JUDGMENT OF THE COURT OF FIRST INSTANCE (Eighth Chamber)

28 October 2009 *

In Case T-137/08,

BCS SpA, established in Milan (Italy), represented by M. Franzosi, V. Jandoli and F. Santonocito, lawyers,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Botis, acting as Agent,

defendant,

* Language of the case: English.

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

Deere & Company, established in Wilmington, Delaware (United States), represented by J. Gray, Solicitor, and A. Tornato, lawyer,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 16 January 2008 (Case R 222/2007-2) relating to invalidity proceedings between BCS SpA and Deere & Company,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Eighth Chamber),

composed of M.E. Martins Ribeiro, President, N. Wahl (Rapporteur) and A. Dittrich, Judges,

Registrar: N. Rosner, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 9 April 2008,

having regard to the response of OHIM lodged at the Court Registry on 22 July 2008,

having regard to the response of the intervener lodged at the Court Registry on 29 July 2008,

further to the hearing on 11 March 2009,

gives the following

Judgment

Background to the dispute

1 On 1 April 1996, the intervener, Deere & Company, filed an application with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), 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 Community trade mark (OJ 2009 L 78, p. 1), for registration as a Community trade mark of the following sign:



2 The goods in respect of which registration was sought are in Classes 7 and 12 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, and correspond, for each of those classes, to the following description:

— Class 7: 'Attached, pushed or self-propelled agricultural and forestry machines';

— Class 12: 'Self-propelled agricultural and forestry machines, in particular farm tractors, small tractors, land tractors and trailers'.

3 The colours covered by the application for registration were designated using the Munsell system as: 9.47 GY3.57/7.45 (green) and 5.06 Y7.63/10.66 (yellow). The arrangement is described as being 'green for the vehicle body and yellow for the wheels', as is shown by a picture attached to the application and reproduced below:



4 On 20 November 2001, that mark was registered on behalf of the intervener ('the disputed mark').

5 On 5 January 2004, the applicant, BCS SpA, filed an application for a declaration of invalidity in respect of all the goods protected by the registration of the disputed mark, on the basis of Article 51(1)(a) in conjunction with Article 7(1)(b) of Regulation No 40/94 (now Article 52(1)(a) and Article 7(1)(b) of Regulation No 207/2009) and of Article 52(1)(c) in conjunction with Article 8(4) thereof (now Article 53(1)(c) and Article 8(4) of Regulation No 207/2009)).

6 In support of its application for a declaration of invalidity, the applicant maintained, first, that the disputed mark was devoid of any distinctive character on the day when the application for registration was filed and that there had been insufficient proof of distinctive character acquired through use for the purposes of Article 7(3) of Regulation No 40/94 (now Article 7(3) of Regulation No 207/2009).

7 Secondly, the applicant claimed that the disputed mark had been registered despite the existence of an Italian non-registered trade mark, also consisting of a combination of the colours green and yellow. The applicant maintained that the use of that mark before 1996 in relation to 'agricultural machines, in particular farm tractors, small tractors, land tractors and trailers' in Belgium, Denmark, Greece, Spain, France, Italy, the Netherlands, Austria, Portugal and the United Kingdom conferred on the applicant the right to prohibit the use of a subsequent trade mark.

8 By decision of 30 November 2006, the Cancellation Division of OHIM rejected the application for a declaration of invalidity on both grounds, finding, first, that the applicant had failed to rebut the validity of the evidence of distinctiveness acquired through use submitted by the intervener in accordance with Article 7(3) of Regulation No 40/94 and, secondly, that although the applicant had shown that it had used the colours yellow and green on various types of agricultural machinery before the filing date of the disputed mark, it had not proven that, before that date, that sign was perceived as an indication of commercial origin by the relevant public in the territories concerned.

9 On 2 February 2007 the applicant filed an appeal against the decision of the Cancellation Division on the grounds that the distinctiveness acquired through use of the disputed mark had not been assessed in relation to all the territories concerned and that, although the Cancellation Division had accepted that the applicant's sign had been used on the market, it had wrongly concluded that it was not perceived by the relevant public as an indication of origin.

