Reports of Cases

ORDER OF THE GENERAL COURT (Ninth Chamber)

14 February 2017 [1]

(EU trade mark — Opposition proceedings — Cancellation of the earlier figurative mark serving as a basis for the contested decision — No need to adjudicate)

In Case T-333/14,

Andreas Helbrecht, residing in Hilden (Germany), represented by C. König, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by M. Rajh, acting as Agent,

defendant,

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

Lenci Calzature SpA, established in Turchetto-Montecarlo (Italy), represented by F. Celluprica and F. Fischetti, lawyers,

ACTION for annulment of the decision of the Fifth Board of Appeal of EUIPO of 27 February 2014 (Case R 830/2013-5), concerning opposition proceedings between Lenci Calzature and Mr Helbrecht,

THE GENERAL COURT (Ninth Chamber),

composed of S. Gervasoni, President, L. Madise and R. da Silva Passos (Rapporteur), Judges,

Registrar: E. Coulon,

makes the following

1 — Language of the case: English.

Order

Background to the dispute, procedure and forms of order sought by the parties

1 On 8 January 2009 the applicant, Mr Andreas Helbrecht, filed an application for registration of a European Union trade mark with the European Union Intellectual Property Office (EUIPO) 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 European Union trade mark (OJ 2009 L 78, p. 1)).

2 Registration as a mark was sought for the word sign SportEyes. The goods in respect of which registration was sought fall within Class 25 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, and correspond to the following description: 'Footwear of leather, imitations of leather, rubber or plastic, in particular rain shoes and boots; headgear of textile materials, headgear of leather and imitations of leather, headgear of rubber or plastic, in particular peaked caps; clothing of textile fabrics, leather and imitations of leather, rubber or plastic; gloves'.

3 The EU trade mark application was published in *Community Trade Marks Bulletin* No 11/2009 of 30 March 2009.

4 On 29 June 2009 the intervener, Lenci Calzature SpA, 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 2 above.

5 The opposition was based on the following earlier rights:

— the following earlier EU figurative mark, filed on 15 October 2004 and registered on 6 September 2008 under number 4073334 in respect of goods in Class 25, namely ‘shoes, boots, slippers and footwear in general, clothing and headgear’:



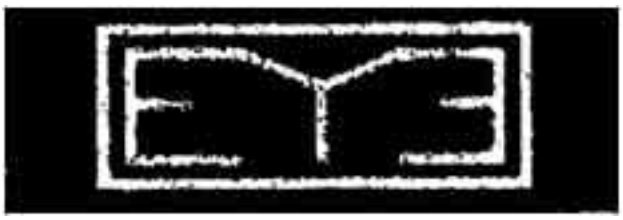
— the following earlier EU figurative mark, filed on 15 October 2004 and registered on 5 September 2008 under number 4077251 in respect of goods in Class 25:



— the following earlier EU figurative mark, filed on 15 October 2004 and registered on 5 September 2008 under number 4077236 in respect of goods in Class 25:



— the following earlier EU figurative mark, filed on 31 May 2000 and registered on 24 July 2001 under number 1683986 in respect of goods in Class 25:



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

7 By decision of 7 March 2013, the Opposition Division, after having examined the opposition solely in relation to the earlier mark registered under number 4073334, upheld the opposition for all of the goods at issue.

8 On 3 May 2013 the applicant filed a notice of appeal with EUIPO, pursuant to Articles 58 to 60 of Regulation No 207/2009, against the decision of the Opposition Division.

9 By decision of 27 February 2014 (‘the contested decision’), the Fifth Board of Appeal of EUIPO confirmed the decision of the Opposition Division and rejected the application for registration of the mark applied for. The Board of Appeal stated, in paragraph 16 of the contested decision, that it would start by examining the earlier trade mark registered under number 4073334. It found, in paragraphs 17 to 19 of the contested decision, that the relevant territory was that of the European Union and that the target consumer was the public at large, deemed to be reasonably well informed and reasonably observant and circumspect, and with a level of attention that had to be regarded as average. The Board of Appeal endorsed, in paragraph 20 of the contested decision, the Opposition Division’s assessment that the goods at issue were identical. In paragraphs 30 and 31 of the contested decision,

the Board of Appeal took the view that, visually and phonetically, the signs at issue were similar. In paragraph 32 of that decision, it considered that those signs were conceptually similar to a high degree for the English-speaking public. In paragraph 33 of the contested decision, the Board of Appeal accordingly concluded that the signs at issue were similar. As regards the likelihood of confusion, the Board of Appeal considered, in paragraphs 34 to 40 of the contested decision, that, taking into account consumers' imperfect recollection of trade marks, there was a likelihood of confusion given the identical nature of the goods at issue and the similarity of the signs in question. After having indicated, in paragraph 39 of the contested decision, that, for reasons of procedural economy, it was not going to examine the other earlier marks on which the opposition was based, the Board of Appeal dismissed the appeal.

