



Reports of Cases

OPINION OF ADVOCATE GENERAL
KOKOTT
delivered on 1 December 2016¹

Case C-598/14 P

The European Union Intellectual Property Office (EUIPO)

v

Gilbert Szajner

(Appeal — EU trade mark — Word mark ‘LAGUIOLE’ — Application for declaration of invalidity based on rights in the earlier business name ‘Forge de Laguiole’ — Declaration of partial invalidity by the Board of Appeal of EUIPO — Partial annulment of the Board of Appeal’s decision by the General Court — Articles 8(4), 53(1)(c), 65(1) and 65(2) of Regulation (EC) No 207/2009 — Determining the extent of the protection granted to a sign by the relevant national law — National judgment given after the decision by the Board of Appeal of EUIPO — Review of the Board of Appeal’s decision by the General Court — Article 58(1) of the Statute of the Court of Justice — Review of the General Court’s decision by the Court of Justice on appeal)

I – Introduction

1. The main issue in this appeal is the extent to which European Union Courts are able to review national law within the system of legal protection for the EU trade mark.
2. This issue arises in connection with a case involving the term ‘Laguiole’, which in France is associated not only with knives, but also with a good deal of litigation. This litigation concerns in particular the use of the name of the town of Laguiole, which nowadays is often used as a synonym for the well-known folding knives that are traditionally manufactured there. The issue of the extent to which this name can be used to market products that have no connection with the town of Laguiole has not yet been conclusively resolved in national law.²
3. The present case, however, involves solely the initially separate question of the extent of the protection enjoyed by the *business name* ‘Forge de Laguiole’ in the context of Article 8(4)(b) of Council Regulation (EC) No 207/2009 on the European Union trade mark in conjunction with Article L. 711-4(b) of the French Intellectual Property Code.

¹ — Original language: German.

² — The dispute over the use of the name ‘Laguiole’ has spanned a period of more than 20 years, the latest stage being a decision by the French Cour de Cassation (Court of Cassation) of 4 October 2016; on this and generally on the background to the case, see Tymen, E., ‘Une nouvelle manche dans la guerre autour des couteaux Laguiole’, *Le Figaro* of 11.10.2016, available at <http://www.lefigaro.fr/conjoncture/2016/10/11/20002-20161011ARTFIG00196-une-nouvelle-manche-dans-la-guerre-autour-des-couteaux-laguiole.php>.

4. The Board of Appeal of the European Union Intellectual Property Office ('EUIPO') was of the view in this respect that, under French case-law, a business name in principle enjoys protection for all of the business activities covered by the objects of the company. According to the General Court, in contrast, a business name is protected only for the activities that the company also actually pursues. The General Court based this view on the judgment of the French Cour de Cassation (Court of Cassation) of 10 July 2012 in the *Cœur de Princesse* case ('*Cœur de princesse* judgment'),³ which was handed down only *after* the Board of Appeal's decision.

5. In EUIPO's view, herein lies an error of law on the part of the General Court, as the General Court could only set aside a decision by the Board of Appeal if this decision were erroneous in law at the time it was handed down. EUIPO says that the General Court, by taking into consideration the *Cœur de princesse* judgment, did not therefore discover an error by the Board of Appeal, but rather it replaced the latter's assessment by its own. Conversely, according to the General Court, that judgment simply sets out French law as it should have been applied by the Board of Appeal.⁴

6. This controversy demonstrates that there is a certain tension between the reference to national law in the EU trade mark system and the rules that normally govern the review by the General Court with regard to the decisions by the EUIPO Boards of Appeal. Under those rules, the General Court must in principle confine itself to finding the decision that the Board of Appeal should have reached on the basis of the particulars underlying the Board of Appeal's decision. It is clear from the existing case-law of the Court of Justice that these rules are not applied without modification if the General Court's interpretation of a national legal provision is at issue. This appeal gives the Court of Justice the opportunity to clarify and further develop this case-law.⁵

II – Legal Framework

A – EU law

1. Statute of the Court of Justice

7. The first paragraph of Article 58 of the Statute of the Court of Justice states:

'An appeal to the Court of Justice shall be limited to points of law. It shall lie on the grounds of lack of competence of the General Court, a breach of procedure before it which adversely affects the interests of the applicant as well as infringement of Union law by the General Court.'

2. Regulation No 207/2009

8. Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark⁶ was replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark,⁷ with Articles 8, 52 and 63 of Regulation No 40/94 becoming Articles 8, 53 and 65 of Regulation No 207/2009 without any substantial modification.

3 — Annex 4 to the response by Mr Szajner.

4 — See judgment of 21 October 2014, *Szajner v OHIM — Forge de Laguiole (LAGUIOLE)* (T-453/11, EU:T:2014:901, paragraph 51) ('judgment under appeal').

5 — Judgments of 5 July 2011, *Edwin v OHIM* (C-263/09 P, EU:C:2011:452), and of 27 March 2014, *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2014:186).

6 — OJ 1994 L 11, p. 1.

7 — OJ 2009 L 78, p. 1.

9. Article 8(4) of Regulation No 207/2009 states:

‘4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to Union legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the EU trade mark, or the date of the priority claimed for the application for registration of the EU trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.’

10. Article 53(1)(c) of Regulation No 207/2009 provides:

‘1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

...

- (c) where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled.’

11. Article 65(1) and (2) of Regulation No 207/2009 reads as follows:

‘1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.’

B – *French law*

12. Articles L. 711-4(b) and L. 714-3 of the Code de la propriété intellectuelle (French Intellectual Property Code) (‘IPC’) are worded as follows:

L. 711-4

‘A sign may not be adopted as a trade mark if it interferes with prior rights, in particular

...

