

Court of Justice EU, 11 oktober 2017, Cactus



TRADE MARK LAW

Judgments CIPA V Registrar and Praktiker Bau v Deutsche Patent und Markenamt do not relate to earlier trade marks registered before the date of those judgments

- As the Advocate General observed in point 56 of his Opinion, however — following the approach adopted in the IP Translator judgment — the line of authority derived from the Praktiker Bau judgment concerns only applications for registration as EU trade marks and does not concern the scope of the protection of trade marks registered at the date of that judgment's delivery.

46. Such an approach is moreover consistent, as the Advocate General noted in point 57 of his Opinion, with the principles of legal certainty and protection of legitimate expectations.

47. Thus, the General Court cannot be criticised for having considered, in paragraph 38 of the judgment under appeal, that Cactus was not required to specify the goods or types of goods to which the retail trade related.

48. Thus, it is apparent from examining the judgments in IP Translator — as interpreted by the Court in the Brandconcern judgment — and Praktiker Bau that the scope of the protection of a trade mark registered before the delivery of those judgments, such as Cactus' word mark, registered on 18 October 2002, and Cactus' figurative mark, registered on 6 April 2001, cannot be affected by the authority derived from those judgments in so far as they concern only new applications for registration as EU trade marks.

Use of only the figurative element of a composite mark is "genuine use" if the distinctive character of the mark as registered is not altered

- It follows that the condition of 'genuine use' in the sense of point (a) of the second subparagraph of Article 15(1) of the same regulation is satisfied even where only the figurative element of a composite mark is used, as long as the distinctive character of that mark, as registered, is not altered.

65. The Court has already held in that regard that it follows directly from the wording of point (a) of the second subparagraph of Article 15(1) of that regulation that the use of the trade mark in a form which differs from the form in which it was registered is regarded as use for the purposes of the first subparagraph of that article provided that the distinctive character of the mark in the form in which it was registered is not altered (judgment of 18 July 2013, Specsavers International Healthcare and Others, C-252/12, EU:C:2013:497, paragraph 21).

66. It should be recalled that, in so far as it does not impose strict conformity between the form in which the trade mark is used and the form in which the mark was registered, the purpose of point (a) of the second subparagraph of Article 15(1) of that regulation is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (see, to that effect, judgment of 18 July 2013, Specsavers International Healthcare and Others, C-252/12, EU:C:2013:497, paragraph 29).

Source: curia.europa.eu

Court of Justice EU, 11 oktober 2017

(T. von Danwitz, C. Vajda, E. Juhász, K. Jürimäe (Rapporteur) and C. Lycourgos)

JUDGMENT OF THE COURT (Fourth Chamber)

11 October 2017 (*)

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Figurative mark containing the word elements 'CACTUS OF PEACE CACTUS DE LA PAZ' — Opposition by the proprietor of word and figurative EU trade marks containing the word element 'Cactus' — Nice Classification — Article 28 — Point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 — Genuine use of the mark in an abbreviated form)

In Case C-501/15 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 22 September 2015,

European Union Intellectual Property Office (EUIPO), represented by A. Folliard-Monguiral, acting as Agent,

appellant,

the other party to the proceedings being:

Cactus SA, established in Bertrange (Luxembourg), represented by K. Manhaeve, avocate,

applicant at first instance,

Isabel Del Rio Rodríguez, residing in Malaga (Spain),

party to the proceedings before the Board of Appeal of EUIPO,

THE COURT (Fourth Chamber),

composed of T. von Danwitz, President of the Chamber, C. Vajda, E. Juhász, K. Jürimäe (Rapporteur) and C. Lycourgos, Judges,

Advocate General: N. Wahl,

Registrar: K. Malacek, Administrator,

having regard to the written procedure and further to the hearing on 29 March 2017,

after hearing the Opinion of the Advocate General at the sitting on 17 May 2017,

gives the following

Judgment

1. By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court of Justice to set aside the judgment of the General Court of the European Union of 15 July 2015, *Cactus v OHIM* —

Del Rio Rodríguez (CACTUS OF PEACE CACTUS DE LA PAZ) (T-24/13, not published, ‘the judgment under appeal’, EU:T:2015:494), by which the General Court annulled in part the decision of the Second Board of Appeal of EUIPO of 19 October 2012 (Case R 2005/2011-2) relating to opposition proceedings between Cactus SA and Ms Isabel Del Rio Rodríguez (‘the decision at issue’).

Legal context

2. Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), which came into force on 13 April 2009, repealed and replaced Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

3. Article 15(1) of Regulation No 207/2009, entitled ‘Use of [EU] trade marks’, provides:

‘If, within a period of five years following registration, the proprietor has not put the [EU] trade mark to genuine use in the [Union] in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the [EU] trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

(a) use of the [EU] trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

...’

4. Article 28 of that regulation, entitled ‘Classification’, provides:

‘Goods and services in respect of which [EU] trade marks are applied for shall be classified in conformity with the system of classification specified in [Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1)].’

5. Article 42 of Regulation No 207/2009, entitled ‘Examination of opposition’, provides, in paragraph 2 thereof:

‘If the applicant so requests, the proprietor of an earlier [EU] trade mark who has given notice of opposition shall furnish proof that, during the five-year period preceding the date of publication of the [EU] trade mark application, the earlier [EU] trade mark has been put to genuine use in the [Union] in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier [EU] trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier [EU] trade mark has been used in relation to only part of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.’

6. Rule 2 of Regulation No 2868/95, entitled ‘List of goods and services’, provides:

‘1. The common classification referred to in Article 1 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, shall be applied to the classification of the goods and services (“the Nice Agreement”).

2. The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.

3. The goods and services shall, in principle, be grouped according to the classes of the Nice Classification, each group being preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes under that Classification.

4. The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.’

7. By two communications, one published in 2003, the other in 2012, the President of EUIPO issued guidance concerning the use of class headings of goods provided for in the Nice Agreement.

8. The first paragraph of Point IV of Communication No 4/03 of the President of EUIPO, of 16 June 2003, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (‘Communication No 4/03’), stated:

‘The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class.’

9. On 20 June 2012 the President of EUIPO adopted Communication No 2/12, repealing Communication No 4/03 and concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (‘Communication No 2/12’). Point V of that communication states:

‘As regards [EU] trade marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, [EUIPO] considers that the intention of the applicant, in view of the contents of the previous Communication No 4/03, was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made.’

Background to the dispute

10. The background to the dispute is set out in paragraphs 1 to 12 of the judgment under appeal and may be summarised as follows.

11. On 13 August 2009 Ms Isabel Del Rio Rodríguez filed an application to register the following figurative sign as an EU trade mark with EUIPO, under Regulation No 207/2009:

CACTUS OF PEACE

CACTUS DE LA PAZ

12. The goods and services in respect of which registration was sought are in Classes 31, 39 and 44 of the Nice Agreement.

13. On 12 March 2010 Cactus filed a notice of opposition, pursuant to Article 41 of Regulation No 207/2009, to the registration of the mark applied for in respect of all the goods and services covered by it.

14. The opposition was based on the following earlier marks:

- the EU word mark CACTUS, registered on 18 October 2002 under number 963694, for goods and services in Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42 of the Nice Agreement, and
- the EU figurative mark, reproduced below, registered on 6 April 2001 under number 963595, for the same goods and services as those covered by the earlier word mark, with the exception of ‘foodstuffs not included in other classes; natural plants and flowers, grains; fresh fruits and vegetables’ in Class 31 of that agreement:



15. The opposition was based on Article 8(1)(b) of Regulation No 207/2009.

16. By decision of 2 August 2011, the Opposition Division upheld the opposition for ‘seeds, natural plants and flowers’ in Class 31 of the Nice Agreement and ‘gardening, plant nurseries, horticulture’ in Class 44 of that agreement, which are covered by the earlier word mark.

