

Court of Justice EU, 28 June 2018, EUIPO v Puma



TRADE MARK LAW

The General Court was right to consider that EUIPO's bodies could not satisfy their obligation to state reasons

- The Board of Appeal indicated that Puma had raised the argument that the reputation of the earlier marks had been recognised 'in numerous Office decisions', but failed to mention or analyse those decisions with regard to their content or their probative value in relation to the possible reputation of the earlier marks, whereas it did do that in relation to a number of decisions of the national offices.

Contrary to what EUIPO claims, there was no error in law on the part of the General Court as regards its interpretation of those principles. In that regard, it is true that EUIPO's bodies are not automatically bound by their previous decisions, given that, as the General Court rightly pointed out in paragraph 20 of the judgment under appeal, the examination of any trade mark application must be stringent and full in order to prevent trade marks from being improperly registered, so that the existence of reputation must be examined by taking into account the factual circumstances of each individual case (see, by analogy, order of 12 February 2009, Bild digital and ZVS, C-39/08 and C-43/08, not published, EU:C:2009:91, paragraph 17, and, to that effect, judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM, C-51/10 P, EU:C:2011:139, paragraph 77). It does not follow, however, that those bodies are relieved of the obligations set out in paragraph 66 above, arising from the principles of sound administration and equal treatment, including the obligation to state reasons.

81 The latter obligation is all the more important in circumstances such as those of the present case, set out in paragraph 77 above, in which the relevance of some of EUIPO's previous decisions relied on before its bodies for the purposes of carrying out a complete examination of the existence of the reputation of the earlier mark at issue cannot be disputed, given that such an examination, as the General Court pointed out, in essence, does not strictly depend on the mark applied for.

**If the Board of Appeal itself were to reach the conclusion that it could not satisfy its obligation to state reasons, without the evidence which had been lodged in the earlier proceedings before EUIPO, it must be considered, that it would have been necessary for the Board to exercise its power to request the production of that evidence for the**

**purposes of exercising its discretion and carrying out a full examination of the opposition**

- Thus, the General Court did not err in law in concluding in paragraph 37 of the judgment under appeal that, in the circumstances of the present case, it was incumbent on the Board of Appeal, in accordance with the principle of sound administration, either to provide the reasons why it considered that the findings made by EUIPO in the three previous decisions relating to the reputation of the earlier marks had to be disregarded in the present case, or request that Puma submit supplementary evidence of the reputation of the earlier marks.

Source: [curia.europa.eu](http://curia.europa.eu)

Court of Justice EU, 28 June 2018

(...)

JUDGMENT OF THE COURT (Second Chamber)

28 June 2018 (\*1)

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Article 8(5) — Article 76 — Opposition proceedings — Relative grounds for refusal — Regulation (EC) No 2868/95 — Rule 19 — Rule 50(1) — Earlier decisions of the European Union Intellectual Property Office (EUIPO) recognising the reputation of the earlier trade mark — Principle of sound administration — Taking account of those decisions in subsequent opposition proceedings — Obligation to state reasons — Procedural obligations of the Boards of Appeal of EUIPO)

In Case C-564/16 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 7 November 2016,

European Union Intellectual Property Office (EUIPO), represented by D. Botis and D. Hanf, acting as Agents, appellant,

the other party to the proceedings being:

Puma SE, established in Herzogenaurach (Germany), represented by P. González-Bueno Catalán de Ocón, abogado,

applicant at first instance,

THE COURT (Second Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, K. Lenaerts, President of the Court, acting as Judge of the Second Chamber, A. Rosas, C. Toader and E. Jarašiūnas, Judges,

Advocate General: M. Wathelet,

Registrar: C. Strömholm, Administrator,

having regard to the written procedure and further to the hearing on 14 December 2017,

after hearing the Opinion of the Advocate General at the sitting on 25 January 2018,

gives the following

**Judgment**

1 By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court to set aside the judgment of the General Court of the European Union of 9 September 2016, PUMA v EUIPO — Gemma Group (Representation of a bounding

**feline)** (T-159/15, EU:T:2016:457, *‘the judgment under appeal’*), by which the latter annulled the decision of the Fifth Board of Appeal of EUIPO (*‘the Board of Appeal’*) of 19 December 2014 (Case R 1207/2014-5) relating to opposition proceedings between Puma SE and Gemma Group Srl (*‘the decision at issue’*).

#### Legal context

2 Article 8 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), entitled *‘Relative grounds for refusal’*, provides in paragraph 5:

*‘Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier [EU] trade mark, the trade mark has a reputation in the [EU] and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.’*

3 Article 63 of that regulation, which appears in Title VII entitled *‘Appeals’*, provides in paragraph 2:

*‘In the examination of the appeal, the Board of Appeal shall invite the parties as often as necessary to file observations within the period to be fixed by the Board of Appeal on communications from the other parties or issued by itself.’*

4 Article 75 of the regulation provides:

*‘Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.’*

5 Article 76 of Regulation No 207/2009 provides:

*‘1. In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.*

*2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.’*

6 Article 78(1) of that regulation provides as follows:

*‘In any proceedings before the Office, the means of giving or obtaining evidence shall include the following:*

- (a) hearing the parties;*
- (b) requests for information;*
- (c) the production of documents and items of evidence;*
- (d) hearing witnesses;*
- (e) opinions by experts;*
- (f) statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.’*

7 Rule 19 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4) (*‘Regulation No 2868/95’*), entitled *‘Substantiation of the Opposition’*, provides in paragraphs 1 and 2:

*‘1. The Office shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time limit specified by it ...*

*2. Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:*

*(a) if the opposition is based on a trade mark which is not an EU trade mark, evidence of its filing or registration, by submitting:*

*...*

*(ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered;*

*...*

*(c) if the opposition is based on a mark with reputation within the meaning of Article 8(5) of the Regulation, in addition to the evidence referred to in point (a) of this paragraph, evidence showing that the mark has a reputation, as well as evidence or arguments showing that use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;*

*...*

8 Rule 50(1) of Regulation No 2868/95 provides:

*‘Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings mutatis mutandis.*

*...*

*Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article [76(2) of Regulation No 207/2009].’*

#### Background to the dispute

9 On 14 February 2013, Gemma Group filed an application for registration of an EU trade mark at EUIPO under Regulation No 207/2009.

10 Registration as a trade mark was sought for the following figurative sign in blue:



11 The goods in respect of which registration was sought were in Class 7 of the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponded to the following description: *Machines for processing of wood; Machines for processing aluminium; Machines for treatment of PVC*.

12 The EU trade mark application was published in Community Trade Marks Bulletin No 66/2013 of 8 April 2013.

13 On 8 July 2013, Puma 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 11 above. The ground relied on in support of the opposition was that set out in Article 8(5) of that regulation.

14 The opposition was based, inter alia, on the following earlier marks (*'the earlier marks'*):

– the international figurative mark represented below, which was registered on 30 September 1983 under the number 480105 and has been renewed until 2023, with effect in Austria, Benelux, Croatia, France, Hungary, Italy, Portugal, the Czech Republic, Romania, Slovakia and Slovenia, covering goods in Classes 18, 25 and 28 corresponding, for each of those classes, to the following description:

– Class 18: *'Bags to wear over the shoulder and travel bags, trunks and suitcases; especially for apparatus and sportswear'*;

– Class 25: *'Clothing, boots, shoes and slippers'*;

– Class 28: *'Games, toys; equipment for physical exercise, equipment for gymnastics and sports (not included in other classes), including sports balls'*.



– the international figurative mark reproduced below, which was registered on 17 June 1992 under the number 593987 and has been renewed until 2022, with effect in Austria, Benelux, Bulgaria, Cyprus, Croatia, Spain, Estonia, Finland, France, Greece, Hungary, Italy, Latvia, Lithuania, Poland, Portugal, the United Kingdom, the Czech Republic, Romania, Slovenia and Slovakia, covering, inter alia, the goods in Classes 18, 25 and 28 corresponding, for each of those classes, to the following description:

– Class 18: *'Leather goods or imitation leather goods included in this class; handbags and other cases that are not adapted to the goods which they are intended to contain, as well as small articles made from leather, particularly purses, pocket wallets and cases for keys; handbags, ...'*;

– Class 25: *'Clothing, footwear, headgear; parts and components of footwear, soles, insoles and adjustment soles, heels, boot uppers; ...'*;

– Class 28: *'Games, toys, including miniature footwear and miniature balls (used as toys); apparatus and gear for physical training, gymnastics and sport included in this class; ...'*;



15 In support of its opposition based on Article 8(5) of Regulation No 207/2009, Puma relied on the reputation of the earlier trade marks in all the Member States and for all the goods listed in paragraph 14 above.

16 On 10 March 2014, the Opposition Division of EUIPO (*'the Opposition Division'*) rejected the opposition in its entirety. Having found that there was a certain degree of similarity between the signs at issue, it took the view — with regard to the reputation of earlier trade mark No 593987 — that, for reasons of procedural economy, it was not necessary to examine the evidence which Puma had filed in order to prove the extensive use and reputation of that trade mark and that the examination of the opposition would be carried out on the assumption that the earlier trade mark had *'enhanced distinctiveness'*. Starting from that premiss, it concluded, however, that the relevant public would not establish a link between the marks at issue, as required by Article 8(5) of Regulation No 207/2009, due to the differences between the goods covered by each of those marks.

17 On 7 May 2014, Puma filed a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.

18 By the decision at issue, the Board of Appeal dismissed the appeal. First, it found that there was a certain degree of visual similarity between the earlier trade marks and the trade mark applied for and that they conveyed the same concept of a *'pouncing feline recalling a puma'*. Secondly, the Board of Appeal, nevertheless, rejected Puma's argument that the Opposition Division had confirmed that the earlier trade marks had a reputation, on the ground that the Opposition Division had, in fact, limited itself to stating that, for reasons of procedural economy, the evidence of reputation filed by Puma did not have to be assessed in the present case and that the examination would proceed on the assumption that earlier trade mark No 593987 had *'enhanced distinctiveness'*. The Board of Appeal also examined and rejected the evidence of the reputation of the earlier trade marks regarding the goods referred to in paragraph 14 above. Thirdly, the Board of Appeal found that, even assuming that the reputation of the earlier marks were to be regarded as proven, the opposition based on Article 8(5) of Regulation No 207/2009 would have to fail because the other conditions, namely the existence of an unfair advantage taken of the distinctive character or the repute of the earlier marks or of detriment to their

distinctive character or repute, had also not been satisfied.

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

19 By application lodged at the General Court Registry on 1 April 2015, Puma brought an action for the annulment of the decision at issue. In support of that action, Puma put forward, in essence, three pleas in law, alleging (i) infringement of the principles of legal certainty and sound administration, inasmuch as the Board of Appeal had rejected the evidence relating to the reputation of the earlier trade marks and found that their reputation had not been proved, (ii) infringement of Articles 75 and 76 of Regulation No 207/2009, inasmuch as the Board of Appeal had examined the evidence relating to the reputation of the earlier trade marks although the Opposition Division had not carried out such an examination, and (iii) infringement of Article 8(5) of that regulation.

