

Court of Justice EU, 26 October 2016, Westermann v EUIPO



TRADEMARK LAW

The General Court did not err in law by not taking in consideration the revocation of the old trademark in the decision on likelihood of confusion.

- **Revocation of the old trademark was before the date of the appealed decision of the General Court**

29. In addition, the Court has already held that the expiry of an earlier mark after the action had been brought before the General Court did not deprive the decision of the Board of Appeal of EUIPO of its purpose or of its effects. The assessment in that decision that there was a likelihood of confusion between the marks at issue therefore continued to produce its effects at the time the General Court delivered its judgment (order of 8 May 2013, *Cadila Healthcare v OHIM*, C-268/12 P, not published, EU:C:2013:296, paragraphs 31 to 34).

30. In view of those considerations, and since, in the present case, the actual date of revocation of the earlier mark which formed the basis for the opposition to the registration of the mark applied for by Westermann, namely 13 June 2013, is subsequent to the decision at issue, which is dated 3 April 2013, it must be held that the General Court was not required, during its review of the lawfulness of the decision at issue, to take into account the EUIPO decision revoking that earlier mark.

- **To hold that the General Court is required to take into consideration a EUIPO decision revoking an earlier mark on which an opposition is based, would be contrary to the settled case-law of the Court according to which the General Court cannot annul or alter such a decision on grounds which come into existence subsequent to its adoption**

31. It must be added that, in accordance with Article 55(1) of Regulation No 207/2009, in the event of revocation, the EU trade mark shall be deemed not to have had, as from the date of the application for revocation, the effects specified in that regulation.

32. To hold that the General Court is required to take into consideration a EUIPO decision revoking an earlier mark on which an opposition is based, even though this occurred after the adoption of the decision of the Board of Appeal of EUIPO finding the opposition well founded, would be contrary to the settled case-law of the Court, cited in paragraph 27 of the present judgment, according to which the General Court cannot annul or alter such a decision on grounds which come into existence subsequent to its adoption.

33. In the light of the foregoing, it must be held that the General Court did not err in law in its review as to whether the assessment of the likelihood of confusion

between the marks at issue carried out by the Second Board of Appeal of EUIPO in the decision at issue was well founded, since, at the date on which that decision was adopted, the earlier mark which formed the basis for the opposition to the registration of the mark applied for by Westermann was producing the effects specified in Regulation No 207/2009.

34. The argument raised by Westermann in that regard must therefore be rejected as unfounded.

Source: curia.europa.eu

Court of Justice EU, 26 October 2016

(M. Berger, A. Borg Barthet, F. Biltgen, Y. Bot)
JUDGMENT OF THE COURT (Tenth Chamber)

26 October 2016 (*)

(Appeal — EU trade mark application — Figurative mark containing the word elements ‘bambino’ and ‘lük’ — Opposition proceedings — Earlier EU figurative mark containing the word element ‘bambino’ — Partial refusal of registration — Revocation of the earlier mark on which the opposition was based — Letter from the applicant informing the General Court of that revocation — Refusal of the General Court to add that letter to the case file — Failure to state reasons)

In Case C-482/15 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 9 September 2015,

Westermann Lernspielverlage GmbH, formerly Westermann Lernspielverlag GmbH, established in Braunschweig (Germany), represented by A. Nordemann and M. Maier, Rechtsanwälte, applicant,

the other party to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by J. Crespo Carrillo, acting as Agent, defendant at first instance,

THE COURT (Tenth Chamber),

composed of M. Berger, President of the Chamber, A. Borg Barthet and F. Biltgen (Rapporteur), Judges,

Advocate General: Y. Bot,

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, Westermann Lernspielverlage GmbH, formerly Westermann Lernspielverlag GmbH (‘Westermann’) asks the Court to set aside the judgment of the General Court of the European Union of 15 July 2015, *Westermann Lernspielverlag v OHIM — (bambinoLÜK)* (T-333/13, not published, ‘the judgment under appeal’, EU:T:2015:490), by which the General Court dismissed its action for annulment of the decision of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 3 April 2013 (Case R 1323/2012-2), relating to

opposition proceedings between Diset SA and Westermann ('the decision at issue').

