Reports of Cases

OPINION OF ADVOCATE GENERAL
WAHL
delivered on 17 May 2017 [1]

Case C-501/15 P

European Union Intellectual Property Office (EUIPO)
v

Cactus SA

(Appeal — Community trade mark — Regulation (EC) No 207/2009 — Articles 15, 28 and 42 — Figurative sign containing the word elements CACTUS OF PEACE CACTUS DE LA PAZ — Opposition by the owner of earlier Community trade marks containing the word element CACTUS — Scope of those earlier trade marks — Retail services — Assessment of the genuine use of a figurative trade mark in circumstances in which only a part of the registered trade mark is used)

1. By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court to set aside the judgment of the General Court in Case T-24/13. [2] In that judgment, the General Court annulled the decision of the EUIPO Board of Appeal annulling the decision of the Opposition Division inasmuch as it had found that genuine use of earlier trade marks had been substantiated.

2. This case raises two main issues. They both turn, in particular, on the concept of 'genuine use' within the meaning of Article 15 of Regulation (EC) No 207/2009. [3] On the one hand, the case deals with the extent of the protection that ought to be afforded to an earlier trade mark where, apart from a general reference to the relevant class of goods and services, no specific indication regarding the goods and services covered by the trade mark had been given at the time of registration. In that regard, the case provides the Court with an opportunity to clarify its case-law following from *IP Translator* [4] and *Praktiker*. [5] On the other hand, the case invites the Court to clarify how the genuine use of a composite trade mark ought to be assessed where that trade mark is, in practice, employed in an abbreviated form.

1 Original language: English.

2 Judgment of 15 July 2015, *Cactus* v *OHIM — Del Rio Rodríguez (CACTUS OF PEACE CACTUS DE LA PAZ)*, T-24/13, not published, EU:T:2015:494 ('the judgment under appeal').

3 Council Regulation of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1, 'the Trade mark regulation').

4 Judgment of 19 June 2012, *The Chartered Institute of Patent Attorneys*, C-307/10, EU:C:2012:361 ('*IP Translator*').

5 Judgment of 7 July 2005, Praktiker Bau- und Heimwerkermärkte, C-418/02, EU:C:2005:425 ('*Praktiker*').

I. Legal framework

3. Article 15(1) of the Trade mark regulation provides:

'If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community 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 Community 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 Community 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 28 of the Trade mark regulation states:

'Goods and services in respect of which Community trade marks are applied for shall be classified in conformity with the system of classification specified in the Implementing Regulation.'

5. Article 42(2) of the Trade mark regulation deals with the examination of an opposition. It provides:

'If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.'

6. Under the heading 'List of goods and services', Rule 2 of Regulation (EC) No 2868/95[6] states:'(1) The common classification referred to in Article 1 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, shall be applied to the classification of the goods and services.

(2) The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.

(3) The goods and services shall, in principle, be 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 under that Classification.

6 Commission Regulation of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1, 'the Implementing Regulation').

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.'

II. Background to the proceedings

7. The judgment under appeal describes the background of the case in the following manner.

8. On 13 August 2009, Ms Isabel Del Rio Rodríguez filed an application for registration of a Community trade mark with EUIPO on the basis of the Trade mark regulation.

9. Registration as a trade mark was sought for the figurative sign containing the word elements CACTUS OF PEACE CACTUS DE LA PAZ.

10. The goods and services for which registration was sought are in Classes 31, 39 and 44 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 ('the Nice Classification').[7]

11. The trade mark application was published on 14 December 2009.

12. On 12 March 2010, Cactus SA ('Cactus') filed an opposition pursuant to Article 41 of the Trade mark regulation to registration of the trade mark applied for.

13. In support of its opposition, Cactus relied on its earlier registered Community trade marks ('the earlier Cactus trade marks'). More specifically, the opposition was based, on the one hand, on the Community word mark CACTUS ('the earlier word mark') registered on 18 October 2002 for goods and services in Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42.[8] On the other hand, the opposition was based on the Community figurative mark ('the earlier figurative mark') registered on 6 April 2001 for the same goods and services as those covered by the word mark, with the exception of 'foodstuffs not included in other classes; natural plants and flowers, grains; fresh fruits and vegetables' in Class 31.

14. The opposition, which was based on Article 8(1)(b) of the Trade mark regulation, was directed against all the goods and services covered by the trade mark applied for and was based on all the goods and services covered by the earlier marks.

