



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

13 July 2017*

(EU trade mark — Invalidity proceedings — European Union word mark MONTORSI F. & F. — Earlier national word mark Casa Montorsi — Relative ground for invalidity — Likelihood of confusion — Article 53(1)(a) and Article 8(1)(b) of Regulation (EC) No 207/2009 — Agreement on coexistence of the marks — Scope — Article 53(3) of Regulation No 207/2009)

In Case T-389/16,

Agricola italiana alimentare SpA (AIA), established in San Martino Buon Albergo (Italy), represented by S. Rizzo, lawyer,

applicant,

v

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

defendant,

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

Casa Montorsi Srl, established in Vignola (Italy), represented by S. Vereva, K. Muraro and M. Balestrieri, lawyers,

APPLICATION brought against the decision of the First Board of Appeal of EUIPO of 28 April 2016 (Case R 1239/2014-1) relating to invalidity proceedings between Casa Montorsi and AIA,

THE GENERAL COURT (Eighth Chamber),

composed of A.M. Collins, President, M. Kancheva and J. Passer (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 22 July 2016,

having regard to the response of EUIPO lodged at the Court Registry on 11 October 2016,

having regard to the response of the intervener lodged at the Court Registry on 13 October 2016,

* Language of the case: Italian.

having regard to the absence of a request for a hearing by the main parties within three weeks after service 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 12 February 2007, Montorsi Francesco & Figli SpA filed an application for registration of an EU trade mark with the European 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)).
- 2 Registration as a mark was sought for the word sign MONTORSI F. & F.
- 3 The goods in respect of which registration was sought are in Class 29 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats’.
- 4 The EU trade mark application was published in *Community Trade Marks Bulletin* No 38/2007 of 30 July 2007 and the corresponding trade mark was registered on 18 January 2008.
- 5 On 28 December 2010, the intervener, Casa Montorsi Srl, applied for a declaration of invalidity of the contested trade mark pursuant to Article 53(1)(a) of Regulation No 207/2009 in respect of all the goods referred to in paragraph 3 above.
- 6 The application for a declaration of invalidity was based on the earlier Italian word mark Casa Montorsi, filed on 24 February 1995, registered on 2 June 1998 as number 751820, subsequently renewed and designating in particular goods within class 29 and corresponding to the following description: ‘Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs; milk and milk products; edible oils and fats’.
- 7 The ground relied on in support of the application for a declaration of invalidity was that referred to in Article 8(1)(b) of Regulation No 207/2009, alleging the existence of a likelihood of confusion.
- 8 During the administrative procedure, the contested mark was transferred to Negroni SpA, then to the applicant, Agricola italiana alimentare Spa (AIA).
- 9 The applicant claimed that the application for a declaration of invalidity should be rejected, on the ground that it was contrary to a private document which it had signed with the intervener on 4 May 2000 (‘the agreement’) and whereby they accepted the coexistence of their respective trade marks on the Italian market and undertook mutually not to oppose the exploitation of the marks. The applicant also requested proof of the use of the earlier mark.

