

Case T-30/09

Engelhorn KGaA

v

**Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)**

(Community trade mark — Opposition proceedings — Application for the Community word mark *peerstorm* — Earlier Community and national word marks *PETER STORM* — Relative ground for refusal — Likelihood of confusion — Article 8(1)(b) of Regulation (EC) No 40/94 (now Article 8(1)(b) of Regulation (EC) No 207/2009) — Genuine use of the earlier marks — Articles 15 and 43(2) of Regulation No 40/94 (now Articles 15 and 42(2) of Regulation No 207/2009))

Judgment of the General Court (Eighth Chamber), 8 July 2010 II - 3808

Summary of the Judgment

1. *Community trade mark — Appeals procedure — Appeals before the Community judicature — Application initiating proceedings — Formal requirements*
(*Statute of the Court of Justice, Art. 21; Rules of Procedure of the General Court, Art. 44(1)(c)*)

2. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Definition — Interpretation having regard to the ratio legis of Article 43(2) and (3) of Regulation No 40/94 (Council Regulation No 40/94, Art. 43(2) and (3))*
3. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Definition — Criteria for assessment (Council Regulation No 40/94, Art. 43(2) and (3))*
4. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Application of the criteria to the case in question (Council Regulation No 40/94, Art. 43(2) and (3))*
5. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Genuine use — Criteria for assessment — Requirement of solid and objective evidence (Council Regulation No 40/94, Arts 15(2)(a) and 43(2) and (3))*
6. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark (Council Regulation No 40/94, Art. 8(1)(b))*

1. Under Article 21 of the Statute of the Court of Justice and Article 44(1)(c) of the Rules of Procedure of the General Court, applications must include a brief statement of the pleas in law on which they are based. Although specific points in the text of the application can be supported

and completed by references to specific passages in the documents annexed to it, a general reference to other documents cannot compensate for the failure to set out the essential elements of the legal argument which must, under those provisions, appear in the application itself.

It is not for the Court to take on the role of the parties by seeking to identify the relevant material in the documents to which they refer.

(see paras 18-19)

2. The *ratio legis* of the requirement that the earlier mark must have been put to genuine use, within the meaning of Article 43(2) and (3) of Regulation No 40/94 on the Community trade mark, if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, where there is no good commercial justification deriving from active functioning of the mark on the market. However, the purpose of those provisions is not to assess commercial success or to review the economic strategy of an undertaking, nor are they intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks.

(see para. 23)

3. 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. Furthermore, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly.

When assessing whether use of the trade mark is genuine, within the meaning of Article 43(2) and (3) of Regulation No 40/94 on the Community trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.

As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during

which the mark was used and the frequency of use.

As a result, use of the earlier mark need not always be quantitatively significant in order to be deemed genuine.

(see paras 24-26)

(see paras 27-28)

4. 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. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by a high intensity or some settled period of use of that mark or vice versa.
5. Genuine use of a trade mark, within the meaning of Article 43(2) and (3) of Regulation No 40/94 on the Community trade mark, cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of actual and sufficient use of the trade mark on the market concerned. In addition, under Article 15(2)(a) in conjunction with Article 43(2) and (3) of that regulation, proof of genuine use of an earlier national or Community trade mark which forms the basis of an opposition against a Community trade mark application also includes proof of use of the earlier mark in a form differing in elements which do not alter the distinctive character of that mark in the form in which it was registered.

In addition, the turnover and the volume of sales of the goods under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market.

(see paras 29-30)

6. There is, for the average European Union consumer, a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, between the word sign peerstorm, registration of which as a Community trade mark is applied for in respect of 'clothing, footwear, headgear' in Class 25 of the Nice Agreement, and the word mark PETER STORM previously registered as a Community trade mark for identical goods.

There is a degree of visual and aural similarity between the marks at issue. As regards the articles of apparel concerned, visual similarity is of particular importance in this instance since it is acknowledged that, in general, the purchase of clothing involves a visual examination of the marks.

It has not been shown that the earlier mark, used as a whole in the clothing sector, has a low degree of inherent distinctiveness in the territory of the Union.

Even if the earlier mark were to have only weak distinctive character, given that the goods covered by the earlier mark and the mark applied for are identical and given the elements of similarity between the signs at issue in particular at a visual level, a likelihood of confusion between the marks at issue cannot be ruled out for the relevant public. That is all the more so since there is also a degree of conceptual similarity between the marks at issue.

(see paras 50-51, 75, 78-80)