



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

13 September 2016*

(EU trade mark — Revocation proceedings — EU figurative mark representing a polygon — Genuine use of a mark — Second subparagraph of Article 15(1)(a) and Article 51(1)(a) of Regulation (EC) No 207/2009 — Form differing in components which do not alter the distinctive character of the mark)

In Case T-146/15,

hyphen GmbH, established in Munich (Germany), represented by M. Gail and M. Hoffmann, lawyers,
applicant,

v

European Union Intellectual Property Office (EUIPO), represented by M. Fischer, acting as Agent,
defendant,

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

Skylotec GmbH, established in Neuwied (Germany), represented by M. De Zorti and M. Helfrich, lawyers,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 9 March 2015 (Case R 1506/2014-4), concerning revocation proceedings between Skylotec and hyphen,

THE GENERAL COURT (Second Chamber),

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

Registrar: A. Lamote, Administrator,

having regard to the application lodged at the Registry of the General Court on 23 March 2015,

having regard to the response of EUIPO lodged at the Court Registry on 1 July 2015,

having regard to the response of the intervener lodged at the Registry of the Court on 3 July 2015,

further to the hearing on 17 March 2016,

* Language of the case: German.

gives the following

Judgment

Background to the dispute

- 1 On 11 June 2001, the company that succeeded the applicant, hyphen GmbH, filed an application for registration of a European Union trade mark at the European Union Intellectual Property Office (EUIPO), under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).
- 2 Registration as a mark was sought for the following figurative sign in black and white:



- 3 The goods and services in respect of which registration was sought are in Classes 3, 5, 9, 24, 25 and 42 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those Classes, to the following description:
 - Class 3: ‘Soaps; perfumery, essential oils, cosmetics’;
 - Class 5: ‘Pharmaceutical, veterinary and sanitary preparations’;
 - Class 9: ‘Airtight clothing affording protection against accidents, radiation and fire, anti-glare devices, anti-glare visors, glasses (optical devices), cases for glasses and contact lenses, frames for glasses, frames for glasses, lenses for glasses, optical contact lenses, timekeeping instruments’;
 - Class 24: ‘Textile and textile goods (included in Class 24)’;
 - Class 25: ‘Clothing, footwear, headgear’;
 - Class 42: ‘Development and design of all types of textile products, in particular clothing, headgear, accessories, footwear and bags, graphic arts services, industrial design services, development of products for protection against solar radiation’.
- 4 The mark was registered on 12 September 2002 under number 2255537 and has been renewed since then.
- 5 On 17 October 2012, the intervener, Skylotec GmbH, filed an application for revocation pursuant to Article 51(1)(a) of Regulation No 207/2009 in respect of the registered mark, alleging a lack of genuine use of that mark over a continuous period of five years.

- 6 By decision of 28 April 2014, the Cancellation Division dismissed the application for revocation for the following goods and services:
 - Class 9: ‘Airtight clothing’;
 - Class 24: ‘Textiles (included in Class 24)’;
 - Class 25: ‘Clothing, footwear, headgear’;
 - Class 42: ‘Development and design of all types of textile products, in particular clothing, headgear, accessories, footwear and bags, development of products for protection against solar radiation’.
- 7 The Cancellation Division did, however, allow the application for the following goods and services, which are not the subject of the present action:
 - Class 3: ‘Soaps; perfumery, essential oils, cosmetics’;
 - Class 5: ‘Pharmaceutical, veterinary and sanitary preparations’;
 - Class 9: ‘Airtight clothing affording protection against accidents, radiation and fire, anti-glare devices, anti-glare visors, glasses (optical devices), cases for glasses and contact lenses, frames for glasses, frames for glasses, lenses for glasses, optical contact lenses, timekeeping instruments’;
 - Class 24: ‘Textiles (included in Class 24)’;
 - Class 42: ‘Graphic arts services, industrial design services’.
- 8 The Cancellation Division observed, in respect of the goods and services for which the application for revocation had been dismissed, that although the signs used showed differences in the form for which the mark had been registered, those differences did not alter the distinctive character of the registered mark, since the difference pertained only to a banal decorative component in the form of an ellipsis lacking any distinctive character of its own.
- 9 The signs used were presented in the following shapes (‘sign No 1’, ‘sign No 2’ and ‘sign No 3’ respectively), the only difference between sign No 1 and sign No 2 being in the use of the sky blue colour instead of black:





