

## Court of Justice EU, 6 March 2019, BMB v EUIPO



## TRADE MARK LAW

**Appeal against General Courts finding that the fact that the contested design is filled with sweets cannot constitute a relevant point of visual comparison, since the contested design is registered merely for the box or container of those sweets dismissed:**

- [the appeal amounts in no more than a request for re-examination which the CJEU does not have jurisdiction to undertake](#)

36. Thus, by its claim that the fact that the design is represented as being filled with sweets was not taken into consideration, BMB merely reproduces an argument already made before the General Court, which amounts in reality to no more than a request for re-examination of the application brought before the General Court, which the Court of Justice does not have jurisdiction to undertake (see, to that effect, order of 3 December 2015, *Verband der Kölnisch-Wasser Hersteller v OHIM*, C-29/15 P, not published, EU:C:2015:799, paragraph 28).

- [the same goes for the claim that the General Court failed to correctly take into consideration all of the relevant elements in its analysis of the similarity between the signs at issue](#)

49. It must be noted that, by its reasoning set out in support of this third part, the applicant seeks to obtain a fresh appraisal of the General Court's assessment of the facts relating to the visual, phonetic and conceptual similarity of the signs at issue, which does not, save where the facts have been distorted, constitute a question of law subject, as such, to review by the Court

of Justice on appeal (see, to that effect, order of 22 June 2016, *Matratzen Concord v EUIPO*, C-295/15 P, not published, EU:C:2016:554, paragraph 28). However, BMB does not allege, in that regard, any distortion of the facts.

**The General Court did not err in law by not taking into consideration a judgment of the tribunal de grande instance de Paris:**

- [this judgment cannot bind the adjudicating bodies of EUIPO in invalidity proceedings](#)

62. It should be noted in that regard that, in any event, the judgment of the tribunal de grande instance de Paris (Regional Court, Paris), handed down in a dispute connected to trade mark infringement proceedings, cannot bind the adjudicating bodies of EUIPO in invalidity proceedings, such as those in question in the present case, as neither the parties nor the subject matter of those proceedings are identical ([see, by analogy, judgment of 21 July 2016, \*Apple and Pear Australia and Star Fruits Diffusion v EUIPO\*, C-226/15 P, EU:C:2016:582, paragraphs 52 and 63](#)).

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## Court of Justice EU, 6 March 2019

(C. Lycourgos (Rapporteur), E. Juhász and I. Jarukaitis)

JUDGMENT OF THE COURT (Tenth Chamber)

6 March 2019 (\*)

(Appeal — Community design — Regulation (EC) No 6/2002 — Article 25(1)(e) — Invalidity proceedings — Design representing comfit boxes for sweets — Declaration of invalidity)

In Case C-693/17 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 10 December 2017,

BMB sp. z o.o., established in Grójec (Poland), represented by K. Czubkowski, radca prawny, appellant,

the other parties to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by S. Hanne and D. Walicka, acting as Agents,

defendant at first instance,

Ferrero SpA, established in Alba (Italy), represented by M. Kefferpütz, Rechtsanwalt,

intervener at first instance,

THE COURT (Tenth Chamber),

composed of C. Lycourgos (Rapporteur), President of the Chamber, E. Juhász and I. Jarukaitis, Judges,

Advocate General: E. Tanchev,

Registrar: A. Calot Escobar,

having regard to the written procedure,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

**Judgment**

1. By its appeal, BMB sp. z o.o. asks the Court to set aside the judgment of the General Court of the

European Union of 3 October 2017, BMB v EUIPO — Ferrero (Container for sweets) (T-695/15, not published, *‘the judgment under appeal’*, EU:T:2017:684), whereby the General Court dismissed its action seeking annulment of the decision of the Third Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 8 September 2015 (Case R 1150/2012-3), concerning invalidity proceedings between Ferrero SpA and BMB (*‘the decision at issue’*).

#### Legal context

##### European Union law

2. Article 25 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), entitled *‘Grounds for invalidity’*, provides, in paragraph 1(e):

*‘A Community design may be declared invalid only in the following cases:*

...

