

Appeal brought on 12 February 2016 by Kenzo Tsujimoto against the judgment of the General Court (First Chamber) delivered on 2 December 2015 in Case T-414/13: Kenzo Tsujimoto v European Union Intellectual Property Office

(Case C-85/16 P)

(2016/C 335/36)

Language of the case: English

Parties

Appellant: Kenzo Tsujimoto (represented by: A. Wenninger-Lenz, M. Ring, Rechtsanwältinnen, W. von der Osten-Sacken, Rechtsanwalt)

Other parties to the proceedings: European Union Intellectual Property Office, Kenzo

Form of order sought

The appellant claims that the Court should:

- set aside the judgment of the General Court (First Chamber) of 2 December 2015 in Case T-414/13;
- give a final ruling on the dispute;
- order EUIPO and Kenzo S.A. to pay the costs of the proceedings, including the costs of the proceedings before the Board of Appeal.

Pleas in law and main arguments

1. Infringement of Article 76 (2) CTMR

Both oppositions brought by KENZO S.A. are based on Article 8 (5) CTMR ⁽¹⁾. In both cases, the Board of Appeal took into account evidence in support of the reputation claim which was filed by the Opponent before the Opposition Division in order to establish genuine use of the mark. It is undisputed that the documents concerned were filed after the expiry of the time limits for submitting evidence of the existence, validity and scope of protection of the earlier right pursuant to Rule 19 (1) CTMIR ⁽²⁾. It follows from Rule 19 (1), (2) and 20 (1) CTMIR that an opposition based on Article 8 (5) must be rejected if the opponent fails to prove the reputation of the earlier trademark within the period specified by the Office. Nevertheless, the General Court comes to the conclusion that the Board of Appeal had discretion as to whether the evidence concerned should be taken into account in support of the reputation claim, that the Board recognized and did exercise its discretion and provided proper reasons for taking that evidence into account. The appellant, on the other hand, is of the opinion that the finding of the General Court awarding discretion to the Board of Appeal is flawed by an error in law and amounts to misapplication of Rules 19 (1), (2) and 20 (1) CTMIR.

The appellant is aware that the other parties to the proceedings claim that the admissibility of the consideration of documents filed in support of genuine use in support of the reputation claim is to be guided not by Rule 20 (1) CTMIR, but by Rule 50, paragraph 1, alinea 3, of Regulation No 2868/95 as a special procedural Rule before the Board of Appeal.

Even if the discretion of the Board of Appeal were to be construed in line with Rule 50 (1) (iii) CTMIR, that discretion was exercised incorrectly by the Board of Appeal and the General Court misapplied Article 76 (2) by approving the Board of Appeal's considerations on the indissociable link between proof of use and proof of reputation as proper exercising of its discretion. In fact, the Board of Appeal did not even determine the scope of its discretion, i.e. by determining whether the discretion in the subject case must be exercised restrictively or not. If the Board of Appeal had exercised its discretion

correctly, it should have recognized that the discretion must, in conformity with the Rintisch judgment (Case C-120/12 P, Bernhard Rintisch v. OHIM) be exercised restrictively. In the circumstances, the only way of correctly exercising discretion would have been not to take into consideration the documents supporting the reputation claim. The General Court overlooked the fact that the Board of Appeal failed to correctly determine the scope of its discretion and to apply its discretion within that scope and, by so doing, infringed Article 76 (2) CTMR.

2. Infringement of Article 8 (5) CTMR

The appellant claims that the General Court failed to compare the marks 'KENZO' and 'KENZO ESTATE' as a whole and so infringed Article 8 (5) CTMR. In addition, the appellant claims that the reputation claim was confirmed by the General Court on the basis of documents which should, under proper application of the law and proper exercising of its discretion by the Board of Appeal, not have been taken into account. The appellant further claims that the General Court failed to undertake the necessary global assessment when it concluded that the contested trademark would be likely to be associated with the earlier mark and would take unfair advantage of the earlier mark's reputation. Finally, the appellant submits that the Board of Appeal and the General Court erred when concluding that the appellant had failed to substantiate 'due cause' within the meaning of Article 8 (5) CTMR.

⁽¹⁾ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark
OJ L 78, p. 1

⁽²⁾ Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark
OJ L 303, p. 1

Appeal brought on 12 February 2016 by Kenzo Tsujimoto against the judgment of the General Court (First Chamber) delivered on 2 December 2015 in Case T-522/13: Kenzo Tsujimoto v European Union Intellectual Property Office

(Case C-86/16 P)

(2016/C 335/37)

Language of the case: English

Parties

Appellant: Kenzo Tsujimoto (represented by: A. Wenninger-Lenz, M. Ring, Rechtsanwältinnen, W. von der Osten-Sacken, Rechtsanwalt)

Other parties to the proceedings: European Union Intellectual Property Office, Kenzo

Form of order sought

The appellant claims that the Court should:

- set aside the judgment of the General Court (First Chamber) of 2 December 2015 in Case T-522/13;
- give final judgment on the dispute;
- order EUIPO and Kenzo S.A. to pay the costs of the proceedings, including the costs of the proceedings before the Board of Appeal.