Reports of Cases

JUDGMENT OF THE COURT (First Chamber)

21 July 2016*

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Article 76(2) — Regulation (EC) No 2868/95 — Rule 50(1), third subparagraph — Figurative mark — Opposition by the proprietor of the earlier trade mark — Proof of the existence, validity and extent of the protection of the earlier trade mark — Consideration by the Board of Appeal of evidence submitted out of time — Rejection of the opposition by the Board of Appeal)

In Case C-597/14 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 22 December 2014,

European Union Intellectual Property Office (EUIPO), represented by S. Palmero Cabezas and A. Folliard-Monguiral, acting as Agents,

applicant,

the other parties to the proceedings being:

Xavier Grau Ferrer, residing in Caldes de Montbui (Spain),

applicant at first instance,

Juan Cándido Rubio Ferrer,

Alberto Rubio Ferrer,

residing in Xeraco (Spain),

interveners at first instance,

THE COURT (First Chamber),

composed of R. Silva de Lapuerta, President of the Chamber, J.-C. Bonichot, C.G. Fernlund, S. Rodin (Rapporteur) and E. Regan, Judges,

Advocate General: M. Szpunar,

Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 21 October 2015,

* Language of the case: Spanish.

after hearing the Opinion of the Advocate General at the sitting on 13 January 2016,

gives the following

Judgment

1 By its appeal, the European Union Intellectual Property Office (EUIPO) seeks to have set aside the judgment of the General Court of the European Union of 24 October 2014 in *Grau Ferrer* v *OHIM — Rubio Ferrer (Bugui va)* (T-543/12, not published, EU:T:2014:911) ('the judgment under appeal'), by which it annulled the decision of the Fourth Board of Appeal of EUIPO of 11 October 2012 (Joined Cases R 274/2011-4 and R 520/2011-4) relating to opposition proceedings between Mr Xavier Grau Ferrer, on one hand, and Messrs Juan Cándido Rubio Ferrer and Alberto Rubio Ferrer, on the other, ('the contested decision').

Legal context

Regulation (EC) No 207/2009

2 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) was codified by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

3 Article 15(1) of Regulation No 207/2009, entitled 'Use of EU trade marks', provides:

'If, within a period of five years following registration, the proprietor has not put the EU trade mark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the EU trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

(a) use of the EU trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

…'

4 Article 41(3) of that regulation, which governs the filing of an opposition to the registration of an EU trade mark, provides:

'Opposition must be expressed in writing and must specify the grounds on which it is made. … Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments.'

5 Article 76(2) of that regulation, entitled 'Examination of the facts by the Office of its own motion', provides:

'The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.'

The Implementing Regulation

6 Rule 15(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1) as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4) ('the Implementing Regulation'), entitled 'Notice of opposition', states:

'The notice of opposition shall contain:

…

(b) a clear identification of the earlier trade mark or earlier right on which the opposition is based, namely:

(i) where the opposition is based on an earlier mark within the meaning of Article 8(2)(a) or (b) of [Regulation No 40/94, the wording of which is identical to that of Article 8(2)(a) and (b) of Regulation No 207/2009] or where the opposition is based on Article 8(3) of [Regulation No 40/94, the wording of which is identical to that of Article 8(3) of Regulation No 207/2009], the indication of the file number or registration number of the earlier mark, the indication whether the earlier mark is registered or an application for registration, as well as the indication of the Member States including, where applicable, the Benelux, in or for which the earlier mark is protected, or, if applicable, the indication that it is an EU trade mark;

…

(e) a representation of the earlier mark as registered or applied for; if the earlier mark is in colour, the representation shall be in colour;

…'

7 Rule 19 of the Implementing Regulation, entitled 'Substantiation of the opposition', provides:

'1. The Office 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 in accordance with Rule 18(1).

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, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:

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

…

(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;

…'

8 Under the heading ‘Examination of the opposition’, Rule 20(1) of that regulation provides:

‘If until expiry of the period referred to in Rule 19(1) the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well his entitlement to file the opposition, the opposition shall be rejected as unfounded.’

9 According to Rule 50(1), third subparagraph, of that regulation:

‘Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74(2) of [Regulation No 40/94, the wording of which is identical to that of Article 76(2) of Regulation No 207/2009].’

Background to the dispute

10 The General Court summarised the facts giving rise to the dispute as follows:

‘1. On 23 October 2008, the interveners, Juan Cándido Rubio Ferrer and Alberto Rubio Ferrer, filed an application for registration of an EU figurative mark with [EUIPO], pursuant to Regulation [No 40/94, codified by Regulation No 207/2009].