- 10 On 20 March 2014, the Cancellation Division declared the contested mark invalid for the goods ‘meat, fish, poultry and game; eggs’, but upheld its validity for the other goods covered by that mark, namely ‘meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs; milk and milk products; edible oils and fats’, and also for other goods not mentioned in the list of goods covered by the contested mark.
- 11 In particular, the Cancellation Division considered that the agreement did not preclude the admissibility of the intervener’s application for a declaration of invalidity because the agreement, the terms of which were imprecise as regards territory and duration, could not be regarded as an express consent for the purposes of Article 53(3) of Regulation No 207/2009. As regards proof by the intervener of use of the earlier mark, the Cancellation Division considered that that proof had been adduced, but only for the goods ‘hams, salamis and charcuterie’ in the subcategory ‘meat’. As regards the comparison of the goods, it observed that, among the goods covered by the contested mark, only the goods ‘meat, fish, poultry and game; eggs’ were identical or similar to those for which the earlier mark had been used, namely those coming within the subcategory ‘meat’. As regards the comparison of the signs, the Cancellation Division observed that the contested mark had an average degree of similarity with the earlier mark because both marks contained the same family name Montorsi. Last, the Cancellation Division considered that, having regard to the identity or similarity of the marks at issue, there was a likelihood of confusion for the Italian public in the case of the goods ‘meat, fish, poultry and game; eggs’ covered by the contested mark and that that mark should be declared invalid for those goods.
- 12 On 12 May 2014, the applicant lodged an appeal with EUIPO, under Articles 58 to 64 of Regulation No 207/2009, against the Cancellation Division’s decision, in order that the contested mark would continue to be registered for the goods ‘meat, fish, poultry and game; eggs’.
- 13 By decision of 28 April 2016 (‘the contested decision’), the First Board of Appeal of EUIPO dismissed the appeal.
- 14 The Board of Appeal observed, first of all, that the applicant did not dispute before it any of the Cancellation Division’s findings relating to proof of use of the earlier mark, the similarity of the signs and goods and the likelihood of confusion. The only argument in the appeal was based on the agreement, which, in the applicant’s submission, precluded the application for a declaration that the contested mark was invalid because of a likelihood of confusion.
- 15 The Board of Appeal considered that EUIPO was not bound by the agreement, which regulated private interests, but that it had to ascertain whether it was possible to infer from that agreement that the intervener had ‘consent[ed] expressly to the registration’, as referred to in Article 53(3) of Regulation No 207/2009, or that the marks at issue coexisted. The Board of Appeal considered that the agreement did not allow such consent to be established. It added that, even if the part of the agreement in which the parties to the agreement ‘recognise[d] that their respective marks [could] coexist’ were taken into account, it would still need to be proved that the coexistence of the marks was attributable to the absence of a likelihood of confusion on the part of the relevant public, and such proof would require proof of the concurrent use of the marks at issue over a sufficiently long period prior to the date on which the contested mark was filed. That proof of such concurrent use had not been adduced, still less proof that that concurrent use did not give rise to any likelihood of confusion. The Board of Appeal therefore dismissed the appeal.

Forms of order sought

- 16 The applicant claims that the Court should:
- annul the contested decision;

– order EUIPO to pay the costs.

17 EUIPO and the intervener contend that the Court should:

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

Law

18 The applicant puts forward two pleas in law in support of its action, alleging, first, infringement of Article 53(1)(a) of Regulation No 207/2009, read with Article 8(1)(b) of that regulation, and, second, infringement of Article 53(3) of that regulation.

19 It is appropriate to begin by examining the second plea.

Second plea, alleging infringement of Article 53(3) of Regulation No 207/2009

20 The applicant claims that it is indisputable that the parties to the agreement accepted the coexistence of their respective present and future trade marks on the Italian market, which prevents the intervener from applying for a declaration that the contested mark is invalid.

21 The applicant maintains that the intervener cannot in any event prevent the registration of the contested mark in every country of the European Union apart from Italy, or even, taking the agreement into account, prevent the registration of the mark in Italy.

22 The applicant takes issue with the Board of Appeal for not having taken into account the ‘principle of relativisation’ of the reasons for invalidity resulting from the earlier rights at issue. The relative grounds for refusal protect only private interests. Although the consent of the proprietor of an earlier right does not allow an absolute ground for refusal to be defeated, such consent does allow a relative ground for refusal to be defeated. In that respect, the conflict between two marks concerns only the competing undertakings and not consumers, in accordance with the case-law of the General Court.

23 As regards, more specifically, infringement of Article 53(3) of Regulation No 207/2009, the applicant, in the first place, disputes the Board of Appeal’s assertion, in the first two sentences of paragraph 25 of the contested decision, that in order for there to be consent to registration of a mark, the sign to be registered must be identified accurately, which is not the case here.

24 The applicant submits that the agreement clearly refers not to the trade mark MONTORSI itself, but to present or future registrations or uses of the word ‘montorsi’ in the context of a distinctive sign with regard to the goods in class 29. A restrictive interpretation of that reference would not make sense, since, when the agreement was concluded, neither of the parties to the agreement was the proprietor of the trade mark MONTORSI in the strict sense. Consequently, the applicant maintains that, contrary to the Board of Appeal’s assertion in the contested decision, the parties to the agreement had consented expressly to the registration and the use, not only of the trade mark MONTORSI in the strict sense, but also to any distinctive sign containing the word ‘montorsi’, as is the case of the trade mark MONTORSI F. & F.

