



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

4 April 2019*

(EU trade mark — Revocation proceedings — EU figurative mark TESTA ROSSA —
Partial revocation — Article 51(1)(a) of Regulation (EC) No 207/2009 (now Article 58(1)(a) of
Regulation (EU) 2017/1001) — Proof of use — Outward use of the contested mark — Equal treatment)

In Cases T-910/16 and T-911/16,

Kurt Hesse, residing in Nuremberg (Germany), represented by M. Krogmann, lawyer,

applicant in Case T-910/16,

Wedl & Hofmann GmbH, established in Mils (Austria), represented by T. Raubal, lawyer

applicant in Case T-911/16,

v

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

defendant,

the other parties to the proceedings before the Board of Appeal of EUIPO, interveners before the
General Court, respectively in Case T-910/16 and Case T-911/16, being

Wedl & Hofmann GmbH,

and

Kurt Hesse,

ACTIONS brought against the decision of the First Board of Appeal of EUIPO of 5 October 2016
(Case R 68/2016-1), relating to revocation proceedings between Mr Hesse and Wedl & Hofmann,

THE GENERAL COURT (Fifth Chamber),

composed of D. Gratsias, President, I. Labucka and I. Ulloa Rubio (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the applications lodged at the Court Registry on 23 December 2016,

having regard to the responses of EUIPO lodged at the Court Registry on 15 March 2017,

* Language of the case: German.

having regard to the responses of the interveners lodged at the Court Registry on 9 March (Case T-910/16) and 23 March 2017 (Case T-911/16),

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

Background to the dispute

- 1 On 8 July 2008, the applicant in Case T-911/16 and intervener in Case T-910/16, Wedl & Hofmann GmbH, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), itself replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 Registration as a mark was sought for the following figurative sign, for which the colours black and red (Pantone 186 C) were claimed:



- 3 The goods and services in respect of which registration was sought are in Classes 7, 11, 20, 21, 25, 28, 30, 34 and 38 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:
 - Class 7: ‘Electric coffee grinders (not hand-operated)’;
 - Class 11: ‘Coffee machines, electric; electric cooking utensils, in particular apparatus for making hot beverages and cold beverages; ice machines and apparatus’;
 - Class 20: ‘Furniture’;

- Class 21: ‘Household, kitchen utensils and containers; coffee filtering apparatus (non-electric); coffee pots (non-electric); coffee grinders (hand-operated); glassware, porcelain, in particular tableware; glass beverage ware’;
 - Class 25: ‘Clothing, namely gymnastic wear and sportswear, aprons, shirts, polo shirts and tee-shirts; headgear’;
 - Class 28: ‘Games and playthings; gymnastic and sporting articles, namely golf clubs, golf bags, balls for golf, footballs, racquets for tennis, tennis bags, balls for tennis, not included in the other classes’;
 - Class 30: ‘Coffee, tea, cocoa, sugar; pastry and confectionery, ices; chocolate; chocolate-based beverages; sweets’;
 - Class 34: ‘Smoker articles; matches’;
 - Class 38: ‘Telecommunications, in particular providing telecommunications connections to global computer networks’.
- 4 The trade mark application was published in *Community Trade Marks Bulletin* No 43/2008 of 27 October 2008. The mark was registered on 11 May 2009 under the number 007070519 in respect of the goods and services referred to in paragraph 3 above.
- 5 On 15 October 2014, the applicant in Case T-910/16 and intervener in Case T-911/16, Mr Kurt Hesse, filed an application for partial revocation of the contested mark on the basis of Article 51(1)(a) of Regulation No 207/2009 (now Article 58(1)(a) of Regulation 2017/1001) in respect of the goods and services in Classes 7, 11, 20, 21, 25, 28, 30, 34 and 38, except for the goods ‘coffee, tea, cocoa, sugar; chocolate; chocolate-based beverages; sweets’ in Class 30.
- 6 On 17 February 2015, within the period given, Wedl & Hofmann submitted observations regarding the use of the contested mark and requested that the application for revocation be rejected, without, however, furnishing all the evidence of use. Wedl & Hofmann sent by post the evidence of use which arrived at EUIPO on 23 February 2015, after the expiry of the time limit. On 10 May 2015, Wedl & Hofmann submitted additional documents by which it sought to prove genuine use of the contested mark.
- 7 On 17 November 2015, the Cancellation Division revoked Wedl & Hofmann’s rights in respect of all of the goods and services covered by the application for revocation, with effect from 15 October 2014.
- 8 On 13 January 2016, Wedl & Hofmann filed a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001), against the decision of the Cancellation Division.
- 9 By decision of 5 October 2016 (‘the contested decision’), the First Board of Appeal of EUIPO partially upheld Wedl & Hofmann’s appeal and partially annulled the Cancellation Division’s decision in so far as the Board of Appeal maintained the registration of the contested mark in respect of ‘household, kitchen containers; glassware, porcelain, in particular tableware; glass beverage ware’ in Class 21 and ‘clothing, namely aprons, shirts, polo shirts and tee-shirts; headgear’ in Class 25 (‘the contested goods in Classes 21 and 25’). In particular, first of all, the Board of Appeal found that the evidence of use which Wedl & Hofmann had submitted late was admissible on the basis of Article 76(2) of Regulation No 207/2009 (now Article 95(2) of Regulation 2017/1001). In that regard, it stated, in paragraph 22 of the contested decision, that Article 76 of Regulation No 207/2009 granted EUIPO a discretion to decide whether or not to take facts and evidence submitted late into account and added that the Court of Justice had held that, as a general rule and unless otherwise specified, the submission of facts and evidence remained possible after the expiry of the time limits to which such submission was

