



Reports of Cases

OPINION OF ADVOCATE GENERAL
SHARPSTON
delivered on 23 November 2017¹

Case C-418/16 P

mobile.de GmbH, formerly *mobile.international GmbH*
v
European Union Intellectual Property Office (EUIPO)
the other parties to the proceedings being:

Rezon OOD

(Appeal — European Union trade mark — Invalidity proceedings — Decisions of the Boards of Appeal annulling decisions of the Cancellation Division and remitting cases for further prosecution pursuant to Article 64(2) of Regulation (EC) No 207/2009 — Whether in such circumstances the Cancellation Division has a discretion to consider evidence submitted out of time under Article 76(2))

1. In this trade mark appeal *mobile.de* challenges the judgment of the General Court of 12 May 2016 in *mobile.international v EUIPO – Rezon (mobile.de)*.² In those proceedings, *mobile.de* contested two decisions of the First Board of Appeal of the European Intellectual Property Office ('EUIPO' or 'the Office').³ The General Court rejected *mobile.de*'s case in its entirety. *Mobile.de* now raises six grounds in support of its appeal against that ruling.

2. The Court's established case-law confirms that in the course of proceedings under Regulation (EC) No 207/2009 on the Community trade mark⁴ the EUIPO Divisions and the Boards of Appeal enjoy a discretion as to whether to take account of evidence which is submitted after the expiry of specified time limits.⁵ The sixth ground of appeal concerns in particular the interpretation of Articles 64 and 76(2) of Regulation No 207/2009 with regard to the exercise of that discretion in a situation where a Board of Appeal remits a case to the relevant EUIPO Division. That issue gives rise to a new point of law and the Court has requested an Opinion in relation to that matter only.

¹ Original language: English.

² Joined Cases T-322/14 and T-325/14, not published, EU:T:2016:297 ('the judgment under appeal'). Since delivery of that judgment, *mobile.international GmbH* has changed its name to *mobile.de GmbH*.

³ The decisions were dated 9 January 2014 and 13 February 2014.

⁴ Council Regulation of 26 February 2009 (OJ 2009 L 78, p. 1). That regulation was repealed and replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European trade mark (OJ 2017 L 154, p. 1) with effect from 1 October 2017. The new regulation codifies Regulation No 207/2009 and the provisions at issue are unchanged in Regulation 2017/1001.

⁵ Judgment of 13 March 2007, *OHIM v Kaul*, C-29/05 P, EU:C:2007:162, paragraph 42. See more recently, judgment of 18 July 2013, *New Yorker SHK Jeans v OHIM*, C-621/11 P, EU:C:2013:484, paragraphs 28 and 30. Advocate General Szpunar provides a helpful explanation of the evolution of that case-law in his Opinion in *OHIM v Grau Ferrer*, C-597/14 P, EU:C:2016:2, points 39 to 53.

EU legislation

Regulation No 207/2009

3. Recital 10 of Regulation No 207/2009 states ‘there is no justification for protecting [European Union] trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used’.

4. Article 53 is entitled ‘Relative grounds for invalidity’. Pursuant to Article 53(1)(a), an EU trade mark is to be declared invalid where there is an earlier trade mark which is, inter alia, a trade mark registered in a Member State,⁶ and if the conditions set out in Article 8(1) or (5) are fulfilled. In the case at issue, it is Article 8(1)(b) that is directly relevant. That provision applies in circumstances where: ‘if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark’.

5. Article 57 provides:

‘1. On the examination of the application for revocation of rights or for a declaration of invalidity, the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.

2. If the proprietor of the [EU] trade mark so requests, the proprietor of an earlier [EU] trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier [EU] trade mark has been put to genuine use in the [European Union] in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier [EU] trade mark has at that date been registered for not less than five years. If, at the date on which the [EU] trade mark application was published, the earlier [EU] trade mark had been registered for not less than five years, the proprietor of the earlier [EU] trade mark shall furnish proof that, in addition, the conditions contained in Article 42(2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier [EU] trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the [Union].

...’⁷

6. Title VII of the regulation is entitled ‘Appeals’. In accordance with Article 58(1), an appeal lies from the various divisions of EUIPO including the Cancellation Divisions. Pursuant to Article 63(2), in examining an appeal the Board of Appeal is to ‘invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself’.