15. By decision of 2 August 2011, the Opposition Division upheld the opposition for 'seeds, natural plants and flowers' in Class 31 and 'gardening, plant nurseries, horticulture' in Class 44, which are covered by the earlier word mark. Registration of the trade mark applied for was therefore refused for those goods and services, but accepted for the services in Class 39.

7 The Nice Classification contains a list of classes, which are accompanied by explanatory notes. Since 1 January 2002 this classification comprises 34 classes for goods and 11 classes for services. Each class is composed of several general indications, which make up the class heading, and of the alphabetical list of goods and services. The goods and services at issue here are as follows. Class 31: 'Seeds, natural plants and flowers'; Class 39: 'Storage, distribution and transport of manure, fertilisers, seeds, flowers, plants, trees, tools and gardening goods of all kinds'; Class 44: 'Gardening, plant nurseries, horticulture'.

8 Those goods and services correspond, for certain of those classes, to the following description. Class 31: 'Foodstuffs not included in other classes; natural plants and flowers, grains; fresh fruits and vegetables; except cactuses, cactus seeds and, more generally, plants and seeds of the cactus family'; Class 35: 'Advertising, business management, among other management of shops, management of do-it-yourself or gardening shops, management of supermarkets or hypermarkets; business administration, office functions, among other advertising, radio and/or television advertising, dissemination of advertising matter, publication of publicity texts, direct mail advertising; market surveys; outdoor advertising; business management assistance; demonstration of goods, distribution of samples; opinion polling; personnel recruitment; cost-price analysis; public relations'; Class 39: 'Transport; packaging and storage of goods; travel arrangement, including haulage; storage of goods, rental of storage and/or warehouses; delivery of goods; courier services'.

16. The Opposition Division considered, inter alia, that, following Ms Del Rio Rodríguez's request that Cactus prove that the earlier marks had been put to genuine use, the evidence submitted by the applicant showed genuine use of the earlier word mark for 'natural plants and flowers, grains; fresh fruits and vegetables; except cactuses, cactus seeds and, more generally, plants and seeds of the cactus family' in Class 31, and for 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35.

17. On 28 September 2011, Ms Del Rio Rodríguez filed an appeal against the Opposition Division's decision.

18. By decision of 19 October 2012 ('the contested decision'), the Second Board of Appeal of EUIPO upheld the appeal and dismissed the opposition in its entirety. In particular, it held that the Opposition Division had erred in considering that Cactus had adduced proof of genuine use of the earlier Cactus trade marks in respect of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35. More specifically, the Board of Appeal found that (i) those services were not covered by the earlier Cactus trade marks; (ii) although Cactus claimed use in respect of 'supermarket services', not only were those services not covered by the earlier Cactus trade marks but genuine use in respect of those services had not been demonstrated and (iii) the 'management of supermarkets or hypermarkets' in Class 35, which is covered by the earlier Cactus trade marks, corresponds to management services which are provided to third undertakings, with the result that that service should be regarded as different from retail services in terms of its nature, purpose and the end-users to whom it is directed. The Board of Appeal also considered that Cactus had not adduced proof, for the period between 14 December 2004 and 13 December 2009, of genuine use of the earlier Cactus trade marks for any of the goods or services covered by those marks.

III. Procedure before the General Court

19. By application lodged on 21 January 2013, Cactus claimed that the General Court should annul the contested decision.

20. In the judgment under appeal, the General Court annulled the contested decision in so far as the opposition was rejected on the ground that 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35 was not covered by the earlier Cactus trade marks and in relation to 'natural plants and flowers, grains' in Class 31, and dismissed the action for the remainder.

IV. Procedure before the Court and forms of order sought

21. By its appeal, lodged with the Court on 22 September 2015, EUIPO claims that the Court should:

– set aside the judgment under appeal;

– order Cactus to bear the costs.

22. Cactus claims that the Court should dismiss the appeal and order EUIPO to bear the costs.

23. The parties presented oral argument at the hearing held on 29 March 2017.

V. Analysis

24. EUIPO relies on two grounds in support of its appeal.

25. In its first ground of appeal, it claims that the judgment under appeal breaches Article 28 of the Trade mark regulation, read in conjunction with Rule 2 of the Implementing Regulation, because it equated the coverage of the class heading in Class 35 with all the services belonging to that class.