25 In the second place, the applicant contends that the Board of Appeal’s interpretation, in the passage following paragraph 25 of the contested decision, that it cannot be inferred from the agreement that there was express consent to the registration of the contested mark as an EU trade mark, is excessively formalistic. The validity of the agreement is indeed limited to Italian territory. However, in the present

case the express consent given for Italian territory necessarily implies consent to the registration of the contested mark at EU level. Since the intervener expressly consented to the coexistence of the marks on Italian territory, including future registrations of marks containing the word ‘montorsi’, it would not be logical now to deny that consent with regard to the contested mark on the basis of a hypothetical conflict, specifically limited to Italian territory. The applicant would have had no say in the matter if the intervener had attempted to annul the registration of the contested mark on the basis of earlier rights in France, Spain or countries of the Union other than Italy.

- 26 EUIPO, supported by the intervener, contends that the assertion that the intervener’s consent in the agreement means that the intervener cannot enforce its rights in the earlier trade mark is contradicted by the facts. The applicant claims, correctly, that in the case of relative grounds for refusal the proprietor of the earlier right may choose whether or not to defend his own trade mark and, if he decides to do so, to act in his exclusive interest. In the present case, however, the intervener clearly decided to defend the earlier mark, since it submitted an application to EUIPO for a declaration that the contested mark is invalid. The fact that the intervener previously signed an agreement and may seem not to have fulfilled its obligations as set out in that private document relates to the private sphere of the parties to the agreement, who can rely on the consequences of any breach of the agreement before the national civil courts.
- 27 The argument that relative grounds for refusal protect only private interests does not affect the finding that express consent for the purposes of the application of Article 53(3) of Regulation No 207/2009 was required. The case-law cited by the applicant refers to a different question, that of the capacity to act of the persons who intend to rely on relative grounds for the refusal of the registration of an EU trade mark.
- 28 As regards its competence, EUIPO should actually take the agreement in question into account in order to ascertain whether it is possible to find in that document clear consent to the registration of the contested mark within the meaning of Article 53(3) of Regulation No 207/2009 and, furthermore, in order to ascertain whether the conditions of coexistence of the marks in question on the market are satisfied as a relevant factor in the context of Article 53(1)(a) read in conjunction with Article 8(1)(b) of Regulation No 207/2009.
- 29 Furthermore, it does not follow at all from the agreement that the intervener consented expressly to the registration of the contested mark as an EU trade mark. EUIPO points out that Article 53(3) of Regulation No 207/2009 is in the nature of a derogation and must therefore be interpreted restrictively. Therefore, in order to constitute consent to the registration of the contested mark, the agreement should clearly, manifestly and expressly refer to the contested mark and the burden of proof is borne by the party that relies on the consent; the other party to the agreement is not required to prove his disagreement.
- 30 The agreement contains no clear and precise consent to registration of the contested mark as an EU trade mark, for the reasons specifically set out in the contested decision. The agreement is vague and imprecise. The territorial scope and the period of application of the agreement are not expressly stated. In particular, the trade mark MONTORSI F. & F. is not correctly identified in the agreement. In the first place, it is not mentioned in the private document. In the second place, the word ‘Community’ or ‘European’ is never stated in the agreement, which mentions only Italian registrations and a dispute pending before the Tribunale di Modena (District Court, Modena, Italy). Last, paragraph 2 of the agreement states that ‘the parties acknowledge that the distinctive signs of each of them thus far registered and/or used for goods in international class 29 may coexist’. Since registration of the contested mark was granted on 18 January 2008, that fundamental point of the agreement also leads to the conclusion that the contested mark cannot be regarded as definitely forming part of that agreement. Consequently, it seems that the agreements concerning the coexistence of the marks and their registration in fact relate solely to the Italian registrations, as was correctly observed in the contested decision. In any event, EUIPO is of the view that the fact that the

contested mark was not clearly identified in the agreement is, even on its own, a sufficient reason to rule out the possibility that the intervener consented expressly to the registration of that mark in the European Union.