*(e) if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use’.*

##### French law

3. Article L713-3 of the Intellectual Property Code provides:

*‘Save where the owner has consented, the following shall be prohibited if there is a risk that they might lead to confusion in the mind of the public:*

*(a) the reproduction, use or affixing of a mark, or the use of a mark which has been reproduced, in respect of goods or services similar to those for which the mark is registered;*

*(b) the imitation of a mark or the use of an imitated mark, in respect of goods or services identical with, or similar to, those for which the mark is registered.’*

##### Background to the dispute

4 On 15 November 2007, BMB filed a design with EUIPO, which was registered the same day as a Community design under No 826 680-0001, pursuant to Regulation No 6/2002.

5 The registered design is for comfit boxes and containers in Class 09.03 of the Locarno Agreement Establishing an International Classification for Industrial Designs of 8 October 1968, as amended. It is represented as follows:



View 1



View 2



View 3

6. On 11 July 2011, the intervener at first instance, Ferrero, filed an application for a declaration of invalidity of the registered design before EUIPO pursuant to Article 25(1)(c) to (g) of Regulation No 6/2002.

7. In support of its application, the intervener invoked three earlier rights, including International Registration No 405 177 of a trade mark, registered on 12 March 1974, with effect in, in particular, France. The registration is protected for goods in Class 30 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, including for 'sweets', and is reproduced below:



8. By decision of 25 April 2012, the Cancellation Division of EUIPO granted the application for a declaration of invalidity under Article 25(1)(e) of Regulation No 6/2002 on the basis of the international registration referred to above. It considered, in essence, that, on account of the similarity of the signs and the identity of the goods, there was a likelihood of confusion on the part of the relevant public.

9. On 21 June 2012, the appellant filed a notice of appeal with EUIPO, pursuant to Articles 55 to 60 of Regulation No 6/2002, against the Cancellation Division's decision.

10. By the decision at issue, the Third Board of Appeal of EUIPO dismissed the appeal and upheld the invalidity of the contested design pursuant to Article 25(1)(e) of Regulation No 6/2002.

11. The Board of Appeal held that the distinctive character per se of the earlier international registration was 'below average', since it 'shows a standard container which can be filled with different products, such as sweets'. However, it held, in essence, that, on account of the high visual similarity of the signs at issue, which are not offset by phonetic and conceptual differences, and of the fact that the goods in question have at least a high degree of similarity, there was a likelihood of confusion on the part of the relevant public.

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

12. By application lodged at the Registry of the General Court on 24 November 2015, BMB brought an action for annulment of the decision at issue.

13. It raised three pleas in law in support of its action. By its first plea, it claimed that the decision at issue was founded on an incorrect legal basis on the ground that the Board of Appeal had erred in founding the decision on Article 8(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1), not on Article L713-3 of the Intellectual Property Code. The second plea alleged infringement of Article 25(1)(e) of Regulation No 6/2002 inasmuch as the Board of

Appeal had erred in finding that there was a likelihood of confusion. Lastly, by its third plea, the appellant claimed that the Board of Appeal, by failing to have regard to evidence that it should have taken into consideration for the purpose of ruling on the appeal, had infringed Article 63(1) of that regulation.

14. By the judgment under appeal, the General Court dismissed those pleas. It rejected the first plea on the ground that it had no factual basis. It considered that the Board of Appeal had adopted the decision at issue pursuant to Article L713-3 of the Intellectual Property Code, not Article 8(1)(b) of Regulation No 207/2009, it being necessary to regard the reference made to the latter provision as the legal basis for the decision at issue as a mere formal error. It also rejected the second and third pleas after having found that the Board of Appeal had correctly assessed the evidence before it and had been able to find, without making an error of law or assessment, that there was a likelihood of confusion.

#### **Forms of order sought by the parties**

15. By its appeal, BMB claims that the Court should:

- set aside the judgment under appeal;
- annul the decision at issue or, in the alternative, if the state of the proceedings does not enable the Court of Justice to give final judgment, refer the case back to the General Court; and
- order Ferrero and EUIPO to pay the costs incurred before the Court of Justice and the General Court and order Ferrero to pay the costs incurred in proceedings before EUIPO.

16. EUIPO contends that the Court should:

- dismiss the appeal; and
- order the appellant to pay the costs incurred by EUIPO.

17. Ferrero contends that the Court should:

- principally, dismiss the appeal;
- alternatively, if the appeal is not dismissed in its entirety, refer the case back to the General Court; and
- order the appellant to pay the costs incurred by Ferrero before the Court of Justice.

