



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

29 November 2012*

(Community trade mark — Invalidity proceedings — Community word mark Fagumit and Community figurative mark FAGUMIT — Earlier national figurative mark FAGUMIT — Relative ground for invalidity — Article 8(3) and Article 165(4)(b) of Regulation (EC) No 207/2009)

In Cases T-537/10 and T-538/10,

Ursula Adamowski, residing in Hamburg (Germany), represented by D. von Schultz, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by G. Schneider, acting as Agent,

defendant,

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

Fabryka Węży Gumowych i Tworzyw Sztucznych Fagumit sp. z o.o., established in Wolbrom (Poland), represented by M. Krekora, T. Targosz and P. Podrecki, lawyers,

TWO ACTIONS brought against two decisions of the First Board of Appeal of OHIM of 3 September 2010 (Cases R 1002/2009-1 and R 1003/2009-1), concerning invalidity proceedings between Fabryka Węży Gumowych i Tworzyw Sztucznych Fagumit sp. z o.o. and Ursula Adamowski,

THE GENERAL COURT (Second Chamber),

composed of N.J. Forwood (Rapporteur), President, F. Dehousse and J. Schwarcz, Judges,

Registrar: E. Coulon,

having regard to the applications lodged at the Registry of the General Court on 26 November 2010,

having regard to the responses of OHIM lodged at the Court Registry on 5 April 2011,

having regard to the responses of the intervener lodged at the Court Registry on 17 March 2011,

having regard to the replies lodged at the Court Registry on 1 July 2011,

* Language of the case: German.

having regard to the rejoinders of the intervener lodged at the Court Registry on 26 September 2011,

having regard to the observations of the parties on the joining of the present cases for the purposes of judgment,

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having decided, acting upon a report of the Judge-Rapporteur, to give a ruling without an oral procedure, pursuant to Article 135a of the Rules of Procedure of the General Court,

gives the following

Judgment

- 1 On 18 February and 12 March 2003 respectively, the applicant, Ursula Adamowski, filed two Community trade mark applications at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) 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 Community trade mark (OJ 2009 L 78, p. 1)).
- 2 The mark in respect of which registration was sought on 18 February 2003 is the figurative sign reproduced below:



- 3 The mark in respect of which registration was sought on 12 March 2003 is the word sign Fagumit.
- 4 The goods in respect of which registration was sought are in Classes 12 and 17 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, and correspond to the following description:
 - Class 12: Rubber being end-products for the motor vehicle industry, namely new tyres, including being solid rubber tyres and clincher bands;
 - Class 17: Hoses; rubber being semi-finished goods in the form of film, sheets, rods, profiles, blocks, cords, bands, pipes and tubes: rubber being end-products for industrial tubes, namely PVC tubes, water hoses, air hoses, cable protection tubes, abrasion-resistant tubes, fuel lines, tubes for chemicals, autogenous tubes, acetylene hoses, propane hoses and double hoses; rubber being end-products for the motor vehicle industry, namely retreaded tyres, including being solid rubber tyres and clincher bands; tubes, intermediate rings (distance rings) and gaskets.
- 5 The marks referred to in paragraphs 2 and 3 above were registered on 28 June 2004.

- 6 On 7 and 8 April 2008, the intervener, Fabryka Węży Gumowych i Tworzyw Sztucznych Fagumit sp. z o.o., made two applications for a declaration of invalidity in respect of the contested marks pursuant to:
- Article 51(1)(b) of Regulation No 40/94 (now Article 52(1)(b) of Regulation No 207/2009), on the ground that the applicant was acting in bad faith when she filed the trade mark applications;
 - Article 52(1)(b) of Regulation No 40/94 (now Article 53(1)(b) of Regulation No 207/2009), on the ground that the applicant acted in her own name when filing the applications for registration of the contested marks without the consent of the intervener, which is the proprietor of the Polish mark reproduced below, registered on 15 January 1997 in respect of ‘rubber hoses, PVC hoses’ in Class 17 of the Nice Agreement:



- Article 52(1)(c) of Regulation No 40/94 (now Article 53(1)(c) of Regulation No 207/2009), on the basis of the intervener’s business name, registered in Poland in 1993 and used in the course of trade, in the export of goods to various Members States including, inter alia, Germany since 1993.
- 7 By two decisions of 25 June 2009, the Cancellation Division rejected the applications for a declaration of invalidity.
- 8 On 27 August 2009, the intervener filed two notices of appeal at OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decisions of the Cancellation Division.
- 9 By two decisions of 3 September 2010 (‘the contested decisions’), the First Board of Appeal upheld the appeal, annulled the decisions of the Cancellation Division and, after finding that the three grounds of invalidity relied on by the intervener were well founded, declared the contested marks to be invalid.
- 10 In particular, as regards the ground based on Article 53(1)(c) of Regulation No 207/2009 (see the third indent of paragraph 6 above), the Board of Appeal found that the intervener had adduced evidence of use of the term ‘fagumit’ in the course of international trade since 1 June 1997, by means of exports to, inter alia, Germany pursuant to a distribution agreement concluded with the company Adamex Handels- u. Transportgesellschaft mbH, managed by the applicant. That sign was protected in Germany under Article 5(2) of the Markengesetz (German Trade Mark Law). So far as concerns the ground alleging breach of Article 53(1)(b) of Regulation No 207/2009 (see the second indent of paragraph 6 above), the Board of Appeal stated, first of all, that the contested mark reproduced in paragraph 3 above constitutes the dominant element of the Polish mark on which the application for a declaration of invalidity is based, whereas the contested mark reproduced in paragraph 2 above is essentially a reproduction of the Polish mark. Since the terms ‘agent or representative’, used in Article 8(3) of Regulation No 207/2009, also cover the manager of the agent, representative or distributor and in so far as a document of 10 April 1998 cannot be considered to be consent for the applicant to register the contested marks, the Board of Appeal also found that ground to be well founded. With regard to the ground based on Article 52(1)(b) of Regulation No 207/2009, the Board of Appeal noted that, pursuant to the aforementioned distribution agreement, the applicant was obliged to ensure that the intervener’s commercial interests were protected — an objective which was

compromised by the Community trade mark applications — whereas the document of 10 April 1998 could not establish that the applicant acted in good faith when she filed the trade mark applications in question. In the absence of any other circumstances to show that the intervener surrendered its rights under the sign Fagumit or that the applicant acted in good faith, that ground must also be found to be well founded.

Form of order sought

11 The applicant claims that the Court should:

- annul the contested decisions;
- dismiss the applications for annulment;
- order OHIM to pay the costs relating to the proceedings before the Cancellation Division, the Board of Appeal and the Court.

12 OHIM and the intervener contend that the Court should:

- dismiss the actions;
- order the applicant to pay the costs.

Law

- 13 After hearing the views of the parties on that point, it is appropriate that these cases should be joined for the purposes of judgment, in accordance with Article 50 of the Rules of Procedure of the General Court.
- 14 In both of the present cases, the applicant relies on three pleas in law, alleging (i) breach of Article 53(1)(c), read in conjunction with Article 8(4) of Regulation No 207/2009, (ii) breach of Article 53(1)(b), read in conjunction with Article 8(3) of Regulation No 207/2009, and (iii) breach of Article 52(1)(b) of Regulation No 207/2009.
- 15 As OHIM submits, each of the grounds for invalidity accepted by the Board of Appeal constitute sufficient grounds for a declaration of invalidity in respect of the contested marks. In that context, the Court will first examine the second plea in law which concerns the ground for invalidity laid down in Article 53(1)(b) of Regulation No 207/2009.
- 16 In that plea, the applicant claims, first, that Article 165(4)(b) of Regulation No 207/2009 precludes the intervener from relying on Article 53(1)(b) of that regulation.
- 17 That argument cannot be upheld. Article 165(4)(b) of Regulation No 207/2009 provides that a Community trade mark may not be declared invalid pursuant to Article 53(1) and (2) of that regulation if the earlier right was registered, applied for or acquired prior to 1 May 2004 in a State having acceded to the European Union on that date.
- 18 The purpose of that provision is to exclude the possibility of a Community trade mark registered or filed before 1 May 2004 from being challenged solely on the basis of the accession of certain States to the European Union, when that possibility did not exist before that accession. The provision in question does not therefore seek to preclude the proprietor of a mark from making, after 1 May 2004, an application for a declaration of invalidity where it had been possible to do so before that date.