⁶ The expression ‘earlier trade marks’ is defined in Article 8(2). The list in that provision of such marks includes a national trade mark such as that in the proceedings at issue (see point 14 below) (Article 8(2)(a)(ii)).

⁷ Article 42(2) of Regulation No 207/2009 applies to opposition proceedings where the proprietor of an earlier trade mark seeks to prevent an applicant for an EU trade mark from registering the mark at issue. Article 42(2) sets out the rules for examination of opposition to registration of a trade mark. It is functionally equivalent to Article 57(2) of Regulation No 207/2009 (cited in point 5 above).

7. Article 64 is entitled ‘Decisions in respect of appeals’; it states:

‘1. Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

2. If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the *ratio decidendi* of the Board of Appeal, in so far as the facts are the same.

...’

8. Article 76 is in Title IX of the Regulation, which is entitled ‘Procedure’. Article 76 lays down the rules for the examination of the facts by the Office of its own motion. Article 76(2) states, ‘the Office may disregard facts or evidence which are not submitted in due time by the parties concerned’.

Commission Regulation (EC) No 2868/95

9. Commission Regulation (EC) No 2868/95⁸ lays down the rules necessary for implementing Regulation No 207/2009. The aim of the implementing rules is to ensure the ‘smooth and efficient operating of trade mark proceedings before the Office’.⁹

10. In cases where an applicant for an EU trade mark requests the proprietor of an earlier mark to provide proof of use pursuant to Article 42(2) of Regulation No 207/2009, Rule 22(2) of the Implementing Regulation provides that the Office is to invite the opposing party to provide the proof required within a specified period. If proof is not provided before the time limit expires, the Office must reject the opposition.¹⁰

11. Rule 40(6) states: ‘if the applicant [for revocation or for a declaration of invalidity] has to furnish proof of use or proof that there are proper reasons for non-use under [Article 57(2) or (3) of the Regulation], the Office shall invite the applicant to furnish proof of genuine use of the mark, within such period as it may specify. If the proof is not provided within the time limit set, the application for [a] declaration of invalidity shall be rejected. Rule 22(2), (3) and (4) shall apply *mutatis mutandis*.’

Background to the dispute

12. On 17 November 2008, mobile.de filed two applications with EUIPO. One application was to register the figurative mark set out below for goods and services in Classes 9, 16, 35, 38 and 42 of the Nice Agreement Concerning the International Classification of Goods and Services as revised and amended (‘the Nice Classification’).¹¹ It was registered on 26 January 2010.

⁸ Regulation of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1) (‘the Implementing Regulation’). That regulation has been amended several times. The 2009 consolidated version includes the amendments made by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4). That is the version that applied at the relevant time. The Implementing Regulation has since been repealed and replaced by Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Regulation No 207/2009 and repealing Regulations No 2868/95 and No 216/1996 (OJ 2017 L 205, p. 1).

⁹ The fifth and sixth recitals of the Implementing Regulation.

¹⁰ The rules in Article 42(2) for opposition proceedings apply *mutatis mutandis* to invalidity proceedings.

¹¹ Classes 9, 16 and 38 are not relevant to the present appeal. Class 35 refers to services for advertising, business management, business administration, office functions, and Class 42 covers scientific and technological services and research and design relating thereto, design and development of computer hardware and software, rental of computer software and provision of search engines for the Internet.



13. The second application was to register the word mark 'mobile.de' for goods and services within the same classes that apply to the figurative mark. It was registered on 29 September 2010.

14. On 18 January 2011 Rezon OOD filed two applications for declarations of invalidity against the two EU trade marks registered by mobile.de. Rezon relied upon Article 53(1)(a) of Regulation No 207/2009 read together with Article 8(1)(b) of that regulation. Rezon's applications were based upon the figurative mark registered in Bulgaria for services in Classes 35, 39 and 42 of the Nice Classification ('the earlier mark').¹²



15. Rezon's applications concerned only those services falling within Class 35 and Class 42. In response to a request made by mobile.de, Rezon was asked to submit evidence to demonstrate genuine use of the earlier trade mark in accordance with Article 57(2) and (3) of Regulation No 207/2009.

