



Reports of Cases

Case T-161/16

(publication by extracts)

Puma SE

v

European Union Intellectual Property Office

Order of the General Court (First Chamber), 22 May 2019

(EU trade mark — Opposition proceedings — International registration designating the European Union — Figurative mark CMS Italy — Earlier international figurative marks representing a feline bounding to the left — Relative grounds for refusal — Reputation of the earlier marks — Article 8(5) of Regulation (EC) No 207/2009 (now Article 8(5) of Regulation (EU) 2017/1001) — Evidence of reputation — Previous decisions of EUIPO recognising the reputation of the earlier marks — Taking account of those decisions — Obligation to state reasons — Principle of sound administration)

1. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation — Protection of the well-known earlier mark extended to dissimilar goods or services — Conditions — Reputation of the mark in the Member State or in the European Union — Evidence of reputation — Previous decisions of EUIPO finding that the earlier mark enjoys a reputation*
(Council Regulation No 207/2009, Art. 8(5); Commission Regulation No 2868/95, Art. 1, Rule 19(2)(c))

(see paragraphs 30, 31)

2. *EU trade mark — Decisions of EUIPO — Principle of equal treatment — Principle of sound administration — EUIPO's previous decision-making practice — Principle of legality — Need for a strict and comprehensive examination in each particular case*
(Council Regulation No 207/2009, Art. 75)

(see paragraphs 32, 33)

3. *EU trade mark — Definition and acquisition of the EU trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation — Protection of the well-known earlier mark extended to dissimilar goods or services — Conditions — Reputation of the mark in the Member State or in the European Union — Decision departing from the earlier decision-making practice of EUIPO as regards*

the reputation of the earlier mark — Obligation to state reasons — Principle of sound administration
(Council Regulation No 207/2009, Arts 8(5) and 75)

(see paragraphs 34, 46, 48)

Résumé

The case which gave rise to the order *Puma v EUIPO — CMS (CMS Italy)* (T-161/16), made on 22 May 2019, originated in PUMA's opposition to registration of the figurative mark CMS Italy, the main figurative element of which is a feline bounding to the right, on the basis of three international figurative mark registrations, the sole or main element of which is a feline bounding to the left, with effects in various Member States. The ground relied on in support of that opposition was that set out in Article 8(5) of Regulation No 207/2009¹ (now Article 8(5) of Regulation 2017/1001²).

That opposition had been rejected on the ground that the reputation of the earlier marks had not been established, the Opposition Division refusing in particular to take into consideration several previous decisions of the European Union Intellectual Property Office (EUIPO) which had established the reputation of some of those marks, which the opponent had invoked as evidence, on the ground that the legality of EUIPO's decisions had to be assessed on the basis of Regulation No 207/2009 as interpreted by the EU Courts, and not on the basis of previous decision-making practice. The appeal against that decision had been dismissed by the Board of Appeal, which had implicitly endorsed that assessment and rejected the evidence submitted by the applicant before it, on the ground, essentially, that it was not additional evidence, but main evidence.

By its reasoned order, made on the basis of Article 132 of the Rules of Procedure, the General Court declared the action manifestly well founded, having regard to the judgment of 28 June 2018, *EUIPO v Puma* (C-564/16 P, EU:C:2018:509), the findings of which it summarised. In particular, the General Court noted that, where previous decisions of EUIPO on which an opponent relies as evidence, in so far as they found that the earlier trade mark relied on in support of its opposition under Article 8(5) of Regulation No 207/2009 had a reputation, are detailed as regards the evidential basis and the facts on which that finding is based, those decisions constitute a strong indication that that mark may also be regarded as having a reputation for the purposes of that provision in the ongoing opposition proceedings.

In the circumstances, the General Court found that the applicant had specifically relied, as evidence of the reputation of the earlier marks, on three previous decisions of EUIPO which constituted a recent decision-making practice concluding that two of the three earlier marks enjoyed a reputation in relation to goods identical or similar to those in question and to some of the Member States concerned in the case in point. It was therefore incumbent on the Board of Appeal to take those decisions of EUIPO into account and to consider whether or not it should decide in the same way and, if not, to provide an explicit statement of its reasoning for departing from those decisions. By denying that those decisions had any relevance, the Board of Appeal infringed the principle of sound administration.

Consequently, the General Court annulled the contested decision of the Board of Appeal.

¹ Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).

² 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).