17. The Opposition Division considered, inter alia, that, following Ms Del Rio Rodríguez’s request that Cactus prove that the earlier marks had been put to genuine use, the evidence submitted by the applicant showed genuine use of the earlier word mark for the goods in Class 31 of the Nice Agreement, and for ‘retailing of natural plants and flowers, grains; fresh fruits and vegetables’ services in Class 35 of that agreement.

18. Registration of the trade mark applied for was therefore refused for the goods and services mentioned in paragraph 16 above, but accepted for the services in Class 39 of the Nice Agreement.

19. On 28 September 2011 Ms Del Rio Rodríguez filed an appeal with EUIPO against the Opposition Division’s decision.

20. By the decision at issue, the Second Board of Appeal of EUIPO upheld the appeal and dismissed the opposition in its entirety. In particular, it found that the Opposition Division had erred in considering that Cactus had adduced proof of genuine use of the earlier trade marks in respect of ‘retailing of natural plants and

flowers, grains; fresh fruits and vegetables’ services in Class 35 of the Nice Agreement.

The procedure before the General Court and the judgment under appeal

21. By application lodged at the Registry of the General Court on 21 January 2013, Cactus brought an action for annulment of the decision at issue.

22. In support of its action, Cactus relied on, in essence, three pleas in law, alleging respectively (i) infringement of Article 42(2) of Regulation No 207/2009, (ii) infringement of Articles 75 and 76(1) of that regulation and (iii) infringement of Article 76(2) of that regulation.

23. By the judgment under appeal, the General Court upheld the first two pleas and rejected the third plea. Consequently, the General Court annulled the decision at issue to the extent that it, first, rejected the opposition on the ground that ‘retailing of natural plants and flowers, grains; fresh fruits and vegetables’ services in Class 35 of the Nice Agreement was not covered by the earlier trade marks and, second, rejected the opposition based on ‘natural plants and flowers, grains’ in Class 31 of that agreement; it dismissed the action as to the remainder.

Forms of order sought by the parties

24. By its appeal, EUIPO claims that the Court should:
- allow the appeal in its entirety and set aside the judgment under appeal, and
 - order Cactus to pay the costs.
25. Cactus claims that the Court should:
- dismiss the appeal in its entirety, and
 - order EUIPO to pay the costs.

The appeal

26. In support of its appeal, EUIPO raises two grounds of appeal based, respectively, on an infringement of Article 28 of Regulation No 207/2009, read in conjunction with Rule 2 of Regulation No 2868/95, and an infringement of Article 42(2) of Regulation No 207/2009, read in conjunction with point (a) of the second subparagraph of Article 15(1) of that regulation.

The first ground of appeal

Arguments of the parties

27. By its first ground of appeal, EUIPO criticises the General Court for having infringed Article 28 of Regulation No 207/2009, read in conjunction with Rule 2 of Regulation No 2868/95, in adopting an erroneous interpretation of the judgments of 19 June 2012, [Chartered Institute of Patent Attorneys \(C-307/10, ‘the judgment in IP Translator’, EU:C:2012:361\)](#), and of 7 July 2005, [Praktiker Bau- und Heimwerkermärkte \(C-418/02, ‘the judgment in Praktiker Bau’, EU:C:2005:425\)](#). That erroneous interpretation led it to consider, in paragraphs 36 and 37 of the judgment under appeal, that the use of all the general indications of the class heading in Class 35 of the Nice Agreement extends the protection of the earlier trade marks to all the services included in that class, including services consisting in retailing goods.

28. EUIPO recalls that Communication No 4/03 had initially authorised the use of the general indications composing the class headings of the Nice Agreement.

According to the wording of that communication, the designation of the whole class heading of a particular class of that agreement constituted a claim to all the goods or services falling within that particular class, including those not mentioned in the alphabetical list. Thus, none of those indications was regarded as too vague or indefinite.

29. The Court overturned that approach in the judgment in [IP Translator](#). According to EUIPO, it is apparent from paragraphs 57 to 64 of that judgment that the general indications of a particular class may cover only the goods or services included in the alphabetical list of that class, provided two cumulative conditions are fulfilled: the individual terms making up the class heading must be sufficiently ‘clear and precise’, and the application must reflect the applicant’s intention to cover all the goods or services included in that alphabetical list.

30. Following the delivery of that judgment, Communication No 4/03 was repealed and replaced by Communication No 2/12 which limits, in relation to EU trade marks applied for before 21 June 2012, the scope of the general indications of a class heading of the Nice Agreement to all the goods or services in the alphabetical list of a particular class, as opposed to all the goods and services in that class.

31. In the present case, EUIPO does not dispute that retail services fall within Class 35 of the Nice Agreement. However, neither retailing services as such, nor ‘retailing of natural plants and flowers, grains; fresh fruits and vegetables’ are included in the alphabetical list of that class. EUIPO thus considers that the General Court erred in finding that the earlier marks were protected in respect of retail services.

32. EUIPO adds that, in finding that Class 35 of the Nice Agreement covers retail services for all possible goods, the General Court also made an error of interpretation in respect of the judgment in [Praktiker Bau](#), which provides that the applicant is required to specify the goods or types of goods to which the retail services relate.

33. Thus, in holding, in paragraph 38 of the judgment under appeal, that the judgment in [Praktiker Bau](#) does not apply to trade marks registered before the date of delivery of that judgment, the General Court disregarded the retroactive effect of case-law, which may be limited only in exceptional circumstances. Indeed, the Court of Justice did not limit the effects of the judgment in [Praktiker Bau](#). The General Court was therefore wrong not to apply the interpretation adopted in that judgment to the earlier marks.

34. Cactus disputes the merits of all those arguments.

Findings of the Court

35. EUIPO criticises, in essence, the General Court for having misread the judgments in [IP Translator](#) and [Praktiker Bau](#) in holding that the authority derived from those judgments did not have a retroactive effect and for having concluded — wrongly — that the designation of the class heading of Class 35 of the Nice Agreement covers all the services within that class, including retail services in respect of any goods.

EUIPO takes the view that that line of authority applies retroactively and that it should have been applied to the earlier marks, regardless of the fact that those marks were registered before the delivery of those judgments.

36. In the judgment under appeal, the General Court considered, in paragraphs 36 to 38, that, in the light of the principle of legal certainty, it was not appropriate to apply the authority derived from the judgments in [IP Translator](#) and [Praktiker Bau](#) to the earlier marks given that they had been registered before those judgments were delivered. The General Court thereby concluded that, for the earlier marks, the designation of the class heading of Class 35 of the Nice Agreement covered all the services within that class, including the services consisting in the retail of any goods.

37. As regards, in the first place, the scope of the judgment in [IP Translator](#), it should be recalled that, in paragraph 61 of that judgment, the Court held that, in order to comply with the requirements of clarity and precision, an applicant for a trade mark who uses all of the general indications of a particular class heading of the Nice Classification to identify the goods or services for which protection of the trade mark is sought must specify whether his application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.