- 31 In addition, contrary to the applicant's assertions, there is a dispute between the parties to the agreement as to the interpretation of certain essential elements of that agreement, in particular as to whether it relates only to national trade marks or also to foreign, international or EU trade marks.
- 32 The fact that the parties do not agree on the interpretation of the agreement is confirmed by their conduct before EUIPO and the national courts. That conduct does not correspond to a clear, consistent and peaceful course of conduct.
- 33 In conclusion, the agreement does not show that the intervener 'consent[ed] expressly' to the registration of the contested mark. The Board of Appeal did not infringe Article 53(3) of Regulation No 207/2009.
- 34 The intervener claims that, as the decision of the Cancellation Division and the contested decision indeed confirm, any private agreements between the parties are not in any event binding on EUIPO. There is no legal basis for such binding effect. That also relates to the fact that the contracts have relative effects *inter partes* and are therefore incompatible with the effects *erga omnes* of an opposition or invalidity decision. There is therefore a general interest to be protected. The Board of Appeal was thus correct to assert that EUIPO was not bound by the agreement, but had to ascertain whether it was possible to infer consent or the coexistence of the marks from the agreement.
- 35 The intervener also claims that the existence of consent is not established, primarily because of the imprecise terms of the agreement, as the Board of Appeal points out, but also because the applicant's opposition to the intervener's application, filed on 15 April 2008, for registration, under number 6832125, of the trade mark CASA MONTORSI as an EU trade mark would then have made no sense. There is an inconsistency in the applicant's arguments.
- 36 In any event, the contested mark is not specifically mentioned in the agreement, nor, as the contested decision correctly states, does the agreement mention the expressions 'Community trade mark', 'Community registration' or 'EU trade mark'. Consent can be neither implicit nor presumed. It is not the Board of Appeal that is 'excessively formalistic'. The applicant seeks at any price to interpret the agreement for its sole convenience.
- 37 It should be borne in mind that Article 53(1)(a) of Regulation No 207/2009 provides, in particular, that '[an EU] trade mark shall be declared invalid on application to the Office ... where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in paragraph 1 ... of that Article are fulfilled'.
- 38 Article 53(3) of Regulation No 207/2009 provides that '[an EU] trade mark may not be declared invalid where the proprietor of a right referred to in paragraphs 1 or 2 consents expressly to the registration of the [EU] trade mark before submission of the application for a declaration of invalidity or the counterclaim'.
- 39 Article 53(3) of Regulation No 207/2009 therefore requires that, in order to be prevented from subsequently submitting an application for a declaration that that mark is invalid, the proprietor of an earlier right must have consented expressly to the registration of an EU mark.
- 40 Thus, in a case where the proprietor of disputed trade marks maintained that the applicants for a declaration that those marks were invalid, owing to a likelihood of confusion, had consented to the registration of the marks through, in particular, peaceful coexistence and a coexistence agreement, the Court observed that, for registration of a sign that might result in a likelihood of confusion to be

permitted, the agreement of the proprietor of the right must be express. The Court inferred that peaceful coexistence of the marks could not take the place of express consent for the purposes of Article 53(3) of Regulation No 207/2009; and, as regards the coexistence agreement, the Court, after pointing out that that agreement did not concern the contested marks, but a different mark, stated that the agreement could not be interpreted in such a way as to extend beyond its scope without the express consent of the parties, for the purposes of Article 53(3) of Regulation No 207/2009. The Court found that there was no express consent (judgment of 3 June 2015, *Pensa Pharma v OHIM — Ferring and Farmaceutisk Laboratorium Ferring (PENSA PHARMA and pensa)*, T-544/12 and T-546/12, not published, EU:T:2015:355, paragraphs 35, 37, 40, 49 and 51).