- (b) a business name or corporate name, if there is a likelihood of confusion on the part of the public;

...’

L. 714-3

‘The registration of a trade mark which is not in accordance with the provisions of Articles L. 711-1 to L. 711-4 shall be declared invalid by court order.’

III – Background to the case and proceedings before EUIPO and the General Court

13. Mr Szajner is the proprietor of the Union word mark LAGUIOLE, which was applied for on 20 November 2001 and registered on 17 January 2005 by EUIPO under Regulation No 40/94 (replaced by Regulation No 207/2009).

14. The trade mark LAGUIOLE was registered inter alia for various goods and services in Classes 8, 14, 16, 18, 20, 21, 28, 34 and 38 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended. This involved a wide range of various goods and services, ranging from hand tools and implements (hand-operated), via jewellery, watches, tableware, writing articles, leatherwear, works of art, as well as sporting articles and smokers' articles through to telecommunications services.⁸ However, following the partial withdrawal that took place during the proceedings before EUIPO, knives, forks and scissors were no longer included.⁹

A – Proceedings before EUIPO and decision by the Board of Appeal

15. On 22 July 2005, Forge de Laguiole filed an application for a declaration of partial invalidity in respect of the trade mark LAGUIOLE under Article 52(1)(c) of Regulation No 40/94, in conjunction with Article 8(4) of that regulation (now Articles 53(1)(c) and 8(4) of Regulation No 207/2009).

16. The application for a declaration of invalidity was based on the business name Forge de Laguiole, which was used by Forge de Laguiole for the 'manufacture and sale of all cutlery articles, scissors, gift articles and souvenirs — all tableware-related articles'. According to Forge de Laguiole, this business name entitles it under Article L. 711-4(b) in conjunction with Article L. 714-3 IPC to prohibit use of the trade mark LAGUIOLE.

17. By decision of 27 November 2006, the Cancellation Division rejected the application for a declaration of invalidity.

18. On 25 January 2007, Forge de Laguiole filed a notice of appeal with EUIPO against the Cancellation Division's decision.

19. By decision of 1 June 2011, the First Board of Appeal of EUIPO upheld the appeal in part and declared that the trade mark LAGUIOLE was invalid for the goods in Classes 8, 14, 16, 18, 20, 21, 28 and 34. It dismissed the appeal as regards the services in Class 38 (telecommunications services).¹⁰

20. The Board of Appeal based its decision on two pillars, each of which on its own was, it considered, a sufficient basis for its conclusion that the business name Forge de Laguiole enjoyed protection for all of the activities referred to in the objects of the company.¹¹ First, the Board of Appeal considered that under Article L. 711-4(b) of the IPC the protection enjoyed by a business name under French law extends, as a matter of principle, to all of the business activities covered by its objects if these objects are sufficiently clear, as in this case.¹² Second, the Board of Appeal was of the view that, even if it were

8 — Paragraphs 1 and 2 of the judgment under appeal.

9 — See paragraph 2 of the judgment under appeal, and paragraphs 5 and 6 of the decision by the Board of Appeal of EUIPO of 1 June 2011 (Annex 1 to the claim at first instance) ('decision at issue').

10 — Paragraphs 3 to 8 of the judgment under appeal.

11 — Paragraphs 9 and 33 of the judgment under appeal.

12 — Paragraphs 34 and 41 of the judgment under appeal; paragraphs 87 to 90 of the decision at issue (Annex 1 to the defence at first instance).

to be conceded that the wording of the objects of the company ('manufacture and sale of all gift articles and souvenirs — all tableware-related articles') was not sufficiently clear, Forge de Laguiole had proven that it had expanded its business into these areas of activity prior to filing of the application for registration of the contested EU trade mark.¹³

B – Judgment of the General Court

21. On 8 August 2011, Mr Szajner brought an action before the General Court seeking annulment of the decision at issue. He based his action on infringement of Article 53(1)(c) in conjunction with Article 8(4) of Regulation No 207/2009 and argued in particular that, under Article L. 711-4 of the IPC, contrary to the view of the Board of Appeal, the protection of a business name covers only the business activities actually pursued by a company.¹⁴

22. In its judgment of 21 October 2014, the General Court found first that, for the purpose of its interpretation of French law, the Board of Appeal relied on the case-law existing as of the date the decision at issue was adopted, namely 1 June 2011. It said, however, that this case-law is not consistent and has given rise to controversy in specialised legal literature.¹⁵

23. The General Court took the view that this controversy had been resolved by the French Cour de Cassation (Court of Cassation) in the *Cœur de princesse* judgment as 'the protection [enjoyed] by the business name only covers the business activities actually pursued by the company and not those listed in its articles of association'.¹⁶ Even though the judgment in question was handed down after the decision at issue, the General Court was of the view that it could be taken into account by the Court in its review of the lawfulness of that decision.¹⁷

24. The General Court thus concluded that the first pillar of the reasoning of the Board of Appeal, based on the business activities specified in the objects of Forge de Laguiole, could not justify the decision at issue.¹⁸ In examining the substance of the second pillar of that decision, the General Court found further that, contrary to the view of the Board of Appeal, Forge de Laguiole had demonstrated only that the business activities it pursued were the manufacture and sale of all articles falling within the cutlery sector or the fork and spoon sector, as well as within the gift and souvenir sector, to the extent that these goods fall within those sectors. The General Court therefore annulled the decision at issue in so far as the decision had held there was a likelihood of confusion within the meaning of Article L. 711-4 of the IPC as regards other articles, and restricted its examination of the likelihood of confusion within the meaning of that provision to the business activities that it considered were actually pursued by Forge de Laguiole during the period in question.¹⁹

25. Following this review,²⁰ the General Court upheld the decision at issue only in relation to a certain number of goods that come within the business activities actually pursued by Forge de Laguiole and in respect of which the General Court had identified a likelihood of confusion between the business name Forge de Laguiole and the trade mark LAGUIOLE. In other respects the General Court upheld the action and annulled the decision at issue in so far as the Board of Appeal had declared that the trade mark LAGUIOLE was also invalid for other goods.²¹

13 — Paragraph 34 of the judgment under appeal; paragraphs 91 to 94 of the decision at issue (Annex 1 to the defence in first instance).

