



## Reports of Cases

JUDGMENT OF THE COURT (Second Chamber)

16 July 2020\*

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Application for registration of EU word mark tigha — Opposition filed by the proprietor of the earlier EU trade mark TAIGA — Partial dismissal of the application for registration — Article 8(1)(b) — Assessment of the likelihood of confusion — Assessment of the conceptual similarity of the signs at issue — Article 42(2) — Proof of genuine use of the earlier mark — Proof of use ‘in relation to part ... of the goods or services’ — Determination of an independent subcategory of goods)

In Case C-714/18 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 14 November 2018,

**ACTC GmbH**, established in Erkrath (Germany), represented by V. Hoene, S. Gantenbrink and D. Eickemeier, Rechtsanwälte,

appellant,

the other parties to the proceedings being:

**European Union Intellectual Property Office (EUIPO)**, represented by D. Gája, acting as Agent,

defendant at first instance,

**Taiga AB**, represented in Varberg (Sweden), represented by C. Eckhartt, A. von Mühlendahl, K. Thanbichler-Brandl and C. Fluhme, Rechtsanwälte,

intervener at first instance,

THE COURT (Second Chamber),

composed of A. Arabadjiev, President of the Chamber, T. von Danwitz and A. Kumin (Rapporteur),  
Judges,

Advocate General: E. Sharpston,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after hearing the Opinion of the Advocate General at the sitting on 19 December 2019,

\* Language of the case: English.

gives the following

### Judgment

- 1 By its appeal, ACTC GmbH seeks to have set aside the judgment of the General Court of the European Union of 13 September 2018, *ACTC v EUIPO — Taiga (tigha)* (T-94/17, not published, ‘the judgment under appeal’, EU:T:2018:539), by which the General Court dismissed its action for annulment of the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 9 December 2016 (Case R 693/2015-4), relating to opposition proceedings between Taiga AB and ACTC (‘the contested decision’).

### 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) was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. Regulation No 207/2009, as amended by Regulation 2015/2424, was repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1). Nevertheless, in view of the date on which the application for registration at issue was filed, namely 28 December 2012, which is decisive for the purpose of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009, in its initial version (see, to that effect, judgment of 4 July 2019, *FTI Touristik v EUIPO*, C-99/18 P, EU:C:2019:565, paragraph 2).

- 3 Article 8(1)(b) of Regulation No 207/2009 provides:

‘1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

...

(b) 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.’

- 4 The first subparagraph of Article 15(1) of that regulation provides:

‘If, within a period of five years following registration, the proprietor has not put the [EU] trade mark to genuine use in the [European 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.’

- 5 According to Article 42(2) of that regulation:

‘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 period of five years preceding the date of publication of the [EU] trade mark application, 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 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 part only 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 Article 43(1) of the same regulation provides:

‘The applicant may at any time withdraw his [EU] trade mark application or restrict the list of goods or services contained therein. Where the application has already been published, the withdrawal or restriction shall also be published.’

### **Background to the dispute and the contested decision**

7 The background to the dispute is set out in paragraphs 1 to 10 of the judgment under appeal. For the purposes of the present proceedings, it may be summarised as follows.

8 On 28 December 2012, the appellant filed an application for registration of an EU trade mark with EUIPO, pursuant to Regulation No 207/2009. The mark in respect of which registration was sought is the word sign ‘tigha’ (‘the mark applied for’).

