Reports of Cases

JUDGMENT OF THE COURT (Second Chamber)

5 April 2017 [1]

(Appeal — EU trade mark — Invalidity proceedings — Regulation (EC) No 207/2009 — Article 8(4) — Article 65(1) and (2) — Word mark LAGUIOLE — Application for a declaration of invalidity based on a prior right acquired pursuant to national law — Application of national law by EUIPO — Role of the EU Courts)

In Case C-598/14 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 A. Folliard-Monguiral, acting as Agent,

appellant,

the other parties to the proceedings being:

**Gilbert Szajner**, residing in Saint-Maur-des-Fossés (France), represented by A. Sam-Simenot, avocate,

applicant at first instance,

**Forge de Laguiole SARL**, established in Laguiole (France), represented by F. Fajgenbaum, avocate,

intervener at first instance,

THE COURT (Second Chamber),

composed of M. Ilešič, President of the Chamber, A. Prechal (Rapporteur), A. Rosas, C. Toader and E. Jarašiūnas, Judges,

Advocate General: J. Kokott,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after hearing the Opinion of the Advocate General at the sitting on 1 December 2016,

gives the following

1 — Language of the case: French.

## 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 21 October 2014, *Szajner* v *OHIM — Forge de Laguiole (LAGUIOLE)* (T-453/11, EU:T:2014:901; 'the judgment under appeal'), by which the General Court annulled in part the decision of the First Board of Appeal of EUIPO of 1 June 2011 (Case R 181/2007-1), relating to invalidity proceedings between Forge de Laguiole SARL and Mr Gilbert Szajner ('the decision at issue').

## Legal context

### *European Union law*

*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 [European Union] trade mark (OJ 2009 L 78, p. 1). The provisions of Articles 8, 52 and 63 of Regulation No 40/94 were reproduced, without any substantial modification, in Articles 8, 53 and 65 of Regulation No 207/2009.

3 Article 8(4) of Regulation No 207/2009 provides:

'Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to [EU] legislation or the law of the Member State governing that sign:

(a) rights to that sign were acquired prior to the date of application for registration of the [EU] trade mark, or the date of the priority claimed for the application for registration of the [EU] trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.'

4 Article 53(1)(c) of Regulation No 207/2009 provides:

'[An EU] trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

…

(c) where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled.'

5 Article 65(1) and (2) of Regulation No 207/2009 provides:

'1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the [TFEU], of this Regulation or of any rule of law relating to their application or misuse of power.'

*The implementing regulation*

6 Rule 37(b)(iii) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 (OJ 1995 L 303, p. 1) ('the implementing regulation') provides:

'An application to the Office for revocation or for a declaration of invalidity … shall contain:

…

(b) as regards the grounds on which the application is based,

…

(iii) in the case of an application pursuant to Article [53] of Regulation [No 207/2009], particulars of the right on which the application for a declaration of invalidity is based and particulars showing that the applicant is the proprietor of an earlier right as referred to in Article [53] of Regulation [No 207/2009] or that he is entitled under the national law applicable to lay claim to that right.'

***French law***

7 Article L. 711-4 of the Code de la propriété intellectuelle (Intellectual Property Code) ('IPC') is worded as follows:

'A sign may not be adopted as a trade mark if it interferes with prior rights, in particular:

…

(b) a business name or corporate name, if there is a likelihood of confusion on the part of the public;

…'

8 Article L. 714-3 of the IPC provides:

'The registration of a trade mark which is not in accordance with the provisions of Articles L. 711-1 to L. 711-4 shall be declared invalid by court order.

…

Only the proprietor of a prior right may raise an action for annulment on the basis of Article L. 711-4. However, his action shall not be admissible if the application for registration of the trade mark was filed in good faith and he has acquiesced in its use for a period of five years.

The annulment has absolute effect.'

**Background to the dispute and the decision at issue**

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

'1 ... [Mr Szajner] is the proprietor of the [EU] word mark LAGUIOLE, which was applied for on 20 November 2001 and registered on 17 January 2005 by [EUIPO] under Regulation [No 40/94, codified by Regulation No 207/2009].

