



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

2 February 2016*

(Community trade mark — Revocation proceedings — Community figurative mark MOTOBI B PESARO — Genuine use of the mark — Article 51(1)(a) of Regulation (EC) No 207/2009 — Evidence submitted against the application for revocation after the expiry of the period set for that purpose — Failure to take account thereof — Discretion of the Board of Appeal — Provision to the contrary — Circumstances precluding additional or supplementary evidence from being taken into account — Article 76(2) of Regulation No 207/2009 — Rule 50(1), third subparagraph, of Regulation (EC) No 2868/95)

In Case T-171/13,

Benelli Q.J. Srl, established in Pesaro (Italy), represented by P. Lukácsi and B. Bozóki, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by F. Mattina and subsequently by P. Bullock, acting as Agents,

defendant,

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

Demharter GmbH, established in Dillingen (Germany), represented by A. Kohn, lawyer,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 16 January 2013 (Case R 2590/2011-2), relating to revocation proceedings between Demharter GmbH and Benelli Q.J. Srl,

THE GENERAL COURT (Second Chamber),

composed of M.E. Martins Ribeiro (Rapporteur), President, S. Gervasoni and L. Madise, Judges,

Registrar: I. Dragan, Administrator,

having regard to the application lodged at the Court Registry on 21 March 2013,

having regard to the response of OHIM lodged at the Court Registry on 20 June 2013,

having regard to the response of the intervener lodged at the Court Registry on 17 June 2013,

* Language of the case: English.

having regard to the decision to reassign the case to the Second Chamber,
further to the hearing on 7 July 2015,
gives the following

Judgment

Background to the dispute

- 1 On 14 June 2001, the applicant, Benelli Q.J. Srl, formerly Benelli SpA, filed an application for registration of a Community trade mark at 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 trade mark in respect of which registration was sought is the following figurative sign:



- 3 The goods in respect of which registration was sought are in Classes 9, 12 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 to the following descriptions:
 - Class 9: ‘Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, sound recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire extinguishing apparatus’;
 - Class 12: ‘Vehicles, apparatus for locomotion by land, air or water, parts and accessories for the aforesaid goods included in this class’;
 - Class 25: ‘Clothing, footwear, headgear’.

- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 5/2002 of 14 January 2002 and the mark applied for was registered on 1 August 2002.
- 5 By letter of 18 November 2009, the intervener, Demharter GmbH, requested that the applicant withdraw the mark at issue on account of lack of use within the preceding five years, stating that if the applicant failed to do so, it would file an application for revocation with OHIM.
- 6 On 22 December 2009, the intervener filed an application for revocation of the mark at issue in respect of all the goods referred to in paragraph 3 above, pursuant to Article 51(1)(a) of Regulation No 207/2009, alleging that the mark had not been put to genuine use within a continuous period of five years preceding the filing of the application for revocation, although, to its knowledge, the mark at issue had been used for motorcycles between 1950 and 1974.
- 7 On 6 April 2010, the applicant submitted observations and evidence of use within the set deadline. Following observations from the intervener, the applicant submitted additional evidence on 28 July 2010, 29 October 2010 and 4 March 2011.
- 8 By decision of 21 October 2011, the Cancellation Division found that genuine use of the mark at issue had not been proved and thus declared the rights of the applicant revoked as of 22 December 2009.
- 9 On 19 December 2011, the applicant filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Cancellation Division. On 21 February 2012, the applicant filed its statement of grounds of appeal, which included additional evidence.
- 10 By decision of 16 January 2013 ('the contested decision'), the Second Board of Appeal of OHIM dismissed the appeal. First, concerning the evidence produced before the Cancellation Division, the Board of Appeal (i) described all the documents lodged by the applicant during the administrative proceedings and (ii) noted that the applicant had already submitted evidence of use on four previous occasions, before declaring (in point 34 of the contested decision) that it endorsed the Cancellation Division's conclusion that the documents submitted by the applicant were clearly insufficient for the purposes of establishing genuine use of the mark at issue. In points 35 to 44 of the contested decision, the Board of Appeal elaborated on its own reasoning for finding that the evidence adduced was insufficient for those purposes.
- 11 Secondly, concerning the evidence produced for the first time before the Board of Appeal, the Board observed, in point 46 of the contested decision, that Article 76 of Regulation No 207/2009 granted OHIM discretion to decide whether or not to take into account facts and evidence submitted out of time. The Board of Appeal added, in point 47 of the contested decision, that the Court of Justice had held that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remained possible after the expiry of the time limits to which such submission was subject under the provisions of Regulation No 207/2009, and that OHIM was in no way prohibited from taking account of facts and evidence which were submitted or produced late.
- 12 In point 50 of the contested decision, the Board of Appeal found that, in the present case, there was a provision to the contrary which precluded evidence submitted out of time from being taken into account, namely Article 51(1)(a) of Regulation No 207/2009, as applied under Rule 40(5) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4). Thus, the submission of proof of use of the Community trade mark after the expiry of the time limit resulted in the revocation of the mark.