14 — Paragraph 38 of the judgment under appeal.

15 — Paragraph 42 of the judgment under appeal.

16 — Paragraph 43 of the judgment under appeal.

17 — Paragraph 45 of the judgment under appeal.

18 — Paragraphs 51 and 52 of the judgment under appeal.

19 — Paragraphs 53, 73 and 74 of the judgment under appeal.

20 — Paragraphs 161 to 165 of the judgment under appeal.

21 — Paragraph 166 and point 1 of the operative part of the judgment under appeal.

IV – Appeal proceedings and forms of order sought by the parties

26. On 22 December 2014, EUIPO brought this appeal against the judgment of the General Court. On 23 March 2015, Forge de Laguiole submitted its response. EUIPO and Forge de Laguiole ask the Court of Justice to set aside the judgment under appeal and order Mr Szajner to pay the costs.

27. Initial problems with service meant that Mr Szajner was not able to file his response until December 2015. He contends that all of the orders sought and grounds of appeal submitted by EUIPO and by Forge de Laguiole should be declared inadmissible and, in the alternative, that the orders sought and grounds of appeal be declared unfounded, that the appeal should be rejected, that the setting aside of the judgment under appeal be declared unnecessary and that EUIPO be ordered to pay the costs.

28. The appeal was examined before the Court of Justice on the basis of the written documents.

V – Appraisal

A – Admissibility

29. Mr Szajner challenges both the admissibility of the appeal by EUIPO (see below at 1) and also the admissibility of the form of order sought by Forge de Laguiole (see below at 2).

1. Admissibility of the appeal by EUIPO

30. Mr Szajner argues that EUIPO cannot lodge an appeal against a judgment of the General Court, the subject matter of which was a decision by the Board of Appeal, as it has neither *locus standi* nor an interest in bringing proceedings. Furthermore, he says, EUIPO's grounds of appeal are inadmissible, as they altered the subject matter of the dispute between the parties before EUIPO.

31. These objections are unfounded.

32. First, under Article 172 of the Rules of Procedure of the General Court of 4 March 2015,²² an action against a decision by the Board of Appeal of EUIPO, before the General Court, is brought against EUIPO as defendant. Further, under Article 56(2) of the Statute of the Court of Justice, 'any party which has been unsuccessful, in whole or in part, in its submissions' may bring an appeal before the Court of Justice against the decisions of the General Court. In this case EUIPO was unsuccessful in part at first instance, so both its *locus standi* and also its interest in bringing the appeal are indisputable, which is moreover confirmed by the settled practice of the Court of Justice.²³

33. Nor does the fact that EUIPO appears as defendant or appellant in proceedings before the EU Courts involving decisions by its own Board of Appeal infringe the principles of judicial independence, impartiality and neutrality, or those of legitimate expectations and due process. Admittedly, the appeal proceedings before the Boards of Appeal of EUIPO are preliminary to actions brought against EUIPO's decisions before the General Court, and the quasi-judicial features of these proceedings are undisputed. Furthermore, the decisions by the Boards of Appeal of EUIPO are in a sense attributed to it, as it cannot contest them before the General Court and its rights are limited

22 — Formerly Article 133(2) of the Rules of Procedure of the General Court of 2 May 1991.

23 — See, for example, judgments of 21 July 2016, *EUIPO v Grau Ferrer* (C-597/14 P, EU:C:2016:579), and of 11 December 2014, *OHIM v Kessel* (C-31/14 P, not published, EU:C:2014:2436); and the order of 8 May 2014, *OHIM v Sanco* (C-411/13 P, not published, EU:C:2014:315).

vis-à-vis other defendants or the interveners.²⁴ Nevertheless, contrary to Mr Szajner's view, EUIPO is not 'both judge and party' in the proceedings before the EU Courts since, in these proceedings, it is of course not EUIPO but rather the Court of Justice making a decision on the legality of the decisions by the Board of Appeal. Thus the question raised by Mr Szajner as to the Boards of Appeal's status as a court or tribunal in terms of Article 6(1) of the European Convention on Human Rights or Article 47 of the Charter of Fundamental Rights of the European Union can be left aside.

34. Moreover, the belief that EUIPO was actually not defendant in the proceedings at first instance, but intervener, and therefore had to demonstrate its interest in bringing the appeal proceeding, is also ineffective. It is true that the proceedings before the General Court concerned a decision by the Board of Appeal of EUIPO on a dispute between the proprietor of a subsequent trade mark and the proprietor of an earlier sign. Nevertheless, it is clear from the Rules of Procedure of the General Court cited above²⁵ that EUIPO nonetheless assumes the role of the defendant in such proceedings.²⁶

35. Lastly, Mr Szajner submits that EUIPO's grounds of appeal in connection with the *Cœur de princesse* judgment are inadmissible, and that EUIPO altered in this respect the subject matter of the dispute before the General Court as it was delimited in the claims by the parties to the proceedings before EUIPO.