16. By two decisions of 28 March 2013, the EUIPO Cancellation Division rejected both Rezon's applications for declarations of invalidity in their entirety. It considered that Rezon had failed to prove genuine use of the earlier mark in Bulgaria. On 17 May 2013, Rezon filed notices of appeal challenging both decisions.

17. The Board of Appeal annulled the Cancellation Division's decisions ('the decisions at issue'). The cases were remitted to the Cancellation Division for examination of the invalidity request on its merits pursuant to Article 64 of Regulation No 207/2009. The Board of Appeal found on the basis of further evidence submitted by Rezon pursuant to its appeals, inter alia, that there was genuine use of the earlier mark for certain advertising services in Class 35, but not for all services in that Class as claimed by Rezon and not for any services in Class 42.

The proceedings before the General Court

18. On 6 and 7 May 2014, mobile.de lodged appeals against the decisions at issue in the General Court. Mobile.de submitted that the Board of Appeal had misinterpreted Regulation No 207/2009 and the Implementing Regulation. On 4 March 2016, the General Court decided to join the two cases. By its judgment of 12 May 2016, the General Court dismissed both appeals.

¹² Class 39 covers transport packaging and storage of goods and travel arrangements.

Procedure before the Court

19. On 27 July 2016, mobile.de lodged an appeal against the General Court’s ruling. It asks the Court to set aside the judgment under appeal and to order EUIPO to pay all costs. Mobile.de raises six grounds in support of its appeal, claiming that the General Court erred in law by misinterpreting the following provisions of Regulation No 207/2009: (i) Article 57(2) and (3) read together with Rules 22(2) and 40(6) of the Implementing Regulation; (ii) Article 76(2); (iii) Article 15(1)(a); (iv) Article 57(2) read together with Rules 22(3) and (4) of the Implementing Regulation; (v) Articles 56(1) and 54(2); and (vi) Article 64(1).

20. Rezon claims that the appeal is inadmissible and/or unfounded. EUIPO argues that the appeal is unfounded. Both parties submit that mobile.de should pay the costs.

Assessment of the sixth ground of appeal — misinterpretation of Article 64 of Regulation No 207/2009

The judgment under appeal

21. The General Court makes the following points in paragraphs 79 to 87 of the judgment under appeal.

22. First, as regards mobile.de’s contention that the Board of Appeal considered that evidence of genuine use had been demonstrated only for services in Class 35 of the Nice Classification relating to ‘advertising in connection with vehicles’ and that the Cancellation Division’s decision could be annulled solely with regard to such services,¹³ it recalled that the wording of Article 64(1) of Regulation No 207/2009 states, ‘following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution’.¹⁴ Second, it explained that pursuant to Article 64(2) of Regulation No 207/2009, if the Board of Appeal remits a case for further prosecution to the department whose decision was appealed, that department is bound by the *ratio decidendi* of the Board of Appeal, in so far as the facts are the same.¹⁵ Third, it noted that the issue of genuine use of the earlier mark when raised by the proprietor constitutes a preliminary question that should be decided before a ruling is made on the invalidity proceedings proper.¹⁶ Fourth, the operative part of the Board of Appeal’s decisions should be read and interpreted in the light of the reasoning set out in those decisions.¹⁷

23. Here, the extract of the operative part of the Board of Appeal’s decisions annulling the Cancellation Division’s decisions rejecting Rezon’s applications for declarations of invalidity implied that that Division was bound from the date of the Board of Appeal’s ruling. It was circumscribed by the Board of Appeal’s assessment that genuine use was demonstrated in relation to the earlier mark only for a subcategory of services, those within Class 35, ‘advertising in connection with vehicles’.¹⁸

¹³ Paragraph 79.

¹⁴ Paragraphs 79 and 80.

¹⁵ Paragraph 81.

¹⁶ Paragraph 82.

¹⁷ Paragraph 83.

¹⁸ Paragraph 85.