38. The Court indicated, in paragraphs 29 and 30 of the judgment of 16 February 2017, [Brandconcern v EUIPO and Scooters India \(C-577/14 P, ‘the judgment in Brandconcern’, EU:C:2017:122\)](#), that the [IP Translator](#) judgment provided clarifications only on the requirements relating to new EU trade mark registration applications, and thus does not concern trade marks that were already registered at the date of that latter judgment’s delivery. The Court thus inferred, in paragraph 31 of the judgment in [Brandconcern](#), that it therefore could not be considered that the Court, by the [IP Translator](#) judgment, had sought to question the validity of the approach set out in Communication No 4/03 as regards trade marks registered before the delivery of that latter judgment.

39. Communication No 2/12 cannot call into question that case-law and thus lead to the scope of protection of trade marks registered before the delivery of the [IP Translator](#) judgment for goods or services designated by the general indications of the class headings of the Nice Agreement being limited solely to the goods or services mentioned in the alphabetical list of that class and to that protection being denied, in accordance with Communication No 4/03, to all the goods and services within that class.

40. As the Advocate General observed [in points 45 and 46 of his Opinion](#), the scope of the protection afforded by trade marks that have been registered may not be altered on the basis of a non-binding communication which has no function other than to

provide clarification for applicants as to the practices of EUIPO.

41. During the hearing before the Court, EUIPO contended that it could not be inferred from the *Brandconcern* judgment that the protection afforded by the earlier marks could extend beyond the goods or services mentioned in the alphabetical list of the class concerned. It observed that, in that judgment, the Court confirmed the reasoning adopted by the General Court, according to which the registration of an earlier trade mark referring to a class heading was to be interpreted as seeking to protect that trade mark exclusively for all the goods in the alphabetical list of the relevant class and not beyond, in accordance with the provisions of Communication No 2/12 relating to trade marks registered before the delivery of the judgment in *IP Translator*.

42. It is nevertheless appropriate to note in that regard, as the Advocate General observed in [points 48 to 50 of his Opinion](#), that such a reading of the *Brandconcern* judgment is erroneous. That judgment did not concern the distinction between, on the one hand, the goods or services appearing in the alphabetical list of a class of the Nice Agreement and, on the other hand, overall and more broadly, goods or services covered by the heading of that class. It was concerned solely with determining whether it was the literal meaning of the relevant class heading that was to be taken into account or, on the contrary, whether it was to be considered that such a heading covered the goods appearing in the alphabetical list of that class. The judgment in *Brandconcern* cannot, therefore, be read as having limited the scope of the registration of earlier trade marks using the heading to solely the goods or services appearing in the alphabetical list of that class.

43. It follows from the foregoing that the General Court was right to hold that the authority derived from the *IP Translator* judgment did not apply to the earlier trade marks.

44. As regards, in the second place, the scope of the judgment in *Praktiker Bau*, it is important to recall that, in paragraphs 39 and 50 of that judgment, the Court held that, although retail trade in goods constitutes a service in Class 35 of the Nice Agreement, the applicant must nevertheless be required to specify, for the purposes of registering a trade mark, the goods or the types of goods to which the retail trade relates.

45. As the Advocate General observed in [point 56 of his Opinion](#), however — following the approach adopted in the *IP Translator* judgment — the line of authority derived from the *Praktiker Bau* judgment concerns only applications for registration as EU trade marks and does not concern the scope of the protection of trade marks registered at the date of that judgment's delivery.

46. Such an approach is moreover consistent, as the Advocate General noted in [point 57 of his Opinion](#), with the principles of legal certainty and protection of legitimate expectations.

47. Thus, the General Court cannot be criticised for having considered, in paragraph 38 of the judgment

under appeal, that Cactus was not required to specify the goods or types of goods to which the retail trade related.

48. Thus, it is apparent from examining the judgments in *IP Translator* — as interpreted by the Court in the *Brandconcern* judgment — and *Praktiker Bau* that the scope of the protection of a trade mark registered before the delivery of those judgments, such as Cactus' word mark, registered on 18 October 2002, and Cactus' figurative mark, registered on 6 April 2001, cannot be affected by the authority derived from those judgments in so far as they concern only new applications for registration as EU trade marks.

49. Last, to the extent that Article 28(8) of Regulation No 207/2009, as amended by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), lays down a transitional provision allowing the proprietors of EU trade marks applied for before 22 June 2012 and registered in respect of the entire heading of a class of the Nice Classification to declare, before 24 September 2016, that their intention, at the date when the application was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of that heading but included in the alphabetical list for that class, it suffices to point out that that provision was not applicable at the date of the decision at issue.

50. It follows from the foregoing considerations that the General Court did not err in law in holding that, for the earlier trade marks at issue, the designation of the class heading of Class 35 of the Nice Agreement covered all the services included in that class, including services consisting of the retail of goods.

51. The first ground of appeal must therefore be rejected as unfounded.

The second ground of appeal

Arguments of the parties

52. By its second ground of appeal, EUIPO claims that the General Court infringed Article 42(2) of Regulation No 207/2009, read in conjunction with point (a) of the second subparagraph of Article 15(1) thereof, in finding that the use of the earlier trade mark's only figurative element — the stylised cactus — without the word element 'Cactus' equated to a use 'in a form that differs in elements which do not alter the distinctive character of that mark in the form in which it is registered' within the meaning of that latter provision.

53. EUIPO argues that that finding is vitiated by four errors of law.

54. The General Court committed a first error of law in considering that the stylised logo of a cactus was 'essentially equivalent' to the form in which the composite mark was registered. It did not verify whether the word element 'Cactus', which had been omitted from the abbreviated version of the earlier figurative mark, was per se distinctive in respect of 'natural plants and flowers, grains' or whether that word element was, on account of its size and position within the earlier trade mark, negligible or, on the contrary, apt to catch the consumer's attention and be

memorised on its own as identifying the commercial origin of the goods.

55. The second alleged error consists in the General Court's having deduced the equivalence of the marks as used and registered solely from the semantic equivalence of their word and figurative components, without carrying out an overall assessment of the equivalence of the signs, necessitating an analysis of the visual and, possibly, phonetic differences which may be capable of distinguishing the form in which the earlier mark was registered from that in which that mark was used.

56. The third alleged error lies in the General Court's implicit basing of its finding of the equivalence between the stylised cactus and the form in which the composite mark was registered on the prior knowledge that consumers may have of the latter. Without that prior knowledge, consumers would have no reason to assume that the stylised cactus was an element of a composite mark, the second element of which was necessarily the word 'Cactus'.

57. Last, the General Court's alleged fourth error was in its disregarding the need to examine the alteration of the distinctive character of the earlier composite mark in the perception of European consumers, not only consumers in Luxembourg. Had the perception of European consumers been taken into account, the General Court would have had to come to the conclusion that, for a substantial part of the relevant public, the stylised cactus could not be equated with the word 'cactus' or with the earlier composite mark as a whole, since the equivalent term in the official languages of the European Union — 'cacto', 'kaktus', 'kaktusas', 'kaktuzs' and 'κάκτος' — have a different spelling and pronunciation.

58. Cactus argues, primarily, that the second ground of appeal must be regarded as inadmissible since EUIPO is, in fact, asking the Court to reassess factual elements and thus to substitute its own assessment for that of the General Court.

59. In the alternative, Cactus contends that EUIPO's arguments are unfounded.

Findings of the Court

60. Under 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 lies on points of law only. The General Court thus 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 they distort the facts or evidence, constitute a point of law which is subject as such to review by the Court of Justice on appeal (judgment of 12 July 2012, *Smart Technologies v OHIM*, C-311/11 P, EU:C:2012:460, paragraph 52 and the case-law cited).