9 The goods for which registration was sought are, inter alia, in Class 25 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 (‘the Nice Agreement’), and correspond to the following description:

‘Clothing, footwear, headgear; Suits; Clothing of imitations of leather; Motorists’ clothing; Clothing; Dresses; Gabardines [clothing]; Belts [clothing]; Half-boots; Gloves [clothing]; Shirt yokes; Shirts; Shirt fronts; Wooden shoes; Trousers; Hats; Jackets [clothing]; Jerseys [clothing]; Stuff jackets [clothing]; Skull caps; Hoods [clothing]; Ready-made clothing; Headgear for wear; Camisoles; Short-sleeve shirts; Clothing of leather; Leggings [trousers]; Underwear; Coats; Pelisses; Caps [headwear]; Cap peaks; Outerclotthing; Ear muffs [clothing]; Combinations [clothing]; Parkas; Ponchos; Pullovers; Waterproof clothing; Skirts; Sandals; Sashes for wear; Shoes; Soles for footwear; Footwear uppers; Tips for footwear; Footwear; Smocks; Ski gloves; Underpants; Socks; Boots; Boot uppers; Headbands [clothing]; Stockings; Stockings (Sweat-absorbent -); Tights; Sweaters; Tee-shirts; Jumper dresses; Knitwear [clothing]; Singlets; Topcoats; Uniforms; Underwear (Anti-sweat -); Pants; suits water-skiing; Vests; Hosiery; Top hats’.

10 The EU trade mark application was published in *European Union Trade Marks Bulletin* No 2013/011 of 16 January 2013.

11 On 12 April 2015, Taiga, intervener at first instance, filed a notice of opposition against registration of the mark applied for, inter alia, for the goods referred to in paragraph 9 of the present judgment.

12 The opposition was based on the earlier EU word mark TAIGA, covering, inter alia, goods falling within Class 25 of the Nice Agreement and corresponding to the following description:

‘Clothing; outer clothing; underwear; footwear; headgear for wear and headwear; work shoes and boots; working overalls; gloves; belts and socks’.

13 The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation No 207/2009.

- 14 By decision of 9 February 2015, the Opposition Division of EUIPO rejected the opposition in its entirety.
- 15 On 28 September 2015, Taiga filed a notice of appeal with OHIM against the Opposition Division's decision.
- 16 By the contested decision, the Fourth Board of Appeal of EUIPO ('the Board of Appeal') partially annulled that decision of the Opposition Division, namely for all the goods at issue, falling within Class 25 of the Nice Agreement, and consequently rejected the application for registration concerning those goods. It considered use of the earlier mark to have been proved for certain goods in Class 25, which were identical or similar to the goods covered by the mark applied for, that the signs at issue were highly similar from a visual perspective, phonetically identical — at least for English-speaking consumers — and that those signs could not be linked to any concept for the majority of the relevant public. In those circumstances, the Board of Appeal concluded that there was a likelihood of confusion on the part of that public, for the purposes of Article 8(1)(b) of Regulation No 207/2009, in respect of the goods in Class 25.

### **Procedure before the General Court and the judgment under appeal**

- 17 By application lodged at the Registry of the General Court on 13 February 2017, the appellant brought an action for annulment of the contested decision.
- 18 In support of its action, it raised two pleas in law, alleging, respectively, infringement of Article 42(2) of Regulation No 207/2009 and infringement of Article 8(1)(b) of that regulation.
- 19 By the judgment under appeal, the General Court dismissed the action in its entirety.

### **Forms of order sought by the parties**

- 20 The appellant requests that the Court:
- set aside the judgment under appeal and annul the contested decision;
  - in the alternative, set aside the judgment under appeal and refer the case back to the General Court, and
  - order EUIPO to pay the costs.
- 21 EUIPO contends that the Court should:
- dismiss the appeal, and
  - order the appellant to pay the costs.
- 22 Taiga claims that the Court should:
- dismiss the appeal, and
  - order the appellant to pay the costs of the proceedings, including the costs to which it has been exposed.

## The appeal

- 23 In support of its appeal, the appellant raises two grounds of appeal, alleging, respectively, infringement of Article 42(2) of Regulation No 207/2009 and infringement of Article 8(1)(b) of that regulation.