20 As regards more particularly the first plea, Puma essentially submitted that, by rejecting the evidence which it had adduced relating to the reputation of the earlier trade marks and by departing from its decision-making practice relating to the reputation of those earlier trade marks, the Board of Appeal had infringed the principles of legal certainty and sound administration.

21 Having regard in particular to Puma's argument alleging that the Board of Appeal failed to provide adequate reasons justifying such a departure from its decision-making practice, the General Court restated the content of the right to sound administration and made clear that it includes, among other obligations, the obligation for the administration to give reasons for its decisions.

22 It also stated that the Court of Justice has consistently held that, in accordance with the principles of equal treatment and sound administration, EUIPO is required to take into account decisions already taken in respect of similar applications and to consider with especial care whether it should decide in the same way or not, provided that respect for those principles is consistent with respect for legality.

23 The General Court went on to state in paragraph 30 of the judgment under appeal that, by three decisions of 20 August 2010, 30 August 2010 and 30 May 2011 ('the three previous decisions'), EUIPO concluded that the earlier marks had a reputation and were widely known to the public. In that same paragraph, the General Court outlined the essential content of the decisions and the evidence presented by Puma in the proceedings which led to those decisions. In paragraph 31 of the judgment under appeal, the General Court observed that those decisions, which were duly relied on by Puma in the proceedings before the Board of Appeal, were nonetheless not examined or even mentioned in the decision at issue, as the Board of Appeal merely stated that EUIPO was not bound by its previous decision-making practice.

24 Thus, the General Court considered, first, that the earlier trade marks had been found to have a reputation

by EUIPO in the three previous decisions, borne out by a number of decisions from national offices adduced by Puma and, secondly, that that finding was a finding of a factual nature which did not depend on the trade mark applied for.

25 In paragraph 34 of the judgment under appeal, the General Court drew the following conclusion:

*'... in light of the case-law ... according to which EUIPO must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not, and in the light of its obligation to state reasons, the Board of Appeal could not depart from EUIPO's decision-making practice without providing the slightest explanation regarding the reasons which led it to take the view that the factual findings in respect of the reputation of the earlier marks, which were made in those decisions, would not, or would no longer, be relevant. The Board of Appeal in no way states that that reputation has become weaker since the abovementioned recent decisions were made or that that decision-making practice may be unlawful.'*

26 In that regard, the General Court rejected EUIPO's argument that those decisions did not have to be taken into account since none of them was accompanied by the evidence of the earlier marks' reputation which had been submitted in the relevant proceedings. The General Court explained that, when examining an appeal directed against a decision of the Opposition Division, the Board of Appeal enjoys the discretion, under the third subparagraph of Rule 50(1) of Regulation No 2868/95, to decide whether or not to take into account additional or supplementary facts and evidence which were not presented within the time limits set or specified by the Opposition Division.

27 In view of the circumstances of the case, the General Court made the following observation in paragraph 37 of the judgment under appeal:

*'... in the light of its recent previous decision-making practice, which is borne out by a relatively high number of national decisions and by a judgment of the General Court, the Board of Appeal should, in accordance with the principle of sound administration ... have either requested that the applicant submit supplementary evidence of the reputation of the earlier marks — if only to rebut it — as the third subparagraph of Rule 50(1) of Regulation No 2868/95 enabled it to do, or provided the reasons why it took the view that the findings made in those previous decisions as regards the reputation of the earlier marks had to be discounted in the present case. That was particularly necessary because some of those decisions referred in a very detailed manner to the evidence on which the assessment of the reputation of the earlier marks in those decision was based, which should have drawn the Board of Appeal's attention to the existence of that evidence.'*

28 The General Court concluded that EUIPO had infringed the principle of sound administration, in particular its obligation to state the reasons on which its decisions are based.

29 Finally, the General Court considered that, in view of the fact that the strength of the earlier trade marks' reputation had to be taken into account in the overall assessment of whether there was harm for the purposes of Article 8(5) of Regulation No 207/2009, a matter upon which the Board of Appeal had ruled for the sake of completeness in the decision at issue, the Board of Appeal's error in law might have had a decisive influence on the outcome of the opposition, since the latter had not carried out a full examination of the reputation of the earlier trade marks, thereby preventing the General Court from ruling on the alleged infringement of Article 8(5).

30 Consequently, in paragraph 44 of the judgment under appeal, the General Court upheld Puma's first plea in law and, without examining the other pleas in the action, annulled the decision at issue in so far as the Board of Appeal had rejected its opposition.

Forms of order sought by the parties to the appeal

31 EUIPO claims that the Court should:

- set aside the judgment under appeal and
- order Puma to pay the costs.

32 Puma contends that the Court should:

- dismiss the appeal and
- order EUIPO to pay the costs.

#### **The appeal**

33 In support of its appeal, EUIPO relies on two grounds alleging, first, infringement of Article 76(1) of Regulation No 207/2009 and of the principle of sound administration, read in conjunction with Rule 19(2)(c) of Regulation No 2868/95 and Article 8(5) of Regulation No 207/2009, and, second, infringement of Rule 50(1) of Regulation No 2868/95 and of Article 76(2) of Regulation No 207/2009.

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

##### **The first ground of appeal**

34 The first ground relied on by EUIPO has three parts.

35 In the first part of its first ground of appeal, EUIPO alleges that the General Court infringed Article 76(1) of Regulation No 207/2009 and the principle of sound administration. Having found that Puma '*duly relied on*' the three previous decisions in support of its opposition, the General Court implicitly, but necessarily, accepted that a general and imprecise reference to the findings of those decisions and to the evidence submitted by Puma in those previous proceedings involving different parties amounted to reliable evidence of reputation, for the purposes of Rule 19(2)(c) of Regulation No 2868/95.

36 EUIPO states that reputation is not a fact which produces effects erga omnes, but a finding limited to the parties to the proceedings in question and to the aims of those proceedings, so that EUIPO's previous decisions declaring that a mark has a reputation cannot, in themselves, constitute evidence of reputation in subsequent proceedings. Any reference to such decisions may thus be interpreted correctly only as a general and imprecise reference to the documents produced in the previous proceedings before EUIPO, and if EUIPO's duty of neutrality in inter partes proceedings, laid down in Article 76(1) of Regulation

No 207/2009, and the principle of sound administration are not to be prejudiced, such a reference may not be admitted as reliable evidence of reputation, contrary to the view taken by the General Court. In the absence a precise identification by the opponent of the evidence on which it intends to rely, it is impossible for EUIPO to guarantee the rights of defence of the party applying to register a sign as a mark.

37 Furthermore, the General Court's finding disregards the adversarial principle and the principle of equality of arms between the parties in inter partes proceedings, in that it falls to the opponent, and not EUIPO, to give the trade mark applicant the opportunity to assess and, if necessary, challenge the factual basis used for the adoption of previous decisions. Moreover, EUIPO states that, in the present case, its inability to identify the relevant documents was not of a '*physical*' nature, but was rather the result of the fact that, in the absence of a clear and specific reference to the evidence which Puma intended to rely on, it was required to search actively for the relevant documents in order find proof of reputation. Thus Puma's argument, presented for the first time before the Court of Justice, that all the documents submitted in the previous proceedings are in any case accessible online, is not only incorrect, but also irrelevant, even if it were held to be admissible.

38 On the basis of that first error in law, the General Court's interpretation of the decision at issue was manifestly wrong in that it considered that the previous decisions were not '*even mentioned*' in the decision at issue, whereas they were included in the summary of Puma's arguments, and were examined directly by the Board of Appeal in relation to the fact that they lacked any legally binding force, and in the Board of Appeal's reasoning included for the sake of completeness.

39 In the second part of its first ground of appeal, EUIPO claims that the General Court erred in law by stating that, in accordance with the principle of good faith as interpreted by the Court of Justice in [the judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM \(C-51/10 P, EU:C:2011:139\)](#), the Board of Appeal should have explained the reason why it had not taken into account EUIPO's findings in the three previous decisions with regard to the reputation of the earlier marks. It submits that that finding of the General Court is based on two erroneous premisses, the first of which consisted in acknowledging that it was acceptable to rely on those previous decisions, which was not the case, as was demonstrated by the arguments relied on in the first part of the first ground of appeal.

40 The second erroneous premiss is the General Court's recognition of the existence of EUIPO's '*decision-making practice*' having found that the earlier marks had a reputation, inasmuch as that recognition disregarded the notion of '*reputation*' and the relative nature of the ground for refusal of registration under Article 8(5) of Regulation No 207/2009, and the adversarial nature of the proceedings provided for in Article 76(1) of that regulation.

41 Even where, as in the present case, the opponent relies on marks which have been recognised previously as having a reputation by EUIPO, it is still required to challenge the applications to register subsequent marks on a case-by-case basis by establishing in each case the reputation of the marks which it relies on. The reputation of an earlier mark depends, not only on the evidence presented by the proprietor of that mark, but also on the counter-arguments presented by the other party to the proceedings.

42 Consequently, the finding of reputation cannot be regarded as a mere finding of fact, which is essentially static, as the General Court wrongly held in paragraph 33 of the judgment under appeal. On the contrary, although it does not strictly depend on the mark applied for, such a finding is subject to the application of the adversarial principle in each individual set of opposition proceedings. In the present case, the General Court's assessment that the three previous decisions constituted a '*decision-making practice*' was tantamount to recognising the existence of a '*presumption of reputation*' which infringes Article 76(1) of Regulation No 207/2009, read in conjunction with Article 8(5) of that regulation.

43 That misconception of the value of the three previous decisions led the General Court to commit other errors in law. The General Court wrongly stated that the Board of Appeal should have provided the reasons why it considered that the findings made in the three previous decisions relating to the reputation of the earlier marks had to be rejected, thereby applying the case-law arising from [the judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM \(C-51/10 P, EU:C:2011:139\)](#). That case-law is relevant only to ex parte proceedings concerning the refusal of an application for registration on absolute grounds.

44 In any event, even if that case-law were applicable to inter partes proceedings, that would be the case only for issues which have to be raised for reasons of public policy, for issues identified by EUIPO as being facts which are well known, or where a factual situation which has already been established in the proceedings in question is found to be comparable to a factual situation established in earlier proceedings. On the other hand, that case-law cannot be applied in relation to the specific facts relied on in earlier proceedings or the assessments of evidence made in such proceedings in order to make a finding of fact in subsequent proceedings.