- 13 Nonetheless, in point 51 of the contested decision, the Board of Appeal stated that Rule 40(5) of Regulation No 2868/95 cannot be interpreted as precluding evidence from being taken into consideration where the evidence is additional and new factors emerge, even if such evidence is adduced after the expiry of that strict time limit. After recalling, in points 52 to 54 of that decision, the conditions under which evidence may be considered additional and admissible, the Board of Appeal found, in point 55 of the contested decision, that the condition for the belated evidence being taken into consideration had actually only partially been met.
- 14 Concerning goods in Classes 9 and 25, the evidence (Annexes 6 and 7 to the statement of grounds) was considered to be new and not additional. The Board of Appeal found, in point 56 of the contested decision, that (i) the evidence regarding clothing items which had been filed before the Cancellation Division was obviously irrelevant since it did not concern the mark at issue and (ii) that no evidence at all had been submitted as regards Class 9 goods. The evidence was therefore declared inadmissible.
- 15 In point 57 of the contested decision, the Board of Appeal found that the belated evidence had to be deemed 'additional' as regards motorcycles (classified in Class 12), since it merely served to 'supplement' the main evidence. Nevertheless, the Board of Appeal observed that the Cancellation Division had already exercised its discretionary power in admitting the additional evidence of use submitted by the applicant together with its observations in reply to the intervener. Therefore, according to the Board of Appeal, the applicant had already had several chances, before the Cancellation Division, to submit adequate evidential material and, consequently, had had plenty of time to collect and prepare it in order to comply with the legal requirements. Thus, the Board of Appeal took the view that the circumstances did not speak in favour of accepting the supplementary documents.
- 16 In paragraph 58 of the contested decision, with regard to the documents produced by the applicant for the first time before the Board of Appeal (excluding Annexes 6 and 7 which had been declared inadmissible), the Board added that, in any case, whether those documents were taken into consideration or not, they did not demonstrate genuine use of the mark between 22 December 2004 and 21 December 2009 ('the relevant period') for the reasons set out by the Board of Appeal in paragraphs 59 to 69 of the contested decision (see paragraph 14 above).

Forms of order sought

- 17 The applicant claims that the Court should:
- alter the contested decision and order the dismissal of the application for revocation filed by the intervener;
 - failing that, annul the contested decision and remit the case to OHIM for further examination and a new decision;
 - order OHIM to pay the costs.
- 18 OHIM and the intervener contend that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.

Law

Admissibility of the general reference by the applicant to its written submissions in the proceedings before OHIM

- 19 OHIM submits that the general reference made by the applicant to all the arguments which it had submitted in writing in the administrative proceedings is inadmissible.
- 20 Under Article 21 of the Statute of the Court of Justice of the European Union and Article 44(1)(c) of the Rules of Procedure of the General Court of 2 May 1991, applications must include a summary of the pleas in law on which they are based. It is settled case-law that, 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 (see judgment of 8 July 2010 in *Engelhorn v OHIM — The Outdoor Group (peerstorm)*, T-30/09, ECR, EU:T:2010:298, paragraph 18 and the case-law cited therein).
- 21 At the hearing, the applicant stated, in response to a question put by the Court, that the reference it had made at certain points in the application was not to be interpreted as a general reference, but that its arguments were limited solely to the specific points developed in the application. In the light of that further information, the Court concludes that the plea of inadmissibility raised by OHIM must be rejected.

The admissibility of the complaints directed against the Cancellation Division's decision

- 22 OHIM contends that the applicant's objections against the findings made by the Cancellation Division should be declared inadmissible.
- 23 It must be recalled in this connection that, by virtue of Article 65(1) of Regulation No 207/2009, actions may be brought before the European Union judicature only against decisions of the Boards of Appeal so that it is only pleas directed against the decision of the Board of Appeal itself which are admissible in such an action (judgment of 7 June 2005 in *Lidl Stiftung v OHIM — REWE-Zentral (Salvita)*, T-303/03, ECR, EU:T:2005:200, paragraph 59).
- 24 At the hearing, the applicant stated, in reply to a question put by the Court, that the application was to be interpreted to the effect that the complaints set out therein were directed solely against the contested decision. Accordingly, the plea of inadmissibility raised by OHIM in this regard must be rejected.

Admissibility of the new evidence submitted by the applicant before the Court

- 25 The applicant has attached to the application before the Court new evidence consisting of an affidavit by the Mayor of the municipality of Pesaro (Italy). OHIM contends that the affidavit is inadmissible.
- 26 In that regard, it should be borne in mind that the purpose of an action before the Court is to review the legality of decisions of the Boards of Appeal of OHIM as provided for in Article 65 of Regulation No 207/2009. It is therefore not the Court's function to re-evaluate the factual circumstances in the light of evidence which has been adduced for the first time before it (judgments of 19 November 2008 in *Rautaruukki v OHIM (RAUTARUUKKI)*, T-269/06, EU:T:2008:512, paragraph 20, and of 25 June 2010 in *MIP Metro v OHIM — CBT Comunicación Multimedia (Metromeet)*, T-407/08, ECR, EU:T:2010:256, paragraph 16). It follows that facts not submitted by the parties before the

departments of OHIM cannot be submitted at the stage of the appeal brought before the Court (see judgment of 13 March 2007 in *OHIM v Kaul*, C-29/05 P, ECR, EU:C:2007:162, paragraph 54 and the case-law cited therein).

- 27 Moreover, it must be stated that the applicant, replying to a question put by the Court, did not deny that the Mayor of Pesaro, who held that position from 2004 onwards, could have had drawn up at the applicant's request during the administrative proceedings an affidavit which, although different on account of the dates referred to therein, which are subsequent to the date of the administrative proceedings, would nevertheless have been similar to that drawn up in the context of the present action.
- 28 In those circumstances, as OHIM contends, the annex referred to in paragraph 25 above, which was not produced by the applicant during the administrative proceedings, must be declared inadmissible.