2. Registration as a mark was sought for the following figurative sign: …

3. The goods and services in respect of which registration was applied for are in Classes 31, 35 and 39 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended …

…

5 On 10 August 2009, [Mr] Grau Ferrer filed a notice of opposition, pursuant to Article 41 of Regulation No 207/2009, to registration of the EU figurative 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 figurative marks:

— Spanish registration No 2600724 of the figurative sign applied for on 8 June 2004 and registered on 22 November 2004 for all the goods in class 31:

…

— European Union registration No 2087534 of the figurative sign below, applied for on 14 February 2001 and registered on 14 June 2002 for the goods and services in the following classes:

— Class 31: …

— Class 32: …

— Class 39: …

…

8. On 21 December 2010, the Opposition Division partially upheld the opposition. First, it held that [Mr Grau Ferrer] had not provided any documents representing the earlier Spanish figurative mark as registered within the period prescribed for that purpose … Therefore, it rejected the opposition based on the earlier Spanish figurative mark on the ground that its existence and validity had not been sufficiently substantiated within the period prescribed. Second, it upheld the opposition based on the earlier EU mark … It considered, first of all, that the evidence of genuine use of the earlier EU mark had been adduced …

9 On 10 February 2011, [Mr Grau Ferrer] filed a notice of appeal (R 520/2011-4) and on 14 February 2011, the interveners [Messrs Rubio Ferrer] filed a notice of appeal (R 274/2011-4) with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the Opposition Division's decision.

10 By decision of 11 October 2012 …, the Fourth Board of Appeal of EUIPO upheld the appeal in Case R 274/2011-4 and rejected the appeal in Case R 520/2011-4. Essentially, first, it confirmed the Opposition Division's decision according to which the evidence of the existence of the earlier Spanish figurative mark had not been produced. Second, it held that the evidence produced was not sufficient to show that the earlier EU mark had, during the relevant period, been put to genuine use in the form under which it was registered or in a form which does not alter its distinctive character for one of the goods for which it was registered. Therefore, it annulled the Opposition Division's decision of 21 December 2010 and rejected the opposition in its entirety.'

The proceedings before the General Court and the judgment under appeal

11 By application lodged at the Registry of the General Court on 18 December 2012 (Case T-543/12), Mr Grau Ferrer brought an action for the annulment of the contested decision.

12 In support of his action, Mr Grau Ferrer relied on three pleas based, first, on the infringement of Articles 75 and 76(2) of Regulation No 207/2009 and Rule 50 of the Implementing Regulation, second, the genuine use of the earlier EU figurative mark No 2087534 registered by Mr Grau Ferrer on 14 June 2002 ('the earlier mark') and, third, the likelihood of confusion between the earlier mark and the earlier Spanish figurative mark, on the one hand, and the EU figurative mark for which registration was sought by Messrs Rubio Ferrer, on the other.

13 The General Court upheld the action for annulment holding, in paragraph 48 of the judgment under appeal, that the Board of Appeal of EUIPO had failed to exercise its discretion or to give reasons for its refusal to take account of the earlier Spanish mark and, in paragraphs 86 and 87 of the judgment under appeal, that the documents produced before the Board of Appeal contained a sign which only differed from the earlier mark by negligible elements, so that they point to genuine use of that mark.

14 The General Court held that the remainder of the pleas put forward by Mr Grau Ferrer were irrelevant or unfounded.

15 Accordingly, the General Court annulled the contested decision.

Forms of order sought

16 By its appeal, EUIPO claims that the Court should:

— set aside the judgment under appeal and to rule itself on the substance of the case or to refer it back to the General Court, and

— order Mr Grau Ferrer to pay the costs.

17 No other parties to the proceedings submitted any pleadings before the Court.

The appeal

18 In support of its appeal, EUIPO raises three grounds of appeal based on the infringement of Article 76(2) of Regulation No 207/2009, Rule 50(1), third subparagraph, of the Implementing Regulation, and Article 15(1), second subparagraph, point (a), of Regulation No 207/2009 respectively.

The second ground of appeal

19 By its second ground of appeal, which it is appropriate to examine first, EUIPO argues essentially that, in paragraphs 45 to 48 of the judgment under appeal, the General Court erred in law by holding that the Board of Appeal had discretion deriving from Rule 50(1), third subparagraph, of the Implementing Regulation and Article 76(2) of Regulation No 207/2009 'independently of whether the late evidence was supplementary' or not, and consequently that it also had discretion as regards 'new' evidence.

20 In paragraph 45 of the judgment under appeal, the General Court stated that the case-law of the Court concerning the discretion of the Board of appeal and the grounds for taking into consideration late evidence makes no distinction between additional and supplementary evidence, then, in paragraph 46 of that judgment, it dismissed the argument that the Board of Appeal was not entitled to take into consideration the evidence submitted by Mr Grau Ferrer because it was new.