10 By decision of the Second Board of Appeal of OHIM of 16 January 2008 ('the contested decision'), the appeal was dismissed in its entirety.

Procedure and forms of order sought

11 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

12 OHIM and the intervener contend that the Court should:

— dismiss the action in its entirety;

— order the applicant to pay the costs.

13 By decision of 5 March 2009, the Court invited the parties to submit any observations they might have on certain documents at the hearing.

Law

14 In support of its action the applicant relies on three pleas in law, alleging infringement of Article 7(3), Article 8(4) and Article 73 of Regulation No 40/94 (now Article 75 of Regulation No 207/2009).

The first plea, alleging infringement of Article 7(3) of Regulation No 40/94

Arguments of the parties

15 The applicant submits, first, that the Board of Appeal erred in law in not assessing whether the disputed mark (a combination of the colours green and yellow) had been used as a trade mark, in accordance with the conditions identified in the case-law. In support of that argument, the applicant maintains that the Board of Appeal failed to make an overall assessment of the items of evidence and merely examined them individually, without coordinating them or viewing them as a whole.

16 Secondly, the applicant claims that the Board of Appeal did not properly assess the evidence in the file, first, because the documents submitted did not cover the whole of the European Union or at least a substantial part thereof and, secondly, because the probative value of that evidence was weak either because it showed merely that the colours were used with a word mark or because it came from the intervener's commercial partners and not from independent sources which were representative of the consumers concerned.

17 According to the applicant, a particularly high standard of proof must be applied in examining whether the disputed mark has acquired distinctive character through use, since colours have no inherent distinctive character because they are primarily used on goods for decorative purposes and not for the purpose of indicating origin. That is all the more so where, as in the present case, they are primarily used with another distinctive indication to which the consumers concerned are likely to pay more attention.

18 Furthermore, the applicant submits that the Board of Appeal did not assess whether the relevant public had actually perceived the combination of the colours green and yellow, without an accompanying figurative or word mark, as an indication of the commercial origin of the goods in question. The administrative file contains only a market survey, relating to the perception of the relevant public in Germany, in which the distinctive character of the disputed mark is assessed.

19 Thirdly, the applicant maintains, first, that the data relating to sales volumes, advertising expenditure and market shares do not concern all the territories or are particularly weak for some of them and, secondly, that the statements made by the various associations do not refer to the intervener's exclusive use of the disputed mark, that they were made subsequent to the filing of the application for registration of the disputed mark and that they were not administered by a Notary Public.

20 At the hearing the applicant also submitted that the graphic representation of the disputed mark is of 'variable geometry', in the sense that it is neither clear nor specific and fails to satisfy the requirements laid down in the case-law.

21 OHIM and the intervener contend that this plea should be rejected. Furthermore, OHIM submitted, at the hearing, that the applicant's plea relating to the graphic representation of the disputed mark constituted a new plea and was therefore inadmissible.

Findings of the Court

— Admissibility of the claim raised at the hearing

22 The claim relating to the ambiguous graphic representation of the disputed mark concerns the application of Article 4 of Regulation No 40/94 (now Article 4 of Regulation No 207/2009) and Article 7(1)(a) of Regulation No 40/94 (now Article 7(1)(a) of Regulation No 207/2009). In its application, the applicant merely claimed that the Board of Appeal infringed Article 7(3), — which permits a derogation from Article 7(1)(b), (c) and (d) (Article 7(1)(c) and (d) are now Article 7(1)(c) and (d) of Regulation No 207/2009) — Article 8(4) and Article 73 of Regulation No 40/94.

23 It follows that the claim put forward by the applicant at the hearing relating to the disputed mark's conformity with the requirements of graphic representation does not amplify a plea made in the application, but constitutes a new plea in law introduced in the course of the proceedings. Consequently, that plea is inadmissible under Article 48(2) of the Rules of Procedure of the Court of First Instance.

— The merits of the plea alleging infringement of Article 7(3) of Regulation No 40/94

24 It is appropriate, first of all, to bear in mind the principles identified in the case-law relating to the application of Article 7(3) of Regulation No 40/94.

25 As regards the acquisition of distinctive character through use, it is apparent from the case-law that the identification, by the relevant class of persons, of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature and effect of it, which make it capable of distinguishing the product concerned from those of other undertakings (see, by analogy, Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 64).

