

Court of Justice EU, 16 July 2020, ACTC v EUIPO



TAIGA v TIGHA

## TRADE MARK LAW

### No invalidation due to no genuine use – opposition

**In the case of independent subcategories of goods or services for which the trade mark is registered, genuine use must be proven for each independent subcategory.**

- With regard to goods or services, which may be sub-divided into several independent subcategories, it is necessary to require the proprietor of the earlier mark to adduce proof of genuine use of that mark for each of those autonomous subcategories.

**Purpose and intended use of the good or service is essential to define an independent subcategory.**

- With regard to the relevant criterion or criteria to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently, the Court has held, in essence, that the criterion of the purpose and intended use of the goods or services at issue is an essential criterion for defining an independent subcategory of goods (...).

- When the goods concerned have several purposes and intended uses determining whether there exists a separate subcategory of goods by considering in isolation each of the purposes that those goods may have will not be possible.

- Goods aimed at different publics and sale in different shops is relevant for assessing the relevant public, but not for defining an independent subcategory of goods.

Source: [ECLI:EU:C:2020:573](#)

### Court of Justice EU, 16 July 2020

((A. Arabadjiev, T. von Danwitz and A. Kumin (registrar))

JUDGMENT OF THE COURT (Second Chamber)  
16 July 2020 (\*)

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Application for registration of EU word mark tigha — Opposition filed by the proprietor of the earlier EU trade mark TAIGA — Partial dismissal of the application for registration — Article 8(1)(b) — Assessment of the likelihood of confusion — Assessment of the conceptual similarity of the signs at issue — Article 42(2) — Proof of genuine use of the earlier mark — Proof of use ‘in relation to part ... of the goods or services’ — Determination of an independent subcategory of goods)

In Case C-714/18 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 14 November 2018,

ACTC GmbH, established in Erkrath (Germany), represented by V. Hoene, S. Gantenbrink and D. Eickemeier, Rechtsanwälte, appellant,

the other parties to the proceedings being: European Union Intellectual Property Office (EUIPO), represented by D. Gája, acting as Agent, defendant at first instance,

Taiga AB, represented in Varberg (Sweden), represented by C. Eckhardt, A. von Mühlendahl, K. Thanbichler-Brandl and C. Fluhme, Rechtsanwälte, intervener at first instance,

THE COURT (Second Chamber),

composed of A. Arabadjiev, President of the Chamber, T. von Danwitz and A. Kumin (Rapporteur), Judges, Advocate General: E. Sharpston, Registrar: A. Calot Escobar,

having regard to the written procedure, after hearing the [Opinion of the Advocate General](#) at the sitting on 19 December 2019, gives the following

### Judgment

1. By its appeal, ACTC GmbH seeks to have set aside the [judgment of the General Court of the European Union of 13 September 2018, ACTC v EUIPO — Taiga \(tigha\) \(T-94/17, not published, ‘the judgment under appeal’, EU:T:2018:539\)](#), by which the General Court dismissed its action for annulment of the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 9 December 2016 (Case R 693/2015-4), relating to opposition proceedings between Taiga AB and ACTC (*‘the contested decision’*).

### Legal context

2. Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1) was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. Regulation No 207/2009, as amended by Regulation 2015/2424, was repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1). Nevertheless, in view of the date on which the application for registration at issue was filed, namely 28 December 2012, which is decisive for the purpose of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009, in its initial version (see, to that effect, judgment of 4 July 2019, [FTI Touristik v EUIPO](#), C-99/18 P, EU:C:2019:565, paragraph 2).

3. Article 8(1)(b) of Regulation No 207/2009 provides: ‘1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered: ...

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

4. The first subparagraph of Article 15(1) of that regulation provides:

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

5. According to Article 42(2) of that regulation:

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

6. Article 43(1) of the same regulation provides: ‘The applicant may at any time withdraw his [EU] trade mark application or restrict the list of goods or services contained therein. Where the application has already been published, the withdrawal or restriction shall also be published.’

#### **Background to the dispute and the contested decision**

7. The background to the dispute is set out in paragraphs 1 to 10 of the judgment under appeal. For the purposes of the present proceedings, it may be summarised as follows.

8. On 28 December 2012, the appellant filed an application for registration of an EU trade mark with EUIPO, pursuant to Regulation No 207/2009. The mark in respect of which registration was sought is the word sign ‘tigha’ (*‘the mark applied for’*).

9. The goods for which registration was sought are, inter alia, in Class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended (*‘the Nice Agreement’*), and correspond to the following description: ‘Clothing, footwear, headgear; Suits; Clothing of imitations of leather; Motorists’ clothing; Clothing; Dresses; Gabardines [clothing]; Belts [clothing]; Half-

boots; Gloves [clothing]; Shirt yokes; Shirts; Shirt fronts; Wooden shoes; Trousers; Hats; Jackets [clothing]; Jerseys [clothing]; Stuff jackets [clothing]; Skull caps; Hoods [clothing]; Ready-made clothing; Headgear for wear; Camisoles; Short-sleeve shirts; Clothing of leather; Leggings [trousers]; Underwear; Coats; Pelisses; Caps [headwear]; Cap peaks; Outerwear; Ear muffs [clothing]; Combinations [clothing]; Parkas; Ponchos; Pullovers; Waterproof clothing; Skirts; Sandals; Sashes for wear; Shoes; Soles for footwear; Footwear uppers; Tips for footwear; Footwear; Smocks; Ski gloves; Underpants; Socks; Boots; Boot uppers; Headbands [clothing]; Stockings; Stockings (Sweat-absorbent -); Tights; Sweaters; Tee-shirts; Jumper dresses; Knitwear [clothing]; Singlets; Topcoats; Uniforms; Underwear (Anti-sweat -); Pants; suits water-skiing; Vests; Hosiery; Top hats’.

10. The EU trade mark application was published in *European Union Trade Marks Bulletin* No 2013/011 of 16 January 2013.

11. On 12 April 2015, Taiga, intervener at first instance, filed a notice of opposition against registration of the mark applied for, inter alia, for the goods referred to in paragraph 9 of the present judgment.

12. The opposition was based on the earlier EU word mark TAIGA, covering, inter alia, goods falling within Class 25 of the Nice Agreement and corresponding to the following description:

‘Clothing; outer clothing; underwear; footwear; headgear for wear and headwear; work shoes and boots; working overalls; gloves; belts and socks’.

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

14. By decision of 9 February 2015, the Opposition Division of EUIPO rejected the opposition in its entirety.

15. On 28 September 2015, Taiga filed a notice of appeal with OHIM against the Opposition Division’s decision.

16. By the contested decision, the Fourth Board of Appeal of EUIPO (*‘the Board of Appeal’*) partially annulled that decision of the Opposition Division, namely for all the goods at issue, falling within Class 25 of the Nice Agreement, and consequently rejected the application for registration concerning those goods. It considered use of the earlier mark to have been proved for certain goods in Class 25, which were identical or similar to the goods covered by the mark applied for, that the signs at issue were highly similar from a visual perspective, phonetically identical — at least for English-speaking consumers — and that those signs could not be linked to any concept for the majority of the relevant public. In those circumstances, the Board of Appeal concluded that there was a likelihood of confusion on the part of that public, for the purposes of Article 8(1)(b) of Regulation No 207/2009, in respect of the goods in Class 25.

#### **Procedure before the General Court and the judgment under appeal**

17. By application lodged at the Registry of the General Court on 13 February 2017, the appellant brought an action for annulment of the contested decision.

18. In support of its action, it raised two pleas in law, alleging, respectively, infringement of Article 42(2) of Regulation No 207/2009 and infringement of Article 8(1)(b) of that regulation.

19. By the judgment under appeal, the General Court dismissed the action in its entirety.

**Forms of order sought by the parties**

20. The appellant requests that the Court:

- set aside the judgment under appeal and annul the contested decision;

- in the alternative, set aside the judgment under appeal and refer the case back to the General Court, and

- order EUIPO to pay the costs.

21. EUIPO contends that the Court should:

- dismiss the appeal, and

- order the appellant to pay the costs.

22. Taiga claims that the Court should:

- dismiss the appeal, and

- order the appellant to pay the costs of the proceedings, including the costs to which it has been exposed.

**The appeal**

23. In support of its appeal, the appellant raises two grounds of appeal, alleging, respectively, infringement of Article 42(2) of Regulation No 207/2009 and infringement of Article 8(1)(b) of that regulation.

**First ground of appeal**

**Arguments of the parties**

24. By the first ground of appeal, the appellant criticises, in essence, the General Court for finding, in paragraph 34 of the judgment under appeal, that the articles of clothing referred to in the evidence produced by Taiga to demonstrate use of the earlier mark all had the same purpose. The General Court was thus wrong to hold that those goods did not constitute an independent subcategory of goods falling within Class 25 of the Nice Agreement.