subject under the provisions of Regulation No 207/2009, and that EUIPO was in no way prohibited from taking account of facts and evidence which were submitted or produced late. Secondly, the Board of Appeal pointed out that outward use of a mark did not necessarily mean use aimed at end consumers and that it could not be ruled out that the use relied upon by Wedl & Hofmann was genuine solely because the commercial acts invoked by it were not directed at end consumers, but at industrial customers like licensees and franchisees. Consequently, the Board of Appeal found that Wedl & Hofmann had, on the basis of the evidence provided, proved genuine use of the contested mark as regards the contested goods in Classes 21 and 25. Lastly, the Board of Appeal found that the evidence was insufficient to prove that the contested mark had been used in connection with the remainder of the goods and services covered by the application for revocation.

Forms of order sought

Case T-910/16

10 Mr Hesse claims that the Court should:

- annul the contested decision and declare Wedl & Hofmann’s rights to be revoked also in respect of the contested goods in Classes 21 and 25;
- order EUIPO to pay the costs.

11 EUIPO and Wedl & Hofmann contend that the Court should:

- dismiss the action;
- order Mr Hesse to pay the costs.

Case T-911/16

12 Wedl & Hofmann claims that the Court should:

- annul or alter the contested decision;
- order EUIPO to pay the costs.

13 EUIPO and Mr Hesse contend that the Court should:

- dismiss the action;
- order Wedl & Hofmann to pay the costs.

Law

14 Having heard the parties on the matter, the Court considers it appropriate to join the present cases for the purposes of the decision which closes the proceedings, in accordance with Article 19(2) and Article 68(1) of the Rules of Procedure of the General Court.

15 It must be stated at the outset that the Board of Appeal found that the evidence of use showed that there had been genuine use of the contested mark in connection with the contested goods in Classes 21 and 25. By contrast it found that there had been no genuine use of the contested mark in

connection with the remainder of the goods and services covered by the application for revocation. By their respective actions, Mr Hesse seeks to have the application for revocation upheld in respect of all the goods and services covered by that application and Wedl & Hofmann seeks to have that application dismissed in its entirety.

