



Reports of Cases

JUDGMENT OF THE GENERAL COURT (First Chamber)

28 October 2015*

(Community trade mark — Opposition proceedings — Application for Community figurative mark
Maccka — Unregistered earlier national figurative mark Maccka — Relative ground for refusal —
Article 8(4) of Regulation (EC) No 207/2009 — Application by OHIM of national law)

In Case T-96/13,

Rot Front OAO, established in Moscow (Russia), represented initially by B. Térauda, and subsequently
by O. Spuhler and M. Geitz, lawyers,

applicant,

v

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

defendant,

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

Rakhat AO, established in Almaty (Kazakhstan),

ACTION brought against the decision of the Second Board of Appeal of OHIM of 28 November 2012
(Case R 893/2012-2) concerning opposition proceedings between Rot Front OAO and Rakhat AO,

THE GENERAL COURT (First Chamber),

composed of H. Kanninen, President, I. Pelikánová and E. Buttigieg (Rapporteur), Judges,

Registrar: I. Dragan, Administrator,

having regard to the application lodged at the Court Registry on 22 February 2013,

having regard to the response of OHIM lodged at the Court Registry on 31 May 2013,

having regard to the reply lodged at the Court Registry on 2 August 2013,

further to the hearing on 20 March 2015,

gives the following

* Language of the case: English.

Judgment

Background to the dispute

- 1 On 26 November 2010, Rakhat AO filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).
- 2 Registration as a mark was sought for the following figurative sign:

Macka

- 3 The goods in respect of which registration was sought are in Classes 29 and 30 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 29: ‘Fruit snacks, marmalades, jams, crystallised fruits, jellies for food, fruit pulp, fruit jellies, fruit chips, in particular dried or crystallised, preserved or crystallised fruits, fruit preserved in alcohol, roasted almonds, roasted nuts, brittle, flaked coconut’;
 - Class 30: ‘Sweetmeats, sugar confectionery, including being decorations for Christmas trees, sugared almonds, ices, sorbets, popcorn, puddings, pralines, including with liquid centres, in particular of spirits, confectionery in the form of pastilles, marzipan, almond confectionery, confectionery in the form of jellied fruits, confectionery in the form of fudge, nut confectionery, sweets, caramels (candy), chocolate, coatings, chocolate in blocks, bars or balls, in particular soft melt-in-the-mouth chocolate, filled chocolate, chocolate or pralines combined with nuts or other fruits, with liqueurs or syrups; Caramels, dragees, chewing gum, not for medical purposes; Wine gums; Marshmallows; Liquorice juice; Liquorice; Persipan; Nougat’.
- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 2011/019 of 28 January 2011.
- 5 On 14 April 2011, the applicant, Rot Front OAO, filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.

- 6 The opposition was based on the unregistered figurative mark used in the course of trade in respect of confectionery in Greece and Germany, reproduced below:



- 7 The ground relied on in support of the opposition was that set out in Article 8(4) of Regulation No 207/2009.
- 8 By decision of 12 April 2012, the Opposition Division rejected the opposition. It held, in essence, that the applicant had failed to show that it had acquired, in accordance with the German law under which the unregistered earlier mark was protected, the right to prohibit the use of the trade mark applied for. In particular, the relatively limited volume of sales of the goods concerned in the light of the size of the confectionery market in Germany did not allow it to be established that the earlier mark had acquired sufficient recognition ('Verkehrsgeltung'), for the purposes of Paragraph 4(2) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen of 25 October 1994 (Law on the protection of trade marks and other distinctive signs) (BGBl. I, p. 3082) ('the Markengesetz'), amongst the relevant public consisting of the entirety of the German population.
- 9 On 7 May 2012, the applicant filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.
- 10 By decision of 28 November 2012 ('the contested decision'), the Second Board of Appeal of OHIM upheld the decision of the Opposition Division. First of all, it held that, since the applicant had failed to prove the use of more than mere local significance within the meaning of Article 8(4) of Regulation No 207/2009 with respect to its unregistered earlier mark in Greece, the opposition was inadmissible or, in any event, unfounded, in so far as that earlier right had been invoked in its support. Next, the Board of Appeal stated that, in order to oppose the registration of the trade mark applied for, the applicant had to prove that it had acquired the right to prohibit the use thereof before the date of its registration in accordance with the legislation in Germany where the unregistered earlier mark had also been used. In that regard, it had to prove that that trade mark was recognised by a substantial part of the relevant public as belonging to the applicant, for the purposes of Paragraph 4(2) of the Markengesetz. The Board of Appeal held, like the Opposition Division, that, in the light of the goods concerned which are for everyday consumption and are purchased by the general public, the relevant public consisted of the entirety of the German population. The fact that the trade mark was written in characters of the Cyrillic alphabet or that the goods at issue were distributed in Germany by means of shops visited principally by Russian-speaking consumers did not, in the opinion of the Board of Appeal, allow it to be concluded that the relevant public consisted solely of those Russian-speaking consumers. Finally, the Board of Appeal held that, even if the evidence concerning the volumes of sales of confectionery under the earlier trade mark produced by the applicant was admitted, it was in any event not possible, in the absence of other information, to assess the intensity of those sales with