25. By the first part of this ground, the appellant claims that the General Court should not have based its assessment on the goods referred to in that evidence, but on those for which the earlier mark had been registered. Thus, the question which the General Court ought to have answered is whether the earlier mark was registered for a category of goods sufficiently broad for it to be possible to identify within it a number of independent subcategories, such that the use related only to specific goods of that ‘broad category’.

26. By the second part of the ground, the appellant criticises the General Court for failing to take into account the fact that clothing, referred to in the said evidence and covered by the mark applied for, was, first, intended for different ranges of use, namely to cover, conceal, adorn or protect the human body, and, second, was aimed at different publics and sold in different shops, such that the former could be distinguished from the latter.

27. EUIPO takes the view that the first ground of appeal should be dismissed as inadmissible in so far as the appellant claims that the General Court made an incorrect assessment of the evidence submitted by Taiga before the Board of Appeal to demonstrate that the earlier mark had been put to genuine use. According to

EUIPO, therefore, the appellant challenges the factual assessment made by the General Court, without alleging a distortion of those facts or invoking any error of law that might invalidate the General Court’s reasoning. In any event, that ground should be dismissed as unfounded.

28. TAIGA contends that the ground must be rejected as unfounded.

**Findings of the Court**

29. As a preliminary point, it is appropriate to reject the line of argument of EUIPO relating to the inadmissibility of the first ground of appeal. The appellant does not in fact challenge a factual assessment of the General Court, but calls into question the methodology and criteria applied by the General Court to define use ‘*in relation to part ... of the goods or services*’, within the meaning of Article 42(2) of Regulation No 207/2009. Since this ground of appeal thus concerns criteria in respect of which the General Court must assess the existence of genuine use for the goods or services for which it is registered, or part of those goods or services, within the meaning of that provision, that ground raises a question of law which can be subject to review by the Court of Justice on appeal (see, to that effect, [judgment of 12 December 2019, Der Grüne Punkt v EUIPO](#), C-143/19 P, EU:C:2019:1076, paragraph 51 and the case-law cited).

30. By its line of argument, the appellant criticises the General Court, first of all, for considering it appropriate to ascertain whether the only articles referred to in the proof of use submitted by the intervener constituted an independent subcategory in relation to the goods in Class 25 of the Nice Agreement, next, for not correctly applying the criterion of the purpose and intended use of the goods in question in order to determine such an independent subcategory as well as, last, for failing to take into account the fact that the goods at issue were aimed at different publics and were sold in different shops.

31. In that regard, it should be recalled at the outset that the General Court noted, in paragraphs 29 to 32 of the judgment under appeal, the following: ‘29. *The provisions of Article 42 of Regulation No 207/2009 allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration, so they cannot be interpreted in such a way as to give rise to an unjustified limitation of the scope of protection of the earlier mark, in particular in the event that the goods or services for which that mark was registered constitute a sufficiently narrowly defined category, and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him (see, to that effect, judgment of 14 July 2005, Reckitt Benckiser (España) v OHIM — Aladin*

(ALADIN), T-126/03, EU:T:2005:288, paragraphs 51 and 53).

30. If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition (judgments of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, T-126/03, EU:T:2005:288, paragraph 45, and of 13 February 2007, *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, T-256/04, EU:T:2007:46, paragraph 23).

31. However, although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not result in the proprietor of that trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. It must be observed in that regard that it is in practice impossible for the proprietor of a trade mark to furnish proof that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of “part of the goods or services” cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories (judgments of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, T-126/03, EU:T:2005:288, paragraph 46, and of 6 March 2014, *Anapurna v OHIM — Annapurna (ANNAPURNA)*, T-71/13, not published, EU:T:2014:105, paragraph 63).

32. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for goods or services which can meet their specific needs, the purpose or intended use of the goods or services in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services. In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, *Aust Störck v EUIPO — Chiquita Brands (Fruitfuls)*, T-367/14, not published, EU:T:2016:615, paragraph 32

and the case-law cited).

32. Having regard to those rules of law and case-law principles, the General Court examined, in paragraphs 33 to 36 of the judgment under appeal, whether the articles covered by the evidence provided by Taiga constituted an independent subcategory of goods in relation to the goods in Class 25 of the Nice Agreement, covered by the earlier mark, grouping only weather-protective outdoor clothing. As a first step, the General Court considered that those articles had ‘the same purpose, since they [were] intended to cover the human body, to conceal, adorn and protect it against the elements’ and that they could not ‘in any event, be regarded as “substantially different”’, within the meaning of the case-law referred to in paragraph 31 of the judgment under appeal. As a second step, the General Court noted that the particular characteristics of those articles, namely those consisting in weather protection, were, in principle, irrelevant, in so far as, in accordance with the case-law cited in paragraph 32 of the judgment under appeal, ‘the characteristics of the goods are not, as such, relevant to the definition of subcategories of goods or services’. Accordingly, the General Court rejected the first plea in law.

33. Under the first sentence of Article 42(2) of Regulation No 207/2009, an applicant for an EU trade mark may require the proprietor of the earlier trade mark to furnish proof that the earlier mark has been put to ‘genuine use’ in the European Union during the period of five years preceding the date of publication of the trade mark application against which an opposition has been filed.

34. First of all, it must be recalled that the concept of ‘genuine use’ is an autonomous concept of EU law (see, to that effect, [judgment of 11 March 2003, Ansul](#), C-40/01, EU:C:2003:145, paragraphs 25 to 31).

35. In that regard, in order for a mark to be regarded as being put to ‘genuine use’, within the meaning of the first sentence of Article 42(2) of Regulation No 207/2009, it is necessary that that mark be used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered for the consumer or end user by enabling him or her, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, to that effect, [judgment of 17 October 2019, Landeskammer für Land- und Forstwirtschaft in Steiermark v Schmid](#), C-514/18 P, not published, EU:C:2019:878, paragraphs 36 and 37 and the case-law cited). Indeed, a trade mark which is not used obstructs not only competition — since it limits the range of signs which can be registered as trade marks by others and denies competitors the opportunity to use that trade mark or a similar one when putting on to the internal market goods or services which are identical or similar to those covered by the mark in question — but also the free movement of goods and services ([judgment of 19 December 2012, Merken](#), C-149/11, EU:C:2012:816, paragraph 32).

36. In order that a trade mark may achieve that essential function, Regulation No 207/2009 confers on the

proprietor of the mark a set of rights, while limiting them to what is strictly necessary for the performance of that function, as the Advocate General observed in point 40 of her Opinion.

37. Article 15 of Regulation No 207/2009 thus provides that there is no justification for protecting an earlier mark unless it is put to ‘genuine use in the Union in connection with the goods or services in respect of which it is registered’.

38. Article 42(2) of that regulation applies that principle of law in the specific context of opposition proceedings. The last sentence of Article 42(2) of that regulation provides that, if the earlier trade mark has been used in relation to part only of the goods or services for which it is registered, it is, for the purposes of the examination of the opposition, to be deemed to be registered in respect only of that part of the goods or services.

39. In that connection, it should be noted, as the Advocate General did in point 47 of her Opinion, that the breadth of the categories of goods or services for which the earlier mark was registered is a key element of the balance between, on the one hand, the maintenance and preservation of the exclusive rights conferred on the proprietor of the earlier mark and, on the other hand, the limitation of those rights in order to prevent a trade mark which has been used in relation to part of the goods or services being afforded extensive protection merely because it has been registered for a wide range of goods or services, which the General Court correctly took into account in paragraphs 29 to 31 of the judgment under appeal.

40. So far as concerns the concept of ‘part of the goods or services’ referred to in Article 42(2) of Regulation No 207/2009, it must be recalled that the Court has held, in the context of the application of Article 43(1) of that regulation, that a subcategory of the goods covered by an application for registration as an EU trade mark must be identified having recourse to a criterion enabling that subcategory to be delimited in a sufficiently precise manner (see, to that effect, judgment of 11 December 2014, *OHIM v Kessel medintim*, C-31/14 P, not published, EU:C:2014:2436, paragraph 37).

41. As the Advocate General noted in point 58 of her Opinion, the analysis carried out by the Court in that judgment can be transposed to the application of Article 42(2) of Regulation No 207/2009 since the definition of an independent subcategory of goods or services must be based on the same criteria, whether in relation to a request for restriction of the list of goods or services covered by the application for registration or an opposition, so as to make it possible, in the assessment of the likelihood of confusion, to compare the goods or services at issue, which are defined on the basis of the same criteria.

42. It follows, first, as the Advocate General noted in point 50 of her Opinion, that a consumer who wishes to purchase a product or service in a category that has been defined particularly precisely and narrowly, but within which it is not possible to make any significant subdivisions, will associate all the goods or services belonging to that category with the earlier mark, such

that that trade mark will fulfil its essential function of guaranteeing the origin of those goods or services. In those circumstances, it is sufficient to require the proprietor of the earlier mark to adduce proof of genuine use of that trade mark in relation to part of the goods or services in that homogeneous category.