#### **The appeal**

18. In support of its appeal, BMB puts forward a single ground, alleging infringement of Article 25(1)(e) of Regulation No 6/2002. The ground comprises four parts.

#### **The first part of the single ground of appeal**

##### **Arguments of the parties**

19. By the first part of its single ground of appeal, BMB claims, in essence, that, in paragraph 4 of the judgment under appeal, the General Court erred in law by classifying the earlier international registration as a 'three-dimensional mark', whereas it is common ground that the mark was registered as a figurative mark. Thus, the General Court compared the contested design to a mark which is not the earlier international registration, but rather a three-dimensional mark assumed to be similar to that registration.

20. More specifically, BMB highlights that the examination of the ground for invalidity specified in Article 25(1)(e) of Regulation No 6/2002 must be

based on the perception by the relevant public of the distinctive sign relied on in support of that ground together with the overall impression which the sign leaves in the mind of the public. However, it follows from the General Court's case-law that a three-dimensional mark is not necessarily perceived by the relevant public in the same way as a figurative mark. In the first case, the public perceives a tangible object whereas, in the second case, the public sees only an image. It cannot therefore be presumed that the two signs in question are similar, even though the contested design is similar to the earlier registration.

21. BMB claims that the General Court incorrectly based its assessment of similarity and of the likelihood of confusion on the comparison of the contested design with a sign different from the earlier international registration invoked by Ferrero, and therefore committed an error of law which must result in the judgment under appeal being set aside.

22. EUIPO and Ferrero contend that the Court should reject the first part of the single ground of appeal.

#### **Findings of the Court**

23. By the first part of its single ground of appeal, BMB claims, in essence, that, in paragraph 4 of the judgment under appeal, the General Court incorrectly classified the earlier international registration as a 'three-dimensional mark', whereas the mark is a figurative mark. That error allegedly led the General Court to compare the contested design to a mark which is not the earlier international registration, but rather a three-dimensional mark assumed to be similar to that registration.

24. It should be noted that the statement in paragraph 4 of the judgment under appeal is part of a finding of fact by the General Court, the validity of which the Court of Justice cannot examine in the context of an appeal, save where the General Court has distorted the facts (see, to that effect, order of 22 June 2016, *Matratzen Concord v EUIPO*, C-295/15 P, not published, EU:C:2016:554, paragraph 28).

25. In the present case, contrary to the requirements which flow from the case-law of the Court of Justice, BMB, merely asserting that the sign at issue covered by the earlier international registration was registered as a figurative mark, has not expressly alleged distortion of the facts examined by the General Court (see, to that effect, judgment of 29 October 2015, *Commission v ANKO*, C-78/14 P, EU:C:2015:732, paragraph 54 and the case-law cited).

26. In any event, it must be stated that it is clear from the reproduction in paragraph 4 of the judgment under appeal of the sign covered by the earlier international registration, that is, international registration No 405 177, submitted by Ferrero in its application for a declaration of invalidity of the contested design, that the General Court based its assessment of the likelihood of confusion on the comparison of that sign with the sign registered as a design by BMB.

27. However, it should be noted that the sign covered by the earlier international registration is the same as the sign taken into consideration by the Board of

Appeal of EUIPO in order to examine whether there was a likelihood of confusion between the earlier international registration and the contested design. Moreover, BMB did not dispute before the General Court that the Board of Appeal of EUIPO assessed whether there was a likelihood of confusion having regard to the sign covered by the earlier international registration submitted by Ferrero in its application for a declaration of invalidity of that design.

28. It follows that BMB cannot validly claim that the General Court carried out an assessment, in particular of the likelihood of confusion, on the basis of a different sign to that covered by that registration.

29. Accordingly, the first part of the single ground of appeal must be rejected as unfounded.

#### **The second part of the single ground of appeal**

##### **Arguments of the parties**

30. By the second part of its single ground of appeal, the appellant criticises, in essence, the General Court for having found, in paragraph 52 of the judgment under appeal, that the sweets placed inside the contested design could not constitute a relevant visual point of comparison, as the design is registered only for the box and container containing those sweets and the earlier international registration was also registered in order to be filled with sweets.