- 10 On 13 June 2014, the intervener filed a notice of appeal with EUIPO under Articles 58 to 64 of Regulation No 207/2009 against the decision of the Cancellation Division.
- 11 By decision of 9 March 2015 ('the contested decision'), the Fourth Board of Appeal of EUIPO upheld the action and revoked the applicant's rights for the remaining goods and services, being those referred to in paragraph 6 above. In contrast to the Cancellation Division, it considered that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 (paragraph 9 of the contested decision).
- 12 In paragraph 24 of the contested decision, the Board of Appeal found that the Cancellation Division's approach had been incorrect, in that it had assumed that the question whether the mark's distinctive character had been altered turned on the question whether the added arrangement was by itself distinctive. In the Board of Appeal's view, it was not the distinctive character of the addition that was decisive, but rather the distinctive character or, more specifically, the 'distinguishing' character of the mark in its registered form that was determinative. The Board of Appeal added that it was appropriate to consider whether the distinguishing character of the mark had been altered by what had been added.
- 13 The Board of Appeal went on to state in paragraph 25 of the contested decision that the mark, as registered, was a purely graphical sign, arranged in an extremely simple manner that could potentially be perceived as a dog bone or a dumbbell, but in no way as a hyphen. It therefore found, in paragraph 26 of the contested decision, that in the case of signs of such extreme simplicity, it was that much easier for additions or alterations to alter the overall impression produced by the sign. The Board of Appeal took the view that the 'distinctive character' within the meaning of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 does not refer to the ability to serve as an indicator of origin, but simply to the overall impression.
- 14 The Board of Appeal stated the following in paragraph 27 of the contested decision:
- 'In the overall impression produced, the form used has a clearly different effect. [In] the form used, the outer circle and the central area together look more like a button. The association with a dog bone, possible [in] the registered form, disappears. Overall, the distinctive character of the form used is produced by a graphic overall impression, of which the outer circle and the central area are equal, inseparable parts. It is precisely because both the registered form and the form used use the most basic and simple geometric forms that the overall impression is different.'
- 15 Next, referring to the General Court's case-law, the Board of Appeal stated in paragraphs 28 and 29 of the contested decision that a modernisation of the marks in order to adapt them to current tastes was permissible. It nevertheless took the view that the name of the manufacturer or other indications could be added to the registered form as a distinctive sign, on the label, which stood out by itself. Thus,

according to the Board of Appeal, the addition of the word element 'hyphen c' was permitted, but not the outer circle. Although the form used was imagined without the circle, the circle might not by itself represent a mark. It was even less possible for the form used to be divided into two separate visual representations. The outer circle encircled the central area, so as not to exist by itself.

- 16 In paragraphs 31 to 39 of the contested decision, the Board of Appeal also examined the evidence relating solely to the goods in Class 24 and the services in Class 42 that had been submitted for assessment by the Cancellation Division. It found, first, that proof of use of the earlier mark had not been made out on other grounds for the goods in Class 24, those being, in essence, the lack of sufficient evidence (paragraphs 31 and 32 of the contested decision) and, secondly, that the evidence adduced in respect of the services in Class 42 was wholly unsuitable for proving the use of those services (paragraphs 33 to 39 of the contested decision).
- 17 In the light of those considerations, the Board of Appeal partly annulled the Cancellation Division's decision, by which it had dismissed the intervener's action, with the result that the applicant's rights to the registered mark were revoked in full, including those relating to the goods and services in Classes 9, 24, 25 and 42.
- 18 The contested decision reproduced the registered mark in the following form:



- 19 By amending decision of 26 May 2015, that is to say, a decision adopted two months after the present proceedings were instituted by the applicant, the Board of Appeal stated that the contested decision included a slightly altered representation of the registered mark, namely that referred to in paragraph 18 above, instead of the one shown in paragraph 2 above. The Board of Appeal considered it to be a clerical error in the form of an error of reproduction which it had to rectify of its own motion under Rule 53 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995, L 303, p. 1), as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005, L 172, p. 4).