43. Second, as the Advocate General noted in point 52 of her Opinion, with regard to goods or services in a broad category of goods, which may be sub-divided into several independent subcategories, it is necessary to require the proprietor of the earlier mark to adduce proof of genuine use of that mark for each of those autonomous subcategories. Indeed, if the proprietor of the earlier mark has registered his trade mark for a wide range of goods or services which he may potentially market, but which he has not done during the period of five years preceding the date of publication of the trade mark application against which it has filed an opposition, his interest in enjoying the protection of the earlier mark for those goods or services cannot prevail over his competitors’ interest in registering their trade mark for those goods or services.

44. With regard to the relevant criterion or criteria to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently, the Court has held, in essence, that the criterion of the purpose and intended use of the goods or services at issue is an essential criterion for defining an independent subcategory of goods (see, to that effect, judgment of 11 December 2014, *OHIM v Kessel medintim*, C-31/14 P, not published, EU:C:2014:2436, paragraph 39).

45. It is in the light of those principles that it is necessary to examine, first of all, the first part of the first ground of appeal, according to which the General Court should have relied, in its analysis consisting in ascertaining whether there existed a coherent subcategory of the earlier mark capable of being viewed independently, on the goods for which the earlier mark is registered.

46. In that regard, it should be noted that it is apparent both from the wording of the last sentence of Article 42(2) of Regulation No 207/2009 and from paragraphs 39 to 42 of the present judgment that it is important to assess in a concrete manner — principally in relation to the goods for which the proprietor of the earlier mark has furnished proof of use of the earlier mark — whether those goods constitute an independent subcategory in relation to the goods falling within the class of goods concerned, so as to link the goods for which genuine use of the earlier mark has been proved to the category of goods covered by the application for registration of that trade mark.

47. The General Court examined, in paragraph 33 of the judgment under appeal, whether the articles referred to in the proof of use produced by Taiga constituted an independent subcategory in relation to the goods in Class 25 of the Nice Agreement, that is to say, in relation to the more general category for which the earlier trade mark was registered. In addition, the General Court correctly linked those articles to that more general category, before concluding, in paragraph 34 of the

judgment under appeal, that those articles could not be regarded as substantially different.

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

49. Next, so far as concerns the second part of the first ground of appeal, the appellant criticises the General Court, in the first complaint thereof, for failing properly to apply the criterion of the purpose and intended use of the goods at issue in order to determine an independent subcategory of goods. That complaint must also be rejected as unfounded.

50. It is apparent from the judgment of 11 December 2014, OHIM v Kessel medintim (C-31/14 P, not published, EU:C:2014:2436, paragraphs 37 and 39 to 41) that the aim of the criterion of the purpose and intended use of the goods in question is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically, as the Advocate General observed in points 70 and 71 of her Opinion.

51. Accordingly, if, as in the present case, the goods concerned have several purposes and intended uses — as is often the case — determining whether there exists a separate subcategory of goods by considering in isolation each of the purposes that those goods may have will not be possible, contrary to what the appellant claims. Indeed, such an approach would not enable independent subcategories to be identified coherently and would have the effect, as the Advocate General noted in point 71 of her Opinion, of limiting excessively the rights of the proprietor of the earlier mark, inter alia in that his legitimate interest in expanding his range of goods or services for which his trade mark is registered would not sufficiently be taken into consideration.

52. The General Court was therefore right not to take into account each of the uses of the goods at issue — to cover, conceal, adorn or protect the human body — in isolation, those different uses combining for the purpose of putting those goods on the market, as the Advocate General noted in point 72 of her Opinion.

53. Last, the second complaint of the second part of the first ground of appeal, by which the appellant claims that the Court failed to take into account the fact that the goods were aimed at different publics and were sold in different shops, must also be rejected as unfounded, in so far as such criteria are not relevant for defining an independent subcategory of goods, but for assessing the relevant public (see, to that effect and by analogy, judgment of 11 December 2014, OHIM v Kessel medintim, C-31/14 P, not published, EU:C:2014:2436, paragraphs 37 and 41).

54. Accordingly, the first ground of appeal must be rejected as unfounded.

#### **Second ground of appeal**

55. The second ground of appeal is divided into three parts.

##### **First part of the second ground**

###### **– Arguments of the parties**

56. By the first part of the second ground of appeal, the appellant claims that, since the General Court misapplied the conditions for genuine use of the earlier

mark, it incorrectly came to the conclusion that the goods ‘*clothing*’ and ‘*headgear*’ covered by the mark applied for were identical to the goods covered by the earlier mark.

57. EUIPO and Taiga are of the view that the first part of the second ground of appeal must be dismissed as unfounded.

##### **– Findings of the Court**

58. In so far as the first part of the second ground of the appeal is based solely on an erroneous application of the conditions for genuine use of the earlier mark and the General Court did not, as is apparent from paragraphs 47, 52 and 53 of the present judgment, err in that regard, that part must be rejected as unfounded.

#### **Second part of the second ground**

##### **– Arguments of the parties**

59. By the second part of the second ground of appeal, which is divided into three complaints, the appellant challenges the General Court’s assessment of the conflicting signs’ visual, phonetic and conceptual similarity.

60. As far as the first complaint is concerned, the appellant considers that, had the General Court taken into account the unusual composition of the mark applied for, owing to the presence of ‘*asymmetric consonants*’ and the unusual spelling of that mark because of the group of letters ‘*igh*’, it would not have concluded that the conflicting signs were visually similar.

61. Regarding the second complaint, the appellant claims that the General Court incorrectly ‘*assumed*’, without any evidence, that the group of letters ‘*ti*’ was always pronounced ‘*tai*’. It is clear that that is not the case, however, and, therefore, that it was not required to adduce proof in that regard.

62. As regards the third complaint, the appellant criticises the General Court’s analysis whereby it found that the conceptual differences between the signs at issue had not been established in the territory of the European Union as a whole, such that those differences were not capable of counteracting the visual and phonetic similarities between those signs. First, contrary to what the General Court stated in paragraph 71 of the judgment under appeal, the word ‘*taiga*’ has a ‘*specific and immediate meaning*’ not only for average consumers from the north and east of the ‘*European continent*’, but also for those from the south of the continent as well as for English-speaking consumers. Indeed, due to the undisputed size of the boreal forest, named the ‘*taiga*’, as well as its significance for the world as a whole, the term is part of the general education of the ‘*European continent*’ and beyond.

63. Second, the General Court was wrong not to apply its own case-law according to which, in order to conclude that there are conceptual differences between the signs at issue, it is sufficient that a term is understood in a part of the European Union.

64. EUIPO maintains that the first three complaints put forward in support of the second part of the second ground of appeal must be dismissed as inadmissible and

that the first and third complaints must, in any event, be dismissed as unfounded.

65. Taiga is of the view that that part of the second ground must be rejected as unfounded.

#### –. Findings of the Court

66. It must be noted that, by the first and second complaints of the second part of the second ground of appeal, the appellant seeks to have the Court make a fresh assessment of the phonetic and visual similarity of the signs at issue, without invoking any distortion of the facts or evidence by the General Court in that regard.

67. It should be recalled that, in accordance with the second subparagraph of Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal lies on points of law only. The General Court has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence submitted to it. The appraisal of those facts and evidence does not, therefore, save where they have been distorted, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal. The assessment of the visual and phonetic similarity of the signs at issue is an assessment of a factual nature ([judgment of 19 March 2015, MEGA Brands International v OHIM](#), C-182/14 P, EU:C:2015:187, paragraphs 47 and 48 and the case-law cited).

68. Accordingly, the first and second complaints of the second part of the second ground of appeal must be rejected as inadmissible in so far as they seek a fresh assessment of the facts.

69. Moreover, to the extent that it must be considered that, under the second complaint, the appellant criticises the General Court's application of the rules on the burden of proof, reproaching it for having '*assumed*', without any evidence, that the group of letters '*ti*' was always pronounced '*tai*' and for having required the appellant to adduce evidence to the contrary, it should be recalled that, in paragraph 58 of the judgment under appeal, the General Court *inter alia* noted that the Board of Appeal had taken the view, in point 40 of the contested decision, that, at least for English-speaking consumers, the pronunciation of the syllables '*ti*' and '*tai*' of the marks at issue was identical. Furthermore, in paragraphs 60 to 62 of the judgment under appeal, the General Court approved the Board of Appeal's conclusion that the signs at issue were phonetically identical, at least for English-speaking consumers, after having pointed out that the appellant had adduced no evidence to suggest that the sound of the first syllables '*ti*' and '*tai*' of the signs at issue was not identical for the English-speaking public.

70. The General Court did not err in law in taking into account the fact that the appellant had not adduced evidence to call into question the assessment of the Board of Appeal that the first syllables '*ti*' and '*tai*' was pronounced identically for the English-speaking public in approving that assessment. Indeed, first, that assessment was illustrated by an example taken from the *Oxford English Dictionary*, as follows from point 40 of the contested decision. Second, in an action for

annulment before the General Court, the onus is on the applicant to show the alleged errors which, in its view, vitiate the contested decision.