2 ... The goods and services in respect of which the trade mark LAGUIOLE is registered are in, inter alia, Classes 8, 14, 16, 18, 20, 21, 28, 34 and 38 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended …

…

3 On 22 July 2005, … Forge de Laguiole SARL filed an application for a declaration of partial invalidity in respect of the trade mark LAGUIOLE under Article 52(1)(c) of Regulation No 40/94, in conjunction with Article 8(4) of that regulation (now Articles 53(1)(c) and 8(4) of Regulation No 207/2009).

4 The application for a declaration of invalidity was based on the business name Forge de Laguiole, which was used by [that company] for the "manufacture and sale of all cutlery articles, scissors, gift articles and souvenirs — all tableware-related articles". According to [Forge de Laguiole SARL], this business name — which is of more than mere local significance — entitles it under French law to prohibit the use of a subsequent trade mark.

5 The application for a declaration of partial invalidity was directed against all of the goods and services referred to in paragraph 2 above.

6 By decision of 27 November 2006, the Cancellation Division [of EUIPO] rejected the application for a declaration of invalidity.

7 On 25 January 2007 [Forge de Laguiole SARL] filed a notice of appeal with [EUIPO], under Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009), against the Cancellation Division's decision.

8 By [the decision at issue], the First Board of Appeal of [EUIPO] upheld the appeal in part and declared that the trade mark LAGUIOLE was invalid for the goods in Classes 8, 14, 16, 18, 20, 21, 28 and 34. It dismissed the appeal as regards the services in Class 38.

9 In particular, the Board of Appeal took the view that, under French case-law, the protection enjoyed by a business name extended, as a matter of principle, to all of the business activities covered by the objects of the company, but that in cases where those objects were vague or the activities pursued were not covered by them, the protection was limited to the activities actually and specifically pursued. In the present case, the objects of [Forge de Laguiole SARL] were sufficiently clear as regards the "manufacture and sale of all cutlery articles, scissors". The Board of Appeal also stated that, even if it were to be conceded that the wording of the objects of the company ("manufacture and sale of all gift articles and souvenirs — all tableware-related articles") was vague, the business name of [Forge de Laguiole SARL] deserved protection, at least in the sectors in which it had actually pursued its business activities prior to the filing of the application for registration of the trade mark LAGUIOLE.

10 The Board of Appeal considered, in this regard, that [Forge de Laguiole SARL] had demonstrated that it had carried on a business activity, prior to the filing of the application for registration of the trade mark LAGUIOLE, involving the trade in goods coming under "tableware", "homeware", the wine sphere, scissors and articles for smokers, golfers, hunters and for leisure, as well as other accessories. By contrast, [Forge de Laguiole SARL] had failed to demonstrate that it had carried on a business activity in respect of luxury goods and travel articles, which, moreover, were not covered by its objects. Lastly, the Board of Appeal considered that, except for telecommunication services in Class 38, all of the goods covered by that trade mark encroached upon [Forge de Laguiole SARL's] business sectors or were situated in related business sectors.

…’

## The procedure before the General Court and the judgment under appeal

10 By application lodged at the Registry of the General Court on 8 August 2011, Mr Szajner brought an action for annulment of the decision at issue, relying on a single plea in law, alleging infringement of Article 53(1)(c) of Regulation No 207/2009, read in conjunction with Article 8(4) thereof.

11 The General Court upheld that single plea and annulled the decision at issue in so far as the Board of Appeal of EUIPO had found that there was a likelihood of confusion between the business name ‘Forge de Laguiole’ and the trade mark LAGUIOLE in respect of goods other than those which corresponded to the activities actually pursued under that business name as on the date of the application for registration of the contested mark. It dismissed the action as to the remainder.