- 41 In the present case, the agreement refers, in the introduction (paragraphs A to C), to a dispute between the parties before the Tribunale di Modena (District Court, Modena) concerning the use of the word ‘montorsi’ in the dried meat sector, and also to the negotiations held between the parties in order to resolve that dispute and avoid future disputes over the word for all goods in Class 29. That introduction to the agreement mentions Italian trade marks containing the word ‘montorsi’.
- 42 The first subparagraph of paragraph 2 of the agreement specifies that ‘the parties recognise that the distinctive signs of each of them thus far registered and/or used for goods in international class 29 (in particular for meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats) may coexist’. The second subparagraph of paragraph 2 of the agreement specifies that ‘consequently, the parties, for themselves and those entitled to claim under them, mutually agree not to challenge the respective registrations of those signs as trade marks, and not to oppose the use of those signs — whether as a business name, mark, sign or other atypical function — by the other party’. Paragraph 3 of the agreement specifies, moreover, that ‘the parties waive any claim that they might have as regards the use of the distinctive sign MONTORSI by the other party thus far’.
- 43 As EUIPO observes, the agreement refers to Italian signs and registration and to a dispute in Italy. It makes no reference to the Union or to EU law. The agreement mentions the word ‘montorsi’, but not the word sign MONTORSI F. & F. at issue in the present case. In addition, the coexistence of the marks and the non-challenge undertaking referred to in the agreement concern signs ‘thus far’ registered or used, that is to say, until 4 May 2000. Last, according to the agreement, the parties waive any claim which they might have with respect to the use of the ‘distinctive sign MONTORSI by the other parties thus far’.
- 44 It follows from the foregoing that, as the Cancellation Division and the Board of Appeal observed in essence, the agreement seems to be limited to signs registered or used in Italy up to the date on which it was concluded and in an Italian context. As the Board of Appeal rightly points out, the formulation of the agreement inevitably gives rise to the assumption that the agreements on the coexistence of the marks and their registration relate only to the Italian claims. The agreement does not mention the sign MONTORSI F. & F., at issue in the present case, still less any future registration of that sign — or, indeed, any sign containing the word ‘montorsi’ — as an EU trade mark.
- 45 In the light of those factors, which show at least the absence of determination, in the agreement, of the parties’ position on the question of the registration at Union level of marks containing the word ‘montorsi’, and in the light of the fact that the consent provided for in Article 53(3) of Regulation No 207/2009 must be given expressly, the Board of Appeal was correct to conclude that it could not be inferred from the agreement that the intervener had consented expressly to the registration of the sign MONTORSI F. & F. as an EU trade mark.

- 46 That conclusion of the Board of Appeal is not, contrary to the applicant's contention, excessively formalistic. It follows from the terms of the agreement and from the requirements of Article 53(3) of Regulation No 207/2009. Indeed, the applicant itself agrees that the validity of the agreement is limited to Italian territory. As the intervener observes in essence, it is the applicant that is attempting to confer on the agreement a significance that exceeds its terms.
- 47 The applicant claims, however, that that conclusion is illogical, since it could also register the contested mark in every country of the Union other than Italy, as the intervener does not hold earlier rights in those countries, or indeed in Italy, owing to the agreement. The applicant further submits that it would be illogical to declare the contested mark, registered at Union level, invalid because of a likelihood of confusion claimed and found to exist only in Italy, when, by the agreement, the intervener specifically undertook not to challenge the mark in Italy and, therefore, expressly acknowledged that there might be a likelihood of confusion in Italy.
- 48 The applicant's arguments are not such as to call the Board of Appeal's position into question.
- 49 The fact that, for its own economic, strategic or other reasons, the intervener, rather than pursue a dispute with the applicant, preferred to agree with the latter that their respective signs and marks existing at the date of the agreement should coexist, does not mean that the intervener undertook not to challenge an EU trade mark. Such consent does not mean that any likelihood of confusion which it accepted by contract in the Italian context and within the limits of the coexistence agreement should be deemed to be accepted outside that context as well and, more particularly, in the case of an EU trade mark. With respect to such a trade mark, the scope and effects of which are wider than those of a national trade mark, the intervener, in the absence of express consent to the registration of an EU trade mark, retained the right to rely on the likelihood of confusion.
- 50 It should further be observed that, while denying that right to the intervener, the applicant claimed it for itself. As is apparent from EUIPO's file, and as EUIPO and the intervener observe, the applicant, while denying in the present case that the intervener is entitled to apply for a declaration that the contested mark is invalid, did not hesitate to oppose an application by the intervener for registration of the sign CASA MONTORSI as an EU trade mark. Yet there is nothing in the agreement to suggest that it provides for asymmetrical undertakings between the parties: on the contrary, the agreement states that the parties give their mutual consent to the coexistence of their respective signs and marks existing at the date of its conclusion.
- 51 As regards, next, the assertion that the relative grounds for refusal protect only private interests and that the consent of the proprietor of an earlier right is therefore binding on EUIPO, it is sufficient to observe that, in any event, such consent to registration of the contested trade mark was not given in the present case.
- 52 Moreover, and as EUIPO and the intervener observe in essence, the judgment on which the applicant relies in support of that assertion does not relate to the question of the impact, vis-à-vis EUIPO, of a trade mark coexistence agreement. That judgment concerns the different question, which is of no relevance in the present case, of the persons entitled to rely on an absolute or relative ground for refusal to register an EU trade mark (judgment of 8 July 2008, *Lancôme v OHIM — CMS Hasche Sigle (COLOR EDITION)*, T-160/07, EU:T:2008:261, paragraphs 20 to 26).
- 53 It follows from all of the foregoing considerations that the second plea is unfounded and must be rejected.