71. The second complaint of the second part of the second ground of appeal must, accordingly, be rejected as unfounded to the extent that it reproaches the General Court for having disregarded the rules on the burden of proof.

72. By the third complaint, in the first place, the appellant, in essence, criticises the General Court for finding, in paragraph 71 of the judgment under appeal, that there was nothing in the file to establish that the word '*taiga*' had a '*specific and immediate meaning*' for average English-speaking consumers and consumers from the south of the '*European continent*'.

73. By that line of argument, the appellant, without developing a legal argument aimed specifically at identifying the error of law vitiating the judgment under appeal, seeks to have the Court make a fresh assessment of the facts and evidence. In so far as it does not invoke any distortion of those elements, that line of argument must, accordingly, be rejected as inadmissible (see, to that effect, judgment of 13 November 2019, *Outsource Professional Services v EUIPO*, C-528/18 P, not published, EU:C:2019:961, paragraph 47 and the case-law cited).

74. In the second place, in so far as the appellant challenges the methodology and criteria applied by the General Court in its assessment of the conceptual similarity of the signs at issue, it actually reproaches it for having erroneously applied Article 8(1)(b) of Regulation No 207/2009, which is a question of law which can be subject to review by the Court of Justice on appeal (see, to that effect, [judgment of 12 December 2019, Der Grüne Punkt v EUIPO](#), C-143/19 P, EU:C:2019:1076, paragraph 51 and the case-law cited).

75. The appellant criticises the General Court for finding, in paragraphs 67 and 71 of the judgment under appeal, that it had not shown that the word '*taiga*' had a '*specific and immediate meaning*' for the relevant public made up of EU consumers as a whole, when it is not apparent from the case-law of the General Court that the word in question must be understood by the whole of the relevant public. It is sufficient that only part of the relevant public associates the term in question with a particular concept to conclude that there are conceptual differences liable to counteract visual and phonetic similarities between the signs at issue for the whole of the relevant public.

76. The Court, however, has held that, where a proprietor of an EU trade mark opposes, pursuant to Article 8(1)(b) of Regulation No 207/2009, registration of a similar EU trade mark which would create a likelihood of confusion, such an opposition must be upheld where it is established that there is a likelihood of confusion in part of the European Union ([judgment of 22 September 2016, combit Software](#), C-223/15, EU:C:2016:719, paragraph 26 and the case-law cited).

77. Consequently, if visual or phonetic similarities between the signs at issue exist for a substantial part of the relevant public, for which conceptual differences

between those signs, liable to counteract those similarities, have not been proved, the General Court must carry out a global assessment of the likelihood of confusion (see, to that effect, judgment of 4 March 2020, EUIPO v Equivalenza Manufactory, C-328/18 P, EU:C:2020:156, paragraphs 74 to 76 and the case-law cited).

78. The General Court therefore did not err in law in taking into account the fact that the appellant had not adduced evidence that, for a substantial part of the relevant public, the term ‘taiga’ had a ‘specific and immediate meaning’.

79. Therefore, the second part of the second ground of appeal must be rejected as partly inadmissible and partly unfounded.

### **Third part of the second ground – Arguments of the parties**

80. By the third part of the second ground of appeal, the appellant claims that there is no likelihood of confusion on the part of the relevant public, within the meaning of Article 8(1) of Regulation No 207/2009, given that, with regard to the global assessment of that public, first, the signs at issue are marketed in different shops, second, the visual dissimilarities between the terms ‘taiga’ and ‘tigha’ are more important than any assumed phonetic similarities and, third, the goods at issue are similar to a low degree.

81. EUIPO considers that the third part of the second ground of appeal must be dismissed as inadmissible and, in any event, as unfounded.

82. Taiga contends that that part must be rejected as unfounded.

### **– Findings of the Court**

83. The third part of the second ground of appeal must be rejected as unfounded since the appellant does not identify any paragraph of the judgment under appeal which it is challenging nor does it allege any error of law on the part of the General Court, but merely reiterates the line of argument it had already developed in its application at first instance (see, to that effect, judgment of 6 September 2018, Basic Net v EUIPO, C-547/17 P, not published, EU:C:2018:682, paragraph 43 and the case-law cited).

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

85. Having regard to the foregoing considerations, the appeal must be dismissed as partly inadmissible and partly unfounded.

### **Costs**

86. Under Article 137 of the Rules of Procedure of the Court of Justice, applicable to the procedure on appeal pursuant to Article 184(1) of those rules, a decision as to costs is to be given in the judgment or order which closes the proceedings. Pursuant to Article 138(1) of those Rules of Procedure, which is also 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.

87. Since EUIPO and Taiga have applied for costs to be awarded against the appellant and the latter has been

unsuccessful, the appellant must be ordered to pay the costs of this appeal.

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

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

\* Language of the case: English.

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### **OPINION OF ADVOCATE GENERAL**

**E. SHARPSTON**

delivered on 19 December 2019 (1)

Case C-714/18 P

ACTC GmbH

v

European Union Intellectual Property Office (EUIPO)  
 ”(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Application for registration of the EU word mark tigha — Opposition proceedings brought by the proprietor of the earlier EU trade mark TAIGA — Partial rejection of the application for registration — Article 8(1)(b) — Assessment of the likelihood of confusion — Assessment of the conceptual similarity of the signs at issue — Article 42(2) — Proof of genuine use of the earlier mark — Proof of use ‘in relation to ... part of the goods or services’ — Determination of an independent subcategory of goods)”

### **I. Introduction**

1. The present case should lead the Court to rule on the scope of the concept of ‘part of the goods or services’ referred to in Article 42(2) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [EU] trade mark, (2) as amended by Regulation (EU) 2015/2424, (3) which governs the proof of genuine use of an earlier EU trade mark in the context of opposition proceedings brought by the proprietor of that mark.

2. Although that concept was interpreted by the General Court of the European Union in the judgment of 14 July 2005, Reckitt Benckiser (España) v OHIM — Aladin (ALADIN), (4) the Court has not had occasion, however, to confirm the principles set out therein, on which the judgment of 13 September 2018, ACTC v EUIPO — Taiga (tigha), (5) the subject of this appeal (‘the judgment under appeal’) brought by ACTC GmbH, is based.

3. This appeal therefore gives the Court the opportunity to examine an essential component of the analysis relating to the existence of genuine use of the earlier EU trade mark, namely the material extent of that use, following the judgment of 19 December 2012, Leno Merken, (6) which concerned the territorial extent of that use. In particular, the Court is asked to rule on the criterion to be used for defining a subcategory of goods and/or services for which the earlier EU trade mark has been put to genuine use.

4. At the request of the Court, this Opinion will be limited to the analysis of the main new legal issues which arise in this case, namely those raised by the first ground of appeal, alleging infringement of Article 42(2) of Regulation No 207/2009, and by the third complaint of the second part of the second ground of this appeal,



relating to the assessment of the conceptual similarity of the signs at issue.

## II. Legal framework

5. Article 8(1)(b) of Regulation No 207/2009 provides:

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

*...*

*(b)*

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

6. The first subparagraph of Article 15(1) of that regulation is worded as follows:

*'If, within a period of five years following registration, the proprietor has not put the EU trade mark to genuine use in the Union in connection with the goods and services in respect of which it is registered ..., the EU trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.'*

7. Article 42(2) of that regulation states:

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

## III. Background to the dispute

8. The background to the dispute was set out in detail in the judgment under appeal, in particular, in paragraphs 1 to 10 thereof, to which I refer in that regard. The main points needed to understand this Opinion may be summarised as follows.

9. This dispute arises from the opposition filed by Taiga AB, proprietor of the EU word mark TAIGA ('the earlier mark') against registration of the word sign 'tigha' ('the mark applied for') sought by ACTC, in relation to goods in, inter alia, Class 25 of the Nice Agreement (7) and corresponding to the following description: *'Clothing; outer clothing; underwear; footwear; headgear for wear and headwear; work shoes and boots; working overalls; gloves; belts and socks.'*

10. That opposition is based on the existence of a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009.

11. By a decision of 9 February 2015, the Opposition Division rejected the opposition. Taiga filed a notice of appeal against that decision. By a decision of 9 December 2016 ('the contested decision'), the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) partially annulled the decision of the Opposition Division, namely for all the goods at issue, in Class 25 of the Nice Agreement, and consequently rejected the application for registration concerning those goods.

12. In the first place, the Board of Appeal found that the use of the earlier mark had been proved, inter alia, for certain goods in Class 25 of the Nice Agreement (clothing; outer clothing; underwear; headgear for wear and headwear; working overalls; gloves; belts and socks).

