



Reports of Cases

JUDGMENT OF THE COURT (Fourth Chamber)

11 October 2017*

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Figurative mark containing the word elements ‘CACTUS OF PEACE CACTUS DE LA PAZ’ — Opposition by the proprietor of word and figurative EU trade marks containing the word element ‘Cactus’ — Nice Classification — Article 28 — Point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 — Genuine use of the mark in an abbreviated form)

In Case C-501/15 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 22 September 2015,

European Union Intellectual Property Office (EUIPO), represented by A. Folliard-Monguiral, acting as Agent,

appellant,

the other party to the proceedings being:

Cactus SA, established in Bertrange (Luxembourg), represented by K. Manhaeve, avocate,

applicant at first instance,

Isabel Del Rio Rodríguez, residing in Malaga (Spain),

party to the proceedings before the Board of Appeal of EUIPO,

THE COURT (Fourth Chamber),

composed of T. von Danwitz, President of the Chamber, C. Vajda, E. Juhász, K. Jürimäe (Rapporteur) and C. Lycourgos, Judges,

Advocate General: N. Wahl,

Registrar: K. Malacek, Administrator,

having regard to the written procedure and further to the hearing on 29 March 2017,

after hearing the Opinion of the Advocate General at the sitting on 17 May 2017,

gives the following

* Language of the case: English.

Judgment

- 1 By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court of Justice to set aside the judgment of the General Court of the European Union of 15 July 2015, *Cactus v OHIM — Del Rio Rodríguez (CACTUS OF PEACE CACTUS DE LA PAZ)* (T-24/13, not published, ‘the judgment under appeal’, EU:T:2015:494), by which the General Court annulled in part the decision of the Second Board of Appeal of EUIPO of 19 October 2012 (Case R 2005/2011-2) relating to opposition proceedings between Cactus SA and Ms Isabel Del Rio Rodríguez (‘the decision at issue’).

Legal context

- 2 Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), which came into force on 13 April 2009, repealed and replaced Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).
- 3 Article 15(1) of Regulation No 207/2009, entitled ‘Use of [EU] trade marks’, provides:

‘If, within a period of five years following registration, the proprietor has not put the [EU] trade mark to genuine use in the [Union] in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the [EU] trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

- (a) use of the [EU] trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

...’

- 4 Article 28 of that regulation, entitled ‘Classification’, provides:

‘Goods and services in respect of which [EU] trade marks are applied for shall be classified in conformity with the system of classification specified in [Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1)].’

- 5 Article 42 of Regulation No 207/2009, entitled ‘Examination of opposition’, provides, in paragraph 2 thereof:

‘If the applicant so requests, the proprietor of an earlier [EU] trade mark who has given notice of opposition shall furnish proof that, during the five-year period preceding the date of publication of the [EU] trade mark application, the earlier [EU] trade mark has been put to genuine use in the [Union] in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, 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. In the absence of proof to this effect, the opposition shall be rejected. If the earlier [EU] trade mark has been used in relation to only part of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.’

- 6 Rule 2 of Regulation No 2868/95, entitled ‘List of goods and services’, provides:
- ‘1. The common classification referred to in Article 1 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, shall be applied to the classification of the goods and services (“the Nice Agreement”).
 2. The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.
 3. The goods and services shall, in principle, be grouped according to the classes of the Nice Classification, each group being preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes under that Classification.
 4. The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.’
- 7 By two communications, one published in 2003, the other in 2012, the President of EUIPO issued guidance concerning the use of class headings of goods provided for in the Nice Agreement.
- 8 The first paragraph of Point IV of Communication No 4/03 of the President of EUIPO, of 16 June 2003, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (‘Communication No 4/03’), stated:
- ‘The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class.’
- 9 On 20 June 2012 the President of EUIPO adopted Communication No 2/12, repealing Communication No 4/03 and concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (‘Communication No 2/12’). Point V of that communication states:
- ‘As regards [EU] trade marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, [EUIPO] considers that the intention of the applicant, in view of the contents of the previous Communication No 4/03, was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made.’

Background to the dispute

- 10 The background to the dispute is set out in paragraphs 1 to 12 of the judgment under appeal and may be summarised as follows.