26. In the second ground, EUIPO claims that the judgment under appeal breaches Articles 42(2) and 15(1) of the Trade mark regulation because the General Court found that the use of the figurative element, namely, a logo depicting a stylised cactus, without the word element did not alter the distinctive character of the figurative trade mark as registered.

A. The first ground: can a trade mark cover retail services even if those services are not mentioned in the alphabetical list of Class 35 of the Nice Classification?

1. Introduction

27. This ground of appeal turns on the possibility of registering trade marks for retail services and the use of class headings to designate the goods and services covered by a trade mark. It also raises an important question regarding the impact of communications, published by EUIPO regarding its registration practice, on the extent of the protection afforded by a trade mark.

28. In a broader sense, this ground deals with the scope of the protection to be afforded to an earlier trade mark in circumstances where the general class headings of the Nice Classification have been employed to designate the products and services to be covered by the trade mark. After the registration of the earlier Cactus trade marks, the Court's case-law has limited the possibility for trade mark applicants of referring simply to general class headings in designating the products and services to be covered by the trade mark. It has also provided guidance on the conditions under which trade mark registrations for retail services can be allowed.

29. On the one hand, in *IP Translator*, the Court held that 'in order to respect the requirements of clarity and precision …, an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.'[9]

30. On the other hand, in *Praktiker*, the Court held that while a trade mark can cover retail services, 'the applicant must be required to specify the goods or types of goods to which those services relate' in the application.[10]

31. In the judgment under appeal, the General Court held that the Court's statement in *IP Translator* does not affect the extent of the protection afforded by the earlier Cactus trade marks and that the designation of the class heading of Class 35 covers 'all the services included in that class', including services consisting of the retail of goods. According to the General Court, the protection of the earlier Community trade marks extends to retail services concerning the trade of any product, since these marks were filed before the Court's judgment in *Praktiker*. For those reasons, the General Court concluded that the earlier Community trade marks are protected in respect of the services of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables'.[11]

9 *IP Translator*, paragraph 61.

10 *Praktiker*, paragraph 50.

11 Paragraphs 36 to 39 of the judgment under appeal.

32. According to EUIPO, the General Court wrongly applied the authority deriving from *IP Translator* and wrongly limited the application of the *Praktiker* judgment in relation to the earlier Cactus trade marks. In EUIPO's view, that amounts to a breach of Article 28 of the Trade mark regulation, read in conjunction with Rule 2 of the Implementing Regulation. Since neither retail services as such, nor the services of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' are included in the alphabetical list of Class 35, the earlier Cactus trade marks are not protected in respect of such services.

33. Cactus considers that EUIPO's complaints are misplaced and that the first ground of appeal should be dismissed as unfounded.

2. The EUIPO practice

34. As a preliminary point, it is useful to observe that the goods and services in respect of which Community trade marks are applied are classified in accordance with the common classification referred to in Article 1 of the Nice Agreement. In accordance with Rule 2 of the Implementing Regulation, the list of goods and services must be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified preferably in only one class of the Nice Classification.

35. Before the Court's judgment in *IP Translator*, EUIPO accepted trade mark applications that referred to one or several class headings without requiring any further indication as to which goods and services were to be covered by the trade mark applied for. More specifically, in that context, Communication No 4/03 of the President of the Office [12] explained the practice of the (then) Office for Harmonisation in the Internal Market in respect of class headings. On the one hand, the use of the general indications composing the class headings was allowed. None of them was regarded as too vague or indefinite. On the other hand, it was considered that the designation of the whole class heading of a given class covered all goods and services *potentially* falling within the class in question (the all-encompassing approach).

36. After the judgment in *IP Translator* was given on 19 June 2012, EUIPO replaced Communication No 4/03 with Communication No 2/12. [13] The latter establishes a distinction depending on the date on which the Community trade mark has been applied for. Regarding Community trade marks applied for on or after 21 June 2012, applicants are expressly to declare their intention of covering all the goods and services in the alphabetical list of a particular class. Regarding Community trade marks applied for before the cut-off date of 21 June 2012, the use of the general indications of a class heading is understood to entail the application extending to all the goods or services of the alphabetical list of a particular class. As mentioned above, such an application was in the past assumed to cover, in accordance with the all-encompassing approach, all the goods or services falling within a particular class.