36. However, this objection is unfounded. As EUIPO correctly submits, the interpretation of French law was already the subject matter of the dispute between the parties in the proceedings before the Board of Appeal. This related in particular to the extent of the protection enjoyed by a business name, in respect of which the *Cœur de princesse* judgment was raised before the Court — by Mr Szajner himself for that matter.²⁷ Thus, EUIPO's arguments on the admissibility of that judgment at first instance in no way amounted to expanding the subject matter of the dispute between the parties to the proceedings before EUIPO.

2. Admissibility of the form of order sought by Forge de Laguiole

37. Mr Szajner also challenges the admissibility of the form of order sought by Forge de Laguiole, saying that it is seeking to have the judgment under appeal set aside even though it is not the appellant. He says that, pursuant to Article 174 of the Rules of Procedure of the Court of Justice, the order sought should seek to have the appeal by EUIPO allowed or dismissed, in whole or part. Therefore, he says, Forge de Laguiole's pleadings are in fact a cross-appeal which, under Article 176 of the Rules of Procedure, should have been submitted by a separate document.

38. This purely formalistic argument must be rejected. It is true that, in the order sought at the end of its submissions, Forge de Laguiole is in effect asking not for the appeal by EUIPO to be upheld, but for the judgment under appeal to be set aside. It is nevertheless clear from its response in its entirety that Forge de Laguiole fully supports EUIPO's submissions and grounds of appeal. It is thus clear that it is calling for the appeal to be allowed. Furthermore, it does not submit any separate grounds of appeal and legal arguments, which would be required for a cross-appeal under Article 178(3) of the Rules of Procedure.

3. Interim conclusion

39. Thus both the appeal by EUIPO and the form of order sought by Forge de Laguiole are admissible.

24 — See, in particular, Article 65(4) of Regulation No 207/2009 and the judgment invoked by Mr Szajner of 12 October 2004, *Vedial v OHIM* (C-106/03 P, EU:C:2004:611, paragraph 26 et seq.).

25 — Point 32 of this Opinion.

26 — See also the judgment of 12 October 2004, *Vedial v OHIM* (C-106/03 P, EU:C:2004:611, paragraph 27).

27 — See paragraph 25 of the judgment under appeal.

B – *Substance*

40. As mentioned before, the Board of Appeal based its justification for the extent of the protection for the business name Forge de Laguiole both on the business activities specified in its objects and also on the business activities it actually pursues.²⁸ In the judgment under appeal, the General Court found the first strand of reasoning to be completely incorrect, saying that the protection of a business name in French law covers only the business activities actually pursued. The General Court found the second strand of the reasoning to be partly incorrect because actual pursuit was demonstrated for only some of the business activities included in the objects of Forge de Laguiole.²⁹

41. In the context of its appeal, EUIPO contests the General Court's conclusions both in regard to the protection of the business activities specified in the objects of Forge de Laguiole (see below at 1) and also in regard to the business activities it actually pursues (see below at 2).

1. Protection of the business activities specified in the objects of Forge de Laguiole (first ground of appeal and first part of the second ground of appeal)

42. EUIPO argues that the General Court should not have taken into consideration the *Cœur de princesse* judgment, which was handed down after the decision by the Board of Appeal (first ground of appeal, see below at a)). Furthermore, it says, the Court distorted this judgment (first part of the second ground of appeal, see below at b)).

a) Consideration of the *Cœur de princesse* judgment by the General Court

43. According to EUIPO, the examination that the General Court carries out in relation to the Board of Appeal's application of national law is restricted *ratione temporis*. Thus, it says, in accordance with the judgment in *OHIM v National Lottery Commission*,³⁰ the General Court could indeed rely on national judgments that had already been handed down at the time of the Board of Appeal's decision, but were not taken into consideration by the Board of Appeal. However, widening that possibility to national judgments handed down *after* the decision by the Board of Appeal exceeds the General Court's powers of investigation.

44. Regulation No 207/2009 contains numerous references to national law. This pertains in particular to situations in which, as here, earlier rights conflict with an EU trade mark. In such a case, the protection that an EU trade mark can claim is made conditional on the law of a Member State. The national law concerned thus becomes a rule of law to be applied in implementing Regulation No 207/2009.

45. Thus, Article 65(2) of Regulation No 207/2009, which provides that an action may be brought before the General Court against decisions of the Boards of Appeal of EUIPO in particular on the grounds of 'infringement of ... *this Regulation or of any rule of law relating to [its] application*',³¹ is to be understood as meaning that infringement of a provision of national law, which comes into effect by a reference in Regulation No 207/2009, can be challenged before the General Court.³²

28 — See point 20 of this Opinion.

29 — See point 24 of this Opinion.

30 — Judgment of 27 March 2014, *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2014:186, paragraphs 44 and 46).

31 — Emphasis added.

32 — See, in detail on this, my Opinion in *Edwin v OHIM* (C-263/09 P, EU:C:2011:30, point 61 et seq.).

46. The General Court's review in this respect is, as the Court of Justice has already found, a full review of legality. Thus the General Court is restricted neither to the elements that are submitted by the parties, and nor to those that were taken into consideration by the Board of Appeal. On the contrary, it is able to seek information of its own motion to ascertain the content, the conditions of application and the scope of the rules of national law relied upon.³³

47. Contrary to EUIPO's submission, the General Court's power of review is therefore not limited to verifying whether the Board of Appeal has applied national law correctly. Rather, it is incumbent on the General Court to review whether and to what extent a national legal rule relied upon gives the proprietor of an earlier sign the right to prohibit the use of an EU trade mark.