26 In that regard, the expression 'use of the mark as a trade mark' must be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking (see, by analogy, Case C-353/03 *Nestlé* [2005] ECR I-6135, paragraph 29).

27 Furthermore, the acquisition of the distinctive character of a mark may be as a result of its use in conjunction with another registered trade mark or as part thereof (see, to that effect, Case C-488/06 P *L & D* v *OHIM and Sämann* [2008] ECR I-5725, paragraph 49 and the case-law cited).

28 It is also important to bear in mind that Article 7(3) of Regulation No 40/94 does not draw any distinction on the basis of the type of sign at issue. Consequently, colours or combinations of colours may per se acquire, for the goods or services in respect of which registration is sought, a distinctive character in consequence of the use which has

been made of them, by virtue of Article 7(3) of Regulation No 40/94 (see, to that effect, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraphs 78 and 79 and the case-law cited).

29 The distinctive character of a sign, including that acquired through use, must be assessed in relation, first, to the goods or services in respect of which registration of the mark is applied for and, secondly, to the presumed perception of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see, by analogy, *Philips*, paragraphs 59 and 63).

30 In that respect, the competent authority must make an overall assessment of the evidence that the sign applied for has come to identify the product concerned as originating from a particular undertaking (see, by analogy, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 49).

31 Furthermore, it is settled case-law that, for the purposes of assessing whether a mark has acquired distinctive character through use, the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see, by analogy, *Windsurfing Chiemsee*, paragraph 51; *Philips*, paragraph 60; and *Nestlé*, paragraph 31).

32 It is in the light of the above considerations that this plea must be examined.

33 As regards the claim that the Board of Appeal failed to make an overall assessment of the items of evidence and merely examined them individually, without viewing them as a whole, it is apparent from the contested decision that, although the Board of Appeal examined each item of evidence, it also found that all the evidence submitted by the intervener was 'consistent and mutually corroborative' (paragraph 33 of the contested decision).

34 It is also apparent from paragraphs 32, 36 to 38 and 41 of the contested decision that the Board of Appeal's finding concerning the acquisition of distinctive character is based, first, on the taking into account of a body of evidence proving the prolonged and intensive use of the disputed mark and, secondly, on the fact that that use enabled the target public to identify the commercial origin of the goods bearing that sign.

35 As regards the claim that the Board of Appeal erred in failing to assess whether the disputed mark had been used as a trade mark, it must be borne in mind that it is true that not every use of a sign, in particular the use of a combination of two colours, necessarily constitutes use as a trade mark (see paragraphs 25 and 26 above).

36 However, in the present case, in its assessment of the merits of the registration of the disputed mark, the Board of Appeal, in paragraphs 32 and 38 of the contested decision, took into account, inter alia, statements from professional associations according to which the combination of the colours green and yellow referred to agricultural machines manufactured by the intervener and the fact that the intervener had been using the same combination of colours on its machines consistently in the European Union for a considerable time prior to 1996.

37 Those two factors are sufficient to conclude that the use of the combination of the colours green and yellow was not purely stylistic, but enabled the relevant public to identify the commercial origin of the goods bearing that combination of colours. Consequently, the applicant's claim that the Board of Appeal infringed Article 7(3) of

Regulation No 40/94 in failing to assess whether the combination of the colours green and yellow had been used as a trade mark cannot be upheld.

38 The following must be pointed out as regards the claim that the evidence in the file of the Board of Appeal did not relate to all the Member States of the European Union as at 1 April 1996.

39 First, it is important to state that, although it must be proved that the disputed mark has acquired distinctive character throughout the Community (see, to that effect, Case C-25/05 P *Storck* v *OHIM* [2006] ECR I-5719, paragraph 83), the same types of evidence do not have to be provided in respect of each Member State.

40 The fact that, with the exception of Germany, the file did not contain any opinion poll designed to assess the way in which the disputed mark was perceived by the relevant public in the European Union cannot therefore give rise to the annulment of the contested decision.