45 In the third part of its first ground of appeal, EUIPO argues in essence that the General Court could not, without infringing Article 76(1) of Regulation No 207/2009 and the principle of sound administration, conclude, as it did in paragraph 37 of the judgment under appeal, that the Board of Appeal was under the subsidiary obligation to invite, of its own motion, Puma to submit supplementary evidence of the reputation which it claimed.

46 Puma disputes all three parts of EUIPO's first ground of appeal.

47 Puma submits, inter alia, that the General Court correctly applied the principle of sound administration, in that it found that Puma '*duly relied on*' the three previous decisions as part of its duty, under Rule 19(2)(c) of Regulation No 2868/95, to show the reputation of the earlier marks. It is difficult to consider that the act of relying on those three previous decisions merely amounts to a general reference to the documentation produced in the earlier proceedings, when these are definitive decisions made by an administrative authority, recognising the reputation of the marks identified with precision in the notice of opposition, which are published and easily accessible on the EUIPO website, and the relevant passages of which were summarised in that notice in the language of the case. Such decisions thus constitute, in themselves, invaluable and conclusive evidence of the reputation of the earlier marks. Moreover, reputation is an objective fact with an erga omnes effect, and if the only circumstance capable of influencing that reputation is the passage of time, EUIPO provided no analysis in that regard.

48 As regards the second part of EUIPO's first ground of appeal, Puma argues that the fact that the General Court described the three previous decisions as a '*decision-making practice*' does not amount to a misconception of either the adversarial nature of the proceedings at hand or of the notion of '*reputation*', since no rule of EU law authorised EUIPO to disregard or to ignore the principles of equal treatment and sound administration which required it to take into account the three previous decisions and to consider with especial care whether it should decide in the same way or not, or at least to invite, of its own motion, Puma to submit supplementary evidence of the reputation of the earlier marks.

49 With regard to the third part of EUIPO's first ground of appeal, Puma disputes EUIPO's arguments, stating, in essence, that the procedural obligations set out by the General Court in paragraph 37 of the judgment under appeal do not in any way prejudice EUIPO's position in inter partes proceedings.

#### **The second ground of appeal**

50 By its second ground of appeal, EUIPO argues that, having found in paragraph 37 of the judgment under appeal that the Board of Appeal should have invited Puma to submit supplementary evidence of the reputation of the earlier marks, as it was permitted to do under the third subparagraph of Rule 50(1) of Regulation No 2868/95, the General Court also incidentally infringed Article 76(2) of Regulation No 207/2009. It is clear from the wording, the context and the purpose of that provision that it applies only to the facts relied on and to the evidence presented by the parties on their own initiative. Likewise, it would not be possible to apply that provision by analogy to a situation such as the one in the present case, bearing in mind that there is a specific legal basis for that type of application, namely Article 78(1)(c) of Regulation No 207/2009. Thus, EUIPO submits that none of those two provisions could be used to circumvent EUIPO's duty

of neutrality and the underlying principle of equality of arms.

51 Puma disputes the claim that the General Court's assessment in paragraph 37 of the judgment under appeal is vitiated by illegality.

Findings of the Court of Justice

The first and second parts of the first ground of appeal

52 By the first two parts of the first ground of appeal, which should be examined together, EUIPO disputes the General Court's assessment of Puma's first plea for annulment advanced before that court alleging infringement of the principles of legal certainty and sound administration in that the Board of Appeal had rejected the evidence relating to the reputation of the earlier marks and had concluded that the reputation of those marks had not been demonstrated for the purposes of Article 8(5) of Regulation No 207/2009.

53 More particularly, EUIPO submits, in essence, that the General Court infringed Article 76(1) of Regulation No 207/2009 and the principle of sound administration, read in conjunction with Rule 19(2)(c) of Regulation No 2868/95 and Article 8(5) of Regulation No 207/2009, in finding, first, that EUIPO's three previous decisions had been '*duly relied on*' by Puma before the Opposition Division and, secondly, that, in application of the principles of sound administration and equal treatment, as interpreted by the case-law arising from [the judgment of 10 March 2011, \*Agencja Wydawnicza Technopol v OHIM\* \(C-51/10 P, EU:C:2011:139\)](#), the Board of Appeal should have taken into account those decisions by considering with especial care whether it should decide in the same way or not, and that it was not authorised to disregard EUIPO's decision-making practice without providing the slightest explanation as to the reasons which had led it to consider that the findings of fact on the reputation of the earlier marks made in those decisions were not, or were no longer, relevant.

54 In that regard, it is apparent from the wording of Article 8(5) of Regulation No 207/2009 that the application of that provision is subject to the cumulative conditions that: first, the marks at issue must be identical or similar; second, the earlier mark cited in opposition must have a reputation; and, third, there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, order of 17 September 2015, *Arnoldo Mondadori Editore v OHIM*, C-548/14 P, not published, EU:C:2015:624, paragraph 54).

55 More particularly, with regard to the second condition relating to the existence of a mark's reputation, the only one at issue in the present case, it is clear from the case-law of the Court of Justice that a mark has a reputation within the meaning of EU law where it is known by a significant part of the public concerned by the goods or services covered by that mark, within a substantial part of the territory of the European Union (see, to that effect, [judgment of 3](#)

[September 2015, \*Iron & Smith\*, C-125/14, EU:C:2015:539](#), paragraph 17 and the case-law cited).

56 The existence of repute must be assessed by taking into consideration all the relevant factors of the case, that is to say, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it ([judgment of 14 September 1999, \*General Motors\*, C-375/97, EU:C:1999:408](#), paragraph 27).

57 Although the issue whether the earlier marks acquired a reputation, for the purposes of Article 8(5) of Regulation No 207/2009, constitutes a finding which is part of the assessment of the facts by the General Court which cannot be the subject of an appeal, save where the facts and evidence submitted to the General Court are distorted (see, to that effect, [judgment of 21 January 2016, \*Hesse v OHIM\*, C-50/15 P, EU:C:2016:34](#), paragraph 29), the issue whether the evidence presented in support of the reputation was properly obtained and whether the general principles of law and the rules of procedure in relation to the burden of proof and the taking of evidence were observed constitutes a point of law which is subject to review by the Court of Justice (see, to that effect, [judgment of 10 May 2012, \*Rubinstein and L'Oréal v OHIM\*, C-100/11 P, EU:C:2012:285](#), paragraph 74).

58 As regards the burden of proof and the taking of evidence, where the proprietor of a mark wishes to rely on the ground for refusing registration referred to in Article 8(5) of Regulation No 207/2009, Rule 19(1) and (2)(c) of Regulation No 2868/95 provides that EUIPO must give the opposing party the opportunity to present the facts, evidence and arguments in support of its opposition, in particular evidence that the earlier mark has a reputation, or to complete any facts, evidence or arguments that have already been submitted. Since Regulation No 207/2009 and Regulation No 2868/95 do not list the forms of evidence which the opponent may present in order to demonstrate the existence of the earlier mark's reputation, the opponent is free, in principle, to choose the form of evidence which it considers useful to submit to EUIPO in opposition proceedings based on an earlier right; EUIPO is obliged to examine the evidence submitted by the opponent, and cannot reject out of hand a type of evidence on the basis of its form (judgment of 19 April 2018, *EUIPO v Group*, C-478/16 P, not published, EU:C:2018:268, paragraphs 56 to 59).

59 Furthermore, Article 76(1) of Regulation No 207/2009 provides that, in proceedings before EUIPO, the latter must, in principle, examine the facts of its own motion. However, that provision provides that, in proceedings relating to relative grounds for refusal of registration, such as the ground provided for in Article 8(5) of that regulation, the examination is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought.

60 In addition, in accordance with the settled case-law of the Court of Justice, EUIPO is under a duty to exercise its powers in accordance with the general principles of EU law, including the principles of equal treatment and sound administration ([judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM, C-51/10 P, EU:C:2011:139](#), paragraph 73, and order of 11 April 2013, *Asa v OHIM*, C-354/12 P, not published, EU:C:2013:238, paragraph 41).

61 The Court of Justice has stipulated that, having regard to those principles, EUIPO must take into account the decisions previously taken in respect of similar applications and consider with especial care whether it should decide in the same way or not, since the way in which those principles are applied, as was recalled by the General Court in paragraph 20 of the judgment under appeal, must be consistent with respect for the principle of legality, which means that the examination of any trade mark application must be stringent and full, and must be undertaken in each individual case (see, to that effect, [judgments of 10 March 2011, Agencja Wydawnicza Technopol v OHIM, C-51/10 P, EU:C:2011:139](#), paragraphs 74, 75 and 77, and of 17 July 2014, *Reber Holding v OHIM*, C-141/13 P, not published, EU:C:2014:2089, paragraph 45; and order of 14 April 2016, *KS Sports v EUIPO*, C-480/15 P, not published, EU:C:2016:266, paragraph 37).

62 In that context, it is necessary to reject out of hand EUIPO's argument that the General Court erred in law in holding that the principles arising from the [judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM \(C-51/10 P, EU:C:2011:139\)](#) referred to in the preceding paragraph apply to proceedings based on a relative ground for refusal, such as the one provided for in Article 8(5) of Regulation No 207/2009.

63 Although it is true that those principles were established by the Court of Justice in a case concerning an absolute ground for refusal, that is to say the ground referred to in Article 7(1)(c) of Council Regulation No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), the Court of Justice then expressly ruled that they also applied to opposition proceedings based on a relative ground for refusal (see, to that effect, judgment of 17 July 2014, *Reber Holding v OHIM*, C-141/13 P, not published, EU:C:2014:2089, paragraph 46; orders of 11 April 2013, *Asa v OHIM*, C-354/12 P, not published, EU:C:2013:238, paragraph 42; of 15 October 2015, *Cantina Broglie 1 v OHIM*, C-33/15 P, not published, EU:C:2015:705, paragraph 49; of 15 October 2015, *Cantina Broglie 1 v OHIM*, C-34/15 P, not published, EU:C:2015:704, paragraph 49; and of 14 April 2016, *KS Sports v EUIPO*, C-480/15 P, not published, EU:C:2016:266, paragraph 37).

64 The Court of Justice has also already explained, as the General Court pointed out in paragraphs 18 and 19 of the judgment under appeal, that the right to sound administration, in accordance with Article 41(2) of the Charter of Fundamental Rights of the European Union,

includes the obligation of the administration to give reasons for its decisions. That obligation, which also stems from Article 75 of Regulation No 207/2009, has the dual purpose of enabling interested parties to know the purported justification for the measure taken so as to be able to defend their rights and of enabling the Courts of the European Union to exercise their jurisdiction to review the legality of the decision in question (see, to that effect, [judgments of 10 May 2012, Rubinstein and L'Oréal v OHIM, C-100/11 P, EU:C:2012:285](#), paragraph 111, and of [17 March 2016, Naazneen v OHIM, C-252/15 P, EU:C:2016:178](#), paragraph 29).