Consideration of that issue also formed part of the preliminary issue concerning proof of genuine use. Pursuant to Article 57(2) of Regulation No 207/2009 it was that subcategory which was to be assessed in the Cancellation Division's examination of the merits of the applications for declarations of invalidity.¹⁹

24. The General Court concluded that the Board of Appeal therefore did not infringe Article 64(1) of Regulation No 207/2009 by annulling the Cancellation Division's decisions.²⁰

Analysis

25. Mobile.de claims in essence that by failing to specify in the operative part of the decisions at issue that the Cancellation Division's decisions were annulled in part only, as regards certain services in Class 35 (namely advertising in connection with vehicles), the Board of Appeal committed an error of law. That sole issue should have been remitted to the Cancellation Division for further prosecution.

26. I disagree with mobile.de. In my view the sixth ground of appeal should be rejected as being unfounded.

27. It is true that the General Court cites Article 64(1) of Regulation No 207/2009 without expressly stating its view of the meaning of that provision. However, it is clear from the reasoning set out in paragraphs 81 to 86 of the judgment under appeal that the General Court considered whether the Board of Appeal had examined Rezon's application for invalidity and whether the Board had adopted a decision in relation to that request. The General Court took the view that the Board of Appeal had complied with the requirements of Article 64(1), in so far as the Board examined the application and decided that Rezon had successfully demonstrated proof of genuine use of the earlier mark solely for a subcategory of services within Class 35. The Board thus decided to annul the Cancellation Division's decision and to remit the case for further prosecution.

28. I consider that the General Court's reasoning can be interpreted in a manner that is consistent with Article 64(1) of Regulation No 207/2009 and that the judgment under appeal is well founded in that respect.

29. The sixth ground of appeal is divided into three parts. Mobile.de claims first, that the General Court erred in law in failing to rule that the Board of Appeal should have specified in the operative part of its decision that the Cancellation's Division decision was annulled in part only. Second, mobile.de disagrees with the General Court's view (expressed in paragraph 82 of the judgment under appeal) that the issue of genuine use constitutes a preliminary question to be decided at the outset of invalidity proceedings. Third, mobile.de claims that the General Court erred in paragraph 85 of the judgment under appeal in its analysis of the Board of Appeal's decision. Where proof of genuine use within the meaning of Article 57(2) of Regulation No 207/2009 is at issue and the Board of Appeal remits the case for further prosecution pursuant to Article 64(2), the proprietor of the earlier trade mark should not be able to present new evidence in any subsequent proceedings before the Cancellation Division. It would be contrary to Article 76(2) to admit new or supplementary evidence on the issue of genuine use; and it would lead to a flagrant breach of Article 57(2) of Regulation No 207/2009 and Rules 22(2) and 40(6) of the Implementing Regulation.

30. It seems to me that mobile.de's argument is based both upon a misreading of the judgment under appeal and a misinterpretation of Articles 64 and 76(2) of Regulation No 207/2009.

¹⁹ Paragraph 86.

²⁰ Paragraph 87.

31. Regarding mobile.de's complaint that the General Court failed to sanction the lack of precision in the Board of Appeal's decision, it is clear from the judgment under appeal that the General Court considered that that decision was in accordance with the requirements established in settled case-law inasmuch as the statement of reasons on which the Board's decision is based must clearly and unequivocally disclose the Board's thinking, so that the persons concerned can be appraised of the justification for the decision taken and the European Courts can exercise their respective powers of review.²¹ As the General Court rightly states in paragraph 83 of its judgment the operative part of the decisions at issue must be read in the context of the reasoning in the decision as a whole.²² I agree with the General Court's assessment that the Board of Appeal made a definitive determination that proof of genuine use was established for one type of service only — 'advertising in connection with vehicles'.

32. It therefore seems to me that while the operative part of the Board's decision could have been more clearly expressed, the General Court did not err in law in concluding that the Board of Appeal had found that Rezon had demonstrated genuine use for that subcategory of services only. Whilst it is true that the Board of Appeal annulled the Cancellation Division's decisions and remitted both cases, the General Court took the view that the *effect* of the Board of Appeal's decisions was that only the question of the merits of the invalidity applications relating to services in Class 35 concerning the subcategory of 'advertising in connection with vehicles' under Article 8(1)(b) of Regulation No 207/2009 required further examination. That reading is confirmed by the General Court's statements in paragraphs 85 and 86 of the judgment under appeal that the Board of Appeal had decided definitively that genuine use was not established for the general categories of services in Class 35 (advertising in connection with vehicles apart) and Class 42.