a view to determining the impact of the trade mark on the relevant German public. As a result, the Board of Appeal held that the applicant had failed to prove that the unregistered earlier trade mark was recognised by a substantial part of that public as a trade mark belonging to it within the meaning of German law, and therefore had failed to satisfy one of the conditions of Article 8(4) of Regulation No 207/2009, namely to have acquired, on the basis of that trade mark and according to the legislation of the Member State applicable to that sign, the right to prohibit the use of a more recent trade mark.

Forms of order sought

11 The applicant claims that the Court should:

- annul the contested decision;
- order OHIM to pay the costs.

12 OHIM contends that the Court should:

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

Law

Admissibility

- 13 In the response, OHIM contested the admissibility, first, of certain documents annexed to the application on the ground that those documents had been produced for the first time before the Court and, secondly, of certain references made in the application to national case-law and academic writing as constituting new facts.
- 14 In reply to a written question from the Court, and to a question asked at the hearing, OHIM withdrew part of its objections concerning the admissibility of the decisions of national courts and the academic writing produced for the first time before the Court and of the references made by the applicant in their regard.
- 15 In any event, it should be borne in mind in that regard that, even if certain decisions of national courts and extracts from academic writings are submitted by the applicant for the first time before the Court, the applicant is entitled to refer to them in so far as they are documents and arguments relating to national legislation and the national courts' judicial practice. It is apparent from the case-law that neither the parties nor the Court itself can be precluded from drawing on national legislation, case-law or academic writing for the purposes of interpreting national law to which, as in the present case, EU law makes reference (see paragraph 19 below), where it is not alleged that the Board of Appeal failed to take the factual aspects of a specific national judgment into account, but rather reliance is placed on judgments or academic writing in support of a plea alleging that the Board of Appeal misapplied a provision of national law (see, to that effect, judgment of 12 July 2006 in *Vitakraft-Werke Wührmann v OHIM — Johnson's Veterinary Products (VITACOAT)*, T-277/04, ECR, EU:T:2006:202, paragraphs 70 and 71).

- 16 Only the question as to the admissibility of the documents produced as Annex A.5 to the application remains open. The applicant claims that those documents must be declared admissible because they do not present any new arguments in relation to those which are already apparent from the other documents produced before OHIM.
- 17 The documents included as Annex A.5 to the application consist of an article entitled ‘Russian supermarkets in Germany: the samovar — not to Tula’, in Russian, together with its English translation, published on the website ‘www.dw.de’. Contrary to what the applicant claims, the article at issue, produced for the first time before the Court, amounts to a new factual aspect in support of the arguments already put forward before OHIM and cannot be taken into consideration within the context of the present action. The purpose of actions before the Court is to review the legality of decisions of the Boards of Appeal of OHIM for the purposes of Article 65 of Regulation No 207/2009, so it is not the Court’s function to review the facts in the light of documents produced for the first time before it. Accordingly, the documents produced in Annex A.5 to the application must be excluded, without it being necessary to assess their probative value (see, to that effect, judgment of 24 November 2005 in *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)*, T-346/04, ECR, EU:T:2005:420, paragraph 19 and the case-law cited).

