



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

17 April 2024*

(EU trade mark – Opposition proceedings – Application for EU figurative mark in Insajderi – Earlier national word mark INSAJDERI and earlier national figurative mark in Insajderi Gazetë online – Relative ground for refusal – Article 8(3) of Regulation (EU) 2017/1001 – Extent of the examination to be carried out by the Board of Appeal – Article 27(2) of Delegated Regulation (EU) 2018/625 – Failure to submit evidence – Translation – Article 7 of Delegated Regulation 2018/625 – Right to be heard – Article 41 of the Charter of Fundamental Rights – Article 94(1) of Regulation 2017/1001 – Possibility for the Board of Appeal to accept evidence submitted for the first time before it – Article 27(4) of Delegated Regulation 2018/625 – Article 95(2) of Regulation 2017/1001)

In Case T-119/23,

Insider LLC, established in Pristina (Republic of Kosovo), represented by M. Ketler, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by D. Gája, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO being

Florim Alaj, residing in Zug (Switzerland),

THE GENERAL COURT (Eighth Chamber),

composed of A. Kornezov, President, K. Kecsmár (Rapporteur) and S. Kingston, Judges,

Registrar: V. Di Bucci,

having regard to the written part of the procedure,

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,

* Language of the case: English.

gives the following

Judgment

- 1 By its action based on Article 263 TFEU, the applicant, Insider LLC, seeks annulment of the decision of the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 5 December 2022 (Case R 1152/2022-5) ('the contested decision').

Background to the dispute

- 2 On 16 June 2020, the other party to the proceedings before the Board of Appeal, Mr Florim Alaj, filed with EUIPO an application for registration of an EU trade mark in respect of the following figurative sign:

The image shows a stylized logo consisting of the letters 'in' in a green, lowercase, sans-serif font, followed by the word 'Insajderi' in a larger, black, uppercase, sans-serif font. The 'in' is positioned to the left of 'Insajderi'.

- 3 The mark applied for covered services in Class 41 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, corresponding to the following description: 'Providing information, news, and commentary in the field of current events in relation to education, entertainment and sport via the Internet'.
- 4 The applicant filed a notice of opposition to registration of the mark applied for in respect of the services referred to in paragraph 3 above.
- 5 The opposition was based on the following two earlier marks, registered in Kosovo, filed on 5 May 2020 and covering services in Classes 35, 38 and 41:
 - Kosovan word mark No 27 062 INSAJDERI;
 - Kosovan figurative mark No 27 063, represented below:

The image shows a smaller version of the stylized logo 'in Insajderi' described in the previous block. It features the letters 'in' in green followed by 'Insajderi' in black.

- 6 The ground relied on in support of the opposition was that set out in Article 8(3) of 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).
- 7 On 10 May 2022, the Opposition Division upheld the opposition and refused registration of the mark applied for in respect of all the services referred to in paragraph 3 above.
- 8 On 30 June 2022, the other party to the proceedings before the Board of Appeal of EUIPO filed a notice of appeal with EUIPO against the decision of the Opposition Division.

- 9 By the contested decision, the Board of Appeal granted the appeal, annulled the Opposition Division’s decision and rejected the opposition in its entirety, on the ground that the applicant had not demonstrated, before the end of the period prescribed for submitting facts, evidence and arguments in support of the opposition, the existence of the earlier marks claimed and its proprietorship of them, in accordance with Article 7(2) and Article 8(1) of Regulation 2017/1001. It found, inter alia, that the certified translations of the registration certificates for the earlier marks, provided by the applicant as evidence of the existence of those marks and of its proprietorship of them (‘the translations’), constituted unofficial translations in which the original text was not visible, making it impossible to verify whether essential information was mentioned in the original certificate.

Forms of order sought

- 10 The applicant claims that the Court should:
- annul the contested decision;
 - order EUIPO to pay the costs of the proceedings.
- 11 EUIPO contends that the Court should:
- dismiss the action in its entirety;
 - order the applicant to pay the costs in the event that a hearing is convoked.

Law

- 12 In support of its action, the applicant relies, in essence, on three pleas in law, alleging (i) infringement of Article 27(2) of Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation 2017/1001 and repealing Delegated Regulation (EU) 2017/1430 (OJ 2018 L 104, p. 1), (ii) infringement of Article 7 of that delegated regulation and of Articles 24 to 26 of Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation 2017/1001 and repealing Implementing Regulation (EU) 2017/1431 (OJ 2018 L 104, p. 37) and (iii) infringement of Article 41(1) of the Charter of Fundamental Rights of the European Union (‘the Charter’), read in conjunction with the second sentence of Article 94(1) of Regulation 2017/1001.
- 13 It is appropriate to begin by examining the first plea, followed by the third plea and, finally, if necessary, the second plea.