65 Furthermore, that obligation has the same scope as that which derives from the second paragraph of Article 296 TFEU which requires that the statement of reasons must disclose in a clear and unequivocal manner the reasoning followed by the institution which adopted the measure in question, without it being necessary for that reasoning to go into all the relevant facts and points of law, since the question whether the statement of reasons meets those requirements must, nonetheless, be assessed with regard, not only to its wording, but also to its context and to all the legal rules governing the matter in question (see, to that effect, [judgment of 21 October 2004, KWS Saat v OHIM, C-447/02 P, EU:C:2004:649](#), paragraphs 63 to 65, and order of 14 April 2016, *KS Sports v EUIPO*, C-480/15 P, not published, EU:C:2016:266, paragraph 32).

66 It follows from the foregoing that, in circumstances where an opponent relies on earlier EUIPO decisions relating to the reputation of a mark, in a precise manner, before the Opposition Division, as evidence of the reputation, for the purposes of Article 8(5) of Regulation No 207/2009, of the same earlier mark relied on in support of its opposition, it is incumbent on the competent EUIPO bodies to take into account the decisions which they have already adopted and to consider with especial care whether it should decide in the same way or not, in accordance with the case-law cited in paragraph 61 above. Where those bodies decide to take a different view from the one adopted in those previous decisions, they should, having regard to the context in which they adopt their new decision, since reliance on those previous decisions forms part of that text, provide an explicit statement of their reasoning for departing from those decisions.

67 It is in the light of those considerations that it is necessary to examine whether in the present case, as EUIPO claims, the General Court infringed Article 76(1) of Regulation No 207/2009 and the principle of sound administration, read in conjunction with Rule 19(2)(c) of Regulation No 2868/95 and Article 8(5) of Regulation No 207/2009.

68 With regard, first, to EUIPO's argument that the General Court erred in law in paragraph 31 of the judgment under appeal in finding that the three previous decisions recognising the reputation of the earlier marks had been 'duly relied on' by Puma, it must be observed, first of all, that the General Court found in paragraph 30 of the judgment under appeal

that those three previous decisions had been put forward by Puma in its written pleadings before the Opposition Division.

69 As was pointed out in paragraph 58 above, the opponent is free, in principle, to choose the form of evidence which it considers useful to submit to EUIPO. Therefore, nothing precludes earlier EUIPO decisions determining the existence of reputation in other inter partes proceedings from being relied on in that context as evidence in support of the reputation of that earlier mark, in particular where they are identified in a precise manner and their substantive content is set out in the notice of opposition in the language of the case, which was what occurred in the present case.

70 In so far as EUIPO claims that, by its finding in paragraph 31 of the judgment under appeal, the General Court accepted that Puma's reference to those decisions was a valid reference both to all of EUIPO's assessments and to the evidence submitted by Puma in those earlier proceedings, so that that reference is valid evidence to establish the existence of the reputation of the earlier marks for the purposes of Rule 19(2)(c) of Regulation No 2868/95, it must be stated that that argument is based on a misreading of paragraph 31 which must now be put in context.

71 In that regard, the General Court's analysis in paragraphs 30 and 31 of the judgment under appeal was intended to address Puma's argument, summarised in paragraph 28 of that judgment, that the Board of Appeal could not depart from its *'decision-making process'* recognising the reputation of the earlier marks without explaining how that departure from the three previous decisions was justified.

72 Since EUIPO had responded to that argument, as is clear from paragraph 29 of the judgment under appeal, by referring to the reasoning of the decision at issue, according to which the legality of EUIPO's decisions must be assessed solely on the basis of Regulation No 207/2009 and not on the basis of an earlier decision-making practice of EUIPO or of the national offices, the General Court set out in paragraph 30 of the judgment under appeal the content of the three previous decisions, by outlining the assessments made by the competent EUIPO bodies in those decisions and by referring to the evidence on which those decisions were based.

73 As is clear from paragraphs 28 to 30 of the judgment under appeal, the General Court made those findings in order to address the issue whether EUIPO, when it adopted the decision at issue, had satisfied the obligations arising from the principle of sound administration, in particular its obligation to state reasons recalled in paragraph 64 and 65 above, in circumstances where Puma, in support of its opposition, had relied on previous decisions of EUIPO concluding that those earlier marks had a reputation, having identified them in a precise manner, and had, by summarising those decisions in the language of the case, specifically referred to the relevant passages of those decisions and the evidence which they contained.

74 It is therefore in the light of those circumstances that the General Court held in paragraph 31 of the judgment under appeal that the three previous decisions had been *'duly relied on'* by Puma, without, however, accepting that the reference to those decisions constituted a valid reference to all of the evidence lodged in the earlier proceedings brought before the EUIPO bodies.

75 It follows that there was no error of law on the part of the General Court when it found in paragraph 31 of the judgment under appeal that the three previous decisions had been *'duly relied on'* by Puma.

76 Secondly, with regard to EUIPO's argument that the General Court disregarded the principle of sound administration and the scope of the obligation to state reasons by which EUIPO was bound, it must be stated that, in accordance with the case-law cited in paragraphs 61, 64 and 65 above and with what was held in paragraph 66 above, EUIPO was required to take into account the three previous decisions relied on by Puma in the present case and, were it to depart from the approach adopted in those decisions on the issue of the reputation of the earlier marks examined in those decisions and in the present case, it was incumbent on EUIPO, in view of the context of the decision at issue, to provide an explicit statement of its reasoning for that departure.

77 In that regard, it should be recalled that the General Court examined the three previous decisions relied on by Puma before the Opposition Division in paragraph 30 of the judgment under appeal — the wording of which is not called into question in the present appeal — by setting out the substantive content of those decisions. The General Court went on to note in paragraph 33 of the judgment under appeal that the reputation of the earlier marks had been established by EUIPO in those three previous decisions which were borne out by a number of national decisions concerning the same earlier marks, goods that were identical or similar to those at issue and some of the Member States concerned by the present case, adding that the finding that the earlier marks had a reputation was a finding of a factual nature which did not depend on the mark applied for.

78 In paragraph 34 of the judgment under appeal, the General Court concluded that *'accordingly'*, and having regard to the obligations stemming from the principles of sound administration and equal treatment, *'the Board of Appeal could not depart from EUIPO's decision-making practice without providing the slightest explanation regarding the reasons which led it to take the view that the factual findings in respect of the reputation of the earlier trade marks, which were made in [the three previous decisions, were not, or were no longer,] relevant.'*

79 Thus the General Court was right to examine whether the Board of Appeal, by merely stating in the decision at issue that EUIPO was not bound by its decision-making practice, had satisfied its obligation to state reasons, in view of the context in which that decision had been made and in view of the legal rules

governing the matter in question, including the principles of sound administration and equal treatment.

80 Contrary to what EUIPO claims, there was no error in law on the part of the General Court as regards its interpretation of those principles. In that regard, it is true that EUIPO's bodies are not automatically bound by their previous decisions, given that, as the General Court rightly pointed out in paragraph 20 of the judgment under appeal, the examination of any trade mark application must be stringent and full in order to prevent trade marks from being improperly registered, so that the existence of reputation must be examined by taking into account the factual circumstances of each individual case (see, by analogy, order of 12 February 2009, *Bild digital and ZVS*, C-39/08 and C-43/08, not published, EU:C:2009:91, paragraph 17, and, to that effect, [judgment of 10 March 2011, \*Agencja Wydawnicza Technopol v OHIM\*, C-51/10 P, EU:C:2011:139](#), paragraph 77). It does not follow, however, that those bodies are relieved of the obligations set out in paragraph 66 above, arising from the principles of sound administration and equal treatment, including the obligation to state reasons.

81 The latter obligation is all the more important in circumstances such as those of the present case, set out in paragraph 77 above, in which the relevance of some of EUIPO's previous decisions relied on before its bodies for the purposes of carrying out a complete examination of the existence of the reputation of the earlier mark at issue cannot be disputed, given that such an examination, as the General Court pointed out, in essence, does not strictly depend on the mark applied for.

82 The General Court was therefore right to consider that, in such circumstances, EUIPO's bodies could not satisfy their obligation to state reasons by merely stating that the lawfulness of EUIPO's decisions must be assessed solely on the basis of Regulation No 207/2009 and not on the basis of its earlier decision-making practice.

83 Finally, in so far as EUIPO claims that the General Court wrongly found in paragraph 31 of the judgment under appeal that the three previous decisions were '*not examined or even mentioned*' in the decision at issue, suffice it to state that that line of argument does not succeed, since the General Court's finding cannot be regarded as running counter to the content of that decision.

84 Although it is true that in the part of the decision at issue entitled '*Submissions and arguments of the parties*', the Board of Appeal indicated that Puma had raised the argument that the reputation of the earlier marks had been recognised '*in numerous Office decisions*', the fact remains that the Board of Appeal failed to cite from among the '*evidence submitted by the opponent*' the three previous decisions and that, in the part of that decision entitled '*Reasons*', it neither mentioned nor analysed those decisions with regard to their content or their probative value in relation to the possible reputation of the earlier marks, whereas it did

do that in relation to a number of decisions of the national offices.

85 In view of all the foregoing considerations, it must be concluded that the General Court did not disregard Article 76(1) of Regulation No 207/2009 or the principle of sound administration, read in conjunction with Rule 19(2)(c) of Regulation No 2868/95 and Article 8(5) of Regulation No 207/2009, in holding that the Board of Appeal, by merely stating that, in circumstances such as those of the present case, the lawfulness of EUIPO's decisions must be assessed solely on the basis of Regulation No 207/2009, as interpreted by the European Union Courts, and not on the basis of an earlier decision-making practice of EUIPO or of the national offices, had disregarded the principle of sound administration, in particular the obligation to state reasons for its decisions, and thus rendered the decision at issue unlawful.

86 It follows that the first and second parts of the first ground of appeal must be rejected as unfounded.

Third part of the first ground of appeal and the second ground of appeal 87

By the third part of the first ground of appeal and by the second ground of appeal, which should be examined together, EUIPO alleges that the General Court infringed Article 76(1) of Regulation No 207/2009, read in conjunction with the principle of sound administration, and Article 76(2) of that regulation, read in conjunction with Rule 50(1) of Regulation No 2868/95, by holding in paragraph 37 of the judgment under appeal that, in the circumstances of the case, the Board of Appeal should have invited Puma to submit supplementary evidence of the reputation of the earlier marks — if only to refute that evidence — as it was permitted to do by the third paragraph of Rule 50(1) of Regulation No 2868/95.

88 EUIPO argues, in particular, that such an interpretation of those provisions and principles infringes the adversarial principle, as expressed in Article 76(1) of Regulation No 207/2009 in relation to *inter partes* proceedings before EUIPO, and disregards the fact that EUIPO's obligation to exercise its discretion to decide whether or not to take into account facts and evidence submitted late applies only to the facts and evidence presented by the parties on their own initiative.

