it has been unsuccessful and the appellant has applied for costs in these proceedings.

VII – **Conclusion**

86. In the light of the foregoing considerations, I propose that the Court should:

(1) set aside the judgment of the General Court of 4 March 2015 in Case T-572/12 *Nissan Jidosha KK* v *OHIM*;

(2) annul the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 6 September 2012 in Case R 2469/2011-1;

(3) order the Office for Harmonisation in the Internal Market (Trade Marks and Designs) to pay the costs both at first instance and on appeal.