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LUXEMBOURG

ОБЩ СЪД НА ЕВРОПЕЙСКИЯ СЪЮЗ
TRIBUNAL GENERAL DE LA UNIÓN EUROPEA
TRIBUNÁL EVROPSKÉ UNIE
DEN EUROPÆISKE UNIONES RET
GERICHT DER EUROPÄISCHEN UNION
EUROOPA LIIDU ÜLDKOHUS
ΓΕΝΙΚΟ ΔΙΚΑΣΤΗΡΙΟ ΤΗΣ ΕΥΡΩΠΑΪΚΗΣ ΕΝΩΣΗΣ
GENERAL COURT OF THE EUROPEAN UNION
TRIBUNAL DE L'UNION EUROPÉENNE
CÚIRT GHINEARÁLTA AN AONTAIS EORPAIGH
OPČÍ SUD EUROPSKE UNIE
TRIBUNALE DELL'UNIONE EUROPEA

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AZ EURÓPAI UNIÓ TÖRVÉNYSZÉKE
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SPLOŠNO SODIŠČE EVROPSKE UNIJE
EUROOPAN UNIONIN YLEINEN TUOMIOISTUIN
EUROPEISKA UNIONENS TRIBUNAL

- 640321 -
JUDGMENT OF THE GENERAL COURT (First Chamber)

30 September 2014 *

(Community trade mark — Revocation proceedings — Community word mark
LAMBRETTA — Genuine use of the mark — Partial revocation — Article 51(2)
of Regulation (EC) No 207/2009)

In Case T-51/12,

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, N. Ferreti and C. Galli, lawyers,

ACTION brought against the decision of the First Board of Appeal of OHIM of
1 December 2011 (Case R 2312/2010-1), 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,

* Language of the case: English.

having regard to the application lodged at the Court Registry on 8 February 2012,
having regard to the response of OHIM lodged at the Court Registry on 16 July 2012,
having regard to the response of the intervener lodged at the Court Registry on 30 July 2012,
having regard to the reply lodged at the Court Registry on 7 December 2012,
having regard to the rejoinder of OHIM lodged at the Court Registry on 5 April 2013,
having regard to the rejoinder of the intervener lodged at the Court Registry on 4 April 2013,
further to the hearing on 4 April 2014,
gives the following

Judgment

Background to the dispute

- 1 The applicant, Scooters India Ltd, is the proprietor of the Community word mark LAMBRETTA, which it applied for on 7 February 2000 and which was registered on 6 August 2002 under the number 1495100 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)).
- 2 The goods in respect of which the Community trade mark was registered are in Classes 3, 12, 14, 18 and 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, and correspond, for each of those classes, to the following description:
 - Class 3: ‘Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices’;
 - Class 12: ‘Vehicles; apparatus for locomotion by land, air or water’;

- Class 14: ‘Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments’;
 - Class 18: ‘Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery’;
 - Class 25: ‘Clothing, footwear, headgear’.
- 3 On 19 November 2007, the intervener, Brandconcern BV, filed an application for partial revocation of the mark LAMBRETTA on the basis of Article 50(1)(a) and 50(2) of Regulation No 40/94 (now Article 51(1)(a) and 51(2) of Regulation No 207/2009) in respect of the goods in Classes 3, 12 and 18 referred to in paragraph 2 above, claiming that there had been no genuine use of that mark within a continuous period of five years.
 - 4 On 24 September 2010, the Cancellation Division partially revoked the mark LAMBRETTA, with effect from 19 November 2007, in respect of the goods in Classes 3, 12 and 18, with the exception of ‘perfumery, essential oils, cosmetics, hair lotions’ in Class 3.
 - 5 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, to the extent that it had upheld the application for revocation in respect of the goods in Class 12 and some of the goods in Classes 3 and 18.
 - 6 By decision of 1 December 2011 (‘the contested decision’), the First Board of Appeal of OHIM annulled the decision of the Cancellation Division in so far as the mark LAMBRETTA had been revoked in respect of ‘soaps’ in Class 3. The Board of Appeal dismissed the appeal as to the remainder and also dismissed the intervener’s ‘ancillary appeal’. In particular, it found that the evidence provided by the applicant was not sufficient to prove that there had been genuine use of the mark LAMBRETTA in connection with the goods in Class 12 and some of the goods in Classes 3 and 18.