Substance

- 29 The applicant submits, in essence, two pleas in law against the contested decision, alleging (i) infringement of Article 51(1)(a) of Regulation No 207/2009 and (ii) infringement of Rule 50(1), third subparagraph, of Regulation No 2868/95.
- 30 The plea in law alleging infringement of Rule 50(1), third subparagraph, of Regulation No 2868/95 should be examined first.

Second plea in law, alleging infringement of Rule 50(1), third subparagraph, of Regulation No 2868/95

- 31 The applicant alleges that the Board of Appeal failed to take into consideration the evidence submitted, on the ground that the Board of Appeal stated, in point 57 of the contested decision, that the circumstances did not speak in favour of accepting the supplementary documents.
- 32 In that regard, it must be observed that, in the present case, the Board of Appeal held that the condition for accepting evidence submitted out of time had actually only partially been met since the evidence produced before the Cancellation Division regarding Class 25 clothing items did not concern the mark at issue and no evidence had been submitted before the Cancellation Division as regards Class 9 goods, so that only the belatedly-submitted evidence concerning motorcycles falling within Class 12 was to be deemed 'additional' within the meaning of Rule 50 of Regulation No 2868/95.
- 33 First, with regard to the evidence concerning motorcycles falling within Class 12, in points 59 to 68 of the contested decision the Board of Appeal expressly referred to the documents concerned, took them into consideration, analysed them, and stated why that evidence did not give any further adequate information concerning the extent of use of the mark at issue during the relevant period.
- 34 It follows that, since the Board of Appeal examined the relevance of the documents concerning the motorcycles falling within Class 12, the applicant's complaint is ineffective in this respect.
- 35 Secondly, as regards the evidence relating to the goods falling within Classes 9 and 25, in point 56 of the contested decision the Board of Appeal held that the evidence (Annexes 6 and 7 to the statement of grounds of appeal) was new and not additional, and therefore declared it inadmissible.
- 36 The applicant contests the finding that the evidence concerned is inadmissible and alleges that the Board of Appeal incorrectly refused to use its discretionary power.

- 37 Contrary to what OHIM seems to be submitting, it is indeed apparent from the contested decision that the Board of Appeal did not examine that evidence and that its statement that the circumstances did not speak in favour of accepting the supplementary documents applied solely to the annexes, which indeed it had analysed, concerning motorcycles and not to Annexes 6 and 7 to the statement of grounds of appeal, which are not included among the documents, as listed in points 59 to 67 of the contested decision, assessed by the Board of Appeal. The Board of Appeal referred to and examined Annex 5 to the statement of grounds of appeal in point 63 of the contested decision and, in the next point, referred to and examined Annex 8 to that statement, without giving any consideration to Annexes 6 and 7.
- 38 Furthermore, OHIM's arguments that the applicant has not called into question the Board of Appeal's assessment of the evidential value of the new evidence produced for the first time before it or the reasons for which the Board considered that evidence insufficient for the purposes of proving genuine use of the mark at issue cannot be accepted.
- 39 The applicant claims, in particular, that it could have been established on the basis of the invoices in Annexes 6 and 7 to the statement of grounds of appeal, together with the other evidence which had been submitted before the Cancellation Division, that the mark at issue had been put to genuine use.
- 40 It is necessary to ascertain whether, in declaring inadmissible the evidence submitted before it concerning the goods falling within Classes 9 and 25 on the ground that it was new, and not additional, evidence, the Board of Appeal committed an error vitiating the legality of the contested decision.
- 41 The Board of Appeal noted in that connection, in point 47 of the contested decision, that, as regards Article 76 of Regulation No 207/2009, the Court of Justice had held that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remained possible after the expiry of the time limits to which such submission was subject under the provisions of Regulation No 207/2009, and, in point 49 of that decision, that OHIM was in no way prohibited from taking account of facts and evidence thus submitted or produced late, so that OHIM had discretion to decide whether or not to take such belatedly-submitted evidence into account.
- 42 In point 50 of the contested decision, the Board of Appeal held that Article 51(1)(a) of Regulation No 207/2009, as applied under Rule 40(5) of Regulation No 2868/95, was indeed a provision to the contrary and that it was apparent from those provisions that the submission of proof of use of the Community trade mark after the expiry of the time limit resulted in the revocation of the mark.
- 43 Nonetheless the Board of Appeal added, in point 51 of the contested decision, that Rule 40(5) of Regulation No 2868/95 could not be interpreted as precluding evidence from being taken into consideration where the evidence was additional and new factors emerged, even if such evidence was adduced after the expiry of that strict time limit and, in point 52 of that decision, that Rule 50(1), third subparagraph, of that regulation rendered the admissibility of new evidence subject to the condition that the evidence had to be additional.
- 44 The Board of Appeal stated, in point 53 of the contested decision, that, as was clear from the term 'additional', the additional evidence had to be supplementary material and not the main evidence, so that when no evidence of use had been submitted within the time limit or when the evidence submitted was obviously insufficient or irrelevant, the party could not be rewarded with the opportunity to submit evidence of use for the first time or the main part of the evidence after the expiry of the time limit.
- 45 In point 54 of the contested decision, the Board of Appeal added that Rule 22(2) of Regulation No 2868/95 had to be understood as not precluding additional evidence, which merely supplemented other evidence submitted within the time limit laid down, from being taken into account, where the

initial evidence was not irrelevant but was held to be insufficient. Such reasoning, which, according to the Board of Appeal, in no way rendered Rule 22(2) of that regulation superfluous, was all the more appropriate because the Community trade mark proprietor had not abused the time limits by knowingly employing delaying tactics or by demonstrating manifest negligence, and because the additional evidence which it had submitted merely corroborated the evidence resulting from the affirmations which were submitted within the time limits.