12 In particular, the General Court found, in paragraphs 23 to 25 of the judgment under appeal, that the reliance, by Mr Szajner, on the judgment of the Cour de cassation (Court of Cassation, France) of 10 July 2012 (No 08-2012.010; ‘the judgment of 10 July 2012’) as evidence, for the first time at the stage of the oral procedure, was admissible, as the application of Article L. 711-4 of the IPC by EUIPO may be reviewed by the General Court in the light of a judgment of an national court which postdates the adoption of the decision of EUIPO and is relied on by a party to the proceedings.

13 In that regard, the General Court took the view, in paragraphs 43 to 50 of the judgment under appeal, that the business name enjoyed protection only for ‘business activities actually pursued by the company and not those listed in its articles of association’, as the Cour de cassation (Court of Cassation) held in the judgment of 10 July 2012. According to the General Court, that judgment is applicable in the context of disputes relating to the application of Article L. 711-4 of the IPC, even though the context in which it was delivered was different. The General Court stated that it mattered little that that judgment had been delivered at a date after that of the adoption of the decision at issue, since it merely ‘clarified a disputed legal issue’ and that, in any event, departures from precedent apply retroactively to existing situations.

14 The General Court thereby concluded, in paragraph 51 of the judgment under appeal, that the protection of the business name ‘Forge de Laguiole’ exclusively covered the business activities actually pursued under that name as on the date of the application for registration of the contested mark, namely 20 November 2001.

15 In paragraph 78 of that judgment, the General Court noted that, according to French case-law, the assessment of the likelihood of confusion depends on several factors, including the degree of similarity (visual, phonetic and conceptual) between the signs at issue, the degree of similarity between the economic sectors covered by those signs, and the more or less high level of distinctiveness of the earlier sign.

16 Given the degree of similarity between, first, the signs at issue, and, second, the goods and business sectors of the parties, the General Court confirmed, in paragraph 166 of the judgment under appeal, that there was a likelihood of confusion for ‘hand tools and implements (hand-operated); spoons; saws, razors, razor blades; shaving cases; nail files and nail nippers, nail-clippers; manicure sets’ in Class 8, ‘paper-cutters’ in Class 16, ‘corkscrews; bottle-openers’ and ‘shaving brushes, fitted vanity cases’ in Class 21, and ‘cigar cutters’ and ‘pipe cleaners’ in Class 34. It annulled the decision of the Board of Appeal of EUIPO in so far as it had found that such a likelihood existed for other goods.

**Forms of order sought by the parties**

17 EUIPO claims that the judgment under appeal should be set aside and that Mr Szajner should be ordered to pay the costs.

18 Forge de Laguiole SARL ('Forge de Laguiole') requests the Court to grant the form of order sought by EUIPO in its entirety.

19 Mr Szajner contends:

— that all the orders sought and grounds of appeal submitted by EUIPO and Forge de Laguiole should be declared inadmissible;

— in the alternative, that they should be declared unfounded;

— that the appeal should be dismissed;

— that it should be declared unnecessary to set aside the judgment under appeal; and

— that EUIPO should be ordered to pay the costs.

**The appeal**

20 In support of its appeal, EUIPO relies on two grounds, the first alleging infringement of Article 65(2) of Regulation No 207/2009, and the second alleging infringement of Article 8(4) of that regulation, read in combination with Article L. 711-4 of the IPC.

21 Mr Szajner contends, as his principal argument, that EUIPO's appeal and the form of order sought by Forge de Laguiole are inadmissible. In the alternative, he argues that the grounds relied on in support of that appeal must be rejected as unfounded.

***Admissibility***

22 Mr Szajner argues that the appeal is inadmissible by reason of EUIPO's lack of *locus standi*. In particular, he submits, its dual role as judge and appellant in this appeal manifestly disregards the principle of judicial independence, impartiality and neutrality, the principle of legitimate expectations and, consequently, the right to a fair trial. In any event, he submits, that appeal is inadmissible, since, first, the judgment under appeal does not directly affect EUIPO's interests and, second, the grounds relied on by it in relation to the judgment of 10 July 2012 alter the terms of the dispute.