10 By application lodged at the Registry of the General Court on 13 May 2014, the applicant brought the present action.

11 EUIPO lodged its response at the Court Registry on 24 October 2014.

12 The intervener lodged its response at the Court Registry on 31 October 2014.

13 In the application, the applicant claims that the Court should:

— annul the contested decision;

— order EUIPO and the intervener to pay the costs.

14 In their responses, EUIPO and the intervener claim that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

15 By document lodged at the Court Registry on 28 October 2016, the applicant brought to the Court's attention the fact that the Cancellation Division had declared the earlier figurative marks referred to in paragraph 5 above either revoked (Decision No 10958 C of 3 March 2016 relating to the trade mark registered under number 1683986) or invalid (Decisions No 12041 C, No 12042 C and No 12040 C of 7 July 2016 relating to the trade marks registered under numbers 4073334, 4077236 and 4077251), and that all of those decisions had become final.

16 On 24 November 2016 the Court, acting on a proposal from the Judge-Rapporteur, communicated to the parties a measure of organisation of procedure by which it asked them to set out their views on whether, in the light of the adoption of those decisions, the present action continued to serve any purpose.

17 In response, the applicant, by document lodged at the Court Registry on 8 December 2016, essentially stated that he considered that the action continued to have a purpose, since he was seeking registration of the mark applied for, unless the Court intended to annul the contested decision on the ground that the earlier trade marks had been declared invalid or had been revoked.

18 The intervener, for its part, indicated, by document lodged at the Court Registry on 9 December 2016, that, in its view, the action no longer served any purpose.

19 EUIPO, by document lodged at the Court Registry on 8 December 2016, also confirmed the definitive nature of the four decisions cited in paragraph 15 above. Furthermore, it indicated that it was of the opinion that, as the earlier trade mark registered under number 4073334, on which the contested

decision was based, had been invalidated by Decision No 12041 C of 7 July 2016, the present action was now devoid of purpose. Last, EUIPO took the view that the applicant should be ordered to pay the costs.

Law

20 It is appropriate to recall that, according to settled case-law, opposition proceedings are devoid of purpose if the earlier trade mark on which they are based is cancelled (see judgment of 25 May 2016, *Mountain Ibiza* v *EUIPO — Etyam (ocean beach club ibiza)*, T-753/14, not published, EU:T:2016:312, paragraph 24 and the case-law cited).

21 Therefore, in such a case, the action for annulment brought before the Court against the decision of the Board of Appeal also becomes devoid of purpose (order of 27 September 2010, *Hidalgo* v *OHIM — Bodegas Hidalgo — La Gitana (HIDALGO)*, T-365/08, not published, EU:T:2010:407, paragraph 6, and judgment of 25 May 2016, *ocean beach club ibiza*, T-753/14, not published, EU:T:2016:312, paragraph 25).

22 According to Article 55(2) of Regulation No 207/2009, an EU trade mark which has been declared invalid is to be deemed not to have had, as from the outset, the effects specified in that regulation. It follows that the earlier mark must be deemed not to have produced its effects and, therefore, not to have been able to serve as a basis for opposition to the mark applied for (see, to that effect, judgment of 4 March 2015, *Three-N-Products* v *OHIM — Munindra (PRANAYUR)*, T-543/13, not published, EU:T:2015:134, paragraph 16).

23 In the present case, the contested decision is based exclusively on the examination of the likelihood of confusion between the mark applied for and the earlier mark registered under number 4073334, which was the reason for which the Opposition Division upheld the opposition. It is common ground, however, that, by its decision of 7 July 2016, the Cancellation Division declared that earlier mark to be invalid and that that decision has become final.

24 Therefore, following the invalidation of the earlier mark registered under number 4073334, the only earlier mark on the basis of which the opposition had been declared to be well founded in the contested decision disappeared and the opposition proceedings became devoid of purpose as far as that earlier mark was concerned. Consequently, in accordance with Article 131 of the Rules of Procedure of the General Court, the present action has become devoid of purpose and there is no longer any need to adjudicate on it.