- 16 In support of his action in Case T-910/16, Mr Hesse relies on a single plea in law, alleging, in essence, infringement of Article 51(1)(a) of Regulation No 207/2009.
- 17 In Case T-911/16, Wedl & Hofmann relies on two pleas in law, the first alleging infringement of Article 51(1)(a) of Regulation No 207/2009, Article 15(1)(a) of Regulation No 207/2009 (now Article 18(1)(a) of Regulation 2017/1001) and Rule 40(5) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1) (now Article 19(1) of Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Regulation No 207/2009 and repealing Regulations No 2868/95 and (EC) No 216/96 (OJ 2017 L 205, p. 1)), read in conjunction with Rule 22(3) and (4) of Regulation No 2868/95 (now Article 10(3) and (4) of Delegated Regulation 2017/1430), and the second alleging infringement of the principle of equal treatment.
- 18 The Court considers it appropriate, first, to deal with the single plea in law in Case T-910/16 and the first plea in Case T-911/16 together, given that they both allege, in essence, infringement of Article 51(1)(a) of Regulation No 207/2009, and, secondly, to deal with the second plea in Case T-911/16.
- 19 It should be noted, as a preliminary point, that the parties do not, in the proceedings before the Court, dispute the admissibility of the evidence which Wedl & Hofmann submitted before the Cancellation Division.
- 20 It is true that, in paragraph 5 of the written pleading he lodged in Case T-911/16 and before submitting his arguments seeking to dispute Wedl & Hofmann's claims as to the substance of the case, Mr Hesse states that 'the action is unfounded if only because the applicant submitted ... its evidence of use ... after the expiry of the time limit of 17 December 2015 given to it by [EUIPO]'. Furthermore, in support of his argument, Mr Hesse refers to the judgment of 18 July 2013, *New Yorker SHK Jeans v OHIM* (C-621/11 P, EU:C:2013:484).
- 21 However, that argument must be rejected as ineffective since, by his response, Mr Hesse claims not that the contested decision should be annulled on the basis of an error of law which the Board of Appeal, in his submission, made by taking that evidence into consideration, but that the action brought by Wedl & Hofmann should be dismissed.
- 22 Lastly, even if it were to be considered that, by that argument, Mr Hesse is, in reality, asking the Court to dismiss Wedl & Hofmann's action and uphold the contested decision on a ground other than that on which the Board of Appeal relied in that decision, such an argument must be rejected. It is sufficient, in that regard, to point out that the Court reviews the legality of the decisions of the adjudicating bodies of EUIPO. If it holds that such a decision, called into question in an action brought before it, is vitiated by illegality, it must annul it. It may not dismiss the action while substituting its own reasoning for that of the competent body of EUIPO (see judgment of 9 September 2010, *Axis v OHIM — Etra Investigación y Desarrollo (ETRAX)*, T-70/08, EU:T:2010:375, paragraph 29 and the case-law cited).

The single plea in Case T-910/16 and the first plea in Case T-911/16, alleging, in essence, infringement of Article 51(1)(a) of Regulation No 207/2009

- 23 In the context of his single plea in law in Case T-910/16, Mr Hesse submits that the Board of Appeal should have confirmed the complete revocation of the contested mark.
- 24 In the context of its first plea in law in Case T-911/16, Wedl & Hofmann maintains, in essence, that it provided proof of genuine use in connection with all the goods and services in respect of which the mark was registered and not only in connection with the contested goods in Classes 21 and 25.
- 25 Under Article 51(1)(a) of Regulation No 207/2009, the rights of the proprietor of an EU trade mark are to be declared to be revoked, on application to EUIPO or on the basis of a counterclaim in infringement proceedings, 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.
- 26 According to Article 15(1)(a) of Regulation No 207/2009, proof of genuine use of an EU trade mark also includes proof of its 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.
- 27 Under Rule 22 of Regulation No 2868/95, which is applicable to revocation proceedings in accordance with Rule 40(5) of that regulation, the proof of use of a mark must concern the place, time, extent and nature of use of the mark and it is, in principle, to be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) of Regulation No 207/2009 (now Article 97(1)(f) of Regulation 2017/1001) (judgments of 8 July 2004, *Sunrider v OHIM — Espadafor Caba (VITAFRUIT)*, T-203/02, EU:T:2004:225, paragraph 37, and of 10 September 2008, *Boston Scientific v OHIM — Terumo (CAPIO)*, T-325/06, not published, EU:T:2008:338, paragraph 27).
- 28 In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade mark protection to the case where large-scale commercial use has been made of the marks (see judgments of 8 July 2004, *MFE Marienfelde v OHIM — Vétoquinol (HIPOVITON)*, T-334/01, EU:T:2004:223, paragraph 32 and the case-law cited, and of 27 September 2007, *La Mer Technology v OHIM — Laboratoires Goëmar (LA MER)*, T-418/03, not published, EU:T:2007:299, paragraph 53 and the case-law cited).
- 29 As is clear from the case-law, there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (see, by analogy, judgment of 11 March 2003, *Ansul*, C-40/01, EU:C:2003:145, paragraph 43). In addition, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (see judgments of 6 October 2004, *Vitakraft-Werke Wührmann v OHIM — Krafft (VITAKRAFT)*, T-356/02, EU:T:2004:292, paragraph 26 and the case-law cited, and of 4 July 2014, *Construcción, Promociones e Instalaciones v OHIM — Copisa Proyectos y Mantenimientos Industriales (CPI COPISA INDUSTRIAL)*, T-345/13, not published, EU:T:2014:614, paragraph 21 and the case-law cited).
- 30 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services,