Substance

- 18 In support of its action, the applicant relies on a single plea in law, alleging infringement of Article 8(4) of Regulation No 207/2009, in so far as the Board of Appeal erred in its interpretation of Paragraph 4(2) of the Markengesetz on the basis of which the applicant claims the protection of its unregistered earlier mark in so far as it was used in Germany. However, the applicant does not call into question the Board of Appeal’s finding that the opposition was unfounded in so far as the earlier right used in Greece was invoked in its support.
- 19 In that regard, it should be borne in mind that, under Article 8(4) of Regulation No 207/2009, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for is not to be registered where and to the extent that, pursuant to the law of the Member State governing that sign, rights to that sign were acquired prior to the date of application for registration of the Community trade mark and that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark (see, to that effect, judgment of 18 April 2013 in *Peek & Cloppenburg v OHIM — Peek & Cloppenburg (Peek & Cloppenburg)*, T-507/11, EU:T:2013:198, paragraph 18 and the case-law cited; see also, by analogy, judgment of 9 December 2010 in *Tresplain Investments v OHIM — Hoo Hing (Golden Elephant Brand)*, T-303/08, ECR, EU:T:2010:505, paragraphs 89 and 90).
- 20 These conditions are cumulative. Thus, where a trade mark does not satisfy one of those conditions, the opposition based on the existence of a non-registered trade mark or of other signs used in the course of trade within the meaning of Article 8(4) of Regulation No 207/2009 cannot succeed (judgment of 30 June 2009 in *Danjaq v OHIM — Mission Productions (Dr. No)*, T-435/05, ECR, EU:T:2009:226, paragraph 35).
- 21 As regards the unregistered earlier mark in so far as it was used in Germany, the Board of Appeal began its assessment of the opposition by examining whether the applicant had acquired, prior to the date of application for registration of the Community trade mark, in accordance with the German law applicable in the present case, the right to prohibit the use of a subsequent trade mark, within the meaning of Article 8(4)(b) of Regulation No 207/2009.
- 22 The applicant submits that Paragraph 4(2) of the Markengesetz recognises the acquisition of rights over a trade mark by use which leads to recognition by the relevant public, namely the target public of the goods referred to, that the sign belongs to the proprietor. The applicant takes the view that, in

the present case, the Board of Appeal erred in the interpretation of that provision and, as a result, misapplied Article 8(4) of Regulation No 207/2009 in so far as it took into consideration, when assessing whether the earlier mark is recognised by the relevant public, the entirety of the German public, although German law makes it possible, under certain conditions, to limit the relevant public by taking account only of consumers with a command of a certain foreign language or in relation to the distribution channels of the goods covered by the mark at issue. The applicant submits that, in the present case, the conditions are satisfied to limit the relevant public to Russian-speaking consumers in Germany. The applicant bases its interpretation of German law on several German supreme court judgments, an extract from a commentary on the Markengesetz and a judgment of the Swiss Federal Court.

- 23 OHIM concurs, in essence, with the Board of Appeal's assessment and takes the view that the applicant failed to prove, as it had to, that the earlier trade mark was recognised by a substantial part of the German public, as is required by Paragraph 4(2) of the Markengesetz, with the result that it may not oppose the registration of the trade mark applied for. OHIM submits that, in the light of the evidence produced by the applicant before the Board of Appeal as regards the content of German law, neither the fact that the goods covered by the earlier trade mark were sold only in certain specialist shops aimed essentially at Russians living in Germany, nor the use of Cyrillic characters in the earlier trade mark justified a limitation of the relevant public only to Russian-speaking consumers.
- 24 In that regard, it should be observed that the question of the extent to which a sign which is protected in a Member State confers the right to prohibit the use of a subsequent trade mark must be examined in the light of the applicable national law (see judgment of 10 July 2014 in *Peek & Cloppenburg v OHIM*, C-325/13 P and C-326/13 P, EU:C:2014:2059, paragraph 47 and the case-law cited). To that end, account must be taken, in particular, of the national legislation relied on and the judicial decisions delivered in the Member State concerned (judgment of 29 March 2011 in *Anheuser-Busch v Budějovický Budvar*, C-96/09 P, ECR, EU:C:2011:189, paragraph 190) and of academic writings (see, by analogy, judgment of 5 July 2011 in *Edwin v OHIM*, C-263/09 P, ECR, EU:C:2011:452, paragraph 53).
- 25 Under German law, which is applicable in the present case, the right of the proprietor of a non-registered trade mark to oppose the use of a subsequent trade mark is governed by Paragraph 4(2) in conjunction with Paragraph 14(2) of the Markengesetz.
- 26 Paragraph 4 of the Markengesetz provides:
- ‘Trade mark protection shall accrue ...
2. through the use of a sign in the course of trade in so far as the sign has acquired recognition as a trade mark within the affected trade circles
- ...’
- 27 Paragraph 14(2)(2) of the Markengesetz prohibits the use by a third party in the course of trade, without the proprietor's consent, of a sign, such as a Community trade mark, which would be capable of leading to a likelihood of confusion with the protected sign.
- 28 The parties are in agreement that, pursuant to Paragraph 4(2) of the Markengesetz, a right in respect of an unregistered trade mark can be obtained through use only on condition that that use leads to the recognition of that mark by a substantial part of the relevant public. By contrast, the parties do not agree on the definition of the relevant public ('beteiligte Verkehrskreise') which must be taken into consideration in the assessment of that recognition for the purposes of Paragraph 4(2) of the Markengesetz.