23 In this regard, it is appropriate to recall, in the first place, that, in accordance with Article 172 of the Rules of Procedure of the General Court, the action brought before the General Court against a decision of a Board of Appeal of EUIPO is brought against EUIPO, as defendant. Moreover, under the second paragraph of Article 56 of the Statute of the Court of Justice of the European Union, while an appeal may be brought by any party which has been unsuccessful, in whole or in part, in its submissions, interveners other than the Member States and the EU institutions may bring such an appeal only where the decision of the General Court directly affects them.

24 Given that EUIPO acted, in this case, as defendant and not as intervener at first instance, and that it was unsuccessful in part, its *locus standi* and its interest in bringing the appeal are indisputable, and in no way does EUIPO need, in that regard, to demonstrate that the General Court's decision affects it directly.

25 It also follows from the foregoing that, contrary to what Mr Szajner contends, it cannot be accepted that EUIPO has, in any way whatsoever, a 'dual role as judge and appellant'.

26 In the second place, it should be recalled that, as is apparent from paragraph 9 of the present judgment, the interpretation of French law was already the subject matter of the dispute between the parties to the proceedings before the Board of Appeal of EUIPO. Thus, the line of argument put forward by EUIPO relating to the judgment of 10 July 2012 cannot constitute an expansion of the subject matter of the dispute between the parties to the proceedings before EUIPO.

27 Consequently, it is necessary to reject the plea of inadmissibility raised by Mr Szajner against EUIPO's appeal.

***Admissibility of the form of order sought by Forge de Laguiole***

28 Mr Szajner disputes the admissibility of the form of order sought by Forge de Laguiole in so far as, since it does not merely seek, contrary to what Article 174 of the Rules of Procedure of the Court provides, to have EUIPO's appeal allowed or dismissed, in whole or in part, but to have the judgment under appeal set aside, that form of order constitutes, in reality, a cross-appeal, which, in accordance with Article 176 of those rules, ought to have been introduced by a separate document.

29 However, it is clear from the response of Forge de Laguiole that that response is submitted in support of the grounds relied on by EUIPO and that, accordingly, that company has requested that the appeal be allowed.

30 It follows that the plea of inadmissibility raised by Mr Szajner in respect of the form of order sought by Forge de Laguiole must also be rejected.

***The first ground of appeal, alleging infringement of Article 65(2) of Regulation No 207/2009***

*Arguments of the parties*

31 By its first ground of appeal, EUIPO, supported by Forge de Laguiole, criticises the General Court for disregarding the scope of its review of the legality of the decisions of the Board of Appeal of EUIPO, by carrying out an assessment of the judgment of 10 July 2012, despite the fact that that judgment was later in time than the Board of Appeal's decision.

32 In this regard, EUIPO argues that, as on the date of the decision at issue, the case-law of the French courts was laid down by the judgment of the Cour de cassation (Court of Cassation) of 21 May 1996 (No 94-16531; 'the judgment of 21 May 1996'), in which that court, in the context of an action seeking prohibition of the use of a more recent trade mark, took into consideration the objects of the applicant without taking into account the business activity which it actually pursued. Even though, in paragraph 46 of the judgment under appeal, the General Court inferred, from decisions delivered after the judgment of 21 May 1996 by lower French courts, an indication that the case-law had evolved in a direction contrary to that followed by the Board of Appeal of EUIPO, the General Court did not identify those decisions and, therefore, failed to comply with the obligation to state reasons.

33 Given that the General Court found, in paragraph 50 of the judgment under appeal, that the judgment of 10 July 2012 was 'as such, a new matter of fact', the legality of the decision at issue should not, according to EUIPO, have been reviewed in the light of the latter judgment, which that Board of Appeal was not entitled to take into account.

34 Mr Szajner argues that the General Court was right to find, in paragraphs 21 to 25 of the judgment under appeal, that the judgment of 10 July 2012 had to be taken into account as evidence, a fortiori as that judgment had been the subject of an exchange of arguments before the General Court.