Forms of order sought

- 7 Following a partial withdrawal at the hearing, the applicant claims that the Court should:
 - annul the contested decision in so far as the Board of Appeal dismissed the applicant’s appeal in relation to the goods in Class 12;

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

8 OHIM contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

9 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

10 In support of its action, the applicant puts forward a single plea in law, alleging infringement of Article 51(2) of Regulation No 207/2009. It puts forward two complaints in that regard.

The first complaint, alleging that the Board of Appeal erred in confining its examination to some of the goods in Class 12 covered by the mark LAMBRETTA

11 The applicant submits that, at the time when it filed its application for registration of the mark LAMBRETTA, on 7 February 2000, it was OHIM's practice to understand a reference to a complete class heading in an application for registration as covering all the goods listed in that class and not only the goods corresponding to the literal meaning of that heading. The applicant maintains that it had to be able to rely on its application being interpreted in the same way, notwithstanding the judgment of the Court of Justice in Case C-307/10 *Chartered Institute of Patent Attorneys* [2012] ECR I-0000, and the altered practice of OHIM as a result. The applicant submits that the Board of Appeal found that genuine use of the mark LAMBRETTA had been proven in respect of spare parts for scooters.

12 OHIM maintains that the applicant had not received any assurance on its part that the registration would cover all the goods in Class 12 and that the Board of Appeal, as the competent authority for determining whether the indications in the specification of the goods meet the requirements of clarity and precision, was entitled to interpret the application for registration as covering only the heading of Class 12 taken in its literal meaning.

13 The intervener submits that there has, in any event, been no genuine use of the mark LAMBRETTA whether or not the goods that it covers are limited to the strict sense of the heading of Class 12.

- 14 It must be stated that it is apparent from paragraphs 35 to 50 of the contested decision that, as regards the goods in Class 12, the Board of Appeal confined its examination solely to 'vehicles; apparatus for locomotion by land, air or water', in the literal sense of those terms. Consequently, after finding, in paragraph 36 of the contested decision, that the evidence provided by the applicant was limited to the sale of spare parts for scooters and did not include any evidence pertaining to the sale of 'vehicles; apparatus for locomotion by land, air or water', the Board of Appeal found, in paragraph 37 of the contested decision, that 'it cannot be inferred from the sale of spare parts that the [applicant] has also manufactured and sold ... any vehicle'.

The scope of the examination carried out by the Board of Appeal

- 15 First of all, it must be pointed out that the complaint put forward by the applicant has only a partial factual basis. As OHIM correctly points out, the Board of Appeal's finding, in paragraph 36 of the contested decision, that 'the evidence [submitted by the applicant] is limited to the sale of spare parts for scooters' does not make it possible to conclude that the Board of Appeal found that there had been genuine use of the mark LAMBRETTA in relation to those goods.
- 16 On the contrary, it is apparent from a reading of paragraph 36 of the contested decision, placed in context, that the Board of Appeal exclusively examined whether that mark had been used in connection with the sale of 'vehicles; apparatus for locomotion by land, air or water' and that the observation in question was used only to make it clear that the evidence concerning the spare parts was not capable of proving that there had been genuine use of the mark in respect of vehicles or apparatus for locomotion. In other words, that evidence, listed in paragraph 35 of the contested decision, was rejected for the sole reason that it related to the sales of spare parts for scooters and not to the sale of scooters as such and the Board of Appeal did not examine whether it proved, to the requisite legal standard, that there had been genuine use of the mark LAMBRETTA in respect of spare parts.
- 17 However, that finding is not sufficient to reject the first complaint put forward by the applicant as unfounded. Since the applicant complains *inter alia* that the Board of Appeal did not confine the revocation to goods other than spare parts for scooters, it must be held that the first complaint necessarily involves determining whether the genuine use of the mark has to be examined in relation to the spare parts. It cannot be accepted that, in responding to the applicant's challenge that the Board of Appeal did not draw inferences from the genuine use of the mark in connection with spare parts, OHIM simply states that that use was not examined, if such an examination was, however, required.
- 18 Consequently, it must be examined whether spare parts for scooters must be regarded as included in the goods in Class 12 covered by the mark

LAMBRETTA, with the result that the Board of Appeal was required to carry out an examination in that regard.