25 Although the applicant claims that a decision of the Court on the merits in the present proceedings would procure him an advantage, it should be borne in mind that, according to settled case-law, the interest in bringing proceedings must continue until the final decision, failing which there will be no need to adjudicate, which presupposes that the action must be likely, if successful, to procure an advantage for the party bringing it (judgment of 7 June 2007, *Wunenburger* v *Commission*, C-362/05 P, EU:C:2007:322, paragraph 42, and order of 11 October 2007, *Wilfer* v *OHIM*, C-301/05 P, not published, EU:C:2007:593, paragraph 19; see, also, judgment of 10 December 2010, *Ryanair* v *Commission*, T-494/08 to T-500/08 and T-509/08, EU:T:2010:511, paragraph 43 and the case-law cited).

26 It must be pointed out, in the present case, that a decision on the merits by the Court is not likely to procure an advantage for the applicant. Pursuant to Article 64(3) of Regulation No 207/2009, decisions of the Boards of Appeal take effect only as from the date of expiry of the period referred to in Article 65(5) of Regulation No 207/2009 or, if an action has been brought before the EU Courts, as from the date on which that action is dismissed. Neither of those situations obtains where, as in the present case, the Court finds that there is no need to adjudicate (order of 26 November 2012, *MIP*

Metro v *OHIM — Real Seguros (real,- QUALITY)*, T-548/11, not published, EU:T:2012:623, paragraph 23; see also, to that effect, orders of 3 July 2003, *Lichtwer Pharma* v *OHIM — Biofarma (Sedonium)*, T-10/01, EU:T:2003:182, paragraph 17, and of 11 September 2007, *Lancôme* v *OHIM — Baudon (AROMACOSMETIQUE)*, T-185/04, not published, EU:T:2007:249, paragraph 22). The present action becomes devoid of purpose since the contested decision is automatically deemed not to have had, as from the outset, the effects specified in Regulation No 207/2009 and, therefore, not to have been able to uphold any opposition whatsoever, as follows from paragraphs 21 and 22 above. The Court therefore cannot rule on the legality of a decision such as the one at issue, which is deprived of all legal effect. For the same reasons, *a fortiori*, it cannot annul that decision.

27 Moreover, when the Court has before it a claim for annulment, the purpose of the action before it is to review the legality of decisions of the Boards of Appeal of EUIPO for the purposes of Article 65 of Regulation No 207/2009 (see, to that effect, judgment of 14 May 2009, *Fiorucci* v *OHIM — Edwin (ELIO FIORUCCI)*, T-165/06, EU:T:2009:157, paragraph 21 and the case-law cited). In that regard, the Court carries out a review of the legality of the decisions of EUIPO bodies and may not, in any event, substitute its own reasoning for that of the EUIPO body which adopted the contested act (see, to that effect, judgment of 14 May 2009, *ELIO FIORUCCI*, T-165/06, EU:T:2009:157, paragraph 65). Thus, it is not for the Court to rule on the likelihood of confusion between the mark applied for and the other earlier marks, namely the marks registered under numbers 1683986, 4077236 and 4077251, which have become either obsolete (1683986) or invalid (4077236 and 4077251). Such an examination would, if appropriate, fall to be carried out by EUIPO pursuant to Article 8(1)(b) of Regulation No 207/2009.

28 It follows from all of the foregoing that there is no longer any need to adjudicate on the present action.

Costs

29 Under Article 137 of the Rules of Procedure, where a case does not proceed to judgment, the costs are to be in the discretion of the Court.

30 In the present case, the applicant has requested that the intervener and EUIPO be ordered to pay the costs of the proceedings.

31 EUIPO, for its part, has requested that the applicant be ordered to pay the costs.

32 In that regard, it should be stated that the lack of need to adjudicate in the present case is due to the cancellation of the earlier figurative mark on which the opposition is based.

33 Accordingly, it is appropriate to decide that the intervener shall bear its own costs and pay those incurred by the applicant. EUIPO shall bear its own costs.

On those grounds,

THE GENERAL COURT (Ninth Chamber)

hereby orders:

1. **There is no longer any need to adjudicate on the action.**

2. **Lenci Calzature SpA shall bear its own costs and pay those incurred by Mr Andreas Helbrecht. The European Union Intellectual Property Office (EUIPO) shall bear its own costs.**

Luxembourg, 14 February 2017.

E. Coulon
Registrar

S. Gervasoni
President