37. As EUIPO points out, the distinction between, on the one hand, the goods or services in the alphabetical list of a particular class and, on the other hand, the goods or services potentially falling within that particular class is an important one. That is because not all possible goods and services falling under a given class are referred to in the alphabetical list.

38. That brings me to the impact of the Court's statement in *IP Translator* on the extent of the protection afforded by trade marks registered before the delivery of that judgment.

12 Communication No 4/03 of the President of the Office of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations.

13 Communication No 2/12 of the President of the Office of 20/06/2012 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations.

3. The case-law and its implications

(a) The judgment in IP Translator

39. The recent judgment in *Brandconcern*, handed down after the close of the written procedure in the present case, has clarified the purport of the Court's statement in *IP Translator* regarding trade marks registered before that judgment was handed down. [14]

40. Ruling on appeal, the Court held in *Brandconcern* that the Court's statement in *IP Translator* does not concern owners of trade marks which have already been registered, but solely (new) applicants for trade marks. More specifically, it held that the Court intended only to specify the requirements to which applicants for national trade marks are to be subject, who use the general indications of a class in order to identify the goods and services for which protection as a trade mark is sought. Those requirements are intended to ensure that it is possible to determine with certainty the scope of the protection afforded by a trade mark when a trade mark applicant uses all the indications included in a class heading. The Court also explained that *IP Translator* had no bearing on the validity of the approach set out in Communication No 4/03 as regards trade marks registered before the delivery of that judgment. [15]

41. In other words, the Court's statement was not held to be applicable to trade marks registered before the delivery of that judgment.

42. That conclusion must be equally valid here: the General Court cannot be faulted for having considered that the Court's statement in *IP Translator* does not impinge on the extent of the protection afforded by trade marks registered before the delivery of that judgment. [16]

43. The fact that, in Communication No 2/12, EUIPO adopted a new approach also in relation to trade marks registered before 21 June 2012 does not change that.

44. As noted above, on the basis of that Communication, EUIPO revised its practice with regard to previously registered trade marks: for those trade marks, the use of the general indications of a class heading was understood to mean that the protection afforded by the trade mark extended to all the goods or services in *the alphabetical list* of a particular class, rather than to all the goods or services (potentially) falling within the particular class, as had been the case before.

45. Quite simply, the extent of the protection afforded by trade marks that have been registered may not be altered on the basis of a non-binding communication. It would be contrary to the stability of registered trade marks [17] if EUIPO could, by dint of a communication, limit the coverage of trade marks already registered.

14 Judgment of 16 February 2017, *Brandconcern* v *EUIPO and Scooters India*, C-577/14 P, EU:C:2017:122.

15 Paragraphs 29 to 32.

16 Any other interpretation would render the amendment to Article 28 of Regulation No 207/2009 introduced by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21) devoid of purpose. On the basis of that regulation, a transitional provision was added to Article 28 which allows the proprietors of EU trade marks applied for before 22 June 2012 and registered in respect of the entire heading of a class of the Nice Classification to declare, before 24 September 2016, that their intention, at the date when the application was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of the heading, but included in the alphabetical list for that class.

17 See point 56 below.

46. In that regard, it should not be forgotten that the EUIPO communications at issue here are intended to explain and clarify the EUIPO practice in examining Community trade mark applications. They are not legally binding. At the time when the earlier Cactus trade marks were registered, EUIPO accepted the registration of trade marks for retail services in Class 35 and no limitation regarding the use of class headings to designate goods and services covered by the trade mark had been expressed in the relevant communications, or for that matter, in the case-law. [18]

47. Contrary to what EUIPO claimed at the hearing, what is stated above is not gainsaid by its reading of the *Brandconcern* judgment. It is certainly true that the Court not only held that its statement in *IP Translator* does not apply to trade marks that had already been registered, but also specifically validated the General Court's approach that an earlier trade mark referring to the relevant class heading (in that case, Class 12) was to be interpreted as seeking to protect that trade mark for all the goods in the *alphabetical list* of the relevant class, in accordance with the approach set out in Communication No 2/12 for trade marks registered before the delivery of the judgment in *IP Translator*. [19] In EUIPO's submission, that amounts to accepting that the use of a class heading in designating the products or services covered by the trade mark can extend only to the products or services referred to in the alphabetical list of a given class.