33. Another way of looking at mobile.de's complaint is to ask whether the Board of Appeal's decision to remit the two cases in their entirety means that mobile.de cannot use the EU trade mark which it has registered for those categories (and subcategories) of goods for which genuine use has *not* been established by Rezon. It seems to me that mobile.de clearly *can* use its trade mark for those goods and services. That view is based on the General Court's reading of the Board of Appeal's decision taken as a whole — the operative part read together with the reasoning set out therein.

34. I therefore consider that mobile.de's complaint in that respect is misconceived.

35. Next, did the General Court err in paragraph 82 of its judgment when it described the question of genuine use of an earlier trade mark for the purposes of Article 57(2) as a preliminary matter?

36. In my view, it follows from the wording of Article 57(2) of Regulation No 207/2009 ('in the absence of proof to this effect the application for a declaration of invalidity shall be rejected')²³ that the General Court is right. Under that regulation there are different stages in invalidity proceedings. First, the proprietor of the earlier trade mark will challenge the application for an EU trade mark — in this case, that challenge was made pursuant to Articles 53(1)(a) and 8(1)(b) of Regulation No 207/2009. Second, under Article 57(2) the holder of the EU trade mark may decide to counter any such challenge by requesting that the proprietor of the earlier mark furnish proof of genuine use. Thus, an aim of Article 57(2) is to prevent the proprietor of the earlier mark (here, Rezon) from attacking an EU trade mark if the earlier mark on which the proprietor relies is liable to be annulled for non-use.²⁴ It follows from the legislative scheme that if the holder of the EU trade mark succeeds under Article 57(2) (because proof of genuine use is not established) it is unnecessary to examine the substantive grounds of any invalidity application (Article 8(1)(b) in the case at issue) and that application must fail. However, if the proprietor of the earlier mark is successful in establishing

21 Judgment of 20 January 2011, *General Química and Others v Commission*, C-90/09 P, EU:C:2011:21, paragraph 59 and the case-law cited.

22 Order of 10 July 2001, *Irish Sugar v Commission*, C-497/99 P, EU:C:2001:393, paragraph 15.

23 Judgment of 18 July 2013, *New Yorker SHK Jeans v OHIM*, C-621/11 P, EU:C:2013:484, paragraph 24.

24 See recital 10.

genuine use, it then becomes necessary to examine the substantive grounds. That is the effect of the decisions at issue as upheld by the General Court in relation to part of the services covered by mobile.de's EU trade mark, namely those services concerning 'advertising in connection with vehicles'.²⁵

37. I understand the General Court simply to be stating that the question of genuine use should be examined at the outset of the assessment in invalidity proceedings when it describes that issue as a 'preliminary matter'.

38. There is some overlap between the second and third parts of the sixth ground of appeal as regards the combined reading of Articles 57(2) and 76(2) of Regulation No 207/2009 and Rules 22(2) and 40(6) of the Implementing Regulation. The issues raised essentially concern the submission of evidence after the time limits specified by EUIPO have expired.

39. It is settled case-law that the Boards of Appeal are not in principle bound by the time limits set at first instance within the Office and that they may admit evidence submitted out of time by virtue of their discretion under Article 76(2) of Regulation No 207/2009 provided that that discretion is exercised objectively and in a reasoned manner. The Court has held that, when no proof of use of the mark concerned is submitted within the time limit set, the Office must automatically reject the opposition. However, when evidence has been produced within the time limit set by the Office, the production of supplementary evidence remains possible.²⁶

40. Thus, the second part of mobile.de's complaint that evidence of genuine use which is not submitted in due time cannot be admitted must be rejected as unfounded, as it follows from settled case-law that EUIPO has a discretion as to whether to take account of supplementary evidence.²⁷

41. In my view, the third part of the sixth plea is based on a misreading of the General Court's judgment. The General Court did not go so far as to state here that, where the Board of Appeal remits a case under Article 64(2) of Regulation No 207/2009, the Cancellation Division to which the case is remitted could decide to consider supplementary evidence as to the genuine use of services in Class 35 that were *not* within the description of 'advertising in connection with vehicles' as well as services in Class 42.