The interpretation of the list of goods as set out in the application for registration of the mark LAMBRETTA

- 19 It must be stated, first of all, that the words ‘vehicles; apparatus for locomotion by land, air or water’ correspond to the list of goods in Class 12 covered by the mark LAMBRETTA, as set out in the trade mark application filed by the applicant on 7 February 2000, and accurately reproduce the heading of Class 12, as defined by the Nice Agreement.
- 20 Accordingly, the question that arises is whether that indication was to be understood, by OHIM, as referring solely to ‘vehicles; apparatus for locomotion by land, air or water’ in the strict sense of the words, or, more generally, to all the goods in Class 12.
- 21 In the context of the application of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), the question of the interpretation of a reference to the general indications of the class headings of the classification according to the Nice Agreement formed the subject-matter of the judgment in *Chartered Institute of Patent Attorneys*. In paragraph 56 of that judgment, the Court of Justice held that such general indications could be used to identify the goods and services covered by the trade mark application, provided that such identification is sufficiently clear and precise.
- 22 Furthermore, the Court of Justice has held, in that regard, that an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought has to specify whether the application is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services and that, if the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered (*Chartered Institute of Patent Attorneys*, paragraph 61).
- 23 Since that judgment was delivered after the facts at issue in the present case, the question that arises is that of its bearing on the present case.
- 24 It is settled case-law that the interpretation which, in the exercise of the jurisdiction conferred upon it by Article 267 TFEU, the Court of Justice gives to a rule of EU law clarifies and defines where necessary the meaning and scope of that rule as it must be, or ought to have been, understood and applied from the time of its coming into force. It follows that the rule so interpreted may, and must, be applied by the courts even to legal relationships arising and established before the judgment ruling on the request for interpretation, provided that in other

respects the conditions enabling an action relating to the application of that rule to be brought before the courts having jurisdiction are satisfied. In view of those principles, limiting the effects of a judgment giving a preliminary ruling on a matter of interpretation appears to be quite exceptional (Joined Cases C-367/93 to C-377/93 *Rodgers and Others* [1995] ECR I-2229, paragraphs 42 and 43). The Court of Justice did not limit the effects of the judgment in *Chartered Institute of Patent Attorneys*.

- 25 Accordingly, OHIM, which was also confronted with the question of the effect of the judgment in *Chartered Institute of Patent Attorneys* on trade mark applications filed prior to its delivery also arose, published, on 20 June 2012, the day after the delivery of that judgment, Communication No 2/12 of the President concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations. It is apparent from point V of that communication that OHIM took the view that, as regards Community trade marks registered before 21 June 2012, the use of all the general indications listed in the class heading of a particular class reflected the applicant's intention to cover, by his demand, all the goods or services included in the alphabetical list relating to that class. The President of OHIM justified that approach by referring to the contents of Communication No 4/03 of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations.

- 26 In Communication No 4/03, the President of OHIM had stated that it constituted a proper specification of goods and services in a trade mark application if the general indications or the whole class headings provided for in the Nice Classification were used, allowing a proper classification and grouping, and that OHIM did not therefore object to the use of those general indications or class headings, contrary to some national offices. It was added that, given that the 34 classes for goods and the 11 classes for services in the Nice Classification comprise the totality of all goods and services, the use of all the general indications listed in the class heading of a particular class constituted a claim to all the goods or services falling within that class.

- 27 In those circumstances, the approach set out by the President of OHIM in Communication No 2/12 applies the principles of the protection of legitimate expectations and of legal certainty. A legitimate expectation had been created by OHIM itself, since it had given assurances as regards the treatment of trade mark applications using the complete heading of a particular class. It was also important for it to be possible to establish with certainty the extent of the protection conferred by Community trade marks registered before 21 June 2012 that referred to class headings in the Nice Classification, both in the interests of the proprietors of those marks and those of persons consulting the register of marks.