13. In the second place, in the context of the assessment of the likelihood of confusion, after having observed that the relevant territory was that of the European Union, and that consumers would pay an enhanced level of attention when buying goods covered by the earlier mark and an average level of attention in respect of certain goods covered by the mark applied for (clothing, footwear, headgear and bags), the Board of Appeal found, in particular, that the goods at issue, in Class 25 of the Nice Agreement, were identical or similar to the goods covered by the earlier mark, that the signs at issue were visually very similar, phonetically identical, at least for English-speaking consumers, and that those signs could not be associated with any concept for the majority of the relevant public. In those circumstances, the Board of Appeal found, regarding the goods in Class 25 of the Nice Agreement, that there was a likelihood of confusion between the marks at issue.

## IV. The procedure before the General Court

14. On 13 February 2017, the appellant brought an action before the General Court for the annulment of the contested decision. In support of its action, it relied, in essence, on two pleas in law, alleging infringement, first, of Article 42(2) of Regulation No 207/2009 and, second, of Article 8(1)(b) of that regulation.

15. By the judgment under appeal, the General Court dismissed that action in its entirety.

## V. The forms of order sought by the parties and the procedure before the Court of Justice

16. By its appeal, the appellant requests the Court, primarily, to set aside the judgment under appeal and to annul the contested decision and, in the alternative, to set aside that judgment and refer the case back to the General Court. It also asks the Court to order EUIPO to pay the costs.

17. EUIPO requests the Court to dismiss that appeal and to order the appellant to pay the costs.

18. Taiga, for its part, requests the Court to dismiss that appeal and to order the appellant to pay the costs, including those incurred by Taiga.

## VI. Assessment

19. In support of its appeal, the appellant puts forward two grounds.

20. The first ground of appeal alleges infringement by the General Court of Article 42(2) of Regulation No

207/2009. By that ground, the appellant asks the Court to adjudicate on the rules and principles applicable to the definition of a subcategory of goods in connection with proof of genuine use of the earlier mark. (8) 21. The second ground of appeal alleges infringement by the General Court of Article 8(1)(b) of that regulation. The appellant criticises the assessments made by the General Court concerning the existence of a likelihood of confusion between the marks at issue and, in particular, concerning the manner in which the examination relating to the conceptual similarity of the conflicting signs was carried out.

**A. The first ground of appeal, alleging infringement of Article 42(2) of Regulation No 207/2009**

**1. The judgment under appeal**  
22. Before the General Court, the appellant claimed that the proof of use submitted by Taiga did not prove genuine use of the earlier mark for the category of 'clothing', as a whole, in Class 25 of the Nice Agreement. In particular, the appellant criticised the Board of Appeal for not having found that there was an independent subcategory of goods covered by the earlier mark, which referred only to special weather protective outdoor clothing. (9)

23. The General Court examined the arguments raised by the appellant in paragraphs 23 to 37 of the judgment under appeal. It recalled, first of all, in paragraph 28 of that judgment, the provisions laid down in Articles 15 and 42 of Regulation No 207/2009. The General Court then recalled the principles it has developed in its own case-law, concerning, on the one hand, in paragraphs 29 to 31 of the judgment under appeal, the ratio legis of Article 42 of that regulation, and, on the other hand, in paragraph 32 of that judgment, the criteria to be used for determining whether an independent subcategory of goods exists for the purposes of that provision.

24. For the purposes of the analysis, I feel that it would be useful to reproduce those paragraphs:

'29. The provisions of Article 42 of Regulation No 207/2009 allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration, so they cannot be interpreted in such a way as to give rise to an unjustified limitation of the scope of protection of the earlier mark, in particular in the event that the goods or services for which that mark was registered constitute a sufficiently narrowly defined category, and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him (see, to that effect, judgment of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraphs 51 and 53).

30. If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories

*capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition [judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraph 45, and judgment of 13 February 2007, *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, [ (10)] (T-256/04, EU:T:2007:46, paragraph 23)].*

31. However, although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not result in the proprietor of that trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. It must be observed in that regard that it is in practice impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories [judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraph 46, and judgment of 6 March 2014, *Anapurna v OHIM — Annapurna (ANNAPURNA)*, T-71/13, not published, EU:T:2014:105, paragraph 63].

32. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for goods or services which can meet their specific needs, the purpose or intended use of the goods or services in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services. In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, *August Storck v EUIPO — Chiquita Brands (Fruitfuls)*, T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited).' (11)

25. After thus recalling the applicable legal rules and case-law principles, the General Court examined, in paragraphs 33 to 36 of the judgment under appeal, whether the proof submitted by Taiga actually made it possible to discern an independent subcategory of goods

containing only special weather-protective outdoor clothing.

26. First, the General Court held that the articles referred to in the evidence of use submitted by Taiga have ‘*the same purpose, since they are intended to cover the human body, to conceal, adorn and protect it against the elements*’ and ‘*cannot, in any event, be regarded as “[in essence] different”*’ within the meaning of the case-law referred to in paragraph 31 of the judgment under appeal. (12)

27. Second, the General Court pointed out that the particular characteristics of those goods are, in principle, irrelevant, since, in accordance with the case-law cited in paragraph 32 of the judgment under appeal, they are not relevant to the definition of a subcategory of goods. (13)

28. In paragraph 37 of the judgment under appeal, the General Court consequently rejected that plea.

## 2. Analysis

29. By the first ground of its appeal, the appellant criticises paragraph 34 of the judgment under appeal in which the General Court held that the articles referred to in the evidence of use submitted by Taiga had the same purpose, since they were intended ‘*to cover the human body, to conceal, adorn and protect it against the elements*’.

30. The appellant maintains that that analysis is vitiated by two errors of law, since the General Court departed from the rules and principles which it had itself identified in its judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN) and Mundipharma v OHIM — Altana Pharma (RESPICUR)*.

31. This first ground of appeal is divided into two parts.

32. By the first part of this ground, the appellant complains that the General Court based its assessment not on goods for which the earlier mark was registered but only on the goods referred to in the evidence of use submitted by Taiga. According to the appellant, the question which the General Court should have answered is whether the earlier mark was registered for a category of goods which was sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, so that the use related only to specific goods in a broader category.

33. By the second part of this ground of appeal, the appellant criticises the General Court for not taking into account the fact that those goods are designed to have multiple uses, namely to cover, conceal, adorn or protect the human body, that they are targeted, furthermore, at a different public and, finally, that they are sold in shops which are also different, so that those goods may easily be distinguished from the clothing goods covered by the mark applied for.

34. I note, as a preliminary point, that it is not for the Court of Justice to rule on whether genuine use of the earlier mark has actually been proved for a subcategory of goods different from the generic category of the clothing in Class 25 of the Nice Agreement. That is an assessment of the relevant facts and of the evidence, which lies, in principle and according to settled case-

law, within the sole jurisdiction of the General Court. (14)

35. In contrast, it is for the Court of Justice to rule on the legal principles and rules used by the General Court for the purposes of its assessment. The concept of ‘*part of the goods or services*’ referred to in Article 42(2) of Regulation No 207/2009 is intended to specify the material extent of use, which constitutes an essential component for the purposes of analysing whether there is genuine use of the trade mark.

36. Although the appellant makes no criticism of the case-law developed by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN) and Mundipharma v OHIM — Altana Pharma (RESPICUR)*, it is, in my view, essential for the Court of Justice to express a view on that case-law in order not only to rule on the heads of complaint raised by the appellant in this appeal, but also to confirm or call into question case-law on which the General Court has relied for several years.

### (a) The rules and principles set out by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN) and Mundipharma v OHIM — Altana Pharma (RESPICUR)*

37. I wish to state clearly at the outset that I agree with the considerations set out by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN) and Mundipharma v OHIM — Altana Pharma (RESPICUR)*, reproduced in point 24 of this Opinion.

38. I think that the interpretation which the General Court has given to the concept of ‘*part of the goods or services*’, in Article 42(2) of Regulation No 207/2009, makes it possible, above all, to ensure the essential function of the trade mark. That interpretation is also in line with the rules laid down by the EU legislature in that regulation and with the case-law of the Court of Justice concerning the interpretation of the concept of ‘*genuine use*’ of the earlier mark.

39. The function of a trade mark, I would point out, is to guarantee the identity of origin of the marked goods or services to the consumer by enabling that person, without any possibility of confusion, to distinguish those goods or services from others which have a different origin. (15)

40. In order to ensure that that function can be fulfilled, Regulation No 207/2009 confers on the proprietor of the trade mark a series of rights and powers, thus enabling – through the exclusive use of the distinctive sign and the identification of the goods or services which it covers – fair and undistorted competition on the market. However, those rights must be limited to what is strictly necessary for the attainment of that objective, particularly as, unlike the protection granted by other intellectual and industrial property rights, the protection conferred by trade mark rights may be of unlimited duration.

41. The EU legislature has therefore sought to ensure that trade marks can fulfil their essential function while at the same time ensuring that the trade mark right is not

diverted from its function in order to obtain an unfair competitive advantage.