the characteristics of the market and the scale and frequency of use of the mark (see judgment of 10 September 2008, *CAPIO*, T-325/06, not published, EU:T:2008:338, paragraph 30 and the case-law cited).

- 31 Furthermore, genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see judgment of 23 September 2009, *Cohausz v OHIM — Izquierdo Faces (acopat)*, T-409/07, not published, EU:T:2009:354, paragraph 36 and the case-law cited). An overall assessment must therefore be carried out, which takes into account all the relevant factors in the particular case and entails a degree of interdependence between the factors taken into account (see judgment of 18 January 2011, *Advance Magazine Publishers v OHIM — Capela & Irmãos (VOGUE)*, T-382/08, not published, EU:T:2011:9, paragraph 30 and the case-law cited).
- 32 The Board of Appeal's analysis, as regards, first, the genuine nature of the use of the contested mark in connection with the contested goods in Classes 21 and 25, and, secondly, the absence of any genuine use of the contested mark in connection with the remainder of the goods and services covered by the application for revocation, must be examined in the light of the foregoing considerations.
- 33 It must be pointed out at the outset that, as the application for revocation of the contested mark was filed on 15 October 2014, the five-year period referred to in Article 51(1)(a) of Regulation No 207/2009 ran, as the Board of Appeal correctly observed in paragraph 43 of the contested decision, from 15 October 2009 to 14 October 2014.
- 34 For the purposes of examining whether the use of the contested mark was genuine, the Board of Appeal relied on the following items of evidence provided by Wedl & Hofmann, as described in the contested decision:
- screenshots from the website 'www.testarossacafe.com', containing information on Wedl & Hofmann's locations as the operator of a chain of 'coffee bars' in Europe, Asia, the Middle East and Egypt;
 - two images of a football shirt, which has the contested mark in a slightly modified form on the front;
 - printouts of advertisements for and photographs of the 'coffee bars' in Germany, Hungary and the United Kingdom, in which the contested mark is visible;
 - an email, dating from February 2014, containing the confirmation of an order for an advertisement, in the amount of EUR 30 000, for the 'coffee' covered by the contested mark in the magazine *Body & Soul*;
 - a list of the locations of the 'coffee bars' in respect of the contested mark that have been established in Germany, Italy, Hungary, Austria and Romania since 2009;
 - four printouts of an advertisement for the 'coffee' covered by the contested mark for the Müller chain of retail shops;
 - various tables from the proprietor of the contested mark containing overviews of sales from 2009 to 2015 of goods covered by the contested mark, in particular paper cups, paper napkins, coffee, glasses, capsules, ballpoint pens, cutlery, ashtrays, lighters, clocks, key rings and sunshades, with corresponding information as to the volumes and the values of the sales of the goods distributed and the recipients of those sales;