Forms of order sought

- 20 The applicant claims that the Court should:
- annul the contested decision;
 - order EUIPO to pay the costs.
- 21 EUIPO and the intervener contend that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.

Law

- 22 The applicant puts forward a single plea in law, alleging in essence that, in having found that the registered mark had not been used in a manner that preserved the acquired rights, the Board of Appeal disregarded the second subparagraph of Article 15(1)(a) of Regulation No 207/2009.
- 23 It is apparent from recital 10 of Regulation No 207/2009 that the legislature considered that there is no justification for protecting an earlier trade mark, except where the trade mark is actually used. In that regard, it should be recalled that Article 51(1)(a) of Regulation No 207/2009 provides that the rights of a proprietor of a Community trade mark are to be declared revoked, on application to EUIPO, 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.
- 24 Under the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, use of the Community mark is considered to include use ‘in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered’.
- 25 It follows directly from the wording of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 that the use of the trade mark in a form which is different from the form in which it was registered is considered as a use for the purposes of the first subparagraph of that article, to the extent that the distinctive character of the trade mark in the form in which it was registered is not changed (judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 21; see also, to that effect, judgments of 8 December 2005, *Castellblanch v OHIM — Champagne Roederer (CRISTAL CASTELLBLANCH)*, T-29/04, EU:T:2005:438, paragraph 30; 10 June 2010, *Atlas Transport v OHIM — Hartmann (ATLAS TRANSPORT)*, T-482/08, not published, EU:T:2010:229, paragraphs 28 and 29; and 24 May 2012, *TMS Trademark-Schutzrechtsverwertungsgesellschaft v OHIM — Comercial Jacinto Parera (MAD)*, T-152/11, not published, EU:T:2012:263, paragraph 15).
- 26 For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 22 and the case-law cited; see also, to that effect, judgments of 29 April 2004, *Procter & Gamble v OHIM*, C-468/01 P to C-472/01 P, EU:C:2004:259, paragraph 32; 8 May 2008, *Eurohypo v OHIM*, C-304/06 P, EU:C:2008:261, paragraph 66; and 12 July 2012, *Smart Technologies v OHIM*, C-311/11 P, EU:C:2012:460, paragraph 23).
- 27 It must be observed that the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 relates to a situation where a national or Union registered trade mark is used in trade in a form slightly different from the form in which registration was effected. The purpose of that provision, which avoids imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that same mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in insignificant respects, and the two signs can therefore be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade (judgments of 23 February 2006, *Il Ponte Finanziaria v OHIM* —

Marine Enterprise Projects (BAINBRIDGE), T-194/03, EU:T:2006:65, paragraph 50; 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 30; and of 5 December 2013, *Olive Line International v OHIM — Carapelli Firenze (Maestro de Oliva)*, T-4/12, not published, EU:T:2013:628, paragraph 23; see also, to that effect, judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 29; see also, by analogy, judgment of 25 October 2012, *Rintisch*, C-553/11, EU:C:2012:671, paragraphs 21 and 22).

- 28 Thus, a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).
- 29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the earlier mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).
- 30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).
- 31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).
- 32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009.
- 33 Paragraph 24 of the contested decision indicates that the Board of Appeal annulled the decision of the Cancellation Division, in essence on the ground it had merely determined, in an isolated manner, whether the added arrangement was in itself distinctive. The Board of Appeal, by contrast, held in the same paragraph that it was appropriate to determine whether the distinctive character of the trade mark in the form registered had been altered by what had been added. The Board of Appeal added that the registered mark was a purely graphical sign, arranged in an extremely simple manner (paragraph 25 of the contested decision) and that, in the case of signs of such extreme simplicity, it was that much easier for additions or alterations to alter the overall impression produced by the sign (paragraph 26 of the contested decision). The Board of Appeal further stated that distinctive character within the meaning of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 did not refer to suitability for serving as an indication of origin, but merely the overall impression.