- 28 In the present case, OHIM submits that the mark LAMBRETTA was applied for on 7 February 2000 and registered on 6 August 2002, namely before the

publication, on 16 June 2003, of Communication No 4/03. Consequently, the applicant had not been given any assurance on its part as regards the extent of the protection conferred by the Community trade mark and the Board of Appeal did not necessarily have to presume that the applicant had the intention of covering all the goods in Class 12 or, as the case may be, in the alphabetical list which relates to that class.

- 29 Such reasoning cannot succeed. First, it can be relevant only in the light of the principle of the protection of legitimate expectations, which protects applicants for Community trade marks under certain subjective conditions (namely, the actual existence of a legitimate expectation), and not in the light of the principle of legal certainty, which protects the interest of the public — and not only that of trade mark proprietors — in the possibility of establishing with certainty the scope of the protection conferred by earlier registrations.
- 30 Second, it is indeed true that the treatment of marks registered before 21 June 2012 proposed in Communication No 2/12 is justified by reference to the earlier communication No 4/03. However, it must be pointed out that the wording of Communication No 2/12, and in particular of point V of that communication, does not indicate any limitation of the practice that OHIM proposes adopting as regards the treatment of marks registered previously. In particular, OHIM does not make any distinction according to whether the marks in question were applied for or registered before or after the publication of Communication No 4/03, although it must have been aware of the fact that the approach described in Communication No 2/12 was going to apply to both groups of marks. Consequently, although it justified its approach by referring to the specific situation of some of the marks registered before 21 June 2012, OHIM did not indicate that it wished to limit the application of that approach to those marks alone.
- 31 Third, Communication No 4/03 states that it ‘is intended to explain and clarify the practice of [OHIM]’, that the rules which it sets out ‘will continue to be applied in the various proceedings ... , and to the extent that exceptions from these rules have occurred, this will no longer be the case’ and, lastly, that ‘[t]here are no decisions of the Boards of Appeal which would be at variance with the rules explained’. Consequently, according to OHIM itself, Communication No 4/03 was not intended to introduce a new practice, but to explain and clarify OHIM’s previous practice.
- 32 Fourth, OHIM’s previous practice — as well as that of some national trade mark offices — was endorsed and applied, at the time, in the case-law of the General Court. Accordingly, in paragraph 42 of the judgment in Case T-186/02 *BMI Bertollo v OHIM — Diesel (DIESELIT)* [2004] ECR II-1887, it was held that as the intervener’s application for registration of its trade mark in Italy referred to the headings of all the classes, its national registration covered all the goods capable of being comprised within those classes. Similarly, the General Court held that the intervener’s Community registration covered all the goods capable of being

comprised within the classes applied for at the Community level, that is to say Classes 11, 19, 20 and 21, given that the intervener had referred to the headings of those classes in its application.