61. As regards the third alleged error, by which EUIPO criticises the General Court for having based its finding of the equivalence between the signs on the alleged prior knowledge consumers had of the sign as registered, it must be pointed out that findings in relation to the attentiveness, the perception and the

attitude of the relevant public are appraisals of fact (see, to that effect, judgment of 12 July 2012, *Smart Technologies v OHIM*, C-311/11 P, EU:C:2012:460, paragraph 51 and the case-law cited).

62. As regards the fourth alleged error, by which EUIPO criticises the General Court for having examined the possible alteration of the distinctiveness of the earlier figurative mark only in the perception of consumers in Luxembourg and not in the perception of European consumers in general, it is appropriate, for the same reasoning as that set out in the preceding paragraph of the present judgment, to point out that the considerations criticised are factual in nature and that it is not for the Court of Justice to rule on them unless there has been a distortion of the facts, which is not alleged in the present case.

63. The second ground of appeal must therefore be rejected as inadmissible in so far as it concerns the definition of the relevant public and that public's perception of the earlier figurative mark.

64. The second ground of appeal, however, is admissible in so far as the first and second errors alleged in it concern the criteria in the light of which genuine use of a trade mark in an abbreviated form should be assessed. Contrary to what Cactus maintains, the determination of the criteria to be employed for the global assessment of equivalence of signs from the perspective of their distinctiveness is a question of law falling within the Court of Justice's jurisdiction.

65. The Court has already held in that regard that it follows directly from the wording of point (a) of the second subparagraph of Article 15(1) of that regulation that the use of the trade mark in a form which differs from the form in which it was registered is regarded as use for the purposes of the first subparagraph of that article provided that the distinctive character of the mark in the form in which it was registered is not altered (judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 21).

66. It should be recalled that, in so far as it does not impose strict conformity between the form in which the trade mark is used and the form in which the mark was registered, the purpose of point (a) of the second subparagraph of Article 15(1) of that regulation is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (see, to that effect, judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 29).

67. It follows that the condition of 'genuine use' in the sense of point (a) of the second subparagraph of Article 15(1) of the same regulation is satisfied even where only the figurative element of a composite mark is used, as long as the distinctive character of that mark, as registered, is not altered.

68. So far as concerns the first alleged error, EUIPO cannot criticise the General Court for not having

verified the extent to which the part omitted, namely the word element ‘Cactus’, had a distinctive character and was important in the perception of the sign as a whole, when the General Court rightly compared the sign as used in its abbreviated form to the sign as registered.

69. In paragraph 61 of the judgment under appeal, the General Court found — and that finding has not been disputed by EUIPO in the present appeal — that the two elements of the earlier figurative mark, namely a stylised cactus and the word element ‘Cactus’, conveyed, in their respective forms, the same semantic content. It follows from that finding, however, that the General Court considered that the word element ‘Cactus’ could not be regarded as possessing a distinctive character that was different from that of the stylised cactus and that the absence of that word element in the abbreviated version of the earlier figurative mark was not sufficiently important in the perception of that mark as a whole as to alter its distinctive character.

70. As regards the second alleged error, it should be pointed out, as the Advocate General observed in [point 81 of his Opinion](#), that the General Court rightly conducted a global assessment of the equivalence of the sign used in an abbreviated form, the stylised cactus alone, and of the sign protected by the earlier figurative mark, the stylised cactus, accompanied by the word element ‘Cactus’. In that regard, it must be noted, first, that, contrary to what EUIPO claims, the General Court conducted a visual comparison, noting that the representation of the stylised cactus was the same in the two signs. Second, an express phonetic comparison of those signs would have been superfluous, since the General Court found that the two elements of the earlier figurative mark had the same semantic content. It must therefore be held that the General Court could, without infringing point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009, merely carry out, in paragraph 61 of the judgment under appeal, an examination of the equivalence of the signs at issue on the visual and conceptual levels.

71. The second ground of appeal must therefore be rejected as unfounded in so far as it concerns the criteria in the light of which it is appropriate to assess the equivalence of the signs at issue for the purpose of demonstrating genuine use.

72. Accordingly, the second ground of appeal must be rejected as partly inadmissible and partly unfounded.

73. In the light of all of the foregoing elements, the appeal must be dismissed in its entirety.

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 Cactus has applied for costs and EUIPO has been unsuccessful, the latter must be ordered to pay the costs.

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

1. Dismisses the appeal;

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

von Danwitz, Vajda, Juhász, Jürimäe, Lycourgos

Delivered in open court in Luxembourg on 11 October 2017.

A. Calot Escobar, T. von Danwitz

Registrar, President of the Fourth Chamber

OPINION OF ADVOCATE GENERAL WAHL

delivered on 17 May 2017 (1)

Case C-501/15 P

European Union Intellectual Property Office (EUIPO)

v

Cactus SA

(Appeal — Community trade mark — Regulation (EC) No 207/2009 — Articles 15, 28 and 42 — Figurative sign containing the word elements CACTUS OF PEACE CACTUS DE LA PAZ — Opposition by the owner of earlier Community trade marks containing the word element CACTUS — Scope of those earlier trade marks — Retail services — Assessment of the genuine use of a figurative trade mark in circumstances in which only a part of the registered trade mark is used)

1. By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court to set aside the judgment of the General Court in Case T-24/13. (2) In that judgment, the General Court annulled the decision of the EUIPO Board of Appeal annulling the decision of the Opposition Division inasmuch as it had found that genuine use of earlier trade marks had been substantiated.

2. This case raises two main issues. They both turn, in particular, on the concept of ‘genuine use’ within the meaning of Article 15 of Regulation (EC) No 207/2009. (3) On the one hand, the case deals with the extent of the protection that ought to be afforded to an earlier trade mark where, apart from a general reference to the relevant class of goods and services, no specific indication regarding the goods and services covered by the trade mark had been given at the time of registration. In that regard, the case provides the Court with an opportunity to clarify its case-law following from IP Translator (4) and Praktiker. (5) On the other hand, the case invites the Court to clarify how the genuine use of a composite trade mark ought to be assessed where that trade mark is, in practice, employed in an abbreviated form.

I. Legal framework

3. Article 15(1) of the Trade mark regulation provides: ‘If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.’

The following shall also constitute use within the meaning of the first subparagraph:

(a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered; ...'

4. Article 28 of the Trade mark regulation states:

'Goods and services in respect of which Community trade marks are applied for shall be classified in conformity with the system of classification specified in the Implementing Regulation.'

5. Article 42(2) of the Trade mark regulation deals with the examination of an opposition. It provides:

'If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.'

6. Under the heading 'List of goods and services', Rule 2 of Regulation (EC) No 2868/95 (6) states:

'(1) The common classification referred to in Article 1 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, shall be applied to the classification of the goods and services.

(2) The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.

(3) The goods and services shall, in principle, be grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes under that Classification.

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.'

II. Background to the proceedings

7. The judgment under appeal describes the background of the case in the following manner.

8. On 13 August 2009, Ms Isabel Del Rio Rodríguez filed an application for registration of a Community trade mark with EUIPO on the basis of the Trade mark regulation.

9. Registration as a trade mark was sought for the figurative sign containing the word elements CACTUS OF PEACE CACTUS DE LA PAZ.

10. The goods and services for which registration was sought are in Classes 31, 39 and 44 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 ('the Nice Classification'). (7)

11. The trade mark application was published on 14 December 2009.

12. On 12 March 2010, Cactus SA ('Cactus') filed an opposition pursuant to Article 41 of the Trade mark regulation to registration of the trade mark applied for.