- 11 On 13 August 2009 Ms Isabel Del Rio Rodríguez filed an application to register the following figurative sign as an EU trade mark with EUIPO, under Regulation No 207/2009:

CACTUS OF PEACE

CACTUS DE LA PAZ

- 12 The goods and services in respect of which registration was sought are in Classes 31, 39 and 44 of the Nice Agreement.
- 13 On 12 March 2010 Cactus filed a notice of opposition, pursuant to Article 41 of Regulation No 207/2009, to the registration of the mark applied for in respect of all the goods and services covered by it.
- 14 The opposition was based on the following earlier marks:
- the EU word mark CACTUS, registered on 18 October 2002 under number 963694, for goods and services in Classes 2, 3, 5 to 9, 11, 16, 18, 20, 21, 23 to 35, 39, 41 and 42 of the Nice Agreement, and
 - the EU figurative mark, reproduced below, registered on 6 April 2001 under number 963595, for the same goods and services as those covered by the earlier word mark, with the exception of ‘foodstuffs not included in other classes; natural plants and flowers, grains; fresh fruits and vegetables’ in Class 31 of that agreement:



- 15 The opposition was based on Article 8(1)(b) of Regulation No 207/2009.
- 16 By decision of 2 August 2011, the Opposition Division upheld the opposition for ‘seeds, natural plants and flowers’ in Class 31 of the Nice Agreement and ‘gardening, plant nurseries, horticulture’ in Class 44 of that agreement, which are covered by the earlier word mark.

- 17 The Opposition Division considered, inter alia, that, following Ms Del Rio Rodríguez's request that Cactus prove that the earlier marks had been put to genuine use, the evidence submitted by the applicant showed genuine use of the earlier word mark for the goods in Class 31 of the Nice Agreement, and for 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35 of that agreement.
- 18 Registration of the trade mark applied for was therefore refused for the goods and services mentioned in paragraph 16 above, but accepted for the services in Class 39 of the Nice Agreement.
- 19 On 28 September 2011 Ms Del Rio Rodríguez filed an appeal with EUIPO against the Opposition Division's decision.
- 20 By the decision at issue, the Second Board of Appeal of EUIPO upheld the appeal and dismissed the opposition in its entirety. In particular, it found that the Opposition Division had erred in considering that Cactus had adduced proof of genuine use of the earlier trade marks in respect of 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35 of the Nice Agreement.

The procedure before the General Court and the judgment under appeal

- 21 By application lodged at the Registry of the General Court on 21 January 2013, Cactus brought an action for annulment of the decision at issue.
- 22 In support of its action, Cactus relied on, in essence, three pleas in law, alleging respectively (i) infringement of Article 42(2) of Regulation No 207/2009, (ii) infringement of Articles 75 and 76(1) of that regulation and (iii) infringement of Article 76(2) of that regulation.
- 23 By the judgment under appeal, the General Court upheld the first two pleas and rejected the third plea. Consequently, the General Court annulled the decision at issue to the extent that it, first, rejected the opposition on the ground that 'retailing of natural plants and flowers, grains; fresh fruits and vegetables' services in Class 35 of the Nice Agreement was not covered by the earlier trade marks and, second, rejected the opposition based on 'natural plants and flowers, grains' in Class 31 of that agreement; it dismissed the action as to the remainder.

Forms of order sought by the parties

- 24 By its appeal, EUIPO claims that the Court should:
- allow the appeal in its entirety and set aside the judgment under appeal, and
 - order Cactus to pay the costs.
- 25 Cactus claims that the Court should:
- dismiss the appeal in its entirety, and
 - order EUIPO to pay the costs.

The appeal

- 26 In support of its appeal, EUIPO raises two grounds of appeal based, respectively, on an infringement of Article 28 of Regulation No 207/2009, read in conjunction with Rule 2 of Regulation No 2868/95, and an infringement of Article 42(2) of Regulation No 207/2009, read in conjunction with point (a) of the second subparagraph of Article 15(1) of that regulation.

