Reports of Cases

JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

26 November 2014*

(Community trade mark — Opposition proceedings — Application for Community figurative mark Alifoods — Earlier international and Community word marks ALDI — Relative ground for refusal — No likelihood of confusion — No similarity between the signs — Article 8(1)(b) of Regulation (EC) No 207/2009 — Rule 19(2)(a)(ii) of Regulation (EC) No 2868/95)

In Case T-240/13,

Aldi Einkauf GmbH & Co. OHG, established in Essen (Germany), represented by N. Lützenrath, U. Rademacher, L. Kolks and C. Fürsen, lawyers,

applicant,

v

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

defendant,

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

Alifoods, SA, established in Alicante (Spain),

ACTION against the decision of the Fourth Board of Appeal of OHIM of 25 February 2013 (Case R 407/2012-4), relating to opposition proceedings between Aldi Einkauf GmbH & Co. OHG and Alifoods, SA,

THE GENERAL COURT (Ninth Chamber),

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

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 25 April 2013,

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

having regard to the change in the composition of the Chambers of the General Court,

* Language of the case: German.

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 [1]

Background to the dispute

1 On 29 October 2010, Alifoods, SA filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The trade mark in respect of which registration was sought is the following figurative sign:



3 The goods and services in respect of which registration was sought are in Classes 29, 32 and 35 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 29: ‘Meat, fish, poultry and game; Meat extracts; Preserved frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs, milk and milk products; Edible oils and fats’;

— Class 32: ‘Beers; Mineral and aerated waters and other non-alcoholic drinks; Fruit drinks and fruit juices; Syrups and other preparations for making beverages’;

— Class 35: ‘Advertisement services; Business management; Business administration services; Office function services; Organisation of exhibitions for commercial or advertising purposes, wholesaling and/or retailing in shops of meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages; Wholesaling and/or retailing and selling via global computer networks of meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages’.

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

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 4/2011 of 7 January 2011.

5 On 7 April 2011, the applicant — Aldi Einkauf GmbH & Co. OHG — filed a notice of opposition, under Article 41 of Regulation No 207/2009, to registration of the trade mark applied for in respect of the goods and services referred to in paragraph 3 above.

6 The opposition was based on the following earlier marks:

— the international word mark ALDI, registered on 11 August 2005 under No 870896, with effect in the European Union, in respect of goods and services in Classes 35, 38, 40, 41 and 42 and, as regards Class 35 — the only class relevant to the present proceedings ('the international trade mark') — corresponding to the following description: 'Advertising; business management; business administration; office functions; retailing in all product areas; online retailing in all product areas; operating supermarkets, retail outlets and discount retail outlets; advertising on the Internet, for others; providing information on the Internet, namely information about consumer products, consumer advice information and customer service information; arranging of commercial transactions for third parties, also on the Internet; arranging of contracts regarding the purchase and sale of goods as well as the providing of services for others, also via the Internet';

— …

7 The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation No 207/2009.

8 On 7 February 2012, the Opposition Division rejected the opposition in its entirety.

9 On 22 February 2012, Aldi Einkauf filed an appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.

10 By decision of 25 February 2013 ('the contested decision'), the Fourth Board of Appeal of OHIM dismissed the appeal.

11 First, the Board of Appeal found that, since Aldi Einkauf had only submitted a printout from the OHIM database, it had not filed proof of the existence, validity and scope of protection of the international trade mark, in accordance with Rule 19(1) and Rule 19(2)(a)(ii) 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. The Board of Appeal therefore rejected the opposition in so far as it was based on that mark (paragraphs 10 to 13 of the contested decision).

…

Forms of order sought

17 Aldi Einkauf claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

18 OHIM contends that the Court should:

— dismiss the action;

— order Aldi Einkauf to pay the costs.

Law …

2. Substance …

First ground of appeal: infringement of Rule 19(2)(a)(ii) of Regulation No 2868/95

22 Aldi Einkauf essentially submits that the Board of Appeal erred in law in rejecting the opposition based on the international trade mark on account of an alleged failure to prove the existence of that mark.