13. In support of its opposition, Cactus relied on its earlier registered Community trade marks ('the earlier Cactus trade marks'). More specifically, the opposition was based, on the one hand, on the Community word mark CACTUS ('the earlier word mark') registered on 18 October 2002 for goods and services in Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42. (8) On the other hand, the opposition was based on the Community figurative mark ('the earlier figurative mark') registered on 6 April 2001 for the same goods and services as those covered by the word mark, with the exception of 'foodstuffs not included in other classes; natural plants and flowers, grains; fresh fruits and vegetables' in Class 31.

14. The opposition, which was based on Article 8(1)(b) of the Trade mark regulation, was directed against all the goods and services covered by the trade mark applied for and was based on all the goods and services covered by the earlier marks.

15. By decision of 2 August 2011, the Opposition Division upheld the opposition for 'seeds, natural plants and flowers' in Class 31 and 'gardening, plant nurseries, horticulture' in Class 44, which are covered by the earlier word mark. Registration of the trade mark applied for was therefore refused for those goods and services, but accepted for the services in Class 39.

16. The Opposition Division considered, inter alia, that, following Ms Del Rio Rodríguez's request that Cactus prove that the earlier marks had been put to genuine use, the evidence submitted by the applicant showed genuine use of the earlier word mark for 'natural plants and flowers, grains; fresh fruits and vegetables; except cactuses, cactus seeds and, more generally, plants and seeds of the cactus family' in Class 31, and for 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35.

17. On 28 September 2011, Ms Del Rio Rodríguez filed an appeal against the Opposition Division's decision.

18. By decision of 19 October 2012 ('the contested decision'), the Second Board of Appeal of EUIPO upheld the appeal and dismissed the opposition in its entirety. In particular, it held that the Opposition

Division had erred in considering that Cactus had adduced proof of genuine use of the earlier Cactus trade marks in respect of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35. More specifically, the Board of Appeal found that (i) those services were not covered by the earlier Cactus trade marks; (ii) although Cactus claimed use in respect of 'supermarket services', not only were those services not covered by the earlier Cactus trade marks but genuine use in respect of those services had not been demonstrated and (iii) the 'management of supermarkets or hypermarkets' in Class 35, which is covered by the earlier Cactus trade marks, corresponds to management services which are provided to third undertakings, with the result that that service should be regarded as different from retail services in terms of its nature, purpose and the end-users to whom it is directed. The Board of Appeal also considered that Cactus had not adduced proof, for the period between 14 December 2004 and 13 December 2009, of genuine use of the earlier Cactus trade marks for any of the goods or services covered by those marks.

III. Procedure before the General Court

19. By application lodged on 21 January 2013, Cactus claimed that the General Court should annul the contested decision.

20. In the judgment under appeal, the General Court annulled the contested decision in so far as the opposition was rejected on the ground that 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35 was not covered by the earlier Cactus trade marks and in relation to 'natural plants and flowers, grains' in Class 31, and dismissed the action for the remainder.

IV. Procedure before the Court and forms of order sought

21. By its appeal, lodged with the Court on 22 September 2015, EUIPO claims that the Court should:

- set aside the judgment under appeal;
- order Cactus to bear the costs.

22. Cactus claims that the Court should dismiss the appeal and order EUIPO to bear the costs.

23. The parties presented oral argument at the hearing held on 29 March 2017.

V. Analysis

24. EUIPO relies on two grounds in support of its appeal.

25. In its first ground of appeal, it claims that the judgment under appeal breaches Article 28 of the Trade mark regulation, read in conjunction with Rule 2 of the Implementing Regulation, because it equated the coverage of the class heading in Class 35 with all the services belonging to that class.

26. In the second ground, EUIPO claims that the judgment under appeal breaches Articles 42(2) and 15(1) of the Trade mark regulation because the General Court found that the use of the figurative element, namely, a logo depicting a stylised cactus, without the word element did not alter the distinctive character of the figurative trade mark as registered.

A. The first ground: can a trade mark cover retail services even if those services are not mentioned in the alphabetical list of Class 35 of the Nice Classification?

1. Introduction

27. This ground of appeal turns on the possibility of registering trade marks for retail services and the use of class headings to designate the goods and services covered by a trade mark. It also raises an important question regarding the impact of communications, published by EUIPO regarding its registration practice, on the extent of the protection afforded by a trade mark.

28. In a broader sense, this ground deals with the scope of the protection to be afforded to an earlier trade mark in circumstances where the general class headings of the Nice Classification have been employed to designate the products and services to be covered by the trade mark. After the registration of the earlier Cactus trade marks, the Court's case-law has limited the possibility for trade mark applicants of referring simply to general class headings in designating the products and services to be covered by the trade mark. It has also provided guidance on the conditions under which trade mark registrations for retail services can be allowed.

29. On the one hand, in *IP Translator*, the Court held that 'in order to respect the requirements of clarity and precision ..., an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.' (9)

30. On the other hand, in *Praktiker*, the Court held that while a trade mark can cover retail services, 'the applicant must be required to specify the goods or types of goods to which those services relate' in the application. (10)

31. In the judgment under appeal, the General Court held that the Court's statement in *IP Translator* does not affect the extent of the protection afforded by the earlier Cactus trade marks and that the designation of the class heading of Class 35 covers 'all the services included in that class', including services consisting of the retail of goods. According to the General Court, the protection of the earlier Community trade marks extends to retail services concerning the trade of any product, since these marks were filed before the Court's judgment in *Praktiker*. For those reasons, the General Court concluded that the earlier Community trade marks are protected in respect of the services of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables'. (11)

32. According to EUIPO, the General Court wrongly applied the authority deriving from *IP Translator* and wrongly limited the application of the Praktiker judgment in relation to the earlier Cactus trade marks. In EUIPO's view, that amounts to a breach of Article 28 of the Trade mark regulation, read in conjunction with Rule 2 of the Implementing Regulation. Since neither retail services as such, nor the services of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' are included in the alphabetical list of Class 35, the earlier Cactus trade marks are not protected in respect of such services.

33. Cactus considers that EUIPO's complaints are misplaced and that the first ground of appeal should be dismissed as unfounded.

2. The EUIPO practice

34. As a preliminary point, it is useful to observe that the goods and services in respect of which Community trade marks are applied are classified in accordance with the common classification referred to in Article 1 of the Nice Agreement. In accordance with Rule 2 of the Implementing Regulation, the list of goods and services must be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified preferably in only one class of the Nice Classification.

35. Before the Court's judgment in *IP Translator*, EUIPO accepted trade mark applications that referred to one or several class headings without requiring any further indication as to which goods and services were to be covered by the trade mark applied for. More specifically, in that context, Communication No 4/03 of the President of the Office (12) explained the practice of the (then) Office for Harmonisation in the Internal Market in respect of class headings. On the one hand, the use of the general indications composing the class headings was allowed. None of them was regarded as too vague or indefinite. On the other hand, it was considered that the designation of the whole class heading of a given class covered all goods and services *potentially* falling within the class in question (the all-encompassing approach).

36. After the judgment in *IP Translator* was given on 19 June 2012, EUIPO replaced Communication No 4/03 with Communication No 2/12. (13) The latter establishes a distinction depending on the date on which the Community trade mark has been applied for. Regarding Community trade marks applied for on or after 21 June 2012, applicants are expressly to declare their intention of covering all the goods and services in the alphabetical list of a particular class. Regarding Community trade marks applied for before the cut-off date of 21 June 2012, the use of the general indications of a class heading is understood to entail the application extending to all the goods or services of the alphabetical list of a particular class. As mentioned above, such an application was in the past assumed to cover, in accordance with the all-encompassing approach, all the goods or services falling within a particular class.