First plea: infringement of Article 27(2) of Delegated Regulation 2018/625

- 14 The applicant claims that the other party to the proceedings had not disputed before the Board of Appeal the existence of the earlier marks. Therefore, in examining that factor and the authenticity of the translations on its own initiative, the Board of Appeal infringed Article 27(2) of Delegated Regulation 2018/625. In that regard, the applicant submits that the Board of Appeal did not explain why that examination was necessary in order to ensure a correct application of Regulation

2017/1001 or how it concerned essential procedural requirements within the meaning of Article 27(2) of Delegated Regulation 2018/625. Last, the applicant asserts, in essence, that the question of the authenticity of translations is a matter of fact rather than one of law, such that the aforementioned article is not applicable in that regard.

- 15 EUIPO disputes the applicant's arguments.
- 16 As a preliminary point, it must be borne in mind that there is functional continuity between the different jurisdictions of EUIPO on the one hand, and the Boards of Appeal on the other. The review undertaken by the Boards of Appeal is not limited to the lawfulness of the decision which is the subject of the appeal brought before them, but, by virtue of the devolutive effect of the appeal proceedings, it requires a reappraisal of the dispute as a whole, since the Boards of Appeal must re-examine in full the initial application and take into account evidence produced in due time. Thus, it follows from Article 71(1) of Regulation 2017/1001 that, through the effect of the appeal before it, the Board of Appeal is called upon to carry out a full re-examination of the merits of the opposition, in both law and fact (see, to that effect, judgment of 7 December 2017, *Coca-Cola v EUIPO – Mitico (Master)*, T-61/16, EU:T:2017:877, paragraph 115 and the case-law cited).
- 17 As is apparent from Article 7(2) of Delegated Regulation 2018/625, the opposing party is to file evidence of the existence, validity and scope of protection of its earlier mark or right, by means, inter alia, of filing, registration or renewal certificates, as well as evidence proving its entitlement to file the opposition within the period prescribed for submitting facts, evidence and arguments in support of the opposition. In particular, if the opposition is based on Article 8(3) of Regulation 2017/1001, the opposing party is to provide evidence of its proprietorship of the prior trade mark and of its relationship with the agent or representative. Moreover, it is apparent from Article 7(4) of Delegated Regulation 2018/625 that filing, registration or renewal certificates are to be in the language of the proceedings or accompanied by a translation into that language.
- 18 It is in the light of those considerations that it is necessary to examine whether the Board of Appeal could, on the one hand, raise of its own motion the failure to submit the original registration certificates for the earlier marks and examine the existence, validity and scope of protection of the earlier marks and the fact that the applicant was the proprietor of them and, on the other hand, verify of its own motion the authenticity of the translations.
- 19 In that regard, it follows from the second sentence of Article 27(2) of Delegated Regulation 2018/625 that matters of law not raised by the parties may be examined by the Board of Appeal where it is necessary to resolve them in order to ensure a correct application of Regulation 2017/1001 having regard to the facts, evidence and arguments presented by the parties or where they concern essential procedural requirements.
- 20 It follows from Article 7 of Delegated Regulation 2018/625 that corroboration of an opposition by evidence of the existence, validity and scope of protection of the earlier marks on which the opposition is based, as well as entitlement of the opposing party to file the opposition under Article 8 of Regulation 2017/1001, are essential conditions for its success.
- 21 Therefore, the Board of Appeal was fully entitled to examine of its own motion the question of substantiation of the earlier mark in accordance with Article 7 of Delegated Regulation 2018/625, in so far as evidence of the existence, validity and scope of protection of the earlier marks on which the opposition is based, and of the fact that the opposing party is their proprietor, are necessary

conditions for the application of the relative grounds for refusal under Article 8(3) of Regulation 2017/1001. It follows that that substantiation of the earlier rights falls within the scope of the second sentence of Article 27(2) of Delegated Regulation 2018/625.