31. The appellant claims that the contested design and the earlier international registration must be compared in their respective forms as indicated in the registers and that, in the case of a design, the indication of the goods according to the Locarno classification must not be taken into account. That classification is used purely for the purpose of registering and searching for designs, but does not specify the scope of protection or possible use. Therefore, the contested design should be regarded as a combination of elements, each of which is important and, accordingly, the composite appearance of the product cannot be amended or disregarded when it is compared to other designs. In the present case, it is necessary, according to the appellant, to take into account the coloured sweets contained in the box which, in practice, may be printed inside or outside the box.

32. EUIPO contends that the second part of the single ground of appeal is unfounded. Ferrero contends that this part is inadmissible and, in any event, unfounded.

##### **Findings of the Court**

33. By the second part of its single ground of appeal, BMB claims, in essence, that, in paragraph 52 of the judgment under appeal, the General Court was incorrect to refuse to take into consideration the fact that the contested design, unlike the earlier international registration, is represented filled with sweets.

34. It is apparent from paragraph 51 of the judgment under appeal that BMB claimed before the General Court that the Board of Appeal of EUIPO committed an error and vitiated its assessment by an inconsistency regarding the visual comparison of the registrations and the dominant elements of the contested design. According to BMB, that error and that inconsistency

were based on the fact that the contested design is represented filled with sweets, which were not, however, taken into account by the Board of Appeal of EUIPO as regards the visual comparison of the registrations, although they enabled a clear distinction to be made between the registrations and were taken into account in the analysis of the dominant elements of the contested design.

35. In answer to that claim, the General Court observed, in paragraph 52 of the judgment under appeal, that, contrary to BMB's claim, and as the Board of Appeal of EUIPO rightly held in paragraph 27 of the decision at issue, *'the fact that the contested design is represented filled with sweets cannot constitute a relevant point of visual comparison, since the contested design is registered merely for the box or container of those sweets and ... it is clear that the earlier international registration was also registered for a filling with sweets'*.

36. Thus, by its claim that the fact that the design is represented as being filled with sweets was not taken into consideration, BMB merely reproduces an argument already made before the General Court, which amounts in reality to no more than a request for re-examination of the application brought before the General Court, which the Court of Justice does not have jurisdiction to undertake (see, to that effect, order of 3 December 2015, *Verband der Kölnisch-Wasser Hersteller v OHIM*, C-29/15 P, not published, EU:C:2015:799, paragraph 28).

37. It follows from the foregoing that the second part of the single ground of appeal must be rejected as unfounded.

### **The third part of the single ground of appeal**

#### **Arguments of the parties**

38. By the third part of its single ground of appeal, BMB claims, in essence, that the General Court, when comparing the earlier international registration and the contested design, failed to correctly assess the significance of the differences between them, despite having acknowledged those differences, namely the rounded edges and the label of the contested design, and failed to take into account all of the dominant and distinctive elements of the signs at issue. However, according to the appellant, the visual comparison of the signs at issue indicates that the overall impression conveyed by each of the marks differs significantly.

39. In support of this third part, BMB recalls that the earlier international registration consists only of a representation which must be perceived as an image of a box of sweets in black and white, whereas the contested design is made up of a number of figurative and word elements other than the mere representation of a box of sweets.

40. That part contains three complaints.

41. By the first complaint, BMB claims that the General Court erred in finding, in paragraphs 58 and 59 of the judgment under appeal, that it was not possible to carry out a phonetic and conceptual comparison of the signs at issue, whereas the fact that the earlier international registration has no conceptual or phonetic

aspect cannot be disregarded. According to BMB, the presence of the word element *'MIK MAKI'* in the contested design is an essential difference between the two signs. BMB refers in that regard to an earlier decision of the Board of Appeal of EUIPO in which a later three-dimensional mark containing a word element was found to differ significantly, from a phonetic standpoint, from an earlier three-dimensional mark with no word elements.

42. Consequently, in the assessment of the likelihood of confusion, the General Court should have assessed the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings. However, it is settled case-law that, in the case of marks made up of the appearance of the product itself, consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging, and, therefore, any graphic or word element added to such a mark must be regarded as dominant and distinctive.

43. Furthermore, the General Court allegedly failed to take into account the conditions under which the marks may be present on the market. Sweets are usually sold in self-service shops or kiosks, where the consumer chooses the product himself from a small selection of products or asks the seller for the product by name. Thus, the assessment of visual and phonetic similarity is particularly important. In that regard, the appellant claims that the General Court erred, in paragraph 32 of the judgment under appeal, in finding that the average consumer must rely on his imperfect recollection of the marks in order to compare them, whereas the average consumer often has the opportunity to compare directly, on shop shelves, the goods at issue in the present case.