23 OHIM disputes the merits of that argument.

24 It should be recalled that, under Rule 20(1) of Regulation No 2868/95, the opposition is to be rejected as unfounded if, by the expiry of the period referred to in Rule 19(1) of that regulation, the opposing party has not yet proved the existence, validity and scope of protection of his earlier mark or earlier right, as well as his entitlement to file the opposition.

25 Under Rule 19 of that regulation:

‘1. [OHIM] shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time limit specified by it and which shall be at least 2 months starting on the date on which the opposition proceedings shall be deemed to commence …

2. Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right … In particular, the opposing party shall provide the following evidence:

(a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting:

(i) …

(ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered;

…’

26 The Board of Appeal found in paragraph 13 of the contested decision that, despite the fact that the earlier word mark ALDI - registered under No 870896 — is an international trade mark, Aldi Einkauf had only submitted a printout from the OHIM database. In the same paragraph, the Board

consequently found that such a printout did not constitute a copy of the relevant registration certificate or equivalent document emanating from the administration by which the trade mark was registered, in this case, the World Intellectual Property Organisation (WIPO).

27 It should be noted that Aldi Einkauf does not deny having submitted no more than a printout from the OHIM database and that, in the application, Aldi Einkauf points out that it submitted an 'official printout from the [OHIM] online database', which is also apparent from the administrative file for the procedure before OHIM.

28 It must therefore be held that, since OHIM is not responsible for managing international registrations and is not the administration by which the trade mark was registered, for the purposes of Rule 19(2)(a)(ii) of Regulation No 2868/95, the document submitted by Aldi Einkauf does not constitute proof of the existence, validity and scope of protection of the international trade mark. Consequently, it is appropriate to confirm the assessment made by the Board of Appeal in that regard.

29 For the sake of completeness, it should be stated that, as suggested by the reference made by the Board of Appeal to its previous decision-making practice in paragraph 13 of the contested decision, that assessment is borne out by a teleological interpretation of Regulation No 2868/95. Under Article 152 of Regulation No 207/2009, the OHIM publication relating to an international registration designating the European Community only incorporates certain information, including a reproduction of the mark and the numbers of the classes of the goods or services in respect of which protection is claimed, but not a list of those goods or services. Such lists are not translated by OHIM and, accordingly, are only available in the three languages in which WIPO publishes international registrations, namely English, Spanish and French.

30 If the information published by OHIM were regarded as sufficient proof of the existence, validity and scope of protection of the international trade mark at issue, and also as satisfactorily proving that, in that regard, the international registration designating the Community is treated as a Community trade mark, it would mean that the international registration received preferential treatment. Since, in all opposition proceedings — including those conducted in a language which is not among those in which WIPO publishes international registrations — documents proving the existence of earlier rights must be available in the language of the proceedings, international registrations designating the Community would be exempted in that respect in cases where the language of the opposition proceedings was one of the other two official languages of OHIM, that is to say, German or Italian. In such cases, the list of goods or services in respect of which registration is sought would not in fact be available in the language of proceedings. However, neither Regulation No 207/2009 nor Regulation No 2868/95 provides for such preferential treatment.

31 Furthermore, if the information published by OHIM were regarded as sufficient proof of the existence, validity and scope of protection of the trade mark at issue only in opposition proceedings in which the language of the proceedings is also one of the three languages in which WIPO publishes international registrations, not only would such a situation be contrary to the wording and interpretation of the regulation in question, but it would create, in legal terms, uncertainty and inequality.

32 It follows that the Board of Appeal was correct to hold, in paragraph 13 of the contested decision, that the opposition had to be rejected as unfounded in so far as it was based on the international trade mark.

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

…

On those grounds,

THE GENERAL COURT (Ninth Chamber)

hereby:

1. Dismisses the action;

2. Orders Aldi Einkauf GmbH & Co. OHG to pay the costs.

Berardis Czúcz Popescu

Delivered in open court in Luxembourg on 26 November 2014.

[Signatures]