



Reports of Cases

JUDGMENT OF THE COURT (Fifth Chamber)

16 February 2017*

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Article 51(2) — Word mark LAMBRETTA — Genuine use of the mark — Application for revocation — Partial revocation — Communication No 2/12 of the President of EUIPO — Limitation of the temporal effects of a judgment of the Court)

In Case C-577/14 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 10 December 2014,

Brandconcern BV, established in Amsterdam (Netherlands), represented by A. von Mühlendahl and H. Hartwig, Rechtsanwälte, and by G. Casucci, N. Ferretti and C. Galli, avvocati,

appellant,

the other parties to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by J. Crespo Carrillo, acting as Agent,

defendant at first instance,

Scooters India Ltd, established in Lucknow (India), represented by C. Wolfe, Solicitor, and by B. Brandreth and A. Edwards-Stuart, Barristers,

applicant at first instance,

THE COURT (Fifth Chamber),

composed of J.L. da Cruz Vilaça (Rapporteur), President of the Chamber, M. Berger, A. Borg Barthet, E. Levits and F. Biltgen, Judges,

Advocate General: M. Campos Sánchez-Bordona,

Registrar: I. Illéssy, Administrator,

having regard to the written procedure and further to the hearing on 11 May 2016,

after hearing the Opinion of the Advocate General at the sitting on 19 July 2016,

gives the following

* Language of the case: English.

Judgment

- 1 By its appeal, Brandconcern BV seeks to have set aside the judgment of the General Court of the European Union of 30 September 2014, *Scooters India v OHIM — Brandconcern (LAMBRETTA)* (T-51/12, not published, ‘the judgment under appeal’, EU:T:2014:844), by which the General Court annulled the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 1 December 2011 (Case R 2312/2010-1) relating to revocation proceedings between Brandconcern and Scooters India Ltd (‘the contested decision’).

Legal context

- 2 Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009, codified and repealed Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).
- 3 Article 51 of Regulation No 207/2009, which corresponds to Article 50 of Regulation No 40/94, entitled ‘Grounds for revocation’, states:

‘1. The rights of the proprietor of the [EU] trade mark shall be declared to be revoked on application to [EUIPO] or on the basis of a counterclaim in infringement proceedings:

- (a) 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; however, no person may claim that the proprietor’s rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;

...

2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the [European Union] trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.’

- 4 By two communications, one published in 2003 and the other in 2012, the President of EUIPO provided guidance as regards the use of class headings of goods set out in 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 (‘the Nice Agreement’).
- 5 The first paragraph of Point IV of Communication No 4/03 of the President of EUIPO, of 16 June 2003, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (‘Communication No 4/03’), stated:

‘The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class’.

- 6 On 20 June 2012, the President of EUIPO adopted Communication No 2/12, repealing Communication No 4/03 and concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations ('Communication No 2/12'). Point V of that Communication states:

'As regards [EU] trade marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, [EUIPO] considers that the intention of the applicant, in view of the contents of the previous Communication No 4/03, was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made.'

Background to the dispute and the contested decision

- 7 Scooters India is the proprietor of EU trade mark LAMBRETTA, which was applied for on 7 February 2000 and registered by EUIPO on 6 August 2002. The goods in respect of which that mark was registered are included, inter alia, in Class 12 of the Nice Agreement, corresponding to the following description: 'vehicles; apparatus for locomotion by land, air or water'.
- 8 On 19 November 2007, Brandconcern filed an application for partial revocation of the trade mark LAMBRETTA under Article 50(1)(a) and (2) of Regulation No 40/94, now Article 51(1)(a) and (2) of Regulation No 207/2009, for the goods included, inter alia, in Class 12. In that regard, it pleaded lack of genuine use of that mark within a continuous period of five years.
- 9 On 24 September 2010, the Cancellation Division partially revoked the trade mark LAMBRETTA, with effect from 19 November 2007, in respect of the goods included, inter alia, in Class 12. On 23 November 2010, Scooters India filed a notice of appeal with EUIPO against the decision of the Cancellation Division.
- 10 By the contested decision, the First Board of Appeal of EUIPO, inter alia, rejected the appeal as regards the goods in Class 12 of the Nice Agreement. In that decision, the Board of Appeal, as regards the goods in that class, confined its examination of the genuine use of the trade mark LAMBRETTA solely to 'vehicles; apparatus for locomotion by land, air or water' in the literal sense of those terms. After finding that the evidence submitted by Scooters India in support of that genuine use was limited to evidence relating to the sale of spare parts for scooters and did not contain any evidence relating to the sale of 'vehicles; apparatus for locomotion by land, air or water', the Board of Appeal took the view that 'it cannot be inferred from the sale of spare parts that [Scooters India] has also manufactured and sold ... any vehicle'.