44. By the second complaint, BMB submits that the General Court failed to take into account the dominant elements of the signs at issue, in particular the design and shape of the edges of each sign, the presence of a coloured label and the logo *'MIK MAKI'* of the contested design.

45. The two signs at issue should be compared having regard to their standard elements. The presentation of a container for sweets with a lid in both cases is a descriptive element of those signs. However, the word element *'MIK MAKI'* used in the contested design is far more distinctive than the container itself.

46. By the third complaint, BMB claims that the General Court failed to have regard to View 1 of the contested design, reproduced in paragraph 5 of this judgment, and therefore disregarded an essential characteristic of that design, that is, the logo *'BMB'* of its right holder.

47. EUIPO and Ferrero contend that the third part of the single ground of appeal should be declared inadmissible and, in any event, unfounded.

#### **Findings of the Court**

48. By the third part of its single ground of appeal, BMB raises three complaints claiming, in essence, that the General Court failed to correctly take into

consideration all of the relevant elements in its analysis of the similarity between the signs at issue.

49. It must be noted that, by its reasoning set out in support of this third part, the applicant seeks to obtain a fresh appraisal of the General Court's assessment of the facts relating to the visual, phonetic and conceptual similarity of the signs at issue, which does not, save where the facts have been distorted, constitute a question of law subject, as such, to review by the Court of Justice on appeal (see, to that effect, order of 22 June 2016, *Matratzen Concord v EUIPO*, C-295/15 P, not published, EU:C:2016:554, paragraph 28). However, BMB does not allege, in that regard, any distortion of the facts.

50. It follows that the third part of the single ground of appeal must be rejected as inadmissible.

#### **The fourth part of the single ground of appeal**

##### **Arguments of the parties**

51. By the fourth part of its single ground of appeal, BMB submits, in essence, that the General Court infringed Article 25(1)(e) of Regulation No 6/2002 in conjunction with the principles of the sound administration of justice and the protection of legitimate expectations. That fourth part comprises two complaints.

52. First, BMB claims that the General Court committed a manifest error of assessment in finding, in paragraph 26 of the judgment under appeal, that the reference to Article 8(1)(b) of Regulation No 207/2009, not Article L713-3 of the Intellectual Property Code — which, BMB claims, was applicable to the decision — as the legal basis of the decision at issue was a mere formal error. As the decision at issue was intended to annul the right held by BMB, it would have been reasonable to require there to be no uncertainty as to the legal basis of that decision.

53. Secondly, BMB criticises the General Court's finding, in paragraph 29 of the judgment under appeal, that it was not necessary, in determining the likelihood of confusion in the case, to take national case-law into consideration. The General Court considered in that regard that Article L713-3 of the Intellectual Property Code transposed the provisions of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which, at the time the decision at issue was adopted, had been replaced by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), and that, consequently, it was sufficient to apply the case-law of the Court of Justice of the European Union. However, according to BMB, the Court has never ruled on similar cases concerning the invalidity of a design in the light of Article 25(1)(e) of Regulation No 6/2002. As a result, judgment No 2008/10106 of 6 November 2009 of the Third Chamber of the tribunal de grande instance de Paris (Regional Court, Paris, France), concerning the same earlier international registration as that at issue in the present case and on which the General Court had requested the

parties to submit observations, should have been taken into consideration by the General Court.

54. In that regard, BMB claims that the national case-law is essential to the assessment in the present case of the likelihood of confusion, as the judgment of the tribunal de grande instance de Paris (Regional Court, Paris) confirms that a sign with the same characteristics of the contested design does not infringe the earlier international registration. That French court took into consideration, inter alia, the fact that the contested design at issue in the case that gave rise to that judgment, has no right angles, has rounded edges and includes a label with the words '*Pick Up*' covering two thirds of the container, which results in its differing significantly from the earlier international registration. In the present case, the earlier international registration and the contested design have the same differences as those referred to in the case that gave rise to that judgment. BMB submits, in that regard, that, inasmuch as the only difference between the design analysed by the tribunal de grande instance de Paris (Regional Court, Paris) and the contested design in the present case is the name on the label of the contested design, that is, '*MIK MAKI*', such difference has no bearing on the assessment of the likelihood of confusion carried out in the present case.

