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JUDGMENT OF THE GENERAL COURT (First Chamber)

30 September 2014 (*)

(Community trade mark — Revocation proceedings — Community word mark LAMBRETTA — Genuine use of the mark — Article 51(1)(a) of Regulation (EC) No 207/2009)

In Case T-132/12,

Scooters India Ltd, established in Lucknow (India), represented by B. Brandreth, Barrister,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM),
represented by J. Crespo Carrillo, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being

Brandconcern BV, established in Amsterdam (Netherlands), represented by G. Casucci and N. Ferretti, lawyers,

ACTION for annulment brought against the decision of the First Board of Appeal of OHIM of 12 January 2012 (Case R 2308/2010-1), relating to revocation proceedings between Brandconcern BV and Scooters India Ltd,

THE GENERAL COURT (First Chamber),

composed of H. Kanninen, President, I. Pelikánová (Rapporteur) and E. Buttigieg, Judges,

Registrar: J. Weychert, Administrator,

having regard to the application lodged at the Court Registry on 23 March 2012,

having regard to the response of OHIM lodged at the Court Registry on 3 July 2012,

having regard to the response of the intervener lodged at the Court Registry on 17 July 2012,

further to the hearing on 4 April 2014,

having regard to the request of the intervener to reopen the oral procedure, lodged at the Court Registry on 23 April 2014,

gives the following

Judgment

Background to the dispute

The applicant, Scooters India Ltd, is the proprietor of the Community word mark LAMBRETTA, which it applied for on 19 April 2000 and which was registered on 11 September 2001 under the number 1618982 by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

The goods in respect of which the Community trade mark was registered are in Classes 6, 7 and 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

Class 6: 'Badges and signs of metal, metal rods, bars, tubes and pipes; non-electric cables and wires; non-electric cables and wires of common metal; iron mongery, small items of metal hardware; nuts and bolts; screws, shims, washers and rivets; metal boxes and containers; fuel tanks; locks, padlocks and keys; chains, safety chains; springs';

Class 7: 'Engines; alternators; ball and roller bearings; dynamos, brake linings and shoes; carburettors; catalytic converters; clutches, control cables; crank cases, crank shafts and cranks; cylinders and cylinder heads, dynamos and generators; sparking plugs and glow plugs; vehicle jacks; lubricators; magnetos; pistons, cylinders; cylinder heads; connecting rods; speed governors; springs; starters for motors and engines';

Class 28: 'Games and playthings; gymnastic and sporting articles not included in other classes'.

On 19 November 2007, the intervener, Brandconcern BV, filed an application for revocation of the mark LAMBRETTA, on the basis of Article 50(1)(a) of Regulation No 40/94 (now Article 51(1)(a) of Regulation No 207/2009), in respect of all the goods referred to in paragraph 2 above, claiming that there had been no genuine use of that mark within a continuous period of five years.

On 24 September 2010, the Cancellation Division revoked the mark LAMBRETTA in respect of all the goods for which it had been registered, with effect from 19 November 2007.

On 23 November 2010, the applicant filed a notice of appeal with OHIM, under Articles 58 to 64 of Regulation No 207/2009, against the decision of the Cancellation Division. That appeal was limited to the goods in Classes 6 and 7.

By decision of 12 January 2012 ('the contested decision'), the First Board of Appeal of OHIM dismissed the appeal. In particular, it found that the evidence furnished by the applicant was not sufficient to prove that the mark LAMBRETTA had been put to genuine use.

Forms of order sought

The applicant claims that the Court should:

annul the contested decision;

order OHIM to pay the costs incurred by the applicant before the Board of Appeal and the Court.

OHIM contends that the Court should:

dismiss the action;

order the applicant to pay the costs.

The intervener contends that the Court should:

dismiss the action and uphold the contested decision;

order the applicant to pay the costs incurred by the intervener before the Board of Appeal and the Court.

Law

The request to reopen the oral procedure

On 23 April 2014, the intervener submitted a request for a new hearing to be held and, in the alternative, for it to be allowed to submit written observations. It claims, in essence, that it did not receive the notification of the hearing. It was only in the afternoon of 4 April 2014, at the hearing in Case T-51/12 *Scooters India v OHIM — Brandconcern (LAMBRETTA)*, involving the same parties, that it learned that the hearing in the present case had been held at 09.30 on the same day.

It must be pointed out, in that regard, that, in its response, the intervener, which was properly represented, agreed that service was to be effected upon it by telefax. Consequently, the notification of the hearing and the report for the hearing were served by telefax on 3 February and 5 March 2014 respectively to the number stated by the intervener's representatives. For each of the documents served, the Registry received a fax transmission report stating that transmission had been correctly carried out.

In those circumstances, it is necessary to reject the claim by the intervener's representatives that the intervener is not responsible for its failure to attend the hearing on the ground that the communications of 3 February and 5 March 2014 were never received by the law firm. Since the intervener agreed that service was to be effected upon it to the telefax number stated by its representatives, the reports confirming transmission provided by the Registry prove that the documents were in fact served on the recipient, subject to evidence to the contrary. However, in its request to reopen the oral part of the procedure, the intervener does not set out any facts that are capable of calling into question the accuracy of the reports confirming the transmission of the two abovementioned communications.

It follows that the intervener's request to reopen the oral procedure must be rejected.

Substance

The applicant puts forward a single plea in law, alleging infringement of Article 51(1)(a) of Regulation No 207/2009, in support of which it puts forward three complaints.

It follows from the first subparagraph of Article 15(1) and from Article 51(1)(a) of Regulation No 207/2009 that the rights of a proprietor of a Community trade mark are to be declared to be revoked, on application to OHIM, if, within a continuous period of five years, the trade mark has not been put to genuine use in the European Union in connection with the goods or services in respect of which it is registered and there are no proper reasons for its non-use.