37. As EUIPO points out, the distinction between, on the one hand, the goods or services in the alphabetical list of a particular class and, on the other hand, the goods or services potentially falling within that particular class is an important one. That is because not all possible goods and services falling under a given class are referred to in the alphabetical list.

38. That brings me to the impact of the Court's statement in *IP Translator* on the extent of the protection afforded by trade marks registered before the delivery of that judgment.

3. The case-law and its implications

(a) The judgment in *IP Translator*

39. The recent judgment in *Brandconcern*, handed down after the close of the written procedure in the present case, has clarified the purport of the Court's statement in *IP Translator* regarding trade marks registered before that judgment was handed down. (14)

40. Ruling on appeal, the Court held in *Brandconcern* that the Court's statement in *IP Translator* does not concern owners of trade marks which have already been registered, but solely (new) applicants for trade marks. More specifically, it held that the Court intended only to specify the requirements to which applicants for national trade marks are to be subject, who use the general indications of a class in order to identify the goods and services for which protection as a trade mark is sought. Those requirements are intended to ensure that it is possible to determine with certainty the scope of the protection afforded by a trade mark when a trade mark applicant uses all the indications included in a class heading. The Court also explained that *IP Translator* had no bearing on the validity of the approach set out in Communication No 4/03 as regards trade marks registered before the delivery of that judgment (15)

41. In other words, the Court's statement was not held to be applicable to trade marks registered before the delivery of that judgment.

42. That conclusion must be equally valid here: the General Court cannot be faulted for having considered that the Court's statement in *IP Translator* does not impinge on the extent of the protection afforded by trade marks registered before the delivery of that judgment. (16)

43. The fact that, in Communication No 2/12, EUIPO adopted a new approach also in relation to trade marks registered before 21 June 2012 does not change that.

44. As noted above, on the basis of that Communication, EUIPO revised its practice with regard to previously registered trade marks: for those trade marks, the use of the general indications of a class heading was understood to mean that the protection afforded by the trade mark extended to all the goods or services in *the alphabetical list* of a particular class, rather than to all the goods or services (potentially) falling within the particular class, as had been the case before.

45. Quite simply, the extent of the protection afforded by trade marks that have been registered may not be altered on the basis of a non-binding communication. It

would be contrary to the stability of registered trade marks (17) if EUIPO could, by dint of a communication, limit the coverage of trade marks already registered.

46. In that regard, it should not be forgotten that the EUIPO communications at issue here are intended to explain and clarify the EUIPO practice in examining Community trade mark applications. They are not legally binding. At the time when the earlier Cactus trade marks were registered, EUIPO accepted the registration of trade marks for retail services in Class 35 and no limitation regarding the use of class headings to designate goods and services covered by the trade mark had been expressed in the relevant communications, or for that matter, in the case-law. (18)

47. Contrary to what EUIPO claimed at the hearing, what is stated above is not gainsaid by its reading of the *Brandconcern* judgment. It is certainly true that the Court not only held that its statement in *IP Translator* does not apply to trade marks that had already been registered, but also specifically validated the General Court's approach that an earlier trade mark referring to the relevant class heading (in that case, Class 12) was to be interpreted as seeking to protect that trade mark for all the goods in the *alphabetical list* of the relevant class, in accordance with the approach set out in Communication No 2/12 for trade marks registered before the delivery of the judgment in *IP Translator*. (19) In EUIPO's submission, that amounts to accepting that the use of a class heading in designating the products or services covered by the trade mark can extend only to the products or services referred to in the *alphabetical list* of a given class.

48. In that regard, I would simply observe that in *Brandconcern*, the question of a distinction between, on the one hand, the goods or services mentioned in the *alphabetical list* and, on the other hand, all the goods or services covered by the relevant class heading did not arise.

49. On appeal, the Court was asked to rule on whether the General Court was right to conclude that, while the proprietor of the earlier trade mark (LAMBRETTA) had obtained, in accordance with its application filed before the entry into force of Communication No 4/03, registration of its trade mark for 'vehicles; apparatus for locomotion by land, air or water' in Class 12, the owner had to be granted, on the basis of Communication No 2/12, protection for any of the goods listed in the *alphabetical list* relating to Class 12, in accordance with the intention of the owner. (20)

50. Consequently, *Brandconcern* does not constitute an authority validating EUIPO's approach in Communication No 2/12 in relation to the assumption that a trade mark registered before the cut-off date of 21 June 2012 can at most afford protection to the goods or services mentioned in the relevant *alphabetical list*. By the same token, *Brandconcern* should not be read as precluding, from the outset, that protection afforded by trade marks registered before the judgment in *IP Translator* was given could extend beyond the goods

and services referred to in the *alphabetical list* of a given class.

51. Having clarified that, I shall now move on to discuss the reach of the Court's judgment in *Praktiker*.

(b) The judgment in *Praktiker*

52. The question that arises here is whether the General Court was right to hold that, because the earlier Cactus trade marks were registered before the Court delivered its judgment in *Praktiker*, the protection afforded by those earlier marks extends to retail services concerning the trade of any product without there being a need to specify the goods or types of goods concerned by the retail service in question.

53. It is true, as EUIPO points out, that the limitation of the effect of the Court's judgments in time is not the rule, but the exception. EUIPO is also correct in pointing out that the Court did not specifically limit the effect in time of its judgment in *Praktiker*.

54. The exceptionality of limiting the temporal effects of judgments is the logical corollary of how the effects of the Court's judgments are deployed. The Court's judgments produce effects, as a matter of principle, *ex tunc*. According to the well-established formula, reiterated in the context of preliminary rulings under Article 267 TFEU, the interpretation that the Court gives to a rule of EU law clarifies and defines the meaning and scope of that rule as it must be or ought to have been understood and applied from the time of its entry into force. It follows that the rule thus interpreted may, and must, be applied even to legal relationships which arose and were established before the judgment ruling on the request for interpretation, provided that in other respects the conditions for bringing a dispute relating to the application of that rule before the competent courts are satisfied. (21) Accordingly, the Court limits the effects of its judgments only in exceptional circumstances. (22) In any event, the Court may do so only in the actual judgment ruling upon the interpretation sought. (23)

55. Having said that, the approach taken by the General Court is in my view warranted. The reason for that is simple.

56. It would be inconsistent to accept the application of the Court's statement in *Praktiker*, but not that in *IP Translator*, to already registered trade marks. Allowing the retroactive application of *Praktiker* in the present case would be not only inconsistent but also wrong. That is because the statement made in *Praktiker* is, like the judgment in *IP Translator*, inapplicable here. Both judgments deal with trade mark applications, whereas the issue that concerns the Court here turns on the scope of the protection afforded by a previously registered trade mark.

57. As Advocate General Campos Sánchez-Bordona pointed out in *Brandconcern*, there is an important difference between the two stages of application for and registration of trade marks. The interpretation of the list of goods and services contained in an application may still be amended in accordance with Article 43 of the Trade mark regulation. That is not the same as the interpretation of the list of goods and

services covered by a trade mark which is already registered. Pursuant to Article 48 of the same regulation, a registered trade mark is, as a matter of principle, unchangeable. (24) To accept that a subsequent statement of the Court concerning trade mark applications has a bearing on the protection afforded by previously registered trade marks would undermine the stability of such trade marks. It would also be contrary to the principle of legal certainty and frustrate the legitimate expectations of trade mark owners.