48. In that regard, I would simply observe that in *Brandconcern*, the question of a distinction between, on the one hand, the goods or services mentioned in the alphabetical list and, on the other hand, all the goods or services covered by the relevant class heading did not arise.

49. On appeal, the Court was asked to rule on whether the General Court was right to conclude that, while the proprietor of the earlier trade mark (LAMBRETTA) had obtained, in accordance with its application filed before the entry into force of Communication No 4/03, registration of its trade mark for 'vehicles; apparatus for locomotion by land, air or water' in Class 12, the owner had to be granted, on the basis of Communication No 2/12, protection for any of the goods listed in the alphabetical list relating to Class 12, in accordance with the intention of the owner. [20]

50. Consequently, *Brandconcern* does not constitute an authority validating EUIPO's approach in Communication No 2/12 in relation to the assumption that a trade mark registered before the cut-off date of 21 June 2012 can at most afford protection to the goods or services mentioned in the relevant alphabetical list. By the same token, *Brandconcern* should not be read as precluding, from the outset, that protection afforded by trade marks registered before the judgment in *IP Translator* was given could extend beyond the goods and services referred to in the alphabetical list of a given class.

51. Having clarified that, I shall now move on to discuss the reach of the Court's judgment in *Praktiker*.

18 EUIPO has accepted trade mark registrations for retail services since the adoption of Communication No 3/01 of the President of the Office of 12 March 2001 concerning the registration of Community trade marks for retail services. See judgment of 30 June 2004, *BMI Bertollo* v *OHIM — Diesel (DIESELIT)*, T-186/02, EU:T:2004:197, paragraph 42.

19 Judgment of 16 February 2017, *Brandconcern* v *EUIPO and Scooters India*, C-577/14 P, EU:C:2017:122, paragraph 32.

20 Judgment of 16 February 2017, *Brandconcern* v *EUIPO and Scooters India*, C-577/14 P, EU:C:2017:122, paragraphs 19 and 32. See also judgment of 30 September 2014, *Scooters India* v *OHIM — Brandconcern (LAMBRETTA)*, T-51/12, not published, EU:T:2014:844, in particular paragraphs 35 and 36. See also judgment of 31 January 2013, *Present-Service Ullrich* v *OHIM — Punt Nou (babilu)*, T-66/11, not published, EU:T:2013:48, paragraphs 49 and 50. In that case, the General Court held that a trademark applicant who has employed all the general indications listed in the class heading of Class 35 before Communication No 2/12 entered into force can be assumed to have intended to cover all the services included in the alphabetical list of that class. However, the General Court did not address the fact that the reference to the alphabetical list was not included in Communication No 4/03.

(b) The judgment in Praktiker

52. The question that arises here is whether the General Court was right to hold that, because the earlier Cactus trade marks were registered before the Court delivered its judgment in *Praktiker*, the protection afforded by those earlier marks extends to retail services concerning the trade of any product without there being a need to specify the goods or types of goods concerned by the retail service in question.

53. It is true, as EUIPO points out, that the limitation of the effect of the Court's judgments in time is not the rule, but the exception. EUIPO is also correct in pointing out that the Court did not specifically limit the effect in time of its judgment in *Praktiker*.

54. The exceptionality of limiting the temporal effects of judgments is the logical corollary of how the effects of the Court's judgments are deployed. The Court's judgments produce effects, as a matter of principle, *ex tunc*. According to the well-established formula, reiterated in the context of preliminary rulings under Article 267 TFEU, the interpretation that the Court gives to a rule of EU law clarifies and defines the meaning and scope of that rule as it must be or ought to have been understood and applied from the time of its entry into force. It follows that the rule thus interpreted may, and must, be applied even to legal relationships which arose and were established before the judgment ruling on the request for interpretation, provided that in other respects the conditions for bringing a dispute relating to the application of that rule before the competent courts are satisfied.[21] Accordingly, the Court limits the effects of its judgments only in exceptional circumstances.[22] In any event, the Court may do so only in the actual judgment ruling upon the interpretation sought.[23]

55. Having said that, the approach taken by the General Court is in my view warranted. The reason for that is simple.

56. It would be inconsistent to accept the application of the Court's statement in *Praktiker*, but not that in *IP Translator*, to already registered trade marks. Allowing the retroactive application of *Praktiker* in the present case would be not only inconsistent but also wrong. That is because the statement made in *Praktiker* is, like the judgment in *IP Translator*, inapplicable here. Both judgments deal with trade mark applications, whereas the issue that concerns the Court here turns on the scope of the protection afforded by a previously registered trade mark.