41 The absence of an opinion poll does not preclude a sign's being shown to have acquired distinctive character through use, as other evidence may serve to show that that is the case (see paragraph 31 above). It is apparent from *Windsurfing Chiemsee* (paragraphs 49 to 53) that it is not absolutely necessary to carry out an opinion poll for the purposes of concluding that a sign has acquired distinctive character through use.

42 As regards the figures, the only ones not appearing in the Board of Appeal's file are the turnovers in Finland and Ireland. However, in respect of those two Member States and

the other Member States of the European Union as at 1 April 1996, the intervener had submitted detailed data to OHIM on its market shares and sales volumes from 1970 to 1996 and on those of its competitors.

43 As regards the claim that the market shares held by the intervener were too low to be capable of proving deep and long-lasting market penetration, the goods in question constitute industrial goods the price of which is high and the purchase of which is preceded by a process during which the consumer inquires attentively about the range on offer by comparing and inspecting the various competing models.

44 On such a market, it is not necessary for a mark to achieve a large market share for it to be possible to conclude that the relevant consumers have retained it in their minds. It is sufficient that the disputed mark be proved to have a strong and long-lasting presence on the market.

45 In the present case, it is apparent from the Board of Appeal's file, first, that the intervener had consistently been using the same combination of colours on all its agricultural machines in the European Union for a considerable period prior to 1996 and, secondly, that in the countries in which the applicant considers that the intervener's market share was particularly low the intervener's presence precedes the date of the application for registration by at least 30 years, since that presence goes back to 1966 in Austria, 1939 in Finland, 1949 in Greece and 1953 in Italy (paragraphs 5 and 38 of the contested decision). Those facts have not been disputed by the applicant.

46 It follows from the above that, although it is true that the disputed mark was used and promoted in conjunction with the word mark John Deere and that the intervener's advertising expenditure in the European Union was presented as a whole and not individually for each country, the applicant is wrong to claim that it was not proved to the required legal standard that the intervener had used the combination of the colours green and yellow on its goods as a trade mark and that the market penetration of its goods had been deep and long-lasting in all the Member States of the European Union as at 1 April 1996.

47 Consequently, it must be examined whether that use and that market penetration were sufficient to enable the relevant public to identify, through the disputed mark, the commercial origin of the goods covered.

48 In that regard, the applicant questions the relevance and the probative value of the statements from the various associations, which were taken into account by the Board of Appeal. It criticises the fact that those statements were not made spontaneously, that their content was dictated or at least coordinated by the intervener, that they did not refer to the exclusive use of the disputed mark by the intervener, that they were made after the reference period and were not made before a notary public and that the bodies making the statements were neither representative of the relevant public nor independent, since they were for the most part the intervener's trading partners.

49 As regards the date of the statements, the fact that they were signed in 2000 does not mean that they are devoid of evidential value for the purposes of assessing the acquisition of distinctive character through use as at the date when the application for registration of the disputed mark was filed (see, to that effect, judgment of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland* v *OHIM and Cornu*, not published in the ECR, paragraph 53). Furthermore, Article 51(2) of Regulation No 40/94 (now Article 52(2) of Regulation No 207/2009) prohibits the registration of the disputed mark from being declared invalid if it is proved that it acquired distinctive character before the date of the application for a declaration of invalidity, in the present case, 5 January 2004. Consequently, the applicant's claim that the statements submitted are not relevant, since they do not necessarily relate to the period before 1 April 1996, is, in any event, ineffective.

50 As regards the issue of the absence of spontaneity on the part of the associations and of the intervener's role in the drawing up of the statements submitted, it is important to point out that the fact that those statements were made following a request by the intervener and that the intervener may have coordinated the preparation of those statements does not, in itself, cast doubt on their content and evidential value.

51 In the absence of evidence to the contrary, it must be assumed that each association signed its statement of its own free will and takes responsibility for the content. Furthermore, the evidential value of a statement cannot be denied on the ground that it was not made before a notary public (judgment of 10 September 2008 in Case T-325/06 *Boston Scientific* v *OHIM — Terumo (CAPIO)*, not published in the ECR, paragraph 41).

52 Furthermore, it is important to point out that the applicant's claim that the statements from distributors of agricultural machines and from associations of manufacturers of agricultural machines are not reliable cannot be upheld.