58. Lastly, and by way of conclusion, I shall address a point raised by EUIPO at the hearing.

(c) Concluding remarks

59. EUIPO pointed out that Cactus had not indicated before 24 September 2016, in accordance with Article 28(8) of the Trade mark regulation, that its intention, at the date when its application for the earlier Cactus trade marks was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of the class heading, but included in the alphabetical list for that class.

60. That is of course, in itself, of no consequence for the fate of this appeal.

61. However, the point made by EUIPO, and the ensuing comment by Cactus on the lack of such a declaration, serves to illustrate two points.

62. First, it shows that the legislature sought to align the protection afforded, in the future, to trade marks registered before the delivery of the Court's judgment in *IP Translator* with those registered after the delivery of that judgment. (25) Indeed, Article 28(8) of the Trade mark regulation states that EU trade marks for which no declaration has been filed by 24 September 2016 are to be deemed to extend, as from that date, only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

63. On the other hand, it is by no means clear to what extent the fact that the alphabetical list referred to in Class 35 does not expressly mention retail services is decisive for the purposes of determining whether trade marks such as the earlier Cactus trade marks can afford protection for retail services also. In fact, it does not appear entirely implausible to argue that, given the explanatory note to Class 35, (26) those services could be included in that class even under the literal approach. (27)

64. On the basis of all the above, I consider that it was without committing an error that the General Court held that the designation of the class heading of Class 35 covered all the services included in that class, including services consisting of the retail of goods. Accordingly, the first ground of appeal must be dismissed as unfounded.

B. The second ground: How is the distinctiveness of a trade mark to be assessed where that trade mark is employed in an abbreviated form?

1. Introduction

65. In the judgment under appeal, the General Court held that 'it should be noted that the earlier figurative

mark is made up of a figurative element, namely a stylised cactus, followed by the word element "Cactus". The two elements comprising the earlier figurative mark therefore convey, in their respective forms, the same semantic content. It should be added that, both in the figurative mark registered and the abbreviated form of that mark, the representation of the stylised cactus is the same, with the result that the consumer equates the abbreviated form of that mark with its registered form. It follows that the earlier figurative mark, as registered, and the mark, as used by the applicant in its abbreviated form, must be regarded as essentially equivalent. It must therefore be concluded that the applicant's use only of the stylised cactus does not alter the distinctive character of the earlier figurative mark.' (28)

66. Was the General Court right to hold that the use of the stylised logo depicting a cactus, without the word element 'Cactus', amounts to use 'in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered' within the meaning of Article 15(1) of the Trade mark regulation? That is the question the Court must resolve in examining the second ground of appeal.

67. EUIPO thinks not. It argues, in essence, that the General Court's conclusion is based on an incorrect criterion (namely, the semantic equivalence of the logo and the word element 'Cactus'). In its view, the General Court ought to have examined separately the distinctive character and importance of the omitted word element 'Cactus'.

68. More specifically, it identifies four errors in law in the judgment under appeal, which all relate to Article 15(1) of the Trade mark regulation. First, in basing its conclusion only on the semantic concordance between the logo and the word element, the General Court failed to examine to what extent the word element 'Cactus' was distinctive and important in the composite mark. Second, the General Court failed to have regard to the visual and (possible) phonetic differences between the logo and the composite mark. Third, it wrongly based its finding on the prior knowledge that the public in Luxembourg has of the earlier figurative trade mark. Fourth, in assessing the distinctiveness of the figurative trade mark, it failed to consider the perception of the European public as a whole.

69. Cactus submits that the second ground of appeal is inadmissible. In any event, it maintains that the General Court's reasoning is faultless.

2. The criteria for determining whether the use of a trade mark in an abbreviated form alters the distinctive character of the trade mark as registered

70. At the outset, I must express my doubts regarding the admissibility of at least two (of the four) arguments put forward by EUIPO in this ground of appeal. As is well known, the Court has no jurisdiction to reassess facts or evidence. It may not, as a rule, substitute its own assessment with that of the General Court. (29)

71. In my view, EUIPO's arguments relating to the consumers' perception of the earlier figurative mark and the relevant public (errors three and four) invite,

implicitly, the Court to reassess the facts underlying the present case. The case-law considers such arguments inadmissible. (30) Indeed, the characteristics of the relevant public and the perception of consumers regarding the trade mark in question belong, as such, to the General Court's jurisdiction to assess the facts. (31) 72. Regarding the third alleged error, EUIPO argues that the General Court implicitly based its finding on the equivalence between the stylised cactus and the figurative trade mark, as registered, on the prior knowledge that consumers (in Luxembourg) may have of the element omitted. Regarding the fourth alleged error, EUIPO submits that if account had been taken of the perception of European consumers generally, the General Court could not have concluded as it did. Verifying the accuracy of those claims would clearly require reassessment of the facts and evidence submitted before — and assessed by — the General Court.

73. However, the two remaining arguments appear to be reviewable by the Court. (32) That is because they turn on the criteria to be employed in assessing whether the use of a trade mark in an abbreviated form alters the distinctive character of the registered trade mark.

74. Article 15(1)(a) of the Trade mark regulation allows the trade mark owner to make variations to the trade mark registered when that mark is exploited commercially. In accordance with that provision, variations are allowed in so far as the distinctive character of the trade mark is not altered. Accordingly, the purpose of the provision is to enable the owner to adapt better to the marketing and promotion requirements of the goods or services concerned. In that context, the Court has held that a registered trade mark has been put to genuine use 'where proof is provided of use of that mark in a slightly different form from that in which it was registered'. (33)

75. Generally speaking, whether the form in which the trade mark is used is essentially equivalent to the form in which it was registered requires an overall assessment of equivalence.

76. Nevertheless, the case-law does not provide clear guidance on how it is to be assessed whether the use of a trade mark in an abbreviated form alters the distinctive character of the registered trade mark. That case-law deals mostly with somewhat different configurations concerning, in particular, the addition of new conceptually distinct elements to the registered trade mark (or the use of the trade mark in an altered form). In that context, the General Court routinely considers that a finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the elements added, carried out on the basis of the intrinsic qualities of each of those elements, as well as of the relative position of the different elements within the arrangement of the trade mark. (34)

77. This appeal raises the question whether that is equally true where elements are omitted.

78. In my view, the answer to that question depends on the circumstances of each individual case.

79. Let us assume that Cactus had registered a figurative trade mark composed of two elements: a figurative element depicting a rose and a word element 'Cactus'. Let us also assume that Cactus had employed only the figurative element depicting a rose in exploiting the figurative trade mark in its commercial operations. In such circumstances, the distinctive and dominant character of the element omitted would have to be assessed in order for the impact of the omission on the distinctiveness of the trade mark as registered to be determined. That is, in essence, because of the conceptual dissonance between the figurative element and the word element which comprise the registered trade mark. Indeed, in such a situation, the omission of one of the elements may have a bearing on distinctiveness. (35)

80. The situation is different here. The figurative element (the stylised cactus) and the word element (Cactus) refer to the same concept. Although I am doubtful whether it is correct to say that a logo and a word element have the same semantic content, as the General Court did, that does not alter the fact that the element omitted is conceptually equivalent to the figurative element which is used.

81. Despite the General Court not having declared its intention of conducting a global assessment of equivalence, it is clear to me that it did so in the contested paragraph of the judgment under appeal. Indeed, it compared the trade mark as used (stylised cactus) to the trade mark as registered (stylised cactus and the word element). It is that global assessment of equivalence that allowed it to conclude that the two marks were essentially equivalent. As Cactus points out, where the elements in question are conceptually equivalent, the distinctive character of the word element Cactus cannot be different from that conveyed by the figurative element of the trademark. In such a situation, examining separately the distinctiveness of the word element omitted would be superfluous.

