

Court of Justice EU, 17 January 2018, Josel v EUIPO



Appeal against judgment of the General Court regarding genuine use of the wordmark NN dismissed by reasoned order:

• grounds of appeal are either manifestly inadmissible or manifestly unfounded

Pursuant to Article 181 of its Rules of Procedure, where the appeal is, in whole or in part, manifestly inadmissible or manifestly unfounded, the Court may at any time, acting on a proposal from the Judge-Rapporteur and after hearing the Advocate General, decide by reasoned order to dismiss that appeal in whole or in part.

4. That provision must be applied in the present case.

5. On 30 November 2017, the Advocate General took the following position:

[...]

‘Since the four grounds of appeal are either manifestly inadmissible or manifestly unfounded, I propose that the Court dismiss the appeal.’

6. It should be added, as regards the second ground of appeal, that, even if the appellant relied, in the first instance, in a sufficiently clear and precise manner, on the use of the earlier Spanish mark nn associated with a logo in the form of a circle without other elements, its application before the General Court, in particular paragraphs 34 to 38 thereof, does not indicate any dispute regarding the statement of the Board of Appeal of EUIPO, at paragraph 18 of the decision of that Board of Appeal of 14 April 2015, at issue in the present case, according to which the variation consisting of representing the letters ‘NN’ within a circle, at different levels and with different shades, is not negligible when the sign is compared to the simple word mark NN. Accordingly, any claim before the General Court of the use of the earlier mark NN associated with a logo in the form of a circle had to be rejected by that court.

7. On that last ground as well as those relied on by the Advocate General, the appeal must be dismissed.

Source:

Court of Justice EU, 17 January 2018

(C. Vajda (Rapporteur), President of the Chamber, K. Jürimäe and C. Lycourgos)

ORDER OF THE COURT (Ninth Chamber)

17 January 2018

(Appeal – article 181 of the Rules of Procedure – EU trade mark – Opposition proceedings – Registration of the word mark NN – Opposition dismissed – No genuine use of the earlier mark)

In Case C-536/17 P,

APPEAL under article 56 of the Statute of the Court of Justice of the European Union, brought on 11 September 2017,

Josel SLU, established in Barcelone (Spain), represented by J. Güell Serra, abogado, appellant the other party to the proceedings being:

European Union Intellectual Property Offices (EUIPO), defendant at first instance,

Nationale-Nederlanden Nederland BV, established in ‘s-Gravenhage (Netherlands), represented by A. Janssen, R. Sjoerdsma and C. Jehoram, advocaaten, interveners at first instance,

THE COURT (Ninth Chamber),

composed of C. Vajda (Rapporteur), President of the Chamber, K. Jürimäe and C. Lycourgos, Judges,

Advocate General: M. Wathelet,

Registrar: A. Calot Escobar,

having decided, after hearing the Advocate General, to give a decision by reasoned order, pursuant to Article 181 of the Rules of Procedure of the Court of Justice, makes the following

Order

1. By its appeal, Josel SLU, seeks to have set aside the judgment of the General Court of the European Union of 28 June 2017, *Josel v EUIPO - Nationale Nederlanden Nederland (NN)* (T-333/15, not published, ‘the judgment under appeal’, EU:T:20 17:444), by which the General Court dismissed its action seeking annulment of the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 14 April 2015 (Case R 153112014-4), relating to opposition proceedings between Josel and Nationale-Nederlanden Nederland.

2. In support of its appeal the appellant relies on four grounds of appeal, alleging:

- infringement of Article 69 of the Rules of Procedure of the General Court,

- incorrect examination of the evidence filed before EUIPO,

- misinterpretation of the Court's case-law in that the General Court concluded that the use of the mark in question altered the distinctive character of the mark, and

- A defective statement of reasons.

The appeal

3. Pursuant to Article 181 of its Rules of Procedure, where the appeal is, in whole or in part, manifestly inadmissible or manifestly unfounded, the Court may at any time, acting on a proposal from the Judge-Rapporteur and after hearing the Advocate General, decide by reasoned order to dismiss that appeal in whole or in part.

4. That provision must be applied in the present case.

5. On 30 November 2017, the Advocate General took the following position:

‘1. I am of the view that the appeal in the present case should be dismissed as being, in part, manifestly inadmissible and, in part, manifestly unfounded and that the appellant should be ordered to pay the costs in accordance with Article 137 and Article 184(1) of the Rules of Procedure of the Court, for the following reasons.

