



Reports of Cases

JUDGMENT OF THE COURT (Fifth Chamber)

22 June 2016*

(Appeal — European Union trade mark — Figurative mark including the element ‘CVTC’ — Requests for renewal made in respect of some of the goods or services for which the mark is registered — Further period — Regulation (EC) No 207/2009 — Article 47 — Principle of legal certainty)

In Case C-207/15 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 4 May 2015,

Nissan Jidosha KK, established in Yokohama (Japan), represented by B. Brandreth, Barrister, and D. Cañadas Arcas, abogada,

appellant,

the other party to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by D. Hanf and A. Folliard-Monguiral, acting as Agents,

defendant at first instance,

THE COURT (Fifth Chamber),

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

Advocate General: M. Campos Sánchez-Bordona,

Registrar: A. Calot Escobar,

after hearing the Opinion of the Advocate General at the sitting on 17 March 2016,

gives the following

Judgment

- 1 By its appeal, Nissan Jidosha KK (‘Nissan’) seeks to have set aside the judgment of the General Court of the European Union of 4 March 2015 in *Nissan Jidosha v OHIM (CVTC)* (T-572/12, not published, ‘the judgment under appeal, ‘EU:T:2015:136), by which the General Court dismissed its action for

* Language of the case: English.

annulment of the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 6 September 2012 (Case R 2469/2011-1), relating to a request for renewal of the registration of the EU figurative mark CVTC ('the decision at issue').

Legal context

Regulation (EC) No 207/2009

- 2 Article 46 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as applicable in the present case, is entitled 'Duration of registration' and provides:

'EU trade marks shall be registered for a period of 10 years from the date of filing of the application. Registration may be renewed in accordance with Article 47 for further periods of 10 years.'

- 3 Article 47 of that regulation, entitled 'Renewal', provides:

'1. Registration of the EU trade mark shall be renewed at the request of the proprietor of the trade mark or any person expressly authorised by him, provided that the fees have been paid.

2. The Office shall inform the proprietor of the EU trade mark, and any person having a registered right in respect of the EU trade mark, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office.

3. The request for renewal shall be submitted within a period of six months ending on the last day of the month in which protection ends. The fees shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the day referred to in the first sentence, provided that an additional fee is paid within this further period.

4. Where the request is submitted or the fees paid in respect of only some of the goods or services for which the EU trade mark is registered, registration shall be renewed for those goods or services only.

5. Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be registered.'

- 4 Article 48 of the regulation, entitled 'Alteration', is worded as follows:

'1. The EU trade mark shall not be altered in the Register during the period of registration or on renewal thereof.

...'

- 5 Article 50 of Regulation No 207/2009, entitled 'Surrender', provides:

'1. An EU trade mark may be surrendered in respect of some or all of the goods or services for which it is registered.

2. The surrender shall be declared to the Office in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register.

...'

6 Article 81 of that regulation, entitled ‘Restitutio in integrum’, provides:

‘1. The applicant for or proprietor of an EU trade mark or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to comply with a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the obstacle to compliance has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any right or means of redress.

2. The application must be filed in writing within two months from the removal of the obstacle to compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided in Article 47(3), third sentence, shall be deducted from the period of one year.

...’

Regulation (EC) No 2868/95

7 Rule 30 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 355/2009 of 31 March 2009 (OJ 2009 L 109, p. 3), entitled ‘Renewal of registration’, provides:

‘(1) An application for renewal shall contain:

...

(c) if the renewal is requested for only part of the goods and services for which the mark is registered, an indication of those classes or those goods and services for which renewal is requested or those classes or those goods and services for which renewal is not requested, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs and presented in the order of the classes of that classification.

(2) The fees payable under Article 47 of the Regulation for the renewal of an EU trade mark shall consist of the following:

(a) a basic fee;

(b) a class fee for each class exceeding three in respect of which renewal is applied for; and

(c) where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 47(3) of the Regulation, as specified in the Fees Regulation.

...

(5) Where an application for renewal is not submitted or is submitted after expiry of the period provided for in the third sentence of Article 47(3) of the Regulation, or where the fees are not paid or are paid only after the period in question has expired, or where the deficiencies are not remedied within that period, the Office shall determine that the registration has expired and shall so notify the proprietor of the EU trade mark.

...'