The procedure before the General Court and the judgment under appeal

- 11 By application lodged at the Registry of the General Court on 8 February 2012, Scooters India brought an action seeking the annulment of the contested decision, relying on a single plea in law alleging infringement of Article 51(2) of Regulation No 207/2009. That plea consisted of two parts.
- 12 In the context of examining the first part of the single plea in law, the General Court, in paragraphs 35 to 38 of the judgment under appeal, found that the reference to 'vehicles; apparatus for locomotion by land, air or water' in the Community trade mark application had to be interpreted as intended to protect the trade mark LAMBRETTA in respect of all the goods in the alphabetical list in Class 12 of the Nice Agreement. It also took the view that, even if 'spare parts for scooters' did not actually appear in the alphabetical list of goods in Class 12, the Board of Appeal was required to examine whether there had been genuine use of that mark in respect of the many fittings and parts listed therein.

Consequently, finding that the Board of Appeal had not examined the genuine use of that mark for those spare parts for scooters, the General Court upheld the first part of that plea and annulled the contested decision.

- 13 As regards the second part of the single plea in law, the General Court found, in paragraphs 42 to 44 of the judgment under appeal, that, as a result of the annulment of the contested decision as determined in the context of the first part, the Board of Appeal had to consider whether Scooters India had made use of the trade mark LAMBRETTA in respect of spare parts. The General Court took the view that the examination had to be made in accordance with the criteria set out by the Court of Justice in its judgment of 11 March 2003, *Ansul* (C-40/01, EU:C:2003:145, paragraphs 40 to 43).

Forms of order sought by the parties before the Court of Justice

- 14 Brandconcern claims that the Court should:

- set aside the judgment under appeal;
- dismiss the action by Scooters India seeking annulment of the contested decision;
- in the alternative, set aside the judgment under appeal in so far as it annulled the contested decision with regard to the goods ‘vehicles; apparatus for locomotion by land, air or water’ in Class 12 of the Nice Agreement; and
- order EUIPO and Scooters India to bear the costs.

- 15 EUIPO contends that the Court should:

- dismiss the appeal as inadmissible;
- in the alternative, dismiss the appeal as being unfounded; and
- order Brandconcern to pay the costs.

- 16 Scooters India contends that the Court should:

- dismiss the appeal; and
- order Brandconcern to pay the costs.

The appeal

- 17 In support of its appeal, Brandconcern raises two grounds of appeal alleging, respectively, infringement of Article 51(1)(a), read in conjunction with Article 51(2), of Regulation No 207/2009, and a procedural error on the part of the General Court.

The first ground of appeal

Arguments of the parties

- 18 As a preliminary point, Brandconcern submits that Scooters India did not, before the General Court, dispute the finding by the Board of Appeal of EUIPO, in the contested decision, that the trade mark LAMBRETTA had not been used for the goods in respect of which it was registered, namely ‘vehicles; apparatus for locomotion by land, air or water’ in Class 12 of the Nice Agreement. In those circumstances, and for that reason alone, the General Court should have dismissed Scooters India’s action. In any case, Brandconcern argues that the General Court should have declared the action brought by Scooters India inadmissible on the ground that the subject matter of that action was different from that of the appeal brought before the Board of Appeal. The appellant also states that Scooters India had raised the issue of the protection of the trade mark LAMBRETTA with regard to spare parts, as ‘individual components’ of the goods in respect of which the trade mark is registered, only at the stage of the action before the General Court and not before EUIPO.
- 19 Next, Brandconcern submits that, with regard to the rule laid down by the Court of Justice in paragraph 61 of the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361), relating to the word sign ‘IP Translator’, the General Court erred in law in finding that the Board of Appeal of EUIPO had a duty to examine, by virtue of the principle of legal certainty, whether Scooters India had made genuine use of the trade mark LAMBRETTA for goods in respect of which it had not been registered. According to the appellant, the General Court erroneously held that, while Scooters India obtained registration of the trade mark LAMBRETTA for, pursuant to its application, ‘vehicles; apparatus for locomotion by land, air or water’ in Class 12 of the Nice Agreement, Scooters India had to be granted the protection arising from the registration of that trade mark for any of the goods listed on the alphabetical list relating to that class.
- 20 In the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361), the Court of Justice held that, for reasons of clarity and precision, an application for registration must state whether it is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. That application cannot be interpreted as designating all the goods in a particular class without a declaration by the trade mark applicant to that effect. Brandconcern argues that, contrary to what was found in the judgment under appeal, the case-law arising from that judgment should have been applied to the present case, taking account of the principle that a judgment delivered pursuant to Article 267 TFEU produces effects retroactively, notwithstanding the reasoning of legal certainty put forward by the General Court.
- 21 In any event, the requirements of clarity and precision with regard to the scope of registration cannot be met when account is taken of an alleged intention of the applicant of going beyond the literal meaning of the terms used in the registration, if such an intention is not established, as in the present case, in the declaration covering the goods listed in the alphabetical list of a particular class.
- 22 EUIPO and Scooters India submit that this ground of appeal must be rejected as unfounded.