*Findings of the Court*

35 It is appropriate first of all to recall, as regards the allocation of the various roles between the applicant for a declaration of invalidity, the competent bodies of EUIPO and the General Court, first, that Rule 37 of the implementing regulation provides that the applicant must provide particulars showing that he is entitled under the national law applicable to lay claim to an earlier right protected under national law. That rule requires the applicant, in order to be able to have the use of an EU trade mark prohibited by virtue of an earlier right, to provide EUIPO with, not only particulars showing that he satisfies the necessary conditions under the national law which he seeks to have applied, but also particulars establishing the content of that law (see, to that effect, judgments of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraphs 49 and 50, and of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraph 34).

36 Second, as regards, more specifically, EUIPO's obligations, the Court has held that, where an application for an EU trade mark to be declared invalid is based on an earlier right protected by a rule of national law, the competent EUIPO bodies must first assess the authority and scope of the particulars submitted by the applicant in order to establish the content of that rule (judgments of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraph 51, and of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraph 35). In addition, since the decision of the competent EUIPO bodies may have the effect of depriving the proprietor of the trade mark of a right that has been granted to him, the scope of such a decision necessarily implies that the authority which takes it is not limited to the role of mere validation of the national law as submitted by the applicant for a declaration of invalidity (judgment of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraph 43).

37 Third, in accordance with Article 65(1) and (2) of Regulation No 207/2009, the General Court has jurisdiction to conduct a full review of the legality of EUIPO's assessment of the particulars submitted by an applicant in order to establish the content of the national law whose protection he claims (see, to that effect, judgments of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraph 52, and of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraph 36).

38 Furthermore, in so far as the application of national law, in the procedural context in question, may have the effect of depriving the proprietor of an EU trade mark of his right, it is essential that the General Court is not deprived, notwithstanding possible lacunae in the documents submitted as evidence of the applicable national law, of the real possibility of carrying out an effective review. To that end, it must therefore be able to confirm, beyond the documents submitted, the content, the conditions of application and the scope of the rules of law relied upon by the applicant for a declaration of invalidity. Consequently, the judicial review conducted by the General Court must meet the requirements of the principle of effective judicial protection (judgment of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraph 44).

39 Next, it is important to stress that the review by EUIPO and by the General Court must be conducted in the light of the need to ensure the practical effect of Regulation No 207/2009, which is to protect the EU trade mark (see, to that effect, judgment of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraph 40).

40 As the Advocate General pointed out in point 49 of her Opinion, if the General Court were to restrict itself to applying the national law as it was interpreted by the national courts at the time of the decision by the Board of Appeal of EUIPO, this could result in the refusal to register an EU trade mark or its revocation, even though the relevant national law does not provide, as of the time at which the General Court issues its decision, any basis for so doing.

41 That result would run counter not only to the requirement of ensuring the practical effect of Regulation No 207/2009, recalled in paragraph 39 of the present judgment, but also, by depriving the General Court of the real possibility of conducting in an effective manner the full review of legality mentioned in paragraphs 37 and 38 of this judgment, to the principle of effective judicial protection.

42 It follows that, in assessing the protection granted by national law, the General Court must apply a rule of national law as interpreted by the national courts at the time at which it issues its decision. It must therefore also be able to take into consideration a decision originating from a national court, issued after the adoption of the decision of the Board of Appeal of EUIPO.

43 It is true that the taking into consideration of a decision of a national court issued after the adoption of the decision of the Board of Appeal of EUIPO could lead the General Court to undertake an assessment of a rule of national law which differs from that of that Board of Appeal. However, since the judicial review of the assessment of national law by that Board of Appeal, conducted by the General Court, would be a full review of legality, the fact — revealed after the adoption of the decision of the same Board of Appeal — that that decision was based on an incorrect interpretation of national law cannot, as the Advocate General noted in point 53 of her Opinion, prevent that error from being corrected.