48. It follows that the General Court, in assessing the protection that is granted by national law, must apply a national legal rule in the way it is interpreted by the national courts at the time of its decision. In doing so, the General Court must also be able to take into consideration a national judgment handed down after the decision by the Board of Appeal, after the parties (as in this case³⁴) had the opportunity to make submissions on that judgment.³⁵

49. This view of the General Court's power of review is confirmed by the fact that it would conflict with ensuring the effectiveness of Regulation No 207/2009 if the General Court had to restrict itself to applying the national law as it was interpreted by the national courts at the time of the decision by the Board of Appeal,³⁶ since this could result in the refusal to register an EU trade mark or its revocation, even though the relevant national law does not provide (or no longer provides) any basis for this. Not only would such a situation fail to do justice to the requirements of effective legal protection, but it should also be rejected on the grounds of procedural economy. It could force the applicant for or proprietor of an EU trade mark to begin a new application procedure with EUIPO, in order to assert its wrongfully rejected rights in the EU trade mark in question.

50. In that context, the present situation should be distinguished from a situation in which a national legal rule, which becomes applicable by way of the reference to national law in Regulation No 207/2009, was amended after the Board of Appeal's decision. It is true that, in the absence of a restriction in that regard, a reference such as in Article 8(4) of Regulation No 207/2009 is a 'dynamic' reference which refers to the version of national law from time to time in force. However, invoking an amendment to a national legal rule in the context of Article 8(4) of Regulation No 207/2009 would give rise to a new factual situation and would no longer be the object of an already existing legal dispute as to the existence of an EU trade mark. In that case new proceedings for a declaration of invalidity of the EU trade mark concerned would have to be brought.

51. To apply, as in the present case, an unchanged national legal rule in the way it is interpreted by the national courts at the time of the decision by the General Court is, in contrast, consistent with the principle that in general (that is, unless specifically provided otherwise by way of exception) the judicial interpretation of a legal rule has retroactive effect. It is restricted to clarifying how such a rule 'must be or ought to have been understood and applied from the time of its entry into force'.³⁷ The question of this legal principle's general validity (disputed by EUIPO) does not need any further clarification in this case as there are no indications that this principle does not apply in the French

33 — Judgments of 5 July 2011, *Edwin v OHIM* (C-263/09 P, EU:C:2011:452, paragraph 52), and of 27 March 2014, *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2014:186, paragraphs 44 and 46).

34 — See paragraph 25 of the judgment under appeal.

35 — See, in regard to this requirement, judgment of 27 March 2014, *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2014:186, paragraphs 55 to 59).

36 — See, in this context, Opinion of Advocate General Bot in *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2013:782, points 91 and 92), and judgment of 27 March 2014, *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2014:186, paragraphs 40 and 44).

37 — This is the wording used by the Court of Justice on the retroactive effect of its interpretation of EU law in the preliminary ruling procedure (see, for example, judgment of 22 September 2016, *Microsoft Mobile Sales International and Others* (C-110/15, EU:C:2016:717, paragraph 59)). See also in this context paragraph 48 of the judgment under appeal.

law relevant here. On the contrary, the information submitted by Mr Szajner testifies to its applicability particularly in regard to the case-law of the French Cour de Cassation (Court of Cassation).³⁸ As the General Court correctly found, the *Cœur de princesse* judgment does not otherwise contain any indication that the Cour de Cassation (Court of Cassation) wished to restrict the temporal scope of the interpretation reached in that decision.³⁹

52. It should be noted in this regard for the sake of completeness that the assessment of the substance of a national judgment, and in particular the question whether it involves a departure from or confirmation of existing case-law, cannot be decisive for whether or not the General Court can take into consideration a national decision that was handed down after the decision by the Board of Appeal.⁴⁰ Thus, whether the *Cœur de princesse* judgment departed from or confirmed existing French case-law can be left aside.

53. It is true that taking into consideration a national judgment that was handed down after the Board of Appeal's decision can result in the General Court's assessing a national legal rule differently from the Board of Appeal on the basis of that judgment alone. Thus it is not inconceivable for the General Court, as EUIPO submits, to annul or amend a decision by the Board of Appeal because of an 'error without fault'. However, precisely because of the General Court's power to investigate, the judicial review of the Board of Appeal's assessment of the national law does not concern 'fault', but rather a comprehensive review of its legality. If it transpires only subsequently that the Board of Appeal's decision is based on an incorrect interpretation of domestic law, then this should not prevent that error being corrected.

54. Nor is this contradicted by the fact that, as EUIPO notes, the General Court must in principle do no more than reach the decision that the Board of Appeal should have made on the basis of the information on which the decision by the Board of Appeal was based.⁴¹ This principle applies to the facts on which the Board of Appeal based its decision and to the subject matter of the dispute, as it was defined before EUIPO. First, however, as a result of the interpretation of a national legal rule that was already raised before the Board of Appeal, the subject matter of the dispute is not altered. Secondly, the national law to be applied in implementing Regulation No 207/2009 does not have the status of a pure fact;⁴² rather, under Article 65(2) of that regulation, it is subject to a full review of legality by the General Court. The General Court therefore has the option, contrary to the principles otherwise applicable in the review system under trade mark law, to determine of its own motion, if necessary, the content of national law and the conditions of its application.⁴³

55. It should be pointed out as a precaution in this regard that this option to investigate the facts of its own motion puts a certain pressure on the General Court to obtain information about national law and its development. However, because of the division of tasks between the EU Courts and the national courts, the interpretation of national law is a matter for the latter, and there are no specific instruments available to the EU Courts by which they may clarify an issue of interpretation of national law.⁴⁴ Therefore the option open to the General Court to obtain information of its own motion about

38 — See paragraphs 25 and 27 and Annexes 5 (p. 1), 5 *bis* (p. 2) and 7 (p. 1) to Mr Szajner's response.