Findings of the Court

- 23 With regard to the argument put forward in the first place by Brandconcern, it is sufficient to note that Scooters India requested, in its application before the General Court, annulment of the contested decision in that it rejected the action brought against the decision of the Cancellation Division of EUIPO revoking the trade mark LAMBRETTA for the goods in Class 12 of the Nice Agreement, including ‘parts and accessories for vehicles and apparatus for locomotion by land’.

- 24 In the same application, Scooters India submitted that those goods were simply a sub-category of 'vehicles; apparatus for locomotion by land, air or water', namely the goods under the heading of Class 12 mentioned in its application for registration, and not different goods. Therefore, Brandconcern cannot validly claim that Scooters India did not contest, before the General Court, the finding of the Board of Appeal of EUIPO, in the contested decision, that the trade mark LAMBRETTA had not been used for the goods in respect of which it was registered.
- 25 In those circumstances, that argument must be rejected as unfounded.
- 26 Brandconcern also complains that the General Court erred in law in so far as it limited the temporal effects of the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361). According to Brandconcern, that judgment is applicable in the present case in so far as it requires applications for registration of an EU trade mark, including those made before the delivery of that judgment, to be interpreted to the effect that only the goods expressly included in such applications are covered by the protection afforded by the EU trade mark.
- 27 In that regard, it must be borne in mind that although, in paragraphs 21 to 24 of the judgment under appeal, the General Court examined the issue of the impact of the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361), and, in particular, paragraph 61 of that judgment, on the interpretation of the application for registration of the trade mark LAMBRETTA, it also found that the Court of Justice had not limited the temporal effects of that judgment.
- 28 In paragraph 61 of the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361), the Court of Justice thus took the view that, in order to respect the requirements of clarity and precision imposed by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), the applicant for a national trade mark who uses all of the general indications listed in the heading of a particular class of the Nice Agreement in order to identify the goods and services for which the protection of the trade mark is sought must specify whether the application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application relates to only some of those goods or services, the applicant will be required to specify which of the goods or services in that class are intended to be covered.
- 29 However, it is important to bear in mind, in the first place, that paragraph 61 of that judgment does not concern the proprietors of trade marks which have already been registered, but solely applicants for trade marks.
- 30 In the second place, in paragraph 61 of that judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361), the Court of Justice limited itself to specifying the requirements to which new applicants for national trade marks remain subject, who use the general indications of a class in order to identify the goods and services for which protection as a trade mark is sought. Such requirements, as the Advocate General stated in point 64 of his Opinion, help to prevent the situation in which it is not possible to determine with certainty the scope of the protection afforded by a trade mark when a trade mark applicant uses all the indications included in the heading of a class.
- 31 It cannot, therefore, be held that the Court of Justice, by the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361), sought to question the validity of the approach set out in Communication No 4/03 as regards trade marks registered before the delivery of that judgment. Consequently, the rule set out in paragraph 61 of that judgment is not applicable to the registration of the trade mark LAMBRETTA, which took place before the delivery of that judgment.