- 34 The Board of Appeal further observed in paragraph 28 of the contested decision that the form used by the applicant could no longer be referred to as a 'modernised' form.
- 35 The Board of Appeal stated, in paragraph 29 of the contested decision, that that conclusion was not called into question by the fact that it was perfectly acceptable to use a mark as registered at the same time as other distinctive signs. Therefore, the addition of additional components would have other consequences than the eradication of components of the form as registered. The Board of Appeal took the view, however, that in such cases the addition would have to be an autonomous 'component' capable of being a mark on its own and capable of being recognised as an autonomous mark in the form used.
- 36 By those findings, the Board of Appeal erred in law with its postulate for the examination of the registered mark, before even undertaking that examination in relation to the specific case before it.
- 37 Firstly, as is apparent from the case-law referred to in paragraph 28 above, a finding that the distinctive character of the registered mark has been altered calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark.
- 38 Therefore, contrary to the Board of Appeal's conclusion in paragraph 24 of the contested decision, the correct approach was that adopted by the Cancellation Division, viz., to consider the added component on the basis of its intrinsic quality and its position within the arrangement of the trade mark.
- 39 Secondly, in stating, in paragraph 26 of the contested decision, that the 'distinctive character ... does not refer to suitability for serving as an indication of origin', the Board of Appeal departed from the Court of Justice's case-law referred to in paragraph 26 above, according to which the distinctive character of a mark means that that mark serves to identify the product in respect of which registration is sought as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings.
- 40 It follows that, first, in failing to examine the added component in accordance with the case-law and, second, in misinterpreting the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, the Board of Appeal made errors of law. It is appropriate to examine next whether those errors are such as to affect the lawfulness of the contested decision.
- 41 It is appropriate to examine, in the first place, sign No 1 and sign No 2.
- 42 Firstly, it should be noted that the registered mark draws its distinctive character from the presence of the only figurative element it comprises which, by virtue of its registration, has a minimum of distinctive character.
- 43 The Court has held that, in order to avoid infringing Article 8(1)(b) of Regulation No 207/2009, it is necessary to acknowledge a certain degree of distinctiveness of an earlier registered mark. It follows that the earlier trade mark cannot be found to be generic, descriptive or devoid of any distinctive character, without calling into question its validity in revocation proceedings, which would give rise to an infringement of Article 8(1)(b) of Regulation No 207/2009 (see, to that effect, judgment of 24 May 2012, *Formula One Licensing v OHIM*, C-196/11 P, EU:C:2012:314, paragraphs 47, 51 and 52).
- 44 Thus, even if the registered mark had to be considered devoid of a high degree of distinctive character, a minimum of distinctive character should nevertheless be acknowledged for it, by virtue of its having been registered.