89 Thus, by its line of argument, EUIPO in essence criticises the General Court for having transformed the Board of Appeal's discretion under Article 76(2) of Regulation No 207/2009, read in conjunction with Rule 50(1) of Regulation No 2868/95, to decide whether to take into account supplementary facts and evidence which were not presented within the time limits set by the Opposition Division, into an obligation, with that obligation, in EUIPO's opinion, also being wrongly extended to the facts and evidence which the parties did not submit of their own initiative.

90 In that regard, it is clear from paragraph 35 of the judgment under appeal that EUIPO argued before the General Court that the Board of Appeal was not required to take into account the three previous

decisions on the ground that Puma had not provided the Opposition Division with the evidence of the reputation of the earlier marks produced in the proceedings which led to those decisions being adopted. According to EUIPO, Puma should have lodged that evidence again or referred to it in a precise manner.

91 In reply to that line of argument, the General Court, in paragraph 36 of the judgment under appeal, correctly referred to the case-law according to which Article 76(2) of Regulation No 207/2009 and the third subparagraph of Rule 50(1) of Regulation No 2868/95 grant EUIPO the discretion to decide whether or not to take into account additional or supplementary facts and evidence which were not presented within the time limits set or specified by the Opposition Division. In accordance with those provisions, when evidence is produced within the time limit set by EUIPO, as it is agreed to be in the present case, the production of supplementary evidence remains possible (see, to that effect, [judgment of 21 July 2016, EUIPO v Grau Ferrer, C-597/14 P, EU:C:2016:579](#), paragraph 26 and the case-law cited).

92 However, by stating in paragraph 37 of the judgment under appeal that *‘in the circumstances of the present case, in the light of its recent previous decision-making practice, which is borne out by a relatively high number of national decisions and by a judgment of the General Court, the Board of Appeal should, in accordance with the principle of sound administration ... have ... requested that the applicant submit supplementary evidence of the reputation of the earlier marks — if only to rebut it — as the third subparagraph of Rule 50(1) of Regulation No 2868/95 enabled it to do’*, the General Court did not rely on Article 76(2) of Regulation No 207/2009 and the third subparagraph of Rule 50(1) of Regulation No 2868/95, but on the principle of sound administration.

93 In the present case, it is clear from paragraphs 30, 33 and 37 of the judgment under appeal that, in the notice of opposition, the substantive content of the three previous decisions was set out by Puma in the language of the case, such that it must be considered that that content was made known to the Opposition Division and the Board of Appeal, and to Gemma Group.

94 It is also clear from paragraph 30 of the judgment under appeal that, in the three previous decisions, the competent EUIPO bodies had established that one of the earlier marks had been found, *‘on the basis of a large number of items of evidence’*, to have a *‘substantial reputation, at least in France’* and that one of them was also considered *‘in the light of the extensive evidence provided,’* to have acquired *‘a substantial reputation through use in the European Union’*, enjoying a *‘high degree of distinctiveness as a result of its “long standing and intensive use” and “high degree of recognition”*. The General Court also established that some of those decisions described in great detail the evidence which had led to the conclusion that the earlier marks had a reputation.

95 In that context, the three previous decisions, in so far as they had recognised the reputation of the earlier marks, were a strong indication, in the opposition proceedings at issue, that those marks could also be regarded as having a reputation for the purposes of Article 8(5) of Regulation No 207/2009, as has already been stated in paragraph 81 above.

96 Therefore, as has already been held in paragraph 76 above, EUIPO was required to take into account the three previous decisions relied on by Puma and had to provide an explicit statement of its reasoning in the present case in so far as it had decided to depart from the approach adopted in those decisions on the reputation of the earlier marks.

97 That being so, if the Board of Appeal itself were to reach the conclusion that it could not satisfy its obligations arising from the principle of sound administration and, in that context in particular, its obligation to state reasons, recalled in paragraph 66 above, without the evidence which had been lodged in the earlier proceedings before EUIPO, it must be considered, as the General Court did, that it would have been necessary for the Board to exercise its power to request the production of that evidence for the purposes of exercising its discretion and carrying out a full examination of the opposition.

98 It must be recalled in that respect, as the Court of Justice has already held, that it follows from Article 63(2) of Regulation No 207/2009, read in conjunction with Article 78 of that regulation, that, for the purposes of the examination of the merits of the appeal brought before it, the Board of Appeal of EUIPO is not only to invite the parties, as often as necessary, to file, within time limits which it sets, observations on notifications which it has sent to them, but may also decide on measures of inquiry, including the production of facts or evidence. In turn, such provisions demonstrate the possibility of seeing the underlying facts of a dispute multiply at various stages of the proceedings before EUIPO (judgments of [13 March 2007, OHIM v Kaul, C-29/05 P, EU:C:2007:162](#), paragraph 58, and of 28 February 2018, [mobile.de v EUIPO, C-418/16 P, EU:C:2018:128](#), paragraph 57).

99 In the light of that case-law and the case-law recalled in paragraph 91 above, according to which, when evidence is produced within the time limit set by EUIPO, the production of supplementary evidence remains possible, an obligation, such as the one established by the General Court in paragraph 37 of the judgment under appeal pursuant to the principle of sound administration, cannot be regarded as running counter to the provisions of Regulation No 207/2009.

100 Thus, the General Court did not err in law in concluding in paragraph 37 of the judgment under appeal that, in the circumstances of the present case, it was incumbent on the Board of Appeal, in accordance with the principle of sound administration, either to provide the reasons why it considered that the findings made by EUIPO in the three previous decisions relating to the reputation of the earlier marks had to be disregarded in the present case, or request that Puma

submit supplementary evidence of the reputation of the earlier marks.

101 In view of all of the foregoing considerations, the third part of the first ground of appeal and the second ground of appeal raised by EUIPO must be rejected as unfounded.

102 Since the grounds and arguments raised in support of the appeal have been rejected, the appeal must be dismissed.

#### Costs

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

104 Under Article 138(1) of those rules, applicable to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

105 Since EUIPO has been unsuccessful and Puma has applied for costs, EUIPO must be ordered to pay the costs.

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

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

Ilešič

Lenaerts

Rosas

Toader

Jarašiūnas

Delivered in open court in Luxembourg on 28 June 2018.

A. Calot Escobar

Registrar

M. Ilešič

President of the Second Chamber

(\*1) Language of the case: English.

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OPINION OF ADVOCATE GENERAL

WATHELET

delivered on 25 January 2018 (1)

Case C-564/16 P

European Union Intellectual Property Office (EUIPO)

v

Puma SE

(Appeal — European Union trade mark — Regulation (EC) No 207/2009 — Article 8(5) — Opposition proceedings — Relative grounds for refusal — Regulation (EC) No 2868/95 — Rules 19 and 50(1) — Concept of ‘reputation’ — Probative value of earlier EUIPO decisions recognising the reputation of an earlier trade mark — Concept of ‘previous decision-making practice’ — Obligation to state reasons — Procedural obligations of the Boards of Appeal of EUIPO)

#### I. Introduction

1. By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court to set aside the judgment of the General Court of the European Union of 9 September 2016, PUMA v EUIPO — Gemma Group (Representation of a bounding feline) (T-

159/15, EU:T:2016:457, ‘the judgment under appeal’), by which the latter annulled the decision of the Fifth Board of Appeal of EUIPO of 19 December 2014 (Case R 1207/2014-5) relating to opposition proceedings between Puma SE (2) and Gemma Group Srl (3) (‘the decision at issue’).

2. The question at the heart of the appeal may be of practical importance in the implementation of opposition proceedings brought on the basis of the ground laid down in Article 8(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark. (4) It involves determining whether the proprietor of a trade mark who gives notice of opposition on that basis against the registration of a new trade mark may justify his application simply by referring to the fact that the reputation of his trade mark had already been established in decisions of EUIPO which did not involve the same parties.

#### II. Legal context

##### A. Regulation No 207/2009

3. Under Article 8(5) of Regulation No 207/2009, ‘upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier [European Union] trade mark, the trade mark has a reputation in the [European Union] and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.

4. Amongst the provisions of Title VII of Regulation No 207/2009, entitled ‘Appeals’, Article 63(2) reads as follows:

‘In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.’

5. Pursuant to Article 75 of Regulation No 207/2009, ‘decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments’.

6. Article 76 of Regulation No 207/2009 provides: ‘1. In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.’

7. Lastly, in accordance with Article 78(1) of Regulation No 207/2009:

‘1. In any proceedings before the Office, the means of giving or obtaining evidence shall include the following:

...

(c) the production of documents and items of evidence;

...’

### **B. Regulation (EC) No 2868/95**

8. Under Rule 19(2) of Commission Regulation No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark: (5)

‘Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:

(a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting:

(i) if the trade mark is not yet registered, a copy of the relevant filing certificate or an equivalent document emanating from the administration with which the trade mark application was filed;

(ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered;

(b) if the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of the Regulation, evidence showing that this mark is well-known in the relevant territory;

(c) if the opposition is based on a mark with reputation within the meaning of Article 8(5) of the Regulation, in addition to the evidence referred to in point (a) of this paragraph, evidence showing that the mark has a reputation, as well as evidence or arguments showing that use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

...’

9. Rule 50(1) of Regulation No 2868/95 provides:

‘Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings mutatis mutandis.

In particular, when the appeal is directed against a decision taken in opposition proceedings, Article 78a of the Regulation shall not be applicable to the time limits fixed pursuant to Article 61(2) of the Regulation.

Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence

should be taken into account pursuant to Article [76], paragraph 2, of ... Regulation [No 207/2009].’

### **III. Background to the dispute**

10. On 14 February 2013, Gemma Group filed an application for registration of a European Union trade mark with EUIPO pursuant to Regulation No 207/2009.

11. Registration as a trade mark was sought for the following figurative sign in blue:



12. The goods in respect of which registration was sought were in Class 7 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, and corresponded to the following description: ‘Machines for processing of wood; machines for processing aluminium; machines for treatment of PVC’.

13. The European Union trade mark application was published in Community Trade Marks Bulletin No 66/2013 of 8 April 2013.

14. On 8 July 2013, the applicant, Puma, filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 to registration of the trade mark applied for in respect of all the goods referred to in paragraph 12 of this Opinion. The ground for the opposition was that set out in Article 8(5) of Regulation No 207/2009.