42. It is thus apparent from Article 15 of Regulation No 207/2009 that there is no justification for protecting an earlier mark unless it is put to '*genuine use in the Union in connection with the goods or services in respect of which it is registered*'. (16)

43. To that end, Article 42(2) of that regulation provides that an EU trade mark applicant may request proof that the earlier mark has been put to '*genuine use*' in the Union during the period of five years preceding the date of publication of the trade mark application against which an opposition has been filed. (17) The EU legislature therefore considered that a period of five years was reasonable for assessing whether the use is genuine.

44. It is apparent from the Court's case-law that the concept of '*genuine use*' is an autonomous concept of EU law. (18) According to the Court, there is '*genuine use*' of a trade mark where it is used in accordance with its essential function; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. (19) The Court considers that a trade mark which is not used obstructs not only competition — since it limits the range of signs which can be registered as trade marks by others and denies competitors the opportunity to use that trade mark or a similar one when putting on to the internal market goods or services which are identical or similar to those covered by the mark in question — but also the free movement of goods and services. (20)

45. I consider that the principles set out by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)* are in line with the case-law of the Court of Justice.

46. In the first place, the General Court examined, in the judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and in the context of Article 43(2) of Council Regulation (EC) No 40/94 on the Community trade mark (21) (now Article 42(2) of Regulation No 207/2009), the issue of the extent of the protection to be afforded in the event of '*partial use*' of the earlier mark, that is to say of a mark in relation to which genuine use has been established for only '*part of the goods or services*' for which it has been registered. On the basis that the provisions of Article 43 of Regulation No 40/94 (now Article 42 of Regulation No 207/2009) constitute a limitation on the rights which the proprietor of the earlier mark derives from his registration, the General Court interpreted the concept of '*part of the goods or services*' referred to in that provision as meaning that it enables the earlier mark above all to fulfil its essential function. The interpretation it provided thus seeks to strike a fair balance between, on the one hand, the maintenance and preservation of the exclusive rights conferred, for that purpose, on the proprietor of the earlier mark and, on the other hand, the limitation of those rights in order to prevent a trade mark which has been used in relation to part of the goods or services being afforded extensive protection merely because it

has been registered for a wide range of goods or services. (22)

47. The breadth of the categories of goods or services for which the earlier mark was registered is a key element of that balance. (23)

48. The General Court thus identifies two kinds of situation.

49. The first situation is that in which the earlier mark has been registered for goods and services defined particularly '*precisely and narrowly*' and, thus, forming a more homogenous category of goods or services. In that case, the General Court considers that it is not possible to make any significant sub-divisions within the category concerned, since the proof of genuine use of the mark for those goods or services must cover the entire category for the purposes of the opposition. (24)

50. I agree with the General Court's reasoning. As regards goods in a category of more or less homogenous goods, a consumer who wishes to purchase a product in that category will think or is likely to think of the earlier mark and of what that mark will guarantee him as regards the quality of the product, for example. Accordingly, it is justified and adequate, in my view, to prove genuine use of the mark for part of the goods in that category. That makes it possible to avoid the likelihood of confusion referred to in Article 8(1)(b) of Regulation No 207/2009, and also to protect the commercial interests of the proprietor of the earlier mark. It is important not to limit unduly the exclusive rights of that proprietor to extend his range of goods within that homogenous category by requiring excessive proof of genuine use.

51. The second situation is that in which the earlier mark has been registered for a broad heterogeneous category of goods or services. The General Court assumes, in that case, that it is possible to identify a number of subcategories capable of being viewed independently, provided that those subcategories are coherent, which means that they contain goods or services which are '*similar*' or which are not '*in essence different*'. (25) In that situation, the General Court considers that proof of genuine use of the trade mark in relation to part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. (26)

52. I also agree with that analysis. With regard to goods in a heterogeneous category of goods which are nevertheless in the same class of goods, there is not only a lower risk of confusion on the part of the relevant public, but also less justification for protecting the commercial interests of the proprietor of the earlier mark. If he has registered his trade mark for a broad range of goods which he may possibly market, but which, clearly, he has not yet put on the market, he blocks the access of his competitors to a large goods market. The solution set out by the General Court therefore ensures observance of the rights afforded to the proprietor of the earlier mark, in particular that of enjoying protection in relation to goods or services similar to those for which he has been able to prove

genuine use and that of extending his range of goods to include them, while making the trade mark available for goods or services which, because they are ‘*sufficiently distinct*’, (27) fall within another category or subcategory of goods or services.

53. In the second place, in order to identify a ‘*coherent*’ subcategory of goods capable of being viewed independently, the General Court relies on the criterion of the purpose or intended use of the goods or services at issue since it considers that the nature or characteristics of those goods or services are irrelevant for the purposes of that assessment. (28)

54. Once again, I can only agree with that assessment.

55. First, in my view, it makes it possible to safeguard the exclusive rights of the proprietor of the earlier mark. To define an independent subcategory of goods taking account not only of the purpose but also of the particular nature and characteristics of those goods would be tantamount to limiting far too strictly the material scope of those rights and, in particular, the rights of that proprietor to develop and extend his range of goods for which the earlier mark is registered. Although the criteria relating to the nature and characteristics of the goods are, in themselves, important criteria, they are more relevant for defining the relevant public and assessing the likelihood of confusion.

56. Second, I would point out that the Court has endorsed the General Court’s approach in assessing the validity of a limitation on goods proposed by a trade mark applicant pursuant to Article 43(1) of Regulation No 207/2009.

57. In the judgment of 11 December 2014, *OHIM v Kessel medintim*, (29) the Court held that the criterion of the purpose and intended use of the goods at issue was a criterion which made it possible to define sufficiently precisely a subcategory of goods covered by the application for registration as an EU trade mark, thus satisfying the requirement of clarity laid down in Article 43(1) of Regulation No 207/2009. (30) As is implicit in paragraph 39 of that judgment, (31) the Court confirmed the case-law established by the General Court in the judgment in *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, according to which the purpose or intended use of the product or service at issue is a decisive criterion in the definition of a subcategory of goods or services, since consumers primarily seek a product or service which can meet their specific needs. (32)

58. In my view, there is nothing to prevent the Court’s analysis in the judgment of 11 December 2014, *OHIM v Kessel medintim*, (33) with regard to the definition of a subcategory of goods in the context of Article 43(1) of Regulation No 207/2009, from being transposed to the application of Article 42(2) of that regulation. It seems to me that the definition of a subcategory of goods, whether in relation to an opposition or a restriction, must be based on identical criteria, so as to make it possible, in the assessment of the likelihood of confusion, to compare the goods at issue, which are defined on the basis of the same criteria.

59. In the light of those factors, I therefore think that the

Court should confirm the rules and principles which the General Court set out in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)* for the purposes of defining a subcategory of goods and/or services in connection with the application of Article 42(2) of Regulation No 207/2009. 60. It is now necessary to examine the merits of the first ground of appeal raised by the appellant, which is divided into two parts.

**(b) The first part of the first ground of appeal, alleging incorrect application of the method for determining an independent subcategory of goods**

61. I should point out that, by the first part of the first ground, the appellant maintains that, in paragraph 34 of the judgment under appeal, the General Court erred in law by assessing whether there was an independent subcategory of goods solely on the basis of the goods referred to in the evidence of use submitted by Taiga. According to the appellant, the General Court should have considered whether the earlier mark was registered for a category of goods which was sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently.

62. I consider that this part of the first ground of appeal is unfounded.

63. Since the proprietor of the earlier mark has proved genuine use of that mark in relation to part of the goods for which it is registered, the question whether those goods fall within a subcategory capable of being viewed independently must be assessed in concreto with regard, above all, to those goods. It is therefore not a case of defining, in an abstract manner, subcategories of goods, but rather of comparing the goods in respect of which the earlier mark has been put to genuine use with the category of goods covered by the application for registration of that mark.

64. It must be concluded from a reading of paragraphs 33 and 34 of the judgment under appeal that the General Court did just that. It is apparent from paragraph 33 of that judgment that the General Court examined whether the articles referred to in the evidence of use submitted by Taiga constituted an independent subcategory ‘*in relation to the goods in Class 25 [of the Nice Agreement]*’, that is to say, in relation to the more general category of goods covered by the earlier mark. By concluding, in paragraph 34 of the judgment under appeal, that those articles ‘*cannot, in any event, be regarded as “[in essence] different” within the meaning of [the judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*]*’, the General Court therefore correctly compared the articles for which genuine use of the earlier mark was proved with the goods in the more general category of clothing for which that mark was registered.

65. I therefore propose that the Court reject this first part of the first ground of appeal as unfounded.

**(c) The second part of the first ground of appeal, alleging incorrect application of the criteria for determining an independent subcategory of goods**

66. The second part of the first ground of appeal is

composed of two complaints.