57. As Advocate General Campos Sánchez-Bordona pointed out in *Brandconcern*, there is an important difference between the two stages of application for and registration of trade marks. The interpretation of the list of goods and services contained in an application may still be amended in accordance with Article 43 of the Trade mark regulation. That is not the same as the interpretation of the list of goods and services covered by a trade mark which is already registered. Pursuant to Article 48 of the same regulation, a registered trade mark is, as a matter of principle, unchangeable.[24] To accept that a subsequent statement of the Court concerning trade mark applications has a bearing on the protection afforded by previously registered trade marks would undermine the stability of such trade marks. It would also be contrary to the principle of legal certainty and frustrate the legitimate expectations of trade mark owners.

58. Lastly, and by way of conclusion, I shall address a point raised by EUIPO at the hearing.

21 See, for example, judgments of 11 August 1995, *Roders and Others*, C-367/93 to C-377/93, EU:C:1995:261, paragraph 42 and the case-law cited, and of 6 March 2007, *Meilicke and Others*, C-292/04, EU:C:2007:132, paragraph 34 and the case-law cited.

22 The Court allowed the limitation of the temporal effects of its judgments, inter alia, in the recent judgment of 28 April 2016, *Borealis Polyolefine and Others*, C-191/14, C-192/14, C-295/14, C-389/14 and C-391/14 to C-393/14, EU:C:2016:311, paragraphs 101 to 111. See also judgment of 8 April 1976, *Defrenne*, 43/75, EU:C:1976:56.

23 See, among many, judgment of 9 March 2000, *EKW and Wein & Co*, C-437/97, EU:C:2000:110, paragraph 57.

24 Opinion of Advocate General Campos Sánchez-Bordona in *Brandconcern* v *EUIPO*, C-577/14 P, EU:C:2016:571, points 67 and 68.

(c) Concluding remarks

59. EUIPO pointed out that Cactus had not indicated before 24 September 2016, in accordance with Article 28(8) of the Trade mark regulation, that its intention, at the date when its application for the earlier Cactus trade marks was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of the class heading, but included in the alphabetical list for that class.

60. That is of course, in itself, of no consequence for the fate of this appeal.

61. However, the point made by EUIPO, and the ensuing comment by Cactus on the lack of such a declaration, serves to illustrate two points.

62. First, it shows that the legislature sought to align the protection afforded, in the future, to trade marks registered before the delivery of the Court's judgment in *IP Translator* with those registered after the delivery of that judgment.[25] Indeed, Article 28(8) of the Trade mark regulation states that EU trade marks for which no declaration has been filed by 24 September 2016 are to be deemed to extend, as from that date, only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

63. On the other hand, it is by no means clear to what extent the fact that the alphabetical list referred to in Class 35 does not expressly mention retail services is decisive for the purposes of determining whether trade marks such as the earlier Cactus trade marks can afford protection for retail services also. In fact, it does not appear entirely implausible to argue that, given the explanatory note to Class 35,[26] those services could be included in that class even under the literal approach.[27]

64. On the basis of all the above, I consider that it was without committing an error that the General Court held that the designation of the class heading of Class 35 covered all the services included in that class, including services consisting of the retail of goods. Accordingly, the first ground of appeal must be dismissed as unfounded.

B. The second ground: How is the distinctiveness of a trade mark to be assessed where that trade mark is employed in an abbreviated form?

1. Introduction

65. In the judgment under appeal, the General Court held that 'it should be noted that the earlier figurative mark is made up of a figurative element, namely a stylised cactus, followed by the word element "Cactus". The two elements comprising the earlier figurative mark therefore convey, in their respective forms, the same semantic content. It should be added that, both in the figurative mark registered and the abbreviated form of that mark, the representation of the stylised cactus is the same, with the result that the consumer equates the abbreviated form of that mark with its registered form. It

25 Judgment of 16 February 2017, *Brandconcern* v *EUIPO and Scooters India*, C-577/14 P, EU:C:2017:122, paragraph 33.

26 The explanatory note to the Nice Classification (7th edition, in force at the time when the applications for the earlier Cactus trade marks were lodged) states that the general class heading of Class 35 includes services which consist in the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods. See also Guidelines for examination of European Union trade marks, European Union Intellectual Property Office (EUIPO), Part B, Examination, Section 3, Classification, 1 August 2016, p. 4. In the guidelines, EUIPO explains that explanatory notes clarify which goods or services are meant or not meant to fall under the class headings and which are to be considered an integral part of the classification.