- various tables from the proprietor of the contested mark containing orders and deliveries of textiles covered by the contested mark, dating from 2010 to 2012, with information as to the prices and the recipients;
- various photos of ‘coffee bars’ in which the contested mark can be seen;
- a list for Romania of goods covered by the contested mark that are sold to the various franchisees, inter alia sweets, crockery, porcelain, advertising articles, bags, sunshades, lapel badges and clothing such as aprons, caps or polo shirts, with indications of the prices and the corresponding quantities;
- a photograph showing two lighters bearing the contested mark;
- an exchange of emails between Mr W. and Mr F., by which Mr. F. informs Mr W. that Wedl & Hofmann, has, since 1998, had a telephone number which can be called from Germany, France, Italy and Switzerland;
- an advertising brochure for the contested mark setting out, inter alia, the origin of the coffee covered by the contested mark and the process by which that coffee is manufactured and produced. That brochure also shows coffee capsules and other goods covered by the contested mark, such as coffee cups and glasses, coffee machines, sugar sachets, spoons, aprons, polo shirts, waiters’ pouches and paper napkins, all bearing the contested mark;
- a franchise brochure in respect of the contested mark describing the franchise concept and various goods covered by the contested mark.

35 In the first place, Mr Hesse claims that the evidence submitted by Wedl & Hofmann cannot prove that there has been genuine use of the contested mark in connection with the contested goods in Classes 21 and 25, since that evidence of use does not concern sales to end consumers. In that regard, Mr Hesse maintains that the tables of sales which Wedl & Hofmann provided as proof of use are directed at licensees and franchisees, but do not prove that the goods were distributed to end consumers.

36 EUIPO and Wedl & Hofmann dispute Mr Hesse’s arguments.

37 In the present case, it must be pointed out that it is true that, according to the case-law, genuine use of a trade mark requires that the mark be used publicly and outwardly (judgment of 8 July 2004, *VITAFRUIT*, T-203/02, EU:T:2004:225, paragraph 39; see also, to that effect, judgment of 11 March 2003, *Ansul*, C-40/01, EU:C:2003:145, paragraph 37). It is also true that when assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see judgment of 8 July 2004, *VITAFRUIT*, T-203/02, EU:T:2004:225, paragraph 40 and the case-law cited).

38 However, the Board of Appeal was, in paragraphs 58 and 59 of the contested decision, fully entitled to state that that outward use does not mean that it is necessarily use aimed at end consumers. Genuine use of the mark relates to the market on which the proprietor of the EU trade mark pursues its commercial activities and on which it hopes to put its mark to use. Accordingly, taking the view that outward use of a mark, for the purposes of the case-law, must consist of use aimed at end consumers would effectively mean that marks used only in inter-corporate relations are excluded from the scope of Regulation No 207/2009. The relevant public to which marks are addressed does not comprise only end consumers, but also specialists, industrial customers and other professional users (see judgment of 7 July 2016, *Fruit of the Loom v EUIPO — Takko (FRUIT)*, T-431/15, not published, EU:T:2016:395, paragraph 49 and the case-law cited).

- 39 In that regard, as is clear from the many documents provided by Wedl & Hofmann as proof of use of the contested mark, it is not disputed that Wedl & Hofmann operates a chain of ‘coffee bars’ through its franchisees and licensees and that the contested goods in Classes 21 and 25 are sold on the market to end consumers by those franchisees and licensees, under the franchise or licence agreements. Consequently, in accordance with the case-law set out in paragraph 38 above, those sales are capable of establishing that the contested mark has been used publicly and outwardly. In those circumstances, the fact that Wedl & Hofmann did not have any direct relations with end consumers is irrelevant.
- 40 That assessment cannot be called into question by Mr Hesse’s argument that the fact that Wedl & Hofmann signed franchise and licence agreements which impose on licensees and franchisees a number of obligations with regard to advertising, promotion and marketing places a franchise or licence agreement on the same footing as straightforward relations with its employees and agents, which cannot be classified as genuine use within the meaning of Article 15 of Regulation No 207/2009. In that regard, it must be pointed out that a franchise or licence is method of organisation which is common in the course of trade and cannot be considered to be purely internal use. It must be stated that, in a market such as that of the European Union, in order to create or preserve an outlet for goods such as those at issue in the present case, it is common to direct commercial acts at professionals in the sector concerned and particularly at resellers. Thus, it cannot be ruled out, as a matter of principle, that use of a mark which is proved by commercial acts directed at professionals from the sector may be considered to be use consistent with the essential function of the mark for the purposes of the case-law cited in paragraph 30 above (judgment of 7 July 2016, *FRUIT*, T-431/15, not published, EU:T:2016:395, paragraph 50).
- 41 In any event, it must be pointed out that it is clear from the evidence, in particular from the tables of data showing the volumes and the values of the sales of goods which were distributed in 2009 to 2015, that orders were also sent to companies other than franchisees or licensees. That shows that the contested mark was used publicly and outwardly and not solely within the undertaking which is the proprietor of the contested mark or within a network of franchisees and licensees.
- 42 The Board of Appeal was therefore right in finding that the condition that the mark must be used publicly and outwardly appeared to be satisfied in the present case.
- 43 In the second place, Mr Hesse submits that Wedl & Hofmann’s provision of the contested goods in Classes 21 and 25 has no commercial *raison d’être* other than that of promoting other goods and services covered by the contested mark, such as ‘coffee’ or ‘coffee bar’ services. He maintains that, in such circumstances, the affixing of the contested mark to those goods does not contribute towards creating an outlet for those goods or distinguishing them in the interest of consumers from the goods of other undertakings, since those goods are not in competition with other goods or services on the market.
- 44 EUIPO and Wedl & Hofmann dispute Mr Hesse’s arguments.
- 45 It is settled case-law that ‘genuine use’ must be understood to denote actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the end consumer or user by enabling him, without any possibility of confusion, to distinguish those goods or services from others which have another origin (judgments of 11 March 2003, *Ansul*, C-40/01, EU:C:2003:145, paragraphs 35 and 36, and of 9 December 2008, *Verein Radetzky-Orden*, C-442/07, EU:C:2008:696, paragraph 13).
- 46 It must be stated in that regard that it follows from that concept of genuine use that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from