- 22 Furthermore, contrary to what the applicant claims, the question of the authenticity of the translations is a matter of law. As has been noted in paragraph 17 above, compliance with the obligation to substantiate the opposition and to provide translation in the language of the proceedings of the elements submitted for that purpose is a matter which the Board of Appeal is obliged to examine, in accordance with Article 7 of Delegated Regulation 2018/625, and which is liable to affect its assessment of the appeal brought before it. Furthermore, in the absence of a possibility of ensuring that the translations are in conformity with the original documents, the trade mark applicant may not have been able to defend itself adequately (see, to that effect and by analogy, judgment of 13 December 2016, *Guiral Broto v EUIPO – Gastro & Soul (CAFE DEL SOL)*, T-549/15, not published, EU:T:2016:719, paragraph 28).
- 23 The Board of Appeal was therefore justified, on the one hand, in raising of its own motion the failure to submit the original registration certificates for the earlier marks and in examining the existence, validity and scope of protection of the earlier marks and the fact that the applicant was the proprietor of them and, on the other hand, in verifying of its own motion the authenticity of the translations.
- 24 It follows that the first plea in law must be rejected as unfounded.

Third plea: infringement of Article 41(1) of the Charter, read in conjunction with the second sentence of Article 94(1) of Regulation 2017/1001

- 25 The applicant claims, in essence, that, by raising of its own motion, on the one hand, the failure to submit the original registration certificates for the marks at issue and, on the other hand, doubts as to the authenticity of the translations of those documents, without giving it the opportunity beforehand to comment on that issue, the Board of Appeal infringed Article 41(1) of the Charter in that it deprived the applicant of its right to be heard.
- 26 EUIPO disputes the applicant's arguments, contending, first, that the applicant did not submit, during the administrative procedure, any original registration certificate for the earlier marks, despite having received, on 8 March 2021, a communication in which EUIPO emphasised the applicant's obligation to substantiate the earlier rights within the period prescribed. In its view, the Board of Appeal was not obliged to rely solely on translations and could not verify, on that basis alone, whether essential information such as the filing date, the proprietor or the list of services was mentioned in the original certificate. In addition, EUIPO contends that the Board of Appeal did not breach the applicant's right to be heard, since the obligation of producing evidence to prove the existence, validity and scope of protection of the earlier marks, as well as evidence proving the applicant's entitlement to file the opposition, was known to the applicant by virtue of Article 7(2) of Delegated Regulation 2018/625. Last, the Board of Appeal was not obliged to inform the applicant of the flaws of the evidence it submitted in support of the opposition, in accordance with Article 8(1) and (9) of that delegated regulation.
- 27 It is important, first of all, to recall that, according to the second sentence of Article 94(1) of Regulation 2017/1001, decisions of EUIPO are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. That provision constitutes a specific application of the general principle of protection of the rights of the

- defence, enshrined, moreover, in Article 41(2)(a) of the Charter, according to which a person whose interests are affected by a decision of a public authority must be given the opportunity effectively to make his or her point of view known (judgment 8 June 2022, *Apple v EUIPO – Swatch (THINK DIFFERENT)*, T-26/21 to T-28/21, not published, EU:T:2022:350, paragraph 40).
- 28 All EU acts must respect fundamental rights, as recognised by the Charter, that respect constituting a condition of their lawfulness which it is for the EU Courts to review in the framework of the complete system of legal remedies established by the FEU Treaty, and the institutions, bodies, offices and agencies of the EU are required to respect the Charter (see, to that effect, judgment of 3 September 2008, *Kadi and Al Barakaat International Foundation v Council and Commission*, C-402/05 P and C-415/05 P, EU:C:2008:461, paragraphs 283 to 285, and Opinion 2/13 (*Accession of the European Union to the ECHR*) of 18 December 2014, EU:C:2014:2454, paragraphs 169 and 171).
- 29 The right to be heard in all proceedings, laid down in Article 41(2)(a) of the Charter, which is inherent in respect for the rights of the defence, guarantees every person the opportunity to make known his or her views effectively during an administrative procedure and before the adoption of a decision in relation to that person that is liable to affect his or her interests adversely (see judgment of 27 July 2022, *RT France v Council*, T-125/22, EU:T:2022:483, paragraph 75 and the case-law cited).
- 30 In addition, the right to be heard extends to all the factual and legal material which forms the basis of the decision, but not to the final position which the authority intends to adopt (see judgment of 7 February 2007, *Kustom Musical Amplification v OHIM (Shape of a guitar)*, T-317/05, EU:T:2007:39, paragraph 27 and the case-law cited).
- 31 EUIPO is under an obligation, in proceedings pending before its departments, to afford the parties the opportunity to express their point of view on all matters which form the basis of the decisions of those departments (see judgment of 20 March 2019, *Prim v EUIPO – Primed Halberstadt Medizintechnik (PRIMED)*, T-138/17, not published, EU:T:2019:174, paragraph 27 and the case-law cited).
- 32 In the case at hand, it is not disputed that the Board of Appeal rejected the opposition pursuant to Article 7(2) and Article 8(1) of Delegated Regulation 2018/625, without the applicant having had an opportunity to present its comments on the decisive ground of that decision. The Board of Appeal itself raised the absence of original versions of the registration certificates for the earlier marks as well as doubts as to the authenticity of the translations to infer, on that basis alone, as has been set out in paragraph 9 above, that the applicant had not demonstrated the existence of the earlier marks and its proprietorship of them and that, therefore, the opposition had to be rejected. As the applicant submits in its third plea, the fact that the Board of Appeal examined that issue of its own motion, without having heard it in the case on that point, constitutes a procedural irregularity (see, to that effect, judgment of 13 December 2016, *CAFE DEL SOL*, T-549/15, not published, EU:T:2016:719, paragraph 31 and the case-law cited).
- 33 A infringement of the rights of the defence may, however, be held to exist only provided that the failure to take into account the view of an interested party has had a concrete effect on the ability of that party to defend itself. Nevertheless, the applicant cannot be required to show that the contested decision would have been different in content but simply that such a possibility cannot be totally ruled out, since it would have been better able to defend itself had there been no procedural error (see, to that effect, judgments of 1 October 2009, *Foshan Shunde Yongjian*