Background to the dispute and the decision at issue

- 8 As is apparent from paragraphs 1 to 13 of the judgment under appeal, on 23 April 2001, Nissan filed an application for registration of an EU trade mark at EUIPO. The mark in respect of which registration was sought is the following figurative sign:



- 9 The goods in respect of which registration was sought are in Classes 7, 9 and 12 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.
- 10 The mark at issue was registered on 29 October 2003 in respect of goods in those three classes.
- 11 On 27 September 2010, EUIPO informed Nissan that that mark was due for renewal before 23 April 2011.
- 12 On 27 January 2011, Nissan requested EUIPO to renew that mark in respect of some of the goods covered by the registration, namely those in Classes 7 and 12.
- 13 On 9 May 2011, EUIPO informed Nissan that the renewal of the mark at issue in respect of the goods in Classes 7 and 12 had been recorded in the Register of EU trade marks on 8 May 2011 and that the registration in respect of the Class 9 goods had been removed from the register.
- 14 On 14 July, 22 July and 1 August 2011, Nissan asked EUIPO to include the Class 9 goods in the renewal of that mark.
- 15 By a decision of 26 August 2011, EUIPO refused Nissan's request.
- 16 On 29 August 2011, Nissan asked EUIPO to annul that decision.
- 17 By a decision of 28 September 2011, the Administration of Trade Marks Division confirmed the decision of 26 August 2011.
- 18 On 25 November 2011, Nissan filed an appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009, against that decision of the Administration of Trade Marks Division.
- 19 By the decision at issue, the First Board of Appeal of EUIPO dismissed that appeal. The Board of Appeal found, in essence, that the request for renewal of the mark at issue in respect of the goods in Classes 7 and 12 constituted a surrender of that mark, for the purposes of Article 50 of Regulation No 207/2009, as regards the goods in Class 9. Furthermore, noting that the partial renewal of that mark had been registered by EUIPO and notified to Nissan, upon which it had been effective *erga omnes*, the Board of Appeal found that, for reasons of legal certainty, Nissan could not be allowed to reverse its decision not to renew the mark at issue in respect of certain goods.

The procedure before the General Court and the judgment under appeal

- 20 By application lodged at the General Court Registry on 21 December 2012, Nissan sought annulment of the decision at issue.
- 21 In support of its action, Nissan raised a single plea in law, alleging, in essence, infringement of Articles 47 and 50 of Regulation No 207/2009.
- 22 The General Court found, in paragraphs 26 to 30 of the judgment under appeal, that EUIPO had erred in treating Nissan's request for partial renewal as equivalent to a surrender of the mark, for the purposes of Article 50 of Regulation No 207/2009, in respect of the Class 9 goods.
- 23 The General Court nevertheless ruled, in paragraphs 34 to 50 of the judgment under appeal, that that finding could not, in the circumstances of the case, result in the annulment of the decision at issue, EUIPO being justified, under Article 47 of Regulation No 207/2009, in renewing the mark at issue only in respect of the goods in Classes 7 and 12.
- 24 The General Court therefore rejected the single plea in law raised by Nissan and, in consequence, dismissed the action in its entirety.

Forms of order sought

- 25 Nissan claims that the Court of Justice should set aside the judgment under appeal, annul the decision at issue and order EUIPO to pay the costs.
- 26 EUIPO contends that the Court should dismiss the appeal and order Nissan to pay the costs.

The appeal

- 27 Nissan puts forward two grounds of appeal in support of its appeal, alleging infringement of Article 47 and of Article 48 of Regulation No 207/2009 respectively.

Arguments of the parties

- 28 By its first ground of appeal, Nissan complains that the General Court held that Article 47 of Regulation No 207/2009 does not permit successive requests for partial renewal of an EU trade mark. Nissan maintains that there is nothing in the wording of that article to preclude such requests, for which there may, moreover, be legitimate reasons. According to Nissan, Article 47 generally permits the renewal of such a mark before the expiry of the further period provided for in the third sentence of Article 47(3) of Regulation No 207/2009 ('the further period').
- 29 In that regard, Nissan notes, in the first place, that the effect of the General Court's interpretation is, on the one hand, to deprive proprietors of EU trade marks who attempt to comply with the initial time limit laid down in the first sentence of Article 47(3) of Regulation No 207/2009 of the benefit of the further period, and, on the other, to favour those who are capable of paying the additional fee which renewal during the further period entails.
- 30 In the second place, Nissan submits that the General Court's position is actually tantamount to treating a request for partial renewal as equivalent to a surrender, for the purposes of Article 50 of Regulation No 207/2009, in respect of goods not covered by that request, even if the requirements of that article have not been fulfilled.