the goods or services of other undertakings (judgments of 11 March 2003, *Ansul*, C-40/01, EU:C:2003:145, paragraph 37, and of 9 December 2008, *Verein Radetzky-Orden*, C-442/07, EU:C:2008:696, paragraph 14).

- 47 Consequently, in order to determine whether genuine use has been established or not, it is necessary to assess whether, by use of the mark, the undertaking seeks to create or preserve an outlet for its goods or services in the European Union, as against the goods or services of other undertakings. That will not be the case if those goods or services do not enter into competition with goods or services offered on the market by other undertakings, that is to say if they are not — and are not intended to be — offered commercially (judgment of 9 September 2011, *Omnicare v OHIM — Astellas Pharma (OMNICARE CLINICAL RESEARCH)*, T-289/09, not published, EU:T:2011:452, paragraph 68).
- 48 In the present case, even though it cannot be ruled out that the contested goods in Classes 21 and 25 might be offered with the ultimate goal of encouraging the relevant public to purchase the ‘coffee’ sold by Wedl & Hofmann, they are not, however, handed out as a reward for the purchase of other goods, such as ‘coffee’, or to encourage the sale of those goods, since it is clear from the evidence furnished by Wedl & Hofmann, in particular the advertising material, the franchise brochures and the lists of sales, that the contested goods in Classes 21 and 25 are accounted for and offered separately, with order numbers and the volumes and values of the sales, independently of ‘coffee’, even if it were to be accepted that that product is that which is primarily marketed by Wedl & Hofmann. Those sales constitute use which is objectively such as to create or preserve an outlet for the goods concerned and which entails a volume of sales which, in view of the period and frequency of use, is not so low that it could be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. Consequently, it must be held that the goods concerned are independent goods which have their own outlet.
- 49 Furthermore, it must be pointed out that the contested goods in Classes 21 and 25 are in competition with other similar goods on the market, in particular where they are provided by undertakings that are present on the market for coffee, which are also likely to provide goods such as ‘paper cups’, ‘coffee cups’, ‘glasses’ or ‘sugar sachets’ in order to promote their main product, namely coffee.
- 50 Consequently, it must be held that, by using its mark in such a way, Wedl & Hofmann seeks to create or preserve an outlet for the contested goods in Classes 21 and 25 on a market on which other undertakings are present.
- 51 The Board of Appeal was therefore right in finding that the documents which Wedl & Hofmann had provided concerning the use of the contested mark proved that the contested mark had not been used in a purely internal manner in connection with the contested goods in Classes 21 and 25 for the sole purpose of promoting the sale of Wedl & Hofmann’s other goods.
- 52 In the third place, Wedl & Hofmann submits, in essence, that it provided proof of genuine use in connection with all the goods and services in respect of which the mark had been registered and not only in connection with the contested goods in Classes 21 and 25. In that regard, it maintains that, if the Board of Appeal had correctly assessed the documents provided as proof of use, it ought to have concluded that sufficient proof of use had been provided in respect of all the goods and services referred to in paragraph 3 above.
- 53 EUIPO and Mr Hesse dispute Wedl and Hofmann’s arguments.
- 54 In the present case, it must be stated that the documents that Wedl & Hofmann provided do not permit the inference that the Board of Appeal erred in finding that there had been no genuine use of the contested mark in connection with goods and services other than the contested goods in Classes 21 and 25.