Legal context

2. Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), in the version applicable to the present case, provides, in Article 8(1)(b):

'Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

...

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.'

3. Article 65 of that regulation, which is entitled 'Actions before the Court of Justice', provides, in paragraphs 1, 2 and 3 thereof:

'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 Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.

3. The Court of Justice has jurisdiction to annul or to alter the contested decision.'

4. Under Article 69(c) and (d) of the Rules of Procedure of the General Court, proceedings may be stayed:

...

(c) at the request of a main party with the agreement of the other main party;

(d) in other particular cases where the proper administration of justice so requires.'

5. Article 77 of the Rules of Procedure of the General Court, entitled 'Information relating to service', states:

'1. For the purposes of the proceedings, the application shall state whether the method of service to which the applicant's representative agrees is that referred to in Article 57(4) or telefax.

2. If the application does not comply with the requirements referred to in paragraph 1, for the purposes of the proceedings service on the party concerned shall be effected, until the defect has been remedied, by registered letter addressed to that party's representative.

Service shall then be deemed to be duly effected by the lodging of the registered letter at the post office of the place in which the General Court has its seat.'

Background to the dispute

6. On 5 May 2010, Westermann filed an application for registration of an EU trade mark at EUIPO under Regulation No 207/2009.

7. Registration as a mark was sought for the following figurative sign:



8. The goods in respect of which registration was sought are in Classes 9, 16 and 28 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 ('the Nice Agreement'), and correspond, for each of those classes, to the following description:

– Class 9: *'Image, sound, image and sound, and data carriers of all kinds (included in class 9), in particular video cassettes, recording discs, music cassettes, CDs, picture discs, DVDs, CD-ROMs, CDIs, floppy discs, in particular being electronic publishing products, and for instructional and teaching purposes, and apparatus for video and computer games adapted for use with television receivers, in particular for instructional and teaching purposes; software, in particular for instructional and teaching purposes; data processing equipment, computers and other computer hardware, and parts and accessories therefor (included in class 9), all goods other than in connection with motor vehicles or motor vehicle parts of all kinds';*

– Class 16: *'Printed matter and published materials of all kinds (included in class 16), in particular books, exercise books, files, periodicals, newspapers, calendars, posters, sheets, transparencies, films, illustrated maps, index cards, geographical maps and wall charts, in particular for instructional and teaching purposes; instructional and teaching material (except apparatus), in particular in the form of printed matter, games, globes, wall boards and drawing implements for wall boards; photographs (prints and originals); posters; writing implements, in particular fountain pens, ballpoint pens, coloured pencils and pencils; office requisites (except furniture), in particular stamps (seals), inking pads, inks, letter openers, paper knives, letter trays, document files, desk pads, punches, loose-leaf files, paper clips and staples; transfers (decalcomanias), rub-down transfers, paper and plastic stickers';*

– Class 28: *'Games, in particular board games, dominoes, parlour games, card games, educational games and games of strategy, in traditional and in electronic form (except as apparatus adapted for use with television receivers); toys and playthings; electronic video and games, except as apparatus adapted for use with television receivers, in particular for instructional and teaching purposes'.*

9. The EU trade mark application was published in the European Union Trade Marks Bulletin No 2010/122 of 6 July 2010.

10. On 14 September 2010, Diset filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 to registration of the mark applied for in respect of the goods referred to in paragraph 8 above.