55. EUIPO and Ferrero contend that the Court should reject the fourth part of the single ground of appeal.

##### **Findings of the Court**

56. By the fourth part of its single ground of appeal, BMB claims, in essence, that the General Court committed a manifest error of assessment in so far as it found, in paragraph 26 of the judgment under appeal, that the Board of Appeal of EUIPO, even though it referred to Article 8(1)(b) of Regulation No 207/2009 in the decision at issue, applied Article L713-3 of the Intellectual Property Code. Moreover, BMB submits that the General Court, by holding that it was not necessary to take into consideration French national case-law relating to the earlier international registration in the assessment of the likelihood of confusion, erred in law.

57. Regarding, first, the claim relating to the General Court's alleged error in paragraph 26 of the judgment under appeal, it should be noted that BMB merely repeats the argument it raised at first instance that the Board of Appeal of EUIPO founded the decision at issue on an incorrect legal basis, without however challenging specifically the General Court's reasoning that the error committed by the Board of Appeal of EUIPO should be regarded as a formal error. That argument was rejected in paragraphs 20 to 26 of the judgment under appeal.

58. As recalled in paragraph 36 of this judgment, it is settled case-law that a request that, without containing reasoning seeking specifically to identify the error which allegedly vitiates the decision at issue, merely reproduces arguments already made before the General Court amounts in reality to no more than a request for re-examination of those arguments, which the Court of Justice does not have jurisdiction to undertake.

59. Secondly, BMB challenges the General Court's finding in paragraph 29 of the judgment under appeal that, inasmuch as Article L713-3 of the Intellectual Property Code transposes provisions of First Directive 89/104, which, at the time the contested decision was adopted, had been replaced by Directive 2008/95, it is sufficient to interpret the likelihood of confusion in accordance with the case-law of the Court of Justice.

60. In that regard, it should be noted that BMB does not call into question, as such, the General Court's finding in paragraph 29 of the judgment under appeal. BMB merely states that, as there is no case-law of the Court of Justice in similar cases relating to applications for a declaration of invalidity, pursuant to Article 25(1)(e) of Regulation No 6/2002, of a design with distinctive word elements, the General Court ought to have taken into consideration the judgment of the tribunal de grande instance de Paris (Regional Court, Paris) and, as a result, committed an error of law in that regard. Thus, BMB fails to set out the reasons why the fact that there is no case-law of the Court of Justice, if this would prove to be the case, should establish that the General Court committed an error of law in paragraph 29 of the judgment under appeal. Moreover, BMB does not raise any specific argument regarding any error of law committed by the General Court in its interpretation of Article 25(1)(e) of Regulation No 6/2002.

61. Moreover, if the purpose of BMB's claim should be understood as criticising the General Court for failing to follow the judgment of the tribunal de grande instance de Paris (Regional Court, Paris), it should be noted that BMB does not set out the reason why other legal precedents of French courts, such as those submitted by Ferrero before the General Court and the Court of Justice, which run counter to that judgment, should not have been taken into consideration by the General Court.

62. It should be noted in that regard that, in any event, the judgment of the tribunal de grande instance de Paris (Regional Court, Paris), handed down in a dispute connected to trade mark infringement proceedings, cannot bind the adjudicating bodies of EUIPO in invalidity proceedings, such as those in question in the present case, as neither the parties nor the subject matter of those proceedings are identical (see, by analogy, judgment of 21 July 2016, *Apple and Pear Australia and Star Fruits Diffusion v EUIPO*, C-226/15 P, EU:C:2016:582, paragraphs 52 and 63).

63. It follows that the fourth part of the single ground of appeal must be rejected.

64. In those circumstances, the appeal must be dismissed in its entirety.

#### **Costs**

65. Under Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is unfounded, the Court is to make a decision as to costs. Under Article 138(1) of those Rules, applicable 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.

66. Since EUIPO and Ferrero have applied for the appellant to pay the costs and the appellant's single ground of appeal has been unsuccessful, it must be ordered to pay the costs of the appeal proceedings.

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

1. Dismisses the appeal;
2. Orders BMB sp. z o.o. to pay the costs.

Lycourgos

Juhász

Jarukaitis

Delivered in open court in Luxembourg on 6 March 2019.

A. Calot Escobar

C. Lycourgos

Registrar

President of the Chamber

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