Housewares and Hardware v Council, C-141/08 P, EU:C:2009:598, paragraph 94 and the case-law cited, and of 20 March 2019, *PRIMED*, T-138/17, not published, EU:T:2019:174, paragraph 28 and the case-law cited).

- 34 It must therefore be ascertained whether it cannot be entirely ruled out that, had it not been for the procedural irregularity referred to in paragraph 32 above, the outcome of the proceedings would have been different.
- 35 That is the case here. After all, had the Board of Appeal given the applicant the opportunity effectively to make known its views on the absence of the original versions of the registration certificates for the earlier marks, the latter would have been in a position to provide them, enabling the Board of Appeal to examine them and to ascertain the authenticity of the translations.
- 36 Accordingly, the contested decision was adopted in breach of the right to be heard guaranteed by Article 41(2)(a) of the Charter.
- 37 That finding is not called into question by EUIPO's arguments. First, in terms of EUIPO's argument that the submission of those original certificates at that stage was late, it should be recalled that, pursuant to Article 95 of Regulation 2017/1001, EUIPO may disregard facts or evidence which are not submitted in due time by the parties concerned.
- 38 As the Court of Justice has held, it follows from the wording of that provision that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the periods to which such submission is subject under the provisions of Regulation 2017/1001 and that EUIPO is in no way prohibited from taking account of facts and evidence which are submitted or produced out of time (see judgment of 20 March 2019, *PRIMED*, T-138/17, not published, EU:T:2019:174, paragraph 46 and the case-law cited).
- 39 By stating that EUIPO 'may' decide to disregard such evidence, Article 95(2) of Regulation 2017/1001 grants EUIPO broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account (see judgment of 20 March 2019, *PRIMED*, T-138/17, not published, EU:T:2019:174, paragraph 47 and the case-law cited).
- 40 Furthermore, it follows from the case-law that no reason of principle related to the nature of the proceedings under way before the Board of Appeal or to the jurisdiction of that department precludes it, for the purpose of giving judgment on the appeal before it, from taking into account facts and evidence produced for the first time before it (see judgment of 20 March 2019, *PRIMED*, T-138/17, not published, EU:T:2019:174, paragraph 48 and the case-law cited).
- 41 In addition, under Article 27(4) of Delegated Regulation 2018/625, the Board of Appeal may accept evidence submitted for the first time before it only where that evidence satisfies two conditions: on the one hand, it '[is], on the face of it, likely to be relevant for the outcome of the case', and, on the other hand, it '[has] not been produced in due time for valid reasons, in particular where [it is] merely supplementing relevant facts and evidence which had already been submitted in due time, or [is] filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal'.