46 The Board of Appeal inferred from this, in point 56 of the contested decision, that Annexes 6 and 7 to the statement of grounds of appeal submitted before it by the applicant were inadmissible on the following grounds:

‘Concerning the goods in Classes 9 and 25, the evidence (Annexes 6 and 7 to the statement of ground[s]) is new and not additional. The evidence regarding clothing items which was filed before the Cancellation Division was obviously irrelevant since it did not concern the mark at issue. No evidence at all was submitted as regards Class 9 goods. [The evidence] is, therefore, inadmissible.’

47 Admittedly, Article 76(2) of Regulation No 207/2009 provides that OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned.

48 As the Court of Justice has held, it results from the wording of that provision 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 that regulation and that OHIM is in no way prohibited from taking account of facts and evidence which are submitted or produced late (judgments in *OHIM v Kaul*, cited in paragraph 26 above, EU:C:2007:162, paragraph 42; of 18 July 2013 in *New Yorker SHK Jeans v OHIM*, C-621/11 P, ECR, EU:C:2013:484, paragraph 22, and of 3 October 2013 in *Rintisch v OHIM*, C-122/12 P, ECR, EU:C:2013:628, paragraph 23).

49 In stating that the latter ‘may’, in such a case, decide to disregard evidence, Article 76(2) grants OHIM broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account (judgment in *Rintisch v OHIM*, cited in paragraph 48 above, EU:C:2013:628, paragraph 24).

50 In so far as the second plea put forward by the applicant exclusively concerns the Board of Appeal’s finding that its discretionary power applied only to the evidence which supplemented that which had already been submitted, and not to the evidence which, according to the Board of Appeal, was submitted only at the appeal stage without any relevant material having been submitted before the Cancellation Division, it need only be ascertained whether the Board of Appeal was correct in holding that that latter evidence was inadmissible.

51 The Court of Justice held as follows, in paragraphs 32 and 33 of the judgment in *Rintisch v OHIM*, cited in paragraph 48 above (EU:C:2013:628):

‘32 Under the third subparagraph of Rule 50(1) of [Regulation No 2868/95], where the appeal is directed against a decision of an Opposition Division, the Board of Appeal must limit its examination of the appeal to facts and evidence presented within the time limits set or specified by the Opposition Division, unless the Board considers that additional or supplementary facts and evidence must be taken into account pursuant to Article [76](2) of Regulation No [207/2009].

33 [Regulation No 2868/95] therefore expressly provides that the Board of Appeal enjoys, when examining an appeal directed against a decision of the Opposition Division, the discretion deriving from the third subparagraph of Rule 50(1) of [Regulation No 2868/95] and from Article

[76](2) of Regulation No [207/2009] to decide whether or not to take into account additional or supplementary facts and evidence which were not presented within the time-limits set or specified by the Opposition Division.’

- 52 As Advocate General Sharpston stated in footnote 23 in her Opinion in *Rintisch v OHIM*, cited in paragraph 48 above (EU:C:2013:628), ‘ the different language versions of the third subparagraph of Rule 50(1) [of Regulation No 2868/95] do not fully correspond’, ‘[f]or example, the French text refers to “faits et preuves nouveaux ou supplémentaires” and the Dutch text states “aanvullende feiten en bewijsstukken”’.
- 53 It must be added that the expression ‘ faits ou preuves nouveaux’, construed to the effect that in the proceedings before the lower instance there was allegedly no fact or item of evidence submitted, is used neither in the English version (additional or supplementary facts and evidence), nor the German version (zusätzliche oder ergänzende Sachverhalte und Beweismittel), nor the Danish version (yderligere eller supplerende kendsgerninger og beviser), nor the Estonian version (lisa- või täiendavaid fakte ja tõendeid), nor the Spanish version (hechos y pruebas adicionales), nor the Italian version (fatti e prove ulteriori o complementari), nor the Portuguese version (factos adicionais ou suplementares), nor the Czech version (další nebo doplňkové skutečnosti a důkazy), nor the Swedish version (att ytterligare eller kompletterande sakförhållanden och bevis bör), to give several examples.
- 54 It is apparent from the various language versions that the ‘new’ facts or evidence as provided for in the French version, must supplement facts or evidence already submitted so that, as Advocate General Sharpston stated in point 66 of her Opinion in *Rintisch v OHIM*, cited in paragraph 48 above (EU:C:2013:628), ‘it is plain that, in order for evidence to be so characterised [as ‘new’ or supplementary], other evidence must have been submitted at an earlier stage of the proceedings’.
- 55 That interpretation, which is apparent from paragraph 33 of the judgment in *Rintisch v OHIM*, cited in paragraph 48 above (EU:C:2013:628), also applies having regard to the Board of Appeal’s discretionary power, which cannot extend to evidence submitted for the first time before it where no evidence had been submitted before the Cancellation Division.
- 56 It must be pointed out, in the present case, that the applicant had several chances in the proceedings before the Cancellation Division (namely on 8 January 2010, 28 July 2010, 29 October 2010 and 4 March 2011) to submit the facts and evidence required to establish genuine use of the mark at issue with regard to the three classes in respect of which that mark had been registered.
- 57 Although evidence was in fact submitted concerning the motorcycles falling within Class 12, it is necessary to uphold the Board of Appeal’s findings according to which the evidence filed before the Cancellation Division relating to the Class 25 clothing items was obviously irrelevant since it did not concern the trade mark at issue (point 56 of the contested decision), the figurative aspects shown being moreover scarcely legible, and that no evidence at all had been submitted as regards the Class 9 goods, with the result that the evidence concerned had to be declared inadmissible.
- 58 It must be held that, not having submitted any facts or evidence concerning the goods falling within Classes 9 and 25 in the proceedings before the Cancellation Division, the applicant could not make good that omission by filing evidence for the first time before the Board of Appeal for the purposes of establishing the genuine nature of the use of the mark at issue so far as concerns the goods in those two classes.
- 59 It must also be observed in this connection that the applicant, replying to a question put at the hearing by the Court, was completely unable to name the annexes filed before the Cancellation Division which would establish that the Board of Appeal’s finding in point 56 of the contested decision, that the applicant had not filed proof of use of the mark at issue with respect to the goods falling within Classes 9 and 25, was incorrect.