- 31 In the third place, Nissan maintains that the clear and unequivocal submission by proprietors of EU trade marks of requests for partial renewal does not mean that those proprietors expect subsequent requests for renewal made within the further period to be refused, since EUIPO has already, on at least two previous occasions, accepted successive requests for partial renewal in those circumstances.
- 32 In the fourth place, Nissan notes that Rule 30(5) of Regulation No 2868/95, as amended by Regulation No 355/2009, permits the partial renewal of an EU trade mark throughout the further period, in return for the sequential payment of fees relating to the various goods concerned. In its submission, there is no reason for making any distinction between that situation and renewal of that mark in the form of successive requests for partial renewal.
- 33 In the fifth place, Nissan submits that the principle of legal certainty does not preclude a request for renewal of an EU trade mark from being supplemented during the further period. In its submission, legal certainty for third parties is undermined only if EUIPO wrongly treats a request for partial renewal as a surrender and registers its decision on the request for partial renewal before the expiry of the further period.
- 34 EUIPO counters that the General Court interpreted and applied Article 47 of Regulation No 207/2009 correctly.
- 35 In support of its position, EUIPO contends that it is clear from the wording of the first and second sentences of Article 47(3) of Regulation No 207/2009 that the requisite conditions for the renewal of an EU trade mark must be fulfilled, in principle, within the initial six-month period prior to expiry of the period of protection. Thus, it argues that the belated renewal of that mark during the further period is of an exceptional character, as is borne out both by the fact that the EU legislature made that renewal conditional upon the payment of an additional fee and by its implications for the European trade mark system.
- 36 EUIPO contends in that context that, in accordance with Article 47(5) of Regulation No 207/2009, EU trade marks are renewed with retroactive effect, renewal taking effect upon expiry of the registration. Consequently, the register of EU trade marks does not always faithfully reflect the degree of protection conferred on a mark, economic operators thus being unable to assess with certainty the existence and scope of registered exclusive rights. Given that the possibility of renewing an EU trade mark during the further period creates a considerable degree of legal uncertainty, the third sentence of Article 47(3) of that regulation should be interpreted strictly.
- 37 In addition, EUIPO contends that where a ‘complete’ renewal request that satisfies the two cumulative conditions set out in Article 47(1) of Regulation No 207/2009 is submitted within the initial period mentioned above, even if that request relates to only some of the goods in respect of which the EU trade mark is registered, the third sentence of Article 47(3) of that regulation cannot be applied, as it is introduced by the words, ‘failing this’.
- 38 Furthermore, according to EUIPO, in the light of Article 47(4) of Regulation No 207/2009, where the proprietors of EU trade marks file such a request for partial renewal, they are implicitly declaring that they do not wish to extend the protection conferred by their trade mark to the remaining goods. EUIPO notes in that respect that that interpretation does not amount to treating a request for partial renewal as a surrender for the purposes of Article 50 of that regulation, in so far as that surrender takes effect upon the declaration of surrender and subsequent registration.
- 39 EUIPO further submits that, in so far as a request for partial renewal is not deficient, there is no requirement that EUIPO await the end of the further period to register and publish a request for renewal of the EU trade mark filed in good time in respect of certain goods only. On the contrary, according to Article 47(5) of Regulation No 207/2009, it is obliged to do so.

40 EUIPO also emphasises the fact that the registration of the partial renewal and, in particular, the expiry of the registration of the EU trade mark in respect of goods whose renewal has not been requested produces effects *erga omnes*. While, according to EUIPO, the third sentence of Article 47(3) of Regulation No 207/2009 is such that the competent authorities and the public must be aware that such a mark can be renewed during the further period, they cannot anticipate that an EU trade mark which has been validly renewed in part only will subsequently be extended to other goods.

Findings of the Court

41 It is necessary to determine, in the first place, whether, as the General Court held, Article 47(3) of Regulation No 207/2009 precludes a request for renewal relating to certain classes of goods or services in respect of which an EU trade mark has been registered from being submitted during the further period laid down in the third sentence of that provision when a request for renewal concerning other classes of goods or services covered by the same mark has been submitted previously, within the period laid down in the first sentence of that provision.

42 On that point, it must be noted that, in paragraph 38 of the judgment under appeal, the General Court considered that ‘... it is clear from the wording of [the third sentence of Article 47(3) of Regulation No 207/2009] and, more specifically, from the expression “failing”, that the possibility of submitting a request for renewal after the expiry of the initial period is conditional on no request for renewal having been submitted during that period’, and that, ‘accordingly, the request for renewal must, as a general rule, be submitted during the initial period and it is only by way of exception, where no request has been submitted during the initial period, that the proprietor of a mark or any person expressly authorised by him may submit such a request during the grace period, in return for the payment of a surcharge ...’.