- 42 In the case at hand, since the Board of Appeal called into question the authenticity of the translations and found that, by not providing the original versions of the registration certificates for the earlier marks on which the opposition was based, the applicant had not complied with the requirements laid down in Article 7(2) and Article 8(1) of Delegated Regulation 2018/625 in terms of evidence of the existence of the marks and of the fact that the applicant was the proprietor of them, such that its opposition was rejected as unfounded, as has been found in paragraph 35 above, it cannot be ruled out that, had the applicant been heard on that point, it could have submitted the original versions of those certificates, that, pursuant to Article 27(4) of Delegated Regulation 2018/625, the Board of Appeal could have accepted them and that, consequently, the outcome of the opposition proceedings would have been different.
- 43 Second, contrary to what EUIPO claims, its communication to the applicant of 8 March 2021 cannot be regarded as inviting it to present its comments on the absence of original versions of the registration certificates for the earlier marks or on the authenticity of the translations. What is at issue in this case is a standardised communication, which makes no mention of the issues relating to the existence, validity and scope of protection of the earlier marks and to their proprietorship that the Board of Appeal intended to raise of its own motion, on the basis of Article 7(2) and Article 8(1) of Delegated Regulation 2018/625.
- 44 Furthermore, the fact that, at the stage of the proceedings before the Opposition Division, the applicant was informed of its obligation to substantiate the earlier marks within the period prescribed is irrelevant in assessing whether the rights of the defence were respected at the stage of the proceedings before the Board of Appeal. Since the powers of the Boards of Appeal imply that they are to re-examine decisions taken by EUIPO's departments and, in the present case, the Board of Appeal raised of its own motion the lack of evidence of the existence, validity and scope of protection of the earlier marks, that information cannot be held to have enabled the applicant effectively to make known before the Board of Appeal its point of view regarding the rejection of its opposition as a result of the failure to produce the original versions of the registration certificates for the earlier marks and doubts as to the authenticity of the translation of those certificates (see, to that effect and by analogy, judgment of 13 December 2016, *CAFE DEL SOL*, T-549/15, not published, EU:T:2016:719, paragraph 43).
- 45 Third, it follows from the wording of Article 8(1) of Delegated Regulation 2018/625 that, where no evidence is provided within the period prescribed, or where the evidence provided is manifestly irrelevant or manifestly insufficient to meet the requirements laid down in Article 7(2) of that delegated regulation for any of the earlier rights, the opposition is to be rejected as unfounded. Such a conclusion cannot be drawn, however, where certain of that evidence has been produced within the period prescribed or where it is not manifestly irrelevant or manifestly insufficient. In the case at hand, it is common ground that the applicant submitted before the Opposition Division, within the period prescribed, translations of the registration certificates for the earlier marks. That evidence is not manifestly irrelevant or manifestly insufficient, since, had the applicant been heard and produced the originals of those certificates during the proceedings before the Board of Appeal, the Board of Appeal would in no case have been obliged to reject the opposition on the basis of Article 8(1) of Delegated Regulation 2018/625. That article does not constitute a rule which prevents the Board of Appeal from making use of the discretion conferred on it by Article 95(2) of Regulation 2017/1001, since Article 8(1) of Delegated Regulation 2018/625 must be interpreted in such a way that it is consistent with the superior rules of law set out in Regulation 2017/1001 and Article 41 of the Charter (see, to that effect, judgment of 13 December 2016, *CAFE DEL SOL*, T-549/15, not published, EU:T:2016:719, paragraph 38).

- 46 Fourth, in so far as EUIPO submits that it cannot be required to invite a party expressly to submit evidence, it should be recalled that it was for the Board of Appeal to ensure that the conditions laid down by Article 41(2) of the Charter and the second sentence of Article 94(1) of Regulation 2017/1001 had been complied with, something which did not occur in the present case (see, to that effect, judgment of 20 March 2019, *PRIMED*, T-138/17, not published, EU:T:2019:174, paragraph 44 and the case-law cited).
- 47 For all the foregoing reasons, it is appropriate to uphold the third plea in law and, without it being necessary to rule on the second plea in law, to annul the contested decision.

Costs

- 48 Under Article 134(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.
- 49 Since EUIPO has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant.

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

- 1. Annuls the decision of the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 5 December 2022 (Case R 1152/2022-5);**
- 2. Orders EUIPO to bear its own costs and to pay those incurred by Insider LLC.**

Kornezov

Kecsmár

Kingston

Delivered in open court in Luxembourg on 17 April 2024.

V. Di Bucci
Registrar

S. Papasavvas
President