### *First ground of appeal*

#### *Arguments of the parties*

- 24 By the first ground of appeal, the appellant criticises, in essence, the General Court for finding, in paragraph 34 of the judgment under appeal, that the articles of clothing referred to in the evidence produced by Taiga to demonstrate use of the earlier mark all had the same purpose. The General Court was thus wrong to hold that those goods did not constitute an independent subcategory of goods falling within Class 25 of the Nice Agreement.
- 25 By the first part of this ground, the appellant claims that the General Court should not have based its assessment on the goods referred to in that evidence, but on those for which the earlier mark had been registered. Thus, the question which the General Court ought to have answered is whether the earlier mark was registered for a category of goods sufficiently broad for it to be possible to identify within it a number of independent subcategories, such that the use related only to specific goods of that 'broad category'.
- 26 By the second part of the ground, the appellant criticises the General Court for failing to take into account the fact that clothing, referred to in the said evidence and covered by the mark applied for, was, first, intended for different ranges of use, namely to cover, conceal, adorn or protect the human body, and, second, was aimed at different publics and sold in different shops, such that the former could be distinguished from the latter.
- 27 EUIPO takes the view that the first ground of appeal should be dismissed as inadmissible in so far as the appellant claims that the General Court made an incorrect assessment of the evidence submitted by Taiga before the Board of Appeal to demonstrate that the earlier mark had been put to genuine use. According to EUIPO, therefore, the appellant challenges the factual assessment made by the General Court, without alleging a distortion of those facts or invoking any error of law that might invalidate the General Court's reasoning. In any event, that ground should be dismissed as unfounded.
- 28 TAIGA contends that the ground must be rejected as unfounded.

#### *Findings of the Court*

- 29 As a preliminary point, it is appropriate to reject the line of argument of EUIPO relating to the inadmissibility of the first ground of appeal. The appellant does not in fact challenge a factual assessment of the General Court, but calls into question the methodology and criteria applied by the General Court to define use 'in relation to part ... of the goods or services', within the meaning of Article 42(2) of Regulation No 207/2009. Since this ground of appeal thus concerns criteria in respect of which the General Court must assess the existence of genuine use for the goods or services for which it is registered, or part of those goods or services, within the meaning of that provision, that ground raises a question of law which can be subject to review by the Court of Justice on appeal (see, to that effect, judgment of 12 December 2019, *Der Grüne Punkt v EUIPO*, C-143/19 P, EU:C:2019:1076, paragraph 51 and the case-law cited).



30 By its line of argument, the appellant criticises the General Court, first of all, for considering it appropriate to ascertain whether the only articles referred to in the proof of use submitted by the intervener constituted an independent subcategory in relation to the goods in Class 25 of the Nice Agreement, next, for not correctly applying the criterion of the purpose and intended use of the goods in question in order to determine such an independent subcategory as well as, last, for failing to take into account the fact that the goods at issue were aimed at different publics and were sold in different shops.

31 In that regard, it should be recalled at the outset that the General Court noted, in paragraphs 29 to 32 of the judgment under appeal, the following:

‘29 The provisions of Article 42 of Regulation No 207/2009 allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration, so they cannot be interpreted in such a way as to give rise to an unjustified limitation of the scope of protection of the earlier mark, in particular in the event that the goods or services for which that mark was registered constitute a sufficiently narrowly defined category, and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him (see, to that effect, judgment of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, T-126/03, EU:T:2005:288, paragraphs 51 and 53).

30 If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition (judgments of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, T-126/03, EU:T:2005:288, paragraph 45, and of 13 February 2007, *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, T-256/04, EU:T:2007:46, paragraph 23).

31 However, although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not result in the proprietor of that trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. It must be observed in that regard that it is in practice impossible for the proprietor of a trade mark to furnish proof that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of “part of the goods or services” cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories (judgments of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, T-126/03, EU:T:2005:288, paragraph 46, and of 6 March 2014, *Anapurna v OHIM — Annapurna (ANNAPURNA)*, T-71/13, not published, EU:T:2014:105, paragraph 63).

32 As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for goods or services which can meet their specific needs, the purpose or intended use

of the goods or services in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services. In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, *August Storck v EUIPO — Chiquita Brands (Fruitfuls)*, T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited).’