27 See *Praktiker*, paragraph 50. See also, to that effect, judgment of 10 July 2014, *Netto Marken Discount*, C-420/13, EU:C:2014:2069, paragraphs 33 to 36.

follows that the earlier figurative mark, as registered, and the mark, as used by the applicant in its abbreviated form, must be regarded as essentially equivalent. It must therefore be concluded that the applicant's use only of the stylised cactus does not alter the distinctive character of the earlier figurative mark.' [28]

66. Was the General Court right to hold that the use of the stylised logo depicting a cactus, without the word element 'Cactus', amounts to use 'in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered' within the meaning of Article 15(1) of the Trade mark regulation? That is the question the Court must resolve in examining the second ground of appeal.

67. EUIPO thinks not. It argues, in essence, that the General Court's conclusion is based on an incorrect criterion (namely, the semantic equivalence of the logo and the word element 'Cactus'). In its view, the General Court ought to have examined separately the distinctive character and importance of the omitted word element 'Cactus'.

68. More specifically, it identifies four errors in law in the judgment under appeal, which all relate to Article 15(1) of the Trade mark regulation. First, in basing its conclusion only on the semantic concordance between the logo and the word element, the General Court failed to examine to what extent the word element 'Cactus' was distinctive and important in the composite mark. Second, the General Court failed to have regard to the visual and (possible) phonetic differences between the logo and the composite mark. Third, it wrongly based its finding on the prior knowledge that the public in Luxembourg has of the earlier figurative trade mark. Fourth, in assessing the distinctiveness of the figurative trade mark, it failed to consider the perception of the European public as a whole.

69. Cactus submits that the second ground of appeal is inadmissible. In any event, it maintains that the General Court's reasoning is faultless.

2. The criteria for determining whether the use of a trade mark in an abbreviated form alters the distinctive character of the trade mark as registered

70. At the outset, I must express my doubts regarding the admissibility of at least two (of the four) arguments put forward by EUIPO in this ground of appeal. As is well known, the Court has no jurisdiction to reassess facts or evidence. It may not, as a rule, substitute its own assessment with that of the General Court. [29]

71. In my view, EUIPO's arguments relating to the consumers' perception of the earlier figurative mark and the relevant public (errors three and four) invite, implicitly, the Court to reassess the facts underlying the present case. The case-law considers such arguments inadmissible. [30] Indeed, the characteristics of the relevant public and the perception of consumers regarding the trade mark in question belong, as such, to the General Court's jurisdiction to assess the facts. [31]

28 Paragraph 61 of the judgment under appeal.

29 See amongst many, judgment of 2 September 2010, *Calvin Klein Trademark Trust* v *OHIM*, C-254/09 P, EU:C:2010:488, paragraph 49 and the case-law cited.

30 See, amongst many, judgment of 12 July 2012, *Smart Technologies* v *OHIM*, C-311/11 P, EU:C:2012:460, paragraph 52 and the case-law cited.

31 See, for example, judgments of 4 October 2007, *Henkel* v *OHIM*, C-144/06 P, EU:C:2007:577, paragraph 51, and of 12 July 2012, *Smart Technologies* v *OHIM*, C-311/11 P, EU:C:2012:460, paragraph 51 and the case-law cited.

72. Regarding the third alleged error, EUIPO argues that the General Court implicitly based its finding on the equivalence between the stylised cactus and the figurative trade mark, as registered, on the prior knowledge that consumers (in Luxembourg) may have of the element omitted. Regarding the fourth alleged error, EUIPO submits that if account had been taken of the perception of European consumers generally, the General Court could not have concluded as it did. Verifying the accuracy of those claims would clearly require reassessment of the facts and evidence submitted before — and assessed by — the General Court.

73. However, the two remaining arguments appear to be reviewable by the Court.[32] That is because they turn on the criteria to be employed in assessing whether the use of a trade mark in an abbreviated form alters the distinctive character of the registered trade mark.