60 The applicant simply referred to the ‘2008/2009 Benelli accessories and clothing catalogue listing spare parts and clothing [without there being any] reference to MOTObI’, requesting the Court itself to verify whether that finding was incorrect while nevertheless failing to mention any specific document which would enable the alleged error to be proved.

61 It must be stated that, although the catalogue referred to in paragraph 60 above does refer to Benelli, there is no mention whatsoever of the mark at issue itself on any of the documents included in that catalogue.

62 Therefore, in finding that the applicant had failed at the stage of the proceedings before the Cancellation Division to submit any evidence at all relating to the use of the mark at issue so far as concerns the goods falling within Classes 9 and 25, the Board of Appeal did not commit any error vitiating the legality of the contested decision.

63 It follows from all the foregoing considerations that the second plea in law must be rejected.

First plea in law, alleging infringement of Article 51(1)(a) of Regulation No 207/2009

64 The applicant, in essence, criticises the Board of Appeal for finding that the evidence submitted by the applicant for assessment was insufficient for the purposes of establishing that the mark at issue had been put to genuine use.

65 It is apparent from recital 10 of Regulation No 207/2009 that the legislature considered that there is no justification for protecting a Community trade mark, except where the trade mark is actually used. In accordance with that recital, Article 51(1)(a) of Regulation No 207/2009 provides that the rights of a proprietor of a Community trade mark are to be declared revoked, in particular, 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 non-use. That provision adds that the commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use is to be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

66 Rule 22(3) of Regulation No 2868/95, which is applicable to applications for revocation pursuant to Rule 40(5) of that regulation, provides that evidence of use of the mark must concern the place, time, extent and nature of use of the mark at issue (judgments of 10 September 2008 in *Boston Scientific v OHIM — Terumo (CAPIO)*, T- 325/06, EU:T:2008:338, paragraph 27, and of 24 May 2012 in *TMS Trademark-Schutzrechtsverwertungsgesellschaft v OHIM — Comercial Jacinto Parera (MAD)*, T-152/11, EU:T:2012:263, paragraph 17).

67 The rationale for the requirement that a mark must have been put to genuine use in order to be protected under EU law is that OHIM’s register cannot be compared to a strategic and static depository granting an inactive proprietor a legal monopoly for an unlimited period. On the contrary, and in accordance with recital 10 of Regulation No 207/2009, that register must faithfully reflect what companies actually use on the market to distinguish their goods and services in economic life (see also, to that effect, order of 27 January 2004 in *La Mer Technology*, C-259/02, ECR, EU:C:2004:50, paragraphs 18 to 22).

68 In the interpretation of the notion of genuine use, account must be taken of the fact that the rationale for the requirement that the mark at issue must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to

restrict trade mark protection to the case where large-scale commercial use has been made of the marks (see judgment in *MAD*, cited in paragraph 66 above, EU:T:2012:263, paragraph 18 and the case-law cited therein).

- 69 As is apparent from paragraph 43 of the judgment of 11 March 2003 in *Ansul* (C-40/01, ECR, EU:C:2003:145), 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 externally (see judgment in *MAD*, cited in paragraph 66 above, EU:T:2012:263, paragraph 19 and the case-law cited therein; see also, by analogy, judgment in *Ansul*, EU:C:2003:145, paragraph 37).
- 70 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create 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 (see judgment in *MAD*, cited in paragraph 66 above, EU:T:2012:263, paragraph 20 and the case-law cited therein; see also, by analogy, judgment in *Ansul*, cited in paragraph 69 above, EU:C:2003:145, paragraph 43).
- 71 As to the extent of the use to which the trade mark at issue 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 (see judgment in *MAD*, cited in paragraph 66 above, EU:T:2012:263, paragraph 21 and the case-law cited therein).
- 72 In order to examine, in a particular case, whether a Community trade mark has been put to genuine use, an overall 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 the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the mark at issue 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 products or services on the relevant market. As a result, the Court has stated that use of the mark at issue need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a market share for the goods or services protected by the mark (see judgment in *MAD*, cited in paragraph 66 above, EU:T:2012:263, paragraph 22 and the case-law cited therein).
- 73 The Court of Justice also added, in paragraph 72 of the judgment of 11 May 2006 in *Sunrider v OHIM* (C-416/04 P, ECR, EU:C:2006:310) that it was not possible to determine a priori and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not, which means that a *de minimis* rule, which would not allow OHIM or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down. Thus, the Court of Justice has held that, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use (see judgment in *MAD*, cited in paragraph 66 above, EU:T:2012:263, paragraph 23 and the case-law cited therein).