- 32 Having regard to those rules of law and case-law principles, the General Court examined, in paragraphs 33 to 36 of the judgment under appeal, whether the articles covered by the evidence provided by Taiga constituted an independent subcategory of goods in relation to the goods in Class 25 of the Nice Agreement, covered by the earlier mark, grouping only weather-protective outdoor clothing. As a first step, the General Court considered that those articles had ‘the same purpose, since they [were] intended to cover the human body, to conceal, adorn and protect it against the elements’ and that they could not ‘in any event, be regarded as “substantially different”, within the meaning of the case-law referred to in paragraph 31 of the judgment under appeal. As a second step, the General Court noted that the particular characteristics of those articles, namely those consisting in weather protection, were, in principle, irrelevant, in so far as, in accordance with the case-law cited in paragraph 32 of the judgment under appeal, ‘the characteristics of the goods are not, as such, relevant to the definition of subcategories of goods or services’. Accordingly, the General Court rejected the first plea in law.
- 33 Under the first sentence of Article 42(2) of Regulation No 207/2009, an applicant for an EU trade mark may require the proprietor of the earlier trade mark to furnish proof that the earlier mark has been put to ‘genuine use’ in the European Union during the period of five years preceding the date of publication of the trade mark application against which an opposition has been filed.
- 34 First of all, it must be recalled that the concept of ‘genuine use’ is an autonomous concept of EU law (see, to that effect, judgment of 11 March 2003, *Ansul*, C-40/01, EU:C:2003:145, paragraphs 25 to 31).
- 35 In that regard, in order for a mark to be regarded as being put to ‘genuine use’, within the meaning of the first sentence of Article 42(2) of Regulation No 207/2009, it is necessary that that mark be used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered for the consumer or end user by enabling him or her, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, to that effect, judgment of 17 October 2019, *Landeskammer für Land- und Forstwirtschaft in Steiermark v Schmid*, C-514/18 P, not published, EU:C:2019:878, paragraphs 36 and 37 and the case-law cited). Indeed, a trade mark which is not used obstructs not only competition — since it limits the range of signs which can be registered as trade marks by others and denies competitors the opportunity to use that trade mark or a similar one when putting on to the internal market goods or services which are identical or similar to those covered by the mark in question — but also the free movement of goods and services (judgment of 19 December 2012, *Merken*, C-149/11, EU:C:2012:816, paragraph 32).
- 36 In order that a trade mark may achieve that essential function, Regulation No 207/2009 confers on the proprietor of the mark a set of rights, while limiting them to what is strictly necessary for the performance of that function, as the Advocate General observed in point 40 of her Opinion.
- 37 Article 15 of Regulation No 207/2009 thus provides that there is no justification for protecting an earlier mark unless it is put to ‘genuine use in the Union in connection with the goods or services in respect of which it is registered’.