15. The opposition was based, inter alia, on the following earlier trade marks (‘the earlier trade marks’):

– the international figurative mark represented below, which was registered on 30 September 1983 under the number 480105 and has been renewed until 2023, with effect in Benelux, the Czech Republic, France, Croatia, Italy, Hungary, Austria, Portugal, Romania, Slovenia and Slovakia and covering goods in Classes 18, 25 and 28 corresponding, for each of those classes, to the following description:

– Class 18: ‘Bags to wear over the shoulder and travel bags, trunks and suitcases; especially for apparatus and sportswear’;

– Class 25: ‘Clothing, boots, shoes and slippers’;

– Class 28: ‘Games, toys; equipment for physical exercise, equipment for gymnastics and sports (not included in other classes), including sports balls’:



– the international figurative mark reproduced below, which was registered on 17 June 1992 under the number 593987 and has been renewed until 2022, with effect in Benelux, Bulgaria, the Czech Republic, Estonia, Greece, Spain, France, Croatia, Italy, Cyprus, Latvia, Lithuania, Hungary, Austria, Poland, Portugal, Romania, Slovenia, Slovakia, Finland and the United Kingdom, covering, inter alia, the goods in Classes 18,

25 and 28 corresponding, for each of those classes, to the following description:

– Class 18: ‘Leather goods or imitation leather goods included in this class; handbags and other cases that are not adapted to the goods which they are intended to contain, as well as small articles made from leather, particularly purses, pocket wallets and cases for keys; handbags, portfolios, storage and shopping bags, school bags, bags for campers, rucksacks, pouches, match bags, transport and storage bags, and travel bags made from leather and imitation leather, synthetic materials, base-metal alloys and textile fabrics; travelling sets (leatherware); shoulder belts (straps); animal skins; trunks and suitcases; umbrellas, parasols and walking sticks; whips, saddlery’;

– Class 25: ‘Clothing, footwear, headgear; parts and components of footwear, soles, false soles and corrective soles, heels, boot uppers; non-slipping devices for boots, studs and spikes; ready-made interlining and pockets for clothes; corsetry items; boots, slippers and mules; finished items of footwear, street shoes, sports shoes, leisure footwear, shoes for physical training, running shoes, gymnastic, bathing and physiological slippers included in this class, tennis shoes; gaiters and spats, gaiters and spats of leather, leggings, puttees, spats for shoes; clothes for physical training, trunks and jerseys for gymnastics, trunks and jerseys for football, shirts and shorts for tennis, swimwear and beach clothing, swimming pants and underpants and swimming costumes, included two-piece swimwear, clothing for sports and leisure, including knitwear and jerseys, as well as for physical training, jogging, endurance running and gymnastics, trunks and trousers for sports, jerseys, jumpers, tee-shirts, sweat-shirts, clothing for tennis and skiing; tracksuits and leisure clothing, all-weather tracksuits and clothing, stockings (hosiery), football socks, gloves, including leather gloves, as well as imitation or synthetic leather, hats and caps, hair bands, head bands and sweat bands, scarves, shawls, headscarves, mufflers; belts, anoraks and parkas, raincoats, overcoats, overalls, jackets, skirts, breeches and trousers, pullovers and matching combinations composed of several items of clothing and underclothing; underclothing’;

– Class 28: ‘Games, toys, including miniature footwear and miniature balls (used as toys); apparatus and gear for physical training, gymnastics and sport included in this class; equipment for skiing, tennis and fishing; skis, ski bindings and ski poles; edges of skis and coverings for skis; balls for games and play balloons, including balls and balloons for sports and games; dumb-bells, shots, discuses, javelins; tennis rackets, bats for table tennis or ping-pong, badminton and squash, cricket bats, golf clubs and hockey sticks; tennis balls and tennis ball throwing apparatus; roller skates and skates, combination shoes for roller-skating, also with reinforced soles; tables for table tennis; clubs for gymnastics, barrel hoops for sports, nets for sports, goal nets and ball nets; sports gloves (games accessories); dolls, dolls clothes, dolls shoes, caps and

bonnets for dolls, belts for dolls, aprons for dolls; knee-pads, elbow-pads, ankle-protectors and leggings for sports; decorations for Christmas trees’:



16. In support of its opposition based on Article 8(5) of Regulation No 207/2009, Puma relied on the reputation of the earlier trade marks in all the Member States and for all the goods listed in paragraph 15 of this Opinion.

17. On 10 March 2014, the Opposition Division rejected the opposition in its entirety. Whilst finding there to be a certain degree of similarity between the signs at issue, it took the view — with regard to the reputation of earlier trade mark No 593987 — that, for reasons of procedural economy, it was not necessary to examine the evidence which the applicant had filed in order to prove the extensive use and reputation of that trade mark and that the examination would be carried out on the assumption that the earlier trade mark had ‘enhanced distinctiveness’. On the basis of that premiss, it concluded that the link required by Article 8(5) of Regulation No 207/2009 was not established in the present case.

18. On 7 May 2014, the applicant filed a notice of appeal against that decision with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009.

19. At the end of the decision at issue, the Fifth Board of Appeal of EUIPO dismissed the appeal.

20. First, it found that there was a certain degree of visual similarity between the earlier trade marks and the trade mark applied for and that they conveyed the same concept of a ‘pouncing feline recalling a puma’.

21. Secondly, the Board of Appeal rejected the applicant’s argument that the Opposition Division had confirmed that the earlier trade marks had a reputation, on the ground that the Opposition Division had, in fact, limited itself to stating that, for reasons of procedural economy, the evidence of reputation filed by the applicant did not have to be assessed in the present case and that the examination would proceed on the assumption that earlier trade mark No 593987 had ‘enhanced distinctiveness’. The Board of Appeal also examined and rejected the evidence of the reputation of the earlier trade marks regarding the goods referred to in paragraph 15 of this Opinion.

22. Thirdly, the Board of Appeal found that, even assuming that the reputation of the earlier trade marks should have been regarded as proven, the opposition based on Article 8(5) of Regulation No 207/2009 would have to fail because the other conditions, namely the existence of an unfair advantage taken of the distinctive character or the repute of the earlier trade marks or of detriment to their distinctive character or repute, had not also been satisfied.

IV. The procedure before the General Court and the judgment under appeal

23. By application lodged at the General Court Registry on 1 April 2015, Puma brought an action for the annulment of the decision at issue.

24. In support of its action, Puma put forward, in essence, three pleas in law, alleging (i) infringement of the principles of legal certainty and sound administration inasmuch as the Board of Appeal had rejected the evidence relating to the reputation of the earlier trade marks and found that their reputation had not been proved, (ii) infringement of Articles 75 and 76 of Regulation No 207/2009 inasmuch as the Board of Appeal had examined the evidence relating to the reputation of the earlier trade marks although the Opposition Division had not carried out such an examination, and (iii) infringement of Article 8(5) of that regulation.

25. By its first plea, Puma submitted, in essence, that, by rejecting the applicant's evidence relating to the reputation of the earlier trade marks and by departing from its decision-making practice relating to the reputation of the earlier trade marks, the Board of Appeal had infringed the principles of legal certainty and sound administration. In support of that plea, the applicant put forward two arguments before the General Court: the first argument concerned the Board of Appeal's refusal to take into consideration the evidence which had not been translated into the language of the proceedings, the second argument related to the Board of Appeal's alleged departure from its previous decision-making practice.

26. Having found certain images submitted by Puma to be inadmissible because they were produced for the first time before it, the General Court examined the two arguments relied on by Puma in the context of its first plea. It restated the content of the right to good administration, which includes, *inter alia*, the obligation of the administration to give reasons for its decision, observing that the purpose of that obligation to state reasons is twofold: first, to enable the persons concerned to ascertain the reasons for the measure in order to defend their rights and, secondly, to enable the Courts of the European Union to exercise their power to review the legality of the decision.

27. The General Court pointed out that, in its case-law on the principles of equal treatment and sound administration, *inter alia* in its judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM* (C-51/10 P, EU:C:2011:139), the Court of Justice clarified that, when examining an application for registration of a European Union trade mark, EUIPO had to take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not; however, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. The General Court went on to observe that, consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else. Moreover,

for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application should be stringent and full, in order to prevent trade marks from being improperly registered. That examination should be undertaken in each individual case, since the registration of a sign as a trade mark would depend on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal.

28. The General Court rejected Puma's first argument, advanced in support of its first plea, finding that — pursuant to Rule 19 of Regulation No 2868/95 — the Board of Appeal was correct in taking the view that the evidence which had not been submitted in the language of the proceedings could not be taken into consideration.

29. As regards Puma's second argument, namely its submission that the Board of Appeal erred in law by departing from the decision-making practice of EUIPO and the case-law of the General Court, the General Court pointed first of all to the content of three recent EUIPO decisions, in which EUIPO concluded that the earlier trade marks had a reputation; in that connection, the General Court likewise referred to the evidence submitted by Puma in those proceedings in support of the reputation of its earlier trade marks. Next, in paragraph 31 of the judgment under appeal, the General Court took the view that those decisions had been duly relied on by Puma in the course of the procedure before the Board of Appeal, but that the Board of Appeal had not examined or even mentioned them in the decision at issue, with that board merely stating that EUIPO was not bound by its previous decision-making practice. In addition, the General Court pointed out that EUIPO's conclusions in those three decisions were borne out by a number of decisions of national offices put forward by Puma.

30. Thus, the General Court took the view, first, that the earlier trade marks had been found to have a reputation by EUIPO in three recent decisions and, second, that the finding that a trade mark has a reputation is a finding of a factual nature which does not depend on the trade mark applied for.

31. In paragraph 34 of the judgment under appeal, the General Court concluded from the foregoing that, 'in light of the case-law ..., according to which EUIPO must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not, and in the light of its obligation to state reasons, the Board of Appeal could not depart from EUIPO's decision-making practice without providing the slightest explanation regarding the reasons which led it to take the view that the factual findings in respect of the reputation of the earlier marks, which were made in those decisions, would not, or would no longer, be relevant. The Board of Appeal in no way states that that reputation has become weaker since the abovementioned recent decisions were made or that that decision-making practice may be unlawful'.

32. In that regard, the General Court dismissed EUIPO's argument that those decisions should not be taken into account on the ground that none of them was accompanied by evidence of the earlier trade marks' reputation which had been submitted in the context of those proceedings, explaining that the Board of Appeal enjoys, when examining an appeal directed against a decision, the discretion under the third subparagraph of Rule 50(1) of Regulation No 2868/95 to decide whether or not to take into account additional or supplementary facts and evidence which were not presented within the time limits set or specified by the Opposition Division.

33. In the light of the circumstances of the present case, the General Court stated, in paragraphs 37 and 38 of the judgment under appeal, that, 'in the light of its recent previous decision-making practice, which is borne out by a relatively high number of national decisions and by a judgment of the General Court, the Board of Appeal should, in accordance with the principle of sound administration ..., have either requested that the applicant submit supplementary evidence of the reputation of the earlier marks — if only to rebut it —, as the third subparagraph of Rule 50(1) of Regulation No 2868/95 enabled it to do, or provided the reasons why it took the view that the findings made in those previous decisions as regards the reputation of the earlier marks had to be discounted in the present case. That was particularly necessary because some of those decisions referred in a very detailed manner to the evidence on which the assessment of the reputation of the earlier marks in those decisions was based, which should have drawn the Board of Appeal's attention to the existence of that evidence'. The General Court thus upheld Puma's first plea in law, finding that EUIPO had infringed the principle of sound administration, in particular its obligation to state the reasons on which its decisions are based.