The first ground of appeal

Arguments of the parties

- 27 By its first ground of appeal, EUIPO criticises the General Court for having infringed Article 28 of Regulation No 207/2009, read in conjunction with Rule 2 of Regulation No 2868/95, in adopting an erroneous interpretation of the judgments of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, ‘the judgment in *IP Translator*’, EU:C:2012:361), and of 7 July 2005, *Praktiker Bau- und Heimwerkermärkte* (C-418/02, ‘the judgment in *Praktiker Bau*’, EU:C:2005:425). That erroneous interpretation led it to consider, in paragraphs 36 and 37 of the judgment under appeal, that the use of all the general indications of the class heading in Class 35 of the Nice Agreement extends the protection of the earlier trade marks to all the services included in that class, including services consisting in retailing goods.
- 28 EUIPO recalls that Communication No 4/03 had initially authorised the use of the general indications composing the class headings of the Nice Agreement. According to the wording of that communication, the designation of the whole class heading of a particular class of that agreement constituted a claim to all the goods or services falling within that particular class, including those not mentioned in the alphabetical list. Thus, none of those indications was regarded as too vague or indefinite.
- 29 The Court overturned that approach in the judgment in *IP Translator*. According to EUIPO, it is apparent from paragraphs 57 to 64 of that judgment that the general indications of a particular class may cover only the goods or services included in the alphabetical list of that class, provided two cumulative conditions are fulfilled: the individual terms making up the class heading must be sufficiently ‘clear and precise’, and the application must reflect the applicant’s intention to cover all the goods or services included in that alphabetical list.
- 30 Following the delivery of that judgment, Communication No 4/03 was repealed and replaced by Communication No 2/12 which limits, in relation to EU trade marks applied for before 21 June 2012, the scope of the general indications of a class heading of the Nice Agreement to all the goods or services in the alphabetical list of a particular class, as opposed to all the goods and services in that class.
- 31 In the present case, EUIPO does not dispute that retail services fall within Class 35 of the Nice Agreement. However, neither retailing services as such, nor ‘retailing of natural plants and flowers, grains; fresh fruits and vegetables’ are included in the alphabetical list of that class. EUIPO thus considers that the General Court erred in finding that the earlier marks were protected in respect of retail services.
- 32 EUIPO adds that, in finding that Class 35 of the Nice Agreement covers retail services for all possible goods, the General Court also made an error of interpretation in respect of the judgment in *Praktiker Bau*, which provides that the applicant is required to specify the goods or types of goods to which the retail services relate.

- 33 Thus, in holding, in paragraph 38 of the judgment under appeal, that the judgment in *Praktiker Bau* does not apply to trade marks registered before the date of delivery of that judgment, the General Court disregarded the retroactive effect of case-law, which may be limited only in exceptional circumstances. Indeed, the Court of Justice did not limit the effects of the judgment in *Praktiker Bau*. The General Court was therefore wrong not to apply the interpretation adopted in that judgment to the earlier marks.
- 34 Cactus disputes the merits of all those arguments.

Findings of the Court

- 35 EUIPO criticises, in essence, the General Court for having misread the judgments in *IP Translator* and *Praktiker Bau* in holding that the authority derived from those judgments did not have a retroactive effect and for having concluded — wrongly — that the designation of the class heading of Class 35 of the Nice Agreement covers all the services within that class, including retail services in respect of any goods. EUIPO takes the view that that line of authority applies retroactively and that it should have been applied to the earlier marks, regardless of the fact that those marks were registered before the delivery of those judgments.
- 36 In the judgment under appeal, the General Court considered, in paragraphs 36 to 38, that, in the light of the principle of legal certainty, it was not appropriate to apply the authority derived from the judgments in *IP Translator* and *Praktiker Bau* to the earlier marks given that they had been registered before those judgments were delivered. The General Court thereby concluded that, for the earlier marks, the designation of the class heading of Class 35 of the Nice Agreement covered all the services within that class, including the services consisting in the retail of any goods.
- 37 As regards, in the first place, the scope of the judgment in *IP Translator*, it should be recalled that, in paragraph 61 of that judgment, the Court held that, in order to comply with the requirements of clarity and precision, an applicant for a trade mark who uses all of the general indications of a particular class heading of the Nice Classification to identify the goods or services for which protection of the trade mark is sought must specify whether his application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.
- 38 The Court indicated, in paragraphs 29 and 30 of the judgment of 16 February 2017, *Brandconcern v EUIPO and Scooters India* (C-577/14 P, ‘the judgment in *Brandconcern*’, EU:C:2017:122), that the *IP Translator* judgment provided clarifications only on the requirements relating to new EU trade mark registration applications, and thus does not concern trade marks that were already registered at the date of that latter judgment’s delivery. The Court thus inferred, in paragraph 31 of the judgment in *Brandconcern*, that it therefore could not be considered that the Court, by the *IP Translator* judgment, had sought to question the validity of the approach set out in Communication No 4/03 as regards trade marks registered before the delivery of that latter judgment.
- 39 Communication No 2/12 cannot call into question that case-law and thus lead to the scope of protection of trade marks registered before the delivery of the *IP Translator* judgment for goods or services designated by the general indications of the class headings of the Nice Agreement being limited solely to the goods or services mentioned in the alphabetical list of that class and to that protection being denied, in accordance with Communication No 4/03, to all the goods and services within that class.