**(1) The first complaint, relating to the criterion of the purpose and intended use of the goods**

67. In support of its first complaint, the appellant criticises the General Court for not having applied correctly the criterion of the purpose and intended use of the goods at issue in order to identify a coherent subcategory of goods capable of being viewed independently. It maintains that the General Court did not take into account the different purposes of those goods or the multiple uses for which they are intended for the purposes of that identification, such uses consisting, *inter alia*, in ‘*adorning*’ or ‘*protecting*’ the human body which, according to the appellant, are mutually exclusive.

68. I consider that this complaint is admissible since the appellant does not dispute the findings of the General Court concerning the purpose and intended use of the goods for which genuine use has been established, but the way in which the General Court applied the criterion of the purpose and intended use in order to determine whether there was an independent subcategory of goods for the purposes of Article 42(2) of Regulation No 207/2009.

69. However, I consider that the appellant’s criticism is unfounded.

70. The aim of the criterion of the purpose and intended use of the goods is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically.

71. A product has purposes which progress and know-how tend to multiply. Cleansing products, for example, are no longer intended only to clean the skin, but also to care for it, whether in a medical sense or not. In the same way, clothing goods fulfil, as well as their primary function, that is, to cover, conceal or protect the human body against adverse weather conditions, a common aesthetic function, by contributing to the consumer’s external image. Although consumers look for clothes to protect themselves against the rain, be that outer clothing or a hat, or to protect themselves against the cold, such as underwear or gloves and socks, they may also look for the most aesthetically pleasing garment. Clearly, each of those purposes cannot be considered in isolation in determining whether there is a distinct subcategory of goods. If that were the case, it would limit once again the rights of the proprietor of the earlier mark to expand and enhance his range of goods. Moreover, it would obviously discourage research and development which trade mark law specifically aims to encourage.

72. In the judgment under appeal, the General Court was therefore right, in my view, not to distinguish between the uses consisting of ‘*protecting*’ the human body, ‘*adorning*’ it, or ‘*concealing*’ it and ‘*covering*’ it, which are intended uses of clothing goods. Far from being mutually exclusive, those different uses are combined for the purpose of putting those goods on the market.

73. I would point out however that those different purposes are a factor which may be taken into consideration when assessing the relevant public, its level of attention and the likelihood of confusion.

74. In the light of these factors, I therefore propose that the Court reject this first complaint of the second part of the first plea as unfounded.

**(2) The second complaint, relating to the criteria concerning the nature and characteristics of the goods at issue**

75. By the second complaint, the appellant criticises the General Court for not having properly considered the fact that the goods at issue were targeted at a different public and that they were, furthermore, sold in shops which were also different, so that those goods differ from the clothing goods covered by the mark applied for.

76. This complaint must be rejected at the outset as unfounded.

77. It is apparent from the case-law which I have just examined that criteria other than the purpose and intended use of the goods at issue, such as the public at which they are targeted or their distribution chain, are not, as a general rule, relevant for defining a subcategory of goods capable of being viewed independently. Accordingly, the General Court cannot be said to have committed any error of law by not taking those criteria into account for the purposes of its assessment.

78. In the light of all those considerations, I therefore propose that the Court reject the first ground of appeal as unfounded.

**B. Focused consideration of the second ground of appeal**

79. In accordance with the Court’s request, this Opinion will be limited to the analysis of the second part of this second ground of appeal and, in particular, to the third complaint thereof.

80. In order to give a better understanding of the context of that complaint, I should point out that, by its second ground of appeal, the appellant maintains that the General Court wrongly concluded that there was a likelihood of confusion between the marks at issue. The first part of this ground alleges an incorrect assessment of the similarity or identity of the goods at issue. The second part of the ground of appeal is made up of three complaints, concerning the assessment of the visual, phonetic and conceptual similarity respectively of the signs at issue. Finally, the third part of the second ground of appeal concerns the global assessment of the likelihood of confusion carried out by the General Court.

81. As regards, in particular, the third complaint of the second part of the second ground of appeal, this alleges that the General Court incorrectly assessed the conceptual similarity of the signs at issue. The appellant criticises, in essence, the General Court’s analysis in which it concluded that the conceptual differences between the mark applied for and the earlier mark had not been established on the territory of the European Union as a whole, so that they could not offset the visual and phonetic similarities between the signs at issue.

82. In support of that complaint, the appellant relies on two arguments.

83. As regards the first argument, the appellant criticises the General Court’s analysis in paragraph 71 of the judgment under appeal, in which it held that the appellant had not succeeded in showing that the word

'taiga' has specific meaning for average consumers located in the south of the European continent and for English-speaking consumers.

84. According to the appellant, that analysis is incorrect. It claims that it developed that argument in paragraph 18 of its application to the General Court and demonstrated indisputably that that term forms part of the current terminology of the French language and moreover, of general education throughout Europe given the size of the area to which that term relates.

85. In my view, that argument is manifestly inadmissible.

86. It should be pointed out that, in paragraph 71 of the judgment under appeal, the General Court found that *'there is nothing in the file to establish that the word "taiga" has a specific and immediate meaning for average consumers who are located in the parts of the territory of the European Union other than the north and east of the European continent, who constitute a significant proportion of EU consumers'* and that that is the case, *'inter alia, for average consumers in southern parts of the European continent and English-speaking consumers'*.

87. It is settled case-law that the General Court has exclusive jurisdiction to assess the value which should be attached to the evidence produced before it. That assessment does not therefore constitute, save where the evidence has been distorted, a point of law which is subject to review by the Court of Justice on appeal. (34)

88. In its appeal, the appellant has not established, or even alleged, that the assessment in paragraph 71 of the judgment under appeal was based on a distortion of the evidence. Moreover, I would point out in the alternative that, contrary to what it alleges, the appellant did not develop those arguments in paragraph 18 of its application.

89. Consequently, I consider that this first argument must be rejected as manifestly inadmissible.

90. As regards the second argument, the appellant criticises the General Court for having disregarded its own case-law on assessing the conceptual similarity of the signs at issue.

91. The appellant submits that the analysis in paragraph 67 of the judgment under appeal, which led the General Court to conclude that the appellant had failed to demonstrate that the word 'taiga' has a clear and specific meaning from the point of view of the relevant public made up of EU consumers as a whole, is unsupported in the case-law to which the General Court expressly referred, namely the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*. (35) Moreover, the appellant maintains that, in accordance with the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini (PANINI)*, (36) in order to conclude that there are conceptual differences between the signs at issue, it is sufficient that a term is understood in a part of the European Union.

92. After examining that case-law, I consider that neither of those criticisms is well founded.

93. As regards the first criticism, relating to an incorrect

reference to the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*, (37) it is useful to recall that, in paragraph 54 of that judgment, the General Court held that conceptual differences between the signs at issue are such as to counteract, to a large extent, visual and aural similarities if one of the marks at issue has, from the point of view of the 'relevant public', a clear and specific meaning so that the public is capable of grasping it immediately.

94. I begin by observing that, in view of the words used by the General Court in that judgment, it was entitled to conclude, in the judgment under appeal, that, for all consumers located in the territory of the 28 Member States of the European Union, the word 'taiga' would not clearly and immediately prompt them to recall their geographical education so that they would readily associate it with the boreal forest.

95. Having said that, I observe that, in the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*, (38) the General Court referred to the 'relevant public' without any further mention or clarification, whereas, in paragraph 67 of the judgment under appeal, it stated that the relevant public was *'made up of EU consumers, as a whole'*. It is that detail of *'as a whole'* that the appellant in this case is disputing.

96. I do not think that, by adding that detail, the General Court disregarded its case-law or committed any error of law.

97. As is apparent from paragraph 67 of the judgment under appeal, the detail *'as a whole'* is designed to show that it is necessary to take into account the perception of consumers located in all the States which make up the European Union. It thus enables the General Court to reject the appellant's argument relating to the perception of consumers located *'in many [EU] countries'*.

98. The General Court thus applied its case-law according to which, *'[w]here the protection of the earlier trade mark extends to the entirety of the European Union, it is necessary to take into account the perception of the marks at issue by the consumer of the goods in question in that territory'*. (39) Unlike the case which gave rise to the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*, (40) in which the relevant public was composed of German consumers, (41) in the case in the main proceedings the relevant public is composed, as is apparent from paragraphs 38 and 39 of the judgment under appeal, of consumers located in the territory of the European Union.

99. Finally, I would point out that the reference to the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*, (42) is preceded by the words *'see, to that effect'*. The expression *'to that effect'* shows that the General Court intended to refer to the principle set out in the judgment in question while specifically applying that principle to the present case. That expression did not therefore require the General Court to reproduce in identical terms the principle set out in the judgment in question. It

allowed it, on the contrary, in paragraph 67 of the judgment under appeal, to take the specific features of the present case into account.

100. Accordingly, it seems to me that it cannot be alleged that the General Court erred in referring to paragraph 54 of the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel* (BASS). (43)

101. As regards the second criticism, relating to the General Court's failure to have regard to the judgment of 11 December 2013 *Eckes-Granini v OHIM — Panini* (PANINI), (44) I think that that too is unfounded.