- 33 Consequently, even if account is taken of the fact that a previous practice of OHIM does not bind either OHIM as regards its subsequent decisions or the Courts of the European Union in carrying out their review of those decisions (see, to that effect, Case C-412/05 P *Alcon v OHIM* [2007] ECR I-3569, paragraph 65, and Case T-346/04 *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)* [2005] ECR II-4891, paragraph 71), it must be held that considerations relating to the principles of the protection of legitimate expectations and, *a fortiori*, of legal certainty fully justified OHIM's extending the scope of Communication No 2/12 to marks registered before the publication of its earlier Communication No 4/03.
- 34 Furthermore, such an approach is necessary even if Communication No 2/12 is disregarded. The General Court has already recognised that the principle of legal certainty demands that the view be taken that, by using all the general indications listed in a class heading, the proprietor of a Community trade mark registered before Communication No 2/12 came into force intended to cover all the goods or services included in the alphabetical list in that class (see, to that effect, judgment of 31 January 2013 in Case T-66/11 *Present-Service Ullrich v OHIM — Punt-Nou (babilu)*, not published in the ECR, paragraph 50). As has been pointed out in paragraph 29 above, the applicability of the principle of legal certainty does not, in the present case, depend on whether the mark LAMBRETTA was registered before or after the publication of Communication no 4/03.
- 35 Accordingly, the words 'vehicles; apparatus for locomotion by land, air or water' in the Community trade mark application that the applicant filed with OHIM on 7 February 2000 must be interpreted as intended to protect the mark LAMBRETTA in respect of all the goods in the alphabetical list in Class 12. The applicant moreover confirms, in its written pleadings, that that was indeed its intention when it filed its application for registration.
- 36 Even though 'spare parts for scooters' do not actually appear in the alphabetical list of goods in Class 12, it must be stated that, as the applicant submits, that list contains many fittings and parts for vehicles, such as, *inter alia*, 'vehicle wheels' (No 120053), 'pneumatic tires [tyres] / tires, solid, for vehicle wheels / tyres, solid, for vehicle wheels' (No 120158) and crankcases for land vehicle components, other than for engines (No 120058). It must be pointed out that that finding does not prejudice the question whether the spare parts that the applicant claims to have marketed actually fall within Class 12 or, as the intervener claims, in Classes 6 and 7.
- 37 Consequently, at the very least some spare parts for scooters were included in the list of goods covered by the mark LAMBRETTA, with the result that the Board of

Appeal was required to examine the genuine use of that mark in relation to those spare parts.

- 38 Given that the Board of Appeal did not carry out such an examination, the first complaint put forward by the applicant must be upheld and the contested decision must be annulled on the basis of infringement of Article 51(2) of Regulation No 207/2009.

The second complaint, alleging that the Board of Appeal erred in not taking the actual use of the mark in connection with parts into account in order to determine whether there had been genuine use of the mark in connection with the goods of which they are an integral part

- 39 The applicant submits that the Board of Appeal erred in law by not applying the case-law of the Court of Justice according to which the actual use of a mark in connection with parts preserves the rights of the proprietor of that mark in relation to the goods of which those parts are an integral part.
- 40 OHIM maintains, first, that the Board of Appeal was right not to examine the evidence relating to the spare parts and, secondly, that there are serious doubts that those goods were sold under the mark LAMBRETTA.
- 41 The intervener adds that the documents submitted by the applicant did not prove that spare parts in Class 12 were sold under the mark LAMBRETTA.
- 42 It must be held, in that regard, that, inasmuch as the Board of Appeal did not examine whether the evidence relating to the spare parts proved that there had been genuine use of the mark in that regard, the second complaint has no factual basis. Furthermore, it is apparent from the examination of the first complaint that, as a result of the annulment of the contested decision, the Board of Appeal will have to examine whether the applicant has used the mark LAMBRETTA in connection with those spare parts.
- 43 In the course of that examination, the Board of Appeal will, inter alia, have to determine whether that use satisfies the criteria set out by the Court of Justice in its judgment in Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 40 to 43.
- 44 In particular, it will be necessary to examine, first, whether the applicant has actually marketed scooters under the mark LAMBRETTA in the past, and not only in the period 19 November 2002 to 18 November 2007, and, secondly, whether the applicant actually marketed under the trade mark LAMBRETTA, in the period 19 November 2002 to 18 November 2007, either parts that were integral to the make-up or structure of the scooters previously sold or goods or services that were directly related to scooters and were intended to meet the needs of customers of those goods.

Costs

- 45 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. In that regard, it must be borne in mind that, pursuant to 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.
- 46 Since the intervener has been unsuccessful, it must be ordered to bear its own costs.

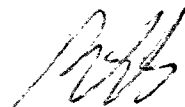
On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

1. **Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 1 December 2011 (Case R 2312/2010-1);**
2. **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;**
3. **Orders Brandconcern BV to bear its own costs.**


Kanninen


Pelikánová


Buttigieg

Delivered in open court in Luxembourg on 30 September 2014.

E. Coulon

H. Kanninen

P.P. 



Registrar

President

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