- 38 Article 42(2) of that regulation applies that principle of law in the specific context of opposition proceedings. The last sentence of Article 42(2) of that regulation provides that, if the earlier trade mark has been used in relation to part only of the goods or services for which it is registered, it is, for the purposes of the examination of the opposition, to be deemed to be registered in respect only of that part of the goods or services.
- 39 In that connection, it should be noted, as the Advocate General did in point 47 of her Opinion, that the breadth of the categories of goods or services for which the earlier mark was registered is a key element of the balance between, on the one hand, the maintenance and preservation of the exclusive rights conferred on the proprietor of the earlier mark and, on the other hand, the limitation of those rights in order to prevent a trade mark which has been used in relation to part of the goods or services being afforded extensive protection merely because it has been registered for a wide range of goods or services, which the General Court correctly took into account in paragraphs 29 to 31 of the judgment under appeal.
- 40 So far as concerns the concept of ‘part of the goods or services’ referred to in Article 42(2) of Regulation No 207/2009, it must be recalled that the Court has held, in the context of the application of Article 43(1) of that regulation, that a subcategory of the goods covered by an application for registration as an EU trade mark must be identified having recourse to a criterion enabling that subcategory to be delimited in a sufficiently precise manner (see, to that effect, judgment of 11 December 2014, *OHIM v Kessel medintim*, C-31/14 P, not published, EU:C:2014:2436, paragraph 37).
- 41 As the Advocate General noted in point 58 of her Opinion, the analysis carried out by the Court in that judgment can be transposed to the application of Article 42(2) of Regulation No 207/2009 since the definition of an independent subcategory of goods or services must be based on the same criteria, whether in relation to a request for restriction of the list of goods or services covered by the application for registration or an opposition, so as to make it possible, in the assessment of the likelihood of confusion, to compare the goods or services at issue, which are defined on the basis of the same criteria.
- 42 It follows, first, as the Advocate General noted in point 50 of her Opinion, that a consumer who wishes to purchase a product or service in a category that has been defined particularly precisely and narrowly, but within which it is not possible to make any significant sub-divisions, will associate all the goods or services belonging to that category with the earlier mark, such that that trade mark will fulfil its essential function of guaranteeing the origin of those goods or services. In those circumstances, it is sufficient to require the proprietor of the earlier mark to adduce proof of genuine use of that trade mark in relation to part of the goods or services in that homogeneous category.
- 43 Second, as the Advocate General noted in point 52 of her Opinion, with regard to goods or services in a broad category of goods, which may be sub-divided into several independent subcategories, it is necessary to require the proprietor of the earlier mark to adduce proof of genuine use of that mark for each of those autonomous subcategories. Indeed, if the proprietor of the earlier mark has registered his trade mark for a wide range of goods or services which he may potentially market, but which he has not done during the period of five years preceding the date of publication of the trade mark application against which it has filed an opposition, his interest in enjoying the protection of the earlier mark for those goods or services cannot prevail over his competitors’ interest in registering their trade mark for those goods or services.
- 44 With regard to the relevant criterion or criteria to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently, the Court has held, in essence, that the criterion of the purpose and intended use of the goods or services at issue is an



essential criterion for defining an independent subcategory of goods (see, to that effect, judgment of 11 December 2014, *OHIM v Kessel medintim*, C-31/14 P, not published, EU:C:2014:2436, paragraph 39).

- 45 It is in the light of those principles that it is necessary to examine, first of all, the first part of the first ground of appeal, according to which the General Court should have relied, in its analysis consisting in ascertaining whether there existed a coherent subcategory of the earlier mark capable of being viewed independently, on the goods for which the earlier mark is registered.
- 46 In that regard, it should be noted that it is apparent both from the wording of the last sentence of Article 42(2) of Regulation No 207/2009 and from paragraphs 39 to 42 of the present judgment that it is important to assess in a concrete manner — principally in relation to the goods for which the proprietor of the earlier mark has furnished proof of use of the earlier mark — whether those goods constitute an independent subcategory in relation to the goods falling within the class of goods concerned, so as to link the goods for which genuine use of the earlier mark has been proved to the category of goods covered by the application for registration of that trade mark.
- 47 The General Court examined, in paragraph 33 of the judgment under appeal, whether the articles referred to in the proof of use produced by Taiga constituted an independent subcategory in relation to the goods in Class 25 of the Nice Agreement, that is to say, in relation to the more general category for which the earlier trade mark was registered. In addition, the General Court correctly linked those articles to that more general category, before concluding, in paragraph 34 of the judgment under appeal, that those articles could not be regarded as substantially different.
- 48 Accordingly, the first part of the first ground of appeal must be rejected as unfounded.
- 49 Next, so far as concerns the second part of the first ground of appeal, the appellant criticises the General Court, in the first complaint thereof, for failing properly to apply the criterion of the purpose and intended use of the goods at issue in order to determine an independent subcategory of goods. That complaint must also be rejected as unfounded.
- 50 It is apparent from the judgment of 11 December 2014, *OHIM v Kessel medintim* (C-31/14 P, not published, EU:C:2014:2436, paragraphs 37 and 39 to 41) that the aim of the criterion of the purpose and intended use of the goods in question is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically, as the Advocate General observed in points 70 and 71 of her Opinion.
- 51 Accordingly, if, as in the present case, the goods concerned have several purposes and intended uses — as is often the case — determining whether there exists a separate subcategory of goods by considering in isolation each of the purposes that those goods may have will not be possible, contrary to what the appellant claims. Indeed, such an approach would not enable independent subcategories to be identified coherently and would have the effect, as the Advocate General noted in point 71 of her Opinion, of limiting excessively the rights of the proprietor of the earlier mark, inter alia in that his legitimate interest in expanding his range of goods or services for which his trade mark is registered would not sufficiently be taken into consideration.
- 52 The General Court was therefore right not to take into account each of the uses of the goods at issue — to cover, conceal, adorn or protect the human body — in isolation, those different uses combining for the purpose of putting those goods on the market, as the Advocate General noted in point 72 of her Opinion.
- 53 Last, the second complaint of the second part of the first ground of appeal, by which the appellant claims that the Court failed to take into account the fact that the goods were aimed at different publics and were sold in different shops, must also be rejected as unfounded, in so far as such criteria