2. In support of its appeal, the appellant has put forward four grounds of appeal.

3. By its first ground of appeal, the appellant criticises the General Court for having, contrary to Article 69 of its Rules of Procedure, refused to stay the proceedings taking into account that *Nationale-Nederlanden Nederland BV*, intervener at first instance, had applied to the Spanish commercial courts for revocation of the earlier mark due to non-use. The appellant considers that the principles of legal certainty, proper administration of justice and the protection of legitimate expectations required a stay of the proceedings.

4. It should be pointed out that the European Union trade mark regime is an autonomous system with its own set of rules and objectives peculiar to it, which applies independently of any other national system (judgment of 16 July 2009, *American Clothing Associates v OHIM and OHIM v American Clothing Associates*, C-202/08 P and C-208/08 P, EU:C:2009:477, paragraph 58).

Accordingly, neither EUIPO nor, where appropriate, the Courts of the European Union are bound by a decision taken at the level of a Member State, even if they may take it into consideration.

5. Furthermore, according to Article 69(c) and (d) of the Rules of Procedure of the General Court, pending proceedings may be stayed at the joint request of the parties or in other particular cases where the proper administration of justice so requires. It follows that the decision whether or not to stay proceedings falls within the discretion of the General Court (order of 20 October 2011, *DTL v OHIM*, C-67/11 P, not published, EU:C:2011:683, paragraphs 32 and 33).

6. Given that the General Court is not bound by a decision at Member State level and has a discretionary power to suspend it, it was not obliged to stay the proceedings. The first ground must therefore be rejected as manifestly unfounded.

7. By its second ground of appeal, the appellant complains that the General Court failed to examine and take into consideration all the documents it provided during the administrative procedure before EUIPO to establish use of its trade mark. According to the appellant, it is clear from the judgment under appeal that the General Court omitted some items of evidence, in particular those which used the letters “nn” associated with a logo in the form of a circle, without the word elements “núñez i navarro” and without the word “hotels”.

8. It should be pointed out that, in its application to the General Court, the appellant essentially argued that the decision of the Fourth Board of Appeal of EUIPO was incorrect in that it considered that there was use of the

earlier Spanish mark in a form which differed from the form in which the registration had been made. It argued that, by means of a circle, the letters “nn” were separated and isolated from the subsequent additions that accompanied them, such as the name of the holding company of the group “núñez i navarro” or the business sector or area, for example “hotels”.

9. According to the appellant, that means that only the letters “nn” constitute the mark. The name of the parent company or holding company of the group of companies “núñez i navarro”, to which it belongs, constitute secondary elements which do not form part of the earlier Spanish mark (paragraph 35 of the application before the General Court).

10. On that basis, it can hardly be inferred that the appellant intended to maintain that it used the letters “nn” without further indication.

11. The second ground of appeal is therefore manifestly inadmissible, in so far as it is only in the context of the appeal before the Court that the appellant claims, for the first time, at least in a sufficiently clear and precise manner, that there had been use of the earlier Spanish mark nn associated with a logo in the form of a circle without other elements.

12. By its third ground of appeal, the appellant submits that the General Court wrongly considered that the use of the mark nn in combination with the names “núñez i navarro” alters the distinctive character of the earlier Spanish mark as registered and, consequently, did not demonstrate genuine use of that mark. According to the appellant, the sign “nn” is used in combination with other elements, but consumers will perceive it as a business identifier.

13. I note that the General Court rejected as unfounded the appellant’s single plea in law, alleging an infringement of Article 15(1)(a) and Article 42(2) and (3) of Regulation No 207/2009. In that regard, it upheld the Board of Appeal’s finding that the addition of the word element “núñez i navarro” to the earlier mark altered the distinctive character of that mark. The General Court found that while the word element “núñez i navarro” is always placed below the circle containing the letters “nn”, in the majority of the items of evidence produced it occupies a central position, especially when either the word element “hotels” or the reference to an address is placed below it.

14. Furthermore, according to the General Court, the word element “núñez i navarro”, in terms of width, occupies a much more significant space than the word element “nn”, having regard to the number of characters each contains. Moreover, given that the surnames “nunez” and “navarro” appear in the marks used, the letters “nn” are very likely to be perceived as constituting the initials of those surnames. The General Court noted, moreover, that, as surnames, the words “núñez” and “navarro” are not generic terms referring to the services in question and therefore have normal distinctive character when they are used to describe those services.