- 74 However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor of the mark to produce additional evidence to dispel possible doubts as to its genuineness (judgment of 18 January 2011 in *Advance Magazine Publishers v OHIM — Capela & Irmãos (VOGUE)*, T-382/08, EU:T:2011:9, paragraph 31).
- 75 Furthermore, the General Court has specified that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see judgment in *MAD*, cited in paragraph 66 above, EU:T:2012:263, paragraph 24 and the case-law cited therein).
- 76 It is necessary to examine, in the light of those considerations, whether the Board of Appeal was correct in concluding that the mark at issue had not been put to genuine use in the five years preceding the date of the application for revocation of that mark, thus endorsing the Cancellation Division's decision.
- 77 Since the application for revocation of the mark at issue was lodged on 22 December 2009, the five-year period referred to in Article 51(1)(a) of Regulation No 207/2009, which was mentioned in paragraph 16 above, extends, as the Board of Appeal correctly observed in point 32 of the contested decision, from 22 December 2004 to 21 December 2009.
- 78 The following evidence was provided by the applicant in the administrative proceedings before the Cancellation Division concerning the use of the mark at issue:

— participation [in the] EICMA [Exhibition] (2003):

- [an] extract from the [website] www.cyberscooter.it with a reference to MOTOBI motorcycles at the EICMA 2003 [Exhibition];
- [an] extract from [the website] www.eicma.it containing information regarding [the] EICMA 2010 [Exhibition]. [The] EICMA [Exhibition] is a motorcycle exhibition [show] in Milan. There is no reference to MOTOBI.

extracts [from websites] on MOTOBI motorcycles (2004):

- [an extract] from [the website] www.pakautocar.com including two pictures of motorcycles. According to the title of the website, these are “Motobi motorcycle... wallpaper... images”;
- [an extract] from [the website] www.motorcyclespecifications.info/Motobi_Velvet400.html including technical information on a MOTOBI scooter (2004); and
- [an extract] from [the website] www.bikez.com including technical information on a “Motobi Adiva 150” (2004) scooter and a “Motobi Adiva 125” (2004) scooter.

buying order (15 October 2009):

- [a] buying order from Keeway France SAS placing an order with Benelli Q.J. Srl for 26 units of Pepe 50 scooters with the MOTOBI [trade mark] for the French market. The order is signed by the “director general”. The document is dated 15 October 2009. A letter from Mr PAN of Keeway France SAS in which it is indicated that the Keeway buying order was signed by him;
- [a] letter of 25 November 2009 from Benelli Q.J. Srl (signed by the Legal Representative and Director General of Benelli) in reply to the buying order indicating that [the company] will be able to supply the scooters by the end of July 2010.

invoices (2010):

- one invoice from Benelli Q.J. Srl to Keeway France dated 20 July 2010 for the sale of one “Velvet 125 cc black Motobi” for the amount of EUR 680 and a transport document;
- one invoice from Benelli Q.J. Srl to Motor Show Center Sport Srl. in Milan dated 30 June 2010, for the sale of three motorcycles for the amount of EUR 3 448 and two transport documents[,] dated 2 July 2010 for two “Velvet 125 nero Motobi” and 30 June 2010 for three “49x on road nero — Motobi” [respectively].

pictures (undated):

- four pictures of motorcycles [bearing] the trade mark “MOTOBI”:



- internet print-outs from Google ... of “Velvet Motobi” images.

resale of “MOTOBI” spare parts (undated):

- [an] extract from [the website] webcache.googleusercontent.com with information on MOTOBI spare parts. It is indicated that “Motobi was founded by one of six Benelli brothers in 1950[,] who made motorcycles for a little over twenty years before the factory doors closed”;
- other ... extracts [from websites] (eBay, motorcycles.shop, webcache.googleusercontent.com, justgastanks.com) involving third parties selling vintage MOTOBI spare parts or old MOTOBI motorcycles. The pages were printed out on 29 October 2010.

catalogues:

- Benelli motorcycle catalogues showing pictures of goods that are referred to as Velvet and Adiva. According to the [Community trade mark] proprietor, the catalogues are dated 2004. However[,] this date is not visible on the catalogues. It is also claimed that [the catalogues] show the cobranding of MOTOBI with Velvet and Adiva. The following sign appears on the first page:

Benelli accessories & apparel catalogue 2008/2009 listing spare parts and clothing. There is no reference to MOTOBI.