44 This conclusion is not called into question by the case-law according to which, first, the General Court must, in principle, confine itself to finding the decision that the Board of Appeal of EUIPO should have reached on the basis of the particulars underlying the Board of Appeal's decision, second, the General Court may annul or alter a decision against which an action has been brought only if, at the date on which that decision was adopted, it was vitiated by one of those grounds for annulment or alteration referred to in Article 65(2) of Regulation No 207/2009, and, third, it may not annul or alter that decision on grounds which come into existence subsequent to its adoption (see, to that effect, judgments of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraphs 71 and 72, and of 26 October 2016, *Westermann Lernspielverlage* v *EUIPO*, C-482/15 P, EU:C:2016:805, paragraph 27 and the case-law cited).

45 While it is true that that principle has a broad scope and prohibits, inter alia, the General Court from annulling or altering the decision of the Board of Appeal of EUIPO by taking into account facts which came into existence after that decision had been adopted or by applying substantive legal provisions which were not yet in force at the time of that adoption, it does not, by contrast, prohibit the General Court from taking into account, in disputes concerning the application of Article 8(4) of Regulation No 207/2009, an evolution in the interpretation, by the national courts, of the rule of national law examined by the Board of Appeal of EUIPO. That rule of national law was one of the particulars subject to assessment by that Board of Appeal and the application of that rule by the same Board of Appeal is subject, pursuant to Article 65(2) of that regulation, to a full review of legality by the General Court (see, to that effect, judgment of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraphs 36 to 38).

46 However, in accordance with the principle that the parties should be heard, which comes under the right to a fair trial laid down in Article 47 of the Charter of Fundamental Rights of the European Union, the taking into consideration by the General Court of a decision of a national court issued after the adoption of the decision of the Board of Appeal of EUIPO is subject to the condition that, as

in the present case, the parties have had, before the General Court, the opportunity to submit observations on the relevant national decision (see, to that effect, judgment of 27 March 2014, *OHIM* v *National Lottery Commission*, C-530/12 P, EU:C:2014:186, paragraphs 52 to 54).

47 Lastly, so far as concerns the alleged failure to comply with the obligation to state reasons, it must be held, in relation to the aspects of French law that were taken into consideration by the General Court, that the latter, in assessing the judgment of 10 July 2012, relied exclusively, in paragraph 44 of the judgment under appeal, on the wording of that judgment.

48 Although it is true that the General Court found, in paragraph 46 of the judgment under appeal, that the earlier case-law of lower French courts, albeit inconsistent, allowed, prior to the judgment of 10 July 2012, the conclusion to be drawn that the protection of the business name was limited to the business activities actually pursued by the company in question, it is nevertheless apparent from paragraphs 43 to 45 of the judgment under appeal that the General Court primarily based its assessment of the legality of the decision at issue, not on that earlier case-law, but on the judgment of 10 July 2012, and that it provided sufficient reasons for that assessment.

49 The view cannot, therefore, be taken that the General Court did not comply with its obligation to state reasons for its decisions.

50 It follows from the foregoing that, since the account taken by the General Court of the judgment of 10 July 2012 does not constitute an infringement of Article 65(2) of Regulation No 207/2009, the first ground of appeal must be rejected as unfounded.

***The second ground of appeal, alleging infringement of Article 8(4) of Regulation No 207/2009, read in combination with Article L. 711-4 of the IPC***

51 The second ground of appeal is divided into two parts.

*The first part of the second ground of appeal, alleging distortion of the judgment of 10 July 2012*

– *Arguments of the parties*

52 By the first part of its second ground of appeal, EUIPO, supported by Forge de Laguiole, criticises the General Court on the ground that it distorted the judgment of 10 July 2012.