- 55 In that regard, it must be pointed out that, as the Board of Appeal correctly found, Wedl & Hofmann only provided sufficient indications as regards the place, time and extent of use of the contested mark in connection with the contested goods in Classes 21 and 25, in the form, inter alia, of tables containing a number of separate data regarding the date of the sales, the countries to which the sales were made, the goods sold and the prices and value of the sales. Furthermore, the indications in the tables are confirmed by other items of evidence such as photographs, advertisements, an advertising brochure and a franchise brochure. Regarding the remainder of the goods and services, Wedl & Hofmann has not provided any evidence which makes it possible to establish that those goods were sold in the European Union during the relevant period. It was for Wedl & Hofmann to prove genuine use of the contested mark, that is to say, to furnish a body of evidence based not on probabilities or presumptions, but on solid and objective evidence enabling it to show that that mark had been put to effective and sufficient use on the market concerned (see, to that effect and by analogy, judgment of 23 September 2009, *acopat*, T-409/07, not published, EU:T:2009:354, paragraphs 69 and 70).
- 56 More specifically, first, it must be pointed out that no indication or proof of genuine use of the contested mark as regards the goods in Classes 7, 11, 20 and 28 can be inferred from those documents. In that regard, it must be stated that Wedl & Hofmann has not provided any invoices, order forms, sales figures, advertising figures, or data showing the market share for goods such as the ‘coffee grinders’ in Class 7, ‘furniture’ in Class 20, ‘games’ and ‘playthings’ in Class 28, ‘coffee machines’ and ‘electric cooking utensils’ in Class 11 or ‘sporting articles’ in, in particular, Class 28, marketed under the contested mark. Furthermore, regarding the ‘gymnastic wear and sportswear’ in Class 25, the Board of Appeal correctly pointed out, in paragraph 66 of the contested decision, that, it was not sufficient, for it to be accepted that there had been genuine use of those goods, to produce only one photograph of a football shirt on which the contested mark is displayed, without any additional evidence.
- 57 Secondly, as regards the goods in Class 34, namely ‘smoker articles’ and ‘matches’, it must be pointed out that, although sales of ‘lighters’ and ‘ashtrays’ are to be found in the tables of data which Wedl & Hofmann provided regarding sales, the volumes of those sales are very low, indeed almost insignificant, in comparison with the sales volumes of other goods such as ‘coffee’, ‘paper cups’ or coffee ‘cups’ or ‘glasses’. The evidence does not therefore make it possible to determine whether the use is sporadic use, not going beyond token use, or use which is sufficiently extensive to be taken into consideration.
- 58 Thirdly, regarding the services in Class 38, it must be pointed out that proof of use has also not been furnished. None of the evidence shows that Wedl & Hofmann has supplied telecommunications services. As the Board of Appeal correctly states in paragraph 67 of the contested decision, the mere fact that Wedl & Hofmann set up a service telephone number does not prove that Wedl & Hofmann supplied telecommunications services under the contested mark. The mere provision of a service telephone number or a direct line for customers does not constitute an independent service which is supplied in return for payment by a third party, and cannot be regarded as being capable of creating an outlet, but only as a service of assistance connected with the sale of the goods actually marketed by the proprietor of the trade mark. In the absence of invoices or objective information regarding the turnover generated by the offer of those services and details as to the date, quantity or quality of the services provided, the exchange of emails referred to in paragraph 34 above does not on its own make it possible to conclude that the contested mark has been put to genuine use.
- 59 As regards Mr W.’s request for a hearing, it is sufficient to state that that request must, in any event, be rejected, on the ground that, in view of all of the above considerations, the Court has been able to determine the matter on the basis of the submissions, pleas in law and arguments put forward.
- 60 The Board of Appeal was therefore right in finding that there had been no genuine use of the contested mark in connection with goods and services other than the contested goods in Classes 21 and 25.