21 The General Court held essentially, in paragraph 48 of the judgment under appeal, that the Board of Appeal had discretion and had an obligation to give reasons for its refusal without distinguishing 'new' evidence from 'supplementary' evidence.

22 EUIPO maintains that the discretion and the obligation to state reasons do not concern new evidence. In support of that argument, it points out the differences between the various language versions of the judgment of 3 October 2013 in *Rintisch* v *OHIM* (C-120/12 P, EU:C:2013:638); 3 October 2013 in *Rintisch* v *OHIM* (C-121/12 P, EU:C:2013:639); and 3 October 2013 in *Rintisch* v *OHIM* (C-122/12 P, EU:C:2013:628). According to EUIPO, on the basis of Article 42(2) of Regulation No 207/2009 and Rule 20(1) of the Implementing Regulation, in the absence of complete proof before the Opposition Division, the opposition is to be dismissed without being examined as to the substance. Therefore, it would be impossible to reopen the possibility of opposition at Board of Appeal level.

23 As far as concerns the wording of Rule 50(1), third subparagraph, of the Implementing Regulation, it must be observed that the French language version is different from the Spanish, German and English versions in one fundamental respect. Whereas the latter versions provide that the Board of Appeal must take into consideration only additional or supplementary facts and evidence, the French version describes that evidence as 'nouveaux ou supplémentaires' ['new or supplementary'].

24 According to settled case-law, provisions of EU law must be interpreted and applied uniformly in the light of the versions existing in all the languages of the European Union. Where there is divergence between the various language versions of an EU legislative text, the provision in question must be interpreted by reference to the purpose and general scheme of the rules of which it forms part (see, to that effect, judgments of 15 November 2012 *in Kurcums Metal*, C-558/11, EU:C:2012:721, paragraph 48, and 9 April 2014 in *GSV*, C-74/13, EU:C:2014:2058, paragraph 27).

25 In that connection, it must be recalled that Article 76(2) of Regulation No 207/2009, which constitutes the legal basis for Rule 50 of the Implementing Regulation, provides that the Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

26 The Court has held that, when no proof of use of the mark concerned is submitted within the time limit set by the Office, the opposition must automatically be rejected by it. However, when evidence is produced within the time limit set by the Office, the production of supplementary evidence remains possible (see, to that effect, judgment of 18 July 2013 in *New Yorker SHK Jeans* v *OHIM*, C-621/11 P, EU:C:2013:484, paragraphs 28 and 30).

27 As the Advocate General observed, in paragraphs 55 and 57 of his Opinion, Article 76(2) of Regulation No 207/2009 should be interpreted in the same way in relation to proof of the existence, validity and scope of protection of a trade mark since that provision contains a rule which applies horizontally within the scheme of that regulation, inasmuch as it applies irrespective of the nature of the proceedings concerned. It follows that Rule 50 of the Implementing Regulation cannot be interpreted as meaning that it extends the discretion of the Boards of Appeal to new evidence.

28 It must be stated that the General Court erred in law in paragraphs 45, 46 and 48 of the judgment under appeal by holding that the Board of Appeal had failed to exercise the discretion conferred on it to decide whether or not it was appropriate to take new evidence into consideration.

29 However, it must be recalled that it follows from settled case-law of the Court of Justice that where the grounds of a judgment of the General Court disclose an infringement of EU law but the operative part of the judgment is shown to be well founded for other legal reasons, the appeal must be dismissed (see, in particular, judgments of 15 December 1994 in *Finsider* v *Commission*, C-320/92 P, EU:C:1994:414, paragraph 37; 16 December 1999 in *CES* v *E*, C-150/98 P, EU:C:1999:616, paragraph 17, and 13 July 2000 in *Salzgitter* v *Commission*, C-210/98 P, EU:C:2000:397, paragraph 58).

30 That is the position in the present case. The General Court did not uphold the only plea under consideration, but also relied on the fact that the Board of Appeal had rejected the evidence at issue without examining whether it could be regarded as being ‘supplementary’. By failing to undertake that examination, the Board of Appeal did in fact infringe Article 76(2) of Regulation No 207/2009 as the General Court held.

31 In those circumstances, and without its being necessary to consider the other pleas in law advanced by EUIPO in support of its appeal, the appeal must be dismissed in its entirety.

Costs

32 Under Article 137 of the Rules of Procedure of the Court of Justice, which is applicable to the procedure on appeal pursuant to Article 184(2) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings. Since EUIPO has been unsuccessful, it must be ordered to bear its own costs.

On those grounds, the Court (First Chamber) hereby:

1. Dismisses the appeal;

2. Orders the European Union Intellectual Property Office (EUIPO) to pay the costs.

[Signatures]