- 29 In that regard, in the first place, it must be held that the Board of Appeal erred in law when it rejected, by referring to the case-law of the Court concerning Regulation No 207/2009, the applicant's argument that the relevant public to be taken into account in the present case had to be limited only to Russian or Russian-speaking consumers in Germany on the ground that the goods covered by the earlier mark were sold only in shops which were specifically intended for them. As has been noted in paragraph 24 above, the question of the extent to which an unregistered earlier mark protected in a Member State confers on its proprietor the right to prohibit the use of a subsequent trade mark must be examined in the light of the criteria laid down by the national law of the Member State where the sign relied on was used — namely, in the present case, German law — including national case-law and academic writing, and not in the light of the case-law of the Court concerning the application of Regulation No 207/2009.
- 30 In the second place, as regards the examination of national law pursuant to which the applicant claims to have acquired the right to oppose the registration of the trade mark applied for on the basis of its unregistered mark — namely Paragraph 4(2) in conjunction with Paragraph 14(2) of the Markengesetz —, it should be observed that it is indeed apparent from the case-law that the opponent must establish that the earlier sign relied on in support of the opposition falls within the scope of the law of the Member State relied on and that it allows use of a subsequent mark to be prohibited (judgment in *Anheuser-Busch v Budějovický Budvar*, cited in paragraph 24 above, EU:C:2011:189, paragraph 190). That rule places on the opponent the burden of providing OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law which he is seeking to have applied, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also with particulars establishing the content of that law (see, by analogy, judgment in *Edwin v OHIM*, cited in paragraph 24 above, EU:C:2011:452, paragraph 50).
- 31 However, it is also apparent from the case-law that, in the circumstances in which OHIM may be called upon to take account of the national law of the Member State in which an earlier right on which the opposition is based is protected, it must, of its own motion and by whatever means considered appropriate, obtain information about that national law, where such information is necessary to assess the applicability of the ground for refusal of registration in question; accordingly, OHIM must take into consideration, in addition to the facts which have been expressly put forward by the parties to the opposition proceedings, facts which are well known, that is, facts which are likely to be known by anyone or which may be learnt from generally accessible sources (see judgment of 20 April 2005 in *Atomic Austria v OHIM — Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*, T-318/03, ECR, EU:T:2005:136, paragraph 35 and the case-law cited; see also, by analogy, judgment of 13 September 2012 in *National Lottery Commission v OHIM — Mediatek Italia and De Gregorio (Representation of a hand)*, T-404/10, EU:T:2012:423, paragraph 20 and the case-law cited, upheld on this point by judgment of 27 March 2014 in *OHIM v National Lottery Commission*, C-530/12 P, ECR, EU:C:2014:186, paragraph 45). OHIM is under an obligation to obtain, of its own motion, information about national law where it already has before it information relating to national law, either in the form of claims as to its content, or in the form of evidence submitted and whose probative value has been claimed (judgment of 20 March 2013 in *El Corte Inglés v OHIM — Chez Gerard (CLUB GOURMET)*, T-571/11, ECR, EU:T:2013:145, paragraph 41).
- 32 Such an obligation is essentially referred to in the Guidelines for Examination in OHIM, relied on by OHIM at the hearing, which, by reference to the judgment in *OHIM v National Lottery Commission*, cited in paragraph 31 above (EU:C:2014:186), describe its power to verify, by whatever means it deems appropriate, the content, the conditions governing the application and the scope of the provisions of the applicable law relied upon by the opponent (Guidelines for Examination in OHIM, part C, section 4, paragraph 4.1). At the hearing, OHIM stressed that that power to verify was limited to ensuring the correct application of the law on which the opponent relies, but did not exempt the opponent from the burden of proof. In addition, that power to verify could not lead OHIM to take the place of the opponent in respect of its obligation to cite the relevant law for the purposes of the case.