102. Contrary to what the appellant maintains, that judgment does not permit the inference that it is sufficient that a term is understood in a part of the European Union to conclude that there are conceptual differences which offset the visual and phonetic similarities between the signs at issue.

103. It is first necessary to recall the context of the case which gave rise to that judgment.

104. In that case, the General Court was called upon to examine whether, for the relevant public consisting of EU consumers, there was a clear conceptual difference between the element '*panini*', the subject of the mark applied for, and the element '*granini*', the subject of the earlier mark.

105. After having found, at the outset, that the element '*granini*' had no meaning, the General Court examined to what extent the relevant public associated the element '*panini*' with a particular concept. To that end, the General Court distinguished between, first, the Italian-speaking public, which it considered quite able to associate the element '*panini*' with small bread rolls or sandwiches made from those small bread rolls and for which there was a clear conceptual difference between the signs at issue, second, the non-Italian-speaking public, such as the Spanish- or French-speaking public, also capable of associating the element '*panini*' with a particular concept and, finally, third, the public for which that element '*panini*' was, by contrast, wholly meaningless. (45)

106. At the end of that analysis, the General Court confirmed the assessment of the Board of Appeal, which had found that, in some Member States, such as Italy and Spain, the signs at issue were conceptually different, whereas, in other Member States, in which the element '*panini*' had no meaning, no comparison could be made between the signs at issue from a conceptual point of view. (46)

107. Contrary to what the appellant maintains, the General Court did not therefore consider in the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini* (PANINI), (47) that it is sufficient that one section only of the relevant public associates the term in question with a particular concept to conclude that there are conceptual differences capable of offsetting the visual and phonetic similarities between the signs at issue.

108. Accordingly, it cannot be alleged that, in the judgment under appeal, the General Court disregarded the rules applied in the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini* (PANINI). (48)

109. I would point out that, in the judgment under appeal, the General Court followed an analytical framework similar to that which it had adopted in the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini* (PANINI): (49) it examined the extent to which the relevant public (consisting, I would recall, of EU consumers) was able to associate the word '*taïga*' with a specific concept. The General Court distinguished, in particular, between: – consumers located in the north and east of the European continent, who are very likely to be able to associate the word '*taïga*' with the boreal forest and for whom there is therefore a conceptual difference between the signs at issue, (50)

– '*average*' consumers located in parts of the territory of the European Union other than the north and east of the European continent, in particular, consumers from southern Europe and English-speaking consumers, who constitute a significant proportion of the relevant public and for whom it was not established that there is a clear conceptual difference between the signs at issue. (51)

110. Since, in accordance with the case-law referred to, the meaning of a word must be assessed in relation to the way in which it is understood by the relevant public as a whole and must therefore not be limited to the perception of consumers in only one part of the relevant territory, the General Court rejected, in paragraph 73 of the judgment under appeal, the appellant's argument that the meaning of the term '*taïga*' is such as to offset the visual and phonetic similarities between the signs at issue. It cannot be claimed that, in so doing, the General Court erred in law.

111. In the light of all those considerations, I therefore propose that the Court reject the third complaint of the second part of the second ground of appeal, as in part manifestly inadmissible and in part unfounded.

## VII. Conclusion

112. In the light of the foregoing considerations, I propose that the Court should, without prejudice to the admissibility or merits of the other grounds of appeal put forward by ACTC GmbH or to the order for costs, reject the first ground of this appeal as unfounded, and the third complaint of the second part of the second ground of appeal as in part manifestly inadmissible and in part unfounded.

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1. Original language: French.

2. OJ 2009 L 78, p. 1.

3. Regulation of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21; '*Regulation No 207/2009*'). Regulation No 207/2009 was replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the



- European Union trade mark (OJ 2017 L 154, p. 1).
4. T-126/03, (*the judgment in Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*), EU:T:2005:288.
  5. T-94/17, not published, EU:T:2018:539.
  6. C-149/11, EU:C:2012:816.
  7. Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended (*the Nice Agreement*).
  8. The issue of genuine use is specific and preliminary in character, since it leads to a determination whether, for the purposes of the examination of the opposition, the earlier trade mark can be deemed to be registered in respect of the goods or services in question, that issue thus not falling within the context of the examination of the opposition proper, alleging the existence of a likelihood of confusion with that mark.
  9. In its appeal, the appellant maintains that the subcategory of goods which is claimed to exist comprises the following goods: *'clothing; outer clothing, underwear, headgear for wear and headwear, gloves; belts and socks; all aforementioned goods to be used as special weather protective outdoor clothing for the purpose of protection against cold, windy and/or rainy weather conditions only; working overalls'* (Emphasis added).
  10. *'Judgment in Mundipharma v OHIM — (Altana Pharma RESPICUR)*'.
  11. That case-law consists of the judgment in *Mundipharma v OHIM — Altana Pharma (RESPICUR)* (paragraphs 29 and 31), and the judgment of 16 May 2013, *Aleris v OHIM — Carefusion 303 (ALARIS)* (T-353/12, not published, EU:T:2013:257, paragraphs 22 and 23).
  12. See paragraph 34 of the judgment under appeal.
  13. See paragraph 35 of the judgment under appeal.
  14. See judgments of 5 September 2019, *European Union v Guardian Europe and Guardian Europe v European Union* (C-447/17 P and C-479/17 P, EU:C:2019:672, paragraph 137 and the case-law cited), and of 13 November 2019, *Outsource Professional Services v EUIPO* (C-528/18 P, not published, EU:C:2019:961, paragraph 47 and the case-law cited).
  15. See, inter alia, judgment of 17 October 2019, *Landeskammer für Land- und Forstwirtschaft in Steiermark v Schmid* (C-514/18 P, not published, EU:C:2019:878, paragraph 37 and the case-law cited).
  16. See, also, recital 10 of that regulation.
  17. See, in that regard, clarifications provided by the EU legislature in Rules 15 to 22 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), Regulation No 2868/95 being applicable to Regulation No 207/2009.
  18. See, inter alia, judgment of 11 March 2003, *Ansul*, C-40/01, EU:C:2003:145, paragraphs 25 to 31.
  19. See order of 27 January 2004, *La Mer Technology* (C-259/02, EU:C:2004:50, paragraph 27), and judgment of 17 October 2019, *Landeskammer für Land- und Forstwirtschaft in Steiermark v Schmid* (C-514/18 P, not published, EU:C:2019:878, paragraph 36 and the case-law cited).
  20. See judgment of 19 December 2012, *Leno Merken* (C-149/11, EU:C:2012:816, paragraph 32).
  21. OJ 1994 L 11, p. 1.
  22. See judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraph 51.
  23. *Ibidem*, paragraph 44.
  24. *Ibidem*, paragraph 45.
  25. Here I am quoting the words used by the General Court in the judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* (paragraph 46).
  26. See judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* (paragraph 45).
  27. *Ibidem* (paragraph 46).
  28. That is apparent from the case-law established in the judgment in *Mundipharma v OHIM — Altana Pharma (RESPICUR)*. See also paragraph 32 of the judgment under appeal.
  29. C-31/14 P, not published, EU:C:2014:2436.
  30. See paragraph 37 of that judgment.
  31. In that paragraph, the Court refers expressly to paragraphs 48 to 50 of the judgment of 8 November 2013, *Kessel v OHIM — Janssen-Cilag (Premeno)* (T-536/10, not published, EU:T:2013:586). Those paragraphs conclude the reasoning adopted by the General Court in paragraphs 43 to 47 of its judgment.
  32. See paragraph 29 of that judgment.
  33. C-31/14 P, not published, EU:C:2014:2436.
  34. See judgments of 5 September 2019, *European Union v Guardian Europe and Guardian Europe v European Union* (C-447/17 P and C-479/17 P, EU:C:2019:672, paragraph 137 and the case-law cited), and of 13 November 2019, *Outsource Professional Services v EUIPO* (C-528/18 P, not published, EU:C:2019:961, paragraph 47 and the case-law cited).
  35. T-292/01, EU:T:2003:264.
  36. T-487/12, not published, EU:T:2013:637.
  37. T-292/01, EU:T:2003:264.
  38. *Idem*.
  39. Judgment of 13 June 2013, *Hostel drap v OHIM — Aznar textil (MY drap)* (T-636/11, not published, EU:T:2013:314, paragraph 22) (emphasis added).
  40. T-292/01, EU:T:2003:264.
  41. Paragraph 43 of that judgment.
  42. T-292/01, EU:T:2003:264.
  43. *Idem*.
  44. T-487/12, not published, EU:T:2013:637.
  45. See judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini (PANINI)* (T-487/12, not published, EU:T:2013:637, paragraph 56).
  46. *Ibidem*, paragraph 58.
  47. T-487/12, not published, EU:T:2013:637.
  48. *Idem*.
  49. *Idem*.
  50. See paragraph 70 of the judgment under appeal.
  51. See paragraph 71 of the judgment under appeal.