- 45 Secondly, as found previously by the Cancellation Division, the added component in sign No 1 and one of the added components in sign No 2, being the circle consisting solely in one of the simplest and most common forms and basic geometrical figures, is devoid of distinctive character, so that it has no distinctive or dominant character in the composition of the registered mark (see, to that effect, judgment of 24 November 2005, *GfK v OHIM — BUS (Online Bus)*, T-135/04, EU:T:2005:419, paragraph 40).
- 46 Thirdly, the thickness of the feature of the circle used does not suffice to confer distinctive character on the added component. The distinction drawn by EUIPO at the hearing, to the effect that the registered mark is altered because the circle does not frame it but rather surrounds it seems rather artificial. In fact, the circle surrounds the registered mark and, by delineating its outer limits, also has the effect of placing it within a framework, i.e., framing it.
- 47 Fourthly, contrary to what the Board of Appeal found, in paragraph 27 of the contested decision, the addition of the circle to the registered mark had the effect of creating a sort of transformation, in the sense that, according to the Board of Appeal's findings, signs Nos 1 and 2 looked rather more like a button, whereas the registered mark looks a dog bone or a dumbbell.
- 48 Therefore, the Board of Appeal was incorrect in finding, in paragraph 27 of the contested decision, that, '[i]n the form used, the outer circle and the central area form[ed] a unit' and that '[t]he the outer circle and the central area together rather resemble[d] a button' since, although the circle is not ancillary to the overall impression, it is an autonomous part of the form in which the mark was registered, which, incidentally, consists in a juxtaposition of a circle and a figurative component, the overall impression of which cannot be said to convey to the public a separate perception between the mark as registered and the mark as altered to the point where the public will perceive a different image from that conveyed by the registered mark alone.
- 49 It is clear in that regard that the registered mark retains its distinctive character, irrespective of whether it is shown in the form as registered or surrounded by a circle, without its being necessary to go via random and necessarily inaccurate comparisons in order to establish a link between the mark in respect of which registration is sought and a known object, viz. a dumbbell or a dog bone, whilst establishing a different link different between signs Nos 1 and 2 and another known object, namely a button, which is not readily apparent from the examination of the abovementioned components.
- 50 Fifthly, nor can the registered mark and the additional component be said to form an inseparable whole. The additional component is not ancillary; indeed it is juxtaposed onto the registered mark, but will not be confused with it to the point where the public, faced with the mark as registered and signs Nos 1 and 2, will have the impression that the latter convey different concepts or different meanings. It is thus clear that signs Nos 1 and 2 are, overall, equivalent to the mark as registered.
- 51 It must be remembered that in the judgment of 24 May 2012, *MAD* (T-152/11, not published, EU:T:2012:263), the Court held, implicitly but necessarily, in paragraphs 40 and 41 of that judgment, that the fact that the registered mark in that case was surrounded by a coat of arms did not alter the distinctive character of the mark as registered.
- 52 Although it cannot be disputed that, the weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good, the reverse being also true (see, to that effect, judgment of 24 September 2015, *Form of an oven*, T-317/14, not published, EU:T:2015:689, paragraph 33), it is clear that, in the present case, the mere addition to the registered mark of a component so lacking in distinctive character as a circle, in both sign No 1 and sign No 2, does not have the effect of altering the mark; otherwise, it would be virtually impossible for proprietors of trade marks such as the registered mark at issue here, consisting of a single figurative element, to adapt the registered mark to changing tastes in order to modernise it.