- 32 Consequently, by finding, in paragraph 35 of the judgment under appeal, that, according to the approach set out in Point V of Communication No 2/12, it was appropriate for the words ‘vehicles; apparatus for locomotion by land, air or water’, corresponding to the goods mentioned under the heading of Class 12 of the Nice Agreement, featuring in the application for the trade mark LAMBRETTA, to be interpreted as seeking to protect that trade mark for all the goods in the alphabetical list of Class 12, the General Court did not commit an error in law capable of justifying setting aside the judgment under appeal.
- 33 Moreover, the interpretation of the contested application for registration adopted by the General Court is substantiated by the amendment introduced to Article 28(8) of Regulation No 207/2009 by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21). The latter regulation inserted a transitional provision into that article, allowing the proprietors of EU trade marks applied for before 22 June 2012 and registered in respect of the entire heading of a class of the Nice Classification to declare, before 24 September 2016, that their intention, at the date when the application was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of the heading but included in the alphabetical list for that class.
- 34 In those circumstances, the first ground of appeal must be rejected as unfounded.

The second ground of appeal

Arguments of the parties

- 35 By its second ground of appeal, raised in the alternative, Brandconcern argues that the judgment under appeal is vitiated by failure to state reasons, in that the General Court annulled the contested decision, whereas it found that Scooters India had not used the trade mark LAMBRETTA for the goods in respect of which it was registered, namely, ‘vehicles; apparatus for locomotion by land, air or water’ under the heading of Class 12 of the Nice Agreement. In particular, there was a contradiction between, on the one hand, the reasons for that judgment examining the issue of the use of that trade mark for merely spare parts for scooters alone and, on the other hand, the operative part of that judgment annulling the contested decision as regards also the goods under the heading of Class 12 as well.
- 36 EUIPO submits that the second ground of appeal is inadmissible or, in any case, unfounded. For Scooters India, that ground of appeal must be rejected as unfounded.

Findings of the Court

- 37 The case-law of the Court of Justice clearly states that an appeal must indicate precisely the contested elements of the judgment which the appellant seeks to have set aside, and also the legal arguments specifically advanced in support of the appeal. The Court has also made it clear that a mere abstract statement of the grounds in the appeal does not satisfy the requirements set out in Article 58 of the Statute of the Court of Justice of the European Union and in Article 168(1)(d) of the Rules of Procedure of the Court of Justice. Furthermore, Article 169(2) of the Rules of Procedure specifies that the grounds of appeal and legal arguments relied on must identify precisely those points in the grounds of the decision of the General Court which are contested. An appeal that does not have such characteristics cannot be the subject of a legal assessment which would allow the Court of Justice to exercise its function and to carry out its review of legality (judgment of 7 November 2013, *Wam Industriale v Commission*, C-560/12 P, not published, EU:C:2013:726, paragraphs 42 to 44).

- 38 In the present case, Brandconcern did not state, in its appeal, what the points of the judgment under appeal are in which the General Court ruled that Scooters India had not used the trade mark LAMBRETTA for the goods for which it was registered. Moreover, whilst it is true that Brandconcern, in its reply, refers to paragraphs 14, 16 and 17 of the judgment under appeal, it is not apparent from those paragraphs that the General Court took the view that Scooters India had not used the trade mark LAMBRETTA for the goods for which it was registered.
- 39 Contrary to Brandconcern's assertions, the judgment under appeal concerns the issue relating to the interpretation of an application for registration and it makes no comment of any kind on the genuine use of the trade mark at issue for any of the goods in Class 12 of the Nice Agreement whatsoever.
- 40 In those circumstances, the second ground of appeal must be rejected as unfounded.
- 41 Since none of the grounds of appeal raised by Brandconcern has been upheld, the appeal must be dismissed in its entirety.

Costs

- 42 In accordance with Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is unfounded, the Court is to make a decision as to the costs. Under Article 138(1) of those rules, which apply to the procedure on appeal by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.
- 43 Since EUIPO and Scooters India have applied for costs and Brandconcern has been unsuccessful, the latter must be ordered to pay the costs.

On those grounds, the Court (Fifth Chamber) hereby

1. Dismisses the appeal;

2. Orders Brandconcern BV to pay the costs.

Da Cruz Vilaça
Levits

Berger

Borg Barthet
Biltgen

Delivered in open court in Luxembourg on 16 February 2017.

A. Calot Escobar
Registrar

J.L. da Cruz Vilaça
President of the Fifth Chamber