- Benelli accessories & apparel catalogue 2008/2009 listing spare parts and clothing. There is no reference to MOTOBI.

on the company:

- extracts from [the website] webcache.googleusercontent.com with information on “Benelli Adiva 150” and on the history of Benelli, and, in particular, “the 2005 Benelli Motorcycle range”. The extracts contain some pictures but there is no information on the MOTOBI trade mark — only a reference to MOTOBI and Benelli having produced around 300 motorcycles per day in 1962. According to the [Community trade mark] proprietor, [those extracts] show that Benelli produces Adiva motorcycles, which are also cobranded with MOTOBI;
- [an] internet press-release dated 15 September 2005 which indicates that Benelli has been bought by a Chinese firm, and an ... extract from [the website] www.twowheelsblog.com containing the article “Benelli in crisis: production cut as possible move to China considered” (illegible date);
- [an] extract from [the website] www.benelliclubgb.net containing information on the Benelli Motobi Club GB, printed on 29 October 2010;
- extracts from websites regarding the Benelli museum, which [contains] MOTOBI motorcycles, printed on 29 October 2010.’

79 Furthermore, other evidence was produced by the applicant before the Board of Appeal, which was examined by the Board in points 59 to 67 of the contested decision. The Board made the following observations concerning that evidence.

80 It found that the invoice which was filed as Annex 1 to the statement of grounds of appeal was dated 2 August 2010, that is to say outside the relevant period, and showed the sale of three scooters — thus a very small quantity — at a unit price of EUR 680. It next found that the declarations filed as Annex 2 to that statement were vague and did not mention whether the products had been sold but merely that they had been produced. Annex 3 to that statement did not relate to PESARO B MOTOBI goods. Annex 4 to that statement referred to the right to use the ‘Benelli’ and MotoBi’ logos in exhibitions planned for 2005, without proving that those logos were used. Annex 5 to that statement contained an article in English relating to the history of the MOTOBI mark. The most recent date mentioned was 1972. That latter annex also showed undated photographs of scooters. Annex 8 to the statement of grounds of appeal showed undated photographs of motorcycles. Annex 9 to that statement showed undated photographs of scooters printed in 2011. Annex 10 to the abovementioned statement showed the technical specifications of two 2004 MOTOBI models. Lastly, Annex 11 to that statement contained press articles and photographs of ‘benelli’ motorcycles without mentioning the PESARO B MOTOBI trade mark.

- 81 It must be stated that, both for the reasons given by the Cancellation Division, which are reproduced in point 16 of the contested decision, and for those given by the Board of Appeal, which are set out in points 59 to 68 of that decision, the evidence produced by the applicant in the administrative proceedings is, taken as a whole, clearly insufficient for the purposes of establishing genuine use of the mark at issue.
- 82 As OHIM has correctly observed, most of the documents produced by the applicant for the purposes of establishing genuine use of the mark at issue are devoid of evidential value in so far as they are undated or bear a date before or after the relevant period, or do not refer to the mark at issue, or are undated photographs which cannot be cross-referenced with other documents such as product catalogues or lists of references. None of the documents contain data regarding the turnover or the number of sales of the goods bearing the trade mark during the relevant period.
- 83 The only evidence submitted by the applicant to the Board of Appeal which contains a date falling within the relevant period referred to in paragraph 77 above is: a buying order dated 15 October 2009 for 26 MOTOBI scooters, with a reply dated 25 November 2009. That order gave rise to a single invoice, dated 20 July 2010 and so after the relevant period, which concerns a single scooter, not 26 scooters.
- 84 It must be noted in this connection that, although the buying order of 15 October 2009 for 26 MOTOBI scooters falls within the relevant period for the purposes of proof of genuine use of the trade mark, the applicant's reply to that order nevertheless bears a date at which the applicant had just been informed that the intervener was about to bring proceedings for revocation (see paragraph 5 above) and that, as provided for under the last sentence of Article 51(1)(a) of Regulation No 207/2009, that evidence falls within a period of three months preceding the filing of the application for revocation.
- 85 Furthermore, as regards, first, the applicant's argument that it provided numerous pieces of evidence, it must be stated that the mere fact that the applicant produced 'numerous pieces of evidence' in the administrative proceedings, as it itself asserts, is of no account for the purposes of establishing that the mark at issue was put to genuine use, in so far as proving that fact depends not on the volume of the annexed documents, especially where those documents do not mention the figurative mark at issue or, in almost all cases, are dated before or after the relevant period, but on the quality and the relevance of the documents, which must enable the applicant to prove the genuine use claimed, since genuine use cannot simply be assumed on the basis of fragmentary and insufficient evidence.
- 86 Moreover, in relying on documents dated before or after the relevant period and by stating that 'it shall be assumed that these documents also have an effect on the relevant time period', the applicant has clearly committed two errors: (i) claiming that documents which do not relate to the relevant period must be taken into consideration for the purposes of proving the genuine nature of the use of the mark at issue and (ii) proceeding on the basis that genuine use can be proved by mere probabilities or suppositions, contrary to the case-law cited in paragraph 75 above.
- 87 Admittedly, the Court of Justice has held, in paragraph 34 of the order in *La Mer Technology*, cited in paragraph 67 above (EU:C:2004:50), that circumstances subsequent to the filing of the application for revocation may be taken into account. However, it further stated that such circumstances may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time.
- 88 The genuine nature of the use of the mark at issue may furthermore not be proved by evidence which does not relate to the relevant period.