43 It must be pointed out that, in accordance with settled case-law, the wording used in one language version of a provision of EU law cannot serve as the sole basis for the interpretation of that provision, or be made to override the other language versions. Provisions of EU law must be interpreted and applied uniformly in the light of the versions existing in all EU languages. Where there is a divergence between the various language versions of an EU legislative text, the provision in question must be interpreted by reference to the general scheme and the purpose of the rules of which it forms part (see judgment of 9 April 2014 in *GSV*, C-74/13, EU:C:2014:243, paragraph 27 and the case-law cited).

44 It must be noted in that regard that, according to Article 47(3) of Regulation No 207/2009, in the French-language version examined by the General Court in the judgment under appeal, ‘la demande de renouvellement est à présenter dans un délai de six mois expirant le dernier jour du mois au cours duquel la période de protection prend fin. Les taxes doivent également être acquittées dans ce délai. À défaut, la demande peut encore être présentée et les taxes acquittées dans un délai supplémentaire de six mois prenant cours le lendemain du jour visé dans la première phrase, sous réserve du paiement d’une surtaxe au cours dudit délai supplémentaire.’

45 However, it must be noted that certain language versions of the third sentence of Article 47(3) of Regulation No 207/2009 differ from the text set out in the preceding paragraph in that they do not use words corresponding to ‘à défaut’ (‘failing this’), which the General Court took into account in paragraph 38 of the judgment under appeal, or any other similar words.

46 For example, the German-language version reads: ‘der Antrag und die Gebühren können noch innerhalb einer Nachfrist von sechs Monaten nach Ablauf des in Satz 1 genannten Tages eingereicht oder gezahlt werden, sofern innerhalb dieser Nachfrist eine Zuschlagsgebühr entrichtet wird’; the Dutch-language version reads: ‘de indiening van de aanvraag en de voldoening van de taksen kunnen nog binnen een extra termijn van zes maanden na het verstrijken van de in de eerste zin genoemde termijn geschieden, tegen betaling van een toeslag binnen deze extra termijn’; the

Portuguese-language version reads: ‘o pedido pode ainda ser apresentado e as taxas pagas num prazo suplementar de seis meses, a contar do dia seguinte ao referido na primeira frase, sob reserva do pagamento de uma sobretaxa no decurso desse prazo suplementar’; and the Finnish-language version reads: ‘hakemus voidaan kuitenkin vielä esittää ja maksut suorittaa kuuden kuukauden lisämääräajan kuluessa, joka alkaa ensimmäisessä virkkeessä tarkoitettun päivän jälkeisenä päivänä, jos mainitun määräraajan kuluessa suoritetaan lisämaksu’.

- 47 In any event, it cannot be clearly and unequivocally inferred from the use of the expression ‘à défaut’ in the French-language version of that provision that a request for renewal of an EU trade mark may be submitted only exceptionally during the further period, if no other request to that effect has previously been submitted.
- 48 On the contrary, the wording of the third sentence of Article 47(3) of Regulation No 207/2009 in all the language versions set out in the preceding paragraphs suggests that the EU legislature made the submission of a request for renewal of an EU trade mark during the further period conditional only upon the payment of an additional fee, which, as the Advocate General noted in point 56 of his Opinion, constitutes the only factor enabling a request for renewal lodged in those circumstances to be distinguished from a request submitted within the initial six-month period.
- 49 Furthermore, contrary to what was suggested by the General Court in paragraph 39 of the judgment under appeal and to EUIPO’s contention, the broad logic of Article 47(3) of Regulation No 207/2009 is not such as to call that interpretation into question.
- 50 It should be noted in that regard that, in particular, according to Article 47(4) of that regulation, where the request for renewal is submitted in respect of only some of the goods or services for which the EU trade mark is registered, registration is to be renewed for those goods or services only, while Article 47(5) of that regulation provides that renewal is to take effect from the day following the date on which the existing registration of the trade mark at issue expires, and that the renewal is to be registered.
- 51 It must be held that it is not apparent from those provisions that the submission, during the periods referred to in Article 47(3) of Regulation No 207/2009, of requests for renewal of an EU trade mark, staggered over time and relating to different classes of goods or services, is prohibited.
- 52 Furthermore, the objectives pursued by Regulation No 207/2009 support the interpretation that such requests for renewal should be accepted, provided that they are lodged before the further period expires.
- 53 It must be observed in that respect, as the Advocate General noted in point 65 of his Opinion, that, by providing for the possibility of continuously requesting renewal of the registration of an EU trade mark for periods of 10 years and, in that context, laying down two consecutive periods within which that renewal may be requested pursuant to Articles 46 and 47 of Regulation No 207/2009, that regulation aims, in view of the economic importance of the protection conferred by EU trade marks, to facilitate the retention by the proprietors of those trade marks of their exclusive rights.
- 54 It must be noted in that regard that, as is apparent from the Communication from the Commission to the European Parliament, the Council, the European Economic and Social Committee and the Committee of the Regions of 24 May 2011, entitled ‘A Single Market for Intellectual Property Rights — Boosting creativity and innovation to provide economic growth, high quality jobs and first class products and services in Europe’ (COM(2011) 287 final) (p. 5), the protection of brand equity stimulates investment in the quality of products and services, particularly in sectors which rely heavily on brands and customers’ brand loyalty.