According to the case-law, there is genuine use of a trade mark where the mark is 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, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Moreover, the condition of genuine use of the mark requires that that mark, as protected on the relevant territory, be used publicly and outwardly (see judgment of the General Court of 27 September 2007 in Case T-418/03 *La Mer Technology v OHIM — Laboratoires Goëmar (LA MER)*, not published in the ECR, paragraph 54, and the case-law cited).

By its first complaint, the applicant submits that the Board of Appeal examined the evidence submitted to it in isolation and not in conjunction with the evidence already provided to the Cancellation Division, inter alia the statement of Mr W., the President of the Lambretta Club of Great Britain.

OHIM and the intervener dispute those arguments. In their view, first, the applicant did not challenge before the Board of Appeal the Cancellation Division's finding, in paragraphs 33 and 34 of its decision, that, in essence, the evidence relating to the use of the mark LAMBRETTA by the Lambretta Club of Great Britain was not capable of showing that there was a business relationship in the sense of mutual cooperation, with the result that that evidence was not capable of showing that there was genuine use of the mark. Consequently, they submit that the applicant's complaint is not admissible before the

Court. Secondly, they submit that that finding on the part of the Cancellation Division is fully justified as to its substance.

In that regard, first, it is true, as OHIM and the intervener claim, that the applicant did not expressly challenge, before the Board of Appeal, the findings relating to the evidence concerning the Lambretta Club of Great Britain that the Cancellation Division made in paragraphs 33 and 34 of its decision. However, it is apparent from the statement of grounds for the appeal submitted by the applicant to the Board of Appeal, that the applicant, by relying on the evidence submitted previously, necessarily intended to challenge those findings.

The applicant stated, in the statement of grounds for its appeal before the Board of Appeal, that it had '[filed evidence] ... showing genuine use of the mark ... for the goods listed within Classes 6 and 7' and that, 'in relation to goods in Classes 6 and 7, [it was] maintain[ing] all submissions previously made ... and [was] request[ing] that the Board of Appeal [reconsider] the evidence and arguments filed ... and [overturn] the decision of the Cancellation Division'. That implies a challenge to the Cancellation Division's findings in paragraphs 33 and 34 of its decision.

In addition, the applicant submitted, before the Board of Appeal, that the documents provided had been assessed in an overly harsh way, 'given that the previous evidence was filed under an explanatory witness statement of [Mr W.]'. That submission clearly shows that the applicant continued to rely, before the Board of Appeal, on the evidence previously provided and, in particular, on Mr W.'s statement.

Consequently, contrary to what OHIM and the intervener maintain, the applicant is entitled to put forward before the Court that evidence, as well as the complaint alleging that the Board of Appeal failed to take it into account.

Secondly, even if the applicant had not expressly called into question the Cancellation Division's assessment of the evidence that it had submitted in the proceedings before it and, in particular, that division's assessment of Mr W.'s statement, as OHIM claims, that would not have relieved the Board of Appeal of its obligation to carry out its own assessment of that evidence.

It is apparent from the case-law that the extent of the examination which the Board of Appeal must conduct in respect of the decision under appeal is not, in principle, determined by the grounds relied on by the party who has brought the appeal. Therefore, even if the party who has brought the appeal has not raised a specific ground of appeal, the Board of Appeal is none the less bound to examine whether or not, in the light of all the relevant matters of fact and of law, a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling (Case T-308/01 *Henkel v OHIM — LHS (UK) (KLEENCARE)* [2003] ECR II-3253, paragraph 29).

Thirdly, it must be borne in mind that to examine, in a particular case, whether an earlier trade mark has been put to genuine use, a global assessment must be carried out, which takes into account all the relevant factors of the particular case (Case T-203/02 *Sunrider v OHIM — Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 42, and Case T-334/01 *MFE Marienfelde v OHIM — Vétoquinol (HIPOVITON)* [2004] ECR II-2787, paragraph 36). It cannot be ruled out that an accumulation of evidence may allow the necessary facts to be established, even though each of those pieces of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (judgment of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36).

In the present case, after examining the admissibility of the new evidence submitted by the two parties before it (paragraphs 16 to 23 of the contested decision) and setting out the provisions governing the revocation procedure and the case-law relating to those provisions (paragraphs 24 to 29 of the contested decision), the Board of Appeal exclusively set out (paragraph 30 of the contested decision) and assessed (paragraphs 31 to 39 of the contested decision) that new evidence. By contrast, it did not even mention the evidence previously submitted to the Cancellation Division. Furthermore, the Board of Appeal did not, in general terms, adopt the assessment made by the Cancellation Division.

In those circumstances, it is necessary to uphold the first complaint put forward by the applicant and to hold that the Board of Appeal infringed its obligation, referred to in paragraph 25 above, to carry out a global assessment which took into account all the relevant factors of the particular case.

As the assessment carried out by the Board of Appeal is therefore vitiated in its entirety, the contested decision must be annulled, without there being any need to examine the two other complaints put forward by the applicant.

Costs

Under Article 87(2) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant. It must be borne in mind, in that regard, that, under Article 136(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are to be regarded as recoverable costs.

Since the intervener has been unsuccessful, it must be ordered to bear its own costs.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 12 January 2012 (Case R 2308/2010-1);

Orders OHIM to bear its own costs and to pay those incurred by Scooters India Ltd, including those incurred for the purposes of the proceedings before the Board of Appeal;

Orders Brandconcern BV to bear its own costs.

Kanninen Pelikánová Buttigieg

Delivered in open court in Luxembourg on 30 September 2014.

[Signatures]

* Language of the case: English.