are not relevant for defining an independent subcategory of goods, but for assessing the relevant public (see, to that effect and by analogy, judgment of 11 December 2014, *OHIM v Kessel medintim*, C-31/14 P, not published, EU:C:2014:2436, paragraphs 37 and 41).

54 Accordingly, the first ground of appeal must be rejected as unfounded.

### ***Second ground of appeal***

55 The second ground of appeal is divided into three parts.

#### *First part of the second ground*

##### *– Arguments of the parties*

56 By the first part of the second ground of appeal, the appellant claims that, since the General Court misapplied the conditions for genuine use of the earlier mark, it incorrectly came to the conclusion that the goods ‘clothing’ and ‘headgear’ covered by the mark applied for were identical to the goods covered by the earlier mark.

57 EUIPO and Taiga are of the view that the first part of the second ground of appeal must be dismissed as unfounded.

##### *– Findings of the Court*

58 In so far as the first part of the second ground of the appeal is based solely on an erroneous application of the conditions for genuine use of the earlier mark and the General Court did not, as is apparent from paragraphs 47, 52 and 53 of the present judgment, err in that regard, that part must be rejected as unfounded.

#### *Second part of the second ground*

##### *– Arguments of the parties*

59 By the second part of the second ground of appeal, which is divided into three complaints, the appellant challenges the General Court’s assessment of the conflicting signs’ visual, phonetic and conceptual similarity.

60 As far as the first complaint is concerned, the appellant considers that, had the General Court taken into account the unusual composition of the mark applied for, owing to the presence of ‘asymmetric consonants’ and the unusual spelling of that mark because of the group of letters ‘igh’, it would not have concluded that the conflicting signs were visually similar.

61 Regarding the second complaint, the appellant claims that the General Court incorrectly ‘assumed’, without any evidence, that the group of letters ‘ti’ was always pronounced ‘tai’. It is clear that that is not the case, however, and, therefore, that it was not required to adduce proof in that regard.

62 As regards the third complaint, the appellant criticises the General Court’s analysis whereby it found that the conceptual differences between the signs at issue had not been established in the territory of the European Union as a whole, such that those differences were not capable of counteracting the visual and phonetic similarities between those signs. First, contrary to what the General Court stated in

paragraph 71 of the judgment under appeal, the word ‘taiga’ has a ‘specific and immediate meaning’ not only for average consumers from the north and east of the ‘European continent’, but also for those from the south of the continent as well as for English-speaking consumers. Indeed, due to the undisputed size of the boreal forest, named the ‘taiga’, as well as its significance for the world as a whole, the term is part of the general education of the ‘European continent’ and beyond.