74. Article 15(1)(a) of the Trade mark regulation allows the trade mark owner to make variations to the trade mark registered when that mark is exploited commercially. In accordance with that provision, variations are allowed in so far as the distinctive character of the trade mark is not altered. Accordingly, the purpose of the provision is to enable the owner to adapt better to the marketing and promotion requirements of the goods or services concerned. In that context, the Court has held that a registered trade mark has been put to genuine use 'where proof is provided of use of that mark in a slightly different form from that in which it was registered'.[33]

75. Generally speaking, whether the form in which the trade mark is used is essentially equivalent to the form in which it was registered requires an overall assessment of equivalence.

76. Nevertheless, the case-law does not provide clear guidance on how it is to be assessed whether the use of a trade mark in an abbreviated form alters the distinctive character of the registered trade mark. That case-law deals mostly with somewhat different configurations concerning, in particular, the addition of new conceptually distinct elements to the registered trade mark (or the use of the trade mark in an altered form). In that context, the General Court routinely considers that a finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the elements added, carried out on the basis of the intrinsic qualities of each of those elements, as well as of the relative position of the different elements within the arrangement of the trade mark.[34]

77. This appeal raises the question whether that is equally true where elements are omitted.

78. In my view, the answer to that question depends on the circumstances of each individual case.

79. Let us assume that Cactus had registered a figurative trade mark composed of two elements: a figurative element depicting a rose and a word element 'Cactus'. Let us also assume that Cactus had employed only the figurative element depicting a rose in exploiting the figurative trade mark in its commercial operations. In such circumstances, the distinctive and dominant character of the element omitted would have to be assessed in order for the impact of the omission on the distinctiveness of

32 Cf. Opinion of Advocate General Szpunar in *OHIM* v *Grau Ferrer*, C-597/14 P, EU:C:2016:2, point 111.

33 Judgment of 13 September 2007, *Il Ponte Finanziaria* v *OHIM*, C-234/06 P, EU:C:2007:514, paragraph 86.

34 Judgments of 10 June 2010, *Atlas Transport* v *OHIM — Hartmann (ATLAS TRANSPORT)*, T-482/08, not published, EU:T:2010:229, paragraphs 38 and 39, and of 14 July 2014, *Vila Vita Hotel und Touristik* v *OHIM — Viavita (VIAVITA)*, T-204/12, not published, EU:T:2014:646, paragraph 34 and the case-law cited. On the other hand, the Court has also held that use of a composite sign which is registered as a trade mark can maintain the rights acquired on both that composite sign and a part of it which is the subject of a distinct registration, provided this part remains perceived as a trade mark as such. See judgment of 18 April 2013, *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraphs 27 to 35.

the trade mark as registered to be determined. That is, in essence, because of the conceptual dissonance between the figurative element and the word element which comprise the registered trade mark. Indeed, in such a situation, the omission of one of the elements may have a bearing on distinctiveness. [35]

80. The situation is different here. The figurative element (the stylised cactus) and the word element (Cactus) refer to the same concept. Although I am doubtful whether it is correct to say that a logo and a word element have the same semantic content, as the General Court did, that does not alter the fact that the element omitted is conceptually equivalent to the figurative element which is used.

81. Despite the General Court not having declared its intention of conducting a global assessment of equivalence, it is clear to me that it did so in the contested paragraph of the judgment under appeal. Indeed, it compared the trade mark as used (stylised cactus) to the trade mark as registered (stylised cactus and the word element). It is that global assessment of equivalence that allowed it to conclude that the two marks were essentially equivalent. As Cactus points out, where the elements in question are conceptually equivalent, the distinctive character of the word element Cactus cannot be different from that conveyed by the figurative element of the trademark. In such a situation, examining separately the distinctiveness of the word element omitted would be superfluous.

82. For that reason, the General Court was right to hold that the use of the stylised cactus alone without the word element 'Cactus' does not alter the distinctive character of the earlier figurative trade mark. Accordingly, I am of the view that the second ground of appeal should be dismissed as partly inadmissible and partly unfounded.

VI. Conclusion

83. In the light of those considerations, I propose that the Court dismiss the appeal and order EUIPO to pay the costs.

35 See, regarding the analysis to be carried out, for example, judgments of 24 November 2005, *GfK* v *OHIM — BUS (Online Bus)*, T-135/04, EU:T:2005:419, paragraph 36 et seq., and of 21 January 2015, *Sabores de Navarra* v *OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraphs 35 to 42.