- 55 The pursuit of that aim in the context of Regulation No 207/2009 is also confirmed by the fact that, according to Article 47(2) of that regulation, EUIPO must, in good time, inform the proprietor of the EU trade mark, and any person having a registered right in respect of that trade mark, of the expiry of the registration. Moreover, under Article 81 of that regulation, the proprietor of an EU trade mark who, in spite of all due care required by the circumstances having been taken, was unable to comply with a time limit vis-à-vis EUIPO may have his rights re-established, provided that he submits a request within a maximum of one year from expiry of the unobserved time limit.
- 56 It is necessary to examine, in the second place, whether reasons of legal certainty, linked to the *erga omnes* effect of registering a request for partial renewal of an EU trade mark from the day following the date on which the existing registration of that mark expires, preclude the successive requests for renewal at issue in the present case, as the General Court held in paragraphs 40 and 41 of the judgment under appeal and as EUIPO maintains.
- 57 It is sufficient to note in that respect that the objection thus raised is based on the false premiss that it follows from Article 47(4) and (5) of Regulation No 207/2009 not only that EUIPO is under an obligation to register a request for partial renewal prior to the expiry of the further period but also that it is impossible for EUIPO to envisage, when registering such a request, information measures that would enable both the rights of proprietors of EU trade marks and the rights of third parties to be safeguarded, instead of the removal of certain classes of goods or services from the register.
- 58 It follows from all the foregoing considerations that the General Court erred in law in determining that Article 47(3) of Regulation No 207/2009 and the principle of legal certainty preclude the submission, during the further period, of a request for renewal relating to certain classes of goods or services in respect of which an EU trade mark is registered, when a request for renewal concerning other classes of goods or services covered by the same mark has been submitted previously, within the period laid down in the first sentence of that provision.
- 59 Accordingly the first ground of appeal must be upheld and, without there being any need to examine the second ground of appeal, alleging infringement of Article 48 of Regulation No 207/2009, the judgment under appeal must be set aside.

The action before the General Court

- 60 In accordance with the first paragraph of Article 61 of the Statute of the Court of Justice of the European Union, the Court, where the decision of the General Court is quashed, may itself give final judgment in the matter, where the state of the proceedings so permits. That is the case here.
- 61 In that regard, it follows from paragraphs 41 to 58 of the present judgment and from paragraphs 26 to 30 of the judgment under appeal that the single plea in law relied on by Nissan in support of its application at first instance, alleging, in essence, infringement of Articles 47 and 50 of Regulation No 207/2009, is well founded, and that, in consequence, the decision at issue must be annulled.

Costs

- 62 Under Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court itself gives final judgment in the case, the Court is to make a decision as to the costs.
- 63 Under Article 138(1) of those rules, applicable to appeal proceedings 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.

⁶⁴ Since Nissan has applied for costs and EUIPO has been unsuccessful, the latter must be ordered to pay the costs both of the proceedings at first instance in Case T-572/12 and of the appeal.

On those grounds, the Court (Fifth Chamber) hereby:

- 1. Sets aside the judgment of the General Court of the European Union of 4 March 2015 in *Nissan Jidosha v OHIM (CVTC)* (T-572/12, not published, EU:T:2015:136);**
- 2. Annuls the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 6 September 2012 (Case R 2469/2011-1), relating to a request for renewal of the registration of the European Union figurative mark CVTC;**
- 3. Orders the European Union Intellectual Property Office to bear its own costs and to pay those incurred by Nissan Jidosha KK both in relation to the proceedings at first instance in Case T-572/12 and to the appeal.**

[Signatures]