39 — Paragraph 48 of the judgment under appeal.

40 — Thus the line of argument used by the General Court in paragraph 46 of the judgment under appeal (albeit only as an alternative) is not effective.

41 — See in particular the judgment, invoked by EUIPO, of 5 July 2011, *Edwin v OHIM* (C-263/09 P, EU:C:2011:452, paragraphs 71 and 72 and the case-law cited), and also judgment of 26 October 2016, *Westermann Lernspielverlage v EUIPO* (C-482/15 P, EU:C:2016:805, paragraph 27 and the case-law cited).

42 — Judgment of 27 March 2014, *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2014:186, paragraph 37).

43 — See point 46 of this Opinion.

44 — See in detail on this my Opinion in *Edwin v OHIM* (C-263/09 P, EU:C:2011:30, point 49 et seq.).

national law and its development does not in any way release the party relying on that law from providing particulars to establish the interpretation it puts forward.⁴⁵ Thus in appeal proceedings the General Court cannot be criticised for failing to take into consideration a new element on national law that the party relying on it should have brought to its attention.

56. In the light of the above observations, it must be concluded that the General Court did not infringe Article 65(2) of Regulation No 207/2009 by taking the *Cœur de princesse* judgment into consideration. The first ground of appeal should therefore be dismissed.

b) Scope of the *Cœur de princesse* judgment

57. In the context of the first part of its second ground of appeal, EUIPO asserts that the General Court distorted the *Cœur de princesse* judgment and thus infringed Article 8(4) of Regulation No 207/2009. Before I turn to this line of reasoning, I will briefly consider the scope of the examination of national law by the Court of Justice in appeal proceedings.

i) Review of the findings reached by the General Court on national laws in the appeal proceedings

– General preliminary comments

58. As just discussed, the application of national law by the Board of Appeal of EUIPO in the context of Regulation No 207/2009 is subject to an extremely comprehensive review by the General Court. In contrast, the review carried out subsequently by the Court of Justice in appeal proceedings in relation to the application of national law by the General Court is considerably more limited.

59. Unlike Article 65(2) of Regulation No 207/2009, which allows an action at first instance to be brought on the grounds of ‘infringement of ... this Regulation or any rule of law relating to ... [its] application’, Article 58 of the Statute of the Court of Justice limits its powers of review on an appeal to ‘the infringement of Union law by the General Court’. Thus, although the reference to national law in Regulation No 207/2009 affords a ‘legal status’ to that law,⁴⁶ the result of this is only that national law is subject to a full review of legality *before the General Court*. By no means does it hereby become *EU* law, infringement of which can be the subject of a complaint in the appeal proceedings.⁴⁷

60. In line with that, in the *Edwin v OHIM* judgment the Court of Justice found that its examination of the General Court’s application of national law in the context of Regulation No 207/2009 is limited to determining whether the General Court distorted the wording of the national provisions at issue or the national case-law and academic writing concerning them. In addition, the Court of Justice reviews merely whether the General Court reached findings that were manifestly inconsistent with their content and whether, in examining all the particulars, it made a manifest error in assessing their significance in relation to each other.⁴⁸

45 — See in this regard judgment of 5 July 2011, *Edwin v OHIM* (C-263/09 P, EU:C:2011:452, paragraph 50).

46 — Opinion of Advocate General Bot in *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2013:782, point 86).

47 — For more detail on this point, see my Opinion in *Edwin v OHIM* (C-263/09, EU:C:2011:30, point 42 et seq.); on the different position of national law in relation to practice or procedure under EU law, see also Kokott, J., ‘Le droit de l’Union et son champ d’application’, *La Cour de justice de l’Union européenne sous la présidence de Vassilios Skouris*, Bruylant, Brussels, 2015, pp. 349 to 366 (p. 350 ff.).

48 — See judgment of 5 July 2011, *Edwin v OHIM* (C-263/09 P, EU:C:2011:452, paragraph 53); see also order of 29 November 2011, *Tresplaine Investments v OHIM* (C-76/11P, not published, EU:C:2011:790, paragraph 66).

61. Thus the role of the Court of Justice is indeed not limited, as it is with mere facts, to examining a distortion of the evidence taken into consideration by the General Court, but also includes the review of ‘manifest errors of assessment’.⁴⁹ Nevertheless this review is limited to examining whether the General Court has made a *manifest* error in assessing the factors *before it*. Unlike the General Court, the Court of Justice thus does not carry out a comprehensive assessment of national law, but goes no further than reviewing the assessment by the General Court on the basis of the elements criticised by the parties and manifest errors. Nor, therefore, is it a matter for the Court of Justice to determine the content of national law of its own motion.

62. This restriction is justified both by the role of the Court of Justice as appellate court and also by the significance of national law in the context of Regulation No 207/2009. Thus, national law is indeed not only ‘mere fact’ and is comprehensively examined by the General Court. Nevertheless it remains part of the circumstances (albeit legal) of the dispute. These circumstances are to be determined and assessed by EUIPO and the General Court, but are examined by the Court of Justice in the appeal only for manifest errors. This is because the function of the Court of Justice as appellate court is not to guarantee the uniform application of national law, which is a matter for the senior courts of the countries in question. Rather, it is responsible for ensuring that EU law is interpreted and applied in a uniform manner.