53 In particular, in finding, in paragraph 44 of the judgment under appeal, that, in the judgment of 10 July 2012, the Cour de cassation (Court of Cassation) had not interpreted Article L. 711-4 of the IPC, while stating that the passage from that latter judgment that 'the protection [enjoyed] by the business name covers only the business activities actually pursued by the company and not those listed in its articles of association' did not contain any restriction, either in its wording or in its factual or procedural context, which could lead to the belief that its application was restricted to the individual circumstances of the case considered and that it could, therefore, be applied by analogy for the purposes of interpreting Article L. 711-4 of the IPC, the General Court, in the view of EUIPO, attributed to the judgment of 10 July 2012 a significance which it manifestly does not have. According to EUIPO, that passage of the judgment sought solely to define fraud in the application by the company concerned for registration of the trade mark at issue, and not the extent of the protection enjoyed by the business name of that company in respect of a subsequent trade mark. Article L. 711-4(b) of the IPC, however, requires a 'prospective examination' of the likelihood of confusion to be carried out, which could disregard the specific conditions of use of the signs at issue, including the earlier business name, since restricting the scope of the protection enjoyed by a business name exclusively to activities specifically pursued is not required in the case of merely potential conflicts.

54 Forge de Laguiole adds that, given that the judgment of 10 July 2012 is a judgment dismissing an action, that is to say, a judgment upholding the decision delivered on appeal, it cannot, in French law, constitute a leading judgment.

55 Mr Szajner argues that EUIPO's position, according to which the judgment of 10 July 2012 concerns only the issue of fraudulent trade mark applications, is inconsistent both with the case-law prior to that judgment and with how that judgment has been interpreted in French legal literature, which indicates unanimity as regards the general scope of that judgment.

– *Findings of the Court*

56 It should be recalled from the outset that, so far as concerns the examination, in the context of an appeal, of the findings made by the General Court with regard to the applicable national law, the Court of Justice has jurisdiction to determine, first of all, whether the General Court, on the basis of the documents and other evidence submitted to it, distorted the wording of the national provisions at issue or of the national case-law relating to them, or the wording of the academic writings concerning them; second, whether the General Court, as regards those particulars, made findings that were manifestly inconsistent with their content; and, last, whether the General Court, in examining all the particulars, attributed to one of them, for the purpose of establishing the content of the national law at issue, a significance which is not appropriate in the light of the other particulars, where that is manifestly apparent from the documentation in the case file (judgment of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraph 53).

57 Therefore, it is for the Court of Justice to determine whether EUIPO's argument relates to errors allegedly made by the General Court in its findings with regard to the national legislation at issue, which would be open to review by the Court of Justice on the basis of the considerations set out in the preceding paragraph of the present judgment (see, to that effect, judgment of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraph 54).

58 In the present case, the General Court found, in paragraph 44 of the judgment under appeal, that the judgment of 10 July 2012 originated not from an appeal lodged on the basis of Article L. 711-4 of the IPC, but rather from an action seeking the annulment of a trade mark on the ground of fraud in the filing of the application for registration and a claim relating to unfair competition.

59 As the General Court also found in that paragraph, there are no indications in the judgment of 10 July 2012 that the Cour de cassation (Court of Cassation) intended to limit the applicability of its assessments on the scope of protection for a business name to the particular circumstances underlying that judgment. On the contrary, it carried out those assessments in the context of rejecting the first ground of appeal, which was based on, inter alia, an infringement of Article L. 711-4(b) of the IPC. EUIPO's argument that those assessments are not relevant for the purposes of the application of that provision cannot therefore be accepted.

60 EUIPO also argues that it was in order to examine the second ground of appeal raised before it relating to unfair competition that the Cour de cassation (Court of Cassation) took as a basis the business activities actually pursued by the proprietor of a business name, which presupposed an actual competitive situation between the undertakings involved.

61 However, it is manifestly evident from the wording of the judgment of 10 July 2012, first, that the assessment that 'the protection [enjoyed] by the business name covers only the business activities actually pursued by the company and not those listed in its articles of association' was undertaken in the context of the reply to the first ground of appeal, alleging fraud in the filing of the trade mark application at issue in the case that gave rise to that judgment, and, second, that the Cour de cassation

(Court of Cassation) referred to the business activities that were actually pursued by the company in question, both in the context of its reply to that first ground of appeal and in its reply to the second ground of appeal, relating to an action for unfair competition.

62 Having regard to those considerations, it is not manifestly evident that the General Court distorted the judgment of 10 July 2012.