53 First, it is not at all apparent from the case-law that only statements made by associations representing consumers may be taken into account. On the contrary, the wording used in that regard by the Court of Justice, namely 'statements from chambers of commerce and industry or other trade and professional associations' (*Windsurfing Chiemsee*, paragraph 51), also includes statements from associations of manufacturers and/or distributors.

54 Accordingly, in the present case, it is necessary to ascertain only whether the various associations which made statements may be regarded as independent and were thus able to make their statements without taking the intervener's particular interest into account.

55 As regards the farmers' associations and the associations of manufacturers of agricultural machinery, whose fundamental objective is to safeguard and promote the interests of the sector which they represent and organise, the applicant has not submitted any evidence to show their partiality or their interest in the intervener's obtaining the registration of a mark to which it has no right. Accordingly, the Board of Appeal was fully entitled to take the statements from those associations into account.

56 As regards the independence of the bodies which acted as distributors for the intervener in Finland and Italy, it is sufficient to state that their statements only corroborate those of the association of manufacturers of agricultural machinery in Italy and of the association representing farmers in Finland. As was stated in paragraph 55 above, the applicant has not submitted any evidence capable of calling the evidential value of the statements of those two associations into question. It follows that the Board of Appeal's taking into account of the statements of the Finnish and Italian distributors cannot result in the annulment of the contested decision.

57 As regards the argument that the statements do not prove the intervener's 'exclusive use' of the disputed mark, it must be pointed out that it is the association that the public makes between the mark and a commercial origin, and not the exclusive use of the mark, that is relevant.

58 In the present case, with the exception of those relating to Ireland and Denmark, the statements of the various associations state that the combination of the colours green and yellow, used in relation to agricultural machinery, is associated, in the sector concerned, with the intervener. The opinion poll in Germany corroborates that assertion.

59 As regards Ireland and Denmark, the statements submitted show that the above-mentioned combination of colours is associated with the goods of a number of manufacturers and not solely with those of the intervener. However, that cannot result in the annulment of the contested decision.

60 First, the Board of Appeal assessed whether the disputed mark had acquired distinctive character on the basis of a body of evidence, inter alia the statements of various associations and the opinion poll carried out in Germany, and on the fact that the intervener's goods have had a strong presence on all the relevant markets for a significant period and that the intervener had, in an intensive and sustained manner, used the combination of the colours green and yellow as a mark on those goods.

61 Secondly, it is important to state that it is apparent from paragraph 5 of the contested decision that the intervener has been present on the Danish market since 1947 and on the Irish market since 1951. Furthermore, it is apparent from the Board of Appeal's file that the intervener has had a strong presence on those two markets since 1970, which is comparable to its presence in a number of other Member States of that time.

62 Consequently, the Board of Appeal cannot be criticised for having concluded that it had been proved to the required legal standard that the disputed mark had become distinctive within the terms of Article 7(3) of Regulation No 40/94 as at 1 April 1996, the date on which the application for registration of the disputed mark was filed.

63 It follows from all of the foregoing that the applicant's first plea cannot be upheld.

The second and third pleas, alleging infringement of Article 8(4) and Article 73 of Regulation No 40/94 respectively

Arguments of the parties

64 In the context of its second and third pleas, the applicant submits, in essence, that the criteria applied in the contested decision with regard to its Italian non-registered mark covering the colours green and yellow were stricter than those applied in the examination of the application for registration of the disputed mark, although the circumstances under which rights in the mark were acquired are essentially the same in both cases. Consequently, the Board of Appeal infringed not only Article 8(4) of Regulation No 40/94, but also Article 73 of that regulation inasmuch as its reasoning was insufficient and contradictory.

65 OHIM and the intervener contend that those pleas should be rejected.

Findings of the Court

66 It must be held that the plea alleging infringement of Article 73 of Regulation No 40/94 is unfounded.

67 It is apparent from the case-law that the statement of reasons required under Article 73 of Regulation No 40/94 must show in a clear and unequivocal manner the reasoning of the author of the act. That duty has two purposes: to allow interested parties to know the justification for the measure so as to enable them to protect their rights and to enable the Community judicature to exercise its power to review the legality of the decision (see judgment of 21 November 2007 in Case T-111/06 *Wesergold Getränkeindustrie* v *OHIM — Lidl Stiftung (VITAL FIT)*, not published in the ECR, paragraph 62 and the case-law cited).