42. However, mobile.de's appeal does raise a novel point of law, in as much as the wording of Article 64(2) of Regulation No 207/2009 which states that the '... department shall be bound by the *ratio decidendi* of the Board of Appeal, in so far as the facts are the same' is unclear. Where the Board of Appeal remits a case for further prosecution, does the relevant department of the Office have a discretion to accept and consider supplementary evidence on a matter upon which the Board of Appeal has already adjudicated?

43. That is a question of general importance since it applies horizontally across the scheme of Regulation No 207/2009 to the full range of proceedings governed by that regulation.²⁸

²⁵ See point 17 above.

²⁶ Judgment of 21 July 2016, *EUIPO v Grau Ferrer*, C-597/14 P, EU:C:2016:579, paragraph 26. The Court confirmed in that case that the discretion under Article 76(2) of Regulation No 207/2009 does not extend to new evidence, that is to say, in cases where no evidence whatsoever relating to proof of use is submitted within the time limits set by EUIPO (see paragraph 27).

²⁷ See, most recently, judgment of 4 May 2017, *Comercializadora Eloro v EUIPO*, C-71/16 P, not published, EU:C:2017:345, paragraphs 55 to 59 and the case-law cited.

²⁸ The range of proceedings includes opposition, revocation and invalidity proceedings, see judgment of 21 July 2016, *EUIPO v Grau Ferrer*, C-597/14 P, EU:C:2016:579, paragraph 27.

44. With regard to examining an appeal, I read Article 64(1) as referring to the situation where the Board of Appeal may exercise its discretion under Article 76(2) by taking account of supplementary evidence in accordance with this Court's case-law. If the Board makes definitive findings of fact based on that evidence and remits the case at issue to the relevant department of EUIPO under Article 64(2), that department is bound by the Board's ruling on appeal. It is not then open to that department to assess supplementary evidence submitted by a party on a matter that is the subject of a definitive ruling on appeal. In *mobile.de*'s case, the Board of Appeal's ruling was not susceptible to further prosecution for the purposes of Article 64(2) of Regulation No 207/2009 in so far as it concerns services in Class 35 that were not 'advertising in connection with vehicles' or services in Class 42. Supplementary evidence in relation to those matters could not therefore be put before the Cancellation Division following the Board of Appeal's decision to remit.

45. However, concerning the question whether there was a likelihood of confusion regarding services relating to 'advertising in connection with vehicles' for the purposes of Article 8(1)(b) of that regulation, the Cancellation Division was required to examine that question in accordance with the rules under Regulation No 207/2009 and the Implementing Regulation. That was not a matter that had been examined by the Board of Appeal and there had been no definitive ruling in that respect. That examination includes the power to exercise the discretion conferred by Article 76(2). It seems to me that the wording of Article 64(2) covers precisely that situation.

46. I emphasise, however, that it would be incompatible with the scheme of the legislation to construe Articles 64(2) and 76(2) of Regulation No 207/2009 in a manner which allowed departments of the Office to consider supplementary evidence in cases where the Board of Appeal has made findings of fact and issued a definitive ruling. It would be wrong to construe the words 'in so far as the facts are the same' as meaning that supplementary evidence may be submitted and therefore the facts are not 'the same' within the meaning of Article 64(2). That seems to me go beyond what is envisaged by Article 76(2). It would undermine Title VII of Regulation No 207/2009 governing the appeals procedure. It would render the decisions of the Boards of Appeal legally uncertain in all cases where there is a decision to remit. Such an interpretation would dent the judicial architecture established by Regulation No 207/2009. Furthermore, such a view would be incompatible with the practical purpose of Regulation No 207/2009 which is to protect the EU trade mark.²⁹ Lastly, it would be incompatible with the principle of legal certainty.

47. I therefore consider that the sixth ground of appeal should be rejected as unfounded.

Costs

48. In accordance with Article 137 of the Rules of Procedure of the Court of Justice, a decision as to costs shall be given in the judgment which closes these proceedings.

Conclusion

49. In the light of the foregoing considerations I propose that the Court should:

- reject the sixth ground of appeal as being unfounded; and
- make the appropriate order for costs pursuant to the Rules of Procedure of the Court of Justice at the close of these proceedings.

²⁹ Judgment of 5 April 2017, *EUIPO v Szajner*, C-598/14 P, EU:C:2017:265, paragraph 39.