Reports of Cases

JUDGMENT OF THE GENERAL COURT (Sixth Chamber)

13 September 2013 *

(Community trade mark — Invalidity proceedings — Community word mark CASTEL — Absolute ground for refusal — Descriptive character — Article 7(1)(c) of Regulation (EC) No 207/2009 — Admissibility — Absolute ground for refusal not put forward before the Board of Appeal — Examination of the facts by OHIM of its own motion — Article 76(1) of Regulation (EC) No 207/2009)

In Case T-320/10,

Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell, established in Castell (Germany), represented by R. Kunze, G. Würtenberger and T. Wittmann, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by P. Geroulakos and G. Schneider, acting as Agents,

defendant,

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

Castel Frères SAS, established in Blanquefort (France), represented by A. von Mühlendahl and H. Hartwig, lawyers,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 4 May 2010 (Case R 962/2009-2), relating to invalidity proceedings between Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell and Castel Frères SAS,

THE GENERAL COURT (Sixth Chamber),

composed of H. Kanninen, President, I. Labucka and S. Soldevila Fragoso (Rapporteur), Judges,

Registrar: S. Spyropoulos, Administrator,

having regard to the application lodged at the Court Registry on 2 August 2010,

having regard to the response of OHIM lodged at the Court Registry on 15 November 2010,

having regard to the response of the intervener lodged at the Court Registry on 10 November 2010,

* Language of the case: English.

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

further to the hearing on 8 November 2012,

gives the following

Judgment[1]

…

Forms of order sought

9 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

10 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

11 At the hearing, the intervener stated that it was withdrawing Annexes I.9 and I.10 to its response, which had been submitted for the first time before the Court.

Law

…

Admissibility of the plea in law alleging infringement of Articles 7(1)(d) and 52(1)(a) of Regulation No 207/2009

…

24 It is apparent from the examination of the administrative file that the plea alleging infringement of Article 7(1)(d) of Regulation No 207/2009 was not put forward before the Board of Appeal and that it was therefore submitted for the first time before the Court.

25 In any event, contrary to what the applicant claims, that absolute ground for refusal did not have to be examined by the Board of Appeal of its own motion in the context of invalidity proceedings.

26 Under Article 76(1) of Regulation No 207/2009, when considering absolute grounds for refusal, OHIM examiners and, on appeal, the Boards of Appeal of OHIM are required to examine the facts of their own motion in order to determine whether the mark registration of which is sought comes within one of the grounds for refusal of registration laid down in Article 7 of that regulation. It follows that the competent bodies of OHIM may be led to base their decisions on facts which have not been put

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

forward by the applicant for the mark. OHIM is required to examine of its own motion the relevant facts which may lead it to apply an absolute ground for refusal (Case C-25/05 P *Storck* v *OHIM* [2006] ECR I-5719, paragraph 50; Case T-129/04 *Develey* v *OHIM (Shape of a plastic bottle)* [2006] ECR II-811, paragraph 16; and judgment of 12 April 2011 in Joined Cases T-310/09 and T-383/09 *Fuller & Thaler Asset Management* v *OHIM (BEHAVIOURAL INDEXING and BEHAVIOURAL INDEX)*, not published in the ECR, paragraph 29).

27 In invalidity proceedings, however, OHIM cannot be required to carry out afresh the examination which the Examiner conducted, of his own motion, of the relevant facts which could have led him to apply the absolute grounds for refusal. It follows from the provisions of Articles 52 and 55 of Regulation No 207/2009 that the Community trade mark is regarded as valid until it has been declared invalid by OHIM following invalidity proceedings. It therefore enjoys a presumption of validity, which is the logical consequence of the check carried out by OHIM in the examination of an application for registration.

28 By virtue of that presumption of validity, OHIM's obligation, under Article 76(1) of Regulation No 207/2009, to examine of its own motion the relevant facts which may lead it to apply absolute grounds for refusal, is restricted to the examination of the application for a Community trade mark carried out by the Examiners of OHIM and, on appeal, by the Boards of Appeal during the procedure for registration of that mark. In invalidity proceedings, as the registered Community trade mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity to invoke before OHIM the specific facts which call the validity of that trade mark into question.

29 It follows from the foregoing that, in the invalidity proceedings, the Board of Appeal was not required to examine of its own motion the relevant facts which might have led it to apply the absolute ground for refusal set out in Article 7(1)(d) of Regulation No 207/2009.

30 The present plea must therefore be rejected as inadmissible.

…

On those grounds,

THE GENERAL COURT (Sixth Chamber)

hereby:

1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 4 May 2010 (Case R 962/2009-2);

2. Orders OHIM to bear its own costs and to pay those incurred by Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell;

3. Orders Castel Frères SAS to bear its own costs.

Kanninen Labucka Soldevila Fragoso

Delivered in open court in Luxembourg on 13 September 2013.

[Signatures]