63. It is true that there is a certain tension between this restriction on the Court of Justice’s review of national law in the appeal proceedings and the rationale for the General Court’s power of review in this respect. The latter consists of guaranteeing that the question whether and to what extent a national law confers on the proprietor of a sign the right to prohibit the use of a subsequent trade mark is answered *at the time of the General Court’s decision*. However this tension cannot be avoided because of the distinction between the duties of the General Court and those of the Court of Justice and also because of the role of the Court of Justice in the appeal proceedings. Thus the possibility cannot be ruled out that the Court of Justice approves an assessment of the national law by the General Court that no longer corresponds to the country’s legal reality because of an interpretation given in the meantime by national case-law. Should this result in a fundamental change for the protection of a national sign that affects the validity of an EU trade mark, it might be appropriate for an application for revision before the General Court or even to bring new invalidity proceedings before EUIPO.

– Application in the present case

64. It must be observed in this case, in relation to the evidence on French law that was taken into consideration by the General Court, that, in assessing the *Cœur de princesse* judgment, the General Court relied solely on the wording of that judgment.⁵⁰

65. The General Court did indeed also observe that, even before the *Cœur de princesse* judgment, the prior case-law of lower French courts (albeit inconsistent) allowed the conclusion that the protection of the business name was limited to the business activities actually pursued by the company in question.⁵¹ However, the General Court did not base its assessment of the scope of the *Cœur de princesse* judgment on this observation, which was put forward merely as an alternative. It can therefore be left aside whether the General Court satisfied its obligation to provide reasons by referring to ‘numerous previous judgments of French courts produced by the parties before [EUIPO] and the Court’, without citing those judgments.

49 — Opinion of Advocate General Bot in *OHIM v National Lottery Commission* (C-530/12 P, EU:C:2013:782, point 84).

50 — Paragraph 44 of the judgment under appeal.

51 — Paragraph 46 of the judgment under appeal.

66. In the context of this appeal, the Court of Justice's assessment is thus limited to reviewing whether the General Court distorted the wording of the *Cœur de princesse* judgment and made findings that were manifestly inconsistent with the statements in that judgment. As the General Court did not rely on further evidence as to national law, nor can it be accused of distorting or obviously misinterpreting such evidence. Nevertheless the power of review by the Court of Justice can be understood as meaning that what is to be reviewed is whether the *Cœur de princesse* judgment, in combination with the wording of Article L. 711-4(b) of the IPC, is capable of supporting the assessment by the General Court or whether further information on French law were obviously needed for this.

67. In contrast, the comments in French legal literature that were submitted by Mr Szajner in favour of the General Court's interpretation of the *Cœur de princesse* judgment can be used as supporting comments as best. The fact that it has not been proved whether this information was produced to the General Court nor whether it was taken into consideration by the Court can thus be left aside.

ii) Claim that the *Cœur de princesse* judgment has been distorted

68. EUIPO and Forge de Laguiole claim that the General Court distorted the *Cœur de princesse* judgment by finding that the statement, in that judgment, on the limits of the protection conferred on a business name is completely unambiguous and can be applied generally.

69. They say that the *Cœur de princesse* judgment did not concern a definition of the scope of protection for a business name in relation to a trade mark that was applied for by a third party. Rather, the subject matter of that judgment was the issue of fraud in the application to register the trade mark by the company owner himself. Thus, they say, in that case, the company *Cœur de princesse* only registered a trade mark of the same name to damage a third party. Moreover, this registration was carried out for activities that were not pursued by the company *Cœur de princesse* and were not included in its original corporate objects.

70. This is indeed correct and was also accepted by the General Court. Thus the General Court observed in particular that it was not an action under Art. L. 711-4 of the IPC that formed the basis of the *Cœur de princesse* judgment, but rather a claim for annulment of a trade mark on the ground of fraud in filing the application for registration and a claim for unfair competition.

71. Nevertheless, as the General Court also correctly found, there are no indications in the *Cœur de princesse* judgment that the Cour de Cassation (Court of Cassation) wanted to limit the applicability of its statement on the scope of protection for a business name to the particular circumstances underlying that judgment. On the contrary, the Cour de Cassation (Court of Cassation) made the statement in question in the context of rejecting the first ground of appeal, which was based in particular on the alleged infringement of Article L. 711-4(b) of the IPC. Therefore EUIPO's argument that the statement by the Cour de Cassation (Court of Cassation) was not relevant in the context of Article L. 711-4(b) of the IPC is not convincing. Particularly in the context of this provision, it seems logical moreover to focus on the business activities that are actually pursued by the proprietor of a business name, as Article L. 711-4(b) of the IPC makes the possibility of invoking an earlier business name against a subsequent trade mark dependent on there being a likelihood of confusion on the part of the public. Only with difficulty could such a likelihood of confusion be proved for activities that are not pursued.

72. The unsubstantiated objection by Forge de Laguiole that, as the *Cœur de princesse* judgment confirmed the preliminary decision, it could not involve a leading case cannot prevent this conclusion either, because, in this case, it does not need to be established whether the *Cœur de princesse* judgment is a 'leading case'. It is sufficient to note that it is clear from the structure of the response to the first ground of appeal, and also from the stance on the statement regarding the scope of protection for a business name, that the finding here is general and fundamental.

73. Lastly, EUIPO claims that it was in order to examine the second ground of appeal that was also argued before it that the Cour de Cassation (Court of Cassation) took as a basis the business activities actually pursued by the proprietor of a business name. This ground of appeal, it says, concerned the scope of the unfair competition, which assumed an actual competitive situation between the companies involved. This line of reasoning, however, misses the point, as the statement at issue in this case was not made in the course of the Cour de Cassation's (Court of Cassation's) answer to the second ground of appeal, which related to unfair competition. Thus the dispute between the parties as to the need for an actual competitive situation in the area of unfair competition does not require any discussion in this case.