11. The opposition was based, inter alia, on the earlier EU figurative mark, registered on 6 July 2004 under No

3915121 in respect of goods and services in Classes 16, 28 and 41 of the Nice Agreement, represented below:



12. The goods and services covered by the earlier trade mark are in Classes 16, 28 and 41 of the Nice Agreement, and correspond, for each of those classes, to the following description:

- Class 16: *'Publications, magazines, books and children's stories'*;
- Class 28: *'Building blocks and games and educational playthings for early childhood, excluding dolls'*;
- Class 41: *'Educational services; providing of training; entertainment; sporting and cultural activities'*.

13. The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation No 207/2009.

14. On 25 May 2012, the Opposition Division of EUIPO upheld the opposition in part. It found that there was a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009 between the signs at issue, save as regards the goods in Class 16 of the Nice Arrangement, covered by the EU trade mark application, corresponding to the following description: *'Writing implements, in particular fountain pens, ball-point pens, coloured pencils and pencils; office requisites (except furniture), in particular stamps (seals), inking pads, inks, letter openers, paper knives, letter trays, document files, desk pads, punches, loose-leaf files, paper clips and staples; transfers (decalcomanias), rub-down transfers, paper and plastic stickers'*.

15. On 18 July 2012, Westermann lodged a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division of EUIPO.

16. By the decision at issue, the Second Board of Appeal of EUIPO upheld the appeal in part, allowing the registration of the trade mark applied for in respect of *'software, in particular for instructional and teaching purposes (all goods other than in connection with motor vehicles or motor vehicle parts of all kinds) and 'data-processing equipment, computers and other computer hardware, and parts and accessories thereof (included in Class 9) (all goods other than in connection with motor vehicles or motor vehicle parts of all kinds)'*, all in Class 9 of the Nice Agreement, and dismissed the appeal in respect of the remaining goods in Classes 9, 16 and 28 of the Nice Agreement.

The procedure before the General Court and the judgment under appeal

17. In support of its action at first instance, Westermann relied on a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 207/2009.

18. The General Court rejected that plea in law as unfounded and, accordingly, dismissed the action brought by Westermann.

Forms of order sought by the parties before the Court of Justice

19. Westermann claims that the Court should set aside the judgment under appeal, refer the case back to the General Court and order EUIPO to pay the costs.

20. EUIPO claims that the Court should dismiss the appeal and order Westermann to pay the costs.

The appeal

21. Westermann relies on two grounds in support of its appeal, alleging, respectively, breach of the right to be heard and the right to a fair trial, and infringement of Article 8(1)(b) of Regulation No 207/2009.

The second ground of appeal

Arguments of the parties

22. By its second ground of appeal, which it is appropriate to examine first, Westermann submits that the General Court erred in law and distorted the facts by taking into account — in its review as to whether the assessment of the likelihood of confusion between the marks at issue carried out by the Second Board of Appeal of EUIPO in the decision at issue was well founded — the earlier mark which formed the basis for the opposition to the registration of the mark applied for by Westermann, even though that earlier mark had been revoked and therefore no longer had any effect at the time Westermann brought its action at first instance.

23. It submits that according to the case-law of the Court and, in particular, the [judgment of 11 November 1997, SABEL \(C-251/95, EU:C:1997:528, paragraph 22\)](#), the likelihood of confusion between the marks at issue must be assessed globally, taking into account all

factors relevant to the circumstances of the case and, in particular, the overall impression given by those marks.

24. Westermann submits that the General Court should therefore have remitted the case to the Second Board of Appeal of EUIPO in order to have the opposition assessed on the basis of Diset's marks other than that earlier mark.

25. In addition, Westermann argues that the General Court erred in law when it considered, first, that the element 'bambino' constituted the dominant element in the marks at issue and that the element 'lük' was negligible because of its secondary position in the earlier composite mark and, secondly, that the figurative element representing a stylised child was less distinctive than the term 'bambino' and was therefore negligible in the composite mark, and when it concluded that an element with a weak distinctive character can constitute a dominant element in a composite mark, can lead to neglecting other elements of the mark and thus lead to a similarity of the signs and a likelihood of confusion.