First plea in law, alleging infringement of Article 53(1)(a) of Regulation No 207/2009, read in conjunction with Article 8(1)(b) of that regulation

- 54 The applicant claims that the Board of Appeal's finding that it ought to have proved not only that the coexistence of the trade marks was accepted but also that that coexistence was attributable to the absence of any likelihood of confusion is incorrect.
- 55 The purpose of Article 53(1)(a) and Article 8(1)(b) of Regulation No 207/2009 is to protect not the interests of consumers but the interests of the proprietors of the earlier rights. The existence of any likelihood of confusion is irrelevant, where, as in the present case, the proprietor of the earlier right expressly accepted the coexistence of the trade marks in Italy. In the case of the relative grounds for refusal, the proprietor of the earlier right could choose to defend its right or not to do so and, if he decided to defend it, he would be acting solely in his own interest. Any benefit for the community would merely be a collateral effect of the proprietor's action.
- 56 In any event, the success of the present action, and therefore the maintenance of the contested mark for the goods 'meat, fish, poultry and game; eggs', would not alter the reality of the Italian market, on which the earlier mark and the Italian mark MONTORSI F. & F. would continue to coexist.
- 57 EUIPO and the intervener contest the applicant's position.
- 58 EUIPO claims that, while the coexistence of two marks might possibly reduce the likelihood of confusion between those two marks, such a possibility could be taken into consideration only if, at the very least, during the administrative procedure the applicant for the EU trade mark had established that that coexistence was based on the absence of a likelihood of confusion. In addition, the period of coexistence would have to be sufficiently long to be able to influence the perception of the consumer.
- 59 The applicant ought therefore to have demonstrated that the relevant Italian consumers had been exposed to the concurrent use of the trade marks containing the word 'montorsi' and that that use had not given rise to confusion. Since proof of the coexistence on the market of the marks at issue and of the fact that that coexistence was attributable to an absence of confusion was not adduced to the requisite standard, the coexistence on which the applicant relies cannot be regarded as a factor to be taken into consideration in the assessment of the likelihood of confusion.
- 60 In addition, the assessment of whether a likelihood of confusion does or does not exist requires that all relevant factors be taken into account, which include not only the coexistence of the marks at issue, but also the similarity of the marks and the goods.
- 61 The intervener claims that the applicant's argument that the likelihood of confusion is not a relevant question, since it is only a matter of the protection of the private interests of the proprietor of a trade mark, is based on an incorrect assumption, namely that the relative grounds for refusal are not intended to protect the interests of consumers, but only to protect the interests of the proprietors of the earlier rights.
- 62 The intervener observes that, furthermore, the situation involving a coexistence of marks normally entails the existence of a likelihood of confusion on the part of the public owing to the possible interaction of the signs on the market and that there is no doubt that a coexistence agreement should not adversely affect the objective of protecting consumers, who should not be exposed to the likelihood of confusion.
- 63 Independently of those considerations, it should be noted that the application for a declaration of invalidity relates in the present case to an EU trade mark which is on all points a foreign trade mark as opposed to a national mark, and the validity of which extends to all countries of the Union, and that, in addition, a national trade mark might validly be opposed to an EU trade mark. The relevant

territory for the purposes of the present dispute is not Italy, but the European Union. No ‘legal reflection’ could be sufficiently illogical to suggest that any consent to registration for only one of the countries would, of itself, extend its scope to the other 27 Member States.