- 33 In that regard, it should be noted, first, that, in the present case, the applicant pleaded the provisions of the applicable national law and their content. As is apparent from the third indent of paragraph 11 of the contested decision, the applicant also claimed before OHIM that the relevant public, assessing the recognition of the unregistered earlier mark for the purposes of Paragraph 4(2) of the Markengesetz, consisted of Russian-speaking consumers living in Germany, having regard both to the fact that the earlier mark consisted of letters from the Cyrillic alphabet and to the fact that the goods covered by the earlier mark were distributed by shops, the majority of whose visitors were Russian-speaking consumers.
- 34 It should be observed, secondly, that the definition of the relevant public was decisive for the outcome of the present dispute. Whereas the applicant did not dispute the fact, noted by the Board of Appeal, that the earlier mark had not acquired recognition amongst the public at large consisting of the entirety of average consumers in Germany, it does not appear inconceivable that, should the relevant public for the purposes of Paragraph 4(2) of the Markengesetz be defined as consisting only of Russian-speaking consumers in Germany, as the applicant claims, such recognition might have been acquired.
- 35 In those circumstances, in the light of the case-law recalled in paragraph 31 above, OHIM should have used all the means available to it in connection with its power to verify in order to obtain information about the applicable national law and to carry out further research into the wording and scope of the provisions of national law relied on, in the light of the arguments submitted by the applicant, either of its own motion or by inviting the applicant to corroborate its claims concerning the definition of the relevant public for the purposes of Paragraph 4(2) of the Markengesetz (see, on the latter point, the Opinion of Advocate General Bot in *OHIM v National Lottery Commission*, C-530/12 P, ECR, EU:C:2013:782, paragraphs 66 and 87).
- 36 However, it is not apparent from either the contested decision or the file relating to the proceedings before OHIM, sent to the Court, that OHIM conducted further research into the content and scope of the provisions of national law relied on, in the light of the arguments submitted by the applicant, either of its own motion or by inviting the applicant to corroborate its claims concerning the definition of the relevant public for the purposes of Paragraph 4(2) of the Markengesetz, as OHIM accepted at the hearing.
- 37 Such a preparatory inquiry into the German law by the Board of Appeal would most probably have enabled it to have available to it the evidence which the applicant submitted for the first time before the Court, some of which is not, prima facie, entirely irrelevant so far as concerns the examination of its claims relating to the definition of the relevant public for the purposes of Paragraph 4(2) of the Markengesetz. This is particularly true for the case-law of the Bundesgerichtshof (Federal Court of Justice) in which it has been accepted that, in certain circumstances, even in the case of mass consumption goods, the relevant public could be defined more narrowly having regard to the purpose and the sales opportunities of the specific goods (BGH, I ZR 90/58, DB 1959, 1368, (amtl. Leitsatz) — Sunpearl II) or the purchasers of those goods and interested persons, some of whom might refuse certain goods or disapprove of them (BGH, I ZR 94/80, GRUR 1982, 672 — Aufmachung von Qualitätsseifen). Likewise, it follows from the judgment of the Bundespatentgericht (Federal Patent Court) in *Берѣзка* (28 W (pat) 40/10) that, under certain conditions, the relevant public for goods in, as in the present case, Classes 29 and 30 may be confined to consumers with knowledge of the Russian language, having regard in particular to the presentation, the packaging and the name of the goods referred to in Cyrillic letters.
- 38 In those circumstances, it cannot be ruled out that the lack of a preparatory inquiry by the Board of Appeal had a decisive impact on its interpretation of Paragraph 4(2) of the Markengesetz.

39 It follows that it is appropriate to uphold the single plea in law and to annul the contested decision. In accordance with Article 65(6) of Regulation No 207/2009, OHIM is required to take the necessary measures to comply with the judgment of the Court. In that regard, it will be for OHIM, after exercising its power to make preparatory inquiries into German law, in particular to establish whether that law confers on the applicant the right to prohibit the use of a subsequent trade mark within the meaning of Article 8(4)(b) of Regulation No 207/2009.

Costs

40 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. Since OHIM has been unsuccessful, it must be ordered to bear its own costs and to pay the applicant's costs, in accordance with the form of order sought by the applicant.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

- 1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 28 November 2012 (Case R 893/2012-2);**
- 2. Orders OHIM to bear its own costs and to pay those incurred by Rot Front OAO.**

Kanninen

Pelikánová

Buttigieg

Delivered in open court in Luxembourg on 28 October 2015.

[Signatures]