- 40 As the Advocate General observed in points 45 and 46 of his Opinion, the scope of the protection afforded by trade marks that have been registered may not be altered on the basis of a non-binding communication which has no function other than to provide clarification for applicants as to the practices of EUIPO.
- 41 During the hearing before the Court, EUIPO contended that it could not be inferred from the *Brandconcern* judgment that the protection afforded by the earlier marks could extend beyond the goods or services mentioned in the alphabetical list of the class concerned. It observed that, in that judgment, the Court confirmed the reasoning adopted by the General Court, according to which the registration of an earlier trade mark referring to a class heading was to be interpreted as seeking to protect that trade mark exclusively for all the goods in the alphabetical list of the relevant class and not beyond, in accordance with the provisions of Communication No 2/12 relating to trade marks registered before the delivery of the judgment in *IP Translator*.
- 42 It is nevertheless appropriate to note in that regard, as the Advocate General observed in points 48 to 50 of his Opinion, that such a reading of the *Brandconcern* judgment is erroneous. That judgment did not concern the distinction between, on the one hand, the goods or services appearing in the alphabetical list of a class of the Nice Agreement and, on the other hand, overall and more broadly, goods or services covered by the heading of that class. It was concerned solely with determining whether it was the literal meaning of the relevant class heading that was to be taken into account or, on the contrary, whether it was to be considered that such a heading covered the goods appearing in the alphabetical list of that class. The judgment in *Brandconcern* cannot, therefore, be read as having limited the scope of the registration of earlier trade marks using the heading to solely the goods or services appearing in the alphabetical list of that class.
- 43 It follows from the foregoing that the General Court was right to hold that the authority derived from the *IP Translator* judgment did not apply to the earlier trade marks.
- 44 As regards, in the second place, the scope of the judgment in *Praktiker Bau*, it is important to recall that, in paragraphs 39 and 50 of that judgment, the Court held that, although retail trade in goods constitutes a service in Class 35 of the Nice Agreement, the applicant must nevertheless be required to specify, for the purposes of registering a trade mark, the goods or the types of goods to which the retail trade relates.
- 45 As the Advocate General observed in point 56 of his Opinion, however — following the approach adopted in the *IP Translator* judgment — the line of authority derived from the *Praktiker Bau* judgment concerns only applications for registration as EU trade marks and does not concern the scope of the protection of trade marks registered at the date of that judgment's delivery.
- 46 Such an approach is moreover consistent, as the Advocate General noted in point 57 of his Opinion, with the principles of legal certainty and protection of legitimate expectations.
- 47 Thus, the General Court cannot be criticised for having considered, in paragraph 38 of the judgment under appeal, that Cactus was not required to specify the goods or types of goods to which the retail trade related.
- 48 Thus, it is apparent from examining the judgments in *IP Translator* — as interpreted by the Court in the *Brandconcern* judgment — and *Praktiker Bau* that the scope of the protection of a trade mark registered before the delivery of those judgments, such as Cactus' word mark, registered on 18 October 2002, and Cactus' figurative mark, registered on 6 April 2001, cannot be affected by the authority derived from those judgments in so far as they concern only new applications for registration as EU trade marks.