34. The General Court further found that, since the strength of the earlier trade marks' reputation is taken into account in the overall assessment of whether there is harm for the purposes of Article 8(5) of Regulation No 207/2009, a matter upon which the Board of Appeal ruled for the sake of completeness in the decision at issue, the Board of Appeal's error of law might have had a decisive influence on the outcome of the opposition. However, since the Board of Appeal had not carried out a full examination of the reputation of the earlier trade marks, the General Court took the view that it was not in a position to rule on the alleged infringement of Article 8(5) of Regulation No 207/2009.

35. Accordingly, in paragraph 44 of the judgment under appeal, the General Court upheld Puma's first plea and annulled the decision at issue in so far as it rejected the applicant's opposition, without examining the other pleas in law put forward by the applicant.

#### **V. Forms of order sought by the parties and the procedure before the Court**

36. By its appeal, EUIPO claims that the Court should set aside the judgment under appeal and order

Puma to bear the costs incurred by EUIPO. Puma contends that the Court should dismiss the appeal and order EUIPO to pay the costs incurred.

37. The parties submitted written pleadings and presented oral argument at the hearing on 14 December 2017.

#### **VI. The appeal**

38. In support of its appeal, EUIPO relies on two grounds of appeal. The first ground of appeal alleges infringement of Article 76(1) of Regulation No 207/2009 and the principle of sound administration, read in conjunction with Rule 19(2)(c) of Regulation No 2868/95 and Article 8(5) of Regulation No 207/2009. The second ground of appeal alleges infringement of Rule 50(1) of Regulation No 2868/95 and Article 76(2) of Regulation No 207/2009.

39. It expands upon those two grounds of appeal using four arguments that it details by means of three points. Although this is not the clearest of approaches, the disputed points are, however, stated with due precision. On the basis of those complaints, the first ground of appeal can be broken down into three parts.

40. First, in paragraph 31 of the judgment under appeal, the General Court disregarded EUIPO's procedural position and obligations in inter partes proceedings by finding that three previous EUIPO decisions had been 'duly relied on' by Puma for the purposes of showing the reputation of the Puma trade marks, as required by Rule 19(2)(c) of Regulation No 2868/95.

41. Second, in paragraph 34 of the judgment under appeal, the General Court misconceived the adversarial nature of the inter partes proceedings and the concept of 'reputation' within the meaning of Article 8(5) of Regulation No 207/2009 by qualifying EUIPO's previous decisions as a 'decision-making practice'. It erred in law by requiring the Board of Appeal of EUIPO to explain why it had failed to take account of the findings made by it in the earlier decisions relating to the reputation of the Puma trade marks.

42. Third, in paragraph 37 of the judgment under appeal, the General Court could not find that the Board of Appeal of EUIPO was under the subsidiary obligation to invite, of its own motion, Puma to submit supplementary evidence of the reputation which it claimed. In so doing, the General Court infringed the adversarial principle governing inter partes proceedings laid down in Article 76(1) of Regulation No 207/2009 and the principle of sound administration. This third part echoes the complaint made in the context of the second ground of appeal based on Article 76(2) of Regulation No 207/2009, which is applicable pursuant to Rule 50(1) of Regulation No 2868/95. I will therefore examine those aspects of the appeal jointly when I turn to the second ground of appeal.

A. The first two parts of the first ground of appeal, alleging infringement of Article 76(1) of Regulation No 207/2009 and the principle of sound administration, read in conjunction with Rule 19(2)(c) of Regulation No 2868/95 and Article 8(5) of Regulation No 207/2009

43. I will examine the first two parts of the first ground of appeal together since they both concern, in essence, the impact of a decision-making practice of EUIPO on the proof of a trade mark's reputation.

44. It is important to observe, as a preliminary point, that EUIPO disputes not the possibility of an opposing party's referring to EUIPO's previous decision-making practice but the fact that a previous decision may be taken into account without the opposing party making — in addition to the reference to that decision — specific and accurate references to documents submitted in the proceedings which led to that decision and do so in the language of the new proceedings. (6)

45. If that view were to be accepted, that would amount to denying the probative value of the findings made in the previous decision and, as a result, to stripping the case-law on previous decision-making practice of its relevance to a great extent, since the opposing party would be unable to dispense with identifying evidence previously submitted and demonstrating its relevance for the new opposition proceedings.

46. However, the nature of the 'reputation' of an earlier trade mark within the meaning of Article 8(5) of Regulation No 207/2009 is perfectly compatible with the obligation on EUIPO to take account of its previous decision-making practice, as the Court has held in relation to other grounds for refusal of registration, whether absolute (7) or relative. (8)

47. I see no reason why the principle of equal treatment and the principle of sound administration, which form the basis of the Court's case-law on EUIPO's obligation to 'take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not', (9) would not apply when implementing Article 8(5) of Regulation No 207/2009.

#### **1. The nature of 'reputation'**

48. First of all, a trade mark has a reputation within the meaning of EU law where it is known by a significant part of the public concerned by the goods or services covered by that trade mark, within a substantial part of the territory of the European Union. (10)

49. It is therefore a finding of fact: 'reputation' is a reality. (11) Furthermore, the Court of Justice has indeed already, albeit implicitly, accepted that fact by holding, in the context of an appeal, that the finding that an earlier trade mark had acquired a reputation formed part of the assessment of the facts by the General Court. (12)

50. I therefore concur with the General Court's assessment in paragraph 33 of the judgment under appeal that the finding that the earlier trade marks relied on by Puma have a reputation is a finding of a factual nature which does not depend on the trade mark applied for in the registration proceedings at issue.

51. If it is apparent that EUIPO has already had occasion, in the course of previous proceedings, to find that a particular trade mark has a reputation for the purposes of Article 8(5) of Regulation No 207/2009,

that finding must be regarded as a finding of fact. In addition, the evidence accepted by EUIPO as the basis of that finding must, in principle, appear in the statement of reasons on which the previous decision is based. After all, 'the obligation for EUIPO to state reasons for its decisions in accordance with Article 75, first sentence, of Regulation No 207/2009 has the same scope as that which derives from Article 296, second paragraph, TFEU which requires that the statement of reasons must disclose in a clear and unequivocal manner the reasoning followed by the institution which adopted the measure in question in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable the competent court to exercise its power of review ...'. (13) In order to satisfy that requirement, the evidence providing proof of an earlier trade mark's reputation adduced by the proprietor of that trade mark must, necessarily, to a more or less explicit degree, appear in the EUIPO decision which acknowledges that reality. Such evidence is therefore no longer crucial in the context of subsequent opposition proceedings, since the previous EUIPO decision relies on it in support of its finding. That decision is sufficient in itself.

52. The General Court did not therefore err in law in accepting, in paragraphs 30 and 31 of the judgment under appeal, the reference made by Puma in its notice of opposition to three previous EUIPO decisions as valid references not only as regards the finding made at the end of those proceedings that the earlier trade marks have a reputation but also in relation to the evidence submitted by Puma in the context of those proceedings.

#### **2. The impact of inter partes proceedings on the account taken of a previous decision-making practice**

53. Next, contrary to EUIPO's submission in support of its first ground of appeal, the account taken of a previous decision-making practice relating to the reputation enjoyed by a trade mark is not contrary to the adversarial nature of the opposition proceedings; nor does it preclude the specificity of the finding made in the particular opposition proceedings in question. (14)

54. The Court has taken care to make EUIPO's obligation to take account of its previous decision-making practice subject to two points. First, 'the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality'. (15) Second, 'for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered ... That examination must be undertaken in each individual case.' (16)

55. In accordance with those principles, in the same way that a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed to the benefit of someone else, (17) a person who opposes the

registration of a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed previously.

56. Accordingly, although a decision-making practice of EUIPO relating to the reputation of a trade mark may be relied on by the proprietor of that trade mark in support of its opposition, the trade mark applicant may, for his part, challenge it or criticise its relevance to the case at issue. The ability to rely on a previous decision-making practice does not strip the trade mark applicant of the right to challenge the evidence adduced in support of the opposition.

57. In any event, regardless of whether or not there is any debate between the parties, it will be for EUIPO to take into account the decision(s) relied on, consider with especial care whether it should decide in the same way or not and state the reasons on which its decision is based accordingly, no more no less.

58. In reality, this involves simply performing the obligation to state reasons incumbent on EUIPO pursuant to Article 75 of Regulation No 207/2009. In addition, even though EUIPO does not have to go into all the relevant facts and points of law, its statement of reasons must disclose in a clear and unequivocal manner the reasoning followed by it in such a way as to enable the persons concerned to ascertain the reasons for the measure and to enable the competent court to exercise its power of review. (18) Thus, where the facts and the legal considerations having decisive importance in the context of the decision at issue are sufficiently set out, EUIPO is not required to give specific reasons in order to justify its decision relating to earlier decisions relied on by one of the parties to the proceedings. (19)

59. The General Court therefore did not err in law when it held, in paragraph 34 of the judgment under appeal, that the Board of Appeal could not depart from EUIPO's decision-making practice without providing the slightest explanation regarding the reasons which led it to take the view that the factual findings in respect of the reputation of the earlier trade marks, which were made in those decisions, was not, or was no longer, relevant.

60. In the light of the foregoing, the view must be taken that the arguments relied on in the first two parts of the first ground of appeal are unfounded.

B. The third part of the first ground of appeal, alleging infringement of Article 76(1) of Regulation No 207/2009 and the principle of sound administration, and the second ground of appeal, alleging infringement of Rule 50(1) of Regulation No 2868/95 in conjunction with Article 76(2) of Regulation No 207/2009

61. The third part of the first ground of appeal and the second ground of appeal raised by EUIPO in support of its appeal both concern paragraph 37 of the judgment under appeal, in which the General Court ruled, in essence, that, if the Board of Appeal of EUIPO did not provide the reasons why it took the view that the findings made in its previous decisions had to be discounted, '[it] should, in accordance with the principle of sound administration ..., have ...

requested that [Puma] submit supplementary evidence of the reputation of the earlier marks'.