- 53 In the overall impression, the distinctive and dominant component of the sign used lies in the form as conveyed by the registered mark, as the circle is completely lacking in distinctive character. Thus, signs Nos 1 and 2 continue to draw their distinctive character from the form as registered, with the result that consumers will continue to perceive the figurative element as an indication of commercial origin.
- 54 Similarly, the use of the sky blue colour in sign No 2 is not particularly original; it is not distinctive or dominant and does not have the effect of altering the mark as registered (see, to that effect, judgment of 24 May 2012, *MAD*, T-152/11, not published, EU:T:2012:263, paragraph 41).
- 55 It follows that the Board of Appeal's finding that the mark as registered was altered by the addition of the circle was an error vitiating the lawfulness of the contested decision.
- 56 In the second place, sign No 3 consists in three components: (i) the registered mark; (ii) the circle surrounding the registered mark; and (iii) the word element 'hyphen c', situated below figurative elements written in stylised, individual block letters, particularly with the letter 'y' extending into the letter 'h'.
- 57 It must borne in mind in that regard that, where several signs are used simultaneously, steps must be taken to ensure that, for the purposes of the application of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, such use does not alter the distinctive character of the registered sign, having regard inter alia to business practices in the relevant sector (judgment of 24 September 2015, *Form of an oven*, T-317/14, not published, EU:T:2015:689, paragraph 31; see also, to that effect, judgment of 8 December 2005, *CRISTAL CASTELLBLANCH*, T-29/04, EU:T:2005:438, paragraphs 33 and 34).
- 58 The joint use of a figurative element and a word element on the same textile or clothing item does not undermine the identification function of the registered mark; it is not unusual in the clothing sector to juxtapose a figurative element with word element linked to the designer or manufacturer, without the figurative element losing its autonomous identification function in the overall impression. This finding extends to all the goods and services referred to in paragraph 6 above.
- 59 Thus, in sign No 3, the target consumer's attention will be drawn to both the word element and the figurative element.
- 60 It follows that, in sign No 3, the mere addition of the word element 'hyphen c' does not alter the distinctive character of the registered mark, as found, in essence, by the Board of Appeal in paragraph 29 of the contested decision.
- 61 In the third place, it should be noted that, for goods in Class 24 and services in Class 42, the Board of Appeal found that proof of use of the earlier mark had not been made out on other grounds for the goods in Class 24, meaning, in essence, that adequate proof was lacking (paragraphs 31 and 32 of the contested decision) and also that the evidence adduced in respect of the services in Class 42 was wholly unsuitable for proving the use of those services (paragraphs 33 to 39 of the contested decision).
- 62 The Board of Appeal thus revoked the mark on two different, mutually independent grounds: (i) the alteration of the registered mark, and (ii) the lack of proof of genuine use of the mark.
- 63 The applicant did not in any way contest the Board of Appeal's finding on the latter point and, in failing to do so, did not challenge the lack of use of the sign for goods in Class 24, no more than it gave the reasons why the evidence adduced by it had to be considered suitable for proving use of the registered mark for the services in Class 42. In response to a question put by the Court at the hearing, the applicant did not deny that, in its application, it had failed to put forward specific arguments challenging paragraphs 31 to 39 of the contested decision.

- 64 It follows that, irrespective of the alleged alteration of the registered mark, the contested decision must be partially endorsed, inasmuch as the Board of Appeal found that proof of genuine use of that mark had not been established for goods in Class 24 and services in Class 42, since the applicant has not contested that other, separate ground which also formed the basis for the part of the decision relating to those goods, namely the lack of proof of genuine use, with the result that the action for annulment must be dismissed on this point.
- 65 In the fourth place, by contrast, regarding goods in Classes 9 and 25, the contested decision must be annulled inasmuch as the Board of Appeal held that the registered mark had to be revoked whilst basing itself solely on the finding that it had been altered. As evidenced by paragraphs 33 to 55 above, in finding that the use of signs Nos 1 and 2 altered the registered mark, the Board of Appeal infringed the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, thereby vitiating the lawfulness of the contested decision.
- 66 It follows from all the foregoing considerations that the sole plea in law must be upheld, with the result that the contested decision must be annulled in so far as the Board of Appeal found that, for the goods in Classes 9 and 25, the rights of the proprietor of the registered mark had to be revoked.

Costs

- 67 Under Article 136(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since EUIPO has been unsuccessful, it must be ordered to bear its own costs and to pay those of the applicant, in accordance with the form of order sought by the applicant.
- 68 Under Article 138(3) of the Rules of Procedure, the Court may decide that an intervener is to bear its own costs. In this case, the intervener in support of EUIPO must bear its own costs.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Annuls the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 9 March 2015 (Case R 1506/2014-4), concerning revocation proceedings between Skylotec GmbH and hyphen GmbH in so far as the Board of Appeal found, with respect to goods in Classes 9 and 25 within the meaning of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, that the proprietor of the registered European Union trade mark should have its rights revoked;**
- 2. Dismisses the action as to the remainder;**
- 3. Orders EUIPO to bear its own costs and to pay those incurred by hyphen;**

4. Orders Skylotec to bear its own costs.

Martins Ribeiro

Gervasoni

Madise

Delivered in open court in Luxembourg on 13 September 2016.

[Signatures]