82. For that reason, the General Court was right to hold that the use of the stylised cactus alone without the word element 'Cactus' does not alter the distinctive character of the earlier figurative trade mark. Accordingly, I am of the view that the second ground of appeal should be dismissed as partly inadmissible and partly unfounded.

VI. Conclusion

83. In the light of those considerations, I propose that the Court dismiss the appeal and order EUIPO to pay the costs.

1. Original language: English.

2. Judgment of 15 July 2015, T-24/13, not published, EU:T:2015:494 ('the judgment under appeal').

3. Council Regulation of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1, 'the Trade mark regulation').

4. Judgment of 19 June 2012, C-307/10, EU:C:2012:361 ('IP Translator').

5. Judgment of 7 July 2005, , C-418/02, EU:C:2005:425 ('Praktiker').
6. Commission Regulation of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1, 'the Implementing Regulation').
7. The Nice Classification contains a list of classes, which are accompanied by explanatory notes. Since 1 January 2002 this classification comprises 34 classes for goods and 11 classes for services. Each class is composed of several general indications, which make up the class heading, and of the alphabetical list of goods and services. The goods and services at issue here are as follows. Class 31: 'Seeds, natural plants and flowers'; Class 39: 'Storage, distribution and transport of manure, fertilisers, seeds, flowers, plants, trees, tools and gardening goods of all kinds'; Class 44: 'Gardening, plant nurseries, horticulture'.
8. Those goods and services correspond, for certain of those classes, to the following description. Class 31: 'Foodstuffs not included in other classes; natural plants and flowers, grains; fresh fruits and vegetables; except cactuses, cactus seeds and, more generally, plants and seeds of the cactus family'; Class 35: 'Advertising, business management, among other management of shops, management of do-it-yourself or gardening shops, management of supermarkets or hypermarkets; business administration, office functions, among other advertising, radio and/or television advertising, dissemination of advertising matter, publication of publicity texts, direct mail advertising; market surveys; outdoor advertising; business management assistance; demonstration of goods, distribution of samples; opinion polling; personnel recruitment; cost-price analysis; public relations'; Class 39: 'Transport; packaging and storage of goods; travel arrangement, including haulage; storage of goods, rental of storage and/or warehouses; delivery of goods; courier services'.
9. IP Translator, paragraph 61.
10. Praktiker, paragraph 50.
11. Paragraphs 36 to 39 of the judgment under appeal.
12. Communication No 4/03 of the President of the Office of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations.
13. Communication No 2/12 of the President of the Office of 20/06/2012 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations.
14. Judgment of 16 February 2017, , C-577/14 P, EU:C:2017:122.
15. Paragraphs 29 to 32.
16. Any other interpretation would render the amendment to Article 28 of Regulation No 207/2009 introduced by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21) devoid of purpose. On the basis of that regulation, a transitional provision was added to Article 28 which allows the proprietors of EU trade marks applied for before 22 June 2012 and registered in respect of the entire heading of a class of the Nice Classification to declare, before 24 September 2016, that their intention, at the date when the application was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of the heading, but included in the alphabetical list for that class.
17. See point 56 below.
18. EUIPO has accepted trade mark registrations for retail services since the adoption of Communication No 3/01 of the President of the Office of 12 March 2001 concerning the registration of Community trade marks for retail services. See judgment of 30 June 2004, , T-186/02, EU:T:2004:197, paragraph 42.
19. Judgment of 16 February 2017, , C-577/14 P, EU:C:2017:122, paragraph 32.
20. Judgment of 16 February 2017, , C-577/14 P, EU:C:2017:122, paragraphs 19 and 32. See also judgment of 30 September 2014, , T-51/12, not published, EU:T:2014:844, in particular paragraphs 35 and 36. See also judgment of 31 January 2013, , T-66/11, not published, EU:T:2013:48, paragraphs 49 and 50. In that case, the General Court held that a trademark applicant who has employed all the general indications listed in the class heading of Class 35 before Communication No 2/12 entered into force can be assumed to have intended to cover all the services included in the alphabetical list of that class. However, the General Court did not address the fact that the reference to the alphabetical list was not included in Communication No 4/03.
21. See, for example, judgments of 11 August 1995, , C-367/93 to C-377/93, EU:C:1995:261, paragraph 42 and the case-law cited, and of 6 March 2007, , C-292/04, EU:C:2007:132, paragraph 34 and the case-law cited.
22. The Court allowed the limitation of the temporal effects of its judgments, inter alia, in the recent judgment of 28 April 2016, , C-191/14, C-192/14, C-295/14, C-389/14 and C-391/14 to C-393/14, EU:C:2016:311, paragraphs 101 to 111. See also judgment of 8 April 1976, , 43/75, EU:C:1976:56.
23. See, among many, judgment of 9 March 2000, , C-437/97, EU:C:2000:110, paragraph 57.
24. Opinion of Advocate General Campos Sánchez-Bordona in , C-577/14 P, EU:C:2016:571, points 67 and 68.
25. Judgment of 16 February 2017, , C-577/14 P, EU:C:2017:122, paragraph 33.
26. The explanatory note to the Nice Classification (7th edition, in force at the time when the applications for the earlier Cactus trade marks were lodged) states that the general class heading of Class 35 includes services which consist in the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods. See also Guidelines for examination of European Union trade marks, European Union Intellectual Property Office (EUIPO), Part B, Examination, Section 3, Classification, 1 August 2016, p. 4. In the guidelines,

EUIPO explains that explanatory notes clarify which goods or services are meant or not meant to fall under the class headings and which are to be considered an integral part of the classification.

27. See *Praktiker*, paragraph 50. See also, to that effect, judgment of 10 July 2014, , C-420/13, EU:C:2014:2069, paragraphs 33 to 36.

28. Paragraph 61 of the judgment under appeal.

29. See amongst many, judgment of 2 September 2010, , C-254/09 P, EU:C:2010:488, paragraph 49 and the case-law cited.

30. See, amongst many, judgment of 12 July 2012, , C-311/11 P, EU:C:2012:460, paragraph 52 and the case-law cited.

31. See, for example, judgments of 4 October 2007, , C-144/06 P, EU:C:2007:577, paragraph 51, and of 12 July 2012, , C-311/11 P, EU:C:2012:460, paragraph 51 and the case-law cited.

32. Cf. Opinion of Advocate General Szpunar in , C-597/14 P, EU:C:2016:2, point 111.

33. Judgment of 13 September 2007, , C-234/06 P, EU:C:2007:514, paragraph 86.

34. Judgments of 10 June 2010, , T-482/08, not published, EU:T:2010:229, paragraphs 38 and 39, and of 14 July 2014, , T-204/12, not published, EU:T:2014:646, paragraph 34 and the case-law cited. On the other hand, the Court has also held that use of a composite sign which is registered as a trade mark can maintain the rights acquired on both that composite sign and a part of it which is the subject of a distinct registration, provided this part remains perceived as a trade mark as such. See judgment of 18 April 2013, , C-12/12, EU:C:2013:253, paragraphs 27 to 35.

35. See, regarding the analysis to be carried out, for example, judgments of 24 November 2005, , T-135/04, EU:T:2005:419, paragraph 36 et seq., and of 21 January 2015, , T-46/13, not published, EU:T:2015:39, paragraphs 35 to 42.