61 It follows from the foregoing that, in Case T-910/16, the single plea in law put forward by Mr Hesse, alleging, in essence, infringement of Article 51(1)(a) of Regulation No 207/2009, must be rejected. Consequently, the action in that case must be dismissed.

62 It also follows from the foregoing that, in Case T-911/16, the first plea in law put forward by Wedl & Hofmann, alleging, in essence, infringement of Article 51(1)(a) of Regulation No 207/2009, must also be rejected.

The second plea in Case T-911/16, alleging infringement of the principle of equal treatment

63 By its second plea in law, Wedl & Hofmann submits that it is much more difficult to prove genuine use of a mark held by a small undertaking such as its own. It maintains that the contested decision infringed the principle of equal treatment by imposing on it stringent requirements regarding the provision of evidence of use.

64 EUIPO and Mr Hesse dispute Wedl & Hofmann's arguments.

65 It is settled case-law that the principle of equal treatment requires that comparable situations must not be treated differently, but also that different situations must not be treated in the same way unless such treatment is objectively justified (judgments of 17 July 1997, *National Farmers' Union and Others*, C-354/95, EU:C:1997:379, paragraph 61, and of 16 September 2004, *Merida*, C-400/02, EU:C:2004:537, paragraph 22).

66 Furthermore, it must be observed that, although genuine use must be assessed on a case-by-case basis, that assessment does not consist mainly of taking into consideration the turnover or the volume of sales during the relevant period. The purpose of Article 51(1)(a) of Regulation No 207/2009 and Rule 22(3) of Regulation No 2868/95 is not to assess commercial success or to review the commercial strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (see, by analogy, judgment of 8 July 2004, *VITAFRUIT*, T-203/02, EU:T:2004:225, paragraphs 36 to 38).

67 The Board of Appeal found, after carrying out an overall assessment which took into account all the factors relevant to the particular case, that, with the exception of the contested goods in Classes 21 and 25, the evidence furnished by Wedl & Hofmann was not sufficient to prove that there had been genuine use of the contested mark in connection with the goods and services in Classes 7, 11, 20, 21, 25, 28, 30, 34 and 38.

68 Moreover, the assessment as to whether the use of a trade mark is genuine cannot result in small and large undertakings being treated differently, since that assessment is based on all the facts and circumstances relevant to establishing whether the commercial use of that mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (judgment of 8 July 2004, *VITAFRUIT*, T-203/02, EU:T:2004:225, paragraph 40).

69 It follows that it cannot be held that, in the assessment as to whether there has been genuine use of a mark, there is a difference in treatment depending on the size of the undertaking which is the proprietor of that mark, since the genuine nature of that use is assessed having regard to the same objective criteria described in paragraph 68 above, regardless of the size of the undertaking.

70 It follows from the foregoing that, in Case T-911/16, the plea alleging infringement of the principle of equal treatment must be rejected. As that plea and the plea alleging, in essence, infringement of Article 51(1)(a) of Regulation No 207/2009 have been rejected, the action in that case must therefore be rejected in its entirety.

Costs

71 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

72 Since Mr Hesse has been unsuccessful in Case T-910/16, he must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and Wedl & Hofmann.

73 Since Wedl & Hofmann has been unsuccessful in Case T-911/16, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and Mr Hesse.

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

- 1. Joins Cases T-910/16 and T-911/16 for the purposes of the judgment;**
- 2. Dismisses the actions;**
- 3. Orders Mr Kurt Hesse to pay the costs in Case T-910/16;**
- 4. Orders Wedl & Hofmann GmbH to pay the costs in Case T-911/16.**

Gratsias

Labucka

Ulloa Rubio

Delivered in open court in Luxembourg on 4 April 2019.

[Signatures]