- 63 Second, the General Court was wrong not to apply its own case-law according to which, in order to conclude that there are conceptual differences between the signs at issue, it is sufficient that a term is understood in a part of the European Union.
- 64 EUIPO maintains that the first three complaints put forward in support of the second part of the second ground of appeal must be dismissed as inadmissible and that the first and third complaints must, in any event, be dismissed as unfounded.
- 65 Taiga is of the view that that part of the second ground must be rejected as unfounded.

– *Findings of the Court*

- 66 It must be noted that, by the first and second complaints of the second part of the second ground of appeal, the appellant seeks to have the Court make a fresh assessment of the phonetic and visual similarity of the signs at issue, without invoking any distortion of the facts or evidence by the General Court in that regard.
- 67 It should be recalled that, in accordance with the second subparagraph of 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 has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence submitted to it. The appraisal of those facts and evidence does not, therefore, save where they have been distorted, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal. The assessment of the visual and phonetic similarity of the signs at issue is an assessment of a factual nature (judgment of 19 March 2015, *MEGA Brands International v OHIM*, C-182/14 P, EU:C:2015:187, paragraphs 47 and 48 and the case-law cited).
- 68 Accordingly, the first and second complaints of the second part of the second ground of appeal must be rejected as inadmissible in so far as they seek a fresh assessment of the facts.
- 69 Moreover, to the extent that it must be considered that, under the second complaint, the appellant criticises the General Court’s application of the rules on the burden of proof, reproaching it for having ‘assumed’, without any evidence, that the group of letters ‘ti’ was always pronounced ‘tai’ and for having required the appellant to adduce evidence to the contrary, it should be recalled that, in paragraph 58 of the judgment under appeal, the General Court inter alia noted that the Board of Appeal had taken the view, in point 40 of the contested decision, that, at least for English-speaking consumers, the pronunciation of the syllables ‘ti’ and ‘tai’ of the marks at issue was identical. Furthermore, in paragraphs 60 to 62 of the judgment under appeal, the General Court approved the Board of Appeal’s conclusion that the signs at issue were phonetically identical, at least for English-speaking consumers, after having pointed out that the appellant had adduced no evidence to suggest that the sound of the first syllables ‘ti’ and ‘tai’ of the signs at issue was not identical for the English-speaking public.
- 70 The General Court did not err in law in taking into account the fact that the appellant had not adduced evidence to call into question the assessment of the Board of Appeal that the first syllables ‘ti’ and ‘tai’ was pronounced identically for the English-speaking public in approving that assessment. Indeed, first, that assessment was illustrated by an example taken from the *Oxford English Dictionary*,

as follows from point 40 of the contested decision. Second, in an action for annulment before the General Court, the onus is on the applicant to show the alleged errors which, in its view, vitiate the contested decision.