- 49 Last, to the extent that Article 28(8) of Regulation No 207/2009, as amended by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), lays down a transitional provision allowing the proprietors of EU trade marks applied for before 22 June 2012 and registered in respect of the entire heading of a class of the Nice Classification to declare, before 24 September 2016, that their intention, at the date when the application was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of that heading but included in the alphabetical list for that class, it suffices to point out that that provision was not applicable at the date of the decision at issue.
- 50 It follows from the foregoing considerations that the General Court did not err in law in holding that, for the earlier trade marks at issue, the designation of the class heading of Class 35 of the Nice Agreement covered all the services included in that class, including services consisting of the retail of goods.
- 51 The first ground of appeal must therefore be rejected as unfounded.

The second ground of appeal

Arguments of the parties

- 52 By its second ground of appeal, EUIPO claims that the General Court infringed Article 42(2) of Regulation No 207/2009, read in conjunction with point (a) of the second subparagraph of Article 15(1) thereof, in finding that the use of the earlier trade mark's only figurative element — the stylised cactus — without the word element 'Cactus' equated to a use 'in a form that differs in elements which do not alter the distinctive character of that mark in the form in which it is registered' within the meaning of that latter provision.
- 53 EUIPO argues that that finding is vitiated by four errors of law.
- 54 The General Court committed a first error of law in considering that the stylised logo of a cactus was 'essentially equivalent' to the form in which the composite mark was registered. It did not verify whether the word element 'Cactus', which had been omitted from the abbreviated version of the earlier figurative mark, was per se distinctive in respect of 'natural plants and flowers, grains' or whether that word element was, on account of its size and position within the earlier trade mark, negligible or, on the contrary, apt to catch the consumer's attention and be memorised on its own as identifying the commercial origin of the goods.
- 55 The second alleged error consists in the General Court's having deduced the equivalence of the marks as used and registered solely from the semantic equivalence of their word and figurative components, without carrying out an overall assessment of the equivalence of the signs, necessitating an analysis of the visual and, possibly, phonetic differences which may be capable of distinguishing the form in which the earlier mark was registered from that in which that mark was used.
- 56 The third alleged error lies in the General Court's implicit basing of its finding of the equivalence between the stylised cactus and the form in which the composite mark was registered on the prior knowledge that consumers may have of the latter. Without that prior knowledge, consumers would have no reason to assume that the stylised cactus was an element of a composite mark, the second element of which was necessarily the word 'Cactus'.
- 57 Last, the General Court's alleged fourth error was in its disregarding the need to examine the alteration of the distinctive character of the earlier composite mark in the perception of European consumers, not only consumers in Luxembourg. Had the perception of European consumers been taken into account, the General Court would have had to come to the conclusion that, for a substantial part of

the relevant public, the stylised cactus could not be equated with the word ‘cactus’ or with the earlier composite mark as a whole, since the equivalent term in the official languages of the European Union — ‘cacto’, ‘kaktus’, ‘kaktusas’, ‘kaktuzs’ and ‘κάκτος’ — have a different spelling and pronunciation.

- 58 Cactus argues, primarily, that the second ground of appeal must be regarded as inadmissible since EUIPO is, in fact, asking the Court to reassess factual elements and thus to substitute its own assessment for that of the General Court.
- 59 In the alternative, Cactus contends that EUIPO’s arguments are unfounded.

Findings of the Court

- 60 Under Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal lies on points of law only. The General Court thus has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where they distort the facts or evidence, constitute a point of law which is subject as such to review by the Court of Justice on appeal (judgment of 12 July 2012, *Smart Technologies v OHIM*, C-311/11 P, EU:C:2012:460, paragraph 52 and the case-law cited).
- 61 As regards the third alleged error, by which EUIPO criticises the General Court for having based its finding of the equivalence between the signs on the alleged prior knowledge consumers had of the sign as registered, it must be pointed out that findings in relation to the attentiveness, the perception and the attitude of the relevant public are appraisals of fact (see, to that effect, judgment of 12 July 2012, *Smart Technologies v OHIM*, C-311/11 P, EU:C:2012:460, paragraph 51 and the case-law cited).
- 62 As regards the fourth alleged error, by which EUIPO criticises the General Court for having examined the possible alteration of the distinctiveness of the earlier figurative mark only in the perception of consumers in Luxembourg and not in the perception of European consumers in general, it is appropriate, for the same reasoning as that set out in the preceding paragraph of the present judgment, to point out that the considerations criticised are factual in nature and that it is not for the Court of Justice to rule on them unless there has been a distortion of the facts, which is not alleged in the present case.
- 63 The second ground of appeal must therefore be rejected as inadmissible in so far as it concerns the definition of the relevant public and that public’s perception of the earlier figurative mark.
- 64 The second ground of appeal, however, is admissible in so far as the first and second errors alleged in it concern the criteria in the light of which genuine use of a trade mark in an abbreviated form should be assessed. Contrary to what Cactus maintains, the determination of the criteria to be employed for the global assessment of equivalence of signs from the perspective of their distinctiveness is a question of law falling within the Court of Justice’s jurisdiction.
- 65 The Court has already held in that regard that it follows directly from the wording of point (a) of the second subparagraph of Article 15(1) of that regulation that the use of the trade mark in a form which differs from the form in which it was registered is regarded as use for the purposes of the first subparagraph of that article provided that the distinctive character of the mark in the form in which it was registered is not altered (judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 21).