- 64 Furthermore, the date on which the contested mark was filed was 12 February 2007, so that any conversion of the mark into an Italian national trade mark pursuant to Article 112 of Regulation No 207/2009 would in any event be subsequent to the agreement. It follows that the national trade mark that would result from such a conversion could not in any event coexist with the ‘distinctive signs thus far registered and/or used by each [of the parties] for goods in international class 29’ (paragraph 2 of the agreement), since, at the time of signature of the agreement, on 4 May 2000, that national trade mark did not exist. In that regard, the reference to the applicant’s identical Italian trade mark, which was the subject of a national registration under number 1205683, is inoperative, since it also concerns a trade mark subsequent to the agreement, filed on 22 November 2006 and registered on 1 July 2009, and which does not therefore form part of the ‘distinctive signs thus far registered and/or used by each [of the parties] for goods in international class 29’.
- 65 Last, the intervener emphasises that, by its argument that the agreement is valid only in Italy and that the application for a declaration of invalidity is not admissible because it is based on an Italian priority, the applicant acknowledges that its marks filed or registered outside the national territory are in principle freely contestable by the intervener, which shows that the problem does not relate to the validity or the admissibility of the application for a declaration of invalidity as such, that is to say, as an application of the principle of protection of a general interest, but solely to the possible breach of a private interest based on the existence of a private agreement, in regard to which EUIPO could not be competent.
- 66 The Court has already pointed out, when examining the second plea, that the agreement did not contain any express consent by the intervener to the registration of the contested trade mark as an EU trade mark. It then observed that Article 53(3) of Regulation No 207/2009 did not prevent the intervener from applying for a declaration that the contested trade mark was invalid on the basis of a likelihood of confusion. The applicant cannot therefore again claim, in the present plea, that acceptance of the coexistence of the trade marks in Italy precludes reliance on a likelihood of confusion as against the contested trade mark.
- 67 In addition to the foregoing, the applicant maintains that the Board of Appeal was wrong to find that, in order to rebut the application for a declaration of invalidity, the applicant ought to have proved not only the acceptance of the coexistence of the trade marks, but also the fact that that coexistence was attributable to the absence of a likelihood of confusion.
- 68 The position thus adopted by the applicant cannot succeed.
- 69 In the first place, it should be observed that the Board of Appeal did not state that the applicant had to prove the acceptance of the coexistence of the trade marks, but stated that the applicant had to prove the coexistence of those marks.
- 70 In the second place, it should be observed that, according to the case-law, while it is not precluded that the coexistence of earlier marks on the market might reduce the likelihood of confusion between two marks at issue, the fact nonetheless remains that such a possibility can be taken into consideration only if, during the procedure before EUIPO, the proprietor of the contested EU trade mark has duly demonstrated that such coexistence was based upon the absence of a likelihood of confusion on the part of the relevant public between the earlier marks on which it relies and the earlier mark on which the application for a declaration of invalidity is based, and provided that the earlier marks at issue and the competing marks are identical (see, to that effect, judgments of 11 May 2005, *Grupo Sada v OHIM — Sadia (GRUPO SADA)*, T-31/03, EU:T:2005:169, paragraph 86; of 7 November 2007, *NV Marly v OHIM — Erdal (Top iX)*, T-57/06, not published, EU:T:2007:333, paragraph 97; of 20 January

2010, *Nokia v OHIM — Medion (LIFE BLOG)*, T-460/07, EU:T:2010:18, paragraph 68; and of 10 April 2013, *Höganäs v OHIM — Haynes (ASTALOY)*, T-505/10, not published, EU:T:2013:160, paragraph 48).

- 71 The Board of Appeal was therefore correct to consider that, in order to challenge the application for a declaration of invalidity based on a likelihood of confusion, the applicant ought to have proved — which it failed to do — not only the coexistence of the trade marks but also that that coexistence was attributable to the absence of a likelihood of confusion, and to have done so by adducing evidence such as opinion polls, declarations of consumers' associations or other evidence.
- 72 The present plea must therefore be rejected.
- 73 As neither of the pleas put forward in the present action is well founded, the action must be dismissed.

Costs

- 74 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.
- 75 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Agricola italiana alimentare SpA (AIA) to pay the costs.**

Collins

Kancheva

Passer

Delivered in open court in Luxembourg on 13 July 2017.

[Signatures]