- 19 In that regard, the ground of invalidity laid down in Article 53(1)(b) of Regulation No 207/2009 may be relied on by the proprietor of the mark referred to in Article 8(3) of that regulation, even if that mark was registered only in a country outside the European Union. Unlike Article 8(1), (2), (4) and (5) of Regulation No 207/2009, Article 8(3) of that regulation does not refer to marks registered in a Member State or having effect in such a State. Moreover, if registration of the mark in a Member State were a condition for the application of Article 8(3) of Regulation No 207/2009, that provision would overlap with Article 8(1) and (5). It must therefore be found, as OHIM did, that the intervener could have brought the applications for a declaration of invalidity referred to in paragraph 6 above even before the Republic of Poland's accession to the European Union, with the result that Article 165(4)(b) of Regulation No 207/2009 neither affects the validity of those applications nor the legality of the contested decisions.
- 20 In the present case, the applicant focuses her line of argument on the consent allegedly granted by the proprietor of the mark reproduced in the second indent of paragraph 6 above, and does not dispute her own status as agent or representative of the intervener. In that context, the applicant claims that she obtained the intervener's consent prior to making the applications mentioned in paragraphs 1 to 3 above, by virtue of a document of 10 April 1998.
- 21 OHIM and the intervener contest that assessment.
- 22 The application of Article 8(3) of Regulation No 207/2009 requires the applicant for the mark to be or to have been the agent or representative of the proprietor of the mark and the application to have been filed in the name of the agent or representative without the proprietor's consent and without there being legitimate reasons to justify the agent's or representative's action. That provision is designed to prevent the misuse of a mark by the trade mark proprietor's agent, as the agent may exploit the knowledge and experience acquired during its business relationship with the proprietor and therefore improperly benefit from the effort and investment which the trade mark proprietor himself made (Case T-6/05 *DEF-TEC Defense Technology v OHMI - Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)* [2006] ECR II-2671, paragraph 38).
- 23 Consent for the purposes of the registration of the mark in the name of the representative or agent must be clear, specific and unconditional (see, to that effect, *FIRST DEFENSE AEROSOL PEPPER PROJECTOR*, paragraph 40). However, in the present case, it must be found that, as the Board of Appeal held, the document of 10 April 1998 relied on by the applicant does not fulfil those conditions.
- 24 In particular, according to that document sent to Adamex Industrie GmbH, the intervener's representative agreed to the use ('Benutzung') of the 'original symbol' ('Or[i]ginal-Symbols') and the company 'designation' ('Bezeichnung') of the company Fagumit throughout Europe as well as the reservation ('Vorbehalt') of that symbol and stated that, according to him, that possibility concerned the companies Fagumit GmbH Deutschland, Fagumit SARL Frankreich and Fagumit Schweiz.
- 25 In that context, it must first be noted that the document in question does not refer to the possibility for the applicant to file an application for registration of the sign reproduced in paragraph 2 above as a Community trade mark. In that regard, it should be observed that the applicant is not mentioned in that document and that the document does not refer to the possibility of registration of that sign as a Community trade mark.
- 26 Second, although, as the applicant claimed before the Cancellation Division and the Board of Appeal, the companies Fagumit Deutschland, Fagumit Frankreich and Fagumit Schweiz did not exist at the time that the document in question was sent, that document can easily be perceived as meaning that the intervener did not object to the companies in question operating under the trade name Fagumit and using, at most on an exclusive basis, the associated mark in the course of their business.

- 27 The applicant cannot rely on the fact that the intervener did not object to the use of the sign at issue by companies other than those referred to in the document of 10 April 1998. In that regard, as the applicant points out in paragraph 33 of her applications, and as is apparent from the documents submitted by her before OHIM, use of the mark in question occurred during the course of marketing the goods produced by the intervener. However, such use is the logical consequence of the cooperation between the intervener and the distributors of its goods and does not show any abandonment of the sign reproduced in the second indent of paragraph 6 above, which would enable anyone to make an application for the registration of that sign — or its dominant element — as a Community trade mark.
- 28 It follows that the Board of Appeal did not err in finding that the document of 10 April 1998 cannot be perceived as granting the applicant consent, within the meaning of Article 8(3) of Regulation No 207/2009, to apply for registration of the contested marks.
- 29 In that context, the fact, relied on by the applicant, that her relationship with the intervener was not governed by formal requirements, with the result that the list of companies concerned by the document of 10 April 1998 cannot be considered to be exhaustive, is irrelevant. Since the document in question does not constitute consent within the meaning of Article 8(3) of Regulation No 207/2009, that circumstance, were it established, does not render the Board of Appeal's conclusion invalid.
- 30 Consequently, the second plea in law must be rejected and, for the reasons set out in paragraph 15 above, it is necessary to dismiss the actions in their entirety.

Costs

- 31 Under Article 87(2) 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. As the applicant has been unsuccessful, she must be ordered to pay the costs incurred by OHIM and the intervener, as applied for by them.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Orders that Cases T-537/10 and T-538/10 be joined for the purposes of judgment;**
- 2. Dismisses the actions;**
- 3. Orders Ursula Adamowski to bear her own costs and to pay those incurred by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and by Fabryka Węży Gumowych i Tworzyw Sztucznych Fagumit sp. z o.o. relating to the proceedings before the Court.**

Forwood

Dehousse

Schwarcz

Delivered in open court in Luxembourg on 29 November 2012.

[Signatures]