68 It must also be borne in mind that a contradiction in the statement of the reasons on which a decision is based constitutes a breach of the obligation laid down in Article 73 of Regulation No 40/94 such as to affect the validity of the measure in question if it is established that, as a result of that contradiction, the addressee of the measure is not in a position to ascertain, wholly or in part, the real reasons for the decision and, as a result, the operative part of the decision is, wholly or in part, devoid of any legal justification (see, to that effect, Case T-5/93 *Tremblay and Others* v *Commission* [1995] ECR II-185, paragraph 42).

69 In the present case, the applicant does not claim that it was not in a position to ascertain the reasons why the Board of Appeal adopted the contested decision. Rather it submits that the Board of Appeal assessed comparable items of evidence in different ways and that it consequently drew divergent conclusions from similar evidence. However, such

an approach, even if it were proved, cannot constitute infringement of Article 73 of Regulation No 40/94, but only of Article 8(4) of that regulation.

70 As regards the alleged infringement of Article 8(4) of Regulation No 40/94, the applicant claims that the Board of Appeal concluded that it had not acquired a de facto trade mark right on the Italian market, even though the colours of its sign were identical to those of the disputed mark, the evidence adduced was of the same, if not greater, value and the conditions for the acquisition of a secondary meaning were the same.

71 In that context, it must be pointed out that the standard of proof required of the applicant under Article 8(4) of Regulation No 40/94 corresponds to that required of the intervener under Article 7(3) of that regulation.

72 However, clearly, in the present case, it is apparent from the uncontested facts that the evidence submitted by the applicant before the Board of Appeal was, on the whole, of less evidential value than that submitted by the intervener.

73 First, it is common ground between the parties that the applicant ceased, at least from 1973 to 1982, to use the combination of the colours green and yellow on its goods in Italy. Although it would have been possible for the applicant to acquire a non-registered right in its sign through the use from 1983 to 1996 it did not do so. It is also apparent from the findings made in paragraphs 45 and 46 of the contested decision, which the applicant does not dispute, that it did not use the combination of the colours green and yellow in a consistent and uniform manner. On the contrary, it used a number of shades of green and yellow as well as a combination of the colours green and white.

74 It follows that the suspension of use of the combination of the colours green and yellow as a mark and the varying use of those colours were liable to prevent the public from systematically associating the applicant with a specific combination of colours.

75 Secondly, the Board of Appeal was fully entitled to regard the evidential value of declarations made by former employees of the applicant as questionable. As is apparent from paragraphs 46 and 54 of the contested decision, those declarations were not corroborated by other evidence in the file and they were even partially disproved.

76 Thirdly, the Board of Appeal cannot be criticised for having found that the market survey submitted by the applicant was not persuasive. In that regard the Board of Appeal was fully entitled to point out, in paragraphs 57 and 58 of the contested decision, that the participants in that survey, contrary to that carried out by the intervener, had not been asked for their reasons for giving a particular response and had not been shown a different image in a different colour in order to ensure that they did not recognise the image because of criteria other than the colour. Those facts are not disputed by the applicant. Consequently, it cannot be ascertained whether, at the end of the applicant's survey, the participants recognised the applicant's goods solely as a result of their colours and not as a result of their shape or other factors.

77 It must also be stated that the Board of Appeal was fully entitled to find that the evidential value of the applicant's survey was noticeably lower than that of the survey submitted by the intervener, since the respondents in the applicant's survey had been asked to recreate from memory their perception of the marks 10 years previously.

78 It is apparent from the foregoing that the second and third pleas must be rejected.

79 The action is therefore dismissed.

Costs

80 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs in accordance with the form of order sought by OHIM and the intervener.

On those grounds,

THE COURT OF FIRST INSTANCE (Eighth Chamber)

hereby:

1. Dismisses the action;

2. Orders BCS SpA to pay the costs.

Martins Ribeiro Wahl Dittrich

Delivered in open court in Luxembourg on 28 October 2009.

[Signatures]