63 That conclusion cannot be called into question by the argument of Forge de Laguiole that that judgment is not a 'leading' judgment. Bearing in mind the principles governing the examination, by the Court of Justice, in the context of an appeal, of the findings made by the General Court on the applicable national law, as recalled in paragraphs 56 and 57 of the present judgment, and since it is not for the Court of Justice to determine whether that national judgment constitutes a 'leading' judgment, it suffices to find that, in taking that judgment into consideration, the General Court does not appear to have manifestly distorted its scope.

64 It follows that the first part of the second ground of appeal must be rejected.

*The second part of the second ground of appeal, alleging an error of law by the General Court in taking into account only the nature of the goods in order to determine Forge de Laguiole's business sectors*

– *Arguments of the parties*

65 By the second part of its second ground of appeal, EUIPO, supported by Forge de Laguiole, takes issue with the criteria used by the General Court to determine that company's business sectors. In that regard, EUIPO argues that, even though the General Court, in paragraph 32 of the judgment under appeal, found that the answer to the question of whether and, where appropriate, to what extent Forge de Laguiole's business name enabled it to prevent Mr Szajner from using the mark LAGUIOLE, depends on French law alone, the General Court defined the limits of protection for a business name by referring, in paragraph 63 of the judgment under appeal, exclusively to its own case-law, namely the judgment of 13 February 2007, *Mundipharma* v *OHIM — Altana Pharma (RESPICUR)* (T-256/04, EU:T:2007:46), which concerns the use of earlier marks, which the General Court applied by analogy for the purposes of interpreting Article 8(4) of Regulation No 40/94, corresponding to Article 8(4) of Regulation No 207/2009.

66 Consequently, EUIPO submits, the General Court determined those business sectors solely under the criterion relating to the nature of the goods and thus erred in law in the application of Article 8(4) of Regulation No 207/2009, read in combination with Article L. 711-4 of the IPC. EUIPO maintains that, when making such a determination of business sectors, with the meaning of French law, the intended use and purpose of the goods marketed by the proprietor of the earlier business name should also have been taken into account.

67 Mr Szajner argues that the General Court acted correctly in assessing the similarity of the goods at issue by basing itself not only on their nature but also on their intended use and purpose.

– *Findings of the Court*

68 It is appropriate, first of all, to note, as the Advocate General did in point 78 of her Opinion, that the General Court, when examining the business activities pursued by Forge de Laguiole, did not in any way generally apply its case-law by analogy. Thus, the General Court cited its case-law on the use of earlier trade marks only in paragraph 63 of the judgment under appeal, in order to explain its assessment that the marketing of forks did not make it possible to establish a business activity in the entire 'tableware' sector, but only in a business sector relating to 'forks and spoons'.

69 Next, it must be held that the General Court did not, it is true, first explicitly mention the criteria on the basis of which the business activities actually pursued by Forge de Laguiole had to be determined and that it cited, in paragraph 81 of the judgment under appeal, case-law of the French courts, relied on by the parties, only in the course of its examination of the likelihood of confusion.

70 However, it is clear from the judgment under appeal that, when examining those business activities, in paragraphs 54 to 74 of that judgment, the General Court expressly referred not only to the nature of the goods concerned, but also to their intended use, purpose, customers and distribution channels.

71 It follows that the argument of EUIPO and Forge de Laguiole is based on an erroneous reading of the judgment under appeal.

72 Consequently, the second part of the second ground of appeal must also be rejected as unfounded.

73 It follows from all of the foregoing considerations that the appeal is unfounded and must therefore be dismissed.

## Costs

74 In accordance with Article 138(1) of the Rules of Procedure of the Court of Justice, which applies to appeal proceedings by virtue of Article 184(1) 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 Mr Szajner has applied for costs and EUIPO has been unsuccessful, the latter must be ordered to pay the costs.

75 In accordance with Article 184(4) of the Rules of Procedure, Forge de Laguiole, intervener in the appeal, must be ordered to bear its own costs.

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

**1. Dismisses the appeal;**

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

**3. Orders Forge de Laguiole SARL to bear its own costs.**

[Signatures]