- 89 It must be stated that, in the present case, the later documents submitted by the applicant both before the Cancellation Division and before the Board of Appeal do not enable the extent to which the trade mark was used during the relevant period to be better assessed, since they do not confirm any information in relation to that period.
- 90 As regards, secondly, the applicant's argument that the Board of Appeal failed to take account of 'the significance of [its] participation at the ... world famous EICMA ... exhibition', which takes place, according to the applicant itself, in November every year, and at which the applicant claimed to be present in 2003 and 2004, it must be recalled that the relevant period starts on 22 December 2004 so that, even if the applicant did participate in that exhibition, its participation would have been prior to the period in which the genuine use of the mark at issue had to be proved.
- 91 The applicant's contention that, on account of its participation in 2003 and 2004 in that exhibition, the mark at issue would have been present on the market in subsequent years, is in no way substantiated and it cannot be inferred solely from that participation that the applicant has established that it put that mark to genuine use, a fortiori since, as it has been noted, genuine use cannot be proved by mere probabilities or suppositions, pursuant to the case-law cited in paragraph 75 above.
- 92 As regards, third, the applicant's argument that the Board of Appeal did not give proper consideration to the fact that goods bearing the MOTOBI sub-brands Adiva and Velvet had been manufactured, inter alia, in 2004, it must be stated that, in any event, the evidence concerning those sub-brands is insufficient to establish genuine use of the mark at issue.
- 93 In particular, Annex I to the statement of grounds of appeal, which is an invoice dated 2 August 2010 to Keeway France SAS and which was therefore drawn up after the filing date of the application for revocation, relates to the sale of two 'velvet 125 c. nero — motobi' models and one 'velvet 125 c. grigio — motobi' model. Annexes 8 and 9 to that statement contain photographs of scooters and motorcycles and Annex 10 to that statement contains the technical specifications of two 2004 'motobi' models.
- 94 It must be stated, as OHIM contended at the hearing, that the evidence in question, even assessed as a whole with the evidence lodged by the applicant before the Cancellation Division, is also insufficient for the purposes of proving genuine use of the mark at issue on account of (i) the date of the invoice drawn up after the filing date of the application for revocation and, even if that evidence dated after the application for revocation could be taken into account, (ii) the token nature of the sales made.
- 95 As regards, fourthly, the applicant's argument that the Board of Appeal failed to take into account the fact that the goods falling within Class 12, namely scooters, are not everyday articles sold in large quantities, it is sufficient to observe that the documents produced by the applicant which relate to the relevant period do not mention any scooter sales. The only sale which appears in the documents included in the case file, and which is mentioned in point 38 of the contested decision, is dated after that period.
- 96 Therefore, even assuming that, as the applicant claims, the scooter market is not characterised by a high number of sales, the applicant has shown no sale during the relevant period, but an order for 26 scooters resulting in a single sale, so that, even if that sole sale had been taken into account for the purposes of proving genuine use of the mark at issue, the fact would have remained that the sale in question was clearly insufficient for the purposes of proving genuine use. Moreover, the additional invoice drawn up on 30 June 2010 at the request of Motor Show Center Sport Srl in Pesaro for the sale of three scooters for EUR 3448.14 is also dated after that period, refers only to Motobi and — even if it were to be necessary to take it into consideration — shows merely token use of that latter trade mark.

- 97 As the Court of Justice has held, ‘genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark (judgment in *Ansul*, cited in paragraph 69 above, EU:C:2003:145, paragraph 36).
- 98 As regards, fifth, the statements from the applicant’s employees lodged before the Board of Appeal (see point 57 of the contested decision), being documents which come from the company itself, the Court has ruled that, in order to assess their evidential value, regard should be had first and foremost to the credibility of the account they contain. It added that it is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (judgments in *Salvita*, cited in paragraph 23 above, EU:T:2005:200, paragraph 42, and of 16 November 2011 in *Dorma v OHIM — Puertas Doorsa (doorsa FÁBRICA DE PUERTAS AUTOMÁTICAS)*, T-500/10, EU:T:2011:679, paragraph 49).
- 99 In the present case it must be concluded that, given their provenance, the various statements, which come from the applicant itself and are all drafted identically, stating that the vehicles bearing the MOTOBI trade mark shown in the annexed photographs were developed, prepared and promoted by the applicant in 2004 and 2005, cannot therefore constitute, by themselves, adequate proof of the genuine use of the mark at issue. The information contained therein is only indicative and needs to be corroborated by other proof (see, to that effect, judgment of 15 December 2005 in *BIC v OHIM (Shape of a lighter)*, T-262/04, ECR, EU:T:2005:463, paragraph 79).
- 100 Thus, in the absence of any other document substantiating the information contained in those statements which could corroborate the production and the sale of the goods bearing the mark at issue, those statements, considered in the light of all the other evidence submitted by the applicant in the administrative proceedings, cannot establish that the mark in question was put to genuine use during the relevant period.
- 101 As regards, lastly, the applicant’s argument that the Board of Appeal did not assess the evidence as a whole but separated the various pieces of evidence before it, admittedly, 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 *Ferrero Deutschland v OHIM*, C-108/07 P, EU:C:2008:234, paragraph 36).
- 102 However, it must be concluded in the present case that, even after assessing as a whole all of the evidence submitted by the applicant, it still cannot be inferred that genuine scooter sales were made during the relevant period, so that it is impossible to ascertain the applicant’s market share or its actual economic activity.
- 103 It follows from the foregoing that the first plea must be rejected and the action dismissed in its entirety.

Costs

- 104 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by OHIM and the intervener.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Benelli Q.J. Srl to pay the costs.**

Martins Ribeiro

Gervasoni

Madise

Delivered in open court in Luxembourg on 2 February 2016.

[Signatures]