62. In EUIPO's view, by laying down that 'subsidiary' obligation, the General Court infringed the adversarial principle governing inter partes proceedings laid down in Article 76(1) of Regulation No 207/2009 and the principle of sound administration. It 'incidentally' also infringed 'Article 76(2) of Regulation No 207/2009, applicable in the present case by virtue of Rule 50(1) of Regulation No 2868/95'. (20)

63. It is true that the distinction made in Article 76(1) of Regulation No 207/2009 cannot be ignored. Although that provision states that EUIPO is to examine the facts of its own motion, it does, however, clarify that, in proceedings relating to relative grounds for refusal of registration — such as that laid down in Article 8(5) of Regulation No 207/2009 —, EUIPO is to be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought. Article 76(2) of Regulation No 207/2009 adds that EUIPO 'may disregard facts or evidence which are not submitted in due time by the parties concerned'. (21)

64. On the basis of Article 76(2) of Regulation No 207/2009, the third subparagraph of Rule 50(1) of Regulation No 2868/95 states that, where an appeal is directed against a decision of an Opposition Division, the Board 'shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division ..., unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article [76](2) of Regulation [No 207/2009]'. (22)

65. According to the Court, 'the submission of facts and evidence by the parties [therefore] remains possible after the expiry of the time limits to which such submission is subject under the provisions of Regulation [No 207/2009] and ... [EUIPO] is in no way prohibited from taking account of facts and evidence which are submitted or produced late'. (23) In other words, those various provisions grant the Boards of Appeal of EUIPO the power to decide whether or not to take into account additional or supplementary facts and evidence which were not presented within the time limits set or specified by the Opposition Division, (24) provided, however, that evidence had previously been produced within the time limit set by EUIPO. (25)

66. It is therefore a right afforded to EUIPO and not an obligation: the parties '[do] not enjoy an unconditional right to have [the facts and evidence submitted and produced outside the time limits set] taken into account by the Board of Appeal [of EUIPO]. On the contrary, that board has a discretion as to whether or not to take such information into account when making the decision which it is called upon to give'. (26)

67. Contrary to the reading of the judgment under appeal suggested by EUIPO, the General Court did not, in my view, turn the right afforded to EUIPO by Article

76 of Regulation No 207/2009 and Rule 50(1) of Regulation No 2868/95 to take into account evidence which the parties failed to produce in due time into an obligation to request such evidence. The obligation set out by the General Court in paragraph 37 of the judgment under appeal is based not on the provisions cited above but on the principle of sound administration and, more specifically, on the obligation to state reasons which that principle includes. (26)

68. Although the General Court refers to the third subparagraph of Rule 50(1) of Regulation No 2868/95, it does so solely in so far as that provision ‘allows’ supplementary evidence to be requested. I do not consider the General Court’s finding in this regard to be vitiated by an error in law.

69. The third subparagraph of Rule 50(1) of Regulation No 2868/95 expressly authorises the Board of Appeal of EUIPO to take into account additional or supplementary facts and evidence which were not produced in due time. Article 63(2) of Regulation No 207/2009 allows the Board of Appeal of EUIPO to invite the parties, ‘as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications ... issued by itself’. (27) Moreover, Article 78(1)(c) of Regulation No 207/2009 envisages the possibility of requesting the production of documents and items of evidence ‘in any proceedings before [EUIPO]’.

70. In those circumstances, in the light of the requirement to state reasons to which EUIPO is subject pursuant to the principle of sound administration and which is expressly laid down in Article 75 of Regulation No 207/2009, the General Court did not err in law where it found that the Board of Appeal of EUIPO ‘should, in accordance with the principle of sound administration’, have requested that the proprietor of the earlier trade marks submit supplementary evidence of their reputation if that were necessary in order for findings made in previous decisions to be discounted, and provided an adequate statement of reasons for its decision. This is simply a case of use being made of the possibility provided for in Article 63(2) of Regulation No 207/2009.

71. In addition, the rule laid down by the General Court also ensures compliance with the adversarial principle, since Article 75 of Regulation No 207/2009 prohibits EUIPO from basing its decisions on reasons or evidence on which the parties concerned have had no opportunity to present their comments. When requesting that the opposing party produce supplementary evidence, EUIPO must give the applicant the opportunity to comment on that evidence.

72. In the light of the foregoing, the view must be taken that the arguments advanced in the context of the third part of the first ground of appeal and in the second ground of appeal are unfounded. The two grounds of appeal should therefore be dismissed in their entirety.

73. In the alternative, if the Court of Justice were to regard the finding made in paragraph 37 of the judgment under appeal to be an error in law inasmuch as the General Court referred to the third subparagraph

of Rule 50(1) of Regulation No 2868/95, the principle of sound administration, read in conjunction with Article 63(2) and Article 78(1)(c) of Regulation No 207/2009, appears to me in any event to provide sufficient justification for the operative part of the judgment under appeal. In these circumstances, the General Court’s error cannot constitute sufficient grounds for the judgment under appeal to be set aside. (28)

74. In the light of the foregoing, since the judgment under appeal cannot be set aside on the basis of the first two parts of the first ground of appeal advanced by EUIPO in support of its appeal, the appeal as a whole should likewise be dismissed.

#### VII. Costs

75. Under Article 138(1) of the Rules of Procedure of the Court of Justice, which is applicable to the procedure on an appeal pursuant to 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 Puma has applied for costs and EUIPO has been unsuccessful, the latter must be ordered to pay the costs.

#### VIII. Conclusion

76. In the light of the foregoing considerations, I propose that the Court should:

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

1 Original language: French.

2 ‘Puma’.

3 ‘Gemma Group’.

4 OJ 2009 L 78, p. 1.

5 OJ 1995 L 303, p. 1, as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4).

6 See paragraph 29 of the appeal.

7 See, with regard to Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM* (C-51/10 P, EU:C:2011:139, paragraphs 73 to 77).

8 See, for example, in relation to the assessment of the genuine use made of an earlier trade mark, judgment of 17 July 2014, *Reber Holding v OHIM* (C-141/13 P, not published, EU:C:2014:2089, paragraphs 45 and 46).

9 Judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM* (C-51/10 P, EU:C:2011:139, paragraphs 73 and 74). See also judgment of 17 July 2014, *Reber Holding v OHIM* (C-141/13 P, not published, EU:C:2014:2089, paragraph 45), and orders of 12 December 2013, *Getty Images (US) v OHIM* (C-70/13 P, not published, EU:C:2013:875, paragraphs 41 and 42) and of 11 September 2014, *Think Schuhwerk v OHIM* (C-521/13 P, EU:C:2014:2222, paragraph 57).

10 See, to that effect, judgment of 3 September 2015, *Iron & Smith* (C-125/14, EU:C:2015:539, paragraph 17). See also judgments of 14 September

1999, General Motors (C-375/97, EU:C:1999:408) and of 6 October 2009, PAGO International (C-301/07, EU:C:2009:611, paragraph 30). In paragraph 16 of its judgment of 3 September 2015, Iron & Smith (C-125/14, EU:C:2015:539), the Court expressly acknowledged that the expression ‘has a reputation in the [European Union]’ had the same meaning in the European Union Trade Mark Regulation (both Regulation No 207/2009 and Regulation No 40/94) and in the Directive to approximate the laws of the Member States relating to trade marks (here: Directive 2008/95/EC of the European Union and of the Council of 22 October 2008 (OJ 2008 L 299, p. 25)). In legal literature, Azéma, J., ‘*Marques renommées et marques notoires en droit européen et en droit français*’, *Marques renommées et marques notoires — Well-known and Famous Trade Marks*, L.G.D.J.-Schulten, 2011, pp. 23 to 36, particularly p. 27.

11 See Sancho Gargallo, I., ‘*Alance de la protección de la marca notoria en la jurisprudencia comunitaria*’, in Morral Soldevila, R. (ed.), *Problemas actuales de derecho de la propiedad industrial*, Thomson Reuters-Civitas, 2011, pp. 141 to 155, particularly p. 141.

12 See, to that effect, judgment of 21 January 2016, Hesse v OHIM (C-50/15 P, EU:C:2016:34, paragraph 29).

13 Order of 14 April 2016, KS Sports v EUIPO (C-480/15 P, not published, EU:C:2016:266, paragraph 32). In that order, the Court summarises in a single paragraph its earlier findings in relation to the similar provisions of Regulation No 40/94 and the EC Treaty in its judgment of 21 October 2004, KWS Saat v OHIM (C-447/02 P, EU:C:2004:649, paragraphs 63 to 65).

14 See paragraphs 22 and 51 to 53 of the appeal.

15 Judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM (C-51/10 P, EU:C:2011:139, paragraph 75). See also judgment of 17 July 2014, Reber Holding v OHIM (C-141/13 P, not published, EU:C:2014:2089, paragraph 45), and orders of 12 December 2013, Getty Images (US) v OHIM (C-70/13 P, not published, EU:C:2013:875, paragraph 43) and of 11 September 2014, Think Schuhwerk v OHIM (C-521/13 P, EU:C:2014:2222, paragraph 57).

16 Judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM (C-51/10 P, EU:C:2011:139, paragraph 77), emphasis added. See also orders of 12 December 2013, Getty Images (US) v OHIM (C-70/13 P, not published, EU:C:2013:875, paragraph 44); of 11 September 2014, Think Schuhwerk v OHIM (C-521/13 P, EU:C:2014:2222, paragraph 57); and of 14 April 2016, KS Sports v EUIPO (C-480/15 P, not published, EU:C:2016:266, paragraph 37).

17 See, to that effect, judgment of 10 March 2011, Agencja Wydawnicza Technopol v OHIM (C-51/10 P, EU:C:2011:139, paragraph 76); order of 12 December 2013, Getty Images (US) v OHIM (C-70/13 P, not published, EU:C:2013:875, paragraph 43).

18 See, to that effect, judgment of 17 March 2016, Naazneen Investments v OHIM (C-252/15 P, not published, EU:C:2016:178, paragraphs 28 and 29), and order of 14 April 2016, KS Sports v EUIPO (C-480/15 P, not published, EU:C:2016:266, paragraph 32 and the case-law cited).

19 See, to that effect, order of 14 April 2016, KS Sports v EUIPO (C-480/15 P, not published, EU:C:2016:266, paragraph 38).

20 Paragraph 65 of the appeal.

21 Emphasis added.

22 Judgment of 13 March 2007, OHIM v Kaul (C-29/05 P, EU:C:2007:162, paragraph 42); emphasis added.

23 See, to that effect, judgment of 3 October 2013, Rintisch v OHIM (C-120/12 P, EU:C:2013:638, paragraph 32).

24 See, to that effect, judgment of 21 July 2016, EUIPO v Grau Ferrer (C-597/14 P, EU:C:2016:579, paragraphs 25 to 27).

25 Judgment of 13 March 2007, OHIM v Kaul (C-29/05 P, EU:C:2007:162, paragraph 63). See also judgment of 18 December 2008, Les éditions Albert René (C-16/06 P, EU:C:2008:739, paragraph 142).

26 The General Court makes reference here to paragraphs 18 and 20 of the judgment under appeal, which expressly refer to Article 41(2) of the Charter of Fundamental Rights and the obligation to give reasons for decisions laid down therein.

27 Emphasis added.

28 See, to that effect, judgment of 21 July 2016, EUIPO v Grau Ferrer (C-597/14 P, EU:C:2016:579, paragraph 29).