- 66 It should be recalled that, in so far as it does not impose strict conformity between the form in which the trade mark is used and the form in which the mark was registered, the purpose of point (a) of the second subparagraph of Article 15(1) of that regulation is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (see, to that effect, judgment of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 29).
- 67 It follows that the condition of ‘genuine use’ in the sense of point (a) of the second subparagraph of Article 15(1) of the same regulation is satisfied even where only the figurative element of a composite mark is used, as long as the distinctive character of that mark, as registered, is not altered.
- 68 So far as concerns the first alleged error, EUIPO cannot criticise the General Court for not having verified the extent to which the part omitted, namely the word element ‘Cactus’, had a distinctive character and was important in the perception of the sign as a whole, when the General Court rightly compared the sign as used in its abbreviated form to the sign as registered.
- 69 In paragraph 61 of the judgment under appeal, the General Court found — and that finding has not been disputed by EUIPO in the present appeal — that the two elements of the earlier figurative mark, namely a stylised cactus and the word element ‘Cactus’, conveyed, in their respective forms, the same semantic content. It follows from that finding, however, that the General Court considered that the word element ‘Cactus’ could not be regarded as possessing a distinctive character that was different from that of the stylised cactus and that the absence of that word element in the abbreviated version of the earlier figurative mark was not sufficiently important in the perception of that mark as a whole as to alter its distinctive character.
- 70 As regards the second alleged error, it should be pointed out, as the Advocate General observed in point 81 of his Opinion, that the General Court rightly conducted a global assessment of the equivalence of the sign used in an abbreviated form, the stylised cactus alone, and of the sign protected by the earlier figurative mark, the stylised cactus, accompanied by the word element ‘Cactus’. In that regard, it must be noted, first, that, contrary to what EUIPO claims, the General Court conducted a visual comparison, noting that the representation of the stylised cactus was the same in the two signs. Second, an express phonetic comparison of those signs would have been superfluous, since the General Court found that the two elements of the earlier figurative mark had the same semantic content. It must therefore be held that the General Court could, without infringing point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009, merely carry out, in paragraph 61 of the judgment under appeal, an examination of the equivalence of the signs at issue on the visual and conceptual levels.
- 71 The second ground of appeal must therefore be rejected as unfounded in so far as it concerns the criteria in the light of which it is appropriate to assess the equivalence of the signs at issue for the purpose of demonstrating genuine use.
- 72 Accordingly, the second ground of appeal must be rejected as partly inadmissible and partly unfounded.
- 73 In the light of all of the foregoing elements, the appeal must be dismissed in its entirety.

Costs

⁷⁴ In accordance with Article 138(1) of the Rules of Procedure of the Court of Justice, which applies to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since Cactus has applied for costs and EUIPO has been unsuccessful, the latter must be ordered to pay the costs.

On those grounds, the Court (Fourth Chamber) hereby:

- 1. Dismisses the appeal;**
- 2. Orders the European Union Intellectual Property Office (EUIPO) to pay the costs.**

von Danwitz

Vajda

Juhász

Jürimäe

Lycourgos

Delivered in open court in Luxembourg on 11 October 2017.

A. Calot Escobar
Registrar

T. von Danwitz
President of the Fourth Chamber