26. EUIPO contends that the second ground of appeal must be rejected.

Findings of the Court

27. It must be noted, first of all, that, according to the Court's settled case-law, under Article 65 (2) of Regulation No 207/2009, the General Court may annul or alter a decision of a Board of Appeal of EUIPO only 'on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of [that] Regulation or of any rule of law relating to their application or misuse of power'. It follows that 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. The General Court may not, however, annul or alter that decision on grounds which come into existence subsequent to its adoption (see judgments of 11 May 2006, *Sunrider v OHIM*, C-416/04 P, EU:C:2006:310, paragraphs 54 and 55, and [13 March 2007, *OHIM v Kaul*, C-29/05 P, EU:C:2007:162, paragraphs 52 and 53](#), and order of 30 June 2010, *Royal Appliance International v OHIM*, C-448/09 P, not published, EU:C:2010:384, paragraphs 43 and 44).

28. The Court therefore held that a decision which came to be made by a national court in relation to the revocation of the earlier mark on which the opposition is based could not be taken into account by the General Court in its review of the lawfulness of the decision of the Board of Appeal of EUIPO (see, to that effect, judgments of 11 May 2006, *Sunrider v OHIM*, C-416/04 P, EU:C:2006:310, paragraph 55, and [13 March 2007, *OHIM v Kaul*, C-29/05 P, EU:C:2007:162, paragraph 53](#), and order of 30 June 2010, *Royal Appliance International v OHIM*, C-448/09 P, not published, EU:C:2010:384, paragraph 45).

29. In addition, the Court has already held that the expiry of an earlier mark after the action had been brought before the General Court did not deprive the decision of the Board of Appeal of EUIPO of its purpose or of its effects. The assessment in that decision that there was a likelihood of confusion between the marks at issue therefore continued to produce its effects at the time the General Court delivered its judgment (order of 8 May 2013, *Cadila Healthcare v OHIM*, C-268/12 P, not published, EU:C:2013:296, paragraphs 31 to 34).

30. In view of those considerations, and since, in the present case, the actual date of revocation of the earlier mark which formed the basis for the opposition to the registration of the mark applied for by Westermann, namely 13 June 2013, is subsequent to the decision at issue, which is dated 3 April 2013, it must be held that the General Court was not required, during its review of the lawfulness of the decision at issue, to take into account the EUIPO decision revoking that earlier mark.

31. It must be added that, in accordance with Article 55(1) of Regulation No 207/2009, in the event of revocation, the EU trade mark shall be deemed not to have had, as from the date of the application for revocation, the effects specified in that regulation.

32. To hold that the General Court is required to take into consideration a EUIPO decision revoking an

earlier mark on which an opposition is based, even though this occurred after the adoption of the decision of the Board of Appeal of EUIPO finding the opposition well founded, would be contrary to the settled case-law of the Court, cited in paragraph 27 of the present judgment, according to which the General Court cannot annul or alter such a decision on grounds which come into existence subsequent to its adoption.

33. In the light of the foregoing, it must be held that the General Court did not err in law in its review as to whether the assessment of the likelihood of confusion between the marks at issue carried out by the Second Board of Appeal of EUIPO in the decision at issue was well founded, since, at the date on which that decision was adopted, the earlier mark which formed the basis for the opposition to the registration of the mark applied for by Westermann was producing the effects specified in Regulation No 207/2009.

34. The argument raised by Westermann in that regard must therefore be rejected as unfounded.

35. As to the remainder, it must be recalled that, in accordance with Article 256(1) TFEU and the first subparagraph 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 has 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 (see judgment of 11 May 2006, *Sunrider v OHIM*, C-416/04 P, EU:C:2006:310, paragraph 49 and the case-law cited, and the order of 4 June 2015, *United Autoglas Deutschland v OHIM*, C-579/14 P, not published, EU:C:2015:374, paragraph 25 and the case-law cited).

