



## Reports of Cases

### Case C-621/11 P

New Yorker SHK Jeans GmbH & Co. KG

v

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

(Appeal — Application for registration of the Community word mark FISHBONE — Opposition proceedings — Earlier national figurative mark FISHBONE BEACHWEAR — Genuine use of the earlier mark — Taking into account additional evidence not submitted within the time limit set — Regulation (EC) No 207/2009 — Articles 42(2) and (3) and Article 76(2) — Regulation (EC) No 2868/95 — Rule 22(2))

Summary — Judgment of the Court (Fourth Chamber), 18 July 2013

*Community trade mark — Opposition proceedings — Facts and evidence not produced in support of the opposition within the period prescribed for that purpose — Taking into account — Discretion of the Board of Appeal*

*(Council Regulation No 207/2009, Arts 42(2) and 76(2)); Commission Regulation No 2868/95, Art. 1, Rule 22(2))*

It is clear from the wording of Article 76(2) of Regulation No 207/2009 on the Community trade mark that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time limits to which such submission is subject under the provisions of Regulation No 207/2009 and that the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) is in no way prohibited from taking account of facts and evidence which are invoked or produced late. In stating that the latter ‘may’, in such a case, decide to disregard evidence, that provision grants OHIM broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such information into account.

As regards, more specifically, the submission of proof of genuine use of the earlier mark in the context of opposition proceedings, it must be noted that, although Article 42(2) of Regulation No 207/2009 provides that, if the applicant for registration so requests, the proprietor of a mark who has given notice of opposition is to furnish proof of genuine use of the mark, in the absence of which the opposition is to be rejected, that regulation does not contain a provision specifying the time limit within which such proof must be adduced. By contrast, Rule 22(2) of Regulation No 2868/95 implementing Regulation No 40/94 on the Community trade mark provides, in this regard, that, where such an application is made, OHIM is to invite the proprietor of the earlier mark to furnish proof of use of the mark or show that there are proper reasons for non-use within such period as it may specify.

Where evidence considered relevant for the purposes of establishing use of the mark at issue was produced within the time limit set by OHIM under Rule 22(2) of Regulation No 2868/95, the submission of additional proof of such use remains possible after the expiry of that time limit. In such a case OHIM is in no way prohibited from taking account of evidence submitted out of time through use of the discretion conferred on it by Article 76(2) of Regulation No 207/2009.

As regards the exercise of that discretion by OHIM for the purposes of the possible taking into account of evidence submitted out of time, it should be noted that the Court has already held that where OHIM is called upon to give judgment in the context of opposition proceedings, taking such facts or evidence into account is particularly likely to be justified where OHIM considers, first, that the material produced late is, on the face of it, likely to be relevant to the outcome of the opposition brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not preclude such matters being taken into account.

(see paras 21-25, 30, 33)