74. In view of these considerations it is not apparent that the General Court distorted the Cœur de princesse judgment or that further evidence as to national law was necessary to confirm the finding in that judgment. Moreover, the opinions in French legal literature that were produced by Mr Szajner confirm the interpretation of the Cœur de princesse judgment by the General Court.⁵²

75. Consequently, the first part of the second ground of appeal must be rejected.

2. Business activities actually pursued by Forge de Laguiole (second part of the second ground of appeal)

76. In the second part of its second ground of appeal, EUIPO, supported by Forge de Laguiole, claims that the General Court did not correctly identify the business activities actually pursued by Forge de Laguiole. It says that the General Court did indeed correctly note that the scope of protection enjoyed by the business name Forge de Laguiole depended on French law alone. However, when it examined the business activities pursued by Forge de Laguiole, the General Court relied only on the nature of the goods concerned and not on their intended use and purpose, as required by French case-law; furthermore, the General Court relied in this regard on its own case-law on genuine use of the EU trade mark, even though the Court of Justice has ruled out analogous application of this case-law for the purposes of Article 8(4) of Regulation No 207/2009.

77. This line of reasoning must be rejected as manifestly unfounded, without further clarification being needed here on the question of the analogous application of the case-law on Article 4(2) and (3) of Regulation No 207/2009 for the purposes of Article 8(4) thereof.⁵³

78. It should be noted at the outset that the General Court, when examining the business activities pursued by Forge de Laguiole, by no means generally applied by analogy its case-law on genuine use of the EU trade mark. The General Court cited its case-law on the concept of the categories or subcategories of goods only in paragraph 63 of the judgment under appeal. This was done in order to explain the observation that the marketing of forks does not prove a business activity in the entire tableware sector, but only a business activity in the area of place settings. The criticisms submitted by EUIPO and Forge de Laguiole are ineffective in respect of this observation.

79. Furthermore, the criticism by EUIPO and Forge de Laguiole is manifestly unfounded in so far as it is based on an inaccurate understanding of the judgment under appeal. It is true that the General Court did not expressly precede its examination of Forge de Laguiole's actual activities by considering the criteria for determining the activities concerned. Thus the General Court cited the French case-law, to which the parties here refer, only in the course of its consideration of the likelihood of confusion.⁵⁴

52 — See in particular Annex 16 to the response by Mr Szajner.

53 — See on this the judgment, invoked by EUIPO, of 29 March 2011, *Anheuser-Busch v Budějovický Budvar* (C-96/09 P, EU:C:2011:189, paragraphs 142 to 146), and the Opinion of Advocate General Cruz Villalón in *Anheuser-Busch v Budějovický Budvar* (C-96/09 P, EU:C:2010:518, points 69 and 70).

54 — See paragraph 81 of the judgment under appeal.

This is, however, insufficient for a finding of a failure to state reasons for the judgment under appeal. For it is manifestly apparent from this judgment that the criteria laid down in the case-law concerned, which the parties agreed was the relevant case-law, was also applied by the General Court in order to determine the activities actually pursued by Forge de Laguiole.

80. Indeed, when examining these activities, the General Court specifically referred not only to the nature of the goods concerned, but also to their intended use, purpose, customers and distribution channels.⁵⁵

81. After the General Court has given due consideration to these various factors, their assessment is a factual analysis. Save where there is some distortion of the facts, which in this case is neither alleged nor apparent, this is not subject to review by the Court of Justice.⁵⁶ EUIPO and Forge de Laguiole may disapprove of the factual findings reached by the General Court on the basis of the nature, intended use and purpose of the goods concerned in relation to the business activities that were pursued by Forge de Laguiole. However, this is not enough to establish that the General Court made an error in law in the judgment under appeal.

82. Consequently the second part of the second ground of appeal cannot be upheld either.

3. Summary

83. As none of the grounds of appeal submitted by EUIPO is successful, the appeal must be dismissed in its entirety.

VI – Costs

84. Under Article 184(2) of the Rules of Procedure of the Court of Justice, the Court is to make a decision as to costs where it dismisses the appeal.

85. It follows from Article 138(1) in conjunction with Article 184(1) of the Rules of Procedure that the unsuccessful party is to be ordered to pay costs if they have been applied for. Since Mr Szajner has made such an application and EUIPO has been unsuccessful, the latter must be ordered to pay the costs.

86. It also follows from Article 184(4) of the Rules of Procedure that an intervener at first instance which has not itself brought the appeal can be ordered to pay its own costs if it has participated in the written or oral part of the proceedings before the Court of Justice. In accordance with this, Forge de Laguiole SARL, which in this instance took part in the written proceedings, should be ordered to pay its own costs.

VII – Conclusion

87. On the basis of the above considerations, I propose that the Court of Justice should:

- (1) dismiss the appeal;
- (2) order EUIPO to bear its own costs and to pay those incurred by Mr Gilbert Szajner;

55 — See paragraphs 61, 62 and 67 to 69 of the judgment under appeal in relation to the business activities actually pursued by Forge de Laguiole. In the context of examining the likelihood of confusion, see, further, paragraphs 85, 99, 101, 104, 106 and 110 of the judgment under appeal.

56 — See, by analogy, orders of 30 January 2014, *Industrias ALEN v The Clorox Company* (C-422/12 P, EU:C:2014:57, paragraph 38), and of 20 January 2015 in *Longevity Health Products v OHIM* (C-311/14 P, not published, EU:C:2015:23, paragraph 39).

(3) order Forge de Laguiole SARL to bear its own costs.