36. Furthermore, such a distortion must be obvious from the documents in the file, without there being any need to carry out a new assessment of the facts and the evidence (see, to that effect, [judgment of 2 September 2010, *Calvin Klein Trademark Trust v OHIM*, C-254/09 P, EU:C:2010:488, paragraph 50 and the case-law cited](#)).

37. Accordingly, Westermann's line of argument relating to the General Court's assessment of the similarity between the signs at issue and, in particular, between the elements 'bambino', 'lük' and the figurative element representing a stylised child, is inadmissible since, under the guise of an alleged error of law, that line of argument actually seeks to contest, without invoking any distortion, the General Court's assessment of those factual elements, which falls outside the jurisdiction of the Court in an appeal.

38. Accordingly, the second ground of appeal must be rejected as in part inadmissible and in part unfounded.

The first ground of appeal

Arguments of the parties

39. By its first ground of appeal, Westermann criticises the General Court for refusing to add to the case file a letter of 12 June 2015 — by which it informed the General Court of the existence of the decision of the

Second Board of Appeal of EUIPO of 22 May 2015 (Case R 2209/2014-2), revoking, with retroactive effect from 13 June 2013, the earlier mark on which the opposition was based — on the ground that that document was not provided for in the Rules of Procedure of the General Court.

40. According to Westermann, by refusing to take into consideration that letter and to mention, in the judgment under appeal, the fact that the earlier mark on which the opposition was based no longer existed when that judgment was delivered, the General Court prevented it from adducing relevant evidence and, consequently, breached its right to be heard and its right to a fair trial.

41. In its reply, Westermann adds that the decision at issue and the judgment under appeal breached its fundamental right to property inasmuch as they rejected its EU trade mark application.

42. In addition, Westermann argues that, by refusing, without stating reasons, to grant its requests at first instance for a stay of the proceedings, the General Court breached its right to a fair trial and infringed Article 69(c) and (d) and Article 77 of the Rules of Procedure of the General Court.

43. According to Westermann, since those requests were duly reasoned, and necessary in order to ensure the proper administration of justice, and since they were not opposed by EUIPO, the General Court should have granted them.

44. EUIPO contends that the first ground of appeal should be rejected.

Findings of the Court

45. It must be noted, first of all, that it can be seen from paragraphs 30 and 33 of the present judgment that (i) the General Court was not required, in its review of the legality of the decision at issue, to take into account the EUIPO decision revoking the earlier mark on which the opposition to the registration of mark applied for by Westermann was based and (ii) at the date on which the decision at issue was adopted, that earlier mark was producing the effects specified in Regulation No 207/2009.

46. In those circumstances, the Court must reject as ineffective both the argument alleging that, by refusing, without stating reasons, to add to the case file the letter of 12 June 2015 by which Westermann informed it of the existence of the EUIPO decision revoking the earlier mark and that, by omitting to mention that information in the judgment under appeal, the General Court breached Westermann's right to be heard and its right to a fair trial, and the argument that the General Court wrongly, and without stating reasons, rejected Westermann's requests for a stay of the proceedings.

47. Those arguments are not capable of calling into question the General Court's conclusion in the judgment under appeal, according to which the Second Board of Appeal of EUIPO was correct to find that there was a likelihood of confusion between the marks at issue.

48. As for the argument alleging that the decision at issue and the judgment under appeal infringed

Westermann's fundamental right to property, it must be rejected as inadmissible, since it was raised for the first time at the reply stage.

49. Consequently, the first ground of appeal should be rejected as in part inadmissible and in part ineffective.

50. Since none of the grounds of appeal relied on by Westermann can succeed, the appeal must be rejected in its entirety.

Costs

51. Under 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 EUIPO has applied for costs and Westermann has been unsuccessful in its pleadings, Westermann must be ordered to pay the costs of the present proceedings.

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

1. Dismisses the appeal;
2. Orders Westermann Lernspielverlage GmbH to pay the costs.

* Language of the case: English