- 71 The second complaint of the second part of the second ground of appeal must, accordingly, be rejected as unfounded to the extent that it reproaches the General Court for having disregarded the rules on the burden of proof.
- 72 By the third complaint, in the first place, the appellant, in essence, criticises the General Court for finding, in paragraph 71 of the judgment under appeal, that there was nothing in the file to establish that the word ‘taiga’ had a ‘specific and immediate meaning’ for average English-speaking consumers and consumers from the south of the ‘European continent’.
- 73 By that line of argument, the appellant, without developing a legal argument aimed specifically at identifying the error of law vitiating the judgment under appeal, seeks to have the Court make a fresh assessment of the facts and evidence. In so far as it does not invoke any distortion of those elements, that line of argument must, accordingly, be rejected as inadmissible (see, to that effect, judgment of 13 November 2019, *Outsource Professional Services v EUIPO*, C-528/18 P, not published, EU:C:2019:961, paragraph 47 and the case-law cited).
- 74 In the second place, in so far as the appellant challenges the methodology and criteria applied by the General Court in its assessment of the conceptual similarity of the signs at issue, it actually reproaches it for having erroneously applied Article 8(1)(b) of Regulation No 207/2009, which is a question of law which can be subject to review by the Court of Justice on appeal (see, to that effect, judgment of 12 December 2019, *Der Grüne Punkt v EUIPO*, C-143/19 P, EU:C:2019:1076, paragraph 51 and the case-law cited).
- 75 The appellant criticises the General Court for finding, in paragraphs 67 and 71 of the judgment under appeal, that it had not shown that the word ‘taiga’ had a ‘specific and immediate meaning’ for the relevant public made up of EU consumers as a whole, when it is not apparent from the case-law of the General Court that the word in question must be understood by the whole of the relevant public. It is sufficient that only part of the relevant public associates the term in question with a particular concept to conclude that there are conceptual differences liable to counteract visual and phonetic similarities between the signs at issue for the whole of the relevant public.
- 76 The Court, however, has held that, where a proprietor of an EU trade mark opposes, pursuant to Article 8(1)(b) of Regulation No 207/2009, registration of a similar EU trade mark which would create a likelihood of confusion, such an opposition must be upheld where it is established that there is a likelihood of confusion in part of the European Union (judgment of 22 September 2016, *combit Software*, C-223/15, EU:C:2016:719, paragraph 26 and the case-law cited).
- 77 Consequently, if visual or phonetic similarities between the signs at issue exist for a substantial part of the relevant public, for which conceptual differences between those signs, liable to counteract those similarities, have not been proved, the General Court must carry out a global assessment of the likelihood of confusion (see, to that effect, judgment of 4 March 2020, *EUIPO v Equivalenza Manufactory*, C-328/18 P, EU:C:2020:156, paragraphs 74 to 76 and the case-law cited).
- 78 The General Court therefore did not err in law in taking into account the fact that the appellant had not adduced evidence that, for a substantial part of the relevant public, the term ‘taiga’ had a ‘specific and immediate meaning’.
- 79 Therefore, the second part of the second ground of appeal must be rejected as partly inadmissible and partly unfounded.

*Third part of the second ground*

*– Arguments of the parties*

- 80 By the third part of the second ground of appeal, the appellant claims that there is no likelihood of confusion on the part of the relevant public, within the meaning of Article 8(1) of Regulation No 207/2009, given that, with regard to the global assessment of that public, first, the signs at issue are marketed in different shops, second, the visual dissimilarities between the terms ‘taiga’ and ‘tigha’ are more important than any assumed phonetic similarities and, third, the goods at issue are similar to a low degree.
- 81 EUIPO considers that the third part of the second ground of appeal must be dismissed as inadmissible and, in any event, as unfounded.
- 82 Taiga contends that that part must be rejected as unfounded.

*– Findings of the Court*

- 83 The third part of the second ground of appeal must be rejected as unfounded since the appellant does not identify any paragraph of the judgment under appeal which it is challenging nor does it allege any error of law on the part of the General Court, but merely reiterates the line of argument it had already developed in its application at first instance (see, to that effect, judgment of 6 September 2018, *Basic Net v EUIPO*, C-547/17 P, not published, EU:C:2018:682, paragraph 43 and the case-law cited).
- 84 Accordingly, the second ground of appeal must be rejected as partly inadmissible and partly unfounded.
- 85 Having regard to the foregoing considerations, the appeal must be dismissed as partly inadmissible and partly unfounded.

**Costs**

- 86 Under Article 137 of the Rules of Procedure of the Court of Justice, applicable to the procedure on appeal pursuant to Article 184(1) of those rules, a decision as to costs is to be given in the judgment or order which closes the proceedings. Pursuant to Article 138(1) of those Rules of Procedure, which is also applicable 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.
- 87 Since EUIPO and Taiga have applied for costs to be awarded against the appellant and the latter has been unsuccessful, the appellant must be ordered to pay the costs of this appeal.

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

- 1. Dismisses the appeal;**
- 2. Orders ACTC GmbH to pay the costs.**

Arabadjiev

von Danwitz

Kumin

Delivered in open court in Luxembourg on 16 July 2020.



A. Calot Escobar  
Registrar

A. Arabadjiev  
President of the Second Chamber