15. It should be noted that, in accordance with Article 256(1) TFEU and the first paragraph of Article 58 of

the Statute of the Court of Justice of the European Union, an appeal is limited to points of law. The General Court therefore has JOSEL V EUIPO exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts or evidence are distorted, constitute points of law subject, as such, to review by the Court of Justice on appeal.

16. It must be stated that the appellant's complaints relate to findings and assessments of a factual nature made by the General Court, in the judgment under appeal) concerning the examination of the evidence which the appellant has adduced in order to prove genuine use of the earlier Spanish mark. In accordance with the case-law of the Court, the distinctive character of a mark and its various elements is a question of fact which is not subject to review by the Court on appeal.

17. Consequently, the third ground of appeal is manifestly inadmissible.

18. By its fourth ground of appeal, the appellant complains that the General Court dismissed as unfounded its single ground of appeal, alleging infringement of point (a) of the second subparagraph of Article 15(1), and Article 42(2) and (3) of Regulation No 207/2009, without having explained why it was not necessary to rule on the impact of the other amendments and additions to the sign “nn” in the evidence produced by the appellant and mentioned in paragraph 35 of the judgment under appeal.

19. It must be pointed out that, in paragraph 35 of the judgment under appeal, the General Court found that *“the signs used in the evidence are composed of a reproduction of the two letters “n” in the form of a figurative element where they are placed at two different levels inside a dark-coloured circle, and the word element “núñez i navarro”; in some instances the word element “hotels” and an address are also present”*.

20. In paragraph 46 of the judgment under appeal, the General Court confirmed *“the Board of Appeal’s conclusion that the addition of the word element “núñez i navarro” to the earlier mark changes its distinctive character”*.

21. In paragraph 47 of the judgment under appeal, the General Court held that *“without needing to rule on the impact of the other modifications and additions in the evidence presented as mentioned in paragraph 35 above, the Court rejects, as unfounded, the single plea in law, alleging infringement of Article 15(1)(a) and Article 42(2) and (3) of Regulation No 207/2009”*.

22. It is apparent from the reading of those paragraphs of the judgment under appeal that the General Court considered that the addition of the word element “núñez i navarro” to the earlier mark was sufficient in itself to alter the distinctive character of that mark. It therefore did not err in law in holding that it was not necessary to consider whether the addition to the earlier mark of the word element “nunez i navarro” and, in certain cases, the word element “hotels” and the

mention of an address altered the distinctive character of the earlier mark.

23. It follows that the decision of the General Court set out in paragraph 47 of the judgment under appeal is sufficiently reasoned and that the fourth ground of appeal must be rejected as manifestly unfounded.

24. Since the four grounds of appeal are either manifestly inadmissible or manifestly unfounded, I propose that the Court dismiss the appeal.’

6. It should be added, as regards the second ground of appeal, that, even if the appellant relied, in the first instance, in a sufficiently clear and precise manner, on the use of the earlier Spanish mark nn associated with a logo in the form of a circle without other elements, its application before the General Court, in particular paragraphs 34 to 38 thereof, does not indicate any dispute regarding the statement of the Board of Appeal of EUIPO, at paragraph 18 of the decision of that Board of Appeal of 14 April 2015, at issue in the present case, according to

which the variation consisting of representing the letters ‘NN’ within a circle, at different levels and with different shades, is not negligible when the sign is compared to the simple word mark NN. Accordingly, any claim before the General Court of the use of the earlier mark NN associated with a logo in the form of a circle had to be rejected by that court.

7. On that last ground as well as those relied on by the Advocate General, the appeal must be dismissed.

Costs

8. Under Article 137 of the Rules of Procedure of the Court of Justice, applicable to the procedure on appeal pursuant to Article 184(1) of those rules, a decision as to costs is to be given in the order which closes the proceedings. Since the present order has been adopted before the appeal has been served on the defendant and, therefore, before the latter could have incurred costs, Josel SLU must be ordered to bear its own costs.

On those grounds, the Court (Ninth Chamber) hereby orders:

1. The appeal is dismissed.

2. Josel SLU shall bear its own costs.

Luxembourg, 17 January 2018.

A. Calot Escobar

Registrar

C. Vajda

President of the Ninth Chamber